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Tagging the Lanham Act

PROTECTING GRAFFITI ART FROM WILLFUL INFRINGEMENT

INTRODUCTION

Art has long been integral to society's sense of culture, life, and liberty, and conceptions of what constitutes art and who the artists are in our society have evolved in the thousands of years since our ancestors first sketched on cave walls. But as the role of art in society has changed, so have the demands for the legal protection of that art. Graffiti has gone from being known as the result of troubled youth tagging walls to commercially commissioned art, and monetizing graffiti is now a possibility. John F. Kennedy said, "If art is to nourish the roots of our culture, society must set the artist free to follow his vision wherever it takes him."¹ To achieve this, society must protect artists' ownership rights. Protecting artists' rights can be difficult, however, for nontraditional art forms like graffiti.

Graffiti has been described as a perennial feature "of life at the edges of the contemporary city."² While graffiti once signified urban blight, it has become a sought-after art form. It has been reprinted on commercial items and removed from its original location and displayed in galleries.³ Graffiti artists produce pieces that, like President Kennedy suggested, will nourish the roots of our culture if the artists are free to follow their vision. A recent example of this is the response to Banksy, the popular and elusive British graffiti artist. When Banksy created a piece depicting the

¹ *President John F. Kennedy: Remarks at Amherst College, October 26, 1963*, NAT'L ENDOWMENT FOR THE ARTS, <https://www.arts.gov/about/kennedy> [http://perma.cc/62NP-6T3F] (last visited Mar. 4, 2016); see Michelle Bougdanos, *The Visual Artists Rights Act and Its Application to Graffiti Murals: Whose Wall Is It Anyway?*, 18 N.Y.L. SCH. J. HUM. RTS. 549, 551 (2002) (quoting SIMON G. ARINK, JOHN F. KENNEDY: THE MAN AND THE PRESIDENCY 105 (1987)).

² Cameron McAuliffe, *Graffiti or Street Art? Negotiating the Moral Geographies of the Creative City*, 34 J. URB. AFF. 189, 189 (2012).

³ Cathay Y. N. Smith, *Street Art: An Analysis under U.S. Intellectual Property Law and Intellectual Property's Negative Space Theory*, 24 DEPAUL J. ART, TECH. & INTELL. PROP. 259, 262-63 (2013).

twin towers “looming over the Manhattan skyline,” one person described it as being “beautiful,” and people from across New York City flocked to see it before it was removed.⁴ Today, however, graffiti art is often reproduced and sold without the artists’ permission.⁵ One graffiti artist aptly framed the issue by stating that “people think that because our art is public and it is sometimes illegally painted, they could use it any way they want.”⁶

The unauthorized use of graffiti art has highlighted the need for better legal protections of graffiti art. For other art forms, the most common methods of protection—copyright and moral rights—do not similarly protect illegally created works of art. There are a few reasons why protecting graffiti art is particularly difficult. There is a normative intuition that the law should not protect something that is a product of illegal activity. Moreover, many graffiti artists do not want to sell their work—as one artist said, “many . . . [graffiti artists] feel that it is a breach of integrity to do this sort of stuff for profit.”⁷ Although many graffiti artists traditionally had no intention of profiting from their art (and thus protection was not needed), the fact that graffiti is becoming popular is leading others to profit from it illegitimately. Hence, artists need protection as a result of others’ unauthorized use.

This note considers a current case of graffiti art that is being used without authorization, explores various potential ways of protecting graffiti art, and evaluates the likelihood that such methods will be effective. Part I examines the roots and legal definition of graffiti art. It then considers whether graffiti art should be protected. Part II examines three sources of law—moral rights, copyright, and the Lanham Act—as possible avenues for protecting graffiti artists’ work. Finally, Part III argues that graffiti artists will likely be best protected by section 43(a) of the Lanham Act.

⁴ James Baron, *Racing to See Banksy, While It Can Still Be Seen*, N.Y. TIMES (Oct. 15, 2013), http://www.nytimes.com/2013/10/16/nyregion/racing-to-see-banksy-graffiti-while-it-can-still-be-seen.html?_r=0 [<http://perma.cc/7SNM-4R8B>].

⁵ Smith, *supra* note 3, at 264-65.

⁶ Jamison Davies, *Art Crimes?: Theoretical Perspectives on Copyright Protection for Illegally-Created Graffiti Art*, 65 ME. L. REV. 27, 29 (2012).

⁷ *Graffiti Q&A*, GRAFFITI, http://www.graffiti.org/faq/graffiti_questions.html [<http://perma.cc/T5AB-RYTT>] (last visited Mar. 4, 2016).

I. WHAT IS GRAFFITI, AND WHY SHOULD WE PROTECT IT?

Graffiti is a form of expression that dates back to the ancient Greeks and Egyptians.⁸ American graffiti can be traced to colonial times.⁹ In the 1960s, graffiti as we know it today emerged and included “everything from random scrawls to mural work.”¹⁰ Now, as the result of artists like Banksy, the legal system has accepted (if not legalized) the notion of graffiti, for better or worse, and many states have codified the definition of graffiti.¹¹

There are two general types of graffiti: graffiti vandalism and graffiti art. The distinction between the two categorizations often hinges on the creator’s motivation. Generally, the impetus behind graffiti vandalism is to break the law, whereas the motivation behind graffiti art is to create art.¹² Some graffiti artists have additional motivations for creating graffiti art—for example, one graffiti artist is motivated to create pieces because he believes it will “beautify and benefit business.”¹³ Graffiti art could benefit business by beautifying a building or attracting a new customer base. There have been cases in both federal and state courts that test the boundaries of what constitutes graffiti art.

A. *Recent Cases*

There are strong policy considerations that weigh in favor of protecting graffiti art. These stem from the same interests society has in protecting all other forms of art. Generally, an artist should “have the right to prevent the use of his or her name as the author of the work . . . in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation.”¹⁴ Graffiti artists have

⁸ Marisa A. Gómez, *The Writing on Our Walls: Finding Solutions Through Distinguishing Graffiti Art from Graffiti Vandalism*, 26 U. MICH. J.L. REFORM 633, 636 (1993).

⁹ *Id.* at 637.

¹⁰ *Id.* at 639.

¹¹ In Georgia, graffiti is defined as

any inscriptions, words, figures, paintings, or other defacements that are written, marked, etched, scratched, sprayed, drawn, painted, or engraved on or otherwise affixed to any surface of real property or improvements thereon without prior authorization of the owner or occupant of the property by means of any aerosol paint container, broad-tipped marker, gum label, paint stick, graffiti stick, etching equipment, brush, or other device capable of scarring or leaving a visible mark on any surface.

GA. CODE ANN. § 17-15A-2 (2012).

¹² Bougdanos, *supra* note 1, at 559; *see, e.g.*, Gómez, *supra* note 8, at 635.

¹³ Bougdanos, *supra* note 1, at 549.

¹⁴ *Id.* at 556.

attempted to exercise this right but have reached dead ends in many different sources of law. These artists claim that the unauthorized use of their work affects their reputation and creates the impression that the artists are “corporate ‘sellouts.’”¹⁵ But they do not feel that using intellectual property law as protection is selling out; generally, they view it as “quite the opposite.”¹⁶ In fact, some of these artists may feel that legal recognition and protection of graffiti art validates their works.

Recently, a dispute over the use of graffiti art has garnered media attention. Three graffiti artists filed a suit against Roberto Cavalli¹⁷ seeking damages and injunctive relief.¹⁸ The plaintiffs alleged that Cavalli introduced a clothing and accessories line called *Just Cavalli*, where each piece in the collection was covered with graffiti art derived from a mural that was used without the artists’ consent.¹⁹ The plaintiffs, Jason Williams, Victor Chapa, and Jeffrey Rubin, who are “known as Revok, Reyes, and Steel, respectively,” claimed that Cavalli’s use of their mural “in a clothing and accessories line was a willful infringement.”²⁰ The complaint alleged that Revok, Reyes, and Steel (the Artists) are three of street art’s most acclaimed figures whose work has been exhibited around the world, but that they “have never consented to lend their artwork to consumer products of any kind.”²¹ The complaint further contended that “one can easily discern” that *Just Cavalli* is a copy of the mural.²² The Artists claimed that the use of this well-known mural “has [damaged], and will continue to[] damage Plaintiffs’ reputations and careers.”²³ The complaint alleged five causes of action, including copyright infringement, unfair competition under the

¹⁵ Bill Donahue, *Graffiti Artists Sue Roberto Cavalli for Copying Mural*, LAW360 (Aug. 26, 2014, 2:43 PM), <http://www.law360.com/articles/570914/graffiti-artists-sue-roberto-cavalli-for-copying-mural> [<http://perma.cc/6FKE-2AKV>].

¹⁶ Elie, *Three Graffiti Artists File Suit Against Roberto Cavalli for Using Their Mural in New Fashion Lines Without Permission*, BOWERYBOOGIE.COM (Sept. 3, 2014, 6:05 AM), <http://www.boweryboogie.com/2014/09/three-graffiti-artists-file-suit-roberto-cavalli-using-mural-new-fashion-lines-without-permission/> [<http://perma.cc/4MXZ-GGTY>].

¹⁷ *Id.*

¹⁸ See generally Complaint, *Williams v. Cavalli*, No. 2:14-cv-06659 (C.D. Cal. Aug. 25, 2014).

¹⁹ Eriq Gardner, *It’s Official: Suing Over Graffiti Is Fashionable*, HOLLYWOOD REP. (Aug. 26, 2014, 2:22 PM), <http://www.hollywoodreporter.com/thresq/official-suing-graffiti-is-fashionable-728198> [<http://perma.cc/X3S2-7CP5>].

²⁰ Elie, *supra* note 16, at 2.

²¹ Complaint, *supra* note 18, at 2.

²² *Id.* at 3.

²³ *Id.* at 4.

Lanham Act, false designation of origin under the Lanham Act, and two state law claims (unfair competition and negligence).²⁴

The complaint further stated that “[n]othing is more antithetical to the outsider ‘street cred’ that is essential to graffiti artists . . . than the association with European chic, luxury and glamour—of which Cavalli is the epitome.”²⁵ The Artists claimed that the use of their mural was even more egregious than just unauthorized use because the work that Cavalli misappropriated included plaintiffs’ “stylized signatures from the [m]ural (literally, their names).”²⁶ Most of the mural was made up of the Artists’ personal signatures, which “is not uncommon to graffiti art.”²⁷ Plaintiffs claimed that, to make matters worse, Cavalli did some of his own painting over the Artists’ painting and “added what appears to be a signature, creating the false impression that Roberto Cavalli himself was the artist.”²⁸ In response to the suit, Roberto Cavalli has refused to admit any wrongdoing.²⁹ Cavalli’s spokesperson stated that in order to save time and money, they were looking “to discuss a mutually agreeable resolution of the issues.”³⁰ On February 12, 2015, a district court in the Central District of California held that because the mural had source-identifying attributes, Cavalli had violated section 43(a) of the Lanham Act.³¹

B. Policy Considerations

Graffiti artists should have legal avenues to protect their art. And while there are strong policy reasons for protecting graffiti art, there are also policy reasons against legally protecting graffiti artists. The arguments for protection include recognition of artists’ works, progression of the arts, and encouraging artistic expression. While the majority of graffiti artists are not seeking to display their art in galleries, graffiti artists should still be able to

²⁴ *Id.* at 9-16.

²⁵ *Id.*

²⁶ Elie, *supra* note 16, at 2.

²⁷ Complaint, *supra* note 18, at 7.

²⁸ Gardner, *supra* note 19.

²⁹ Lauren Milligan, *Cavalli Bites Back in Graffiti Case*, VOGUE (Aug. 29, 2014), <http://www.vogue.co.uk/news/2014/08/29/roberto-cavalli-responds-to-graffiti-lawsuit> [<http://perma.cc/97NG-LU2S>].

³⁰ *Id.*

³¹ Order Denying Motion to Dismiss, *Williams v. Cavalli*, No. 2:14-cv-06659 (C.D. Cal. Aug. 25, 2014), <https://thestyleofthecase.files.wordpress.com/2015/02/denied.pdf> [<http://perma.cc/ZNS5-4ZA5>].

protect their ownership of their art.³² Failing to provide legal protection to graffiti artists inhibits the “advancement and progression of the arts.”³³ The proponents of graffiti art “recognize that some works have extraordinary merit and deserve both recognition and preservation.”³⁴ Proponents also feel that graffiti artists are not motivated by a desire to vandalize, but rather to express themselves or “to gain respect by the only means that are accessible to them.”³⁵

On the other side of the argument, many citizens and public officials wish to eradicate graffiti and are enraged by the effort and cost associated with graffiti removal.³⁶ Lawmakers have come up with creative ways to prevent graffiti, including “regulating the sale of graffiti instruments . . . forcing property owners to pay for graffiti removal; developing and using graffiti-resistant materials on buildings; enforcing curfew restrictions for minors; focusing efforts on immediate cleanup; and using murals and commissioned works both to promote and prevent graffiti art.”³⁷ Those opposed to graffiti argue that graffiti is vandalism, notwithstanding its artistic value.³⁸

Additionally, opponents feel that graffiti is “ugly, invites criminal activity, indicates neighborhood decay and is done by criminals who should be punished.”³⁹ Moreover, they argue that it is very costly.⁴⁰ Mayor Rudy Giuliani of New York City was an advocate of the “‘broken window’ theory,” which posits that “an unfixed broken window in a building gives a city block the appearance of decay and disrepair, and thus encourages the congregation of lawless individuals, who see the physical deterioration as a sign that their shady activities will go unnoticed.”⁴¹ Mayor Giuliani believed that graffiti, like an unfixed broken window, signified urban decay.⁴² He further argued that “[o]nce the criminal element is established on a block or in a

³² Danwill Schwender, *Promotion of the Arts: An Argument for Limited Copyright Protection of Illegal Graffiti*, 55 J. COPYRIGHT SOC'Y U.S.A. 257, 257 (2007).

³³ *Id.* at 258.

³⁴ Lori L. Hanesworth, *Are They Graffiti Artists or Vandals? Should They Be Able or Caned?: A Look at the Latest Legislative Attempts to Eradicate Graffiti*, 6 DEPAUL-LCA J. ART & ENT. L. 225, 227 (1995).

³⁵ *Id.*

³⁶ *Id.*

³⁷ *Id.* at 234.

³⁸ *Id.* at 227.

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ Annette Hall, *The Mayor's Anti-Graffiti Task Force: May the Force Be With You*, COOPERATOR, <http://www.cooperator.com/articles/1201/1/The-Mayor8217s-Anti-Graffiti-Task-Force/Page1.html> [<http://perma.cc/EFR7-68XS>] (last visited Mar. 4, 2016).

⁴² *Id.*

neighborhood, law-abiding citizens start avoiding the area, leaving it to the miscreants and loiterers, and eventually the pestilence spreads outward into otherwise ‘healthy’ blocks.”⁴³

The problem with graffiti is that there are strong arguments on both sides of the policy debate. But since protecting art is considered so integral to our society, lawmakers should attempt to protect it while safeguarding against the problems identified by the opposition. Many of the arguments raised by Mayor Giuliani and other graffiti opponents might be less persuasive now, because fewer people think of graffiti as urban blight and instead consider it an act of expression. It may be time for a reevaluation of graffiti’s merit.

II. POTENTIAL LEGAL PROTECTIONS FOR GRAFFITI ART

Graffiti artists have three options for protecting their art against the kind of infringement that Cavalli committed against Revok, Reyes, and Steel, and the infringement discussed generally in Part I.⁴⁴ These options include suing under the Visual Artists Rights Act (VARA), copyright law, and the Lanham Act.

A. VARA and Moral Rights

The first potential source of law that might provide protection to graffiti artists is VARA, which codifies moral rights.⁴⁵ “The term ‘moral rights’ is a translation of the French term ‘droit moral,’ and refers . . . to the ability of authors to control the eventual fate of their works.”⁴⁶ Moral rights safeguard both the reputational and personal value of the work.⁴⁷ These rights were initially developed based on the belief that “[t]o deform an artist’s work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done.”⁴⁸ Moral rights exist separately from other rights, such as economic and property rights, and allow an author to “protect a work—essentially a piece of the

⁴³ *Id.*

⁴⁴ *See supra* Part I.

⁴⁵ 17 U.S.C. § 106A(b) (2012).

⁴⁶ Betsy Rosenblatt, *Moral Rights Basics*, HARV. L. SCH., <https://cyber.law.harvard.edu/property/library/moralprimer.html> [<http://perma.cc/EB3J-ERCE>] (last visited Mar. 4, 2016).

⁴⁷ *Id.*

⁴⁸ Brian T. McCartney, “Creepings” and “Glimmers” of the Moral Rights of Artists in American Copyright Law, 6 UCLA ENT. L. REV. 35, 39 (1998) (quoting Gilliam v. Am. Broad. Co., 538 F.2d 14 (2d Cir. 1976)).

author—from unauthorized treatment, even after relinquishing economic and property rights.”⁴⁹ The rights stem from the right of integrity that “prevents alteration of a creative artist’s work that would injure her honor or reputation.”⁵⁰ Moral rights give the artist the right to “(1) have her name associated with her work, (2) disavow her association with a work, and (3) prevent having another’s name associated with her work.”⁵¹ Moral rights were codified in 1990 by VARA, which created statutory moral rights and was essentially an extension of the Copyright Act.⁵²

VARA, based largely on state law and European notions of how to afford artists control over the fate of their works, “provides a visual artist with rights of integrity and attribution.”⁵³ VARA is, in part, the United States’ acceptance of the Berne Convention for the Protection of Literary and Artistic Works,⁵⁴ an international convention that provided creators, such as artists, with the means to control how their creations are used.⁵⁵ VARA, however, is not as protective as the Berne Convention. While the Berne Convention protects all works of art, VARA only protects *visual* works of art.⁵⁶

An artist who wishes to pursue a claim under VARA must prove that the graffiti is a “piece of visual art” of “recognized stature.”⁵⁷ The first element of a VARA claim, “piece of visual art,” is narrowly defined as a “painting, drawing, print, sculpture, or still photographic image.”⁵⁸ The success of a VARA claim often turns on the second element—“recognized stature.”⁵⁹ This element is considered to be a very high bar, and in an attempt to meet it, artists can present “testimony of artists, dealers, curators, collectors, and others who are involved in the creation and appreciation of art.”⁶⁰ As discussed above, and as the cases below show, while an artist can attempt to enforce moral rights, VARA’s application is very limited.⁶¹

⁴⁹ Bougdanos, *supra* note 1, at 552.

⁵⁰ McCartney, *supra* note 48, at 38.

⁵¹ *Id.*

⁵² 17 U.S.C. § 106A(b) (2012); *see also* Bougdanos, *supra* note 1, at 551.

⁵³ Bougdanos, *supra* note 1, at 551.

⁵⁴ *Id.* at 552.

⁵⁵ Berne Convention for the Protection of Literary and Artistic Arts, July 24, 1971, 102 Stat. 2853, 828 U.N.T.S. 222.

⁵⁶ Bougdanos, *supra* note 1, at 553.

⁵⁷ 17 U.S.C. § 106A(b).

⁵⁸ *Id.*; *see also* Bougdanos, *supra* note 1, at 553.

⁵⁹ 17 U.S.C. § 106A. *See generally* Bougdanos, *supra* note 1, at 550.

⁶⁰ 17 U.S.C. § 106A; *see also* Bougdanos, *supra* note 1, at 554.

⁶¹ Bougdanos, *supra* note 1, at 553.

In 1998, in *Hanrahan v. Ramirez*, a California judge found that a wall mural painted on the exterior of a liquor store did in fact meet the statutory requirements.⁶² The mural at issue in *Hanrahan* “depicted an anti-drug, alcohol and smoking message as a part of a community improvement plan.”⁶³ Three years after the mural was created, the owners of the store painted over half of the mural and put an advertisement in its place.⁶⁴ In response, the plaintiff in *Hanrahan* brought a lawsuit under the destruction clauses of VARA.⁶⁵ The court found that because the mural had been selected as a winner in a national contest and had widespread local support, it had recognized stature.⁶⁶

It is important to note, however, that judicial recognition of recognized stature will not occur in the large majority of graffiti art cases, as the stature element requires a factual determination and is applied on a case-by-case basis. For this reason, many works of graffiti art, excluding murals like the one discussed above, fall outside the scope of VARA. Courts have reflected this in holding that VARA does not apply to works of art that cannot be removed and are illegally placed on another person’s property without their consent.⁶⁷ Additionally, VARA only protects against the destruction of art—VARA cannot help artists who are attempting to prevent unauthorized copying and reproduction.⁶⁸

VARA rights are preservationist in nature because they apply only to original artwork.⁶⁹ Even when a litigant is pursuing preservation under VARA, however, the claims will likely fail. In *English v. BFC & R East 11th Street LLC*, the district court ruled that illegally created wall murals were not protected under VARA.⁷⁰ The court in *BFC* held that VARA “does not apply to artwork that is illegally placed on the property of others, without their consent, when such artwork cannot be removed from the site in question.”⁷¹

⁶² See *Hanrahan v. Ramirez*, No. 2:97-CV-7470 RAP RC, 1998 WL 3439997, at *4 (C.D. Cal. June 3, 1998).

⁶³ Bougdanos, *supra* note 1, at 564.

⁶⁴ See *Hanrahan*, 1998 WL 3439997, at *2.

⁶⁵ *Id.*

⁶⁶ *Id.*; see Bougdanos, *supra* note 1, at 564.

⁶⁷ Smith, *supra* note 3, at 268 (citing *English v. BFC & R East 11th St. LLC*, No. 97 Civ. 7446(HB), 1997 WL 746444, at *1 (S.D.N.Y. Dec. 3, 1997)).

⁶⁸ See *supra* Section I.B.

⁶⁹ Celia Lerman, *Protecting Artistic Vandalism: Graffiti and Copyright Law*, 2 N.Y.U. J. INTELL. PROP. & ENT. L. 295, 330 (2013).

⁷⁰ *English*, 1997 WL 746444, at *5.

⁷¹ *Id.*

The very nature of graffiti makes removal without complete destruction impossible.⁷² Additionally, VARA provides that its protections are limited to those listed in section 113(d),⁷³ which “protects a real property owner’s rights to improve, renovate, or raze their property by declining copyright protection for any ‘work of visual art [that] has been incorporated in or made part of a building’” even when it would cause “destruction, distortion, mutilation, or other modification of the work.”⁷⁴ Thus, although VARA offers protection to graffiti artists in limited circumstances, it will not provide the kind of protection that artists like Revok, Reyes, and Steel are seeking. The next type of claim that graffiti artists could try to use to enforce their rights is one arising under copyright law.

B. Copyright

In addition to protections under VARA, graffiti artists can also seek protection for their work under copyright law. But this route to protection provides its own obstacles for graffiti artists.

To be protected under copyright law, a work of art must be an “(1) original (2) work of authorship (3) fixed in a tangible medium of expression from which it can be perceived.”⁷⁵ In order to state a copyright infringement claim, a plaintiff “must allege ownership of the copyright, registration, and infringement.”⁷⁶ And “[u]nder U.S. copyright law, if a street artist creates an unsanctioned work on another party’s building or wall, the real property owner owns the ‘material object’ or ‘tangible medium,’ and therefore owns the actual physical copy of the artwork.”⁷⁷

These elements were applied in a case in the Northern District of Illinois, *Villa v. Pearson Education*, where a graffiti artist brought an action for copyright infringement after his artwork was reproduced without his permission.⁷⁸ The court listed three factors that would impact the extension of copyright protection to graffiti art: (1) registration, (2) legality of the

⁷² Al Roundtree, *Graffiti Artists “Get Up” in Intellectual Property’s Negative Space*, 31 CARDOZO ARTS & ENT. L.J. 959, 970 (2013).

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ John Eric Seay, *You Look Complicated Today: Representing an Illegal Graffiti Artist in a Copyright Infringement Case Against a Major International Retailer*, 20 J. INTELL. PROP. L. 75, 79-80 (2012).

⁷⁶ *Villa v. Pearson Educ., Inc.*, No. 03 C 3717, 2003 U.S. Dist. LEXIS 24686, at *2 (Dec. 9, 2003) (citing *Sweet v. City of Chicago*, 953 F. Supp. 225, 227 (N.D. Ill. 1996)).

⁷⁷ Smith, *supra* note 3, at 267.

⁷⁸ *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686, at *1.

creation, and (3) level of “creativity exhibited in [the] original [artwork].”⁷⁹ The defendants argued that Villa could not obtain copyright protection because the mural was illegally created and incorporated words and letters.⁸⁰ The court declined to rule on those two issues, deeming them factual questions, which are improper on a 12(b)(6) motion.⁸¹ The court did indicate that looking into these assertions “first would require a determination of the legality of the circumstances under which the mural was created . . . [and] second would necessitate an evaluation of the degree of creativity exhibited in [the artist’s] original mural.”⁸²

While a claim like the one in *Villa* facially fulfills the factors that courts consider for a copyright claim, courts have left the door open to “potentially excluding ‘illegal’ street art from traditional intellectual property protection.”⁸³ *Villa* does this by placing two potential hurdles in front of graffiti artists seeking protection under copyright law: legality and creativity.⁸⁴ After *Villa*, one commentator stated that courts will “be reluctant to grant copyright protection to a piece of unsanctioned street art, or may allow ‘illegality’ to be raised as a[n] . . . ‘unclean hands’ defense” to copyright infringement.⁸⁵

One commentator has argued that “[f]ailing to provide copyright protection to these artists inhibits the advancement and progression of the arts, which directly conflicts with the basic purpose of the Copyright Act.”⁸⁶ Regardless, after *Villa*, it will be hard for a potential litigant to overcome the unclean hands defense, which could work to preclude copyright protection for graffiti artists. “[T]here is [also] a strong normative intuition that a work made in violation of the law should not be entitled to copyright protection.”⁸⁷ That is, there is a moral feeling that there should not be a capital gain from breaking the law.⁸⁸ This is generally referred to as the unclean hands doctrine.⁸⁹ Courts like that in *Villa* have recognized the unclean hands doctrine as a defense in copyright infringement cases.⁹⁰ “The doctrine of

⁷⁹ *Id.* at *7.

⁸⁰ *Id.* at *2.

⁸¹ *Id.*

⁸² *Id.* at *3.

⁸³ Smith, *supra* note 3, at 264.

⁸⁴ *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686, at *7.

⁸⁵ Smith, *supra* note 3, at 265-66.

⁸⁶ Schwender, *supra* note 32, at 258.

⁸⁷ Davies, *supra* note 6, at 29.

⁸⁸ *Id.*

⁸⁹ *Id.* at 29-30.

⁹⁰ See *Villa v. Pearson Educ., Inc.*, No. 03 C 3717, 2003 U.S. Dist. LEXIS 24686, at *1 (Dec. 9, 2003); see also Schwender, *supra* note 32, at 258.

unclean hands, originally an equitable defense, essentially states that a plaintiff should not profit from his wrongdoing.”⁹¹ This could be one major stumbling block to a graffiti artist seeking protection under U.S. copyright law.

Even if courts allow copyright protection of graffiti art after *Villa*, defendants like Cavalli will likely be able to get around this protection because copyright law will not prevent the removal and sale of works of art.⁹² If Cavalli simply paid the owner of the wall for the art, he would own it and could freely reproduce it. Thus while copyright law offers graffiti artists a potential avenue for protection, it is untested, and as discussed above,⁹³ is treated somewhat harshly by the courts.⁹⁴ Additionally, at least one of the claims by graffiti artists alleging violations of copyright law has settled out of court, and if that continues, there will be little precedent to guide courts and litigants.⁹⁵

C. *The Lanham Act*

1. Unfair Competition

A claim of unfair competition under the Lanham Act is a claim of trade dress infringement. Trade dress is defined as “[t]he design and shape of the materials in which a product is packaged.”⁹⁶ A trade dress can be the product design, configuration, or shape. Section 43(a) of the Lanham Act will protect the trade dress if it “serves the same source-identifying function as a trademark.”⁹⁷ The Lanham Act will also protect a trade dress that has not been federally registered,⁹⁸ but it is important to note that there is no “product” in a graffiti case.

A design must be distinctive in order to be protected under the Lanham Act.⁹⁹ Although section 43(a) of the Lanham Act does not require a distinctive trade dress in order for a work of art to receive the Act’s protections, courts have collectively enforced that requirement.¹⁰⁰ As the court stated in *Wal-Mart v. Samara Bros.*, without the element of distinctiveness, it is unlikely that the use

⁹¹ Schwender, *supra* note 32, at 258.

⁹² Smith, *supra* note 3, at 266-67.

⁹³ See *supra* Section II.B.

⁹⁴ Davies, *supra* note 6, at 38.

⁹⁵ *Id.* at 28.

⁹⁶ *Trade Dress Definition*, LEGAL INFO. INST., http://www.law.cornell.edu/wex/trade_dress [<http://perma.cc/8ZXV-AL74>] (last visited Mar. 4, 2016).

⁹⁷ *Id.*

⁹⁸ *Id.*; 15 U.S.C. § 1125(a) (2012).

⁹⁹ See generally *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205 (2000).

¹⁰⁰ *Id.* at 210.

of a trade dress would cause confusion, so it follows logically that the “distinctive” element is required.¹⁰¹ In *Wal-Mart v. Samara Bros.*, Wal-Mart was selling “a line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like,” which mirrored Samara’s product line.¹⁰² At the time, a representative from JC Penny, which was under contract with Samara to sell the clothing line, saw the products at Wal-Mart and thought they were Samara products. JC Penny complained to Samara that Wal-Mart was selling the Samara product at a lower price than that which JC Penny was contractually permitted to sell the clothes.¹⁰³ JC Penny, upon discovering that the clothes being sold at Wal-Mart were not actually Samara’s, filed a lawsuit claiming that Wal-Mart had infringed on their trade dress and that it amounted to unfair competition under the Lanham Act.¹⁰⁴ The trial court found that this clothing line had a distinctive trade dress that could be protected by section 43(a) of the Lanham Act.¹⁰⁵ But the Supreme Court reversed the decision, holding that “in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning,” and the court held that Samara had not made the requisite showing that the clothing had secondary meaning.¹⁰⁶

According to the Court, a mark can be distinctive in two ways.¹⁰⁷ First, a mark can be inherently distinctive, meaning that its “intrinsic nature serves to identify a particular source.”¹⁰⁸ Second, a mark can acquire distinctiveness when “it has developed secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’”¹⁰⁹

Graffiti artists can claim that the trade dress is their signature or style because it identifies a particular source. The rationale is that the artist has worked for years to develop a certain reputation, which allows the public to easily identify the

¹⁰¹ *Id.*

¹⁰² *Id.* at 207.

¹⁰³ *Id.* at 208.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at 216.

¹⁰⁷ *Id.* at 210-11.

¹⁰⁸ *Id.* at 210 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)).

¹⁰⁹ *Id.* at 211 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 & n.11 (1982)).

work as the artist's, and therefore the use of the artist's signature or style amounts to an infringement of the artist's trade dress.¹¹⁰ The artist's signature would have secondary meaning where, upon seeing a famous graffiti artist's signature, one could identify the creator of a particular work of art.¹¹¹ Therefore, infringement of a trade dress would be a potentially viable claim for a graffiti artist seeking protection from unauthorized commercial use of their art. The only limiting factors in this claim would be the artist's popularity and how well known the signature is. "[T]he minds of the public"¹¹² language suggests that a large number of people must be misled in identifying the source of the product.

2. False Designation of Origin

The Lanham Act protects all aspects of registered trademarks.¹¹³ "In addition to protecting registered marks, the Lanham Act, in § 43(a), gives a producer a cause of action for the use by any person of 'any word, term, name, symbol, or device, or any combination thereof... which... is likely to cause confusion... as to the origin...'"¹¹⁴ This protection does not allow one to use "false designations of origin, false descriptions, and false representations in the advertising and sale of goods and services."¹¹⁵ But the Act "does not prohibit false statements generally. It prohibits only false or misleading descriptions or false or misleading representations of fact made about one's own or another's goods or services."¹¹⁶ A false designation of origin is a statutory, federal tort apart from common law unfair competition and is not limited to lawsuits between business competitors.¹¹⁷ Additionally, it does not require ownership of a registered trademark.¹¹⁸ Specifically, Congress enacted section 43(a) to codify the common law-defined act of "passing off," which is the representation of one person's goods or works as those of

¹¹⁰ Complaint, *supra* note 18, at 10-12.

¹¹¹ See *Wal-Mart Stores*, 529 U.S. at 211.

¹¹² *Id.*

¹¹³ 15 U.S.C. § 1125(a) (2012).

¹¹⁴ *Wal-Mart Stores*, 529 U.S. at 211 (quoting 15 U.S.C. § 1125(a)).

¹¹⁵ *Herb Reed Enters., Inc. v. Monroe Powell's Platters, LLC*, 25 F. Supp. 3d 1316, 1321 (D. Nev. 2014) (quoting *Jack Russell Terrier Network of N. Ca. v. Am. Kennel Club, Inc.*, 407 F.3d 1027, 1036 (9th Cir. 2005)).

¹¹⁶ *Groden v. Random House, Inc.*, 61 F.3d 1045, 1052 (2d Cir. 1995). See generally 15 U.S.C. § 1125 (2012).

¹¹⁷ *Origin, representations concerning*, ALR Digest Antitrust and Trade Regulation [West] (2015) (citing 15 U.S.C.A. § 1125(a)).

¹¹⁸ *Id.*

another.”¹¹⁹ Judge Clark of the U.S. Court of Appeals for the Second Circuit, in a concurring opinion discussing the scope of section 43(a) of the Lanham Act, said that it is a “quite extensive provision covering the false description or representation of goods introduced into commerce . . . [and] there is indication . . . that the bar has not yet realized the potential impact of this statutory provision.”¹²⁰

When looking to this provision of the Lanham Act, it is important to consider the common law background and the legislative history of the Act.¹²¹ The need for the protections afforded by section 43(a) of the Lanham Act was realized well before it was enacted.¹²² Efforts to carve out a statutory protection for misuse of designations of origin can be traced to 1918, when it was deemed necessary to implement domestic legislation reflecting the United States’ ratification of the Buenos Aires Convention of 1910.¹²³ Article VIII of the Buenos Aires Convention provides that “the false representation as to the origin of a product, shall be prosecuted by the interested party in accordance with the laws of the State wherein the offence is committed.”¹²⁴ When this idea was codified in 1920, it “provided a federal statutory basis for private protection against one particular type of unfair competition not resulting from the infringement of a registered trademark.”¹²⁵ The Lanham Act has now superseded section 3 of the Act of March 19, 1920 (1920 Act),¹²⁶ but it is interesting to note that this section of the 1920 Act was of “such limited application as to deprive it of almost all practical use.”¹²⁷ The Lanham Act was intended to cover more false designation of origin claims and be less restrictive.¹²⁸

Had section 3 of the 1920 Act been applicable to a graffiti case like the one brought against Cavalli and other infringements similar to those discussed in Part I,¹²⁹ the claim would likely have

¹¹⁹ Denine C. Pagano, “*Origin of Goods*”: *Delving Into Dastar Corp. v. Twentieth Century Fox Film Corp.*, ST. JOHN’S J. LEGAL COMMENT. 421, 422 (2005).

¹²⁰ *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538, 546 (2d Cir. 1956) (Clark, C.J., concurring).

¹²¹ Walter J. Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, 32 N.Y.U. L. REV. 1029, 1032 (1957).

¹²² *Id.* at 1033.

¹²³ *Id.* (footnote omitted).

¹²⁴ *Id.*

¹²⁵ *Id.* at 1034.

¹²⁶ Act of March 19, 1920, Pub. L. No. 163-104, 41 Stat. 533.

¹²⁷ Walter J. Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, 32 N.Y.U. L. REV. 1029, 1034-35 (1957).

¹²⁸ *Id.* at 1035.

¹²⁹ *See supra* Part I.

been successful. Section 3 of the 1920 Act “referred only to false designation of *origin*, thereby excluding from its scope any other forms of misdescription or misrepresentation”; further, “[t]he section was limited to articles of *merchandise* . . . [and] required a showing that the use of the false designation of origin occurred ‘willfully and with intent to deceive.’”¹³⁰ The case against Cavalli satisfies these elements. Cavalli did not create the art, so a false designation occurred, and the act was likely willful because he took pictures of the art and printed it knowing he did not design it. Thus, it does not follow that the Lanham Act is *less restrictive*, because the use of graffiti as alleged in *Cavalli* would not be covered by it.

For a valid claim under section 43 of the Lanham Act for false designation of origin, a litigant must prove three elements: “(1) The alleged violator must employ a false designation; (2) the false designation must deceive as to origin, ownership or sponsorship; and (3) the plaintiff must believe that ‘he or she is or is likely to be damaged by such [an] act.’”¹³¹

Courts consider the following factors when making the determination of likelihood of confusion: “(1) strength of the mark; (2) proximity or relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels; (6) type of goods and degree of purchaser care; (7) intent in selecting mark; and (8) likelihood of expansion.”¹³² In this inquiry, no one factor is dispositive, and not all of the factors will apply in every case.¹³³ The question of confusion is one of fact, and thus “[t]he state of mind of the public must be the basis for the court’s determinations but the plaintiff is not required to prove the likelihood of confusion at the pleading stage.”¹³⁴

One court has found that under section 1125(a) of the Lanham Act, there was a valid claim of infringement when a work was edited without the consent of the writers and thus departed substantially from the original work.¹³⁵ In *Gilliam v. American Broadcasting*, the art being transformed was a Monty Python comedy skit that before being aired was edited to such an extent

¹³⁰ Derenberg, *supra* note 127, at 1034-35; *see* Act of March 19, 1920, 41 Stat. 533.

¹³¹ *Am. Online, Inc. v. IMS*, 24 F. Supp. 2d 548, 551 (E.D. Va. 1998) (citing 15 U.S.C. § 1125(a)(1) (2012)).

¹³² *Herb Reed Enters. v. Monroe Powell’s Platters, LLC*, 25 F. Supp. 3d 1316, 1324-25 (D. Nev. 2014); *Walter v. Mattel, Inc.*, 210 F.3d 1108, 1111 (9th Cir. 2000); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

¹³³ *Herb Reed Enters.*, 25 F. Supp. at 1325.

¹³⁴ *F.E.L. Publ’n, Ltd. v. Nat’l Conference of Catholic Bishops*, 466 F. Supp. 1034, 1044 (N.D. Ill. 1978).

¹³⁵ *Gilliam v. Am. Broad. Co.*, 538 F.2d 14, 17 (2d Cir. 1976).

that it changed the nature of the work. The court in *Gilliam* stated that “[t]o deform . . . [an artist’s] work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done [Thus] it is the writer or performer, rather than the network, who suffers the consequences of the mutilation”¹³⁶ The court further stated that “an allegation that a defendant has presented to the public a ‘garbled,’ distorted version of plaintiff’s work seeks to redress the very rights sought to be protected by the Lanham Act, 15 U.S.C. § 1125(a), and should be recognized as stating a cause of action under that statute.”¹³⁷ After *Gilliam*, changing the nature of the work has become a high water mark for other courts in deciding whether or not the Lanham Act will provide protection.

The district court in *Choe v. Fordham* made it clear that for protection under the “changing the nature of the work” standard, the level of deformation has to be radical and to such a point that the essential meaning of the artwork is lost.¹³⁸ This “high water mark” is potentially insurmountable for graffiti artists because it can be argued that their work is not radically changed when, for example, someone takes a picture of the art and then sells the image. But if the action of photographing and reselling an image is recast as changing the meaning of the original work, graffiti artists might overcome this high bar. Printing a work of graffiti art on various goods takes the art out of context and may constitute a radical deformation of the work.

After getting over the bar of the standard, a plaintiff must show that the defendant substantially distorted the original work.¹³⁹ Finally, the mark must almost automatically identify the source.¹⁴⁰ One potential problem graffiti artists might face in seeking protection under the Lanham Act is that it “is designed to make actionable the misleading use of marks in interstate commerce and to protect those engaged in interstate commerce against unfair competition,” and technically these artists are not engaged in interstate commerce with their works.¹⁴¹

In a case in the Eastern District of Virginia, *America Online, Inc. v. IMS*, a marketing company accidentally sent 60 million unauthorized email advertisements containing “aol.com”

¹³⁶ *Id.* at 24.

¹³⁷ *Id.* at 24-25 (citation omitted).

¹³⁸ *Choe v. Fordham Univ. Sch. of Law*, 920 F. Supp. 44, 47-48 (S.D.N.Y. 1995).

¹³⁹ *Lish v. Harper’s Magazine Found.*, 807 F. Supp. 1090, 1106-07 (S.D.N.Y. 1992); *Follet v. New Am. Library Inc.*, 497 F. Supp. 304, 311-12 (S.D.N.Y. 1980).

¹⁴⁰ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).

¹⁴¹ *Am. Online, Inc. v. IMS*, 24 F. Supp. 2d 548, 551 (E.D. Va 1998).

in the subject line.¹⁴² The plaintiffs alleged a claim of trademark infringement under the Lanham Act.¹⁴³ The court held that AOL had pled a claim on which relief could be granted because people were likely to be confused about whether the email came from AOL itself.¹⁴⁴ The court reasoned, “[a]ny email recipient could logically conclude that a message containing the initials ‘aol.com’ in the header would originate from AOL’s registered intent domain.”¹⁴⁵ The same is true of the false designation of a graffiti artist’s work. Any follower of a famous graffiti artist, upon seeing his signature on goods and services, could logically conclude that the graffiti artist was working for the company.

One potential hurdle to using the Lanham Act as a source of protection for graffiti art is that *Dastar Corp. v. Twentieth Century Fox* potentially closes the door on the Lanham Act being a source of viable protection for graffiti artists. While it has not yet been argued, it is conceivable that if many graffiti artists begin seeking protection, it will be. However, *Dastar* is distinguishable from the issues presented by the unauthorized commercial use of graffiti. Recently, in the case against Cavalli, the argument that *Dastar* precludes the Lanham Act from protecting graffiti artists was used and denied.¹⁴⁶ The court held that *Dastar* only dealt with reverse passing off, and that is not what the Artists in the case against Cavalli were alleging. Rather, the allegations were “that Defendants’ use of [plaintiff Chapa’s] ‘revolutions’ imagery created the ‘false and deceptive impression that the *Just Cavalli* garments and accessories are associated with and/or manufactured by [Chapa] and Plaintiffs.”¹⁴⁷ Therefore, the plaintiffs were claiming that Cavalli sold products with their source-identifying images. The court stated, “[t]his conduct constitutes passing off, which occurs when a producer sells its own goods while misrepresenting that they were made by another.”¹⁴⁸ The court then concluded that since this constituted passing off, and not reverse passing off, *Dastar* did not preclude Chapa’s Lanham Act claim.

In *Dastar*, the author of a book about World War II granted exclusive television rights to Twentieth Century Fox Film

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ Order Denying Motion to Dismiss, *supra* note 31.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

Corporation (Fox).¹⁴⁹ The writer renewed the book's copyright in 1975, but Fox did not renew the television series, which left the series in the public domain.¹⁵⁰ In 1988, Fox then reacquired the television rights.¹⁵¹ Dastar Corporation released a video in 1995 entitled "World War II Campaigns in Europe," which it made from tapes of the original version of the television series.¹⁵² The tapes were acquired from the public domain.¹⁵³ Fox filed suit, alleging that Dastar's sale of the video without proper credit to Fox was reverse passing off under the Lanham Act.¹⁵⁴ The Supreme Court held that there was no false designation of origin, stating that "[b]ecause . . . Dastar was the 'origin' of the [physical] products it sold as its own, respondents cannot prevail on their Lanham Act claim."¹⁵⁵ The court went on to define "origin" as "the producer of the tangible product sold in the marketplace."¹⁵⁶ The Court went further to say "the phrase 'origin of goods' is . . . incapable of connoting the person or entity that originated the ideas . . . that 'goods' embody or contain."¹⁵⁷ According to the court, consumers do not generally care about the origin, and the Court stated that "the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers."¹⁵⁸

Based on the Court's holding that there was no Lanham Act violation because Dastar created the "physical product," one could imagine Cavalli arguing that he did not violate the Lanham Act because he too created the physical product being sold in the market. But the facts of *Dastar* are distinguishable from graffiti art cases, and the policy reasons for the Court's decision, particularly avoiding superfluity in protecting what copyright law already protects,¹⁵⁹ do not similarly inform graffiti art cases. Additionally, the holding that origin "refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods,"¹⁶⁰ does not include graffiti artists. In the case of graffiti, the artist is not simply the author of an idea, but rather, the artist actually produces a tangible item. The *Dastar* court reasoned that offering

¹⁴⁹ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25 (2003).

¹⁵⁰ *Id.* at 26.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 27.

¹⁵⁵ *Id.* at 38.

¹⁵⁶ *Id.* at 31.

¹⁵⁷ *Id.* at 32.

¹⁵⁸ *Id.* at 32-33.

¹⁵⁹ *Id.* at 35.

¹⁶⁰ *Id.* at 37.

Lanham Act protection to “communicative products” (such as the videos made by Dastar) “that are valued for the intellectual content that they convey . . . would cause trademark law to conflict with copyright law.”¹⁶¹ The court distinguished communicative products “from products that are valued for their physical qualities, like a hammer or a can of cola.”¹⁶² When graffiti art is viewed through this lens, it is clear that it is closer to the hammer and the can of cola because it is valued for its physical qualities. Therefore, using the Lanham Act to protect graffiti is not in conflict with copyright law in the way that protecting Fox’s videos would have been.

Even if graffiti was considered to be a communicative product, *Dastar* still does not preclude protection under the Lanham Act. “The Supreme Court reasoned it should follow that misinformation about the origin of a ‘communicative product’ can only be protected by the Lanham Act if that misinformation deals with the producer of the physical product itself.”¹⁶³ The use of art, particularly the art of a well-known graffiti artist, is not like identifying cola with Coke or Pepsi. By using the graffiti artists’ independent signatures, the confusion relates to the identity of the producer of the physical product itself. Therefore, if it is a communicative product, it is one that should be protected after *Dastar*.

III. THE LANHAM ACT IS THE BEST OPTION FOR PROTECTING GRAFFITI ART

Although graffiti artists appear to have a few options to protect their work, most of these options are not viable. In the current legal landscape, and as discussed below, the Lanham Act is the best route to protection. When deciding to bring a case, artists will have to decide which claims to plead. This will depend on what type of redress the artist is seeking. For example, if the artist wants to prevent the art’s destruction, VARA is the best choice, as those rights are preservationist in nature.¹⁶⁴ But if an artist wants to enjoin a designer from using the artist’s work without permission, VARA will not suffice.

¹⁶¹ Timothy C. Connor, *After Dastar: Can a Right of Attribution Still Exist Under § 43(a) of the Lanham Act?*, 9 INTELL. PROP. L. BULL. 11, 27-28 (2004).

¹⁶² *Id.*

¹⁶³ *Id.* at 15 (citing *Dastar*, 539 U.S. at 33).

¹⁶⁴ See *supra* Section II.A.

There are three significant obstacles for a graffiti artist seeking VARA's protections.¹⁶⁵ First, VARA rights are preservationist in nature and do not relate to reproduction. Second, VARA has a requirement that the work of art be of recognized stature, which sets a very high bar.¹⁶⁶ Finally, the unclean hands doctrine provides infringers with an affirmative defense.¹⁶⁷ For these reasons, VARA is not a viable option for graffiti artists seeking protection from unauthorized commercial uses of their art.

Copyright law is similarly unable to protect graffiti art. Graffiti artists face four main obstacles to securing copyright protection. First, the application of copyright law to graffiti is largely untested, and in the few cases that have been before a judge, the courts have treated the claim with hostility.¹⁶⁸ A greater problem is that graffiti artists' claims of infringement brought under copyright law tend to settle, which means there is little precedent to indicate whether a litigated copyright claim could be successful.¹⁶⁹ It is not clear why these cases settle, but one potential explanation is that because the outcome is unclear, there is more risk in allowing the courts to decide this question. Additionally, if a judge decides these cases, there will be a record that will have precedential value, whereas if there is a settlement, it can be secretive, where no one knows the specific details. Moreover, courts like the one in *Villa* strongly indicate that this type of claim will fail.

Villa put in place three main hurdles for artists like Revok, Reyes, and Steel in using copyright law to protect their work from uses like Cavalli's. First, the work must be registered; second, the work must be original; and third, illegality of creation can potentially be used as an affirmative defense.¹⁷⁰ The court in *Villa* said that it would look into the originality and the "degree of creativity exhibited in [the artist's] original mural."¹⁷¹ The court alluded to the fact that the use of "words and letters" might weigh against a finding of creativity in the mural and therefore prevent the satisfaction of the "creativity" element.¹⁷² The last and most significant problem *Villa* presents for copyright protection for

¹⁶⁵ See *supra* Section II.A; 17 U.S.C. § 106A (2012).

¹⁶⁶ See *supra* Section II.A; 17 U.S.C. § 106A.

¹⁶⁷ See *supra* Section II.A; 17 U.S.C. § 106A.

¹⁶⁸ See *supra* Section II.B; *Villa v. Pearson Educ., Inc.*, No. 03 C 3717, 2003 U.S. Dist. LEXIS 24686 (Dec. 9, 2003).

¹⁶⁹ See *supra* Section II.B; *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686.

¹⁷⁰ See *supra* Section II.B; *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686.

¹⁷¹ See *supra* Section II.B; *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686.

¹⁷² See *supra* Section II.B; *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686.

unauthorized commercial uses of graffiti is that it opens the door for the illegality of creation, or unclean hands, to be used as an affirmative defense, which results in courts' refusal to protect graffiti artists from this type of infringement.¹⁷³ Hence, copyright protection will likely not reach or protect graffiti art that is used in commercial products without the consent of the artist.

The last source of law available to graffiti artists, and the one with the most potential coverage for their infringement claims, is section 43(a) of the Lanham Act. This route to protection provides the best odds of success and presents artists with two different types of claims—unfair competition and false designation of origin.¹⁷⁴

First, an unfair competition claim under section 43(a) of the Lanham Act will be successful if it can be proved that the mark is inherently distinctive and has a secondary meaning.¹⁷⁵ Graffiti from a well-known artist can likely satisfy these elements. Murals, especially the one at issue in the case against Cavalli, are inherently distinctive. Additionally, each artist generally has a unique style that can be considered a trade dress. That trade dress develops secondary meaning and identifies the artist who painted it. An artist who is not well known enough may be unsuccessful in pursuing an unfair competition claim under the Lanham Act. Fortunately for Revok, Reyes, and Steel, they are well-known artists whose style and signatures would be easily identifiable by their followers.¹⁷⁶

Second, a false designation of origin claim under the Lanham Act is another viable option for potential protection and remedy for plaintiffs like Revok, Reyes, and Steel. They could likely prove the three elements needed to plead a claim for false designation, including that (1) a false designation was employed; (2) there is a likelihood of confusion; and (3) harm is caused. As to the first element, Roberto Cavalli and other potential defendants are employing false designations of origin by using the art. The second element is met because the art being used includes the Artists' signatures. In *America Online*, the use caused a likelihood of confusion because it included the company's signature. This is especially true when the signature is the artist's name, where people familiar with the artist's work would associate the signature with the work and therefore mistakenly believe the

¹⁷³ See *supra* Section II.B; *Pearson Educ.*, 2003 U.S. Dist. LEXIS 24686.

¹⁷⁴ See *supra* Section II.C; 15 U.S.C. § 1125 (2012).

¹⁷⁵ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-11 (2000).

¹⁷⁶ See *supra* Part I; Complaint, *supra* note 18, at 2.

artist had sold the designs to the infringer. Many graffiti artists have an online presence, as well, and their work is thus easily identifiable by their style, even if it is unsigned.¹⁷⁷ Third, it can be argued that the depiction and unauthorized use of their art causes harm to the reputations of graffiti artists, because as discussed above, some followers of these artists would assume they have “sold out.”¹⁷⁸

The Lanham Act elements could be satisfied for a graffiti claim, and the holding of *Dastar* does not get in the way. One way to frame the argument for protection of graffiti, notwithstanding the holding of *Dastar*, is that art is a “good” under the meaning the court subscribes to in *Dastar*, and graffiti is a form of art. Lanham Act protection should extend to graffiti because a “defendant’s failure to credit . . . is actionable only where the defendant literally repackages the plaintiff’s goods and sells them as the defendant’s own.”¹⁷⁹ Taking a picture of the artwork and reprinting it on a different product is the same as repackaging the good and reselling it as your own.

While *Dastar* has been extended to cases other than those involving the use of videos in the public domain, *Dastar* should not be extended to graffiti or art in general. It doesn’t seem to apply to the *Cavalli* case because Cavalli put a physical product in the marketplace, and he should not be allowed to infringe on the rights of the creator of the art that was reprinted on that physical product. Additionally, there are strong policy reasons for protecting graffiti and encouraging the creation of art, such as the advancement and protection of the arts.¹⁸⁰

Furthermore, in using the false designation of origin analysis, the unclean hands doctrine¹⁸¹ can be flipped on defendants like Roberto Cavalli to prevent them from profiting from their wrongdoing. Instead of allowing these defendants to use this affirmative defense as a shield to liability, the defense can instead be a sword for plaintiffs.

CONCLUSION

It is worth noting that graffiti artists whose art was illegally created might have difficulty seeking protection because of the normative values of the unclean hands doctrine. It is also

¹⁷⁷ Lerman, *supra* note 69, at 329.

¹⁷⁸ See *supra* Section I.B.

¹⁷⁹ Pagano, *supra* note 119, at 462.

¹⁸⁰ See *supra* Part II.

¹⁸¹ See *supra* Part III.

important to keep in mind that many claims of infringement brought by graffiti artists will likely settle, so it will be hard to consistently gauge what will or will not be a valid claim. But judging from past case law and society's changing thoughts on the value of graffiti art, the Lanham Act will potentially be a valid way to protect these works of art from unfair and unauthorized use.

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