

The doctrine of 'personality rights' in the uk



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The United Kingdom has never acknowledged a specific doctrine of 'personality rights'; the law provides neither coherent nor consistent protection, as the courts are 'sceptical about creating monopoly rights in nebulous concepts such as names, likeness or popularity'.^[1] Therefore celebrities and other high-profile individuals rely on a combination of passing off, trademark, copyright and privacy laws for protection of the commercial value of their personality. None of these were invented to protect personality rights; however they are gradually developing to adjust to the commercial reality of the value of celebrity merchandising and endorsements. Misleading the public by giving a false impression of endorsement of a product by a celebrity has been to commit the tort of passing off for over a decade.^[2] The tort of passing off was traditionally defined as 'nobody has the right to represent his goods as the goods of someone else'.^[3] The 'classical trinity' is necessary to succeed in passing off: 'the goodwill or reputation must be attached to the products or services of the plaintiff, the misrepresentation must lead to the confusion as to the source of the goods and services, and this confusion must cause damage to the claimant'.^[4] In the case of *Fenty & Ors v Arcadia Group Brands Ltd (t/a Topshop) & Anor*,^[5] high street fashion retailer Topshop licensed an image of popstar Rihanna's face from a photographer and printed it on a t-shirt without either her permission being sought nor obtained. Rihanna then sued for passing off. Mr Justice Birss applied the doctrine to the dispute. Although on very particular facts, Birss J found in favour of Rihanna and established a general principle that arguably goes against any celebrities who might have hoped to see the creation of a doctrine of personality rights. This decision develops the tort of passing off to

small degree whilst emphasising that, in each case, the facts are decisive. [6] The debate about the recognition of personality rights in the UK is gathering impetus in the wake of *Fenty* with academics like Walsh questioning if 'personality rights are finally on the agenda'. [7]

In the 1970s the UK courts were regularly unwilling to find false impressions relating to merchandising resulted in misrepresentation because of the need to show that they were engaged in a 'common field of activity'. This introduced a somewhat blunt test for confusion and there often would be no proximity between, for example, a radio broadcaster and a cereal manufacturer. [8] Until the test was discarded, at least as an absolute condition, [9] it limited attempts to expand the categories of misrepresentation to cover licensing connections. [10] Where the absence of a common field of activity was not conclusive the court for example held the use of the name of the pop group Abba on merchandise did not amount to passing off on the basis that there was no real possibility that the public would be confused into thinking that Abba had approved the goods merely because their name or photograph appeared on them. [11] Likewise the use of a photograph of the Spice Girls on the cover of a sticker collection was held not to constitute passing off. [12] An important exception came when it was held passing off had been established where cartoon characters, the Teenage Mutant Ninja Turtles, were on clothing without authorisation, since the public did expect the goods to be licensed. [13] This case was distinguished from the Abba scenario on the basis that it was brought in the context of the unauthorised reproduction of images of cartoons in which

copyright existed, rather than the image or name of a celebrity. Yet the decision is generally viewed as opening up character merchandising law in the UK.

In the seminal case of *Irvine* Laddie J held passing off covered cases of false endorsement, like where Talksport had altered an image of racing driver Eddie Irvine to have him hold a branded Talksport radio for advertising purposes without his permission. Laddie J considered the increasingly popular marketing practice of personality licensing, including the licensing of a personality's name or likeness outside a celebrity's area of expertise as a common and lucrative practice for them, to reject the 'common field of activity' condition. Laddie J identified the inherent flexibility of passing off by saying 'the sort of cases which come within the scope of a passing off action has not remained stationary over the years...passing off is closely connected to and dependent upon what is happening in the market place'.^[14] Although *Irvine* was celebrated as a turning point in the protection of personality rights, the important limitation in the judgment was that passing off was limited to false endorsement and excluded merchandising cases. The classic celebrity-merchandising situation seems similar: the celebrity has a reputation and the public knows that it is common practice for celebrities to market their popularity by granting merchandise licenses.^[15] Laddie J differentiated between cases of endorsement and merchandising, however in *Fenty* Birss J approved Laddie J's reasoning but made it clear there is no difference in merchandising cases and that the legal principles apply equally well in passing off if the public had been deceived into thinking the celebrity had authorised the product.

Rihanna easily established sufficient goodwill in the fashion industry, as a style icon because of her 'cool, edgy image'.^[16] This was demonstrated in her endorsement contracts with Nike and Gillette, her fashion design and promotion work with rival retailer River Island, and she had worked with H&M, Gucci and Armani to collaborate on and design clothing. Birss J therefore stated Rihanna's 'identity and endorsement in the world of high street fashion was perceived...to have tangible value by an organisation well placed to know'.^[17]

Misrepresentation was the key issue. Topshop argued the clothing was simply a t-shirt bearing an image of Rihanna and the public had no expectation that it was authorised by her, whereas Rihanna contended that the particular facts of the case meant customers were misled into believing she had endorsed the t-shirt herself. The court considered the point in depth, addressing the various circumstances before considering the issue as a whole. Certain evidence considered was found to be neutral to finding a misrepresentation. The fact there was other unauthorised clothing bearing Rihanna's image on sale did not imply that the public would necessarily believe that such clothing was authorised. Topshop had sold both clothing bearing authorised images and clothing, which was approved or endorsed by celebrities. Overall, its customers were neutral: having no positive expectation either way when considering clothing bearing a celebrity's image. Also the t-shirt was fashionable and on sale in a high street retailer. Certain factors indicated finding in Topshop's favour. Some of Rihanna's official merchandise included an 'R slash' trademark logo or her name, the t-shirt lacked both, and apart from a few days online the word 'Rihanna' was

not used at all. There was also no genuine evidence of actual confusion. However on balance, significant factors supported Rihanna. Topshop had made considerable effort to emphasise connections in the public consciousness between the store and celebrities notably Kate Moss, and now more importantly Rihanna. This made it more likely purchasers would conclude that the t-shirt was authorised and being a fashion retailer, consumers would reasonably expect Topshop to publicise and sell products authorised by celebrities. Topshop's prior association with Rihanna was important as Topshop ran a competition in 2010 to win a personal shopping appointment with Rihanna. Rihanna also visited Topshop in 2012 which they chose to publicise by tweeting to their 350, 000 Twitter followers, just before the t-shirt went on sale – a significant commercial communication in the eyes of Birss J, to a demographic who valued social media highly. Topshop had therefore repeatedly associated itself and its products with Rihanna in a high-profile manner and this demonstrated Topshop were looking to take advantage of Rihanna's position as a style icon. The image on the t-shirt was taken during the video shoot of Rihanna's single ' We Found Love' from her 2011 ' Talk that Talk' album. Importantly, it showed Rihanna with the same hairstyle and headscarf as the album cover. This meant that the image was not just recognisably Rihanna but looked like a promotional shot for the music release. The court found that it was entirely likely that, to her fans, the image might be regarded as part of the marketing campaign. This was a critical point in the decision. Although Birss J believed a ' good number' of purchasers would buy the t-shirt without considering the question of authorisation, he concluded that, in the circumstances, a substantial proportion of those judging the t-shirt (specifically Rihanna fans) would be

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encouraged to think that it was clothing authorised by the popstar. They would have recognised that particular image of Rihanna not simply as an image of her but as a particular image of her connected with the particular context of the album. Many of these purchasers would have bought the product because they thought that Rihanna had authorised it; others would have bought it because of the value of the perceived authorisation itself. In each case, the idea that it was authorised was part of what motivated them to buy the product and in each case they would have been deceived.

The test for damage was also easily satisfied. If a substantial number of purchaser's were deceived into buying the t-shirt because of a false belief that it was authorised by Rihanna herself, then that would have damaged Rihanna's goodwill, both by way of sales lost to her merchandising business and a loss of control over her reputation in the fashion sphere. ^[18]

Considering the particular facts, it is not surprising Birss J found in Rihanna's favour. The classical trinity of passing off were fulfilled, however this decision is unlikely to open the floodgates for cases to be brought every time a celebrity's image is used without a merchandising license, as it was made clear ' the mere sale by a trader of a t-shirt bearing an image of a famous person is not without more, an act of passing off'. ^[19] Birss J was eager to emphasise that ' there is today in England no such thing as a free standing general right by a famous person (or anyone else) to control reproduction of their image.' ^[20] The judgment is useful as a confirmation of the general principles of passing off applied to unauthorised use of celebrity images. ^[21] If the UK is approaching the creation of a doctrine of personality rights in

some form, it is necessary to analyse the justifications and gauge whether they are robust enough to validate the subsequent restraints that would be placed upon society. The justifications suggested in support of personality rights fall largely into three groups: moral, economic and consumer protection arguments.

The labour-based moral justification is founded on John Locke's theory of property. [22] Essentially, it provides that an individual has a moral right in the object of value transformed because of their efforts. Nimmer supported this point by contending that the person who has 'long and laboriously nurtured the fruit of publicity values' and has spent 'time, effort, skill, and even money' in their creation, is presumably allowed to enjoy it. [23] Professor McCarthy feels personality rights are 'a "common-sense", self-evident right needing little intellectual rationalisation to justify its existence'. [24] However, Madow deconstructs these arguments by contending that fame is something 'conferred by others' and is not necessarily down to the efforts of the individual. [25] Moreover according to Madow the labour argument ignores the fundamental role the media play in the creation of celebrities. He uses the example of Einstein and observes that the media selected him because he did interviews, was quotable and he had the right 'look'. [26] The image of Einstein that is familiar today, what it means to the public – the mad but pleasant scientist with bushy white hair and moustache – was a personality created by the media. Therefore only when the media and public take notice and attach importance to a personal image can it fully enter into the market place. [27] Thus

contrary to the statement by McCarthy, it would appear a celebrity cannot justify that they solely created their public image and consequently cannot stake an indisputable moral claim to the exclusive ownership or control of the economic value that comes with it.

Personality rights can also be justified on economic arguments. Economic theory proposes persons should be economically incentivised into 'undertaking socially, enriching activities' such as creating a persona that benefits society culturally, ^[28] and this creativity can only be encouraged if the person is given exclusive right to control their creations, because this 'provides incentive for performers to make economic investments required to produce performances appealing to the public'. ^[29] However Carty doubts whether personality rights would produce increases in 'economic activity' or 'innovation'. ^[30] Following Madow's ideas, the UK is currently without a personality right, yet celebrities still gain significant income from their publicity values and failure to introduce such a right in the future will not stop individuals profiting from the income already gained through endorsements and merchandising officially authorised by them. ^[31] According to Madow such protection also has 'distributional consequences', ^[32] whereby personality rights elevate the price of merchandise and advertising in general, placing more wealth in the hands of a select few, who already derive significant income, and away from the mass of consumers making up society. ^[33]

Another justification for personality rights is the consumer protection argument focusing on the idea that without protection, the public will be

misled about the authorisation of a celebrity's association with a product or service. At first sight the consumer protection argument appears advisable, joining protection of the celebrity's success with protection of the consumer, and it mirrors the traditional rationale for trademark and passing off. ^[34] However personality rights would allow celebrities to stop commercial uses of their personas that are not fraudulent or deceptive, and Professor Shiffrin states personality rights give celebrities power 'to control the dissemination of truth for his or her own profit'. ^[35] On another level, Madow argues the degree to which personality rights would stop the consumer being misled is generally superfluous, ^[36] because in situations where there is a realistic chance that, consumers will be deceived or confused about a celebrity's association or endorsement, legal mechanisms better adapted for that reason already exist, notably passing off.

In conclusion, the extent to which *Fenty* constitutes a creation of a doctrine of 'personality rights' is limited. In the words of Roberts 'this judgment does not change the law; and it does not create an "image right". It simply applies the existing doctrine of passing off to the evolving commercial reality of the value of celebrity endorsements'. ^[37] The decision is important as it improves a flaw in the *Irvine* verdict, ^[38] in the same way that *Irvine* marked the first time that passing off was applied to false endorsement, *Fenty* is the first time it has been applied to false merchandising featuring a real person, with merchandising claims having only previously succeeded in relation to fictional characters, ^[39] and indicates that UK courts are slowly recognising the need to protect the commercial value of celebrity merchandising. It is

clear from the case that the result was carefully balanced on particular facts and that if for example Rihanna had not been a fashion icon or the image was different she would have less chance of being successful. *Fenty* highlights the issue of misrepresentation is however always one of fact, and the false belief of the purchaser is key: to constitute passing off, a false belief incited in the mind of the prospective purchaser must play a role in their choice to buy. Although there are persuasive advocates of the creation of a doctrine of personality rights, ^[40] and there is also no definite rationale for an absolute rejection, ^[41] it would seem the decision in *Fenty* should be welcomed because there are substantial drawbacks in the moral, economic and consumer protection justifications put forward. The decision develops passing off to a small degree to keep up with modern business practice without creating personality rights, which are not necessary as celebrities are already sufficiently protected. The tort of passing off has again demonstrated its inherent flexibility and that it is ' closely connected to and dependent upon what is happening in the market place'. To sum up, ' without an element of consumer deception, English law in this area remains characteristically cautious', ^[42] and this should be welcomed.

[1] J. Klink, '50 years of Publicity Rights in the United States and the Never Ending Hassle with Intellectual Property and Personality Rights in Europe', (2003), 4 *IPQ* 363, p. 366.

[2] *Irvine v Talksport Ltd* [2003] EWCA Civ 423

[3] *Reddaway v Banham* (1896) 13 RPC 218 at 244 per Lord Halsbury

[4] *Reckitt & Colman v Borden* [1990] 1 WLR 491 at 499 per Lord Oliver

[5] [2010] EWHC 2310 (Ch)

[6] D. Meale, 'Rihanna's face on a T-shirt without a licence? No, this time it's passing off', (2013) 8(11) *JIPLP* 823, p. 823.

[7] C. Walsh, 'Are personality rights finally on the UK agenda?', (2013) 35(5) *EIPR* 253, p. 253.

[8] *McCulloch v Lewis A May* [1947] 2 All ER 845

[9] *Lyngstad v Anabas Products* [1977] FSR 62 at 67;

[10] *Wombles Ltd v Wombles Skips Ltd* [1975] FSR 488 Ch D;

[11] *Lyngstad v Anabas Products* [1977] FSR 62

[12] *Halliwell & Ors v Panini & Ors* (6 June, 1997, unreported)

[13] *Mirage Studios v Counterfeit Clothing* [1991] FSR 145

[14] [2002] FSR 60 at para 13-14

[15] J. Klink, *op. cit.*, p. 375.

[16] *Fenty v Topshop* [2013] EWHC 2310 (Ch) at [46]

[17] *Ibid* at [42]

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[18] *Ibid* at [72]

[19] *Ibid* at [75]

[20] *Ibid* at [2]

[21] H. Beverley-Smith and L. Barrow, 'Talk that tort...of passing off: Rihanna, and the scope of actionable misrepresentation: Fenty v Arcadia Group Brands Ltd (t/a Topshop), (2014), 36(1) *EIPR* 57, p. 61.

[22] J. Locke, *The Second Treatise of Government*, (New York: Liberal Arts Press, 1952)

[23] M. B. Nimmer, 'The Right of Publicity', (1954) 19 *Law and Contemporary Problems* 203, p. 216.

[24] J. T. McCarthy, *The Rights of Publicity and Privacy*, (New York: C. Boardman, 1987), s. 1. 1[B] [2] at 1-5; s. 1. 11[C] at 1-46.

[25] M. Madow, 'Private Ownership of Public Image: Popular Culture and Publicity Rights', (1993), 81 *CLR* 125, p. 182.

[26] *Ibid*, p. 190

[27] J. Fowles, *Celebrity Performers and the American Public*, (Washington D. C.: Smithsonian Institute Press, 1992), p. 84.

[28] J. T. McCarthy, 'Melville B. Nimmer and the Right of Publicity: A Tribute' (1987) 34 *UCLA LR* 1703, p. 1710.

[29] D. E. Shipley, 'Publicity Never Dies: It just Fades Away', (1981) 66 *Cornell LR* 673, p. 681.

[30] H. Carty, 'Advertising, Publicity Rights and English Law', (2004) 3 *IPQ* 209, p. 251.

[31] M. Madow, *op. cit.*, p. 211

[32] *Ibid*, p. 218.

[33] *Ibid*

[34] H. Carty, *op. cit.*, p. 252.

[35] S. Shiffrin, 'The First Amendment and Economic Regulations: Away from a General Theory of the First Amendment', (1983) 78 *NW ULR* 1212, p. 1258.

[36] M. Madow, *op. cit.*, p. 233.

[37] J. Roberts, 'Face off: Rihanna wins "image rights" case', (2013), 24(8) *Ent LR* 283, p. 285.

[38] A. De Landa Barajas, 'Personality rights in the United States and the United Kingdom – is Vanna too much? Is Irvine not enough?', (2009) 20(7) *Ent LR* 253, p. 258.

[39] J. Roberts, *op. cit.*, p. 285.

[40] S. Bains, 'Personality rights: should the UK grant celebrities a proprietary right in their personality? Part 2', (2013) 18(6) *Ent LR* 205

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[41]

[42] H. Beverley-Smith, *op. cit.*, p. 61.