

IP Protection For Personalities From Elvis To Eddie

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Introduction

Merchandising generally, and character and personality merchandising in particular, has become a huge part of the entertainment and sporting world. An exclusive licence to sell a variety of clothing, toys and other merchandise bearing a famous name or image is often now the subject of intense bidding wars.

When it comes to protecting the names and images of the famous, there are two opposing strands of thought. On the one hand, personalities have worked hard to create their fame and therefore why should they not be able to benefit from the results of this hard work. On the other hand, some consider that a personality's fame is created by the public – it is society at large which decides whether or not an individual is famous or not and, therefore, their name and image should belong to the public.

“Personality or Publicity Rights” US

Until the turn of the last century, treatment of a name and likeness as a commercial commodity had not advanced to a stage where Courts were prepared to treat a persona as a protectable thing. By the 1930s, however, when US mass media advertising was well established and product endorsement by personalities was widespread, the US had established rights in persona to some extent. At the same time, however, in England in *Tolley v. Fry*¹; Lord Greer (of which, more later) concluded that those who entered occu-

pations which invited publicity should consider their names and reputations as a matter of public interest and as public property. By the 1950s, US and UK case law had diverged in completely opposite directions and it was a landmark US case in the 1950s, *Haelan Labs v. Topps Chewing Gum*² which properly established a new right of publicity. Subsequent cases in the US have decided that such a right is a fully fledged property right and is available in differing degrees in most US States. Such cases have been subject to ever increasing litigation in the US amongst sports-men and -women and entertainers - an example being Dustin Hoffman's award of \$3,000,000 damages against a US publisher who used an altered photograph of Hoffman wearing women's clothing.

Australia

Australian law has no right of publicity per se but has a law of passing off which unlike the UK has been adapted to protect the famous. In *Henderson v. Radio Corporation*³ the Plaintiffs, who were well known professional ballroom dancers, objected to the release of a record containing music for ballroom dancing bearing, amongst others, their photograph. The photograph was as prominent as any others on the record sleeve and its choice by the Defendants was accidental. On appeal, the High Court of New South Wales concluded that there had been passing off as the defendants had

wrongly appropriated the Plaintiff's professional business reputation. This was sufficient damage in itself – the Plaintiffs had been deprived of a fee for the endorsement of the record.

Perhaps the two most important Australian cases are the *Crocodile Dundee* cases.⁴ The latter of these, decided by the full Australian Federal Court, is the leading Australian authority on the protection of celebrities. The case concerned a TV advertisement for shoes which parodied a scene in the film *Crocodile Dundee*. In the film, Paul Hogan turned the tables on a New York mugger by producing his own knife, which was far larger than the knife wielded by the mugger. In the advertisement, the character dressed in similar clothing to *Crocodile Dundee*, but was obviously not Paul Hogan, was also attacked by a mugger and got the better of him, thanks to the superior shoes he was wearing. The majority of the Federal Court of Australia upheld the first Court of Instance decision on the basis that there had been a misrepresentation of an association of some sort (even though it was vague). The Court was clear, however, that liability was based on a “misrepresentation” of a connection or association as opposed to the mere “appropria-

4. (1) *Hogan v. Koala Dundee* [1988] 12 1PR 508. (2) *Hogan v. Pacific Dunlop* [1989] 14 1PR (Federal Ct. Full Ct.).

2. *Haelan Laboratories Inc. v. Topps Chewing Gum Inc.* 202 F 2d 866 (2d Circuit 1953).

3. *Henderson v. Radio Corporation Pty Ltd.* [1960] NSWLR 279, [1969] RPC 218.

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1. *Tolley v. Fry (J.S.) and Sons* [1930] 1 K.B. 46.

tion” of the name or image. The Court allowed the advertisements to continue with an appropriate disclaimer. Despite some cases including *Henderson* which had suggested that mere appropriation of a famous name was sufficient to amount to passing off, i.e. in other words a common law right of publicity, this is not the case – a misrepresentation must still be shown, i.e. an implication of endorsement or some sort of commercial agreement between the Plaintiff and Defendant. Subsequent Australian cases have followed this line.

Canada

Canada, like the US has recognised a “right of publicity” not depending on there being passing off in the sense of English or even Australian law. In *Athans v. Canadian Adventure Camps*⁵, the Plaintiff, a professional water skier, exploited his reputation commercially and used as a trade mark a specific photograph of himself water-skiing. The Defendant, who operated a children’s summer camp, used in an advertising brochure a drawing recognisably derived from the Plaintiff’s photograph. Although the Plaintiff failed on the grounds of passing off on the basis that the image would mean nothing to readers of the advertisement, the Court found that there had been an invasion of his exclusive right to market his own personality.

Europe

France has strong laws enabling individuals to prevent the unauthorised exploitation of their name and image. As in most countries with a publicity right, this right has stemmed from the right of privacy for individuals – something which English law has never had. Prior to 1970, when the right of privacy was enshrined in the French Civil Code, the Courts were prepared to protect the unauthorised use of images. Protection of a person’s privacy protects their identity, their health, and their private and social relations. French law affords a complete contrast to English law in re-

spect of privacy, highlighted probably no better than the English case of *Kaye v. Robertson*.⁶ Gordon Kaye, the actor well known for his appearance in the BBC comedy series “Allo Allo,” was involved in a serious accident in his car when a tree fell on it during a storm. A journalist from the *Sunday Sport* photographed and purported to interview Gordon Kaye while in hospital recovering from surgery. The *Sunday Sport* proposed to publish the interview and photograph as an “exclusive” despite Kaye being unable to give an interview at all. The Court of Appeal granted an interlocutory injunction based on malicious falsehood and libel but dismissed Mr. Kaye’s claim for passing as “hopeless.” If the photographs had been used without the purported interview, arguably there would have been no claim at all to prevent that publication – something which would not have happened in France, or indeed most other countries in Europe.

This right of privacy, i.e. the right to prevent the unauthorised publication of one’s image has been transformed from a private, negative non-economical right to a positive economical right, i.e. the right for the well known to use their image as a marketable asset in a way impossible in the UK. One of the first French cases involved Petula Clark⁷ who had authorised an agency to interview and photograph her for a particular publication. The agency concerned, however, sold the photographs to another agency who used them in a weekly publication. Petula Clark was successfully awarded damages by the French Court proportional to the loss of her opportunity to earn revenue from the publication of the photographs. This has been followed consistently in France. One of the more recent cases concerned a photograph of Eric Cantona⁸ on the front cover of a weekly sports publication without his consent. The

Court held that the absence of any authorisation had prevented Cantona from being able not only to control how his image was used in the magazine but also to earn money for its use.

Publicity rights are provided in statute in Italy, Germany and the Netherlands similar to those granted under French law. The legal framework in these territories, however, provide for the right to use the name and image of people in public life without consent when it is in the interests of free speech to do so. Case law provides a balance between the protection of a celebrity’s image and the right of free speech, i.e. a biographical work of a well-known individual. The use of a well-known individual’s image for advertising purposes, however, without authorisation, would be unlawful.

History in the UK

Without a general right of publicity/personality, the only rights which a personality can rely on are passing-off and trade mark infringement, and to some extent copyright infringement and possibly the Trade Descriptions Act 1968.

The essential difference between the English and Australian interpretations of passing-off is that in English law there is no presumption that a person suffers damage from wrongly being identified as endorsing the goods or business of another. As we have seen in Australia, going back to *Henderson v. Radio Corporation*, Australian law applies a doctrine that a personality who can be said to be a trader (in the widest sense of the word) is always free to grant or withhold his or her endorsement and that any unauthorised use damages or deprives him of the fee he could otherwise have insisted on. This right, however, is not as strong as the absolute right of publicity which exists in the US and most EU territories – a misrepresentation as to endorsement is irrelevant, it is the appropriation of the image which is

5. *Athans v. Canadian Adventure Camps Limited* [1977] 80 DLR (3d) 583.

6. *Kaye v. Robertson* [1991] FSR 62 C.A.
7. Paris 15 Dec 1965, JCP 66 II, 14711.

8. Paris 10.10.96, *Gazette* 18.22/05/99 p28.

actionable. *Henderson v. Radio Corporation* has been cited in several English merchandising cases and not followed. Probably the earliest English case on the point is the libel case of *Tolley v. Fry* where the Defendant chocolate company used a caricature of a famous amateur golfer to advertise its products. This carried with it the implied misrepresentation that he had compromised his status by accepting payment for the endorsement. Although the Court upheld the claim on the basis of libel, Lord Greer concluded that:

“those entering occupations which invite publicity should consider their names and reputations as a matter of public interest and public property.”

By the 1970s, however, the character and personality merchandising industry in the UK was becoming well established. The first of the more recent cases, *Lyngstad v. Annabas*⁹ involved a claim for passing off by members of the pop group ABBA against the Defendant's sale of T-shirts, pillow-cases, badges and other products bearing the name and photographs of the group. The group did not own the copyright in any of the photographs, which had been cleared by the Defendants. ABBA had no UK licensees for any of the products. The Court refused an interlocutory injunction mainly on the basis of the balance of convenience as the Plaintiffs had no existing trade which would be prejudiced or any immediate likelihood of any such trade. The Court also, however, doubted that the Plaintiffs had made out that there was any misrepresentation:

“I do not think that anyone reading the advertisements of which the complaint is made or indeed receiving the goods described in them could reasonably imagine that all the pop stars named in the advertisements were giving their approval to the goods offered or that the defendants were doing anything more than catering for a popular demand among teenagers for effigies of their idols.”

The last few words of this state-

ment have been often repeated in English Court decisions.

Similar reasoning was used in *Merchandising Corporation of America and others v. Harpbond*¹⁰ in the early 1980s when the Defendants sold pictures of a pop star in which the First Plaintiffs had contractual merchandising rights. Again, copyright in the photographs had been cleared by the defendants beforehand. In *Harrison and Starky v. Polydor*¹¹ George Harrison and Ringo Star sued a record company who proposed to release recordings of interviews given by the Beatles, interspersed with Beatles songs. There was no copyright infringement or breach of confidence and the action was brought on the basis of passing off. The High Court, refusing an interlocutory injunction held that it was clear to anyone buying the record that it was called “The Beatles Tapes” because of what it contained – there was no implied endorsement authorisation by the group.

The case of *Stringfellow v. McCain Foods*¹², although not strictly a personality case, highlights the limitations in English law. Peter Stringfellow, the proprietor of the London nightclub sued McCain, the manufacturer of frozen foods, for advertising a new thin type of potato chip as “Stringfellows.” A TV advertisement for the chips used the theme of a kitchen turning into a discotheque. The Court of Appeal overturned the High Court decision – although the theme of the advertisement might cause some viewers to make the mental jump necessary to associate the chips with the Plaintiff's club, and therefore to a certain extent a misrepresentation was present, it was not proved that any damage had been caused or was inherently likely. The Plaintiff's chances of exploiting its merchandising rights had not been affected.

In addition, the Court doubted whether such damage was recoverable in a passing off action at all.

Teenage Mutant Ninja Turtles

In 1991, however, the Courts began to recognise the merchandising industry in a case concerning not the image of a person, but in relation to cartoon characters. In the *High Court case of Mirage Studios Inc. v. Counter-Feat Clothing Limited*¹³, a case concerning the sale of unlicensed T-shirts bearing images similar to the teenage mutant ninja turtles, the Court took the view that the public expected to buy the genuine article – a teenage child wishing to buy a mutant turtle as part of the craze at the time would wish to get a genuine turtle, i.e. a product bearing an image of the turtle which was licensed or endorsed by Mirage Studios Inc. In the absence of evidence, the Court inferred that even if a customer was aware that the object he was buying was not genuine, he would not buy it but seek the real object. It was thought by many that this was the first step to opening the door to a new “personality right” not simply for created cartoon characters (which are artistic works) but also for real people. It is interesting to note that the Court was not prepared to uphold a claim for copyright infringement as the “unofficial” turtles were not a substantial copy of the design of the originals. They were sufficiently similar, however, to amount to a misrepresentation to support a claim for passing off. The rationale behind this decision can be based on the fact that with a cartoon character, which is an artistic work, there is an underlying right to protect, i.e. copyright, even if that right is not infringed. If the case before the Court at the time concerned a well known living (or dead) individual, would the decision have been the same? There is no underlying property right in the persona of an individual, or group of individuals, and, it is unlikely that Court would have come to the same decision.

10. *Merchandising Corporation of America v. Harpbond* [1983] FSR 32.

11. *Harrison and Starkey v. Polydor Limited* [1977] FSR 1.

12. *Stringfellow v. McCain Foods (GB) Limited* [1984] FSR 175.

13. *Mirage Studios v. Counter-Feat Clothing Co. Ltd.* [1991] FSR 145.

The High Court Decision in *Elvis*¹⁴

It was against this background that the High Court made its decision in *Re: Elvis Presley Trade Marks*. In 1989, Elvis Presley Enterprises Inc., the successors to the Estate of Elvis Presley, filed UK trade mark applications for ELVIS, ELVIS PRESLEY and the signature “ELVIS A. PRESLEY.” The Estate had registered a number of trade marks around the world for a wide range of products and is particularly aggressive in asserting its IP and publicity rights in the U.S.

(i) The UK applications were initially accepted by the Trade Marks Registry but were subsequently opposed by Sid Shaw, a trader who had been marketing Elvis memorabilia in the UK since the late 1970s under the name “ELVISLY YOURS.” The marks were opposed on the basis that they were not distinctive of any source and that they conflicted with Sid Shaw’s own prior registrations for ELVISLY YOURS. After the Registry had originally upheld the applications, Sid Shaw appealed to the High Court which upheld the appeal. The Court in a judgment which was quite critical of character and personality merchandising in general, held that the public did not care whether Elvis Presley memorabilia was approved by the Estate of Elvis Presley or not.

(ii) The Plaintiff had argued that consumers’ awareness of merchandising practices meant that they would always assume that products relating to famous personalities or fictitious characters came from a particular “genuine source.” Of this, Laddie J. held:

“I am not willing to assume that this is the public perception generally. On the contrary, my own experience suggests that such an assumption would be false. When people buy a toy of a well-known character, I have no reason to believe that they care one way or the other who made, sold or licensed it.”

Despite this further discouragement to merchandisers and personalities alike, the industry was

comforted to a certain extent by the fact that this was a one off case – the trade mark applications had been filed some 10 years after Elvis’ death by which time third parties had been allowed to sell their own memorabilia without any complaint from the Estate. In addition, although evidence had been submitted to the Registry of use of the marks by the Estate in the U.K., this evidence was not submitted to the High Court – there was very little, if any, evidence of any actual use of the marks. The only products on sale in the UK bearing the name Elvis had been totally unconnected with the Estate.

Court of Appeal Decision in *Elvis*¹⁵

The character and personality merchandising industry hoped that the Court of Appeal in the Elvis case would attempt to address some of the negative comments made by the High Court about merchandising in general. Although there was a general feeling that the Court of Appeal would not overturn the High Court decision, particularly because of the lack of evidence adduced by Enterprises, it was certainly perceived that some of the comments made by the High Court had generally gone too far. The Court of Appeal refused the appeal and refused registration of all three marks. The Court concluded that they were not inherently distinctive and, as there was no evidence produced by Enterprises of any use of the marks in the UK which might have indicated that the marks had become distinctive of the Estate of Elvis Presley in the minds of the public, there was therefore no reason at all why the marks should be registered.

Although the appeal was concerned solely with the distinctiveness of the mark ELVIS PRESLEY and the signature “ELVIS A. PRESLEY” for trade mark registration purposes, the Court had the opportunity to discuss character merchandising in general. The Court of Appeal has not completely shut the door on preventing unlicensed use of a name or likeness for merchandising. However, it has

confirmed that it is not prepared to assume the products bearing the name or image of a character (whether real or fictional) on products, are licensed or endorsed by an official source without evidence.

The Current UK Position

From these cases it seems clear that at least as far as ‘merchandising’ cases are concerned the UK Courts are not prepared to assume that any product bearing the name or image of a personal character is necessarily from a “genuine source” without evidence that consumers believe that to be the case. Furthermore, neither the Trade Marks Registry nor the Courts are prepared to accept that a well-known name or image is distinctive of any product or service without evidence that this is the case. So without publicity or personality rights and some unhelpful Court decisions, is it still possible to protect the name and images of individual groups or even fictional characters? The recent *Eddie Irvine* case would suggest it is and may be an indicator that the UK Courts are now prepared to acknowledge commercial value in the name or image of a well known individual.

The *Eddie Irvine* Case¹⁶

The action was brought by Eddie Irvine, Ferrari’s driver in Formula 1 racing, against the defendant Talksport Limited, formerly known as Talk Radio. Talk Radio took a picture of Irvine which had been legally obtained and manipulated it to remove a mobile phone Irvine was holding and replaced it with a radio with the words “Talk Radio.” This promotional picture was then sent out to potential advertisers.

Irvine brought an action for damages for passing off and argued that he had a substantial reputation and goodwill and that the defendant had created a false message which a not insignificant section of the public would take to mean that Irvine had endorsed the radio station. An injunction was not sought as Talk Radio had made it clear that the

14. *Re: Elvis Presley Trade Marks* [1997] RPC 543.

15. [1999] RPC 567.

16. *Edmund Irvine and Tidswell Limited v. Talksport Limited* Ch D 13 March 2002.

campaign was a one-off promotion designed to coincide with the British Grand Prix. The defendant on the other hand relied on case law including the *Elvis* case which stated that there is no free standing right to character exploitation enjoyable exclusively by a celebrity and a passing off claim could not be based on an allegation of false endorsement.

The Court agreed with Irvine and held that an action for passing off could be based on false product endorsement. The Judge recognised the fact that it was common for famous people to exploit their names and images by way of endorsement in today's brand conscious age, not only in their own field of expertise but wider afield also. It was right therefore for valuable reputations to be protected from unauthorised use by other parties.

Previously the claimant and the defendant would have had to be operating in a "common field of activity" before a passing off claim could be established. The Judge rejected this narrow approach to endorsement and looked at various cases to support this view including, interestingly, recent Australian case law.

In the future, in order to succeed in a claim for false endorsement, claimants will need to show that: (i) at the time of the acts complained of he or she had a significant reputation or goodwill; and (ii) the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods had been endorsed, recommended or were approved of by the claimant.

The Court accepted that Irvine succeeded on both counts and that it was irrelevant that the brochure itself had been only distributed once to just under 1,000 recipients. Even if the damage done may be negligible in direct money terms the court accepted that potential long term damage could be considerable.

The case highlights the important difference between endorsement and merchandising. Character merchandising involves the exploitation of images by creating "spin-off"

products as in *Elvis* whereas the *Irvine* case deals with the evolution of the law on passing off to embrace modern branding and trade practice whereby an individual can financially benefit from the endorsement or recommendation of another party's goods or services in order to boost sales. A passing off action will now protect an individual's exclusive right to benefit from the attractive force of his or her goodwill or reputation and to protect that right against damage or dilution arising from a false claim or suggestion of endorsement of a third party's goods or business.

Although the Court was clear to stress the difference between endorsement and merchandising, the line separating the two is a grey one and it may not be long before the UK Courts are prepared to extend the law or passing-off to any unauthorised commercial exploitation of a person's name or image.

The Arsenal Cases

The recent opinion of the Advocate General of the European Court of Justice in the *Arsenal v. Reed* case appears to give the advantage back to the rights-owners. Mr. Reed sold memorabilia and souvenirs from a stall outside the ground of Arsenal Football Club in London, and had been doing so for 30 years. These included hats, badges and scarves bearing one or more marks connected with the club. Arsenal took proceedings against him for passing off and trade mark infringement. Arsenal was the proprietor of registered trade marks for "ARSENAL," "GUNNERS," and the Arsenal crest and cannon devices in a variety of classes.

The Advocate General, Ruiz Jarabo Colomer, delivered his opinion on 13 June 2002. The judgment in this case is significant as it examines the parameters of trade mark infringement, particularly with regard to brands relating to personalities and clubs. The case was first brought before Mr. Justice Laddie in the High Court in April 2001.

Questions posed by Laddie J. concerning the correct interpretation of

trade mark law were referred to the European Court of Justice. The Advocate General's function is to propose answers to the questions asked. His opinion is not binding, and the ECJ can choose whether or not to accept his answers. However, the full court follows the Advocate General's opinion in 80% of cases.

Why the ECJ was Consulted

One of Mr. Reed's defences was that the words and signs on his products were not being used as trade marks (i.e. to show origin of the goods), and therefore that his use of the signs registered as trade marks could not be trade mark infringement.

Laddie J. wished to seek clarification of the law as to whether or not a trade mark could be infringed by use of a mark in a non trade mark sense. If the view of the Court of Appeal in *Philips v. Remington* (that a trade mark did not need to be used in a trade mark sense to infringe a registered trade mark) was correct – Mr. Reed would infringe. On the other hand, if a sign needs to be used in a trade mark sense to infringe, Mr. Reed would not infringe. Laddie was satisfied that the marks had not been used in a trade mark sense, stating, "in my view the Arsenal signs on Mr. Reed's products would be perceived as a badge of support loyalty or affiliation to those to whom they are directed. They would not be perceived as indicating trade origin."

The Advocate General's Conclusion

The Advocate General concluded that, provided that use of a sign identical to a registered trade mark is used for the purposes of commercial exploitation, such use is capable of infringing the registered trade mark. Whether a mark is being used "as a trade mark" is a question of fact for the national court to determine depending on the circumstances of the case – but there is a presumption that use of the sign is trade mark usage. The Advocate General's view was that a consumer's reason for buying a scarf or shirt is irrelevant, the key factor is that he or she buys the item because it incorporates the

distinctive sign.

He concluded that Mr. Reed did infringe Arsenal's registered trade marks. The Advocate General's reasoning would seem to follow the judgment of the Court of Appeal in *Philips v. Remington*. If followed by the full court, this decision will give further ammunition to rights owners wishing to control the production of merchandise, and marks another step towards full trade mark protection for club and personality brands.

Shortly after the first instance, decision in *Arsenal*, The Rugby Football Union sued Cotton Traders for selling England rugby shirts bearing a red nose logo, for which the RFU had a trade mark registration. The court held that the mark denoted England at large, or the rugby team, rather than the RFU and dismissed the claim, declaring the mark invalid.

Human Rights

In 1998, the Human Rights Act was passed and came into force in October 2000. Article 8 of the Act provides:

(i) *Everyone has the right to respect for his private and family life, his home and his correspondence.*

(ii) *There shall be no interference by a public authority with the exercise of this right except such as in accordance with the law and is necessary in a democratic society in the interests of national security public safety or the economic well-being of the country, for the prevention of disorder or crime, for the protection of health or morals, or for the protection of the rights and freedoms of others.*

However, on the other hand, Article 10 of the Human Rights Act expressly recognises the importance of freedom of expression. In effect, a balancing act needs to be conducted.

A number of high profile cases tested the state of the law last year pulling at various strands of the numerous "privacy" rules. The vast majority of cases have considered "infringements" of privacy or breach of confidence and the publication of stories relating to drink, drugs and sex. On the other hand, the laws have also been used to protect personalities, in particular, the sale or release of photographs.

In *Douglas v. Hello*, Michael Douglas and Catherine Zeta Jones granted *OK!* Magazine the exclusive right to publish photographs of their wedding at the Plaza in New York for payment of a substantial sum of money. The guests were searched on arrival at the wedding and cameras not allowed into the reception. Despite these measures, unauthorised pictures were obtained by *Hello!*

Proceedings were issued against *Hello!* seeking an injunction to restrain publication of the magazine which was due out before *OK!* The Court of Appeal gave a number of indications of matters to be taken into account by the English courts when deciding "privacy" disputes:

privacy is a right which can only be interfered with for "legitimate aims" and in ways which are proportionate; and

the courts will recognise "degrees of privacy": the more intimate the aspect of private life which is interfered with, the more serious must be the reasons for interference.

In *Beckham and Another v. MGN Limited 2001* (unreported) David and Victoria Beckham applied for an injunction to prevent the *Sunday People* publishing unauthorised photographs of the recently decorated interior of their house. The newspaper wanted a cross undertaking from the Beckhams that they would not seek to publish their own similar photographs. The Judge held that the undertaking was not required and that the Beckhams should have the freedom to dispose of their privacy as they wished.

When the Human Rights Act was first introduced, there was much speculation that a tort of privacy would evolve. So far it has not and many relevant cases have been made up of a mixture of breach of confidentiality, breach of contract, data protection and infringement of privacy. The cases and precedents are evolving and there are substantial differences between the views of many of the Judges within the English Courts. Many decisions still vary depending on the mood of the day.

Trade Mark Registration

Any trade mark must be capable of distinguishing the products or services of one trader from the products and services of another. There is no reason, therefore, why an image of a famous individual, whether a drawing, a computer generated graphic or a photograph or film still cannot function as a trade mark. There are many pictorial marks registered – for example Damon Hill's eyes seen through the slit of his visor and a particular image of Alan Shearer. As you might expect, these marks are registered for a broad range of goods which are the subject of official merchandise. What must be remembered, however, is that trade mark registration is not, and never will be, either in the UK or anywhere else in the world, a back door to a right of publicity, i.e. the registration of a particular image of an individual as a trade mark will not protect the image per se of that individual but that only particular image in as much as it is used in a trade mark sense. When considering the question of registering a photograph or photographs of an individual or individuals, careful thought must be made - even if such marks are registered, they would be extremely difficult to enforce. In relation to a musical act, for example, there are a number of problems:

(i) Which photograph to register? - act is likely to have a number of different images – is it possible to choose one which is particularly distinctive?;

(ii) Even if the mark was registered, what use of images of the act could the registrations prevent? Arguably only the use of the identical photograph or something so similar as to be almost identical;

(iii) A band, and indeed all living individuals, age, re-invent themselves, change their hairstyles and their images – if there was to be any chance of protecting the image of the band, subsequent applications would have to be made on a regular basis to keep track of the change in styles of the group;

(iv) Importantly, the marks would have to be used in a trade mark sense i.e. as a badge of origin - it would not be sufficient that the photographs occasionally appeared in magazines or on posters but would have to be used in a consistent manner in relation to all merchandising and money making activities of the band in order to avoid arguments of deception or non use. This is bearing in mind that the marks would have been accepted as distinctive in the first place.

This particular example highlights the problems of registering images as trade marks. There are ways of protecting an image as the trade mark - Damon Hill's eyes for example. In relation to drawings and photographs of personalities, copyright exists in such works and will prevent unauthorised use. The personality in question should ensure, as far as possible, assignments of copyright in those photographs. If this is not possible, the use of release forms by photographers is an extremely useful tool - these are essentially agreements with photographers that they will only use their photographs for the particular purpose for which they were taken and will not be licensed to photo agencies or any other third party without permission. This is particularly effective for "official" photo-shoots and events. If photographers are not prepared to sign such releases then they are not invited to the party. There is often a difficult balance, however - a personality needs to balance the protection of his or her name and image with the necessity for the oxygen of publicity. Such agreements with photographers, however, do not prevent the taking and use of paparazzi shots. These are, however, generally long range and poor quality photographs and are therefore of limited attraction to those who indulge in the manufacture of personality merchandise - they are usually limited to editorial use in newspapers or magazines.

Not only does the control of such photographs limit the opportunities for third parties to produce unofficial merchandise, but it means that the overall image of the individual

or group is much more distinctive - those products bearing names and images are much more likely to be authorised or endorsed by the personality in question.

The key to successful registration of an image as a trade mark and subsequent avoidance of claims for invalidity once registered is to concentrate on a limited number of very distinctive images, e.g. famous and well known poses of individuals taken by well known photographers. Such photographers may agree to assign the copyright in such photographs or, at the very least, agree to an exclusive licence of a copyright. In addition, the top professional photographers are unlikely to allow their photographs to be used for general photo agency use. Through consistent use of a few particular images in relation to authorised and official products, the public will become educated to recognise those images as trade marks for the personality in question. There is a much greater chance of being able to succeed in an action for passing off (in addition to copyright infringement) if a third party uses that photograph in relation to a product. In addition, if the image becomes particularly distinctive, there is also the possibility that third parties may be liable for passing off for use of similar images (where copyright infringement would obviously not be applicable). If particular images become distinctive of the personality, there is no reason to suppose that they cannot be protected as registered trade marks - bearing in mind the Registry's current position, evidence of distinctiveness in support of the applications should be hefty and detailed.

Names

Unlike a photograph, there is no copyright in a name. Arguably there may be copyright in a signature although, the Court of Appeal did cast some doubt on this in the *Elvis* case. There is no question that names of individuals who have a reputation in a particular area of business are distinctive of those goods or services relating to that business, for example Paul Smith for clothing and Josiah Wedgwood for china and pottery.

The problem we are looking at here is protecting the names of those people who are well known as personalities, i.e. who are in the public eye and are wishing to seek trade mark registration of a name not only in relation to the field of activity for which they have built up some reputation but for other goods and services. Unfortunately after *Elvis* the Trade Marks Registry took the view that it would refuse, without any evidence, application for names of well known individuals or established groups of individuals as trade marks. This is whether or not individuals have a reputation in some of those goods or services or not.

The usual advice is to seek to protect the name of an individual before they become well known or established. In particular the record industry has woken up to the fact that the names of artists and bands can have a significant value and will often contribute to costs of registration. There is a balance to be made however - if the artist is unsuccessful, then securing a trade mark registration in a wide number of classes of goods and services will be an expensive waste of time. If, however, the artist has massive success, and trade mark registration is not sought, by the time trade mark applications are made, it may well be too late - the marks might not be accepted and the market might be flooded with unofficial products. The key is to cover some of the most significant classes of goods and services at an early stage. Once trade mark protection is achieved, authorised and official merchandise can be put on to the market before third parties have had a chance to do so. Trade mark registrations will give the artist the ability to prevent any unauthorised use of their names and image. This will mean that most if not all goods bearing the name of the artist are authorised which will again educate the public to identify the name as being distinctive of the artist in relation to any product. This again will help avoid any claim that the registered mark should be revoked because it is deceptive or in the public domain and will make enforcement much easier.

Domain Names: A Parallel Universe

There have been a number of recent decisions under the Internet Corporation for Assigned Names (ICANN) Uniform Domain Name Dispute Resolution Policy (UDRP) which have dealt with the protection of personality rights. Originally it was not intended that the dispute procedure would apply to such rights and in recognition of the disharmony in this area of law WIPO stated, "registrations that violate trade names, geographical indications or personality rights would not be considered to fall within the definition of abusive registration." The issue now in dispute is whether the Policy applies to protect personal names in the absence of common law or registered trademark rights or whether the Policy should be interpreted more broadly to encompass rights of personality.

English law does not protect character or personality rights unlike Californian law which provides statutory protection to prevent the unauthorised use of a name or image for commercial purposes without the need to provide evidence of goodwill. After the *Elvis* decision in the U.K., the Trade Marks Registry has taken the view that it will refuse trade mark applications for names of well-known individuals provided evidence is put forward that the mark is inherently distinctive or has become distinctive through use. The ICANN panelists, however, have been clear that a test of registrability is not appropriate for its dispute procedure and following the decision granting Jeanette Winterson the rights to "*jeanettewinterson.com*" an apparent convergence between trade mark law and passing off seems to be taking place.

To recap, in order to bring a successful claim under the UDRP a Complainant must prove (a) that the domain name in dispute is identical or confusingly similar to a mark in which the Complainant has rights, (b) that the Respondent has no rights or legitimate interests in the domain name and (c) it has been registered

and used in bad faith. In order to establish whether a domain name owner has legitimate interests in the name s/he must be able to show (i) a bona fide use of the name before notification of the dispute or be able to demonstrate preparations to use the domain name or (ii) the Respondent is commonly known by the domain name or (iii) s/he is making a legitimate or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish another's reputation or mark.

The *Jeanette Winterson* case has set the standard that relief against cybersquatting is not limited to owners of registered trademarks. Whilst Julia Roberts and Jeanette Winterson were found to have rights in their names constituting unregistered trade marks, the singers Sting and Bruce Springsteen however did not. Sting failed in his case as did not put forward evidence of rights sufficient for the WIPO panel to conclude that there was a mark in which he had rights. The question is therefore does being known under a name or having rights in that name the same thing? The answer to this following the *Sting* case appeared to be no.

In the *Sting* case the Panel decided that both individuals were "commonly known" by the name "Sting" but that neither had a legitimate right to use the name. The decision was based on evidence that the Respondent had made a bona fide use of the name prior to obtaining the domain name registration and there was no indication that he was seeking to trade on the goodwill of the well-known singer or had acquired the name with the primary purpose of selling it (even though he later offered to sell it for \$25,000).

In the *Bruce Springsteen* case the panel did not consider that the name Bruce Springsteen had acquired a secondary meaning. However the decision was criticised in a more recent case concerning the singer/musician Peter Frampton. The panel concluded that the well known activities as a musician and composer over many years were the very ac-

tivities that gave rise to common law trademarks in the first place. The name PETER FRAMPTON was also the subject of a registered trademark. The panel stated that by the registration of the mark the USPTO had implicitly recognised that the mark had acquired appropriate secondary meaning in the market place.

But what if the cybersquatter does have registered rights or attempts to avoid confusion? Madonna was successful in obtaining the *Madonna.com* domain name despite the registrant's attempts to rely on a Tunisian trade mark registration (the place where it was possible to obtain trade marks almost instantly and thus seek to evade the UDRP criteria) and a notice on the web site "*Madonna.com* is not affiliated or endorsed by the Catholic Church, Madonna College, Madonna hospital or Madonna the singer." The registrant had stronger arguments that there was no evidence that his primary motivation was to sell the domain name, i.e. he was not in the business of cybersquatting, that his registration did not prevent Madonna from using her mark as a domain name and that the use of a generic term was not bad faith as a matter of law. The Panel found however, applying the "preponderance of evidence" test, that the registrant was trading on the fame of the singer for commercial gain and ordered the transfer of the registration. Consequently mere registration of a trade mark does not create a legitimate interest under the Policy and a registrant must demonstrate that the registration is obtained in good faith for the purpose of making a bona fide use of the mark in the jurisdiction where the mark is registered and not obtained merely to circumvent the application of the Policy.

So is there a test of what amounts to bad faith? It was held in the *Crew* case that the registration of domain names for speculative purposes constitutes an abusive registration when the registrant has no demonstrable plan to use the name for a bona fide

purpose, was aware of another's rights, engaged in a pattern of conduct and which prevented the trade mark holder from having a domain name which corresponds to his mark. Interestingly, in this case a dissenting panellist stated that the Policy rejects the possibility that someone might not know exactly how he or she intends to use the domain name and therefore makes such uncertainty automatic bad faith registration. In the more recent case concerning Damon Hill, the Panel stated that it was inconceivable that the domain name *damonhill.com* was registered without awareness of Damon Hill being one of the most famous racing drivers in the world. The Respondent had argued that the name was registered in respect of their company named THE DAMON THE HILL.

To draw some sort of conclusion,

where no plausible explanation is given for adopting a domain name that corresponds to the name of a famous entertainer, the panellist will generally find that there has been a violation of the Policy.

In a recent case, concerning a US politician Kathleen Kennedy Townsend, the Panel stated that the protection of an individual politician's name, no matter how famous, is outside the scope of the Policy as it is not connected with commercial exploitation. In a case concerning a high profile religious minister in the U.S., Dr Jerry Falwell, the Panel similarly held that the type of fame that arises through political or religious notoriety is not recognisable under the Policy to protect the individual's name. In the U.S., protection would be provided under the Anticybersquatting Consumer Protection Act which expressly provides for protection of

personal names.

Conclusion

It is clear that those wishing to protect their names and images may find it more difficult to do so in the UK than elsewhere in the world. Although, there are ways in which names and images of the famous can be protected as trade marks, such protection is not easy to achieve and needs careful thought beforehand. Trade mark protection may help, if the Advocate General's opinion is followed by the ECJ. In addition, despite some unhelpful court decisions, it is possible to create an environment whereby unauthorised personality merchandise can be prevented through actions for passing off, particularly post-*Irvine*. However, perhaps the only way that clarity can be achieved is, as in most of the rest of the civilised world, through publicity rights legislation.