

# IP, Personality Rights, & Reputation Management

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1

## Introduction

- What are personality rights?
- What do these protect?
- Remedies in the UK
  - Defamation
  - Breach of confidence
  - Copyright
  - Trademarks
  - Passing off
- Should there be a personality right?

2

## Character Merchandising

- Right of the individual to use their name, image, voice etc as they wish and to prevent others from using it to endorse a product.
- Celebrities are used in advertising to enhance the commercial attractiveness of product or service
- Protection for cartoon and other fictional characters

3

## Legal Protections

- Right to privacy/right to publicity
  - No such personality right in UK
- Various non-specific legal remedies
  - Cases divided into
    - False endorsement
      - Use of individuals to advertise certain products
    - Merchandising
      - Sale of memorabilia which is linked to a famous person

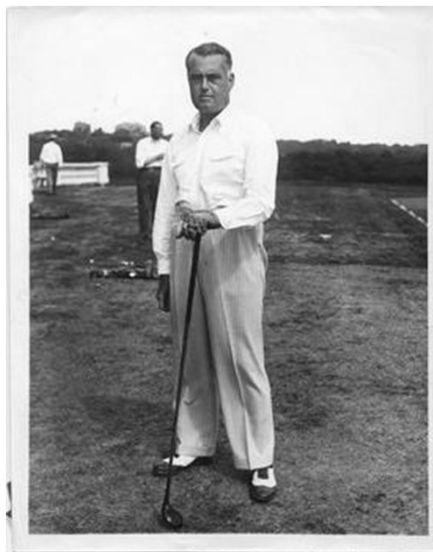
4

## Legal Remedies

- How far can libel be used to protect personality rights?
  - Tolley v Fry [1931] A.C. 33
  - Charleston v News Group Newspapers [1995] 2AC 65
- Breach of contract
  - Pollard v Photographic Co (1888) 40 Ch.D. 345
- Breach of confidence
  - Creation Records v News Group Newspapers [1997] EMLR 444
  - Douglas v Hello! (2007) UKHL 21

5

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6

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7

## Creation Records



8

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9

## Copyright

- Copyright, Designs and Patents Act 1988
  - protects literary, dramatic and musical works
  - Originality
  - May be used to protect images, drawings, photographs, illustrations
  - Where images are copyright material and are being copied to a substantial extent without a licence then this may result in infringement

10

# Copyright

## □ Limitations

- No copyright in celebrity's image or name itself
- only useful for photographs, text where copyright held by celebrity
  - what if the images are new photographs?
    - Who owns the copyright in the photograph?
  - Who owns performance rights in sound or video recordings?

11

# Defences

- *Duchess of Sussex v Associated News* [2021] EWHC 273
  - A 21<sup>st</sup> Century *Albert v Strange* (1849)
- Copyright Infringement: Exceptions
  - Criticism, review or quotation
    - *Hubbard v Vosper* (1972)
  - Reporting current events
  - Courts would consider whether use was fair

12

## Public Interest Defence

- Public interest
  - HRH Prince of Wales v Associated Newspapers Limited 2006
  - Lion Laboratories Ltd v Evans (1985)
  - Hyde Park Residence Ltd v Yelland (2000)
  - Ashdown v Telegraph (2001)

13

## Trade Mark

- Protection of registered trade mark
  - Trade Marks Act 1994
    - Use as a trade mark
    - Origin of product
    - Used in course of business
  - Specified categories of goods and services
  - Use of an identical or similar name for the same or similar goods or services
  - Registering names – Elvis Presley Trademark [1999]
    - ‘badge of origin’

14

## Betty Boop



- Hearst Holdings Inc & Anor v AVELA Inc & Ors[2014] EWHC 439 (Ch)
  - Character must be significantly distinctive – Badge of origin or merely descriptive

15

## Passing Off

- Unregistered trade marks
- Use of competitor's name misleads purchaser into believing that there is an association with defendant
- Protects goodwill associated with the name

16



## Passing Off

### □ Requirements

- a misrepresentation
- made by the trader in the course of trade
- to prospective customers of his or ultimate consumers of goods or services supplied by him
- which is calculated to injure the business or goodwill of another trader
- which causes actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so.

17

## Passing Off

### □ False endorsement

- McCulloch v Lewis A May (1947) 65 R.P.C. 58.
- common field of activity

### □ Merchandising

- Lyngstad v Anabas Products Ltd [1977] F.S.R. 62

18

## False Endorsement

- Irvine v Talksport (2002)
  - To prove a false endorsement claim, the claimant had to prove
    - a) he had a substantial goodwill
    - b) the activities 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 approved by Mr Irvine

19

## Fenty v Arcadia [2015]

- Rihanna successfully brought passing off action against Topshop for marketing t-shirts with photographs of her image without her agreement
- Court emphasised importance of particular facts of case including
  - Image was associated with latest album
  - Rihanna had previous links with Topshop
- CA made it clear there is ‘no image right’

20



21

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22

## Other Jurisdictions

### □ US

- Varies across the different states
  - eg Californian Celebrities Rights Act 1985
- Voice and distinctive expressions
  - Carson v Here's Johnny Portable Toilets Inc 698 F.2d 831 (6th Cir. 1983)
  - Midler v Ford Motor Co 849 F.2d 460 (9th Cir, 1988)
- Impersonations
  - In Estate of Presley v Russen 513 F.Supp 1339 (DNJ, 1981)
  - c/f Elvis Presley Enterprises v Sid Shaw Elvisly Yours [1999] EWCACiv 964

23

## Australia

- No actual right of publicity
  - Tort of passing off
    - Henderson v Radio Corporation Pty Ltd [1969] R.P.C. 218.
    - Pacific DunlopLtd v Hogan (1989) 14 I.P.R. 398
    - Newton-John v School-Plough (1986) 11 F.C.R. 233
  - Statutory action for deceptive trading
    - Hogan v Koala Dundee 83 A.L.R. 187

24

## The Civil Law Approach

- Protection generally derives from
  - broad provisions in the civil code together with specific statutory provisions, related to copyright law and trade mark law

25

## The Future?

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- Development of tort of passing off
  - Can this provide a sufficient level of protection?
  - Should there be a specific personality right in English law?
    - Implications?



26

## Implications?

- Who would benefit?
  - The artist / performer?
  - Non-performers?
- Does the industry want this?
  - No AI generated crowds / performances?

