An examination of the commercial and non commercial appropriation of persona within the United Kingdom, with a comparative analysis with common and civil law countries.

MJur

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INTRODUCTION

This paper undertakes an examination of the existing protections available within the United Kingdom for the protection of privacy and aspects of an individual's persona. The paper where necessary gives a brief history of the cause of actions to facilitate discussion as to whether the actions still maintain their original purposes or have developed over time in order to cope with the different requirements of a increasingly media influenced society. With the actions of breach of confidence and passing off the paper uses short case studies of the *Douglas* and *Irvine* cases in order to exemplify the changes the law has undertaken.

In order to provide a comparative analysis the paper examines three other common law countries to show the different protections which are available. Firstly, the paper undertakes a detailed examination of the laws of the United States ("US"), and will show how the US have developed specific rights to privacy and publicity. Australia is used to show how a very similar legal system to the United Kingdom ("UK") has been more willing to adapt more quickly to the requirements of personalities seeking to protect against appropriation of their personality. The final common law system examined is Canada, this part of the paper shows the result of taking a different approach from the UK and the US. The Canadian section shows how it is possible for a legal system to have been influenced by aspects of both the UK and US legal systems, which has resulted in the creation of a specialised tort of appropriation of personality.

The following chapter looks at the protections available within three civil law countries, namely France, Germany and Italy. This section enables a cross comparison with the approach taken by European civil law countries and the effect of the European Convention of Human Rights ("ECHR") on their privacy laws. In addition the civil law section examines and analyses the systems in place within the various countries in response to the question of protecting privacy and publicity, for e.g. a right to publicity in Italy.

The paper undertakes a brief examination and comparative analysis of the various systems in use in different jurisdictions in comparison with UK. The paper throughout examines both historical and existing academic commentary to show the influences and reaction to the development of the law.

Throughout the paper the concept of an individual's persona or personality is used and this terminology was defined by Frazer as the "indicia of identity".[1] Consisting, at its narrowest interpretation, of the name, likeness and voice of a natural person.[2] The "personality right" allows celebrities to protect their "indicia of identity" by providing "the right to control and profit from the commercial use of one's name, image, likeness, etc., and prevent unauthorised appropriation of the same for commercial purposes".[3] Individual's rights are broken down into the right of privacy and right to publicity.[4]

The protections available concerning privacy and/or publicity are examined throughout the paper. The privacy rights discussed below seek to protect the human or dignitary rights, namely the right to exclude others, whereas the publicity or personality rights that are examined look at economic or property rights in an individual. It has been argued that publicity rights cannot exist without effective privacy rights, however the reality is that publicity rights seek to protect the value attached with the recognition value of the individual not the value of giving up their privacy. The right of publicity also encompasses where protection for an individual who chooses not to 'exploit' their persona for commercial gain. A more detailed examination of the

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[1] Frazer, 'Appropriation of Personality-A New Tort', (1983) 99 L.Q.R. 281

[2] S. Bains, 'Personality rights: should the UK grant celebrities a proprietary right in the personality? Part 1' 2007 Ent L.R. 164

[3] Azmul Haque, India: Face Value: Personality Rights and Celebrity Endorsements, September 2, 2003. Available at, *www.mondaq.com/article.asp?articleid=22487.*

[4] T. Lauterbach, 'US-style 'personality' right in the UK--en route from Strasbourg?', 20th BILETA Conference: Over-commoditised; Over-Centralised; Over-Observed: The New Digital Legal World? April 2005, Queen's University of Belfast.

academic thinking behind the essence of a right to privacy and publicity is undertaken in the US section of chapter 2 below. The legal development of the actions has often centred on the initial reluctance of the courts to grant wide protections for exploitation of the property rights in an individual's persona and being more willing to protect the individual.

It is paramount to show that despite protection for both being present within some actions each has been created through and raised different academic and legal debates. For example within breach of confidence, examined in detail below, it is possible and indeed well known to claim an action which covers both privacy and publicity aspects. A well known case that exemplifies this was *Douglas v Hello! Ltd*, where there were two claims one for privacy and the second brought for commercialisation of personality.

As the paper shows below the requirements of different causes of actions, to establish protection for privacy and/or publicity, has resulted in the extension of actions away from their initial scope and intention. The thesis begins by examining breach of confidence.

CHAPTER 1

1 Protections available within the United Kingdom

1.1 Introduction

"That the individual shall have full protection in person and in property is a principle as old as the common law; but it has been found necessary from time to time to define anew the exact nature and extent of such protection."[5]

Frazer defined the concept of an individual's personality or persona as the "indicia of identity."[6] Consisting, at its narrowest interpretation, of the name, likeness and voice of a natural person.[7] The "personality right" allows celebrities to protect their "indicia of identity" by providing "the right to control and profit from the commercial use of one's name, image, likeness, etc., and prevent unauthorised appropriation of the same for commercial purposes".[8] Individual's rights are broken down into the right of privacy and right to publicity.[9]

The current domestic position is that the laws protecting privacy and publicity rights relies upon piecemeal protections e.g. breach of confidence, Human Rights Act 1998 ("HRA"), passing off, defamation, trademarks and copyright, many of which have been forced to develop from their intended scope.

Privacy rights within the UK are traditionally protected within a breach of confidence action and seeking to protect the dignity and personal invasion of an individual. The scope of the action as shown below, has been widened both before and since the enactment of the HRA.

Breach of confidence can also be used in order to protect against the misappropriation of private information, which has a commercial value as shown with OK! Magazines successful claim in the Douglas litigation cases. More traditionally though claimants have sought to protect the commercial value of their persona through alternative actions such as passing off, trade mark and copyright. Although there has been some academic commentary in relation to the push for a specific publicity right no such law current exists within the UK. This has resulted in existing actions being made to develop to offer much wider protection than they were designed for.

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[5] S. Warren and L. Brandeis, 'The Right to Privacy' (1890) 4 Harvard Law Review 193

[6] Frazer, 'above n.1

[7] S. Bains, above n.2

[8] A. Haque, above n.3

[9] T. Lauterbach, above n.4

1.2 **Breach of Confidence**

(a) ***History and Development of Breach of Confidence***

Laws J stated:[10]

"If someone with a telephoto lens were to take from a distance with no authority a picture of another engaged in some private act, the subsequent disclosure of the photograph would surely amount to a breach of confidence…In such a case the law should protect what might reasonably be called a right to privacy, although the name accorded to the cause of action would be breach of confidence."

The breach of confidence action is based upon a proposition of good faith that can protect ideas both valuable and mundane.[11] This idea protected beyond the confidential relationship that was previously required,[12] this creeping development of the law of confidence occurred both before and post the HRA enactment.[13] The use of the action has increased due to litigants using it to enforce their 'Article 8' rights against individuals and the state.[14] Patten J. said the English law does not recognise a general tort or action for invasion of privacy,[15] however a breach of confidence action could potentially provide a horizontal remedy where the claimants 'Article 8' rights were infringed.[16]

The significant recent decision of *Campbell v Mirror Group Newspapers (2004)*[17] has not established a new right to privacy tort law, but the case is a small but definite step in tackling the misuse of private information. Phillipson[18] argues that the lack of a clear legal remedy in respect of the non-consensual disclosure of personal information is one of the most serious lacunae in English law. His view was subsequently confirmed by the Court of Appeal, and this was pronounced "a glaring inadequacy" by the Law Commission.[19] Lord Nicholls remarked that "the continuing and widespread concern at the apparent failure of the law" in this area.[20] Phillipson[21] proposes that the doctrine of confidence can afford far more protection

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[10] *Hellewell v Chief Constable of Derbyshire* [1995] 1 WLR 804

[11] H. Carty, 'The common law and the quest for the IP effect.' I.P.Q. (2007) 237

[12] *Coco v AN Clark (Engineers) Ltd* [1969] R.P.C. 41 per Megarry. J.

[13] Creation Records Ltd v News Group Newspapers Ltd [1997] EMLR 444; Douglas v Hello! Ltd (No 6) [2005] EWCA Civ 595 [2006] Q.B. 125; Venables v News Group Newspapers Ltd [2001] Fam 430; Campbell v Mirror Group Newspapers Ltd [2004] UKHL 22 [2004] 2 AC 457; Douglas v Hello! Ltd sub nom OBG Ltd v Allan [2007] UKHL 21 [2007] 2 WLR 920.

[14] B. Pillans 'Thus far and no further', Comms, L. (2007) 213

[15] Wainwright v Home Office [2003] UKHL 53, [2004] 2 AC 406

[16] Douglas v Hello! Ltd (No 1) [2001] QB 967, 1003 per Sedley LJ.

[17] Campbell above n.13

[18] G. Phillipson & H. Fenwick 'Breach of Confidence as a Privacy Remedy in the Human Rights Act Era', M.L.R. 63(5), 2000, 660

[19] Breach of Confidence (Law Com. No. 110), Para 5.5.: 'the confidentiality of information improperly obtained…may be unprotected'.

[20] R v Khan [1997] AC 558 at 582

[21] Above n.18

in this area than generally recognised[22] but sufficient judicial labour is required to flesh out and give definition to the action, which presently lacks clear legal profile. Although a law that enables protection from unwanted publication of personal information is bound to become a "legal porcupine, which bristles with difficulties".[23]

The law took its modern form in the mid nineteenth century, in *Prince Albert* v *Strange (1849)*,[24] which was brought by the husband of Queen Victoria. The case involved unauthorised copies of private drawings by the professional printer for display in a public exhibition. Cottenham LC, said that in addition to the drawings proprietary rights an action would also have been sustainable on grounds of equity, confidence and contract law.[25]

Cases during the twentieth century have tried to utilise to use breach of contract as a basis of breach of confidence, both where there were express and implied contract term.[26] In a pre HRA era the action was being developed as shown in *Spycatcher*[27] where an obligation of confidence was found to arise independent of a contractual relationship. Lord Keith stated "[the obligation] may exist independently of any contract on the basis of an independent equitable principle of confidence."[28]

Coco v A.N. Clark Engineers Ltd (1969),[29] created the test for confidence, *Coco* dealt with the break down in a moped engine venture, where the defendant was unsuccessfully accused of using confidential information. Megarry J. stated he was dealing with the 'pure equitable doctrine of confidence unaffected by contract'.[30] The test consisted of three parts:[31]

1 the information itself must have the necessary quality of confidence about it;

2 the information must have been imparted in circumstances importing an obligation of confidence; and

3 there must have been an unauthorised use of that information to the detriment of the party communicating it.

The introduction of the HRA, on the 2nd October 2000, has had significant changes to the breach of confidence action. These changes include covering information when it is 'private' rather than 'confidential.

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[22] See D. Feldman, 'Privacy Related Rights and their Social Value' in R Birks (ed) Privacy and Loyalty (Oxford: Clarendon, 1997) 47; Hellewell above n.10 at 807 and Earl Spencer and Countess Spencer v The United Kingdom (1998) 25 EHRR CD 105

[23] R v Inner London Education authority ex p Westminster City Council [1986] 1 WLR 28

[24] Prince Albert v Strange (1849) 1 Mac & G. 25

[25] Ibid at 32

[26] Vokes v Heather (1945) 62 RPC 135

[27] A-G v Guardian Newspapers (No2) [1990] 1 AC 109, [1988] 3 All ER 545

[28] Ibid at 255

[29] Coco above n.12

[30] Ibid at 46

[31] Ibid at 47

(b) ***Human Rights Act 1998***

(i) *Introduction*

The introduction of the Act has brought forth a body of case law under which the right to privacy, as protected under Article 8 of the *European Convention for the Protection of Human Rights and Fundamental Freedoms ("ECHR")*.[32]

The extent to which the confidence has changed[33] post HRA is difficult to identify as new case law appears to increase the protections available.[34] Vaver,[35] stated the HRA has not or is unlikely to create a new privacy tort but has utilised confidence to become privacy's action of choice in the UK,[36] which was re-emphasised by Buxton L.J.[37] In developing the right to protect private information, including the implementation of ECHR Arts 8 and 10, the courts have proceeded through the tort of breach of confidence, into which the jurisprudence of Arts 8 and 10 has to be "shoehorned".[38]

The journalistic invasions of privacy cases involved personal, not public-political affairs of its subjects. These are commonly driven by purely commercial considerations thus do not engage the press's right under art.10 to impart 'information on matters of serious public concern'[39] or values such as the furtherance of a democratic society. In order to allow an analysis this paper will briefly outline arts.8, 10 of the ECHR and art.12 of the HRA.

Warbrick stated, echoing a strongly-worded Resolution of the Council of Europe that the obligation of the state to respect private life by controlling the activities of its agents in collecting personal information ought to extend also to similar operations by private persons such as…newspapers.[40]

Tulkens,[41] suggested a ban on publishing an image may be considered a justifiable interference with the right of freedom of expression so long as it satisfies the criteria of art.10(2).[42] The court has also found it unnecessary or possible to attempt an exhaustive definition of the notion of 'private life.'[43]

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[32] European Convention for the Protection of Human Rights and Fundamental Freedoms (Rome, November 1950); TS 71 (1953); Cmd.8969

[33] T. Aplin, 'The Development of the action for breach of confidence in a post-HRA era', I.P.Q 2007 at 19

[34] McKennitt v Ash [2006] EWCA Civ 1714; HRH Prince of Wales v Associated Newspapers Ltd [2006] EWHC 522; Lord Browne of Madingley v Associated Newspapers Ltd [2007] EWHC 202 (QB)

[35] D.Vaver, 'Advertising using an individual's image: a comparative note', L.Q.R. (2006) 362

[36] HRH Prince of Wales above n.34

[37] Wainwright above n.15 at [28] to [35]; *Campbell above n.13 per* Lords Nicholls and Hoffmann and Baroness Hale at [11], [43] and [133] respectively.

[38] Douglas above n.13 at [53]. See A.McLean and C. Mackey, 'Is there a law of privacy in the UK? A consideration of recent legal developments', E.I.P.R. (2007) 389 at 390

[39] Bladet Tromso v Norway (1999) 29 E.H.R.R. 125

[40] Harris, O'Boyle and Warbrick, Law of the European Convention on Human Rights (London: Butterworths, 1995) 310. Resolution 428 (1970) of the Council of Europe states that the right to privacy under Article 8 should extend to 'interference by private persons including the mass media.' Such resolutions may be taken into account by the European Court of Human Rights as a source of 'soft law': A Clapham, Human Rights in the Private Sphere (Oxford: Clarendon, 1993), 102-103.

[41] Tulkens. J at the European Court of Human Rights at Council of Europe's Strasbourg Conference "Freedom of Expression and the Right to Privacy."

art.8 rights must be examined in conjunction with the other articles, particularly for the purpose of this thesis, art.10 the right of freedom of expression. Therefore before it is possible to determine the extent to which an individual has the right to privacy, it is necessary to examine the individual facts of the case. For example, where a newspaper printed a picture of Naomi Campbell leaving a drug rehabilitation clinic, along with a story saying that she lied concerning her use of narcotics questions regarding the "public interest" in the subject were raised. As Pinto[44] discusses not all confidential information is private and art. 8 is only applicable where the right to a person's private or family life, home or correspondence is involved.

HRA s.12 relates to providing relief where the case may interfere with art.10 of the ECHR.[45] Section 12(3) provides that: 'no…relief is to be granted so as to restrain publication before trial unless the court is satisfied that the applicant is likely to establish that publication should not be allowed'. This requires the court to undertake a substantial balancing test at the interim stage; subsection (4) confirms this, by instructing that when they are dealing with, *inter alia*, journalistic material, they must consider the extent to which 'it is in the public interest for the material to be published.'[46] It's clear that the State's duties under art.10 are engaged under court orders, particularly injunctions amounting to prior restraint and those which infringe free speech. The defamation cases including *Tolstoy Miloslavsky v United Kingdom (1995)*[47] and *Bladet Tromso v Norway (1999)*[48] establish that this is the case, regardless that both parties are private persons.[49]

(ii) *Confidential to Private*

The introduction of the Act has brought forth a body of case law under which the right to privacy, as protected under art.8 ECHR.[50] The chosen action to use the additional protection within the UK is breach of confidence. There is a balancing act between arts.8 and 10 of the ECHR, between the right to private life and the freedom of expression. The courts take a case by case review to ensure that an individual's protections are not withheld with due reason.

(iii) *Articles 8 and 10*

Article 8(1) of the ECHR provides that "everyone has the right to respect for his private and family life, his home and his correspondence." The scope of the article is not confined to protecting individuals from state interference as was shown in *Marckx v. Belgium (1979)*[51] and in *Y v. The Netherlands (1985)*[52] the court

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[42] Article 10(2) – The exercise of these Freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation of rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary

[43] Niemietz v Germany (1992) 16 E.H.R.R 97

[44] T. Pinto, 'Tiptoeing along the catwalk between Articles 8 and 10', Ent L.R. 20004, 15(7), 199

[45] It applies, per s.12(1): 'if a court is considering whether to grant any relief which, if granted, might affect the exercise of the Convention right to freedom of expression'.

[46] Human Rights Act 1998, section 12(4)

[47] Tolstoy Miloslavsky v United Kingdom (1995) 20 E.H.R.R. 442

[48] Bladet Tromso above n.39

[49] X and Y v The Netherlands [1985] 8 E.H.R.R 235

[50] ECHR above n.32

[51] Marckx v Belgium [1979] 2 E.H.R.R 330

stated that "these obligations may involve the adoption of measures designed to secure respect for private life even in the sphere of the relations between individuals themselves". Warbrick agrees with this viewpoint and believes that companies such as newspapers and private individuals should both be included with the article's scope. [53]

The scope of 'private life' covered under Article 8 is broad and is not susceptible to exhaustive definition, Starmer proposes[54] that the courts are not prepared to exclude activities of a business and professional nature as people develop relationships requiring protection during their working lives. The court's refusal "to accept that the public take the celebrities names on goods as a genuine endorsement can change when the personality misappropriation interferes with privacy.[55]

For there to be protection through a breach of confidence action under article 8 there must be a 'quality of confidence.' In determining whether this threshold has been achieved the courts have asked whether the information is identifiable and original,[56] not already in the public domain,[57] not trivial tittle-tattle and is not immoral. The post HRA era has seen the courts applying similar criteria but moving the focus from whether the information is "confidential" to is the information "private." This shift was shown in *A v B & C (2002)*,[58] where Lord Woolf set out guidelines to assist in determining interlocutory applications in breach of confidence cases:

"… in the majority of cases the question of whether there is an interest capable of being the subject of a claim for privacy should not be allowed to be the subject of detailed argument. There must be some interest of a private nature which the claimant wishes to protect, but usually the answer to the question whether there exists a private interest worthy of protection will be obvious."[59]

Lord Nicholls in *Campbell* overturned the decision of Morland. J and discussed the relevance of art 8, stating that "the touchstone of private life is whether in respect of the disclosed facts the person in question had a reasonable expectation of privacy."[60] Baroness Hale firmly believed that is was this reasonable expectation of privacy test, followed in *Douglas (No.3)*,[61] which finely balances arts.8 & 10 by placing careful consideration of the claimant's interests in keeping the information private against the defendant's interest in

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[52] X and Y above n.49

[53] Harris and A Clapham above n.40

[54] K. Starmer, 'European Human Rights Law: The Human Rights Act 1998 and the European Convention on Human Rights,' (Legal Action Group, 1999) Pg 125

[55] C. Griffiths, 'The Human Rights Act 1998 – The implications,' [2000] 5 I.P Law 18 at 19; protection would also be of assistance where the celebrity has a trade mark but the use does not constitute trademark use such as decorative use on a t-shirt

[56] Fraser v Thames TV [1984] 1 Q.B. 44 (Hirst J.) at 65-66, followed in De Maudsley v Palumbo [1996] F.S.R. 447 at 456

[57] Coco above n.12 at 47; Stephens v Avery [1988] Ch. 449, Ch D

[58] A v B & C [2002] E.M.L.R. 7 (Jack J.); [2003] Q.B. 195, CA

[59] Ibid at 206

[60] Campbell above n.13 at 466

[61] Douglas (No.3) above n.13 at 119.

disclosing it.[62] This has now been established as the definitive test in preference to the "obviously private test," set out by Lord Woolf C.J. in *A v B & C*.[63]

Fenwick and Phillipson however believe that the Lord Woolf test is "structured by reference to art.8 case law,"[64] and thus is more unlikely to be prone to uncertainty than the reasonable expectation test. Moreham conversely prefers[65] the reasonable expectation test, but suggests developments for it, as it reflects the subjective nature of the privacy interest, whilst including an objective check on the scope of the action by requiring the expectation of privacy to be "reasonable".

Article 8 rights must be examined in conjunction with the other articles and particularly for the purpose of this thesis, art.10 the right of freedom of expression. Therefore before ascertaining the extent to which an individual has the right to privacy it is necessary to examine the individual facts of the case such as the public interest, which is discussed in greater detail below. As discussed above not all confidential information is deemed to be private nor all information assumed to be confidential until otherwise shown, and art. 8 is only applicable where the right to a person's private or family life, home or correspondence is involved.

(iv) *Public interest defence*

Breach of confidence has always recognised a public interest defence, but it was only used in a handful of cases.[66] Prior to the HRA, public interest was available as a defence,[67] that extended to disclosing information of civil, criminal wrongs and other "just cause or excuses"[68] for breaking confidences. The defence was intentionally narrowly constructed and any disclosure needs to be justified as "one who has a proper interest to receive the information." Thus not merely what is of interest to the public but in the public interest.[69]

However, post HRA the defence has been used as one of a number legal arguments available under art.10. Case law has created a more liberal interpretation of the public interest defence, as seen in *Theakston*, where Ouseley J. commented that there was "a real element of public interest" in publishing his attendance at the brothel.[70] Although he interpreted "public interest" broadly, he felt that the disclosure needs to be proportionate to the public interest served, thus he believed the pictures accompanying the article did not fall under the interest.[71] Ouseley J. believed that the justification for this extended approach to the public interest defence as privacy had extended under art. 8 therefore:

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[62] Campbell above n.13 at 496

[63] A v B & C above n.58

[64] H. Fenwick and G. Phillipson, *Media Freedom under the Human Rights Act* (OUP, Oxford, 2006), p.764.

[65] N. Moreham, 'Privacy in the Common Law: A Doctrinal and Theoretical Analysis', L.Q.R. 2005, 121, 628 at pp.647-648 argues for certain developments to the test.

[66] Jockey Club v Buffham [2003] Q.B. 462; London Regional Transport v Mayor of London [2003] E.M.L.R. 4; Lion Laboratories Ltd v Evans [1985] Q.B. 526; Hubbard v Vosper [1972] 2 Q.B. 84; Fraser v Evans [1969] 1 Q.B. 349; Initial Services Ltd v Putterill [1968] 1 Q.B. 396

[67] *Lion Laboratories ibid*; *W v Edgell* [1990] 1 Ch. 359 at 389-394 *per* Scott J.

[68] *Woodward v Hutchins* [1977] 1 W.L.R. 760, Lion above n.66;

[69] Francome v Mirror Group Newspapers [1984] 2 All E.R. 408 at 413

[70] Theakston v MGN Ltd [2002] E.M.L.R 22 at 42

[71] Ibid at 43, Ouseley J. commented that the public interest in publishing *details* of his sexual activity were less weighty and held at 44 that there was no public interest in publishing the photographs of the claimant inside the brothel; G Phillipson, 'Transforming Breach of Confidence? Towards a Common Law Right of

"… the resolution of the conflict between arts.10 and 8 cannot be dependent on narrowly defined exceptions to the law of confidentiality appropriate for a more restricted concept and inept for so greatly extended a protection."[72]

This extended view of public interest can was also applied in *A v B & C*,[73] where Lord Woolf C.J. accepted that public figures although entitled to a private life had to expect close scrutiny by the media, even where the issue may involve trivial facts. The level to which the media could pry depended upon their position in society.[74] However, in the light of the *Theakston,*[75] *Mosley*[76] and *A v B & C*[77] judgments, the courts have moved from this broader view of public interest and in the context of privacy claims, have treated "public interest" as being central to an art.10 claim. Thus the courts do not treat freedom of expression as a "monolithic, context-less value". However, there still remains some uncertainty about the interrelation of established principles concerning the public interest defence and art.10.

In the aftermath of *McKennitt*[78] the pre HRA principles of public interest defence are reiterated but updated post HRA jurisprudence, in particular *Campbell*. It is now the established position that matters need to be in the public interest and not just of interest to the public,[79] although it is in the public interest to correct deliberate misrepresentation concerning serious behaviour.

Phillipson interestingly argues that using a 'role model' test for public interest relies on an assumption that the individual's actions influence the public, in reality it is unclear how true this is. The assumption, that incorrect impression are harmful to societies public interest, undermines "the very notion of the right to informational autonomy, or selective disclosure, which most commentators see as lying at the heart of the right to privacy".[80] The right to correct misconceptions created by individual's is a strong justification of the rights contained in art.10, such as in *Campbell* where the newspaper article sought to correct the false impression that Ms Campbell did not take drugs.

It is a fine line between what is in the public's interest and what is in the interest of the public and the case law of *Campbell*, *Theakston*, *A v B & C* and *Mosley* shows that the courts are prepared to grant a relatively wide justification under art.10 for printing articles, although less so with pictures, portraying well known individual's in private situations both legal and illegal. These journalistic invasions of privacy cases involved personal, not public-political affairs of its subjects, and are commonly driven by purely commercial considerations thus do not engage the press's right under art.10 to impart 'information on matters of serious public concern'[81] or values such as the furtherance of a democratic society. However the courts have been

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Privacy under the Human Rights Act', M.L.R. 2003, 66, 726 at pp.753-754, however, has argued that Ouseley J. "showed no recognition that what he was doing was part of a proportionality enquiry he was bound to undertake, and no real understanding of the argument that greater detail in reporting amounts to a graver intrusion into privacy which must be justified."

[72] Ibid

[73] A v B & C above n.58

[74] Ibid.

[75] Theakston above n.70

[76] Mosley v News Group Newspapers Ltd [2008] EWHC 1777 (QB)

[77] A v B & C above n.58

[78] McKennitt, above n.34

[79] Douglas above n.13;

[80] G. Phillipson, above n.82 at p.70.

[81] Bladet Tromso above n.39

prepared to set aside the individual's art.8 rights where the subject has been engaged in an immoral act, for example in *Campbell* this was lying about drug taking.

The courts have been more willing to grant protection where the protection of family values were deemed to be at stake such as shown in *Murray v Big Picture (2008)*,[82] where the case involved long lens photographs taken of J.K. Rowling's child. The Court of Appeal found for the Murray's even though the photograph only showed what would have been seen by a passer by as the dissemination of the photograph to wide number of people might lead to further intrusions of privacy.

(v) *Requirements for a breach of confidence action*

Pre HRA a perceived limitation of using breach of confidence to protect privacy was the *Coco* test which required that confidential information was imparted in circumstances, which imported an obligation of confidence.[83] Third parties were restrained from disclosing information once they had notice of the attached obligation of confidence of the information, which was breached when the information disclosed to them.[84]

Post HRA there has been an erosion of the relationship of confidence necessity, which no longer applies to personal information.[85] This began with *Venables*, where Dame Butler-Sloss held[86] that s.12(4). of the HRA required her to regard art.10, under art.10(2), the right to confidence is a recognised exception to the freedom of expression. She believed that a duty of confidence can arise in equity even where no relationship existed between the parties. Citing Lord Goff's dicta in *A-G v Guardian*,[87] saying that a stranger can be restrained from disclosing certain information where it is known to be confidential.[88]

The second limb of the *Coco* test has now been dispensed with in relation to personal information, as shown in *Campbell* and the Court of Appeal decision in *Douglas*. Lord Nicholls in *Campbell* explicitly rejects the

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[82] Murray v Big Picture (UK) Ltd [2008] EWCA Civ 446

[83] See *Report of the Committee on Privacy and Related Matters,* Cm 1102 (1990), para.8.7; WB v H Bauer Publishing Ltd [2002] E.M.L.R. 8 at 30.

[84] Malone v Metropolitan Police Commissioner [1979] Ch. 344 at 361 per Megarry V.C.; and A-G above n.27 at 255 per Lord Keith.

[85] B. Markesinis, C. O'Cinnedie, J. Fedkte and M. Hunter-Henin, 'Concerns and Ideas about Developing the English Law of Privacy', (2004) 52 Am. J. Comp L.133 at .143 welcomes this development; H. Delany, 'Breach of Confidence or Breach of Privacy: The Way Forward' (2005) 27 *Dublin University Law Journal* 151 at pp.154-157 and, more recently, Fenwick above n.64 at pp.728-740.

[86] Venables, above n.13 at 42-44, 77 & 79. Dame Butler-Sloss at 77, emphasised that the exceptions must be construed narrowly and that Arts 2 and 3 of the Convention were also relevant.

[87] A-G. above n.27 at 281 *per* Lord Goff: "I realise that, in the vast majority of cases, in particular those concerned with trade secrets, the duty of confidence will arise from a transaction or relationship between the parties, often a contract, in which event the duty may arise by reason of either an express or an implied term of that contract. It is in such cases as these that the expressions 'confider' and 'confidant' are perhaps most aptly employed. But it is well-settled that a duty of confidence may arise in equity independently of such cases; and I have expressed the circumstances in which the duty arises in broad terms, not merely to embrace those cases where a third party receives information from a person who is under a duty of confidence in respect of it, knowing that it has been disclosed by that person to him in breach of his duty of confidence, *but also to include certain situations, beloved of law teachers, where an obviously confidential document* is wafted by an electric fan out of a window into a crowded street, or when an *obviously confidential document, such as a private diary,* is dropped in a public place, and is then picked up by a passer-by. I also have in mind the situations where secrets of importance to national security come into the possession of members of the public" (emphasis supplied).

[88] Venables, above n.13 at 1065

need of confidential relationship by stating that "this cause of action has now firmly shaken off the limiting constraint of the need for an initial confidential relationship, in doing so it has changed its nature."[89] He believed that this was recognised by Lord Goff in *A-G v Guardian*. Lord Goff stated by "now the law imposes a 'duty of confidence' whenever a person receives information he knows or ought to know is fairly and reasonably to be regarded as confidential". However, Nicholls believes that it is not ideal to use the phrase "duty of confidence" but rather it should describe the information as "confidential".[90]

Where personal information is at issue the courts no longer apply the *Coco*[91] test but rather examine the question of whether the information is both private and that an obligation of confidence arises from it. If this is established the courts will then examine the merits of both arts. 8 & 10. Lord Hoffmann believed that there has been "a shift in the centre of gravity of the action for breach of confidence when it is used as a remedy for the unjustified publication of personal information".[92]

In situations where the press have obtained information about individuals through interviewing friends of the claimant in whom they have confided[93] the obligation of confidence may be imposed upon the newspaper as they should have known that they had received the results of a broken confidence.[94] The alternative option is to impose an obligation on the newspaper directly, on the ground that the reasonable man would have realised that the information received should be kept confidential, due to its clearly private character.[95]

Sir Anthony Clarke M.R. undertook a two stage approach to breach of confidence, by examining whether the information was protected by art.8 and if so would art.10 be more persuasive. He treated both "business" and "personal" information with the same reasonable expectation of privacy test,[96] believing that the nature of a pre-existing relationship is of strong importance in assessing whether a reasonable expectation of privacy could be inferred in respect of the disclosed information.[97]

(vi) *Range*

The courts have continued to have a wide view of the information content that could be classified as "confidential" or "private" since the HRA was enacted. Medical information is still recognised as before, however in *Campbell* the House of Lords interpreted the definition of medical information broadly to include information related to her drug addiction and therapy.[98] Information such as people's physical appearance,

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[89] Campbell, above n.13 at 464

[90] Ibid at 465

[91] H. Beverley-Smith, A. Ohly and A. Lucas-Schloetter, *Privacy, Property and Personality; Civil Law Perspectives on Commercial Appropriation* (CUP, 2005), p.87.

[92] Campbell, above n.13 at 473, See also HRH The Prince of Wales, above n.34

[93] Barrymore v News Group Newspapers [1997] F.S.R. 600 (a friend with whom Barrymore allegedly had a homosexual affair passed the details to a newspaper); Stephens, above n.57

[94] A-G above n.27 at 562; and Breach of Confidence above n.19 at para.4.11

[95] Ibid at para.5.9 that the doctrine can give no remedy to the 'owner' of personal information where the promise of confidentiality is given to another; see also the doubts of Wacks on this point: Privacy and Press Freedom (London: Blackstones, 1995) pg 56.

[96] Madingley v Associated Newspapers Ltd [2007] EWHC 202 (QB). at 36; McKennitt above n.34; X & Y v Persons Unknown [2006] EWHC 278 (QB);

[97] A. Mclean above n.38 at 393; CC v AB [2006] EWHC 3083 (QB); HRH Prince of Wales, above n.34

[98] *Campbell* above n.13, *per* Baroness Hale, Lord Hope and Lord Carswell at 144-147, 91 and 95, and 166 respectively.

whereabouts, people's home address,[99] new identities and place of incarceration also qualify where the safety of the claimant would be at serious risk without protection.[100]

A common and problematic issue that has arisen post HRA is whether details of sexual relationships fall under the umbrella of confidential information. This is exemplified in the case of *Theakston v Mirror Group Newspapers Ltd (2002),*[101] where the claimant was a television personality who without permission was photographed whilst engaging in sexual activities at a brothel. This information was then sold to The Sunday People Newspaper, who planned to publish them, Theakston sort an injunction to restrain publication on grounds of invasion of privacy and breach of confidence. Ouseley J. held that was "impossible to invest with the protection of confidentiality all acts of physical intimacy regardless of the circumstances".[102]

The confidentiality of the sexual activity would depend upon the nature of the relationship, nature of the activity and the other circumstances in which the activity takes place. The judge found the engagement of sexual acts at a brothel was not confidential, due to the brief nature of relationship, the brothel was not a private place and the prostitutes did not regard the information as confidential, the nature of relationship did not inherently make the information confidential and the absence of any express stipulation of confidentiality. Ouseley J. also rejected that the details of the claimant's sexual activities were confidential; however, the photographs were different as they are regarded as a particularly embarrassing and humiliating intrusion into the claimant's personal life.[103]

The judgment of *Theakston* was cited with approval in *A v B & C,* with Lord Woolf C.J. criticising the first instance judge for treating an affair as the same as marriage.[104] Both *Theakston* and *A v B & C* have been criticised for the method in which the test of confidential information was applied, confusing the requirement of confidentiality with that of an obligation of confidence. The fact the information was known to people within the brothel does not necessarily destroy the obligation of confidence. It is additionally argued that *Theakston* and the Court of Appeal in *A v B & C* were also wrong decided according to a test of "private" information.[105] The cases dealt with information that should fall under the "reasonable expectation of privacy" test, regardless of the length of the sexual relationship.[106] This decision has been re-emphasised in *Mosley*,[107] where pictures of the claimant involved in sado-masochistic activities were published in the News of the World. Eady J. awarded damages of £60,000 and said that there was an expectation of privacy where there was consensual activities even where unconventional.

Phillipson argues that the contradictions in judicial reasoning arise from courts' "failure to resolve decisively the extent to which principles deriving from privacy substitute themselves for the traditional ingredients of the

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[99] Green Corns Ltd v Claverly Group Ltd [2005] E.M.L.R. 31 at 47, even where known to people in the surrounding area

[100] *Venables above n.13*

[101] Theakston above n.70

[102] Ibid at 76

[103] Ibid at 77-78, Ouseley J. refused to grant an injunction against publication of the first and second type of information, but granted one in respect of the third type of information.

[104] A v B & C above n.58 at 216

[105] It is relevant to note that in Douglas (No.3), above n.13, Lord Phillips M.R. referred to Theakston above n.70 at 73:“that to date the English courts appear to have taken a less generous view of the protection that the individual can reasonably expect in respect of his or her sexual activities than has the Strasbourg Court.”

[106] Phillipson above n.71 at p.747-8.

[107] Mosley above n.76

action in confidence."[108] However, post *Campbell,* it's likely that this indecisiveness will disappear and the courts will become more willing to apply the "private information" test which does not include considerations particular to confidentiality.[109]

(vii) *Form of information*

Prior to the HRA, there was authority that confidentiality might apply to information in a form such as a record album cover photograph as occurred in *Creation Records Ltd* v *News Group Newspapers Ltd (1997)*.[110] Lloyd J. stated that although there were spectators who had seen the spectacle and could relate it verbally or even by sketch but "It is the photographic record of the scene, the result of the shoot in fact, that was to be confidential."[111] Thus, Lloyd J. distinguished between information in oral form or drawings and information in photographic form. While the former was not treated as confidential and could apparently be disclosed, the latter was considered confidential and to disclose information in this form was a breach of confidence. *Creation Records* established that it was the manifestation of information itself that was subject to protection rather than the individual information elements that make up the overall exhibition of the information.

However, in *Hello!* Lord Walker cast doubt over the correctness of the ruling in *Creation Records,*[112] stating that the claimant is only deserving when the information has been kept secret,[113] with some considerable degree of independent effort from the claimant.[114] The security arrangements in Hello! alone would not grant the necessary quality of confidence. In relation to the image in *Creation Records* and whether it should merit protection as a commercial secret, he felt that photographs of a white Rolls Royce could be thought as a "fairly trivial trade secret," and the defendants did not rely upon Lord Goff's trivia proviso.[115]

The court in *Douglas* recognised the special nature of photographs and how information in other forms could be qualitatively different: by saying, "nor is it right to treat a photograph simply as a means of conveying factual information. It is quite wrong to suppose that a person who authorises publication of selected

[108] Phillipson above n.71 at p.748; M. Waterfield, 'Now You See It, Now You Don't: The Case For A Tort Of Infringement of Privacy in New Zealand', (2004) 10 *The Canterbury Law Review* 182 at pp.202-203.

[109] T. Aplin above n.33 at 26

[110] Creation Records above n.13

[111] *Ibid* at 455

[112] Although he seems happy to agree with the result in Shelley Films Ltd v Rex Features Ltd [1994] E.M.L.R. 134, noting that it involved a serious film with a $40m budget and a sustained effort to keep an essential element of the film secret so as to maintain the interest of the public, Douglas, above n.13 at 289. Moreover, he notes that in this case (as in the case of *Gilbert v Star Newspaper Co Ltd* (1894) 11 T.L.R. 4 to which he also refers), the injunction only applied until the release of the work.

[113] Coco above n.12 at 47

[114] Douglas above n.13 at 293. It may be therefore that he would not have found the Douglas's' claim in commercial confidentiality made out. Apart from trade secrets that "something more" that Lord Walker requires (in relation to unauthorised photographs) might be genuinely embarrassing photographs or photographs the publication of which involves a misuse of official powers.

[115] Carty above n.12 at 237, Douglas above n.13 at 291. And of course within that limiting principle can also be included "vague aspirations or concepts", at least in the entertainment field, as Hirst J. asserted in *Fraser above n.56* at 65, "the content of the idea [must be] clearly identifiable, original, of potential attractiveness and capable of being realised in actuality".

personal photographs taken on a private occasion, will not reasonably feel distress at the publication of unauthorised photographs taken on the same occasion."[116]

The difference of photographs from written information was re-emphasised in *Campbell*.[117] The text that accompanied the photographs made clear that the photographs were not ordinary photographs of her in a public place, but arriving or leaving from the Narcotics Anonymous meetings. Baroness Hale stated:

"A picture is 'worth a thousand words' because it adds to the impact of the words; but also adds to the information given in those words. In context, it also added to the potential harm, by making her think that she was being followed or betrayed, and deterring her from going back to the same place again."[118]

(viii) *Public domain*

The requirement for information to be secret or inaccessible to the public[119] is not an absolute requirement.[120] Thus the fact that some parties have knowledge of the information does not necessarily destroy the confidentiality.[121] The consequences of information becoming common knowledge or entering the public domain was considered in *Attorney General* v *Guardian Newspapers Ltd (No.2) (1990).*[122] The case concerned a book (*Spycatcher*) previously published[123] and was readily imported into the UK. It was the reporting of the unsuccessful litigation in Australia by The Guardian and Observer newspapers and the beginning of the serialisation by The Sunday Times that brought the case. An injunction was denied to the Attorney General and the appeal to House of Lords dismissed as Lord Keith stated "all possible damage to

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[116] *Douglas (No.3)* above n.13 at 106 *per* Lord Phillips M.R. See also *Douglas (No.1)* above n.16 at 165 *per* Keene L.J.

[117] In *D v L* [2004] E.M.L.R. 1, CA, Waller L.J. at 24 recognised that information in the form of a sound recording also may be qualitatively different: "Just as a photograph can make a greater impact than an account of the matter depicted by that photograph, so the recorded details of the very words of a private conversation can make more impact, and cause greater embarrassment and distress, than a mere account of the conversation in question".

[118] *Campbell* above n.13 at 155.

[119] *Saltman Engineering v Campbell Engineering* (1948) 65 R.P.C. 203 at 215 *per* Lord Greene M.R: "The information, to be confidential, must, I apprehend, apart from contract, have the necessary quality of confidence about it, namely, it must not be something which is public property and public knowledge." This was followed in *Coco* above n.12, at 47 *per* Megarry J. See also *A-G* above n.27, at 268 *per* Lord Griffiths and at 282 *per* Lord Goff.

[120] Fenwick above n.64 at pp.678-679; and A. Tettenborn, 'Breach of Confidence, Secrecy and the Public Domain' (1982) 11 *Anglo-American Law Review* 273

[121] See *Prince Albert above n.24*, where an injunction was granted even though the confidential information, in the form of etchings, had been circulated amongst friends of the claimant. See also *Exchange Telegraph Co Ltd v Central News, Ltd* [1897] 2 Ch. 48, where Stirling J. rejected the argument that race information was no longer protected because it had become public to those present at the racecourse. He stated at 53:"But the information was not made known to the whole world; it was no doubt known to a large number of persons, but a great many more were ignorant of it." See also *G v Day* [1982] 1 N.S.W.L.R. 24, where Yeldham J. held that disclosure of the claimant's identity during two television reports were transitory and brief and, as such, information regarding his identity was still confidential. Contrast *Mustard & Son v Dosen and Allcock* [1963] R.P.C. 41, where it was held that by obtaining a patent the appellants had disclosed the confidential information to the world and the information was no longer secret, but common knowledge.

[122] A-G above n.27

[123] In Australia, United States and Republic of Ireland

the interest of the Crown has already been done by the publication of *Spycatcher* abroad and the ready availability of copies in this country."[124]

Lord Goff refused the injunction as he recognised that the obligation of confidence applies only to information that is confidential, he stated "in particular, once it has entered what is usually called the public domain[125] then, as a general rule, the principle of confidentiality can have no application to it."[126]

Whereas in *Spycatcher* the fact the information was in the public domain was a significant factor behind the injunction refusal, Lord Keith accepted that circumstances such as personal secrets could be protected even where wide scale publication occurred if further publication could cause increased harm.[127] This was re-enforced by Lord Goff who spoke of information being so "generally accessible" that it no longer qualified as being confidential, which allows limited circulation before confidentiality being lost.[128]

Support for this approach is found in the Law Commission's Report on Breach of Confidence, which recommends that a broad definition for information entering the 'public domain' and that the courts take the lead on deciding if information is "available to the public" and "relatively secret".[129] Recent case law has supported this theory, particularly *Ashworth Security Hospital v MGN Ltd (2002)* [130] and *WB v H Bauer Publishing Ltd (2002).*[131]

The *Douglas* cases, raised the issue as to the extent that publicity of information can undermine a claim of "privacy" or "confidentiality." Lord Phillips M.R. stated "once intimate personal information about a celebrity's private life has been widely published it may serve no useful purpose to prohibit further publication."[132] However a different opinion occurs in relation to photographs as he stated:[133]

"In so far as a photograph does more than convey information and intrudes on privacy by enabling the viewer to focus on intimate personal detail, there will be a fresh intrusion of privacy when each additional viewer sees the photograph and even when one who has seen a previous publication of the photograph, is confronted by a fresh publication of it. There is thus a further important potential distinction between the law relating to private information and that relating to other types of confidential information."

The court stated the fact that the couple intended, and agreed to publish wedding photographs did not weaken their privacy claim, but is relevant when accessing the damages through the amount of distress or

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[124] A-G above n.27 at 260. See also Lord Keith at 259

[125] Which means no more than that the information in question is so generally accessible that, in all the circumstances, it cannot be regarded as confidential

[126] A-G a*bove n.27 per Lord Goff* at 282, 285 and 286 *per* Lord Goff.

[127] See also R. Dean, 'Twists and Turns on the Road to Privacy' (2004) no 58 *Intellectual Property Forum* 10 at p.18 on the absolute nature of secrecy for trade secrets, but not for personal information; and above n.131.

[128] Both Lord Keith and Lord Goff's statements on this point were cited with approval in *Mills v Newspaper Groups Ltd,* [2001] E.M.L.R. 41., at 968, [25].

[129] Breach of Confidence a*bove n.19 at* para.6.69.

[130] *Ashworth Security Hospital v MGN Ltd* [2001] F.S.R. 33 at 573

[131] WB above n.83

[132] *Douglas (No.3)* above n.13 at 162

[133] *Ibid*

harm suffered.[134] *Douglas* appears to have set a precedent that no publication appears to undermine the privacy claim as long as the information is a photograph and of a private nature.[135]

Protection of an injunction under both strands of the action requires that the information is not part of the public domain as once 'the public' has access and knowledge of the information it will no longer maintain its confidentiality warranting an injunction. Whether the information has entered the public domain is not just about considering its availability and accessibility, but rather the additional harm that could be caused by additional circulation or republication.[136] Pre HRA the courts did not allow personal information to enter the public domain as readily as alternative types of information. Post HRA there has been a differential treatment of personal information to be more entrenched.[137]

The fact an act or photograph is taken in a public place does not mean the information is in the public domain. Phillipson stated that *Theakston* is "open to serious doubt"[138] because it is inconsistent with precedent establishing that confidentiality is not lost by virtue of the information being accessible to some. This was re-enforced with subsequent European Court of Human Rights ("ECtHR") jurisprudence, most notably *Peck v UK (2003),*[139] *Von Hannover v Germany (2005)*[140] and Murray[141] which all re-affirmed that even though the photographs or video occurred in a public location this does not preclude protection under art.8.

In *Attard v General Manchester Newspapers (2001)*,[142] Bennett J. held that Gracie, a conjoined twin, had a reasonable expectation of privacy on the public steps of a hospital and that the unauthorised photographs taken of her infringed that right. As such, the only newspapers that were permitted to publish photographs of Gracie were those who had contracted to do so.[143]

The courts have shifted to a position which accepts the photographs of persons in public places can be "private."[144] As exemplified by the House of Lords ruling in *Campbell*, decided after *Peck* and *Von Hannover*. *Campbell*[145] showed a significant shift from the "confidential information" test to one of "private information" has occurred, which is in line with ECtHR jurisprudence.[146]

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[134] *Ibid* at 163

[135] Above n.42 at 38

[136] *Green Corns Ltd v Claverly Group Ltd* [2005] E.M.L.R. 31 at 47

[137] T. Aplin above n.33 at 38; McKennitt above n.34 at 64 *per* Eady J: "Courts would be less ready, however, in the case of personal private information (as opposed to commercial secrets) to assume that protection has gone forever by virtue of its having come to the attention of certain readers or categories of readers."

[138] Phillipson above n.71. at 737

[139] *Peck v United Kingdom* (2003) 36 E.H.R.R. 41.

[140] Von Hannover v Germany (2005) 40 E.H.R.R. 1

[141] Murray above n.82

[142] Attard v General Manchester Newspapers, unreported, June 14-15, 2001, Fam Div, Bennett J.

[143] Rt Hon. Lord Wakeham criticised the decision, describing it as the law protecting a right of publicity "under the cloak of privacy". "Press, Privacy, Public Interest and the Human Rights Act" (www.pcc.org.uk/press/detail.asp?id=52).

[144] B. Markesinis above n.85 at pp.148-150.

[145] For a dissenting view see J. Morgan, 'Privacy in the House of Lords, Again' [2004] 120 L.Q.R. 563 at 564.

[146] Campbell above n.13 at 123 *per* Lord Hope and Lord Hoffmann, at 74-75, discussing the implications of *Peck.*

Where the information is already in the public domain an injunction is not a remedy available to the court and therefore the main remedy sought by claimants is damages, which are discussed in greater detail below.

(ix) *Conclusion*

The extent to which the confidence has changed[147] post HRA is difficult to identify as new case law appears to increase the protections available.[148] Vaver,[149] stated the HRA has not or is unlikely to create a new privacy tort but has utilised confidence to become privacy's action of choice in the UK,[150] which was re-emphasised by Buxton L.J.[151] In developing the right to protect private information, including the implementation of ECHR arts.8 and 10, the courts have proceeded through the tort of breach of confidence, into which the jurisprudence of arts.8 and 10 has to be "shoehorned".[152] There is an increasingly level of post HRA case law to establish a better understanding of the courts attitude towards the balancing act undertaken between arts.8 and 10.

(c) ***Hello Case Study***

(i) *Facts and rulings [153]*

The *Douglas v Hello*[154] cases were based upon the unauthorised taking and publishing of photographs of Michael Douglas and Catherine Zeta-Jones' wedding reception in 2000. The original claimants were the celebrity couple and OK! magazine who had agreed to purchase authorised photographs of the wedding. The Douglas' were seeking to bring an action to protect the privacy aspects of the photographs, whereas OK! brought an action to protect the appropriation of the potential commercial aspects of the photograph. The parties sought an injunction and each sought damages for the breach of confidence but under the separate strands of the action.

Part of the agreement was that the wedding was to be a private occasion and the couple would undertake and enforce an express prohibition on any guest or other media outlet taking photographs of the wedding. In addition to the actions of breach of confidence, the parties sought protections based upon privacy and malicious falsehood. OK! Also sought to rely upon the economic tort of unlawful interference with trade on the basis that their exclusive deal was undermined by the actions taken by Hello!.

The final ruling came on the 2nd May 2007, the House of Lords delivered its opinion. However, in order to fully understand the case it is important to examine the earlier court decisions. The initial injunction was granted by Buckley J. on 20th November 2000.

The appeal from *Hello!* was allowed by Brooke, Sedley and Keene L.JJ. The appeal was allowed as the balance of convenience would have favoured the defendants who would have lost an entire issue if the injunction had been continued.

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[147] T. Aplin above n.33 at 19

[148] McKennitt and HRH Prince of Wales above n.34; Madingley above n.96)

[149] D.Vaver above n.35

[150] HRH Prince of Wales above n.34

[151] Wainwright above n.15 at 28-[35; see also Lords Nicholls and Hoffmann and Baroness Hale in *Campbell above n.13* at [11], [43] and [133] respectively.

[152] Douglas above n.13 at 53. See A.McLean above n.38 at 390

[153] For a full examination of the case see C. Michalos, 'Douglas v Hello: the final frontier', Ent L.R. 2007 at 241

[154] Douglas above n.13

The trial was heard by Lindsay J. in early 2003, he found that the photographs had the necessary quality of confidence about them, and found that the defendants were liable to for breach of confidence, but declined the claim that there was an existing law of privacy that was available to the claimants.

The claim for interference with business by unlawful means was rejected as there was no intention to injure the claimants nor were the Douglas' in breach of their contract with OK!. The judge granted a perpetual injunction despite the photographs having been published in a national magazine, observing that the item had passed into the public domain it must remain there for confidentiality to have been lost.

Hello! appealed to the Court of Appeal, where Lord Phillips M.R. and Clarke and Neuberger L.JJ. dismissed the appeal in relation to the Douglas's' personally. This was because the courts believed that the test of whether the defendant knew or ought to have known that the couple had a reasonable expectation that the information would remain private was decided against the defendant.

The appeal against OK! was successful as the confidentiality rights belonged to the couple and not the magazine who merely had an exclusive right to exploit the couple's right for a limited period. The court ruled that *OK!* had no right to commercial confidence in relation to the wedding photographs. OK! magazine's cross claim on the economic tort claim was also dismissed as *Hello!* had not aimed or directed its conduct at *OK!* and did not have the necessary intention to cause harm.

OK! appealed to the House of Lords on both that the publication of Hello! magazine was in breach of its equitable right to confidence in the wedding photographs, and that Hello! was liable for unlawful interference with its contractual relationship. The Douglas's' who had been successful in both the Court of First Instance and the Court of Appeal were not a party to the House of Lords appeal.

In the House of Lord's decision the court found for OK! and awarded £1 million in damages for the Hello's misappropriation of commercial information. The court re-emphasised the reasonable expectation of privacy test and said that the knowledge of the guests that no-one except the professional photographer was to take photographs of the events. This imposed an obligation of confidence for OK! as well as the Douglas', the photographs were commercially valuable and the Douglas's had exercised sufficient control to impose an obligation of confidence.[155]

(ii) *Conclusion upon the effects upon the law*

Carty[156] believed that the Douglas's had a hidden agenda in their case searching for the creation of a UK image right. Indeed in the ruling Phillips M.R. even hinted at such an emerging publicity right, although this theory was roundly and wholeheartedly rejected in the House of Lords. Lord Walker noted that "under English law it is not possible for a celebrity to claim a monopoly in his or her image, as if it were a trade mark or brand,"[157] nor has it developed into "any other unorthodox form of intellectual property".[158]

Although the Lords rejected the "image or publicity right" the majority of the Lords[159] accepted that as exclusive licensee the action of breach of confidence did cover the photographs and that the court was sympathetic to the misappropriation element that accompanied OK!'s claim. Lord Nicholls touched upon the

[155] D.I. Bainbridge, Intellectual Property, 7th Edition, Pearson Longman, Pg 324

[156] H. Carty above n.12

[157] Douglas above n.13 at 293

[158] Ibid at 124. Lord Hoffmann asserting that there is no question of this.

[159] Lord Hoffmann, Lord Brown and Baroness Hale

fact that the UK and the US system are different stating that the unauthorised publication was not "improper exploitation" of the Douglas's as it could be under US law.[160]

The case illustrates that the form of information protected through a breach of confidence action include photographs of a non intimate or medical nature. Lord Nicholls stated "breach of confidence or misuse of confidential information now covers two distinct causes of action, protecting two different interests: privacy and secret ('confidential') information".[161]

The House of Lords held that confidentiality encompassed all the wedding photographs under the term of "generic class of information." The quality of confidence was in part due to the precautions taken by the Douglas's, they controlled the information and thus could impose an obligation of confidence,[162] which extended to OK! since "everyone knew that the obligation of confidence was imposed for the benefit of *OK!* as well as the Douglas's"[163] and "they paid … for the benefit of the obligation of confidence imposed on all those present".[164] Although the duty was applied to the generic class of photographs the confidence was in for each individual photograph as "the point of the transaction was that each picture should be treated as a separate piece of information which OK! would have the exclusive right to publish".[165]

The Court of Appeal said that a claim for breach of confidence is not a tort but a restitutionary claim for unjust enrichment.[166] The information was capable of commercial exploitation, which is only protected by law of confidence, is not to be treated as an 'ownable' and 'tradable' property.[167] The licence granted to OK! passed no proprietary interest nor a right to claim in any confidential information available to the Douglas's.[168] The licence merely enables lawful actions that otherwise would have been unlawful.[169]

The majority of the House of Lords, dissented from this view and held that OK! were entitled to sue for breach of confidence itself. Disappointingly, according to Michalos, they offer little analysis of the finding and no reasoning for why the Court of Appeal decision was incorrect.[170]

Lord Walker discussed the fact that the interest of OK! was wholly commercial and relied on a right to a short term confidentiality over a trade secret,[171] the law of confidence can only be invoked if the information in question meets the law's requirements for the protection of 'confidential' information.[172] He concluded that

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[160] He also points out that there was no element of “false endorsement” either, as discussed by Laddie J. in Irvine v Talksport Ltd [2001] 1 W.L.R. 2355

[161] Douglas above n.13 at 255

[162] Ibid per Lord Hoffmann at [118].

[163] Ibid at 114.

[164] Ibid at 117

[165] Ibid at 122. Similar views were expressed by Lord Brown at [329]: “… the secret consists no less of each and every visual image of the wedding than of the wedding as a whole”.

[166] Douglas (No.3) above n.13 at 96-97.

[167] Ibid at 119

[168] Ibid at 134

[169] C. Michalos above n.135

[170] Ibid

[171] Douglas above n.13 at 295, *per* Lord Walker

[172] Ibid at 299

confidentiality of any information should depend on its nature rather than market value and that confidentiality law continued to not afford the protection of exclusivity in a spectacle.[173]

In conclusion the Douglas litigation was the first real test of the effects of the HRA on breach of confidence actions within the UK. The rulings led many to believe that the it was the first step towards a new tort of privacy. Despite the House of Lords rejecting this idea, the case clearly broke new ground and has opened up the action for developmental change to adopt the requirements of art.8 of the ECHR.

(d) ***Remedies***

(i) *Interim*

Prior to the HRA, interim relief could be obtained by establishing an arguable case for confidentiality,[174] this would need to outweigh the public interest defence assuming the evidence supported the defence, which requires credible chance of success at trial.[175] Interim injunctions have been governed by the approach in *American Cyanamid v Ethicon (1975).*[176]

Post HRA the rules governing the courts grants for interim injunction have changed. art.12 of the HRA applies when courts are in the process of considering granting relief that may effect art.10 of the ECHR. Article 12(3) provides no relief is to be granted "unless the court is satisfied that the applicant is likely to establish that publication should not be allowed." Its been argued that if the story were published, the information loses its confidential character, and thus nothing to have a final trial about bar damages.[177]

The meaning of "likely to establish," was settled in the House of Lords in *Cream Holdings Ltd v Banerjee (2005).*[178] Lord Nicholls concluded that the s.12(3) approach meant the applicant must establish that they were "more likely than not" to succeed at trial.[179] However, "there will be cases where it is necessary for a court to depart from this general approach and a lesser degree of likelihood will suffice as a prerequisite."[180]

(ii) *Monetary*

The most common remedy sought is an injunction,[181] as the confider has brought an action under breach of confidence, wanting to keep personal information from entering the public domain. However, claimants can seek, either in place of or in addition to an injunction, damages for mental distress or injured feelings.[182]

Post HRA the courts have granted damages for both strands of breach of confidence, privacy and misappropriation of commercial information, as highlighted in the Douglas litigation, often with little or no

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[173] Ibid at 299-300

[174] See M. Conaglen, 'Thinking about proprietary remedies for breach of confidence', I.P.Q. 2008 at 82

[175] A. Sims, 'A shift in the centre of gravity: The dangers of protecting privacy through breach of confidence', I.P.Q. 2005, 1, 27 at 49-50; G. Phillipson above n.18 at 691-2

[176] American Cyanamid v Ethicon [1975] A.C. 396, HL.

[177] A-G above n.27; Francome, above n.69; Lion Laboratories, above n.66 at 551

[178] Cream Holdings Ltd v Banerjee [2005] 1 A.C. 253

[179] Ibid at 261-2, For a discussion of this case see N. Hatzis, "Libel, Justification and Injunctive Relief under the Human Rights Act" (2006) 25 C.J.Q. 27 and A. Smith, "Freedom of the Press and Prior Restraint" [2005] C.L.J. 4.

[180] Cream Holdings above n.178 at 261-2

[181] Coco above n.12 at 50; Phillipson above n.18 at p.691.

[182] J. Stuckey, 'The Equitable Action for Breach of Confidence: Is Information Ever Property?' (1981) *Sydney Law Review* 402 at p.431

explanation of the rationale or reasoning for the valuations. In Douglas, the award for the couple was £14,600, which is considerably lower than similar awards within the US, as discussed below. *Campbell*[183] is another example where limited damages of £3,500 were awarded by Morland J. specifically £2,500 in compensatory damages for the distress and injury to feelings for the details of her therapy, and £1,000 for aggravated damages for additional distress created by the follow up article.[184] The apparent ease under which courts now seem to be awarding damages for mental distress is exemplified in *Archer v Williams (2003),*[185] *Douglas*[186] and *McKennitt.*[187]

The post HRA case law has handled the damages for mental distress in an unsatisfactory way,[188] as shown in the decision in *Cornelius*. Aplin believes that the basis for awarding damages has long been contentious[189] and left largely undiscussed by the courts. The recognition of this award of damages may suggest a shift in the action away from an equitable action towards a tortuous one.[190]

The largest award for damages so far in the UK under breach of confidence for the privacy rather than commercial appropriation strand of the action is £60,000 award to Max Mosley for a Sunday newspaper article. The deterrent of such an award would need to weighed against the freedom of the presses and the benefits received by the defendant, for example the courts have yet to award damages based upon an account of profits and a compensatory damages award.

There continues to be a debate over the adequacy of damages available under a breach of confidence action as the awards given by the courts so far appear to be more a measure of compensation than a deterrent, such as the award to OK! which was substantially made up of a repayment of their fee to the Douglas's. The availability of damages for post loss of privacy and appropriation of commercial information is however likely to increase the frequency of use and usefulness to an individual seeking to gain adequate protection for private information.

(e) ***Call for an explicit right to privacy***

The action of breach of confidence has developed considerably since its inception both pre and post the HRA to an extent that there has been academic commentary[191] concerning the practicalities of using the action to protect privacy. There has been increasing suggestions that a specific right of privacy should be created to protect privacy with seven main justifications raised by Schreiber[192] namely:

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[183] Campbell above n.13

[184] Unfortunately the judge did not explicitly explain whether the damages where under breach of confidence or Data Protection Act 1998 s.13

[185] *Archer v Williams* [2003] E.M.L.R. 38

[186] *Douglas (no. 6) above n.13* at 56-57.

[187] McKennitt, above n.34

[188] T. Aplin above n.33 at 56

[189] For a discussion see Gurry, *Breach of Confidence* (Clarendon, Oxford, 1984) Ch.23; Stuckey, above n.182 at pp.416-426; and L. Clarke, 'Remedial Responses to Breach of Confidence: The Question of Damages' (2005) 24 C.J.Q. 316 at pp.324-328.

[190] M. Conaglen above n.174 at 100

[191] A. Schreiber, 'Confidence crisis, privacy phobia: why invasion of privacy should be independently recognised in English law' [2006] I.P.Q 160; C. Angelopoulos, 'Modern intellectual property legislation: warm for reform', [2008] Ent L.R. 35; N. Moreham, 'Recognising privacy in England and New Zealand', [2004] CLJUK 555

[192] A. Schreiber above n.191

1 breach of confidence is jurisprudentially inappropriate to protect the right to privacy;

2 privacy is quasi-constitutional, whereas confidence is normal common law;

3 applying confidence to protect privacy has resulted in the distortion of the action;

4 confidence is best applied to commercial information, and privacy is best suited to personal information;

5 confidence may be inadequate in protecting privacy at common law;

6 confidence is inadequate to protect privacy as required under ECHR and HRA; and

7 for socio-educational reasons privacy should be independently protected.

These arguments work on the theory that the existing use of breach of confidence is not suitable to protect privacy as it requires a relationship based right to protect a human right.[193] Privacy is a right valid against the world, subsists in every person independently and is a right to self determination. Bezanson,[194] states the original scope of privacy suggested by Warren and Brandeis[195] has no longer the same application and thus the law should emphasis protection towards the individual's control of information.[196] By using art.6 HRA[197] to apply the ECHR to private individuals a constitutional right would grant greater protection and certainty.[198]

The distortion of breach of confidence action[199] is founded in the belief that the action is over extended by filling the gaps in privacy protection.[200] this has resulted in a diluted and less certain action particularly post HRA.[201] As exemplified in Lord Nicholls in *Campbell*[202] who effectively stated that first two tests from Coco no longer apply in privacy cases.[203]

The action has expanded away from the focus to protect relationships rather than information, it now appears as though information has become the focus.[204] The action is also unable to protect information which is neither confidential or private.[205]

The commercial and personal application is the simplest of the arguments raised. By separating privacy and confidence to apply to private and commercial information respectively, this separation would enable the

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[193] N. Moreham above n.191

[194] R. Bezanson, 'The Right to Privacy Revisited: Privacy, News, and Social Change 1890-1990' (1992) 80 *California Law Review* 1133 at p.1137

[195] S. Warren above n.5

[196] R. Bezanson above n.194 at p.1135

[197] Douglas (No.1) above n.16; Venables above n.13

[198] Wainwright a*bove n.15* at 30

[199] The scope of this analysis only covers breach of confidence, but other actions also protect privacy i.e. nuisance, trespass, defamation, malicious falsehood, copyright and harassment

[200] N. Loon, 'Emergence of a Right to Privacy from within the Law of Confidence', E.I.P.R. 1996, 307

[201] A.McColgan, 'Privacy, freedom of expression and the grant of interim injunctions' [2008] C.J.Q. 23

[202] *Campbell above n.13*

[203] T. Aplin above n.33

[204] T. Pinto, 'A private and confidential update-not for publication', [2007] Ent L.R. 170

[205] A. Hudson, 'Privacy--A Right by Any Other Name' (2003) E.H.R.L.R. (Special Issue: Privacy) 72; J. Morgan, 'Hello! Again: Privacy and Breach of Confidence' [2005] Cambridge L. J. 549

actions to evolve to best adapt to new requirements of the law. Separate actions would ensure each action was focused on the legal principle which had created the specific rights and protections that the action was designed to protect. This would ensure that the action was not stretched to a level where there is legal uncertainty within the actions.

Sedley L.J.[206] however denied that a "bright line separated the "private" from the "commercial." The distinctive two part test for private information is taken from the Australian case of *Lenah*.[207] The test firstly examines whether the information is obviously private and secondly where the "disclosure or observation of information or conduct would be highly offensive to a reasonable person of ordinary sensibilities."[208]

The inadequacy at common law argument relies upon the understanding that the public interest defence is narrower when construed with privacy than with confidence. The author believes that the two post HRA limitations on public interest defence namely what interests the public is not necessarily sufficient to be in the public interest[209] and that the scope must be proportional to the disclosure need a third, which is that there is a proprietary right of privacy.[210]

Two additional reasons why an action for confidence is unsuitable for its current scope are that confidence now protects the dissemination of information whereas privacy is wider than information as shown in the US.[211] Secondly confidence goes to the damage caused, whereas privacy goes to the invasion itself even where no damage is caused an action, but privacy would still offer damages as a remedy.

Recent leading judgments exemplify that the way in which confidence is applied to adapt to privacy issues is still ambiguous, as privacy is still protected by undefined and uncertain means. Lord Phillips M.R., observed that "the court should, in so far as it can, develop the action for breach of confidence in such a manner as will give effect to both arts.8 and 10 rights. We cannot pretend that we find it satisfactory to be required to shoe-horn within the cause of action of breach of confidence claims for publication of unauthorised photographs of a private occasion". [212]

(f) ***Conclusion***

The UK has traditionally been reluctant to recognise a right of privacy which has had a significant and profound impact upon the development of protection of persona.[213] For example it has meant that the system of protection in the UK has originated and developed under a different system to that of the US namely breach of confidence.

The breach of confidence action in the UK has uniquely evolved. In the absence of an imputed obligation of confidence, the courts will not intervene solely on the basis of an apparent infringement of privacy. Thus the

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[206] Douglas (No.1) above n.16

[207] Australian Broadcasting Corp v Lenah Game Meats Pty Ltd (2002) 30 Federal Law Review 177

[208] *Campbell above n.13,* the CA applied this test to the reasonable reader, but the HL affirmed Morland J.'s view that the test is of the reasonable claimant:

[209] *Campbell v Frisbee* [2003] E.M.L.R. 3, CA

[210] A. Schreiber above n.191

[211] M. Thompson, 'More Judicial Support for Privacy' [1995] *Conveyancer and Property Lawyer* Sept-Oct 40

[212] Douglas above n.13

[213] Prince Albert above n.24; The Justice Report, "Privacy and the Law" (1970); The Younger Committee, "Report on the Committee on Privacy" (1972); The Calcutt Committee, "Report of the Committee on Privacy and Related Maters" (1990) and the Government response to the National Heritage Select Committee, "Privacy and Media intrusion." (1995)

courts in the light of the HRA would be cautious in reviewing decisions of other jurisdictions that developed their law against a different backdrop.[214]

Keene LJ ruled[215] "there is no watertight division between the two concepts of breach of confidence and privacy,[216] the former is a developing area of the law, the boundaries of which are not immutable but may change to reflect changes in society, technology and business practice."

Where personal information is involved the courts are no longer tied to the three tiered test created in *Coco.* The courts now ask whether the information is private and if an obligation of confidence occurs. Finally the courts then must undertake a balancing act between arts.8 & 10 of the ECHR.

UK courts are bound to apply, by s.12(1)[217] of the HRA, s.12(3),[218] which makes pre trial restraint more difficult when the right to freedom of expression is engaged than where it is not.[219] However, damages now appear to be more readily available in confidence cases[220] than pre-HRA in addition to, or in substitution for, injunctive relief. The courts have offered little explanation or justification for the award of damages

The existing position of breach of confidence is to be the preferred course of action for the courts in protecting privacy within the United Kingdom. As Lord Hoffmann stated "there is in my opinion no question of creating an 'image right' or any other unorthodox form of intellectual property".[221] The Lords' ruling in *Douglas* has expanded the protection afforded to persons with whom they have contracted to commercialise an otherwise private event.[222]

Buxton L.J. summarised the decisions that a court now has to make in any case involving breach of confidence and arts.8 and 10. The current tests applied by the courts in relation to claims for breach of confidence is whether the information is private and therefore protected by art.8? If not, then the case is at an end, if yes however, the question of whether in all the circumstances, must the interest of the owner of the private information yield to the right of freedom of expression conferred on the publisher by art.10, arises.

Since the HRA enactment the courts have turned to breach of confidence in order to give effect to art.8 of the ECHR,[223] rather than introduce a new tort of privacy.[224] Phillipson said[225] despite the excitement that

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[214] H. Beverly Smith above n.91at p. 84

[215] Douglas, above n.13

[216] Citing Argyll (Duchess) v Argyll (Duke) [1967] 1 Ch. 302 in support

[217] Section 12(1): “This section applies if a court is considering whether to grant any relief which, if granted, might affect the exercise of the Convention right to freedom of expression.”

[218] Section 12(3): “No such relief is to be granted so as to restrain publication before trial unless the court is satisfied that the applicant is likely to establish that publication should not be allowed.”

[219] R v Advertising Standards Authority Ltd, ex parte Vernons Organisation Ltd [1992] 1 W.L.R 1289 per Laws. J

[220] Under Lord Cairns Act; Wacks above n.95 at 149 and 151; R. Gavison, ‘Privacy and the limits of the law’, Yale L.J. 1980, 89, 421; Winer v UK 48 IR 154; Stewart-Brady v UK no. 36908/97 (1998)

[221] Douglas above n.13

[222] Ibid

[223] I. Hare, ‘Vertically Challenged: Private Parties, Privacy and the Human Rights Act’ [2001] 5 E.H.R.L.R. 526; Moreham, N, ‘Douglas and Others v Hello! Ltd – the protection of privacy in English private law’ 64(5) M.L.R. 767

surrounded the pronouncement by Sedley L.J. in *Douglas* no new tort of invasion of privacy has yet been created. Article 8(1) of the ECHR has coupled with the ECtHR and the English courts has helped create a new privacy law, which have fleshed out by case to case.[226] The scope of the action has broadened with the examination whether the information is "private" rather than "confidential". The second limb of the *Coco* test is now redundant.[227]

Phillipson stated[228] that there have been quite dramatic developments in the doctrine of confidence. In addition two significant shifts have occurred, the public interest defence being interpreted more flexibly and is examined in conjunction with art.10 of the ECHR.[229] The second change is in relation to the courts being more prepared to award damages, although in fairly modest amounts, for non-pecuniary harm.

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[224] R. Singh and J. Strachan, 'Privacy Postponed,' E.H.R.L.R. 2003, (Special Issue: Privacy) 11, at 19-20: P. Jaffey, 'Rights of Privacy, Confidentiality, and Publicity, and Related Rights' in P. Torremans (ed.), *Copyright and Human Rights* (The Hague and New York, Kluwer, 2004), pp.166-167; Above n.23 at p.750.

[225] Phillipson above n.82

[226] McKennitt, above n.34 at 49, Douglas, above n.13

[227] D. Vaver above n.35

[228] Phillipson above n.82

[229] J. Caldwell, 'Protecting Privacy Post *Lenah*: Should The Courts Establish A New Tort Or Develop Breach Of Confidence?' (2003) 26 U.N.S.W. Law Journal 90 at pp.121-122; J. Morgan above n.205; R. Mulheron, 'A Potential Framework For Privacy? A Reply To Hello!' (2006) 69(5) M.L.R. 679 at pp.686-689.

1.3 Passing off

(a) *Introduction*

Passing off is seen as a cause of action with potential to protect commercial misrepresentation, and seemingly misappropriation. The tort has developed considerably over time for example abandoning the need to prove fraud. It developed through a series of ad hoc decisions, that were motivated by ethics and morality in order to prevent an unmeritorious[230] defendant escaping liability. The *Irvine* cases are a recent example of the scope and development of the tort and are examined below. The paper will show the development of the tort as well as the current requirements and areas that the tort may continue to develop in the coming years.

(b) *The development of the law to its current state*

(i) *Introduction*

Passing off as a method of protection was summarised by the Master of the Rolls Lord Langdale in *Perry v Truefitt (1842).*[231] stating that"a man is not to sell his own goods *or services* under the pretence that they are the goods of another man."[232]

Professor Cornish[233] gave an analogy of the past views of the courts when he proposed an instinct "in favour of the free use of ideas, whether in the commercial context or otherwise". Copyright and the law of passing off are seen as the exceptions to this approach "in order to achieve a fair reurn on creative and promotional activities".[234] He applauds the "understandable" reluctance to afford rights "in respect of every conceivable return from the use of an idea".[235]

There have been two significant tests for passing off within the UK. The first was stated by Diplock L.J. in *Erven Warninck BV and Another v J. Townend & Son (Hull) Ltd and Another (Advocaat) (1979).*[236] Lord Diplock gave an exegesis of the law of passing off saying five characteristics needed to be present for passing off:

1 a misrepresentation;

2 made by a trader in the course of a trade;

3 to prospective customer of his or ultimate consumers of goods or services supplied by him;

4 which is calculated to injure the business or goodwill of another trader; and

5 which causes actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so.[237]

The test was revised to a classic trinity formulation created by Oliver LJ in *Reckitt & Colman Products Ltd v Borden Inc and Others (Jif Lemon) (1990)*[238] required three elements to be present:

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[230] H. Carty above n.12

[231] Perry v Truefitt (1842) 6 Beav 66

[232] Ibid at 73

[233] Cornish, 'Character Merchandising in the United Kingdom: Rights in Fictional Characters' (1978) A.I.P.L. 492

[234] Ibid

[235] Ibid at 494

[236] Erven Warnick BV and Another v J. Townend & Son (Hull) Ltd and Another (1979) 2 All ER 927

[237] Reckitt & Colman Products Ltd v Borden Inc and Others (Jif Lemon) [1990] R.P.C. 343

The claimant must be able to demonstrate goodwill;

There must be a misrepresentation as to the goods or services offered by the defendant; and

Actual or likely damage[239]

(ii) *Goodwill*

The element of goodwill is at the heart of an action in the tort of passing off.[240] Reputation alone is not sufficient for a successful claim,[241] the claimant must establish that he is in some sense engaged with carrying on a business, from which the trade or public will be led to associate the defendant's activities.[242] The Court of Appeal stated[243] that the best definition of goodwill was in *Inland Revenue Commissioners v Muller & Co's Margarine (1901):*[244]

"Goodwill is composed of a variety of elements. One element may preponderate here and another element there. The benefit and advantage of the good name, reputation, and connection of a business, is the attractive force that brings in custom. The goodwill of a business must emanate from a particular centre or source. However widely or extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates".[245]

In *Muller & Co's Margarine Ltd,*[246] Lord Diplock stated Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached."[247]

(iii) *Duration of Goodwill*

The goodwill must exist at the time of the defendant's activities, future goodwill is not within the scope of passing off.[248] The issue of whether the goodwill has dissipated was examined in *Ad-lib Club Ltd v Glanville (1972)*[249] which stated that the issue is not the lapse of time, but rather whether the claimant's goodwill had lapsed. Goodwill is not instantaneous requiring time to create, though the courts have proved very generous in providing support for relatively new businesses[250] against potential predators as proven in *Stannard v Reay (1967)*[251] where a five week head start was sufficient to have developed goodwill.[252]

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[238] Ibid

[239] Ibid

[240] Spalding & Bros v A W Gamage (1915) 32 RPC 273

[241] Stringfellow v McCain Foods (GB) Ltd. [1984] R.P.C. 501

[242] J. Clerk and W. Lindsell, 'Clerk and Lindsell on Torts 18th ed.' (Sweet & Maxwell 2000) at para.26-12

[243] Scandeor Development AB v Scandeor Marketing AB [1999] FSR 26 at 41

[244] IRC v Muller & Co's Margarine [1901] AC 217

[245] Ibid at 224

[246] Ibid

[247] Ibid at 223

[248] Cadbury Schweppes v Pub Squash [1981] RPC 429; Teleworks Ltd v Telework Group plc [2002] R.P.C. 27

[249] Ad-lib Club Ltd v Glanville [1972] RPC 673

[250] Celebrities can 'trade' in their personalities

[251] Stannard v Reay [1967] RPC 589

(iv) *Geographical extent of goodwill*

Goodwill occurs when there is trade on a natural and daily basis, however there is controversy when there is an absence of trade within that country or in different parts of the country.[253] *Maxims Ltd & Louis Vaudable v Jan Grace Dye (1977),*[254] re-emphasised that goodwill can cross international boundaries,[255] indeed was more likely to do so in an era of international integration.[256] The position changed under the *Trade Marks Act 1994* s.56[257] which brought in protections on well known mark(s) from any Convention nation.[258]

(v) *Goodwill in trading*

For goodwill to occur there must be a representation by the defendant to the claimants customers, as shown in *Granada Group Ltd v Ford Motor Co Ltd (1973).*[259] The case concerned the use of the name 'Granada' for Ford's new luxury car. Graham J said no confusion arose in the public mind between the very different companies and their different products. They may share customers but no common field of activity existed to cause confusion, as confirmed in *Wombles Ltd v Wombles Skips Ltd (1977).*[260] Goodwill must be the reason why customers use the business, they should not use the business for random reasons, but they must be using the business as a result of the business' reputation[261]

Post Irvine the test is whether there is likelihood of confusion or deception in the mind of the 'public' and in establishing this is an indication of a common field of activity may still be a very relevant factor.[262] It remains important and highly relevant whether there is any association exist or could exist in the minds of the public between the activities of the parties.[263]

Even if a person wishes to sell under their own name there are restrictions as by doing so they may be guilty of passing off, shown in *Baume and Co Ltd v A H Moore Ltd (1958),*[264] where the other ingredients of passing off are established".[265]

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[252] H. Carty above n.12

[253] Chelsea Man Menswear Ltd v Chelsea Girl Ltd & Another [1987] RPC 189 per Nourse, J. at 208 who said 'the Levey case (Levey v Henderson-Kenton (Holdings) Ltd [1974] RPC 617) was the only reported case to have imposed a geographical limit, and that was only at a pre-trial stage

[254] Maxims Ltd & Louis Vaudable v Joan Grace Dye [1977] FSR 364

[255] Alain Bernardin et Cie v Pavilion Properties Ltd [1967] RPC 581

[256] Maxims above n.254 at 368, failure to protect a French company's goodwill could be seen as discriminatory under the Treaty of Rome as restraint of trade et al EU Treaty Arts.30 and 49

[257] Trade Marks Act 1994 S.56(2) Identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion, where the mark is well known there is no requirement for an established business

[258] Art.6(1) of Paris Convention for Protection of Intellectual Property 1883

[259] Granada Group Ltd v Ford Motor Co Ltd [1973] RPC 49

[260] Wombles Ltd v Wombles (Skips) Ltd [1977] R.P.C. 99

[261] HFC Bank v Midland Bank [2000] FSR 176 at 183

[262] Nice and Safe Attitude Ltd v Piers Flook (t/a 'Slaam! Clothing Company') [1997] FSR 14

[263] Harrods Ltd v Harrodian School Ltd [1996] R.P.C. 697 at 699; Arsenal Football Club Plc v Reed (2001) 2 C.M.L.R. 23; above n.285

[264] Baume and Co Ltd v A H Moore Ltd [1958] Ch 907,

[265] Ibid at 917

In the case it was decided that confusion was likely given the similarity of the name and the type of the product. Thereby a person with the same name as a well known celebrity trading in their personality may be restricted from using their own name.[266]

The protections covered under goodwill for an individual are relatively wide, where they have or seek to use their name or 'personality'. Protection is only afforded where goodwill has already been created, such as when the individual is a house hold name with a reputation to match. After the Irvine litigation is now established that passing off has been extended to grant protection for promotional goodwill. This occurs even if the celebrity has sought to use separate companies to 'exploit' their persona, as the goodwill itself is in the celebrity's reputation and it is the individual who is represented in the offending action.

(vi) *Misrepresentation*

Misrepresentation is the second of the three limbs of classic passing off trinity set out in Jif Lemon. For misrepresentation to be proved the claimant must show that that the defendant has tried to represent his goods or services. This representation must result in a false belief of connection between the products in the consumer's mind and thus a misrepresentation.

Traditionally, in relation to celebrities, there are two common misrepresentations which are alleged. The first is that the product has been endorsed as to its origin and quality by the celebrity. Secondly is that the public believe that there must be a licence agreement between the celebrity and the products manufacturer or seller.

"With the increasing use of licensing and endorsement as a method of advertising, the public may increasingly come to make such assumptions, although ... the question whether such a misrepresentation has been made will largely be a question of fact."[267]

The previous attitude of the courts is shown in *Lyngstad v. Anabas (1977)*[268] where the claimants (ABBA), sued the defendants for making and distributing pin badges, t-shirts and pillowcases featuring their picture without permission. Oliver J. refused an interlocutory injunction, emphasising that the claimants had no business other than that of musicians and singers and stated:

"I am entirely unsatisfied that there is any real possibility of confusion. I do not think that anyone receiving the goods could reasonably imagine that the pop stars 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."[269]

No confusion existed as the purchasers of such products were buying the celebrity's likeness, not a badge of origin.[270] Scanlan's[271] article and Lyngstad emphasises the development of the law to *Irvine*, where the courts adapted the law to closer match the market practice. The public had at this time had little familiarity to the concept of 'celebrity merchandising' and believed that the celebrity carried on no other business than

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[266] An example would be a modern day case similar to Tussaud v Tussaud (1890) 44 Ch D 678

[267] W. Copinger and J. James, 'Copinger and Skone James on Copyright 14th ed.' (Sweet & Maxwell, 2002) Para. 21-47

[268] Lyngstad v Annabas Products [1977] F.S.R. 62

[269] Ibid at 68; Halliwell v Panini SpA, unreported, June 6, 1997, Ch D

[270] Harrods above n.263

[271] G. Scanlan, 'Personality endorsement and everything' E.I.P.R 2003, 25(12), 563

that of entertainment. This was upheld in a number of legal judgments as a common field of activity was still a distinct factor of the indication of the potential for confusion prior to the Irvine decisions.[272]

A full misrepresentation must be present as mere confusion or likelihood of confusion is insufficient.[273] The misrepresentation does not have to be intentional, as in *Advocaat* case,[274] Diplock LJ stated "that the misrepresentation is 'calculated to injure' the goodwill of the other trader". The important issue is that the misrepresentation is likely to harm the claimant's interests which may occur when the defendant's actions are innocent and not intended to harm.[275] Browne Wilkinson V-C stated that:

"if the misrepresentation is made, there is no requirement of law for further evidence to show how the misrepresentation was the cause of the public buying the goods in question…the public expect to buy what they think they are getting, namely the genuine article…the court must infer that if…the customer in any case, were aware the object he is buying is not genuine, he would not buy it but would seek the real object."[276]

Misrepresentation is examined objectively,[277] as demonstrated in *Morning Star Co-operative Society Ltd v Express Newspapers Ltd (1979).*[278] Foster J noted that the differences between an austere broadsheet Morning Star and the racy tabloid Daily Star were such that "only a moron in a hurry would be misled".[279] The reasonable man is assumed to have the actual or implied knowledge of the customer at the time of the representation.[280]

The mere use of a name used by another trader does not necessarily create the impression of connection,[281] however the use of the same name in a similar field of activity is more likely to be restrained.[282] In the case of *Arsenal FC v Reed (2003),*[283] the use of the words 'Arsenal' and 'Gunners' on unlicensed merchandise were insufficient to establish a misrepresentation. As the club's merchandise said official merchandise on it therefore the public were not confused into thinking that they were buying the genuine article from Mr Reed.

The use of a 'real name' can still be a misrepresentation, as shown in *Tussaud v Tussaud (1890)*[284] which involved a member of the famous family who wished to create a rival waxwork business, but was restrained

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[272] McCulloch v Lewis A. May Ltd [1947] 2 All ER 845; Wombles above n.260; Tavener Rutledge Ltd v Trexapalm Ltd [1977] R.P.C. 275); Halliwell above n.269; The less strict principle concerning a fixed requirement for a common field of activity was applied in for e.g. Lyngstad above n.268; Annabel's (Berkeley Square) Ltd v Schock [1972] F.B.R. 261; Harrods above n.263

[273] Barnsley Brewery Co Ltd v RBNB [1997] FSR 462

[274] Baume above n.254 at 933

[275] Ibid at 916

[276] Mirage Studios v Counter Feat Clothing Co [1991] F.S.R. 145

[277] Whether the reasonable man would think the representation would amount to a misrepresentation

[278] Morning Star Co-operative Society Ltd v Express Newspapers Ltd [1979] FSR 113

[279] Ibid at 117

[280] John Hayter Motor Underwriting Agencies Ltd v RHBS Agencies Ltd [1977] FSR 285

[281] Newsweek Inc v BBC [1979] RPC 441

[282] Island Trading Co v Anchor Brewing Co [1989] RPC 287

[283] Harrods above n.263

[284] Tussaud above n.266

by an injunction as confusion would inevitably arise. This decision was upheld in *Guccio Gucci SpA v Paolo Gucci (1991)*[285] where the defendant was unable to use his name as the evidence suggested confusion of the use of the Gucci name by anyone other than the claimants.

Although passing off has long been argued as an action to protect the celebrity industry the extensions of the action, most notably the removal of the requirement for a common field of activity has increased its use and relevance to the celebrity industry to an extent that a number of cases would have been decided different if they occurred under the extended ambit of passing off.[286]

Misrepresentation is still a highly subjective test of the nature of each judge's appraisal of the alleged "misrepresentation" although the reasonable man test of confusion has ensured that the courts are not faced with a flood of litigation. Porter[287] argues that misrepresentation is the essential part of passing off, which has created unpredictability in passing off actions. As a result of this, English law is, in his view, inadequate to meet the demands of the modern commercial age. Carty[288] disagrees and argues that the tort is adequate and has been given a wider remit recently in order to adapt and develop to meet the modern requirements.

This extended form of passing off has been used by celebrities who are seeking to enforce their personality rights in the UK. A celebrity whose persona has been used can successfully sue where there has been a misrepresentation in relation to a product or service with regards to an endorsement or sponsorship. Additionally passing off is also relevant to a celebrity whose likeness has been used without authorisation.

(vii) *Damage*

For passing off there must be proof that damage has been incurred by the claimant or a likelihood of damage where injunctive relief is sought,. The case of *Law Society of England and Wales v Society of Lawyers (1996)*[289] has however muddied the waters of whether the claimant must identify some specific head of pecuniary damages in order to succeed. Goddard L.J. commented that the law assumes that if the goodwill of a man's business has been interfered with by the passing off of goods, damage results there from. [290]

The case of *Stringfellow v McCain Foods (GB) Ltd (1984)*[291] showed that even when there is goodwill, unless there is evidence of trade declining or damage to the goodwill itself then the court will not award any damages.

Although there are three elements to passing off actions, in practice they are inter-linked. As the defendant's misrepresentation must cause damage to the claimant's goodwill[292] as stressed in *Stringfellow.*[293] Although possible confusion was found there was no actual evidence of damage, as Stringfellow was not merchandising his name and thus was no effect on the reputation of his club. This led Wadlow to conclude:

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[285] Guccio Gucci SpA v Paolo Gucci [1991] FSR 89

[286] Halliwell above n.269; Lyngstad above n.268

[287] H. Porter, 'Character Merchandising: Does English Law Recognise a Property right in Name and Likeness', [1999] Ent. L.R. 180

[288] H. Carty, 'Advertising, Publicity rights & English law' I.P.Q. 2004, 3, 209 at 239

[289] Law Society of England and Wales v Society of Lawyers [1996] FSR 739

[290] Draper v Trist & Tristbestos Brake Linings Ltd (1939) 56 RPC 429

[291] Stringfellow above n.241

[292] J. Clerk above n.242 at para. 26-01

[293] Stringfellow above n.241

"The fundamental distinction between the English and Australian authorities is whether a misrepresentation that one business is licensed by another is conclusively assumed to damage that other, or whether likelihood of damage must be proved in its own right".[294]

Carty[295] highlighted some early dicta which claim that the unauthorised use of a celebrity in advertising is something the celebrity brought on himself. So in *Clark v Freeman (1848)*[296] Lord Langdale noted that a person of the social status of the claimant must accept such exploitation as the price of their eminence as "the very eminence causes it"; while in *Tolley v Fry (1930)*[297] Greer L.J. noted that the claimant having "voluntarily" entered into professions "which by their nature invite publicity" deemed it not unreasonable that he should submit without complaint to his name and reputation being treated "almost as public property".[298]

The existing powers available to the courts to award damages are still limited, with no power for awarding punitive damages under English common law. The courts have been reluctant to award more than the lost licence fee that would have been paid to properly acquire the rights. This measure fails to account for potential lost revenue from not undertaking this offer in favour of another, more high profile endorsement. The purpose of damages should not only be to compensate but to deter future unauthorised appropriation.

(c) ***Irvine litigation and the effect on the tort of passing off***

(i) *Facts and Judgment*

The case of *Irvine v Talksport Ltd (2002)*[299] has radically altered the tort of passing off. Arguably, for the first time, Laddie J. recognised property rights in the goodwill of a celebrities name and image, and that this property is protected by the tort of passing off. The case involved Talksport Radio station, who as part of their re-branding from Talk Radio, sent out a brochure concerning changes they were making and the new rights they had acquired. The photograph used on the front cover was of Irvine holding a transistor radio to his ear with the defendant company's logo attached.[300] The photograph originally did not show Mr Irvine holding a radio but rather a mobile telephone. SMP[301] took that image and manipulated it to include an image of a portable radio to which the words "Talk Radio" had been added. Irvine argued that the distribution of the defendant's brochure bearing the manipulated picture was an actionable passing off. He sought damages but not an injunction as the defendant promised no more flyers would be despatched.[302]

Prior to Irvine, the common field of activity test made a successful passing off action difficult for a celebrity to prove for unauthorised or false endorsement.[303] Irvine changed this, Laddie J. conclusively rejected the

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[294] C. Wadlow, The Law of Passing Off, Sweet & Maxwell, 2nd ed, 1994, at p.313

[295] H. Carty above n.288 at 234

[296] Clark v Freeman (1848) 11 Beav. 112.

[297] Tolley v J S Fry & Sons Ltd [1931] AC 333 at 477 (in the Court of Appeal, which found no innuendo, a decision overturned by the House of Lords)

[298] Similar sentiments are found in early American cases, where privacy was sought to be used to gain publicity protection, e.g. O'Brien v Pabst Sales Co 124 F.2d 167 (5th Cir. 1941)

[299] Irvine above n.160

[300] No copyright infringement existed as Talksport purchased the photograph from the owner

[301] A marketing and communications agency who were hired to produce the promotional boxes that were sent out to just under a 1,000 persons and businesses

[302] Irvine above n.160 at para.8, The letter did not admit any liability for their previous actions

[303] A string of high profile claimants, being in the business of entertainment and not in the manufacture of a particular good or service, failed to establish a cause of action in passing off (McCulloch above n.272;

"common field of activity" doctrine and recognising the marketing reality that celebrities endorse products and services which extend beyond their own expertise.[304]

Irvine proved the material misrepresentation as the unauthorised use of his image in the promotion displayed a connection between himself and the goods, in addition the public would buy Talksport's product believing Irvine had personally endorsed or approved of it. Also Irvine proved that the false endorsement reduced, blurred and/or diminished the exclusivity of the trading goodwill in his name and image.[305]

The damages were originally set by Laddie. J. in the High Court at £2,000, which, was assessed as a reasonable endorsement fee as the whole promotion reached under 1,000 people and cost £11,000. The Court of Appeal however, raised the award to £25,000 as Irvine had not signed any endorsement deals since 1999 for less than £25,000 and this should have been taken into account.

(ii) *Academic discussion and criticisms*

Most academic commentators believe that the decision in Irvine was confirmation that passing off had indeed been extended to cover pure endorsement cases, which previously escaped the ambit of the action. There however have been a number of academic commentaries criticising the judgments in Irvine for leaving a series of unanswered questions.

Learmonth[306] strongly criticised the level of damages awarded in Irvine and stated that the lost licence fee was inadequate to compensate for the harm to Irvine's goodwill. He said that the goodwill should have been protected from both from damage and unlicensed use, and an endorser's goodwill, therefore not only the licence fee should be protected in a damages award. Learmonth states that Irvine has re-emphasised that the current approach taken is too narrow and should take into account personal factors such as the reasons why someone would turn down a £2,000 offer[307] for a minor promotion might be that it would prevent him later accepting, say, £25,000 to promote another major radio station. The reasoning why such a narrow view in this type of passing off case is incorrect is shown by contrasting it with other forms of intangible property such as patents where the loss of a licence fee may well be the only loss suffered.[308]

Sampson believes that the criticisms given by Learmonth were wholly justified. As the courts are without jurisdiction to award aggravated or additional damages for flagrancy, there is little is to stop promoters infringing a celebrity's rights and then buying off the action at a knock-down price. [309]

Scanlan[310] followed the previous criticisms of the judgment and believes that Irvine has in fact created uncertainty in the law of passing off, and is likely to result in further litigation involving similar scenarios to

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Wombles above n.260; Tavener above n.272 Later judgments moved away from a strict application of the principle, holding that the “common field of activity” was not a precondition of success in a passing off claim; rather, it served merely as an indication that a “real possibility of confusion” existed (Lyngstad above n.268 (Oliver J.); Annabel’s above n.272 per Russell L.J.; Harrods above n.263) However, courts continued to deny famous claimants relief on the basis that the buying public would not think the celebrity had given their approval to the goods because they carried on no other business that that of entertainment (Lyngstad above n.268; Halliwell above n.269 (Lightman J.); Kaye v Robertson [1991] F.S.R. 62 (Glidewell L.J.))

[304] Irvine above n.160 at para.39

[305] Ibid at para.39–40

[306] A. Learmonth, ‘Eddie are you okay? Product endorsement and Passing off’ I.P.Q. 2002, 3, 306

[307] The level of damages originally awarded by the court before the Court of Appeal raised this to £25,000

[308] A. Learmonth above n.306

[309] S. Sampson, ‘False Product Endorsement’ Ent. L.R. 2003, 14(6), 150

[310] G. Scanlan above n.271

obtain certainty. He believes that the ramifications of the judgment will result in profound and as yet immeasurable effects of both a legal and economic nature on a number of areas of the law.[311]

As mentioned earlier the Irvine decisions have resulted in a number of further questions being raised by leading academics such as Robinson. Who questioned whether the rigidity applied in Irvine will result in difficulties as to the reality of the additional protection available to the image-holder.[312]

Another criticism of the judgment is that the it did not go far enough to unequivocally set out the new boundaries of the action for example according to Smith et al it has left the question of whether the action is available where an individual's name and image are used but with no suggestion of an endorsement.[313]

Further unanswered problems are the uncertainty, where it is apparent that a look-alike model has been used,[314] or where the featured celebrity has no endorsement reputation and therefore no trading goodwill. If they do manage to meet the requirements of the action, which is by no means certain, how the lost licence fee damages are to be calculated is extremely unclear.

Bains[315] accurately summarised the feeling of the leading academics concerning *Irvine* by arguing that although the case represents a marked improvement in protection, in reality it is only false endorsement cases that are protected and not merchandising, which are ultimately based on the same use of personality. The product endorsement business is a multi million pound industry and the levels of damages available under passing off are too limited to offer comprehensive protection and deterrence from infringements.

(iii) *Potential areas of development for Passing Off*

Laddie J. adoption of a non traditional approach has left the possibility of using passing off more creatively in the future. In a postscript, the judge stated that if passing off in its traditional form had not been able to provide a remedy, he would have looked to the HRA to consider whether art.8 or the *First Protocol of the ECHR* would give the '"final impetus' to reach this result".[316] The effect of the HRA on protection of image in relation to publicity is yet to be examined within the UK in any significant detail, but the protections granted to photographs, under breach of confidence actions, show that potentially the law could develop significantly.

Carty[317] argues that the tort will continue with the developments in the type of harm to customer connection, allowing more exotic and potentially less precise varieties of harm to be successfully alleged. So far loss of licensing opportunity, loss of distinctiveness and loss of control have been alleged. The reasoning that lies behind such allegations are attempts to complain about misappropriation and these are sometimes combined in the concept of "dilution" or blurring of the mark/image.[318] Its allegation, in addition to the concept of a "connection misrepresentation" and a widening notion of what constitutes goodwill means that the tort promises, in the twenty-first century, to be more useful for the celebrity industry than ever before.

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[311] For example on the developing law of privacy and freedom of expression under the HRA

[312] F. Robinson, 'How image conscious is English law', Ent L.R. 2004, 15(1), 151

[313] S. Smith, 'Changing face of image protection in the law' ISLR 2004, 2nd May, 37; K. Sloper, and B. Cordery, 'Personality Endorsement – New Brands Hatch' Ent L.R. 2002, 13(5), 106

[314] If for example there was a repeat of the Australian case of O. Newton-John v Scholl-Plough Pty Ltd (1987) 79 A.L.R. 279

[315] S. Bains above n.2

[316] Warren above n.5

[317] H. Carty above n.288

[318] As a concept it lies behind the changes to registered trade mark law, now contained in s.10(3) Trade Marks Act 1994

In examination of the expected development of the tort in the aftermath of the *Irvine* litigation, the solicitor for Talksport was reported in *The Times* as predicting that image- holders would push back the boundaries of protection further with the courts gradually widening the range of image use that can be said to suggest endorsement.

> "A false endorsement, involving a material misrepresentation to consumers, merits legal protection. And that protection would obviously arise from the tort of passing off. The central issue then becomes whether the tort can retain its coherence and rationale by accepting false endorsement within its control."[319]

The tort can legitimately accommodate such a claim when properly applied. What *Irvine* indicates is the scope for the tort to move away from misrepresentation towards misappropriation and the protection of fame per se.[320] The distinction made in the *Irvine* case between endorsement and merchandising was that under endorsement there is a belief that the celebrity approves of the product and is happy to be associated with it. Merchandising is the exploitation of an image, theme or article which has become famous, and it is not a necessary factor that the public believes there to be a link between the product and the celebrity or idea. Sloper and Cordery[321] propose that the distinction is correct and that the courts will only protect endorsement through passing off, as the likelihood of confusion from the public concerning the endorsement of merchandise is unlikely. Learmonth[322] also agrees that the distinction between endorsement and mere merchandising is crucial. The above reasoning suggests that there is no cause of action in passing off for false merchandising where there is no element of false endorsement by the celebrity, but wherever merchandising includes an operative misrepresentation of endorsement, then passing off will be found.

Aldous L.J. believed that passing off could be further expanded to an extent that it is referred to as unfair competition,[323] enabling it to evolve to meet changes in methods of trade and communication. There have been academic and case law arguments that suggest that the current requirements of goodwill[324] and misrepresentation[325] are unlikely to remain as strictly in the future.[326] The Gowers Review noted that passing off currently does not go far enough to protect many brands and designs from misappropriation.[327]

(iv) *Conclusion*

The rights acquired under passing off are likely to contain the 'greatest potency'[328] to most celebrities, they however have less protection than under trade mark law, which usually offer monopoly rights once granted.

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[319] Paul Stevens of Olswang, reported in The Times, October 28, 2003. In the same article the solicitor for Ian Botham in his litigation against Guinness was quoted as saying: “I think it is an area of law we have got to work on and create.”

[320] H. Carty above n.288, whilst analysing Cornish above n.233

[321] S. Smith above n.313

[322] A. Learmonth above n.306

[323] Arsenal FC Ltd v Matthew Reed [2003] EWCA Civ 696

[324] Future goodwill could also be protected, and that the requirement to build up goodwill may be lowered to a level that pre-advertisement maybe sufficient as discussed in BBC v Talbot Motors [1971] F.S.R. 228.

[325] Misrepresentation will be extended to misappropriation as first discussed by Needham J. in Hexagon v ABC [1976] R.P.C. 628

[326] H. Carty above n.12

[327] Gowers Review para 5.84 available at www.hm-treasury.gov.uk December 1st 2006

[328] C. Macleod and A. Wood, ‘The Picasso case, famous names and branding celebrity’, Ent L.R. (2006) 44

Macleod believes that under the current rights that even vulnerable trade mark rights are of a greater value than valid passing off rights.[329]

(d) **Summary**

Passing off has developed and it was arguably pressure for specific protection that resulted in the decision of Irvine.[330] The evaluation and elaboration of the tort adopted by Laddie J., has similarities with the Australian case of *Henderson v Radio Corporation Pty (1960)*.[331] Within passing off misappropriation[332] has begun to be present furthering the argument that the tort is adaptable to develop along with and in line with "modern commercial practice."[333]

The calls for a new character right to extend passing over to cover the gap with copyright law[334] were discussed by Simon L.J.[335] in *Elvis Presley Trade Marks (1999.)*[336] This suggestion has previously been rejected by the Whitford Committee in 1977, which in itself was the result of a clamour for a change.[337] Simon L.J. argued for the continued rejection of a new right. In addressing the critical issue of distinctiveness there should be no *a priori* assumption that only a celebrity or his successors may ever market[338] his own character. "Monopolies should not be so readily created."[339]

However in *British Telecommunications v One In A Million (1999)*[340] Aldous L.J. commented that earlier case law did not confine the cause of action forever "as to do so would prevent the common law evolving to meet changes in methods of trade and communication as it had in the past".[341] Recently this attitude has continued although not to the extent of creating a distinct common law remedy, such a concept being unknown in English law.[342]

Madow summarises the past attitudes of the courts at the time by stating: "that famous people are a kind of public property whose commercial exploitation, while sometimes deplorable, should not be subject to legal

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[329] Ibid

[330] Above n.330

[331] Henderson v Radio Corporation Pty [1960] S.R. (NSW) 576

[332] An evil which lies behind the Canadian acceptance of the appropriation wrong and the Australian developments in passing off law. Indeed the acceptance of misappropriation as a key to common law development can also be detected in recent developments in the action for breach of commercial confidence

[333] H. Carty above n.288

[334] There being no copyright protection in a name

[335] Elvis Presley Trade Marks [1999] R.P.C. 567

[336] Ibid

[337] This began in McCulloch above n.272

[338] Or be able to licence the marketing of an individual's image

[339] McCulloch above n.272, per Simon L.J.

[340] British Telecommunications v One In a Million [1999] F.S.R. 1, CA.

[341] H. Carty above n.288

[342] Charleston v News Group Newspaper [1995] 2 W.L.R. 450 at 452, where Lord Bridge stressed that the question turned on libel alone and there was no consideration "whether the publication of the photograph by itself constituted some novel tort".

control".[343] This has lead some commentators to discuss whether the action of passing off should not have been extended to protect a celebrity's persona something it was not designed to do. Instead of an inherently unsuited action there has been debate about whether the UK would be better served by a distinct right of publicity more akin to the protections available within the US or under Canada's tort of appropriation of personality.[344]

1.4 **Trademarks**

(a) ***Overview***

The *Trademarks Act 1994 ("TMA"*) s.1(1) defines a trade mark as being:

> "Any sign capable of being reproduced graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trademark may, in particular, consist of words,[345] designs, letters, numerals or the shape of goods or their packaging".

The wording suggests that the trade mark register may be a means of protection for popular personality features. Personal names, titles, nicknames and artist names may become word marks;[346] likenesses, signatures[347] and other visual personality features may fall under picture marks,[348] and voices can be protected as sound marks. A closer examination, however, shows that the trade mark registration system fails soon after popularity occurs. Historically, English courts have felt uncomfortable with registering signs for mere licensing or merchandising purposes. Names of fictional characters such as "Pussy Galore"[349] or "Holly Hobbie"[350] were rejected.[351]

Unlike passing off, enforcement of a trade mark requires no goodwill to have been established. As the primary function of a trade mark is to convey a message that the quality of the product bearing the trade mark are under the control of some person who customarily uses the mark for conveying this message.

Parker J, whilst explaining the policy behind the protection of names, said[352] that on the one hand, apart from the law of trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury.

He continued to say "if the word is descriptive or becomes the name of an article then, it will be difficult, if not impossible, to prove that it is distinctive of his own goods or that there will be any deception in use by others,

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[343] M. Madow, 'Private Ownership in Public Image: Popular Culture and Publicity Rights', (1993) 81 Cal. L.R. 125 at 154

[344] Ibid; F. Robinson above n.312

[345] Including personal names

[346] Sometimes difficulties arise with common names such as John Smith or surnames which the Registrar in the United Kingdom may regard as incapable of distinguishing goods and/or services of undertakings, see Registrar's Work Manual at Para 3.12.8

[347] Barry Artist Trade Mark [1978] R.P.C. 703

[348] Portraits can be distinctive, see Re Anderson L.R. 26 Ch D. 409; Rowland v Michell (1987) 14 R.P.C. 37

[349] Pussy Galore Trade Mark [1967] R.P.C. 265

[350] Re American Greetings Corp.'s Application [1984] 1 W.L.R. 189

[351] J. Klink, '50 years of publicity rights in the United States and the never ending hassle with intellectual property and personality rights in Europe,' I.P.Q. 2003, 363

[352] Burberrys v J.C. Cording & Co Ltd (1909) 26 R.P.C 693

and apart from the TMA, the right of anyone to the exclusive use of a word is always limited by the possibilities of its use by others without any risk of deception."[353]

In order for an item or article to qualify as a trade mark, it must demonstrate a capacity to distinguish itself from others. The court in *Canon Kabushiki v Metro Goldwyn-Mayer (1997)* stated[354] that the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him to distinguish the product or service from others which have another origin".

Another hurdle facing celebrities who are trying to seek protection through Trade Marks is s.11(2)(b) of the TMA, which provides that the use of a mark as an "indication concerning ... characteristics of goods or services" will not infringe.[355]

Porter proposes that if the name or image is found not to be inherently distinctive, the applicant will have to prove acquired distinctiveness through extensive trading under a sign bearing his name or image. He argued that there is both positive and a negative sides to this. The positive being to show trading activity has been carried out by or under license from the celebrity in the goods or services to which the application relates. The negative burden is to show that there has not been widespread use by traders generally of the name or image as in *Princess Diana's case* and *Elvis' case.*[356]

As long ago as 1938 invented words could theoretically be registered as a trade mark, however registration was not automatic.[357] A line of argument preventing trade mark protection for famous names and signs and was introduced in TARZAN.[358] Where the mark was rejected because nothing in the word TARZAN suggested to the consumer that the film, games and toys had any relationship with the applicant company. It was devoid of any distinctive character, which excluded it from trade mark protection.[359] This case highlights the usual situation of commercialised popularity.

In order to register an ordinary name, the words must be rearranged in an original way, novel fictional names, subject to the *Tarzan,*[360] benefit from this.[361] It is in principal possible to register a personal name as shown in Cantona 7, although nicknames have traditionally been more acceptable to the trade mark registry e.g. Gazza for Paul Gascoigne. However, where the name is common such as James Bond this will be more problematic.[362] Physical likeness can be registered, as long as there are distinctive features or aspects that the public will immediately recognise.[363]

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[353] Ibid

[354] Canon Kabushiki v Metro-Goldwyn-Mayer, Case C-39/97 at Para 28

[355] J. Klink above n.351; Bravado Merchandising v Mainstream Publishing [1996] F.S.R. 205, the Court found the unauthorised use of the registered band name 'Wet Wet Wet' protected, inter alia, for books, on a book cover is justified.

[356] H. Porter above n.287

[357] Section 9(1) of the Trade Mark Act 1938

[358] Tarzan Trade Mark [1970] R.P.C. 450

[359] See s.3(1)(b) of the Trade Mark Act 1994

[360] Tarzan above n.358

[361] Section 9(1)(d) of the 1938 Act, above n.395

[362] Chapter 6 of the Trade Registry Work Manual, at paragraph 3.12.8

[363] Examples include Damon Hill, Gazza, Nigel Mansell, Eric Cantona and Jacques Villeneuve

As with all trade marks applicants specify the classes that they wish to register for protection, thus if the mark is already used by a third party in a separate class then registration is still possible, as long as there will be no confusion to the public.

Section 10(3) states that a person infringes a registered trade mark if they use in the course of trade a sign which is identical with or similar to the trade mark and is used in relation to goods and services which are not similar to those for which the trade mark is registered. If these requirement are proven that the trade mark has been used without due cause, takes unfair advantage of, or is detrimental to the distinctive character or repute of the mark.

As mentioned above a trade mark must be registered for specific goods and services, of which there are 45 classes, 34 for goods and 11 for services e.g. class 25 covers clothing. These classes of goods and services restrain unauthorised third parties from using the mark, where not for comparative advertising for example, for similar or identical goods.

Where the use of a trade mark is for comparative advertising this is permitted under s.10(6). The exceptions to this are where the use of the mark is not compliant with honest practices in the trade, an unfair advantage is taken or damage is caused to the distinctive character or reputation of the mark occurs. If any of these occurs the celebrity can bring an action under trade mark law, and potentially a number of other actions such as passing off, copyright or a complaint to the relevant regulatory boards, and the courts have a number of remedies available to them. The three main remedies for trade mark infringement are damages, injunctions and an account of profit. Additional special remedies that are available include an order for erasure of the mark, destruction of the goods and an order for delivery up of the infringing goods.

Registered trade marks are expected to be used[364] and not stockpiled, which is contrary to public policy.[365] The registration once accepted lasts for five years and the owner can enforce the protections during this period even where the mark has not been used, once the initial five year period has expired the mark can be vulnerable for revocation for non use.

Kerly states that where the application is for goods which the 'reasonable' consumer would obviously associate with the celebrity and expect that his name on products would be by way of endorsement, for example golfing equipment by Tiger Woods, there should be no difficulty with the application to register, however when the application relates to goods or services far from the field of activity of the celebrity, it would be subject to further enquiry.[366]

Where the use is not identical to a registered mark the celebrity must show a likelihood of confusion. Laddie J, confirmed[367] that deception to the consumer as to origin of particular goods or services is essential with mere association alone not being satisfactory. If the celebrity is a well known foreign celebrity he can seek an injunction, where an identical or similar mark is being used, in relation to identical or similar goods or services, resulting in a likelihood of damages.[368]

(b) ***European influences***

In addition to the legislation under UK law there are European Directives and agreements which have a profound effect on the law. The Paris Convention offers protection to well-known marks, even where there is

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[364] Re Rawhide Trade Mark [1962] R.P.C 133, see also J. Holyoak, 'UK Character Rights and Merchandising Rights Today' [1983] J.B.L 444

[365] Section 32(3) Trade Marks Act 1994

[366] Sir D. Kerly, 'Kerly's Law of Trade Marks and Trade Name, 13th ed,' (Sweet & Maxwell, 2001) para. 22.51

[367] Wagamama v City Centre Restaurants [1995] F.S.R 713

[368] Section 46(2) of the Trade Marks Act 1994 – so called well known marks

no registration or use in a territory.[369] The basis of protection for well-known marks appears therefore to be not limited to the meaning as to origin but as a work of authorship of the variety of meanings.

The Community Trade Mark Office has without hesitation registered names of persons[370] who have failed to obtained protection within the UK for example the name "Elvis",[371] "Elvis Presley"[372] and "Diana, Princess of Wales"[373] and therewith granted a European wide trade mark right which includes, of course, the territory of the UK.

However as Klink remarks,[374] even when a trade mark registration succeeds, be it on the UK or the Community register, the holder is not necessarily protected.[375] The registration remains toothless if the mark is used as a reference to the celebrity or as a decorating element on merchandising articles.[376] In *Arsenal*,[377] Laddie J. suggested that s.10(1) of the TMA requires trade mark use in order to constitute trade mark infringement.

The European Directives 84/450 and 97/55 require Member States to prohibit "misleading advertising likely to deceive the public".[378] However, Jones[379] argues that the extent to which it applies to non-comparative advertising is unclear, and is aimed more towards damage from deceptions than competitors. Besides which, the Government considers the protection already afforded by the TMA sufficient.[380]

(c) ***Summary***

In summary, "trade mark law is concerned only with the distinguishing of the goods of one company from those of another. Trade mark law will thus indirectly protect the publicity interest only when and where the celebrity's identity, name, or likeness is used in such a way as to identify a particular company's goods, and then used in the same or similar way on another company's."[381] Trade mark law has traditionally offered a limited level of protection for a celebrity, as the protections must in the first place be registered. This can be time consuming and becomes more difficult the more well-known the celebrity becomes. The protections once the mark is registered are limited to the relevant classes of the mark and in addition similar goods and services to those protected. Once the mark has gained registration however it offers increased protection over passing off as no requirement is needed of the use of the mark by the claimant.

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[369] Paris Convention, Article 6(i)(s)

[370] Community Trade Mark Register (CTM Online) at www.oami.eu.int/en/index.htm

[371] Elvis – No.001238971

[372] Elvis Presley – No.001408897

[373] Diana, Princess of Wales – No.00630566

[374] J. Klink above n.351 at 369-70

[375] Failure to register a broad list of goods and services may result in unpreventable use, see Baywatch Production v The Home Video Channel [1997] F.S.R. 22

[376] Kerly above n.365 at pg 772, nos. 22-56

[377] Arsenal above n.323

[378] See Directive 84/450 and Directive 97/55

[379] P. Jones, 'Manipulating the law against misleading imagery: Photo-Montage and appropriation of well-known personality,' E.I.R.P, 1999, 21(1), 28

[380] McCormick, 'The Future of Comparative Advertising,' 2 E.I.P.R, 1998, 41

[381] W. Houseley, 'The Unauthorised Commercial Exploitation of the Publicity Right,' [1996] Y.M.E.L 263 at 278-9

Porter[382] strongly advocates that if a third party uses, without consent, the trading name or style of another trader, the burden of proof should be on him to establish that the intention or effect was not to derive benefit from the goodwill attached to that trading name or style. Such a shift in the burden of proof would bring English law closer to the US law of unfair competition and would have particular application in the area of character merchandising.

Ownership by a celebrity of a trade mark registration of his name or image provides him with a property right which is, at least, protect able in the most blatant of circumstances. Because of the prima facie assumption of the validity of a trade mark registration, there is no need to establish the existence of goodwill before enforcing it and it is for the defendant to prove the invalidity of the mark.

1.5 **Copyright**

(a) ***Introduction***

Copyright is designed to protect the original results of the labour, skill and judgement of an author, artist or another creator.[383] Copyright protects the way in which the work is expressed and not the idea or method that has created it. The driving pressure behind the changes with copyright over time has traditionally come from music, film and software industries who are continually pushing for greater protection for their clients, particularly in the Internet age. One of the main advantages of copyright is that the rights occur automatically with no registration required.[384]

Under UK law there is no copyright in a name, likeness, voice or other indications of a persona, which was confirmed by the Whitford Committee[385] in 1977. The committee's view was upheld in *Exxon Corp v Exxon Insurance Consultants International Ltd. (1982)*[386]*,* where the claimants argued that the word 'Exxon' should be granted copyright protection under the heading as an original literary work. The name could have potentially satisfied the test of skill, labour and judgment under s.1 of the *Copy Design and Patents Act ("CDPA") 1988*. However, the claim was denied as it was found to not convey information, instruction or pleasure, which the court found could not be satisfied by a single word.[387]

The thought of using copyright to grant character rights was examined by the committee.[388] However they believed that an unfair competition law would be the best suitable solution to deal with this 'modern phenomenon' rather than extending copyright law. However, where the salient features of a character readily are identifiable from existing artistic representations e.g. Popeye, there should be the possibility of an action for infringement without having to identify any particular artistic representations as having been copied.

The Committee also examined copyright in relation to book titles and fictitious names,[389] the report said that the present protection for visual representations was sufficient but ruled out protection for names. This was because names alone may fail to be of sufficient skill and labour to warrant protection.

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[382] H. Porter above n.287

[383] M. Flint, N. Fitzpatrick & C. Thorne, A User's Guide to Copyright, 6th Ed, Tottel Publishing

[384] C. Oppenheim, 'Recent changes to Copyright Law and the implications for FE and HE, June 2004, available at http://www.jisclegal.ac.uk/publications/copyrightcoppenheim.htm

[385] Whitford Committee, The report of Copyright and Designs, HMSO 1977, Cmnd 6732

[386] Exxon Corp v Exxon Insurance Consultants International Ltd [1982] R.P.C 69

[387] Hollinrake v Trustwell (1895) 3 Ch. D 420

[388] Whitford Committee above n.385

[389] Literary copyright does not exist in a name, real or fictional, see Conan Doyle v London Mystery Magazine Ltd [1949] 66 R.P.C 312

(b) ***Current law***

The current law of copyright is contained within the CDPA and s.1 sets out the types of works that receive protection namely:

2 original literary, dramatic, musical or artistic works;

3 sound recordings, films, broadcasts or cable programmes, and

4 the typographical arrangement of published editions

The copyright in a photograph,[390] drawing, film and sculpture, even of well known personality, belongs to the creator of the work not the subject, this is provided under s.9(1) and s.11(1) of the CDPA. An exception is when the work itself has been commissioned to the celebrity that they granted the copyright in the work to them and they receive protection under s.85 of the CDPA.[391] This has resulted in the lack of cases in which copyright has been cited by celebrities seeking to protect their persona. As well as not being able to sue under copyright the celebrity, where they are not the owner, also has no rights of the dissemination or use of the work.

The common law does not accept that there can be copyright in a person's name, or that a celebrity can 'own' his appearance for example by stopping someone having a copy of a tattoo. However, signatures are *prima facie* distinctive, though not inevitably so; for example a signature which was little more than a series of neat capital letters would result in the 'distinctive' presumption being rebuffed. Signatures, if unique would fall under a graphic work[392] as would other aspects of perceived identity, such as a team badge or strip.[393] Trading in this graphic work could lead to goodwill in the work, which could then result in a potential cause of action under passing off.[394] However, at present there has been no significant case law to support this theory.

Celebrities can protect their image and voice from exploitation if it has been obtained by making a recording that is of a "qualifying performance," as defined by statute, made without the prior consent of the celebrity.[395] All illicit recordings are prevented,[396] and their commercial manufacture and distribution,[397] are punishable both by civil[398] and criminal proceedings.[399]

Photographs are protected as artistic works, however unless the celebrity is the original copyright owner or has acquired the copyright by assignment or is the exclusive licensee, they will have difficulty in preventing exploitation. Also the more well known the celebrity the more copyright images will exist not under their ownership.

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[390] Section 4(1)(a) of the Copyright, Designs and Patents Act 1988

[391] S. Bains above n.2 at 164

[392] Section 4(1) of the Copyright, Designs and Patents Act 1988

[393] Ibid at s.213(2)

[394] M. Elmslie, & M. Lewis, 'Passing Off and Image Marketing in the UK', E.I.P.R. 1992, 14(8), 270

[395] Section 180 of the Copyright, Designs and Patents Act 1988

[396] Ibid at s.197

[397] Ibid at s.182–184

[398] Ibid at s.194

[399] Ibid at s.198

In order for an individual to obtain copyright protection for a dramatic work, the work must be unified and not made up of separate elements capable of being performed.[400] The difficulties in establishing copyright protection for part of a format are numerous and were established[401] in *Green v Broadcasting Corp of New Zealand (1988),* which concerned the format of the game show 'Opportunity Knocks.' Therefore, the current law is that a substantial part of the protected work must be taken in order for protection to be provided, as re-emphasised in *Nova Productions Ltd v Mazooma Games Ltd (2006).*

Copyright infringement is actionable, by the copyright owner, through s.96 CDPA, or where the infringement is of a moral right through s.103 as the tort of a breach of statutory duty. Damages are available unless the defendant is "innocent,"[402] in which case alternate remedies such as injunction and account of profits are available under s.97.[403] The making, dealing with or use of infringing copies is currently a criminal offence under s.107.

The main copyright protections within the UK are the CDPA mention above, but in addition to the CPDA the lengthy and complex *Copyright and Related Rights Regulations 2003* also apply. Making it a criminal, in addition to a civil offence, to infringe copyright by communicating copyrighted works to the public in the course of business.[404]

A significant benefit of copyright is the guaranteed period of protection that is granted to the copyrighted work, for e.g. 70 years from the end of the year in which the author dies for literary, dramatic and musical works. The significant periods of protection ensure that wherever this unregistered right is applicable it is of great use to an individual seeking to protect their work.

In 2005 the Chancellor of the Exchequer requested a review of the protection periods for copyright. The review was a comprehensive assessment of the current intellectual property regime, with the intention of providing a "foundation for the government's long-term strategic vision for IP policy."[405] There were three main aims:[406]

1 strengthen enforcement of IP rights from piracy and counterfeiting;

2 to provide additional support for British businesses using IP at home and abroad; and

3 strike a balance to encourage innovation and invest in new ideas whilst ensuring that the markets remain competitive.

The Gower Review was published on 6th December 2006 with recommendations that both sound recordings and performers' rights should continue to be protected for 50 years.[407]

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[400] H. Carty above n.12 at 237

[401] IPC Media Ltd v Highbury Publications Ltd [2005] F.S.R. 20 as cited in Green v Broadcasting Corp of New Zealand (1988) 2 NZLR 490 and shown in Nova Productions Ltd v Mazooma Games Ltd [2006] EWHC 24 (Ch).

[402] One who did not know and had no reason to know that the work was copyrighted.

[403] Microsoft v Plato Technology 1999 EWCA Civ 1854

[404] Copyright and Related Rights Regulations 2003 s.24

[405] C. Angelopoulos above n.191 at 35

[406] *Gowers above n.327*

[407] A. Rahmatian, 'The Gowers Review on the length of protection for sound recordings and performers' rights', E.I.P.R 2007 at 353

Copyright law, although having been recently subjected to the Gower Review, according to MacMillan,[408] is still unpredictable and she quotes Vaver by stating that the institution of copyright is "in crisis."[409] Nimmer stated that "old-fashioned" copyright can no longer guide us in developing mechanisms to solve the many difficulties we encounter"[410] Carty[411] argues that the current copyright protection in the UK are not particularly useful in the area of protection of persona's. This is because there is no copyright in the name or image of the celebrity, [412] in addition copyright in photographs belongs to the photographer or his employer,[413] thus allowing the celebrity no control over distribution. Mere protection of copyright in the photographs or images that the celebrity already owns is clearly not satisfactory for the industry, given the attention of the world media and particularly of paparazzi in celebrities. In addition, relevant copyright or performance rights in the sound or video recordings of the celebrity may also not belong to the celebrity themselves.

1.6 **Malicious Falsehood**

(a) ***Overview***

Malicious falsehood is a classic example of a tort that has developed a long way from its initial roots to its current role. It began as a method to deal with wrongful allegations of unlawful claims to proprietary rights in land.[414] The tort of malicious falsehood also has origins in "slander of title" and "slander of goods". Liability is based on the defendant telling lies about the claimant to third parties, which are calculated to cause damage. Malicious falsehood protects the claimant 's economic interests,[415] but in common with the intentional harm tort, it is not confined to the protection of business interests.[416]

The tort now covers areas such as trading reputation of a business and its products, additionally Kaye has shown that the action also covers individual economic interests. The development occurred over the latter half of the nineteenth century, notably in two main cases. The first was *Western Countries Manure Co v Lawes Chemical Manure Co (1874)*[417] where the quality of the claimant's product was incorrectly impugned by the defendant and it was this attack on the goods that helped to create the novel approach of using the tort of malicious falsehood.

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[408] F. MacMillan, 'New Directions in Copyright Law: Volume 5' E.I.P.R 2008 at 209

[409] D. Vaver above n.35 p.21-22.

[410] D. Nimmer, 'The End of Copyright' (1995) 48 *Vand L. Rev.* 1385 at 1420.

[411] H. Carty above n.288

[412] Belisle du Boulay v Jules Rene Hermenegilde du Boulay (1869) 2 L.R.P.C 430; Elvis Presley Enterprises Inc v Sid Shaw Elvisly Yours [1999] R.P.C. 567

[413] Lyngstad above n.268, shows where celebrities are concerned permission to duplicate the photograph may be given by the photographer/owner against the subject's wishes. The position is different however when the photograph has been commissioned for private and domestic purposes: Copyright, Designs and Patents Act 1988, s.85; Mirage Studios above n.276. Here the defendant tried to cash in on the claimant's successful cartoon characters the Teenage Mutant Ninja Turtles by producing their own humanoid turtle characters and licensing their use to various clothing manufacturers. Though passing off was held arguable, the case involved a breach of copyright not of photographs but of 'pictorial drawings'

[414] Gerard v Dickenson (1590) 4 Co Rep 18a, 76 ER 903

[415] D. Stilitz & P. Sales, 'Intentional infliction of harm by unlawful means,' L.Q.R. 1999, 115(Jul), 411, In which he shows the contrast to defamation, which protects reputation

[416] Shepherd v Wakeman (1662) 1 Sid. 79.

[417] Western Countries Manure Co v Lawes Chemical Manure Co (1874) LR 9 Exch 218

In the second case was *Riding v Smith (1876)*[418] the business itself that was criticised. The wife of the claimant who worked in the claimant's shop was alleged to have committed adultery with the vicar. This caused a fall in trade for the shop in the aftermath of the allegations. The court found that this was held to represent a good cause of action, once again increasing the scope of the tort.

The varying strands of the tort of malicious falsehood were reigned together in another case at the end of the nineteenth century in *Ratcliffe v Evans (1892).*[419] The case concerned an allegation by the defendant that the claimant's business had ceased to trade. Bowen LJ found the statements to be actionable when he stated:[420]

> "An action will lie for written or oral falsehoods, not actionable per se nor even defamatory, where they are maliciously published, where they are calculated in the ordinary course of things to produce, and where they do produce, actual damage."

Although, discussed below, defamation has a role to play within the field of protection of an image and personality, the majority of cases by companies and individuals will be filed under the more appropriate but more restrictive tort of malicious falsehood. In Kaye an unauthorised interview and pictures were taken of Kaye in hospital without his consent, the court ruled that the action was extended to include protection of his economic interests. Kaye would have been able to sell his story for a higher value if the defendant's were restrained from publishing their article.

The tort of malicious falsehood has traditionally been seen as very difficult to prove, as shown by the case of *British Airways plc v Ryanair Ltd (2001).*[421] To prove a case under malicious falsehood there are four main requirements:

1 falsity (a false statement);

2 harmful truth;

3 malice; and

4 damage.

(i) *Falsity*

The simplest of the requirements is in line with the defamation test requiring that the statement made must not be true. The claimant must prove falsity and that the public were also mislead by the falsity,[422] the high profile case of *British Airways* collapsed due to this requirement. Under malicious falsehood the burden of proof is upon the claimant unlike defamation cases. Whilst determining the falsity of a statement the 'one meaning rule'[423] is applied, which states that the single natural and ordinary meaning of the word(s) used must be determined.[424]

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[418] Riding v Smith (1876) 1 Ex D 91

[419] Ratcliffe v Evans [1892] 2 QB 524 confirmed in White v Mellin [1895] AC 154

[420] Ratcliffe Ibid

[421] British Airways plc v Ryanair Ltd [2001] FSR 32

[422] Anderson v Liebig's extract of meat Co Ltd (1881) 45 LT 757

[423] Vodafone v Orange [1997] E.M.L.R. 84

[424] Horrocks v Lowe [1975] A.C. 135, per Parker J

(ii) *Harmful truth*

The statement must damage the reputation of the goods or business by harming it, namely that the words in the derogatory comment(s) harm the reputation of the goods or the business.[425] The context in which the statement is made is of crucial importance within this field, as it is an important factor as to whether the comment is harmful or not.[426]

Even innocuous statements can be seen as denigratory once placed into context as proven in *Lyne v Nicholls (1906),*[427] where the defendant falsely stated that his paper's circulation was twenty times that of any local rival.[428] Denigration also includes persons accused of lying as to facts.[429]

(iii) *Malice*

A core element of the action which places the burden upon the claimant to prove, though defendants often claim accidental mistake rather than deliberate malice as the reason for the false statement. This element illustrates a major difference between malicious falsehood and passing-off or defamation where it is not a requirement. As discussed by Jones,[430] the troublesome term 'malice' has been traditionally interpreted as 'contriving and intending to injure the claimants,[431] or an indirect object or purpose,[432] but in recent years, a form of 'recklessly indifferent malice'[433] has emerged.[434] It is the requirement to prove a lie has been told which has curtailed the use of the tort.

The courts have yet to establish a clear definition of malice. In *Royal Baking Powder Co v Wright, Crossley & Co (1900)*,[435] Bankes L.J, defined malice as the absence of any 'just cause or excuse.'[436] A second definition was in *Shapiro v La Morta (1923),*[437] as being 'an intentionally or recklessly made statement.'[438] In *McDonald's Hamburgers Ltd v Burgerking (UK) Ltd (1986),*[439] Whitford J. encapsulated malice when he said that it was to be regarded as, at least, a reckless indifference as to whether harm may be caused to the interests of the claimant. [440]

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[425] Ibid

[426] De Beers Abrasive Products Ltd v International General Electric Co of New York Ltd [1975] 2 All ER 599, [1975] 1 WLR 972

[427] Lyne v Nicholls (1906) 23 TLR 86

[428] Court stated that this could have lured advertisers away

[429] Serville v Constance [1954] 1 All ER 662, [1954] 1 WLR 487

[430] P. Jones above n.379

[431] Western Counties above n.417 at 223, per Polluck B.

[432] Balden v Shorter [1933] 1 Ch. 427 at 430, per Maugham J.

[433] Joyce v Sengupta [1993] 1 All E.R. 897 at 905, per Sir Donald Nicholls V-C

[434] Kaye above n.303

[435] Royal Baking Powder Co v Wright, Crossley & Co (1900) 18 RPC 95

[436] Ibid at 99

[437] Shapiro v La Morta (1923) 40 TLR 201

[438] Ibid at 203

[439] McDonald's Hamburgers Ltd v Burgerking (UK) Ltd [1986] FSR 45, reversed [1987] FSR 112 on another point

[440] Ibid at 61

(iv) *Damage*

Special damage[441] was required to be proven before a claim would be complete,[442] which required evidence of harm to their business. This requirement is now superfluous following the *Defamation Act 1952*, s.3(1) which established that necessity is no longer necessary if the following words are used 'Calculated to cause pecuniary damage to the (claimant) and are published in writing or other permanent form'.

(b) ***Summary***

As Crown[443] states in his article malicious falsehood is a very old cause of action and has been rather underused,[444] in comparison to passing off and defamation. It retains an important role to play in the protection of celebrity personalities especially in control of inaccurate damaging but not defamatory commercial speech. Compaq Computer Corp v Dell Computer Corp Ltd (1992)[445] showed that the tort can be used outside its traditional use for comparative advertising, where the defendant misled the public through details of two computers, one of which displayed the discounted price whereas the other was full price. The single and natural meaning test determined that the customer would have been misled by the falsity in this occasion.[446]

The likelihood is that malicious falsehood is used as one of a few cause of actions cited rather than as the principal action. Kaye re-emphasises that the tort can be of benefit where other actions fail for example in obtaining an injunction.[447] The tort enables a celebrity free to contract with whoever they choose, as exclusivity is often of key importance.

1.7 **Defamation**

(a) ***Overview***[448]

Defamation actions cover the protection of the reputation of an individual, they also extend to cover professional and business aspects of the individual as shown in *Tolley v JS Fry Ltd (1931).*[449] In *Tolley*, an amateur golfer was photographed with a bar of Fry's chocolate sticking out of his back pocket. The photograph was used without consent by the defendant to promote sales of their chocolate. At the time the distinction between an amateur and a professional sportsman was a real one and Tolley was concerned that his amateur status would be jeopardised if the public thought he accepted money for his consent. Tolley was able to obtain an injunction against Fry's restraining their use of this photograph because it implied that he

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[441] Fielding v Variety Inc [1967] 2 QB 841 gave guidelines on the quantum

[442] Horrocks above n.424 per Parker J, who while reiterating the essential requirements of the tort, set out in Kaye above n.303, stated that "the defendant must have published words about the claimant which were false, have done so maliciously and special damage must have followed as the direct and natural result of the publication of those words."

[443] G. Crown, 'Malicious falsehood: Into the twenty first Century' Ent L.R. 1997, 8(1), 6

[444] Pearson, 'Pecuniary elements of malicious falsehood' (1998) 12/6 Lawyer 12

[445] Compaq Computer Corp v Dell Computer Corp Ltd [1992] FSR 93; D. Bainbridge above n.155 at pg 817.

[446] The opposite result was found in Vodafone above n.423 and therefore the claimant was unsuccessful.

[447] Court awarded an injunction under this action rather than defamation

[448] L. McNamara, 'Reputation and Defamation' Reviewed in Comms L. (2008) 63 for a full analysis of defamation

[449] Tolley above n.297

had been paid to advertise Fry's product. As claimants in a libel action must prove damage to his reputation, defamation laws have been used rarely to prevent commercial use of their name or likeness.[450]

Smith defines defamation actions as a legal means of restoring or vindicating a reputation which has suffered distress, harm or embarrassment as the result of publication to a third party by the defendant.[451] Klink[452] proposes that sometimes the traditionally strong defamation law might prove an effective substitute for the elusive privacy, personality or publicity right. As discussed above the tort of malicious falsehood may apply when false statements are maliciously made in order to cause pecuniary damage to a trade competitor, as shown in Vodafone v Orange. [453] The reputation established in the amateur status of a golfer was held to be lowered by presenting him as having been paid for a caricature-advertisement.[454]

The test applied by the courts for defamation was proposed by Atkin L.J, in *Sim v Stretch (1936).*[455] The test is "would the words tend to lower the claimant in the estimation of right thinking members of society generally."[456] This test was applied in the case of Paul McKenna the hypnotist who was accused by the Sunday Mirror of buying a fake PhD from an American University for £1,400.[457]

An important issue is that the test is objective as it looks at what the thoughts of "right thinking members of society" are and whether it would lower the estimation of these persons. However, a problem exists in relation to which right thinking members of society are and to what actions do they need to take to be encompassed as a member of the group. Harwich LJ, in *Charleston v News Group Newspapers Ltd (1995)*[458] said:

> "I have no doubt that…many News of the World readers who saw the offending publication would have looked at the headlines and the photographs and nothing more. But if these readers, without taking the trouble to discover what the article was all about, carried away the impression that two well known actors…were also involved in making pornographic films, they could hardly be described as ordinary, reasonable, fair-minded readers."[459]

Defamation law therefore is not the strongest means by which personality can be protected, as the action does not protect against appropriation and exploitation of the personality but rather against criticism and ridicule of the personality. Whereas in practice third parties usually want to exploit personalities in their best light to attract higher profits, with the main exceptions being the newspaper industry.[460] No free rider wants to hijack popular personality features in order to diminish or criticise.[461] By contrast, he will use the most excellent reputation he can for his marketing.[462] A further weakness of the action according to Klink's is a

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[450] H. Porter above n.287

[451] S. Smith, 'Image, Persona and the law', Sweet and Maxwell at Para. 5-44

[452] J. Klink above n.351

[453] Vodafone above n.423

[454] Tolley above n.297

[455] Sim v Stretch (1936) 52 T.L.R 669

[456] Ibid

[457] M. Hornsnell, 'McKenna sues over claim he bought Phd' The Times 2006 July 11th.

[458] Charleston above n.342

[459] Ibid

[460] S. Bains above n.2

[461] Ibid

disclaimer using small letter to the missing consent of the celebrity as the mere exploitation of another's popularity is not defamatory.[463]

1.8 Other protections

(a) *Introduction*

In addition to the legal protections mentioned above, there are two other areas that this paper will briefly examine, namely regulatory boards and the *Data Protection Act 1998* ("DPA"). A recent example is shown by the Duke of Edinburgh's complaint to the Press Complaints Commission about an incorrect report concerning his health in the London Evening Standard.[464] He sought redress for details of his medical records becoming public knowledge, which he strongly objected to. The HRA has had an effect upon the protections as the bodies, and courts have had to ensure that art.10 of ECHR is not infringed, unless otherwise justified. Jones[465] believes that the laws protecting celebrity personas are deficient but that there is some token redress under both the boards of protections and the DPA.

(b) *Regulatory Boards*

Regulatory bodies have a place in the protection of personality and privacy of individuals. Although useful in theory they have been seen as largely toothless in reality. They fall under the umbrella term of 'public authorities' so therefore have to ensure that they defend personalities in line with the HRA. This paper will examine the two most important regulatory boards, namely the Press Complaints Commission and the Advertising Standards Agency.

The Press Complaints Commission's Code of Practice was ratified on the 1st August 2007 and was created in conjunction with the newspaper and periodical industries.[466] The code contains sixteen separate sections as well as the outline for the public interest exception. Of particular interest to persons wishing to protect their personality and privacy are s.3 which states:[467]

i Everyone is entitled to respect for their private and family life, home, health and correspondence, including digital communications. Editors will be expected to justify intrusions into any individual's private life without consent; and

ii It is unacceptable to photograph individuals in a private place without their consent.[468]

Section 4 of the code offers protection against harassment, and states that journalists must not persist in questioning, telephoning, pursuing or photographing individuals once asked to desist, nor remain on their property when asked to leave and must not follow them. This offers a dual protection, one for the individual themselves and another for their family. Section 10 covers an increasingly contentious area of the method of obtaining information such as clandestine listening devices or photographic means.

The PCC's Code would appear to prohibit the Charleston lacuna,[469] which is where a digitally manipulated photograph of two characters from the soap opera Neighbours was found not to be libellous due to the

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[462] Ibid

[463] Charleston above n.342

[464] http://news.bbc.co.uk/1/hi/uk/7549077.stm

[465] P. Jones above n.379

[466] http://www.pcc.org.uk/cop/practice.html

[467] B. Pillans above n.14 at 213

[468] Although the phrase private place this definition private places are public or private property where there is a reasonable expectation of privacy

[469] Charleston above n.342

accompanying text[470] even though the picture alone would probably have been libellous. This has shown one way in which the Code of Practice has become more important in determining whether processing through manipulation or appropriation of photographic material relating to a data subject is reasonable.

The Code is subject to a similar public interest test as used in confidence actions and includes, but is not exclusive to, detecting or exposing crime or serious impropriety and preventing the public from being misled by an action or statement of an individual or organisation.

The *Broadcasting Act 1996* (as amended) requires Ofcom to consider complaints about unwarranted infringements of privacy contained within a programme or in connection with the obtaining of material included in a programme. When examining a complaint Ofcom will balance the public interest exception available under rule 8.1 Ofcom's code of conduct. The Committee of Advertising Practice ("CAP")[471] is the industry body responsible for the UK's advertising codes. CAP's Broadcast Committee is contracted by the broadcast regulator, Ofcom, to write and enforce the practice codes governing TV and radio advertising.[472] The Committee comprises representatives of broadcasters licensed by Ofcom, advertisers, agencies, direct marketers and interactive marketers.

The Advertising Standards Agency ("ASA") independently administers the CAP codes which, covering television[473] and radio[474] advertisement as well as non broadcast media such as sales promotion and direct marketing.[475] The ASA is recognised by Ofcom and the Office of Fair Trading ("OFT") as the established body responsible for regulating misleading and comparative adverts within the UK. If ASA fails to secure an advertisers agreement to comply with the self regulatory system they can ask the OFT to consider action under the *Control of Misleading Advertisement Regulations 1988* (as amended). A remedy which can be sought from the courts is an injunction to avoid the repeated use of misleading claims or implications within the advert.[476]

The Radio code under s.14 offers protection to well known personalities by prohibiting the use of, or implication of an endorsement where no contractual agreement exists.[477] The section is widely drafted to include impersonations, soundalikes, parodies and similar take-offs from well known persons, and states that they are only permitted where their use is instantly recognisable as such and the person being mimicked could reasonable be expected to have no reason to object.

The case of *David Bedford and the Number* emphasised the regulators[478] limited powers to protect appropriation of celebrity personalities. The case concerned a caricature of a 1970's runner, with a droopy moustache and red hooped running tops. Mr Bedford claimed there had been a breach of Independent Television Committee Advertising Standards Code, rule 6.5. 'Protection of privacy and exploitation of the

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[470] Ibid at pg 73, Lord Bridge felt that persons who only saw the headline and the photograph and not the accompanying text could not be described as ordinary, fair minded readers.

[471] R. Burn and M. Sannie, 'How image conscious are you?', C.W 2008 178, 19-23.

[472] See Communications Act 2003, s.3(2)(f) and Broadcasting Act 1996 (as amended) s.107(1) and s.130, ECHR Art.8 & 10

[473] http://www.asa.org.uk/asa/codes/tv_code/tv_codes/

[474] Ibid

[475] Ibid

[476] Companies referred to the OFT recently include Sport Newspapers and Fones4Free

[477] http://www.cap.org.uk/cap/codes/broadcast_codes/radio_code/Radio+Code+General+Rules+Protection+of+Privacy.htm

[478] In this case Ofcom

individual."[479] While deciding for Mr Bedford, Ofcom said that they felt "the decision that the company had breached the Advertising Standards Code was punishment enough and banning the adverts would be disproportionate."[480] There was no award of damages as Ofcom does not have the power to award damages, therefore in order to obtain damages Mr Bedford needed to go to court. The adverts were still continuing in early 2006, presumably still without Mr Bedford's permission, suggesting that the ruling by Ofcom showed a lack of effectiveness.[481]

A strong weakness of these protections are the lack of effective sanctions currently available under both the PCC and the ASA codes.[482] Both heavily rely on self regulation and the threat of adverse publicity and the requirement of an apology or at worst, through the OFT, seeking an injunction. The possibility of an on screen apology is however, potentially beneficial to a personality who seeks to ensure that his reputation, and future potential earnings are not damaged. The lack of available damages means that the codes are not as effective or as useful to well known persons as they potentially could be. In part due to this more people are looking to the DPA to seek the required remedy, for example in *Campbell*.[483]

(c) ***Data Protection Act***

It has become increasing popular for persons claiming breach of confidence to also claim under the DPA, as seen in *Campbell* and *Murray*.[484] The DPA ensures that data which can identify living persons, both related to a person's individual or their business life, needs to be processed in accordance with eight protection principles.[485] Personal data under the Act includes a persons name, address and likeness.[486]

The *DPA* might be used by an celebrity who suspects an advertiser intends to utilise his image without consent, given that personal data,[487] which is defined[488] as data which relates to a living individual who can be identified, might encompass photographic material and processing and includes organisation, adaptation or alteration of the data, which conceivably includes photo-montage.[489]

Section 10(1) of the DPA states that an individual is entitled at any time by notice in writing to a data controller to cease within a reasonable time, or not to begin processing, any personal data in respect of which he is the data subject, on the grounds that ... processing for that purpose or in that manner is likely to cause substantial damage or substantial distress to him or another.

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[479] As discussed above this is now s.13 in the television code and s.14 in the radio code

[480] www.ofcom.org.uk/bulletin/adv_comp/content_board/?a=87101

[481] D. Vaver above n.35 at 362

[482] J.Adams, 'Merchandising Intellectual Property' Comms L. 2008 at 30

[483] Campbell above n.13

[484] Murray above n.82

[485] In summary the principles require that the data is: processed fairly and lawfully; held only for specific purposes and not used in a way incompatible with those purposes; adequate, relevant and not excessive for the purpose which the data is being processed; accurate and kept up to date; not kept for longer than necessary; processed in accordance with the individual's rights; kept secure.

[486] E. Stoker, 'Right to privacy? David Murray v Big Pictures (UK) Ltd', Ent L.R (2008) 140

[487] Durant v FSA [2003] EWCA Civ 1746 suggests that personal data must have the subject as its focus and the information should be of a biographical nature.

[488] Under Data Protection Act 1998

[489] http://www.ico.gov.uk/upload/documents/determining_what_is_personal_data/whatispersonaldata2.htm.

Section 13 further entitles anyone suffering distress and damage by reason of any contravention to be entitled to compensation for that distress, although the damages awarded by the courts have been limited, e.g. £3,500 in *Campbell*.[490] However, in *Murray*,[491] the claimants sort damages for the breach of the DPA that were equivalent to the market value of the photographs, i.e. a notional licence fee.[492] The Court of Appeal held that the claimant can pursue this course, and the claimants counsel argued that the courts failure to give effective protection to people rights under the DPA could conflict with art.23 of the European directive.[493]

As so far the damages are limited under the DPA an individual may seek compensation from an advertiser who has processed photographic data relating to an individual without consent. If they made it appear that they endorsed the product or service, they may be forced to pay compensation under s.13(2) of the Trade Descriptions Act 1968,[494] which grants an entitlement to such compensation, providing the individual also suffers damage by reason of the contravention or the contravention relates to the processing of personal data for special purposes.[495].

The use of the DPA is likely to increase over the coming years, particularly if breach of confidence actions continue to offer limited damages. If the claimants in *Murray* are successful with their claim the likelihood is an increased examination of the DPA by potential clients and a likelihood of a flood of litigation utilising the act.

1.9 **Conclusion to UK Protections**

The protections available within the UK in relation to privacy have been centred on the breach of confidence action both prior to and post the HRA. The action has undoubtedly developed and extended since its inception and even though the courts have attempted to downplay the extension of confidence actions, Sims'[496] demonstrates that the effects of the extension resulted in a dramatic shift in breach of confidence.[497] Whilst the action had rarely been successfully invoked in instances to protect aspects of privacy in the past,[498] it is now being asked to protect privacy generally to a much wider extent in the post HRA era, due to wider circumstances covered by confidential obligations.

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[490] The courts never distinguished whether the damages were under the Data Protection Act 1998 or under the breach of confidence action.

[491] Murray above n.82

[492] K. MacMillan, 'Baby Steps' Comms L. 2008 at 72

[493] Directive 95/46/EC of the European Parliament and of the Council of October 24, 1995 on the protection of individuals with regard to the processing of personal data and of the free movement of such data. Official Journal L281 23/11/1995 P, 0031-0050. The directive states 'Member States shall provide that any person who has suffered damage as a result of an unlawful processing operation or of any act incompatible with the national provisions adopted pursuant to this directive is entitled to receive compensation from the controller for the damage suffered.'

[494] Trade Description Act 1968

[495] Journalism, literary or artistic purposes

[496] A. Sims above n.175

[497] Campbell, above n.13 per Lord Hope rejecting Lord Hoffmann's claim that the use of breach of confidence to protect privacy had seen "a shift in the centre of gravity" of breach of confidence.

[498] Law Commission above n.19 at Pt II(A), para.8.7; D. Seipp, "English Judicial Recognition of a Right to Privacy" (1983) *Oxford Journal of Legal Studies* 325 at p.359; M. Thompson, "Breach of Confidence and Privacy" in Clarke (ed.), *Confidentiality and the Law* (Lloyd's, London, 1990), pp.65-81; M. Richardson, "Breach of Confidence, Surreptitiously or Accidentally Obtained Information and Privacy: Theory versus

The actions to protect publicity or personality rights are more numerous than for privacy but many of the actions have also developed dramatically from their original scope e.g. passing off and malicious falsehood. The protections available are wide but still are not sufficient to protect all the necessary areas in order to offer as full protection as is available in the US, as shown in the next chapter. A significant problem that still faces individuals in the UK is the area of damages and specifically the quantum of damages that the courts have been willing to offer as shown in Irvine. The lack of punitive damages as a deterrent is a significant issue facing the UK in relation to protection of an individual's persona.

Law" (1994) 19 *Melbourne University Law Review* 673 at pp.684-689; R. Scott, "Confidentiality" in Beatson and Cripps (eds), *Freedom of Expression and Freedom of Information* (OUP, Oxford, 2000), Ch.16, pp.267-274; Clayton and Tomlinson, *Privacy and Freedom of Expression* (OUP, Oxford, 2001), paras 12.27-12.36;

Albert above n.24; *Argyll above n.216*. Contrast *Lennon v News Group Newspapers Ltd* [1978] F.S.R. 573.; *Francome above n.69*; *Stephens above n.57; Barrymore above n.93*; Helliwell above n.10 (police "mugshot"); Shelley Films above n.112 (photograph of a film set); and Creation Records above n.13 (photograph of an assemblage).

CHAPTER 2

2 Examination of other common law jurisdictions

This paper will now examine the protections afforded within the US, a jurisdiction with the world's largest body of case law related to privacy and publicity. After a detailed examination of the US I shall look individually at Canada and Australia. This chapter highlights the anomalies between the protections available in the UK and other common law jurisdictions. The history of the protections available in the US shows how initially the right of privacy developed from authorities from the UK rather than the US. This shows that at least in the past the two jurisdictions have influenced the other in the development of the law.

2.1 United States

(d) History

According to Smith[499] there are seven reasons why celebrities sue in relation to unauthorised use of personality, ranging from the feeling of personal invasion of having their identity exploited contrary to his will[500] to worries that their endorsement value is reduced or damaged due to the unauthorised use of his image in advertising.[501] The reasons and possibilities for bringing causes of action have increased since the right of privacy was raised in Warren and Brandeis revolutionary article.[502] Where they stated:

> 'That the individual shall have full protection in person and in property is a principle as old as the common law; but it has been found necessary from time to time to define anew the exact nature and extent of such protection. Political, social, and economic changes entail the recognition of new rights, and the common law, in its eternal youth, grows to meet the demands of society.'[503]

The paper will examine and highlight the main cases, articles, legislation and arguments that have created the existing US legal systems. Both the right to privacy and right of publicity are examined as well as undertaking a brief overview of other available laws within the US, it is however imperative to remember that there are substantial differences between different states.

Huw Beverley-Smith stated:

> "the central problem which emerges lies in reconciling economic and dignitary aspects of personality within a cause of action (right of privacy) that developed primarily to protect dignitary rather than economic interests. This problem was partial resolved with the development of the right of publicity in the United States."[504]

The historical link between the development of the right of privacy and the problem of appropriation of personality in the US is strong, the conceptual link is however less certain. Despite the fact that appropriation of personality and the right of privacy might seem to be inextricably intertwined, there is no conceptual link between a general right to privacy and the problem of appropriation of personality.[505]

2.2 Privacy

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[499] S. Smith above n.451, at pg 7 & 8

[500] Ibid at para.2-15

[501] Ibid at para.2-17

[502] S. Warren above n.5

[503] Ibid

[504] H. Beverley-Smith above n.91 at pg 144

[505] Ibid at 159

(a) Introduction

The right of privacy is rooted within the common law and provides all individuals within the US with the privilege of a life free from unwarranted publicity.[506] Cooley first described the right, a decade before the famous Warren and Brandeis article, as the right "to be let alone."[507]

The right of privacy was initiated not by the courts or politicians but rather through the pen and wisdom of two leading academic lights Warren and Brandeis.[508] During their research they noted the limits of the causes of action for breach of contract[509] and confidence,[510] and the absence of any common law concept of insult to honour akin to Roman law, Warren and Brandeis therefore were forced to look elsewhere for support for their 'right to privacy.'[511] In reality they concluded that the protection afforded by common law copyright[512] in certain circumstances was merely the application of a more general right to privacy.[513]

As Beverly-Smith highlighted many believed that there was a superficial similarity between invasion of privacy and defamation, in that both were concerned with injury to wounded feelings, whereas defamation rested on damage to reputation, concerning a person's external relations with the community, an injury of an essentially material rather than spiritual nature.[514] Using the dicta of Lord Cottenham LC on appeal in *Prince Albert*[515] Beverly-Smith came to the conclusion:

> "The protection afforded to thoughts, sentiments, and emotions, expressed through the medium of writing or of the arts, so far as it consists in preventing publication, is merely an instance of the enforcement of the more general right of the individual to be let alone. It is like the right not to be assaulted or beaten, the right not to be imprisoned, the right not to be maliciously prosecuted, the right not to be defamed. The principle protects personal writings and all other personal productions, not against theft and physical appropriation, but against publication in any form, is in reality not the principle of private property, but that of inviolate personality".[516]

The article's intention was that the protection afforded should not be curtailed to conscious products of labour, based on a need to encourage effort. This was because they believed that the right to privacy was part . of a more general right to the immunity of the person and the right to one's personality.[517] Through this

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[506] W. Prosser, 'Privacy', 48 CAL. L. REV. 383 (1960)

[507] T. Cooley, Law of Torts 29 (2d ed. 1888).

[508] Warren above n.5

[509] Prince Albert above n.24; Tuck v Priester (1887) 19 QBD 629; Pollard v Photographic Co. (1889) 40 ChD 345

[510] Abernethy v Hutchinson (1825) 3 LJ Ch 209; Prince Albert and Pollard ibid; Warren above n.5 at 211

[511] Warren ibid at 198

[512] Wheaton v Peters, 26-33 US 1055 (1834), held that copyright was derived entirely from statute. However, copyright continued to exist in the common law of individual states of unpublished works; and it was this right that Warren and Brandeis were concerned

[513] Warren above n.5 at 198

[514] H. Beverley-Smith above n.91 at pg 146

[515] Prince Albert above n.24 at 42 and 47

[516] Warren above n.5 at 205

[517] Ibid at 206 - 207

they envisaged the application of an existing principle to a new set of facts rather than creating a novel principle.[518]

The article also peripherally examined the issue and problems associated with appropriation of personality, which was prominent in their conception of a right to privacy and was one of the 'evils' they sought to redress. As shown below many early cases in the aftermath[519] of the article sought to test this new 'right of privacy', particularly involving the unauthorised use of a person's name for advertisement purposes.

A right to privacy in the US has continually evolved since its inception, quickly developing proprietary attributes through the courts protection of economic interests of a proprietary nature rather than dignitary interests in inviolate personality.[520]

(b) Creation of Right of Privacy

In *Schuyler v Curtis (1891),*[521] the Supreme Court of New York County determined a right of privacy existed despite the fact that the claimant's relative was a famous philanthropist, the claimant remained a private person and had not surrender her right of privacy. The decision was reversed by the Court of Appeal,[522] who did not attempt to repeal the availability of a right to privacy, but restated that the right was not descendible or inheritable, and therefore did not survive post mortem.

Another New York case two years later raised the issue of whether the new right of privacy could be outweighed by the First Amendment. The case was *Corliss v Walker (1893)*[523] where Colt J, felt the right of privacy could on occasion be outweighed by the freedom of the presses under the First Amendment. In *Corliss* the widow of a deceased inventor sought to restrain the publication of a biographical sketch and picture of her late husband. Cobb J acknowledged that the main stumbling block in the recognition of a right of privacy was whether it could curtail freedom of speech and the press, though he regarded both as natural rights which should be enforced with due respect for each other.[524] This statement appeared to acknowledge a problem stemming from *Corliss*[525] and which, had not yet been satisfactorily resolved. The availability of a defence under the First Amendment is discussed in greater detail below.

Cases such as *Schuyler*, *Corliss* and *Atkinson* foretold the problem faced by the courts of reconciling a person's status as a public figure with a right of privacy. The case of Schuyler later resulted in the development of the right of publicity, discussed in depth later in the chapter.[526] *Corliss* gave a foretaste of the problems of balancing a right of privacy with free speech and the liberty of the press.

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[518] Ibid at 213

[519] Despite Prosser, above n.506, stating that the article had little immediate effect on the law, D. Leebron, 'Privacy in Tort Law', M.L.R. 1992 55(1) 111, has persuasively shown that the impact of the article within academic circles, and in the courts, was immediate and significant

[520] A. Hunt, Comment, Everyone Wants To Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech, 95 Nw. U. L. REv. 1605, 1612-13 (2001) at 1613

[521] Schuyler v Curtis 15 NYS 787 (Sup Ct 1891)

[522] Ibid

[523] Corliss v Walker 57 Fed Rep 434 (1893)

[524] Ibid at 73

[525] Ibid

[526] R. Wacks (ed.) Privacy (Aldershot, 1993), Vol. II, pt III; see also B. Markesinis, 'The Right to Be Let Alone Versus Freedom of Speech' [1986] PL 67, which argues that the American courts have traditionally been over protective of freedom of speech to the detriment of interests in personal privacy

The case of *Roberson v Rochester Folding Box Co. (1902)*[527] centred on the whether the defendants obtained, without knowledge or consent, the claimant's likeness for use in their flour advertisements with the caption of 'flour of the family.' *Roberson* remains influential as Roberson based her claim neither on libel,[528] nor on the English authority from *Wilkinson v Downton (1897),*[529] despite similarities in relation to claims concerning the suffering of nervous shock. The claimant claimed that as the portrait had been used without consent to advertise the defendant's product, and as a result of their impertinence, she had been subjected to publicity in contravention to her right of privacy which she found disagreeable. The Supreme Court of New York based its decision on invasion of the right to privacy, a decision overturned by a bare majority, who did not take the view that privacy was a pre-existing principle, emphasising the danger of a flood of claims[530] that may have resulted. Moreover, acceptance of such a claim would allow redress for injured feelings, which the majority of the court were reluctant to embrace, in the absence of a clear common law principle.[531]

The minority took a more dynamic view of the options available, by stressing the need to extend the principles to remedy a wrong. The minority said that this was made possible by changing social conditions and commercial practices and rejected the majority's insistence on basing the issue of liability on the invasion of a purely property interest. Privacy rights were regarded as complementary to the right to the immunity of one's person since the common law had regarded one's person and property as inviolate.[532] Relying on the Warren analogy with private writings and other products of the mind, Gray J. used the analogy that a writer was protected in his right to a literary property in a letter against unauthorised publication, as it was property to which the right of privacy was attached.[533] Consequently, the claimant should be afforded the same property in the right to be protected against the use of her face for commercial purposes as if the defendants were publishing her literary compositions. If her face or her portrait had value, then the value was exclusively hers until she granted use to the public.

In the event, the *Roberson* decision received widespread criticism from academic circles[534] and the public as a whole. This led to the unprecedented step of a majority judge publishing an article in defence of the decision.[535] The New York legislature intervened the following year by enacting a statute making the unconsented use of a person's name, portrait or picture for advertising, or the purpose of trade, both a tort and a misdemeanour.[536]

In stark contrast to *Roberson*, three years later, in *Pavesich v New England Life Insurance Co*., *(1905)*[537] the Georgian Supreme Court recognised the existence of a right to privacy at common law. In the court's view,

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[527] Roberson v Rochester Folding Box Co. 171 NY 538 (1902)

[528] She acknowledged that the likeness was a good one

[529] Wilkinson v Downton [1897] 2 QB 57

[530] Roberson above n.527 at 545

[531] Ibid at 546-7, citing H. Hadley, 'The Right to Privacy' (1894) 3 Northwestern U L Rev 1, challenging the Warren and Brandeis thesis

[532] Roberson above n.527 at 564

[533] Ibid at 564

[534] D. O'Brien. 'An Actionable Right of Privacy? Roberson v Rochester Folding Box Co.' (1902) 12 Yale LJ 35

[535] D. O'Brien. 'The Right of Privacy' (1902) 2 Colum L Rev 437, which sought to address the criticisms made by 'such a well informed and conservative' journal as the New York Times (23rd August 1902)

[536] NY Sess. Laws 1903 Ch. 132 ss. 1-2

[537] Pavesich v New England Life Insurance Co. 50 SE 68 (1905)

the foundation of the right to privacy lay in the instincts of nature. They felt privacy should to be regarded as an absolute right which belongs to any person in a state of nature, which every person would be entitled to enjoy within or without society. It thus takes its place alongside other absolute rights such as personal security and personal liberty.[538]

One result of *Roberson* was the appearance of limitation of powers available to the court in creating precedents and the potential for practical dangers resulting from usurpation of powers from legislative bodies. The court felt compelled to call for legislative intervention, before its detailed analysis of the case law denied a remedy for lack of formal authority. In stark contrast, the unanimous decision in *Pavesich* laid emphasis on broad principles rather than a formal analysis of the relevant precedents, which were invoked *ex post facto* to justify a conclusion the court had already reached. Prosser noted,[539] that *Pavesich* became the leading case and the courts in most states adopted its lead rather than approve the conservative stance taken in *Roberson*.

(c) Inviolate personality and the addition of some proprietary attributes

The right to privacy has constantly evolved since its creation as a right of inviolate personality, quickly developing proprietary attributes. Even in the earliest privacy cases, the courts protected economic interests rather than dignitary interests in inviolate personality. As shown in *Edison v Edison Polyform Manufacturing Co. (1907),*[540] where the inventor Thomas Edison brought an action to restrain a company from using:

1 His name as their corporate name; and

2 His name and picture in advertisements for a medicinal preparation, Polyform, which he had invented several years previously and had sold to the defendants.[541]

The assignment did not give the defendants permission to use Edison's name and picture in connection with the medicine. Edison's action for invasion of privacy was successful, and Stevens VC noted:

> 'if a man's name be his own property…it is difficult to understand why the peculiar cast of one's features is not also one's property, and why its pecuniary value, if it has one, does not belong to its owner, rather than to the person seeking to make unauthorised use of it.'[542]

Therefore, Edison differed from two leading privacy cases, *Roberson* and *Pavesich*, in that the claimant was well known, and, significantly, the right of privacy was seen as developing in order to be capable of remedying injuries to interests of an economic nature in addition to injuries to inviolate personality.

In *Munden v Harris, (1911)*[543] the claimant, a young boy, claimed an injunction and damages for the unauthorised use of his picture in a jewellery advertisement, on its face a claim for injured feelings or dignity. However, in giving judgment for the claimant, Ellison J. noted that a person might have a peculiarity of appearance from which he might benefit if used in advertising or merchandising. In such a case, 'it is a right which he may wish to exercise for his own profit, and why may he not restrain another from using it. If there is value in it, sufficient to excite the cupidity of another, why is it not the property of him who gives it the value and from whom the value springs?'[544]

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[538] Ibid at 70

[539] Prosser above n.506 at 386

[540] Edison v Edison Polyform Mfg Co. 67 A 392 (1907)

[541] Ibid

[542] Ibid

[543] Munden v Harris 134 SW 1076 (1911)

[544] Ibid at 1078

The court concluded that a person had 'an exclusive right to his picture on the score of its being a property right of material profit,'[545] and that general damages could be recovered without need to prove specific loss.[546] Although the use of the property label might not have been intentional, what was clear was the acknowledgement of an economic or proprietary interest that any person may have in his own image.[547]

In *Munden*, the court took the view that commercial value could lie in the image of an unknown person and that 'what was worth taking was worth protecting'.[548] It is difficult to draw a line between the multifarious *de facto* interests that different people might enjoy in their image.

The evolution continued in *Fairfield v American Photocopy Equipment Co.(1955),*[549] where a lawyer's name was used without permission in an photocopier advert, the Californian Court of Appeals stated the cause of action for invasion of privacy was a wrong of a personal character resulting in injury to feelings, without regard to effect the publication might have on a person's property, business, pecuniary interests, or standing in the community.[550]

In *Gautier v Pro-Football Inc. (1951)*,[551] the courts stressed that, although the right to privacy was intended primarily for protection of an individual's personality against unlawful invasion, damages may include 'recovery for a 'property' interest inherent and inextricably interwoven in the individual's personality,' although it was injury to the person not property which established the cause of action.[552]

What the development of the law of privacy in the US shows is that the rights can be used to protect economic and dignitary interests ranging from trading interests to interests in feelings or sensibilities. Even though such broad and expansive legal categories as the right of privacy have boundaries the courts have yet to satisfactorily define these boundaries. The Restatement (Second) of Torts[553] recognised four types of invasions of privacy, the second which is commonly thought of as the right of publicity:

1 intrusion;

2 appropriation of name or likeness;

3 unreasonable publicity; and

4 false light.[554]

Despite four different kinds of invasion highlighted, Prosser only identified three interests to be protected.[555] The first interest was the intrusion tort protecting primarily menial interests which had been useful in filling

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[545] Ibid at 1079

[546] Ibid

[547] In referring to the value which excited the cupidity of another, Ellison J was essentially giving expression to the unjust enrichment rationale for a remedy for appropriation of personality

[548] Munden above n.543 at 1080

[549] Fairfield v American Photocopy Equipment Co. 291 P 2d 194 (1955)

[550] Ibid at 197

[551] Gautier v Pro-Football Inc. 106 NYS 2d 553 (1951)

[552] Ibid

[553] Restatement (Second) of Torts § 652C, comments a and b, note some states protect the right of publicity through unfair competition laws

[554] Prosser above n.506 at 389 (outlining the creation of the law of privacy doctrine).

gaps left by trespass, nuisance and the intentional infliction of mental distress.[556] Prosser's second interest was the disclosure tort[557] which along with the tort of false light[558] protected interests in reputation.[559] The final interest was the appropriation tort which protected 'not so much a mental as a proprietary one, in the exclusive use of the claimant's name and likeness as aspects of his identity.'

The appropriation invasion was unlike the others and the ambit of the appropriation category was governed by two rules, the first being that the law protects a person's name only as a symbol of his identity and not protect the name itself from being adopted by others.[560] The second is a consequence of the first, in that liability only arises when a defendant pirated the claimant's identity for their own advantage.

Two leading American tort scholars [561] responding to Prosser, believed that public figures could suffer from invasion of privacy, and the law should apply an appropriately sharp distinction between cases involving economic considerations and purely emotional disturbances such as grief, humiliation and loss of dignity. The difficulty is in reconciling a right to privacy with a right to prevent the unauthorised commercial exploitation of essentially economic attributes in personality proved considerable, and led to the development of a separate right of publicity.

The right of privacy in its infancy was seen as a residual category of tort law, covering cases where harm was emotionally based.[562] Prosser believed that when the tort of intentional infliction of mental suffering became fully developed and received general recognition, the great majority of privacy cases would be absorbed into it.[563]

(i) *Common law invasion of privacy*

Using Florida as an example this paper briefly examines two actions available under common law invasion of privacy, to show additional protections that people can utilise to protect privacy. In addition the paper will briefly examine the right of standing for bring an action under common law invasion of privacy.

(ii) False Light Invasion of Privacy[564]

Where a person has been placed by another before the public in a false light then this person is subject to liability under the common law tort of false light invasion of privacy. Both must occur for liability:

1 the false light in which the other was placed would be highly offensive to a reasonable person; and

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[555] A fact noted by E. Bloustein, 'Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser' (1964) NYULRev. 962 and H. Gross, 'The Concept of Privacy,' (1967) 42 NYULRev 34 at 46

[556] Prosser above n.506 at 392

[557] Ibid at 398

[558] Ibid at 400

[559] He presented this with some of the same overtones of mental distress that can be found within defamation

[560] Cited as support by Prosser were; DuBolay v DuBolay (1869) LR 2 PC 430 and Cowley v Cowley [1901] AC 450; note there is no exclusive rights available in a name

[561] Harper and James, The Law of Torts (Boston, 1956), 689-90

[562] G. White, Tort Law in America – An Intellectual History (Oxford, 1980), 174

[563] Ibid citing Prosser's 1955 edition of the Law of Torts

[564] J. Tabach-Bank, 'Missing the right of publicity boat: How Tyne v Time Warner Entertainment Co. threatens to "Sink" the First Amendment.' 24(2) Loy.L.A.Ent.L.Rev. 247 (2004)

2 the actor had knowledge of or acted in reckless disregard[565] as to the falsity of the publicised matter and the false light in which the other would be placed.[566]

A key requirement is that the published matter is false as the purpose of the tort's protection is related to persons appearing before the public in a light that is other than truthful.[567] Additionally the action also requires publicity,[568] for this to exist the publication must be communicated to at least enough persons so that the information becomes general knowledge.[569] Finally the action requires a 'reasonable' person to be seriously offended as a result of a major misrepresentation of character, history, activities or beliefs.[570] This requirement prevents a 'hypersensitive' claimant from protection,[571] and mere inaccuracy in reporting will not support recovery.[572] Defamation is not a requirement of the action, although many false light cases form a basis for defamation actions as well.[573] The main difference between the two is that actions for false light protect a person's right to be left alone whereas defamation actions are intended to protect public reputation.[574]

(iii) Public Disclosure of Private Facts

A second common law tort that falls under the invasion of privacy is public disclosure of private facts. Where a person gives publicity to matters related to the private life of another they are subject to liability for invasion of privacy, if the publicised matter is likely to be highly offensive to a reasonable person, and the matter is not in the public interest.[575] An action for public disclosure of private facts require:[576]

1 disclosure must be public;

2 disclosure must include private facts that are not already exposed to the public eye;

3 disclosure must be highly offensive and objectionable to a reasonable person; and

4 no legitimate public interest in the disclosure.

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[565] Restatement (Second) of Torts § 652C, The American Law Institute that drafted the Restatement of Torts set forth a caveat that it took "no position on whether there are any circumstances under which recovery can be obtained . . . if the actor did not know of or act with reckless disregard as to the falsity of the matter publicized and the false light in which the other would be placed but was negligent in regard to these matters."

[566] Ibid

[567] Ibid at § 652E cmt a.(1977)

[568] Prosser above n.506

[569] Restatement (Second) of Torts § 652E cmt a.(1977)

[570] Ibid at § 652E cmt c.(1977)

[571] Jacova v. S. Radio & Television Co., 83 So. 2d 34 (Fla. 1955) (holding that the claimants privacy had not been violated when he became the innocent subject of a televised gambling crackdown.

[572] Restatement (Second) of Torts § 652E cmt c.(1977)

[573] Ibid at § 652E cmt b.(1977)

[574] Prosser above n.506 at 400

[575] Restatement (Second) of Torts § 652D cmt b.(1977)

[576] Ibid

The hypersensitive individual is treated in the same way as under false light invasion of privacy.[577] However, Florida unlike California has chosen not to adopt the 'fifth prong' requiring malice or reckless disregard in addition to the requisite of the offensiveness of the disclosure.[578]

When first sought the action required written disclosure of the private facts, spoken words would not support a privacy action.[579] This requirement has widened to include disclosure through photographs,[580] television[581] and motion pictures[582] amongst other media. If the facts are true and of public record then under the First Amendment there can be no recovery for the disclosure of such facts,[583] shown in *Cox Broadcasting Corp*. v. *Cohn (1975)*.[584] An unsolved issue is whether a case can be brought where the private facts are highly offensive to a 'reasonable person' but not of legitimate public concern.[585] The public concern test examines whether the matter as a whole is of public concern and not just the individual facts, courts also takes into account whether the individual is a public figure.[586]

(d) Damages

A significant difference between the right of privacy and right of publicity is in damages. Privacy protects less tangible interests, in dignity and integrity of the self,[587] whereas publicity protects monetary and commercial interest.[588] The measure of damages, under privacy,[589] are based upon the mental distress that have resulted from the intrusion into a secluded and private life, free from the prying eyes and ears of the public.[590] Thus an invasion of 'appropriation privacy' focuses on injury to the psyche.[591]

Under an action for invasion of privacy, a claimant can be afforded with injunctive relief,[592] actual or compensatory damages.[593] The damages can, if proven be based upon injuries resulting from the tortious

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[577] Cape Publ'ns, Inc. v. Bridges, 423 So. 2d 426, 427 (Fla. 1982) cert. denied, 464 U.S. 893 (1983) (stating that kidnapping situations are matters of general public interest, and therefore information that is lawfully obtained about a particular case is considered newsworthy).

[578] Diaz v. Oakland Tribune, Inc., 188 Cal. Rptr. 762, 768 (1983).

[579] Warren above n.5

[580] Barber v. Time, Inc., 159 S.W.2d 291, 295 (Mo. 1942).

[581] Taylor v. K.T.V.B., Inc., 525 P.2d 984, 988 (Idaho 1974).

[582] Donahue v. Warner Bros., 272 P.2d 177, 184 (Utah 1954).

[583] Cox Broadcasting Corp. v Cohn 420 U.S. 469 (1975)

[584] Ibid at 496

[585] Ibid at 490-1

[586] D. Zimmerman, 'Requiem for a Heavyweight: A Farewell to Warren and Brandeis's Privacy Tort', 68 Cornell L.Rev. 291, 299-300 (1983); Jacova above n.571 at 36

[587] J. McCarthy, Rights of Publicity and Privacy, 2nd Ed (New York: Clark Boardman Callaghan, 2001)

[588] Ibid

[589] J. Tabach-Bank above n.564

[590] Restatement (Second) of Torts § 652C, cmt. b (1976).

[591] J. McCarthy above n.587

[592] Restatement (Third) of Unfair Competition 48(2) (1995).

The appropriateness and scope of injunctive relief depend upon a comparative

conduct, including impairment of health, mental anguish, loss of friends, loss of respect in the community, and injury to character or reputation.[594] However, where the claimant fails to successfully demonstrate injury nominal or statutory damages can still be awarded to the claimant.[595]

(e) Privacy as principle

Bloustein proposed a general theory of individual privacy which attempted to reconcile the divergent strands of legal development, proposing that privacy needed to be re-established as a single, unified, legal concept.[596] Following a critique of Prosser's analysis, Bloustein argued that a common thread of principle, namely Brandeis' inviolate personality,[597] running through all the cases could be discerned.[598] He argued cases like *Pavesich* involved the claimant's interests preserving their own personal dignity, rather than injuries to their proprietary interests as in Prosser's scheme.[599]

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appraisal of all the factors of the case, including the following primary factors: (a) the nature of the interest to be protected; (b) the nature and extent of the appropriation; (c) the relative adequacy to the claimant of an injunction and of other remedies; (d) the relative harm likely to result to the legitimate interests of the defendant if an injunction is granted and to the legitimate interests of the claimant if an injunction is denied; (e) the interests of third persons and of the public; (f) any unreasonable delay by the claimant in bringing suit or otherwise asserting his or her rights; (g) any related misconduct on the part of the claimant; and (h) the practicality of framing and enforcing the injunction.

[593] Ibid at 49(2)

Whether an award of monetary relief is appropriate and the appropriate method of measuring such relief depend upon a comparative appraisal of all the factors of the case, including the following primary factors: (a) the degree of certainty with which the claimant has established the fact and extent of the pecuniary loss or the actor's pecuniary gain resulting from the appropriation; (b) the nature and extent of the appropriation; (c) the relative adequacy to the claimant of other remedies; (d) the intent of the actor and whether the actor knew or should have known that the conduct was unlawful; (e) any unreasonable delay by the claimant in bringing suit or otherwise asserting his or her rights; and (f) any related misconduct on the part of the claimant.

[594] Cason v Baskin 30 So. 2d 635 (Fla. 1947)

[595] Ibid

[596] Bloustein above n.555

[597] Warren above n.5

[598] Bloustein above n.555 at 1001

[599] Ibid at 986

Bloustein argued that:[600]

> "No man wants to be 'used' by another against his will, and for this reason that the commercial use of a personal photograph is obnoxious. Use of a photograph for trade purposes turns a man into a commodity and makes him serve the economic needs and interests of others. In a community at all sensitive to the commercialisation of human values, it is degrading to thus make a man part of commerce against his will."

He argued that the potential existence of a right of publicity was dependent on the fact that names and likeness could only command a commercial price in a society which recognised a right to privacy, which enabled control over the conditions under which their name or likeness could be used. He also proposed that there was no right of publicity, but 'a right, under circumstances, to command a commercial price for abandoning privacy.'[601]

However the main flaw in this argument is that it glossed over the fact that, in reality, advertisers do not pay famous persons for giving up their privacy, but pay because such persons' images have a 'recognition value'[602] in society.

Gavison, undertook a strong and thoughtful attack on the reductionist approach within academic literature, where he attempted to restore privacy as a unitary legal concept, reflecting extra-legal notions of privacy rather than breaking it down into its separate component interests.[603] He argued that everyday speech reveals that the concept of privacy is coherent and useful in three different, but related contexts:

1 as a neutral concept, which allows us to identify when a loss of privacy has occurred;

2 as a distinctive value, since claims for legal protection of privacy are compelling only if losses of privacy are undesirable for similar reasons; and

3 As a legal concept, that enables us to identify those occasions calling for legal protection.

Gavison expressly rejected the argument that there can be commercial exploitation of personality as an aspect of privacy, by noting that privacy 'can be invaded in ways that have nothing to do with such exploitation,'[604] citing governmental wiretapping as an example of an invasion of privacy with no hint of commercial exploitation.[605]

Despite the increased opportunity that arose due to creation of the right of publicity, any attempt to banish commercial appropriation from privacy altogether is however unrealistic and undesirable. The courts must take into account whether protection exists under the right to privacy despite elements of economic interests forming part of an action, few cases solely deal with purely dignitary or economic interests. Highlighting that looking at the problem purely from a commercial appropriation perspective, or from an exclusively dignitary right of privacy perspective,[606] distorts the true picture, both economic and dignitary interests must be taken into account by the courts.

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[600] Ibid at 988

[601] Ibid at 989, Every man had the right to prevent commercial exploitation of his personality 'not because of its commercial worth, but because it would be demeaning to human dignity to fail to enforce such a right

[602] D'Amato, 'Comment on Professor Posner's Lecture on Privacy' (1978) 12 GaLRev 497 at 499; Lugosi v Universal Pictures Cal. 603 P2d 425 (1979), 438

[603] R. Gavison, above n.220 at 424

[604] Ibid at 440

[605] Ibid

[606] E. Bloustein above n.555

Alternatively, the choice need not be limited to a simple adoption or rejection of the concept of privacy.[607] If the notion of privacy is sufficiently coherent as a social or psychological concept, then a question arises as to whether it can be embodied within a legal system, having due regard to various competing interests. If we define an interest as a claim, demand, need or concern, and a right as a legally protected interest, then the question arises as to whether privacy should be accorded the status of an interest and then a right.[608]

Freund argued that the right of privacy is of cardinal worth as a principle, and that although it is misleading to incorporate a right of privacy into a legal rule, it would be equally undesirable to exclude it as the term of a legal principle.[609] Although legislation and binding precedent are the ultimate sources of law, principles, embodying the persuasive sources, should not be excluded if only for the reason that principles play a considerable part in the solution of a legal problem to which no rule is directly applicable.[610]

Some regional treaties are also used to protect privacy, art.11 of the *American Convention on Human Rights* sets out the right to privacy in terms similar to the Universal Declaration.[611] In 1965, the Organisation of American States ("O.A.S") proclaimed the *American Declaration of the Rights and Duties of Man,* which called for the protection of numerous human rights, including privacy.[612] The Inter-American Court of Human Rights has begun to address privacy issues in its cases. the use of these Declarations is however still limited in comparison to the 'right to privacy' discussed above.

Thus, with varying levels of generality, the essence of the right of privacy has involved into the following:

1 the right to be 'let alone';[613]

2 the protection of human dignity or inviolate personality;[614]

3 a person's control over access to information about himself;[615]

4 a person's limited accessibility to others;[616] and

5 autonomy or control over the intimacies of personal identity.[617]

(f) Conclusion

It is not surprising that such an expansive category as privacy has received so much attention from academic commentators, the law itself has still to develop and encompass all areas that could be seen as

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[607] P. Freund, 'Privacy: One Concept or Many?' in J.R. Pennock and J.W. Chapman (eds.) Nomos XIII Privacy (New York, 1971), 182

[608] Ibid at 194

[609] Ibid at 198, Warren above n.5 at 213 and E. Barendt, 'Privacy and Loyalty, Clarendon (Oxford) 1997 at 12

[610] R. Cross and J.W. Harris, Precedent in English Law, 4th Ed (Oxford, 1991) 215 at 216

[611] Signed November 22, 1969, entered into force July 18, 1978, O.A.S. Treaty Series No. 36, at 1, O.A.S. Off. Rec. OEA/Ser. L/V/II.23 dec rev. 2, available at http://www.oas.org/juridico/english/Treaties/b-32.htm.

[612] O.A.S. Res XXX, adopted by the Ninth Conference of American States, 1948 OEA/Ser/. L./V/I.4 Rev (1965).

[613] Warren above n.5 at 205

[614] E. Bloustein, above n.555 at 1001

[615] C. Fried, 'Privacy' (1968) 77 Yale LJ 475 at 493

[616] R. Gavison above n.220 at 423

[617] T. Gerety, 'Redefining Privacy,' 12 Harv. C.R.C.L. L. REV. 233 (1977) at 236

falling under the umbrella term 'privacy'.[618] The advantage of Prosser's reductionist account lies in the fact that it manages to reduce a potentially vague concept into a number of autonomous torts, held together under a common umbrella title.

The actions for right of privacy are personal rights specific to the person whose privacy has been invaded,[619] therefore there can be no invasion of a personal right post mortem, and relatives of a deceased person can not bring an action for an invasion of the deceased's privacy, which occurred after the death.[620] An action can only be brought if the family member's own rights of privacy were violated,[621] as otherwise they have no standing under common law.[622] An exception to this is permitted where the portrayal of a dead family member is "sufficiently egregious," and not "merely inaccurate or dramatised."[623]

The privacy laws offer a wide range of protections from the traditional intrusion element to protection from being placed in a false light. The main difficult faced under bringing an action in relation to a celebrity is the availability of a defence under the First Amendment, discussed in greater detail below. However, where an action is successfully brought the courts have a wide range of remedies at their disposal such as injunctions, damages for mental distress, injury to reputation and compensatory damages.

2.3 **Publicity**

(a) Introduction

Currently within the US there is no federal law protecting an individual's right of publicity despite increasing pressure. The right of publicity varies from state to state but under either common law or statutory law almost every state protects certain individuals from the unauthorised exploitation of their identity. McCarthy believes, "the right of publicity is not just another kind of privacy right, it is a wholly different and separate legal right."[624] Despite McCarthy's belief the emergence of the right of publicity from the privacy right is similar to what Phillips was hinting was being to occur in the UK in Hello! The emergence of a separate right of publicity from a right based in privacy was because unlike the right of privacy the right of publicity is conceptually regarded as a property right, which is transferable and is potentially inheritable.

Right of publicity cases prevent "unjust enrichment by providing remedies against exploitation of goodwill and reputation that a person develops in their persona through the investment of time, effort, and money."[625] Weller believes that rights of publicity cases require 'celebrity' claimants, as "there is little pecuniary gain in

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[618] R. Bezanson above n.194 at 1166

[619] R. Kwall, 'Is Independence Day Dawning for the Right of Publicity?, 17 U.C. DAVIs L. REV. 191, 207-28 (1983) at 208

[620] Loft v Fuller, 408 So. 2d at 621

[621] If this is the case they may have standing under the doctrine of relational right of privacy; Fla. SupCt Asked to Interpret Commercial Misappropriation Statute, 31 Media Law Reporter 28, (July 22, 2003), at http://ipcenter.bna.com/pic2/ip.nsf/id/BNAP-5PPL8T

[622] Santiesteban v. Goodyear Tire & Rubber Co., 306 F.2d 9, 12 (5th Cir. 1962);

[623] Fla. SupCt Asked to Interpret Commercial Misappropriation Statute, 31 Media Law

Reporter 28, (July 22, 2003)

[624] J. McCarthy, The Human Persona as commercial property, 19 Collum-VLA J.L. & Arts (1995) 129

[625] Bi-Rite Enter., Inc. v. Button Master, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983); see F. Dougherty, Foreword: The Right of Publicity-Towards a Comparative and International Perspective, 18 LOY. L.A. ENT. L. REv. 421, 440-46 (1998)

appropriating the name and likeness of an unknown individual."[626] In reality there have been hundreds of right of publicity cases involving non-celebrities.[627]

Most jurisdictions require no 'celebrity status' in order to bring an action under the tort.[628] The focus of the tort should not be on the individual's celebrity, but rather on the interest that the action protects by preventing the unauthorised use of that identity. In practice the 'celebrity status' is more relevant when examining the commercial damages.[629] The proposal for a federal right of publicity statue from the American Bar Association's ("ABA") Intellectual Property Law Section's believes that the right of publicity should apply to both celebrity and non-celebrity alike regardless of the commercial value of their identity.[630]

The right of publicity was still in its embryonic stage when Prosser and Bloustein proposed rival conceptions of the right to privacy. In differing ways they both under-estimated the problems in reconciling a right of personal privacy with commercial exploitation of personality,[631] and the increasing momentum towards recognising the right of publicity as separate legal category.[632]

Bloustein refused to acknowledge the existence of economic interests in personality which might be the subject of a separate claim, as he viewed appropriation of personality exclusively as injury to human dignity. Prosser accepted the existence of economic interests preferring to view the appropriation type of privacy as encompassing both economic and dignitary interests.

Without doubt a significant problem facing the right to privacy was the reconciliation of a public figure status with a claim for right to privacy. Although touched upon in *Pavesich*, the difficulties that have arisen are more substantial than the Georgian Supreme Court envisaged. The result in cases involving well known claimant's claiming invasion of privacy by unauthorised use of their image, was that courts often refused to accept that the claimant suffered any indignity, which could form the basis of an award of damages, especially when the celebrity had shown a willingness to license to others the use of their image.

In order to establish whether liability arises the courts examine whether the claimant's persona is used for the purposes of trade, such as in advertising or merchandising.[633] The seller's interests in attracting attention

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[626] F. Weiler, The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity, 13 Cardozo Arts & Ent. L.J. 223, 224 (1994)

[627] I. Schiffres, Annotation, Invasion of Privacy by Use of Claimant's Name or Likeness in Advertising, 23 A.L.R. 3d 865 (1999)

[628] J. McCarthy above n.624

[629] RESTATEMENT (THIRD) OF UNFAIR COMPETITION 46 cmt. b (1995) ("[c]elebrities are not precluded from establishing recognizable injury to personal interests in addition to commercial loss, nor are less well-known claimants precluded from establishing commercial loss in addition to injury to personal interests ....")

[630] See Proposed Right of Publicity Act, 2000 A.B.A. SEC. OF INTELL. PROP. L. Comm.

201, Subcomm. C.8, available at http://www.abanet.org/intelprop/coursematerials/committee-201 - report.doc. The Section's proposed statute is in draft form and has not been formally proposed or adopted by the ABA.

[631] H. Beverley-Smith above n.91 at pg 172

[632] J. McCarthy above n.624; see O. Goodenough, 'The Price of Fame: The Development of the Right of Publicity in the United States,' [1992] EIPR 55

[633] California Civil Code section 3344; White v Samsung Electronics America Inc. 971 F 2d 1395 (9th Cir 1992) at 1401; New York Civil Rights Law section 51; Messenger v Gruner & Jahr Printing and Pub. 208 F 3d 122 (2nd Cir 2000)

to his wares do not outweigh the personal and economic interests protected by the right of publicity.[634] Commercial appropriations of personality often falsely and misleadingly suggest a celebrity endorsement.[635]

(b) Birth of the right of publicity

The New York state legislature led the way for the birth of a right to publicity with the enactment of *New York Civil Right Law 1903* s.50 and s.51. Which prohibit the use of the name, portrait, or picture of any living person without prior consent for advertising purposes or for the purposes of trade.

A further development came after decisions in *O'Brien v Pabst Sales Co. (1941)*[636] inter alia. In *O'Brien* the claimant was a well known professional footballer, who sued the Pabst beer company for using his photograph on its advertising calendar, claiming that this had invaded his right to privacy. O'Brien was particularly aggrieved as he was an active member in a temperance organisation and had refused previous offers to endorse beer. The Court held, by a majority, that since the claimant was one of the best-known and most publicised football players he was not a private person and had effectively surrendered his right to privacy; the publicity he received was only that which he was constantly seeking and receiving.[637]

Holmes J, dissented, arguing that the claimant was entitled to precisely such a claim, for the defendant's infringement of his property right to use his name and picture for commercial products.[638] A view based on an awareness and acknowledgement that commercial advertisers customarily paid for the right to use the name and likeness of a famous person. This was true in the case, as O'Brien had rejected a previous offer from a New York beer company to endorse its product.[639] Holmes J further argued that the majority decision left the claimant and others without a remedy in a case where a non-libellous use was made of his image, but which was contrary to usage and custom among advertisers who were 'undoubtedly in the habit of buying the right to use one's name or picture to create demand and goodwill for their merchandise.'[640] Accordingly, in the absence of an action for invasion of privacy, Holmes J believed the defendant committed a tort of misappropriating the claimant's valuable property right, entitling the claimant to damages or restitution.[641]

The first significant right to publicity case, was *Haelen Laboratories Inc. v Topps Chewing Gum Inc. (1953).*[642] The parties were rival manufacturers of chewing-gum, and the claimant's company entered into contracts with baseball stars for the exclusive right to use their images in connection with its products. With knowledge of these contracts the defendant deliberately induced the players to enter into contracts authorising the defendant to use their image in connection with their chewing gum. The defendant argued that even if such facts were proved, they disclosed no actionable wrong since the contracts with the baseball players were merely waivers of the players' right to sue in tort for invasion of privacy. The right of privacy, in this case deriving from the New York Statute, was a personal and non-assignable right.

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[634] Restatement, Third, above n.676 at s. 47(a)

[635] Rogers v Grimaldi, 875 F 2d 994 (2nd Cir. 1989)

[636] O'Brien above n.298; Paramount Pictures Inc. v Leader Press Inc., 24 F Supp. 1004 (1938); above n.594

[637] O'Brien ibid at 170

[638] Ibid at 167

[639] Ibid at 167, $400 offer

[640] Ibid

[641] Ibid

[642] Haelan Laboratories Inc. v Topps Chewing Gum Inc. 202 F 2d 866 (2nd Cir 1953)

In *Haelan*, Frank J. coined the phrase "right of publicity,"[643] reasoning that prominent persons, "far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorising advertisements, popularising their countenances, displayed in newspapers, magazines, busses, trains and subways."[644] Post *Haelen*, under the right of publicity, anyone who appropriated the commercial value attached to an individual's identify for purposes of trade was subject to liability. Judge Frank by designating this new tort progressed toward breaking the "logjam of confusion"[645] regarding the similar and often confusing privacy torts.[646]

The court found that independently to the right to privacy, people had 'a right in the publicity value of his photograph i.e. the right to grant the exclusive privilege of publishing his picture.'[647] Frank J acknowledged that many prominent people suffer no injury to feelings from having their name or likeness exploited without consent, but, rather, feel deprived from not receiving compensation for such exploitation. In *Haelan,* the court was unwilling to work within the restrictive confines of the right to privacy, realising its inadequacy to deal with problems of commercial appropriation, and developed a new head of liability to allow the law to respond to changing commercial circumstances.

Initially, most states were reluctant to accept the new right of publicity,[648] despite support from influential academics particularly Professor Nimmer,[649] who highlighted deficiencies to the right to privacy and advocated increased recognition of the right of publicity.[650]

(c) **Growth and Recognition of the right of publicity**

(i) The growth of the right of publicity

The law's development was due to case law rather than academic pressure unlike the right to privacy. The case of *Hogan v A.S. Barnes & Co Inc. (1957)*[651] highlights the reluctance of the courts however. In *Hogan* the claimant was a golf professional who claimed under five headings, including infringement of the right of publicity. The Court adopted the viewpoint that the right of publicity, recognised in *Haelan,* was a way of applying the unfair competition doctrine under another label rather than a separate cause of action, with the 'right of publicity' was as apt a label as any.[652]

Despite this initial reluctance by the courts to adopt the right of publicity as a new basis of liability in favour of utilising existing causes of action, they gradually acknowledged the legitimacy of the right to privacy and

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[643] Ibid per Frank. J.

[644] Ibid

[645] J. McCarthy above n.587

[646] J. Tabach-Bank above n.564

[647] Haelan above n.642 at 868

[648] Strickler v National Broadcasting Co. 167 F Supp. 68 (SD Cal. 1958), at 70, where the court stated that it did not wish to 'blaze a trail' to establish a right of publicity as a cause of action in California; H. Berkman, 'The Right of Publicity – Protection for Public Figures and Celebrities' (1976) 42 Brook L Rev 527 at 534

[649] M. Nimmer, 'The Right of Publicity' (1954) 19 Law ContProbl 203

[650] W. Van Carnegem, 'Different Approaches to the Protection of Celebrities against Unauthorised use of their image in Australia, the United States and the Federal Republic of Germany', (1990) 12 EIPR 452 at 455

[651] Hogan v A.S. Barnes & Co Inc. 114 USPQ 314 (Pa. Comm. Pl. 1957)

[652] Ibid at 320

right of publicity as separate claims.[653] This resulted in the right of publicity being a distinctly independent tort and not an application of the misappropriation doctrine[654] as previously occurred.

McCarthy argues that although misappropriation may have produced a basis for the right of publicity in early cases, the right of publicity should not be viewed merely as an application of the misappropriation doctrine since it 'has developed and matured over time into a distinct intellectual property right more defined and precise than the amorphous misappropriation doctrine.'[655]

There are significant variances between the statutory and common law provisions available within the different states.[656] Despite the apparent autonomous nature in relation to the right to publicity, there are still precedents from privacy cases which the courts continue to adopt in order to determine the scope and limits of the publicity right. The links between the two rights have yet to be fully severed, particularly in states where the right of publicity is still in its infancy.[657]

(ii) The recognition of the right of publicity

The canonisation of the right of publicity was in the Supreme Court case of *Zacchini v Scripps-Howard Broadcasting Co. (1977)*[658] where the court ruled the reporting of a fifteen second performance was not protected under the First Amendment. The crucial element of the verdict was the distinction drawn between invasion of privacy and infringement of a right of publicity.[659]

In *Zacchini* the court stated that "petitioner's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in the act; the protection provided an economic incentive for him to make the investment required to produce a performance of interest to the public."[660] The court felt although the interest protected through a cause of action for a false light invasion of privacy was an interest in reputation, with overtones of mental distress, the core rational with the right of publicity lay in 'protecting the proprietary interest of the individual in his in part to encourage such entertainment.'[661]

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[653] H. Berkman, above n.648 at 537, though some courts continued to base claims for invasion of economic interests on invasion of privacy rather than right of publicity or misappropriation e.g. Palmer v Schonhorn Enterprises Inc. 232 A 2d 458 (1967)

[654] Ibid Berkman, at 534 - 541

[655] J. McCarthy above n.587 at 5.6 [B] [1]

[656] Suggestions have been made for a federal law: see M. Hamilton, et al., 'Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress' (1998) 16 Cardozo Arts & Ent LJ 209; E. Goodman, 'A National Identity Crisis: The Need For a Federal Right of Publicity Statute' (1999) 9 DePaul-LCA J Art & Ent L 227; R. Robinson, 'Preemption, The Right of Publicity, and a New Federal Statute' (1998) 16 Cardozo Arts & Ent LJ 183

[657] Allison v Vintage Sport Plaques, 136 F 3d 1443 (11th Cir. 1998), at 1447: 'Alabama's commercial appropriation privacy right…represent[s] the same interest and address[es] the same harms as does the right of publicity as customarily defined.'

[658] Zacchini v Scripps-Howard Broadcasting Co. 433 US 562 (1977)

[659] Ibid at 572

[660] Ibid

[661] Ibid at 573

The law's aims were considered equivalent to the goals of patent and copyright law,[662] focusing on the right of the individual to reap the reward for his endeavours,[663] and not based on feelings or reputation.[664] The court approved Kalven's[665] rationale for the appropriation branch of privacy,[666] preventing unjust enrichment by the theft of goodwill. Kalven argued there could be no social value served by allowing defendants to get for free something with a market value which he would usually pay for.[667]

Cases involving neither the name or image of a famous individual still fell under the right to publicity. The *Carson* case[668] involved the use of his well known introduction of "Here's Johnny" on the Tonight Show. The *Motschenbacher* case[669] related to a race car that was clearly identifiable as that of the claimant, even though in neither case was there a suggestion of a celebrity endorsement. The courts found that both companies infringed the claimant's right to publicity as they were infringing the unequivocal public association with the phrase or car and the celebrity.

The right of publicity was extended through a series of "impersonator" cases, notably those of *Midler*,[670] *Waits*[671] and *White*.[672] *Midler* and *Waits* involved similar facts in that both Bette Middler and Tom Waits did not wish to lend their recognisable voices to advertisement from two well known manufacturers. As the celebrities would not participate in the advertisements the companies employed performers to mimic their voices. The courts found in the claimants favour under the right of publicity and awarded damages of $400,000 for Midler and $2.5m for Waits four years later. Another impersonator case featured a robot designed to mimic Vanna White, who had been made famous by the television show Wheel of Fortune. The robot, during the advert, was dressed in similar attire to Ms White and turned the letters like Ms White in the show. The court decided that despite the fact that there was no likelihood of confusion of thinking the robot was Ms White, it infringed her right of publicity and awarded $430,000.

(d) Requirements for the right of publicity

Liability arises when the defendant has appropriated the commercial value of a person's identity by using, without consent, the person's name, likeness or other indications of identity for purposes of trade.[673] Liability is strictly based on misappropriation rather than misrepresentation, therefore no need for proof of deception

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[662] C. Fernandez, 'The Right of Publicity' Marquette Sports Law Journal (1998), 8, 2, argued that the right to publicity could not be justified by purely economic rationale.

[663] M. Madow above n.343 at 182

[664] Zacchini, above n.658 at 573

[665] Ibid at 574

[666] H. Kalven, 'Privacy in Tort Law: Were Warren and Brandeis Wrong?' (1966) 31 ContProbl 326 at 331

[667] Zacchini, above n.658 at 574

[668] Carson v Here's Johnny Portable Toilets, 698 F.2d 831 (6th Cir. 1983)

[669] Motschenbacher v R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974)

[670] Midler v Ford Motor Co., 849 F.2d 460 (9th Cir. 1988)

[671] Waits v Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992)

[672] White above n.633

[673] Restatement, Third, Unfair Competition (1995) s. 46

or consumer confusion.[674] The protected interest is not, as in passing off in the UK, trading or promotional goodwill but rather the intangible value attached to the person's identity.[675]

Despite dicta to the contrary,[676] prior commercial exploitation or use of identity by the claimants is not a prerequisite. Therefore claimants who have not yet 'exploited' their image[677] or who have not contemplated exploiting their image,[678] are not precluded from claiming an infringement of his right of publicity. The courts have extended this through their statement that the 'appropriation of the identity of an unknown person may result in economic injury or may itself create economic value in what was previously valueless.'[679]

For a successful cause of action any unauthorised appropriation must be sufficient to identify the claimant, otherwise the claimant's identity has not been misappropriated, nor his interest violated.[680] This illustrates a difference between publicity rights and that of registered and unregistered trade marks, as under the law of trade marks there may be liability despite no likelihood of confusion as to source or connection by way of endorsement or sponsorship.[681]

The Restatement states that, 'the name as used by the defendant must be understood by the audience as referring to the claimant,' while in relation to visual likenesses, 'the claimant must be reasonably identifiable from the photograph or other depiction.'[682] McCarthy proposed a variation of the test applied in defamation and privacy cases,[683] namely the statement was published 'of and concerning' the claimant and they are identifiable by the defendant's use to more than a *de minimis* number of persons.[684]

A person's identity may be appropriated in varying ways[685] most commonly personal name,[686] nickname[687] or likeness, use of other indicia of identity such as claimant's voice[688] or distinctive catch-phrase[689] all may

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[674] Rogers above n.635 at 1003 and 1004; D. Bedingfield, 'Privacy or publicity? The enduring confusion surrounding the American tort of privacy', (1992) 55 Modern Law Review 108 at 109

[675] S. Boyd, 'Does English Law recognise the concept of an image or personality right?', (2002) 13(1) Entertainment Law Review 1 at pg 2 for a comparison of protection in the United Kingdom and United States

[676] Lerman v Chuckleberry Publishing Inc. 521 F Supp. 228 (SDNY 1981), at 232

[677] Palmer, above n.653 at 462

[678] Grant v Esquire Inc. 367 F Supp 876 (SDNY 1973)

[679] Motschenbacher above n.669 at 824

[680] Ibid at 826-827; Waits above n.671

[681] Elvis Presley Enterprises Inc. v Capece, 950 F Supp. 783 (S.D.Tex. 1996) at 801; Henley v Dillard Dept Stores, 46 F Supp 2d 587 (N.D.Tex. 1999) at 590

[682] Restatement, Third, Unfair Competition at s.46(d); see also W. Borchard, 'The common law right of publicity is going wrong in the United States: Waits v Frito-Lay and White v Samsung Electronics,' Ent L.R. 1992, 3(6), 208

[683] Restatement, Second, Torts (1977) 564

[684] J. McCarthy above n.587 at 3.7, cited with approval in Henley, above n.681 at 595

[685] Carson above n.668 at 835 and 836

[686] Abdul-Jabbar v General Motors Corp. 85 F 3d 407 (9th Cir 1996), including former names

[687] Hirsch v S.C. Johnson & Sons Inc. NW 2d 129 (1979) at 137

[688] Waits above n.671

[689] Carson above n.668

give rise to liability. Protection is also extended to cover more vague indicia of identity which might combine to identify the claimant, such as a distinctive style of dress, hairstyle and pose.[690] Intent to infringe another's right of publicity is not a requirement of liability at common law and a mistake relating to the claimant's consent is not a valid defence.[691] Goodenough[692] and Kahn[693] both argued that it is human self-determination in aspects of personal identity that supports personality rights.

(e) Defence under the First Amendment

As with rights of privacy a defence is available is under the First Amendment of the *US Constitution*.[694] As newsworthy and political speech, in addition to speech in the guise of entertainment enjoy protection under the First Amendment, freedom of speech continues to be a defence against a right of publicity action.[695] The courts try to balance the rights under the right to publicity with that of societal interests held within the freedom of expression.[696] In general a person is able to use the name, image, likeness or other characteristics in order to convey newsworthy events and matters of public interest but not for commercial use.[697]

In order for an individual's identity to be used in connection with a 'news' story or 'public interest' story without their permission the story requires a reasonable relationship between the person and the story. In order to succeed with an action the individual must demonstrate that their identity was used merely as a vehicle to attract attention to the story and not as part of the story as a whole. In addition an individual can not bring an action for right of publicity concerning an unauthorised biography as the First Amendment protects discussion and legitimate commentary of public person's lives. The exception is where the audience is lead to believe that the work is fact when in fact it is fiction.

The film and publishing industries are largely designed around entertainment principle and thus are afforded wide immunity for right of publicity liability. As shown in *Rogers* v *Grimaldi (1989)*[698] the court allowed Fellini to use Ginger Rogers' first name in the title of his film, Ginger and Fred. The court drew an analogy between film and music titles and held that the use for this purpose was covered under the First Amendment. As the Amendment will provide a complete defence as long as the film is not an "advertisement in disguise."[699]

In *Hoffman v Capital Cities/ABC Inc. (2001)*[700] Dustin Hoffman initially successfully sued Los Angeles Magazine after it used a picture of him in character from the film Tootsie. The magazine successfully

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[690] White above n.633

[691] Douglass v Hustler Magazine Inc. 769 F 2d 1128 (7th Cir 1985) at 1140

[692] O. Goodenough above n.632 at 45

[693] J. Kahn, 'Bringing dignity back to light: Publicity Rights and the eclipse of the tort of appropriation of identity', Cardozo Arts and Entertainment Journal, [1999] 17, 213 at 339

[694] See First Amendment, Right of Publicity, Missouri Supreme Court Creates Predominant Purpose Test for First Amendment Defenses to Publicity Right Claims, Doe v. TCI Cablevision [cases], 117 Harv. L. Rev 1275 (2003-4)

[695] T. Jackson, 'How Far Is Too Far? The Extension of the Right of Publicity to a Form of Intellectual Property' Comparable to Trademark/Copyright, 6 Tul. J. Tech. & Intell. Prop. (2004)181

[696] J. Tabach-Bank above n.564

[697] L. Guttenplan Grant, 'Restricted Images: Who Owns Einstein? The Emerging Right of Publicity and the Conversion of Public Images to Private Properly', C479 ALI- ABA 669, 671 (1990).

[698] Rogers above n.635

[699] Ibid

[700] Hoffman v Capital Cities/ABC Inc. 255 F.3d 1180, 1183 (9th Cir. 2001)

appealed the trial court's ruling claiming that the use of the picture was in fact non-commercial speech and as such protected under the First Amendment.

The case of *Comedy III Productions Inc. v. Gary Saderup, Inc. (2001)*[701] examined the First Amendment and the right of publicity arguments in relation to whether the newsworthiness defence has a timeliness component. The defendant was an artist who using his charcoal depiction of the Three Stooges sold the artwork on lithographs and T-shirts. He argued that as the Three Stooges had once made headlines that his merchandise was 'newsworthy'. The Judge ruled for the claimant and created a new balancing test to determine whether the First Amendment would be set aside by the right of publicity. This occurs when the celebrity was the subject of a work of art which is not an original single work of art. A celebrity's publicity rights are outweighed by the artist's right to commercially produce his art only where it is "sufficiently transformative."

The publicity right does not allow a right to control the celebrity's image by censoring disagreeable portrayals; once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody,[702] lampoon and make other expressive uses of the celebrity image must be given broad scope.[703] It is not a technique for persons to use in order to choose what enters the public limelight but rather a legal option available to ensure that unauthorised appropriation can not occur to their economic detriment.[704]

(f) Descendibility

A fundamental issue was the definition of duration and descendibility of a right of publicity.[705] While privacy rights are personal right which die with the claimant, the right of publicity is a property right. There are considerable variations between statutory and common law provisions in the different states,[706] e.g. at common law, the descendibility of the right of publicity has been recognised in Georgia,[707] New Jersey[708] and in Tennessee.[709] Under statute, the right of publicity is descendible in California,[710] but in New York whatever rights of publicity exist are found in the privacy framework of section 50 of the *Civil Rights Law*[711]

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[701] Comedy III Productions Inc. v Gary Saderup Inc. Supreme Court of California (Apr. 30th 2001) 2001 Cal LEXIS 2609

[702] J. Brown, 'Defending the Right of Publicity: A Natural Rights Perspective', 10 Intell. Prop. L. Bull. 131 (2005-2006)

[703] Comedy III above n.701 at 139

[704] H. Carty above n.288

[705] T. Terrell, and J. Smith, 'Publicity, Liberty and Intellectual Property: A Conceptual and Economic Analysis of the Inheritability Issue' (1985) 34 Emory LJ at 1; P. Fletcher, and E. Rubin, 'The Descendibility of the Right of Publicity: Is There Commercial Life After Death?' (1980) 89 Yale LJ 1125

[706] J. McCarthy above n.587 at Ch 6 (especially 6.8)

[707] Martin Luther King Jr Center for Social Change Inc. v American Heritage Products, 296 SE 2d 697 (Ga. 1982) at 704 to 706

[708] Estate of Presley v Russen, 513 F Supp 1339 (1981)

[709] The State of Tennessee, Ex Rel. The Elvis Presley International Memorial Foundation v Crowell, 733 SW 2d 89 (Ten.App 1987)

[710] California Civil Code section 3344 and 3344.1 (The Astaire Celebrity Image Protection Act)

[711] Constanza v Seinfield, 719 NYS 2d 29 (NYAD 1 Dept 2000) at 30; Stephano v News Group Publications, 485 NYS 2d 220 (Ct,App 1984) at 224

with rights terminating at death.[712] Although many jurisdictions have yet to consider the descendibility issue,[713] most jurisdictions which have done so have recognised that the right is descendible[714] with post mortem duration of between 10[715] and 100 years.[716] Washington[717] however differentiates the time period for protection of individuals and personalities. The celebrity is granted protection for 75 years post mortem whereas an individual is protected for 10 years, although the protections covered for both encompasses names, voices, signatures, photographs and likeness.

Although canonisation began in *Zacchini*, publicity rights for living personalities had begun to be established in California in 1972 through the *Civil Code* s.3344. In 1985 California enacted s.990, establishing the right to pass the publicity right to a successor in order to prevent unauthorised use of the deceased's name and likeness within a 50 year period. In 1999 the California legislature amended s.990 and incorporated it into s.3344, when the post mortem duration was extended to 70 years to be consistent with the copyright protection afforded under the *Sonny Bono Copyright Term Extension Act 1998.*

Numerous states have protection exemptions limiting the available rights post mortem to avoid clashes with the First Amendment, some states protect names and pictures, whilst others offer wider 'persona' protection.

(g) Damages

Once unauthorised commercial appropriation is established the defendant can be liable for either the claimant's pecuniary loss or their own pecuniary gain, although *Comedy III Productions*[718] according to a Professor Barnett[719] may have "quietly rubbed out" the commercial purpose requirement in relation to merchandising. The court did not require the image to be used in advertising or "on or in products" as required by the Californian code, because the court characterised the lithographs themselves as the products. Barnett argued that this would mean that the sale of photographs would be enjoined by the right of publicity, rather than the right only covering images once applied to objects or used in advertising. As in unfair competition, the claimant may establish either or both measures of relief, but may only recover the greater of the two amounts[720] to prevent double recovery.[721]

Proof of monetary loss is not a prerequisite to recovery of damages, and although the claimant may be compensated purely for the deprivation of his right to control the use of the commercially valuable asset of his name or likeness, in the absence of specific loss such damages will be nominal.[722] As there can be difficulty in proving loss to the claimant, or gain to the defendant resulting from the unauthorised

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[712] Pirone v MacMillan Inc. 894 F 2d 579 (2nd Cir 1990); see S. McEvoy, 'Pirone v MacMillan Inc.: Trying to Protect the Name and Likeness of a Deceased Celebrity Under Trade Mark Law and the Right of Publicity' (1997) 19 Comm & L 51

[713] R. Badin, 'USA & Germany: publicity protection – recent developments', (2000) 11(4) Ent L.R N43

[714] Restatement, Third, Unfair Competition at s. 46(h)

[715] Tennessee Code section 47-25-1104 (Personal Rights Protection Act 1984)

[716] Indiana Code section 32-13-1-8

[717] Wash. Rev. Code § 63.60.010 *et seq.*

[718] Comedy III above n.701

[719] Professor Barnett of University of California (Berkeley) as quoted by T. Catanzariti, 'Swimmers, Surfers and Sue Smith – Personality rights in Australia,' Ent L.R. 2002, 13(7), 135

[720] Restatement above n.714 at section 49(d)

[721] Professor Barnett above n.719

[722] Zim v Western Publishing Co. 573 F 2d 1318 (1978) (5th Cir CA) at 1327

appropriation, the courts can apply a 'fair market value' for a lost licence fee as damages, though this is rarely mathematically exact.[723] This applies to both celebrities and private persons whose damages are measured by the fee that the defendant would need to pay an alternative person for a similar service.[724] This measure however may not deprive the defendant of the full extent of their gain, though the courts have flexibility in determining a fair market value, to avoid unjust enrichment and to provide adequate deterrence.[725] Full restitutionary relief is available in the form of account of the defendant's profits,[726] or punitive damages when appropriate.[727] As shown before the level of damages within the US is considerably higher than the levels awarded under passing off in the UK.[728] This is exemplified in a comparison with the damages awarded in Hello! to OK! magazine of £1,033,156 despite OK! having initially paying out a £1m for the rights to the photographs. The availability of punitive damages, unlike the UK, offers the courts a significant deterrent against flagrant breaches of the right.

(h) Conclusion

The right to publicity has significantly developed from its origins in the right of privacy, based on the principle of inviolate personality. From an early point in its history, the appropriation branch of privacy had developed distinctly proprietary attributes, before developing into an autonomous right of publicity, taking the form of a property right more akin to intellectual property rights such as copyright, patents and trade marks, than a right of personality.[729] However, there are difficulties in aligning the right of publicity with well-established core areas of intellectual property, and the justifications which underpin the latter apply uneasily to the right of publicity or a *sui generis* tort of appropriation of personality.[730]

Professor McCarthy believes the right of publicity is borne from common sense and the notion that "my identity is mine, and it is my property to control as I see fit."[731] The right of publicity is a limited right enabling control of commercial use of an individual's persona.[732] The aims of the right are clearly diverse to the aims of the right to privacy as the right to publicity was a freely assignable right of property, rather than a personal right.[733] When the right is assigned, the assignee has a direct cause of action against a third party infringer, rather than a mere release of liability for the invasion of the subject's privacy.[734] However, an assignment or

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[723] An example could be shown with the O'Brien case where he was offered $400 to promote a similar alternative product; above n.298 at section 49(d); Cher v Forum Intern Ltd, 692 F 2d 634 (CA Cal 1982); Zim at ibid at 1327

[724] Restatement above n.714 at section 49(d); Canessa v J.L. Kislak Inc. 97 N.J. Suoer 327, 235 A 2d 62 (1967)

[725] Restatement above n.714 at section 49(d)

[726] Ibid at section 49(d); see also Bi-Rite above n.625

[727] Waits above n.671

[728] Irvine received £25,000 compared to US cases in the 1980's and 1990's awarding Midler $400,000, White $430,000 and Waits $2.5m

[729] J. Brown above n.702

[730] H. Beverley-Smith above n.91 at Ch 9

[731] J. McCarthy above n.587 at 3

[732] Ibid

[733] Haelan above n.642

[734] M. Armstrong, 'The Reification of Celebrity: persona as Property' (1991) 51 Louisiana L.R, 443 at 444

licence of the right of publicity only transfers the right to exploit the commercial value of the assignor's image, and does not transfer any rights of privacy.[735]

The initial law and cases involved with the appropriation of privacy were criticised for inadequately distinguishing between dignitary aspects such as mental distress, humiliation and damage to personal dignity, and the economic interests of celebrities.[736] Although, its too simplistic to draw a sharp distinction between damage to purely economic interests suffered by celebrities and purely dignitary interests suffered by others. Consequently the development of the right of publicity ended to the incongruity of a celebrity claiming invasion of a right of privacy for this harm. Although dignitary and economic interests do not fall neatly under separate causes of action for invasion of privacy and infringement of the right of publicity.[737] Sen warned that increased protection or development towards an "increasing privatisation of the celebrity," would stifle cultural debate and lead to a decline in the exchange of ideas and be to the detriment of society.[738]

McCarthy proposed that the law would be more coherent if the courts recognised a *sui generis* legal right with damages measured by both mental distress and commercial loss. With separately entitled categories the law would be simpler than the existing structure of 'separate' rights of privacy by appropriation and a right of publicity.[739] The successful formulation of such a *sui generis* action in legal systems which do not follow the American model is dependent on two factors.

1 the problem of appropriation of personality must be severed from the discussion of the desirability of introducing a general right of privacy; and

2 it needs to be considered whether there are any convincing underlying justifications for such a new remedy for appropriation of personality, such a new remedy must be based on existing authorities, or logical extension of the authorities.

There has been a debate amongst academics over the extent of the publicity rights that are available within certain states.[740] This debate increased in the aftermath of *White* where the California court found, logically, that there was no likelihood of confusion on the public's behalf but still awarded Ms White a decision based upon the right of publicity. In effect the decision has expanded the scope of the right to not only encompassing her name and likeness but grants protection for any representation that evokes her identity to the viewer.

The right has moved away from its initial roots stemming from the right of privacy to the most significant and widest right of its type within any of the countries examined. The question remains that the states continue to adopt a differing scope to their rights, in relation both to the acts protected the remedies available and the availability of post mortem protection. This has been discussed and been found to be inappropriate by a number of leading academics,[741] however due to the reluctance to adopt a Federal statute it is a situation that will continue for the forthcoming future.

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[735] Bi-Rite above n.625 at 1199

[736] Krouse v Chrysler Canada Ltd (1972) 25 DLR (3d) 49 at 68

[737] H. Beverley-Smith above n.91 at pg 189

[738] S. Sen, 'Fluency of the Flesh: Perils of an expanding right of publicity', (1995) 59 Albany L.R. 739 at 742-743

[739] J. McCarthy above n.587 at 1.39

[740] Ibid; A. Adrian, 'What a lovely bunch of Coconuts! A comparison between Louisiana and the United Kingdom with regards to the appropriation of personality,' Ent L.R. 2004, 15(7), 212

[741] H. Beverley-Smith above n.91

Finally, but perhaps most important, the philosophy that every person should have autonomy over what they endorse, be it an idea, a political candidate or a product, provides a compelling policy reason behind the support for the right of publicity. The opportunities to benefit from celebrity endorsement have exploded in the past few decades, enough to ensure that the law must keep pace with issues in the modern age. The alternative side of this endorsement policy is the important right of a celebrity to be able to choose, as some do, not to exploit his or her identity in commercial ventures. Jack Nicholson, among others, for example has sued to preserve that "non-exploitation" right. The right of publicity helps make this choice lawfully respected, however neither the right to privacy nor the right of publicity are still fully developed in some states notably Louisiana.[742]

2.4 **Additional protection under the Lanham Act**

In addition to the rights of privacy and right to publicity discussed above there are other protections available within the US, for example the *Lanham Act* and its protections for Trade Marks, false advertising and Federal protection for Copyright. *The Lanham (Trademark) Act 1946* (*"Lanham Act!")* took effect on 5 July 1947[743] and is a Federal piece of legislation containing the statutes related to trademark law within the US, prohibiting activities such as trademark infringement, trademark dilution and false advertisement.

(a) Trademarks

Trademarks[744] are protected under the *Federal Lanham Act* and through individual states statutory and/or common law. Trademarks registered under the *Lanham Act* are granted nationwide protection.[745] The definition of trademarks is very similar to the UK and are usually distinctive symbols, pictures, or words used by sellers in order to enable their products to be distinguished and identified. US trademark status can be granted to unique and/or distinctive colour combinations, building designs, product styles, and overall presentations. An extension of this is the availability of trademark status even where initially there is no distinctive or unique element.[746] This protection is granted when a secondary meaning there has developed over a period of time. The granting of such a trademark[747] enables an exclusive right to use or assign the right to use the trademark.[748] In order for the mark to be effective under the Federal protection it must be registered with the Patent and Trademark Office, although the mark can be for either current or for future use. Under some state's common law, trademarks are granted protection as part of the law of unfair competition,[749] no registration is required. Addition protections for trademarks are also provided through the Tariff Act of 1930.[750]

(b) False Advertising

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[742] A. Adrian, above n.740

[743] D. Phelps, 'Certification Marks under the Lanham Act, Journal of Marketing' (1949) 13(4): 498

[744] M. Lemley, 'The Modern Lanham Act and the Death of Common Sense', Yale Law Journal (1999) 108(7), 1687

[745] Lanham Act § 1115

[746] *Parks v. LaFace Records,* 6th Cir., No. 99-2495, 5/12/03

[747] Called a service mark when in relation to a service rather than a product

[748] B. Hoffman, 'Copyright and the First Amendment: defining the delicate balance.' A.A. & L. 2004, 9(4), 383

[749] States have traditionally adopted the Uniform Deceptive Trade Practices Act, which doesn't require registration or the Model Trademark Bill, which does provide for registration.

[750] United States Code § 1526, for more information see http://uscode.law.cornell.edu/uscode/html/uscode19/usc_sec_19_00001526----000-.html

Section 43(a) of the Lanham Act, codified at 15 U.S.C § 1125(a), is a short broadly phrased section, covering amongst other things, false advertising. The section prohibits use of a false or misleading description or representation in commercial advertising or promotion that "misrepresents the nature, characteristics, qualities, or geographic origin of goods, services, or commercial activities."[751] The section although initially aimed at the protection of consumers, can only be used as an action by a business competitor, or an individual protecting his persona, in order to protect its value.[752] This statutory provision can be utilised to protect the rights of personality. Section 43(a) of the *Lanham Act*[753] prohibits:

'Unauthorised use of an aspect of a persons identified in connection with any goods or services…which is likely to cause, confusion, or cause mistake, or to deceive as to the affiliation, connection of association of such person.'

The courts formulated guidelines requiring five elements under § 43(a):[754]

1 the defendant must have made a false or misleading statement of fact in advertising;

2 that statement must have actually deceived or had the capacity to deceive a substantial segment of the audience;[755]

3 the deception must have been material, in that it was likely to influence the purchasing decision;

4 the defendant must have caused its goods to enter interstate commerce; and

5 the claimant must have been or is likely to be injured as a result.

The case of *George Wendt and John Ratzenberger v Host International Inc. and Paramount Pictures Corporation (1994)*[756] shows the court's application of the section. Two actors from the US soap Cheers, brought an action in respect of two robot figures installed at a number of airport bars and which were based on the claimants' characters. The court applied an eight part test, extending the previous five part test to be used in such important cases namely:[757]

1 the strength of the claimant's mark;[758]

2 the proximity test, i.e. how relatively similar the goods are;

3 similarity of the marks;

4 actual evidence of confusion;

5 the manner in which the goods/services have been promoted;

6 whether a potential purchaser is likely to be influenced by the association;

7 the state of mind of the defendant in using the mark; and

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[751] Parks above n.746

[752] *Barrus v. Sylvania*, 55 F.3d 468, 470 (9th Cir. 1995); *Serbin v. Ziebart Int'l Corp.*, 11 F.3d 1163, 1169-70 (3d Cir. 1993)

[753] Lanham Act 1946 (As amended by the Trade Mark Law Revision Act 1988)

[754] United Industries Corp. v Clorox Co. 140 F.3d 1175 at 1180 (8th Cir. 1998)

[755] Dastar Corp v Twentieth Century Fox Film Corp 123 S.Ct. 2041 (2003) (Sup Ct (US))

[756] George Wendt and John Ratzenberger v Host International Inc. and Paramount Picture Corporation 1997 US App. Lexis 25584 (9th Cir. 1994)

[757] Newton v Thomason 22 F.3d 1455 (9th Cir) at 1462

[758] In the context the claimant's reputation

8 the likelihood of expansion of the product line.

Despite the appearance of a more complex test than the UK passing off tort there is no automatic requirement to satisfy all 8 parts.[759] The US courts have said that s.43 of the *Lanham Act* extends to "use of any symbol or device which is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person."[760]

The result of the protection afforded by the *Lanham Act* appears to be comprehensive to English lawyers as shown by *Abdul-Jabbar*[761] where the claimant was able to stop General Motors from using his previous name in an advertisement despite having no apparent protection or reputation over a former name. Another case involved basketball player namely Dennis Rodman[762] who prevented the unauthorised reproduction of his tattoos on merchandise.

In addition to damages, injunctive relief is also available under s.43 for which the claimant needs to demonstrate that there has been actual consumer reliance upon the false advertisement which had an economical impact on its own 'business'.

(c) Copyright

The US currently has Federal legislation protecting copyright under the Constitutional's authority to protect the writings of authors.[763] *The U.S. Copyright Act*[764] has been expanded to include new understanding of the word 'writings',[765] with s.106[766] of the Act including software design, graphic arts, motion pictures and sound recordings.

Unlike trademark law within the US the copyright legislation is almost entirely Federal based, as s.301 of the act,[767] includes a provision precluding inconsistent state law. Copyright protection under s.106 grants the owner an exclusive right to reproduce, distribute, perform, display, or license his work. As with trademark law the owner under s.201(d) is granted an exclusive right to produce or license derivatives of their work.[768] There are limited exceptions under s.107[769] e.g. fair use, e.g. when reviewing a copyright protected subject such as a book review. In order to qualify for copyright protection under s.102,[770] the work must be original and in a recognised medium of expression.[771]

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[759] Cher above n.723; Geisel v Poynter Products, Inc., 283 F. Supp. 261, 353, 158 U.S.P.Q. 450 (S.D.N.Y. 1968); Tin Pan Apple v Miller Brewing Co., 737 F. Supp. 826, 835, 15 U.S.P.Q 2d 1412 (S.D.NY. 1990) Allen v National Video, 610 F.Supp. 612, 226 U.S.P.Q. 483 (S.D.N.Y. 1985)

[760] Newton above n.757 at 1462

[761] Abdul-Jabbar above n.686

[762] Dennis Rodman v Fanatix Apparel, Inc. (D.N.J. May 28th 1996)

[763] See http://www.law.cornell.edu/constitution/constitution.articlei.html#science%20and%20useful%20arts

[764] http://uscode.law.cornell.edu/uscode/html/uscode17

[765] Eldred v Ashcroft 123 S.Ct. 769 (2003) (Sup Ct (US))

[766] http://uscode.law.cornell.edu/uscode/html/uscode17/usc_sec_17_00000106----000-.html

[767] http://uscode.law.cornell.edu/uscode/html/uscode17/usc_sec_17_00000301----000-.html

[768] http://uscode.law.cornell.edu/uscode/html/uscode17/usc_sec_17_00000201----000-.html

[769] http://uscode.law.cornell.edu/uscode/html/uscode17/usc_sec_17_00000107----000-.html

[770] http://uscode.law.cornell.edu/uscode/html/uscode17/usc_sec_17_00000102----000-.html

[771] B. Hoffman above n.748

There is no requirement of registration of a copyrighted work, and neither is there a need to place a copyright notice with the work in order for it to be covered. In addition to the rights mentioned above in 1989 the US is a party to the *Berne Convention for the Protection of Literary and Artistic Works*,[772] which offers authors protections within and externally to the US.

2.5 **Conclusion**

The protections available in the US are more specific than those available within the UK. The twentieth century has seen a continuous dramatic increase in the range of protection afforded within the US, e.g. *White* where there was no likelihood of confusion, but a right of publicity was found and protected with significant level of damages.

Although the right of privacy and right of publicity arose from similar style claims, they are now very distinct and established in their own right. The lack of a Federal right of privacy or right of publicity means that individual states continue to protect persons in differing ways, notably in relation to the descendibility of protections.

Although the majority of claims from a celebrity would be based either under an action for privacy or publicity, the availability of the *Federal Lanham Act* a significant additional protection against unlawful use of trademarks as well as false advertising, and copyright protection. Although the Lanham Act appears to have been under-utilised in comparison to the right of publicity.

2.6 **Australia**

(a) **Introduction**

Australia has taken many of its protections from the traditions of UK law, but has been more open to the adaptations of these causes of actions.[773] The range of rights available is relatively broad as, like the United Kingdom, no right to privacy or publicity statute has been enacted. Although no general right to privacy exists, privacy protects different interests from personality rights. An infringement of a person's personality rights deprives the person of the opportunity to commercially exploit their name or likeness for their own benefit, and causes financial loss. In contrast, a person's right to privacy protects the person's personal autonomy, seclusion from surveillance, and protects a person from intrusive behaviour, which causes humiliation or personal distress.[774]

(b) **Tort of Invasion of Privacy**

(i) General Privacy Right

There is no statutory tort of privacy as such in Australia, as was re-emphasised in the High Court's landmark ruling in *Victoria Park Racing v Taylor*.[775] Which involved an application for an injunction to restrain the owner of adjoining land erecting a platform from which the races could be viewed and commentated on.

In 1979 the Australian Law Reform commission released a paper on 'Unfair publication: defamation and privacy' which proposed bringing in a privacy right that included a type of publicity right. The Draft Bill for Unfair Competition was criticised for anchoring the publicity right to the right to privacy.[776] The assessment of privacy damages gave regard to a wide number of issues including the extent to which the defendant's

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[772] http://www.law.cornell.edu/treaties/berne/overview.html

[773] S Crennan, 'The Commercial Exploitation of Personality', (1995) 8 *Australian Intellectual Property Law Bulletin*10, 129

[774] T. Cantanzariti above n.719

[775] Victoria Park Racing v Taylor (1937) 1A IPR 308

[776] The Draft Commonwealth Bill for an Unfair Publication Act 1979

conduct resulted in injury to the financial position of the claimant[777] and the pecuniary loss suffered or likely to be suffered by the claimant.[778] Although the right to institute an action was survivable[779] it was not descendible.[780] The Draft Bill however in my opinion placed the wrong emphasis on the quantification of damages focusing on solely the financial injury suffered by the claimant rather than the greater of either the injury suffered (an effective licence fee) or an adequate payment to prevent an unauthorised violation (such as an account of profits).

Callinan J when discussing *Victoria Park* in Lenah *Game Meats Pty Ltd v Australian Broadcasting Corp. (1999)*[781] stated that the time could be approaching where Australian law recognised that there could be property in a spectacle. He suggested that the time was ripe for a consideration of whether a tort for invasion of privacy could be introduced either by the legislature or the courts.[782]

In the same case Gummow and Hayne JJ. agreed that *Lenah* could be distinguished from Victoria Park Racing, by stating that the decision in that case "does not stand in the path of the development of such a cause of action, it does not stand for any proposition respecting the existence or otherwise of a tort identified as unjustified invasion of privacy".[783] They commented in obiter that [784] the Privacy Act 1988 (Cth) as amended by the Privacy Amendment (Private Sector) Act 2000 (Cth) "stopped short of enacting what might be called a statutory tort of privacy invasion."[785]

The Australian position post *Lenah,*[786] appears to display a division between those in the High Court who might continue to support a liberal-utilitarian approach to the protection of privacy and those who might espouse a narrower Kantian[787] idea of the future for privacy law.

(ii) *Breach of Confidence*

As there is no general right of privacy in Australia[788] currently privacy interests are protected by the equitable action for breach of confidence. To bring a breach of confidence claim, a claimant must establish that:

1 the material is confidential; and

2 there is a relationship of confidence; and/or

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[777] Ibid at s.29(1)(b)

[778] Ibid at s.29(1)(c)

[779] Ibid at s.37(1)

[780] J. McCarthy above n.587

[781] Lenah Game Meats Pty Ltd v. Australian Broadcasting Corporation [1999] Tas. S.C. 114

[782] Ibid

[783] Ibid per Gummow and Hayne JJ at para.132

[784] Ibid at para.106-8

[785] A. Fitzgerald, 'Australia: Procedure – Interlocutory Injunction – Publication of film resulting from secret filming – confidential information – copyright – Unconscionability – Privacy', E.I.P.R., 2002, 24(6), N85

[786] Lenah, above n.781

[787] I. Kant, *The Moral Law: Kant's Groundwork of the Metaphysics of Morals* (Hugh Paton trans, 1948 ed) 90: 'Now I say that man, and in general every rational being, exists as an end in himself, not merely as a means for every arbitrary use by this or that will: he must in all his actions, whether they are directed at himself or other rational beings, always be viewed at the same time as an end'.

[788] Victoria Park above n.775; D. Butler, 'A Tort of Invasion of Privacy in Australia?' (2005) 29 *Melbourne University Law Review* 339 at pp.373-375.

3 the material has been improperly or surreptitiously obtained.

However, in *Lenah*[789] it was shown that where information is obtained as a result of trespass it should be treated in the same way as confidential information. There can be protection if a photographic image, has been improperly or surreptitiously obtained, as this may constitute confidential information if depiction is private. Images and sounds of private activities, recorded by surreptitious methods, would be confidential and thus convey an obligation of confidence on the persons who obtained them and on those into whose possession they came, if they knew or ought to have known, the manner in which they were obtained.[790]

Young J. said[791] "the Court has power to grant an injunction in the appropriate case to prevent publication of a video tape or photograph taken by a trespasser even though no confidentiality is involved. However, the Court will only intervene if the circumstances are such as to make publication unconscionable."[792] He added[793] that, prima facie, an injunction should seriously be considered where a film was taken by a trespasser on private premises and there is some evidence that publication of the film would affect goodwill.[794]

A person may not be able to bring an action for breach of confidence even if in a private context, on private property or in a private forum, because simple photographs or footage of a person alone may not possess the necessary quality of confidence. It has been acknowledged in the High Court that breach of confidence 'extends to information as to the personal affairs and private life of the claimant, and in that sense may be protective of privacy.'[795]

Breach of confidence, is unlike the tort of passing off in that it developed differently, however dicta from *Lenah*[796] suggests that the courts are not prepared to restrict themselves in matters of the protection of privacy in the way that the English courts did in the post HRA case of *Kaye.*[797]

It has been argued that, while a *sui generis* privacy doctrine might have advantages in terms of greater transparency, the breach of confidence doctrine has already proved to offer appropriate protection of private information.[798]

Whatever developments may take place in the field of breach of confidence it will benefit natural, not artificial, persons. Development may best be achieved by looking across the range of established legal and equitable wrongs. Although in some respects these may be seen as representing species of a genus, being a principle protecting the interests of the individual in leading, to some reasonable extent, a secluded and private life, in the words of the Restatement, "free from the prying eyes, ears and publications of others".[799]

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[789] Lenah Game above n.781 per Gleeson C.J. at para.34

[790] Ibid per Gleeson C.J. at para.39; A. Fitzgerald above n.785

[791] Lincoln Hunt Australia Pty Ltd v. Willesee (1986) 4 N.S.W.L.R. 457. at 463

[792] Unconscionable conduct is the cause of action, which is used when there is no confidentiality involved

[793] Lincoln Hunt above n.791 at 464

[794] A Fitzgerald above n.785

[795] Breen v Williams (1996) 186 CLR 71 at 128 (Gummow J)

[796] Lenah , above n.781

[797] Kaye above n.303

[798] Richardson, M. 'Whither breach of confidence: A right of Privacy for Australia', [2002[26 M.U.L.R. 381; Richardson, M. Above n.498

[799] T. Cantanzariti above n.719

(c) **Publicity Rights**[800]

(i) Formal right to publicity

> "The traditional view in Australia has been that there is no proprietary right in one's own name, image, or persona equivalent to the US 'right of publicity' or the Canadian 'appropriation of personality'".[801]

Lockhart J delivering the principal judgment in *Sony Music Australia Ltd v Tansing (2000)*,[802] commented on the 'right of publicity' claim noting that the right has not been held to be part of the law in Australia to date. He referred to a number of Australian decisions, including Henderson[803] and Moorgate (No.2).[804] These cases do not recognise the existence of a 'right of publicity' as such but contain statements which suggest that an individual should be able to prevent use of a person's attributes where the use is misleading or deceptive.[805] In Australia this has been described as a right to merchandise a character rather than a right of publicity.[806]

(ii) Personality rights

It is a misnomer to talk about personality rights in Australia as they are not rights in the sense of positive rights.[807] Australia has a common commercial practice for celebrities entering endorsement or sponsorship agreements.[808] In addition, the Australian Media and Entertainment Arts Alliance, insist film and television industrial agreements and awards do not cover merchandising and insist tele-visual producers enter agreements if they wish to use an actor's image in merchandising.[809]

In *Pacific Dunlop v. Hogan (1989)*,[810] Burchett J. described the appeal of a celebrity's image as:

> "Character merchandising through television advertisements should not be seen as setting off a logical train of thought in the minds of television viewers. Its appeal is nothing like the insistence of a logical argument on behalf of a product, which may persuade, but also may repel. An association of some desirable character with the product proceeds more subtly to foster favourable inclination towards it, a good feeling about it, an emotional attachment to it.

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[800] R Zapparoni, "Propertising identity: Understanding the United States right of publicity and its Implications – some lessons for Australia" Melbourne University Law Review, 2004, Vol. 28, No. 3, 690-723.

[801] McMullen, "Personality Rights in Australia" [1997] Australian Intellectual Property Journal 86; see also S. Boyd above n.675

[802] Sony Music Australia Ltd v Tansing (Unreported)

[803] Henderson v Radio Corporation Pty [1960] S.R. (NSW) 576

[804] Moorgate Tobacco Co. Ltd v Philip Morris Ltd (No.2) (1984) 156 CLR 414

[805] M Alderson, 'Privacy and publicity – whose life is it anyway?',(1996) 9 Australian Intellectual Property Law Bulletin 7

[806] A. Dufty, 'Australia- Passing Off: Unauthorised release of Michael Jackson recordings – Whether right of publicity exists in Australian law', Ent L.R. 1994, 5(1), E3

[807] S Ricketson, 'Character Merchandising in Australia: Its Benefits and Burdens', (1990) 1 Intellectual Property Journal 4, 191

[808] South Australian Brewing Company Pty Ltd v Carlton & United Breweries Ltd (2002) 53 IPR 90

[809] See for example certified agreement MEAA Fox Studios Australia – Employees Agreement 1999 clause 8.4 (f)

[810] Pacific Dunlop Ltd v. Hogan [1989] 23 F.C.R. 553

> No logic tells the consumer that boots are better because Crocodile Dundee wears them for a few seconds on the screen ... but the boots are better in his eyes, [because they are] worn by his idol."

Australian laws stands in the tradition of English law and the protections of common law personality focus on the actions of passing off and breach of confidence. As there is no statutory right to publicity the approach taken by the Australian Courts has echoes of the UK as the courts have been required to stretch passing off to cover cases involving misappropriation as well as cases of misrepresentation.

However, Australian law has been more willing to adapt to the modern needs of personality and this can be shown through the case of *Grosse v Purvis (2003)*[811] which it was argued could lead to the start of a free standing tort of privacy. However the case law in the aftermath has not progressed this argument further and it remains to be seen if Australia will develop such a tort in the near future. Cantanzariti argues that acknowledging and protecting personality rights would protect privacy, but protecting privacy is not the focus and is an unintended incidental. Protecting personality rights protects investment, and has more in common with unfair competition than privacy.[812]

(d) **Trade Mark**

There is currently no comprehensive legal protection for celebrity personality under Australian law.[813] Until recently celebrities attempting to prevent unauthorised exploitation of their personalities relied upon passing off and the *Trade Practices Act* 1974 *("TPA"),* discussed below. However the *Trade Marks Act 1995 ("TMA")*[814] has enabled trade marks to play an increased role in the protection of celebrity personality,[815] as registration provides protection for selected indicia of personality such as portraits,[816] pictures and

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[811] Grosse v Purvis [2003] QDC 151

[812] T. Cantanzaritti above n.719 at 135

[813] I Motsyni, "Protection of celebrities names and trade marks under the ICANN Uniform Domain Name Dispute Resolution Policy" Murdoch University Electronic Journal of Law, Vol. 10, No.4 (December 2003)

[814] Prompted by the GATT, WTO and TRIPS agreement of December 1993

[815] M. Pendleton, 'Exercising Consumer Protection – The Key to Reforming Trade Mark Law' (1992) 3 Australian Intellectual Property Journal 110 at 113

[816] See Trade Mark No.327865, G.M.F.C, (Aust) Pty Ltd (Gloria Marshall) and Trade Mark No.468651 (Paul Newman)

representations of the individual,[817] surnames,[818] famous names,[819] signatures[820] and slogans associated with the individual.[821]

Australian legislation states that a trade mark is a 'sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with by any other person'.[822]A 'sign' includes any 'letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent'.[823] A trade mark serves to 'distinguish the goods or services of the enterprise from those of another'.[824] If an individual successfully registers their photograph changes to their appearance for use as a mark could mean that the new mark is not substantially identical,[825] the new mark is potentially unlikely to pass the threshold for deceptive similarity[826] as the test is not a side by side comparison but one of a potentially imperfect recollection of the registered mark and the impression of the new mark.[827]

In essence, character and personality merchandising are the licensing of a trade mark, to be associated with the licensee's goods where the proprietor has no direct connection in trade with such goods.[828] Previously, the role of trade marks with regards character and personality merchandising was hindered by the view, at common law, that trade marks as badges of origin, and could not be licensed without the traders' goodwill.[829] Consequently, protection was denied for character merchandising because it was not permissible to deal with trade marks as commodities in their own right.[830]

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[817] These are always registrable but usually require endorsement by the applicant to the effect that the photograph is a good likeness of the applicant: Trade Marks Office, Manual of Practice and Procedure, Pt 22, para 22.2 ('TMO Manual'). See Trade Mark No.654914, MPL Communications Ltd, London (Linda McCartney); Trade Mark No.726720, Universal Products Marketing GmbH, Germany (Michael Schumacher) and Trade Mark No.701835-701841, Jaques Villeneuve, Monaco (Jacques Villeneuve)

[818] However, a trade marked name must be "…inherently adapted to distinguish." The relevant goods or services: 1995 Act s.41(3). The commonness of a surname is a guide to the extent of inherent adaption to distinguish that the surname has in relation to the applicant's goods or services.

[819] Famous names are registerable as long as they are not misleading: 1995 Act s.43

[820] The signature of an applicant is always registerable but requires endorsement to the effect that the trademark consists of the applicant's signature: TMO Manual, Part 22, Para 18.1

[821] TMO Manual, Part 22, Para 12, Carson v Reynolds, 48 CPR (2d) 57 (1980)

[822] Trade Marks Act 1995 s.17

[823] Trade Marks Act 1995 s.6

[824] A Terry, 'Proprietary Rights in Character Merchandising Marks', (August 1990) *Australian Business Law Review*, 229

[825] B. Ladas, 'Australian Athletes need a statutory publicity right', IPSANZ, Intellectual Property Forum Vol. 56, March 2004

[826] Trade Marks Act 1995 (Cth) s.10

[827] Shell Co of Australia Ltd v Esso Standard Oil (Aust) Ltd (1961) 1B IPR 523 at 529

[828] L. Weathered, Trade Marking Celebrity Image: The Impact of Distinctiveness and Use of Trade Mark - [2000] BondLRev 13; (2000) 12(2) Bond Law Review 161

[829] Bowden Wire Ltd v Bowden Brake Co Ltd (No.1) (1914) 31 RPC 385; Pinto v Badman (1891) 8 RPC 181 at 194-5 (Fry LJ)

[830] American Greetings Corp Application (1983) 1 IPR 133 ('Holly Hobbie Case')

In common with passing off and the TPA misrepresentation is the device used in trade mark law to balance the demands of trade mark owners, competitors and consumers.[831] The *1995 Act* recognised trade marks as a form of personal property,[832] abolishing the prohibition preventing trafficking or assignment of trade marks without their accompanying business goodwill,[833] and makes provision for multi-class applications.[834] In addition post mortem rights are available under the act unlike under passing off.[835]

Infringement occurs when a substantially identical or deceptively similar sign is used on goods or services in respect of which the trade mark is registered, or on similar goods, 'as a trade mark'.[836] No high profile celebrity marks cases have come to court in Australia and therefore the lead is taken from the leading brand name case-law.

Section 41(2) TMA states:

> "An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered...from the goods or services of other persons."

The Pritikin[837] case shows that the courts will examine the style of the packaging in helping to determine whether there has been an infringement of a trade mark, i.e. has the party sought to emphasis the word or image.[838] If the work used is merely descriptive or describing a function and not acting as a badge of origin[839] then the claim is unlikely to be successful.[840] Sackville. J gave an in-depth analysis on 'use as a mark' cases,[841] confirming that the impression given to the consumer is vital. This impression was the result of examining the context in which the potentially infringing material appears. When a 'reasonable'

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[831] M. Pendleton above n.815 at 113

[832] Trade Marks Act 1995, s.21(1)

[833] Trade Marks Act 1995, s.74 and s.106(3) which permit the assignment of trade marks with or without goodwill of the business concerned in the relevant goods or services

[834] Trade Marks Act 1995, s.27(5) Recommended by the Working Party to Review the Trade Marks Legislation, to reduce the complexity and cost of trade mark applications: Recommended Changes to the Australian Trade Mark Legislation, Report to the Hon. R. Free, Minister for Science and Technology, AGPS July 1992, 59 ('The Free Report')

[835] At common law the motto *actis personalis moritur cum persona,* applies so that the estate of a deceased person cannot sue or be sued for any tort committed by or against the deceased: Baker v Bolton (1808) 1 Camp 483. This rule has been modified by statute through Law Reform (Miscellaneous Provisions) Act 1944 (NSW) s.2. It is however still uncertain whether this provision would allow the estate of a deceased celebrity personality to take action under passing off. It is possible for misleading or deceptive conduct under the TPA may survive the death of a party although this is still an open question; Premiership Investment Pty Ltd v White Diamond Pty Ltd (1995) 61 FCR 178

[836] Trade Marks Act 1995 s.120

[837] Berzins Specialty Bakeries Pty Ltd v Monty's Continental Bakery (Vic) Pty Ltd, (1987) APIC 90-427.

[838] M. Pendleton above n.815 at 113

[839] Shell above n.827

[840] Johnson & Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd (1991) 12 IPR 1; Koninklijke Philips Electronics NV v Remington Products Australia Pty Ltd [1999] FCA 816; Parkdale Custom Built Furniture Pty Ltd v Puxu Pty Ltd (1982) 149 CLR 191 at 225-6

[841] Pepsico Australia Pty Ltd v The Kettle Chip Co Pty Ltd (1996) AIPC 91-213

hypothetical customer would believe they indicated the origin of the product, then an infringement is likely to have occurred.

In relation to celebrities the test for whether they would obtain protection would potentially relate to whether there was endorsement or merchandise. Endorsement would suggest a service behind the product whereas merchandise suggests a service behind the product itself.[842] Where a celebrity has trade marked their image for advertising services, any unauthorised use of their image or personality is sufficient for advertising purposes to falsely imply a celebrity's sponsorship or connection to the product. Although this does not imply that the celebrity's advertising service is the source of the advertisement, there is a need to suggest the latter to be 'use as a mark'. A mere consumer impression of celebrity connection to the product is not sufficient.

An advantage of registration is the possibility of obtaining defensive trade marks where, due to prior use, it is likely that use of the trade mark would lead to an indication of a connection between the registered owner and the proposed goods and services.[843] An advantage of these marks are that there is no need to prove that there is an intention to use the mark on other goods and services.[844] A second advantage is the availability of Notice of Objections against the importation of infringing goods,[845] which when lodged by the registered owner[846] with Customs, allows the owner to bring proceedings[847] to stop third parties from using a similar or deceptively similar trade mark.

The dilution provision of the TMA as shown in *Campomar Sociedad v Nike International Ltd (2002)*[848] lies at the centre of a significant rewriting of trade mark law for Australia.[849] The courts try[850] to "restrain activities which are likely adversely to affect the interests of the owner of a 'famous' or 'well-known' trade mark by the 'dilution' of its distinctive qualities or of its value to the owner":[851] In Nike[852] the High Court particularly referred to the dilution provision as concerned with protecting interests in "famous" or "well-known" trade marks, adding that dilution theory "does not require proof of a likelihood of confusion", rather, what is protected is "the commercial value or 'selling power' of a mark by prohibiting uses that dilute the distinctiveness of the mark or tarnish the associations evoked by the mark".[853] Even if deception or

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[842] Hogan v Koala Dundee Pty Ltd (1988) 10 ATPR 40-902 and Pacific Dunlop Ltd v Hogan (1989) 11 ATPR 40-948

[843] Trade Marks Act 1995 (Cth) s.185(1)

[844] Ibid at ss.185(2) and 186

[845] Ibid at Part 13

[846] Ibid at ss.132(2) and (3)

[847] Ibid at s.230, the ability to bring an action in passing off is expressly preserved

[848] Campomar Sociedad Ltd v. Nike International Ltd. (2000) 46 I.P.R. 481

[849] M. Richardson, 'Promotional Trade Marks and Trade Mark Law in Australia: Recent Cases,' Ent L.R. 2000, 11(8), 189

[850] M. Richardson, in 'Redefining the boundaries of Unfair competition? The changing face of Trade Mark Law in Australia', I.P.Q. 2000, 3, 295

[851] Campomar, above n.848 at 492-493, referring to Trade Marks Act 1995, s. 120(3), which provides a ground for infringement in these cases involving the use of a "deceptively similar or substantially identical" trade mark with respect to goods or services "unrelated" to the owner's

[852] Ibid at 494

[853] Ibid at 493, quoting from the U.S. Restatement Third, Unfair Competition, § 25, comment (a)

confusion are likely to occur and could be broadly interpreted to include suggestions of endorsement or approval this should not have to be proved for infringement by dilution.[854]

The initial cost of trade mark registration,[855] the complexities of the registration process,[856] the time involved in obtaining registration[857] and the organisational and financial infrastructure required to maintain its use, either by the owner or his/her assignees,[858] means it is only of practical use to relatively well established individuals. Trade mark registration has the advantage of providing post mortem protection for celebrity personality which may be difficult to establish under as passing off and the TPA ss.52 and 53.[859] Trade marks are now devisable by will and by operation of law.[860]

In addition to the limitations above there are a number of defences that could dilute the use of a trade mark as a form of protection. If the mark is used in good faith to indicate the kind, quality or another characteristic of the goods or services being offered then no infringement occurs.[861] If the mark is used for comparative advertising this would also not be an infringement.[862] There is no current defence for parody or satire under the Act.[863]

Whilst trade mark law does provide one of the strongest forms of protection available in Australia they can not by definition provide blanket protection for publicity rights. However, this right is not fully open to many people due to the cost, time and complications it takes to register a trade mark, which in turn can only be used for the relevant goods and services it covers.

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[854] M. Richardson above n.850; Querying the effect of the High Court's decision for the authority of the full Federal Court's judgment in Coca-Cola Co. v. All-Fect Distributors Ltd, (2000) 47 I.P.R. 481. In that case the claimant's concession in an infringement action that the defendant's sweets could be considered "goods of the same description as" its soft drink meant that the case could be resolved under Trade Marks Act, s. 120(2), a provision which allows an exception to infringement where the actual use would not be likely to confuse. Thus the issue of dilution under s. 120(3) (which is expressed to be a provision that only applies if s. 120(2) does not) was closed off. Before Nike, the Coca-Cola result could be interpreted to leave little scope for dilution arguments in future cases. But such an interpretation can now be seen as contrary to the High Court's endorsement of dilution issues being resolved under s. 120(3). That the High Court also refused to accept the binding authority of the concession made in New South Wales Dairy Corporation implies that Coca-Cola should now be similarly confined to its facts.

[855] S. Murumba, 'Commercial Exploitation of Personality,' (Sydney, 1986) Pg 23

[856] IP Australia, Trade Marks Application Kit, Feb 1999, sets out the steps required to obtain a trade mark registration under the 1995 Act

[857] Minimum time for registration from date of filing is ten months

[858] If the trade mark owner is unable to obtain users in the classes in which the trade mark is registered it becomes vulnerable to removal under the 1995 Act, s.94(2)

[859] At common law the motto *actis personalis moritur cum persona,* applies so that the estate of a deceased person cannot sue or be sued for any tort committed by or against the deceased: Baker above n.855. This rule has been modified by statute through Law Reform (Miscellaneous Provisions) Act 1944 (NSW) s.2. It is however still uncertain whether this provision would allow the estate of a deceased celebrity personality to take action under passing off. It is possible for misleading or deceptive conduct under the TPA may survive the death of a party although this is still an open question; Premiership above n.835.

[860] As recommended, prior to the 1995 Act by the Free Report, 38

[861] Trade Marks Act 1995 (Cth) ss.122(1)(a), (b), (e), (f) and (i)

[862] Ibid s.122(1)(d)

[863] Coca-Cola Co. Above n.854

(e) **Use of Personal Identity**

(i) Passing Off

Australian passing off law is broader in scope than its English counterpart and offers greater protection against the unpermitted use of personal identity in advertising and commercial promotion.[864] With the lack of a right to privacy claimants have looked to the tort of passing off to protect their publicity value.[865] Passing off arises where a competitor creates the impression that his product is in some way connected to another, competing product, and has occurred without permission to do so.[866] He "passes off' his product as another, profiting from the goodwill that attaches to it.

The tort of passing off is designed to protect a person's business, especially its goodwill and reputation. The basis of the cause of action lies squarely in misrepresentation, for its underlying rationale is to prevent commercial dishonesty.[867]

The three key elements[868] are:

1 that a person has an established reputation or goodwill;

2 there is a misrepresentation; and

3 the misrepresentation causes damage.

The first passing off action that was applied to a case of false endorsement, was *Henderson v Radio Corp. Pty. Ltd (1960),*[869] which involved two professional dancers who sought protection from the producer who had appropriated their picture for use on the picture that was to adorn the album cover. The significance of this case was the abandonment of the 'common field of activity' doctrine[870] as an essential element of passing off. In *Henderson* the courts adopted a different approach to the UK courts, as the court considered that customers of the claimants could be misled as to whether the defendants had approved or recommended the record. This misappropriation was sufficient for an action of passing off. Thus in the Henderson case false endorsement in advertising was identified as one of the elements of passing off.

In *Hutchence & Others v South Seas Bubble Co Pty Ltd & Another (1986)*[871] a company had sold T-shirts with an INXS design on them without the permission of the holders of the design. Wilcox J stated:

> "The better view now is that there is no necessity for a common field of activity between the claimant and the defendant, provided that there is a misrepresentation by the defendant concerning the defendant's name or product resulting in a likelihood of damage to the

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[864] S. Boyd above n.675

[865] Interestingly, in Moorgate above n.804 at 445 Deane J. rejected a tort of unfair competition but noted that traders could look to adapt the tort of passing off, to meet "new situations and circumstances" and exampled passing off developed "to meet new circumstances involving the deceptive or confusing use of name or other indicia to persuade purchasers or customers to believe that the goods or services have an association, quality or endorsement".

[866] See F.A. Trindade, P. Cane, The Law of Torts in Australia, Oxford U.P. at p. 158. J.G. Fleming, The Law of Torts, 7th Ed at 673.

[867] ConAgra v McCain Foods (Aust) Pty Ltd [1992] 23 IPR 193

[868] Reddaway v Banham [1896] AC 1999

[869] Henderson above n.803

[870] McCulloch above n. 272

[871] Hutchence & Others v South Seas Bubble Co Pty Ltd & Another 64 ALR 330.

claimant, as for example confusion adversely affecting goodwill ... or wrongful appropriation of the claimant's name and reputation."[872]

For a successful action, there must be a misrepresentation of a commercial connection or misrepresentation of an association to succeed in passing off, therefore mere misappropriation of reputation is not enough.[873] This means that the tort is not useful in circumstances where it is clear there is a mere association,[874] no connection such as where there is a prominent and credible disclaimer of any consent[875], or where it is plain unlikely that there is a commercial connection.

The courts have sometimes struggled to find a misrepresentation, and have on occasion resorted[876] to a circular legal fiction, that the public assume that if a person's image is used, that there must be a commercial connection. This assumption is based in part on the fact that the public are aware of cases which provide that a person has to consent to their image being used.

Since *Henderson* the courts have gone further to include protection of passing off for the 'look and feel' of Paul Hogan from the highly successful Crocodile Dundee films. The first case was *Hogan and Another v Koala Dundee Pty Limited (1988),*[877] in which a shop used a Koala equipped with the Crocodile Dundee insignia as a logo and the shop also sold items associated with the film. The second case was *Pacific Dunlop Ltd v Hogan (1989)* [878] which involved an advertisement in which an actor, who did not resemble Crocodile Dundee but used elements such as the hat and the jacket (as worn by the actor in the film), endorsed a particular variety of shoes. Neither copyright nor trade mark law protected such claims. The court held that a passing off action included such character appropriation by association.

These cases[879] illustrate how far the action for passing off has been extended to protect celebrities whose persona is employed to enhance sales of products without consent. They also extend protection to a broadly defined image, including virtually any characteristic recalling the celebrity in the minds of a sufficient number of consumers.

Carty argued that the policy in Australia is to take the tort of passing off as close to a tort of misappropriation as possible.[880] Wadlow referred to the Henderson decision as "ambiguous", it not being clear whether the unauthorised use of the claimants' photograph was unlawful per se or only because there was a misrepresentation of sponsorship.[881]

It is not necessary under passing off for the claimant to have had an existing licensing business or whether they have previously preferred not to grant licenses. Nor does it matter that the defendant may have

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[872] Ibid at 341 per Wilcox J (obiter)

[873] McIlhenny Co. v Blue Yonder Holdings Pty Ltd [1997] 39 IPR 187; B. McCabe, 'When Trading Off Reputation of Others in Not Misleading or Deceptive.' (1998) 6 T.P.L.J. 51

[874] Honey v Australian Airlines Ltd & Another 14 IPR 264. Northrop J

[875] Twentieth Century Fox Film Corporation v The South Australian Brewing Co. Ltd [1996] 34 IPR 225 ('Duff Beer Case')

[876] Hogan above n.842

[877] Pacific Dunlop above n.814

[878] Ibid

[879] Ibid per Gummow J; Hogan, above n.240 per Pincus J

[880] H. Carty, above n.12 at 237

[881] C. Wadlow above n.294 at pg297

derived no benefit from the supposed endorsement, and would not voluntarily have paid a fee.[882] Given the existence a misrepresentation, it does not appear to be necessary that the public actually rely on or to which they attach any importance, and by the same reasoning it does not have to be calculated to cause damage over and above the loss of a licensing fee.[883]

(ii) Trade Practices Act

Parallel to the tort of passing off, there is the statutory action for deceptive trading, contained in s.52 of the TPA,[884] which says that using an image or persona without permission can amount to misleading or deceptive commercial behaviour.[885] The advantages of using of the TPA are that there is no need to prove damage, nor the existence of a reputation, to achieve injunctive relief.

Section 52 of the TPA has been used to protect personality rights. The key elements are:

1 a corporation;[886]

2 in the course of trade or commerce; and

3 engages in conduct that is misleading or deceptive or likely to mislead or deceive.

It is sufficient that the conduct is likely to mislead the public into thinking the respondent's product was in some way promoted or distributed or associated with the applicant, that there was some form of association, provided that it is beyond mere wonderment.[887] The relevant misconception is that the other person endorses or is otherwise associated with the first person.

Section 52 is wider in scope than passing off in that it is not strictly necessary to establish reputation. However, it is difficult for a person to establish that the conduct is misleading and deceptive unless the person is sufficiently famous that the public would assume that the person would license the use of their image, so that the use of their image suggests that a licence in fact exists.

Section 53 of the Act provides protection for celebrities against corporation as a corporation shall not, in trade or commerce, in connection with the supply or possible supply of goods or services or in connection with the promotion by any means of the supply or use of goods or services.[888]

The corporation shall not represent that goods or services have sponsorship, approval, performance, characteristics, accessories, uses or benefits they do not have, nor that they have a sponsorship, approval or affiliation it does not have.

Although designed to protect consumers from buying goods or services that have been falsely associated with another product or a personality the TPA, albeit tacitly, serves to protect against the unauthorised

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[882] S. Boyd above n.675

[883] C. Wadlow above n.294 at pp. 298-299.

[884] "A corporation shall not in trade or commerce engage in conduct that is misleading or deceptive or is likely to mislead or deceive." There is no need to prove damage or the existence of a reputation. Although this is part of a consumer protection statute, the vast majority of actions are brought by traders rather than consumers.

[885] Mark Foys Pty Ltd v TVSN (Pacific) Ltd (2000) 49 I.P.R. 303; H. Carty above n.12

[886] If the protagonist is not a corporation, the conduct may still be subject to s.52 if it has occurred within a territory, or the conduct involves the use of postal, telegraphic or telephonic services or takes place in a radio or television broadcast, s.6 TPA

[887] T. Cantanzariti above n.719

[888] For an in depth look at the Trade Practices Act see S. Boyd above n.675

exploitation of reputation or personality.[889] However, the use of a disclaimer[890] may serve as notice to the public so that they are not misled or deceived by the packaging and this may remove the possibility of using a claim under the TPA.[891] The statutory right available under the TPA overlaps considerably[892] with passing off e.g. both require a misrepresentation, the difference being that the TPA[893] looks to protect the consumer, whereas passing off[894] aims to property the intellectual property rights in the goodwill,[895] attached to either a business or an individual.[896]

(iii) Defamation

The Defamation Act 1974 provides that a person has a cause of action against another if:[897]

1 another publishes a statement which makes an imputation which is defamatory of a person,[898] and the statement is likely to cause the ordinary reasonable member of the community to think less of a person or avoid a person; and

2 the person is identified as the subject of the statement.

The potential threat of a defamation claim can discourage the use of an image where a person's image is vulnerable to damage if it is associated with unsavoury goods or services or it puts the person in a "ridiculous light". The argument placed in front of the court is that the publication of the image is an imputation that the person is the kind of person who would endorse such products or services, and is a defamatory imputation because members of the community would think less of them.

This was the analysis used in *Ettingshausen v Australian Consolidated (1991),*[899] where the claimant was a footballer who argued that publishing a photograph of him naked in the shower. This raised an imputation that he was the type of person who would consent to having his photo taken whilst naked, and would consent to such photos being published, and that ordinary reasonable members of the community would think less of him if they because of this. Defamation may also assist where a person's image is vulnerable to damage by being associated with any goods or services.

Defamation only assists where a person's reputation is adversely affected. It does not prevent anyone exploiting a person's image in circumstances where there is no defamatory imputation because ordinary reasonable members of the community would not think less of the person from the exploitation of the image. For example, it would not prevent a person using the image to endorse innocuous goods and services where the person has not held themselves out as eschewing endorsements. Defamation also

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[889] M. Henry, 'International Privacy, Publicity and Personality Laws' (Michael Henry, ed.) 3.79.

[890] Sony above n.802

[891] A. Dufty above n.806

[892] Hutchence above n.871 at 478

[893] Taco Bell Pty Ltd v Taco Co of Australia (1982) 42 ALR 177 at 202 per Deane and Fitzgerald JJ

[894] ConAgra above n.867

[895] IRC above n.244at 223-4 per Lord McNaughton

[896] Henderson above n.803at 636 per Evatt CJ and Myers J

[897] See T.K. Tobin & M.G. Sexton, "Australian Defamation Law and Practice," Butterworths, Loose-Leaf Service, NSW Law Reform Commission Report No.75, September, 1995

[898] Defamation Act 1974 (NSW) s.9

[899] Ettingshausen v Australian Consolidated Press [1991] 23 N.S.W.L.R 443

does not provide or protect any positive right for a person to enter into agreements to exploit their own person and only applies during a person's life.[900]

(f) Summary

Richardson[901] argued that Australian cases have been valuable in emphasising that personal autonomy is the basis of the protections granted. However, the precise reasons for privacy protection and the implications of those reasons for the scope of protection permitted are still to be elucidated. The liberal-utilitarian idea[902] that persons should be free to conduct themselves as they wish, in the hope that they will flourish into better persons and, society will benefit as a whole, leaves scope for broader claims for a 'right' to privacy coupled with a balancing of interests in cases where privacy and freedom of speech collide.

Traditionally when seeking to prevent the unauthorised use of their personality individuals have been granted only limited protection in relation to privacy aspects. The primary reason for a lack of a per se publicity right according to Ladas[903] was the refusal of the High Court in Victoria Park Racing to recognise a common law right of privacy nor allowing an expansion of the law by introducing a doctrine of unfair competition.

Individuals have traditionally brought actions under the TPA and passing off for claims involving their persona in a commercial context. However, the use of passing off and the TPA in these circumstances has been described as "artificial and fictitious",[904] as the Courts have granted relief in situations where only a mere hint of confusion has been presented rather than a misrepresentation.[905]

It is the lack of a clear publicity right that has resulted in the use of passing off and the TPA for areas that they were never intended to cover, and this has created some problems. For example the additional evidential burden that is required under passing off to prove misrepresentation has resulted in increased costs in comparison to a claim brought under trade mark law, where the registration of a mark has the strong advantage of a presumption of validity, making the prevention of infringement easier, quicker and cheaper.

In summary there are circumstances when a celebrity's image can not be used without permission. Firstly, where the use of the image may constitute a misrepresentation that the other person has some sort of connection or association, with the product or service. This is especially important when an image or identifying features are used in a commercial context, such as to advertise commercially available goods and services. An example is if there is a binding agreement in place which contractually prohibits the other person's image or identifying features being used, or contractually prohibits the image or identifying features being used unless a further fee is paid. This includes individual agreements as well as applicable industry wide agreements such as certified industrial agreements or awards.[906]

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[900] T. Cantanzariti above n.719

[901] M. Richardson above n.718

[902] I. Kant above n.787, J. Mill, 'On Liberty' in Mary Warnock (ed), *Utilitarianism, On Liberty, Essay on Bentham, Together with Selected Writings of Jeremy Bentham and John Austin* (1962) 126, 136.

[903] B. Ladas above n.825

[904] J. McMullen above n.801 at 89

[905] B. Ladas above n.825

[906] T. Cantanzariti above n.719

2.7 **Canada**

(a) **Introduction**

Canada has traditionally recognised that all people have proprietary rights in the exclusive marketing for gain of their personality and that the law entitles him to protect that right if invaded.[907] However, each province has their own approach to protecting personality, therefore it is crucial to determine where the violation took place as determines which rights are available.[908] Statutory privacy rights have been passed in British Columbia, Manitoba, Newfoundland and Saskatchewan[909] of which only British Columbia has a specific provision devoted to the unauthorised commercial exploitation of name and likeness.[910] Ontario has developed a common law approach, in the form of the tort of the misappropriation of personality, which is similar to that existing in many US states.[911] The tort shows an evolutionary approach in its development,[912] which was created through two cases which did not involve endorsement by the claimant, meaning that passing off was inapplicable.[913]

(b) **Privacy**

(i) Introduction

Under the Canadian Constitution and Charter of rights there is no explicit right to privacy.[914] This is because matters of civil or private law fall within provincial jurisdiction as there is no single privacy law, the source of privacy protection may be common law, civil law, or statute, depending on the province.[915]

There are two main Federal acts,[916] the *Privacy Act 1982* (which adopted the *CSA International Privacy Code*[917] into law), and the *Personal Information and Electronic Documents Act 2000*.[918] However, these Acts are targeted at avoiding invasions of privacy in ways rarely benefited celebrities, such as wiretaps by the police or excessive surveillance in the workplace and therefore are beyond the scope of this paper.

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[907] Athans v Canadian Adventures Company Ltd [1977] O.R 2d 425 at 435

[908] L. Murray 'Chapter 1: Copyright Talk: Patterns and Pitfalls in Canadian Policy Discourses' In the Public Interest, The Future of Canadian Copyright Law, ed by M. Geist, September 2005

[909] British Columbia (1996), Manitoba (1987), Newfoundland (1990) and Saskatchewan (1978). It is still not clear whether publicity rights are included, though the British Columbia law includes protection against the unauthorised use of name or portrait for advertising.

[910] R. Howell, 'Publicity Rights in the Common Law Provinces of Canada,' 18 Loy.L.A.Ent L.J 487 (1998)

[911] C. Wadlow above n.294 at p.304; R.Howell ibid

[912] H. Carty above n.12

[913] In Krouse, above n.735, the lack of a common field of activity was stressed in the discussion of the tort of passing off

[914] Canadian Charter of Rights and Freedoms, Part I of the Constitution Act 1982, schedule B to the Canada Act 1982 (United Kingdom), 1982, c. 11, s. 8, at http://laws.justice.gc.ca/en/charter

[915] M. Homsi. 'Outsourcing Our Privacy?: Privacy and Security in a Borderless Commercial World', 54 UNB Law Journal 272 (2005)

[916] Protection can be available under the Federal Copyright Act, particularly under the provisions relating to performer's rights and moral rights see R.S.C. 1995, c. C-42 as amended; W. Hayhurst, 'Canada: Privacy – Photographs', E.I.P.R. 1997, 19(7), D172

[917] A national standard: CAN/CSA-Q830-96.

[918] Bill C-6, Personal Information Protection and Electronic Documents Act, available at http://www.parl.gc.ca/36/2/parlbus/chambus/house/bills/government/C-6/C-6_4/C-6_cover-E.html.

(ii) Recognition of Privacy

Invasion of privacy was first recognised under art.1053 of the *Quebec Civil Code* in *Robbins v. C.B.C. (1957).*[919] Since Robbins, the right of privacy has been codified in both the *Quebec Charter of Human Rights and Freedoms*,[920] and in the *Civil Code*.[921] Under s.8 of the charter there is a right to be secure against unreasonable search or seizure, which the courts have recognised an individual's right to a reasonable expectation of privacy.[922] The Quebec civil law offers protection to safeguard dignity, honour, reputation[923] and for respect for private life,[924] as shown in *Bogajewicz.*[925] Trudeau J. stated that Sony of Canada was obligated to ensure that it obtained consent before using a photograph of the claimant's likeness. As with the appropriation of personality unintentional infringement is no defence in Canadian law.

Quebec's lead in the development of protection for personal privacy was followed by British Columbia,[926] Manitoba,[927] Newfoundland[928] and Saskatchewan[929] who have all enacted privacy statutes that, *inter alia*, prohibit the unauthorised use of a name or likeness in advertising and promotion of goods or services.[930]

There is no requirement for the subject to be 'well-known' in order to bring a claim, a photograph of a seventeen year old girl[931] sitting in a public place, was published in the defendant's magazine and the claimant successfully brought a claim. The Supreme Court said the decision was based on the infringement of her privacy, as there was an abuse of her previous anonymous status, which people cherish.

Whilst, traditionally Quebec[932] relies on the tort of misappropriation of personality to deal with cases like *Bogajewicz*[933] some common law provinces have enacted specific legislation providing for redress when an individual's right to privacy has been invaded.[934]

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919 Robbins v C.B.C. (1957) 12 D.L.R. (2d) 35 (Que. S.C.). The history of privacy protection in Quebec is canvassed by Biron J. in Aubry v. Duclos (1996), 141 D.L.R. (4th) 683 (Que. C.A.) at 688-691.

920 R.S.Q. 1977, c. 12. Art. 5 guarantees to everyone the "right to respect for his private life".

921 S.Q. 1991, c. 64. Art. 3 of the Civil Code of Quebec now states: "Every person is the holder of personality rights, such as the right to life, the right to the inviolability of his person, and the right to respect of his name, reputation and privacy. These rights are inalienable."

922 Hunter v Southam, 2 S.C.R 145 (1984) at 159 - 60

923 Quebec Charter s.4

924 Ibid at s.5

925 Bogajewicz v Sony of Canada Ltd (1995) 63 C.P.R (3d) 458

926 Privacy Act, R.S.B.C. 1979, c. 336

927 The Privacy Act, R.S.M. 1987, c. P-125

928 Privacy Act, R.S.N. 1990, c. P-22.

929 The Privacy Act, R.S.S. 1978, c. P-24

930 S. Boyd above n.675

931 Aubry v Editions Vice-Versa Inc [1998] 1 S.C.R 591

932 In the civil law province, Quebec, the right to one's image was also accepted in the Quebec Supreme Court decision, Deschamps v Renault Canada (1977) 18 C de D 937 where film footage of celebrities was used without their permission in the defendant's advertising campaign, mentioned in D. Collins, 'Age of the Living Dead: Personality Rights of Deceased Persons' [2002] Albany Law Review 39. Only 14 states provide a post-mortem right.

933 Bogajewicz above n.925

However, no court has yet examined the constitutional validity of the publicity aspect of the right of privacy, and whether this can co-exist with freedom of expression, or whether it should be amended to account for free press.[935] It is vital to remember that the Charter seeks to protect both freedom of expression and privacy,[936] both are fundamental constitutional rights, which should both be considered when scrutinising legislation to which the Constitution applies.[937] Thus, freedom of speech, like any other freedom ... must be balanced against the essential need of individuals to protect their reputation.

As argued in Pierre v Pacific Press Limited (1994)[938] there was a belief that the protections available in privacy torts, in this case British Columbia's statutory privacy tort, were unsuitable for publicity protections and indeed inoperative in the light of the right to freedom of expression. In obiter McEachern C.J.B.C. stated, "[t]he Defendants may not succeed on this issue because if they did it could mean that the Charter protects a right to injure, which would be an unusual application for a Charter of Rights and Freedoms".[939]The case exemplifies the pressure for the emergence of a publicity right which has echoes of a privacy right in a similar fashion to that which Phillips was hinting at in Hello! The emergence of the tort of appropriation is discussed in further detail below.

Canada has faced similar problems to other jurisdictions in relation to the lengths that privacy protection extends to. Inevitably, such cases implicate constitutional considerations because the right of privacy [940] is being asserted in a manner which seeks to limit the freedom of the press.[941] Section 2(b) of the Charter[942] guarantees "freedom of expression, including freedom of the press and other media of communication".

Quebec has enacted the *Quebec Charter of Human Rights and Freedom*, s.5 guarantees every person a 'right to respect for his private life'. In *Aubry v Editions Vice-Versa (1998),*[943] the Supreme Court held that publication of a citizen's photograph without consent could violate their right of privacy under Quebec law. The Court found that the right to one's image is covered under the right to respect one's private life in s.5. The freedom of expression and right of the public to be informed are defences under the Charter that in this case did not overrule the person's right.

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[934] D. Tackaberry, 'Canada: Appropriation of Personality – Unauthorised use of Claimant's photograph in advertisement', Ent L.R. 1996, 7(3), E44

[935] In Pierre v. Pacific Press Ltd, [1994] 7 W.W.R. 579 (B.C.C.A.), the British Columbia Court of Appeal considered Pacific Press's argument that the claimant's wrongful publicity claim was too complex for a jury trial. Pacific Press intended to raise at trial the argument that the publicity aspect of British Columbia's statutory privacy tort was inoperative, in light of the freedom of expression guaranteed by s. 2(b) of the Charter. (at 594).

[936] It is necessary to recall that the rights guaranteed by the Charter apply directly to legislation including Quebec's Civil Code (which is, after all, enacted by statute). The Charter does not apply directly to the common law, but impacts indirectly upon the common law through the "Charter values" interpretative approach. See R.W.D.S.U. v. Dolphin Delivery [1986] 2 S.C.R. 573 at 603

[937] For example provincial privacy statutes and Quebec's civil code

[938] Pierre above n.935

[939] Ibid at 594

[940] J. Craig, & N. Nolte, 'Privacy And Free Speech In Germany And Canada: Lessons For An English Privacy Tort', E.H.R.L.R. 1998, 2, 162

[941] Ibid at 162

[942] Canadian Charter of Rights

[943] Aubry above n.931

In summary one general privacy tort exists within Manitoba, Newfoundland and Saskatchewan.[944] Whilst British Columbia has a tort that is actionable without proof of damage and is available to prohibit unauthorised appropriation of a person's name or portrait for the purpose of advertising or promoting the sale or trading in, property or services.[945]

(c) **Appropriation of personality**

(i) Introduction

The courts have recognised that a person,[946] "has a proprietary right in the exclusive marketing for gain of his personality, image and name, and that the law entitles him to protect that right if it is invaded".[947] The primary vehicle for protecting personality and publicity interests in common law jurisdictions is the tort of "appropriation of personality." The tort exists largely in response to the failure of passing off to provide an adequate remedy for unauthorised uses of an individual's persona[948] and is based on taking the commercial magnetism of an individual without paying for it.[949]

(ii) Tort of Appropriation of personality

The tort was first recognised by the Ontario Court of Appeal in *Krouse v. Chrysler Canada Limited (1973).*[950] According to Estey J.A., a professional athlete has a commercial property right with regard to his photograph or likeness when used in advertisements. He continued stating no cause of action is available if the photograph does not suggest an endorsement of the product but merely illustrates the sport in which the athlete participated.

In developing the tort of appropriation of personality, the Ontario Court of Appeal expressly recognised:

1 a tort of this nature was contemplated within Commonwealth common law, being derived from the source of all new torts, the seminal proceeding of "the action on the case;"[951]

2 a specific comparison of the tort with "an action for trover[952] or conversion in its modern form; and"[953]

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[944] See Privacy Act, R.S.M. ch. P-125, § 3(c) (1987) (Can.); Privacy Act, Nfld. R.S. ch. P-22, § 4(c) (1990) (Can.); and Privacy Act, R.S.S. ch. P-24, § 3(c) (1978) (Can.).

[945] Privacy Act, R.S.B.C. ch. 373 § 3(1) (1996) (Can.). This section provides detailed provisions concerning identification of the claimant and an intent "to exploit" by the defendant. Id. §§ 3(2)-(3). Furthermore, it includes defenses relating to news reporting and incidental usages of the name or portrait. Id. § 3(4). The provision is limited to a "name" or "portrait." The term "portrait" is defined as: "mean[ing] a likeness, still or moving, and includes a likeness of another deliberately disguised to resemble the claimant, and a caricature." Id. § 3(5). This definition would seem to exclude "sound-alikes" and the use of a model who "naturally" resembles the claimant.

[946] R. Howell**,** 'Character Merchandising: The Marketing Potential Attaching to a Name, Image, Persona or Copyright Work', 6 Intell. Prop. J. 197 (1991) (Can.). at 218; so far the tort is limited to human characters

[947] Athans above n.907 at 435. The Jamaican Court adopted a similar approach in Bob Marley Foundation v. Dino Michelle Limited [1994] Supreme Court No. CLR 115 of 1992

[948] H. Carty above n.12

[949] Krouse above n. 735; Athans above n.907

[950] Krouse ibid at 15

[951] Ibid at 27

[952] Trover is a form of law suit in common law countries for the recover of damages for wrongful taking of personal property

3 a favourable comparison of the tort with the American principle of "Right of Publicity", although with the acknowledgement that such a proceeding had not in itself yet been recognised in Canada or UK.[954]

The development followed upon the tort of passing off being found inapplicable as the parties were not in a relationship that would cause public confusion[955] as to an "association" between them.[956] Instead, the court's reference to an "endorsement" factor may be seen as part of establishing "a threshold issue establishing a sufficient degree of nexus before the defendant can be said to have culpably appropriated the claimant's personality."[957]

The courts have, marked out factors analogous to the right of publicity in the US, including:

1 the claimant must be identified in the depiction or other indicia;[958]

2 the defendant's use of the claimant's persona should be more than incidental or *de minimis*;[959]

3 there is no express requirement of an intent to misappropriate;[960]

4 there must be damage;[961] and

5 there cannot be a public interest in publication that would counter any misappropriation action.[962]

The potential defences to the tort of appropriation of personality are discussed in greater detail below.

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[953] Krouse above n.735 at 27

[954] Ibid at 23,24,27 and 31

[955] Ibid at 25-26; R. Howell, 'The Common law Appropriation of Personality Tort', 2 Intell. Prop. J. 149,(1986) (Can.) at 170-1

[956] S. Boyd above n.675

[957] R. Howell above n.955 at 170

[958] Joseph v Daniels [1986] 4 B.C.L.R.2d at 244; Krouse, above n.735 at 29-30; J. McCarthy, above n.587 at § 4.15[A]

[959] This element is also a prerequisite or "threshold" issue for the right of publicity proceeding in the United States; R. Howell, 'Personality Rights: A Canadian Perspective: Some Comparisons With Australia', 1 Intell. Prop. J. 212, 218 (1990) (Austl.). Similarly, proceedings under provincial privacy statutes, require an intention "to exploit." See Privacy Act, R.S.B.C. ch. 373, § 3(2) (Can.); Privacy Act, R.S.M. ch. P-125, § 3(c) (1987) (Can.); Privacy Act, R.S.S. ch. P-24, § 3(c) (1978) (Can.); see also Privacy Act, Nfld. R.S. ch. P-22, § 4(c) (1990) (Can.).

[960] Though all current cases in Canada have involved intentional conduct

[961] For the extent to which damage may be implied or to which equitable unjust enrichment may be applicable in this context, see R. Howell above n.955 at 179-86. See also supra text accompanying note 46, concerning the remedy of unjust enrichment for right of publicity violations in the US under Zacchini, above n.658

[962] The need for a "public interest" exception to preclude an application of the tort was expressly recognized in Krouse, above n.735 at 30, but without providing any detail as to how a public interest would relate to the propriety interest in publicity. An appropriate analogy can be drawn with developments in the right of publicity proceeding in the US; R. Howell, Important Aspects of Canadian Law and Canadian Legal Systems and Institutions of Interest to Law Librarians and Researchers in Law Libraries, in Law Libraries in Canada: Essays to Honour Diana M. Priestly 42-48 (J.N. Fraser ed., 1988). at 192-96; above n.981 at 226-27.

Shortly after *Krouse* was *Athans v Canadian Adventures Company Ltd (1977)*[963] where a well-known water-skier, sued Canadian Adventure Camps for misappropriation of his image. The camps used a photograph of Athans to create a line drawing in their advertising materials.[964] The Ontario High Court determined that those individuals involved in creating the line drawing were aware that the photograph was a distinctive image of Athans, easily recognisable by those familiar with water-skiing.[965]

After examining the photograph and the drawing, the court concluded that the distinctive nature of the photograph was preserved in the drawing.[966] The court held that the image's use in the drawing without consent was an infringement on his exclusive right to market his personality.[967] The decision was distinguished from *Krouse* by stating that the defendant in *Krouse* did not target a particular athlete's personality, but merely intended to depict an anonymous football player as part of a promotional campaign.[968] The court concluded that an action based on the infringement of one's personality is distinct from an action based on trademark or copyright law.[969] In the case, passing off was not demonstrated, the court found that the use of the image was an infringement of his exclusive right to market his own personality. Henry J found that the defendants were liable for the tort of appropriation of personality and damages were quantified at the level of a reasonable licence fee had permission been sought. This led to the new tort being recognised and was subsequently accepted in a number of cases.[970]

A common link between this tort and that of passing off[971] is a requirement of public confusion. For example in the case of the sale of unofficial T-shirts of Crocodile Dundee,[972] the public[973] were found to be in all likelihood buying the goods assuming them to be official merchandise and in fair expectation that quality standards would be higher. Over time, the courts have developed various tests to determine whether a claimant endorsed the defendant's product or business, but difficulties remained in establishing the requisite level of association.[974]

The tort of appropriation of personality has continued to develop as shown in *Gould Estate v. Stoddart Publishing Co. (1996),*[975] *Horton v. Tim Donut Ltd. (1997),*[976] *and Shaw v. Berman (1997)*[977]*.* These cases

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[963] Athans above n.907

[964] Ibid at 584

[965] Ibid at 589

[966] Ibid at 588

[967] Ibid at 595

[968] Ibid at 593

[969] Ibid at 595

[970] Racine v C.J.R. Radio Capitale Ltd [1977] 17 O.R. (2d) 370; Heath v Weist-Barron School of T.V. Ltd [1981] 34 O.R. (2) 126; Dowell v Mengen Institute [1983] 72 C.P.R. (2d) 238

[971] For a leading Canadian passing off case see National Hockey League v Pepsi-Cola Canada Ltd (1992) 70 B.C.L.R. (2d) 27, where the court found that a disclaimer was enough to remove any confusion

[972] Paramount Pictures v Howley (1992) 39 C.P.R. (3d) 419 (Van Camp J.)

[973] The public was not just point of sale consumers but also trade retailers

[974] R. Howell above n.959 at 154 (setting out various tests including: "endorsing," "quality control," "association," and "authorizing or approving").

[975] Gould Estate v Stoddart Publishing Co. [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.) (holding that the publisher and author of a book about the claimant did not appropriate his personality in light of the fact that he was a famous Canadian pianist).

first introduced the issue of a public interest limit upon protection of personalities and the descendibility of personality rights.[978] Each case saw the appropriation of personality claim denied in favour of a public interest in the use of the claimant's identity.

(d) **Defences**

(i) Unrecognisable or de minimis

There is a strict requirement that the claimant must be identifiable from the depiction or indicia as shown in *Joseph v Daniels (1986)*,[979] where the use of only the model's torso was sufficient to avoid identification of the claimant.

In *Krouse*[980] the court took this requirement further by finding in favour of the defendant even though the claimant was clearly depicted, the court ruled that the aim of the poster was to exploit the game of football rather than the claimant. McCarthy discusses the "identification" requirement and provided a number of examples to illustrate that the courts had been prepared to established identification from not merely direct indicia but also from the whole of the circumstances of presentation such as captions and accompanying commentary.[981]

The courts established in *Krouse* and *Pacific Press* that there must be a degree of usage of the person's persona that constitutes a "culpable" taking. This requirement has been similar to that of Australia and requires an embedded, rather than mere, caricature of the person before the court will find the necessary culpable taking.[982]

(ii) Public Interest defence

Gould Estate provides a complete analysis of the public interest debate and presents the issue as "sales vs. subject." This reflects the distinction between appropriations primarily for commercial or merchandising purposes, where public interest in publication cannot displace the proprietary claim of the celebrity, and those that are closer in nature to reporting of facts, ideas and newsworthy events, where the public interest in publication has greater weight.[983]

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[976] Horton v Tim Donut Ltd., [1997] 75 C.P.R.3d 451 (Ont. G.D.), aff'd, No. C26845 (Ont. Ct. App. Oct. 10, 1997) (Can.) (holding that the appropriation of personality tort did not allow the widow of a famous hockey player to enjoin the use of a picture of the player where the defendant had acquired the rights previously).

[977] Shaw v Berman [1997] 72 C.P.R.3d 9, 18 (Ont. G.D.) (Can.) (holding that the tort of appropriation of personality arises only where the claimant's identity is commercially exploited but does not arise where the claimant is the actual subject of the defendant's work).

[978] The Civil Code in Quebec may well enable an estate or next of kin to bring proceedings for the violation of an interest with respect to the deceased. Civil Code, S.Q. ch. 64 (1991) (Can.).

[979] Joseph above n.958 at 244

[980] Krouse, above n.735 at 29-30

[981] J. McCarthy, above n.587at § 4.15[A]

[982] It is suggested that the "endorsement" factor in Krouse, above n.735; See Pacific Dunlop, above n.814 at 43-44 (Austl.); R. Howell above n. 959 at 218. Similarly, proceedings under provincial privacy statutes, require an intention "to exploit.

[983] Gould Estate above n.975 at 526-27; Shaw above n.977 (following Gould Estate in the context of the American celebrity Artie Shaw and the making of a documentary film of his life); Horton above n.976 at 451.

Support for the "sales vs. subject" distinction is found in British Columbia's statutory cause of action for use of "the name or portrait of another."[984] To be actionable, the usage must be primarily for the defendant's benefit, as opposed to the reporting of "current or historical events or affairs, or other matters of public interest."[985] The unauthorised publication of the photographic biography in *Gould Estate*, for example, was found to have met the public interest test by providing a "glimpse into Gould's solitary life" and "knowing more about one of Canada's musical geniuses."[986]

(iii) Unintentional infringement

Unintentional infringement is no defence, as shown in *Bogajewicz*[987] where images purchased from an agency in good faith, with all necessary consents of those depicted thought to have been purchased with it. These images were then used in the defendant's promotional material.

(e) **Descendibility**

The issue of inheritability was discussed in the case of *Gould,*[988] in which 14 years after Mr Gould's death the defendants published a book containing an interview and photographs taken 40 years previously. In addition to *Athans*[989] and *Krouse*[990] the court sought help from the British Columbia case of *Joseph.*[991] The court held that the right of publicity was inheritable, however the case failed as it fell under the informational, artistic or newsworthy exception which is protected as a freedom of expression.[992]

Only two cases in the common law jurisdictions have involved the assertion of personality rights by the estate of a deceased celebrity.[993] In *Gould Estate*, the court found that Gould's publicity rights were descendible and enforceable by the estate, subject to the public interest in publication. The court's reasoning was threefold:

1 the court drew a distinction between privacy and publicity interests, noting that whereas privacy interests are non-descendible or non-inheritable because of their nature as personal interests "in dignity and peace of mind," publicity interests, by contrast, are descendible or inheritable as property rights;[994]

2 the court avoided a "durational limit" on the inheritance, noting that "Gould passed away in 1982, and it seems reasonable to conclude that whatever the durational limit, if any, it is unlikely to be less than 14 years"; and[995]

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[984] Privacy Act 1996 s.3

[985] See Privacy Act, R.S.B.C. ch. 373, § 3(4), (5) (1996); R. Howell above n.959 at 196.

[986] Gould Estate above n.975 at 527.

[987] Bogajewicz above n.925

[988] Gould Estate above n.975 at 520

[989] Athans above n.907

[990] Krouse above n.735

[991] Joseph above n.958

[992] The Court followed the same approach as its US counterparts

[993] Gould Estate above n.975 at 520; Horton above n.976 at 451.

[994] Akin to copyright or patent law; Gould Estate ibid

[995] Ibid

3 the court found statutory preclusion of descendibility of personality rights under provincial Privacy Acts in British Columbia, Newfoundland, and Saskatchewan to be inconsequential. Reasoning that because statutory actions were separate from common law proceedings, being the creation of legislatures, they could be limited as any legislature sees fit.[996]

Furthermore, because provincial statutory rights of action are found in the Privacy Acts, whatever statutory restrictions there may be on rights of action for privacy violations and unauthorised use of personality should not be applied to the common law tort of appropriation of personality.[997] In British Columbia, s.3 of the *Privacy Act* covering the use of "the name or portrait of another" is a tort separate from the general statutory tort of "privacy." This is consistent with *Joseph*,[998] where the Supreme Court viewed s.3 of the *Privacy Act* as available in addition to the common law tort.[999] There are current only 14 states that recognise a post-mortem right.[1000]

(f) **Summary**

Collins, argued that "Canada has employed the tort of 'misappropriation of personality' as the primary method of protecting the publicity rights of celebrities". However the tort is still in the process of evolving in particular there is still debate as to whether it only applies to advertising and the promotion of goods or services through endorsement. Commentators have drawn distinctions between the use of a personality to promote a product and presentation of the personality as the subject of the product itself[1001] the so-called "sales vs. subject" debate. Its evolution to bridge gaps left under passing off looks likely to continue into the next decade.

(g) **Conclusion**

The privacy laws within Canada have been established despite have no explicit right to privacy under the Constitution. The balance of common, civil and statutory law has resulted in a wide ranging and effective privacy laws. The laws are designed and implemented to protect the dignitary aspects of an individual rather than to be an additional way for a celebrity to protect their commercial value. The law has not yet examined the potential extension of the privacy laws to account for publicity aspects or how these would need to be balanced in conjunction with the freedom of the press.

In order to protect publicity or personality issues the tort of appropriation of personality is the most common cause of action cited. However, commentators[1002] believe that the courts must address important issues within this tort, such as how to balance this tort with the public interest in publication and free expression, as

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[996] R. Howell above n.959

[997] Gould Estate above n.975 at 527-9

[998] Joseph above n.958

[999] Ibid at 243-6; R. Howell above n.962 at 190-92 (noting British Columbia to be the only jurisdiction that provides for two statutory torts: (1) a general privacy tort, similar to the tort provided for in the provinces of Manitoba, Saskatchewan, and Newfoundland; and (2) a tort concerning specifically the use of "the name or portrait of another for the purpose of advertising or promoting the sale or other trading in, property or services"). Privacy Act, R.S.B.C. ch. 373, § 3 (1996) (Can.) (appearing to cover "publicity" as well as privacy, despite a provision (§ 5) denying the descendibility of the interest protected under the tort); see also Joseph, ibid. In Joseph, had the claimant been sufficiently identified, the provisions of Section 3 would have applied alongside of common law appropriation of personality in a publicity context. The court did not consider any possible argument of pre-emption of common law relief.

[1000] D. Collins, above n.932 at pg 91, Only 14 states provide a post-mortem right

[1001] For example in a biography

[1002] R. Howell above n.959; J. Craig above n.940 at 171; Collins, above n.932 at pg 42; D. Tackaberry above n.934

well as the descendibility of personality rights. It is expected that as the tort will develop and take on more similarities with the US right of publicity.

A grey area with the tort is whether it will in addition apply to privacy cases.[1003] Carty argued[1004] that the tort is further complicated by uncertainty surrounding a public interest defence and the apparent widening of the scope of the tort of passing off in more recent cases such as *Pepsi-Cola Canada*.[1005] Where passing off was made out where the unauthorised use indicated the product was approved, authorised or endorsed by the celebrity, a much wider view of the tort than that accepted in *Krouse* or *Athans*. Such a development, she argued, calls into question the very purpose of the tort of appropriation of personality.[1006]

2.8 Overall Conclusion of common law jurisdictions

The common law countries examined above all offer extensive protections against invasions of privacy and publicity but each seeks to protect these rights in a different way. The US has created three main protections, namely the right to privacy, right to publicity and the Lanham Act. The scope of these rights is significant, as exemplified in the Vanna White decision discussed above. The remedies available are also more effective than those available in Australia or Canada due to the availability of compensatory or punitive damages. The protection under freedom of expression is significant within all three countries but is more prominent in the US due to the greater case law concerning the issue.

Australia has sought to rely on similar actions to the UK, with the exception of the TPA, and has shown a greater willingness to develop this actions more quickly than in the UK as shown in passing off. The Australian courts have like the UK not yet awarded compensatory damages preferring to rely upon a lost licence fee valuation for passing off and damages for mental distress under breach of confidence actions.

Canada has adopted the a specific tort of appropriation in order to protect personality rights but there is still a significant debate as to whether the courts have yet fully decided if privacy issues will also fall under the tort. The extent of the tort as to whether it covers endorsement, a similar question as faced the UK courts in Irvine, has yet to be conclusive decided. The tort will continue to develop and the balancing act between protection and the public interest is one which the courts will be faced with on a case by case basis. Like the personality rights in the UK and US the protections afforded by the tort are descendible.

CHAPTER 3

3 Examination of civil law jurisdictions

The paper will now examine the protections available under three civil law jurisdictions, France, Italy and Germany. This will enable an analysis of different legal jurisdictions approach to the protection of personality.

3.1 France

(a) Introduction and rationale behind existing laws

The paper examines the sources and rationale behind the existing privacy and publicity laws within France before highlighting issues such as the availability of damages and defences. The section on France then examines questions concerning the descendibility and transferability of the privacy and publicity rights.

[1003] R. Howell above n.955 at 238 (videotape of unemployed men discussing employment).

[1004] H. Carty above n.12 at 209

[1005] National Hockey above n.971 at 401

[1006] R. Howell above n.959 at 501: "if the passing off tort in Canada evolves to encompass the Australian Hogan test [on which see below] in the area of character merchandising, the scope and purpose of the tort of appropriation of personality would need to be considered".

Within France there has been a resistance to adopting a right of publicity such as is present in the US, and what little effort there has been has been the result of the judiciary rather than the politicians. The courts have however through the 'droit a l'image' (right of image) turned what was initially a negative right, i.e. enabling prohibition of unauthorised uses, into a positive right enabling the recovery of damages. The content of personality rights under French law, are generally considered in a negative light, i.e. the right to prohibit the production and distribution of an individual's likeness without the subject's consent, the jurisprudence has nevertheless exposed several exceptions to the exercise of this right.

Prior to the twentieth century French law had seen the right of image as one of a bundle of rights normally described as 'personality rights,'[1007] which traditionally in France have been viewed as an extension of a one's personality.[1008] The right of image was initially seen as a minor personality right and was treated as a spin off of, the right of privacy. This changed in the twentieth century with the adoption of international rules and standards, which placed a greater focus on an individual's protection of privacy and dignity.[1009]

There are two theories as to why the French right of image has developed as it has, the first is the protection from unwanted exposure embodies a privacy interest. This has been called the right to image, and flows from the difficulty in placing a value on a personal right, but also recognises the importance of non alienation of a personal attribute or the ex-patrimonial nature of the right.[1010] The opposing argument is that the right also embodies the protection of a marketable asset, in order to enable compensation to be paid for its use and has been called the right of image.[1011] It is these conflicting interests that have been a key factor in the resistance in France of the recognition of such a right.[1012] Traditionally the right of image and right to image have been seen as part of a number of "personality rights" in France along with the moral rights of authors and the right to protect one's honour and reputation.[1013] The right of image was at least initially treated as an off shoot from the right of privacy, as was the case in the United States.

The battle between the two viewpoints, the wider concept of right of image and the right to image, was brought before the courts in *Les Editions du Sand & Pascuito v Kantor (1996)*[1014] where the court held that the right of image is a personality right that entitles the holder to oppose a dissemination and use of their image without prior consent. The violation of this right may cause moral and economic damage when the holder conferred commercial value to their image as a result their notoriety. Traditionally the decisions on a right of image have involved celebrities for whom their image is an essential feature of their career. Although the courts have failed to award substantial damages in any of these cases.[1015] Logeais highlighted that

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[1007] J. Hauch, 'Protecting Private Facts in France: The Warren & Brandeis Tort Is Alive and Well and Flourishing in Paris,' 68 TUL.L.REV. 1219, (1994)

[1008] Ibid at 1228-9

[1009] Two prominent examples are; Universal Declaration of the Rights of the Human Being and the Citizen 1948 Art 12; European Convention on Human Rights 1950 Art 8

[1010] This view is discussed in length in B. Edelman, 'Sketch of a Subject's Theory, Man and his Image,' D.1970, Chron. 120; E. Gaillard, 'The Dual Nature of the Right of Image and the consequences on French Positive Rights', D. 1984, Chron. 161

[1011] The alternative view is discussed in D. Acquarone, 'The Ambiguity of the Right of Image', D. 1985, Chron. 129; M. Serna, 'The images of people and goods', D. 1997, Chron. 100

[1012] E. Logeais & J. Schroeder, 'The French Right of Image: An ambiguous concept protecting the human persona', 18 Loy. L.A. Ent L.J. 1998, 511 at 512

[1013] J. Hauch above n.1007 at 1228

[1014] Les Editions du Sand & Pascuito v Kantor, CA Paris, Sept. 10, 1996, R.D.P.I., n.68

[1015] E. Logeais above n.1012 at 517

personality rights' are, under French law, fundamental rights attached to the persona of the human being, intended to protect non-patrimonial attributes or manifestations of the person.[1016]

(b) Sources of protection and rights under French law

Predominately statutory protection, for unauthorised use of one's image, is found under the *French Civil and Penal Codes*. However, it is only in very rare circumstances that the misappropriation of an image will be an action brought before the criminal courts. Although not used as often as civil actions there is protection under the *Criminal Code* and most notably under art.226(1), which states that there is the possibility of punishment on anyone who intrudes on the intimacy of another's private life by either:

1 capturing, recording or transmitting words pronounced in private or in confidence without the author's consent; or

2 fixing, recording or transmitting, through any device, the image of a person in a private place, without consent

Further protection is available under art.L226(8) which criminalises the printing of knowingly false stories or the printing of manipulated images of a person without the person's consent, whenever the false nature is not obvious or clearly indicated in the publication.[1017] In order to pursue an action under the *Criminal Code* the action must be brought within three years; the following must also be proved:

1 an intent to take or to disseminate the image, although a showing of wilful indiscretion is not required; and

2 that the image was taken on private property.[1018]

(c) Privacy[1019]

The right of privacy was not explicitly included in the *French Constitution of 1958*. Although privacy actions have been available since 19th Century, courts have taken a strict approach to invasion of privacy rights.[1020] The privacy tort is well established in French law and is contained within art.9 of the *Civil Code*.[1021] Traditionally, according to Picard[1022] the courts have tried to avoid allowing every aspect of public figures to

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[1016] E. Logeais, 'The French Right to One's image – A Legal Lure', Ent L.R. 1994, 163

[1017] Prince Rainier III v Voici, T.G.I. Paris, 17e ch., Correct., Mar. 6, 1997,

[1018] Ibid although French case law is littered with examples that appear to complicate the definition such as Foulon Pigianiol, where a beach with private and paying access was held to be a public place CA Paris, Mar. 11, 1971, D. 1971, 71

[1019] H. Delany and C. Murphy, 'Towards common principles relating to the protection of privacy rights? An analysis of recent developments in England and France and before the European Court of Human Rights' E.H.R.L.R 2007, 568

[1020] *Therond.* Cass. Crim., October 20, 1998, note of Pelletier (Semaine Juridique II 1999 p.474); Decision of the Cour D'Appel of Paris, February 27, 1967 involving Brigitte Bardot in which the judge stated that "the rights an individual has over his own image must not exclude show business artists or public figures". In *Société Mail Newspapers Plc v Prince X,* Cass. Civ., October 3, 1990, it was reiterated that "[e]ach and every person, irrespective of rank, birth, wealth, current or future position, has a right to privacy.

[1021] Introduced by The Law of July 17, 1970 Law No. 70-643

[1022] Picard, 'The Right to Privacy in French Law', in Markesinis (ed) Protecting Privacy (Oxford: OUP, 1999) 49 at 54

be open to the public.[1023] Privacy law within France applies to the same extent to both individual's and public persons and celebrities.

The ECHR was ratified in France in 1974,[1024] although the courts have traditionally been reluctant to refer to the Convention in their judgements, although this is now changing. This can be seen through recent case law in particular *Editions Plon v France (2006),*[1025] *Fressoz v France (2001)*[1026] and *Prisma Presse v France (2003).*[1027]

In 1995 the Constitutional Court ruled that the right of privacy was implicit in the Constitution,[1028] by stating that the freedom proclaimed in art.2 of the *Declaration of the Rights of Man and the Citizen 1789*[1029] implies the respect of privacy.[1030] The tort of privacy was first recognised in France as far back as 1858[1031] and was added to the *Civil Code* in 1970.[1032] In France, personality rights are based on dignitary rather than commercial concerns although the exercise of the rights can have commercial implications. An invasion of privacy would violate art.9 of the *Civil Code*[1033] which states:

> "Everyone has a right to respect for his personal life. In addition to the awarding of damages, orders such as sequestration and attachment can be granted, to prevent or stop an invasion of privacy."[1034]

The right to privacy entitles anyone, irrespective of rank, birth, fortune or present or future office, to oppose the dissemination of their picture without their express permission. This ensures that everyone enjoys an exclusive right to their image, as being a feature of their personality, whereby they may agree or not to the reproduction of the said image and refuse its dissemination, the same applies to their surname, forename or signature.

While France began with a strong right to privacy, created through legislation and case law the ECHR has caused a lessening of these protections in favour of an increase to the protection of freedom of

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[1023] H. Delany above n.1019

[1024] France ratified the ECHR in 1974 (Law No. 73-1227 authorising the ratification of the ECHR and additional protocols 1, 3, 4 and 5, December 31, 1973, Official Journal January 3, 1974, published pursuant to Decree No. 74-360, Official Journal May 4, 1974), Blackburn and Polakiewicz (eds),*Fundamental Rights in Europe: The European Convention on Human Rights and its Member States 1950-2000* (Oxford: OUP, 2000), Ch.13.

[1025] Editions Plon v France (2006) 42 E.H.R.R. 36.

[1026] Fressoz v France (2001) 31 E.H.R.R. 2.

[1027] Pisma Presse v France (Application No.71612/01), decision of July 1, 2003.

[1028] Décision 94-352DC du Conseil constitutionnel du 18 Janvier 1995. available at <http://www.conseil-constitutionnel.fr/decision/1994/94352dc.htm>.

[1029] Declaration des droits l'homme et du citoyen de 1789

[1030] Décision 99-416DC du Conseil constitutionnel 23 July 1999. http://www.conseil-constitutionnel.fr/decision/1999/99416/index.htm

[1031] The *Rachel* affaire. Judgment of June 16, 1858, Trib. pr. inst. de la Seine, 1858 D.P. III 62; above n.1026

[1032] Civil Code, Article 9, Statute No. 70-643, 17 July 1970

[1033] Article 22 of the Statute of July 17, 1970 incorporated into Article 9 of the French Civil Code this right

[1034] Civil Code (1977), Article 9, speaks of an *"atteinte à l'intimité de la vie privée"* which translates as an "attack on the intimacy of one's private life"

expression.[1035] The most high profile case was *Editions Plan*, which related to an injunction restraining the distribution of a book concerning the health of Francois Mitterand entitled 'Le Grand Secret.' The court ruled that the more time that had passed the greater emphasis would be placed on public interest than protection of privacy and medical confidentiality. Therefore the injunction constituted a violation of freedom of expression under art.10 of the ECHR.[1036]

The French courts have recently placed greater emphasis on art.10[1037] rights although this evolution has been more gradual than in the UK. The *Thonon des Bains*[1038] case shows the more balanced views of the court between art.10 of the ECHR and Art.9 of the *Civil Code*.[1039] The case related to the now President Nicolas Sarkozy and articles published in Le Matin concerning his martial difficulties. The court found that the couple had previously courted public interest and thus the articles in part formed the object of legitimate public interest. The court however found that information such as details of the separation, the extra-martial affairs of Cecilia Sarkozy had no public value and were protected under art.9, the couple were awarded nominal damages for this.

Dupré argues that art.8 of the ECHR inspired art.9 of the *Civil Code* although it is difficult to assess the impact of the ECHR on French privacy law as the courts rarely distinguish the two. Usually the courts focus on the balancing act between art.9 of the *Civil Code* and art.10 of the ECHR. The result of the ECHR has been to strengthen the use of art.10 and places the French privacy laws closer to the UK position.[1040]

In addition to the Civil Code protections there are also protections under the Criminal Code specifically arts.226-1 and -8. Article 226-1 covers intrusions on the intimacy of an individual's private life by either capturing, recording, transmitting words pronounced in private or in confidence with consent in addition to fixing, recording or transmitting, through any device the image of an individual in a private place without consent.[1041] As well as being subject to a fine an individual or a corporate entity who are found guilty of breaching the article can be imprisoned for up to one year.

Article 226-8 criminalises the publication of a knowingly false story or manipulated images (where the falsehood is not obvious or clearly indicated) without consent. Any criminal action must be brought within three years and prove that there was an intent to take or disseminate the image and that the image was taken on private property.

(d) **Publicity**

The right of image (also referred to in articles as the right on one's image) was originally established by case law to prevent an unauthorised fixation or reproduction of an image, relying on invasion of privacy or damage to one's honour or reputation.[1042] The right of image has since the latter half of the previous century

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[1035] K. Deringer, 'Privacy and the Press: The convergence of British and French law in accordance with the European Convention of Human rights', 22 Penn. St. Int'l L.R. 191, 2003

[1036] Contrast Plon above n.1025 with the admissibility decision in Prisma Presse above n.1027

[1037] Sté Cogedipresse et al. v Mme Marchand, Vve Erignac et al. Cass. Civ., December 20, 2000.

[1038] Although The *Tribunal de Grande Instance* is a Court of First Instance, inferior to the *Cour d'Appel* and the *Cour de Cassation.*

[1039] Nicolas S. v Journal *Le Matin* TGI Thonon des Bains, December 22, 2006

[1040] H. Delany above n.1019 at 578

[1041] Prince Rainier above n.1017

[1042] J. Hauch above n.1007 at 1237

emerged from being an off shoot of the right of privacy (right to image) into an independent right as illustrated in the case of Papillon, a case concerning a book recording a former criminal's life.[1043]

The right of image is traditionally found in the French Civil Code, and particularly in art.1382 from which four principles have been extracted through case law:

1. the medium which is used to reproduce or disseminate a person's image is not relevant;[1044]
2. the court's have condemned the unauthorised use of a performing artist's fictitious name that reflects their personality;[1045]
3. the person(s) must be recognisable in the reproduction of his or her image;[1046] and
4. consent must be clearly expressed for both the taking and the subsequent usage of a person's image.[1047]

The principles show that the protections are wide in scope due to the fact that the medium used to 'exploit' the persona is not relevant. This offers protections over photographs, newspaper articles, books and film to name a few. The identities of persona that are covered include fictitious names and nicknames which shows the extent to which the scope of the rights that are held by an individual. The main requirement to bring a successful action under the Civil Code is that the individual must be recognisable in the image. There has not been enough case law to fully examine the lengths that the courts will be willing to accept whether an individual is recognisable. For example in Germany, Oliver Khan a famous German goalkeeper was found to be recognisable from a picture of his back, whether the courts in France would be as willing to accept such a decision is unclear.

The requirement for consent both for the initial publication and for subsequent dissemination offers a stronger protection than is found under UK laws. Therefore even where an individual was willing to allow their image to be used in a certain way earlier in their career they could in theory prevent the republishing of the image once they had become more successful, and therefore maintain the 'market value'.

If an obviously commercial value to an image exists, then economic damage may arise. However, in the absence of this, the pre-existing privacy based personality right is still available to individuals and criminal sanctions can apply where the person's image is captured in a private setting.[1048]

Article 9 *Criminal Code* also protects the commercial interests of celebrities,[1049] as shown in case of Fabien Barthez who used the clause to claim damages for the reproduction of his name and likeness on

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[1043] T.G.I. Paris, ord. ref., Feb 27, 1970, II, 16293, note Lindon

[1044] For example a figurine doll in CA Versailles, June 30, 1994, D. 1995, 645, note Ravanas; and a cartoon character in a video game as in Phillippe Le Gallou v Fode Sylla, Jeu National Multimedia and the Front National, CA Versailles, Mar. 8, 1996, Gaz. Pal. 1996, 213

[1045] WS v Jourdain, Cass. 1e civ., Feb. 19, 1975, Ann. 199, 153, though protection may not extend to nicknames which are given by others, whereas fictitious names are usually unique and chosen by the person

[1046] Epoux Lavergne v R. Doisneau and Francois Bornet v R. Doisneau (Hotel de Ville case) T.G.I. Paris, 1 e ch., June 2 1993, Gaz. Pal. 1994, 16; also commented above n.1033; In well known persons it can be enough that their image is invoked or conjured up as shown in Pieplu v. Regie Francaise de Publicite, T.G.I. Paris, Dec 3, 1975, D. 1977, 211

[1047] Beatrice Dalle v RCS France, T.G.I. Paris, Mar. 6, 1996

[1048] The relatives of Francois Mitterand objected to photographs being taken without their knowledge, and subsequently published in a major magazine, of the recently deceased President at home, in bed; CA Paris, 11e ch., July 2, 1997, D.1997, 596

underpants.[1050] The availability of protections under the Criminal Code offers a stronger deterrent against unauthorised exploitation of an individual's persona, due to the remedies that are available to the court. For example under art.226 of the code the court can impose a custodial sentence on an infringer.

The principles described above show how French publicity protection has developed through both case law and legislation. As stated above the medium used in reproducing the image is not relevant as shown through case law covering dolls and cartoon characters. The simplicity of the wording "any person who performs an act that harms another person must compensate the other for the harm caused by that act", grants the courts the power to use a wide range of protections, which can be updated as new situations arise. For example the increased media interest on the internet of famous sporting and political celebrities was not an area that the code was drafted to protect but the fundamental intention of the article was to grant protections for acts both within and outside of the immediate contemplation at its creation.

If within France there was to be a recognition of a subjective dualist right enabling control of the use of one's image then there would be certain advantages.[1051]

1 it would facilitate and make more secure contractual deals involving someone's image;

2 the victim would more easily prove infringement of his right to exploit his image, with no need to claim invasion of privacy as well;

3 it would account for existing case law on celebrities' images and for the status of professional models; and

4 the law governing international disputes arising out of the right to the image would be determined as for copyright.[1052]

In support of his theory, Gaillard[1053] relied upon a similar precedent construction which is the "droit d'auteur' which, under French law, enjoys a moral and patrimonial dimension. Likewise, according to him, the right to the image is dual and its enforcement by French case law reveals striking similarities with the "droit d'auteur'.

This approach parallels the views of McCarthy,[1054] who stated that undoubtedly, the law today would be more coherent if it had developed in such a way that the courts could recognise a sui generis legal right similar to a "right of identity' with damages measured by both mental distress and commercial loss.

As discussed below there are safeguards to the protections granted, which are more wide ranging than in the UK e.g. the level of consent required. Additional defences are similar to those available within the UK such as freedom of speech and newsworthiness. There is no doubt now that under French law there is an exclusive right to protect their image from unauthorised use or dissemination, but although initially conceived as a spin off from privacy rights there is now a right of image enabling an individual to profit on the image itself.

[1049] Brigitte Bardot v Beaverbrook Ltd, Semaine Juridique 1966, No. 14521; Catherine Deneuve, D. 1976, 291 (14.5.1975)

[1050] F. Ponthieu, ‘France: Sport – Right to protection of your own image’, (2001) 12(6) Ent L.R. 59

[1051] E. Gaillard, above n.1029

[1052] Berne Convention

[1053] Gaillard, above n.1010

[1054] J. McCarthy above n.587 at 1.11, quoted by O. Goodenough, in ‘Pointillism, Copyright and the Droit d'Auteur: Time to See a Bigger Picture', [1994] 2 Ent. L.R.

(e) **Defences and damages**

(i) Consent

The necessary consent mentioned above must take place prior to the taking of a picture if in a private context, and prior to the disclosure of the image to the public, [1055] even when taken in a public setting.[1056] The consent must come from the subject of the photograph, unless they are a minor in which case the consent must be from a parental authority.[1057] In respect of prior consent for the subsequent use of an image that has previously been reproduced, the courts rely on the circumstances to infer a kindred personal right to protect,[1058] as well as utilising the questionable distinction between private and public places, which is discussed in greater detail below.

Even when the individual is a public figure consent is still required subject to the newsworthiness exception below. Where the exception is not proven then prior consent is also required where the enforcement of the individual's personality rights outweighs the public interest.[1059] The scope of any publicity campaign must be known and the person must consent to the extent of which the image will be used in the said campaign.[1060]

The French courts have asserted that a general waiver of the right of image for future use is not inferred from previous tolerations of past use of one's image.[1061] Although, despite this the courts may be more reluctant to order seizure or enjoin publication where the claimant has had a nonchalant attitude to the publication of their image.[1062] Though the claimant can still seek and recover damages for this unauthorised use.

(ii) Likeness

Physical likeness receives protection, in addition to photographic image. This was shown in *Depardieu v Suchard (1984)*[1063] where Gerard Depardieu won his action against a well-known chocolate manufacturer which used a British actor, who physically resembled the star, as a look alike in their advert without his consent.[1064] However the likeness must be to the person themselves and not a character they have portraying, unlike in Australia as shown in the *Crocodile Dundee* cases. Catherine Deneuve posed as "Marianne", the symbol of the French Revolution, for a sculptor. A photograph of the bust accompanied an advert for unconnected goods. She failed in her action because the court considered that the advert reproduced "Marianne", as inspired by the actress' face but not Ms Deneuve's herself. Consequently, the public could not have been confused into thinking she had endorsed the goods.[1065]

[1055] [Valery Giscard] d'Estaing v M.Ways, T.G.I. Nancy, October 22, 1976, JCP 1977, II, 18526, where the President prevented the sale of a card game in which he was depicted as the King.

[1056] Daniel Ducruet v Prisma Presse, T.G.I. Nanterre, ord. ref., Aug. 24, 1996

[1057] T.P.I. Poitiers, Oct 21, 1935, D.H. 1936, 45

[1058] Serge July, Ste Nvelle de Presse et Communication v Amar Tamarat, CA Paris, May 3, 1989, C.D.A., 273

[1059] Ste de Presse Jours de France v L'imperatrice Farah Diba, Civ. 1ere, Apr. 13, 1988, J.C.P. 1989, 21219

[1060] D. Bedingfield above n.674

[1061] Soc. Presse Office v Sachs, Civ. 2e, Jan. 1971, D. 1971, 263

[1062] T.G.I. Paris, May 8, 1974, D. 1974, 530

[1063] [Gerard] Depardieu v Suchard T.G.I. Paris, October 17, 1984, D.1985, Somm. 324

[1064] Ibid

[1065] Deneuve, above n.1049

The claimant must be identifiable and must be recognisable. A model who appeared in Doisneau's famous photograph 'The Kiss of the Hotel de Ville' was unable to sue over reproduction of the image in a magazine, because her the photograph largely concealed her face.[1066] It appears that French law requires use of the image or voice itself or a confusingly similar imitation, on the likely assumption that, in order to have misappropriation of the commercial value of a celebrity's image, the public must identify the celebrity and be misled as to his consent to the contentious commercial use of his image.[1067]

The cause of action is not just limited to commercial exploitation of physical appearance. The human voice for instance falls within this protection. Unauthorised recordings of Maria Callas rehearsing in private were actionable,[1068] as was the use of a sound alike of an actor's distinctive voice.[1069] In relation to pseudonyms they are only protected against unlawful appropriation provided the person laying claim to such name can show both a continuous and well-known use in the same sector of activity and the existence of a risk of confusion liable to cause prejudice to him.[1070]

(iii) Photographs taken in a public place

Individuals are not just protected within enclosed spaces, but also against the intrusive nature of long-lens photography such as that employed in *Bardot*[1071] and *Schneider*.[1072] The French High Court defined a public place as being "a place which anybody can have access to without special authorisation, regardless of whether access is subject to some specific conditions, timetables or reasons."[1073] If the subject of the image is taken in a public place then no prior express consent is required if:

1 the photograph or other form of image does not focus on, or single out, the individual or individuals claiming the right of image; and

2 the photographs must show the photographed person or persons engaged in public, rather than private activities.[1074]

The defence that the photograph was taken in a public place is invalid if commercial use is made of the photographs rather than for newsworthy reasons. This is shown by the court's rationale in *Rapho v UFC (1988)*[1075] when the court held that:

> "In such cases of publication, the photographed person is entitled to compensation only if their image is reproduced in an attempt to ridicule them or the caption of the photograph is

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[1066] Françoise Bornet v R. Doisneau GP 15 February 1994, 16.

[1067] E. Logeais above n.1012

[1068] T.G.I. Paris, 1982, D. 1983, 147

[1069] Epoux Above n.1046

[1070] Donia Trade Mark (Unreported) (Trib Comm (Paris)) (France); Nomos (Paris), 'France: Trade and Service Marks – Music – Stage names in the face of the Law of Trade Marks and Personality Rights in the Music Business', Ent.L.R. 2003, 14(6), 66

[1071] Bardot, above n.1049

[1072] Rosa Biasini (Romy Schneider) v Societe Union des Editions modernes and Daniel Angeli, CA Paris, Semaine Juridique 1980, No. 19343

[1073] G. Levasseur, 'Protection of the Person, the Image, and the Private Life (the Criminal Law)', Gaz. Pal. 996 (1994)

[1074] Paris, Feb. 27, 1981, Gaz. Pal. 1981.

[1075] Rapho v UFC, CA Paris, 1e ch. A, Sept. 27, 1988, Gaz. Pal. 1989

unpleasant or their features are used for commercial purposes from which it can be inferred that the person endorsed, for free or for a fee, the advertising use of their image."[1076]

(iv) Damages[1077]

Under French law exemplary damages are unknown, although the *Civil Code* allows recovery of damages, for physical or intangible loss (*dommages moraux)*, on the basis of fault. In cases where damages are awarded, the defendant's fault may be taken into account in assessment of damages, and there are suggestions from academic commentators that *dommages moraux* can be justified on the basis of the punishment of the defendant.[1078]

When concerned with the publication or distribution of the likeness of public figures, the judge may refer to a 'going rate' award on the basis of lost earnings the same licence fee test used in the UK for passing off. At most this is the equivalent sum to what could have been paid contractually, in accordance with the principles of the allocation of damages by virtue of arts.1382 and 1383 of the *Civil Code.*[1079]

Article 226-1 of the French Criminal Code allows in addition to an imprisonment of one year a fine of 300,000 francs (approximately 45,000 euros) if there was a violation of an individual's privacy through "fixing, recording or transmitting, through any device, the image of person in a private place, without their consent."

In addition to damages the Courts can and have awarded injunctions to prohibit the publication of unauthorised photographs,[1080] as well as having the power to award delivery up of the offending photographs.[1081]

(v) Freedom of speech and right to provide news information

Article 10 of the ECHR establishes and promotes the freedom of speech and information.[1082] The French Law on the Liberty of the Press, which is the backbone of the legal regulation of the press also provides for such freedoms.[1083]

An individual who participates in events that are likely to fall under the legitimate public interest falls under the realm of public information, and therefore lose protection over their image, provided that privacy is still respected.[1084] For the exception to take place, the photograph must be taken in circumstances directly linked to the events at stake or their factual consequences.[1085] The use of the information therefore must be for

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[1076] Ibid

[1077] H. Trouille, 'Private life and Public image: Privacy legislation in France', 49 Int'l & Comp. L.Q. 2000, 199

[1078] English Law Commission, Consultation Paper No 132, *Aggravated, Exemplary and Restitutionary Damages,* (1993) at para.4.19. See also R. David, *English Law and French Law* (London: Stevens 1980) p.166: "the Courts will inevitably take into account the gravity of the fault committed, although French law professes to ignore the concept of vindictive or exemplary damages..."

[1079] M. Henry above n.889 at para. 11.123

[1080] Claire Chazal v Ste Angeli, SNC Prisma Press T.G.I. Nanterre, ord. ref., Aug 2, 1996

[1081] French Civil Procedure Code Article 145 N.C.P.C.

[1082] Convention for the Protection of Human Rights and Fundamental Freedoms, Nov. 4, 1950, art. 10, 213 U.N.T.S. 221.

[1083] Law on the Liberty of the Press, Law of July 29, 1881, art. 38, D.P.IV, 1881

[1084] T.G.I. Paris, Sept. 10, 1996, D. 1997,

[1085] T.G.I. Paris, July. 3, 1974, II, 17873.

genuine information purposes, and commercial use of the image will preclude the newsworthiness exemption,[1086] although the Strasbourg Court did acknowledge the concept of commercial speech was protected under art.10.[1087]

The Law of September 30, 1986 may legitimise restriction even where there is a public interest in the right to publish. The Law, which regulates audiovisual communication, expressly provides for the respect of human dignity.[1088] While art.10(2) of the ECHR permits restrictions on free speech, which are "*necessary in a democratic society* ... for preventing the disclosure of information received in confidence...." French case law such as the *Bones of Dionysis*, (1989)[1089] recognised that art.10 places limits on protecting privacy interests.[1090]

The French doctrine "finalité" places restrictions on the presses ability to publish images of individuals. Freedom of expression is enshrined in art.11 of the Declaration of the Rights of Man and of the Citizen - part of the corpus of constitutional law and in the ECHR. Publicly known facts and images of public figures are not generally protected,[1091] although the use of an individual's image or personal history has been held actionable under French law,[1092] as shown by the book Le Grand Secret about Francois Mitterand.[1093]

(vi) Parody

French case law is clear that no prior consent is required when using a person's image for parody,[1094] and it is not for the court to determine whether the parody is in good taste or not. The courts have reasoned by analogy to the parody exception expressly provided under Copyright law[1095] that a parody of a copyrighted work is a non-infringing use.[1096]

Parody is a method of expressing and exercising one's freedom of speech and is seen as essential in a democratic society.[1097] By its definition a parody is not a depiction of truth or reality,[1098] and in order to qualify a parody must have a humorous,[1099] non-offensive,[1100] and informative purpose.[1101] The parody exception does not extend to mocking of a person or persons associated with a trademark.[1102]

[1086] Noah v Soc. Frse de Revues Team T.G.I. Paris, Dec 21, 1983, D. 1984, Somm. 331

[1087] Cour Europeenne des Droits de l'Homme (CEDH) Makt. Inter Verlag 1989; CEDH Feb 24, 1994, Casado Coca, Serie A No. 285

[1088] Law No. 86-1067, Sept. 30, 1986, as amended, J.O. art. 1 (Freedom of communication)

[1089] Judgment of Jan 31, 1989, Cass. Civ. 1re, LEXIS Pourvoi No. 87-15.139

[1090] J. Hauch above n.1007 at 1228

[1091] J. Robert & J. Duffar, 'Droits De L'Homme et libertes fondamentales', ch. V (*La Vie Privée*) (5th ed. 1994). In *Infringement of Privacy, Lord Chancellor's Department, Scottish Office (1993)* a patient gave confidential information to his physician who disclosed it to a small local newspaper which published it. The story was then taken up by the national press. The patient's suit to restrain publication was unsuccessful.

[1092] Fressoz above n.1026

[1093] T.G.I.Paris, 1st ch., Oct. 23, 1996., although in this case unsuccessfully

[1094] CA Paris, Mar. 11, 1991, Feb. 18, 1992, available in Legipresse no. 95, 112

[1095] Droit d'auteur

[1096] C. Civ. Art. L 122-5-4 (Fr.) Listing parody as one exception to the author's exclusive right to reproduction

[1097] E. Logeais above n.1012 at 531

[1098] C. Civ Art. L 122-5-4 (Fr.)

[1099] CA Paris, Mar. 11, 1991, Feb. 18, 1992, available in Legipresse no. 95, 112

(f) **Transferability and Descendibility**

(i) Transferability

The right of image prohibits unauthorised uses of a person's image which fails to respect his privacy. Consent is a prerequisite for the use of a person's image, therefore anybody can give their consent for free or bargain for compensation in exchange for it.[1103]

The silence within the law reflects the ambiguous nature of the right of image, which has not yet been expressly incorporated into statutory law, as occurred with privacy under art.9 of the *Civil Code*. This cautious approach has not prevented the courts from protecting the goodwill attached to professionals.

> "In the artistic field, fame stems from talent, work and lengthy, painstaking efforts along one's career, the person enjoying it is the only one to decide how and when to exploit it. Everybody is entitled to oppose any impairment of his or her persona, any prejudice to the representation which he or she may legitimately expect that people or the public will have of them."[1104]

Under French contract law, consent can be contractually granted, which has allowed the development of image licensing and marketing. However, contracts that are against public policy and morality standards are null and void. In addition due to the fact that the right of image is a personality right, a general and perpetual waiver or transfer could be successfully challenged in the courts.

Paradoxically present case law has, in respect to damages for unauthorised commercial uses of an image, awarded lower damages to well known personalities who have previously commercially exploited their image than to those who have yet to exploit their image.[1105]

(ii) Descendibility

Descendibility of the right of image depends directly on the characterisation of the right. If the right is based as an extension of privacy (extra-patrimonial) then the right will not be descendible, however if the right is classed as an economic right (patrimonial) then the right is descendible.[1106]

Under the majority of case law the right is not descendible to heirs,[1107] as illustrated with the case of French singer Claude Francois.[1108] Although the right is not descendible to heirs the courts have stated that heirs do have a right to object to the use of their father's image, if that image would be offensive to his memory, but this right is not assignable to third parties. The traditional rationale for denying descendibility is that the right of image belongs solely to the living person, as confirmed in the case of Paris Match and photographs of President Mitterand. The case affirmed that "the right of privacy only belongs to living persons and can not

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[1100] CA Paris, 4e ch. B, Nov. 22, 1984, D. 1985, I.R. 165.

[1101] T.G.I. Nancy, Oct. 22, 1976, JCP 1977, II, 18526 note Lindon

[1102] Civ. 2e, Apr. 2, 1997, D. 1977-411, note Edelman

[1103] J. Ghestin & G. Goubeaux, 'Treatise on Civil Rights: Individuals', L.G.D.J. 292, 1989, at 315

[1104] Christian Alers v Pierre unia, T.G.I. Paris, 1e ch., Apr. 20, 1977, D. 1977, 610 note R. Lindon

[1105] SEDEP v Drucker, CA Paris, 1e ch., May 20, 1987, D. 1987, Somm. 384, note Lindon & Amson

[1106] E. Logeais above n.1016

[1107] Cass. Civ. 1e ch., Oct.10, 1995, JCP 1997, II, 22765, note Ravanas

[1108] Societe Bonnet v Societe Cashart United Diffusion Moderne, CA Paris, 4e ch., June 7, 1983, Gaz. Pal. 1984, 2, 258, note Pochon & Lamoureux

be passed onto heirs."[1109] Nonetheless it has been accepted that the heirs can claim their own personality rights.

This idea was first seen in 1988[1110] where the court stated that "the use of an actor's image for advertising purpose is not offensive, yet it was subject to his heirs' authorisation for she could have derived profit from such use according to the law of demand on the advertising market."[1111]

This position was confirmed in the decision of *Les Editions Sand & M. Pascuito v M. Kantor, Mme Colucii (1996),*[1112] which stated:

> "Whereas heirs may seek relief for the harm caused by such violation only if the selection and display of the image is likely to impair the perception that the public may have of the deceased artist, they are entitled to full compensation of the economic damage stemming from said violation."[1113]

Statutory protection also exists to protect the right of performing artists to have their name passed on to their heirs, through art.L212(2) of the *French Intellectual Property Code.* A case utilised this article to enable descendibility in 1997,[1114] suggesting that the courts are willing to adjust a previously firm held belief that there was no descendibility in relation to the right of image. The courts have begun to seek an alternative justification for an argument concerning descendibility based upon protections of a commercial nature rather than the traditionally privacy based nature.

However, later in the judgment the court went on to make a strict interpretation of the article stating that "the descendibility of the right of respect of the performance and memory of the artist is based on the principle of a continuation of the defunct. Therefore, an heir may not exercise such right in his personal interest in an attempt to protect the image which he wants people to have of himself; he may only exercise this right in the sole interest of the deceased artist."[1115]

(g) Conclusion

The two separate rights although initially having been created from the same right have come to have separate values. The right to image is embodied in protecting a privacy interest and has granted an individual the exclusive right to their own image in order to oppose any unauthorised use or dissemination, and covers the extrapatrimonial aspects of the right.[1116] The right of image consequently cover the patrimonial aspects, which are the right to protect the marketable nature of such an image.[1117] Together the two rights cover both the negative subjective right to prohibit use and a positive economic right to commercially utilise or exploit such a right.[1118]

[1109] CA Paris, 11e ch., July 2, 1997, D. 1997, 596

[1110] Mme Brun v SA Expobat, T.G.I. Aix en Provence, Nov. 24, 1988, JCP ed G. 1989, II, 21329, note J. Henderycksen

[1111] Ibid

[1112] Le Editions du Sand & Pascuito v Kantor, CA Paris, Sept. 10, 1996 R.D.P.I

[1113] Ibid

[1114] Bertand Blier et Brigitte Blier v BNP, EURO RSCG France, Gaumont et Annette Blier, T.G.I. Paris, 1e ch., Apr. 23, 1997

[1115] Ibid

[1116] M. Serna above n.1011

[1117] E. Gaillard above n.1010

[1118] E. Logeais above n.1012 at 518

The result of these protections is, according to Logeais,[1119] that no sooner has the French right of image gained a life of its own than new evolutions have threatened its boundaries. On the one hand, the protection of the image of a person's belonging is more frequently claimed on traditional property rights grounds. However, the right is no longer the privilege of the sole individual, it becomes more difficult to assess its core nature.[1120] The French right to the image appears to remain in a somewhat schizophrenic state, with both extra-patrimonial and patrimonial aspects to it. He argues that the laws are unsatisfactory as they currently stands in relation to celebrities and highlights the copyright system introduced by the 1985 as an example. He believes that the law created second class moral rights and exploitation rights to performing artists but the scope is too narrow to include public servants, models and sportsmen. The result is that the image or persona of a celebrity is not perceived as a creative contribution in itself no matter how famous, sophisticated or unique, and they receive only specific rights through achievements materialised in works of authorship or performances.[1121]

Specific provisions are dealt with adequately but the constitutional protection of personality with its dignitary and commercial aspects has caused difficulties in case law, with Dietrich decision being an important new stage. Although referred to this discussion could be reduced and more focused to highlight the tension in these developments (pg232-5)

3.2 **Germany**

(a) Background

German law like the UK does not offer a right of publicity for the commercial value of a person's individual characteristics, such as name and image.[1122] Instead the legal protections against unauthorised appropriation of a persona are found in the General Right of Personality,[1123] first developed by the Federal Supreme court in 1954. The Court stated that the "general right of personality" must be regarded as a constitutionally guaranteed fundamental right based on arts.1 and 2 of the *German Constitution of 1949 ("GG").*[1124]In addition to these protections additional protections are afforded under s. 22 of the *Copyright in Works and Art and Photography Act 1907 ("KUG"),*[1125] granting protection against the distribution/exhibition of a person's image. Alternatively s.12 of the *Civil Code ("BGB")*[1126] grants protection over the individual's Right of Name."

The courts have developed the general right of personality, into a series of protection against unauthorized exploitation of commercial value and defamation.[1127] Initially the authors of BGB rejected proposals from leading scholars to create a comprehensive right of personality.[1128] The legislature decided to protect only

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[1119] Ibid at 542

[1120] Ibid

[1121] E. Logeais above n.1016

[1122] A. Jooss, 'Life after death? Post mortem protection of name, image and likeness under German law,' Ent L.R. 2001, 12(5), 141

[1123] Allegemeines Personlickhkeitsrecht

[1124] Grundgesetz 1949 also known as the Basic Law

[1125] Kunstrurhebergesetz 1907

[1126] Bugerliches Gesetzbuch

[1127] S. Bergmann, 'Publicity rights in the United States and Germany: A comparative analysis,' 19 Loyola Ent L.J. 1999, 479

[1128] J. Simon, 'The general right of personality and its commercial forms', Loyola Ent L.J. 1981, 189; H. Gotting, 'From the right of privacy to the right of publicity', G.R.U.R. Int. 1996, 656

certain specific interests under the general provision of the German law of torts and under the right of name. In 1907, the legislature created the "right to one's image"[1129] under ss.22 and 23 of KUG. The courts extended the "right to one's image" to protect other aspects of an individual's personality where the defendant acted against good morals.[1130]Like the UK, trademark and copyright law are available but offer limited protection under German law. Germany has created alternative protections under through the *Artistic Authors Rights Act*[1131] *("AARA")* and the *German Constitution*.[1132]

(b) Privacy

The German constitutional court has expressly embraced the jurisprudence of the ECHR, rejecting the traditionally held belief that the court's judgments were not binding upon domestic courts.[1133] This was re-emphasised under art.46(1) of the ECHR which requires all state organs to abide by the judgments of the court. This is not only applicable to past violations but continues to have practical significance for any ongoing or future cases.[1134]

As mentioned previously in the paper the *Von Hannover* case established that the German Courts had not given enough protection to art.8 of the ECHR in relation to art.10,[1135] in relation to the press coverage of celebrities, who are not undertaking public activities. The ECtHR held that the criteria of a 'figure of contemporary society par excellence' was too narrowly defined by the German courts.[1136]

The definition of such a figure is now, a figure who independently of singular events attracts public interest owing to his status and relevance. s.23 of the *Copyright (Arts Domain) Act* classifies the existence of intimate company of a 'figure of contemporary history par excellence' as an event of contemporary history, and they therefore would not obtain privacy protections as such. The German courts have emphasised that it is not only politicians and public servants who are of public interest,[1137] but also includes persons within fields such as of art, economics and sport.

Article 5(1) of the GG explicitly states that 'entertainment' media is covered by the right to freedom of the press.[1138] The freedom of speech is a fundamental provision within the GG, under art.5(1) there is a

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[1129] Recht am eigenen Bud

[1130] J. Helle, 'Specific personality rights in private law,' cited in 19 Loy. L.A. Ent. L.J. 479 (1999) at 501

[1131] Kunsturhebergesetz

[1132] Grundgesetz

[1133] F.Hoffmeister, 'Case comment Germany: Status of European Convention on Human Rights in domestic law', I.J.C.L (2006) 722

[1134] Ibid

[1135] H. Rosler, 'Caricatures and satires in art law: the German approach in comparison with the United States, England and the Human Convention on Human Rights', E.H.R.L.R (2008) 463

[1136] B. Muller & H. Munz, 'The protection of privacy in Germany: has anything changed since the Von Hannover v Germany decision?' Comms. L. (2005) 205

[1137] Reference to the opinions of the judges at the ECtHR - Barreto and Zupancic.

[1138] B. Muller above n.1136

guarantee for freedom of expression for individuals,[1139] the press and broadcasters. Freedom of speech is limited when the statement contains contemptuous critique or contains a defamation.[1140]

In addition to the ECHR rights , domestic law also protects certain core human rights, including right to privacy under the GG and more specifically under art.1(2).[1141] Further domestic protection is available for the right to respect for one's family life under art.6 of GG.[1142]

(c) Right to one's Image

As discussed below ss.22 and 23 of the AARA provide a right to control the publication of their picture. The interpretation of a picture is wide and includes likenesses to the person,[1143] even to the extent of the back of a goalkeeper.[1144] However, once the person becomes part of public life the protections are more limited for e.g. the exemption for personalities of history.[1145] The economic rights are retained when the personality is exploited in the field of advertisement or merchandising.[1146] In addition the German Parliament has passed a law to prohibit the paparazzi when in secluded places and their actions can now be a criminal offence under the *German Criminal Code* s.201(a).

The right grants individuals the exclusive right to determine whether to display and distribute their likeness. An unauthorised public distribution of the likeness is expressly prohibited under s.22 of KUG. However, there is an exception under s.23 for the publication of newsworthy events and likeness of "persons of contemporary history."[1147] Even where the subject is in the public eye they do not have to accept distribution of their image without prior consent,[1148] where the distribution is deemed to violate their justified interests.[1149] These justified interests include use of photographs for commercial gain, such as in advertising campaigns without the individual's consent, photographing them in their home or garden or in a secluded place, or in embarrassing situations.[1150] In addition to the German statutes, the ECHR is applicable as shown in *Von*

1139 *Entscheidungen des Bundesverfassungsgerichts* (BverfGE) 30, 173, 188-89--*Mephisto* (1971). See for the backgrounds, H. Rösler, 'Dignitarian Posthumous Personality Rights---An Analysis of U.S. and German Constitutional and Tort Law' (2008) 26 Berkeley J. Int'l L., 153.

1140 Then the freedom of speech deserves not preference and the utterance has no protection. See Gounalakis and Rösler, *Ehre, Meinung und Chancengleichheit im Kommunikationsprozeß* (1998) at 73.

1141 Article 1(2) of the Basic Law reads: "The German people therefore uphold human rights as inviolable and inalienable and as the basis of every community, of peace and justice in the world."

1142 Article 6 provides: (1). Marriage and the family shall enjoy the special protection of the State.(2). The care and upbringing of children is the natural right of parents and a duty primarily incumbent upon them. The State shall watch over them in the performance of this duty.

1143 *Marlene Dietrich* (2000) N.J.W. 2195, 2200, BGH.

1144 *Fussballtor* (1979) N.J.W. 2205, BGH.

1145 KUG, s.23(1).

1146 *Blauer Engel* N.J.W. 2201, 2202, BGH

1147 Personen der Zeitgeschichte; See Paul Dahlke (1959) G.R.U.R. 427, 428, BGH

1148 A. Vahrenwald, 'Photographs and Privacy in Germany', 1995, Ent L.R. 203

1149 § 23(2) KUG; See A. Vahrenwald, 'Germany: Personality rights – Computer game FIFA Soccer Championships 2004', Ent L.R. 2004, 15(5), 41

1150 H. Padley, 'Lord Coe left standing as Princess has fairytale ending in the European court', Ent. L.R. 2005, 16(1) 17

Hannover [1151], where it was held that Germany had breached Princess Caroline of Monaco's art.8 rights in permitting publication in the German press of various anodyne photographs taken in public places.[1152]

German courts have exempted most commercial use of portrait rights from the defences available under s.23 KUG.[1153] Advertising[1154] and merchandising of memorabilia,[1155] for example in general, require a licence, whereas edited journal articles[1156] and pieces of art, do not even where they pursue a commercial aim at the same time.[1157]

The concept of likeness under German law is broad and the form and medium of publication is immaterial, with the determining factor being whether the person is recognisable. It is sufficient for the reason for being recognised to be the result of clothing, gestures or hair-style, and it is even sufficient if only a limited group of persons knew who was being depicted.[1158]

The use of a look-alike does not fall under the scope of s.22 KUG as the confusion created falls under the protections granted by the general right of personality, discussed below. In addition if the use of the image is in a parody, there is only protection when there is danger of confusion or in situations where the parody amounts to defamation.[1159]

Klink[1160] believes that although the protections under the right to one's image happen to, in part, substitute for a publicity right this is not by design and has arisen as the right has grown from the protection against dishonourable public exposure to cover economic benefits of commercialised popularity.[1161] Klink also believes that as the right is an imprint of a constitutional human right its main difficulty is that it can be neither waived nor transferred.[1162] However in situations where the likeness of a person who has been deceased for under ten years is used then consent of the next of kin is required, this in the opinion of Bergmann is a quasi inheritable right that could form the basis of a more substantial and permanent right.[1163]

In the aftermath of *Von Hannover* concerning Princess Caroline, her husband brought an action against three newspapers, claiming they infringed *inter alia* other things his right to control his image.[1164] The case

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[1151] Application no 59320/00

[1152] L Skinner, 'You're a celebrity, madam. So do we have a right to share your privacy in a public place?' *Comms* L., 2004, 4, 118

[1153] O. Weber, 'Human Dignity and the Commercial Appropriation of Personality: Towards a Cosmopolitan Consensus in Publicity Rights?' (2004) 1:1 *SCRIPTed*

[1154] Bundesgerichtshof, Fuchsberger, (1992) Neue Juristische Wochenschrift 2084

[1155] Bundesgerichtshof, Nena, (1987) Neue Juristische Wochenschrift RR 231

[1156] Bundesgerichtshof, Kundenzeitschrift, (1995) Neue Juristische Wochenschrift RR 789

[1157] Bundesgerichtshof, Marlene Dietrich, (1999) BGHZ 143 at 214

[1158] G. Schricker & E. Gerstenberg, 'Copyright law,' §60/§ 22 KUG, no.2 (1987), using the example of Charlie Chaplin being recognisable by his moustache, bowler hat and walking stick.

[1159] H. Rosler above n.1135

[1160] J. Klink above n.351

[1161] Caroline of Monaco (2002) I.I.C. 33, BVerfG at 104-6

[1162] G. Schricker above n.1158 at no.6; Dietrich see above n.1143; Blauer above n.1146

[1163] S. Bergmann above n.1127 at 495

[1164] BGH U. v. 15.11.2005, VI ZR 286/04, VI ZR 287/04, VI ZR 288/04, not yet published, *www.bundesgerichtshof.de* (accessed 6 December 2005).

involved Prince Ernst driving at excessive speed in France, where he spent the majority of his time. The incident was widely covered by the German press who published articles about the incident and attached context neutral pictures to accompany the article. He claimed an injunction against further publication of the articles as the incident was not newsworthy and thus not covered under freedom of the press exception.[1165]

The court held that the newspapers had not infringed his right to control image under s.22 of the *Copyright (Arts Domain Act)*[1166] and his personality rights protected under s.823 and s.1004 of the BGB in conjunction with arts.1(1) and 2(1) of the GG.[1167] Although the court felt his personality right was infringed it was justified through the interests of the press outweighing his interests. The pictures that accompanied didn't pass on any protectable information, as they were unrelated to the incident itself, and therefore were allowed.

Amongst the courts reasoning was that persons, particularly those in the public light must accept publication of objectively true facts, even if this affects their reputation. The incident had taken place in the 'social sphere' which is seen as an area where that person has acted publicly or contributed to social affairs.[1168]

(d) Right of name

There is separate protection for the right of name, under s.12 of BGB, which protects the unauthorised appropriation of a name, with the likelihood of confusion being the determining factor within the meaning of the provision.[1169] The use of a name in public and in adverts is lawful unless there is an appropriation or defamation of the name.[1170]

The name of a person is the simplest and most elemental way to distinguish its holder and subsequently their personality. This is highlighted by saying that personal names may be called "trade marks of personality"[1171] in today's business of heightened commercialised popularity. Within s.12 BGB there is a much stronger control over the use of a name than is available under UK law.[1172] The BGB grants an absolute right to people to use their name and to restrict others from using it without consent. The provision

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[1165] B. Muller above n.1136 at 205

[1166] Section 22(1) provides that images can only be disseminated with the express approval of the person concerned. Section 23(1), No 1 provides for exceptions to that rule, particularly where the images portray an aspect of contemporary society, on condition that publication does not interfere with a legitimate interest of the person concerned (s 23(2)).

1167 For a reference in German, see *www.gesetze-im-internet.de/bundesrecht/gg/index.html* (accessed 6 December 2005):'Article 1(1) - Protection of the Dignity of Man The dignity of human beings is inviolable. All public authorities have a duty to respect and protect it. 'Article 2(1) - Freedom of Personal Liberty Everyone shall have the right to the free development of their personality provided that they do not interfere with the rights of others or violate the constitutional order or moral law.'

[1168] B. Muller above n.1136

[1169] Palandt & Heinrichs, Commentary to the BGB, no.20 (56th ed. 1997) §12

[1170] Catarina Valente (1959) G.R.U.R. 430, B.G.H.; Rennsportgmeinschaft (1981) G.R.U.R. 846, B.G.H. at 848

[1171] H. Gotting, 'From the right of privacy to the right of publicity', G.R.U.R. Int. 1996, 656, at 71

[1172] J. Klink above n.351 at 377

applies to any sign capable of distinguishing one name holder from another, first names,[1173] surnames,[1174] name abbreviations,[1175] artist names,[1176] nicknames, titles, seals,[1177] and picture signs[1178] are covered.

A case that was decided in favour of the claimant was in *Khan* v *Electronic Arts (2002)*,[1179] where Oliver Khan claimed that the right to his name and the right to his image, were being appropriated for use in a computer game. The court decided that even though the game had already begun to be sold within Germany, Khan's claims were justified as he never belong to the federations whose rights to names and images had been purchased by the defendant.[1180]

Thus when the German protection is stretched to its maximum it offers protection on almost all forms of unauthorised use of popular names from t-shirts,[1181] on book and film titles[1182] to fictional characters.[1183]

(e) Right to personality

The rights mentioned above in AARA are complemented by the statutory rights that protect the rights to one's name and picture and a general personality right that is based on arts.1 and 2 of GG. In reality this protection works as a safety net to cover all aspects of personality that have not been included in specific statutes. Article 1 states that the dignity of man shall be inviolable. To respect it shall be the duty of all state authority. Whilst art.2 says that everyone shall have the right to the free development of his personality in so far as he does not violate the rights of others or offend against the constitutional order or the moral code.

Although art.2 appears to be a broad provision,[1184] it is made less effective within Germany as s.253 BGB states that damages can only be awarded for damage to material assets, meaning that it is very difficult to successfully claim damages for the appropriation of personality features.[1185]

The German Federal Supreme Court has recognised, since 1954,[1186] the commercial interests in personality,[1187] and has called it a right of economic self determination.[1188] The following decade saw the consolidation and expansion of the right in various areas of protection for example the protection against

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[1173] Romy (1960) N.J.W. 869 CA (OLG) Munich; Uwe (1983) N.J.W. 1185 B.G.H.

[1174] Vogeler (1960) G.R.U.R. 490, B.G.H.

[1175] J.W. 21, 248 CA (KG) Berlin

[1176] Valente, above n.1170; Heino (1987) N.J.W. 1413 District Court (LG) Dusseldorf

[1177] B.G.H. 119, 237

[1178] Red Cross (Rotes Kreuz) B.G.H. 126, 291; Salamander German Reichsgericht (RG) 171, 155; Zwillingszeichen (1957) G.R.U.R. 288, B.G.H.

[1179] Kahn v Electronic Arts GmbH (Unreported, January 13, 2004) (OLG (Hamburg))

[1180] S. Smith, above n.313

[1181] Boris Becker (1990) N.J.W. 1106, B.G.H.

[1182] Romy, above n.1173

[1183] Mephisto B.G.H. 50, 133

[1184] S. Bains above n.2 at 164

[1185] Dahlke above n.1147

[1186] Leserbrief [1954] N.J.W. 1404, B.G.H.

[1187] Mephisto above n.1183

[1188] Rennsportgmeinschaft, above n.1170

invasion of privacy, the right to object against publication of intimate, offensive or libellous information or statements and of information suitable of harming a person's reputation, image or social standing.[1189]

Although the rights now cover economic aspects of the right to personality this was not the intention at their creation. The intention of the rights was to ensure that personal freedoms specifically privacy were guaranteed. The extension of the rights to cover the commercial aspects of the development of one's personality, has caused a number of difficulties within German case law.[1190] This is exemplified below and specifically with the important new stage of the law introduced by the decision in Dietrich.

(f) Transferability and Descendibility

The German "general right of personality" has been considered a personal right since its creation,[1191] and therefore transfer of ownership is not permissible,[1192] additionally the right is not descendible.[1193] By doctrine human rights, can not be objects of commerce. No one can sell, buy, or waive human rights. Consequently, the name right might not be waived, transferred or inherited.[1194] However, as discussed previously, the consent of the next of kin must be sought and gained if used within ten years of the person's death. During this period the kin have the authority to demand licensing fees and monetary compensation.[1195]

The landmark decision of *Marlene Dietrich* constituted a departure by the Federal Supreme Civil Court with its traditional views by awarding monetary compensation for post-mortem violations of personality rights. The case was a significant extension of the law as it recognised the inheritability of "patrimonial" elements of the "general right of personality". The significance of this decision was that previously the courts had denied the possibility of the right being passed onto the individual's heirs as by its apparent nature it was a purely "personal" right, and therefore tied to its individual bearer without the capacity to be inherited.[1196]

In respect of how other aspects of personality are concerned, the state of the law is not clear.[1197] Due to an absence of any specific statutory provision, it was again fell to the Federal Supreme Court to develop rules.[1198] The court have repeatedly stated that the legal protection of personality accorded by art.1 GG does not end at death.[1199] The general right to dignity and integrity survives, so that the image of the deceased continues to be protected, at least from gross injuries to their honour and reputation.[1200]This right to protection can be claimed by the decedent's next of kin within the meaning of s.22 KUG.

[1189] A. Jooss above n.1122

[1190] W. Van Carnegem above n.650 at 452

[1191] Dasch, Consent to the interference with the right to one’s image, 35 (1990) cited in 19 Loy. L.A. Ent. L.J. 479 (1999) at 513

[1192] J. Helle above n.1130 at 5

[1193] Gotting, above n.1171; Palandt above n.1169

[1194] Dietrich above n.1143

[1195] Ibid

[1196] A. Jooss above n.1122

[1197] J. Hennigan, ‘Altered image rights,’ Ent L.R. 2003, 14(7), 161

[1198] S. Bergmann above n.1127

[1199] Mephisto above n.1183 at 137; Frischzellen-Kosmetik B.G.H. 1984, 681, 426

[1200] Ibid; Emil Nolde [1990] Z.U.M. 180, B.G.H.

The court considered the protection of likeness in s.22 KUG, and held that it would be unacceptable, in light of the GG, if the personality of the artist could be freely imitated immediately after his death.[1201] This decision shows that posthumous protection can last as long as thirty years,[1202] whilst the protection lasts heirs can waive their right to protection and allow commercial use. The courts have now tried to establish that the rights to both privacy and publicity can in at least some circumstances be passed onto the individual's heirs. Klink however argues[1203] that the development of the case law in this way could result in a significant erosion of the separation between dignitary and economic rights. He argues that this dilution in addition to creating confusion about the extent to which a human right should be stretched to keep up with a publicity right, will more than likely result in the creation of a weaker personality right and an ineffective sort of quasi personality-publicity right.

(g) Conclusion

The protections available under German law are wide and numerous, however they are predominately personal rights that offer only limited economic protection especially post mortem. There is no doubt that Germany is still a far cry away from joining the US and Italy in recognising a commercial right of publicity.[1204] In addition the German rights confuse the distinction between a human right and a property right under their existing protections as shown in Dietrich.[1205]

The perceived standpoint of German law was discussed in the aftermath of *Von Hannover*[1206] where submissions were made on behalf of the Association of Editors of German Magazines, who argued that the existing laws placed Germany in a 'half-way' house between UK and French law. They believed that the existing laws were adequate and fair in terms of the rights of protection, specifically privacy rights, and freedoms of the press.[1207]

In reality as highlighted by Carty[1208] and Van Caenegem,[1209] the rights available under German law are a mixture of tort, copyright, human rights and restitution, with the exact protection depending on the characteristics of the case. Bergmann has stated that "step by step the right to one's image has moved away from the law of defamation ... and is turning into a commercially exploitable right".[1210]

[1201] OLG Hamburg G.R.U.R. 1989, 666

[1202] H. Gotting, above n.1171 at 71 (suggesting a post mortem right of 70 years); H. Schack, 'The right of personality of the creators and the performing artists after death', G.R.U.R. 1985, 352 at 359

[1203] J. Klink above n.351 at 381

[1204] A. Jooss above n.1122 at 147

[1205] S. Bains above n.2; T. Lauterbach, "US-style 'personality' right in the UK--en route from Strasbourg?", 20th BILETA Conference: Over-commoditised; Over-Centralised; Over-Observed: The New Digital Legal World? April 2005, Queen's University of Belfast

[1206] Von Hannover above n.140

[1207] L. Skinner above n.1152

[1208] H. Carty above n.288

[1209] W. Van Caenegam above n. at 650

[1210] S. Bergmann above n.1127 at 520

3.3 **Italy**

(a) Introduction

Italian law does not expressly provide protection for the right of publicity[1211] unlike the US through statute and common law.[1212] However, it protects the prevention of unauthorised commercial exploitation by utilising statutory enactments which protect individual privacy, one's image, one's name and to a smaller extent copyright. In addition Italian judges are authorised by statute to reason by analogy a process known as *analogia iuris* and *analogia legis*, which enables the judges to apply existing statutory rules on similar subjects. The Italian right of publicity owes much of its creation and continuing viability to this process.[1213] This is however one of the main obstacles to securing effective protection for the right of publicity, as it is not expressly enumerated by statute. Rather, the right of publicity exists as a result of the *Italian Civil Code's*[1214] empowerment of the courts to use the processes of *analogia iuris* and *analogia legis.*

(b) Statutory Protection for name, pseudonym, image and copyright

Article 6 of the *Italian Civil Code* provides a right to protect the integrity of one's name from improper or unauthorised use. Every person has a right to the name given according to law. The name includes the given name and surname. No changes, additions, or corrections of names are permitted, except in the cases and subject to the formalities indicated by law.[1215]

Article 7 offers additionally judicial remedies for violation of the right to name. Pseudonyms are covered under the protections from arts.6 and 7 where they are used by a person in such a manner as to have acquired the importance of a name.[1216]A person whose right to the use of his name is contested or who may be prejudiced by the use made of it by others, can judicially request that the injurious practice be terminated, without prejudice to the right to damages. The court can order that the decision be published in one or more newspapers.[1217]

The right of image, provides the ability to prohibit the use of one's photograph or likeness without authorisation. Article 10 provides that whenever the likeness of a person, or of his parent, spouse or child, has been exhibited or published in cases other than those in which such exhibition or publication is permitted by law, or in a manner prejudicial to the dignity or reputation of such person or relative, the court, upon request of the interested party, can order the termination of the abuse without prejudice to the right to damages.[1218]

[1211] H. Carty above n.12

[1212] S. Gatti, 'The "right" to the commercial exploitation of one's own popularity', Commercial Law Review, 1988, 355; R. Hoffman, 'The right of publicity – Heir's right, advertiser's windfall, or court's nightmare?' 31 DePaul L.R. 1, 1981, 1

[1213] S. Martuccelli, 'The right of publicity under Italian civil law', 18 Loy. L.A. Ent L.J. 1998, 543

[1214] Codice civile (now merged with the Commercial code)

[1215] Ibid [Person and the Family] art.6, translated in 1 Italian Civil Code and Complementary Legislation bk.3, tit. I, art.6

[1216] Ibid at art.9

[1217] Ibid at art.7

[1218] Ibid at art.10,

Italian copyright laws and specifically art.96 of the *Copyright Law 1941*, which provides that the portrait of a person may not be displayed, reproduced or commercially distributed without the consent of such person.[1219]

Consent of the subject is not required where the reproduction of the portrait is justified by his notoriety or his holding of public office, or by the needs of justice or the police, or for scientific, didactic, or cultural reasons, or when reproduction is associated with facts, events and ceremonies which are of public interest or have taken place in public. The portrait may not, however, be displayed or commercially distributed when its display or commercial distribution would prejudice the honour, reputation or dignity of the person portrayed.[1220]

(c) Judicial creation of the Italian Right of Publicity

The expansion of the right of image to the right of publicity began in *Dalla* v *Autovox SpA (1984)*.[1221] Although the right of publicity is a judicial creation, its legitimacy and viability are nonetheless supported by the *Civil Code*.[1222] The *Dalla* case was unique as the claimant's claim was not an infringement of his right to name under art.6 or 7 of the *Civil Code*, nor of his right of image or portrait under art.10 of the *Civil Code* or even art.96 of the *Copyright law*.[1223] This was because neither his name nor his image, face, features or picture had been used in the advert. Prior to *Dalla* most commentators believed that the misrepresentation of one's persona for commercial purposes occurred only with the unauthorised use of the celebrity's actual name or image. The use of this wider celebrity persona increases the purchasing public's desire.[1224]

Dalla argued that the use of the cap and glasses constituted a misappropriation of his persona because they created an immediate association of between himself and Autovox.[1225] In addition it was alleged that the advertisement damaged his reputation because consumers were likely to believe that he endorsed Autovox's products, despite the fact that he had previously consistently refused to appear in commercials.[1226]

The court held that the misappropriation of Dalla's persona had been accomplished not through the use of his name or likeness, but through the use of other indicia of his identity, namely the cap and glasses. Thus the infringement was not one of the right of image itself, but of the yet unrecognised right to publicity. The court recognised that the infringement of the right of publicity was derived from the appropriation of the singer's personal identity and had been used for purposes of trade, not for purposes of public interest in information. The judge granted Dalla's claim by relying on three main factors:

1 his constant use of the wool cap;

2 his degree of fame and notoriety as a musician; and

[1219] Law No. 633 of April 22, 1941, art.96, translated in 2 UNESCO, Copyright laws and treaties of the World ch. VI. § II, art.96 (1956)

[1220] Ibid at art.97

[1221] Dalla v Autovox SpA. Pret. Di Roma, 18 Apr. 1984, Foro It. 1984, I, 2030

[1222] S. Martuccelli, 'An up and coming – the right of publicity: Its birth in Italy and its consideration in the United States', Ent L.R. 1993, 4(4), 109

[1223] B. Bettelli, 'Italy: copyright – photograph', Ent. L.R. 2006, 17(5), N44

[1224] S. Gatti above n.1212 at 1

[1225] Dalla above n.1221 at 2032

[1226] Ibid

3 the graphic character of the advertisement.[1227]

A significant post *Dalla* case was *Baglioni* v *Eretel Srl and Disco Spring (1986),*[1228] which upheld the use of the right of publicity to enjoin commercial appropriation of one's persona. In *Baglioni*, the court held that the unauthorised reproduction of a popular singer's image and signature in the pages of a calendar constituted an infringement of his right to publicity.[1229] The court found that the misappropriation of the popular Italian singer Baglioni's persona could damage him in three ways:

1 by impairing his popularity and reputation;

2 by failing to adequately compensate him; and

3 by leading to the loss of control over the singer's own persona.[1230]

Another post *Dalla* case was *Vitti* v *Doimo SpA (1987),*[1231] where the court held that the unauthorised use of a look-alike of an Italian actress in an advertisement for a magazine misappropriated her persona for commercial purposes.[1232] The magazine had used a photograph of Vitti on the cover and an article with a section of her biography.[1233] The court found that this use of a look-alike was sufficient to violate Vitti's right of publicity.[1234]

The case law has shown that protection for misappropriation is available, if the misappropriation does not occur through the use of the person's name or likeness but rather through the use of elements and accessories which are identifiable by the public with a particular person. This view recognises that the persona of a public figure may have resulted from the cultivation of their public identity through artistic and professional work.

(d) **Elements of a cause of action**

The case law since *Dalla* has created, prima facie, four elements that are necessary for a right of publicity violation.[1235]

1 must be a public figure, not simply an ordinary person;

2 the defendant has used distinguishing characters of the celebrity;

3 unauthorised use of his popularity is for a commercial purpose, to convince the public that he endorses or sponsors the product; and

4 the unauthorised use of the celebrity persona caused immediate damage

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[1227] Ibid at 2032-3

[1228] Bagliono v Eretel Srl, Pret. Di Roma, 18 Feb. 1986, Il diritto di autore 1986, 215

[1229] Ibid

[1230] Ibid

[1231] Vitti v Doimo SpA, Pret. Di Roma, 6 July 1987, Il diritto di autore 1987, 570

[1232] Ibid

[1233] Ibid

[1234] Ibid

[1235] In civil law systems such as Italy, the concept of judicially created law and stare decisis do not ordinarily exist. Though each court can interpret the law independent of and, also in contrast to, prior rulings of higher courts in the same jurisdiction

The right of publicity prevents the misappropriation of the commercial value of the persona. The right does not prevent the diffusion of information concerning their private life,[1236] but rather the use of the persona in relation to unauthorised endorsements. Thus one must be a public figure, who has a quantifiable value attached to their persona to utilise the right of publicity in Italy.[1237]

Use of a distinguishing characteristic of the celebrity is a necessity for a cause of action, the characteristic does not have to be a physical attribute. Usually this is accomplished through the use of a statutory protected element such as the name, nickname or professional name of the celebrity.[1238] In addition the use of a likeness such as a photograph, drawing or videotape[1239] satisfies this requirement. The use of other distinguishing characteristics can also infringe the right of publicity as occurred in *Dalla*.[1240]

The use of the persona must be for commercial purposes, and the claimant must show that their attributes have been used in a similar manner. The Italian courts have used similar definitions to the US courts when determining what is commercial and what is non-commercial. Commercial areas include using characteristics such as likeness, name or distinguishing characteristics to advertise goods or services. Non commercial areas include using a person's identity in news reports, fictional or non fictional works.

It is a prerequisite that the claimant can prove that the use of their image has caused them damage. The damage that is caused must also be immediate in its nature.[1241] In assessing damages the court calculates the economic advantage gained by the defendant or the loss suffered by the claimant.[1242] The court can determine the "fair market value" of the persona, taking the degree of popularity and reputation of the celebrity in public.[1243]

(e) **Rationale for protection**

Although the courts pre-empted the scholars in terms of pushing for the right of publicity, there has still been discussion by Italian scholars as to the right of publicity.[1244] These have created four main rationale for the new right of publicity.

1 as a result of judicial interpretation of the right to image, the right of publicity protects individual's interests in personal dignity and autonomy;

[1236] The right of privacy includes the right to avoid unauthorised and unjustified intrusions into one's private life that could cause embarrassment and humiliation or distress

[1237] Dalla above n.1221 at 2032-4

[1238] Codice civile [Person and the Family] art.6, 7 and 9, translated in 1 Italian Civil Code and Complementary Legislation bk.3, tit. I, art.6, 7 and 9

[1239] Ibid at art.10,

[1240] Dalla above n.1221 at 2033

[1241] A. Barenghi. 'The price of (missed) consent: The damage of image exploitation and its liquidation', Riv. Dir. Inf. 1992, 565

[1242] App. Milano, 9 apr. 1976, Trib. Torino, 15 Jan. 1994, Dir. Inol. 1994, 223 (so called price of consent)

[1243] S. Gatti, above n.1212 at 362

[1244] Garutti, 'Combination of the image of a well known personality to the aim of differentiation', Diritto Dell 'Informazione E Dell'Informat 560 (1990); A. Marini, 'From Sophie Loren to Stefania Sandrelli: Evolution or Involution of the Jurisprudence?' Giust Civ. 1990, 2371; V. Metafora, 'The myth of Narciso and the jurisprudence: About the right to own one's portrait', Riv. Crit. Dir. Priv. 1990, 867; M. Ricolfi, 'Issues about the legal system of the commercial exploitation of the image', Nuova Giur. Civ. Comm. 1992, I, 44

2 the right secures the commercial value attached to a public figure's persona and prevents unjust enrichment[1245] of those who have misappropriated it;[1246]

3 prevention of harmful or excessive use of the persona that may damage or dilute the commercial value of the identity; and

4 although proof of deception or confusion is not a prerequisite of a cause of action, the right indirectly prevents customers from false suggestions of endorsement.[1247]

(f) Right to Publicity for Foreigners

Under the rule of mutuality a foreigner can profit from the civil rights, as the civil law recognises that foreigners have the right to initiate legal proceedings which are available to Italian citizens in order to protect the enjoyment and exploitation of one's rights.

However, the right of publicity includes protection provided for the right of image, which is a right of personality. Under Italian law personality laws are determined by the state of where the claimant is domiciled.[1248] Thus the court would need to judge in a case of right of publicity, whether or not the state law of the foreigner recognises the right of publicity.

(g) Transferability and Descendibility[1249]

The distinctive characteristics that are covered under the protection granted by the right of publicity can be separated from the celebrity for commercial purposes. Thus enabling the rights attached to one's persona to be theoretically transferable to third parties.[1250] In relation to descendibility there are varying views in relation to whether it exists under the Italian right of publicity,[1251] therefore the situation is as yet unresolved in Italy. The courts have continued to follow the lead from the US, namely that exploitation of a persona's image will be protected, however this right is more likely to be protected if the person it was exploited during the celebrity's lifetime.[1252]

(h) Conclusion

In conclusion there is no doubt that a right of publicity now exists in Italy, and the right that has been created is similar to the rights existing in the US. Although judicially created rights are uncommon in civil law jurisdictions, Italian courts are authorised by statute to "reason by analogy" and apply provisions that regulate similar cases or analogous matters.[1253]

The protection of publicity rights of celebrities allows them to take advantage of the benefits of their efforts. This protection will also ensure the avoidance of unjust enrichment that can be created by the unauthorised

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[1245] l'arricchimento senza causa; Codice civile [Obligations] art.2041-2, translated in 1 Italian Civil Code and Complementary Legislation bk.6, tit. VIII, art.2041-2

[1246] T. Watkin, The Italian Legal Tradition, Ashgate Publishing Group, 1997

[1247] A. Langvardt, 'The troubling implications of a right of publicity "wheel" spun out of control', 45 U.Kan.L.R. 329, (1997) at 352

[1248] Law No. 218, of May 31, 1995, art. 24 (Suppl. Ord. Gazz. Uff., June 3, 1995, n.128)

[1249] S. Martuccelli above n.1222 at 109

[1250] S. Gatti, above n.1212 at 364

[1251] R. Ausness, 'The right of publicity: A "Haystack in a hurricane', Temple L.Q, vol. 55, no.3, 1982, at 977 (see also "The survivability issue", at 994).

[1252] Lugosi above n.602

[1253] S. Martuccelli above n.1213 at 563

exploitation of a celebrity's popularity. Italian courts use the interpretation of the statutes to protect the publicity rights, in order to recognise the social and economic value of providing the protection.[1254]

CHAPTER 4

4 Analysis and Cross comparison of Privacy and Personality Rights

4.1 Privacy

The privacy rights examined within this paper are doctrinally different but are based upon similar protections and theories, as shown by the development of breach of confidence and passing off actions in the UK and Australia. The similarities for bringing an action are exemplified with the removal of the requirement of a confidential relationship as shown in *Lenah*. Although there are significant similarities the actions do not have the same scope within all the examined countries as shown by the narrower interpretation of confidence within Australia as shown by the need for the information to have been removed within surreptitious means.

The US right of privacy stemmed from the UK case of *Prince Albert*. The case was influential in both jurisdictions, with the result in the US being the beginning of a tort of invasion of privacy, which has subsequently been adopted in numerous states in various guises. The result of the case within the UK was to start the gradual progression of breach of confidence. The US system of privacy is more definitive in relation to the extent of the privacy action, for example in Florida both the false light invasion of privacy and public disclosure of private facts are covered, creating a greater certainty of the scope of the act than were previously available in the UK.

The privacy protections had developed both prior to and post the enactment of the HRA and now covers a wide range of situations than its initial intention. Within all of the examined countries there are exceptions to the right of privacy, as discussed below.

(a) Defences including freedom of speech[1255]

The ECHR has brought to the forefront the issue of freedom of speech and the press and the protection of privacy. The UK has seemingly given greater protection recently to art.8 than art.10 in case law. This has not traditionally been the case within Germany who in the case of *Von Hannover* were found to have given too wide protection to freedom of speech which is a fundamental protection under art.5 GG. The court found that Germany needed to give greater protection to celebrities and public persons even when in a public place.

In contrast France has undergone a different path with an increase in protection of freedom of speech in relation to privacy protections post ECHR.[1256] The more gradual development is in comparison to the development of freedom of expression in the UK. The *Sarkozy* case has shown that the courts are now prepared to allow the public interest test greater flexibility in situations where information was not trivial or very private. This is also being tested in relation to public persons being in public at the time of an event. France has additional protections than those granted under the ECHR for freedom of speech as covered in the French Law on the Liberty of the Press. Assuming that basic dignity and privacy are not infringed[1257] then the French laws allow publication where the event or information would be of legitimate public interest.

In Italy the public interest defence is encapsulated within art.97 of the *Copyright Law*, which allows the reproduction of a portrait, and presumably names, where it is justified by their notoriety or public office and is

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[1254] R. Sacco, 'The enrichment gained by means of a tort', 1959 cited in 18 Loy. L.A. Ent. L.J. 543 (1997-1998) at 563

[1255] J. Craig above n.940 at 174

[1256] K. Deringer above n.1035

[1257] Law No. 86-1067, Sept. 30, 1986, as amended, J.O. art. 1 (Freedom of communication)

associated with the facts or events which are of public interest. This defence has not yet been tested in the aftermath of *Von Hannover* which may curtail the wide interpretation of this article.

Common law countries such as US and Canada also hold freedom of speech as a fundamental right, requiring strong rationale to restrain them. Within the US the First Amendment crystalises the freedom of expression protections. The first amendment allows discussion and legitimate commentary of public persons lives. There is strong protection for entertainment purposes, stronger than within the UK where there seems to be a requirement to prove art.10 of the ECHR whereas in US the emphasis is more on proving privacy that the freedom of expression.

Within Canada freedom of expression is granted the same weight as the of right of as privacy. For example within Quebec both are covered under s.2(b) of the Charter of Human Rights and Freedom, which guarantees "freedom of ... expression, including freedom of the press and other media of communication". This places the protections on a similar level to the UK, where both rights are part of the ECHR enacted in the HRA. The Canadian privacy laws, in relation to freedom of expression, appear stronger than those currently applied within the UK, as shown in *Aubry*[1258] where publication of a photograph without consent was held to violate the right to private life. Although the courts maintain that each right is treated equally. In Canada, unlike in the UK, unintentional infringement is no defence, thus placing even stronger protection on the privacy right.[1259]

(b) **Descendible/Transferability**

Two similarities between all of the privacy actions, discussed in this paper, are that privacy is treated as a human right and doctrinally is non-transferable or descendible, and thus can not be directly enforced by the family of an individual. An exception to this is a provision within the US protections is where a family member can claim if the infringement directly affects their privacy rights at the same time,[1260] as claimed in *Tyne.* The right to name and right to image can indirectly be protected within Germany under s.22 KUG. Although the courts have seen this as an extension for protections to publicity or personality rights rather than in relation to privacy rights. The availability of this provision is due to the fact that under German laws privacy is protected both as a human right and a proprietary right.[1261] The courts rationale is that it would be abhorrent for image of a deceased person to become free property which could be caused gross injury to their honour and reputation.

A second similarity is the availability of remedies for invasion of privacy, as shown earlier in the paper, common law damages for breach of confidence in the UK had been more restrictive prior to *Mosley* than were available in other jurisdictions. The value of damages awarded under the US protections has traditionally been higher and based upon the mental distress that was caused as a direct consequence of the intrusion.[1262] Within Canadian provincial law there is the possibility of damages to be awarded for the unauthorised appropriation of name or portrait even if there was no damage caused. In addition to damages all of the countries examined offer injunctions to prohibit further publication or restrain the initial publication. In France there is an additional protection available to be award sequestration of the offending materials.[1263]

All of the countries examined above have awarded their courts the power to impose damages for any mental distress suffered by the claimant, although not all jurisdictions specify a separate award for this, in some jurisdictions this is contained within a single award for breach of privacy. Additionally all of the countries

[1258] Aubry above n.931

[1259] Bogajewicz above n.925

[1260] Santiesteban above n.662

[1261] Mephisto above n.1183 upheld in Frischzellen above n.1199; Emil Nolde above n.1200

[1262] Cason above n.594

[1263] Civil Code (1977), Article 9

discussed can award an injunction preventing either the initial publication of the offending action i.e. photographs, newspaper article or advertisement or a follow up publication if further damage would be suffered. Each country weighs up the availability of an injunction with the respective public interest tests. An alternative remedy available within the UK is an award of delivery up of the offending materials e.g. under the TMA.

4.2 **Personality rights**

(a) **Style and setup of the personality rights**

As discussed previously the UK rights are contained within a number of actions that have been developed to cover personality rights. The most common protection that is claimed within the UK for this kind of action is passing off which has moved on to such an extent that it now incorporates aspects of misappropriation from its original protection of misrepresentation.[1264]

The protections offered in the UK are mirrored by those in Australia, although passing off has been adapted earlier and more broadly than in the UK.[1265] The protections within Australia are described as right to merchandise.[1266] Additional protection is given under the *Trade Practices Act* which does not require reputation or need to prove damage, which shows an extension of passing off that is currently unavailable with the UK.

Canada offers a specific tort of appropriation of personality that covers gaps left by the passing off protections,[1267] although it contains aspects of passing off, such as the public confusion requirement in effect its a hybrid of the UK and US rights. Germany and France like the UK rely upon various separate rights rather than a specific right of publicity. The *German Constitution (GG)* under arts.1 and 2 in addition to the right of name under s.12 BGB and s.22 KUG provide much broader protections than are currently available within the UK. Although the French rights were created through existing privacy rights as in the US, they protect rights in various ways through personality rights both civil and criminal in nature.[1268] Protections for likeness to a person are available but not if they are 'in character' as is the case with voice protection.

As shown above the US and Italy have chosen to adopt a full right of publicity,[1269] the US system is a state based system is based upon misappropriation rather than misrepresentation as occurred in UK passing off. The areas covered by the right are the same as those covered under passing off namely name and image in addition catch phrases and voice is also covered. The right of publicity unlike the UK does not require any previous use of personality or goodwill. In addition to the right of publicity there are additional protections within copyright and the *Lanham Act*, offering superior protections to those available within the UK. The second country that has adopted a right of publicity was Italy, which was created through the *Civil Code*, protection for the right of name and image under arts.6 and 10 of the *Civil Code* are complemented through art.96(1) of the *Copyright law.* As with the US system it is based upon misappropriation rather than misrepresentation. Lookalikes are also covered under the protections.[1270] The US right of publicity is available to all citizens whereas the Italian rights are only available to public persons.

[1264] B. Pillans above n.14

[1265] S. Boyd above n.675

[1266] A. Dufty above n.806

[1267] H. Carty above n.12

[1268] Prince Rainier above n.1017

[1269] T. Antony, 'Is there a right of collective personality?' [2006] E.I.P.R. 485

[1270] Vitti above n.1231

(b) **Defences**

The UK like Canada, US and Australia does not allow unintentional infringement as a legitimate defence to appropriation of personality rights. Further similarities between the protections of both civil and common law countries also include the public interest tests and the importance attached to the freedom of the press.

The UK balances the rights of privacy with freedom of expression under art.10 of the ECHR, with established case law granting guidance as to how the court's will balance the individual rights. Where the individual is engaging in a private family or personal act the courts had leaned towards granting protection, but have been less inclined to grant the same protection to matters involving sexual acts or where the individual has previously lied about the situation, such as in Campbell.

The US has freedom of expression protections enshrined within the First Amendment, which ensures that where the persona is being used for legitimate news stories or public commentary then the right of publicity is not infringed. Within Canada a similar test applies which results in the defence not being available for commercial or merchandise use, but is applicable in newsworthy scenarios.

The civil law countries are all ruled by art.10 of the ECHR, which covers freedom of expression and ensures that newsworthy stories and genuine public interest protections are upheld. In addition each have their own domestic protections for example in Germany s.23 of KUG, which has a more generous public interest test for public persons, particular when it comes to reporting true facts. In France the fact the image for example occurs in public is no defence when the image is used for commercial purposes.[1271] In France unlike in the UK a defence of parody is also available in addition to the other protections available in the UK.

(c) **Damages**

All the domestic courts discussed above retain the power to award damages but each have different methods of quantification. The UK and Italy both have a requirement that damages must be proven, for example that the trade or goodwill held by the individual has been diminished by the defendant's action.

The damages awarded in the UK for endorsement cases are considerably lower than those awarded in the US and are quantified on a 'lost licence fee' basis. In the US for example *Waits*[1272] was awarded $2.5m in 1992 whereas the highest compensation awarded to a celebrity in the UK is *Irvine* who was awarded £25,000 in 2003. The lost licence fee test is also available within Australia, Canada, France and Italy.[1273] A problem with the lost licence fee test is that it only takes regard of the current value of an individual, therefore an individual who has deliberately sought to exploit his persona to maximise the revenue that it can command.

In addition to the lost licence fee other tests include an award of the claimant's pecuniary loss or the defendant's pecuniary gain which are available in both the US and Italy but not in the UK. An account of profits is a third alternative within the US, which also retains unlike the UK, the possibility of punitive damages.

The Civil law systems have a different approach to the US and Canada when it comes to quantifying damages and have traditionally been more similar to the UK in awarding lower levels of damages.[1274] The civil law countries have sought to quantify the awards of damages on a compensatory basis rather than seeking to punish a defendant through punitive damages where they have committed an intentional offence.

[1271] Rapho above n.1075

[1272] Waits above n.671

[1273] M. Henry above n.889

[1274] E. Logeais above n.1012 at 511

(d) **Descendibility/Transferability**

The UK allows personality rights to be transferred as shown by Trade Marks and Copyright Act, the situation under passing off is more debatably however as it is unproven at the highest courts but as current academic thinking says the right is classified as a proprietary right rather than a human or dignitary right it is like to be both transferable and descendible.

The UK has not established a precedent in relation to the descendibility of rights under passing off. The US has however established the length of post mortem protections, which varies between the separate states vary from no post mortem protection to 100 years. It is likely however that if the UK courts award post mortem protection they would not the Washington state system, which currently awards different protections for personalities and individuals. The UK courts would more likely focus on the question of whether the individual has the prerequisite goodwill as without it there would be nothing to protect.

Italy has shown that rights are transferable for commercial reasons but the descendibility question has yet to be conclusively answered, although the indications are that the Italian courts would follow the lead of the US courts and grant descendibility to one level or another.[1275] Wider protections are available in Australia in the UK, although Australia has also faced a similar question in regards to the availability of post mortem protections under passing off and the TPA.[1276] The tort of appropriation in Canada has not set a fixed time limit for protection preferring to examine each case individually on the subject of the facts. There is however a strict newsworthiness and public interest test, which is taken into consideration when deciding whether or not to grant the post mortem right.

The situation within Germany and France is however very difficult due to the dual nature of personality rights, which have two distinct aspects the patrimonial (privacy based) and the extra-patrimonial (economic). The result is that the economic aspects are transferable and descendible, e.g. for 30 years under s.22 KUG.[1277] The privacy rights are 'human rights' however and thus are not inheritable or transferable. An exception is however available in France where family members can protect the reputation of a deceased person for ten years.

4.3 **Overall Conclusion**

This paper has outlined the piecemeal protections available to individual's within the UK to protect their privacy and personality from unauthorised appropriation. The UK law has developed slowly through a mixture of statutory protections and case law, and although there has been much academic commentary, this has had notably less influence than in the US.

With privacy laws in the UK, the most important and cited action has been breach of confidence, which has evolved from protection of commercial relationships to protection of personal information. The action has undoubtedly become wider than it was initially envisaged for and has been increasingly used since the inception of the HRA and now has two distinct strands of protection.. The action appears to now be at a situation where there is increasing certainty over what is covered and how strictly the public interest test applied. *Mosley* showed that the trend for stronger privacy controls has continued to an extent under which it appears that extra-marital affairs, at least photographs or film and probably written descriptions, are covered under art.8 of the ECHR as the right to respect for one's private and family life. The strict test for freedom of expression has re-emphasised that what interests the public is not necessarily in the public interest.

[1275] S. Martuccelli above n.1222

[1276] It is possible for misleading or deceptive conduct under the TPA may survive the death of a party although this is still an open question; Premiership above n.835

[1277] Dietrich above n.1143

Although as shown earlier within the paper there has been a push for a specific and explicit invasion of privacy tort or right to privacy, it appears unlikely that there will be any such significant shift towards a system similar to the US in the near future. The current protections although created through doctrinally inappropriate circumstances are now such as to be recognised as offering wide and satisfactory protections for privacy. The enactment of the HRA has undoubtedly been a strong factor in the increase in privacy protections within the UK as has been exemplified in *Campbell* and *Douglas*.

In relation to the personality rights available within the UK the paper has shown that they are still in a state of slight confusion. This is particularly shown with passing off which has continued to develop away from its original creation. The removal of the requirement for a common field of activity and the progression from being misrepresentation based to increasing incorporating misappropriation has shown the flexibility of the cause of action. This flexibility however can create confusion and uncertainty as to the exact limits of the action.

In addition the damages available under passing off although increasing, notably in *Irvine*, are still extremely limited and in reality in an era of multi million pound advertising budgets are hardly an effect deterrent. If the UK were to follow the course taken by Canada's tort of appropriation of personality this would ensure that a number of gaps that are not currently covered by passing off were removed and this would additionally avoid stretching passing off even further beyond its initial remit. The UK continues to not recognise punitive damages at common law, such an extension of damages to include the pecuniary gain of the defendant, pecuniary loss of the claimant or an account of profits would present a more significant deterrent. The courts would be able to enforce the different damage awards in different circumstances such as a lost licence fee where the infringement was genuinely unintentional, whereas flagrant disregard for the action could be punished through an account of profits. The action is currently in my opinion reactive to problems that have occurred rather than looking to be a preventative measure.

The other protections available for protections for personality are limited in their effectiveness within the UK, there have been numerous unsuccessful applications of Trade marks. This area therefore offers complicated and often expensive protection that may be ineffective as the trade mark can still be used in circumstances where the image is being used to describe characteristics of a good or service. The trade mark system was not designed to protect marks for mere licensing or merchandising purposes.

Copyright protection also has a limited applicability with regards to protection of an individual's privacy or persona. This is due to the fact that where a photographic image is taken, unless commissioned, the copyright resides with the photographer rather than the subject. This is in comparison to the significantly tougher laws described above that are enforced in France and Italy, where the subject must give permission for their image to be used when not related to newsworthy events.

Malicious falsehood is a cause of action that had little use within the UK and could offer greater persona protection than has been currently tested within the UK.[1278] Malicious falsehood like passing off and breach of confidence has been developed from its original intention, it does however, retain strong relevance to comparative advertising cases and inaccurate but not defamatory commercial speech. Despite this it is likely to be mostly utilised as one of a number of separate actions claimed.

In conclusion the protections available for UK celebrities and public persons are satisfactory without being as comprehensive or as complete as they could be. The tradition of adapting causes of action to fit current requirements shows no sign of stopping or being replaced with a purpose made right of privacy or right to publicity. The UK legislature has allowed and indeed encouraged the common law to develop in line with new issues as and when they occurred rather than trying to pre-empt potential issues. The enactment of the HRA is the single most significant single development upon privacy laws within the UK, although there had also been a continuing development of breach of confidence prior to the HRA. The courts apparent

[1278] G. Crown above n.443

happiness to horizontally apply the ECHR through s.6 of the HRA has resulted in a large increase in the application of the breach of confidence action.

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