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**“A Right of Personality for the UK:
A comprehensive study of its
significance, rationality, and its
impacts on UK celebrities.”**



The City Law School, City St George's University of London

**This thesis is submitted in fulfilment of the requirements for the award of the
degree of**

Doctor of Philosophy

By:

Shajid Chowdhury (S140026566)

[Supervisors: Mr Enrico Bonadio & Mr Patrick Goold]

June 2025

Declaration

I, Shajid Chowdhury, confirm that the work presented in this thesis is my own. Where information has been derived from other sources, I confirm that this has been indicated in the thesis. I further confirm that this thesis has not been submitted for the fulfilment of any other award or qualification at any other academic institution.

Shajid Chowdhury

Abstract

The English legal system currently does not recognise a right of personality, nor does it confer any exclusive rights in a celebrity's name, image, likeness or identity. Absent such rights, protection against unauthorised exploitations of celebrity personality is only piecemeal, in that, the English courts 'stretch' the existing legal doctrines to remedy such misuses. The tort of passing off has been stretched the most in this regard, but owing to its requirement of misrepresentation, even the obvious cases of persona misappropriation could not be accommodated. Even privacy-based tort of breach of confidence was invoked, but privacy could not form the basis of protection as the object of protection under privacy is fundamentally different from that of under personality. The established IP rights, like trademarks and copyrights, were also applied, but it failed to deliver, since none of these principles were originally designed to accommodate personality claims. Such inadequacy and ineffectiveness of the available legal remedies have created a 'lacunae' in the English law, as the system is failing to provide the celebrities their desired levels of protection or any at all. The thesis addresses this lacunae in law and advocates that the only solution lies in adopting a distinct right of personality in the system. Proposing so is both pragmatic and practicable since such rights can only remedy personality misappropriation, and most importantly, adoption of such rights have provided the necessary solution in many other legal systems around the world. This thesis conducts a thorough analysis of the rationales that commonly underlies such personality rights and by evaluating the views of both proponents and opponents, constructs the legal foundation/basis of the right. A comparative study of ten (10) jurisdictions, combining both common-law states (like USA, Canada, etc.) and civil law states (like Germany, France, Italy, etc) is also conducted and based on the experience and practice of such compared states, potential models for a right of personality have been recommended in this thesis as the solution. The models recommended are designed to meet the modern realities of persona exploitation and is influenced by the current English IP regimes and the international jurisprudence available on personality rights. The proposed models are also designed with an in-built check and balance mechanism so that any monopolistic application of the right can be minimised and competing rights of free speech and/or public interest, if any, in the impugned exploitation are not undermined.

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Acknowledgments

I would like to begin by thanking ALLAH, the most Gracious and the most Merciful.

My doctoral journey has been personally transformative, intellectually challenging but deeply rewarding. Throughout this long journey many individuals have lent their support and encouragement, which motivated me to persevere through all the challenges in the way. I am immensely grateful to them and truly at a loss for words to express my gratitude.

I am forever indebted to my supervisors, Professor Enrico Bonadio and Dr Patrick Goold for their exceptional mentorship and guidance throughout this doctoral journey. Without their constant support and motivation, I would not have the strength or the clarity to see this journey through to completion. At every step of this journey, I found them beside me, guiding me towards the next. I also express my sincere gratitude to Professor Panos Koutrakos for being very supportive and for always making the time to address my concerns.

I am eternally grateful to my parents, Helen and Motin, and my elder sister, Tasnuva for believing in me and for making me believe that I can make this journey by myself. Your unconditional love and support have been the cornerstone of all my academic endeavours. I cannot thank you enough for the sacrifices you have made to get me this far in life.

Lastly, to my friends here in London – Sakib, Mahar, Tanjid, Alaska, Tasmia, Omar & Yasmin - a big thanks for your unconditional support, reassurance and patience, which was my anchor during the troubled moments. Your presence has worked wonders at times, and there are no words to express how grateful I am to have you all in my life. I am deeply grateful to Aunt Meherunessa for caring for me in London as if I were her own son. And, of course, love and gratitude to my fur-babies – Archie, Arthur Jr & Buttercup, whose presence helped keep me grounded and humane throughout this journey.

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List of Abbreviations

ASA	Advertising Standards Authority
BCAP	Code of Broadcast Advertising
BCIP	Benelux Convention on Intellectual Property
BGB	German Civil Code
CAP	Code of Non-broadcast Advertising and Direct & Promotional Marketing
CPDA	Copyright, Designs and Patents Act
ECHR	European Convention on Human Rights
ECtHR	European Court of Human Rights
EUTMR	EU Trademark Regulation
HRA	Human Rights Act
IP	Intellectual Property
IPO	Intellectual Property Office
IPSO	Independent Press Standard Organisation
PBC	Privacy Act (British Columbia)
PCC	Press Complaint Commission
PM	Privacy Act (Manitoba)
PNFLD	Privacy Act (Newfoundland)
PS	Privacy Act (Saskatchewan)
KUG	German Artistic Copyright Act
NYCRL	New York Civil Rights Law
Ofcom	Office of Communications
TMA	Trade Marks Act (UK)
TRP	Television Rating Point
WIPO	World Intellectual Property Organization

INTRODUCTION

Every human being as a separate living entity is unique. They have different names, looks, voice, signature, sense of dressing, styling, and special character traits. These varying attributes or characteristics, collectively, creates an 'indicia of identity'¹ for every human being, as the uniqueness associated with such features make them distinctly identifiable from one another. This indicia of identity, embodying every possible external manifestations of oneself/personhood, constructs the 'persona' or 'personality' of an individual, which marks his/her unique existence and provides for a point of reference to be remembered with.²

Interestingly, this 'persona/personality' when it is of a 'celebrity' does not only typify that person's unique existence. It also typifies the fame, popularity and goodwill that the celebrity has amassed on his personhood by becoming a household name and by attracting immense public appeal, love and support. Such a personality, therefore, is extremely commercially rewarding, as it is extensively used in the media, in advertisements, product promotions/merchandising, etc., by publishers, editors, manufacturers and advertisers for capturing their targeted consumer class.³ Their appeal and goodwill, and the society's obsession with their personality, is basically at play here, being used to influence the consumers on their everyday life choices on what to use, buy or even how to think. As such, a specialised market for investing on celebrity personality has been created, where commercial entities, big or small, are in the fierce competition of grabbing famous persona for their products/services, so that they can capitalise on the public's fixation on the persona and maximise their consumer reach. Through this specialised market of commercial appropriation of famous persona, the celebrities are seen to be making more money than they could have possibly made by using the skills or being in the profession they are (actually) famous for. Additionally, this persona of celebrities also typifies significant social and cultural values, as these are often used by the public to exchange cultural meanings and experience and used symbolically to represent social and moral standings. These often forms the subject matter of various literary and artistic works, public discourse and discussion, and even objects to promote new art forms or revive old ones.

Now, considering the commercial magnetism, and the significant publicity and social values that such celebrity persona usually entails, it is not illogical for the celebrities to seek to protect their persona from unauthorised use. The reason is not always the greed for money. Provided how short and uncertain the career of a celebrity can be, maximising income through various publications, merchandising and/or endorsement deals is very important. Above all, protection is needed not only to keep all profits to

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

² Julius Pinckaers, 'A New Intellectual Property for the US & EU' in D Vaver (ed), *Intellectual Property Rights: Critical Concepts in Law* (Routledge 2006) 237.

³ Hajo Rupp, 'Who Owns Celebrity? – Law and the formation of Fame' [2014] 12(4) ESLJ.

oneself but also to ensure that the *goodwill* of the persona is not ruined, as once it is lost, no one can make profit from it anymore, and can even end the celebrity's career.⁴

Above all, a celebrity's personality and the fame therein were not created over night; it took him years of hard work, painstaking efforts, and talent to harvest this fame and demand in the society. Therefore, this meticulously and thoughtfully crafted persona should, by all means, belong to him *only* and should very well be treated as his 'asset' allowing no one to trespass to it, i.e., use it without his permission. So, the celebrities should be allowed to protect this highly valuable asset 'as of right', just as they can protect their other prized possessions, both tangible and intangible, which also costed them significant effort and time to be obtained. Such a 'right' to protect one's persona from unauthorised use/encroachment by others are notionally referred to as the 'right of personality'. This right would provide a celebrity an exclusive right of control over the use of his 'indicia of identity,' and decide where, how, when and by whom (and at what price) these indicia will be used by third parties.⁵

The UK, rather *oddly*, despite having a rich celebrity culture and a high yielding entertainment industry with highly acclaimed artists, singers, actors, performers and sportspersons, does not recognise any such right of personality in its legal system. Instead, the English legal system offers protection to celebrity persona against unauthorised use on a piecemeal basis, by stretching its existing rights of action under various torts and the intellectual property rights to answer such concerns of the celebrities. The celebrities in the UK, therefore, find themselves navigating through myriads of fragmented protective tools available through the torts of passing off, breach of confidence, defamation, etc., and even trademark and copyrights, when seeking to protect their persona from unauthorised exploitation.

A bit of *History*

Although the English law recognises no distinct and standalone general right of personality, the concept of celebrity persona itself is not novel. Though recognition of its existence came much later but it can be held that its initiation was with the reproduction of photographic images without consent. The invention of photography was witnessed in the 1st quarter of the 19th century – but there was no legal remedy available if someone reproduced or distributed those images for his own profits without the prior authorisation of the person depicted in the image. The American Law Register of 1869 did mention of a similar incident which took place in Europe – where a woman,

⁴ See, *Campbell v MGN Limited* [2004] UKHL 22 - Lord Hoffman opined that, what celebrities has to sell is themselves: their personality and the goodwill therein, meaning that a loss of goodwill/reputation may not be a problem at all for those investing in celebrity persona as the market is constantly fed with new personality, but for the celebrities, it can be devastating.

⁵ Jeremy Blum & Tom Ohta, 'Personality disorder: strategies for protecting celebrity names and images in the UK' (2014) 9(2) *Journal of Intellectual Property Law & Practice*, 137. See also, Azmul Haque, 'India: Face Value: Personality Rights and Celebrity Endorsements' (2003) <www.mondaq.com/article.asp?articleid=22487> accessed 03 October 2019.

whose images were reproduced without her consent, got compensation.⁶ When mentioning about this case, the author opined that ‘...*special damage may have formed the basis of it; but it cannot be doubted, that had there been none, her right to control the market of her own beauty could not have been denied her by any court.*’⁷ In so doing, the author may have softly acknowledged that an individual’s personality, can be subject of legal protection and that, making use of such persona without consent is a legal wrong. This was probably the earliest case where the legal community started taking issues with such unconsented use of one’s persona – but for the purpose of legal analysis, this case could not be referred to with utmost accuracy as no official report of the case was found by the author mentioning it on The American Law Register. Had the author been able to obtain a report for the case, this could have been used as the starting point for arguing the illegality involved in such unconsented use of one’s persona.

However, *Pollard v Photographic Co*⁸ was one of the first reported English case of unauthorised image use. In this case, the plaintiff employed a photographer to take her photograph and later, when she discovered that the picture was used on a Christmas card exhibited on the photographer’s shop window, she applied for an injunction to restrain the photographer from exhibiting or selling copies of her photograph. The Defendant contended that the court had no jurisdiction to grant an injunction where there was no injury to the plaintiff’s property and that, a person had no property right in his own features. The court, however, granted the injunction on the grounds that there was an implied contract not to use the photographs for sale or exhibition and that, such use amounted to a breach of confidence.⁹ Though the court have ruled in favour of the plaintiff in this case, liability was formed on the basis of the tort of breach of confidence but not for the breach of plaintiff’s personality rights which was infringed when her photograph was used without authorisation.

In contrast, one’s name – which is an indicia of that person’s personality – was not even recognised as a subject matter for legal protection. This was clarified in the Privy Council case of *Du Boulay v Du Boulay*¹⁰ where the illegitimate son of a female slave and her master adopted the master’s surname and the master’s family commenced proceedings to stop that illegitimate child to use the name. The Court rejected such a claim and held that there is no exclusive right to the use of a family name. The Courts were explicit in stating that they do not recognise there being any absolute right of a person to a particular name no matter what annoyance it causes.¹¹ The court’s position remain unchanged even in the fairly recent case of *Re: Elvis Presley Trademarks*¹², where the court refused to grant trademark registrations on the name, "Elvis Presley"

⁶ J. A. J, The Legal Relations of Photographs [1869] 8 Amer. L. Reg. N.S.; See also, George M. Armstrong, ‘The Reification of Celebrity: Persona as Property’ [1991] 51 La. L. Rev., 443.

⁷ J. A. J, (n 6)

⁸ (1888) 40 Ch D 345.

⁹ Charles Simon, ‘Torts - Invasion of Privacy-Unauthorized Use of Photograph’ [1966] 16 DePaul. L. Rev., 255.

¹⁰ (1869) 2 L.R.P.C. 430.

¹¹ Ibid.

¹² (1997) R.P.D. & T.M. 543

and variations thereof, to be used on toiletry products. The Court once again cleared the air stating that there is no scope of copyrights or any similar exclusive rights to one's name.¹³ Furthermore, the court, also clarified that an individual cannot obtain a copyright in his own appearance – which is another indicia of his personality.¹⁴

Historically, the English courts, as such, whenever faced with similar concerns of unauthorised use of name or image, found no liability/unlawfulness of the use in majority of the cases, as it recognised no exclusive right on one's name or image, i.e., personality rights.¹⁵ Even in those handful of cases, where liability was found using the piecemeal approach, it was either on the basis of tort of passing off or breach of confidence.¹⁶ The English courts in all of these cases, tried to 'shoehorn' personality rights into other existing legal doctrines. None of the courts, however, bothered to acknowledge that an individual has a right over his indicia of personality, which is being breached in cases such as these, and that, it should be recognised as a separate cause of action in itself.

The *Parameters* of this Thesis

The current position of the English law, given the foregoing, logically leads to several questions, when the significance of safeguarding celebrity persona is juxtaposed with the options available to safeguard the same and the court's tendency of shoehorning. In the absence of a right of personality, how does the celebrities in the UK prevent/protect their persona from misappropriation/unauthorised exploitation? What are the options or tools of protection that UK offers to its celebrities in such cases? Are those measures of protection/tools adequately and effectively protecting such highly valuable celebrity persona? If not, would it be suitable to adopt a right of personality in the English legal system? If so, what would be the justifications for incorporating/introducing such a standalone and distinctive right? If UK were to introduce such a right, how would it be shaped?

The agenda of this thesis is to effectively answers all of these questions in order to highlight the significance, the rationale and the impacts of having a right of personality for the celebrities in the UK. This thesis, as such, has been divided into five chapters. Chapter 1 is aimed at bringing clarity on the subject itself, i.e., the celebrity personality. It will define the broad concept of 'celebrity' and then, make way to addressing what would constitute as the 'indicia of identity' for the purpose of protection under any right of personality. This chapter will also elaborate the usual ways of personality exploitation by third parties, which are the also the ways in which celebrity persona are/can be misappropriated. Chapter 2 will focus on the rights of action/patchwork of

¹³ Ibid.

¹⁴ Ibid.

¹⁵ See cases: *Lyngstad v Anabas Productions* [1977] FSR 62; *Halliwell v Panini SpA*. (1997) LEXIS (Ch.D. June 6. 1997).

¹⁶ See, *Douglas v Hello! Ltd* [2001] 2 All ER 289, *Irvine v. Talksports Ltd* [2002] WLR 2355, *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3.

laws offered in the UK to accord protection to celebrity persona. The aim is to analyse all such causes of action in light of the available jurisprudence and case precedents and triangulate the true effectiveness and adequacy of each of the measures of protection offered. Triangulating so is important to sufficiently answer whether a right of personality is indeed necessary in the UK. Once a clear picture of the actual levels of protection being offered is portrayed and the necessity of a right of personality is determined, the thesis will move on to Chapter 3 for justifying the rationalities of introducing such a distinct right in the UK. When advancing justifications for the right, all the counter-arguments and interests likely to impede/limit the introduction/incorporation of such a right will be evaluated. In Chapter 4, the thesis will exhibit established and functioning personality right regimes from other jurisdictions. For this purpose, the thesis will nominate several common law jurisdictions and civil law jurisdictions – only those where such a right or similar ones have been introduced. The aim of this Chapter is to analyse the scope, application and structure of personality rights models, in force, in those nominated jurisdictions, and at the end conduct a comparative analysis of the regimes. Such analysis will lay the groundwork for Chapter 5, where recommendations will be made on likely personality right models for the UK. The aim of this Chapter is to take the best features out of the regimes analysed and arrange it in a way so that potential models for personality rights can be pitched. It will also attempt to answer some of the incidental questions which may emerge when such a right is incorporated into the legal system. At the end, a fitting conclusion will be provided to end the thesis.

CHAPTER - 1

1.1: Introduction

Before the thesis can delve into assessing the viability of the safeguards available in the UK and set the stage for embracing a right of personality, it is imperative to conceptualise the practice of personality exploitation that such safeguarding/right relates to. As such, a framework needs to be first constructed in which such practices can be studied. This Chapter has been specifically crafted to provide such a framework, that addresses the two fundamentals of personality exploitation, i.e., the subject matter of exploitation and the common forms/methods of exploitation. It will, therefore, breakdown the subject matter, i.e., celebrities and their persona, and set clear taxonomies of uses of such persona by third parties.

This Chapter will first define the term ‘celebrity’, with the aim to achieve an all-encompassing definition of the term that meets the modern commercial practices, social reality and the technological advancements. Once such a definition is achieved, this Chapter will proceed to elaborate what creates a celebrity persona/personality, i.e., the indicia of identity. It will aim to portray all likely indicia that a celebrity persona may comprise of, starting with the traditional ones to the new and even unconventional ones which has surfaced from modern exploitation practices. This Chapter will also stress on the need to achieve a broad definition for celebrity persona, so that both conventional and unconventional indicia are accommodated by the definition. Implicitly, when elaborating these concepts, the Chapter will also endeavour to establish how a celebrity’s persona generates its social and commercial magnetism and as such, why it becomes worthy of legal protection.

After the subject matter is clarified, the Chapter will classify the uses or the forms in which celebrity persona is exploited. Understanding the uses are important as such uses can be done with authority and without. When it is done with authority, no questions/concerns of safeguarding or having a protected right arises; but if it is done without authority, it does. A clear classification of the uses will provide an insight to where, and against what the safeguards, currently being offered, applies and the intended right of personality will apply, if adopted. This Chapter will endeavour to broadly categorise the uses, so that the fast-evolving nature of personality exploitation practice can be accommodated and the categories remain adaptive to the change.

1.2: Meaning of ‘Celebrity’

So, to begin with, what differentiates a ‘celebrity’ from a lesser-known, simple member of the general public? Some says it is their involvement in the media/creative industry that makes them more recognisable and popular among the public. Some says it is their acceptance from within the public for their work, actions or contribution made to the society as a whole. Some also says that it is their impact on the audience that

actually puts them to step out of the crowd. However, theoretically celebrities have been defined on the basis of their 'well-knownness'¹⁷. While this can be an understatement for many, but this serves to be the starting point for defining what constitutes being a celebrity.

There is no set threshold for determining when or how much 'knownness' would acquire the status of a celebrity for an individual. But there must be a minimum of public awareness of the existence of that individual for there to be some well-knownness¹⁸. Such public awareness is present when a certain but significant number of people knows or are concerned with that individual either by way of stories of that individual in the media/news or by being in personal contact with him/her.

Although public awareness or showing that a good number of people knows about that individual can work towards establishing one's popularity, but there is a qualitative requirement as well. When it comes to understanding the qualitative aspect, the nature of the work/action which has enabled that individual to step out from the crowd is relevant.

Traditionally, people became famous/popular by doing something heroic or extraordinary¹⁹. Since it had to be something great or extraordinary, it needed to be done with diligent planning and virtue as the achievement would be the heroic status in the society. With such heroic status, they became role models for commoners, someone to look up to and follow their footsteps to achieve similar status for themselves. Therefore, being on that position, those famous were considered as the beacon of hope, responsibility and fairness. However, now similar status can be attained just by one's outstanding performance in films, music, art and sports²⁰, courtesy to the tremendous development of the media industry, internet and particularly the exponential growth (and popularity) of social media platforms. Actors, musician, artists, sportsperson and alike are nowadays considered to be famous as their talents and abilities in their respective fields are widely honoured, cheered and celebrated by the members of the public. National level sports personnel are often treated like national heroes if they have won trophies for the nation in the international competitions. But these people do not get to come to limelight just by their participation in the sport, film or the act. They have to have a 'break through' to be popular – like they have to play a match winning stroke or be the man of the match/tournament; give a very successful film or play a music that has been trending in the top10 hit list – then only they would attain a special position in the society. Now be it the traditional path or the modern method of performance, these celebrities are often classified as 'achieved' celebrity as their celebrity status is achievement based.²¹

¹⁷ Daniel Boorstin, *The Image: A Guide to Pseudo-Events in America* (1st edn, New York: Atheneum 1971).

¹⁸ Chris Rojek, *Celebrity* (London: Reaktion Books 2001) 12.

¹⁹ Ellis Cashmore, *Celebrity/Culture* (Oxford: Routledge, 2006), 50.

²⁰ Philip Drake & Andy Miah, 'The Cultural Politics of Celebrity' [2010] 6(1) *Cultural Politics an International Journal*, 51; Neal Gabler, 'Toward a New Definition of Celebrity' (2001) *The Norman Lear Centre* <www.scribd.com/document/368172051/Gabler-pdf> accessed 18 January 2020.

²¹ Rupp (n 3).

With these ‘achieved’ celebrities, the society has a stream of ‘ascribed’ celebrities as well, who rose to fame not on the basis of their achievements or things they have done for the society or for themselves but because of their origin, birth or relation with celebrities.²² Usually, the sons and daughter of famous people (even those of the achieved celebrities) qualifies as ‘ascribed’ celebrities as they are known by the members as the children of such famous individuals – meeting the basic requirement of public awareness. Interestingly, being married to a public person has been seen to have worked towards achieving publicity as an ascribed celebrity, as the public is getting to know this person due to their partner’s prominence. *Georgina Rodriguez* - the wife of the world-famous Portuguese football player Cristiano Ronaldo, is a fitting example of an ascribed celebrity. There is a continuous media coverage of her daily (public) activities just as an ‘achieved’ celebrity and even documentaries have been prepared on her activities and lavish lifestyle in *Netflix*²³; simply demonstrating that there is an audience for these and such genre or class of audience is not different to those that has made ‘*achieved celebrities*’ celebrities.

However, there is now a third kind of celebrities – courtesy to media platforms like YouTube, Instagram, Facebook, TikTok and a steep rise in the demand for reality shows – where the status is not acquired by way of any skills or relationship. These are those kinds of public faces that exists for their own sake – who have been termed as ‘attributed’ celebrities²⁴. This category of celebrities is the creation of the mass media through their publicising of pseudo-events, often for the purpose of increasing Television Rating Point (TRP) and making profits. Gaining fame in this category is as easy/convenient as posting/uploading, let’s say a prank video, podcast on a topic with significant public interest, short video of dancing on someone else’s song/music which is trending or even simply trying-out new clothes and showing off different forms of styling. No doubt, such online content creation requires dedication and painstaking efforts, as not everyone posting or uploading videos become famous overnight; those contents need to achieve a maximum number of views and likes on the internet, i.e., to go ‘viral’ for the content creator to get public recognition and acquire ‘*knownness*’. Further interestingly, the many reality shows that we feed on for our daily dose of entertainment are also good examples of ‘acquired celebrity’, whereby the participants, just by being a part of it gains popularity. Is it not the case of those who competes in reality shows like Love Island, every year? Of course it is. The same is the case with those being featured in tabloid press, documentaries or even in series of trivial pictures.²⁵

In today’s time, therefore, a person who creates online contents in social media platforms or gets featured in a reality show are considered celebrities – even though they have not displayed any extraordinary skills, special talent or have done something

²² Rojek (n 18) 18.

²³ Please see the Netflix documentary ‘*I Am Georgina*’ (2024).

²⁴ Jessica Evans, ‘Celebrity, Media and History’, in Evans J and Hesmondhalgh D (eds), *Understanding Media: Inside Celebrity* (Open University Press 2005), 17; Rojek (n 18) 18; Boorstin (n 17) 38.

²⁵ Graham Murdock, ‘Celebrity Culture and the Public Sphere: The Tabloidization of Power’, in Gripsrud, J and Weibull L [eds], *Media, Markets & Public Spheres, European Media at the Crossroads* (Intellect 2010), 279.

extra-ordinary for the society or for themselves unlike a sportsperson or an artist does in their respective fields to achieve popularity. Whatever they have done was enough to achieve/attract some public awareness and well-knownness, as the public desires/waits to watch their videos/reels/posts which attains them the status of a celebrity.

These third category appears to be problematic when one tries to define what constitutes the status of a celebrity. It clearly overshadows the qualitative aspect - which is considered to be another requirement besides that of public awareness. It equally does not fit within the general understanding of celebrity, and it makes it evident that it is not possible to tie or link all factual types of celebrities within a common definition.

Further insight to the structure of state of 'celebrity' can be obtained if the way in which these people are communicated to the mass public is analysed. There are two aspects to this – the medium through which they are communicated indicates the feature(s) which forms the core of the celebrities, and the quality of coverage can point out what is referred to when alluding to a celebrity²⁶.

It is commonly believed that the development of media industry through the high-speed growth of technology, especially the internet, created a whole new platform for the people to showcase their talents, activities or their existence²⁷. Technology made it possible to present oneself in the fastest, yet cheapest (often free) way possible. If you want to make a public appearance you no longer have to arrange a place, prepare a stage, gather people and advertise for a certain period; you just have to make a video with a smart-phone and share it in the social media. Boom! You have managed to make yourself public without breaking a sweat. Even if you need to advertise for gaining public attention and awareness – it is simple again – you no longer have to hire an ad-agency; just prepare your own advert, subscribe to the paid automated marketing services available in the social media platforms like Facebook and wait. The marketing algorithm in place would continuously feature your advert at the top of the targeted web pages ensuring that it meets the eyes of the users. This being the modern scenario of showcasing, so how did the mass media play their part in communicating the celebrities to the public?

The media exchanges information by combining words, pictures and sounds precisely so that the recipients could get an idea of a person and his/her life. This is more easily done now with the use of multimedia-based celebrity news coverage which are often designed to discuss the life/lifestyles of famous people or controversies in which they are involved. We have seen celebrity divorces to form news headlines, talk-shows being conducted to discuss the wow-factor in the adoption of underprivileged child done by celebrities. So, the celebrities and them being known, these days, depend on the media communicating them to the targeted audience. In Rupp's words, this

²⁶ Rupp (n 3).

²⁷ Drake and Miah (n 20) 49; Gabler (n 20) 3; Cashmore (n 19) 257.

conveying, displaying and portraying all aspects of one's personality in pictures and text, audible and visible information, media coverage establishes celebrity in a concrete shape.²⁸ The dissemination of such information is done on a broad scale ensuring that huge number of people can view or access it at around the same time. It is done in the quickest possible time – media products being brought out in short-time allowing new information about the public persons to be disseminated on a daily basis.²⁹ The media industries have newspapers, TV and radio broadcasting, news-blogs and webpages at their disposal by which events or news are circulated in superfast speed rather than depending on the imprecise word of mouth communication technique. In this way the media industries ensure that a permanent and long-lasting public awareness is established, through which people learn, understands and remembers the existence of certain individuals better than that of someone living in their apartment block.

It is apparent from above that media presence is nucleus in attaining the status of a celebrity. Public seizes the media presentation of celebrities and associates it with their daily lives. They do not simply take the information presented; they get involved with it proactively. In doing so the public participates in the growth of the celebrity.³⁰ But what makes people remember these “famous” persons, individually? What information is retained by the public from these media presentations/communications which helps them to distinguish and differentiate these celebrities from the general public? The answer lies in the conceptualisation of the notion of ‘celebrity persona.’

1.3: Meaning of ‘Celebrity Persona’

The public remembers a ‘popular’ person most commonly by his name, image, characteristics and reputation – all of which are inbuilt facets of one’s individuality/persona. So, in this sense it would not be inaccurate to assert that public remembers their cherished celebrities by their personality. With this comes the crucial question of what is actually meant by or is referred to, when alluding to this term. In theory, the term personality has been defined to comprise of superficial indicia of one’s individuality/personhood that uniquely lies in that person’s name, looks, image, voice, styling, mannerisms, etc. These are those features, attributes or characteristics that makes every human being distinctly identifiable, unique and individually recognisable. Such outward manifestation of oneself or one’s indicia by which that person can be identified is basically that person’s ‘persona’ or ‘personality.’³¹ The term, therefore, should not be misconceived/misunderstood as being used “...in the sense understood

²⁸ Rupp (n 3).

²⁹ Evans (n 24) 24.

³⁰ Seifert A, *Das Model(l) Heidi Klum. Celebrities als kulturelles Phänomen [The Model Heidi Klum. Celebrities as Cultural Phenomenon]* (Konstanz: UVK Verlagsgesellschaft 2010), 38; Lea Hellmueller and Nina Aeschbacher, ‘Media and celebrity: production and consumption of “well-knownness” [2010] 29(4) Communication Research Trends <<https://scholarcommons.scu.edu/cgi/viewcontent.cgi?article=1051&context=crt>> accessed 11 January 2020.

³¹ Pinckaers (n 2).

by psychiatrists to connote character or depth.”³² It refers to the features that are capable of painting the picture of the celebrities in the minds of the viewers. In practice, as well, the term ‘persona’ has been commonly referred to as an all-encompassing label that engrosses all those elements that makes the celebrity recognisable/identifiable; this is very much apparent from the prevalent practices in the common-law jurisdictions like US & Canada (to be discussed in detail in Chapter 4).³³

Traditionally, however, the term ‘persona’ was restricted to celebrity names and likeness only. Persona was held to comprise of the real *name* of the celebrity³⁴. This was later broadly interpreted to include nicknames³⁵, stage-names³⁶ and even fictitious names³⁷ – as long as such variants of names were understood by the audience as referring to the celebrity³⁸. In terms of likeness as an indicia of persona, it was generically defined to comprise of two and three dimensional visual depictions of celebrity’s physical appearances.³⁹ Logically, this led to inclusion of pictures, portraits, photographs and visual representations through camera snaps, video recordings, drawing, sketches, paintings, sculpture, etc, as long as the celebrity was readily identifiable with the naked eye.⁴⁰ The traditional limits started to expand as soon as the term persona was allowed to include, all *evocative* aspects of celebrity identity. Tan articulated that the phrase ‘evocation’ plays a crucial role in bringing all other indicia of celebrity identity in excess of name and likeness within the definition of ‘persona’.⁴¹ Using the literal meaning of ‘evocation’, any elements or features that has the ability to ‘call forth’, ‘conjure up’ or ‘bring to the recollection’ the celebrity in the minds of the public, should constitute a part of that celebrity’s persona.⁴²

McCarthy also added that persona should be defined as a collective term for describing the elements of human identity.⁴³ According to him the term persona covers everything starting from personal names, nicknames, stage names, pictures, images and persona in a role or characterization; that the traditional concept of only ‘name and likeness’ to constitute one’s persona is, at today’s world, inadequate to account for many other aspects/indicia of a person which can identify him and which he can be famous for.⁴⁴ McCarthy further added that persona can also include physical aspects,

³² T Martino & G. C. Draughn, ‘The commercial exploitation of personality: law and advertising practice’ (1987) 9 J Media L & Prac 112.

³³ See cases, *Lugosi v Universal Pictures*, 160 Cal Rptr 323, 336 (1979); *Onassis v Christian Dior-New York*, 472 NYS 2d 254, 260, (1984); *Athans v. Canadian Adventure Camps Ltd* (1977) 17 OR 2d 425.

³⁴ *Abdul-Jabbar*, 85 F 3d 407 (9th Cir, 1996).

³⁵ *Doe v TCI Cablevision* 110 SW 3d 363 (Mo banc, 2003).

³⁶ *Cher v Forum International Ltd*, 692 F 2d 634 (9th Cir, 1982).

³⁷ William L Prosser, ‘Privacy’ (1960) 48 California Law Review 383, 404.

³⁸ *Doe* (n 35); *Carson v. Here’s Johnny Portable Toilets, Inc.* 698 F 2d 831, 837 (6th Cir, 1983). See also, David Tan, *The Commercial Appropriation of Fame: A Cultural Analysis of the Right of Publicity and Passing Off* (Cambridge University Press, 2017) 71.

³⁹ Jeffrey Malkan, ‘Stolen Photographs: Personality, Publicity, and Privacy’ (1997) 75 Texas Law Review 779, 788

⁴⁰ See, *Ali v Playgirl* 447 F Supp 723 (SD NY, 1978).

⁴¹ Tan (n 38) 75.

⁴² *Ibid.*

⁴³ J Thomas McCarthy, ‘Public Personas and Private Property: The Commercialisation of Human Identity [1989] 79 TMR 681, 689.

⁴⁴ J Thomas McCarthy, *The Rights of Publicity and Privacy* (2nd ed. Thompson West 2004).

if that is capable of identifying that individual or is evocative (in Tan's word) – a proposition later affirmed in the American case of *Bette Midler*⁴⁵, where celebrity voice was held to be part of persona as an individual can be identified by his voice. Coombe, iterating in the same line as McCarthy, attempted to describe 'personality' broadly. Her theme of persona was focused on the identification of an individual by referring to that individual's recognition value⁴⁶. As per her contentions, personality includes not only someone's visual likeness but also all the elements of complex constellation of visual, verbal and aural signs that altogether circulates in the society and formulates the celebrity's recognition value.⁴⁷ In Neethling's lens, persona is made up of the identity which is defined as a person's '*...uniqueness which individualises him as a particular person and this distinguishes him from others... Identity is manifested in various indicia by which a person can be recognized, such as his name, image, voice, fingerprints, handwriting, etc.*'⁴⁸ Interestingly, Vaver propelled for an even broader definition, when he intimated that likeness should not be limited to the celebrity's unadorned appearance; if a celebrity is recognisable/identifiable from his unique clothing style, use of accessories or even a specific body part (used in isolation), such external features/characteristics should be taken as a part of his persona as much as his name, face or likeness.⁴⁹

Conversely, some scholars are against giving such an expansive definition to persona. Logeais, for example, is seen to agree that personal attributes like name, likeness, images forms a part of a celebrity's identity and therefore his persona, but she is against of adding external objects/physical objects (like clothing styles, accessories used, hairstyles) to form a part of persona, despite the potential of those external objects to evoke the celebrity in the minds of the viewers like his other indicia.⁵⁰ Likewise, Haynes also provides for a restrictive definition, which specifically includes name, likeness, voice and signature only.⁵¹ This, as it seems to be the case, clearly contradicts to McCarthy's theory of personality and also that of Vaver's, which tends to include virtually anything that can be used to identify/distinguish an individual from the rest. Such a restrictive definition would find itself at odds with the trends of the court, as the courts across multiple jurisdictions have included external but unique

⁴⁵ *Midler v. Ford Motor Co.* 549 F. 2d 460 (9th Cir. 1988).

⁴⁶ Rosemary Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation, and the Law* (Duke University Press, 1998), 89.

⁴⁷ *Ibid*; See also, Gillian Black, *Publicity Rights and Image: Exploitation and Legal Control* (Hart Publishing 2011) 44.

⁴⁸ Johann Neethling, 'Personality Rights' in Jan M Smits (ed), *Elgar Encyclopaedia of Comparative Law* (Cheltenham, Edward Elgar, 2006) 540-543; See also, Black (n 47) 45.

⁴⁹ David Vaver, 'What's Mine is not Yours: Commercial Appropriation of Personality under the Privacy Acts of British Columbia, Manitoba and Saskatchewan' (1981) 15 UBCL Rev 241, 274.

⁵⁰ Elizabeth Logeais, 'The French Right to One's Image: a Legal Lure?' [1994] EntLR 163, 169.

⁵¹ Richard Haynes, 'Footballers Image Rights in the New Media Age' [2007] 7(4) European Sports Management Quarterly, 261.

physical attributes like dressing style⁵², catch-phrase⁵³, unique accessories worn⁵⁴ and even unidentifiable line drawings⁵⁵ within the definition of persona.

Moving on from the attempts by scholars/commentators to define celebrity persona, the Canadian provincial statutes in Manitoba, Newfoundland and Saskatchewan have defined persona to include, name, likeness and voice.⁵⁶ US state legislation of Indiana defined persona to include name, voice, signature, photograph, image, likeness, gestures, distinctive appearance or mannerism⁵⁷. The legislation referred to the term 'publicity' which, by the very nature of what it is consisted of, sits as a subset of 'personality' and would be used interchangeably in this thesis. Similarly, the State legislation of Washington dictates that name, voice, signature, photograph or likeness of an individual, all falls within the spectrum of one's persona.⁵⁸ Likewise, in California, indicia of name, voice, signature, photograph, or likeness of celebrity have been expressly included in the definition of persona. Interestingly, unlike of that in the UK, these US States have acknowledged personality as a separate property right and as such, the definition of persona was given a statutory footing, cancelling the possibility of any further academic speculation or debate over what constitutes 'persona.'

Therefore, in the context of the UK, where personality is yet to be recognised as a separate legal right, there would be debates on what actually constitutes or creates one's persona/personality. But one thing is certain that given the commercial landscape of celebrity persona, whenever that definition is determined for application in the UK, it will not be limited to the traditional indicia of name or likeness. Rather ambitiously, but quite justifiably – following the expansive approaches of the scholars above and the persuasive trends in other jurisdictions, persona could be interpreted into three broad categories; in that, first category may consist of traditional indicia of name and likeness, and all other variants of these indicia that has been so far recognised through expansive interpretation; second category: any evocative voices, signature, imitable mannerisms, gesture, postures, special acts; third category, special character traits and features, unique dressing sense, hair style, make up, catch-phrases and alike. Provided how factors like media, communication, public awareness and features of one's persona plays out in making a person famous and well-known these days, it only seems fair to give 'persona' such a broad and flexible definition. Keeping it broad and flexible would also allow to accommodate the ever-changing nature of personality exploitation and the underlying commercial landscape.

⁵² *White v Samsung* 971 F 2d 1395 (9th Cir 1992).

⁵³ *Carson* (n 38).

⁵⁴ *Dalla v Autovox SpA*, Pret. di Roma, 18 Apr.1984, Foro It. 1984, I, 2030.

⁵⁵ *Athans* (n 33).

⁵⁶ Privacy Act 1987, s. 3(c) (Manitoba); Privacy Act 1990, s. 4(c) (Newfoundland); Privacy Act 1978, s. 3(c) (Saskatchewan).

⁵⁷ Indiana Code Title 32, Article 36.

⁵⁸ The Revised Code of Washington (RCW) Title 63, section 10.

1.4: Taxonomy of (mis)Uses

In modern times, the commercial potential of celebrity persona is endless. Manufacturers, service providers, marketers, advertisers, all are in a constant race to grab celebrity persona to cash in the goodwill, popularity and public fixation that it holds, to their advantage. If they can manage to associate their product/services with a popular persona, their product appeal quadruples and sales are maximised. Customers are attracted by enhancing the adverts with the use of someone very popular among them. Their goodwill, reputation, and the society's obsession with their personality, is used to influence the consumers on their everyday life choices on what to use, buy or even how to think. As such, there is now a specialised market for investing on celebrity personality and business are ready to pay unimaginable amounts of money just to get a share of this specialised market, so that they can also use/exploit celebrity persona for exemplifying their commercial gains. Even the media and publishers are not far behind from the advertisers in this race. They also want to sell steamy celebrity news/gossips, celebrity photographs and their private stories so that they can achieve highest TRPs or maximise the sale of their tabloid or magazines.

Such exploitation/use of one's persona raises two crucial questions – firstly, what is being exploited/used, i.e., the subject matter and secondly, the form of exploitation/use of such persona, i.e., the use(s) the subject matter has been put to. The former refers to the persona of celebrities - which has been discussed at length above – where exploiters can make use of one indicium or more or even all of it depending on their needs and the public appeal of the celebrity. The latter refers to the ascertaining of the usual methods or techniques of exploiting the persona of celebrities. Ascertaining so is critical, as once the usual methods are dissected, classified and analysed, it would become apparent how unauthorised uses of celebrity persona may take place. It will then let the thesis grow and assess what safeguards are there in the UK against such (mis)uses, why protection is paramount and how a right of personality can help achieve the required level of protection.

When it comes to use/exploitation of personality, the first set of practices were identified by Madow. In his words, persona is broadly used for three purposes: to merchandise products, to enhancing the marketability/appeal of products and services, and to showcase the lives and activities of the celebrities for profit/TRP.⁵⁹ Goodenough subsequently came up with five categories of use of persona, in that, he remarked use of persona for informational purposes (like news reporting), for creative purposes (like fictional use for entertainment), advertising purposes (for selling products/services), iconic/adorning purposes (pure representations of celebrity image in posters, figurines, etc., i.e., merchandising) and performance use (like actors performing in character, singers singing in his/her own right).⁶⁰ With his broad list of exploitation, he further attempted to argue that making commercial gains/profit is

⁵⁹ Michael Madow, 'Private Ownership of Public Image: Popular Culture and Publicity' [1993] 81 California Law Review, 125, 129.

⁶⁰ Oliver Goodenough, 'Re-Theorising Privacy and Publicity' [1997] IPQ 37 41.

always not the main factor for using/exploiting celebrity persona. However, given the sheer possibility of celebrity persona to always bring forth some public appeal on whatever use it may be attached with and have, at least, some bearing on the overall sales or TRP, Goodenough's such remark get easily displaced. It would be the same even if he was pointing at the informational/new reporting uses when making such remarks.

A further complex classification of persona exploitation was expounded by Carty, whereby she categorised it into: informational advertising use (product/service endorsement by the celebrity), enhancement advertising use (capturing public attention through associating celebrities, usually by parody, mimicry, imitation), allegiance use (merchandising of celebrity souvenirs or tribute memorabilia) and also biographical information use (featuring the celebrity himself – his life, scandals and contribution to the society).⁶¹ Colston and Middleton formulated a tripartite classification of exploitation – which closely followed the classifications advanced by Madow. In their words, own persona is used by the celebrities themselves for the sake of being famous/popular, persona is used for the merchandising of memorabilia often using the real or fictional 'character' of the celebrity and lastly, persona is used for endorsing/showing approval of products/services by the celebrity.⁶² A more simplified classification of use/exploitation, however, was forwarded by Beverly-Smith. He kept the use limited to advertising use, use for merchandising purposes and media publication of information (showcasing of lives and activities of celebrities).⁶³

Interestingly, most of these variations and classification of use/exploitation overlaps one another. With a closer look it is easily discoverable that Goodenough's informational use, Colston's exploitation of image, Madow's showcasing of celebrity lives, Carty's biographical information use and Beverly-Smith's media publication of information – technically alludes to the same type of exploitation. Similar overlaps can be witnessed between Goodenough's advertising, Colston's endorsement, Madow's marketability enhancement, Beverly-Smith's advertisements and Carty's both informational advertising use and enhancement advertising use. With there being many other overlapping, be it in the terminologies, definition or underlying methods of use, as Black identified, there is a key difference on the issue of Goodenough's performance use, as such an exploitation is not evident in other accounts.⁶⁴ One explanation for others not acknowledging this use in their proposed classification of persona exploitation can be because unauthorised use/copying of celebrity's performance is not an appropriation of celebrity persona *per se*⁶⁵ (and therefore, not in line with subject matter of this thesis). Furthermore, as Black pointed out, celebrity

⁶¹ Hazel Carty, 'Advertising, Publicity Rights and English Law' [2004] IPQ 209, 216.

⁶² Catherine Colston & Kirsty Middleton, *Modern Intellectual Property Law* (2nd edn, Cavendish 2005) 632.

⁶³ Huw Beverly-Smith, *The Commercial Appropriation of Personality* (Cambridge University Press, 2002) 3.

⁶⁴ Black (n 47) 35.

⁶⁵ McCarthy (n 43).

performances is the object of protection under the UK Copyrights, Design & Patents Act 1988 and as such, its (mis)use is not relevant to personality rights.⁶⁶

Nevertheless, from these overlaps in the classifications of uses, three broad categories of use of celebrity persona can be presumed to emerge; these are: endorsement use, merchandising use and media use. For the purpose of this thesis, these three categories will be adopted and each of these categories will be illustrated with reference to three landmark English cases. This thesis will call these English cases as *covert* personality cases, the reason for which will be apparent as the thesis progresses through the proceeding chapters. For now, what needs to be understood is that this project is concerned with how UK safeguards these highly commercialised celebrity persona from misappropriation/unauthorised use. Using these English cases would provide a clear (but brief enough to suit this stage) perspective of how English judiciary tend to answer concerns over the (mis)use of celebrity persona. Another reason is that in all of these cases, liability for misuse has been commonly conceived on the basis of infringing other protected rights of the relevant celebrities and not those that should exist in their persona. The thesis will subsequently show that conceiving liability based on other rights/causes of action, which were never designed to protect celebrity persona in the first place, have inherent problems/challenges, and that the success in these cases cannot be seen as celebrity personality being given the required levels of protection in the UK.

So, moving on, the first in line of three broad categories is the *endorsement* use – where the celebrity is endorsing, supporting or promoting a particular product or service in the market. Here, the name, reputation, goodwill and the acceptance of celebrities among the public are used with the product/service to show that their much loved, followed and cherished celebrity ‘approves’ the product/service, assures the quality or is happy to have been linked with it. His mere affiliation with products/services helps in earning the trust of the public on their quality and as such, convinces the public to purchase them. So, advertisers here are not actually utilizing the celebrities for the abilities he is famous for or just for modelling, photo/video shoot for the advertisement; the celebrities are actually chosen for their value, obtained through their public status, acceptance and goodwill, that ultimately adds on to the value of the product/services being advertised. Under this category of exploitation, the celebrity’s persona is just another marketing tool, being used in conjunction with another party’s products/services to increase their public appeal and not as a new product separately⁶⁷. The celebrities here are not doing any self-promotion by using their persona or trying to sell themselves, rather they are merely endorsing a third party’s product/service in return of a fee. There can be connections between the celebrity involved and the product/service promoted, like sportspersons endorsing sports clothing, footwear and gears – which are often labelled as ‘tools of trade’ endorsement in marketing terms⁶⁸. But it is to be noted that such a link is not always

⁶⁶ Black (n 47) 35.

⁶⁷ Carty (n 61) 210.

⁶⁸ Beverly-Smith (n 63) 2.

maintained, and advertisers can just want to make use of the goodwill or popularity of the concerned celebrity to maximise their overall reach with the targeted consumers. Good examples can be using sportspersons to endorse a fizzy drink – where there appears to be no link at all between them as the sportsperson is not involved in the soft-drinks industry. Cristiano Ronaldo endorsing Clear Men shampoo – can be the best example of such use – which is termed as ‘non-tools endorsement’ in marketing⁶⁹. As a link between the celebrity and the endorsed product is a not necessary factor, it can be simply asserted that essence of use of celebrity persona under this category is predominantly to grab attention of the consumers.⁷⁰

A good example of celebrity persona being used for endorsement purposes can be illustrated through the case of *Irvine v Talksport*⁷¹. The Defendant made unauthorised use of the image of Eddie Irvine - one of the popular F1 racer of that time – in their advertisement brochure. The image used was edited to insert the logo of the Defendant’s radio station to make it look like as if Irvine was holding a device bearing that logo. This was clearly suggestive of Irvine endorsing Talksport’s radio station. The purpose was simple; to use Irvine’s goodwill as a sportsperson to promote the validity and reliability of the radio station which has recently started featuring sport news. Irvine’s association demonstrated that a sportsperson of Irvine’s stature is approving this particular radio station out of all other existing radio stations. The Court’s finding was in favour of Irvine and liability was construed on the basis tort of passing off - as the Court viewed such unauthorised use of Irvine’s photograph to be misleading and deceptive for the consumers. In reality, this was a case of Irvine’s image, i.e., his persona being used without his consent and the court was covertly deciding whether his personality rights have been infringed by such use under the guise of passing-off, since such rights are not recognised in the UK. This case will be further explored and reasons why this is being opined will be witness at length in the next Chapter of the thesis.

Secondly, the *merchandising* use. This is, ideally, where the celebrities allow production of goods which bear their names, image, signature, unique – traits and any other indicia from which these celebrities can be identified. Posters, T-shirt, mugs, bandanas, lockets, etc., bearing the indicia of a popular individual are some common examples of such merchandising. As Goodenough remarked, such merchandising normally includes products which are utilitarian, like T-shirts and mugs and also of pure representation of the celebrity like posters. These products, souvenirs or memorabilia bearing the celebrity persona is not bought because a commoner need a new mug or a T-shirt; these are bought solely for the purpose of showing their love, support, and loyalty towards their favourite celebrity.⁷² Therefore, if a person buys an Al-Nassr jersey bearing Cristiano Ronaldo’s name and his famous jersey number or buys a T-shirt featuring Robert Downey Jr as Iron Man, that person is technically

⁶⁹ Beverly-Smith (n 63) 2.

⁷⁰ Ibid.

⁷¹ [2002] WLR 2355.

⁷² See, Diane Zimmerman, ‘Who Put the Right in the Right of Publicity?’[1999] 9(1) DePaul J. Art & Ent L 35, 61.

buying a piece of that celebrity for himself. So, under this category of exploitation, the celebrity persona becomes the product itself, and it is not a mere marketing tool. By contrast, in endorsement uses, as seen above, the persona is used as a mere marketing tool, just to promote another's product/service.⁷³

The leading English case which illustrates merchandising use is *Fenty v Arcadia Group Brands Ltd.*⁷⁴ In this case, pop star Rihanna's photograph, taken during the video shoot of her music album, was used without her consent in t-shirts manufactured and sold by the Defendant. Rihanna's photograph, in this case, was not used to endorse or promote the products of the Defendant as was in *Irvine*. Instead, the use of the photograph in the product, i.e., the t-shirt itself made it the 'image carrier' and thus, turned Rihanna into a product – a *merchandise* – for the Defendant. Obviously, the turning of Rihanna into such a merchandise meant that Rihanna fans will be tempted to buy these t-shirts more to show their allegiance or loyalty to Rihanna and therefore, maximising the sales for the Defendant. In this case the Court held the use of Rihanna's photograph was unlawful, even though the Defendant has obtained lawful license from the photographer who held copyright of the photograph. The Court constructed liability on the doctrine of passing-off and held that the unauthorised use of Rihanna's image was misleading and deceiving for the public. In this case, as well, the Court was dealing with celebrity persona, i.e., Rihanna's image and adjudicating covertly, whether the encroachment to Rihanna's persona infringed her personality rights. But as such rights are non-existent in the UK, remedy was provided in the guise of misrepresentation under passing-off, as was done in *Irvine*. This case will be discussed in detail in the next Chapter.

Lastly, the *media* use. This is ideally where a celebrity agrees to allow the showcasing of his/her life and/or activities in their personal life, for a fee. Such media coverages of celebrity lifestyle are often referred to as the 'moral conduct' of these famous persons.⁷⁵ Most importantly, selling one's images/photographs to gossip magazines, newspapers and now in various webpages is very common with the celebrities, as it can generate another significant income stream for them. Under this category of exploitation, a celebrity's name, image or his reputation can be used to report news, which can be a factual story and thus accuracy is important. This popularly includes gossips or scandal about celebrities. Many tabloid newspapers survive solely on the supply and publication of such gossips and scandals, like drug abuse, marriages, divorce and occurrences in star-studded parties. This type of exploitation actually stems from the interest that public has in getting to know their cherished celebrities. People's curiosity in knowing the 'stories or narratives of famous individuals creates a good market for this category of exploitation of celebrity persona. Once a person manages to rise to fame, either through a hit film or song, or by doing a YouTube video

⁷³ See, Goodenough (n 60).

⁷⁴ [2015] EWCA Civ 3; For other illustrative examples, please see: *Lyngstad* (n 15); *Halliwell* (n 15).

⁷⁵ A Maloney, 'Rihanna's splash and grab. Singer shares topless Hawaii holiday snaps' *The Sun*, (London 18 April 2012) <www.thesun.co.uk/sol/homepage/showbiz/bizarre/4261741/Rihanna-topless-in-holiday-snaps-she-posts-on-Facebook.html> accessed 22 November 2019.

on a serious social matter, it is a common trend now for the public to want to know more of that person. Such curiosity is more concentrated on what those famous persons are doing in their personal life than what they are doing in their professional life. This opportunity financially benefits the media industry and encourages them to make use of celebrity persona in the form of showcasing celebrity lifestyles to the public to feed their never-ending curiosity. Apart from such news reporting, under this category of exploitation, celebrity persona can be used for fictional, parodical and/or satirical purposes as well, where accuracy is not a necessity. However, the point to be noted here is that the subject matter of value is the celebrity persona itself – it can be their name, image or any other indicia which are being featured for itself by the media or similar platforms.

One of the leading English cases which falls well within this category of use or typifies media use is the case of *Douglas v Hello!*⁷⁶. This case witnessed a paparazzo to have taken several unpermitted photographs of Catherine Zeta Jones and Michael Douglas at their wedding, which were subsequently sold to and published by the *Hello!* magazine. This is a classic example of using persona in image for news reporting – they were reporting the wedding of these two film-stars as news headlines. The Douglas couple has already licensed the exclusive rights of using/publication of their wedding photographs to *OK!* magazine and has implemented various security measures so that the wedding photographs are not obtained by anyone else. The unauthorised publication by *Hello!* was at odds with the exclusive rights of using the couples' wedding photographs given to *OK!*. The court ruled in favour of the Douglas couple on the basis of breach of confidence and privacy rights, whereas, covertly the Court was dealing with unauthorised use of Douglas' persona and addressing concerns as to their personality rights – which is not recognised in the UK. This case would be discussed again when analysing the measures implemented in the UK to safeguard personality interests, in the next Chapter of the thesis.

Moreover, from the elaboration of the uses and the illustrations provided through case laws, several issues emerge, that needs tying up before this thesis can move forward. Both the endorsement uses, and merchandise uses broadly refers to *advertising* - but the way celebrity persona is exploited in these uses are significantly different. The media use on the other hand, does not entail any advertising and is simply *publication* of the celebrity persona in words, through visual representations and similar mediums. Notwithstanding this core difference, one element that may be common across all of these uses is that they have a commercial purpose/agenda to serve. Having a commercial dimension is important, as the thesis will be show in the proceeding chapters that absent such dimensions, unauthorised uses may not be successfully complained against by the celebrities unless such non-commercial uses are found to injure the celebrity's dignity and reputation. As this thesis is concerned with the unauthorised uses of celebrity persona, these uses of persona must be without prior consent or authority and must be public. If uses are exclusively private – be it

⁷⁶ [2005] EWCA Civ 595.

authorised or unauthorised, it will not be considered in this thesis. Excluding such uses does not, however, imply that they are permissible; those may be in breach of other protected rights of celebrities, which are not the subject matter of this thesis. Nevertheless, the classification of uses as aforementioned, by its very definition/nature involves an element of communication with the public, otherwise, the purpose of using persona gets frustrated/remains unserved. As such, public use is inherent in these uses, so the issue of private use is unlikely to arise if celebrity persona is used exactly as defined. Moreover, the adoption of these three classifications should not also imply that there are no other variants of use/exploitation of celebrity persona. These classifications are aimed to broadly cover all imaginable and creative uses of celebrity persona. Such is considered to be sufficient to serve the agenda of this thesis.

1.5: Conclusion

This Chapter unlocks the avenues needed to comprehend and contextualise the notion of celebrity persona and its uses that are at play in this thesis. Before the thesis can delve into the issues of safeguarding of persona and underlying personality rights, it was imperative to understand what requires such safeguarding and on which objects such rights may rest. This Chapter simply endeavoured to elaborate the object of necessary protection, i.e., celebrity persona by first explaining what is commonly understood by the concept of 'celebrity' itself. Once both the concepts of *celebrity* and *celebrity persona* were clarified, the likely uses of this object of protection have been examined. With these required clarifications on the table, the thesis can now confidently dive into the crucial question of how celebrity persona is safeguarded in the UK when these categorised uses/exploitation is done without prior consent/authority from the relevant celebrity.

CHAPTER - 2

2.1: Introduction

It is imperative to set the tone of this section of the thesis at the outset. The English Legal System does not recognise any definitive, standalone and distinctive '*right of personality*' (or synonymously, a right of publicity) that can be used to protect a celebrity's persona from misappropriation or unauthorised exploitation by another.⁷⁷ Throughout, the English judiciary, whenever faced with an issue of such misappropriation/unauthorised exploitation of celebrity persona and regardless of the resolution they have reached, confirmed that in English law there is no such rights that can allow the celebrities to have exclusive control of their persona. Rejection of such rights were sometimes justified on the premise that such rights risk giving the celebrities a 'monopoly' over anything that forms a part of their personality. Sometimes, concerns of undermining competing rights of media, freedom of expression and even public interest has triumphed over the need to embrace such rights. Concerns of increased number of frivolous litigation and floodgate opening were also expressed to rationalise the ongoing rejection of personality rights.

In the previous Chapter, we have seen that in today's world, celebrity persona is one of the most highly commercialised commodities, with a never-ending demand. Celebrity persona has established itself as one of the fundamental elements in the human entertainment system. People just cannot get enough of it. With its application, literally, in all walks and aspects of human life, its demand has always been high and so to remain – perpetually increasing its value. The value it holds in terms of commercialisation and in terms of reputation/dignity, logically demands for its safeguarding from exploiters who are looming at large to freeride on such a lucrative and high valued commodity for their own economic advantage.

In the absence of any *sui generis* rights that could provide protection against this '*mischief*' i.e., the misappropriation or unauthorised commercial exploitation of the persona, celebrities in the UK are having to rely on myriads of other protective rights/causes of actions/legal doctrine for relief. The English judiciary, keeping true to their standing in not accepting a distinctive personality right, have continued to stretch, expand and interpret the existing legal doctrines or protective rights in an attempt to afford protection to the celebrities faced with this mischief.⁷⁸

As the subject matter of this thesis includes the assessment and justification of recognising a standalone personality right in the UK, the suitability, effectiveness and adequacy of the existing rights or cause of actions that the celebrities have been resorting to for protection and the Court have been applying, needs to be ascertained.

⁷⁷ See, *Fenty v Arcadia* [2013] EWHC Civ 3, where the Court affirmed this by stating that in the UK there is no such thing as a free-standing general right by a celebrity (or anyone else) to control the use of their image/personality; See also, *Kaye v Robertson* [1991] FSR 62;

⁷⁸ Jörg Fedtke, 'Concerns and ideas about the developing English law of privacy (and how knowledge of foreign law might be of help)' [2004] 52 AJCL 136.

As such the aim of this Chapter is to analyse and critically evaluate each of such legal doctrines or cause of actions and on the premise of such assessment ascertain whether these causes of action are able to provide an effective and adequate measure of the protection to the celebrities against this mischief.

This Chapter will, therefore, entail a detailed analysis of the English torts, followed by the English Intellectual Property rights, privacy rights and finally, some regulatory codes. Analysis and evaluation of each of these causes of action will include its development in general and its application in the context of celebrity personality. The analysis will then continue to identify and evaluate the strengths and limitations of each of the rights/doctrines in order to ascertain its effectiveness as a remedy, so as to finally answer the query of this Chapter.

2.2: The *Unlikely* Torts

2.2.1: Passing Off

2.2.1(a) *What it was and what it is now?*

The action of passing off, often being underscored as a ‘protean tort’, being purely economic in nature, can be easily classed as an epitome of fine judicial law making in the early 1800s. It was created to combat deceitful trade practices of traders who misled customers by misrepresenting that his goods/services are those of another with a goodwill/reputation. The emergence of this tort was marked, when Lord Langdale famously postulated that “...*a man is not to sell his own goods under the pretence that they are the goods of another man.*” in *Perry v Truefitt*⁷⁹. This principle eventually gained further traction when Lord Halsbury reiterated “... *nobody has any right to represent his goods as the goods of somebody else*” in *Reddaway & Co. Ltd. v. George Banham & Co. Ltd*⁸⁰.

These laid the foundational brickwork of this tort by drawing emphasis on misrepresentation that injures another’s goodwill. At the time of its initial formulation, it was aimed at dealing with trademarks and trade names before the trademark regime was introduced. It was the courts’ baton to ensure honest trading by safeguarding the goodwill a trader/business had established in its identity and get-up. At the core, therefore, the concerns that this tort intended to tackle was not the quality of the misrepresented good/service but the act of misrepresentation itself that enabled a market competitor to benefit on the established goodwill of another and thus, providing for a cause of action to those goodwill exploited traders rather than deceived consumers.

In its initial phase, presence of the element of fraudulent intent was necessary for such an action to stand, and the courts progressively shifted towards a strict liability

⁷⁹ (1842) 49 E.R. 749.

⁸⁰ [1896] 13 R.P.C. 218.

standard based on misrepresentation, emphasising the misleading effect rather than the intent.⁸¹ Lord Parker's ruling in *Spalding v Gamage*⁸² was pivotal in this transition, decisively affirming the paramountcy of safeguarding goodwill over the trademarks, trade names and/or get up itself; thus eliminating the requirement to demonstrate fraud. Although this tort no longer mandates fraudulent intent, but the presence of one, as Carty posits, certainly enhances the claim by prompting the courts to infer deception from such fraudulent conduct of the Defendants.⁸³

The tort went through significant foundational re-shaping during the late 1970s when an “*extended passing off*” doctrine was developed in *Erven Warnink BV v J Townend & Sons (Hull) Ltd*⁸⁴ (the Advocaat case), that safeguarded the goodwill of a class of traders or a distinctive product style not just that of one single trader. In this case, Lord Diplock identified five core components necessary for a valid passing off action:

- (1) a misrepresentation,
- (2) made by a trader in the course of trade,
- (3) to prospective customers of his or ultimate consumers of goods/services supplied by him
- (4) which is calculated to injure the business or goodwill of another trader in the sense that this is a reasonably foreseeable consequence), and
- (5) which causes actual damage to the business or goodwill of trader by whom the action is brought.

This formulation of Lord Diplock reasserted the rationale of passing off being grounded on the protection of goodwill against misrepresentation – the extent of which being as broad as covering misrepresentation concerning a product type/class rather than a specific brand.

The tort went through further judicial re-shaping when it was streamlined a decade later by the House of Lords in *Reckitt & Colman Ltd v Borden Inc*⁸⁵ (the Jif Lemon case). In this case, Lord Oliver re-organised the core requirements of the tort, providing us with the infamous “*classic trinity*” test, which dictates that (quoting Lord Oliver):

- (1) “*First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with identifying get up*”; i.e., **Goodwill**. Such goodwill being previously defined as the benefit and advantage of the good name, reputation and connection of a business;⁸⁶ and what remains to be protected is not name or the mark itself but the public connection derived from the trading activity using such name or mark.⁸⁷ Moreover, any goodwill to attract protection under this tort needs to be

⁸¹ Hazel Carty, *An Analysis of the Economic Torts* (2nd edn, Oxford University Press 2010) 226-227.

⁸² [1915] 32 RPC 273.

⁸³ Carty (n 81) 226-227; See also, *Slazenger v Feltham* (1889) 6 RPC 531.

⁸⁴ [1979] AC 731.

⁸⁵ [1990] 1 WLR 491.

⁸⁶ *CIR v Muller & Co's Margarine Ltd* [1901] AC 217; See also, Carty (n 81) 250.

⁸⁷ *Spalding* (n 82); See also, Carty (n 81) 250;

attached with business activities and must be existent at the time of the exploiter's conduct.⁸⁸ Such goodwill needs to be well established in the jurisdiction as well, mere reputation without market presence would not suffice.⁸⁹

- (2) *"Second, he must demonstrate a misrepresentation by the defendant to the public (whether intentional or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff."* i.e., **Misrepresentation**. Misrepresentation continues to remain at the very core of the tort. Any such action would require proof of a representation being made that has or is likely to deceive/confuse a 'substantial'⁹⁰ number of public into associating exploiter's goods/services with that of the one holding the goodwill. Therefore, the tort mandates actual deception to have occurred, by way of actual misrepresentation and mere appropriation of trade value would be insufficient as held by the Privy Council in *Pub Squash*⁹¹. The ambit of misrepresentation required in the context of passing off has subsequently evolved from its original form, which was concerned with only 'source' misrepresentation.⁹² It now includes 'connection' misrepresentation, where the customers are misled into believing that the one with the actual goodwill has endorsed or is connected/associated with the exploiter's product or service⁹³.
- (3) *"Thirdly, he must demonstrate that he suffers or ... that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."* i.e., **Damage**. Such damage must be actual or is likely and must be related to the goodwill in question⁹⁴. Interestingly, the spectrum of actionable damages has been broader since inception, but it too has gone through a robust progressive evolution. In its current form it encompasses, starting from the classical harm of diversion of trade (where customers are misled and sales are lost)⁹⁵, to devaluation of reputation (where inferior goods are associated with another's goodwill, harming its overall reputation)⁹⁶, loss of licensing opportunities or diversification⁹⁷ and even for loss of control⁹⁸.

⁸⁸ See, *Dunhill v Sunoptic SA* [1979] FSR 337, 368, CA.

⁸⁹ *Anheuser-Busch v Budejovicky Budva* [1984] F.S.R. 413

⁹⁰ *Neutrogena Corp v Golden Ltd* [1996] RPC 473.

⁹¹ *Cadbury-Schweppes Pty Ltd v Pub Squash Company Pty Ltd* [1981] RPC 429; See also, *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462; *Marengo v Daily Sketch & Daily Graphic Ltd* [1948] UKHL J0227-2

⁹² *Spalding* (n 82).

⁹³ See, *International Scientific Communications Inc v Pattison* [1979] FSR 429; *Sony v Saray Electronics* [1983] FSR 30, *Harrods v Harrodian School* [1996] RPC 697.

⁹⁴ *Unitex Ltd v Union Texturising Co Ltd* [1973] FSR 181.

⁹⁵ *Reddaway* (n 80).

⁹⁶ *Spalding* (n 82).

⁹⁷ *Lego v Lego M Lemelstrich* [1983] FSR 155.

⁹⁸ *Unitex* (n 94).

The classic trinity from the *Jif Lemon* case continues to be the mostly preferred and typically applied authority in this tort by the English courts, which in a sense happens to be the simplified version of Lord Diplock's five-factor formulation of the tort in the *Advocaat Case*.⁹⁹ Under the classic trinity, therefore, 'goodwill' is the interest being safeguarded, 'misrepresentation' is the concerned wrongful act, and 'damage' (or potential damage) is the required consequence. Given these being what this tort has been aimed at (and subsequently refined to) protecting, one can easily understand why celebrities in the UK resorted to passing off to prevent unauthorised exploitation of their persona in absence of a distinct personality right in the country. As seen in the previous Chapter, any misappropriation is prejudicial to the 'value' of celebrity persona (be it economic or dignitarian), which has been generated through the 'well-knownness', reputation and popularity (collectively – 'goodwill'), tort of passing off, may (at the first instance) appear to be the most apt medium of protection as the same is also programmed to safeguard goodwill.

2.2.1(b) *Passing off & Celebrity Persona:*

Passing off has long been viewed as the most suitable and protean tort to accommodate claims of unauthorised use of celebrity persona. As there is no standalone right of personality in the UK, the ambit of this tort has been stretched, expanded, and blurred at times, to fill in this gap and could easily be classed as the mostly borrowed legal doctrine for the celebrities and the Court. The following segments in this part of the Chapter will first focus on the jurisprudence to ascertain whether any protection was actually afforded to celebrities under this borrowed cause of action, the challenges/shortcoming that comes with it and then finally answer whether the mischief, as identified at the beginning of this chapter, is effectively and adequately remedied by this doctrine.

2.2.1(b)(i) Early Attempts

Early attempts to invoke protection under passing off, particularly in cases of image or character merchandising were met with significant resistance from the Court. Probably the earliest case was in *Correlli v Wall*¹⁰⁰, where a famous novelist's claim against unauthorised use of her likeness in publishing post cards was refused.

In *McCulloch v May*¹⁰¹ ('Uncle Mac'), a famous children's broadcaster for the BBC known as "Uncle Mac", who was also well known for his involvement in charitable activities and book writing, failed to prevent in passing-off, a cereal manufacturer from marketing a product named "Uncle Mac's Puffed Wheat" using his name (i.e., his persona) and the inherent goodwill. Despite his extensive media presence and the marketed product invoking his persona without prior authorisation, the Court ruled that

⁹⁹ This has been reaffirmed in *Consorzio del Prosciutto di Parma v Marks & Spencer Plc* [1990] EWCA [1990] EWCA Civ J1129-13.

¹⁰⁰ (1906) 22 TL.R. 532.

¹⁰¹ [1947] 2 All E.R. 845.

this unauthorised use did not imply any false association between the parties, as they were in completely different line of business, lacking any 'common field of activity'. Absent any shared commercial domain, with the claimant being a children's broadcaster and the defendant being a cereal manufacturer, the likelihood of public confusion necessary for source misrepresentation to constitute passing off was eliminated. Simply put, as the claimant was not in the cereal trade, he had no goodwill in the relevant industry, hence nothing to protect under passing off.

Through this case, which was one of the earliest celebrity persona cases in the line, Wynn-Parry J introduced the concept of common field of activity, as a key element in demonstrating public confusion to justify misrepresentation for the purpose of passing off. Interestingly, this not only added a further requirement (better put as a further impediment) in the process but also set the tone for the latter judiciary when it came to dealing with cases of similar nature. Most importantly, this decision did create an eccentricity as it meant that traders in the UK can freely (mis)appropriate the personality and the inherent goodwill of celebrities to endorse their products/services as technically celebrities may never become their direct competitor or operate in the same commercial sphere and therefore, never establish liability under passing off.¹⁰² It clearly demonstrated that the English judiciary was not prepared even to consider giving recognition to merchandising rights and by extension, to the risk of misappropriation of celebrity persona in absence of such recognition.

This principle of a common field of activity (and so was the Court's restrictive attitude) was subsequently reaffirmed in cases like *Wombles, Ltd., v. Wombles Skips, Ltd*¹⁰³ - 'The Wombles' case and *Tavener Rutledge Ltd v Trexapalm Ltd*¹⁰⁴ - 'The Kojak' case. In *Wombles*, the Wombles were a popular TV series characters and the defendants, who were garbage container producers, used the Wombles' public perception of being clean and tidy beings and the name itself to market their products. The court rejected the claim of passing off, emphasising on the absence of common field of activity between the respective businesses of the parties. Similarly, in *Kojak*, the defendants used the name of a famous lollipop sucking detective character from the TV series named Kojak to market 'kojakpops' lollies. The claim under passing-off - unsurprisingly (given the precedent that has been set by previous courts) – failed as the court found no common field of activity between production of lollipops and production of films/TV series. As such, no connection between the two would be inferred by the public as required for the purpose of showing misrepresentation in passing off.

Given the striking thematic connection between the famous characters and the concerned product – both in *Wombles* and *Kojak* – it is extremely difficult to accept how the public would not have found that connection and how the Court could not be satisfied on the misrepresentation requirement in those cases. It only, however, showed that the English Judiciary maintained their overly restrictive stance by

¹⁰² Catherine Walsh, 'Are personality rights finally on the UK agenda?' (2013) 35(5) E.I.P.R. 253, 254-255.

¹⁰³ [1975] FSR 488.

¹⁰⁴ [1975] F.S.R. 479 Ch D.

reinforcing emphasis on the common field of activity requirement and in the process, steered clear of recognising personality rights, even as softly as recognising the same in the guise of passing off.¹⁰⁵ More interestingly, Walton J in *Kojak*, went as far as questioning whether the practice of such character merchandising is even recognised by the public as a legitimate business practice – demonstrating a clear ignorance of the widespread practice of character/persona licensing existent at the time.

Perhaps the most prominent case in the series of English judiciary's deliberate and unshuttering push towards non recognition of personality rights is *Lyngstad v Anabas Productions*¹⁰⁶, where the pop band ABBA sued Anabas Productions in the UK to prevent the company from selling posters, T-shirts and merchandises alike featuring their image. In the pursuit of maintaining the high standard set by the previous courts and the English judiciary's continuous but restrictive application of the common field of activity requirement, ABBA's claim was rejected by the Court. As ABBA were musicians operating in the music industry and the Defendant was a merchandiser retailing products bearing the images of celebrities, they did not share any common field of activity. As such, the Court was not convinced that there would be any confusion among the public with the defendant's merchandise being associated with the band (or its members) or that it has authorised the defendant's products as their official merchandise. Oliver J famously reasoned:

*"I am entirely unsatisfied that there is here a real possibility of confusion. I do not think anyone reading the advertisements of which complaint is made or indeed receiving the goods described in them could reasonably imagine that all the pop stars named in the advertisements were giving their approval to the goods offered or that the defendants were doing anything more than catering for a popular demand among teenagers for effigies of their idols. There is no business of the plaintiffs here with which in my judgment the defendants' goods could possibly be confused. To suggest that there is some proprietary right in the plaintiffs' name which entitled them to sue simply for its use is contrary to all the English authorities."*¹⁰⁷

What was interesting in this case was that unlike in *Uncle May*, ABBA had their own official merchandise trade, but at the relevant time, it had a little or no presence in the UK market, where the defendant operated; thus, lacking the goodwill (which needs to be attached to an ongoing business in the UK) for the claim in passing off to succeed.¹⁰⁸ On the particular aspect of ABBA lacking actionable goodwill in the UK despite their fame (which was held insufficient), the Court opined: *'...goodwill is of course an essentially localised concept and the court does not interfere to protect*

¹⁰⁵ See also Walsh (n 102) 254-255; Marshall A Leaffer, 'Character Merchandising in the U.K., A Nostalgic Look' (1994) 11 Articles by Maurer Faculty 460 -461.

¹⁰⁶ [1977] FSR 62.

¹⁰⁷ Ibid, 67-68.

¹⁰⁸ Ibid; See also, Emmanuel K. Oke, 'Image rights and passing off: should reputation be enough for celebrities to succeed in English courts?' (2020) 15(1) Journal of Intellectual Property Law & Practice 49-54 39 -40; Hayley Stallard, 'The Right of Publicity in the United Kingdom' (1998) 18 Loy LA Ent LJ 565.

against exploitation here a foreign business which has established no goodwill here'.¹⁰⁹

What was more interesting to observe in ABBA's case was that it failed 'largely' because of and not solely due to the common field of activity principle as was seen in the previous cases.¹¹⁰ The Court, here, went a step further to consider whether any confusion was genuinely possible, when Oliver J tested (and founded in the negative) the reasonableness of the public imagining that ABBA had authorised the Defendant's merchandise in question. Oliver J further remarked that there was no general custom for singers like ABBA to give licence for their image to be used by the merchandisers, so general public are unlikely to care, let alone genuinely confuse themselves with the question of whether such licenses were granted by the celebrities or not.¹¹¹

Commentators like King and Walsh viewed ABBA's ruling to have relaxed the requirement of common field of activity by drawing emphasis on the proof of genuine likelihood of confusion.¹¹² In reality, however, this has just doubled the impediments, as the Court will not only look in to the need to show a common field of activity but also at the likelihood of confusion. Nevertheless, Oliver J's remarks in *ABBA* may sound relevant and potent, but it fails to acknowledge the fact that celebrities like the ABBA often leverage their persona in businesses or commercial ventures that is distinct from the popularity generated by the persona.¹¹³ So, when that same persona is exploited by a rival business/competitor without authorisation, it potentially injures the business interest of the celebrity and therefore, should be also actionable.

In any event, the Court replicated itself again nearly two decades later in *Halliwel v. Panini SpA*.¹¹⁴ The famous singing band "Spice Girls" sought to prevent the Defendant company from selling their sticker collection, namely "The Fab Five," featuring the images of Spice Girls without their authorisation. At the time, the band was negotiating a deal with another entity (Topps Inc) to produce a sticker set and contented that without any disclaimer on the Defendant's sticker set, the public will be misled/confused into believing that 'The Fab Five' set was produced and/or authorised by the band. Justice Lightman, rejecting the claim, refused to accept that the absence of the said disclaimer could reasonably misled the public into buying the defendant's sticker set believing that the set was from Spice Girls. Such a conclusion was reached regardless of the band's extensive merchandising trade, as the Court was not satisfied that the band had acquired the requisite goodwill as publishers of sticker sets, since their set still in the planning phase with Topp Inc and yet to be marketed.¹¹⁵ Consequently, the Court found no misrepresentation for a passing off claim to

¹⁰⁹ *Lyngstad* (n 106).

¹¹⁰ Julie King, 'The Protection of Personality Rights for Athletes and Entertainers under English Intellectual Property Law: Practical Difficulties in Relying on an Action of Passing Off' (2000) 7 Sports Law J 351, 360.

¹¹¹ Andrew McGee, Sarah Gale & Gary Scanlan, 'Character Merchandising: Aspects of Legal Protection' (2001) 21 Legal Stud 226, 245.

¹¹² See, Walsh (n 102) 260.

¹¹³ *Ibid*.

¹¹⁴ (1997) LEXIS (Ch.D. June 6. 1997)

¹¹⁵ King (n 110).

succeed, re-iterating the need for the proof of actual confusion and actual damage (as was required in *ABBA*). The Court, oddly, disregarded the fact that the unstopped action of the defendants would put the band at a serious disadvantage when negotiating their potential deal with Topps Inc (and incur financial losses in the process). The Court yet again denied accepting celebrity fame or even their own merchandising activities to be sufficient to justify passing off – essentially making it an uphill struggle. One would not be wrong to call it impossible at the time, as the Court technically required proof of business presence, in the exact product concerned and on top, proof of actual public confusion into believing the goods were authorised by the celebrity.¹¹⁶

2.2.1(b)(ii) The False Dawn

Interestingly, an early breakthrough came with *Mirage Studios & Others v. Counter-Feat Clothing Ltd*¹¹⁷- *The Turtles Case*, which was heralded by commentators as a ‘fitting’ response to the set of existing anti-merchandising cases like the *Wombles* and *Kojak*, as seen above.¹¹⁸ Contrary to *ABBA* or the *Spice Girls*, this was a ‘third party character merchandising case’¹¹⁹, where the defendant has misappropriated the likeness of fictional characters (by making drawings of these characters and licensing them to T-shirt manufacturers) rather than the likeness of a real person. Such characters were originated/owned by the claimants who also had the business of licensing the reproduction of the characters on third party manufactured goods.

The Court founded in favour of the claimant, recognising that fictional characters such as these cannot license itself to another for merchandising, the owners would have to do it, and so when such characters are merchandised, the public would reasonably assume that the creators of the characters must have granted the licence to the merchandiser and base their purchase decision on this very assumption.¹²⁰ This, as the Court remarked, was sufficient to create an association between the claimants and the defendant’s goods that would misled the public, hence establishing misrepresentation for passing off; also that any inferior goods sold under the continued use of the defendant of the characters would compromise the goodwill of the claimants and injure Claimants’ own licensing business, hence, establishing a common field of activity.¹²¹ Therefore, in the absence of any license being granted to the Defendants, the Court accepted the reasonable need for the Claimant to make it known to the public in order to avoid any confusion on connection with the Defendant’s products and the claim succeeded.

¹¹⁶ Stallard (n 108) 572.

¹¹⁷ [1991] FSR 145.

¹¹⁸ See, Leaffer (n 105) 460-461; Seung Chong and Spyros M. Maniatis, ‘The Teenage Mutant Hero Turtles Case: ‘Zapping’ English Law on Character Merchandising Past the ‘Embryonic’ Stage’ [1991] 7 EIPR 253.

¹¹⁹ Stallard (n 108).

¹²⁰ *Mirage* (n 117) 155-156.

¹²¹ *Ibid*; See also, Scanlan (n 111) 245.

Undoubtedly, *The Turtles Case* could be perceived as an expansion towards a less restrictive parameter, as deception as to licensing was held actionable for the first time. The Turtle court's expansive view appeared to be protecting even *fictitious* characters and intimated that unlicensed merchandising where public is anticipating official/authorised merchandise should be restrained under passing off. The court showed their acceptance that character merchandising and the licensing involved therein is an extensive and legitimate business practice which the public are well aware of and thus displacing views of Walton J in *Kojak* and Oliver J in *ABBA*.

This perceived premise, however, soon transpired to be a 'false dawn'¹²², as Walsh correctly pointed out that *Turtles* was a copyright case and Turtle court's such expansive view only constituted the *dicta* of the ruling and therefore, of limited application in passing off.¹²³ As such, the classic trinity was still the only mechanism to follow, implying that the restrictive approaches taken by the previous courts in applying the same remains unaltered as the applicable precedent for the latter courts to follow. Moreover, the Turtle court's expansive attitude was soon reigned by later courts, particularly in *Elvis Presley Trademarks*¹²⁴, where Simon Brown LJ explicitly warned against extending intellectual property law regime to protect all unauthorised use of a celebrity persona. The Elvis court further criticized the Turtles court, restricting the ruling of the same to be fact specific and that is, should not be universally applied in all passing off character merchandising cases.¹²⁵

2.2.1(b)(iii) The Turning Point

A seismic shift in the landscape expanding the traditional confines of the tort was actually brought about through the case of *Irvine v Talksport Ltd.*¹²⁶ In this case, the English Judiciary recognised the notion of 'false endorsement' involving celebrity persona, for the very first time. Such false endorsement was defined to take place where a third party suggests that its goods/services are approved by the celebrity whose persona has been attached to it.¹²⁷ In *Irvine*, the Claimant was a famous Formula 1 race car driver, who also happened to be extensively involved in endorsement deals with many other English companies. The Defendant in this action operated one of the largest radio stations in the UK, which had just started featuring sports news. The Defendant had taken a photograph of Irvine talking on his phone, which was subsequently doctored to digitally insert the logo of the Defendant's radio station to make it look like as if Irvine was holding a device bearing the logo of the Defendant. This edited photograph (something akin to a deepfake in today's time) was placed on the Defendant's advertisement brochure and sent to various businesses.

¹²² Carl Steele, 'Personality merchandising, licensing rights and the march of the turtles' (1997) 5(2) S. & L.J. 14, 18.

¹²³ Walsh (n 102) 253-260; Leaffer (105).

¹²⁴ [1999] R.P.C. 567.

¹²⁵ Ibid, 552.

¹²⁶ [2002] EWCA Civ 423.

¹²⁷ Carty, (n 81) 279.

The court accepted that the inclusion of the doctored image in the brochure gave the impression that Irvine was 'endorsing' the radio station. The court re-clarified 'endorsement' as a representation that '*...tells the public that he approves a particular product/service provided by a business or that he is happy to be associated with it...*'¹²⁸ and concluded that the Defendant's unauthorised use of Irvine's persona was likely to (mis)lead the recipients of the brochure into believing wrongly that the endorsement was actually done by Irvine himself and falsely convey his support/approval. Based on this premise, the court was convinced that there was a misrepresentation (for the purpose of passing off) by way of such false endorsement and found in favour of Irvine.

This ruling and the rationale therein, had several facets of utmost significance in the context of the known parameters of passing off. Firstly, the court accepted a broad notion of endorsement misrepresentation and harm through lost licensing opportunity.¹²⁹ Secondly, it provided for a much wider notion goodwill than before, as Laddie J recognised that it is commonplace for celebrities to leverage their persona into building substantial revenue streams through endorsement deals and in the process, create a form of goodwill that is distinct from the traditional goodwill found in connection with tangible goods/services which the tort of passing off has been concerned with. This particular form of goodwill was introduced by the Irvine Court as 'promotional goodwill', which was embedded in Irvine's persona due to the associated fame and reputation (that had the power to attract endorsement deals by itself) and which the Court has allowed him to safeguard in this claim.¹³⁰ This, indeed, was something novel as previous courts had been conspicuous on the need of goodwill to be linked with a product/service (i.e., source connection) but now due to *Irvine*, goodwill on celebrity persona would suffice and the same has been ruled to be a commercially protectable interest. Interestingly enough, Spence identified that Laddie J's use of the expression 'reputation or goodwill' allowed for the terms in the expression to be used interchangeably, essentially meaning that a claim would succeed even if the celebrity had never engaged in any endorsement deals (so probably no goodwill) but has a commercially exploitable fame/reputation in his relevant field of expertise.¹³¹

Thirdly (and perhaps, most significantly), Laddie J by acknowledging the extensive practice of personality licensing outside the celebrity's field of expertise and by expanding the ambit of goodwill to include promotional goodwill, removed the 'common field of activity' requirement for passing off claims involving false endorsement to succeed.¹³² Irvine here did not have any goodwill attached to any goods/services being supplied that would be adversely affected by the Defendant's misrepresentation; Irvine operated in the automotive sports industry whereas the Defendant in media. In the absence of any commercial overlaps, the court, only to

¹²⁸ *Irvine* (n 126).

¹²⁹ *Carty*, (n 81) 279.

¹³⁰ *Ibid*; See also, *Walsh* (n 102).

¹³¹ Michael Spence, *Intellectual Property* (Oxford: Oxford University Press, 2007) 230-233.

¹³² *Blum* (n 5) 138.

bring Irvine within the bounds of the tort, interestingly, went as far as holding Irvine to have an actionable goodwill in the trade of endorsement and that Defendant's misrepresentation would be damaging that goodwill.¹³³ Such ruling consequently meant that misrepresentation does not need to be tethered to common field of activities anymore; rather, proof of public being misled into believing in an endorsement would suffice.

Despite the significance of the ruling and expansive attitude of the judiciary in *Irvine*, the Courts remain hinged on to the classic trinity. *Irvine* ruling had only broadened the perimeters of the test, so far as logically possible, but it did not depart from it or caused it to also incorporate the notion of 'misappropriation' which is the mischief the celebrities demanded protection against. Whilst one would not be mistaken to perceive that the Irvine Court did in fact brought in the flavours of 'misappropriation' within the trinity, but the ruling was actually framed within the paradigm of misrepresentation, in that, the unauthorised use of Irvine's persona was not actionable, but the misleading impression of his endorsement was. We shall see later in this Chapter why the court's ignorance in adopting the concept of misappropriation impacts the overall effectiveness of passing off in safeguarding celebrity personality. In any event, given the attitude of the previous courts in this context, the *Irvine* ruling is laudable as it introduced a new (and somewhat promising) dimension for the protection of celebrity persona, but as Walsh rightly pointed out, this extension of the tort '*may not be the breakthrough hoped for*' by the celebrities,¹³⁴ being still constrained by the classic trinity and not providing any breakthrough for instances other than that of false endorsements.

2.2.1(b)(iv) Merchandising Rescued

Undoubtedly, *Irvine* has introduced foundational improvements on the traditional parameters of the tort, which led the tort to offer a likely remedy when celebrity persona got entangled with false endorsement. It, therefore, logically begs the question of whether courts in cases like *ABBA* - where celebrity persona/likeness has been unauthorisedly used in merchandising - would have concluded differently, i.e., in the favour of the celebrities, in light of *Irvine*. Unfortunately, the answer was still in the negative, due to the unfitting and unfortunate distinction that Laddie J has casted in *Irvine* between endorsement and merchandising, by restricting the tort to endorsement cases only.¹³⁵ As Schlegelmilch remarked, the Irvine ruling is good for protecting celebrities in endorsement cases, but not all commercial uses entail endorsement.¹³⁶ So putting images of a celebrity on merchandises (like in *ABBA* or *Spice Girls*) does

¹³³ Jennifer Davis, 'Why the United Kingdom should have a law against misappropriation' (2010) 69(3) Cambridge Law Journal, 561, 573; Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (4th edn, Sweet and Maxwell, 2011).

¹³⁴ Walsh (n 102) 255.

¹³⁵ *Irvine v Talksport Ltd* [2002] 1 WLR 2355.

¹³⁶ Jonathon Schlegelmilch, 'Publicity Rights in the UK and the USA: It is time for the United Kingdom to follow America's lead' (2016) 1 Gonzaga Law Review Online 101, 115.

not necessarily constitute misrepresentation that the merchandise was 'endorsed' by the celebrity and thus, attracts no protection under the *Irvine* improvements.¹³⁷ There is no telling that the legitimate interest in protecting persona in cases of unauthorised merchandising, like in *ABBA* or *Spice Girls*, is no less significant than protecting the same in cases of unauthorised endorsement, like in *Irvine*. As such, there is no reason why the ask of protecting persona in two different mediums of commercial exploitation will be answered and/or responded inconsistently by the judiciary.

Fortunately, this inconsistency in judicial response was finally resolved in the case of *Fenty v Arcadia Group Brands Ltd*¹³⁸ where the Court addressed whether the sale of t-shirts by fashion retailer Topshop featuring Rihanna's photograph (taken during the video shoot for one of her music albums) satisfies the tort of passing off. Unlike *Irvine*, the unauthorised use of Rihanna's image was not made in the context of endorsement (or with any explicitly endorsement message), but on a merchandise that Topshop purported to sale. The Defendant had license of the photograph but no prior authorisation from Rihanna for using the same in their merchandise. Rihanna invoked the tort claiming that such unauthorised use would mislead the public into believing that she has authorised the t-shirt or that it is an official merchandise. Given the court's longstanding approach on (unauthorised) uses of celebrity persona in merchandising cases and the inapplicability of *Irvine* developments in such cases, on facts (being similar to *ABBA*), Rihanna's claim should have failed. The courts have, so far, consistently failed to find misrepresentation in unauthorised persona merchandising cases viewing it as not automatically deceptive. The Rihanna court, however, despite acknowledging this view, with Birss J stating, "...the mere sale by a trader of a t-shirt bearing an image of a famous person is not, without more, an act of passing off"¹³⁹ went on to find the case in favour of Rihanna, accepting that 'more'¹⁴⁰ was present in this case due to her unique circumstances which satisfied the public deception requirement for the purpose of misrepresentation.

The Rihanna Court acknowledged that Rihanna's goodwill extends far beyond the music industry into that of fashion and glamour being a global style icon and trendsetter. She was extensively involved in merchandising products and had a range of endorsements deals within the fashion industry (with Nike, Gillette, etc)¹⁴¹, thus, astutely creating a commercially exploitable goodwill on her image and so within the industry. In collaboration with retail brands like River Island, H&M & Armani¹⁴² she had her own clothing range, using her own branding on such products. Interestingly, Topshop itself had previously collaborated with Rihanna sometime between 2010 and 2011¹⁴³, having sold products authorised by her in their stores – an information which

¹³⁷ Ibid.

¹³⁸ [2015] EWCA Civ 3.

¹³⁹ Ibid, para 75.

¹⁴⁰ Blum (n 5) 138.

¹⁴¹ Huw Beverley-Smith and Liddy Barrow, 'Talk that tort... of passing off: Rihanna, and the scope of actionable misrepresentation: *Fenty v Arcadia Group Brands Ltd* (t/a Topshop)' (2014) 36(1) E.I.P.R. 58

¹⁴² Ibid.

¹⁴³ Oke (n 108) 49-54.

was well within the public domain. All of these, as Blum puts it, constituted the ‘*more*’ that Birss J required and thus, convincing him to conclude that Rihanna’s circumstances were unique enough to justify the likelihood of public connecting Topshop’s t-shirts with Rihanna as her authorised products. The Rihanna court however, underscored that the ruling was fact specific (and thus, not departing from its usual position) which turned on the proof of Rihanna’s merchandising goodwill and because of the way Topshop featured Rihanna on their product confused the consumers. Regardless of this categoric restriction, the Rihanna court did extend the realm of the tort to now catch merchandising cases; but much would depend on the way persona was presented and the context of the celebrity, as court remained hung on the idea that this type of merchandising practice is not automatically deceptive.

Importantly, just as in *Irvine*, whatever expansion or improvements that the Rihanna court introduced in the tort, were introduced within the strict confines of the *classic trinity*¹⁴⁴. Burden of proof remained on Rihanna, where goodwill was established based on her broad portfolio of commercial enterprises ranging from music to fashion; misrepresentation remained the central issue, as it was Topshop’s prior affiliation with Rihanna and their presentation of the star that proved deceptive; lastly, proof of damages – which was accepted in two folds - loss of sales of own merchandise and loss of control over image, i.e., dilution (as also seen in *Irvine*) as a result of such misrepresentation. The court, yet again, did not acknowledge or even address the mischief of misappropriation, and did not consider whether such misappropriation to be actionable by itself without needing misrepresentation to be present.

2.2.1(c) Limitations:

Now that we have seen how the English courts have been tackling personality misappropriation cases by applying passing off, at this juncture, it is imperative that we turn to the assessment of whether such judicial treatment effectively and adequately provided the necessary level of safeguarding to the celebrity persona, given its inherent goodwill and the enormous commercial value. The next phase is aimed at highlighting and evaluating the apparent limitations of the tort in the context of celebrity persona and judiciaries reluctance, best put as ‘*scepticism*’, in acknowledging the elephant in the room, i.e., the misappropriation of personality, when they had the perfect opportunity to do so. Such analysis will be targeted to commensurate the theme of this Chapter and the overall project and verify whether the tort of passing off can effectively and adequately address the mischief of misappropriation.

¹⁴⁴ Beverley-Smith (n 141) 57-61.

2.2.1(c)(i) Goodwill

The entry point of the passing off rubric is ‘goodwill;’ absent such goodwill, the realm of passing off will be inaccessible¹⁴⁵; essentially meaning that the tort is ‘reserved’ for those with goodwill. In its traditional formulation, ‘source’ goodwill was required, together with the requirement of common field of activity. It meant, quite absurdly, that no celebrity can unlock the tort, firstly, as virtually always they operated in unrelated fields. Secondly, absent a common commercial sphere, the celebrity was never found to have the goodwill attached to the relevant good/service that may be injured through the exploiter’s action. Early cases, like *Uncle Mac*, *ABBA*, therefore, stands testament to this oddity, as even without direct competition, the plaintiff celebrities had the legitimate interest to control their persona given its inherent commercial value and goodwill, that the English courts in these cases turned a blind eye to.

With the *odd* requirement of ‘common field of activity’ removed and the inclusion of ‘promotional’ goodwill in *Irvine* for false endorsements cases – the parameters of goodwill experienced a promising stretch. However, even to fall within this promotional goodwill (in the absence of source goodwill), a celebrity would have to marshal evidence of such goodwill being embedded on his/her persona to attract promotional/endorsements deals (like Irvine could). Proving so can be an unsurmountable exercise by new/rising celebrities or social media influencers or so called ‘micro-celebrities’ of today’s time, who definitely has the ‘persona’ born of their fame and well-knownness but may – quite often – lack clear commercial goodwill (be it promotional or otherwise) due to not being famous ‘enough’ to attract endorsement or promotional deals.

The position remains unchanged for such lesser celebrities even if their persona gets entangled with unauthorised merchandising of goods and even if they attempt to establish goodwill through the *Fenty* ruling. Firstly, as English courts remains fixated on the point that a mere unauthorised use of celebrity persona on merchandise will not be caught in passing off automatically and such a case would only turn on facts¹⁴⁶; secondly, even Rihanna had to discharge the burden of proving goodwill through her multifaceted commercial ventures, endorsement and merchandising deals ranging from the music to fashion industry – which is a matter of impossibility for such lesser celebrities with a persona. This, therefore, has the effect of excluding an entire class of famous people who has a persona, but no traditional business built around it, from any legal recourse if their persona has been unauthorisedly exploited. Nonetheless, this also creates an absurd disparity, making popularity directly proportionate to the likelihood of protection, meaning the more popular you are, the higher the likelihood of protection under the tort.

Conversely, proof of goodwill can be equally onerous for top-tier celebrities too, who are not actively exploiting their persona commercially other than in their respective field of fame. Not engaging in endorsement, merchandising or any similar commercial

¹⁴⁵ Beverley-Smith (n 63) 70.

¹⁴⁶ *Fenty* (n 138).

activities outside of the celebrities' own field of play, is not uncommon; some celebrities do not deliberately engage in such activities, some may not even be approached due to their ideology, lifestyle and choices.

Such an onerous and 'harsh' requirement as a stepping stone for the only tort that somewhat purports to afford some protection to the celebrities against misappropriation, is clearly unacceptable. Given the increased use of social media blurring the line and making the divide between a celebrity and a lesser celebrity more arbitrary¹⁴⁷, and regardless of their place in the fame hierarchy, all celebrities must be afforded the equal levels of protection against unauthorised use of their personality.

2.2.1(c)(ii) Misrepresentation

If a plaintiff celebrity manages to enter the realm of passing off by establishing goodwill, the underlying mechanism of the tort would not start unless there is misrepresentation; any unauthorised use of persona that falls short of deception will, therefore, not be caught by the tort.¹⁴⁸ A celebrity will have to again marshal evidence to show that the exploiters use of his/her persona is likely to deceive the consumers into believing that he/she has endorsed the product (like *Irvine*) or is commercially connected with or has authorised the product (like *Rihanna*); mere proof of evocation of persona will not suffice.¹⁴⁹ As Carty pointed out, unauthorised/unendorsed products carry just as much appeal as an official one and that, fans often purchase those as a badge of allegiance or favouritism, meaning that discharging the burden of proving deception even in cases similar to that of *Irvine* or *Rihanna*, would be an arduous task.¹⁵⁰ The *Spice Girls* case best illustrates this; the fans bought the impugned stickers not because they thought the sticker set was an official merchandise but because of their love for Spice Girls¹⁵¹, rendering the proof of deception often impossible in these cases.¹⁵²

Given this need for deception, if the impugned use simply exploits celebrity persona in a way that is not misleading, e.g. in a parodical or satirical product or a tribute memorabilia, it will fall outside the ambit of the tort. Likewise, humorous advertising campaigns evoking celebrity persona but cleverly enough not to outright impersonate it, will be immune from liability. Even any unauthorised biographical merchandise or artwork using celebrity persona, prepared just to profit off their fame, would nevertheless remain immune, if the presentation is not suggestive of sponsorship/authorisation by the relevant celebrity. In its current formulation, the requirement of misrepresentation makes it as easy as exploiters including a simple disclaimer or tagging the impugned goods as 'unofficial' and escape liability (something even the *Rihanna* court has also talked about) and continue to profit from the unauthorised use of persona.

¹⁴⁷ *Fraley v. Facebook, Inc.*, 830 F. Supp 2d 785 (N.D. Cal 2011) 808.

¹⁴⁸ Virtually all case has confirmed this.

¹⁴⁹ See generally, Davis (n 133); Hazel Carty (n 81).

¹⁵⁰ Hazel Carty, 'Character Merchandising and the Limits of Passing Off' (1993) 13 Legal Stud 289.

¹⁵¹ King (n 110).

¹⁵² See also, *Re American Greetings Corp's Application* (Holly Hobbie case) (1983) 1 IPR 133.

Further illustratively (and hypothetically), the act of imitating the distinctive ‘raspy’ voice – a part of the persona - of the famous singer Tom Waits in the US case of *Waits v Frito-Lay Inc*¹⁵³, would be outside the scope of this tort. The very imitation would indicate that the public is not deceived into believing that Tom Waits have endorsed or authorised the product in question. Similarly, the use of a look-alike robot that evoked the identity of Vanna White (a famous TV personality and popular game show host) in an ad campaign by Samsung in another US case of *White v. Samsung Electronics America, Inc.*,¹⁵⁴ would also remain immune from liability under this tort since the look-alikeness by itself, without involving literal use of Vanna White’s name, voice, likeness, is unlikely to deceive the fans in question. Such outcome, indeed, appears to be odd compared to how the US courts have concluded in those cases, condemning misappropriation only and without needing any deception by misrepresentation.

Furthermore, all the case studies and illustrative examples aforementioned technically elucidate to an interesting observation. All cases of misrepresentation, in the context of celebrity personality and passing off, includes in it at the core, the act of misappropriation as the prerequisite but not all cases of misappropriation in the same context include misrepresentation. In fact – building on this observation - on a closer look at all the celebrity plaintiffs, it would not be wrong to assume that they commenced action primarily to reprimand the misappropriation/unauthorised use of their persona and not the misrepresentation that it may or may not result from it. It was the urge to prevent this prerequisite, i.e., the misappropriation, which was at the fore and not misrepresentation, given the legitimate desire of any celebrity to control the use of their persona provided its commercial value and attached dignity. Based on this rationale, one would also not be wrong to assume that the celebrities are forced to search for deception in a case of typical misappropriation when invoking this tort and thus, fail in most cases. They fail as not all cases of misappropriation features misrepresentation and the tort in its current formulation does not recognise this prerequisite to misrepresentation, to be actionable by itself.¹⁵⁵

Such inability of the tort to recognise wrong in pure misappropriation of persona in place of misrepresentation is clearly one of the biggest limitation of the tort and a lacuna in law.¹⁵⁶ Nimmer also agreed that protection should not be limited to misrepresentation but encompass all forms of unauthorised commercial exploitation of persona.¹⁵⁷ The Irvine court, in Davis’s analysis, gave relief addressing the very issue of misappropriation, but remained within the traditional confines of the trinity¹⁵⁸ and went as far as transcending source goodwill to promotion goodwill, just so that the finding of deception can be achieved. Regardless of the foundational improvements that both the *Irvine* and *Fenty* brought in the terrain of passing-off, the courts have

¹⁵³ *Waits v. Frito-Lay, Inc.* (978 F.2d 1093 (9th Cir. 1992).

¹⁵⁴ *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395.

¹⁵⁵ See, Walsh (n 102) 253-260; Beverley-Smith (n 141) 57-61; Davis (n 133).

¹⁵⁶ Wadlow (n 133).

¹⁵⁷ Melville B. Nimmer, ‘The Right of Publicity’ (1954) 19 Law & Contemporary Problems, 203-223.

¹⁵⁸ Davis (n 133).

remained firm in not accepting and/or incorporating the concept of misappropriation within the tort, although presence of it is a virtual certainty in all cases of passing off involving celebrity persona. The courts unjustified tethering on the trinity, particularly, its relentless pursuit of misrepresentation, significantly narrowed down the application of the tort in protecting celebrity personality and created a gap for non-deceptive misappropriation cases. This gap, therefore, further exposes celebrity persona at risk of various forms of harm, including loss of licensing opportunities due to dilution or loss of control, various dignitarian/reputational harm due to nonconsensual disgraceful/ use – none of which involves consumer deception.

The gap, therefore, will engulf with it the majority of the claims initiated by the celebrities. Only those celebrities, whose circumstances mirror that of in *Irvine* or *Rihanna*, can ultimately succeed in a claim under passing off. This clearly indicates how restrictive the tort has been reshaped to - despite the seismic shifts brought out by *Irvine* and *Fenty* – effectively deterring the celebrities from their desired safeguarding.

2.2.1(c)(iii) Damage

If the plaintiff celebrity has managed to reach this phase of the tort, he has definitely established his goodwill and has not been caught by the 'gap' that the misrepresentation requirement has created. At this stage, the question is merely of causation, whereby, the celebrity will have to establish that the deception caused through the unauthorised use of persona has 'injured or is likely to injure'¹⁵⁹ the goodwill that his personality entails.

Like the previous two aspects of the classic trinity, this one has also faced foundational improvements. In *Irvine*, purview of damages was extended to encompass loss of licensing fee and subsequently, Birss J further elongated the extent of damages to even include direct loss of sales and loss of control over image (i.e., persona) in *Fenty*. It is, therefore, apparent that the tort was only functional as far economic and tangible losses are concerned¹⁶⁰. As Stallard posits, this may be troublesome, as celebrities may struggle to marshal evidence of damage to his licensing trade, if he is not currently engaged in, involved or actively marketing his persona for merchandising or endorsement.¹⁶¹ This, therefore, very subtly imposed another requirement namely, 'exploitation requirement'; in that, to prove real economic loss, they must be marketing their persona themselves in the first place and expect profit from such exposure.¹⁶² This again, however, reverts to the issue where celebrities with goodwill (sufficient for the purpose of this tort), whose persona has been unauthorisedly used in deceitful

¹⁵⁹ *Reddaway* (n 80).

¹⁶⁰ See also the earlier case of *Stringfellow v McCain Foods (GB) Ltd* [1984] R.P.C. 501.

¹⁶¹ Stallard (n 108) 570; Carrie Rainen, 'The Right of Publicity in the United States and the United Kingdom' (2005) 12 New Eng J Int'l & Comp L 197, 223.

¹⁶² Kevin M. Fisher, 'Which Path to Follow: A Comparative Perspective on the Right of Publicity' (2000) 16 Conn J Int'l L 95,109.

trade practices, may ultimately fail to avail the requisite levels of damage or may even falter entirely due to lack of causation if this exploitation requirement is not satisfied.

Regardless of this possibility, Davis observed that the court over time has been flexible in defining at least this facet of the trinity to the extent that the line between damages for pure misappropriation claims and that of in passing off (which does not recognise pure misappropriation as actionable at all), blurred.¹⁶³ Whilst this should have meant, essentially, passing off to cover both economic damages and non-economic damages (like dignitarian losses, humiliation by disgraceful portrayal, etc), but in reality, as Walsh confirms, passing off only covers erosion of exclusivity as non-economic damage, but remains silent on other non-economic damages.¹⁶⁴

Interestingly, again building on the observation that the plaintiff celebrities are basically here to claim against misappropriation but does so in the cover of misrepresentation (as there is little or no other option), the real damage that they actually sustain here is to their '*exclusive right to control their persona*'. Since this is what is being harmed in misappropriation cases, the plaintiff celebrity should not be, resultantly, required to satisfy any 'exploitation requirement', as implied by Fisher¹⁶⁵. Based on the same rationale, the celebrity plaintiff should be also allowed to recuperate for non-economic losses under this tort, in addition to the economic ones, as loss of control injures both commercial interests and dignitarian interests of persona. However, this proposition is '*as good as its sounds*' being notional or a hypothesis, but indeed, a very practical one. It would have been the rationale underlying the assessment of damages and the causation therein had the court embraced pure misappropriation as actionable under the tort. Needless to say, that the court had conveniently rejected the inclusion of misappropriation despite the conducive circumstances present in *Irvine* and in *Fenty*. Rather the court decided to expand the logical bounds of the tort and not attempt judicial innovation. This again, possibly creates a lacuna in the law, similar to the one Wadlow has expressed in relation to the misrepresentation requirement above¹⁶⁶, and further restricts/limits of scope of application of the tort, making it yet more difficult for the celebrities to attain their desired remedy.

2.2.1(c)(iv) Unpredictability and Inconsistency

In the context of unauthorised use of celebrity persona, the tort remains extremely fact-specific; leaving much to turn on the very facts of each case and on how such facts are interpreted by the court for finding the classic trinity of the tort. This renders the outcomes extremely unpredictable. Carty explains it beautifully, judicial decisions in this context has not been systematically consistent historically but '*ad-hoc*'; demonstrating judicial individualism instead of doctrinal uniformity.¹⁶⁷ She added, by

¹⁶³ Davis (n 133).

¹⁶⁴ Walsh (n 102) 253-260.

¹⁶⁵ Fisher (n 162).

¹⁶⁶ Wadlow (n 133).

¹⁶⁷ Carty (n 150) 290.

citing both *Kojak* and *Wombles* as fitting illustrations, that absence of such doctrinal uniformity renders judicial outcome less predictable and inconsistent, ultimately capsizing the overall effectiveness of the tort.¹⁶⁸

Significantly, the restrictive and fact-specificness of the tort was reinforced when the courts in *Irvine* and *Fenty*, despite introducing foundational changes, explicitly confirmed that the rulings were strictly fact specific. The latter court in *Elvis*, was also seen to restrict the *Turtles* ruling to its own facts, which was once perceived as a necessary breakthrough. In *Fenty*, Underhill LJ remarked that, “...*this case is as close to the borderline*”¹⁶⁹ indicating that a slightly different factual matrix could have led to a different outcome in this case. Had a more generic image of Rihanna was used or had there being no previous affiliation between Topshop and Rihanna, no misrepresentation may have been found in *Fenty*. This ultimately negated the general application of these landmark cases in subsequent cases, so no guarantee that similar judicial conclusions would be achieved in later cases or a different outcome would have been achieved in previous cases, like *ABBA* or *Spice Girls*, if decided in the post *Irvine* and *Fenty* era.

Undoubtedly, such re-enforced fact-specificness of the rulings and the consequent unpredictability and inconsistency in the outcome, adds on to the list of the limitations and questions the overall effectiveness of the tort.

2.2.1(d) *The Only Strength:*

Conversely, amid all of these glaring limitations of the tort, commentators like, Walsh, did not stop to label the tort as an ‘open-ended- remedy’¹⁷⁰ for celebrities. This is perhaps because the adaptability and elasticity that the tort has demonstrated over the years of its application. The tort has indeed come a long way from its rigid position in *Uncle Mac* to now embracing even instances of false endorsements and merchandising deceptions through the *Irvine* and *Fenty*. The Court has refreshed and refined the requirements underlying the classic trinity, offering more protection to the celebrities than it possibly could through its original formulations of the 1970s.

Commentators have even lauded this adaptability and elasticity, referring it as a ‘*virtue of the common law*’, making it reactive and well receptive to the ever changing business practices, particularly in the world of celebrity merchandising and endorsement.¹⁷¹ It has been also praised for being cautious and for its watchful prudence in not creating monopolies that undermines competitive market practices, when expanding¹⁷²; rather it expanded with its traditional confines and stayed true to the trinity in determining liability. Such fixation to the trinity, in the lens of the

¹⁶⁸ Ibid.

¹⁶⁹ *Fenty* (n 138).

¹⁷⁰ Walsh (n 102) 256.

¹⁷¹ Bzhar Abdullah Ahmed and Talib Braim Sulaiman; Critical Analysis of The Role of Passing Off In The Modern Intellectual Property Legal System’ [2023] 6(2) International Journal of Global Community.

¹⁷² Davis (n 133) 577-579.

commentators, prioritised consumer interest by keeping deception at the forefront. This fixation further avoided non deceptive pure misappropriation cases which otherwise may have led to the 'monopoly' over persona and compromise the delicate balance between public interest and freedom of expression.¹⁷³

As seen above, the piecemeal approach of the tort (which is viewed as a limitation, quite reasonably though!) could be conversely viewed as a method to filter only legitimate claims and prevent floodgates being opened or making the tort an overbreadth. Although Scanlan was worried that the expansive attitude of the Irvine court has potentially blurred the long-established confines of the tort and resultantly, may produce unforeseen and incalculable consequences¹⁷⁴, but there is no evidence of frivolous cases flooding the courts in the post Irvine era. Such evidence may very well lead commentators like Walsh to interpret the piecemeal and fact specific nature of this tort in light of the acquired elasticity and adaptivity, as the 'strength' of the tort, begging more appraisal.

2.2.1(e) *True Effectiveness:*

Now that we have both the strength and the limitations of the tort on the table, it would not be premature to turn to the assessment of the tort's true effectiveness in affording the protection desired by the celebrities. Given the limitations, there remains no room to argue that *Irvine* and *Fenty* improvements, even at their broadest interpretation could afford protection to contemporaneous US celebrities like *Vanna White*, *Tom Waits*, or even *Hugo Zacchini*¹⁷⁵, who have successfully made out a case for personality misappropriation in the US courts. Keeping within the jurisdiction, the famous footballer, *Eric Cantona*¹⁷⁶, had his case not settled out of court, would have been either required to prove significant public deception of him (falsely) endorsing¹⁷⁷ the Defendant's wine (walking in the path of *Irvine*) or prove that public has been deceived into believing his association with the Defendant's merchandise which featured his persona¹⁷⁸ (walking in the path of *Fenty*). Provided how piecemeal and fact driven the judiciary has been in the context of passing off, one can confidently postulate that it would be an arduous task for Cantona to attract protection under the tort. In any event, plainly speaking, the overall success rate of celebrities in attracting protection under the tort has been very low as well, as evidenced above. All of these compounded, logically, may lead to the conclusion that the limitations of the tort clearly outweighs whatever strength the commentators have presumably attached to the tort. So, what does this imply for the enquired effectiveness of the tort in the context of

¹⁷³ De Landa Barajas, "Personality rights in the United States and the United Kingdom" [2009] Ent. L.R. 253,257; Walsh, (n 102) 255.

¹⁷⁴ Gary Scanlan, 'Personality, endorsement and everything: the modern law of passing off and the myth of the personality right' (2003) 25(12) E.I.P.R. 563, 569.

¹⁷⁵ *Zacchini v. Scripps-Howard Broadcasting Company* 433 US 562 (1977).

¹⁷⁶ *Cantona v. Cantona French Wines* - where football star Eric Cantona's persona was featured on the Defendant's advertisement – Stallard (n 108) 571.

¹⁷⁷ Stallard (n 108) 571-572.

¹⁷⁸ Fisher (n 162) 110.

celebrity persona? On the face of it, given the lacuna created within the classic trinity and the restrictive, as opposed to the general, application of the *Irvine* and *Fenty* rulings, the effectiveness of the tort is questionable. As such, it can be also concluded that tort is insufficient and inadequate in safeguarding celebrity persona from the 'mischief' of misappropriation or unauthorised use/exploitation.

Significantly, what makes such '*conclusion*' as to the effectiveness more interesting is that there is a divide among the commentators when it is applied against their ideologies; proponents being those who concurs with the limitations identified and thus, by extension affirms the '*conclusion*' and opponents being those who does not. The assessment of the veracity of such a *conclusion* would be incomplete unless both sides of the divide are not pitted against each other (albeit briefly).

Starting with the proponents, Davis has been the speaker, who identified and strongly condemned the tort for deliberately excluding 'pure misappropriation' from its spectrum of protection.¹⁷⁹ She, by referring to Carty's observation of *Irvine*, acknowledged that it is the 'misappropriation' and not misrepresentation that lies at the core of liability. In her words, the courts have covertly protected against misappropriation whilst outwardly denying its recognition and by extension, affirmed the lacuna in law that has been created by the misrepresentation requirement, as discussed above. Likewise, early commentators like Stallard have generally commented that the patchwork of laws, including tort of passing off, that the English courts have applied in an attempt to protect celebrity persona, offered no protection to the celebrities and went as far as advocating for the creation of a new and distinct personality right in the UK.¹⁸⁰ Such a proposal to shift or adopt a new right, clearly infers that commentators like Stallard considers the current formulation of the tort to be inadequate, thus tacitly approving the '*conclusion*'.

On the contrary, opponents like Carty has very strongly downplayed the identified limitations of the tort, by voicing against incorporating misappropriation in the tort, as otherwise, it will lead to a monopoly on personality, restricting competition and free speech.¹⁸¹ She believes that the tort's need for customer connection and misrepresentation serves a greater public interest since it ensures legal intervention on deceitful commercial practices.¹⁸² Interestingly, Carty acknowledges that the moral dilemma in preventing unjust enrichment from unauthorised exploitation of celebrity persona but in her lens, any such moral arguments are clearly outweighed by the public interest in free speech and competition. Other opponents like Walsh remarked that given the trajectory of improvement that's passing off has followed, particularly from *Irvine*, it has been reshaped to safeguard personality licensing, and she is

¹⁷⁹ Davis (n 133).

¹⁸⁰ Stallard (n 108).

¹⁸¹ Hazel Carty, "Passing off" [2012] I.P.Q. 106, 113; See also, Walsh (n 102) 253-260.

¹⁸² Davis (n 133).

cautiously optimistic that the doctrine has the potential to extend protection being highly adaptive and elastic.¹⁸³

Although Carty's objections are potent, the biggest downside of her argument is that a complete 'no' to misappropriation cases leaves deserving celebrities with no legal recourse; leading to the absurdity of prioritising an abstract competitive ideal over individual injustice through misappropriation without deception. It can be argued that Carty's public interest can be still be served and free competition would not be harmed if the celebrities are allowed to control the commercial exploitation of their persona, as it can ultimately foster a more honest marketplace; public will know the source of the product and the true endorsements whilst, celebrities could engage in persona licensing as and so he/she desires, enabling official/authorised merchandise in the market which competes on an equal footing. As to Walsh's view, whilst she has identified the blurring of misrepresentation into misappropriation in *Irvine*, she has not labelled it as a lacuna in law. She did in fact acknowledge the doctrinal limits of the tort, which ultimately, but subtly plays in the favour of *conclusion* being tested.

Based on the foregoing analysis, it can be strongly held that opponents' case is highly likely to fall short of that from the proponents. The *conclusion*, therefore, that passing off is an ineffective and inadequate means of safeguarding celebrity persona against unauthorised use is likely to stand. Moreover, it will continue to stand until such time the limitations or lacuna in law, as identified, is resolved either through further judicial innovation or legislative reforms.

2.2.2: Malicious Falsehood

2.2.2(a) *The Law*:

The tort of malicious falsehood is aimed at safeguarding a trade or business from harmful and falsely malicious statement. In its classic formulation it was designed to prevent wrongful allegation of unlawful claims to proprietary rights in land.¹⁸⁴ At the core, is the mischief of the defendant spreading false statements about the claimant to the third parties with the intent to cause harm. This tort has since undergone significant re-formulations over the centuries to now cover trading reputation of a business¹⁸⁵, its products¹⁸⁶ and even individual economic interests¹⁸⁷. Stilitz and Sales adds, the tort is designed to protect economic interest and is not confined to protection of business interest only.¹⁸⁸ The modern formulation of the tort started emerging in the late 19th century, with Bowen LJ in *Ratcliffe v Evans*¹⁸⁹ clarifying the ambit of the tort as an action which could be commenced against false statements made either in writing or orally, which may not be defamatory in itself, and made maliciously, which

¹⁸³ Walsh (n 102) 253-260.

¹⁸⁴ *Gerard v Dickenson* (1590) 4 Co Rep 18a, 76 ER 903.

¹⁸⁵ *Riding v Smith* (1876) 1 Ex D 91.

¹⁸⁶ *Western Countries Manure Co v Lawes Chemical Manure Co* (1874) LR 9 Exch 218.

¹⁸⁷ *Kaye v Robertson* [1991] F.S.R. 62.

¹⁸⁸ See also, D. Stilitz & P. Sales, 'Intentional infliction of harm by unlawful means,' L.Q.R. 1999, 115(Jul), 411.

¹⁸⁹ [1892] 2 QB 524 confirmed in *White v Mellin* [1895] AC 154.

is likely to cause damage and in fact, caused actual damage. Subsequently, the tort attained its modern form, rather oddly a difficult one despite the developments, through *British Airways plc v Ryanair Ltd*¹⁹⁰; in that, the requirements of such a claim are now in four folds, as below:

1. Falsity, in that, the statement in question must not be true; burden of proof of falsity and that, such falsity has misled the public, is on the plaintiff.¹⁹¹ The falsity to be assessed on the basis of 'one meaning rule', where the literal meaning of the words used in the statement will be taken into account.¹⁹²
2. Harmful Truth, in that, the false statement must damage the reputation of the goods or business¹⁹³, and post *Kaye*¹⁹⁴, the reputation of an individual. The context in which the statement was made will be considered in assessing the harmfulness of the statement.¹⁹⁵
3. Malice, in that, burden of proof is on the plaintiff¹⁹⁶; no clear definition exist, but malice can be established in the absence of any just cause or excuse behind the making of the statement¹⁹⁷, or if the statement is intentionally or recklessly made,¹⁹⁸ or even where there was a reckless indifference to the maker of the statement as to the harmfulness of the statement to the interest of the plaintiff¹⁹⁹; and
4. Damage, in that, burden is on the plaintiff to establish causation, i.e., special damage sustained due to the maliciously made false statement²⁰⁰. However, the traditional requirement to provide evidence of harm has been significantly relaxed by virtue of s.3(1) of the Defamation Act 1952.

2.2.2 (b) Effectiveness:

Now tuning to the application of this tort in the context of misappropriation or unauthorised exploitation of celebrity persona, i.e., the mischief that the celebrities are trying to prevent here. In Fisher and Gannon's words, a celebrity may be able to prevent the (mis)use of his persona, if it contained a malicious falsehood, which has the effect of harming his trade.²⁰¹ By contrast Scanlan deems the application of this tort inappropriate in such cases, asserting that the tort only protects a party's 'trade' or 'business' interest from the adverse effects of any falsely malicious statements

¹⁹⁰ [2001] FSR 32.

¹⁹¹ *Anderson v Liebig's extract of meat Co Ltd* (1881) 45 LT 757; See also, *British Airways* (n 190).

¹⁹² *Vodafone v Orange* [1997] E.M.L.R. 84.

¹⁹³ *Horrocks v Lowe* [1975] A.C. 135.

¹⁹⁴ *Kaye* (n 187).

¹⁹⁵ *De Beers Abrasive Products Ltd v International General Electric Co of New York Ltd* [1975] 2 All ER 599.

¹⁹⁶ See also, *British Airways* (n 190).

¹⁹⁷ *Royal Baking Powder Co v Wright, Crossley & Co* (1900) 18 RPC 95.

¹⁹⁸ *Shapiro v La Motta* (1923) 40 TLR 201.

¹⁹⁹ *McDonald's Hamburgers Ltd v Burgerking (UK)* [1987] FSR 112.

²⁰⁰ *Horrocks v Lowe* [1975] A.C. 135,

²⁰¹ Fisher (n 162) 110; Philippa Gannon, 'Sporting Glory?' (1996) 146 NEW L.J. 1160.

made but not the party's own economic interest that is harmed because of unauthorised exploitation of persona.²⁰²

The modern formulation of the tort, however, seems to displace Scanlan's view and make way for that of Fisher and Gannon, thanks to the ruling of *Kaye v Robertson*²⁰³, which happens to have broadened the ambit of the tort to also cover individual economic interest as well. In *Kaye*, the TV star Gordon Kaye obtained injunction under the action of malicious falsehood against the Defendants attempting to publish, without consent, his photographs of lying in hospital following a car accident where he sustained serious injuries. The tort, in its then formulation, could not accommodate Kaye's claim. It only afforded protection to the interest of a trade or business against malicious false statements, whereas Kaye's claim was about the misuse of his photograph, i.e., his persona. Based on this very rationale, Scanlan found it odd and 'unreasonable' for the tort to have unnecessarily extended to afford protection to something irrelevant to its subject matter, i.e., persona and its commercial value, which the tort was not aimed at protecting.²⁰⁴ Further scepticism was raised on the rationality of the *Kaye* ruling that allowed a remedy under this tort, when rejecting the same under defamation due to lack of merit.

Conversely, Holyoak, who welcomed such extension to the tort, by calling it 'useful' clarified that the ruling is relevant to the protection of persona from malicious falsehood as the *Kaye* court has *implicitly* recognised the commercial tradability and marketability of Kaye's persona.²⁰⁵ Holyoak added, if such was the court's rationale behind allowing injunction to Kaye, it should logically follow that Kaye would have incurred damage or was likely to, if the publication could not be prevented and Kaye losing his exclusive right to market his story of recovery. Interestingly, what ushered from Holyoak's analysis of the *Kaye* ruling is that if the commercial potentials of celebrity persona are recognised by the Court, then any malicious false imputation which may harm that potential and resultantly cause damage, should be remedied against under this tort. Undoubtedly, such an assumption may seem a bit far-fetched, particularly in the absence of any Courts explicitly walking in this path and most significantly, due to the continued attitude of the English judges to reject a distinct personality right.

In any event, Scanlan profoundly critiqued the consequence that imparted from the Holyoak's analysis of *Kaye*, stating that such a consequence was unlikely as the question in front of the court was whether the act of the Defendant 'falsely imputed' Kaye's consent to the impugned publication and nothing more than that.²⁰⁶ He further critiqued that Holyoak's reasoning is limited to cases where a celebrity has a sperate business, independent from his activity as a celebrity and an unauthorised use of his persona constituted a malicious falsehood which damaged the reputation of that

²⁰² Andrew McGee, Sarah Gale & Gary Scanlan, 'Character Merchandising: Aspects of Legal Protection' (2001) 21 Legal Stud 226, 236

²⁰³ *Kaye* (n 187). See also J Holyoak 'United Kingdom Character Merchandising Rights and Merchandising Rights Today' [1993] JBL 444.

²⁰⁴ Scanlan (n 111) 236.

²⁰⁵ Holyoak (n 203) 454.

²⁰⁶ Scanlan (n 111) 237.

business and not the celebrity personally.²⁰⁷ Scanlan argued, this reasoning is unlikely to fit in cases, where the use of the persona is both unauthorised and is used in a merchandising/endorsement programme, whilst being used in another programme with authorisation.²⁰⁸

Based on the foregoing, it is apparent that the celebrities are likely to struggle in establishing the relevance of misappropriation of their persona to the subject matter of protection under this tort. Assuming that celebrities can manage to pass this hurdle, they still have to satisfy the 4-part test enshrined in *British Airways plc v Ryanair Ltd*. This would be problematic as majority of misappropriation cases would not entail any false imputation with malicious intent, causing harm to the celebrity. Hypothetically speaking, misappropriation in cases like *Irvine*, *ABBA* or *Fenty* would fail to satisfy the test for malicious falsehood, as unauthorised use of their images may, if given the broadest interpretation possible, qualify as false imputation of authority but the issue of malice may remain unproven, as misappropriation may not be always done with an intent to cause harm but just done for the sake of it, be it to make profit from it or not.

Despite the evident challenges in qualifying for protection under this tort, Crown showed his optimism that this tort has been '*rather underused*' in the context of misappropriation of celebrity persona and has a potential to extend protection in such cases.²⁰⁹ Furthermore, *Kaye* stands as a good example of the tort providing remedy when other causes of action have failed. Nevertheless, the boundaries of this tort in the context of celebrity persona remains untested. Until such time it is fully tested and the challenges identified are further explored judicially or otherwise, for the purpose of this thesis and particularly for the question that this Chapter seeks to answer, malicious falsehood will be acknowledged, if anything, to provide 'some' protection (based on *Kaye*), but it will be ruled out as an effective and adequate measure of protection to the celebrities.

2.2.3: Defamation

2.2.3(a) *The Law*:

Traditionally, defamation has been defined by Atkin LJ, in *Sim v Stretch*²¹⁰ as a legal mechanism that protects an individual's reputation, where defamatory words, statements or pictures lower that individual in the eyes of right thinking members of the society.²¹¹ It was designed, as Smith puts it, to restore the plaintiff's reputation which has suffered harm, distress, or embarrassment due to a defamatory publication to a third party by the Defendant.²¹² Since its inception, it has been developed robustly through common law and subsequent parliamentary intervention led to the creation of

²⁰⁷ Ibid.

²⁰⁸ Ibid.

²⁰⁹ G. Crown, 'Malicious falsehood: Into the twenty first Century' (1997) 8(1) Ent L.R. 6; Pearson, 'Pecuniary elements of malicious falsehood' (1998) 12(6) Lawyer 12.

²¹⁰ (1936) 52 TLR 699.

²¹¹ Scanlan (n 111) 237.

²¹² S. Smith, *Image, Persona and the law* (2nd edn, Sweet and Maxwell 2008) p 5-44.

standalone statutes that dictated the ambit of its application, with Defamation Act 2013, currently being in force. The legal framework expanded further during the course of UK's membership at the European Union and most significantly, with the enactment of Human Rights Act 1998. Interestingly, defamation is seen to have considerable overlaps with various other torts, including, malicious falsehood, breach of confidence, etc, and invoking this tort with the ones it overlaps with, either jointly or in the alternative, are commonplace, as seen in *Kaye*.

As defamation seeks to safeguard one's reputation, in Scanlan's words, it may provide for an appropriate cause of action against unauthorised use of celebrity persona in the context of character merchandising (his area of focus) if such use can be showed to be damaging the reputation of the celebrity.²¹³ Further in his words, reputation and character are inextricably linked.²¹⁴ This proposition, interestingly, fits well with the essence of this thesis, as persona has been defined to include multilayered indicia such as image, voice, likeness, character, which collectively have economic values and non-economic values (dignity, reputations, etc)²¹⁵, warranting safeguards against misuse. Therefore, building on this and Scanlan's view, any form of misuse of celebrity persona be it in merchandising, endorsement or media use, which has the effect of harming his/her reputation - which is embedded in his/her personality, may attract protection under defamation. Stallard seems to agree to this as well, referring to early jurisprudence²¹⁶ and stating that unauthorised use may be defamatory if the use is contrary to the known attributes or qualities of the celebrity, derogatory to his image or goodwill or harmful to his reputation.²¹⁷ This view further resonates with that of Klink, who proposed that the robust nature of the tort may effectively fit as a subrogate for elusive personality or publicity rights.²¹⁸

A near perfect illustration of the application of the tort in the context of celebrity persona can be found from the case of *Tolley v. J.S. Fry & Sons, Ltd*²¹⁹. In this case Tolley was a famous amateur golfer and the Defendant was a chocolate manufacturer. The Defendant in their advertisement, used without consent, a caricature of Tolley being on his golfing gear just having played a stroke and a bar of Fry's chocolate sticking out from his back pocket. At the time there were strict rules for amateur golfers against endorsements and Tolley was concerned that the advertisement constituted a 'defamatory' innuendo. In that, it implied Tolley has endorsed the product for a fee and by doing so, has surrendered his amateur status, adversely affecting his image as a sportsperson based on the standards applicable then.

²¹³ Scanlan (n 111) 237.

²¹⁴ Ibid.

²¹⁵ The non-economic values of personality will be discussed in detail in the next Chapter.

²¹⁶ See cases like: *Sim v. Stretch*, 52 T.L.R. 669, 671 (H.L. 1936) (Eng.) (Atkin, L.); *Youssoupoff v. Metro Goldwyn-Mayer*, 50 T.L.R. 581, 584 (C.A. 1934) (Eng.); *Parmiter v. Coupland*, 151 Eng. Rep. 340, 341-42 (Ex. Ch. 1840) (Eng.) (Parke, B.); See also, Stallard (n 108) 573.

²¹⁷ Stallard (n 108) 573-574.

²¹⁸ 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, 351

²¹⁹ [1931] AC 333

The court found in favour of Tolley, ruling that the unauthorised use was indeed defamatory based on the innuendo that it entailed. The Court, although accepting a claim in defamation due to the magnitude of the harm caused to Tolley, also remarked that, it should be within the usual expectation that getting involved in a certain line of work or profession can naturally ‘thrust’ a person to public limelight. Such comment from the Court can be interpreted in two ways. Firstly, use of famous person’s image like Tolley’s, in Court’s opinion, is a common occurrence in a celebrity life and not *unexpected*, so not all unauthorised use would be actionable under this tort. Secondly, based on this very reasoning, Tolley’s case would have been concluded differently but for the potential harm that Tolley would have suffered in this case from the unauthorised use. Professor Buchanan²²⁰ critiqued such mindset of the Court, asserting that if the Court maintains such an ideology, it will essentially allow misusers to freeride on someone else’s fame.

Further following Coleman’s view that, “...*had the plaintiff been a professional golfer he would not have succeeded in his claim ... as the adverse imputation would not then have amounted to a libel.*”²²¹, it could be safely presumed that the Court has made its intentions clear; absent special circumstances, particularly the innuendo that existed in Tolley’s case, it is highly unlikely that any unauthorised use of persona could be actionable under defamation. Scanlan reaffirms this by clarifying further that the only other way defamation may be invoked against unauthorised use of persona, if the (mis)use is in the context of character merchandising and it is such that it implies hypocrisy on the part of the celebrity or any improper or questionable conduct.²²² An example of this can be where a celebrity has used his persona to advocate for wild life preservation and his persona has been subsequently misappropriated in merchandising high end leather products made of animal skin. On the contrary, unauthorised use of let’s say, Zayn Malik’s (a famous English singer) image to merchandise acoustic guitars would not be considered defamatory, despite the misappropriation and the freeriding on Zayn’s fame, as his unauthorised association with the guitars would not harm his image as a singer. Moreover, by extension, as Scanlan confirms, any unauthorised uses in advertisement campaigns which are illegal or immoral may also be actionable under the tort.²²³

2.2.3(b) Effectiveness:

Now let’s turn to the question of what this tort of defamation offers to the celebrities who are trying to prevent the mischief of misappropriation. Given the outcome of *Tolley*, despite relief was granted to the celebrity there, it has been kept restricted in its application by emphasising on the need for a special circumstances or innuendo

²²⁰ Catherine Louise Buchanan, ‘A Comparative Analysis of Name and Likeness Rights in the United States and England.’ (1988) 18 Golden Gate U. L. Rev, 308.

²²¹ Allison Coleman, The Unauthorized Commercial Exploitation of the Names and Likenesses of Real Persons’ (1982) 7 Eur. Intell. Prop. Rev. 189; See also, Buchanan (n 220).

²²² Scanlan, (n 111) 239.

²²³ Ibid.

for the claim to succeed. Absent such circumstances, instances to invoke defamation are very limited. Even in those very limited circumstances, as Stallard²²⁴ remarked and Fisher²²⁵ agreed, just proving unauthorised exploitation would not suffice and as Blum²²⁶ added, such use must also damage the reputation of the celebrity. In terms of proving damage to reputation, again, that may also prove to be challenging as the court would consider the *use* from the point of view of an ordinary, reasonable and a fair-minded reader, as seen in *Charleston v News Group Newspapers*²²⁷. In this case, the unauthorised publication of digitally doctored images containing the heads of TV actors in pornographic poses were held not be defamatory. This decision was reached since such publication together with the disclaimer which it entailed, could not cause any reasonable reader to infer that the plaintiff celebrities have participated or consented to such alterations and thus, the (mis)use did not imply any improper or questionable conduct on the part of the actors, so no defamation. *Charleston*, therefore, served not only as a fitting example showcasing the difficult threshold of application but also a further weakness in the action, in that, addition of a disclaimer as to the missing consent of the celebrity in respect of the impugned use would simply put the use as non-defamatory, so no protection.²²⁸

Furthermore, in practice, as Bains²²⁹ reminded, invariably all misusers (except news publishers) would want to exploit the persona in its 'best-light' by relying on its positive aspects to maximise profits rather than subject such commercially potent persona to criticism or ridicule and diminish its value.²³⁰ This can only logically mean that instances of misuse leading to damage to reputation/persona would be very *rare* given the underlying purpose of the misusers (i.e., to profit), leaving defamation to apply only in extreme cases of persona misappropriation.²³¹ Interestingly, if cases like *Irvine*, *Fenty*, *ABBA* or even *Douglas* are brought to be seen under the scope of this tort, none of these contained any special circumstances like *Tolley* and as such, none of these cases would qualify as those extreme cases where defamation is likely to function.

Given the foregoing, there appears to be no room for doubt that scope of applying defamation against misappropriation of celebrity personality, is astutely limited. Although initially there were some optimisms of defamation providing viable remedy as it has the design to safeguard reputational harm, which could be extended to celebrity personality, based on the current trend in its application, however, it provides very little in comparison to that initial optimism. So, for the purpose of this thesis, particularly the question that this Chapter seeks to answer, defamation, just like malicious falsehood will be acknowledged, if anything, to provide 'some' protection

²²⁴ Stallard (n 108) 53.

²²⁵ Fisher (n 162).

²²⁶ Blum (n 5) 137-147.

²²⁷ [1995] 2 AC 65.

²²⁸ *Charleston* (n 227).

²²⁹ S. Bains, 'Personality rights: should the UK grant celebrities a proprietary right in the personality? Part 1' (2007) Ent L.R. 164.

²³⁰ Blum (n 5) 137-147.

²³¹ Stallard (n 108) 572-573.

(albeit in very limited circumstances), but it will be ruled out as an effective and adequate measure of protection to the celebrities.

2.3: The *Un-helpful* IP Rights

2.3.1: Trademark

2.3.1(a) *The Regime:*

In the UK, the trademark regime is dictated by the Trade Mark Act 1994 ('TMA'). The TMA allows, "...*any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of the other...*"²³² to be registered as a trademark. Owning a trademark, enables the holder of the mark to prevent a third party from using the mark without having to establish misrepresentation unlike passing off, as seen above. The TMA now expressly allows, "...*words (including personal name), designs or letters...*"²³³ to be subject matter of trademark provided it is distinctive in nature. Celebrities, therefore, frequently seek to register their names, nicknames, signatures, logos, or other indicia as trademarks for products and services they endorse or promote, under the TMA.

The landmark ruling that continues to assert authority when it comes to trademarking celebrity 'names', despite being decided under the now-superseded Trade Marks Act 1938, is the *Elvis Presley Case*²³⁴. In the instant case, the Court faced an application from the deceased singer's estate to register *names* like 'ELVIS', 'ELVIS PRESLEY', and the *signature* 'Elvis A Presley' for a range of toiletries under one particular class of use, which was opposed by an existing merchandiser of Elvis Presley related memorabilia, trading as 'Elvisly Yours'. The application, though accepted by the Trademark registry, was subsequently rejected by the High Court, when Laddie J confirmed that the application failed as *names* could not pass the threshold by not being indicative of the commercial source and being just descriptive. Such descriptive attribute has negated the '*distinctiveness*' of the name which was central for the requested registration. Breaking this down further, the Elvis court was convinced that the Elvis themed memorabilia were purchased by the public because of the very 'Elvis' theme it featured and not because it implied the source of the product, which trademarks are designed to indicate. The Court was also not convinced that the name was distinctive enough to be trademarked it has long passed into common language²³⁵; thus, losing its exclusivity in distinctively identifying the source, owing to the enormous popularity of Elvis throughout the world.²³⁶

²³² Trade Mark Act 1994 (TMA), S.1.

²³³ TMA 1994, S.1(1).

²³⁴ *Elvis Presley Trade Marks* [1999] RPC 567 (CA)

²³⁵ See also *Tarzan Trademark* 1970 R.P.D. & T.M. 450 (C.A.) (Eng.) (refusing to allow an American company to register a trademark for the name Tarzan)

²³⁶ See, Stallard (n 108) 569; Rainen (n 161) 220.

Laddie J's reasonings were subsequently affirmed by the Court of Appeal, which went a step further to indicate that the claim brought by the famous singer's estate was not one for mere trademark registration. It was, in fact, a claim for establishing an exclusive right of character exploitation (i.e., personality right) for the celebrities, covertly, under the guise of a trademark application. Simon Brown LJ confirmed that the trademark regime is no place for acknowledging and/or accommodating such rights and reinforced focus of trademark where it should typically be, i.e., on the test of distinctiveness and the ability to signify origin. He added, *emphasis drawn*, that merely being famous or putting a famous name as the proposed mark will not automatically satisfy the underlying threshold.²³⁷ Morritt LJ, observed the lack of any evidence demonstrating a connection between Elvis's name and the goods in question and confirmed that in absence of such evidence the mark will be viewed by the public as purely descriptive.²³⁸ Simon Brown LJ further consolidated this by reiterating that Elvis was famous as a singer and not as a soap producer, and thus, Elvis' name as a mark failed to signify the good's origin.

Contrary to Elvis court's standing, the TMA, which, as Stallard observes, have relaxed the whole trademark regime by allowing personal names to be accepted as a valid trade mark.²³⁹ In doing so, it has attracted countless personality-related applications immediately after it come to force from the likes of Eric Cantona, Alan Shearer, etc.²⁴⁰ Now, that should have meant a clear steer away from *Elvis*, but the English judiciary in subsequent cases remained inclined to *Elvis* by clinging on to the distinctiveness requirement even after the TMA, making it apparent that the right to register names as a mark does not automatically render it a valid trademark. One such noteworthy claim, where a similar conclusion was reached by the Courts is *Diana Princess of Wales* case²⁴¹. There, the estate sought registration for the *name* 'DIANA, PRINCESS OF WALES' across various goods and services which were on high public demand following her demise, as those commemorated her life. The Hearing Officer, as Blum pointed out, formed the view that the public are unlikely to attach any trademark significance to the Princess' name featured on the commemorative items.²⁴² This was particularly because, no such significance existed during her lifetime and that, an average purchaser would not expect that all commercial items bearing her name came from the same source.²⁴³ Resultantly, the name was not found to be distinctive and more significantly, not indicative of the source for the purpose of trademark registration and the application failed.

Interestingly, this relevance of *Elvis* in the presence of the clear provisions in the 1994 Act was questioned in *Winterson v. Hogarth*²⁴⁴, by referring Elvis' requirement of

²³⁷ See, Stallard (n 108) 598.

²³⁸ Ibid 593.

²³⁹ S.1 TMA 1994.

²⁴⁰ Stallard (n 108) 593.

²⁴¹ [2001] ETMR 254.

²⁴² Blum (n 5) 139.

²⁴³ Ibid.

²⁴⁴ [2000] E.T.M.R. 783, 790 (Eng.).

distinctives to be what was required under the previous Act and not the one in force. However, later cases like the *Linkin Park Case*²⁴⁵, clearly shows that the *Elvis* ruling remains relevant, as it was before, since this case also turned on the need to establish distinctiveness into implying the origin, which it failed and hence, the name received no registration.

Furthermore, for a clear and clever insight, one can look into the practice statement contained in the Trade Mark Registry's Examiners Guide 2018 (as updated on 2024).²⁴⁶ It is considered relevant to this part of the project since the Guide dictates how an application is determined by the Examiners and would, therefore, help to ascertain the instances where they are prepared to allow registration and thus, allow protection to the celebrities.

As to famous names²⁴⁷, the practice statement dictates that its suitability for acceptance would very much depend on the category of goods/services that the application covers, and the *level* of popularity enjoyed by the applicant celebrity. It factors in the possibility that if the famous name is used on to certain types of goods like memorabilia or commemorative articles, the average consumer will merely view the name/mark as an indication that the goods/services are about that celebrity rather than an indication of the trade source. So, no registration in such cases; exactly what *Elvis* has mandated. Conversely, if the same famous name is applied for as a mark on media items like printed publications, musical recordings, films, videos, TV programmes, etc., on the basis that the name would imply commercial control over these articles, and that the release/marketing of such articles has been authorised by that celebrity, registration will be granted. It is astutely inferable from this that if a celebrity is famous in the music industry and wants to trade mark his name in relation to a music album he is releasing, there will be no issue as to distinctiveness (regardless of his level of popularity) as his name as the mark on the music album will clearly indicate its trade source (i.e., the celebrity own the music album or that the work is his).

In respect of image carriers²⁴⁸ (e.g., posters, calendars, photographs, transfers and figurines) the famous name will not be considered as distinctive but rather seen as the subject matter of such goods and this will deny registration.²⁴⁹ The level of popularity will also have a bearing on such determination, as reaffirmed in the *A/lex*

²⁴⁵ *Linkin Park LLC* [2006] ETMR 74.

²⁴⁶ 'Manual Of Trade Marks Practice' (2018) <www.gov.uk/guidance/trade-marks-manual/the-examination-guide>

²⁴⁷ Ibid, Part B.

²⁴⁸ Ibid.

²⁴⁹ See, Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Linkin Park* (In The Matter Of Application No. 2313504 In The Name Of Linkin Park LLC): "*First, if one imagines a consumer who wants a poster depicting LINKIN PARK asking a shop assistant whether that shop stocks such things, he would be very likely to say "Do you have any LINKIN PARK posters?" I accept that he might use the alternative formulation, but in my judgment this is less likely. In the question "Do you have any LINKIN PARK posters?" the mark is clearly being used to describe a characteristic of the goods being sought, namely their subject matter.*"

Ferguson Trademark case²⁵⁰. Conversely so, if the celebrity is still on the lower end of popularity metric, the outcome of the application can differ.

As to the famous names of deceased celebrities²⁵¹, the Guide dictates that those are more likely to be viewed by public merely as a historical or tributary reference to the subject matter of the products and not as indicative of the trade origin of the goods. So, no registration. However, application outcome would turn on facts of each case, particularly factors like length of time after death, connection between the products in the application and those associated with deceased celebrity will be considered.

In relation to registering pictures and photographs of celebrities, be it living or deceased, the Examiner's position remains the same with that of in cases of famous names.²⁵² Based on the category of the goods or services in question, celebrity photos and pictures are likely to be viewed as mere decoration and thus, lack the distinctiveness required. The pictures or photographs of a celebrity could not be construed as a trademark if used on image carriers like posters, calendars, etc as it would be seen purely as the subject matter and not indicative of the origin. Interestingly, it may be found distinctive, if the category of the goods is changed, e.g., instead of image carriers, let's say a film, where that celebrity has played a role in.

2.3.1(b) Testing the Trademark 'Teeth':

So, moving on, with the backdrop as above, where does this actually take the celebrities and the mischief of misappropriation that they seek to prevent?

At the onset, one needs to make peace with the fact that the existing trademark law does not capture every aspect of celebrity persona. The TMA, the case laws and the practice guidance suggests that trademark registration and thus, protection may be available for *names, signatures, and symbols* provided these have passed the distinctiveness threshold. Other facets of the celebrity personality, including but not limited to voice, face, unique mannerisms, likeness, image, character (real or fictional) falls outside of the trademark safety net. Most importantly, as aforementioned, celebrity photographs or likeness are not afforded protection due to lack of distinctiveness and as such, runs the risk of misappropriation unless the celebrity can use a registered trademark (may be on his name or logo) in connection with it. *Fenty* provides a fitting illustration on this. Rihanna had an established fashion brand and

²⁵⁰ Appointed Person in respect of the mark Alex Ferguson (In The Matter Of Application No. 2323092 In The Name Of Sir Alexander Chapman Ferguson): "*The more famous the personage(s) or event(s), the more likely it is that there will be a market for such goods and the less likely it is that the name will be regarded as acceptable for registration in relation to goods of that kind on the basis of the approach currently applied by the Registry in the United Kingdom.*"

²⁵¹ PS, part B; See the example provided: In respect of names of famous composers, such as Beethoven or Vivaldi, for musical recordings or entertainments services, the names are unlikely to be seen as a trade mark for such goods or services but merely a reference to the music being performed. However, the names are likely to be acceptable for goods such as paints or bathroom fittings for example.

²⁵² 'Manual Of Trade Marks Practice' (2018) <www.gov.uk/guidance/trade-marks-manual/the-examination-guide> Part B

had related marks (in her name, logo, stylised abbreviations) registered for her merchandise. Topshop, quite cleverly, avoided using any of her registered name or logo and instead exploited one of her images which had no label or mention of her registered name or logo, leaving it outside of trademark protection. Had the image in question was trademarkable, Rihanna could have been afforded protection. Therefore, celebrities cannot rely on trademark alone to protect every aspect of their persona, making this one of the crucial limitations of trademark protection.

Even to avail protection for those accepted aspects of persona, celebrities would require passing the formalities of application, registration, specifying the class of goods and use. A celebrity who has not yet exploited his persona commercially or has not created a brand for himself around it, would, regardless of having sufficient value in his persona, have no enforceable trademark on it. More importantly, in absence of such commercial exploitation, specifying the class of goods and use would be a matter of impossibility and such formalities may never get fulfilled and the application rejected.

Now let's assume that the celebrity has entered the realm of registration and applies to register his famous name. Owing to the applicable precedents, the name simply being famous will not be automatically afforded registration. By contrast, as *Elvis* dictates, the more famous it is, the less distinctive it becomes so slipping away from the safety net.²⁵³ As celebrities will be famous naturally since that is their career hazard, it would then seem likely that they would never achieve distinctiveness to pass the threshold. Undoubtedly, this is the biggest paradox and a yet another limitation that exist within the trademark regime; as the very fame that has given birth to the persona which warrants protection, is now being held to outweigh the distinctiveness that is needed for availing that protection. Nevertheless, as the courts and examiners have been seen to measure the level of fame when it comes to distinctiveness, we can assume there is still hope for celebrities in this regard; a hope that they are not found to be on top end of the fame ladder!

Significantly, this distinctiveness will be required for the purpose of satisfying the prerequisite of registration, in that, the public must be able to identify the trade origin/source of the goods or services in question through the mark proposed. It is, therefore, the creation of that perception in public's mind which will complete the registration. If the mark falls short of creating this perception, it will be held to be merely describing the subject matter, and the registration will fail. As such, this prerequisite is a crucial requirement for trademark registration and also a crucial limitation at the same time. Crucial requirement as in, otherwise the purpose for a trademark will be frustrated; crucial limitation as in, because the celebrities will be required to take extra steps for the perception to be established and reinforced among the public. Blum referred this as having to '*educate*'²⁵⁴ the public (by the celebrities themselves) on the fact that the celebrity is using his name on the concerned articles in a trademark

²⁵³ See, Stallard (n 108) 569-570; Rainen (n 161).

²⁵⁴ Blum (n 5) 140.

'sense', so that the public perception required as a prerequisite can be forged. This need to 'educate', in fact resonates with Morritt LJ, who suggested that creating a public perception is possible even for trademarking a *name* (though it appeared to be impossible following *Elvis*) if proactive measures are taken.²⁵⁵

Morritt LJ, however, did not include in his judgment what he actually meant by referring to taking proactive steps or in his words, ditto, '*whatever means*'. It can be, perhaps safely presumed that he alluded to the common practice of modern celebrities of creating a brand for himself by actively employing his persona in commercial enterprises, that both establishes and reinforces the said public perception. Porter's view supports this, when he stated that celebrities by trading extensively under a sign featuring their name or image can achieve the required level of distinctives for the purpose of registration.²⁵⁶ Celebrities like David and Victoria Beckham holds successfully registered UK (and also EU) trade marks in their names to brand clothing, fragrances and other merchandises; famous singer Cliff Richard obtained registration in his name "Cliff Richard" in addition to his stylised signature for music and related articles, even Mo Farah, the famous Olympic athlete registered his signature celebration pose MOBOT as a *logo*, in relation to sports clothing²⁵⁷. These are fitting examples where the creation of such a brand and maintaining it, has procured the celebrities the necessary trade mark distinctiveness, since this will constantly make the public to perceive that the celebrity is using the mark in the trade mark *sense* and not as a mere adornment on the product or as a pure subject matter. There is no telling that this is, in itself, a big ask from the celebrities, as just becoming famous was not enough, they would also have to proactively work to develop their persona into a 'brand' and constantly maintain it just so to hold on to the distinctiveness and be eligible for trade mark registration. Walsh quite justifiably critiqued this, as she viewed distinctiveness or trade origin not to be the concern of celebrities since their persona mark is just about the glamour which is added to the product when the mark is used on it.²⁵⁸

Nevertheless, this would also mean that those celebrities who have kept their persona away from the usual commercial exploitation, would never be able to develop a brand around them and so, can never attain the distinctiveness required and fall out of protection/trademark registration.

Moving on, even after all these limitations if a celebrity manages to acquire registration, he or she can invoke his/her trademark rights only if the mark has been misappropriated on competing or similar goods/services.²⁵⁹ If the celebrity's mark has been misappropriated on an unrelated and unsimilar product, or unauthorised use

²⁵⁵ *Elvis Presley* (n 234): as per Morritt LJ "... it must be for that person to ensure by whatever means open to him or her that the public associate his or her name with the source of the goods"; See also, Blum (n 5) 140.

²⁵⁶ H. Porter, 'Character Merchandising: Does English Law Recognise a Property right in Name and Likeness', [1999] Ent. L.R. 180

²⁵⁷ Jennifer Heath, 'Celebrity trade mark hall of fame' (*CITMA*, 17th Oct 2018) <<https://www.citma.org.uk/resources/celebrity-trade-mark-hall-of-fame-blog.html>> accessed 02 February 2025

²⁵⁸ Walsh (102) 253-260.

²⁵⁹ s.10 (1) TMA 1994.

does not confuse the public about the trade origins/endorsement, trade mark protection will not be triggered. Trademark is designed to prevent dilution of brand or consumer confusion and if such dilution or confusion are not present, trademark has no role to play. This creates a whole new gap in the purported protection and there are incalculable ways (satirical, parody uses to name a few) in which the trademarked celebrity persona can be misappropriated but the trademark regime, as such, is likely to remain silent about it.

However so these limitations are, celebrities can still benefit from trademark rights, as it operates to prevent confusing uses, unfair exploitation or dilution of brand.²⁶⁰ The test to establish the breach is also quite straightforward, unlike the classic trinity we have witnessed in respect of passing off. Once registered, the trademark confers on the celebrity, a property right²⁶¹ (at least on the indicia of his/her persona that is trademarkable). Such property rights are capable of assignment, transfer or licensing, in full or in part, through agreement or Will, to another²⁶² and the right would remain indefinitely, provided renewal is done every 10 years.²⁶³

Further in the line of benefits (albeit short), the recent ruling in *The Name Of Global Trademark Services Ltd* ²⁶⁴ by Geoffrey Hobbs KC, confirmed that any applications filed by unauthorised third parties, attempting to register a celebrity's name in 'bad faith' will be refused by the UK Intellectual Property Office. This decision was reached when third parties tried to register the name of famous footballers, Thierry Henry and Ronaldinho as a mark on a clothing line. The decision conferred a further benefit – more like an indirect protection to the celebrities, as unrelated and unauthorised person cannot obtain trademark registration on a famous name and monopolize it, in the absence of any registration being obtained by the famous person himself.

Conversely, no matter how convincing the benefits of trademark rights may sound, it is only game after the celebrity has managed to obtain registration. Without registration, the realm of trademark protection remains inaccessible for the celebrities. Protection under trademark may be available only to few aspects/indicia of a celebrity's multilayered persona. Protection is not available if one is *excessively* famous as it causes the distinctiveness to wither away. Protection may not be available if one is not *excessively* famous and have also not developed a brand around that fame. Protection is only available when you are famous only up to the acceptable standards – the measure of which still unknown and is likely to vary from application to application – and also have worked to build a brand around that fame. So, on closer observations, it is not too difficult to see that the English trademark regime provides protection only in extremely limited circumstances and that also, only to few indicia of persona. Providing for protection in extremely limited circumstances cannot be

²⁶⁰ s.10 (2)(3) of TMA 1994.

²⁶¹ s.2 TMA 1994.

²⁶² ss.24-25 TMA 1994.

²⁶³ ss.42-43 TMA 1994.

²⁶⁴ BL O/264/22 – TRADE MARK APPLICATIONS No. 3587268 AND No. 3595047; <www.ipo.gov.uk/t-challenge-decision-results/o26422.pdf> accessed 21 December 2024.

construed as providing efficient and adequate protection; as qualifying into those limited circumstances seem highly improbable, meaning majority of the celebrities will be afforded no protection at all. Trademark law, therefore, is not the panacea for the mischief of misappropriation of personality and celebrities are unlikely to find any safeguarding in garnering relief under it.²⁶⁵ It is also, therefore, not an effective and adequate measure of protection against the mischief that the celebrities are trying to avoid.

2.3.2: Copyrights

2.3.2(a) *What are copyrights?*

Copyright falls within the patchwork of legal remedies that has been explored by the celebrities in the UK in an attempt to safeguard their persona from misappropriation or unauthorised exploitation. The copyright regime in the UK is dictated by the Copyright, Designs, and Patents Act 1988 (CDPA), through which the owner of a fixed and ‘*original*’ artistic, literary, musical, dramatic work (collectively, the ‘*protected works*’) can prevent another from exploiting, reproducing or substantially copying these works.²⁶⁶ Most significantly, such rights are automatic and is not dependent on prior registration, unlike trademarks.²⁶⁷

Simply put, copyright affords an exclusive right to the creators or owners to ‘control’ the use of such works, particularly in terms of its reproduction, distribution, performance or its communication to the general public. As such, for the works to attract protection under copyrights, it must be the owner’s original work²⁶⁸ and must be independently created.²⁶⁹ To preclude a third party from appropriating such protected works without authorisation, proof of a *substantial* part of that protected work being appropriated (quality and not quantity wise) will be also required.²⁷⁰

Now let’s take a step back and re-conceptualise the mischief that has led us to consider the regime of copyrights in the first place. The mischief, in its simplest formulation, is the misappropriation or unauthorised exploitation of celebrity persona, that the celebrities require safeguarding owing to its inherent values be it economic, reputational and goodwill. The copyright regime in its legislative formulation and by its very ‘definition’ is aimed at protecting only the original work of the individual but the not individual himself. This is problematic, as persona, which commonly features the celebrities name, image, voice, likeness, etc., are not ‘*works*’ created by these celebrities; rather persona is the celebrities themselves – their attributes, a

²⁶⁵See also, Reshma Amin, ‘A Comparative Analysis of California’s Right of Publicity and the United Kingdom’s approach to the Protection of Celebrities: Where are they Better Protected?’ (2010) 1 Case Western Reserve Journal of Law, Technology & the Internet, 93, 112.

²⁶⁶ Copyright, Designs & Patents Act 1988 (‘CDPA’).

²⁶⁷ M. Flint, N. Fitzpatrick & C. Thorne, *A User’s Guide to Copyright* (6th edn, Tottel Publishing 2006).

²⁶⁸ CDPA 1988, Section 2 (1) and Section 9.

²⁶⁹ Rainen (n 161) 216.

²⁷⁰ *Bauman v. Fussell*, [1978] R.P.D 485, 487 (C.A.) (Eng.); *Ladbroke Ltd. v. Hill Ltd.*, (1964) 1 W.L.R. 273, 276-78. See also, Stallard (n 108) 568.

manifestation of their outward self²⁷¹. So, this multifaceted notion of celebrity persona that seeks protection may not fit well (or at all) within the definitional requirements of copyrights. To better understand the likelihood of fitment, the common indicia of personality will be separately assessed in light of the copyright regime and conclusion drawn on whether copyright affords any protection and if so, whether, it is effective and adequate in the context of celebrity personality, which is the fundamental question of this Chapter.

2.3.2(b) Copyrighting the Indicia:

Beginning with the indicia of 'name', it has been the long-standing mindset of the Court that names are not copyrightable since *Du Boulay v Du Boulay*²⁷². Subsequent courts affirmed this position and in *Exxon Corp. v Exxon Insurance*²⁷³ the Court underscored the insubstantiality of a name or title, in itself, to qualify as an original literary work as it lacked the necessary creativity or length. Significantly, the final nail came about when the Court of Appeal in *Elvis*, as we saw above, re-affirmed that names are not protectable under copyrights. So, for celebrities there is no shielding under copyrights against misappropriation of their names. Interestingly, in theory, celebrity signatures or autographs if 'unique' and as a graphical depiction of the celebrity's name or mark and containing his distinctive handwriting, styling or design, could qualify as an original artistic/graphic work and attract protection.²⁷⁴ In practice, however, instances where such distinctive and unique signatures have been misappropriated and copyrights have been involved is rare, therefore, this theory remains to be fully tested. Another reason for this is that, as already seen when discussing trademarks above, celebrities more often take the route of trademark registration for their signatures and if protected, seeks safeguarding under trademark rather than invoke copyrights.²⁷⁵

Turning to images and photographs of celebrities, if a celebrity has been featured in a photograph or video or has himself been painted in a portrait or drawn (even in a caricature), the resulting image may attract protection under copyright as an artistic work²⁷⁶. As copyright is afforded to the author or creator of the original work, protection will be normally received by the photographer, videographer, painter or the artist and not the celebrity himself whose image has been featured in such works. This means that the celebrity will have no say in how the author would use his image; if a third party, then misappropriates the image and the author takes no action against it, the celebrity will have no right to stop such misappropriation under copyright.

Fenty, hypothetically illustrates this well, since Rihanna would fail in her claim if it was invoked under copyrights, as the copyright of the Rihanna's image (taken at the video shoot for one of Rihanna's music albums), used by Topshop in their t-shirts, was with

²⁷¹ See also Frazer (n 1); Scanlan (n 111), 230.

²⁷² *Du Boulay* (n 10)

²⁷³ [1982] R.P.C 69.

²⁷⁴ CDPA, Section 4(1).

²⁷⁵ See, *Barry Artist Trade Mark* [1978] R.P.C. 703.

²⁷⁶ CDPA, Section 4 - photographs, paintings, drawings, etc. are protected.

the photographer and Topshop has obtained necessary permission from the photographer before use. The only time, however, the celebrity would be afforded copyright protection on such photographs, paintings or drawings which depicted his image is when the celebrity himself has commissioned the work or has created it themselves.²⁷⁷ Interestingly, if *ABBA*, had attempted recourse under copyrights, they would require proof that the image which was misappropriated by the Defendants was their self-commissioned original artistic work and not owned by any other party in order to attract copyright protection; one can only assume how insurmountable task this would be given the incalculable times ABBA may have participated in photoshoots or has been photographed by photographers regardless of those being commissioned or not. This further illustrates that restricting image to self-commissioned photoshoot/videos only - for the purpose of attracting copyright protection - may not be the most convenient thing to do, particularly for celebrities who may get snapped literally anywhere. So, there is always the risk of the exploiters using an image which is not self-commissioned or is official, and hence, leave the celebrities with no remedy under copyrights. Well, such exploitation may infringe the photographer's copyright, as already explained how, but this is not of relevance here and not helping the celebrities against the mischief at all.

In terms of celebrity voice, contrary to CDPA requirements, it is not a 'work' of the celebrity which would otherwise attracted copyrights. This essentially meant that if a celebrity's voice, vocal style or even the accent is impersonated or mimicked without copying the original voice or sound recording (which may be a protected work within CDPA²⁷⁸), it will not be caught by copyrights. Indeed, there is copyright protection if the voice of the celebrity is fixed in a recording where he vocals a soundtrack or delivered a dialogue in a film; but there is no protection if the voice has been imitated or impersonated without having used any such protected recordings. US cases like, *Midler v. Ford Motor Co*²⁷⁹ and *Waits v. Frito-Lay, Inc.*²⁸⁰ illustrates good examples of such voice imitation or impersonation, which although was found unacceptable in the US courts thanks to their right of publicity, but if tested under the English copyright regime would resulted in the contrary, as no original voice recordings or sound works of these aggrieved celebrities were copied in these cases. So, there is no automatic protection for the celebrity voice, here.

As to the likeness of the celebrities, it is easily inferable from *Elvis*²⁸¹ ruling that the courts are unwilling to safeguard a celebrity likeness because such likeness is not regarded as 'owned' by the celebrity. Again, likeness is not the celebrity's separate work, it is just them; so, it fails to qualify as a protected work within the meaning of

²⁷⁷ CDPA, sections 1 (1)(a), 4 (1), 9 (1), 11 (1)-(2), 16; See also, Rainen, (n 161) 218; Bains (n 229).

²⁷⁸ CDPA 1988, s.1(1)(b).

²⁷⁹ 549 F. 2d 460 (9th Cir. 1988).

²⁸⁰ 978 F.2d 1093 (9th Cir. 1992).

²⁸¹ *Elvis Presley* (n 12) – “Enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any of the myriad of photographs, including press photographs, and drawings in which it does not own the copyright simply by reason of the fact that they contain or depict a likeness of Elvis Presley.”

CDPA. Illustratively, therefore, none of the depiction of likeness, be it *Irvine*'s likeness in holding a device bearing the logo of Talksports radio station, robot look-alike impersonating the likeness of *Vanna White*²⁸², or even Eric Cantona's likeness on the wine advert using his famous catch phrase 'Ooa Aah' would fall within the ambit of copyright protection and no remedy will be offered.

Finally, as to character persona, copyright is likely (but in a limited manner) to extend protection to the fictional characters (e.g., Tom Cruise's character in *Mission Impossible* or Sacha Baron Cohen's character in *The Dictator*) that celebrities are portraying as a part of a film script or a motion picture/film. These are protected works within the meaning of the CDPA (as seen in *The Turtles*) and even fictional cartoon characters or caricatures could be considered as artistic works and thus, protected.²⁸³ Stallard, however, remarked that there will be no protection if the very idea or concept underlying the fictional character has been copied and also if the misappropriation is so imprecise that there appears to be no identifiable resemblance with the original work.²⁸⁴ Also, even if such copyrights are found, it is likely to be with the script writer or the makers of the movie and not necessarily with the celebrity behind the character. So, again, no protection at least to the celebrity in the event of misappropriation. In any event, other than in fictional characters, as Blum concluded, copyrights offer no protection to the real character, which was behind the fictional character.²⁸⁵ A celebrity's real character is again not his 'work' and not something that he owns, - that's just his living and breathing self; so no protection is offered under copyrights. This essentially means that the distinctive traits of their real persona like mannerisms, particular speaking or walking styles, signature moves are not protected unless these transcends into a separate artistic or otherwise protected work within the meaning of CDPA, and therefore, at risk of being freely misappropriated through imitation or otherwise. As such, Cristiano Ronaldo's SIUUU celebratory pose or Gareth Bale's Eleven of Hearts pose, could be openly copied without incurring any liability under copyrights (but may be protected under other areas of law, like Trademark) unless it was captured in a photograph or in any other forms that are covered by the CDPA. Likewise, if a celebrity popularises a particular fashion trend or even hair styling, misappropriation of such idea would attract no protection allowing exploiters to free-ride on the celebrity's popularity using it for advertising or promotional purposes, unless such idea has been transcribed into any of the protected works.

To sum up, there are many indicia in multi layered notion of celebrity persona, which the copyrights cannot safeguard due its own foundational requirements. As Nimmer confirms, '*...the old-fashioned copyright can no longer guide us in developing mechanisms to solve the many difficulties we encounter*'²⁸⁶. One of the difficulties that Nimmer is indicating to, must be the safeguarding of celebrity persona. Copyrights

²⁸² *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992)

²⁸³ Blum (n 5) 142-143; See also, Stallard (n 108) 568.

²⁸⁴ *Ladbroke* (n 270); See also, Stallard (n 108) 568.

²⁸⁵ Blum (n 5) 142-143.

²⁸⁶ David Nimmer, 'The End of Copyright' (1995) 48 Vand L. Rev. 1385 at 1420.

have been designed to protect creative works of the creator and not the creator himself, who may be a celebrity and definitely have on himself a persona which is equally, if not more, commercially lucrative as the creative work. Observing how copyrights may or may not work in protecting persona by testing its application on different aspects of one's personality, it can be strongly held that copyright is not suitable for preventing misappropriation of celebrity persona. It is a clear definitional and structural misfit when put in the legislative bounds of the copyright regime, resulting in little or no protections at all; ultimately rendering it as an ineffective and inadequate measure of protection. Even Carty agreed that the prevalent copyright regime is not useful in the context of protecting celebrity persona.²⁸⁷

2.4: Privacy as Protection

2.4.1: Breach Of Confidence

With the long-standing English protean torts failing to deliver, despite some of those appearing to be a 'perfect fit', and the English IP regime failing to salvage much in such circumstances due to awkwardly difficult qualifiers, the English Judiciary has attempted to afford protection to the celebrities under 'privacy' in the backdoor. Paradoxically, UK offers no standalone and distinct right of privacy, which has been explicitly re-affirmed in the landmark case of *Wainwright v Home Office* ²⁸⁸, when Patten J boldly asserted that English Law does not recognise a cause of action for invasion of privacy. Absent such a standalone right, the English Judiciary has employed the common law framework of breach of confidence as an indirect means to safeguard privacy interest within the legal system.

The common law action of breach of confidence, being grounded on the principle of 'good faith'²⁸⁹ has been a long standing and effective measure of protection for a wide range of interest, be it economic (as in trade secrets, insider information, state secrets) or non-economic (as in private information of an individual concerning his/her dignity and autonomy, more so his privacy).²⁹⁰

Originally requiring a 'confidential relationship' for the tort to be successfully invoked, the tort has since evolved significantly; now covering even those instances where no such relationships exist. This evolution of the tort gained significant popularity among the celebrities, as they could seek relief without having to show any pre-existing relation (which would, invariably, not be present in majority of misappropriation cases) and in the process enforce their rights under Article 8, post the enactment of the Human Rights Act 1998 (HRA).

²⁸⁷ Carty (n 61) 239.

²⁸⁸ (2004) 2 AC 406 at (31).

²⁸⁹ Hazel Carty, 'The common law and the quest for the IP effect.' I.P.Q. (2007) 237.

²⁹⁰ Huw Beverley-Smith, Ansgar Ohly & Agnès Lucas-Schloetter, *Privacy, Property and Personality Civil Law Perspectives on Commercial Appropriation* (2nd edn, Cambridge University Press 2009), 85; Tugendhat and Christie, *The Law of Privacy and the Media* (2nd edn, Oxford University Press 2011) para 6.26–7.

The modern formulation of the tort has its roots in *Prince Albert v Strange*²⁹¹, where Prince Albert was successful in preventing unauthorised publication of his private engravings that he made for private enjoyment and consumption. The Court recognised that the Prince's action was not only based on his property rights, but also in doctrine of equity, confidence, and contract, and thus, acknowledged Prince's cause of action in breach of trust and confidence which the unauthorised publication of the etchings have constituted.²⁹² A similar cause of action was also seen to have been applied by the Courts, subsequently, in *Pollard v Photographic Company*²⁹³, where the image of the plaintiff was used without her consent in Christmas cards and the case was found on her favour. It was then, finally, by Megarry J in *Coco v A.N. Clark Engineers Ltd*²⁹⁴, the tort was given a formal structure, when the tripartite test for breach of confidence was laid down; in that, the information must have the quality of confidence about it, such information was shared in a way that imported an obligation of confidence and such information was used unauthorisedly to the detriment of the party sharing it. Post *Coco* but before HRA (which brought about foundational changes to the tort), cases like *Vokes v Heather*²⁹⁵, reflected a surge in plaintiffs, relying on express or implied contractual terms in support of breach of confidence claims, which ultimately led the Courts in *Spycatcher*²⁹⁶, to confirm that the 'obligation of confidence' as required by *Coco* may exist impliedly and hence, a contract will not be necessary.

Interestingly, it seemed to many that with *Prince Albert*, a standalone 'right of privacy' had finally emerged²⁹⁷ in the UK, but it was not quite the case; as otherwise, in *Kaye v Robertson*²⁹⁸ a famous actor would have been successful in preventing the publication of his interview, which was given while being barely conscious, based on privacy. Interestingly, as Beverley-Smith pointed out, these early English cases had led to the finding and formulating of a sui generis right to privacy in the United States but in case of UK, it has only led the English courts to offer relief in breach of privacy cases by contorting it within the doctrine of breach of confidence.²⁹⁹

Nevertheless, the tort took a further step into its modern formulation when the HRA was enacted in the UK, which gave it new '*breadth and strength*'. Whilst the enactment of the HRA was again perceived by many contemporary commentators as a step towards recognising a right of privacy³⁰⁰, the English Courts, however, remained adamant not to acknowledge such rights distinctly, but continue to assert the suitability

²⁹¹ (1849) 41 E.R. 1171.

²⁹² Ibid.

²⁹³ Pollard (n 8).

²⁹⁴ [1969] RPC 41.

²⁹⁵ (1945) 62 RPC 135

²⁹⁶ *A-G v Guardian Newspapers (No2)* [1990] 1 AC 109.

²⁹⁷ Walsh (n 102) 257.

²⁹⁸ *Kaye* (n 187)

²⁹⁹ Beverley-Smith (n 290) 85.

³⁰⁰ Jonathan Morgan, "Privacy, confidence and horizontal effect: 'Hello' trouble" (2003) 62(2) C.L.J. 444. Tanya Aplin, Lionel Bently, Phillip Johnson, and Simon Malynicz, *Gurry on Breach of Confidence - The Protection of Confidential Information* (2nd edn, Oxford University Press 2012); Mark Warby, Nicole Moreham, Iain Christie, *Tugendhat and Christie: The Law of Privacy and the Media* (2nd edn, Oxford University Press 2011).

of the doctrine of breach of confidence to ‘*absorb*’³⁰¹ privacy interest and cater for its protection.

2.4.1(a) *Emergence of the Human Rights Act 1998:*

The enactment of HRA resulted in seismic changes in the English system as it formally incorporated the convention rights³⁰² into the domestic law. Easily ascertained, the most significant consequence of the HRA is the widening of the ambit of protecting privacy interest in the UK, through the application of Article 8 of the ECHR, which mandated that, ‘*everyone has the right to respect for his private and family life, his home and his correspondence*’. With Article 8 now incorporated within the domestic legal regime, it seemed to provide the much-anticipated premise for protecting the highly commodified private lives of the celebrities, an extension of their personality that they are keen on controlling just like the other aspects of. But the problem of this premise of protection was its deficiency in not having a direct horizontal effect owing to Section 6 of HRA limiting its application to public bodies only; thus, shaping it as a ‘negative right’. Such a negative right meant that celebrities can only invoke this premise to prevent interferences by a public body and so, no protection against invasion of the same by private entities like newspapers, magazines, private media or another private individuals, who are often the common players when it comes to interference with privacy.

Professor Warbrick³⁰³ on acknowledging the oddity in such an application, articulated that the application of Article 8 should not be restricted to state interferences/intrusion only and as the ECtHR has already confirmed in case like *Marckx v. Belgium*³⁰⁴, the application of the Article should also extend to these private actors in the UK. Such extension was made possible, as Black contends, through the application of breach of confidence as a ‘vessel for introducing privacy concerns’ to the court.³⁰⁵ Vaver also confirmed this saying that, given the long standing judicial attitude in the context of privacy interest, HRA is unlikely to establish an autonomous privacy right, but has employed breach of confidence as the de facto mechanism for bringing privacy related claims in the UK.³⁰⁶ This further resonated in Buxton LJ’s observation³⁰⁷, that absent any statutory right of privacy, the courts had to ‘shoehorn’ i.e., integrate the application of Article 8 (and its competitor, Article 10) into the common law tort of breach of confidence.³⁰⁸ In any event, Markensius reminded, as HRA required the Court to interpret law, be it statutory or common law, in light of the rights under the Act, such

³⁰¹ See, Walsh (n 102) 257.

³⁰² European Convention on Human Rights (ECHR).

³⁰³ David Harris, Michael O’Boyle, Ed Bates, and Carla M. Buckley, *Harris, O’Boyle, and Warbrick: Law of the European Convention on Human Rights* (5th edn, OUP 2023).

³⁰⁴ *Marckx v Belgium* [1979] 2 E.H.R.R. 330; See also, *X and Y v The Netherlands* [1985] 8 E.H.R.R. 235.

³⁰⁵ Black (n 47) 63.

³⁰⁶ D. Vaver, ‘Advertising using an individual’s image: a comparative note’, L.Q.R. (2006) 362.

³⁰⁷ *Wainwright* (n 288) at [28] to [35].

³⁰⁸ See also, A.McLean and C. Mackey, ‘Is there a law of privacy in the UK? A consideration of recent legal Developments’, (2007) E.I.P.R. 389, 390.

integration was a matter of inevitability; he further added, as matters considered 'private' under Article 8 can be classified as 'confidential', it renders breach of confidence as the most suitable cause of action in the context of privacy protection.³⁰⁹ Nevertheless, since the HRA, there has been a number of cases invoking Article 8 against media and other parties for invasion of privacy – a generous portion of them being attempted via the tort of breach of confidence.³¹⁰ Ultimately, in *Campbell v Mirror Group Newspapers Ltd*³¹¹, following the long line of Article 8 jurisprudence, the Court settled it, once and for all, that the values in Article 8 (and also Article 10) has, by then, become a part of the tort of confidence and will have a general application.

Now that breach of confidence has opened a channel for safeguarding of privacy interests under Article 8, to qualify for protection, as the classic *Coco* formulations required, there must be a quality of confidence in the information in question. This typically meant that the information had to be identifiable and original³¹² and not already available in the public domain or public knowledge³¹³. Post HRA, the court began to shift their focus on requiring the information to be 'private' rather than (traditionally) just 'confidential', when Lord Woolf in *A v B & C*³¹⁴ remarked, “...*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.*” Now accepting both confidential and/or private information to qualify for protection meant a hallway has opened for wide of range of information like celebrity medical data, addresses & whereabouts and even new identities and place of incarceration to qualify for protection.³¹⁵ The ambit of “private life” under Article 8 is also broad as it may extends to the identity of an individual (indicia of his persona). The European Court of Human Rights has ruled that activities done in public would also constitute a part of one's private life for the purpose of this Article.³¹⁶ Furthermore, an individual's image was also accepted as an aspect of one's personhood and therefore, unauthorised taking of photographs even in public that interferes with a person's right of control over it, may breach Article 8 rights.³¹⁷

³⁰⁹ B.S. Markensis, 'Concerns, Ideas About the Developing English Law of Privacy' (2004) 52 AM. J. COMP. L. 133, 141; See also, Amin (m 265) 116-117.

³¹⁰ *CC v AB* [2006] EWHC 3083 (QB); *McKennitt v Ash* [2008] QB 73; *A v B & C* [2002] 2 All ER 545; *X v BBC* (2005) SLT 796; *Browne v Associated Newspapers Ltd* [2008] 1 QB 103; *Murray v Big Pictures* [2008] EWCA Civ 446; *LNS (John Terry) v Persons Unknown* [2010] EWHC 119 (QB).

³¹¹ [2004] UKHL 22.

³¹² *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

³¹³ *Coco* (n 294); *Stephens v Avery* [1988] Ch. 449, Ch D.

³¹⁴ *A v B & C* [2002] E.M.L.R. 7 (Jack J).

³¹⁵ *Green Corns Ltd v Claverly Group Ltd* [2005] E.M.L.R. 31; *Venables v News Group Newspapers Ltd* [2001] Fam 430.

³¹⁶ *Von Hannover v Germany* (2005) 40 E.H.R.R. 1.

³¹⁷ *Reklos v Greece* (App no 1234/05) (15 April 2009), [2009] EMLR 16

2.4.1(b) The ‘Campbell’ Effect:

Following the emergence of the HRA, the Court also began to recognise the *artificiality*³¹⁸ of the requirement of confidential relationship under the Coco test. It was seen as an impediment to an effective application of the tort to remedy invasion of privacy, as invasion from parties who had no such relationship with the celebrity were not accorded protection.³¹⁹ In the wake of such recognition, the Lord Goff, attempted to redefine the confines of the tort; in that, a duty of confidence could also exist when a confidential information comes to the knowledge of the person in such circumstances where he has notice, or have agreed to, that the very information is confidential, and that it would be just in all the circumstances that he should be prohibited from disclosing the information to others.³²⁰ As Beverley-smith commented, such a broad principle could effectively bring in the surreptitiously obtained private information - like unauthorised photography of celebrities during photoshoots or film shoots - where the entity taking that photograph would not have pre-existing or otherwise confidential relation with the celebrities, in the purview of protection under the tort.³²¹ Lord Goff’s view subsequently attracted significant judicial traction, starting with Dame Butler-Sloss³²², when she confirmed that duty of confidence can arise in equity even where no relationship existed between the parties.

This gradually lead to the erosion of requirement of a confidential relationship until it was ultimately confirmed in *Campbell v. MGN Limited*³²³, where the House of Lords stated that the ‘...[tort] *has now firmly shaken off the limited constraint of the need for an initial confidential relationship... the essence of the tort is better encapsulated now as misuse of information.*’³²⁴ In this case, the famous supermodel was photographed coming out of a Narcotics Anonymous meeting, which was later published by The “Mirror” with faces of other attendees of the meeting pixelated to protect their identities. The news headline read as “*Naomi: I’m a drug addict*” and contained generic information on Campbell’s treatment for drug addiction, including the number of meetings she had attended. Whilst Cambell admitted that there was public interest justifying publication of the fact that she was a drug addict and was having therapy, but the publication of the additional details relating to her treatment constituted a breach of confidence. Cambell’s claim was accepted by the trial Judge but subsequently reversed by the Court of Appeal. On appeal to the House of Lords, the decision of the Court of Appeal was reversed on a 3-2 majority and the additional information published was found to be confidential and therefore, protected under breach of confidence action.

³¹⁸ See, *Stephens* (n 312) and *Campbell* (n 311) at para. 46 per Lord Hoffmann. See also, Beverley-Smith (n 290) 86.

³¹⁹ See also, *Venables* (n 315).

³²⁰ *Attorney-General* (n 296) 281.

³²¹ *Shelley Films Ltd v. Rex Features Ltd* [1994] EMLR 134, 144–50; *Creation Films Ltd v. News Group Newspapers Ltd* [1997] EMLR 444, 451–5; See also, Beverley-Smith (n 290) 87.

³²² See, *Venables* (n 315).

³²³ *Campbel* (n 311).

³²⁴ *Ibid*; See also, Black (n 47) 63.

Although dissenting, Lord Nicholls agreed with Lord Hope in rejecting the necessity of a pre-existing confidential relationship and observed that a duty of confidence arises whenever the party subject to the duty is in a situation where a person can ‘reasonably expect’ his privacy to be protected.³²⁵ The ‘reasonable expectation of privacy’ requirement in Lord Nicholls’ words resonated with Lord Goff’s earlier view that attempted to confer a duty of confidentiality on third parties, if they knew or ought to have known that the information received was fairly and reasonably to be regarded as confidential.³²⁶ Baroness Hale concurred with this view and confirmed that this test of reasonable expectation of privacy can adequately balance the privacy interest under Article 8 with freedom of expression under Article 10; the focus of the court, she continued, would be solely on whether there was a reasonable expectation of privacy and if so, whether the private information was misused contrary to such expectation.

As Aplin highlighted, the Campbell ruling has shifted the analytical approach from focusing on the quality of the information to the balancing of Article 8 and Article 10 interests.³²⁷ Aplin continued, the ruling mandates Article 8 to be invoked based on whether there was a reasonable expectation of privacy and not on whether the information was confidential. This clearly has the effect of displacing the first requirement of the *Coco* test for the action. Interestingly, the Campbell court did not only walk the path set by Lord Woolf in *A v B & C*³²⁸ where the focus from ‘confidential’ characteristics was shifted to ‘private’ characteristics, it technically displaced Lord Woolf’s ‘obviously private test’ by reasserting focus on the expectation of privacy and on the balancing of the articles. As Lord Hoffman³²⁹ summarised, the introduction of the test has brought a foundational change in the tort. It is now being used as a remedy for unjustified publication of personal information. It has turned the court’s focus to the examination of whether the information was ‘private’, and if found private, there will be reasonable expectation of privacy leading to a duty of confidence under the tort.

However, such developments were met with concern, as Fenwick and Phillipson³³⁰ critiqued that the Lord Woolf’s *obviously private* test was well grounded on the Article 8 jurisprudence and is therefore, less likely to create uncertainties that the Lord Nicholls’ test is likely to create. On the other hand, Moreham³³¹, preferred Lord Nicholls’ test as it provisions for both subjective and objective assessment of the situation by recognising the subjectivity in relation to the nature of the impugned information and also, the objectivity in relation to the expectation aspect.

In any event, the Campbell ruling, dictated that, in cases of misuse of personal information the traditional *Coco* test will no longer apply; instead, the extended version

³²⁵ Ibid; See also, Beverley-Smith (n 290) 87.

³²⁶ *Attorney-General* (n 296).

³²⁷ Tanya Aplin & Jennifer Davis, *Intellectual Property Law, Text, Cases and Materials* (4th edn, Oxford University Press 2021) 557.

³²⁸ E.M.L.R. 7.

³²⁹ *Campbell* (n 311).

³³⁰ Helen Fenwick and Gavin Phillipson, *Media Freedom under the Human Rights Act* (OUP, Oxford, 2006), 764.

³³¹ Nicole Moreham, ‘Privacy in the Common Law: A Doctrinal and Theoretical Analysis’ (2005) 121 L.Q.R. 628, 647.

of the tort, which in Lord Nicoll's tone, the tort of '*misuse of private information*', will apply. The *Coco* test, however, as both Alpin and Black confirms, remains applicable in cases where there is pre-existing confidential relations. This interestingly, allows protection of privacy under breach of confidence and Article 8 in two ways – either the information was protected by a confidential relationship (as was in *Spycatcher*³³²) or the information was private, but misused even where there was a reasonable expectation of privacy (as was in *Campbell*).

2.4.1(c) The '*Douglas*' Dimension:

Further monumental changes in the landscape of breach of confidence were brought in *Douglas v Hello!*³³³, where protection under the action was extended to circumstances where no reasonable expectation of privacy existed. In *Douglas*, both Michael Douglas and Catherine Zeta Jones entered into an agreement with OK! magazine giving it exclusive rights to publish their wedding photographs. Pursuant to the agreement the Douglas couple took security measures to ensure that no publishers other than OK! could obtain wedding photographs, employees signed agreements not to take any photographs and even guests were searched for cameras. The agreement also dictated that the Douglas couple would commission the photography and would select the photographs themselves for publication by OK!. The Douglas couple soon found out that OK!'s rival, Hello! magazine has obtained the wedding photographs and were about to publish the photographs before OK!, and applied for an injunction. This injunction, initially granted, was subsequently discharged, allowing Hello! to publish the impugned photographs. The Douglas couple and the OK! magazine claimed for breach of confidence against Hello! against such publication.

In regard to the Douglas's claim, the Court was convinced that the wedding photographs plainly portrayed the private life of the Douglas couple and should fall within the ambit of the doctrine of confidentiality as extended to cover private information following *Campbell*. The Court agreed that the agreement with OK! gave them exclusive rights to exploit only those photos as specifically selected by the Douglas couple and the rights of the rest of the photographs remained with the couple, the taking of which by Hello! invaded the couples' Article 8 rights. As to OK!'s claim, on appeal, the House of Lords controversially held, as Hello! was aware of the exclusive agreement between the plaintiffs and the security measures exercised to ensure that exclusivity, Hello! came under an obligation of confidence to OK! and thus, liability under the action was established.

The Douglas ruling, as such, was significant in various aspects. It protected and by extension, acknowledged the economic aspect of a celebrity's life, besides of it being just 'private' and the need for its safeguarding. This borderline the very rationale on

³³² *Attorney-General* (n 296). See also, *McKennitt v Ash* [2008] QB 73 [8]; *Mosley v News Group Newspapers Ltd* [2008] EWHC 1777 (QB)

³³³ *Douglas v Hello!* [2008] 1 AC 1.

which any personality or publicity rights are founded. The House of Lords, however, realising this, re-affirmed their long standing attitude of rejecting any such rights stating, “...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...”³³⁴ The ruling extended protection under breach of confidence and its extended version post *Campbell*, to cover both privacy and secret (confidential) information. It further extended protection to exclusive licensee (like OK! magazine) of private information (photographs in this case). The court acknowledged that the precautionary steps taken by the Douglas couple to ensure the exclusivity of their agreement with OK! and their retained control over the dissemination of the photographs, were sufficient to impose an obligation of confidence that was extended to OK! and justified *Hello!*'s liability for publishing the photographs. Blum summarises the resultant effect of the Douglas ruling; in that, if steps are taken to create a character of private or confidential nature of the information/image in question, the owners of that information and those with exclusive rights can invoke protection under breach of confidence.³³⁵ This further indicated that liability can still be established without having any reasonable expectation of privacy, just by taking precautionary steps, as the Douglas couple did in this case.

Although the reasonable expectation of privacy appeared to have been relaxed to a commendable extent in *Douglas*, it remained well within judicial application in subsequent cases. In *Murray v Big Pictures*³³⁶, the famous British author J.K. Rowling issued proceedings under misuse of private information (the *extended* version of breach of confidence) against Sunday Express for publishing photographs of her infant son being pushed down in some street in Edinburgh. The claim was initially struck out for disclosing no reasonable cause of action. The Court of Appeal however reinstated the claim on appeal, stating that the child in this case had a reasonable expectation of privacy even being in a public place. The Court further added, the requirement of reasonable expectation of privacy is a broad one and its assessment should include examination of all the circumstances of the case.³³⁷ In a factually similar case of *Weller v Associated Newspapers*³³⁸, some candid photographs of famous musician Paul Weller and his three young children were published by the Defendant without consent. The Court found that the children of this celebrity had a reasonable expectation of privacy and as their Article 8 interest outweighed the publisher's Article 10 rights, a claim in misuse of information was satisfied. More recent examples like *Sir Cliff Richard v BBC*³³⁹, (where BBC's broadcasted report on the singer being investigated was found to breach his reasonable expectation of privacy in the fact that he was being investigated) and *PJS v News Group*³⁴⁰ (where publication of sexual encounter of the

³³⁴ Ibid.

³³⁵ See, Blum (n 5).

³³⁶ [2008] EWCA Civ 446.

³³⁷ The factors to consider would include, ‘... the attributes of the claimant, the nature of the activity in which the claimant was engaged, the place at which it was happening, the nature and purpose of the intrusion, the absence of consent and whether it was known or could be inferred, the effect on the claimant and the circumstances in which and the purposes for which the information came into the hands of the publisher’. - *Murray* (n 336).

³³⁸ [2014] EWHC 1163 (QB).

³³⁹ [2018] EWHC 1837 (Ch D).

³⁴⁰ [2016] UKSC 26.

plaintiff was held to be a misuse of private information), gave the requirement of reasonable expectation of privacy and the tort of misuse of private information a broader dimension. One thing that was also evident from these cases was the Court's continued emphasis on the need for the concerned information to be private, which effectively makes it a stepping stone on the way for the other requirements of reasonable expectation and finally, the balancing of the interests.

2.4.1(d) Limitations:

With the extent of the application of Article 8 privacy rights under the wings of breach of confidence claims being laid, we can safely turn to the assessment of the key shortcoming or limitations in applying this action against the mischief of misappropriation of celebrity persona.

2.4.1(d)(i) Definitional Shortcomings

Be its classic *Coco* formulation or its modern facelift post *Cambell*, (i.e., the misuse of private information form), any claim for breach of confidence and Article 8 only catches those instances where a 'private' information is imparted either within the context of a pre-existing confidential relationship (be it express or implied) or with a reasonable expectation of privacy.

As Pinto³⁴¹ notes, not all confidential information, even if that relates to one's reputation, will be automatically deemed 'private' for the purpose of this action unless it divulges or reveals intimate details, and it is then and only then Article 8 protection would kick in. This undoubtedly meant that not every unauthorised use of celebrity image will be actionable and mere celebrity images, photographs or likeness are unlikely to be considered private. Courts, in cases like *Von Hannover v Germany*³⁴², have also shown their inclination towards not finding any privacy concerns with routine press photography of celebrities in public settings, as long as the photographs does not contain any personal or intimate information about the celebrity.

With this being the threshold, the question is, whether the celebrities can get a foothold of this remedy in order to safeguard against the mischief of misappropriation or unauthorised use of their persona and if so, would it effectively and adequately safeguard them.

One way of assessing this can be simply to see whether the cause of action can be applied in all forms of (mis)appropriation of persona, as acknowledged in Chapter 1 of this thesis. One of the acknowledged (mis)uses, that is, media use, which was analysed in light of *Douglas*, would easily pass this assessment, as breach of confidence has been applied in *Douglas* and remedy was afforded. Although the

³⁴¹ Timothy Pinto, 'Tiptoeing along the catwalk between Articles 8 and 10: Naomi Campbell v Mirror Group Newspapers Limited' (2004) 15(7) Ent L.R., 199 -202.

³⁴² *Von Hannover* (No. 2) (2012) 55 E.H.R.R. 15.

damages awarded to the Douglas couple was meagre compared to what OK! was awarded, raising doubts as to the true effectiveness and adequacy of the remedy, but the purpose here and that of the thesis as a whole, is to ascertain, among other things, whether the existing causes of action provided any form of safeguarding to celebrity persona. Indeed, the resultant remedy of such actions has a bearing on the effectiveness of the cause of action, but such assessment is only plausibly relevant once a suitable cause of action is ascertained. Until then, the measure of the remedy will be kept out of the focus.

In terms of the endorsement (mis)use of persona, as adopted in Chapter 1, the application of breach of confidence can be better illustrated if seen through the case of *Irvine*, itself. The mischief in *Irvine* was the unauthorised use of Irvine's photograph, doctored in way to imply that the Irvine was endorsing Talksport's radio station. The first hurdle would be with the misappropriated photo of Irvine to be considered as 'private' to trigger Article 8. As the image (mis)used did not reveal any personal or intimate details of Irvine, it is highly likely for the claim to fail at a very early stage. Assuming, he somehow passes this stage, this photograph, as the facts clearly states, was not given to Talksport by Irvine by way of any license and there was no endorsement contract between Irvine and Talksport. The parties had no pre-existing relationship, thus putting Irvine outside the periphery of the classic *Coco* test. The photograph was also not given to Talksport in circumstances such as to create a reasonable expectation of privacy that the photograph will not be disclosed. As such, Irvine would also fail to qualify for the modern version of breach of confidence, i.e. misuse of private information action.

Applying the same exercise with the acknowledged (mis)use of persona in merchandising cases, Topshop's use of Rihanna's photograph in *Fenty* would have failed to invoke the protection of breach of confidence based on the exact same reasonings as seen hypothetically in relation to *Irvine* above. One can safely assume that the same reasons would also make *ABBA*, or the *Spice Girls* fall short of protection under the doctrine of breach of confidence.

Although post *Douglas*, the requirement for a reasonable expectation of privacy has somewhat been blurred and to qualify for protection, celebrities would have to show that particular steps were taken to make their information/image sufficiently private (as did the Douglas couple) or must be captured in a private but protected activity (as was in *Douglas*). Celebrities like Irvine, Rihanna or *ABBA*, as illustratively discussed above, would not have qualified for protection since none of them took any such steps or their photographs were taken from a private but protected event.

Moreover, even if these celebrities manages to establish a reasonable expectation of privacy or has taken such steps as seen in *Douglas* to make their misused images sufficiently confidential, they may still fail, since in all of these cases, the images misused were already available in the public domain.³⁴³ As Lord Goff has famously

³⁴³ See, *Attorney-General* (n 296)

clarified, ‘...once it [image] has entered what is usually called the public domain then, as a general rule, the principle of confidentiality can have no application to it.’³⁴⁴ This is particularly problematic since protection will not be extended to information/images already in the public domain and majority of the persona misappropriation cases (as is evident from that of *Irvine*, *Rihanna*, *ABBA*) involves publicly available celebrity images and thus creating a ‘gap’ where protection cannot reach.

As Black clarified, Article 8 actions via breach confidence are relevant only when the celebrity intends to keep his/her images or any of his personal information, ‘private’.³⁴⁵ Instances of personality misappropriation as seen in cases like *Irvine*, *Fenty* or *ABBA*, did not involve any privacy elements at all, as in none of these cases the celebrities intended to keep their images private. As a matter of fact, majority of misappropriation cases are likely to lack such privacy elements and it is common for celebrities to have their images/information widely available in the public domain owing to their ‘career hazard’ of being famous and as such, always at the risk being misused/misappropriated. Breach of confidence, unfortunately, has no answers to these challenges and this further puts the overall effectiveness and adequacy of privacy actions based on breach of confidence to challenge .

As seen, none of this classic cases of misappropriation of persona would have any recourse to remedy under breach of confidence, be it the classic version or new, and therefore, under Article 8; but invariably, in all of these cases the plaintiff celebrities have suffered from the misappropriation/unauthorised exploitation of their persona, and among them both *Irvine* and *Rihanna*’s has been afforded relief under another cause of action.

It is, therefore, apparent that although one of the forms of acknowledged use may fit within the definitional requirement(s) of breach of confidence, the same seems nearly impossible with the other forms of appropriation. All in all, these alludes to the fact the application of breach of confidence is restricted to very limited circumstances. Lacking a general application, as such, raises serious and justified concerns as to the effectiveness of using breach of confidence as a remedy in cases of misappropriation of celebrity persona, as majority of the misuses will not come within its radar.

Carty adds, the action of breach of confidence was historically designed to deal with the unauthorised disclosure of confidential information arising from a pre-existing relationship of confidence and not to prevent unauthorised exploitation of celebrity personality.³⁴⁶ As Beverley-Smith notes, pictures and other aspects of persona are not recognised to be private by this action but the activity that the celebrity may be engaged in, is.³⁴⁷ Resultantly, as Bently³⁴⁸ added, a celebrity involved in daily activities

³⁴⁴ Ibid, per Lord Goff at 282, 285 and 286.

³⁴⁵ Black (n 47) 73.

³⁴⁶ Hazel Carty, ‘Personality Rights And English Law’ in Niall R Whitty and Reinhard Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective* (Edinburgh University Press 2010) 397.

³⁴⁷ Beverley-Smith (n 296) 93.

³⁴⁸ Lionel Bently, Brad Sherman, Dev Gangjee, & Philip Johnson, *Intellectual Property Law: I copy therefore I am* (5th edn, OUP 2018) 1267; See, also *Campbell v. MGN Ltd* [2004] 2 AC 457, (154)

would not be protected. Though the action has been repurposed to cover modern privacy concerns and related commercial realities, as Carty suggested, such, evolution being born out of necessity rather than being structurally developed, lacks coherence and effective application in cases other than those involving pure privacy matters. As a whole, Beverley-Smith underscored that the potential for this action to provide a comprehensive protection to celebrity persona is very limited.³⁴⁹

2.4.1(d)(ii) Balancing with Freedom of Expression

Protection under Article 8, via breach of confidence – regardless of its form - is not absolute and/or not automatic, despite fulfilling the requirements as discussed above. The need for such protection must be weighed against Article 10, freedom of expression rights of the (mis)user as well. This requirement to conduct a balancing exercise was pre-existent in the context of breach of confidence claims; but post HRA and particularly after *Campbell*, attaining the balance has been brought to the forefront of assessment of liability.³⁵⁰ This Article 10 interest, in practice, functions as a defence for (mis)users to justify their (mis)use in the premise of ‘a real element of public interest’ as initially defined by Ouseley J in *Theakston v MGN Ltd*.³⁵¹ Such premise for justifying (mis)use was supported when Lord Woolf, in *A v B & C* ³⁵²normalised that famous people should expect (and accept) close scrutiny by the media although they are entitled to a private life under Article 8. Subsequently, the Court in the aftermath of *Campbell & Douglas*, clarified the parameters of the defence to include such disclosures/uses that are in the ‘public interest’ and not merely of interest to the public.³⁵³ As such, in case of misappropriation of celebrity persona, provided all other requirements have been satisfied, the Court will have to consider whether the impugned publication or use contributed to a current debate of public interest³⁵⁴ and if it does, Article 10 trumps Article 8, and the claim of the plaintiff celebrity would fail. Whilst it may seem that Article 10 would be more relevant in cases of news reporting, which often may not entail a purely economic agenda (but sales may, regardless, increase for the sake of the celebrity element in the publication), Article 10 can provide an arguable defence in the guise of creative/artistic rights, even in cases of commercial (mis)uses of celebrity persona (a good hypothetical example, can be Andy Warhol’s style of arts of celebrities). Therefore, Article 10 defence can well legalise an otherwise act of misappropriation of celebrity persona, and breach of confidence cannot prohibit such (mis)uses done in the name of press or creativity or for informational, satirical, or other artistic purposes. Undoubtedly, the balancing mechanism or (best put as) the defence under Article 10 is indirectly creating a greater scope for misappropriation of celebrity persona, i.e., the mischief that celebrities are seeking to combat and as such,

³⁴⁹ Beverley-Smith (n 296) 93.

³⁵⁰ See also *Campbell v MGN* [2006] QB 125 [95].

³⁵¹ [2002] E.M.L.R. 22 at 42.

³⁵² [2002] E.M.L.R. 7.

³⁵³ See, *McKennitt v Ash* [2008] QB 73; See also, *Douglas* (n 333)..

³⁵⁴ See, *PJS v News Group Newspapers Ltd* [2016] UKSC 26; *Weller v Associated Newspapers Limited* [2014] EWHC 1163 (QB).

further limiting the effectiveness of the protection that breach of confidence was thought to provide.

2.4.1(d)(iii) Doctrinal Disparity

Personality or publicity, no matter how it has been addressed, has long been conceived not as a distinct or a standalone right, in itself, but as a parasite of privacy.³⁵⁵ A probable reason of such conception might be the fact that the ECHR rights – particularly Article 8 and the essence of privacy protection therein, as Black suggested, was significantly influenced by the concept of personality that exists in the civilian jurisdictions of continental Europe.³⁵⁶ Such association is also not uncommon in the US jurisdiction as well, with Halpern commenting that publicity rights have emerged from privacy and before such emergence, it was misconceived as an appropriation branch of the right of privacy.³⁵⁷ Waelde and Whitty says privacy and publicity are two sides of the same coin, i.e., the right to prevent and control the dissemination of image (persona).³⁵⁸ Cornish and Llewellyn remarked that it was privacy's underbelly and its purpose has been to exploit personal information and the persona, for a fee or otherwise.³⁵⁹ Despite this close link between these two concepts, however, as Nimmer³⁶⁰ pointed out, if a celebrity has to protect his personality by resorting to his privacy interest, he is unlikely to achieve the legal protection he requires. Madow³⁶¹ conveniently added, once personality/publicity evolves into a distinct and separate right from that of privacy, both can no longer be seen through the same lens, which may have been possible when personality still remained as privacy's subset.

What both Nimmer and Madow appears to indicate is that although the rights may have overlapping in its foundation, they are fundamentally aimed at different directions; with privacy safeguarding non-economic values of personhood, i.e., dignity, autonomy and intimate self, and publicity safeguarding the economic values of personhood, i.e., public image, fame and popularity. Privacy, therefore, prevented intrusions into an individual's private life but it did not protect the economic value that one may have in his persona, which is also something that he wants to safeguard in misappropriation claims. Most significantly, there are usually two parts to an Article 8 and breach of confidence claim as evident from the relevant jurisprudence; first there is an invasion of one's private sphere for obtaining a private information or image, and second, there is the dissemination of that private information or the image. Interestingly, privacy is only concerned with the antecedent invasion (and may in some

³⁵⁵ Black (n 47) 25.

³⁵⁶ Ibid.

³⁵⁷ Sheldon W Halpern, 'Trafficking in Trademarks: Setting Boundaries for the Uneasy Relationship Between "Property" Rights and Trademark and Publicity Rights' (2009) 58 DePaul L Rev 1013–45, 1039.

³⁵⁸ Charlotte Waelde and Niall Whitty, 'A Rights of Personality Database' in N Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective* (Dundee, Dundee University Press, 2009) para 11.4.5.

³⁵⁹ Cornish and Llewellyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (6th edn, Sweet & Maxwell, 2007) para 9–04.

³⁶⁰ Nimmer (n 157).

³⁶¹ Madow (n 59) 167.

cases, both) whereas, personality/publicity is concerned only with the dissemination.³⁶² As *Wood v Commissioner of Police for the Metropolis*³⁶³ demonstrated, the unauthorised retention of Wood's photograph by the Police was found to violate his Article 8 privacy rights but not a breach of his personality right since those photographs were not exploited publicly (to profit or otherwise). Moreover, damages in breach of privacy claims seeks to compensate the aggrieved celebrity for the distress suffered or injury to feelings, e.g., in *Campbell*, plaintiff received £3500 in damages, and in *Weller*³⁶⁴, children received £5000. In comparison, *Irvine* received £25000 in 'lost licensing fee' in the covert personality claim masqueraded under passing off, which would never be recoverable had Irvine invoked Article 8 privacy-based cause of action. This further showed that privacy can never account for the extent of damage/loss incurred in cases of misappropriation of celebrity persona.

Despite these stark disparities in the underlying purposes of the two outward growing rights, English courts have ignorantly attempted to shoehorn personality/publicity right into privacy rights under Article 8, as they considered unauthorised exploitation of persona to be an insult to human dignity and self-esteem. Bringing forth Halpern's³⁶⁵ view here, UK is currently in the phase where it is misconceiving personality/publicity as the appropriation branch of privacy. Therefore, such misconceived shoehorning was never to suffice as an adequate protection against misappropriation, as privacy rights cannot protect those who's objection is not against the exploitation of their persona, but only to such exploitation being done without their consent and without any remuneration in return.³⁶⁶ Such forceful contorting of a personality into privacy at the face of such doctrinal differences could only lead to unfavourable and awkward results, ultimately making Article 8 an undesirable measure of protection against the mischief of misappropriation.

Rather interestingly, commentators like Schreiber³⁶⁷ did not hold back in arguing that there is even a bigger doctrinal misfit into shoehorning privacy rights into the doctrine of breach of confidence. Schreiber clarified that the doctrine is jurisprudentially ill-suited to protect privacy interests, as the doctrine applied to commercial information, whereas privacy to personal information. He added that the doctrine is further ill-suited to protect privacy at the level required under the ECHR and the HRA, and attempting to achieve something using the doctrine, which was never designed to achieve so, resulted in the distortion of action. With a such a stark doctrinal misfit between privacy and the doctrine of breach of confidence, it is inevitable that when personality interest is being shoehorned into privacy which has been already shoehorned into breach of

³⁶² Black (n 47) 75.

³⁶³ [2009] EWCA Civ 414.

³⁶⁴ *Weller v Associated Newspapers Limited* [2014] EWHC 1163 (QB).

³⁶⁵ Halpern (n 357) 1039.

³⁶⁶ Silvio Martuccelli, 'An up-and-coming Right – The Right of Publicity: Its birth in Italy and its consideration in the United States' [1993] 4 ELR.; Anna E Helling, 'Protection of Persona in the EU and in the US: A Comparative Analysis' (LLM Thesis, University of Georgia 2005).

³⁶⁷ Arye 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; See also, Nicole Moreham, 'Recognising privacy in England and New Zealand', [2004] CLJUK 555.

confidence, further distortion and bizarre results are bound to follow; ultimately, causing the doctrine to lose its effectiveness and charm.

Overall, the English court's attempt to afford protection using privacy and its carrier, breach of confidence as a backdoor policy when other (more popular and closely relevant) causes of action have failed, is both theoretically odd and practically unfavourable. The doctrine of confidence has had its bound stretched post HRA, through *Campbell* and finally by *Douglas*, but the definitional hurdles in the path of convenient qualification for protection remains as untasteful as possible. Commentators like Carty³⁶⁸ and Walsh³⁶⁹ have held the *Douglas* court to have actually answered concerns of personality/publicity rights, but outwardly held it to be a concern of confidence/privacy.³⁷⁰ The court, however, in the very case was vocal about rejecting the idea of UK having any standalone image or personality rights, keeping true to the stance that it has so far maintained regardless the form in which the personality cases came in front of them. Irrespective of the improvement that were introduced to the doctrine of breach of confidence, its overall application in the context of celebrity persona could not be improved and perhaps due to the limitations identified, it never will. Turning back to the question of this Chapter as to whether this doctrine provides an effective and adequate measure of protection to the celebrities against the mischief of misappropriation, given the limitation and the doctrinal oddity caused by the attempted shoehorning, the answer will be no.

2.5: Non-Binding Safeguards

2.5.1: The Advertising Codes

The UK advertising industry has designed several self-regulatory codes of practice to regulate both broadcast and non-broadcast advertising in the country. McCarthy viewed the creation of such self-regulating codes by the industry players themselves, as their commitment to withhold any unfair practices involving the use of (at least) a living person's identity in advertising.³⁷¹ The codes currently in force are UK Code of Non-broadcast Advertising and Direct & Promotional Marketing (CAP Code) and UK Code of Broadcast Advertising (BCAP Code), regulating non broadcast advertising and broadcast advertising respectively. Both the codes have significant overlaps in terms of its scope and the activities it seeks to prohibit and as such, both are relevant for the celebrities.

The CAP Code (Rule 6.1) stipulates that the advertisers must obtain permission from the celebrities before portraying them in their advertising or marketing material in a

³⁶⁸ Carty (n 289).

³⁶⁹ Walsh (n 102).

³⁷⁰ Aplin (n 327).

³⁷¹ See also, McCarthy (n 44).

way that is contrary to the image/view/position of the celebrity.³⁷² The BCAP Code (Rules 6.1 & 6.2) states that subject to exceptions, permission must be obtained before featuring, referring or caricaturing a celebrities in advertisements broadcasted in the TV or before presenting a celebrity in a defamatory, offensive or adverse way in the radio.³⁷³

These advertising codes are developed and maintained by the Committee of Advertising Practice (CAP), which is responsible for the CAP Code and the Broadcast Committee of Advertisement Practice (BCAP), responsible for the BCAP Code. The BCAP is contracted by the broadcasting regulator, Office of Communications (Ofcom), to draft and enforce the codes relevant to the broadcast of advertising through television or radio. The Ofcom is statutorily empowered by virtue of the Broadcasting Act 1996 to determine complaints of unwanted infringements of privacy in contents of the programme or in the way the underlying material of such content was procured. Ofcom's assessment of complaints would encompass striking a balance between the privacy interest of the complainant with the public interest exception.³⁷⁴ Both the CAP and BCAP are independently regulated and administered by the Advertising Standards Authority (ASA). Ofcom and the Trading Standards both recognises ASA as the regulator of misleading and comparative advertisements in the country, both in the broadcast (TV, radio) and non-broadcast (sales promotion, direct marketing, print media) sectors. If a regulatory action by ASA fails, in that, the non-compliant advertiser or marketer has refused to comply with the relevant codes despite the regulatory actions of the ASA, the impugned advertiser or marketer is referred to the Trading Standards for initiating further regulatory actions under the Digital Markets, Competition and Consumers Act 2024 or the Business Protection from Misleading Marketing Regulations 2008. The Trading Standards can seek for an undertaking that the impugned marketing communication is put down or removed from further commission or dissemination. If the undertaking is not provided or if provided but not honoured, the Trading Standard can apply for an injunction to prohibit further appearance of the marketing information.³⁷⁵

An early example of successful invocation of the codes by a celebrity came with the famous footballer, Eric Cantona.³⁷⁶ A look-alike of Eric Cantona, wearing a striped Manchester United team jersey, displaying Eric's famous jersey number 7 and with a turned-up collar, was used in an advert for Molson Beers, where the look-alike even posed in Eric's 'can-can' style. Eric filed a complaint with the ASA stating that such use of a look-alike was distressing and was an unauthorised exploitation of his

³⁷² See, 'Non-broadcast Advertising and Direct & Promotional Marketing (CAP Code)' <www.asa.org.uk/codes-and-rulings/advertising-codes/non-broadcast-code.html>

³⁷³ See, 'UK Code of Broadcast Advertising. (BCAP Code), <www.asa.org.uk/codes-and-rulings/advertising-codes/broadcast-code.html>

³⁷⁴ See, 'The Ofcom Broadcasting Code 2020' <www.ofcom.org.uk/tv-radio-and-on-demand/broadcast-standards/section-eight-privacy/>

³⁷⁵ The CAP Code How the system works' <www.asa.org.uk/static/3fb479a3-0c4c-4a4d-9fd19734712d3520/79c24e18-ac23-453c-9bc45e37de228261/The-CAP-Code-How-the-system-works.pdf>

³⁷⁶ See generally, Stallard (n 108); Fisher (n 162).

likeness (persona). The complaint was upheld, and the advertisement was removed by the advertisers.

Although the example of Eric Cantona's use of the Codes to safeguard against unauthorised use of his persona appeared to commentators, like Fisher, that the Codes were providing the best form of protection, however, the Codes' protection is limited in a number of ways. As Amin identified, firstly the requirement of prior permission to use a celebrity's image under Rule 6.1 of the CAP Code is not triggered, if the marketing material portrayed the celebrity and relayed information that was consistent with his image/views; meaning that misappropriation cannot be (always) prevented using the Codes.³⁷⁷ Secondly, as Amin continued, portrayal of deceased celebrities could not be prevented, unless the portrayal is found to aggrieve or offend the deceased's family. Finally, and most significantly, the codes being voluntary and non-binding, lacked judicial enforceability.³⁷⁸ Ellen added, the Codes may appear more inclined towards protecting exploitation of identity (persona), it does very little to actually do anything about it.³⁷⁹

Stallard commented that the Codes may successfully eliminate the adverts that make unauthorised use of a celebrity's persona but absent enforcement in a court of law, the impugned advertiser may continue to not comply with the Codes. The case of *Bedford v The Number (UK) Ltd*³⁸⁰ sheds more light on the limitations of the Code, in that, David Bedford's (a famous athlete of the 1970s) caricature was used in an advert by the Defendants. David filed a complaint with the Ofcom, claiming that such an advert has breached the then advertising Codes. Ofcom upheld the complaint but rather oddly, did not ban the impugned advert, holding it to be disproportionate, otherwise. Further oddly, Ofcom held that the finding of the breach in itself was a sufficient remedy in David's case. The adverts continued to be aired until 2006, as Vaver suggested³⁸¹, further demonstrating the lack of effectiveness of the Ofcom's decision and its inadequacy in the protection of celebrity personality. Moreover, Amin³⁸² added, even if the advertisement is banned or withdrawn following the order of Ofcom, the exploiter has already profited from the advertisement as soon as it was displayed and therefore, removing it, but also not making any award of damages, fails to alleviate any harm done to the celebrity, or at all. So regardless of whether Ofcom has banned the advertisement or not, Stallard concludes, breach of Codes cannot accord any remedy to a celebrity for misappropriation of his persona³⁸³.

³⁷⁷ Amin (n 265) 114; See also, Fisher (n 162).

³⁷⁸ Ibid; Ellen E. Whitehorn, 'Publicity, Privacy, and Fame: A Comparative Analysis of the Right of Publicity in the United States, Canada, and the U.K., through the Lens of Kanye West's Famous' (2017) 27 *Transnat'l L & Contemp Probs* 201 215

³⁷⁹ Ibid.

³⁸⁰ [2004] ISLR SLR-18.

³⁸¹ Vaver (n 306).

³⁸² Amin (n 115).

³⁸³ Stallard (n 108) 574.

2.5.2: IPSO

Independent Press Standard Organisation (IPSO), a refined version of the former Press Complaint Commission (PCC).³⁸⁴ It is a self-regulatory, non-governmental organisation, having its own set of self-regulating code of practice, namely, '*Editors' Code of Practice*'³⁸⁵ to regulate the practice of press and journalism across all forms of print media, like newspapers, magazines and alike. IPSO is aimed at ensuring the highest editorial standards and professional journalism, which would establish a credible and accountable journalism but at the same time protect the public and freedom of expression. It, therefore, provides for a platform where the members of the public, and in this case, the *celebrities*, to seek redress if the Code has been breached through any form of journalistic or editorial practice in the print media.

Although founded in 1990, it was not until the death of Diana, Princess of Wales in 1997, the then PCC experienced a complete overhaul which had ultimately resulted in the Code of Practice that we see today.³⁸⁶ The public outrage following the car accident of the Princess causing her death when she purportedly attempted to outrun paparazzies trying to take her picture, necessitated to answer the overdue call for a change and a stricter regulation of the practice at the press.³⁸⁷ Codes introduced firm policies on matters such as privacy, harassment, long-lens photography and incorporated the system of review, making editors and publishers (including their employees, staffs, agents) accountable for their work, if it is complained that the Code has been violated. The Code that is currently in force continues to govern the notions of privacy³⁸⁸ and harassment³⁸⁹, mostly importantly, regulates how celebrity image (a part of their persona) is obtained by the newspapers and journalists and prohibits the use of 'clandestine devices'³⁹⁰ and offers a comprehensive complaint/review procedure. Significantly, it provisions for the issue of 'accuracy' at the core, mandating press to exercise care in not publishing misleading or distorted images³⁹¹. The Code also continues to strike a balance in the intended regulation by allowing exceptions of public interest and also defining what such public interest entails, but non-exhaustively.

Now, what does this mean for the celebrities who are trying to get relief from the mischief of misappropriation? Indeed, the Code, as it stands, would allow a celebrity to complain about any inaccurate information/news concerning himself or against any distorted image being published invoking the provisions of 'Accuracy', and also raise concerns on breach of privacy or harassment sustained through the impugned publication. Indeed, this is helpful in today's world which has seen the extent of misuse of Artificial Intelligence (AI) and deepfakes and may even remedy the actors in

³⁸⁴ PCC was dissolved in 2014 and the organisation transitioned to IPSO.

³⁸⁵ Came to force in 1 January 2025.

³⁸⁶ See also, Rainen (n 161); Amin (n 327); Stallard (n 108).

³⁸⁷ Rainen (n 161) 225.

³⁸⁸ IPSO The Editors' Code of Practice 2025, s.2

³⁸⁹ IPSO The Editors' Code of Practice 2025, s.3

³⁹⁰ IPSO The Editors' Code of Practice 2025, s.10

³⁹¹ IPSO The Editors' Code of Practice 2025, s.1

*Charleston v News Group Newspapers*³⁹² as discussed above. This, however, does not assist the celebrity to counter the mischief, as it fails to account for all forms of misappropriations and mostly, concerns itself with the use of celebrity image (and probably name, if given the broadest interpretation) but not any other indicia, like voice, likeness, character etc. On a closer look, the Code comes to play only if it has been published in a misleading or distorted way – unless that is not the case, the impugned publication cannot be pointed at, allowing the publishers to free-ride on the misappropriated persona of the celebrity.

Moreover, as invariably all the commentators critiqued, the Code may seem to provide necessary protection, but that is only in theory; in practice, the Code has no judicial enforceability and is non-binding (and also inapplicable) on those editors or publishers who did not ratify the Code³⁹³.³⁹⁴ Rainen remarked that even if a celebrity can manage to show that the impugned publication (by a member) has breached the Code, there are no real sanctions that would effectively punish the infringer and also have a deterrent effect on others in the press; the most that the celebrity can do is subject the editor or publisher to IPSO's review, which will not lead to any penalties, damages, fines or criminal prosecutions.³⁹⁵ If the review is upheld, it can at best warrant for an apology letter from the publisher to the celebrity, with or without a separate publication for correction or may lead to undertaking as to the future conduct of the publisher.³⁹⁶ The IPSO can also issue a critical adjudication against a newspaper or magazine following the review, requiring them to publicise their mistakes, which they believe to have a strong deterrent impact acting as a 'name and shame' sanction.³⁹⁷

Furthermore, Amin also critiqued IPSO, by identifying the inherent conflict of interest in it, as it paradoxically, leaves the enforcement of the Code to those, who has benefitted for the non-compliance in the first place.³⁹⁸ She further emblazoned this paradox by commenting, *"If the industry in which the abuse arises is left to decide the boundaries of appropriate behaviour, those boundaries will inevitably expand. It may get to a point where any act on the part of either advertisers or newspapers becomes acceptable."*³⁹⁹ Despite these limitations and the inherent peculiarity, early commentators (on PCC) like Stallard remarked that the "...code is taken very seriously" and highlighted that the then PCC (and so by extension, today's IPSO) was (or is) confident on the Code's effectiveness and that, it was one of the *toughest* in Europe.⁴⁰⁰ However, there is no evidence available that showed or shows that this is

³⁹² [1995] 2 AC 65;

³⁹³ IPSO regulates most UK newspapers and magazines (but currently not The Guardian, Independent or Financial Times) , <www.ipso.co.uk/making-a-complaint/complaints-faqs> accessed 11 December 2024.

³⁹⁴ See, Rainen, (n 161) 223; Stallard (n 108) 587.

³⁹⁵ Rainen, (n 161).

³⁹⁶ 'IPSO, Complainants FAQ' <www.ipso.co.uk/making-a-complaint/complaints-faqs>accessed 11 December 2024.

³⁹⁷ Ibid.

³⁹⁸ Amin (n 265) 115.

³⁹⁹ Ibid.

⁴⁰⁰ Stallard (n 108) 587.

actually the case with IPSO and their Code, and it remains untested in absence of any significant celebrity actions invoking the Code at this time.

Albeit IPSO cannot make any award of damages or even negotiate one between the publisher and the celebrity, it does offer a low-cost arbitration scheme, which can make an award to the celebrities, if successful, up to £60,000.00 and recover legal costs up to £25000.00.⁴⁰¹

To sum up, the IPSO, just as the ASA/CAP, are insufficient and equally unhelpful for the celebrities trying to combat the mischief. Given the magnitude of interest of the celebrities at risk here, be in economic or dignitarian (something which will be broken down in the next Chapter) and stark limitations within this system, IPSO does not appear to be the most logical recourse that the Celebrities would want to avail. Yes, they might look into IPSO as a secondary action to run simultaneously with the main action as aforementioned, but not certainly the only action.

2.6: Conclusion

Interestingly, as Professor McCarthy⁴⁰² said, it is in the UK's cultural fabric and societal norm to maintain a 'hands off' approach to others' 'private businesses. Perhaps, this is the sole reason why, despite HRA, English courts still did not recognise a standalone right of privacy, rather shoehorned it into other legal doctrines, like breach of confidence, to afford protection. English court's stance in respect of personality rights does not appear to be any different from this. Although in the case of privacy, it has explicitly agreed the shoehorning - as seen in *Campbell*, they are yet to explicitly do the same with personality, probably because the English courts are yet to ascertain the perfect fit for the shoehorning exercise to be completed for personality rights. There remains to be little or no doubt, given the limitations highlighted above, it would be nearly an impossible task to find a perfect fit, even for the all-knowing judiciary of the country. The jurisprudence that has been analysed throughout this chapter gives a clear indication that protection against the *mischief* has been very inconsistent and infrequent. One might be persuaded by the sight of cases like *Irvine*, *Fenty* or *Douglas* that effective and adequate remedy is there; but a handful of successful cases can never dictate the overall effectiveness and adequacy of an action/protective tool. These cases can be safely termed as borderline cases, where the English Judiciary went as close as recognising a personality right – though covertly answering concerns of personality nature, they outwardly talked about the cause of action that was invoked and even changing it whenever possible to maintain the narrative. These cases further shows that had the judiciary wanted they could have recognised such a right to fill in the glaring lacunae or gap in law - the beauty of the common law system - but the judiciary, as McCarthy beautifully states, remained “...*tied to the legal categories of*

⁴⁰¹ IPSO Arbitration Scheme Rules 2018, Part 6, Rule 31 <www.ipso.co.uk/wp-content/uploads/2024/05/Arbitration-Scheme-Rules-2018.pdf> accessed 11 December 2024.

⁴⁰² McCarthy (n 44). Rainen (n 161) 215.

*the past and up, to the present, unable to accommodate itself to the modern realities...*⁴⁰³ Nevertheless, the cause of actions, be it the torts, IP rights, privacy or the non-binding codes, have limitations of their own, which poses significant hurdles for the celebrities to obtain the required level of protection given the subject matter at stake. Having such limitations are also not unjustified as these tools are being invoked to deal with something that they were never designed to deal with it in first place, showcasing the English judiciary's attempt to push a '*square peg in a round hole*'. By contrast a true personality right would have answered the concerns, filled in the lacunae in law and dealt with the mischief to the satisfaction of the celebrities. With the premise that the existing patchworks of law/ piecemeal approach in the UK is failing to provide the necessary level of protection to the celebrities, and that a personality right is the feasible answer in the circumstances, this thesis can now move on to justify why such rights would be the 'only' solution for celebrities against the mischief.

⁴⁰³ McCarthy (n 44). Rainen (n 161) 215.

CHAPTER - 3

3.1: Introduction

Prior to predicating any justification(s) for the legal recognition of a separate, standalone and purpose built right of personality, it is imperative that the existing legal landscape should be reviewed, albeit briefly, to identify the theoretical approaches taken to the notion (and practice) of personality to date by both the proponents and opponents of the right. It must be acknowledged in the onset that the debate on the need for its recognition and enforcement has led to the creation of a vast array of legal jurisprudence – particularly addressing the US conceptualisation of personality, termed as ‘publicity’⁴⁰⁴- but as Muhonen⁴⁰⁵ accurately identified (and Black reaffirmed), this jurisprudence remains to be unsettled and the rationales advanced in favour (and also against) remains far from being harmonious.⁴⁰⁶

To further showcase the difficulties this inharmonious legal literature causes in achieving a comprehensive understanding of the underlying landscape, Black argued that unlike established areas of law like ‘contract’, personality lacks clear terminologies, common grounds and settled doctrines.⁴⁰⁷ Commentators have successfully managed to pull together myriad of incidents to contextualise infringement of personality starting from interference with the commercial license to use basketball players image as in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc*⁴⁰⁸ to the publication of a fictional interview of Princess Caroline in Germany without her consent.⁴⁰⁹ On a closer look at the legal literature forwarded in respect of personality right, there is primarily a large divide (and further subdivide) even between the supporters of this right; as on one end, supporters viewed this is simply as a right to commercialise fame/popularity or as a right to control this commercialisation and on the other end, it is about safeguarding one’s harm to dignity and autonomy through control of the exploitation itself or simply seen as media exploitation of privacy alike interest.

Further dwelling into this divide, it will be clearer that those on the side that viewed personality – to be more precise ‘publicity’ (the US version of personality) – with sole emphasis on the commercialisation and/or the right to control it for economic gains, promoted justification for its recognition based on ‘economic/commercial interest. This approach is profound in commentators who primarily focused on the right of publicity introduced in the US and other common law jurisdictions. Black has also identified

⁴⁰⁴ As has been clarified previously, publicity is a ‘subset’ of personality, and the terms publicity and personality will be used interchangeably through the thesis as personality is the overarching doctrine including but not limited to the facet of publicity, which has gained particular focus and legal recognition in the American and several other common-law jurisdictions.

⁴⁰⁵ JV Muhonen, ‘Right of Publicity in Finland’ [1997] Ent LR 103; see also, Black (n 47) 11.

⁴⁰⁶ Black (n 47) 12.

⁴⁰⁷ Ibid 11.

⁴⁰⁸ *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc*, 202 F.2d 866 (2d Cir. 1953).

⁴⁰⁹ BGHZ 128 - *Caroline Von Monaco I*; See also, *Aubry v Les Editions Vice Versa* (1998) 1 SCR 591 (where an innocent photograph of a young girl was published without her consent).

another approach to personality as evident from the works of English academics like Beverley-Smith – which is the ‘appropriation of personality’ approach.⁴¹⁰ However, contrary to Black’s conceptualisation respectfully, there appears to be little or no scope to view these approaches differently. Both the approaches take a keen interest in the prospect of commercialisation of one’s persona and means of safeguarding it for the individual owning it (and also the licensees), and both grounds justifications for personality rights on economic interest.

Conversely, those on the other side of this sub-divide have advocated for a right of personality – referring to the same as an overarching and all-encompassing right – based on a dignitarian interest. This approach is particularly common to supporters whose work (and justifications) drew support from civilian jurisdictions like Germany which has introduced personality rights as a separate private right.⁴¹¹ Oddly, commentators who actually oppose the recognition of such rights can be argued to fall on this side as they agree on the need for safeguarding one’s dignity and autonomy but end up providing the right of ‘privacy’ as the solution to the concerns. With all due respect, any proposition of using privacy as an answer/solution has been clearly established to be inadequate for the protection of personality in Chapter 2 – be it for protecting either its economic or dignitarian interest or both.

Further interestingly, there are also supporters who seek to justify the right based on both the economic and dignitarian interests compounded together. In their view (and also as we shall see in the later part of this Chapter), disputes pertaining to misappropriation or unauthorised use of persona is not solely about getting compensated for the lost profits but is often about the injury done to the dignity of the celebrities by using it in ways that contradicts their public image.⁴¹²

Additionally, attempts have been made to use traditional justifications like Lockean labour theory, creator’s incentive theory and consumer protection by commentators - mirroring those justifications that are commonplace for other intellectual property rights to cement a strong case for recognising a personality right. This, more interestingly, has been challenged significantly, leading to the questions of what actually stands as a strong justification for the right.

The aim, therefore, of this chapter would be to start off with the analysis of the economic justification, followed by the discussion of the dignitarian justification. As there is a divide between the proponents of the rights themselves, this chapter will look into whether these justifications can co-exist, and both compounded can present a strong case for the recognition of the right. This would be followed by the evaluation of the other justifications which are commonplace. Finally, the critics of the proponents and their justification(s) will be evaluated in light of the competing interests as identified by both the proponents and opponents of the right.

⁴¹⁰ Black (n 47) 19-24.

⁴¹¹ Ibid.

⁴¹² See *Douglas* (n 333); *Waits* (n 280).

3.2: Economic Justification of Efficiency & Incentive

Undoubtedly, the seminal work of Beverley-Smith posits a good starting point in relation to identifying the economic interests that are innate with persona (more precisely with that of celebrities) which provokes the need for its protection. In his words, if an individual who has been subjected to unauthorised use or misappropriation of persona feels '*no further sense of loss having received a sum of money which accurately reflects the value of what has been lost*' then, the existence of an economic value in the persona of that individual is evident.⁴¹³ He continues, that the source of this economic value is actually the value given to the persona by exploiters (like advertisers, merchandisers and publishers) through purely commercial activities like merchandising, product endorsements, media use, etc., when the persona is traded by the individual itself or by users with license to do so.⁴¹⁴ Also from De Grandpre's words, famous people who has the ability to capture public attention and appeal in the market of 'eyeballs' are in high demand and they embarks on a 'relationship' with the users (endorsers/merchandisers/publishers) to not only communicate/interact with the public and increase their fame and social outreach, but also to get those users meet their targeted consumers.⁴¹⁵ This, as Beverley-Smith added creates an economic interest in the persona, which, in his view, should be objectively valued so that this objectivity renders the scope of being recompensed for any economic harm/detriment caused through misappropriation using a finite and quantifiable sum of money.

The existence of this economic value in persona, then, takes us to the next question, as accurately identified by Black,⁴¹⁶ whether the uses of persona in the public domain and its economic value renders it as a 'social asset' that necessitates protection, so that its innate value and social significance can be safeguarded, and therefore, cement justification of the right on a purely economic standpoint.

Black, re-affirming that the celebrity persona undoubtedly has an economic value owing to the public appeal it creates, contends that through creating and communicating a 'meaning', 'image' and 'identity', it generates common public interest and appeal, playing a central role in public's cultural experience, thus rendering it as a socially valuable asset.⁴¹⁷ These meanings, image and identity form an integral part of people's lives, as they use these to convey messages, interact and showcase their beliefs and opinions.

Coombe analysed the value of celebrity persona within the contemporary cultural and legal frameworks of modern society, contextualising her argument in relation to

⁴¹³ Beverley-Smith (n 63).

⁴¹⁴ Ibid.

⁴¹⁵ Vincent M. de Grandpre, 'Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity' (2001) 12 Fordham Intell Prop Media & Ent LJ 73, 88-92.

⁴¹⁶ Black (n 47) 119.

⁴¹⁷ Ibid 120.

consumerism, mass media, and the commodification of identity.⁴¹⁸ Drawing emphasis on the evolution of celebrity persona into major economic assets in the era of mass production and technological advancements, she underscored the symbolic link between the products and the celebrity persona that serves as a mechanism to establish consumer identity and loyalty; thus, highlighting the immense marketing value that a celebrity persona can hold.⁴¹⁹ Coombe further explored the semiotic and symbolic dimensions of the celebrity persona demonstrating how celebrities have become repositories of collective meaning and identity⁴²⁰. Through their commodification, celebrities represented values, aspirations, and contradictions that resonate with various social and cultural groups. Celebrity persona now stands as a dynamic cultural text embodying a 'floating signifier' rich with multiple meanings and capable of varied interpretation. To further underscore this, Coombe employed the fitting example of Madonna, whose persona has been frequently contested and redefined by diverse audiences to align with their respective cultural narrative.⁴²¹ The increased social importance of celebrity persona is also exemplified with Kylie Minogue being seen as a symbol of a certain gay culture and to such an extent that this was used as a reference in support of ensuring human rights for a gay man in an English Supreme Court case of *HJ(Iran) v SSHD*.⁴²² These clearly showcased that social uses of persona is not only limited to commodification for commercial purposes but is also used by cultural groups or unique sects of the societies to further and/or justify their ideologies.

It is apparent that celebrity persona not only attaches itself with economic value by engaging in commercial use but also attaches itself with significant social value through its prevalent social, cultural, and political uses. This, as confirmed by Grady, establishes celebrity as a 'socially valuable asset' which is exploited by commercial entities for achieving their commercial aims and by public as well, be individually or as a group or community to advance their social, moral, and cultural standing. Needless to say, that such a socially valuable asset necessitates protection otherwise, the innate value and utilities risk being misappropriated, overused, and thus diminished in value. What would now follow is how the proponents of personality rights (or synonymously publicity rights) have justified to ground this right on an economic framework that acknowledges persona as a both commercially and socially valuable asset and work towards safeguarding the very 'value' that is innate with celebrity persona.

De Grandpré grounded his economy-based rationale for publicity rights (which will be carried forwards for the overarching principle of personality) on the notion of economic efficiency, which he considers to be the core justification for property rights as well. In his lens, just as property rights are designed to minimise externalities (that is, costs imposed on third parties) and ensures resource allocation to maximise its social and

⁴¹⁸ Rosemary J Coombe, 'Author/Izing The Celebrity: Publicity Rights, Postmodern Politics and Unauthorised Genders' (1991) 10 Cardozo Arts & Ent LJ 366, 368.

⁴¹⁹ Ibid.

⁴²⁰ Ibid, 370

⁴²¹ Ibid.

⁴²² [2010] UKSC 31. See also, Coome (n 418); Black (n 47) 120-121.

economic value, personality rights should also concentrate the benefits and costs of persona exploitation within the individual so that their personal incentives align with societal development.⁴²³ Drawing an analogy with Harold Demsetz's theory of property right⁴²⁴ - which emerges and constantly evolve to accommodate society's trend towards maximising the value from scarce resources - De Grandpre contends that celebrity persona should be also acknowledged as an economically valuable resource, and treated as 'scarce' – thus, necessitating legal protection to prevent overuse and depletion. This protection, he argues, encourages – more specifically 'incentivises' - people to invest in their public image and performative skills, therefore helping society at large as well as the individuals themselves. De Grandpre drew support from the US Supreme Court's decision in *Zacchini v. Scripps-Howard Broadcasting Co.*⁴²⁵ where it was held that the unauthorised broadcast of Hugo Zacchini's entire human cannonball act infringed his right of publicity, highlighting that this right 'incentivises' creative and performative efforts (by the celebrities).⁴²⁶ This case illustrates the economic underpinnings of the right of publicity (and therefore, by analogy 'personality') pointing out that the Court's rationale aligned with the principles of property rights, which De Grandpre attempted to carry forward to ground his support for an economic interest based justification for personality rights.

The cornerstone of De Grandpre's argument for the need to safeguard economic efficiency is the identification of the negative externalities - which he referred to as 'congestion externalities' – and the significance of neutralising the same.⁴²⁷ Congestion externalities reflect the adverse effects of overexposure and unauthorised uses of celebrity personality. These externalities surface when excessive or improper exploitation of a celebrity's persona diminishes/depreciates its value, both economically and culturally resulting in reducing the incentives for individuals to invest in their own public image.

The economic ramifications of such externalities can be profoundly seen in *Waits v. Frito-Lay*,⁴²⁸ where the use of a sound-alike voice in a commercial diminished public appeal/fondness for Tom Waits' particular and unique vocal style, illustrating how unauthorised use results in social costs by diminishing the public's willingness to engage with a celebrity's authentic work.⁴²⁹ This clearly shows that when a third party uses a celebrity's persona without consent, it not only deprives the celebrity of potential economic gains/profits but also significantly risks 'diluting' the uniqueness and therefore, the 'public appeal/demand' of their persona. This, consequently, impacts the inherent/innate market value or rather the brand value of the persona by diminishing it. This is exactly what Grady referred to as the 'common pool' problem

⁴²³ Grandpre (n 415) 92-94; See also, RH Coase, "The Problem of Social Cost" (2013) 56(4) The Journal of Law and Economics 837.

⁴²⁴ Harold Demsetz, 'The Private Production of Public Goods' (1970) 13 The Journal of Law and Economics 293.

⁴²⁵ *Zacchini* (n 175).

⁴²⁶ Grandpre (n 415) 96-97.

⁴²⁷ *Ibid.*

⁴²⁸ *Waits* (n 280).

⁴²⁹ Grandpre (n 415) 103.

which he, in culmination with the principle of public goods, used to emphasise on the adverse effects of overuse/overexposure of persona.⁴³⁰ Grady provided the much-needed distinction between public goods and celebrity persona, as the latter, unlike the former, lacks non-excludability and non-rivalrous consumption. In his view, unlike public goods such as air, the excessive use of a celebrity persona (excessive advertisements, posters, or merchandise) can diminish its appeal and, in severe instances, render it unattractive. Grady contends that publicity rights (and by analogy, personality right) based on an economic interest model can essentially prevent the "overfishing" of celebrity persona which illustrates the classic "common pool" problem. Borrowing the concept from environmental economics, Grady uses the common pool problem in referring to the unsustainability of over-extraction of shared resources like fish and analogises this concept with celebrity persona. If people are allowed unrestricted use of a celebrity persona, it would be overly exploited in trivial commercial applications (e.g., inexpensive commercials, unauthorised items, etc.), diminishing its exclusivity and long-term worth. This notion further elucidated why courts found in favour of celebrities in cases like that of *Tom Waits*⁴³¹ & *Memphis Dev. Found. v. Factors Etc.*⁴³²

In terms of the cultural ramifications of congestion externalities, which generally ensues in addition to economic consequences, overuse not only undermines the commercial value of celebrity persona but also erodes its cultural significance. This "commodification" of celebrity persona risks transforming them into mere advertising tools, causing to lose their social and symbolic importance.⁴³³ The case of *Tom Waits* is equally relevant here as the public lost their eagerness to engage in his creative works following the unauthorised use of his persona at a commercial - essentially meaning that the social and symbolic meaning that his voice had among the public was diminished. This consequence of over commodification as contended by De Grandpre, interestingly resonates with Madow's view on the privatisation of popular culture, as such privatisation inhibits the public's capacity to interact creatively and culturally.⁴³⁴

Interestingly, both of these economic and cultural ramifications resulting from the De Grandpre's congestion externalities perfectly aligned with Grady's concept of 'rent dissipation' - which underpinned his economic justification for the publicity rights and therefore, personality rights. This rent dissipation theory denoted the inevitability of valuable resources losing its worth over time due to overexploitation and competitive use. Grady asserts that without any legal right to regulate the use of celebrity persona, free riders (e.g., advertisers, merchandisers, publishers etc.) would flood the market with low-quality and repetitive uses and hence, crowd out more valuable uses, such

⁴³⁰ Mark F Grady, 'A Positive Economic Theory of the Right of Publicity' (1994) 1(1) UCLA Entertainment Law Review 98-126

⁴³¹ *Waits* (n 280).

⁴³² *Memphis Dev. Found. v. Factors Etc.*, 616 F.2d 956 (6th Cir. 1980), cert. denied, 449 U.S. 953 (1980).

⁴³³ Grandpre (n 415) , 79.

⁴³⁴ Ibid, See also, Grady (n 430).

as prestigious endorsements, resulting in the depreciation of the celebrity's brand.⁴³⁵ This parallels the "common pool" problem as Grady highlights, wherein an unregulated fishery may be overfished as each user seeks to maximise their short-term benefits, giving no regard to long-term sustainability.⁴³⁶ In the same way, if users get uncontrolled access to celebrity persona, its distinctiveness and marketability starts declining.

Similar diminution in value and/or harm resulting from uncontrolled casual and low value uses like postering, t-shirts, coffee mug, calendars, were also noted by the court in cases like of *Vanna White*, *Elvis Presley*, *Christie Brinkley*, etc.⁴³⁷ The court further acknowledged that as low-value uses increases, high-value opportunities (like premium advertising contracts) are more likely to be missed by celebrities, as it was with *Tom Waits* after the use of sound-alike voice in a commercial crowded out high artistic opportunities for the singer.⁴³⁸ The outcome would not be much different if Adele's unique voice is freely available for use in commercials and advertisers/publishers seeking for an exclusive use of her voice for high yielding endorsement/merchandising/media contracts become less interested in engaging her since her voice has lost that exclusivity. The US court also affirmed through its decision in *Woody Allen's* case⁴³⁹, that overexposure and uncontrolled use can cause the consumers to mistakenly associate celebrity persona with cheap or unendorsed products or campaigns. The (mis)use of Woody Allen's likeness, in this case, to promote video rentals created a false perception that he endorsed the brand and this confusion ultimately diluted Allen's value and affected his ability to leverage his brand for future endorsements.⁴⁴⁰ The Court interestingly went as far as to acknowledge that uncontrolled use of persona would put the users at liberty to hire artists to mimic the celebrity persona (as seen in *Bert Lahr's* case⁴⁴¹) further diluting the distinctiveness of the persona and deplete its value.⁴⁴²

These overuse, crowding out, consumer confusion and devaluation collectively, as Grady frames by focusing on the court's identification of the same in these cases, results in rent dissipation, which needs to be combated in order to preserve the value of celebrity persona and incentivise the optimal use of such a scarce resource. The outcome of the courts in the cases above provided further validation and precedent to the necessity of preventing Grady's rent dissipation – and synonymously De Grandpre's congestion externalities.

⁴³⁵ Grady (n 430) 103-104.

⁴³⁶ Ibid.

⁴³⁷ See, *White* (n 282); *Memphis* (n 432); *Brinkley v. Casablancas*, 80 A.D.2d 428, 438 N.Y.S.2d 1004 (1981).

⁴³⁸ See, *Waits* (n 280); See also, Grady (n 430) 103.

⁴³⁹ *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985).

⁴⁴⁰ Grady (n 430) 120.

⁴⁴¹ *Lahr v. Adell Chemical Co.* 300 F.2d 256 (1st Cir. 1962).

⁴⁴² Ibid; See also, *Onassis v. Christian Dior* 472 N.Y.S.2d 254 (Sup. Ct. 1984)).

To cement these arguments further, which Grady has gracefully employed to advance an economic justification for a publicity (personality) right, he based it within the broader property rights theory of Harold Demsetz, as did De Grandpre. In acquiescence with Demetz, he argued that property rights arise when the costs of enforcement are lower than the benefits of preventing overuse.⁴⁴³ Applying the same principle in the context of persona, he argued that any publicity (personality) rights should be so framed to be capable of protecting only those assets that are scarce and valuable;⁴⁴⁴ so that if the value of persona is high, as was with Tom Wait's voice or Vanna White's likeness⁴⁴⁵, protection can be ensured but if the value is low, uses can be excused (as in *Mickey's Dora's* case).⁴⁴⁶

Furthermore, De Grandpre also commented on the challenges that exist to neutralise these congestion externalities within the current inconsistent and fragmented legal framework.⁴⁴⁷ The challenge lies in differentiating between uses that actually harm a value of the celebrity persona from those that simply extend their cultural exposure. For instance, unauthorised informative/media uses, such as satire or parody, may trigger curiosity rather than fatigue and may result in net positive externalities – meaning increased value and social reach;⁴⁴⁸ whereas the risk of “tiring the public” of a celebrity through overexposure even with trivial or incongruent products is also real and substantial.⁴⁴⁹ The decision in *White*⁴⁵⁰ can contextualise this well, where the advertisement was held to breach her right of publicity. In critiquing the decision as a ‘judicial overreach,’ De Grandpre argued for an economic framework that could restrict the ambit of the right to cases of clear harm, such as direct competition or deception, rather than vague notions of evocation or resemblance.⁴⁵¹

In De Grandpre's view, to overcome these concerns and existing challenges, the celebrities should be afforded exclusive control of their persona so that the externalities can be internalised, which will in return ensure that all costs and benefits associated with its use are fully borne by the user – aligning his argument with the broader economic principle underlying property rights.⁴⁵² This internalising, as it appears, would put the celebrity with the persona at the driving seat – effectively controlling (and maximising) its value by preventing any overuse/overexposure and maintaining its scarce nature. This ‘control of value’ would, therefore, incentivise the celebrities to maintain the quality and exclusivity of their brand and constantly invest on its growth and development, thereby, increasing the economic efficiency.⁴⁵³De

⁴⁴³ Demsetz (n 424).

⁴⁴⁴ Grady (n 430) 116.

⁴⁴⁵ *White* (n 282).

⁴⁴⁶ Grady (n 430) 118.

⁴⁴⁷ Although, he has referred to the legal framework in the US, it is also applicable in the context of UK, which is yet to recognise any right of publicity or personality.

⁴⁴⁸ Grandpre (n 415) 117.

⁴⁴⁹ *Ibid.*

⁴⁵⁰ *White* (n 282).

⁴⁵¹ Grandpre (n 415) 117.

⁴⁵² *Ibid.*

⁴⁵³ *Ibid.*

Grandpre's reliance on Demsetz's theory of property rights underscores this very argument, stressing how privatisation of resources— in this context, i.e., celebrity persona—reduces inefficiencies caused by unregulated exploitation.⁴⁵⁴

The need for safeguarding economic efficiency (undoubtedly) also remains to be the main ethos behind Grady's emphasis on preventing the rent dissipation from overexposure and overuse. In his words, putting an end to this rent dissipation would essentially mean putting a full stop to over exploitation by having exclusive control over the use of persona. A framework based on economic rationale can only recognise the adversity of overuse on the inherent value and would operate to ensure that low value casual uses of persona are avoided and only high value uses are prioritised – clearly maximising the value and incentivising the celebrity. Similar findings by the court in cases like *Waits* and *Vanna White* further solidifies Grady's proposition that any framework for protection of persona should be based on the economic justifications. He further contended that such a framework would treat persona as a 'scarce' resource and allow celebrities to license their persona in a controlled and strategic manner, ensuring optimal allocation and selectivity of premium exploitation deals over casual ones, thereby achieving efficiency. *Zacchini*⁴⁵⁵ ruling stands a perfect fit, as the court ruling reinforced economic efficiency by ensuring that *Zacchini* could allocate his persona (his act of human cannonball) to its highest-value use like live ticketed events, rather than losing control of it to television broadcasters.⁴⁵⁶ Such a framework would be far reaching even to reduce wasteful investment in imitation (as seen in *Lahr*⁴⁵⁷), as Grady contends.

De Grandpre, as well, elucidates that an economic interest centric framework would afford this 'control' and prevent the over-exploitation by imposing liability for uses that undermined a celebrity's commercial endeavours or has mislead the public.⁴⁵⁸ An economic regime would factor in the context and intent of such uses so as to privilege those that contribute to public discourse while discouraging the exploitative practices. At the same time, it would accommodate transformative and communicative uses that enhance the public's involvement with celebrity culture. He, therefore, asserts that by articulating a right of publicity (and by analogy, personality) grounded on economic rationale it could ensure both economic efficiency and cultural vitality in the context of personality exploitation. Undoubtedly, with this standpoint, De Grandpre and Grady both positioned economic interest in the forefront of justifications underlying the personality right.

Both Grady and De Grandpre's notion of economic efficiency in justifying an economic underpinning of personality rights resonates with McCarthy, as in his lens as well, an economic framework can adequately promote economic efficiency, which can in return

⁴⁵⁴ Ibid, 117.

⁴⁵⁵ *Zacchini* (n 175).

⁴⁵⁶ Grady (n 430) 122.

⁴⁵⁷ *Lahr v. Adell Chemical Co.* (300 F.2d 256 (1st Cir. 1962))

⁴⁵⁸ Grandpre (n 415) 117.

will ensure the establishment of a market for persona licensing.⁴⁵⁹ McCarthy defines a right of publicity (personality) ensures that every celebrity can control the commercial exploitation of his/her persona. This right should encompass every aspect of celebrity persona, which can be employed to extract commercial gains.⁴⁶⁰ As Beverley-Smith observes, celebrities are the 'owners' of their own persona and are in the best position to allow and commercialise its use, ensuring a more efficient allocation and maximisation of this commercial resource.⁴⁶¹ So, when this right will afford the 'control' and allow them to license their persona, a commercial market naturally develops, allowing common exploiter's like promoters/merchandisers/publishers to negotiate and buy permissions from the controller. Indeed, this would assure a more economically efficient system by promoting clarity and predictability (in the media and advertising industry) compared to one where users are left uncertain on the authority of their use of a celebrity's persona, resulting in lesser litigation over unauthorised use but increasing economic growth and market stability.⁴⁶²

Further to that, McCarthy also contends that creation of this market through ensuring control over use/allocation of persona fostering economic efficiency would further incentivise the celebrities to put more creative efforts and investment in personal branding. McCarthy noted that celebrities devoted a lot of time, money, and effort on building a commercially scalable public image which is apparent in the entertainment, sports, and fashion industries, where celebrities constantly shape and maintain their image/brand to increase their commercial appeal. Allowing them commercial control over the use and/or allocation of persona would serve as a reward for the creative labour and effort they have devoted in creating it. A personality right based on economic rationale would protect this continuous investment/creative works by ensuring that there is no scope of misappropriation or unauthorised use. McCarthy here drew analogies with the established copyright and patent regimes, arguing that just as creators and inventors receive protection for their creations/inventions, celebrities too should receive protection for their commercially valuable personas.⁴⁶³ Similarly, just as copyright and patent law affords exclusive rights to creators and inventors and therefore encourages continuous innovation and creativity, personality right would operate on a similar basis, offering a financial incentive for celebrities to continue developing their personal brand and public image. The US court's findings in *Waits*⁴⁶⁴ underscored this very argument of McCarthy. The court, recognising the economic value of Tom Waits' voice as an outward manifestation of his creative efforts, affirmed that protecting the economic value through a right of publicity (personality) safeguards the very effort that Tom Waits has put into developing this unique indicium. This notion of encouraging creativity and continuous effort and allowing celebrities, who devoted time, resources, and effort for developing this

⁴⁵⁹ J. Thomas McCarthy, 'The Human Persona as Commercial Property: The Right of Publicity' (1994) 19 Colum-VLA JL & Arts 129.

⁴⁶⁰ Ibid 140.

⁴⁶¹ Beverley-Smith (n 63) 330-331.

⁴⁶² Ibid; See also, McCarthy (n 459).

⁴⁶³ McCarthy (n 459) 138.

⁴⁶⁴ *Waits* (n 280).

commercially valuable persona, to reap its benefits all by themselves, also resonates with the commonly advanced justifications of creator's incentive and by extension with Lockean labour theory (which will be discussed in the latter part of this chapter).

Beverly-Smith⁴⁶⁵, like McCarthy, drew parallels with copyrights and patents in analogising that if individuals are afforded the right to control and profit from the commercial use of their persona, they will have greater motivation to engage in efforts that bring (and enhance) fame or public recognition. He further commented that this position aligns with that of the US Supreme Court in the *Zacchini*⁴⁶⁶ where the court explicitly held that protecting the performer's right of publicity would encourage the creation of performances beneficial to the public.⁴⁶⁷ Conversely, Beverley-Smith also acknowledged that although proponents of the right (apparently those who observe the right to have an economic framework) concentrated strongly on the notion of incentive in the context of safeguarding economic efficiency, opponents and critiques often found the analogy drawn with copyright and patent law to be defective; in that, as the incentives to innovate in the case of patents are more directly linked with societal benefits than the economic exploitation of a celebrity persona and persona can be incidental whereas patent or creative works are, undoubtedly, a result of one's creative manifestation.⁴⁶⁸ These criticisms along with others, however, warrant a detailed analysis so that the effectiveness of these justifications can be tested.

3.2.1: Criticisms:

Just as the justifications of the proponents of publicity rights have been brought forward to make out an arguably strong case for personality right, all the criticisms made by the opponents against such rights will have to be carried forward to test the overall practicality and practicability of such justifications. What follows are the critiques made and how it has been possibly countered.

3.2.1(a) *Critique of the Incentive Argument:*

As rightfully identified by Gervais and Holmes,⁴⁶⁹ Madow has been one of the toughest opponents of the right of publicity (and by extension, right of personality) who has combatted the conventional justifications given by proponents of this right, emphasising its socio-cultural and economic consequences. Harbours a view that granting such rights will lead to the centralisation of cultural power that impedes cultural pluralism and self-determination, Madow's criticism purport to advance a

⁴⁶⁵ Beverley-Smith (n 63) 330-331.

⁴⁶⁶ *Zacchini* (n 175).

⁴⁶⁷ Beverley-Smith (n 63) 308.

⁴⁶⁸ *Ibid* 310-311.

⁴⁶⁹ Daniel Gervais and Martin L. Holmes, 'Fame, Property & Identity: The Purpose and Scope of the Right of Publicity' (2014) 25 *Fordham Intell. Prop. Media & Ent. L.J.* 181, 196; See also, Rosina Zapparoni, 'Propertising Identity: Understanding the United States Right of Publicity and Its Implications - Some Lessons for Australia.' (2004) 28 *Melbourne University Law Review*, 690.

compelling case against accepting the economic justifications, and the right, as a whole.

Madow critiques the notion of 'incentive' advanced by the likes of De Grandpre, Grady and McCarthy, which centres on the belief that the justification for the right is overstated and conceptually flawed as he completely dismantles the core idea that economic right is necessary to incentivise creative labour.⁴⁷⁰ The core of his argument is that existing rewards associated with 'fame', in form of salaries, performance fees, and other compensation sufficiently render incentives for individuals to pursue career of a celebrity and a separate right is not required to ensure so. Carty follows Madow and enquires strongly about the evidence of the incentives that the proponents extensively argue about.⁴⁷¹

Madow highlighted that, historically artists, athletes, and public figures were not drawn to stardom, fame, or popularity for reasons of economic rewards only; but also, for the intrinsic and reputational benefits it entails. He strongly contended that celebrities are already "...*handsomely compensated for the primary activities to which they owe their fame*"⁴⁷² suggesting that their motivations to pursue this career remains unaltered in absence of a right and so "... *there is no compelling reason to think that absent a right of publicity, people would stop trying to become stars.*"⁴⁷³ He, as such, remarked that the additional entitlements created by the right would just amount to an unnecessary layer of economic reward, rather than a cardinal stimulus for creativity. Carty also labels the right just as an 'additional benefit' to an already benefited substance and the only incentive that it can possibly bring is the incentive to hone the skills that push them to fame, rather than the incentive to increase its value.⁴⁷⁴

Just as McCarthy, he also drew analogies with copyright law stating that such analogy is 'misleading'; creation of a celebrity persona is often a collaborative social process or can be incidental (e.g., being born into fame) and not necessarily the product of creative labour as seen in an author/artist producing a novel/painting in copyright cases.⁴⁷⁵ He added, contrary to copyrights, which are constructed and shaped in a tangible medium, celebrity persona egresses from a combination of media exposure, representation, fan following and engagement, and often public discourse. He further added that whilst copyright's primary target is to encourage the production of new creative works that benefits the society, publicity rights lack a similar comparable public benefit. Carty adds to this, that unlike copyrights, publicity rights can only encourage, by ensuring protection, the commercial activities in marketing persona, but not the 'original' act that led to the fame in the first place.⁴⁷⁶

⁴⁷⁰ Madow (n 59) 208.

⁴⁷¹ Carty (n 61) 249-250.

⁴⁷² Madow (n 59) 137.

⁴⁷³ Ibid, 208.

⁴⁷⁴ Carty (n 61) 249-250

⁴⁷⁵ Madow (n 59) 206-208.

⁴⁷⁶ Carty (n 61), 249-250.

Madow further argued that an economic right risks creating incentives to "overinvest" in the production of celebrity culture.⁴⁷⁷ Professor Radin made a similar finding when she observed,

'In the context of property for personhood, then, a 'thing' that someone claims to be bound up with nevertheless should not be treated as personal vis-à-vis other people's claimed rights and interest when there is an objective moral consensus that to be bound up with that category of 'thing' is inconsistent with personhood or healthy self-constitution'.⁴⁷⁸

He warns that granting expansive publicity rights encourages an inefficient allocation of resources, thus, contradicting with the likes of Grady and De Grandpre. He clearly pointed to the fact that increased commercialisation of persona essentially meant vast capital investment into the celebrity-driven industries often at the expense of other areas of cultural production where investment is required.⁴⁷⁹ This, therefore, skewed society's cultural landscape having resources flow disproportionately to celebrity centric industries like reality television, marketing, and brand endorsements, promoting commodification of the culture and fails to serve the broader cultural interest displacing the diverse cultural outputs/creative expression.

Another notable critique by Madow is the "distributional consequences" of publicity rights, where he highlighted how the right results in wealth concentration among elite celebrities. In his words, the right would operate to further increase the price of celebrity endorsement/merchandising/publication by giving celebrities complete control over the use and allocation (and obviously, the power to set a higher price) of their persona.⁴⁸⁰ This will shift wealth away from the mass consumers/public to a very small group of famous people who are already in receipt of substantial compensation for its ongoing exploitation.⁴⁸¹ Madow employed the examples of high-earning celebrities, like Arnold Schwarzenegger (who was paid \$10 million for his role in *Total Recall*) and Ryne Sandberg (who signed a multi-million dollar contract with the Chicago Cubs) to illustrate how such a right serves to redistribute wealth upwards.⁴⁸² This phenomenon, in Hoffman's view,⁴⁸³ is referred to as a "net social disutility", as such redistribution benefits only a handful number whilst granting no benefits to the ordinary citizens or broader public. Madow, as such, puts this thought-provoking question as to whether these celebrities, who are already financially secure, actually need additional safeguarding by way of a publicity (personality) right or not.

⁴⁷⁷ Madow (n 59) 216.

⁴⁷⁸ See, Gervais (n 469) 198; See also, Margaret Jane Radin, 'Justice and the Market Domain' in John W Chapman (ed), *Markets And Justice* (New York University Press 1989) 959-960.

⁴⁷⁹ Madow (n 59) 216.

⁴⁸⁰ Ibid 218

⁴⁸¹ Ibid. See also, Gervais (n 469) 196.

⁴⁸² Madow (n 59) 218.

⁴⁸³ Steven J. Hoffman, 'Limitations on the Right of Publicity' (1980) 28 Bull Copyright Soc'y USA 111, 120; See also, Gervais (n 469) 196.

3.2.1(b) Critique of the Efficiency Argument:

Madow also challenged the economic efficiency argument, which was referred to as a solution to the "*tragedy of the commons*" by Grady. He contended that it misinterprets celebrity persona as economic resources by claiming that persona will wear out and deplete in value absent a right formed on economic rationale.⁴⁸⁴ In his lens, unlike tangible resource like water, persona does not 'wear out' or become 'used up' when subjected to simultaneous multi-party use. Interestingly, Madow observes that free use of celebrity persona might lead to the overexposure but rather diminishing its inherent value, it enhances a celebrity's social and cultural visibility, outreach, and popularity, ultimately benefiting that individual. This clearly put Madow in crossroads with Grady and De Grandpre, who has very strongly contended that overuse leads to diminution of persona and therefore adversely affect the holder.

Madow believes that the free use and constant commodification of persona works towards increasing celebrity's social significance and their "semiotic power", rather than causing it to be overgrazed.⁴⁸⁵ This consequently draws greater consumer interest and public appeal, reinforcing the marketability of the persona as was seen in case of *Elvis*⁴⁸⁶, where the unauthorised use his image (persona) in fan merchandise did not diminish his brand value rather contributed to prolong his presence in the public memory and maintained his symbolic role in US pop culture.⁴⁸⁷

Madow further criticised the notion of "allocative efficiency" by which proponents, like McCarthy argued that a more optimal market allocation will be ensured if celebrities are afforded an exclusive control over persona.⁴⁸⁸ In Madow's view, this notion is flawed as it fails to factor in the cultural and symbolic components of celebrity persona which are shared resources for meaning-making and symbolic communication. If celebrity persona is monopolised by operation of this right, they become less accessible as tools for critique, subversion, and identity formation, essentially resulting in the phenomenon termed by Madow as 'cultural enclosure'.⁴⁸⁹ This enclosure would make celebrity personas unavailable for even the simplest (and often harmless) forms of uses like satire or parody. Celebrity persona, which is classed as a socially valuable asset by the proponents, would risk losing the very ability that made it socially valuable in the first place if a monopolised control is allowed. This enclosure can, contrary to what proponents believed to promote efficiency and value, would rather work in the detriment of the celebrities if the public is impeded to engage with and thus, make persona lose its participatory character, and it is this very element that Madow seeks to protect by opposing the right.

Madow also pitted the concept of free-riding against or more so as an exception to the publicity rights. He acknowledged that society harbours a strong view against free

⁴⁸⁴ Madow (n 59) 220–225.

⁴⁸⁵ Ibid.

⁴⁸⁶ *Memphis* (n 432).

⁴⁸⁷ Madow (n 59) 220–225.

⁴⁸⁸ Ibid. See also, Richard A Posner, Cardozo: *A Study in Reputation* (University of Chicago Press 1990).

⁴⁸⁹ Ibid.

riding, as it allows exploiters to receive 'something for nothing' or in Sander's words 'reap without sowing'.⁴⁹⁰ Madow takes issue with this view, as Black identified, as there is no common-law prohibition against benefiting from the commercial efforts of another, in general.⁴⁹¹ In his view, once any creative work is voluntarily placed in the market, it becomes freely appropriable and therefore, making it commonplace for others to enjoy and exploit it. Madow strongly believes that the case of persona is exactly the same as this and any argument for a monopolised control is weak, as persona becomes freely appropriable as soon as the celebrity puts in the open market.⁴⁹²

Moreover, Madow criticizes that an overly expansive reliance on economic interest through the economic efficiency and exclusivity arguments, fail to take into account the notion of freedom of speech. An illustrative example may be the *Gay Olympics* case,⁴⁹³ where the US Olympic Committee successfully prevented a LGBTQ+ organisation from using the term "Olympic" to label its event on the basis of avoiding dilution/maintaining exclusivity for economic efficiency. This case also reinforced Madow's view that monopolised/exclusive control causes cultural enclosure and erodes the participative elements of persona as marginalised communities like the LGBTQ+ group in this case were denied the ability to use a shared cultural term, i.e., 'Olympics' for self-expression. The issue of free speech/freedom expression remains to be one of the competing interests in the context of personality rights, which shall be addressed separately at the end of this chapter.

3.2.2: Response to Criticisms:

Although, criticisms raised by Madow are stark and the potency of those cannot be underestimated, but these criticisms are certainly not unchallenged. Julius Pinckaers'⁴⁹⁴ work requires particular mention here as it attempted to counter some of the concerns raised by Madow. Firstly, Pinckaers pointed out that allowing commercial exploitation of a persona without authorisation benefits only the entity exploiting it (like publishers/merchandisers/endorsers), which does not necessarily improve the redistribution or concentration of wealth.⁴⁹⁵ Secondly, Madow's distributional consequences are outweighed by the benefits of allowing an exclusive right on the commercial use which creates allocative efficiency by letting the celebrity maximise the value of the exploitation at the cost that users are ready to pay. According to Pinckaers, celebrity persona has a multi-faceted use and given the demand being elastic, "*the owner is less likely to maintain a price that excludes potential users.*"⁴⁹⁶ If

⁴⁹⁰ Anselm Kamperman Sanders, *Unfair Competition Law: The Protection of Intellectual and Industrial Creativity* (Oxford University Press on Demand 1997); See also, Madow (n 59) 200; Black, (n 47) 127.

⁴⁹¹ Madow (n 59) 201; Black, (n 47) 127

⁴⁹² Madow (n 59) 201-203.

⁴⁹³ *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987).

⁴⁹⁴ Pinckaers (n 2). See also, Gervais (n 469) 198-200.

⁴⁹⁵ Pinckaers (n 2).

⁴⁹⁶ Ibid.

this is true, Pinckaers adds, public pays more since they appreciate the association of the persona of their preferred celebrity on a product, and therefore, paying a higher value on this 'association' and not on the persona itself. Thirdly, whilst concerns pertaining to potential undermining of free speech is valid, but it can be adequately taken care of by way of establishing a balancing mechanism which will solve the conflicts.⁴⁹⁷

To aid in countering Madow's view of wealth being redistributed upwards, Black uses economist Adam Smith's opinion that limited monopoly can be a beneficial role in allowing creators to reap the economic rewards of their creations – therefore, not as detrimental as Madow sought to establish.⁴⁹⁸ Black argues that the value from persona is generated by way of authorised exploitation regardless of there being any recognised right or sanction in place for unauthorised use. It is therefore, as Black contends, not the right or possibility of a sanction that generates the 'value' in one's persona but it is the social practice and the market demand that does.⁴⁹⁹ As McCarthy said, any legal recognition or a right would ensure certainty in the commercial practice of persona exploitation which in turn may 'enhance' the value but this is not same as creating the initial value.⁵⁰⁰ Black employs the interesting example of cocaine trade in illustrating this – there is no legal recognition or legitimacy of such a trade, but it is still valued in overwhelming amount of money. Therefore, following Black and McCarthy, Madow's claim that recognising a right would create and confer the 'value' leading to upwards wealth distribution can be considered to have been misconceived. Further to this McCarthy answered the Madow's rhetoric that the right would channel wealth to the already wealthy by using the example of an Olympian whose name was used to promote cereal.⁵⁰¹ McCarthy pointed that a legal right would ensure that the allocation of value goes to the retired Olympian and not to the cereal conglomerate, and therefore, is not causing any redistribution upwards as Madow claims.⁵⁰² McCarthy continued, Madow's arguments are inadequate in the context of a capitalist society as it is never concerned with how wealth has been distributed or redistributed, and accepting Madow's argument would effectively mean refusing rights in expensive personal items like jewellery, supercars, etc.⁵⁰³

In addition, Black further combats Madow's support to free-riding by contending that although Madow is correct in saying that there is no general common law prohibition against free-riding, World Intellectual Property Organisation severely criticised and condemned such practice as being unfair.⁵⁰⁴ The WIPO Handbook underscored the problem of such free riding by defining this as a practice where a market user directly exploits another person's achievements for its own business purpose without

⁴⁹⁷ Ibid.

⁴⁹⁸ Black (n 47) 129;

⁴⁹⁹ Ibid 130.

⁵⁰⁰ McCarthy (n 43).

⁵⁰¹ McCarthy (n 459) 141.

⁵⁰² Ibid.

⁵⁰³ Ibid; See also, David Westfall & David Landau, 'Publicity Rights as Property Rights' (2005) 23 Cardozo Arts & Ent LJ 71,121.

⁵⁰⁴ Sanders (n 490).

substantially departing from the original achievement.⁵⁰⁵ Although this definition is based on free-riding on someone's commercial achievement and not on free-riding on celebrity persona, but based on Black's articulation, the consequence remains the same. As free-riding is done on someone else's persona, the free-rider becomes insufficiently distinguishable from the original holder of the persona and the conduct of the free-rider risks causing damage to the overall reputation, appeal, and public acceptance of this persona. These likely consequences of free-riding, if applied with De Grandpre's externality model, are more likely to show that any benefit that commercial free-riding on persona potentially brings gets outweighed by the detriment it may cause, as its net economic costs are negative. The act of free-riding, therefore, in any logical sense should not be allowed as an exception or as a counter argument to the right.

To sum up, Madow's criticisms are indeed thought provoking but not as potent to trump the economic/commercial justifications advanced for a personality right. The challenges made to Madow's criticisms, as aforementioned, strengthens the case for recognising such a right and thus, aligns with the essence of this thesis.

3.3: Dignitarian Justification of Autonomy & Dignity

No doubt, the safeguarding of the inherent economic/commercial interest of celebrity persona has been the predominant impetus for the proponents of personality rights in advancing arguments for its recognition. But on a closer look, it certainly, is not the only interest the right actually (or could) safeguard. Interestingly, McKeena stresses:

*'... [the] commentators have long ignored an important interest implicated by commercial use of identity that is shared by every individual. Because the things with which individuals choose to associate reflect the way they wish to be perceived, unauthorised use of one's identity in connection with products or services threatens to define that individual to the world. There are costs to whatever meaning we project, and those costs are borne uniquely by the individual. It is that interest, and only that interest, that the law should seek to protect.'*⁵⁰⁶

On a very similar note, Kwall observes that many disputes arising from unauthorised use also included concerns that transcended beyond economic exploitation.⁵⁰⁷ The case of *Waits v. Frito-Lay*,⁵⁰⁸ for instance, showcases that the singer, Tom Waits's concern against the unauthorised use of a sound-alike voice in advertising, was not just about loss of profit, but also about the violation of his personal opinion/standing against participating in commercials/advertisements. Waelde and Whitty could very

⁵⁰⁵ World Intellectual Property Organization, *WIPO Intellectual Property Handbook: Policy, Law and Use* (World Intellectual Property Organization 2004).

⁵⁰⁶ Mark P. McKenna, 'The Right of Publicity and Autonomous Self-Definition' (2005) 67 U. Pitt. L. Rev. 225 <https://scholarship.law.nd.edu/law_faculty_scholarship/600> accessed 13 November 2024.

⁵⁰⁷ Roberta Rosenthal Kwall, 'Preserving Personality and Reputational Interests of Constructed Personas through Moral Rights: A Blueprint for the Twenty-First Century' (2001) 2001 U Ill L Rev 151.

⁵⁰⁸ *Waits* (n 280).

well add in this space, as they held that publicity (personality) rights operates not only to recognise the commercial value of one's persona, but also to protect the inherent dignity of individuals - particularly celebrities whose personas are frequently exploited for economic gain.⁵⁰⁹ These, if anything, should intrigue the question of how dignity gets undermined through unauthorised use of persona and should it be a thriving justification for a personality right?

Neethling rightfully points out that violation of a celebrity's dignity can also stem from his/her inability to prevent third parties from intruding/interfering in his/her personal sphere by misappropriating persona. As such, a right of personality which would operate to afford that 'ability' to prevent such unwanted/unwarranted intrusion to the celebrity's personal sphere. In Neethling's view, personality rights are intrinsically linked to and is 'indispensable' in safeguarding the fundamental notions of dignity and autonomy; such dignity and autonomy being inherent and inalienable characteristics of every human being.⁵¹⁰ Waelde and Whitty's view paralleled to that of Neethling here, as they also defined personality rights to originate from the recognition of fundamental human values tied to an individual's dignity and that, such rights are inherent, inalienable and part of one's personal attributes.⁵¹¹ They strongly argued that personality rights are usually seen to protect the economic value of a celebrity's persona, but it predominantly serves to safeguard the dignitarian values which are also inherent in celebrity persona; thereby signposting their justifications for recognising personality rights on a dignitarian framework, just as Neethling.

Neethling acknowledges that 'personality' encompasses a set of rights that recognises an individual as a moral, physical and spiritual being, contributing significantly to the human experience and one's sense of individual existence. Drawing support from the Gierke's view that personality rights are uniquely personal and inalienable and are inseparable from one's dignity, Neethling positioned personality rights within the category of rights that are innate by virtue of being human and rooted his argument in the classical natural rights theories.⁵¹² Such natural rights theories were also advanced by McCarthy in justifying personality rights, when he stressed on its inalienability with dignity that underscored the necessity of retaining control over its exploitation as it potentially appealed to the basic idea of ensuring justice and fairness.⁵¹³ Waelde and Whitty, similarly observes that personality rights are central to the notion of defending human dignity as a core value and preventing exploitation of the personal space of human existence.

Furthermore, Neethling's justifications strongly relies on the interconnected values of dignity and autonomy. As personality rights are primarily concerned with protecting a celebrity's inherent worth, it operates to ensure that their autonomy, is respected. Such autonomy affords an individual the ability to decide how they would present/associate

⁵⁰⁹ Waelde and Whitty (n 358).

⁵¹⁰ Johann Neethling, 'Personality Rights: A Comparative Overview' (2005) 38 Comp & Int'l LJ S Afr 210, 210-211.

⁵¹¹ Waelde and Whitty (n 358).

⁵¹² Neethling (n 510) 211.

⁵¹³ McCarthy (n 43).

themselves and interact with others, reinforcing their sense of self-worth. Von Bar⁵¹⁴ conceptualised this fundamental notion of autonomy as an extension of human dignity and posited justifications for its legal recognition. This view of Von Bar's lends support to Neethling's argument for autonomy to have a legal value and thus, strengthens the aim of this thesis which seeks to justify personality rights based on dignitarian interest in addition to that of the economic interest already discussed.

As Coombe rightfully affirmed that individuals (celebrities) 'never lose their autonomy from the objects that circulate in their likeness',⁵¹⁵ preservation of their autonomy, therefore, is central as it allows them to have the freedom to control and protect the essential facets of their personality in order to preserve personal dignity. Absent legal recognition of this control, celebrities face serious risk of unauthorised and unwanted exploitation of the same, which Neethling views as an 'affront' to dignity.⁵¹⁶ Such affront is also construed by McCormick and re-affirmed by Black as an infringement to one's privacy and they both, interestingly, did not hold back in saying that such intrusion is also infringement to one personality rights.⁵¹⁷

Neethling further added such unauthorised use risks commodification of celebrities, leaving them open for unchecked public consumption, and social and economic exploitation in an era marked by the exponential rise of social media and digitalisation.⁵¹⁸ As Waelde & Whitty clarified, that dignity in the context of personality rights operates not only to protect the non-commercial attributes of persona but also ensures that celebrities are not commodified without their consent.⁵¹⁹

One can pose an interesting question here, as Madow⁵²⁰ asked plentifully. Why such commodification for celebrity persona is seen a violation to one's personal sphere, when such commodification is only adding on to their fame and publicity, which that celebrity is constantly working towards to increase? The answer lies simply on the understanding that if non-consensual commodification/uncontrolled public consumptions of persona is allowed, celebrities would be at risk of being associated with an event, product or a cause, which they would never have agreed to be associated with due to their personal preference or conflicts with their ideology, social and dignitarian standpoint. Waelde & Whitty, as such, convincingly points out that celebrities should be given the legal means to control, manage (and profit) from the use of their identities and that this would not only alleviate them from this crisis but would also enhance their personal dignity.⁵²¹ This is, obviously, due to the fact that such legal means would recognise their agency and autonomy in deciding how their persona is utilised and portrayed in public and commercial settings.

⁵¹⁴ Ibid; See also, Christian Von Bar, *The Common European Law of Torts* (OUP, 2000).

⁵¹⁵ Coombe (n 46) 102.

⁵¹⁶ Ibid.

⁵¹⁷ Black (n 47) 111; See also, Neil MacCormick, *Legal Right and Social Democracy* (OUP 1984).

⁵¹⁸ Neethling (n 510) 235-236.

⁵¹⁹ Waelde and Whitty (n 358).

⁵²⁰ Madow (n 59).

⁵²¹ Waelde and Whitty (n 358) 500; See also, Carty (n 61).

Such recognition of agency – essentially referring to control- also lies at the core of the justifications given by McCarthy in recognising personality rights. He underscored that ‘control’ ensures that the value derived through celebrity persona is rightfully attributed to that celebrity, rather than unjustly exploited by others and that ‘control’ is a necessary aspect of maintaining personal autonomy and by analogy, dignity.⁵²² In McCarthy’s lens, control is key element in an celebrity’s relationship with his identity, which affords him the exclusivity on how this persona of his will be used. He cited *Midler V Ford Motor Co*⁵²³ whereby the Court recognised the significance of control by upholding Bette Midler’s right to control the use of her voice against third party imitation of the same for commercial gain.

Moreover, Neethling, in acknowledging the risk of celebrity persona being subjected to undignified/inaccurate media portrayals or misuse for commercial gains, referred to the German version of right of personality⁵²⁴ and proposed that such should be introduced in the form of safeguards to enhance celebrity dignity, and prevent unwanted commodification and unchecked social and economic exploitation.⁵²⁵ This proposition appears to gain further substance, as Waelde & Whitty said, whilst economic incentives are often emphasised on for recognising personality rights (particularly in respect of its subset of publicity), the dignitarian arguments remain central in understanding why such personality rights are essential and justified (and the same is quickly gaining recognition across jurisdictions).⁵²⁶

Waelde and Whitty goes on to stress that, as dignity addresses the need for respect and acknowledge an individual's inherent worth regardless of their marketability, it offers a strong justification for personality rights; given present time when celebrity culture is so prevalent and public persons frequently run the risk of losing control over their own image, this is exceptionally crucial. The law, therefore, by recognising a dignity centric personality right, can recognise celebrities to have a special and intimate bond with their identity which goes beyond business interests and media fiddling. Weber also lends support to this viewpoint, as he argued that personality right based on a framework of dignity can protect autonomy and control over identity – as well as the commercial aspect of the same.⁵²⁷ Such focus on defending autonomy and control through a dignity based right of personality, as Waelde & Whitty suggested and Black explains, is also consistent with the broader human rights framework that exists in western legal systems which are committed to protecting autonomy and control in

⁵²² McCarthy (n 43) 685.

⁵²³ *Midler* (n 279); See also, McCarthy (n 43) 687.

⁵²⁴ For example, in Germany, the authors explain how the "general personality right" (allgemeines Persönlichkeitsrecht) developed initially to safeguard an individual's dignity, which includes privacy, bodily integrity, and moral interests, now also protects the commercial value of the persona. This right is protected by the German Basic Law (Grundgesetz), which elevates dignity as a constitutional principle. According to Waelde and Whitty, these protections are not merely theoretical but are used in practice to prevent unauthorised use of individuals' images and likenesses in a way that could compromise their dignity. See, Waelde and Whitty (n 358) 488 – 501.

⁵²⁵ Neethling (n 510) 213.

⁵²⁶ Waelde and Whitty (n 358) 500-501.

⁵²⁷ Olaf Weber, 'Human Dignity and the Commercial Appropriation of Personality: Towards a Cosmopolitan Consensus in Publicity Rights?' (2004) 1(1) SCRIP-ed 161-204 <<https://script-ed.org/wp-content/uploads/2016/07/1-1-Weber.pdf>> accessed 13 November 2024; Waelde and Whitty (n 358) 501.

respect of other intangible attributes of personhood. For example, Article 8 of ECHR, protects private and family life; Article 9, protects freedom of thought, conscience and religion, Article 2, protects right to education, etc.⁵²⁸

As Weber defined, dignity is a fundamental principle of natural law and is recognised in both national constitutions and human rights conventions to have legal value.⁵²⁹ The notion of dignity is constituted based on a celebrity's private sphere, which entails aspects such as identity and the capacity for self-determination in personal matters.⁵³⁰ Such dignity also encompasses reputation, which is characterised as another core notion that justifies rights over an individual's persona. Weber, therefore, implies that dignitary interest fosters a right to control persona and one that protects an individual's inner personality irrespective of its commercial value and regardless of his/her celebrity status.⁵³¹ These combined, as Weber claims, seek to establish that dignity, rather than economic considerations, should be seen as underpinning a right of personality. This undoubtedly is an assertion of high significance, since it highlights the dividing line that exists between the proponents of personality rights. This issue of divide would be further focused on when an attempt would be made to reconcile these two concepts, at the end of this chapter.

Moving on with Weber's seminal work, his one of the key arguments in this context also centres on the concept of 'consent' as a cardinal element of autonomy. Just as contended by Neethling, Waelde and Whitty, Weber too contends that celebrities should have the autonomy to decide how and in what contexts their persona will be used/associated. To properly stress on the legal recognition of the core notion of autonomy, Weber referred back to the 1791 US Bill of Rights and the French "*Déclaration des droits de l'homme et du citoyen*" of 1789 where the notion of autonomy was first articulated and the idea of freedom from state intrusion were established; it also reinforced that individuals possess inherent rights derived from their dignity, including self-determination and identity.⁵³² Weber then connects this notion to the legal recognition of personality rights in civilian jurisdictions, particularly in France and Germany, in parity with Neethling and Waelde and Whitty, which considers personality as fundamental rights. For clarity, Weber refers to Article 1(1) of the German "Grundgesetz" (Basic Law) which promulgated the inviolability of human dignity, to argue that human dignity and autonomy create a right in one's own persona, thus supporting the idea of a dignitary-based right of personality.⁵³³

Weber, by adding on the foundation curved by the likes of Neethling, Waelde and Whitty, emphasises that dignity requires individuals to have control over the use of their persona and cited John Locke's assertion that "every man has a 'property' in his

⁵²⁸ Waelde and Whitty (n 358); See also, Black (n 47) 112.

⁵²⁹ D Feldman, 'Human Dignity as a Legal Value: Part 1' [1999] PL 682, 685; See also, Black, (n 47) 108.

⁵³⁰ Weber (n 527).

⁵³¹ Ibid; Emphasis is drawn to this point in particular as Weber broadens the horizon of personality protection using dignity as its basis to afford protection to any individual (whereas the focus of this thesis is primarily on celebrities) even if they are not famous or lacks celebrity status.

⁵³² Ibid 166-169.

⁵³³ Ibid.

own person" in rationalising his emphasis. Even though Locke's idea acknowledges the commercial value of one's persona, it draws significant emphasis on the inherent ownership over it, which also serves as a moral and philosophical foundation for protecting that persona from exploitation by third parties. As indicia of persona are core components of one's identity, the right to determine how these features are used is indispensable to respecting human dignity.⁵³⁴ This very ability to determine and/or autonomously decide is the defining characteristic of being human, as Günther Dürig posits, and individuals (celebrities) must have a personal sphere to be able to make autonomous and free decisions without external interference.⁵³⁵ By analogy, this personal sphere affords a celebrity the ability to both determine whether he would consent to the commercial exploitation of his persona and if he so consents, the ability to choose the context, and control the extent of such exploitation. Such ability to consent and control is directly linked to one's autonomy, as Weber contends and the same constitutes the inner core of personality, any violation of which will directly undermine dignity.

Weber, additionally, provided the much needed clarification that a celebrity's presence in the public sphere or his association with public activities for the sake of earning his living, does not, in any way indicate that he has forfeited his dignitary rights.⁵³⁶ Now this clarification by Weber and his strong contention on the significance of autonomy stands tall against the rigid 'all or nothing' approach – which, quite oddly, vocalises for an unfettered use of celebrity persona implying that a celebrity has waived all his control and autonomy over his persona by entering in to the public domain. By citing a very potent hypothesis entailing Arnold Schwarzenegger's image and its unconsented digital use to produce another Terminator movie without Arnold's involvement, Weber cemented his argument that such unfettered use based on the 'all or nothing' approach would degrade that individual to a mere object and infringe his dignitary rights.⁵³⁷

Similar 'autonomy' based framework for personality rights gained significant spotlight through McKenna, who has critiqued the conventional mindset towards personality rights that prioritises economic interests over fundamental individual rights.⁵³⁸ A purely economic paradigm to the personality right lacks focus on the dignitary harms that are often suffered in the process. He identifies the inability of the conventional mindset to adequately address the complexities of the core notions of autonomy and self-definition, by highlighting that it fails to remedy the aggrieved celebrity when the unauthorised use of persona did not harm his economic interests but adversely affected how he is socially viewed or perceived - for example, by using his persona in political or social campaigns that he may not endorse.⁵³⁹ In McKenna's view, which is in parity with that of Neethling, Waelde & Whitty and others discussed so far,

⁵³⁴ Ibid.

⁵³⁵ Weber (n 527).

⁵³⁶ Ibid 167-169.

⁵³⁷ Ibid 177.

⁵³⁸ McKenna (n 506).

⁵³⁹ Ibid 56.

unauthorised use/misappropriation of persona is not only economically detrimental but also detrimental and prejudicial to one's self-concept and dignity, as such unauthorised use can be conflicting/contradictory to that celebrity's ideology, values or public image.

To remedy this crisis, McKenna's solution introduces the concept of autonomous self-definition in the context of personality right (which parallels with what Neethling and others above have said already), emphasising that celebrities have an innate interest to control how their persona is presented, regardless of its economic value.⁵⁴⁰ The main premise to this argument is that persona should be considered as an integral part of personhood rather than just a commodity for commercial usage. This autonomous self-definition would operate to ensure that celebrities have the freedom to define themselves (including where, how and when), whose identities are frequently exploited in the public domain for commercial purposes. He further contended that a more comprehensive understanding of the harm suffered by the victims of misappropriation can be acquired by using this autonomy-based framework, as it not only guarantees celebrities to retrain control over the usage of their persona to preserve individual autonomy but also adequately combat the situations in which more serious harm to their identity, values, and individual self-definition are involved.⁵⁴¹ McKenna continued, this autonomy based rationale could afford the court with an effective mechanism to assess whether the unauthorised use was harmful – that is, to determine whether it undermined the celebrity's ability to autonomously define themselves, instead of just measuring the profit that was made through the unauthorised use.⁵⁴² These arguments, therefore, are strong and extremely emotive as it purports to adequately cover the gap that would be created in the absence of a meaningful criterion for distinguishing harmful and innocuous uses of persona, by solely concentrating on the economic losses that ensued due to the unauthorised use.

Furthermore, an interesting 'reconceptualization' of the personality right was introduced by Alice Haemmerli, when she grounded her justifications for the right within the Kantian philosophy and advocated for an 'autonomy-based property right' model.⁵⁴³ Just as McKenna, Haemmerli drew emphasis on the notion that personality rights are not mere tools for economic benefit but is embedded in personal autonomy which is an essential aspect of human dignity and self-determination. She drew upon the seminal work of Warren and Brandeis to establish historical context for the development of privacy-related rights and how these might be expanded to better reflect a Kantian emphasis on autonomy and personal dignity.⁵⁴⁴ Moreover, the fact that over emphasis on the economic paradigm creates significant doctrinal confusion by failing to factor in the dignitarian harm usually caused by unauthorised use was

⁵⁴⁰ Ibid.

⁵⁴¹ Ibid 56-57.

⁵⁴² Ibid 59-62.

⁵⁴³ Alice Haemmerli, 'Whose Who? The Case for a Kantian Right of Publicity' (1999) 49(2) *Duke Law Journal* <www.jstor.org/stable/1373080> accessed 24 November 2024.

⁵⁴⁴ Ibid 423; See also, Samuel D Warren and Loius D Brandeis, 'The Right to Privacy' [1890] 4(5) *Harvard Law Review*.

also highlighted through Haemmerli's work.⁵⁴⁵ This is undoubtedly one of the main criticisms of the right that has echoed through the words of the proponents of dignity-centric justifications since it excessively commodifies persona by only focusing on getting the aggrieved celebrity compensated for the profits made, overlooking the dignitarian/reputational harms which have also ensued due to the misappropriation. To overcome this, Haemmerli gracefully proposes to reframe the right as one grounded in autonomy, which will be apt in acknowledging both the tangible (financial) and intangible (dignitary) harms involved.⁵⁴⁶ She drew further support on this from McCarthy,⁵⁴⁷ who also highlighted that identity rights must protect both economic and moral dimensions of a celebrity's persona. This approach further draws on Kantian idealism, emphasising the inherent worth of individuals over purely economic considerations.

Any unauthorised use of persona, especially for commercial gain, objectifies that person, treating them merely as a means to an end, which is inherently unethical under Kantian moral philosophy.⁵⁴⁸ By integrating Kant's focus on the moral worth of individuals, personality rights should be seen as an inherent aspect of a celebrity's moral and legal rights, allowing him to control his persona's commercial use while simultaneously recognising that this control is not purely about compensation but also about the ability of self-determination. Thus, she confines in combination of the above, that an autonomy-based property model can comprehensively acknowledge the moral agencies of a celebrity associated with his persona and adequately safeguard any invasion to his dignity and autonomy as well as allow financial compensation and therefore, promote a more rational and viable justification for the personality right. This view is critical in terms of the scope of this thesis as the existing legal framework inadequately protects celebrities against unwanted commercial exploitation and in the rare occasions where it offers *some* protection that is only limited to protecting the economic aspect not the dignitarian one. The shift of focus, as promoted by Haemmerli, on viewing celebrity persona solely as a commodity to recognising celebrities as individuals, whose dignity and autonomy deserves protection despite being a public person, is at the heart of accepting dignity-based justifications for the right.

Interestingly, a more ambitious and far-reaching approach towards justifying personality rights was taken by Kwall, as she advocated to extend the 'moral rights' justifications, that underlies copyright protection, to justify personality rights.⁵⁴⁹ Such ambitious move has been grounded on the overlaps she identified between the moral rights and personality rights as both purported to safeguard an individual's non-

⁵⁴⁵ Haemmerli refers to the case of *Zacchini v. Scripps-Howard Broadcasting Co.* to illustrate how a more cohesive, autonomy-based approach could avoid the pitfalls of the US legal system, where rights are unevenly protected depending on jurisdiction. She also references the *Zacchini v. Scripps-Howard Broadcasting Co.* case as an example of how the legal frameworks fall short in addressing the full scope of harm that arises from unauthorized use.

⁵⁴⁶ Haemmerli (n 543) 411.

⁵⁴⁷ McCarthy (n 459).

⁵⁴⁸ Haemmerli (n 543) 414-417; See also, Pinckaers (n 2).

⁵⁴⁹ Kwall (n 507).

economic facets of persona, i.e., integrity, reputation and dignity. According to Kwall, both the doctrines mirror themselves as they address the fundamental need to safeguard an individual from misappropriation or distortion of their persona or work and that such misappropriation or distortion is not limited to just economic concerns but also entails greater dignitarian concerns.

As Kwall explains, these moral rights sufficiently provide for the right of integrity,⁵⁵⁰ attribution⁵⁵¹ and disclosure⁵⁵² which can also adequately combat against any harms to reputation, integrity, public image and therefore 'dignity,' which can be caused by misappropriation or by the distorted use of persona. This essentially means that moral rights can deal with both non-economic harms as well as the economic harms, that commentators for a dignity-based rights have been endeavouring to achieve. She, therefore, rather boldly suggests moving disputes over persona (mis)use into the realm of copyright law's moral rights to defend reputational injuries.⁵⁵³ Both moral rights and a dignity-based personality rights seeks to protect the integrity of the representation, the former ensures that creative works are not altered and remains true to their intent, whilst the latter, controls how celebrity persona is presented in the public domain. Both protects reputation as well, as moral rights infringement prejudices the creator's reputation through distortion of their work and personality rights safeguards against uses of persona in ways that may stain the celebrity's public image. These very theoretical overlaps ground Kwall's contention that moral rights could provide a broader and more principled framework for protecting celebrity persona, compared to the current fragmented and inconsistent mode of protection available.⁵⁵⁴ Though her point is made in context of the varying publicity rights in force in the US, this point is equally applicable in the context of UK, where no such rights are recognised.

Moral rights are as far-reaching as to operate to protect celebrities from unauthorised and/or damaging uses of their persona in non-commercial settings, such as parodies, satirical or similar artistic expressions, where reputational and dignity harm may still occur.⁵⁵⁵ Kwall also highlights the doctrinal benefits of moral rights, especially their emphasis on preserving the originality and integrity of creative works. She contends that by applying moral rights to persona, courts would be able to concentrate on the harm that misappropriation can cause to celebrity's reputation and dignity rather than delving into intricate comparisons between commercial and non-commercial uses.⁵⁵⁶ Furthermore, the inherent restrictions of copyright law, such the fair-use doctrine,

⁵⁵⁰ The right of integrity prohibits modifications to an author's work that destroy its spirit or character, ensuring the work reflects the creator's personality and intentions. See, Ibid 153.

⁵⁵¹ The right of attribution gives authors the right to be recognized for their work and to prevent false attribution. See, Ibid 153.

⁵⁵² The right of disclosure allows creators to control the timing and manner in which their work is presented to the public and protects incomplete or unpublished works. See, Ibid 153.

⁵⁵³ Kwall (n 507) 159-160.

⁵⁵⁴ Ibid, 159

⁵⁵⁵ Ibid.

⁵⁵⁶ Ibid 160.

would offer a methodical way to balance conflicting objectives, such as free speech and creative use.⁵⁵⁷

Kwall's analysis, however, underestimates the doctrinal and structural differences between copyrights and personality rights – as the former emphasizes on authorship and protection of creative works as an 'extension' of the author's personality; whereas the latter focuses on the protection of the personality itself. These foundational differences may obscure the seamless integration of moral rights and personality rights. Moral rights' reliance on copyright law's limitations, such as fair use and the fixation requirement, might not fully accommodate the broader range of harms addressed under personality rights, especially those arising in purely digital or ephemeral contexts. For instance, fair use doctrine may allow transformative or parodic use of persona, undermining the need to safeguard one's dignity; fixation requirement may exclude certain categories of persona from protection. Notwithstanding, these stark differences between the doctrines, moral rights - in the most logical sense - can be construed to operate to protect to one's 'dignity' - which in turn operates to justify the right to control persona, thereby, placing Kwall in the same line of commentators, who promotes 'protection of dignity' in order to rationalise the recognition of a right of personality.

3.3.1: Criticisms:

The proponents on this side of the table have, undoubtedly, demonstrated that the concept of personality intrinsically features the aspects of dignity and autonomy. It is beyond doubt that harm to dignity is likely to occur when persona is misappropriated and more so, if the (mis)use is contrary to the public image/perception of the celebrity; therefore, protecting dignity should operate as a justification of the right. However, the notion that dignity needs to be protected through a personality right has its fair share of backlashes and is certainly not sacrosanct despite how compelling it may sound.

The notions of dignity and autonomy are moral precepts rather than legal doctrines. This abstractness of these interests raises concern as to its practicality and application. Without any coherent legal definition and/or legal value, the notion of dignity is often borrowed from various international instruments and constitutionally entrenched rights. This causes further difficulties as owing to such abstractness, these concepts are incapable of uniform application and therefore, risks leading to inconsistent results. So, even if these are used as a value to guide constitutional and legal developments, it is highly likely to produce controversial rationales and prove to be extremely malleable being just moral precepts.⁵⁵⁸ It, as such, casts serious doubt on whether such an abstract, malleable and obtain borrowed concept can be taken into account in formulating a right as broad and as far reaching as personality. Even if it is employed as a value to justify the right, it may not generate anything beyond its

⁵⁵⁷ Ibid 159.

⁵⁵⁸ Beverley-Smith (n 63) 313-314.

retorical force, ultimately proving to be of no creditable assistance.⁵⁵⁹ This abstractness is further problematic, as any personality rights would have to be balanced with competing interest like freedom of expression, and striking that balance when the right is formed over the vague and abstract moral maxim of dignity, would be immensely difficult.

Another criticism that appears inevitable is the overextension of this abstract notion to include diverse interests like autonomy, reputation, identity, public perception, feelings, distress, privacy, etc, all under the overarching concept of personality and afford protection.⁵⁶⁰ Such overextension is problematic as it risks diluting the core meaning of the notion and what it actually seeks to safeguard.

Despite the abstractness that picked up these critiques, dignity remains a powerful justification for recognising personality rights, as it operates both as a foundational principle and a practical tool for addressing modern challenges pertaining to persona exploitation.

3.3.2: Dignity Framework in Practice:

Whilst in theory, the arguments of the proponents of the right who are on the dignity side seem extremely promising, the viability of the same needs to assess in terms of practice. Waelde & Whitty has, by contrasting evolution of personality rights across civilian, common law and mixed jurisdictions, identified that a dignitarian rationale generally leads to a 'defensive model', particularly, within the civilian jurisdictions to safeguard one's persona. According to their findings, this defensive model aims to protect persona through negative obligations, that is, by preventing unauthorised use or unconsented commodification by third parties. Under this model, the right operates as a shield that prioritises the protection of unauthorised use of persona over monetising/commercialising the same.⁵⁶¹ Similar models are well positioned in jurisdictions like France, where preventing harm to a one's dignity and integrity takes precedence over preventing economic harm.

In analysing the defensive approach, they importantly identified the inherent tension between safeguarding commercial interests and dignitarian interest. Based on their findings, civil law jurisdiction priorities the latter, as the concept of inalienability sits in the core of maintaining the integrity of personality rights, which are observed as being linked with very essence of personhood. Federica Gioia, as cited by Waelde & Whitty, clearly contends that permitting the unrestricted transfer or commercialisation of these rights would compromise dignity by undermining deeply personal nature of these attributes.⁵⁶² Similarly in Argentina, as Waelde & Whitty points out, these rights are expressly stated to be inalienable, which supports the idea that human dignity cannot

⁵⁵⁹ Ibid.

⁵⁶⁰ Neethling (n 510) 210.

⁵⁶¹ Waelde and Whitty (n 358) 492-493.

⁵⁶² Ibid.

be commercialised.⁵⁶³ Consequently, they affirmed that the defensive model's increased emphasis on inalienability is its defining feature and that, it operates to ensure that personality right functions to protect one's dignity rather than being only used as an asset for commercial exploitation.

Whilst the defensive model is a good example of how dignitary-based personality rights has been recognised and is functioning, it does have the deficiency in recognising the economic value that is commonly derived from celebrity persona, as pointed out by Waelde & Whitty. The model that has been identified seems to be at odds with the version of the personality right that proponents like De Grandpre, Grady and even Beverley-Smith seeks to recognise and obviously, protect. As this thesis will seek to find a balance between these interests and attempt to reconcile both the justifications advanced by the proponents of personality rights, it takes a very critical view of this defensive model due to this deficiency. Speaking in line with Waelde & Whitty, this defensive model poses gaps in the law by not giving equal emphasis on the both the economic and dignitarian values of celebrity persona; so, not the best model to advocate for. In the next segment, the thesis will be focusing on the possible ways of reconciling both these interests and attempt to suggest a how these can be balanced and bring to co-exist.

3.4: Can Economy and Dignity Co-exist?

There remains no doubt that proponents have mobilised heavily on either side of the divide to establish that the justification they are rooting for can trump the other and provide the framework for a personality right in their own rationales, with very little regard for the other. Although both the justifications appear to be capable of withstanding all criticisms and challenges posed and boldly go a long way rationalising a personality right, probably without uniting even, this thesis takes the view that a stronger case for personality right can only be advanced through the union of both the justifications. As the case precedents and the proponents (irrespective of their preference) are seen to have acknowledged that both the interests are often harmed (either together or separately) due to misappropriation, this thesis sees no reason why an attempt should not be made to advance a case for a personality right grounded on both economic and dignitarian framework.

The starting point for any such reconciliatory attempt would be to first assess whether these two interests can co-exist in theory. Triangulating those who has advanced economic justifications particularly focusing on the US version of the right, i.e., publicity rights, their main ethos has been to safeguard the commercial aspect of persona by affording 'control' over its use.⁵⁶⁴ The control would then ensure economic and allocative efficiency as the celebrity would decide where to employ his persona, to

⁵⁶³ Ibid 504-505.

⁵⁶⁴ See Grandpre (n 415); Grady (n 430).

what lengths, at what price and when. With this approach, those advancing forward with the right appears to have created no room for issues like dignitarian harm, by overly focusing on potential economic harms only – enabling a form of protection that is common with property interests.

Now those advancing justifications based on dignity and autonomy – with their focus of the rights currently in force in civil law countries, strongly asserted that the ability to commercially exploit persona derives from dignitary considerations and not economic one; so the right must be seen through the lens of respect for human dignity, autonomy and self-determination.⁵⁶⁵ At the core their argument is also the need to give ‘control’ of the exploitation to the individual holding the persona, otherwise his autonomy and ability of self-determination will be undermined. Preservation of this autonomy and dignity would therefore demand that the individual gets to decide when, where and to what extent the persona would be associated. This approach, as such, seeks to safeguard an individual from harm caused to human dignity and reputation, with some emphasis on economic losses (as damages awarded are often nominal) but more on the mental distress and embarrassment caused by the unauthorised use – a form of protection seen with privacy interests.

Interestingly, even though, these justifications are pursuing different agendas, they converge on three aspects, theoretically; both has the issue of ‘control’ sitting at their core; both seeks to achieve ‘damages’ (one for loss of profits and other for emotional distress/embarrassment) and both ultimately aims to safeguard the ‘persona’ itself. Whilst the last 2 meeting points might not draw much support from the available jurisprudence – but the first meeting point of ‘control’ would. The existence of ‘control’ in both the interests causing a doctrinal overlap is also confirmed by Beverley-Smith, as he stressed that *control* can be seen both as an economic right in maintaining commercial exclusivity and also a dignitarian right to maintain autonomy and self-determination.⁵⁶⁶

This proposition, however, might not sit well with Carty, who predominantly viewed *control* as an economic concern and not as a dignitarian one.⁵⁶⁷ This position of Carty has also attracted criticisms from Black, who also views control as the ‘lynchpin’ of both the interest, as she opposed Carty by saying ‘*control, even for commercial purposes, can still be seen as a dignitarian interest, allowing individuals to make his/her life choices*’.⁵⁶⁸ Black, despite opposing, acknowledged that although Carty’s point of view cannot be completely defeated, but her point of view does confirm, if anything, how closely linked these two interests are. So, accepting that control does actually ties up these interests together in theory, it needs to be now assessed whether the interests can co-exist in practice.

⁵⁶⁵ See, Neethling (n 510); Weber (n 527); McKenna (n 506).

⁵⁶⁶ Beverley-Smith (n 63).

⁵⁶⁷ Carty (n 61).

⁵⁶⁸ Black (n 47) 92.

As Black suggested, *Irvine* can be a good starting to verify this here. In *Irvine*, the Court acknowledged that control in itself is a dignitarian interest – allowing Irvine to decide where his persona will be used (recognising autonomy) and that, it is equally important in terms of Irvine’s prospective commercial gains, as his control of use of persona will dictate the enhancement of it in the commercial context in the future.⁵⁶⁹ In *Douglas*, the primary claim (of the Douglas couple) was for mental/emotional distress and inconvenience suffered due to unauthorised publication and financial compensation was made to compensate that but not for loss of profits. Control in this case was recognised not only for economic reasons as the unauthorised publication was detrimental to the existing exclusive deal, but also for dignitarian reasons because of the distress the claimants were subjected to suffer.⁵⁷⁰ These recognition by the Court, therefore, is a testament to the fact these interests can co-exist in practice leading us to next question of whether these interests can be conclusively reconciled.

Any possible reconciliation would, undoubtedly require an integrated approach/model that empowers a celebrity to control and benefit from the exploitation of his persona, therefore, reinforcing both his economic interests and inherent dignitarian interest. A helpful analogy can be made here with copyrights for understanding this integrated approach, as copyrights operate to safeguard both economic and dignitary interest under one legal scheme through CDPA 1988.⁵⁷¹ A further analogy, following Black, can be drawn with the monistic model in Germany which caters for both the interest together. The German model will be a subject matter of detailed analysis in the next Chapter of this project so the details will not be discussed here; but for now, this German model is reminiscent of a working model (although position is reserved as to its practicality, which will be assessed in the proceeding chapter) similar to this very integrated model that make these interests compatible with one another.

So, to sum up, both the interests overlap in theory and in practice. The Court’s trend in *Irvine* ad *Douglas* further alludes to the same overlapping. The fact that these interests can both theoretically and in practice exist together, coupled with established examples like copyright and fully functioning integrated model in jurisdictions like Germany, can lead to the safe conclusion that these concepts can co-exist and are compatible. Such compatibility and reconciliation would greatly contribute to mobilising for a strong case for a personality right.

3.5: Other Traditional Justifications:

3.5.1: Lockean Labour Theory

The Lockean labour theory, inspired by John Locke’s philosophy, is one of the traditional justifications that played a primary role in the debates for justifying private

⁵⁶⁹ *Irvine* (n 126).

⁵⁷⁰ *Douglas* (n 333).

⁵⁷¹ See also, Black (n 47) 96.

property rights like intellectual property, including but not limited to copyrights, patent, etc. This theory reinforces an individual's entitlement of the fruits of his own labour. As Grady affirms, this theory traditionally underpins the majority of judicial reasoning for the publicity (personality right).⁵⁷² Nimmer boldly argues that “...every person is entitled to the fruits of his labour unless there are important countervailing public policy considerations...”⁵⁷³ and that in absence of a right of publicity (personality), “...persons who have long and laboriously nurtured the fruit of publicity values may be deprived of them.”⁵⁷⁴ Nimmer continued, as celebrities usually expend painstaking effort, time and resources to create, develop and better their unique abilities forming their persona - be it the voice for a singer/mimicry artists, physical prowess/endurance for an athlete or a special act that is unique to that very individual – only they should be allowed to exclusively control those and profit from it. This exclusive control and command over profiteering is what personality rights seeks to ensure and that is why, in Nimmer's view, such rights are just the logical extension of the fundamental principle that individuals should reap the benefits of their labour.⁵⁷⁵ The US courts have very well endorsed this view in cases, to name a few, *Haelen*, *Re NCAA*⁵⁷⁶, *Uhlaender v. Henricksen*,⁵⁷⁷ further justifying why this labour theory is considered as the most common justification when it comes to personality.

Just as it is the most commonly argued justification, it is also the most heavily challenged and criticised one in the whole lot. Madow, to begin with, heavily opposes the core notion of individual labour under this theory, as he critics that external factors also contribute to the fame and popularity that creates the value in the persona.⁵⁷⁸ Often public perception, cultural force and media directly contributes in shaping one's persona.⁵⁷⁹ Coombe affirms that there are no convincing evidence that all individuals has laboured his/her persona.⁵⁸⁰ This is particularly true as people can get born into fame (like children of global stars or celebrities – Cristiano Jr (Cristiano Ronaldo's son) for example with an Instagram follower of over 1 million) or gets famous out of pure luck (like those we see in Facebook memes) – essentially meaning that fame/popularity may arise from fortuitous circumstances rather than laborious effort.⁵⁸¹ Coombe also says that the list of entities or personnels that can contribute to the build-up of the persona can be endless – as there cannot be a persona, if that is not nurtured/maintained – often through coaches/mentors/directors, if that not received by others – the audience, if that is not carried to those audiences by the advertisers/media/filmmakers. Therefore, as Black emphasised, the generation of

⁵⁷² Grady, (n 430) 108-109.

⁵⁷³ Nimmer (n 157) 203-223.

⁵⁷⁴ Ibid.

⁵⁷⁵ Ibid. See also, Grady (n 430) 108-109; Noa Dreyman, 'John Doe's Right of Publicity' (2017) 32 Berkeley Technology Law Journal 673, 683.

⁵⁷⁶ *Keller v. Elec. Arts Inc.* (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268; See also, Dreyman (n 575) 683.

⁵⁷⁷ 316 F. Supp. 1277, 1282 (D. Minn. 1970)

⁵⁷⁸ Madow (n 59) 182.

⁵⁷⁹ McKenna (n 506).

⁵⁸⁰ Coombe (n 418).

⁵⁸¹ Beverley-Smith (n 63) 317.

value of the persona is not always in the control of celebrity and not always resultant of the continuous labour and efforts that has been put in.⁵⁸² There are many footballers who is not known to the public, many actors who struggled enough to rise to fame but failed and many are still struggling; are they not putting in painstaking efforts to get recognition? They obviously are, but their labour will not automatically transpire to add a value to their persona; value accrues only when their presence in their respective field will be felt, acknowledged, and appreciated by the targeted recipients or the public. Grady held this theory to be flawed, by referring to the Court's inconsistent application of the labour theory in cases like *Artie Shaw v. Time-Life Records*⁵⁸³ where the justification was not accepted despite there being proof of extensive 'labour' being present; conversely, however, such justifications were allowed in *Waits*.

More interestingly, Haemmerli, whom we saw advancing justification based on the Kantian theory with the backdrop of the autonomy-based property model, completely dispelled this traditional justification. The labour theory takes a more materialistic and restrictive approach; it grounds entitlement purely based on the 'labour' invested in creating the persona, thus the same can be exploited/commodified for economic purposes.⁵⁸⁴ As she correctly identifies, this approach clearly overlooks the moral importance of individual persona as an extension of personal autonomy and fails to acknowledge that the overly expansive commodification leaves potential harms to dignity unaddressed. Thus, as she stresses, the idea of turning one's image into a mere economic commodity as promoted by Lockean labour-based framework directly contradicts to Kant's principle of autonomy, which clearly mandates any right of persona should be viewed as protecting an individual's autonomy over how his persona is used, whether or not this use has economic implications.

3.5.2: Utilitarian Incentive

The economic incentive justification can be found at the core of the copyright, patent and trademark regime, and has been featured heavily in nearly all aspect of intellectual property rights. By analogy, this justification has also gained significant currency among the proponents of personality (publicity) rights, where some has advanced it as a standalone justification and other have advanced this as a part of other broad justifications (like economic efficiency as seen in the earlier segments of this Chapter). This justification suggests that providing personality rights would motivate/induce celebrities to expend more time, effort and resources in developing distinctive and marketable persona. Absent such rights there would be no incentive to commit to more creative efforts, acquire fame or public appeal. Through this right, an exclusive control over persona could be ensured, encouraging celebrities to commit continuous labour to innovate and shape their personas, which in return would be socially beneficial and

⁵⁸² Black (n 47) 97-100.

⁵⁸³ 38 N.Y.2d 201, 1975; See also, Grady (n 430).

⁵⁸⁴ Haemmerli (n 543).

foster cultural development.⁵⁸⁵ This view is exemplified in the US court's ruling in *Zacchini*, where the court affirmed that protecting the performer's right would encourage further creation of similar performances which are beneficial to the public.⁵⁸⁶

This justification, like the other before it has attracted severe criticisms. The most prominent ones are from Madow, which has been already discussed above in details when exploring the criticisms of the economic efficiency justification. Those will not be reiterated here to avoid repetition, but the significance of the criticism needs to consider when this justification is singled out and its strength as a justification in its own right is assessed.

In addition to Madow's criticisms, the analogy done with other rights like patent or copyrights to extend this justification for personality rights has been held to be tainted; incentives to innovation in case of patents and creative works under copyright often bears more benefits to the society than the exploitation of persona ever will be.⁵⁸⁷ This justification is further critiqued for overstating the role of economic incentives in motivating people to seek for fame/popularity. Grady says, as did Madow, that the market system of commercial exploitation is already extremely rewarding and incentivising to everyone to eye for it, just as fresh athletes, junior actors, who are extremely motivated to work hard to reach higher pay bands, land big endorsement deals, etc. One can carefully think in this conjecture – do they really care about a separate right based on this justification to give them this motivation? The most logical answer will be 'NO', leading to the understanding that a right based on this justification can only provide marginal additional incentives. Additionally, it risks creating economic inefficiencies, given how celebrity market is extremely difficult to penetrate and as there are only limited spots available, there will be fierce competition for those limited opportunities which can prove to be counterproductive by drawing talents away from other sectors and ultimately adversely impacting social and cultural welfare.⁵⁸⁸ Furthermore, this justification seeks to address only the marketable value of persona and the not the persona itself, affording protection to which is the main idea behind the personality right.⁵⁸⁹ It needs to be understood that not all persona has a commercial value, but as seen above, misappropriation of the same could still cause harm to the dignity and reputation side. Any justification should operate to recognise the fact that persona is the subject matter to protect, and value is irrelevant. This justification, therefore, appears to be flawed as this fails to recognise this very issue.

3.5.3: Unjust Enrichment

Another justification that has gained considerable traction in the jurisprudence pertaining to personality is the theory of unjust enrichment. This theory renders any

⁵⁸⁵ Grady (n 430) 110.

⁵⁸⁶ See, *Zacchini* (n 175); See also, Beverley-Smith (n 63) 308.

⁵⁸⁷ Grady (n 430).

⁵⁸⁸ Ibid 111.

⁵⁸⁹ Black (n 47) 97.

form of free riding on individual's persona to make a profit without compensating that individual, unjust and unfair. Kwall considers this theory as one of the fundamental rationales behind publicity (persona) rights, which recognises the need to safeguard use of celebrity's goodwill and reputation that he has developed through investment of time, effort and money.⁵⁹⁰ At its core, the theory solely aims to prevent the unauthorised commercial exploitation of celebrity persona and therefore, finds strong support from case like *Zacchini*. The logic, as Beverley-Smith outlined, is simple; if you benefit from the commercial exploitation of another's persona, then it is only fair that the person whose persona was exploited is entitled to a share of the proceeds. This approach, therefore, is based on a moral claim that seeks to prevent one from '*reaping what he has not sown*' by publicity(personality) rights⁵⁹¹ and as such, will be said to share the same premise as the Lockean labour theory.

As this theory shares the same premise with the Lockean labour theory, the criticisms of the Lockean labour theory, as discussed in the foregoing paragraphs will apply to this theory as well. To this Haemmerli added that if the theory operates to bar someone from reaping what he/she has not sown, which is also something that the celebrity has not 'fully' sown (as we now understand the external factors can also cause the fame and not necessarily it will be the celebrity himself to be solely responsible for its creation), then this rationale will be equally weak, as the Lockean labour rationale, for the purpose of justifying personality rights.⁵⁹² Grady further added that, while the theory purports to offer a moral justification for the right, it fails to serve as a predictive or explanatory tool for judicial outcomes; rather, functions more as a rhetorical device that courts invoke to rationalise their judgments.⁵⁹³ Madow also pitted three strong arguments against this rationale.⁵⁹⁴ Firstly, he observes that many plaintiffs in personality cases have themselves benefited from other's creative works, thereby experiencing a similar "windfall", leaving us with question of whether this theory actually any serves fairness, (or at all!). Secondly, there is no rule prohibiting profiting from the commercial efforts/labour of another, so according to him, absent any such general rule, once a celebrity persona is voluntarily placed in the market it becomes open for free appropriation which cannot be prevented to counter unjust enrichment. Lastly, the (mis)uses this rationale seeks to prohibit often adds/contributes creatively to the very persona e.g., by using humour, artistry, or wit and thereby, increasing its value, ultimately questioning whether, if at all, there has been any unjust enrichment in the situation.

⁵⁹⁰ *Bi-Rite Enterprises, Inc v Button Master* 555 F Supp 1188, 1198 (SDNY, 1983); See also, Kwall (n 507).

⁵⁹¹ Madow (n 590) 196; See also, Beverley-Smith (n 63) 321.

⁵⁹² Haemmerli (n 543) 413.

⁵⁹³ Grady (n 430) 110

⁵⁹⁴ Madow (n 59) 196-206

3.5.4: Consumer Protection

This justification predicates that personality rights, if recognised, can operate to prevent the consumers from misleading/deceptive trade practices, false representation of endorsement or manipulative advertisement of low-quality products using big celebrities. As James Treece contends, if publicity (personality) rights are not allowed, the consumers will be unable to distinguish, which products their favourite celebrity have willingly associated himself with and which of the associations have been done without the celebrity consent/authority.⁵⁹⁵ This is particularly concerning, as otherwise, public will be deceived/tricked into engaging with or purchasing the product which falsely presented itself to be in the association with the celebrity they follow or admire. As such, a personality right which ensures that all exploitation of celebrity persona is authorised and therefore, clear of any confusion regarding the association with the product/merchandise/campaign serves to protect consumers.

Conversely, Madow objects to accept consumer protection as a justification for the right.⁵⁹⁶ Maintaining that consumers do not spend the time to participate in the thought process as Treece described, Madow disagreed with the theory that a consumer's choice to purchase is actually affected by the association of celebrity persona; it is also not clear that the rationality of the consumer decision would enhance or be better even if they, for a moment, takes into account such association. He complains, this justification to be using circular reasoning: consumers assume a celebrity's consent to be associated in advertisements because of the law in force and accepted business practices; if these changes and consent of celebrity is no longer needed, there would be no room for assuming voluntary association of celebrities and therefore, no possibility of being misled by use of persona in the promotion of a product or a service. Further to that Black added, this justification can only possibly operate to justify a right that protects the public at large and not a right which serves to protect a celebrity's interest in his/her own persona; consumer protection, from misleading/deception trade practices, can be adequately ensured through other rights, enforced by state itself.⁵⁹⁷

It is well accepted that despite heavy criticisms, these justifications are here to stay and would continue to be featured in any debates for any private property rights like intellectual property and also in the context of personality. It would not be prudent to say these justifications makes no contribution in preparing a strong case for a personality right that this thesis seeks to present, but the potency of the criticisms forwarded cannot be that easily overlooked. Given how strongly some of the proponents of the right has challenged these justifications, it would be safe to presume that the utilities of this justification are comfortably outweighed by its shortcomings and may not ultimately lend the support that was expected.

⁵⁹⁵ James M. Treece, 'Commercial Exploitation of Names, Likenesses, and Personal Histories' (1973) 51 Tex. L. Rev. 637, 647; See also Dreymann (n 575) 691-693.

⁵⁹⁶ Madow (n 59) 228.

⁵⁹⁷ Black (n 47) 101.

3.6: Incoherence and Inconsistency as a Justification:

The social and commercial practice of persona exploitation is widespread, commonplace and the magnitude of it has become unimaginable given the advancement of social media platforms, information technology and web space. Undoubtedly, with the ever so increasing use of persona there is also the tendency to use them without prior authorisation for economic gains as the volume of social and commercial exploitation has, if anything, quadrupling the value of persona even as this very moment.

One cannot argue that the interest in protecting this persona is insignificant or so trivial that it would fail to attract legal and societal consideration for protection – be it for the economic or dignitarian value that it entails. The court in cases like *Irvine* and *Douglas* covertly acknowledged the protection of such interest and the need to safeguard it (but in the guise of other rights). Even Carty, who has indirectly voiced against having a separate right for protecting persona and confided in seeking for an adequate remedy from the existing legal doctrines, affirmed the English court's willingness to protect such interest, by citing cases like *Campbell*,⁵⁹⁸ (although in *Campbell*, the court, somewhat, found a remedy based on privacy/breach of confidence but not in personality *per se*).⁵⁹⁹

De Grandpre, as we have seen already has advanced a strong case for recognising a right grounding it on economic rationales, commented this trend to be seen a 'logical progression' of legal development and how the publicity (personality) has evolved within the last century from being not recognised at all to now being accepted as an 'inalienable' personal right and even as a 'property' in some jurisdictions.⁶⁰⁰ Both Grady and De Grandpre added, the evolution also categorised it as a scarce resource, with the risk of being overused and depleted in value if not protected.

It is also evident from Chapter 2, particularly in the context of UK, that there is a lack of coherent and consistent legal framework to safeguard the interests entailing celebrity persona and the Court's continuous attempt to stretch the existing rights of action in torts, privacy and IP rights to afford protection has failed to adequately and effectively remedied the victims of misappropriation. Such inadequate legal response or rather a lack of response based on ad hoc and fragmented remedies, propels, as Black argued, yet another justification for the recognition of a personality right for the sake of ensuring clarity, coherence and consistency.⁶⁰¹ In acquiescence with Black, the need for coherence serves well and by itself for advocating a separate personality right in the context of UK, which currently does not recognise any such rights but covertly recognises that personality interest needs protection. Interestingly, the concerns of both the proponents and opponents of the right converge on the point that the current personality right regimes available in other jurisdictions is not perfect and

⁵⁹⁸ *Campbell* (n 311).

⁵⁹⁹ Carty (n 61).

⁶⁰⁰ Grandpre (n 415) 78; See also, Black (n 47).

⁶⁰¹ Black (n 47) 103-106.

the piecemeal approach in UK offers extremely unpredictable results; thus, underscoring their common inclination for a consistent and coherent structure of practice.⁶⁰²

This lack of coherence and a systematic structure can be used as an impetus towards introducing a separate standalone right that would reinforce certainty in practice and protection, and channel out the chaos that ensues from the current practice. This would be a rather interesting approach, as Black believes, as concerns of inconsistency and incoherence are usually used by opponents to dissuade or reject the need for a right, but it can be used to advocate for it, instead.⁶⁰³ The opponents can still argue about re-shaping the existing legal remedies to accommodate personality interests, but any rationales advanced would also show the growing significance of persona protection and there is no reason why the same cannot be used in favour of a separate self-sufficient right. Thus, accepting the reality that safeguarding celebrity persona from misappropriation is the '*elephant in the room*' which can no longer be overlooked and that the incoherent nature of legal remedies which are being inconsistently and half-heartedly applied for its protection, a separate, purpose-built personality right should be recognised that orders this chaos and curates such inconsistencies. This justification, grounded on the need to ensure certainty and coherence, fits hand in hand with the economic and dignitarian justifications, and together advances a strong case for a right of personality.

3.7: Personality as a *Property Right*

The rich jurisprudence pertaining to the recognition and safeguarding of persona also predicated the growing traction of positioning or rather classifying persona as a 'property' among the proponents of the right. As Westfall & Landau observed, publicity (personality) rights, which originally gained currency based on functionalist grounds (i.e., commercial reasons), has evolved through formalist reasoning of the courts (particularly in *Haelen*) that publicity (personality) right should acquire all traditional attributes of *property* since some characteristics of property are in-built in one's personality.⁶⁰⁴

Armstrong, who came out to be the most resilient in putting persona in the property footing, underscored how celebrity persona has transformed over the last century from being first taken within the purview of privacy and emotional harm, and then incrementally being seen as a form of property engendering the need for protection.⁶⁰⁵ This shift towards recognising persona as property, as Armstrong contended, actually initiated from *Roberson v. Rochester Folding Box Co.*,⁶⁰⁶ even though in that case compensation was denied for unauthorised use of a young woman's image in an

⁶⁰² Ibid.

⁶⁰³ Ibid.

⁶⁰⁴ Westfall & Landau (n 503) 72-73.

⁶⁰⁵ Armstrong (n 6) 445-452.

⁶⁰⁶ 171 N.Y. 538, 64 N.E. 442 (N.Y. 1902).

advert to sell flour. In this case, the questions of whether the use of celebrity persona (particularly in commercial settings) should be controlled and whether these could have a marketable value, came under significant judicial scrutiny, marking the first positive step towards viewing persona as a property. He extended the theories of Marx and Pashukanis, to justify that as 'land' was transformed into a commercial commodity through historical processes and legal changes, persona too, by similar processes and changes, has been commodified from being something of mere personal or communal value.⁶⁰⁷ Most importantly he underscored that this transformation, in culmination with judicial trend in subsequent cases, has attributed the core elements of 'property' i.e., right to exclude, alienate and transfer, to 'persona' giving it the property effect. What follows (briefly) is how these elements as traditional notions of property have been aligned with persona through theoretical and legal precedents to establish its proprietary nature.

Firstly, the right of personality operates to afford the celebrities with legal means to prevent unauthorised use of their persona; this act of prevention paralleled with traditional property right practices over any tangible goods, as Armstrong says, which affords the owners the right to exclude others from its use. Similar exclusionary notion can be evidenced from cases of *Tom Waits* and *Bette Midler* as the courts upheld their right to control the use of their unique persona, hence stretching the scope of 'exclusion' to intangible elements of personality. Secondly, the right provisions for the transfer, assignment and licensing of persona and thus, underscores its alienability just as any other tangible property like land, artwork etc. Armstrong stressed that the courts were no longer hesitant to accept transferability and alienability of persona, as in *Haelan*, the court affirmed that celebrities could enter into exclusive licensing agreements for the use of their persona by third parties.⁶⁰⁸ *Haelan*, undoubtedly, has laid the foundation for a separate multi-billion dollar world for modern endorsement, merchandising and advertisement bridging celebrity persona with media, huge conglomerates and big brands. Thirdly and by far the most problematic attribution of property feature to persona was with the inheritability/descendibility of persona so that estates of the deceased celebrities can continue to control and profit from that celebrity's persona after death, as they would with any other common properties, like luxury cars or shares in the company. Armstrong observed the difficulty arose as the court, in landmark cases like *Lugosi v. Universal Pictures*⁶⁰⁹ viewed persona as too 'personal' to be inherited by the descendants of celebrities but eventually in cases like *Price v. Hal Roach Studios*,⁶¹⁰ the Court became more amenable in acknowledging that persona could pass to the heirs.⁶¹¹ It was held in *Price*, "*There appears to be no logical reason to terminate this right upon death of the person protected. It is for this*

⁶⁰⁷ Armstrong (n 6) 445-452.

⁶⁰⁸ Armstrong (n 6) 443, 450.

⁶⁰⁹ 25 Cal.3d 813 (Cal. 1979).

⁶¹⁰ 400 F. Supp. 836, 844 (S.D.N.Y. 1975). See also, *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1355 (D.N.J. 1981)

⁶¹¹ Armstrong (n 6) 443, 452.

reason, presumably, that this publicity right has been deemed a 'property right.', thereby, candidly characterising persona as a property.⁶¹²

Interestingly, Neethling has extended his dignity-centric justifications to expand personality rights to offer post-mortem protection. This could be relevant here as his indulgent expansion could be further extended to justify that personality rights should descend and be inheritable. Neethling argued that one's dignity survives the death of that person and the reputation, individuality, identity and integrity, collectively, constitutes this dignity which would still require safeguarding even after his demise. His analysis here is interesting as he accurately highlights the possibility of unwarranted social and/or economic exploitation or misleading media portrayals can retrospectively undermine celebrity's dignity and put the deceased's integrity and individuality in disrepute. This attempt to afford post-mortem protection has been inspired by the German legal regime for personality, which provisions for such postmortem protections based on their constitutional commitment to protect 'dignity'; thus, aligning with the dignity-based justification advanced by Neethling. Similarly, the South African legal regime also recognises the need for post-mortem protection through *actio iniuriarum*, whereby an action can be commenced by the deceased's family members to vindicate the deceased's reputation.

*Martin Luther King Jr's Case*⁶¹³ served as that firsthand example of the benefits reaped due to the court's acceptance of inheritance in the context of personality. In this case, Martin Luther King Jr's persona was trespassed/ misappropriated after his death, even though he never commercialised his persona during in his lifetime. The Court confirmed that 'persona is a property' and whether the same was or was not commercialised or commodified by its owner whilst being alive is irrelevant.⁶¹⁴ The Court further ruled that the deceased celebrity should receive the same levels of protection as he would have enjoyed or has enjoyed whilst being alive and with/without having marketed his persona.

Westfall and Landau commented, referring to the court's trend/attitude in the cases foregoing, that it had adopted 'property syllogism' which is a method of legal reasoning where once a right is found to have any property like characteristic, it should be presumed to have acquired all the others.⁶¹⁵ As such, in the context of persona, as the right would allow its assignability – which is a feature common with existing property rights, property syllogism would confer the rest of the features of property rights, including exclusivity and hereditability to personality. Westfall and Landau highlighted that this formalist approach bypassed deeper policy discussions, such as its utility in terms of social welfare or economic efficiency and instead focused on a

⁶¹² Price (n 610).

⁶¹³ *Martin Luther King, Jr., Center for Social Change Inc. v. American Heritage: Products, Inc.* 296 S.E.2d 697 (Ga. 1982).

⁶¹⁴ Ibid.

⁶¹⁵ Westfall & Landau (n 503) 84.

more rigid and arguably less thoughtful application of property principles to personality rights.⁶¹⁶

To the contrary, Black boldly argued that persona does not fit the famous definition of property given by MacCormick.⁶¹⁷ MacCormick defined property (in his exact wording), as a '*thing*' to be "*conceived as durable objects existing separately from and independently of other objects and of persons, subject to being used, possessed, and enjoyed by persons, and capable of being transferred from one person to another without loss of identity as that very thing*".⁶¹⁸ Any proposition, based on MacCormick's definition, that persona is a property must have the durability, separability and transferability. Black stressed that whilst durability is present while the celebrity is still alive, separability and transferability is not possible, since persona or any indicia therein are not detachable/alienable from one's corporeal body and cannot be transferred without losing the character of the persona itself. Black added, '*The whole notion of persona is so intricately bound up with the individual that to attempt to separate out, and transfer on, the constituent (and intangible) elements of a publicity [personality] right seems hardly possible*'.⁶¹⁹ This inseparability or inalienability also appears to be plausible – particularly because of the position of the proponents who are on the dignity side, as the inalienability and innateness of persona with the individual and therefore its protection, sit at the very core of their argument. By extension of their view, if this innateness is bypassed, persona would amount to a mere commercial commodity – a property- that would only cater for the economic interest at the expense of the dignitarian harm.

In addition, there are other practical problems in accepting persona as a property. Property syllogism in the context of persona meant the usual consequences of property ownership would befall persona. Just as any other property, persona could be then used as a collateral or as a security to debt and in the instance of default, seized to satisfy debt; it may form a part of the individual's estate on bankruptcy. Westfall and Landau, highlighting the Court's uneasiness in accepting this, also remarked that property syllogism is (in reality) problematic in the context of persona, and that persona '*...should not be treated as property for purposes of bankruptcy*'⁶²⁰, ultimately leaving these inevitabilities of property syllogism unaddressed. Court's approach has further convoluted the stability of property syllogism, when it ruled out persona to be a property for the capital gains tax purposes in the case of *Miller v. Comm'r*.⁶²¹

Despite these intriguing doctrinal misfits, this concept has received quite the currency among the proponents (regardless of which side of the divide they fall into) of the right as well. To begin with, De Grandpre stretched his economic justifications to recognise

⁶¹⁶ Ibid.

⁶¹⁷ Gillian Black, "Publicity and Image Rights in Scots Law," (2010) 14(3) Edinburgh Law Review 364, 370-372.

⁶¹⁸ Ibid; See also, Neil MacCormick, *Institutions of Law: An Essay in Legal Theory* (Oxford University Press 2008).

⁶¹⁹ Black (n 617), 370-372

⁶²⁰ Westfall & Landau (n 503) 117.

⁶²¹ 299 F.2d 706 (2d Cir. 1962).

persona as a form of property.⁶²² Although such recognition would have no doctrinal impact on the economic justifications he has given, but, if anything, could strengthen its root more using the core notions of property rights. De Grandre's main inspiration for this property-based approach also followed from *Haelan* just as Armstrong, as seen above. Such recognition, would have the effect of framing the right as an extension of property rights, designed to protect the economic value embedded in a celebrity's persona. He contended that the property-rights approach would also ensure consistency in legal treatment and provide a structure for addressing disputes over misappropriation.

Haemmerli, as aforementioned, explored on how Kantian philosophy can back such a concept of 'property' that includes personal identity, arguing for a kind of "idealism and property" that upholds individual autonomy in advocating for the right.⁶²³ In her lens, Kant's approach to property is deeply tied to one's autonomy and moral agency, as in Kant's view property is not merely about 'possession' but is also about the autonomy of deciding/determining how (and to what extent) that property would be exploited. This essentially meant that owning one's persona is not only about possessing the economic value that is usually perceived to be attached to it (particular in case of celebrities) but also about controlling the expression of that persona to the outside world, such control being fundamental to human dignity. Thus, as she contends, an 'autonomy-based property right' model for persona would afford celebrities the means to control how their persona is presented and prevent others from using it in a way that might undermine their autonomy and self-determination and by analogy, their dignity.⁶²⁴

McCarthy also believes that personality rights can be fundamentally understood by conceptualising it as a natural property right since every individual has an inherent claim over their identity (and by analogy, persona) as a form of 'property'. By famously quoting, '*...my identity is mine – it is my property, to control as I see fit*',⁶²⁵ he asserted strongly that this natural right stems from the principles of justice and fairness which operates to ensure 'control' over one's persona.⁶²⁶ He reiterated that controlling persona should not be treated differently from controlling any other personal property and in doing so favoured the rationale behind the necessity of acknowledging 'control' and 'autonomy' when justifying personality rights. To cement his view, McCarthy drew in the court's recognition of publicity (personality) right as a 'species of intangible personal property in the case of *Tennessee ex rel Elvis Presley International Memorial Foundation v. Crowell*'⁶²⁷.

Even Beverley-Smith identified that justifications of personality right has roots in the natural rights theory based on the Lockean notion of property rights.⁶²⁸ The argument

⁶²² Grandpre (n 415).

⁶²³ Haemmerli (n 543) 423 - 428.

⁶²⁴ Ibid.

⁶²⁵ McCarthy (n 43).

⁶²⁶ Ibid.

⁶²⁷ 733 S.W.2d 89 (1987).

⁶²⁸ Beverley-Smith (n 63).

of the Lockean labour theory does not require separate iteration here but it has been analogised to assert that celebrities should have proprietary rights in their persona, which is they cultivated through effort, skill, or talent; this essentially created a 'natural entitlement' to control and exploit the value of persona for personal gains. The Lockean labour theory, as already seen, is not free from criticisms, which operates to downplay the acceptance of any rationales grounded on it.

To conclude, the case presented in support of justifying personality right as a property right – particularly- through property syllogism, is compelling but not sacrosanct. In so far as an attempt is made to give personality the property effect, this thesis believes, the personality rights should be able to tick all the boxes for a property right and as such, should be accepted to have all the consequences of a property right. It is only fair that if persona gets the much certainty, coherence, and consistency both in theory and practice by way of getting the property effect, it should also have suffered from the downsides of it. It would not be prudent to accept it as a property where it is serving positively, e.g., licensing and misappropriation and not to accept it as so when it is serving negatively as in terms of taxation or bankruptcy. If these loose ends are covered, which is possible through court's proactiveness (which has already achieved the attributing of core characteristics of property to personality), any property effect can fit very well with both the economic and dignitarian dimensions of personality; copyrights, patents and trademarks being particularly good examples of how a property right safeguards both.

3.8: Competing Interests

3.8.1: Public Interest in Creative Expression:

The first public interest, which has been viewed by commentators to limit any right of personality (publicity), is one of creative expression of the public based on celebrity persona. As celebrity persona is seen by proponents like Grady as a socially valuable asset, the variety of its uses range as widely as from satirical and parodical to subversive and political to even as symbolic reference in ensuring human rights by minorities in landmark Supreme Court cases. This makes it clear that the celebrity persona is not detachable from creative expression and is of staggering social importance when it comes to communicating and interacting socially. When this is the case, Madow pointed out that a publicity(personality) right would result in chilling these highly creative expressive uses of already famous people and would transfer the semiotic value of persona to private ownership.⁶²⁹

This chilling effect that Madow highlighted would restrict the diverse use of persona as a subject matter in the media, literature, and in arts. In Hoffman's lens, a publicity(personality) right in effect *"outlaws large areas heretofore deemed*

⁶²⁹ Madow (n 59).

permissible subject matter" for artistic, literary, and expressive works.⁶³⁰ This effectively also meant restrictions in using celebrity persona in fictional and non-fictional works, ultimately narrowing the ability of other creators to cite cultural icons or historical figures in their creative works. This restriction on subject matter would also threaten to impoverish creative/range of free uses and result in authors and filmmakers *"create mythological worlds or characters wholly divorced from reality"* as there are restrictions to freely use the one which exists in real life.⁶³¹ This phenomenon is synonymous with Madow's notion of cultural enclosure, already discussed above, which has been advanced to oppose the right. The restriction that the right is thought to bring about would impede the very creation and communication of meaning and identity which makes it a socially valuable asset. This would also imply that the right would remove the celebrity persona from the rich pool of cultural commons, depriving the public at large of the means to create and communicate meaning, whereas continue to benefit the commercial interest of the celebrities.

Furthermore, the right of persona can also operate to censor investigative (or otherwise) reports and commentaries on the thoughts, lifestyle and conduct of celebrities under the guise of protecting the inherent value of persona. This would not only impede users who seek to comment on or criticise celebrities or prominent individuals but would also risk facing legal actions for engaging in censored activities.⁶³² The mere possibility of a costly litigation could cause media entities, journalists and other commentators to even engage in self-censorship, leading to *"timid, watered-down works"* that fails to engage with controversial or culturally significant public figures.⁶³³ This chilling effect is inevitable as actions under personality right would entail claims for (often significant) monetary damages instead of only injunctive relief. This, in return would suffice to dissuade creators from using celebrities in their works, regardless of its significance and public interest. Any such impediments to access information of public interest and to express one's opinion is also construed to be injurious to Article 10 of the ECHR (freedom of expression) (and also the First Amendment in the context of US). Freedom of Expression is another limitation in the path of personality rights, which shall be dealt in the next section of this Chapter.

Madow, therefore, based on the aforementioned stands corrected when he opined that balancing the rights in persona with the necessity of allowing people to dip into a rich cultural pool, would be the central challenge of introducing the right.⁶³⁴ It is, as such, necessary to seek for factors that can justify the preference of persona over this interest or at least strike a balance between the two.

⁶³⁰ Hoffman (n 483) 125; See also, *Univ. of Notre Dame v. Twentieth Century-Fox Film Corp*, 222 A.D.2d 452, 256 N.Y.S.2d 301.

⁶³¹ Hoffman (n 483) 127; See also, *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352, 358 (1979)

⁶³² See, Hoffman (n 483) 127.

⁶³³ Ibid 126; *Zacchini* (n 175).

⁶³⁴ Madow (n 59).

Hoffman here comes to aid as he suggests beneficial ways of mitigating the conflict of the right with creative uses. Firstly, he paralleled doctrines of publicity (personality) and copyright law, observing that both protects creative expressions rather than ideas. He contended that publicity rights, like copyright, protects a “particular expression” of an individual’s persona.⁶³⁵ From this analogy this can be safely inferred that if any celebrity indicia are not used, fictitious works about a celebrity’s life or a famous sportsperson may not infringe that celebrity’s publicity (personality) rights. This distinction between ideas and expression, as provided by Hoffman, indeed safeguards creative expression by allowing authors and filmmakers to engage in general themes or archetypes without any fear of violating the right. Additionally, as Black suggested, if the use is one of social, subversive or political in nature, it should be considered as a valuable contribution to the society as these are done in public interest and thus should be allowed.⁶³⁶ This allowance can be justified by paralleling it again with the notions of production and reproduction in copyrights. Based on this notion, productive works, (i.e., creating of the persona) is more worthy of protection than reproductive works (like commenting or criticising subversively using the persona); so, the latter should be excused from the stringent application of the right.

In further mitigation, Hoffman ambitiously offers to employ a legal mechanism similar to that of ‘fair use/dealing’ doctrine in the copyright law. Adopting a “fair use/dealing” limitation on publicity (personality) rights would allow certain uses of a celebrity persona to be deemed permissible, even in the absence of prior consent or compensation.⁶³⁷ This exception would necessitate courts to consider the purpose of the use, the nature of the protected persona, the extent and utility of the use, and finally, the effect of the use on the value of persona and its marketability. By incorporating these factors into right of publicity (personality) analysis, courts could better balance the interests of famous persons and general public.

Although it might be tempting to invest into striking a balance between the public interest in creative expression and a personality right through defences/exceptions like fair use and reproductive expressions, such interest should not be invigorated at the expense of the personality right itself, as Coombe warned.⁶³⁸ It must be also noted that such cultural communication is only possible when there is a right that allows persona to prosper and remain in the public domain without any misappropriation or misuse. So, the right of cultural communication is non-existent absent the antecedent recognition of a personality right. This public interest, following Black’s articulation, seems to be more of a subsequent right which can operate to maintain check and balance with the monopoly that personality rights risks creating, rather than a counter veiling right that can limit or impede the recognition of personality rights.

⁶³⁵ Hoffman (n 483) 126-127.

⁶³⁶ Black (n 47) 140-141.

⁶³⁷ Hoffman (n 483) 133.

⁶³⁸ Coombe (n 418).

3.8.2: Public Interest in Freedom of Expression:

Article 10 of the European Convention on Human Rights operate to provide a right to freely hold and express one's speech or opinions. It also includes the right to receive and impart information. Similar constitutional rights have been afforded in the First Amendment of the US Constitution. These rights are often found to be in crossroads with the right of persona (publicity), which may operate to restrict the public to use celebrity persona in their own expressions, speech, or opinions.

Madow highlighted the inevitable conflict of a personality right with the right of freedom of expression using the *Gay Olympic Case*.⁶³⁹ In response, Pinckaers has suggested the need to strike a balance between the two competing rights, as one cannot be preferred at the expense of the other.⁶⁴⁰ McCarthy also observed that striking balance between fundamental rights like Article 10 with private rights like publicity (personality) is something the US and European courts are well versed with, essentially meaning that the balancing exercise will be least critical/difficult in the context of personality rights. Article 10(2) itself, provisions for its own restriction in application by recognising the need to accommodate the 'rights of others'. Black here draws the analogy of copyrights being the 'right of others' which operates to safeguard the original work of the creator from unauthorised use and therefore, interfere with the freedom of expression of others.⁶⁴¹ Just as freedom of expression is allowed over copyrights when no adequate alternative means of expression exists other than the copyrighted creative work, use of celebrity persona should be allowed when a particular speech/expression cannot be achieved without the use of that particular celebrity persona. This can be one way of attaining the balance, as otherwise without the balance, personality rights would outweigh substantial expression rights and free speech.

Whilst a balance is necessary for the said reasons, caution needs to be exercised so that misleading or untruthful expression using persona are not allowed to slip through the balancing mechanism under the guise of freedom of expression, as seen in the case of *Irvine* (a doctored image was misleadingly used).⁶⁴² A better example of this balance was seen in *Campbell*⁶⁴³ where the Defendant's publication (except the treatment details) to correct a misleading impression given by the Claimant qualified as a freedom of expression.

In addition to this, Hoffman identified that 'public interest' can serve in achieving the balance between the competing rights. As a balancing mechanism, Hoffman brought forward the notion of "mere merchandise," like bubble gum, cards and posters that uses celebrity's persona in purely commercial context as opposed to instrument of creative expression like books, films or subversive/political documentaries;⁶⁴⁴ the

⁶³⁹ Madow (n 59) 142.

⁶⁴⁰ Pinckaers (n 2).

⁶⁴¹ Black (n 47) 136.

⁶⁴² Irvine (n 126).

⁶⁴³ *Campbell* (n 311).

⁶⁴⁴ Hoffman (n 483) 115.

former being less likely to be exempted as Article 10 rights (or under the First Amendment in the context of US) unlike the latter which may contribute to serve legitimate public interest. So, aligning with Hoffman's view, those expressions which are made in the public interest should be allowed in order to further bolster the balance.

Hoffman further highlighted, in context of First Amendment which emphasised on the public's right to receive and impart information (in the same way as Article 10), that the public has an *"important interest to be served in free and uninhibited expression in all channels of public information"*.⁶⁴⁵ He stresses that the First Amendment (and so does Article 10) protects not only the right to speak but also the right to hear, view, and engage with that speech. This dualistic approach, as Hoffman continued, in the First Amendment cemented the contention that publicity (personality) rights may have to be curtailed to achieve a balance if it conflicts with the public's ability to access information, creative and journalistic works.

To sum up, Article 10 freedom of expression and rights alike have been given high regard in their respective frameworks, but it is also the case that such rights are not to trump other rights completely. Had this been the case, there would be no provisions like Article 10(2) that recognised the existence of other rights, which may necessitate striking a balance – just as in the case of personality rights. The right to freedom of expression is indeed a working limitation to any right of personality, being 'entrenched' in their respective jurisdictions, but a balancing mechanism would be sufficient to hold it off, and if anything, it is not necessarily that potent to choke up the path for recognising personality rights in the UK.

3.9: Conclusion

The aim of this Chapter was to explore the justifications that have been advanced through the vast academic jurisprudence and implied from court's dealing of cases relating to unauthorised use or misappropriation of persona. This chapter began with the most highlighted justification of economic interest and went on to find out that dignity interest equally thrusts for the recognition of a personality right. The commonly advanced traditional justifications were also looked at and discovered that it has little to offer in the uphill clamber of recognising the right but would still be featured in the ongoing debates for recognition, due to its convenient and incidental nature. The chapter acknowledged that only the economic and dignitarian justifications could remain, which are also not sacrosanct and considered the rebuttals to the criticisms raised. It was accepted, as Beverley-Smith has warned, an over-emphasis on dignity would only result in a *solatium* being received despite sustaining significant harm to reputation and public image from unauthorised use; conversely, an over-emphasis on the economic angle would enable compensation for the profits lost but would risk limiting the communication of persona and any injury to reputation or public image will

⁶⁴⁵ Ibid 125.

remain unaccounted for. So, this chapter attempted to convince that an integrated model that accounts for both is necessary and is also achievable given the key overlap(s) between these interests. The need for ensuring consistency and coherence was also advanced as another justification drawing support from the vacuum created by inconsistent, fragmented, piecemeal and ad-hoc means of protection available in the UK, as shown in Chapter 2. The possibilities of allowing personality rights to have effects of property rights was also considered and found that argument in favour is interesting and thriving. Finally, this Chapter considered the potential limitations to the right when one will be introduced, and explored the means of attaining a balance with those limitations or competing interests. For clarity, the aim of this thesis is to present a compelling case for introducing a personality right in the UK – an aim which cannot progress or be fulfilled without exploring the justifications that may underpin the right and its plausibility. Now that the plausibility of the underlying rationales has been tested, the thesis can move towards the analysis of similar rights that have been introduced (and are in force) in other jurisdictions.

CHAPTER - 4

4.1: Introduction

The previous chapters have endeavoured to paint the picture that celebrity persona is a highly commercialised commodity, which unfortunately is not protected in the UK, but such protection is needed for both economic and non-economic reasons. Given the increased number of countries that has embraced such personality rights/protective measures in their legal systems, its global recognition and universal application are both inevitable and imminent. As such, before a right of personality model(s) can be proposed for the UK in the next Chapter, it is imperative, at this juncture of the thesis, to observe how such rights have been adopted in other jurisdictions.

The aim of this Chapter is simple. It will undertake a thorough examination of various forms of personality rights and/or protective mechanisms that are available in other jurisdictions, including both in common law and civilian law systems. As to the selection of jurisdictions in the common law category, USA has been selected, since it has been the trendsetter in the field of such rights, offering protection much earlier in the relevant timeline. Canada has also been selected because, it is, quite interestingly, a hybrid of US and UK approach; and Australia, as it completely mirrored the UK's piecemeal basis of protection. In terms of the civil law countries, although options were many since a lot of European countries have recognised personality rights, selection of the jurisdictions were primary based on the nature of the right/protection introduced and availability of analysable jurisprudence (particular pertaining to celebrity persona). Germany and Italy have been chosen since they have recognised a standalone right in their jurisdictions. France, Spain, Norway, Sweden & Netherlands have been chosen since they recognised other rights to provide similar protection and have a significant body of jurisprudence involving celebrity personality concerns.

The analysis of these jurisdictions will commonly focus on the nature of the right, its legal basis, scope of application, qualifying threshold, likely exceptions and its descendibility/inheritability postmortem. The analysis will also include a thorough evaluation of the case precedents that has shaped the rights in the concerned jurisdictions. Whilst a vastness of case jurisprudence is expected but emphasis would be placed on the landmark cases only, and prominently on those that involved celebrities. This overall evaluative exercise would attempt to triangulate the true effectiveness and adequacy of protections offered and highlight any potential limitations, including those aspects of the right that remains unsettled. Most importantly, the analysis would reveal how other countries have struck a balance between such rights and their version of freedom of expression/public interests. A part of this exercise will also include a comparative analysis of the jurisdictions that will be discussed, the purpose being to take the best out of them and arrange it in a way so that a best possible model for personality rights can be recommended for the UK in

the next Chapter. To make the comparison more definitive, the jurisdictions will be compared on the basis of the scope, foundational clarity, width of application and postmortem descendibility of the rights those jurisdictions have introduced. The individual study of the jurisdictions and the comparative analysis would showcase the practical application of personality rights in the context of celebrities, whether the rights are truly apt to protect both the economic and non-economic facets of their persona (as defined in Chapter 3) and finally, portray how much far behind UK remains in recognising the commercial reality of celebrity persona and according protection to it. This Chapter, as such, will also lay the foundation for the next Chapter, where likely models for a personality right for the UK will be pitched, by generating ideas from the jurisdictions discussed.

4.2: Common Law Jurisdictions

4.2.1: USA

In the US legal system, there is no federal right of publicity. Instead, individual states provide for a right of publicity, either through statute or at common law. At present nearly 38 US states have recognized some form of publicity rights at common law and the 25 states have also introduced right of publicity legislations.⁶⁴⁶ The right, however, is largely the same in essence, varying on issues like prohibited use, descendibility and duration of postmortem right. For the purpose of these thesis, the right in general will be first analysed – starting from its source in privacy, to its scope, qualifying factors, prohibited uses, descendibility and finally, the recognised exceptions to the right. Although it would be tempting to carry out the analysis of the right on a state-by-state basis, but focus will be kept on two particular states, namely California, as it offers the broadest possible model of publicity protection compared to the other states, and New York, since majority of the relevant jurisprudence is from that particular legal system.

Nonetheless, protection to publicity or personality rights is also available through other legal doctrines enshrined in the federal legislation, namely the Lanham Act. This route has proved to be quite popular among celebrities by producing several favourable outcomes, but it has problems of its own. The protection available under the Lanham Act will be also explored, although briefly, and then the question of whether the celebrities are offered effective protection in the US will be settled.

4.2.1(a) *Right of Publicity, in General:*

The right of publicity in the US has its origin in the US right of privacy and has been influenced to a significant extent by other areas of law namely defamation, copyrights, trademark, misappropriation and false advertising.⁶⁴⁷ The conceptual inception of the

⁶⁴⁶ See, 'Right of Publicity Statutes & Interactive Map - Right of Publicity' (Right of Publicity, January 4, 2024) <<https://rightofpublicity.com/statutes>> accessed 06 January 2025.

⁶⁴⁷ McCarthy (n 44).

right of privacy we see today in the US was from the seminal work of Samuel Warren and Louis Brandeis in the late 1800s⁶⁴⁸ and was first recognised in *Pavesich v. New England Life Ins. Co*⁶⁴⁹ by the Georgian Supreme Court. Following recognition, the subsequent courts in other states started to apply the right and it became incorporated in the common law.⁶⁵⁰ The right of privacy was then significantly influenced by the seminal work of William Prosser, who defined the right, breaking it down into four different torts.⁶⁵¹ Prosser's work brought in new dimensions to the right and the schematics of the right he provided was adopted universally by US courts and was subsequently adopted fully in the Second Restatement of Tort 1977 (Articles 625A – 652I). The 4 torts categorisation of the right by Prosser, included appropriation of one's name or likeness as an intrusion to one's privacy and as such, softly recognising the protection of one's personality. The right of privacy, which was by then, fully recognised within the legal system, operated to safeguard dignity and personal feelings of individuals and not the economic interest they may have embedded in their persona, despite recognising appropriation of it as a tort.⁶⁵² The right was applied as a right to be 'left alone' in its strictest sense.⁶⁵³ As such, its application was difficult in cases involving celebrities, where their claims were about protecting the value of their persona from the appropriation for commercial use and not to be 'left alone' *per se*. The misfitting nature of privacy rights was apparent in *O'Brien v. Pabst Sales Co*⁶⁵⁴, where a famous footballer's photograph was used without his consent in an advertisement by a beer company. Looking through the lens of privacy, the Court founded against the footballer, and it was held that the footballer being 'famous,' was not a private person. By constantly seeking for more fame and publicity, he has in fact surrendered his privacy and the complained use has actually contributed to the publicity he so wanted. In dissenting to this ruling, Holmes J⁶⁵⁵, covertly suggested of a property right in one's name and image to be used in commercial ventures and of a claim, if that right is infringed by misappropriation, and hence alluding to the need for a right that safeguards such commercial values in one's persona, which the privacy rights fail to protect.

It was these inability/difficulties in aligning with right of privacy, a right that prohibits unauthorised commercial exploitation of one's persona (particularly of celebrities) that ultimately led to the development of the separate right, namely the right of publicity in the US.⁶⁵⁶ The right was first formally acknowledged in *Haelen Laboratories Inc. v Topps Chewing Gum Inc.*⁶⁵⁷, where one chewing gum manufacturer claimed against a rival manufacturer when the latter wanted to use a photograph of a famous baseball player who has already granted exclusive rights of his image to the former.

⁶⁴⁸ Samuel D. Warren & William Brandeis, 'The Right to Privacy' (1890) 4 Harv. L. Rev. 193.

⁶⁴⁹ (1905) 122 Ga. 190, 50 S.E. 68.

⁶⁵⁰ McCarthy (n 44).

⁶⁵¹ Prosser (n 37).

⁶⁵² See, Article 652H of the Restatement (Second) of Torts 1977; See also, McCarthy (n 44)

⁶⁵³ Warren & Brandeis (n 648).

⁶⁵⁴ 124 F.2d 167 (5th Cir. 1941).

⁶⁵⁵ *Ibid*, at para 170

⁶⁵⁶ Beverley-smith (n 290) 53.

⁶⁵⁷ 202 F 2d 866 (2nd Cir 1953).

Unsurprisingly, the right of privacy could not serve the basis of this claim, since the privacy rights are considered personal and therefore, unassignable. The Court however, acknowledged that famous individuals have a right in the publicity value of their persona, which is independent of their privacy rights, and that, these people often suffer no injury to feelings from the unauthorised use of their persona, but suffer losses from not receiving license fees or remuneration for such use.⁶⁵⁸ In acknowledging so, Frank J circumvented the problem caused by the inability of the right of privacy to recognise the commercial appropriation and coined a separate and distinct 'right of publicity' to make up for this problem. Frank J argued that this right will safeguard a person against unauthorised commercial appropriation of his persona and would also allow the transferability and/or assignability of the right to third parties.⁶⁵⁹ *Haelen's* ruling and the new right of publicity created mixed reaction among the contemporary scholars and commentators. Nimmer lauded the formulation of the new right and drew emphasis to the deficiencies of the right of privacy that justified the finding of it, and advocated for its implementation and adoption throughout the legal system.⁶⁶⁰ Bloustein concurred with Frank J's view as he argued for a separate right outside privacy to cater for such circumstances.⁶⁶¹ Prosser on the other hand argued that such protection was available under the forth limb of his tortious classification of privacy, which has been adopted in the Restatement (second) of the Torts 1977.⁶⁶²

The right of publicity was subsequently considered in *Hogan v A.S. Barnes & Co Inc*⁶⁶³, where the court asserted that the right was actually serving the unfair competition doctrine but under a different label, constituting no separate cause of action. Although this case and subsequent others, as Berkman analysed, showcased the reluctance of the court (initially) to adopt the right as a separate cause of action, they did recognise impliedly/indirectly that the right was separate from that of privacy.⁶⁶⁴ McCarthy added, the right was initially conceived to function on the basis of the misappropriation doctrine recognised in the US legal system, but the right is much more than such an 'amorphous' doctrine, having been developed and structured into a distinct intellectual property right.⁶⁶⁵

Furthermore, the existence of the right was confirmed by the Supreme Court in the case of *Zacchini v Scripps-Howard Broadcasting Co.*⁶⁶⁶ In this case, the unauthorised use/publication of the 'human cannon ball' act of the famous performer, Hugo Zacchini, in the news was found to infringe the performer's right of publicity. The ruling was

⁶⁵⁸ Ibid.

⁶⁵⁹ Ibid.

⁶⁶⁰ Nimmer (n 157); See also, 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, 455.

⁶⁶¹ Edward J. Bloustein, 'Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser' (1964) 39 N.Y.U.L.R. , 962, 971.

⁶⁶² Prosser (n 37) 388.

⁶⁶³ 114 USPQ 314 (Pa. Comm. Pl. 1957).

⁶⁶⁴ Howard Berkman, 'The Right of Publicity – Protection for Public Figures and Celebrities' (1976) 42 Brook L Rev, 527, 537; See also, *Palmer v Schonhorn Enterprises Inc.* (1967) 232 A 2d 458.

⁶⁶⁵ McCarthy (n 44).

⁶⁶⁶ *Zacchini* (n 175).

significant as it drew a clear distinction between publicity and privacy rights and in doing so, prominently clarified the purpose and rationale for a separate right of publicity. The Court confirmed that Zacchini's claim under publicity is based on the need to be compensated for the skill, effort and time that he has invested in the cannonball act and such safeguarding would operate as an economic incentive for Zacchini to excel in his field and provide more performances⁶⁶⁷. As such, at the core, the right of publicity protects the proprietary interest/right of celebrities to reap the fruit of his endeavours – just as under copyrights and patents, and not prevent injury to feelings or reputation that privacy rights protected.⁶⁶⁸ In Zacchini, the court also borrowed Kalven's justification of preventing unjust enrichment in respect of the appropriation limb of privacy rights, in that, the court concurred there being no social benefit in allowing the appropriator to freeride on a celebrity persona which has a market value and which the appropriator would usually have to pay to use.⁶⁶⁹ This adoption was particularly relevant as in Zacchini the court had to answer the competing interest in news-reporting under the First Amendment of the US Constitution, which is a likely defence to the right and will be discussed later. Nonetheless, with Supreme Court's stamp of recognition on the right and with its assertion of the right's purpose, the right finally grew out of the shadows of privacy and emerged as a separate and distinct right of its own, and ultimately, got its foothold and further recognition in the Restatement (Third) of Unfair Competition 1995 (sections 46-49).

So based on the existing jurisprudence and the stipulations of the Restatement, liability under the right arises whenever, the commercial value of a celebrity personality is appropriated by exploiting without consent, the celebrity's name, likeness or any other indicia of his persona. Therefore, liability is not dependent on misrepresentation or proof of deception or public confusion, as required under the tort of passing off in the UK (and also in Australia) but purely on misappropriation, just as the tort of appropriation introduced in the provinces of Canada (to be seen).⁶⁷⁰ This was confirmed in *White v. Samsung*⁶⁷¹, where the Court reiterated that liability will be established regardless of whether the consumers were deceived or misled into believe that Vanna White is associated with or has endorsed the product. Also unlike the English tort of passing off, object of protection is not the trading or promotional goodwill of the celebrity - as seen in *Irvine* - but the inherent value of the famous persona.⁶⁷² As the object of protection is the intangible value of the persona, no proof of prior exploitation of persona is required as a condition precedent for liability under the right; so the threshold is relatively low and effectively means that the lesser celebrities or

⁶⁶⁷ Ibid, at 572.

⁶⁶⁸ Ibid at 573; See also M. Madow (n 59) 125, 181-182; C. Fernandez, 'The Right of Publicity' (1998) 8 Marquette Sports Law Journal 289.

⁶⁶⁹ *Zacchini* (n 175), 574; See also H. Kalven, 'Privacy in Tort Law: Were Warren and Brandeis Wrong?' (1966) 31 ContProbl 326, 331.

⁶⁷⁰ *Rogers v Grimaldi* (1989) 875 F 2d 994 (2nd Cir. 1989)1003-1004; D. Bedingfield, 'Privacy or publicity? The enduring confusion surrounding the American tort of privacy', (1992) 55 Modern Law Review 108, 109.

⁶⁷¹ *White* (n 282).

⁶⁷² S. Boyd, 'Does English Law recognise the concept of an image or personality right?', (2002) 13(1) Entertainment Law Review 1.

new comers who are yet to exploit their persona in commercial ventures would also qualify for the right.⁶⁷³

Further, to establish liability the celebrity in question must be identifiable from the unauthorised use of his persona. Such a test of identifiability mirrors with that of similar rights or cause of action available in other common law states and in the European jurisdictions (to be discussed below).⁶⁷⁴ Clarity on the issue of identifiability is further provided in the Restatement⁶⁷⁵, in that, the name must be (mis)used in a way that the public can connect/relate the celebrity from the use. In terms of using celebrity likeness, there must be such elements present in the use from which the public could reasonably identify/recognise the celebrity depicted. The test of identifiability was again reaffirmed in *White*, where the court held that liability will be established as soon as the unauthorised use of persona makes the celebrity sufficiently identifiable.⁶⁷⁶ Further building on this premise, liability is unlikely where an unrecognisable body part of a celebrity is used for commercial exploitation.⁶⁷⁷ However, if the well-known eyes of Scarlett Johansson is appropriated to advertise eye makeup and similar accessories, the use may fall within the ambit of the right as long as Scarlett is recognisable from the pair of eyes used.

In addition to the usual forms of appropriation of celebrity names and likeness, the right also recognises that celebrity persona can be appropriated through exploiting celebrity nicknames⁶⁷⁸, voice⁶⁷⁹, distinctive catch-phrase⁶⁸⁰, unique characteristics and even some of the indicia of personality which are vague in nature, such as distinctive hairstyle, dressing and pose.⁶⁸¹ In cases like *Carson v Here's Johnny Portable Toilets*⁶⁸² (where, Johny Carson's famous catch-phrase was used without consent) and *Motschenbacher v R.J. Reynolds Tobacco Co*⁶⁸³ (where the distinct marking of race car was used without consent), the Court found breach of the right, despite these cases involving unconventional indicia of persona, but only because the relevant celebrities were identifiable from those unconventional characteristics. The right also covers use of look-alikes⁶⁸⁴ and sound-alikes⁶⁸⁵, once again proving the broad ambit of protection for celebrities. Furthermore, liability would also depend on the proof that the impugned exploitation was unconsented, and that the exploitation

⁶⁷³ *Palmer v Schonhorn Enterprises Inc.* (1967) 232 A 2d 458 (1967); *Grant v Esquire Inc.* 367 F Supp 876 (SDNY 1973); See contrasting views in *dicta* of *Lerman v Chuckleberry Publishing Inc.* 521 F Supp. 228 (SDNY 1981), at 232

⁶⁷⁴ *Motschenbacher v R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), 826-827; *Waits* (n 282);

⁶⁷⁵ Restatement (Third) of Unfair Competition 1995, Section 46(d)

⁶⁷⁶ *McCarthy* (n 44)

⁶⁷⁷ *Prosser* (n 37).

⁶⁷⁸ *Hirsch v S.C. Johnson & Sons Inc.* (1979) NW 2d 129, 137.

⁶⁷⁹ *Waits* (n 280).

⁶⁸⁰ *Carson v Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983).

⁶⁸¹ *White* (n 282).

⁶⁸² *Carson* (n 680).

⁶⁸³ 498 F.2d 821 (9th Cir. 1974).

⁶⁸⁴ *White* (n 282).

⁶⁸⁵ See, *Midler* (n 279); *Waits* (n 280).

resulted in damage of economic nature.⁶⁸⁶ However, goodwill does not appear to fall within the subject matter of protection under the right. Indeed, celebrity persona encompasses goodwill, reputation, dignity, which are the 'non-economic values' in addition to the commercial interest, which are the economic values (as seen in Chapter 3). The right of publicity has been formulated to strictly safeguard the economic aspects of the persona from misappropriation and not the non-economic aspects.

Once liability is established, subject to the allowed exceptions/defences (discussed below), the plaintiff celebrity may be awarded damages to cover the pecuniary losses he suffered (e.g., loss of licencing fees and/or loss of market use) and/or to cover for the pecuniary gains made by the exploiter (i.e., profits or economic gains made from the unauthorised use).⁶⁸⁷ As per the wording of the Restatement, the plaintiff celebrity may claim for both forms of damages, but may only recover the greater of the two in order to prevent double recovery.⁶⁸⁸ In any event, the plaintiff celebrities are not required to establish financial losses as a prerequisite of the right, but in absence of any specific losses, the award of damage may be nominal.⁶⁸⁹ Owing to the fact that quantification of the exact loss of the celebrity or the gains of the exploiter is a difficult exercise, the court often calculates the lost license fees by applying the fair market value.⁶⁹⁰ Other remedies in restitution also include account of the exploiter's profits or punitive damages where appropriate.⁶⁹¹ Overall, the level of compensation awarded are considerably higher in the US than that is offered compared to other jurisdictions, (like Germany, which has introduced a general right of personality, encompassing both privacy and publicity, but damages awarded are often nominal) and certainly more than it is in the UK, which currently recognises no such rights, be it explicitly or implicitly. Placing *Irvine's* compensation of £25000.00 with *Vanna White's* \$430,000, *Bette Midler's* \$400,000 and *Tom Wait's* \$2.5million, clearly illustrates this position.

In terms of the descendibility, despite being a spin-off from the right of privacy, the right of publicity has established itself as a separate property right and as such, it is descendible/inheritable.⁶⁹² As the right of publicity is not a federal right, but a state provided right, the duration and descendibility of post-mortem rights varies from the state to state. Some states like Georgia, New Jersey, Tennessee has provided for descendibility under the common law regime; states like California & New York have done it through their statutory regime. Some states are still in the process of determining the descendibility of the right. Invariably, all the states allowing descendibility to the right were required to balance the postmortem rights with the competing interests/exceptions in the First Amendment as well.

⁶⁸⁶ See also, Grandpre (n 415) 80; Claire E. Gorman, 'Publicity and privacy rights: Evening out the playing field for celebrities and private citizens in the modern game of mass media' (2004) 53 DePaul L. Rev. 1247, 1249.

⁶⁸⁷ *Comedy III Prods. v. Gary Saderup, Inc* (Apr. 30th 2001) 2001 Cal LEXIS 2609.

⁶⁸⁸ T. Catanzariti, 'Swimmers, Surfers and Sue Smith – Personality rights in Australia,' (2002) 13(7) Ent L.R., 135.

⁶⁸⁹ *Zim v Western Publishing Co.* (1978) 573 F 2d 1318 (5th Cir CA) at 1327.

⁶⁹⁰ *Ibid*; See also, *Cher* (n 36).

⁶⁹¹ *Waits* (n 280).

⁶⁹² T. Terrell, and J. Smith, 'Publicity, Liberty and Intellectual Property: A Conceptual and Economic Analysis of the Inheritability Issue' (1985) 34 Emory LJ, 1; P. Fletcher, and E. Rubin, 'The Descendibility of the Right of Publicity: Is There Commercial Life After Death?' (1980) 89 Yale LJ 1125.

4.2.1(a)(i) Exceptions/Defences to the Right:

The right, however, does not prohibit all forms/types of unauthorised use of celebrity persona; it prevents commercial (mis)uses only since the right is devised to safeguard the economic value of celebrity persona. So, by analogy, general or candid uses of persona, like sharing or uploading photos of celebrities on social media platforms like Instagram, Snapchat, Facebook, etc, will not be detected by the right, unless there is a commercial purpose behind the use. Most significantly, the defence to the right of privacy, as enshrined in the First Amendment of the US Constitution also applies to the right of publicity. In that, uses of celebrity persona that serves the right of freedom of expression and/or legitimate public interest through news-reporting, political speech, even speech in the guise of entertainment would be allowed by the right;⁶⁹³ but such exceptions will not apply if it is a commercial speech or is a commercial advertisement in disguise.⁶⁹⁴ So, by analogy, the news that uses the celebrity persona without consent and is claimed to serve public interest, the story present in the news must have a reasonable connection with the celebrity concerned. The celebrity needs to be the subject matter and not merely a part of the main story and cannot be the vehicle to attract more readers or increase public appeal to maximise sales. The court is, therefore, required to balance the publicity rights of the celebrities with the right of freedom of speech of the exploiter/public interest in the use, before determining liability.⁶⁹⁵ In *Hoffman v Capital Cities/ABC Inc*⁶⁹⁶, the use of the actor Dustin Hoffman's photograph in the character of his film 'Tootsie' in a magazine was allowed, as the court was convinced that use was a non-commercial speech and as such, exempted under the First Amendment.

Further by extension, the First Amendment also allows uses for purely entertainment purposes unless it does not amount to an advertisement in disguise. This is well illustrated in *Rogers v Grimaldi*⁶⁹⁷, where the use of a celebrity's first name in the title of a film, without consent, did not breach that celebrity's publicity rights. The court was convinced that it was not an advertisement in disguise and by referring to the First Amendment held that the use was purely for entertainment purposes. In another case, *Comedy III Prods. v. Gary Saderup, Inc.*⁶⁹⁸, the court was faced with question of whether a charcoal depiction of the Three Stooges sold on lithographs and T-shirts, will constitute a newsworthy use and hence immune from liability under the First Amendment. The court ruled that for such uses to qualify as a defence, it must sufficiently 'transform' by using creative elements, the subject matter into something more than mere imitation or caricature of the celebrity.⁶⁹⁹ The court in *Winter v. DC*

⁶⁹³ See, T. Jackson, 'How Far Is Too Far? The Extension of the Right of Publicity to a Form of Intellectual Property' Comparable to Trademark/Copyright' (2004) 6 Tul. J. Tech. & Intell. Prop. 181;

⁶⁹⁴ Colin R. Munro, 'The Value of Commercial Speech' (2003) 62(1) Cambridge Law Journal, 134. See also, *Ohralik v. Ohio State Bar Association* (1978) 436 US 447, 456; See also, *Jordan v Jewel Food Stores Inc.*, 743 F.3d 509 (7th Cir. 2014);

⁶⁹⁵ J. Tabach-Bank, 'Missing the right of publicity boat: How Tyne v Time Warner Entertainment Co. threatens to "Sink" the First Amendment.' (2004) 24(2) Loy.L.A.Ent.L.Rev. 247.

⁶⁹⁶ 255 F.3d 1180, 1183 (9th Cir. 2001).

⁶⁹⁷ *Rogers v Grimaldi* (1989) 875 F.2d 994 (2nd Cir. 1989).

⁶⁹⁸ *Comedy III* (n 687).

⁶⁹⁹ *Ibid*, at para 1.

*Comic*⁷⁰⁰ found the depiction of two famous musicians as ‘half-man, half-worm’ in an comic book, to be transformative and therefore, the use, in question, qualified for the defence. Likewise, uses of celebrity persona for the purposes of parody, lampoon, unauthorised biography, discussion/commentary of celebrity lives, and any other expressive uses may be exempted under the First Amendment.⁷⁰¹ The right has not been designed to censor criticisms or comments and also not to control what enters the public domain but to ensure that the commercial value of the persona is not appropriated.

4.2.1(a)(ii) The Californian version of the Right:

In the state of California, right of publicity is offered both in statute and common law and arguably offers the most protective version of the right in the country to the celebrities.⁷⁰² Given California is the home of Hollywood, such a pro-celebrity right was anticipated and fitting. The Californian Civil Code warrants that to establish liability under the right, there must be a knowing use of celebrity persona for advertising purposes and there must a direct link between the unauthorised use and the commercial purpose.⁷⁰³ Although, the Californian statutory right may seem to be restrictive, being limited to only advertising uses, the common law version is not, since it finds all types/forms of unauthorised use of celebrity persona as actionable (subject to the exceptions above).⁷⁰⁴ Unlike in New York, both the statutory and common law version of the right protects all aspects/indicia of celebrity persona and not just the traditional indicia of name and image. Interestingly, however the Californian Civil Code, rejected to protect a celebrity’s voice in *Midler v. Ford Motor Co*⁷⁰⁵ where a sound-alike of Bette Midler was used in the Defendant’s commercials; but such use was caught under the common law version of the right and Better Midler was successful in this claim. Subsequently in *White*, it was re-affirmed that appropriation of any identifiable aspects of celebrity persona will be actionable, when the use of a robot dressing like Vanna White was held to be breach of Vanna’s publicity rights under the common law. Given such extreme application of the common law version, there is no doubt that unauthorised uses of unique characteristics of celebrity persona like catch-phrases (as seen in *Carson v. Here’s Johnny Portable Toilets, Inc.*) or distinct marking of race car (as seen in *Motschenbacher v. R.J Reynolds Tobacco Co*) will be caught under the Californian common law version of the right. A fairly recent example of this is the case of *Hilton v Hallmark Cards*⁷⁰⁶, where the unauthorised use of Paris Hilton’s likeness and her famous catch-phrase ‘*that’s hot*’ from the famous TV series, ‘The Simple Life’ was found to infringe Paris’ publicity rights under the Californian common law. The Californian version of the right is also subjected to

⁷⁰⁰ (2003) 30 Cal. 4th 881.

⁷⁰¹ J. Brown, ‘Defending the Right of Publicity: A Natural Rights Perspective’, (2005) 10 Intell. Prop. L. Bull. 131.

⁷⁰² Ellen (n 378) 208.

⁷⁰³ California Civil Code, Article 3344.

⁷⁰⁴ *White* (n 282).

⁷⁰⁵ *Midler* (n 279).

⁷⁰⁶ 599 F.3d 894(9th Cir. 2010).

general defences allowed under the First Amendment of US Constitution as discussed above. In terms of descendibility of the right, in California, the right is protected for 70 years post-mortem.⁷⁰⁷

4.2.1(a)(iii) The New York version of the Right:

In contrast to California, the New York model of right of publicity is slightly restrictive in its application. The New York version is based on statute and remains grounded on privacy; any claim of breach, therefore, needs to satisfy section 50 and 51 of the New York Civil Rights Law. In this model, the protection is limited only to celebrity name, portrait, picture or voice, and other indicia of persona are not recognised for protection.⁷⁰⁸ In *Lombardo v. Doyle, Dane & Bernbach*⁷⁰⁹, the imitative use of the famous singer Lombardo was not found to breach the singer's publicity rights under the statute and court reiterated that the relevant provisions of the statute will be strictly construed and not to be interpreted to include what it does not expressly include. In *Onassis v. Christian Dior*⁷¹⁰, the New York Supreme Court confirmed that other indicia of celebrity persona except for name, portrait, picture or voice, are not accorded protection. However, the use of a look-alike of Jacqueline Onassis in this claim was found to be in breach of the right as the court viewed such use to create an impression of Jacqueline appearing in the commercial. Likewise, the requirement of such impression or illusion from the unauthorised use for the purpose of establishing liability was also seen in *Allen v. National Video, Inc.*⁷¹¹ So it appears, that such an illusion/impression, therefore, depends on the presentation of the look-alike, in that, if the look-alike is indistinguishable from the real celebrity, liability may accrue following these cases. Nevertheless, unlike California, appropriation of unique dressing style, hair style or famous catch-phrases will not be actionable under the New York model of the right. This makes the right restrictive in its application since it cannot protect every aspect of celebrity persona, which may entail equal, if not more, commercial value compared to the ones it focuses to protect. The statutory publicity rights in New York are also subjected to the general defences allowed under the First Amendment. The 'wholly unrelated test' that was devised in *Rogers v. Grimaldi* (as seen above), appears to provide wider freedom of speech in New York compared to that of in California. In terms of descendibility of the right, initially, the New York model did not recognise the descendibility of the right - probably owing to the fact that this model has been codified under privacy and under privacy, rights extinguish with the death of the holder. However, following the 2020 amendment of section 50 of the NYCLR, the right is now descendible and is protected for a period of 40 years postmortem.⁷¹²

⁷⁰⁷ California Civil Code, Article 3344(1); see also, *Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, (2012)692 F.3d 983, 986 (9th Cir. 2012).

⁷⁰⁸ See, New York Civil Rights Law ('NYCRL'), Sections 50 & 51.

⁷⁰⁹ 58 A.D.2d, 620 (2d Dep't 1977) at 623.

⁷¹⁰ *Onassis* (n 33) at 612.

⁷¹¹ 610 F. Supp. 612 (S.D.N.Y. 1985).

⁷¹² See, section 50-f of NYCRL.

4.2.1(b) Lanham Act:

In addition to the State publicity rights, the celebrities in the US have the option to resort to the Lanham Act 1945 (also known as the Trademark Act 1946), which is a federal set of legislation, for protection against the unauthorised commercial exploitation of their persona. The Lanham Act dictates the federal trademark regime of US and covers false advertising/false endorsements and similar deceptive trade practices. Solomon ushered that the purpose of the Act is to safeguard the public from misrepresentation or deception and to safeguard the trademark owners from the false impression that they are associated with or is endorsing the product advertised.⁷¹³ Owing to such purpose, which also shows how restrictive the Act is, the celebrities are often tempted to pursue a claim under the Act against misappropriation of persona, particularly when the persona is used in endorsement/merchandising purposes.⁷¹⁴ Another reason, in Schlegelmilch's words⁷¹⁵, perhaps is because of the right of publicity lacking federal standing and varying state to state.

The celebrities can rely on section 43 of the Act, which strictly prohibits false/misleading advertising using celebrity persona without consent, that misleads the consumer in believing the celebrity's commercial connection with the advertised product. In *George Wendt and John Ratzenberger v Host International Inc. and Paramount Pictures Corporation*⁷¹⁶, section 43 of the Act was invoked by two actors in a claim against the use of their look-alike robots at a number of airport bars. The court found in favour of the plaintiff celebrities and ruled that the requirement of confusion under the statute does not require identical or photographic resemblance but such similarity which is sufficient to confuse the consumers about association. The provision of the Act, as it is capable of being broadly interpreted, can be also used to protect commercial parties against unfair competition.⁷¹⁷ In *Waits v. Frito-Lay*⁷¹⁸, the use of a sound-alike of famous singer Tom Waits in an advertisement was held to constitute false endorsement and was prohibited under the Act. The court was convinced that the unauthorised imitation of the singer's voice was likely to misrepresent the consumers that Tom has endorsed the advertised product. In another claim of false endorsement, *Abdul-Jabbar v. GMC*⁷¹⁹, the use of the basketball player's former name in an advertisement to compare the quality of the cars advertised, were held to be in breach of the Act, as such use was likely to lead the public to believe the player's association with the cars advertised. Despite success in these cases, liability under the Act is dependent on consumer deception/confusion – just like the UK's tort of passing off. The claim under section 43 of the Act in *Carson*

⁷¹³ See Barbara A. Solomon, 'Can The Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper Substitute for a Federal Right of Publicity,' (2004) 94 Trademark Rep. 1202, 1204.

⁷¹⁴ *Carson* (n 680); see also *Waits* (n 280); *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996).

⁷¹⁵ Schlegelmilch (n 136) 105; See also, Brandon Johansson, 'Pause the Game: Are Video Game Producers Punting Away the Publicity Rights of Retired Athletes?' (2010) 10 Nev. L.J. 784, 790.

⁷¹⁶ 1997 US App. Lexis 25584 (9th Cir. 1994).

⁷¹⁷ See, Solomon (n 713) 1204.

⁷¹⁸ *Waits* (n 280)

⁷¹⁹ 85 F.3d 407, 413 (9th Cir. 1996).

*v. Here's Johnny Portable Toilets, Inc*⁷²⁰, failed as the court was not convinced that the use of Johnny Carson's famous catch-phrase is likely to cause confusion among the consumers. Being dependent on the misrepresentation element, the Act simply fails to protect celebrities from the misappropriation of their persona and the commercial value therein, the protection of which has been primary aim of the state provided right of publicity.⁷²¹ As such, the Lanham Act may not be the most suitable form of protection for the celebrities, and scholars have critiqued it as a '*poor fit*'.⁷²²

In addition, the celebrities can also use the trademark provisions of the Act to show that they own a legally enforceable trademark and the subsequent use of similar mark by a third party is likely to confuse the public as to the trade origin of the product.⁷²³ Although the 'confusion' requirement is common here, and above in case of false endorsement, but the object of confusion is different. For false endorsement, it is the confusion as to the association with the product; for trademark cases, it is the confusion as to source or origin of the product. Undoubtedly, the confusion requirement appears to be even more difficult to prove in trademark cases; in that, for persona to be trademarked, it must relate to the origin of the product and not the person himself, and as celebrities are often not the source of the product, there would be no confusion as to the origin, and registration will fail.⁷²⁴ Nevertheless, the trademark obtained under the Act is granted nationwide protection⁷²⁵ and any distinctive symbol, picture, signs, words or even unique colour combinations are capable of being registered. Once registration is obtained, celebrities have the option to use or assign the mark to a third party for use.⁷²⁶ However, protection is only acquired through registration and Act is flexible to register a mark for either present or future use. Conversely, some states do accord protection without registration as an extension of protection against unfair competition.

To conclude, the US right of publicity has been graciously defined as the "...*inherent right of every human being to control the commercial use of his or her identity [persona]*"⁷²⁷ and as a "...*right to "own, protect, and profit from one's name, likeness, voice, or identity"*"⁷²⁸. The right is also rationalised on the notion that, "... *my identity is mine and it is my property to control as I see fit...*"⁷²⁹ These definitions are enough to suggest that the right affords exclusive control over use and profiting from persona to the celebrities and with that, a broad spectrum of protection is made available. Although the right was once considered an off-shoot of privacy, its underbelly, the right has long out grown privacy, establishing itself as a distinct, standalone proprietary

⁷²⁰ *Carson* (n 680)

⁷²¹ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996).

⁷²² See, Solomon (n 713), 1204. Schlegelmilch (n 136), 107.

⁷²³ See, Johansson (n 715) 790.

⁷²⁴ See, Solomon (n 713) 1204.

⁷²⁵ See, Lanham Act 1946, Section 1115.

⁷²⁶ B. Hoffman, 'Copyright and the First Amendment: defining the delicate balance.' 2004, 9(4) A.A. & L. 383

⁷²⁷ Thomas J. McCarthy & Roger E. Schechter, *Right of Publicity and Privacy* (2nd edn, Thomson Reuters 2019)

⁷²⁸ Aaron A Bartz, '... And Where it Stops, Nobody Knows: California's Expansive Publicity Rights Threaten the Federal Copyright System, (1997) 27 Sw. U. L. Rev. 299, 302.

⁷²⁹ Thomas J. McCarthy, *Rights of Publicity and Privacy* (2nd edn, Clark Boardman Callaghan, 2001)

right, something akin to an intellectual property right like copyright, patents and trademarks.⁷³⁰ The purpose of the rights is now significantly different; privacy continues to do what it was aimed for – prevent intrusion to one's private sphere; publicity protects the economic aspect of one's marketable persona, allowing it to be transferred and also descendible post mortem. The right has been based on misappropriation that detect any unauthorised taking of persona as actionable, subject to certain restrictions in the First Amendment. Although, the right of publicity lacks federal footing and tend to vary from one state to another, in essence, the right is largely the same throughout the states that have recognised it. Overall, celebrities in the US are offered a broad, effective and strong protection against misappropriation of persona, and perhaps because of this, the US model has been often referred to as the 'torch bearer' in the world of personality laws.

4.2.2: Canada

There is no sui generis right of publicity/personality under the federal or provincial laws of Canada. Instead, the common law provinces have introduced the 'tort of appropriation' to safeguard rights akin to that of publicity or of the broader concept of personality. Provinces like Manitoba, Newfoundland, Saskatchewan and British Columbia have framed the tort on the basis of privacy legislations, giving it a statutory footing. Ontario, on the other hand, kept the tort in the common law, with roots in privacy and with the possibility of its application in other provinces which does not recognise any such torts or rights. The civilian law province of Quebec also recognises such rights, but implicitly, through case laws.

Even before such legislative and common law developments, celebrity persona was traditionally protected through other existing causes of action - just as in the UK at the moment. Celebrities often resorted to Canadian intellectual property rights regime in copyrights and trademark, common law tort of passing off and even defamation to prevent misappropriation of their persona.⁷³¹ However, as these doctrines/causes of action were not devised to deal with personality rights - some even dating back to a time when the concept of personality rights was non-existent – they provided very limited and/or insufficient protection to the celebrities, as it is the case with celebrities in the UK. In the following segment, the tort of appropriation will be discussed on a provincial basis and at the end the other prominent (but contingent) sources of protection under the federal law will be explored; all to assess whether the celebrities in Canada are receiving effective measure of protection to their personality right.

⁷³⁰ Beverley-Smith (n 290).

⁷³¹ Vaver (n 49), 243.

4.2.2(a) Common Law Tort of Appropriation

The common law tort of appropriation of personality was first recognised in *Krouse v. Chrysler Canada Ltd*⁷³², where a footballer's image (taken during gameplay) was used without his consent in an advertisement by the Defendants. The court, however, was not convinced that the unauthorised use of the footballer's image implied his commercial association with or endorsement of the advertised product. Instead, the court formed the opinion that as the advertisement comprised of various details of interest about the players of the National Football League, including the plaintiff footballer, the use implied association of the game of football, in general (and not the plaintiff, personally), with the advertised product. The court, nevertheless, did explicitly confirm, in obiter, that the common law could accommodate a tort of appropriation of personality in suitable circumstances⁷³³, and thus, for the first time acknowledged the scope of a separate cause of action in tort to safeguard against unauthorised use of persona.

The existence of the tort was subsequently confirmed in *Athans v. Canadian Adventure Camps Ltd*.⁷³⁴, where a famous water-skier's picture (in the form of a line drawing) was used without consent in the advertisement materials of the Defendant. The court firmly held that the unauthorised use of the skier's image for such commercial purposes has "...constituted an invasion and pro tanto an impairment of his exclusive right to market his personality."⁷³⁵ The image which was misappropriated here was one with the skier's signature pose, which has formed a distinctive feature of his persona and which the skier has previously marketed. The simple taking of his persona without consent and harming the skier's commercial interest in it was deemed sufficient to establish the tort, and no misrepresentation of endorsement was required for liability in this case, unlike in *Krause*. The court additionally confirmed that this tort is to be treated as a cause of action which is separate and distinct from the existing cause of action in trademark, copyrights and passing off.⁷³⁶

In *Athans*, the Court confirmed that the celebrities have a "...proprietary right in the exclusive marketing for gain of his personality, image and name..."⁷³⁷ – effectively meaning that the tort definitely covers (mis)appropriation of celebrity name and other indicia of personality in addition to image/photographs. In addition, as the line drawing in *Athans* was found actionable, the tort also appears to cover drawings, portraits and even caricatures as long as the celebrity is identifiable from it⁷³⁸. This collectively affords the celebrities a wider ambit of protection, as the tort effectively covers various (but not all) aspects of their persona from misappropriation.

⁷³² (1974), 1 OR 2d 225.

⁷³³ Ibid, at para 37.

⁷³⁴ (1977) 17 OR 2d 425.

⁷³⁵ Ibid, at para 28.

⁷³⁶ Ibid.

⁷³⁷ Ibid, at para 24.

⁷³⁸ Amy M. Conroy, 'Protecting Your Personality Rights in Canada: A Matter of Property or Privacy?' (2012) 1(1) UWOLJ Leg Stud 3, 11-12.

In *Athans*, the Court further clarified that the test to qualify under this tort is one of identifiability by the viewers from the impugned use; in that, if the celebrity is unidentifiable from the unauthorised use of his/her persona, the tort cannot be invoked⁷³⁹. In *Athans*, the case has turned on the significant likelihood of identifiability of the skier from the unauthorised line drawings of the Defendant. McCarthy added (particularly in light of *Krouse*), that the court will not only focus on the direct indicia of celebrity persona but will also take into account the overall context, circumstances of the presentation, accompanying captions, labels or commentaries in ascertaining whether the celebrity is identifiable from the impugned use.⁷⁴⁰

Further to qualify, the impugned use must be for a commercial purpose/gain, since the tort is based on the exclusive right of the celebrity to commercialise and/or market his persona.⁷⁴¹ A latter case illustrated this prominently; in *Horton v Tim Donut*⁷⁴², the unauthorised use of a memorial portrait of a famous hockey player in Defendant's chain of stores did not constitute a misappropriation for the purpose of the tort. The court was convinced that the purpose behind the use was predominately charitable and commemorative, and not commercial, so the hockey player's exclusive right to market his persona remained unaffected.

In terms of other qualifying factors, the Court initially clarified that the appropriation does not have to be intentional. In *Bogajewicz v Sony of Canada Ltd*⁷⁴³, the Court accepted unintentional appropriation of persona to trigger the tort, although the infringer in this case had purchased the images from an agency in good faith with the honestly belief that the consent of those depicted in the images came with it and used it for advertisement purposes. A decade later, the Court shifted from this position in *Somwar v McDonald's Restaurants of Canada Ltd*⁷⁴⁴ and started to require appropriation to be 'intentional' for the tort to be successfully invoked.⁷⁴⁵

Most significantly, the court recognised several exceptions/defences to the tort in refining its parameters. Uses which are consensual/authorised⁷⁴⁶, incidental to another purpose (as seen in *Horton*) or where use is such that the celebrity is unrecognisable (or de minimis)⁷⁴⁷, the tort will not apply. An unrecognisable/de minimis use was clarified in the British Columbian case of *Joseph v. Daniels*⁷⁴⁸, where the unauthorised use of the photograph of a body builder's torso was not an appropriation of his persona under the tort. The court, there, was not convinced that viewers would recognise and/or identify the body builder from the photograph of the torso alone. As

⁷³⁹ Ibid para 16.

⁷⁴⁰ Thomas J McCarthy, *Rights of Publicity and Privacy* (2nd edn, Clark Boardman Callaghan, 2001)

⁷⁴¹ Ibid; See also, *Gould Estate v Stoddart Publishing Co.* [1996] 30 O.R.3d 520

⁷⁴² [1997] OJ No 390.

⁷⁴³ (1995) 63 C.P.R. (3d) 458.

⁷⁴⁴ [2006] OJ No 64 at para 29.

⁷⁴⁵ The requirement of intent was subsequently affirmed in the Nova Scotia case of *MacDonnell v Halifax Herald Ltd* (2009), 279 NSR (2d) 217 (SC); See generally, Robert G Howell, 'Publicity Rights in the Common Law Provinces of Canada' (1998) 18 Loy LA Ent L Rev 487, 488.

⁷⁴⁶ *Dowell v Mengen Institute* [1983] 72 CPR (2d) 238.

⁷⁴⁷ *Joseph v. Daniels* (1986), 4 B.C.L.R. 2d 239.

⁷⁴⁸ Ibid.

also indicated in *Krouse*, the extent of unauthorised use must constitute a culpable taking and must not be insignificant or so trivial that recognition/identification is unlikely.⁷⁴⁹ The most prominent of the exceptions/defences is when the unauthorised use is justified on the grounds of public interest.⁷⁵⁰ In *Gould Estate v Stoddard Publishing*⁷⁵¹, the court drew the distinction between the commercial use required by the tort and uses entailing public interest. In that, if the use is purely commercial in nature, the proprietary interest of the celebrity in his persona will always prevail over any public interest that the use may entail; whereas, if the use is for reporting facts, ideas and newsworthy events, which are predominantly done to serve legitimate public interest, such proprietary interest will be displaced by the public interest that the uses comprised of. In *Gould*, the court found use of the musician's photographic biography to serve public interest, as the use provided knowledge/information about the Canadian music geniuses (including Mr. Gould) and was ruled as an exception to the tort.⁷⁵²

Moreover, the Court in *Gould*, also clarified one of the crucial aspects of the tort, in that, whether the right safeguarded under the tort is descendible/inheritable. Although the Court confirmed that the right is descendible, but in *Gould* the claim of the estate against publication of photographic biographies of the deceased musician failed due to the application of the public interest application. Nevertheless, the Court in *Gould* enumerated that the tort is designed to safeguard the commercial interest of the celebrities akin to copyrights/patents and not only the privacy interest of the same. Had it been grounded solely on privacy, the right would not be descendible but as it serves much more than that, the right is descendible or inheritable.

Finally, in terms of damages, the formula for assessment appears to be based on the calculation of the sums that the plaintiff celebrity has lost as a reasonable license fee for using his/her persona.⁷⁵³ Given how frequently celebrities and famous individuals engages in marketing their persona and the persona licensing practices being common place, assessment of such damages seems to be fairly easy. The tort, however, is not clear on whether it mandatorily requires a proof of harm or damage in addition to the requirement of unauthorised appropriation; but the courts have considered such damage (or its possibility) in almost all of these cases. Clarity in this aspect is imperative since it will have a bearing on the overall quantification of the damage for the aggrieved celebrities.

⁷⁴⁹ *Krouse* (n 732); See also, Robert Howell, 'Personality Rights: A Canadian Perspective: Some Comparisons With Australia', (1990) 1 *Intell. Prop. J.* 212, 218.

⁷⁵⁰ *Caltagirone v Scozzari-Cloutier* [2007] OJ No 4003.

⁷⁵¹ [1996] OJ No 3288.

⁷⁵² *Ibid*, 527.

⁷⁵³ *Athans* (n 734).

4.2.2(b) Statutory Tort of Appropriation:

The Canadian provinces of Manitoba⁷⁵⁴, Newfoundland⁷⁵⁵ and Saskatchewan⁷⁵⁶ enacted privacy-based legislation that allowed for a general tort of privacy, encompassing the appropriation of personality as part of that general tort.⁷⁵⁷ The approach was slightly different with the province of British Columbia, which devised two separate statutory tort, one for invasion of privacy and the other for appropriation of personality⁷⁵⁸. Notwithstanding the difference in approach, the torts introduced are largely the same in terms of their application and qualifying requirements. All four versions of the tort requires that the plaintiff celebrity must be identifiable/recognisable from the unauthorised use, just as required under the common law counterpart in Ontario.⁷⁵⁹ They do not require any proof of damage for the appropriation to be actionable and in doing so, offers a broad scope of protection.⁷⁶⁰ Most significantly, all four of the torts recognises defences/exceptions in uses which are authorised/consensual⁷⁶¹, uses which are incidental to the exercise of a lawful right of defence of person or property⁷⁶², uses which are authorised or required under any other provincial law⁷⁶³ or by the court and uses by a officers of peace in the course of duty⁷⁶⁴. There are some additional exceptions that are also recognised in these provisions, differently. In essence, those exceptions cover uses which are done to serve public interest, fair commenting on a matter of public interest and publications which are privileged owing to the laws of defamation.⁷⁶⁵ The threshold of what constitutes a matter of public interest varies from one province to another; in that, there is a higher threshold in British Columbia and Newfoundland – where the use must ‘be’ in the public interest and not ‘of’ public interest; there is relatively a lower threshold in Saskatchewan and Manitoba, which only requires reasonable grounds for belief that the use was in the public interest.⁷⁶⁶

There are, however, some noteworthy differences between the torts. The appropriation of celebrity (and ordinary people) name, likeness or voice are actionable under the tort available in Manitoba, Newfoundland and Saskatchewan⁷⁶⁷. The British Columbian tort only covers appropriation of name or portrait, including caricatures, reflecting that actionable persona is construed very restrictively in the province, compared to the other three.⁷⁶⁸ The British Columbian tort is also restrictive compared to the other three as it renders only commercial uses such a advertising/promotion of

⁷⁵⁴ Privacy Act 1987, c. P125 (Manitoba) ('PM').

⁷⁵⁵ Privacy Act 1978, c. P-24 (Saskatchewan) ('PS').

⁷⁵⁶ Privacy Act 1990, c. P-22 (Newfoundland) ('PNFLD').

⁷⁵⁷ See, Amy (n 738) 3-8.

⁷⁵⁸ Privacy Act 1996, c 373 (British Columbia) ('PBC'); See generally, Vaver (n 49).

⁷⁵⁹ PBC at s 3(4); PM at s 3(c); PNFLD s 4(c); PS at s 3(c).

⁷⁶⁰ PBC at s 3(2); PM at s 2(2); PNFLD at s 3(1); PS at s 2.

⁷⁶¹ PBC at s 2(a); PM at s 5(a); PNFLD at s 5(1)(a); PS at s 4(1)(a).

⁷⁶² PBC at s 2(b); PM at s 5(c); PNFLD at s 5(1)(b); PS at s 4(1)(b).

⁷⁶³ PBC at s 2(c); PM at s 5(d); PNFLD at s 5(1)(c); PS at s 4(1)(c).

⁷⁶⁴ PBC at s 2(d)(i); PM at s 5(c); PNFLD at s 5(1)(d)(i); PS at s 4(1)(d)(i).

⁷⁶⁵ PBC at s 2(3); PM at s 5(f)(i)(ii)(iii); PNFLD at s 5(2); PSK at s 4(2).

⁷⁶⁶ See also, Amy (n 738) 3-8; See generally, Vaver (n 49).

⁷⁶⁷ PM at s 3(c); PNFLD at s 4(c); PS at s 3(c).

⁷⁶⁸ PBC at s 3(1).

goods/services actionable under the tort.⁷⁶⁹ The torts in Manitoba, Newfoundland and Saskatchewan, does not require for the use to entail a commercial purpose in the strict sense; rather it requires proof of gain/advantage of the appropriator.⁷⁷⁰ This means, proof of any kinds of gain/advantage which may or may not be commercial in nature would suffice for the torts of these provinces. In terms of descendibility/inheritability, in British Columbia, Newfoundland and Saskatchewan, the tort or the underlying statutory regime does not allow for the personality rights protected to be inherited or descended, as it views such rights to extinguish with the death of the holder.⁷⁷¹ Manitoba legislation is, however, silent on this particular aspect and, as such, claims by the estate/heirs for enforcing the right under the tort depends on the discretion of the provincial court.

Interestingly, in terms of the co-existence of these torts with its common law counterpart, Manitoba, Newfoundland and Saskatchewan statutes provides that the tort exists 'in addition' to other cause of actions available⁷⁷². The British Columbian statute, however, is silent on such co-existence and the provincial court in *Joseph v. Daniels*⁷⁷³ clarified that the statutory tort was available in addition to the common law version of the tort.

4.2.2(c) Civilian Province of Quebec

In Quebec, a civilian law province of Canada, protection for one's personality rights was first allowed through the case of *Aubry v Editions Vice-Versa*⁷⁷⁴, under Quebec Charter of Human Rights and Freedoms, and most importantly, under Civil Code of Quebec. The Civil Code⁷⁷⁵ views any unauthorised use of one's name, likeness or voice for purposes other than legitimate interest of the public as an invasion of privacy, and damages may be awarded for such an invasion, as awarded in *Aubry*. In Quebec, the Supreme Court's ruling in *Aubry*, stands as a good precedent and this, together with the Civil Code of the province, appears to provide for the safeguarding against misappropriation of celebrity persona. Based on *Aubry*, the test for appropriation remains to be the test of identifiability and that the appropriation need not be intentional.⁷⁷⁶ Since the protection is based on privacy, the purpose of the impugned use need not be commercial, like it is with tort of appropriation (statutory or otherwise) introduced elsewhere in the country⁷⁷⁷. The *Aubry* court was silent on the issue of descendibility or inheritability of the right; but it affirmed that the right is grounded on privacy, which comprises of both patrimonial and extrapatrimonial values.⁷⁷⁸ This view

⁷⁶⁹ Ibid at s 3(2).

⁷⁷⁰ PM at s 3(c); PNFLD s 4(c); PS at s 3(c).

⁷⁷¹ PBC at s 5; PNFLD at s 11; PS at s 10.

⁷⁷² PM at s 6; PNFLD at s 7(1); PS at s 8(1).

⁷⁷³ See also, Stuart C. McCormack, *Intellectual Property Law of Canada* (2nd edn. 2010).

⁷⁷⁴ [1998] 1 SCR 591.

⁷⁷⁵ See, Civil Code of Quebec, Articles 35 & 36(5).

⁷⁷⁶ *Aubry* (n 774) at 53.

⁷⁷⁷ *Amy* (n 738) 16.

⁷⁷⁸ *Aubry* (n 774) at 51. See also *Godbout v Longueuil (City)* [1997] 3 SCR 844.

of the court is capable of broad interpretation, even to include the possibility that the patrimonial aspect of the right may be descendible or inheritable. The *Aubry* Court further recognised several exceptions/defences to this right, which mirrors with that of the statutory and common law versions of the tort, as seen above, with the most prominent one to be uses serving legitimate public interest.⁷⁷⁹

4.2.2(d) Other Sources Of Protection

The celebrities in Canada may also have a potential cause of action against unauthorised exploitation of their persona under the provisions of the federal Trade Mark Act 1985. The relevant provision of the Act as follows:

Section 9(1): “No person shall adopt in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...

(k) any matter that may falsely suggest a connection with any living individual;
[or]

(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;

Illustratively, in *Carson v. Reynolds*⁷⁸⁰, the famous TV personality Johnny Carson, invoked section 9(1)(k) of the Act to object to the registration of a mark “*Here’s Johnny*” for the Defendant’s portable toilets. On appeal, the Federal Court of Canada, ruled that that the phrase in the mark misleadingly/falsely associated the celebrity with the sale of the portable toilets and cancelled registration of the mark. No proof of harm or damage to reputation of Johnny’s persona was required by the Court. In another case of *Baron Philippe de Rothschild, S.A. v. La Casa de Habana Inc*⁷⁸¹, the famous Rothschild family objected under section 9(1)(k) to the registration of the mark “*Rothschild at Yorkville*” on the Defendant’s tobacco products. Like in *Carson* the court here found that the use of the name created a false association of the individuals from the family with the tobacco products. Here as well, no proof of harm or damage was required. These two cases illustrate that the Federal trademark regime can be invoked to protect various indicia of personality, in addition to those like name, portraits and signature which are usually trademarked by celebrities.

The celebrities can also invoke section 53(1) of the federal Competition Act 1985 to safeguard against the unauthorised use of their persona in advertising purposes. Under the Act, any unauthorised use of a celebrity’s image, likeness, or voice to advertise, promote, endorse or merchandise goods/services would be constituted as misleading advertising and thus prohibited.

⁷⁷⁹ *Aubry* (n 774) at 57- 59.

⁷⁸⁰ 48 CPR (2d) 57 (1980).

⁷⁸¹ (1987), 19 C.P.R. 3d 114 (Can. Ont. H.C.J.).

As conclusion, it is apparent from the above that although Canada did not embrace any general right of publicity like the US or a broader right of personality, like some of the European counterparts (to be seen below), it offered a tort that provides a veil of protection akin to the publicity/personality right models seen already and to be seen subsequently. Although the basis of the tort varies from province to province, the essence of protection/right is largely the same. Most importantly, the tort, despite based on privacy, recognises the commercial potentialities of celebrity persona. It, therefore, offers comprehensive protection to both the non-economic values (like dignity and honour), and economic values (like lost license fee or loss of profits) of a celebrity's persona. The tort, particularly, the common law version of it, is continuously evolving – a common feature of common law – and the commentators⁷⁸² have called for further clarification on the balancing exercise of the right with freedom of expression/public interest exceptions, and most importantly on the descendibility of the right upon the death of the celebrity. Clarification from the Supreme Court is also required on the applicability of the common law tort of appropriation in other provinces of the country, particularly those which does not recognise personality rights in statute or otherwise.⁷⁸³ Apart from the tort, the celebrities also have the option to resort to the federal trademark and competition laws for protection. Also, the traditional methods, including but not limited to passing off, are still available, with passing off being afforded such scope of protection which is considered to be wider than the tort of appropriation itself.⁷⁸⁴ With such multi-layered protective measures, celebrities in Canada are likely to enjoy comprehensive and effective safeguards against the misappropriation of their persona.

4.2.3: Australia

The Australian Legal system does not recognise any *sui generis* right of publicity or right of personality.⁷⁸⁵ It also does not recognise any distinct right of image, unlike that of in the civil law jurisdictions of Europe. Instead, celebrities in Australia, just as in the UK, has to resort to existing common law doctrines (like passing-off)⁷⁸⁶ and/or statutory intellectual property regimes for the protection of their persona.⁷⁸⁷ Mirroring the English judges, the Australian judges has been seen to stretch these existing legal

⁷⁸² See, Howell (n 749); See also, J. Craig, & N. Nolte, 'Privacy And Free Speech In Germany And Canada: Lessons For An English Privacy Tort', (1998) 2 E.H.R.L.R. 162; D. Collins, 'Age of the Living Dead: Personality Rights of Deceased Persons' [2002] Albany Law Review 39; D. Tackaberry, 'Canada: Appropriation of Personality – Unauthorised use of Claimant's photograph in advertisement', (1996) 7(3) Ent L.R. E44.

⁷⁸³ Amy (n 738) 20.

⁷⁸⁴ See, *National Hockey League v Pepsi-Cola Canada Ltd* (1992) 70 B.C.L.R. (2d) 27; see also, H. Carty, 'Advertising, Publicity rights & English law' (2004) 3 I.P.Q. 209.

⁷⁸⁵ See Lynne Weathered, 'Trade Marking Celebrity Image: The Impact of Distinctiveness and Use as a Trade Mark' (2000) 12 Bond Law Review 161, 164. Cameron Harvey, 'The Medium Is the Message' (1996) 1 Media & Arts Law Review 182, 183; John McMullan, 'Personality Rights in Australia' (1997) 8 Australian Intellectual Property Journal 86, 92–5; Zapparoni (n 469) 693-694.

⁷⁸⁶ Robert Todd and Ian Smith, "Australia" in Michael Henry (ed), *International Privacy, Publicity and Personality Laws* (2001); See also, Howell (n 749); Zapparoni (n 469).

⁷⁸⁷ Hilary May Black, 'The Role of Trade Mark Law' (2002) 7 Media & Arts Law Review 101; See also, Zapparoni (n 469).

doctrines to afford protection to the celebrities; however, whilst some protection is available, it is still limited and often incidental, being a byproduct of the protection of some other subject-matter.⁷⁸⁸ Interestingly, however, the Australian Courts (unlike their English counterparts) has refined and expanded the common law doctrine of passing off through judicial law making to offer greater protection to the celebrities against unauthorised use of their persona in marketing/advertising cases.⁷⁸⁹ Protection has been drawn also from statutes dictating consumer protection and the celebrities have been offered trademark protection on several indicia of their persona. In the following segment, all of these common law and statutory source of protection will be assessed to ascertain how the celebrities in Australia are being safeguarded against misappropriation of their persona in absence of any distinct right of personality or publicity in the legal system.

4.2.3(a) *Passing Off*:

The Australian version of the doctrine of passing-off is very similar to that of the English version; in that, it has been formulated to safeguard one's goodwill and reputation from being used by another to market/represent his own goods/services and profit on the former's such goodwill and reputation. It, therefore, arises when a trader passes off his own product as another, by creating an impression to the public that the other trader is associated with it and profits from that misleading impression of association. As such, this misleading impression to the public, i.e., a 'misrepresentation' lies at the core of the claim and the doctrine is, therefore, applied to prevent misleading and deceptive commercial practices. The traditional elements of this doctrine, mirroring the English version, are proof of goodwill/reputation, misrepresentation, and damage to the bearer of goodwill due to that misrepresentation.

The first successful application of this doctrine to safeguard celebrity persona was in the landmark case of *Henderson v Radio Corp. Pty. Ltd*⁷⁹⁰, where the photographs of two professional dancers were used in an album cover without their consent. The Court was convinced that the use of visual depiction of famous dancers falsely implied that the dancers were associated with the album and that, the Defendant's 'passed off' their album on the fame/reputation of those dances through that false impression of association. This ruling was particularly important as the Court in *Henderson* abandoned the traditional and essential requirement of 'common field of activity' for passing off, which, as already seen in Chapter 2 (in the context of UK), posed a serious impediment for celebrities to qualify for this right. Furthermore, by doing so, it expanded the doctrine to apply where celebrity persona has been unauthorisedly used on a product to deceive/mislead the customers into believing that the celebrity is

⁷⁸⁸ See also Sam Ricketson, 'Character Merchandising in Australia: Its Benefits and Burdens' (1990) 1 Intellectual Property Journal 191, 191.

⁷⁸⁹ S. Boyd, 'Does English Law recognise the concept of an image or personality right?' (2002) 13 (1) Ent. L.R.1.

⁷⁹⁰ [1960] S.R. (NSW) 576.

associated or has endorsed that product.⁷⁹¹ Misrepresentation requirement is still relevant, but in case of (mis)use of celebrity persona, the threshold is the likelihood of false impression of the celebrity's association with the product in the minds of the public.⁷⁹² The latter court in *Hutchence & Others v South Seas Bubble Co Pty Ltd & Another*⁷⁹³, upheld this position by stating that, "...there is no necessity for a common field of activity ... provided that there is a misrepresentation by the defendant concerning the defendant's name or product resulting in a likelihood of damage to the claimant, as for example confusion adversely affecting goodwill ... or wrongful appropriation of the claimant's name and reputation."

The doctrine was further expanded through *Pacific Dunlop Ltd v Hogan*⁷⁹⁴, to also cover misappropriation of celebrity character/likeness by creating false impression of association in product merchandising cases. In this case, unlike in *Henderson*, actor Paul Hogan's image was not used rather the hat and jacket that the actor has worn in his successful movie franchise *Crocodile Dundee*, was used by another actor in an advertisement. The court held that the Crocodile Dundee character is an extension of the actor's persona and that, the use of the distinct feature of that character in the advertisement was sufficient to create the false impression of association required for the purpose of misrepresentation and for the action of passing off as a whole.

Collectively, these cases illustrated the extent the doctrine of passing off has been stretched to, in order to afford protection to celebrity persona – particularly where the persona has been (mis)used to maximise sale of a product/service.⁷⁹⁵ The ambit of the tort has been broadened to include various aspect of celebrity persona, including but not limited to, image, identity, character, etc, as long as its use can create the false impression in the minds of the general public. As misrepresentation of a commercial connection/association with the celebrity has been point of main interest, instances where a credible disclaimer is in place or where it is obvious that there is no association with the celebrity, the claim is likely to fail.⁷⁹⁶ Likewise, in *Newton-John, O. v Scholl-Plough (Australia) Ltd*⁷⁹⁷, the use of Olivia Newton's (famous British-Australian singer) look-alike in a cosmetics advertisement with the slogan, "Olivia? No, Maybelline!" was not held to cause the misrepresentation to justify passing off. The court was convinced that the wording clearly disclaimed that the look-alike was Olivia Newton and as such, there was no scope of misleading the public into believing the singer's association with the products advertised. Similar conclusion was also reached in the case of *Honey v Australian Airlines*⁷⁹⁸, where the Olympic long jumper, Gary Honey's photograph was

⁷⁹¹ Samuel Murumba, *Commercial Exploitation of Personality*, (Sydney: The Law Book Co, 1986) 65; C Harvey, 'The Medium Is the Message' (1996) 1 Media & Arts Law Review 182, 183.

⁷⁹² Larissa Hintz, 'Is the Beer Really Better, Drunk by Your Idol? The Duff Beer Case' (1997) 19 Sydney Law Review 114.; Mark Davison, Kate Johnston and Patricia Kennedy (eds), *Shanahan's Australian Law of Trade Marks and Passing Off* (3rd ed, Thomson Reuters Australia 2003) 572.

⁷⁹³ (1986) 64 ALR 330.

⁷⁹⁴ (1989) 23 FCR 553.

⁷⁹⁵ Ibid.

⁷⁹⁶ *Twentieth Century Fox Film Corporation v The South Australian Brewing Co. Ltd* [1996] 34 IPR 225; *Honey v Australian Airlines Ltd & Another* 14 IPR 264; *McIlhenny Co. v Blue Yonder Holdings Pty Ltd* [1997] 39 IPR 187;

⁷⁹⁷ [1986] FCA 221.

⁷⁹⁸ 14 IPR 264.

used without consent on the promotional poster of Australian Airlines, celebrating his sporting excellence. The court was not convinced that the impugned use implied any endorsement or association of the athlete with the airline. In both of these cases, there were misappropriation of celebrity persona, but since the uses fell short of creating a misrepresentation, passing off was not established.

From all of these case rulings, it is apparent, at least, in an overt sense, that the Australian courts promoted a model largely based on misrepresentation and public confusion, and rejected a model based on misappropriation that prohibits all unauthorised uses of celebrity persona.⁷⁹⁹ The model promoted actually limits the doctrine to cases of misappropriation of character in product merchandising/endorsements; whereas there are other aspects of celebrity persona and numerous other forms of misappropriation that the doctrine fails to recognise and safeguard against. Interestingly, the same limitations that have been discussed in Chapter 2, in respect of the English version of passing off, can be applied here as well, since the model is identical and English courts have given similar expansive application of the doctrine but did not embrace any misappropriation-based model or a distinct right of personality/publicity⁸⁰⁰. Moreover, this misrepresentation-based model is also at odds with the other common law North American jurisdictions, where the safeguarding model is solely based on misappropriation, being focused on the unconsented taking of persona and not requiring any public deception/confusion.

Furthermore, the expansive attitude of the Australian Courts with the doctrine has sparked debates among the commentators. Some have viewed this as the court's endeavour to fit modern marketing practices within the doctrine – incrementally – which was developed long before the recognition of such practices.⁸⁰¹ Some have condemned this incremental approach to be artificial and blurring the rational ambit of the doctrine.⁸⁰² Wadlow directly critiqued the *Henderson* decision to be unclear as to whether the unauthorised exploitation was the main impetus behind liability or was it the misrepresentation of endorsement.⁸⁰³ Then there is another view in favour of a more direct approach – i.e., a misappropriation based model – to tackle the unauthorised exploitation of celebrity persona.⁸⁰⁴ However, Carty lauded the

⁷⁹⁹ Robert Howell, 'The Common Law Appropriation of Personality Tort' (1986) 2 Intellectual Property Journal 149, 151-154; See also, Sam Ricketson, 'Character Merchandising in Australia: Its Benefits and Burdens' (1990) 1 Intellectual Property Journal 191.

⁸⁰⁰ See, *Irvine* (n 126); *Fenty* (n 138).

⁸⁰¹ See, Howell (n 749) 221; Zapparoni (n 469) 698.

⁸⁰² See generally, William Van Caenegem, 'Different Approaches to the Protection of Celebrities against Unauthorised Use of Their Image in Advertising in Australia, the United States and the Federal Republic of Germany' (1990) 12 European Intellectual Property Review 452, 453; Jill McKeough and Andrew Stewart, *Intellectual Property in Australia* (2nd ed, 1997); Mark Davison, Kate Johnston and Patricia Kennedy (eds), *Shanahan's Australian Law of Trade Marks and Passing Off* (3rd ed, Thomson Reuters Australia 2003) 572, 582. David Lindsay, 'Playing Possum? Privacy, Freedom of Speech and the Media following ABC v Lenah Game Meats Pty Ltd — Part II: The Future of Australian Privacy and Free Speech Law, and the Implications for the Media' (2002) 7 Media & Arts Law Review 161.

⁸⁰³ Wadlow (n 133) 297.

⁸⁰⁴ Hilary May Black, 'Corporations Law Goes Into Bat for Bradman' (2000) 19(4) CommsLawB 21.

Australian courts' effort as she viewed their action has taken the doctrine as close to a tort of misappropriation as possible.⁸⁰⁵

4.2.3(b) Competition and Consumer Act 2010:

There is a form of statutory protection against deceptive trade practices and/or false endorsement using celebrity persona under sections 18 and 29 of the Competition and Consumer Act 2010. Any unauthorised exploitation of celebrity persona by a business that leads to a misleading impression that the celebrity concerned is associated/connected with the product, will be considered as a misleading or deceptive conduct and such is prohibited under section 18 of the Act. The threshold for the protection of section 18 is relatively low, as it does not require pre-existing goodwill or reputation like the doctrine of passing off. Section 29(1)(g) & (h), further consolidated the protection for celebrities, as it prohibits any advertisers from falsely representing that the product being advertised is either endorsed, approved or sponsored by a celebrity or that, the celebrity is affiliated with the advertiser. Collectively, these provisions of the Act provide a statutory cause of action for the celebrities that can complement or run parallelly with an action under passing off. The test for breach/liability is same for both the actions, that is, fixated to false/misleading impression/representation. Owing to its similarities with passing off, by analogy, the limitations of passing off would also apply to it. These rules only apply to cases involving unauthorised use of persona in character merchandising/endorsement. They do not protect other indicia of celebrity persona and also fails to detect other forms/methods of misappropriation.

4.2.3(c) Trade Marks Act 1995:

The Australian Trade Marks Act 1995 allows for the registration of some indicia of celebrity persona, like portraits⁸⁰⁶, picture⁸⁰⁷, surnames, signatures and even slogans⁸⁰⁸ associated with the celebrity. Like other trademark regimes in the world, the Australian version in section 41(2) also requires a mark to be able to distinguish goods/services of one business from another.⁸⁰⁹ Just like passing off and Competition and Consumer Act 2010 provisions, the trademark regime is also designed to combat misrepresentation in trade practices. As per section 120 of the Act, the right is infringed if a substantially identical or deceptively similar sign is used on same class of goods/services as the original trademark. Interestingly, there is an uncanny resemblance between the Australian trade mark regime and that of in the UK, since in both regimes, the celebrities would have to be involved in persona merchandising and/or endorsement as a condition precedent for eligibility for trademark registration,

⁸⁰⁵ Carty (n 289).

⁸⁰⁶ Trade Mark No.327865, G.M.F.C, (Aust) Pty Ltd (Gloria Marshall); Trade Mark No.468651 (Paul Newman).

⁸⁰⁷ Trade Mark No.726720, Universal Products Marketing GmbH, Germany (Michael Schumacher) and Trade Mark No.701835-701841, Jaques Villeneuve, Monaco (Jacques Villeneuve).

⁸⁰⁸ *Carson v Reynolds* (1980) 48 CPR (2d) 57.

⁸⁰⁹ A Terry, 'Proprietary Rights in Character Merchandising Marks', (1990) Australian Business Law Review, 229.

particularly to attain the distinctiveness required under section 41(2) of the Act. Logically, this would mean lesser celebrities or newcomers to be ineligible for trademark protection as they are not famous enough to attract merchandising or endorsing deals. Same is true for those celebrities having highly valuable persona but has deliberately chosen not to engage in similar commercial activities. The cost and complexities in the registration process, the time required and often the pre-requisite of prior exploitation, questions the overall practicality of this form of protection for celebrity persona.⁸¹⁰ Nevertheless, it can still offer the strongest form of protection if a celebrity can manage to attain registration as it is property right, but definitely cannot provide a blanket protection for all indicia of personality and all kinds of misuses.

To conclude, 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'.⁸¹¹ In *Sony Music Australia Ltd v Tansing*⁸¹², the court also reaffirmed that in Australian law, there is no existence of any publicity or personality rights for the celebrities. Based on previous cases like *Henderson* and *Hogan*, remedy against unauthorised use of celebrity persona may be found if the use is deceptive or misleading.⁸¹³ This firmly indicates that the only source of protection remains with the tort of passing off and its complementary statutory limb, the Competition and Consumer Act 2010. Such protective tools, however, triggers only when celebrity persona has been misappropriated in character merchandising or endorsements, and such use has been deceptive/misleading for the public. Aside from these instances, protection of celebrity personality in Australia, until a distinct right of personality or publicity is recognised, seems largely non-existent.

4.3: Civil Law Jurisdictions

4.3.1: Germany

In the German Legal system, celebrities and famous individuals are offered protection against misappropriation of their persona, combinedly, through the constitutionally grounded *general* right of personality and through statutory *specific* rights of personality (in 'name' and 'image').

The general right of personality was first recognised by the German Federal Court of Justice in 1954 in the case of *Schacht-Briefe*⁸¹⁴ and was grounded on fundamental

⁸¹⁰ See generally, Murumba (n 791).

⁸¹¹ See generally, McMullen, 'Personality Rights in Australia' (1997) Australian Intellectual Property Journal 86; See also S. Boyd, 'Does English Law recognise the concept of an image or personality right?' (2002) 13(1) Ent. L.R. 2002, 1.

⁸¹² [1993] FCA 623;

⁸¹³ Ibid; See also, M Alderson, 'Privacy and publicity – whose life is it anyway?' (1996) 9 Australian Intellectual Property Law Bulletin, 7.

⁸¹⁴ BGHZ 13, 334 (1954) (Schacht-Briefe).

constitutional rights enshrined in Articles 1⁸¹⁵ and 2⁸¹⁶ of the German Constitution and therefore, protected through the general tort provisions in section 823(1)⁸¹⁷ of the German Civil Code, to be read in conjunction with section 1004⁸¹⁸ of the same Code. The right was framed by the judicial interpretation of ‘*other rights*’ enumerated in section 823(1) of the Civil Code, which is open for interpretation to accommodate rights/interests that needs protecting.⁸¹⁹ The general personality right has been referred to, by the German Courts, as the ‘...*core of the personality which, in principle, is only subject to the free and responsible self-determination of the individual*’⁸²⁰; in that, it is an individual’s absolute subjective right to control the exploitation, use and/or dissemination of his personality as a whole. The specific personality right in one’s own image and in one’s name, interestingly, were introduced much earlier than the general right, but those now functions as a subset of the general right. In the following sections, the specific rights will be explored first and then make way to the analysis of the general personality rights.

4.3.1(a) *The specific right of personality in Image*

The *specific* right of personality in one’s image is dictated by section 22 of KUG⁸²¹, which prohibits use, publication, dissemination or exhibition of one’s image, portraits or photographs without prior consent. The right, therefore, affords the celebrities the freedom/autonomy to decide how he will be presented in the public (i.e., the non-economic interests), and where and when his images will be exploited (i.e., the economic interest).⁸²² However, taking of images/photographs without consent or without the knowledge of the celebrity, like in cases of long lens photography or when the celebrity is on his private sphere, as Beverley-Smith contends, would not be caught

⁸¹⁵ Article 1 of Basic Law for the Federal Republic of Germany (as translated) : “(1) *Human dignity shall be inviolable. To respect and protect it shall be the duty of all state authority...*”

⁸¹⁶ Article 2 of Basic Law for the Federal Republic of Germany (as translated): “(1) *Every person shall have the right to free development of his personality insofar as he does not violate the rights of others or offend against the constitutional order or the moral law...*”

⁸¹⁷ S.823 of the German Civil Code (as translated): “(1) *A person who, intentionally or negligently, unlawfully injures the life, limb, health, freedom, property or some other right of another person is liable to provide compensation to the other party for the damage arising therefrom*”

⁸¹⁸ S.1004 of the German Civil Code (as translated): “(1) *If the ownership is interfered with by means other than removal or retention of possession, the owner may demand that the disturber remove the interference. If there is the concern that further interferences will ensue, the owner may seek a prohibitory injunction.*

(2) *The claim is excluded if the owner is obliged to tolerate the interference.*

⁸¹⁹ See also, Beverley-smith (n 290); Corinna Coors, ‘Celebrity image rights versus public interest: striking the right balance under German law.’ (2014) 9(10) Journal of Intellectual Property Law & Practice, pp 835-840. Tilman Ulrich Amelung, ‘Damage awards for the infringement of privacy – the German approach’ (1999) 14 Tul. Euro. Civ. LF 15, 19.

⁸²⁰ BGH 14 February 1958, BGHZ 26, 349, 354—Herrenreiter

⁸²¹ S.22 of KUG (as translated) – “*Images may only be distributed or publicly displayed with the consent of the person depicted. In cases of doubt, consent is deemed to have been given if the person depicted received remuneration for being photographed. After the death of the person depicted, the consent of the person's next of kin is required for a period of 10 years. Next of kin, as defined by this law, are the surviving spouse or civil partner and children of the person depicted, and, if there is neither a spouse or civil partner nor children, the parents of the person depicted.*”

⁸²² Coors (n 819) 3-8.

under the section 22 right, but will be caught under the general personality right, as it also preserves privacy interest of celebrities.

The term 'image' has been broadly interpreted to include likeness of a person⁸²³ and it has been expanded to cover every type of images, ranging from photographs, motion pictures, statues or even death mask.⁸²⁴ The broad ambit of the term even caught parodical use of German actor Marlene Dietrich's costume and gestures (which she used in her one of her movies), as breach of section 22 right of the actor.⁸²⁵ For the image to be actionable, the celebrity depicted must be identifiable/recognisable⁸²⁶ – it should comprise of such elements that makes reference to the celebrity in question; as such, image taken from the back would be also actionable as seen in *Fussballtor*⁸²⁷. Schricker and Gerstenberg added, such recognition could be made through the clothing, styling, gesture or posture depicted in the concerned image, and even if a small group of people are able to recognise the celebrity from the depiction, the (mis)use to be actionable.⁸²⁸ Rosler, however, clarified, use of look-alikes would fall outside the ambit of the section 22 right but the confusion that it may entail will sufficiently qualify the use as a breach of the general personality right.⁸²⁹

Interestingly, the section 22 right is not absolute and will not automatically render liability on the infringers; it is limited by the exceptions allowed in section 23⁸³⁰ of the Act, which in the words of Beverley-Smith, exists to serve legitimate public interest in artistic, informative and news reporting uses.⁸³¹ The most prominent of these exceptions is the one which allows use of image/likeness of persons of contemporary history, without consent, for publishing newsworthy events. The idea here appears to be, that persons of contemporary history have gained the publicity in a way that general public is granted an interest on their pictorial representation, justified on a genuine need for information.⁸³² Such an exception, appears to be problematic for celebrities, as their fame and popularity among the general public may put them within the sphere of contemporary history, thus, allowing the use of their image for artistic and/or news reporting purposes. Further interestingly, however, this exception gets

⁸²³ *Marlene Dietrich* (2000) N.J.W. 2195, 2200, BGH;

⁸²⁴ KG GRUR 1983, 507 – Totenmaske II. Beverley-Smith (n 290) 106; Dreier, T. und S., Gernot, *Urheberrechtsgesetz, Kommentar* (Munchen: Beck, 2004).

⁸²⁵ *Marlene* (n 823).

⁸²⁶ BGHZ 26, 349 at 351 – *Herrenreiter*; BGH GRUR 1962, 211 – *Hochzeitsbild*

⁸²⁷ *Fussballtor* (1979) N.J.W. 2205, BGH

⁸²⁸ G. Schricker & E. Gerstenberg, 'Urheberrecht (copyright law) §60/§ 22 KUG' (1987).

⁸²⁹ 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', (2008) E.H.R.L.R 463

⁸³⁰ S.23 of KUG (as translated) – "(1) *The following may be distributed and displayed without the consent required under Section 22:*

- I. *Portraits from the field of contemporary history;*
- II. *Pictures in which the people appear only as accessories next to a landscape or other location;*
- III. *Images of meetings, processions and similar events in which the persons depicted took part;*
- IV. *Portraits that are not made to order, provided that their distribution or display serves a higher interest of art.*

(2) *However, this authorization shall not extend to distribution and display which would prejudice the legitimate interests of the person depicted or, if deceased, of his or her relatives."*

⁸³¹ Beverley-Smith (n 290) 106; Coors (n 819).

⁸³² Coors (n 819) 3-8; See also, BGH of 8 May 1956, I ZR 62/54 - *Dahlke* - BGHZ 20, 345; BGH of 10 May 1957, I ZR 234/55 - *Spaetheimkehrer* - BGHZ 24, 200.

displaced by section 23(2) if the celebrity can establish that such unauthorised use has breached his/her justified interests. These justified interests include, among other things, exploitation of own image by the celebrity for commercial gains by, e.g., engaging in product endorsement, advertisement and/or merchandising.⁸³³ This implies that even if the celebrity image forms part of contemporary history, he can still object if the unauthorised use was for making undue commercial gains, which in return has prejudiced his own commercial interest in his image. In such cases, however, the Courts are required to balance the celebrity's *general* personality right protected by Articles 1 and 2 of the German constitution against the public right of information and artistic freedom protected by Articles 5(1) and 5(3) of the same constitution.⁸³⁴ The right, as such, breaches only when the former prevails over the latter.

The invocation of the public interest exceptions and the balancing exercise of the court were profoundly seen in cases where the celebrity image has been used in nonconsensual merchandising and/or endorsement cases, as the Court have to curve out what constituted purely commercial use and what was for legitimate public interest. In an early merchandising case of *Nena*⁸³⁵, the German courts formed a view that unauthorised use of celebrity image in merchandising is aimed at profiting on the fame of celebrity concerned and serves no public interest per se. In this case the German singer Nena's name and image were used without consent to merchandise Defendant's T-shirts; the use was found to infringe Nena's section 22 rights and awarded damages in lost license fee.

Subsequently, in another merchandising case involving *Franz Beckenbauer*⁸³⁶, the Court tried to further refine the balancing mechanism, when the Beckenbauer's image taken during a football match was used in wall calendars without his consent. The Court ruled that if the use of image serves primarily an informational purpose, public interest in that purpose will prevail and it will be caught under section 23(1). The public interest in Beckenbauer's claim was held to prevail, since it was in the public interest to be informed on the highlights of the match. If, however, the (mis)use was predominantly for promoting a product and to increase its public appeal by associating the celebrity with it or to show celebrity's approval of it, than that would be a purely commercial use, which would infringe the celebrity's personality right.

In contrast, the German court in *Panini*⁸³⁷ found the use of the pictures of the football players in a sticker album to have no public interest, tilting the balance in favour of personality rights of the players. Similar conclusions were reached in the *Oliver Kahn*'s case⁸³⁸, where the use of footballer Oliver Kahn's name and depiction in a computer game was held not to serve any informational purpose; rather, the use was predominantly commercial to attract more gamers, increase the product appeal and

⁸³³ BGH N.J.W. 2201, 2202 - *Blauer Engel*

⁸³⁴ Coors (n 819) 3-8; See also, BGH of 28 May 2013 – VI ZR 125/12, GRUR 2013, 1065.

⁸³⁵ BGH NJW-RR 1987, 231.

⁸³⁶ BGH NJW 1979, 2203.

⁸³⁷ BGH of 20 February 1968 - *Ligaspieler* - GRUR 1968, 652, 653.

⁸³⁸ Unreported, 13 January 2004, OLG Hamburg.

maximise sale. The use was found to breach Kahn's personality rights (and also section 12 of BGB) and distribution of the impugned game was suspended.

Conversely, in the *Boris Becker*⁸³⁹ case, the unauthorised endorsement use of the tennis player's image on a tennis instruction book, trumped the personality rights of the tennis player, due to the significant informational value which the book entailed by containing various game tips and techniques of famous tennis players of the time. In another case, involving *Becker's* image, being used on a promotional campaign run by a German Newspaper, it was held to hold informational value and, therefore, was not in breach of Becker's section 22 rights.⁸⁴⁰ Oddly, in both of these cases, Becker's image has enhanced the appeal of the subject matters, i.e., the book in the earlier case and the upcoming magazine in the latter, and it was used to draw the attention of the targeted audience to increase commercial gains, but these were not factored in the balancing exercise. These factors were, however, picked by the Court in the case of *Günther Jauch*⁸⁴¹, where the court found the use of his image in the magazine cover to serve no informational purpose, rather it was a stunt to attract more readers. The Court ruled in favour of Jauch and held, mere commercial use without any significant informational content associated with it, will infringe personality rights. Further contrasting *Becker*, in a factually similar case, the Court ruled the use of Gunter Sachs' (a famous German photographer) image in advertising for the Defendant's newspaper to have minimal informative value and the use was in breach of Sachs' personality rights.⁸⁴²

Although these rulings should imply that unauthorised commercial advertising uses (be it in merchandising or endorsement) infringes personality rights of a celebrity, the German Courts were found to allow satirical commercial advertising as an exception to the right; this meant, even purely commercial advertisements that have an opinion-forming characteristics or that make a comment on matters of current public interest (like, on current political situation, as in the case of *Lafontaine*⁸⁴³) would be an exception to the section 22 right. Furthermore, depiction of *Willy Brandt*⁸⁴⁴ (famous politician) on collector's medal was ruled as an artistic use and hence, not a breach of the politician's right. However, use of German golfer, *Martin Kaymer's* likeness in pop-art portraits made by the Defendant failed to qualify as an artistic use (and also held very little informative value) and was ruled to infringe the golfer's personality rights under the Act.⁸⁴⁵

Collectively, the outcome in these cases suggest any unauthorised exploitation of celebrity image in commercial uses like advertising, endorsing or merchandising would *generally* breach the personality right in image unless there is an overriding public interest underpinning the impugned use. These rulings indicate that the German courts

⁸³⁹ BGH of 29 October 2009, I ZR 65/07 - *Boris Becker* - GRUR 2010, 546.

⁸⁴⁰ Ibid.

⁸⁴¹ BGH of 11 March 2009, I ZR 8/07 - *Guenther Jauch* -, NJW 2009, 3032.

⁸⁴² GRUR 2010, 546; BGH of 31 May 2012, I ZR 234/10 - *Gunter Sachs* - NJW 2013, 793.

⁸⁴³ BGH GRUR 1996, 195 - *Gedenkmedaille*.

⁸⁴⁴ BGH NJW 1996, 593 - *Abschiedsmedaille*.

⁸⁴⁵ OLG Duesseldorf of 23 July 2013 - I-20 U 190/12.

have devised a functioning mechanism that balances the competing interests. Interestingly, what these rulings also show, is that there are no set standard or threshold maintained by the court to quantify the informative value or the artistic value required to tip the balance in favour of the infringer. This is evident as the German courts have reached different conclusions in factually similar cases, as seen above. This undoubtedly creates ambiguity as to the application of the section 23 exceptions and may continue to lead to inconsistent results. Further contributing to this inconsistency is the fact that there is no doctrine of binding precedent within the German Courts (unlike in the UK) and previous court decisions have persuasive authority only.⁸⁴⁶ Absent any fixed threshold or binding precedent, the balancing of the interests will continue to be case specific and will turn on facts, and with that, more refined guidelines as to the application of the right and its balancing with the exceptions, will continue to emerge.

Moreover, there was an early debate regarding the true intent of section 22 of KUG, as Beverley-Smith summarised, that some commentator viewed it to protect honour and reputation of the person whose image has been (mis)used and some ruled it as a mechanism to safeguard privacy interests. The cases where celebrity personality rights have prevailed speaks otherwise, since the German courts have afforded protection of non-economic and non-privacy interests under section 22 to the aggrieved celebrities. The Courts in *Marlene Dietrich* explicitly affirmed that the section 22 right is not limited to non-economic and privacy interests but in practice, it is a hybrid right that safeguards both economic and non-economic interests embedded in one's (celebrity's) image.

4.3.1(b) *The specific right of personality in Name*

Section 12 of German Civil Code (BGB)⁸⁴⁷ provides for a specific personality right in one's name, granting an individual the exclusive of control on the use of his name and to prevent others from using it without consent. The term 'name' includes every word or sign that distinguishes/differentiates one person from another and it has been allowed a broad interpretation to encompass first names, surnames, abbreviations of names, pseudonyms, stage names, nicknames, titles, seals, picture signs, coat of arms, etc.⁸⁴⁸ At its broadest interpretation, the right can prevent unauthorised use of celebrity names in merchandising t-shirts, book titles, and even fictional characters.⁸⁴⁹

⁸⁴⁶ Beverley-Smith (n 290) 115.

⁸⁴⁷ Section 12 of German Civil Code BGB (as translated): "*If the right of a person to use a name is disputed by another person, or if the interest of the person entitled to the name is injured by the unauthorised use of the same name by another person, then the person entitled may require the other to remove the infringement. If there is the concern that further infringements may ensue, the person entitled may seek a prohibitory injunction.*" <www.gesetze-im-internet.de/englisch_bgb/englisch_bgb.html#p0049>

⁸⁴⁸ BGH (1983) N.J.W. 1185- Uwe ; BGHZ 155, 273 – Maxemde; Heino (1987) N.J.W. 1413 District Court (LG) Dusseldorf; BGHZ 119, 237 – *Universitätsblem*; Red Cross (Rotes Kreuz) B.G.H. 126.

⁸⁴⁹ See also, N.J.W. 869 CA (1960) (OLG) Munich (Romy); B.G.H. 50, 133 (Mephisto);

The nonconsensual use of name, however, in advertisement or in the public is not a breach of the right unless, the use is only derogatory⁸⁵⁰

In general, to establish a breach of this right, firstly, it must be shown that an identical or confusingly similar name has been used; secondly, the use is unjustified and thirdly, the use violated the interests of the holder of the name.⁸⁵¹ In the context of celebrities, typically, identical names will be used and involvement of the celebrity in the same area of trade as the infringer is in, is not required to satisfy the requirement of confusion; a false impression that the celebrity has consented or associated with the impugned use would suffice. The case of famous German singer, *Caterina Valente* illustrates this well, where an advertisement for dental cleaning fluids contained a fictional singer saying, “...Even though I did not become as famous as my great colleague, *Caterina Valente*, the stage was my world.”⁸⁵² The German court ruled such use of the singer’s name did not infer or created any impression that she had consented to the advertisement or is the maker of the denture fluids in question; thus, no scope of creating any confusion for the purpose of section 12 of BGB. The Court further clarified that section 12 would not apply in circumstances where it is factually obvious that the celebrity in question would never have consented to the impugned use, as in those cases, there is no possibility of confusion in the public owing to such obviousness.⁸⁵³ As to the second requirement, Beverley-Smith directed to several possible justifications offsetting this requirement, like consent/license to use the celebrity name or when the user’s name is identical to that of the celebrity and the user has the entitlement to use his own name.⁸⁵⁴ As to third requirement, the concerned celebrity needs to establish that the unauthorised use has prejudiced his interests; the economic ones, by diluting the brand value in the name; the non-economic ones, by using the name in a way that portrayed the celebrity in the wrong light.⁸⁵⁵

In terms of remedies, although the wording of section 12 suggests to only injunctive relief, since it has been framed within the tort under section 823 of BGB, it can also provide for damages in addition to the injunctive reliefs to the aggrieved celebrities.

4.3.1(c) *The general right of Personality*

The general right of personality with its deep-rooted constitutional foundation in Articles 1 and 2 of German constitution and its enforcements through section 823 of the BGB, operates to safeguard all indicia of one’s personality, including both economic and non-economic interest contained therein. As this right has been framed through judicial law making, unlike its specialist subsets like section 22 of KUG, the right has no fixed confines and no specific qualifying criteria; rather it is capable of flexible and fact-based interpretation. Such abstract nature of the right is considered

⁸⁵⁰ BGH (1981) G.R.U.R. 846 - *Rennsportgemeinschaft*

⁸⁵¹ Beverley-Smith (n 290) 110.

⁸⁵² BGHZ 30, 7 – *Caterina Valente*

⁸⁵³ *Ibid.*

⁸⁵⁴ Beverley-Smith (n 290) 111.

⁸⁵⁵ *Ibid* 112.

as both a strength and weakness; strength, as there are innumerable variations of personality misappropriation, so a rigid right would be less reactive to the ever changing nature of the problem and become redundant too quickly; weakness, as it is interpretation based with no set boundaries, legal inconsistency and unpredictability as to the outcomes of cases are bound to emerge.⁸⁵⁶ In any event, the right, vague or otherwise, caters to the constitutional right on which it is based and remains indispensable when it comes to the protection of personality in Germany.

Moreover, its indispensable nature is attributable to the fact it is an *umbrella* right, that comprises of and complements all other personality rights offered within the German legal system, like section 22 of KUG and the right to one's name under BGB. Although the specific statutory personality rights take precedence in application, the general personality right functions as a safety net to catch those indicia of personality which the statutory rights have failed to protect. This is significant as other indicia like voice, character, identity, styling, etc, which would not fall within the ambit of protection under section 22 of KUG or section 12 of BGB, are likely to fall within the general right of personality and thus, offering protection to virtually all forms of celebrity persona. Nevertheless, in every case involving personality rights, the Court is minded considering whether the application of the general right of personality is necessary to cover any gaps, if any is created despite the (in)application of the specific personality right. Illustratively, as section 22 of KUG offers no protection against secret/long-lens photography, the general right of personality was applied to afford protection to the aggrieved celebrity in *Spatheimkehrer*.⁸⁵⁷ Also, in the case of *Caterina Valente*⁸⁵⁸, the right of name in section 12 BGB did not protect the singer against the unauthorised use of her name in an advertisement and the Court considered the general right of personality to check whether any protection could be allowed to the celebrity. Most significantly, whenever any section 23 exceptions to the section 22 specific right is raised, the court employs the general right of personality to strike a balance between personality rights and public interest. In complementing the other personality rights, the general right of personality upholds 'dignity' as required by Article 1 of the Constitution and also ensures the free development of personality warranted under Article 2.

In terms of transferability and descendibility of the general right of personality, it was doctrinally unavailable at first since it was considered to be a purely personal right. Such conceptualisation meant that the rights are too personal to be waived allowing others free access or assign its use to a third party. It also meant that the right extinguishes upon death, and it is not passed on to the estate, so postmortem, one's personality is freely accessible, without requiring any prior consent or authorisation. The German courts maintained this position denying its inheritability by the estate, but it was so only as to the general personality rights. The court's position regarding the

⁸⁵⁶ Beverley-Smith (n 290) 113; A Ohly, *Case law and general clauses in the law of unfair competition : a comparison of methods in English and German law* (C Heyman 1997).

⁸⁵⁷ BGHZ 24, 200 – *Spatheimkehrer*.

⁸⁵⁸ *Caterina Valente* (n 852).

section 22 KUG right of image, which provisioned for transferability and post-mortem descendibility, was completely different. The German Courts, however, shifted positions, in the case of *Marlene Dietrich*, where it was affirmed that not only that the general personality rights protect both economic and non-economic values of celebrity persona, but also that such economic value survives post-mortem, being enforceable by the estate of the deceased celebrity. The rulings in this case were significant and equally controversial at the same time, since it admitted the true scope of the general right, which was apparent from its application by previous German courts but was never expressly affirmed. The controversy was more because of the Court *ratioed* that post-mortem the right should not also prevent such uses which dishonours or disrepute the deceased celebrity (non-economic values) but should also prohibit commercial exploitation of that persona without the consent of the estate. Further gaslighting (for better, though) was done, when the Court justified this on the rationale that the celebrity should be allowed to preserve the economic value of his persona earned through painstaking efforts during the lifetime, even after his death, and to be passed on to the estate together with all other assets. Based on these reasonings, the court awarded monetary compensation to the heirs of the late actor for postmortem breach of the actor's general personality rights. Post *Marlene*, the Court now recognise the patrimonial/economic values of the persona to be inherited and accordingly safeguarded through the general right of personality.

In addition, the general personality right has been applied to safeguard invasion of privacy; the right prohibits secret photography, surveillance, telephone tapping, recording conversation, analysing blood samples or genes, even opening another's letter, and reading another's personal diary⁸⁵⁹. It has been applied to prevent publication of personal information, which is also prohibited under German Criminal Code and also by way of the German Federal Data Protection Act (BDGS).⁸⁶⁰ The right has been applied in cases involving defamation as well, which is also a criminal offence under sections 185 and 186 of the German Criminal Code. In defamation cases, the right enables the scope for a civil liability, entailing damages/monetary compensation to the aggrieved party, which would not be available through Criminal prosecution.⁸⁶¹ Beverley-Smith added, Criminal Code is restricted to prohibiting intentional libel and slander, but the general right prohibits those as well as bring in negligent defamation within the purview of liability.⁸⁶² It has been also used to prohibit portraying celebrities in a false light which is not defamatory, that is, presenting them in a way that contradicts their public image, belief or ideology. The *Gentleman Rider* case⁸⁶³ appears to be the fitting example, where the picture of an amateur show jumper was used in an advertisement for a sex enhancement drug without his consent and was found to violate his personality rights.

⁸⁵⁹ See cases like, BGHZ 24, 200 at 208; BGHZ 27, 286; BGH NJW 2005, 497.

⁸⁶⁰ See, BVerfG 35, 202 – *Lebach*.

⁸⁶¹ Beverley-Smith (n 290) 117.

⁸⁶² Ibid 118.

⁸⁶³ BGHZ 26, 349 (1958). See also, *Caterina Valente* (n 852).

Such expansive application of the general right has, therefore, made it an all-encompassing right that caters for invariably all forms of privacy, publicity and personality interests. Although it was initially formulated to safeguard the non-economic aspects of one's persona, it has been now significantly transformed to include both the economic and non-economic aspects of persona. The flexible and innovative judicial activism in this context, coupled with the inclusion of economic interests, has shaped this right as a general personality right that accords exclusive right of control over the commercial exploitation of all aspects of personality.

To conclude, in Carty's⁸⁶⁴ lens, personality rights offered in the German legal system is a fixture of tort, human rights, privacy, and restitution, and the true ambit of its protection ultimately depends on the facts of each case. Given how the general right of personality has been successfully applied and protection given in cases involving privacy, defamation and/or publicity interests, it will be extremely difficult to displace Carty's view. Celebrities in Germany enjoys a multi layered protection in relation to their persona, if they cannot qualify for the specific rights under KUG or BGB, they still have the option to resort to the overarching general right of personality. Notwithstanding, the inherent vagueness of the right, which may lead to inconsistent/unpredictable outcomes, it has the teeth to protect a celebrity's both economic and non-economic values embedded in his persona. Though critiques⁸⁶⁵ have argued that post-mortem protection was not so significant compared to that pre-mortem – in terms of compensation; but one needs to accept that having at least some post-mortem safeguarding is better than having no safeguarding at all. Nevertheless, the rights, both general and specific, would be balanced against legitimate public interest, which again commands significant unpredictability and uncertainty absent any fixed threshold or precedent to follow. Therefore, options for protection in Germany are promising, but the uncertainty looming within the all-encompassing general right and the balancing mechanism can conveniently cloud the path of protection for any celebrities in the country.

4.3.2: France

The French Legal System does not provide for any distinct personality rights like Germany or publicity rights like in the US. It recognises a series of rights, including but not limited to moral rights of authors, right of privacy, right to one's honour and reputation, and right to control one's image, which, collectively, were referred to as 'personality rights' by the commentators and practitioners.⁸⁶⁶ Based on such recognition, right of image was initially perceived as a minor right triggered to protect

⁸⁶⁴ Carty (n 61) 239.

⁸⁶⁵ See A. Jooss, 'Life after death? Post mortem protection of name, image and likeness under German law,' (2001) 12(5)Ent L.R. 141.

⁸⁶⁶ See, Jeanne M. Hauch, Protecting Private Facts in France: The Warren & Brandeis Tort Is Alive and Well and Flourishing in Paris, (1994) 68 TuL. L. REv. 1219, 1228. See also, Elizabeth Logeais and Jean-Baptiste Schroeder, 'The French Right of Image: An ambiguous concept protecting the human persona,' (1998) 18 Loy. L.A. Ent L.J. 511, 513.

one's privacy interest. It was not until the middle of 19th century that this right of image gained prominence as a separate right through judicial law making.

In *Rachel Affair*⁸⁶⁷, a case involving the French actress Rachel, the Court for the first time recognised the right of image, when an artist drew a portrait, without consent, of the actress on her deathbed. In prohibiting the artist from using the image drawn, the court held, "*No one may, without the explicit consent of the family, reproduce and bring to the public eye the image of an individual on her deathbed whatever the celebrity of person involved*".⁸⁶⁸ Through this ruling the Court set the course for an individual to prevent unauthorised use, reproduction and/or dissemination of his image. Similar application was evident in a subsequent case, where a photographer used an image of a child in the window of his studio without the consent from the parents of the child.⁸⁶⁹ Both of these cases marked the beginning of the French right of image '*French Droit a l 'Image*', where the judges enforced the right through the tort principles enumerated in Article 1382 of the French Civil Code. The judges, however, only applied the right when an invasion of one's privacy or damage to one's honour and reputation was apparent – effectively restricting it within the realm of privacy despite giving it the footing of a separate right.⁸⁷⁰ Interestingly, the Court's position was not entirely what it intended to be – particularly looking at the ruling in *Rachel Affair* – as the ruling, although based on privacy interest, included "...as much consideration for the property aspect of the image as it did for the tort aspect..."⁸⁷¹. Subsequent rulings on the application of the right maintained its statutory footing but gradually outgrew the confines of privacy and emerged as a right, which is triggered not only in breach of privacy cases, but also in cases where there is no privacy issue at all and even where only economic interest were affected.

In the following segments, the statutory footing of the right will be first analysed with the likely exceptions to the right that surfaced through case laws and other competing interests. Once the basic cause of action and the exceptions are analysed, emphasis would be drawn on the alleged nature of the right, following which the transferability and descendibility of the right will be considered.

4.3.2(a) Statutory Cause of Action to protect one's image rights:

Protection against unauthorised use of one's image can be found in both the French Criminal Code and French Civil Code.

Article 226(1) of Criminal Code renders punishable any intrusion to another's private life by either capturing, recording, transmitting words pronounced in private without the author's consent or by fixing, recording or transmitting, through any device, the image

⁸⁶⁷ T.P.I. Seine, June 16, 1858, D.P. III 1858, 52.

⁸⁶⁸ Ibid; See also, Jeanne (n 866) 1228; Logeais and Schroeder (n 866) 513.

⁸⁶⁹ T.P.I. Poitiers, Oct. 21, 1935, D.H. 1936, 45.

⁸⁷⁰ See, Jeanne (n 866) 1237.

⁸⁷¹ See, Logeais and Schroeder (n 866) 514.

of a person in a private place, without his consent.⁸⁷² Article L226(8) complemented this further by criminalising intentional publication of false stories or manipulated photographs of a person without his consent unless the false nature is clearly mentioned in the publication or is obvious⁸⁷³. Article 9 recognises the commercial value of celebrity persona and enables monetary compensation to be claimed in the event of breach of the right.⁸⁷⁴ Article 226 also provisions for custodial sentences to the infringer for the unauthorised exploitation of celebrity persona, which serves as a strong deterrent. The time to commence action under the Code is 3 years and the complainant bears the burden of proof to show an intent to take or disseminate the image and that the image was taken on a private property.⁸⁷⁵ The protection under the Criminal Code, however, is very rarely invoked in cases of misappropriation of one's image; typically, seeking relief under the French Civil Code is more popular.

The French right of image is a product of judicial interpretation and expansive application of the tortious liability principles enshrined in Article 1382 of the French Civil Code. Article 1382 stipulates, (*as translated*) “...any person who performs an act that harms another person must compensate the other for the harm caused by that act.”⁸⁷⁶ This provision of the Civil Code has been extended by the French Judiciary to establish the general principle that any person, famous or otherwise, has the right to prevent publication of his image without his consent.⁸⁷⁷ The robust judicial interpretation and application of this general principle in light of the Civil Code, has attributed 4 characteristics to the image rights that it is today.

Firstly, the form or medium that is used to reproduce or disseminate one's image is irrelevant; in that, the right covers all forms of unauthorised reproduction of photographs, portraits, use of image in news articles, books, and even in the form of figurine dolls or cartoon character in a video game.⁸⁷⁸ Secondly, the right covers fictitious names or stage names of performing artists that reflect their persona⁸⁷⁹; in that, the right recognises that fictitious names or stage names are usually unique and chosen by the artist/celebrity himself, which often attributes special characteristics to their persona. Nicknames, however, as given by the fans or followers, may fall outside the ambit of this right.⁸⁸⁰ Thirdly, the right is triggered only when the person is recognisable from the unauthorised reproduction/dissemination of his image; in that, the test is whether it is possible to identify/recognise the person from the image (mis)used. This test, interestingly, applied differently depending on the ‘known-ness’

⁸⁷² See, French Penal Code (Chapter VI), Article 226-1.

⁸⁷³ T.G.I. Paris, 17e ch., Correct., Mar. 6, 1997 (*Prince Rainier III*)

⁸⁷⁴ *Brigitte Bardot v Beaverbrook Ltd*, *Semaine Juridique* 1966, No. 14521; *Catherine Deneuve*, D. 1976, 291; See also, F. Ponthieu, ‘France: Sport – Right to protection of your own image’, (2001) 12(6) Ent L.R. 59.

⁸⁷⁵ *Ibid*; See also, CA Paris, Mar. 11, 1971, D. 1971, 71- 447 (*Foulon-Piganiol*), CA Paris, Jan. 11, 1987, Gaz. Pal. 1987, 1-138, (*Bertin*).

⁸⁷⁶ Article 1382 Code Civil (actual wording in French): “*Tout fait quelconque de l'homme qui cause ti autrui un dommage, oblige celui par la faute duquel il est arrive, ii le rdparer.*”

⁸⁷⁷ Logeais and Schroeder (n 866) 519.

⁸⁷⁸ CA Versailles, June 30, 1994, D. 1995, 645, (Ravanas); CA Versailles, Mar. 8, 1996, Gaz. Pal. 1996, 213 (*Phillippe Le Gallou v Fode Sylla, Jeu National Multimedia and the Front National*).

⁸⁷⁹ *WS v Jourdain*, Cass. 1e civ., Feb. 19, 1975, Ann. 199, 153.

⁸⁸⁰ *Ibid*; See also, Logeais and Schroeder (n 866) 520.

of the concerned person. If the image reproduced is that of an unknown person, the reproduction must be clear and/or must contain such elements that allows undeniable identification⁸⁸¹; whereas, in case of celebrities/famous person, the test is relaxed, as mere imitation, look-alikeness or even use of distinctive features would suffice for the purpose of recognition.⁸⁸² Therefore, it appears that the right is not limited to image or physical appearances only; use of celebrity voice from which the relevant celebrity can be identified will be actionable (as seen in the case of French singer, *Maria Callas*⁸⁸³); so will be the use of sound-alike imitation of an actor's unique and distinctive voice.⁸⁸⁴ As far as celebrity pseudonyms are concerned, protection will be extended if the celebrity can demonstrate continuous and widespread use of that pseudonym in his field of activity and the likelihood of public confusion due to the impugned use.⁸⁸⁵

Lastly, the right warrants the necessity of consent, both at the time of taking the image and for the subsequent use of the same.⁸⁸⁶ The consent required, must be express, taken prior to the use and specific as to the intended use.⁸⁸⁷ Whether the consent in question was sufficient and its scope covered the impugned use is ultimately within the remit of the court's discretion.⁸⁸⁸ Requiring consent in two folds, is particularly favourable for celebrities, because often celebrities might not object to the taking of their image but may do so in respect of subsequent dissemination, either for privacy or for publicity reasons. Also, the specific nature of the consent meant that consent must be given for a specific use and duration.⁸⁸⁹ Such a requirement further rules out the possibility of inferring a 'waiver' of the right for future uses based on the consent given to a past use.⁸⁹⁰

Collectively, it is apparent that the right has been developed through an intricate interplay of the Civil Code and judicial interpretation through cases involving one's persona. The wording of the Code is capable of broad interpretation, allowing wide scope of protection and the flexibility to accommodate novel situation. The same judiciary, however, has been cautious as to not creating an absolute right or allowing a monopoly over one's image. The case laws, therefore, have also devised several exceptions to the right, particularly taking into account the need to balance the image right with competing interests in freedom of speech and expression that is recognised in the Civil Code and contained in the European Convention on Human Rights (which

⁸⁸¹ *Epoux Lavergne and Francois Bornet v R. Doisneau* (Hotel de Ville case) T.G.I. Paris, 1 e ch., June 2 1993, Gaz. Pal. 1994.

⁸⁸² T.G.I. Paris, 3e ch., Feb. 24, 1976 [*Belmondo, Halliday and Vartan v. Eminence*]; T.G.I. Paris, Dec. 3, 1975, D. 1977-211, note Lindon [*Pidplu v. Regie Francaise de Publicit*].

⁸⁸³ T.G.I. Paris, 1982, D. 1983, 147 [*Maria Callas*]

⁸⁸⁴ *Hotel de Ville Case* (n 881)

⁸⁸⁵ *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', (2003) 14(6), Ent.L.R., 66.

⁸⁸⁶ T.G.I. Paris, Mar. 6, 1996 [*Beatrice Dalle v. RCS France*].

⁸⁸⁷ T.G.I. Nanterre, ord. rdf., Aug. 24, 1996 [*Daniel Ducruet v. Prisma Presse*]; CA Paris, May 3, 1989, C.D.A., 273 [*Serge July, Std Nvelle de Presse et Communication v. Amar Tamarat*].

⁸⁸⁸ *Ibid.*

⁸⁸⁹ CA Paris, May 22, 1992, Juris-Data 022338 [*Sabathier v. SteEmotion*]; CA Paris, Feb. 2, 1993, Juris-Data 020353 [*SARL Communication Publication Language v. Baillie*]; CA Paris, May 11, 1994, D. 1995-185 [*SA Baxter Music v. Stl Orangina*].

⁸⁹⁰ Civ. 2e, Jan. 1971, D. 1971, 263, [*Soc. Presse Office v. Sachs*].

France has incorporated into their legal system). The next segment will steer through all such exceptions/defences and demonstrate how the balancing exercise is usually done by the French courts.

4.3.2(b) *Exceptions:*

The first exception is the use of photographs taken in public places. The French courts have defined a public place as "*...a place which anybody can have access to without special authorization, regardless of whether access is subject to some specific conditions, timetables or reasons.*"⁸⁹¹ So, prior consent will not be required if a photograph is taken in such places, as long as the photograph does not solely focus on or single out the person depicted and the photograph is of the person engaged in public and not private activities.⁸⁹² Such an exception, however, is unlikely to stand if photographs taken in public places are used for commercial purposes instead of news reporting purposes.⁸⁹³ This exception may be also displaced if the photograph is used to ridicule the person depicted or disparaging captions has been used in conjunction with the photograph.⁸⁹⁴

The second exception is the use of photographs for parodical work/purposes. The French courts view parody as a form of social commentary and literary criticisms with humour, and recognises that, it is a method of exercising one's freedom of speech and is a crucial element for any democratic society.⁸⁹⁵ The Court further recognises that the parodical work does not portray the truth or reality, and as long as the parody is non-offensive, but humorous and informative, no prior consent will be required for using photographs in such purposes.⁸⁹⁶ However, if the parody amounts to a mockery of the person depicted in the image, which is ultimately detrimental to the trademark that the depicted person is associated with, then such the parody exception will not stand as a defence.⁸⁹⁷

The third and the most prominent of the exceptions, is the use of the image in a newsworthy context that serves freedom of speech and the right to information. As aforementioned, the Article 10 of ECHR applies to the French legal system and the legal system by itself recognises similar rights in freedom of speech and information, through the Liberty of Press laws⁸⁹⁸. As such, the French courts are minded balancing such rights with the image rights before adjudicating any allegations of breach. For the purpose of this balancing exercise, the term 'information' has been widely

⁸⁹¹ G. Levasseur, 'Protection of the Person, the Image, and the Private Life (the Criminal Law)', (1994) Gaz. Pal. 996; See also, Logeais and Schroeder (n 866) 526.

⁸⁹² Paris, Feb. 27, 1981, Gaz. Pal. 1981.; See also Beverley-Smith (n 290) 173.

⁸⁹³ T.G.I. Nancy, June 8, 1973, D. 1974, 126 [T.V v. L'Est Rpublicain et StO Sanal Eco]; CA Paris, le ch. A, Sept. 27, 1988, Gaz. Pal. 1989, [Rapho v. UFC].

⁸⁹⁴ Rapho v UFC (n 893)

⁸⁹⁵ CA Paris, Mar. 11, 1991, Feb. 18, 1992.

⁸⁹⁶ Ibid; CA Paris, 4e ch. B, Nov. 22, 1984, D. 1985, I.R. 165; T.G.I. Nancy, Oct. 22, 1976, JCP 1977, II, 18526.

⁸⁹⁷ Civ. 2e, Apr. 2, 1997 D. 1997-411.

⁸⁹⁸ See, Loi sur la liberte de la presse [Law on the Liberty of the Press], Law of July 29, 1881.

construed.⁸⁹⁹ The French court sees participating in events that entails public interest as putting the person participating into the realm of public information and his image/photograph, resultantly, losing the protection of the right.⁹⁰⁰ Based on such rationale, publication of photographs of 1995 bomb attacks⁹⁰¹, recording of images and/sounds during court proceedings (with prior authorisation from the Court) were allowed⁹⁰². Moreover, to establish the informative purpose, the information must be 'useful'; in that, the fact or photograph published must be “...*directly linked to the relevant events and has to occur for the purpose of informing the public.*”⁹⁰³ However, the use must be purely informative in nature; any commercial element would preclude this news-reporting exception.⁹⁰⁴ This is contrasted by the ECtHR as it recognises commercial speech in the form of advertisement as a part of the Article 10 right.⁹⁰⁵ In addition, the French courts also recognise 'freedom of art' and as such, use of image for literary and artistic works are likely to be exempted from the image rights.⁹⁰⁶ Also in case of fictional works – which are inspired by news item – the court ruled that such works should be allowed for the purpose of serving the interests in freedom of expression.⁹⁰⁷ However, even for fictional/artistic use, where the image comprises of nudity or is a photograph of nude scene in a film, prior consent from the person depicted must be obtained in order to avoid liability.⁹⁰⁸

4.3.2(c) Dualistic Nature of the Right:

Now that the cause of action and the likely exceptions of the right in general are on the table, it is imperative to understand the nature of right itself. As already discussed, the right gained recognition in the mid-19th century and remained as an extension or spin-off of privacy for over a half a century since its inception. The right finally emerged from the shadows of privacy into an independent right through the case of *Papillon*⁹⁰⁹, which concerned the publication of a former convict's image without consent on the cover of the book, that also contained his life stories. The Court clarified that the impugned publication did not infringe the privacy of the former convict, but the use of his image on the cover of the book infringed his right of image and the convict was awarded damages. Interestingly, the *Papillon* ruling, not just established that right of image is no longer dependent on privacy for it to be triggered, it also showed that the right can be applied to safeguard commercial values that one may have in his image. With this at the fore, two separate school of thoughts emerged in relation to the right.

⁸⁹⁹ See, Logeais and Schroeder (n 866) 528.

⁹⁰⁰ T.G.I. Paris, Sept. 10, 1996, D. 1997.

⁹⁰¹ Ibid.

⁹⁰² See, Law of the Liberty of the Press, July 29, 1881, Article 38.

⁹⁰³ T.G.I. Paris, July 3, 1974, II, 17873.; See also, Beverley-Smith (n 290) 177.

⁹⁰⁴ T.G.I. Paris, Dec 21, 1983, D. 1984, Somm. 331 [*Noah v Soc. Frse de Revues Team*].

⁹⁰⁵ CEDH Feb. 24, 1994, Casado Coca, Serie ANo. 285.

⁹⁰⁶ TGI Paris (re'f.) 17.9.1984, D. 1985, somm., 16 – “*if everybody is entitled to claim that the image he wants to give of himself not be seriously distorted, freedom of expression and the integrity of an artistic work must however, be safeguarded*”; See also, Beverley-smith (n 290) 173.

⁹⁰⁷ TGI Paris 8.7.1970, JCP 1970, II, 16550; Cass. civ. 3.12.1980, D. 1981, jur., 221.

⁹⁰⁸ TGI Seine 4.10.1965, JCP 1965, II, 14482. – Cass. civ. 13.2.1985, D. 1986, somm., 51.

⁹⁰⁹ T.G.I. Paris, ord. ref., Feb. 27, 1970, JCP 1970, II, 16293 (*Papillon*)

There is the traditional view that the right is a personal right and not a proprietary right, despite the court concluding in the contrary; on the other side, there is this other view that the extent of the right is ambiguous and embodies two concepts.⁹¹⁰ One concept is that the right safeguards privacy interest since it prevents unwanted intrusion/exposure, which makes it a purely personal right that cannot be quantified in value and inalienable from the holder of the right (i.e., the extrapatrimonial nature of the right). This is conceptually called the '*right to image*' that affords an individual with an exclusive right over his image to decide its use.⁹¹¹ The other concept is that the right is actually protecting a highly marketable asset – particularly, images of celebrities/famous people, which third parties are willing to use in return for a fee. This concept basically recognises the commercial value (i.e., the patrimonial nature) that may be embedded in one's image and has been conceptually called '*the right of image*' that will be triggered, absent any privacy issues, to recover lost profits on the unauthorised use of image.⁹¹²

These two competing concepts were finally assessed by the Court in *Les Editions du Sand & Pasquito v Kantor*⁹¹³, where the French actor, Coluche's images were published in a book without consent (after his death) and some of those photographs were taken in a private context and also during the actor's funeral. In this case, the Court ruled in favour of the actor's widow, who initiated the claim as a breach of the actor's image right, stating that the use has breached the actor's privacy and not only prejudiced the image of the deceased actor but also that of the widow. Interestingly, in respect of the claimed breach of image rights, the Court controversially stated, "*The right of image is a personality right which entitles anyone to oppose the dissemination and use of his or her image without prior consent the violation of this right may cause to its holder moral damage and, as the case may be, economic damage whenever the holder conferred a commercial value to his or her image due to his or her activities or notoriety.*"⁹¹⁴ With this ruling, the Court has blurred the borders between the two competing concepts and affirmed the dualistic nature of the right. Simply put, the image right can safeguard both extrapatrimonial and patrimonial values that the image may hold.

Logically, the '*right of image*' would certainly apply in cases involving celebrities, whose fame and well-knownness has conferred a commercial value to their image and their persona as a whole, and the use of which, in marketing/advertising forms, is an essential part of their career. The celebrities, however, would be required to have commercially exploited their image prior to the unauthorised use in order to qualify for the patrimonial side of the right.⁹¹⁵ The French courts' quantification of damages in

⁹¹⁰ Logeais and Schroeder (n 866) 517.

⁹¹¹ B. Edelman, 'Sketch of a Subject's Theory, Man and his Image,' (1970), Chron. 120; E. Gaillard, 'The Dual Nature of the Right of Image and the consequences on French Positive Rights', (1984) Chron. 161

⁹¹² D. Acquarone, 'The Ambiguity of the Right of Image', (1985) Chron. 129; M. Serna, 'The images of people and goods', (1997), Chron. 100.

⁹¹³ CA Paris, Sept. 10, 1996, R.D.P.I., n.68 [*Les Editions du Sand & Pasquito v Kantor*].

⁹¹⁴ Ibid.

⁹¹⁵ Eric H. Reiter, 'Personality and patrimony: Comparative perspectives on the right to one's image.' (2002) 76 Tul. L. Rev. 673.

such cases, however, has been rather odd; in that, while it required prior commercial exploitation by the concerned celebrity to qualify, it awarded him lower damages, on the basis that, the more the image has been used, the less valuable it becomes and *vice-versa*.⁹¹⁶

Nevertheless, the current perception of the right remains dualist in nature, with non-celebrities generally benefiting from the negative extrapatrimonial right to prevent unwanted exposure; celebrities benefiting from this negative extrapatrimonial right and additionally, from the positive patrimonial right to safeguard the commercial aspect of their image as well.

4.3.2(d) Transferability & Descendibility of the Right

'Consent', which is a condition precedent for use of any image, can be given or licensed to third parties for a fee or even for free.⁹¹⁷ Consent given to third-parties basically acts as a waiver of the right of image and such waiver may be compensated with a fee and the fee payer to benefit from this immunity. However, the law is silent as to the specifics of the licensing of the right and/or the extent of the waiver for a fee or otherwise. The French courts, regardless, had remained inclined towards upholding the fame and goodwill of celebrities by recognising the painstaking efforts they have given to attain those and stressed on the need to allow them the control over the exploitation of that fame and goodwill.⁹¹⁸ Such recognition of the courts, brought in the concept of 'brand image' or the reputation attached to the persona within the parameters of image rights, ultimately, marking the plausibility of licensing or transferring such brand image or reputation to the third parties as a part of controlling the exploitation of his image by the celebrity himself.

In any event, the French law of contract accords for consent to be contractually granted to third parties, and such contractual grant of consent has developed the practice of image licensing, endorsing, character merchandising, sponsorships, etc., significantly for celebrities. As the general rules of French contract law dictates such agreements consenting to the use of image, it will be considered valid and enforceable unless the agreement is against public policy and moral standards, in which case it will be null and void as per the Civil Code. Also, such agreements could be challenged if it comprises of a general and perpetual waiver or transfer of the right, again on the grounds of public policy and also because the right is also based on privacy interests.⁹¹⁹

In terms of descendibility of the right, it depends on dualistic nature of the right; in that, if the right is construed as extra-patrimonial being an extension of privacy, then the right is inalienable from the celebrity and so, not capable of descendibility; if it is

⁹¹⁶ Logeais and Schroeder (n 866) 513.

⁹¹⁷ J. Ghestin & G. Goubeaux, 'Treatise on Civil Rights: Individuals', (1989) L.G.D.J. 292, 315.

⁹¹⁸ T.G.I. Paris, 1e ch., Apr. 20, 1977, D. 1977, 610 [*Christian Alers v Pierre unia*]; See also, Logeais and Schroeder (n 866) 533.

⁹¹⁹ Logeais and Schroeder (n 866) 533.

construed as a patrimonial right that accounts for the commercial value of the image, then the right is detachable and descendible. The position of the French legal system, therefore, is somewhat controversial in this aspect. This controversy has led to a divide among the commentators; those in favour of descendibility are also divided in two groups, some say that the heirs receive the right in succession, other says, right is received in a representative capacity only.⁹²⁰ Those against descendibility clearly says that such rights are personal rights which extinguishes with the death of owner and the claim of the heirs is basically against the breach of their own privacy interest.⁹²¹ The case laws have been inconsistent as well. In *Rachel Affair*, the court deliberated to safeguard the rights postmortem stating that it has passed on to the heirs through succession⁹²². In *Maria Callas*, heirs were allowed their claim, not because they inherited the right by succession but because of the damage they themselves have sustained due to the harm done to the singer's right by the impugned use. By contrast, descendibility was not allowed at all to the heirs in another French singer's case of *Claude Francois*⁹²³. In *Mattise v Aragon*⁹²⁴, the Court held that the heirs can only claim if the impugned use has injured the memory of the deceased. Invariably in all of the cases where descendibility has been refused, the Court based their decision on the rationale that "...the right of privacy only belongs to living persons and cannot be passed to the heirs"⁹²⁵

Subsequently the court, in *Raimu*⁹²⁶ shifted from the position that offensive use to the memory of the deceased was not required, as taking no authorisation from the window of the deceased actor and depriving her from the profits made through the unauthorised use, was sufficient for the claim to sustain⁹²⁷. This view of the court gained further support in the latter case involving a French comedy actor, Colouche, where the Colouche's right of image was held to be descendible to his widow, where the court confirmed, "...heirs may seek relief for the moral harm caused by such violation...is likely to impair the perception....of the deceased artist, they are entitled to full compensation of the economic damage stemming from said violation."⁹²⁸ Both of these cases confirmed, not only that the French right of image has a dualistic nature, but also that it is descendible, and post mortem claims cannot be brought unless such (mis)use impairs the moral character of the deceased celebrity or causes economic losses for the heirs in lost license fees or profits. These cases, undoubtedly set the course for a shift towards recognising the descendibility of the right of image; however,

⁹²⁰ J Ravanas, *La protection des personnes contre la re'alisation et la publication de leur image*, (Paris LGDJ 1978); See also, J. Ghestin et G. Goubeaux, *Traite' de droit civil* (Paris LGDJ, 1989) 260; See also, Beverley-Smith (n 290) 201.

⁹²¹ Pierre Kayser, *La protection de la vie prive'e par le droit*, (3rd edn. Economica 1995) 313.

⁹²² See, Beverley-smith (n 290) 202.

⁹²³ CA Paris, 4e ch., June 7, 1983, Gaz. Pal. 1984, 2, 258 [*Societe Bonnet v Societe Cashart United Diffusion Moderne*].

⁹²⁴ CA Paris 3.11.1982, D. 1983, jur., 248. Followed in TGI Strasbourg (re'f.) 31.5.1989, D. 1989, somm., 357; CA Paris 19.5.1992, JCP 1992, IV, 2345; CA Paris 23.11.1993, Le'gipresse 1994, No. 114, II, 132; TGI Paris (re'f.) 4.8.1995, 167 RIDA (1996) 291 RIDA 1996, No. 167, 291; CA Paris 6.5.1997, D. 1997, jur., 597.

⁹²⁵ CA Paris, 11e ch., July 2, 1997, D. 1997, 596.

⁹²⁶ T.G.I. Aix en Provence, Nov. 24, 1988, J.C.P. ed. G. 1989, II, 213293 (*Raimu*)

⁹²⁷ Mme Brun v SA Expobat, T.G.I. Aix en Provence, Nov. 24, 1988, JCP ed G. 1989, II, 213293

⁹²⁸ CA Paris, Sep. 10, 1996, R.D.P.I., no. 68, 63 [*Les Editions Sand & M. Pascuito v. M. Kantor, Mine Colucci*]

this aspect of the right is far from being settled. To bring forth some clarity on this the Court drew analogy with the performing artists' right under the French Intellectual Property Code, Article L 212(2), which allowed for descendibility of such rights⁹²⁹. The Higher courts, however, gave a strict interpretation of this Article and shifted back to the proposition that heirs are not allowed to claim to safeguard their personal interest (as was allowed in *Raimu* and *Colouche*) but only to safeguard the interest of the deceased celebrity, all so in a representative capacity (as seen in *Mattise v Aragon*).⁹³⁰

As conclusion, the emergence of the French right of image mirrors that of the US right of publicity in that, both of them had roots in privacy but gradually outgrown it to become a distinct right of its own. The only difference being in the US, a standalone right of publicity entailing proprietary interest in persona was established but in France the right of image was stretched to encompass both extrapatrimonial (non-economic) and patrimonial (economic) values of persona. With the dualistic nature of the right, although the extrapatrimonial side sits well-grounded on privacy and tort principles in the Civil Code, the basis of the patrimonial side is still unclear. The French court firmly retained their view of such rights being very personal in nature, so having a basis on proprietary right seems unlikely for the time being. Nevertheless, the French right of image, as it currently stands, is broad in its application; it encompasses the protection of other aspects of persona, as long the test of recognisability is satisfied. There are, however, uncertainties, as to true extent of its scope given its dualistic nature and unclear rationales, which ultimately has a bearing on the levels of compensation recoverable (and remedies as a whole), and most significantly on the descendibility of right.

4.3.3: Italy

In the Italian legal system, there is no statutory right of personality or publicity for the celebrities. It offers protection to several aspect of celebrity persona through various provisions of the Italian Civil Code and its complementary legislations. The Italian common law, however, provides for the legal principle, namely 'right of publicity' which is the outcome of the judiciary's expansive interpretation of the existing Civil Code and legislations, which recognises some right in celebrity persona. Such legal principle, as will be seen, has been devised to cater specifically for celebrity persona and the judges had maintained a *pro-celebrity* stance when it came to the application of the right.

4.3.3(a) 'Typical' Rights in Name, Pseudonym & Image Under Italian statutes:

The Italian Civil Code and its complementary legislations provides for the protection of several aspects of (celebrity) persona. The rights enumerated in such legislations

⁹²⁹ T.G.I. Paris, le ch., Apr. 23, 1997 [*Bertand Blier et Brigitte Blier v. BNP, EURO RSCG France, Gaunont et Annette Blier*]

⁹³⁰ Ibid; See also, T.G.I. Seine, Apr. 1964, Gaz. Pal. 1964-2-2233.

typically safeguards the specific subject matter, that is, the particular aspect of persona it is targeted at protecting, and hence, referred to as 'typical rights' within the Italian legal system.

Such typical rights include protection of *name* under Article 6 & 7 of the Italian Civil Code. Article 6⁹³¹ of the Code recognises the right and expressly prohibits unauthorised and improper use of name by third parties. It clarifies that every name holder has the right to the name held, including his given name and surname. Article 7⁹³² compliments Article 6 by allowing for injunctive relief and also recourse to damages in the event the protected name is exploited without consent. Article 6 and Article 7, both also extends protections to pseudonyms (another aspect of persona), if it has been used by the holder in such a way that it acquired significance of a name.⁹³³

The typical rights also include right of image through Article 10⁹³⁴ of the Code, which prohibits the use of (celebrity) image or likeness, without consent. Any unauthorised use of image or likeness that is detrimental to the depicted person's dignity or reputation, i.e., abusive use, will be caught under this Article and injunctive relief and/or damages would be awarded to the person depicted/portrayed. Article 10 right of image is complemented by sections 96 and 194 of the Italian Copyright Law 1941, which also expressly prohibits reproduction, display or commercial exploitation of one's image/portrait, without prior consent. Article 10 right, as such, caters for the non-economic values of dignity and reputation in one's (celebrity's) image and the Copyright provisions, in addition to such non-economic values, safeguards the economic values that are embedded in the image (mis)used. The Copyright provisions, however, allows nonconsensual uses if such uses are justified in the interest of justice, general public interest, for scientific or cultural reasons, or because the person portrayed is notorious or holds a public office.

Whilst these typical rights appear to offer comprehensive protection to celebrity name, pseudonyms and image, being very specific in nature, it failed to cover or extend protection to other indicia of celebrity persona, including but not limited to voice, signs, character, identify, unique mannerisms, etc. It, as such, created a gap/lacuna in protection of celebrity persona, invoking the need for a right of publicity to be introduced.

⁹³¹ Article 6 of the Civil Code (as translated) – “Every person has the right to the name attributed to him by law.”

⁹³² Article 7 of the Civil Code (as translated) – “...A person whose right to the use of his [or her] 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...”

⁹³³ Article 9 of the Civil Code (as translated) – “A pseudonym, used by a person in such a way that it has acquired the importance of a name, may be protected under Article 7 (1).”

⁹³⁴ Article 10 of the Civil Code (as translated) – “If the image of a person ... has been displayed or published outside of the cases in which the display or publication is permitted by law, or with prejudice to the dignity or reputation of the person himself/herself or of the said relatives, the judicial authority, upon request of the interested party, may order that the abuse cease, without prejudice to compensation for damages.”

4.3.3(b) Italian Right of Publicity:

The Italian judiciary is empowered with the concept of '*analogia legis*' that authorises them to 'reason by analogy' upon existing Codes and its complementary legislations and indulge in judicial law making by applying those provisions to fill in the gaps/lacuna in law⁹³⁵. The Italian right of publicity is a fine specimen of such judicial law making, where the judges have stretched the Civil Codes, to afford protection to other indicia of celebrity persona which the Codes did not recognise, leaving a gap/ lacuna in law. The gap was filled up in the case of *Dalla v Autovox SpA*⁹³⁶, where the judge reasoned that the Code which already protects celebrity image, should be also able to protect other aspects or attributes of celebrity persona; thus, introducing a right of publicity through judicial law making. Although, the right is a product of judicial dexterity and innovation, its legitimacy and applicability are guaranteed by the Italian Civil Code itself, as the judiciary has simply extended the bounds of the existing Code to cover a new area/gap, keeping the basis of protection technically unchanged.

In *Dalla v Autovox*, the Defendant misappropriated two distinctive characteristics of the famous Italian singer, Dalla, i.e., his woollen cap and pair of small round glasses, and used those in its advertising posters. The singer claimed that this unauthorised use created an impression that he is endorsing and/or has approved the products being advertised; that, such impression is detrimental to his reputation as it portrays him in a false light since he was widely known for refusing to appear in commercials or product endorsement campaigns.

Interestingly, the typical rights under the Code and complementary legislations were not applicable in Dalla's case, since Autovox did not misappropriate Dalla's name or image, but instead misappropriated other indicia of his personality, i.e., his cap and glasses, which are not recognised under the typical rights. The court viewed this as the misappropriation of Dalla's *identity*, as Dalla's cap and glasses distinguished him and created a recognisable persona, from which the singer is identifiable.⁹³⁷ The indicia misappropriated also formed the substantial part/centrepiece of the advertising poster, making it apparent that Autovox used these indicia to refer Dalla's association with the product and increase its appeal using Dalla's popularity.⁹³⁸ Collectively, the court was convinced that in this case, Dalla's identity has been misappropriated for making undue commercial gains and not for serving any legitimate public interest. This, ultimately, led the court to emerge with a new right of publicity, by drawing an analogy with typical rights and expanding the existing Code to answer Dalla's claim, which the existing legal regime, in its traditional form, failed to answer.

The right of publicity was subsequently affirmed in another landmark case, *Baglioni v. Eretel Srl and Disco Spring*⁹³⁹, where the right was invoked to prevent the commercial exploitation of Baglioni's (a famous Italian singer) persona (his image and

⁹³⁵ Silvio Martuccelli, 'The Right of Publicity under Italian Civil Law,.' (1998)18 Loy. L.A. Ent. L. Rev. 543.

⁹³⁶ Pret. di Roma, 18 Apr. 1984, Foro It. 1984, I, 2030.

⁹³⁷ Ibid, at 2032-2033.

⁹³⁸ Ibid.

⁹³⁹ Pret. di Roma, 18 feb. 1986, Il diritto di autore 1986, 215.

signature) in the Defendant's calendar. The Court rationalised its finding by stating that such misappropriation was prejudicial to his reputation and popularity, and if not prevented, would erode his right to control his own persona and leave him without any legal recompense. The right was further applied in *Vitti v. Doimo SpA*⁹⁴⁰, where the use of a look-alike of Italian actress Monica Vitti in an advertisement was held to infringe her publicity rights since her persona was used for commercial purposes, without her consent. This case, interestingly, affirmed that the court's primary focus is on the *use*, whether it has been for commercial purposes or not; whether the use creates any false impression in the minds of the public or had misleading effects, was secondary or perhaps not considered at all. This was fittingly illustrated in *Vitti*, as the disclaimer used in the advertisement, which clearly negated the possibility of confusion or misleading the public could not avoid liability for the Defendant.⁹⁴¹ The right was also successfully invoked in *Valentino Garavani SpA v. Postalmarket SpA*⁹⁴², where the unauthorised use of the world famous fashion designer, Valentino's trademark in an catalogue to advertise goods, were held to infringe his publicity rights. Invariably, all of these cases involving famous persons/celebrities indicate that misappropriation of identity is actionable as soon as the indicia or characteristics appropriated alludes to and/or immediately identifies the celebrity. Therefore, the typical right of image could be expanded through *analogia legis* by the courts and the right of publicity could be applied. With the right of publicity focusing primarily on the commerciality of the use, as Martuccelli contended, it showed that the Italian courts were ready to recognise that the *identity* of celebrities holds as much value as that of in their *names* and *images* and that, protection should not be limited to these only but should cover all indicia of their persona.

Moreover, these cases also suggested four characteristics of the right of publicity, more so, qualifying factors.⁹⁴³ Firstly, it applies in cases involving famous persons/celebrities and not ordinary/general public; in that, the right safeguards the commercial value of one's persona from misappropriation like in endorsements/merchandising;⁹⁴⁴ it does not prevent any intrusion to one's private sphere or dissemination of private information. So, the persona needs to have a commercially exploitable value, which is only available if the person is famous, hence, only celebrities can qualify for this right. Secondly, misappropriation must be of distinguishing characteristics of the celebrity; in that, use of statutorily protected indicia like name, pseudonyms, nicknames, photographs, portraits or likeness would continue to suffice. Any other attributes or indicia of personality may suffice provided that it immediately identifies the celebrity and allows for the commercial value embedded in that famous identity to be misappropriated.⁹⁴⁵ As such, uses imitating a celebrity's identity or look-alikes would be also caught under the right.⁹⁴⁶ Thirdly, misappropriation

⁹⁴⁰ Pret. di Roma, 6 july 1987, I1 diritto di autore 1987, 570.

⁹⁴¹ Ibid.

⁹⁴² Pret. di Roma, 7 apr. 1987, Foro It. 1987, I, 2878.

⁹⁴³ Martuccelli (n 935), 558.

⁹⁴⁴ *Dalla* (n 936)

⁹⁴⁵ Ibid.

⁹⁴⁶ *Vitti* (n 940)

must be for purely commercial purposes; in that, unauthorised use of celebrity persona must be for making undue gains and/or to freeride on the fame or public appeal that the celebrity has amassed.⁹⁴⁷ The use, therefore, should be for commercial publications, advertising, merchandising, product promotion and/or endorsement purposes.⁹⁴⁸ Use in non-economic context such as news reporting, fictional/non-fictional works will not suffice. Lastly, the misappropriation must inflict damages to celebrity;⁹⁴⁹ in that, the celebrity must suffer damages directly as a result of the misappropriation of his persona. Such damages must be immediate in nature⁹⁵⁰ and would normally be assessed on the basis of the celebrity's degree of popularity and loss of licensing fee/price of consent⁹⁵¹.

Furthermore, several justifications of the right of publicity had surfaced from the commentators⁹⁵² in light of the application of the right in these cases. The right of publicity, as an interpretive extension of the Article 6 right of image, also safeguards non-economic interest of dignity and autonomy in one's persona.⁹⁵³ The right also protects the economic value of one's persona, in addition to the non-economic ones, and prohibits unjust enrichment of the exploiters by preventing them from freeriding on the fame and popularity of the celebrity.⁹⁵⁴ It preserves the exclusiveness of celebrity persona by preventing dilution of the commercial value by its excessive and/or harmful use. This is particularly important for celebrities who are extensively involved in persona marketing. The right, though not designed to, but still prevents public confusion or misrepresentation from false endorsement or unauthorised merchandising, indirectly.⁹⁵⁵ *Dalla's* case best illustrates this, since unauthorised endorsing could have led the public to falsely believe that the advertised products were endorsed and/or approved by the singer and public may have bought it based on that false premise. The same is with *Valentino*, the use of his mark would false imply that the goods in the sales catalogues were endorsed by Valentino himself, and the sales increased based on that false impression. Interestingly, however, there is a divide among these same commentators who have rationalised the basis of this right in terms of the transferability and descendibility. Given the characteristics of the right, which technically provisions for an exclusive right of control over commercial exploitation of persona, each indicia of celebrity persona can be separated from the person himself;

⁹⁴⁷ *Baglioni* (n 939)

⁹⁴⁸ *Ibid*; See also, *Dalla* (n 936).

⁹⁴⁹ *Ibid*.

⁹⁵⁰ A. Barengi. 'The price of (missed) consent: The damage of image exploitation and its liquidation', (1992) *Riv. Dir. Inf.*, 565.

⁹⁵¹ App. Milano, 9 apr. 1976, Trib. Torino, 15 Jan. 1994, *Dir. Inol.* 1994

⁹⁵² See generally, Martuccelli (n 935); Garutti, 'Combination of the image of a well-known personality to the aim of differentiation', (1990) *Diritto Dell'Informazione E Dell'Informat* 560; V. Metafora, 'The myth of Narciso and the jurisprudence: About the right to own one's portrait', (1990) *Riv. Crit. Dir. Priv.* 867; M. Ricolfi, 'Issues about the legal system of the commercial exploitation of the image', (1992) 1 *Nuova Giur. Civ. Comm.* 44.

⁹⁵³ A.M. Gambino, 'I limiti al right of publicity delle squadre di calcio [The Limits to the Right of Publicity Soccer Teams]', (1994) *Nuova Giurisprudenza Civile Commentata* 557-574;

⁹⁵⁴ T. Watkin, *The Italian Legal Tradition* (Ashgate Publishing Group 1997).

⁹⁵⁵ A. Langvardt, 'The troubling implications of a right of publicity "wheel" spun out of control', (1997) 45 *U.Kan.L.R.* 329, 352.

so in theory, can be assigned, transferred or licensed to thirds parties.⁹⁵⁶ In terms of post-mortem rights and/or descendibility, there remains to be an unresolved divide, where some argued for a post-mortem right for a fixed period of 50 years (mirroring post-mortem rights available in cases of copyrights)⁹⁵⁷ and others argued for post-mortem rights on the condition precedent that the persona was commercially exploited during the lifetime of the celebrity (somewhat mirroring the US model of right publicity).⁹⁵⁸

4.3.3(b)(i) Other potentials of the Right via Analogia Legis

Martuccelli added, typical rights in pseudonyms through Article 6 & Article 7 of the Code could be also extended through *analogia legis* and given protection to the 'stage names' under the right of publicity if it has been commercially misappropriated.⁹⁵⁹ In his lens, stage names of celebrities are often substantially different from their real name but can entail a commercially exploitable value just as the real one. He further dwells into the possibility of including the 'stage image' within the ambit of protection using the same mechanism through *analogia legis* and right of publicity, just as the real image would be protected under the typical rights.⁹⁶⁰ Such seemingly endless expansive possibilities only suggests that the right of publicity has no specific bounds and the judges are at liberty to extend it in light of the Code and the typical rights to respond to any gaps/lacuna created in law. Given the ever so changing nature of persona misappropriation and frequently occurring gaps/lacuna in law, the blurred confines of this right may be its biggest strength and not just a weakness.

To conclude, celebrities in Italy benefits both from the typical rights and the right of publicity; in that, if the celebrities are concerned that their name or image or both is being used in a way that is injurious to their dignity and reputation, they can invoke the typical rights. If they are concerned that third parties are commercially freeriding on their hard-earned persona and wants to preserve their exclusive right of control on such exploitation, they have the right of publicity at their disposal. The threshold to this right also appears to be relatively low, as it only requires misappropriation for commercial purposes. However, the impugned use is likely to be tested whether it serves any legitimate public interest. Given the cases that laid the brickwork of the right, it can be safely presumed that the balance is likely to tip in the favour of the celebrities as soon as the commercial nature of the impugned use is evident. This also alludes to the fact that, Italian judges are '*pro*' celebrity rights; their interpretation of the existing legal principles and the exercise of *analogia legis*, ushers their recognition of the economic aspect of celebrity persona and that, it is worthy of legal protection. It further ushers that the Italian judiciary is prepared to ensure that the celebrities can

⁹⁵⁶ See, S. Gatti, 'The "right" to the commercial exploitation of one's own popularity', (1988) Commercial Law Review, 355; See also, Martuccelli (n 935), 562.

⁹⁵⁷ Ibid.

⁹⁵⁸ Martuccelli (n 935), 562.

⁹⁵⁹ Ibid, 553

⁹⁶⁰ Ibid.

enjoy the benefits of their own efforts in creating a high value persona and that, any form of unjust enrichment derived from the unauthorised exploitation of it is strongly prohibited.

4.3.4: Spain

In Spain, there is no general right of personality like in Germany or any right of publicity akin to US and Italy. Interestingly, there exists, although implicitly, a right of image for both celebrities and general public under the Spanish Constitution and its supplementary legislations. This implicit right has been interpreted, refined and development to what is now known as the Spanish right of Image. What follows is the analysis of such an image right, its ambit of application and possible exceptions.

4.3.4(a) *Spanish Right to Image:*

Section 18(1) of the Spanish Constitution of 1978 recognises the right to one's honour, personal and family privacy, and one's own image. Article 1 of Spanish Organic Law of 1982⁹⁶¹, underscored such rights as '*fundamental rights*' and guarantees civil liability in the event of any illegitimate and/or unauthorised interference with such fundamental rights. Article 7.5 of the Organic Law complemented Article 1 by prohibiting taking, reproduction or publication of photos of one's private life and thereby, safeguarding the privacy interest of the individual. Article 7.6 further prohibited the use of name, voice or image for advertising, business or similar purposes and as such, safeguarded the economic interest of the individual. Emphasis is drawn to Article 7.6, specifically, since such prohibition inadvertently brought in the elements of publicity rights akin to the US and the Italian model. A presumption of harm, under Article 9.3, for the purpose of compensation as '*moral damages*', will ensue if any of the prohibited acts listed in Article 7 is conducted.

The Spanish Constitutional Court clarified the right profoundly as an 'autonomous' right that is intrinsic to one's personhood, projecting the outward manifestation of one's persona to his external world. It is, therefore, a right to decide/control how this outward manifestation of one's persona will be communicated and to prohibit any unauthorised reproduction, dissemination or commercial exploitation by third parties.⁹⁶² Although the right has been commonly defined as a 'personal right' functioning to uphold one's honour and private life, it has been endowed with "...a *potentially patrimonial content*

⁹⁶¹ Ley Orgdnica de 5 de mayo de 1982, num. 1/1982 (1982/1197) (Organic Law of May 5, 1982, No. 1/1982 (1982/1197)).

⁹⁶² See, Constitutional Court Judgment 83/2002. See also, Constitutional Court Sentence 231/1988; Constitutional Court Sentence 99/1994 81/2000; See also, Ana Azurmendi Adarraga, *El derecho a la propia imagen: Su identidad y aproximación al Derecho a la Información* (Civitas Publishing House 1997).

in that through its exercise economically valuable assets can be obtained, and also pecuniary compensation in case of violation."⁹⁶³

4.3.4(a)(i) The Qualifying Factor

To qualify for this right, therefore, the test is one of '*recognoscibilidad*'⁹⁶⁴ i.e., recognisability (similar to that of image rights in other European legal systems); in that, the impugned use of the image will constitute a breach of the right if the image or depiction contains such elements from which the concerned person (celebrity) can be recognised/identified. Although use of a referential image would normally be at the core of the right, but the test of *recognisability* has been given a broad interpretation to also cover the unauthorised use of other indicia of celebrity persona, e.g. name⁹⁶⁵, voice⁹⁶⁶, identity⁹⁶⁷ as long as the relevant celebrity is recognised from such use. This is also in line with the wordings of Article 7.6. The term 'image' has not been restrictively interpreted to be confined to mere portraits, photographs or drawings of a celebrity; use of a celebrity's face/likeness (which is commonly understood when the term *images* is used) definitely makes him recognisable, but so does the use of other distinctive features or characteristics of his persona. Image is therefore, a 'sign' for the purpose of this right, a sign that entails such elements or features, from which a celebrity can be recognised.⁹⁶⁸ This is finely illustrated in the case of *Emilio Aragón v. Probotín*⁹⁶⁹. In this case, the Defendant used expressions and graphic representations (like drawings of a crossed leg, black pants and sports boots) resembling Emilio's (a well-known Spanish TV personality) mannerism and unique styling, in their footwear advertisement. The advertisement also included a slogan, "*The most popular person in Spain has stopped saying: your foot smell*", which again resembled, although satirically, with the song "Your Feet Smell Bad" played by Emilio on the TV. The Defendant, however, did not use the name or image/portrait of Emilio, which would otherwise constitute a *prima facie* breach of Emilio's right of image.

The Spanish Constitutional Court controversially held that the mannerism and graphic representations used in the advertisement were sufficient to make Emilio recognisable from the use and the specific use of name or image is not strictly necessary for breach, as long as the recognition can be done using other indicia of Emilio's persona. The court further categorised that in Emilio's case, his identity has been exploited unauthorisedly and clarified that in case of famous people, identifying physical features like face, likeness, etc are not required for them to be recognised. This ultimately broadened the scope of the image right to include unauthorised use of such other

⁹⁶³ Gitrama, M Gonzalez, 'Imagen, (derecho de la) (eds) *Nueva Enciclopedia Jurídica Seix*, Tomo XI (Barcelona 1962); See also, Manuel Sánchez de Diego, 'Right to One's Own Image in Spain: What It Is and What It Is Not' (2018) 8 *Journal of Information Policy*, 401.

⁹⁶⁴ See also, Diego (n 963).

⁹⁶⁵ See, Judgment 117/1994 of April 25.

⁹⁶⁶ *Ibid*

⁹⁶⁷ *Emilio Aragón v. Probotín* Sentence 81/2001, of March 26.

⁹⁶⁸ *Ibid* 406.

⁹⁶⁹ *Emilio* (n 967).

aspects of persona that are capable of identifying the celebrity in question and not just limiting it to celebrity image/portraits only. In addition, this case was also significant as the Spanish Constitutional Court further clarified that the use of persona (identity in this case) in purely commercial context without consent was one of the main factors underlying the decision of liability in this case, confirming the fact that the constitutional right of image was also a commercial right of image for the celebrities, which would attract civil liabilities as well.⁹⁷⁰

4.3.4(a)(ii) Broad Interpretation of Commercial Use

Most significantly, Article 7.6 of the Organic Law gives a broader meaning to what constitutes as commercial use for the purpose of liability.⁹⁷¹ The Article includes the term '*comerciales*' which has been interpreted to cover not only advertisements and similar marketing activities, but also any use that results in or is intended to bring profit or any other economic benefits. Professor Llari clarified this well; persona of the celebrities is often used in the form of words of information or entertainment, which cannot be always categorised as advertisement or marketing. In such cases, the authors are always doing so for philanthropic or non-profit purposes, and economic benefits might not be apparently visible at its face, but underneath the use serves a definite economic purpose by increasing the public appeal/attraction, and therefore adding a commercial 'value' in the use.⁹⁷² As such, unauthorised use of image in the news or even in entertainment magazine of a famous person might be counted as a commercial use and hence, breach the right.⁹⁷³

In addition, Article 7.6 also enumerates prohibition against '*publication*', which has been also interpreted very broadly to go beyond the usual confines of advertising or publicity.⁹⁷⁴ This expansive interpretation even allowed those publications which did not comprise any economic benefits/profits - like use of images in a booklet for public information campaigns - to constitute a breach of the right, as seen in the case of *Respect for Seniors*⁹⁷⁵. The Court in the same case, also confirmed the true ambit of Article 7.6, by stating, "*Article 7.6 covers purposes of advertising or publicity that are not commercial, that is to say, those in which there is no financial interest*"⁹⁷⁶ The Court further denied the application of Article 8.1 exception (to be discussed below) of cultural use, clarifying that the use of the images were indeed for cultural purposes but such purpose was not sufficient to overthrow the right of image of the persons whose images were used in the booklet. Interestingly, such a broad interpretation of

⁹⁷⁰ See also, Diego (n 963) 414.

⁹⁷¹ Stephen R. Barnett, 'The Right to One's Own Image: Publicity and Privacy Rights in the United States and Spain' (1999) 47 Am J Comp L 555, 566.

⁹⁷² María Eulalia Amat Llari, *The right to one's own image and its advertising value* (Wolters Kluwer Spain, 1992).

⁹⁷³ See, the Decision of the Territorial Tribunal of Barcelona of 12 March 1987 in the *Revista Jurídica de Catalunya*, 1987, Jurisprudencia civil, nos. 3 & 4 (the publication of a picture of a famous politician's wife in the magazine (Named *Pronto*) was held to be commercial in nature and therefore, breached Article 7.6).

⁹⁷⁴ See, Barnett (n 971) 568.

⁹⁷⁵ Decision of the Supreme Court of 7 October 1996, no. 816/1996 RJ 1996/7058.

⁹⁷⁶ Ibid.

commercial use makes the Spanish right of image unique. Invariably, in all other European jurisdictions where such or similar rights exists (already discussed and to be discussed forthwith) and even in the US model of publicity rights, uses like news-reporting and particularly those which do not entail any commercial element will not be detected within the radar of such rights. Indeed, such use may be prevented based on other privacy actions, but image rights, publicity rights or personality rights even in their widest of expansion, would not be able to prevent this in the neighbouring jurisdictions or in the further west.

Now given the broad and unique interpretation of the terms '*image*' and '*commercial purpose*', effectively widening the ambit of protection, there are still some images and/or use of such images which will fall outside the parameters of this protection. Any literary description or literary portrait that describes the person (celebrity) or communicates his images in words will not breach that described celebrity's right of image.⁹⁷⁷ Likewise, caricatures or cartoons of celebrities has been ruled not to breach one's image rights.⁹⁷⁸ In such cases the deformed drawing of the celebrity is also considered to involve similar intellectual process that is present in case of literary descriptions/portraits and as such, not considered as a breach of the right. There is, however, a peculiarity in this rationale, since caricatures are done based on the protected image and remains as an extension of the same, unlike in cases of literary works where description has been given in words, independent of the image. Additionally, any brand marks of famous people, which are already protected under the Spanish Trademark Law, will not fall within the ambit of image rights. This was confirmed in the case involving the famous Spanish artist, *Salvador Dali*⁹⁷⁹ where his mark in his name and image was used for advertisement and commercial purposes. The Court found in favour of the artist insofar as the breach of his trademarks were concerned but ruled out his claim for breach of his image rights. Furthermore, the right of image cannot accord protection in cases where the celebrity image has been portrayed in a false light, i.e., in a way that is contrary to his social image or the public/society's perception of that celebrity. Any uses which are prejudicial to such social image or public perception will have more to do with one's honour and prestige which are protected under other legislative limbs of the Spanish legal system and nothing to do with the right of image.⁹⁸⁰

4.3.4(a)(iii) Post-Mortem Possibilities

The Organic Law further allows the right to be carried postmortem regardless of any Will being left by the individual through Article 4, allowing the estate to enforce the right after death. In the event there are no beneficiaries of the estate, the Spanish

⁹⁷⁷ See also, Ana Azurmendi Adarraga, *El derecho a la propia imagen: Su identidad y aproximación al Derecho a la Información* (Civitas Publishing House 1997), 25; See also, Diego (n 963) 408.

⁹⁷⁸ Ibid; Diego (n 963), 413.

⁹⁷⁹ Decision of Provincial Court of Barcelona (Appellate Court) no. 318/2013 on July 24.

⁹⁸⁰ Judgment 1029/1992, of November 17; See also, Miguel Ángel Alegre Martínez, *El derecho a la propia imagen* (Tecnos 1997).

Ministry of Justice can enforce such rights for up to a period of 80 years postmortem. Allowing such post-mortem rights were received with much criticism from the judiciary. In *Pantoja v. Prographic*⁹⁸¹, the court critiqued that, as the right of image is predominately a fundamental right and is so closely intertwined with the individual, that, with his demise the true object of protection of this fundamental right, (i.e., the person himself) also extinguishes. However, such critic is unlikely to hold any water, since the right, which was once categorised as a fundamental right, has been, through rigorous judicial interpretation been transformed into a commercial right, which facilitates and justifies the right to be carried post-mortem.

4.3.4(b) *Exceptions & Balancing the Competing Rights:*

Conversely, Article 8 of the Organic Law further provided several exceptions to the right; in that, Article 8.1 dictates, use of one's image without consent is allowed if the use is predominantly for historical, scientific or cultural purposes. In the *Zarzuela* case⁹⁸², the Spanish actress Dona Selica's image was used without consent in a poster advertising the remake of a light opera which the actress was previously part of back in 1934. The court ruled that the new poster containing the actress' image did not breach her image right because the purpose of such use was not strictly commercial but was for cultural reasons (i.e., to revive and promote an old Spanish music genre). The *Zarzuela* ruling, however, appears to question the Spanish Court's decision in the latter case of *Respect for Seniors* case, as seen above. The Court in that case did not acknowledge the apparent cultural interest in promoting the respect and wellbeing of senior members of the society, which they did so in the earlier *Zarzuela* case; whereas, in all logical sense the rationale used in the earlier case was more appropriate to the latter one and vice-versa.

Article 8.2 further adds to the list of exceptions: reproduction, dissemination and/or publication of image of public figures or those who holds public office and which has been taken in a public place or in the course of a public act, is not prohibited by the right⁹⁸³. Article 20.1 of the Spanish Constitution provisions for the right of information/freedom of expression, which also acts as an exception to the right of image, as the Court are minded to balance such rights with the Article 20.1 rights.⁹⁸⁴ In the case of *Paquirri Tapes*⁹⁸⁵ the sale of video tapes of famous bullfighter, Paquirri being gored in the bull ring were allowed, as the Court viewed that there were significant public interest in making public aware of the risks and consequences of

⁹⁸¹ Constitutional Court Sentences 231/1988.

⁹⁸² Decision of the Supreme Court of 21 December 1994 (RJ 1994/9775).

⁹⁸³ See, The Decision of the Supreme Court of 11 March 1999 (256/1999) (holding that a newspaper's publication of a photo, taken in a public street, showing the Vice-President of the Spanish Government and his brother, and showing the plaintiff in the background in his role as bodyguard to the Vice-President, was protected by Article 8.2 (c) of the Organic Law, which protects "photos of public events or occurrences when the image of a particular person appears merely incidentally."

⁹⁸⁴ See, The Decision of the Supreme Court of 21 October 1997 (905/1997, RJ 1997\7176) (holding that a newspaper's photo of a well-known financier taken at a game park in Kenya was taken in a place open to the public and therefore was protected by the right of information).

⁹⁸⁵ Decision of the Supreme Court of 28 October 1986 (RJ 1986/6015).

bullfighting and therefore, such public interest outshone the right of image that Paquirri had in his images captured in the tapes. Similar conclusion was also reached in the case of *Masked Eyes*⁹⁸⁶, where the publication of the plaintiff's photo (with his eyes masked) in a newspaper were allowed, as the public interest and/or the right of information underlying this publication was held to outweigh the right of image of the plaintiff. Despite these exceptions, the Spanish Courts, however, remained firm on their standing that the exceptions under Article 8 will be not be interpreted to allow for a freedom of speech defence in unauthorised use of a celebrity name, likeness or image for purely commercial purposes.⁹⁸⁷ The Court has expressly stated, "...*that the right to one's own image can give way only to a right of the same rank, like the public's right of information, and not to "the mere financial interest of a third person."*"⁹⁸⁸

To sum up, the Spanish legal system does not expressly recognise a right of personality or publicity. Instead, a right of image has surfaced through judicial interpretation of the Constitutional provisions and the Organic Law. What is fascinating about the right of images is that it is unique and accords an all-encompassing protection to celebrity persona. Although termed as right of *image*, images in strict sense are not nucleus to the right, all other indicia of celebrity persona can qualify for protection as long as the test of '*recognoscibilidad*' is satisfied. What is more fascinating is that the right covers, in addition to usual advertising activities, publications in magazine and even in the news as soon as the commercial nature of the use is evident. These makes the Spain right of image far reaching than many of its European counterparts and even the US model of publicity, which is often regarded as the leader of publicity rights. One may safely conclude that the right of image has not been left as a right of image *per se*; it has been, owing to the robust interpretation and application over the years, transformed in to a personality right, that is capable in protecting both economic and non-economic values of celebrity persona. Building on this premise, therefore, one can also conclude that the Spanish legal system provides for personality rights to the celebrities, robustly.

4.3.5: Netherlands

The Dutch legal system does not recognise a general right of personality or publicity. It, however, recognises celebrity persona as a protectable interest and has long standing inbuilt mechanisms within its legislative framework that caters for its protection. The most prominent of them is by way of the Dutch Copyright Act 1912 and other less prominent but still useful protective regimes exists under the trademark

⁹⁸⁶ Decision of the Supreme Court of 28 December 1996 (RJ 1996/9510).

⁹⁸⁷ Decision of the Supreme Court of 9 May 1988 (RJ 1988/4099), Aranzadi; See also, Loreto Corredoira y Alfonso, El 'Patrocinio: Surggimen juridico en Espafla y en la C.E.C ('Sponsorship: Legal emergence in Spain and the C.E.C')' (1991) 243; Barnett (n 971) 574.

⁹⁸⁸ Ibid; See also, Barnett (n 971) 575.

laws and Civil Code of the country. The sources of protection will be analysed, as follows.

4.3.5(a) *Portrait Rights*:

The Dutch portrait rights is dictated by the Dutch Copyright Act 1912, through Articles 19 to 21, to be read in conjunction with Articles 25a and 35. In general, these Articles enforces the right of a person to oppose/object to the non-consensual publication of his portrait. The wording of these articles demonstrates that the right is afforded, not only to the creator/author of the portrait but interestingly (and uniquely) on the person who has been portrayed/depicted in the portrait as well. Article 21 states, *“If a portrait is made without having been commissioned by or on behalf of the persons portrayed, the copyright owner shall not be allowed to communicate it to the public, in so far as the person portrayed or, after his death, his relatives have a reasonable interest in opposing its communication to the public.”* Such attribution of the right to the person portrayed is significant, particularly in the context of celebrities, since portraits form an aspect of their persona and limiting the right to the creators (only) would allow no legal recourse to the celebrities, if their portrait has been misappropriated and the creator with the (copy)right does not object to it. Hagen⁹⁸⁹ adds, although the right was attributed to the person portrayed for the purpose of safeguarding his/her privacy interest⁹⁹⁰, it is much more than that, as it can also protect the economic interests in controlling and commercially exploiting one’s portrait, if the person portrayed is a celebrity/famous person.

4.3.5(a)(i) Is it a ‘Portrait’?

To invoke the right, the first step for the Dutch celebrities would be to establish that the impugned (mis)use/publication involves their ‘*portrait*’. Interestingly, as Hagen suggested, the term portrait may allude to an image or a drawing or painting of a face of a person posing, but in reality, the term has been given a much broader interpretation in the context of portrait rights under the Dutch law. At the time of the enactment of the Act, the explanatory memorandum to the legislation defined a portrait as the depiction of a person’s face, however created, which may or may not include depiction of other body parts of the person depicted. Essentially, the test is, therefore, of ‘depiction’, - i.e., whether an individual is identifiable, referable or recognisable.⁹⁹¹ Hagen clarified that such depiction in photographs taken by chance, incidentally or unintentionally would also amount to a portrait for the purpose of the Act.⁹⁹² This is particularly important for the celebrities as it is their career hazard to be paparazzi ’ed whenever they step out in the public, be it to attend a red-carpet event or even to buy

⁹⁸⁹ Steffen Hagen, ‘Sports Image Rights In The Netherlands (Part 1)’ (2011) 3-4 ISLJ, 115.

⁹⁹⁰ See also, Fritz Oppenoorth, ‘Facets of Dutch Portrait Law’ (1993) 28 Copyrightworld 38, 39.

⁹⁹¹ See also *Max Vasteppen* Case, 20/02691, ECLI:NL:HR:2022:621

<<https://uitspraken.rechtspraak.nl/details?id=ECLI:NL:HR:2022:621>> accessed 10 January 2025.

⁹⁹² See, Hagen (n 989) 116.

a cup of coffee from a local coffee shop. The depiction, however, must be of a *person*, as the Court in *FC Ajax* case⁹⁹³, confirmed that portrait rights only cover depiction of natural persons and not of any corporate body or entities. The definition also reflects that there is no fixed *form* for the portrait to be actionable, it can be made as a painting, drawing, casted on other material, captured as photo or recorded by a video camera.⁹⁹⁴

Following the requirement that the depiction needs to be of a natural person, the Dutch Courts in *Ja zuster/nee zuster* case⁹⁹⁵, further added the requirement of having corresponding facial features in the depiction to qualify as a portrait and confirmed that mere association was not accepted. This case involved imitation of famous Dutch TV personalities in plastic dolls sold with promotional key rings. The claim failed as the court was not satisfied that there was any recognisable visual likeness between the dolls and the plaintiff celebrities for it to be considered as a portrait and given protection. The Court continued with this requirement in *Naturiste* case⁹⁹⁶, but also allowed '*possibility*' of recognition through the depiction to be actionable. The Dutch Supreme Court opined that the depiction does not necessarily have to create a full image or representation of the person portrayed in the eyes/minds of the viewers and not every viewer is required to identify/recognise the person; if a handful of viewers can relate or recognise the person from the depiction, it will suffice.⁹⁹⁷

What also followed from this case is that the depiction of a striking body posture may also qualify as an actionable portrait. This was later reaffirmed in the case involving *Yep Kramer*⁹⁹⁸, a famous marathon skater, where the gas boiler company used an image of the skater which depicted his famous ice-skating posture in an advertisement without his consent. The Court was convinced that the famous skater was clearly recognisable from such depiction (qualifying it as a portrait) and that the Defendant has freeridden on the skater's famous persona, leading to the breach of the skater's portrait rights under the act. Subsequently, the requirement of corresponding facial features was further relaxed when the court allowed 'possibility of recognition' through other identifying elements in *Breekijzer* case⁹⁹⁹.

However, significant developments were brought into the right, when the Courts in the *Feyenoord* case¹⁰⁰⁰ held metal pins bearing the caricature of the players of the Feyenoord Football Club, as actionable portrait even though such caricatures had a minimum degree of resemblance with the players portrayed. This was re-affirmed later

⁹⁹³ District Court in Utrecht, 16 January 1980, NJ 1980, 481 (*Krol c.s./Panini*) – A team photo of the club did not qualify as a portrait for the purpose of portrait rights.

⁹⁹⁴ See, Hagen (n 989) 116.

⁹⁹⁵ Supreme Court, 16 January 1970, NJ 1970, 220 (*Ja zuster/nee zuster*).

⁹⁹⁶ Supreme Court, 30 October 1987, NJ 1988, 277 (*Naturiste*).

⁹⁹⁷ Ibid, see also Louis van Gaal Case - District Court of Amsterdam 20 January 2016, ECLI:NL:RBAMS:2016:199 – The Court ruled that a photo that only featured Dutch football coach Louis van Gaal's chin should still be considered a portrait of Van Gaal; even a small part of a face can be a portrait.

⁹⁹⁸ Sub District Court in Harderwijk, 29 May 1991, PRG 1991, 3507; Mediaforum 1991, B115.

⁹⁹⁹ Supreme Court, 2 May 2003, NJ 2004, 80 (*Niessen & IPA/Storms Factory; Breekijzer*) – The Court ruled that depiction may be actionable even where the face is unrecognisable, if the person portrayed is identifiable from any other elements in the picture.

¹⁰⁰⁰ President of the District Court in The Hague, 7 December 1965, BIE 1966, nr. 66 (*Feyenoord players*).

when the caricature of the then Dutch Prime Minister, Jan-Peter Balkenende used in an advertisement depicting him as a toddler (also named JP), was found to be an actionable portrait.¹⁰⁰¹ In all of these cases, the Court's focus was on whether the circumstances or the context elucidated which famous person has been depicted. Interestingly, however, the court for a long time did not recognise depiction through look-alikes to be an actionable portrait. A famous Dutch TV actor, Silvia Millicam claimed against the use of a look-alike in an advertising brochure by the Defendants, where the court ruled it as a non-actionable portrait.¹⁰⁰² This conclusion was reached, *rather oddly*, even though Millicam could show the court that her acquaintances could recognise her from the impugned depiction given the red-haired look-alike used in the picture. This position, however, changed when the depiction, using a look-alike, of Dutch celebrity, Katja Schuurman but showing from the back was held as a portrait for the purpose of the Act¹⁰⁰³.

With such expansive interpretation of the term 'portrait', the test has long shifted from its traditional formulation; it appears that the test is now whether the famous person is recognised from the depiction considering the overall context and the other identifying elements in the image. The application of this test was clearly evident in the recent case involving the famous F1 racer, *Max Verstappen*¹⁰⁰⁴, where Picnic (a supermarket chain) uploaded a 32 second commercial on its Facebook page, depicting a look-alike of Max Verstappen, supplying groceries to its customers. The look-alike was wearing the same racing outfit that Max wore during race-days and to appear in front of the media. The posture, silhouette and even the hair colour of the look-alike was same. The commercial showed that the look-alike was driving the Picnic delivery van taking laps to and from the Picnic distribution centre as a pit-stop to the homes of Picnic customers. The Court found that the look-alike had all the characteristic features of Max and the way the delivering process was showed subtly mirroring a F1 race, it would evoke Max's image in the eyes of the viewers. Such evocation was sufficient to constitute an actionable portrait, and Max's image right infringed.

4.3.5(a)(ii) Was it 'commissioned' or not?

Once celebrities have established that their depiction is actionable, the application of the right will depend on whether the portrait has been commissioned by the celebrity portrayed or not. If it has been commissioned, Article 20 states that the creator is prohibited to use the portrait without the consent of the celebrity portrayed therein. Further to that, Article 19 affords the celebrity portrayed, the right to license, reproduce

¹⁰⁰¹ District Court in Amsterdam, 2 February 2005, LJN: AS4624

¹⁰⁰² President of the District Court in Amsterdam, 22 December 1994, IER 1995/12 (*Millicam*).

¹⁰⁰³ District Court in Breda, 24 June 2005, IER 2005/80 (*Katja Schuurman*); see also President of the District Court in The Hague, 13 April 2006, BMM bulletin 2006-2, p. 80-81 (*Kalou/Achmea*); See also Edgar Davis Case – District Court in Amsterdam. 9 August 2017, C/13/614861/ HA ZA 16-914, ECLI:NL:RBAMS:2017:5415 <<https://uitspraken.rechtspraak.nl/details?id=ECLI:NL:RBAMS:2017:5415>> accessed 10 January 2025.

¹⁰⁰⁴ *Max Verstappen Case* (n 991). .

and/or commercially exploit the portrait himself, and such exploitation will not infringe the copyright of the creator of the portrait.

In the event the portrait is not commissioned by the celebrity himself or on his behalf and the portrait has been used without the consent of the celebrity portrayed therein, the celebrity can invoke Article 21 and object to such a use if the celebrity can demonstrate a reasonable interest in doing so. Such reasonable interest can be either privacy interest - grounded in Article 8 of the ECHR - as confirmed in the *Naturiste* case¹⁰⁰⁵ or a commercial interest, as recognised in the *Teddy Scholten* case¹⁰⁰⁶. In that case, the famous Dutch singer, Teddy Scholten's portrait was used without her consent in an advertisement campaign and the Court formed a view that Teddy could have exploited her persona in similar endeavours but for a fee, so she had a reasonable interest in objecting to such uses. Similar commercial interest was also recognised as a reasonable interest to object in the *Feyenoord* case, where the Dutch court acknowledged that the players depicted would have consented to such depiction in return of a licensing fee or merchandising contract, which has been missed out due to the unauthorised use. The Dutch courts subsequently devised two criteria for establishing such commercial interest in *'t Schaep met de Vijf Pooten* case¹⁰⁰⁷, namely, the celebrity must have popularity acquired in the exercise of his profession and the potentials of commercial exploitation of that popularity. The criteria were applied and the objection based on pure commercial interest was given further prominence in the recent case involving the famous Dutch footballer Edgar Davies, where the footballer successfully objected to the use of a look-alike in a computer game, named, Lucian ADC.¹⁰⁰⁸ The first criteria, however, as Blackshaw¹⁰⁰⁹ commented, has over the years been relaxed, allowing celebrities who are famous for other reasons and not because of his/her profession (like YouTubers, vloggers, contestants of reality shows) to raise Article 21 objections based on their commercial interest.

However, such reasonable interests, be in privacy or commercial, will be weighed against the other competing interests like Article 10 ECHR. The Dutch court in *Murderer of G.J. Heijn*¹⁰¹⁰ affirmed this by stating such reasonable interests will not automatically render the use actionable and that such interests were not more absolute than the freedom of expression, media and/or public interest under the Article 10 ECHR right.

The celebrities in Netherlands, as such, can adequately safeguard their image or likeness aspect of persona under the statutory portrait rights, with the term portrait being able to absorb a wide range/variation of depiction as actionable under the right. The only downside is that the portrait rights does not account for other indicia of

¹⁰⁰⁵ *Naturiste* (n 996); See also, Supreme Court, 1 July 1988, NJ 1988, 1000 (*Vondelpark*). - linked Art 8 ECHR privacy rights with the Art 21 portrait rights.

¹⁰⁰⁶ Court of Appeal in The Hague, 13 April 1960, NJ 1961, 160 (*Teddy Scholten*).

¹⁰⁰⁷ Supreme Court, 19 January 1979, NJ 1979, 383, BIE 1979, no. 23.

¹⁰⁰⁸ *Edgar Davis Case* (n 1003); See also *Max Verstappen Case* (n 991).

¹⁰⁰⁹ Ian S. Blackshaw, Robert C. R. Siekmann, *Sports Image Rights In Europe*, (TMC Asser Press 2005).

¹⁰¹⁰ Supreme Court, 21 January 1994, NJ 1994, 473.

persona, like name, nicknames, autograph, voice, character, etc. Nevertheless, the right allows both the prevention of unauthorised use and control of commercial exploitation of their image/portrait, at the same time. The right also affords protection post-mortem, as Article 21 clearly provisions for the objection to be raised after the celebrity's death i.e., by his estates, meaning that any unauthorised post-mortem use which are demeaning or undignified or even those depriving the estate from commercial gains, can be objected to.

4.3.5(b) Other Sources of Protection:

The Dutch celebrities may also seek protection under the Dutch Trademark regime governed by the Benelux Convention on Intellectual Property (BCIP) and EU Trademark Regulation (EUTMR). Dutch celebrities have the option to choose either of these statutory regimes to trademark their names, nicknames and portraits, pursuant to Article 2.1 of BCIP or Article 4 of EUTMR, provided the marks proposed has a distinctive character. However, the requirement of distinctiveness, is also a limitation since trademark regimes such as these are not designed to protect celebrity persona, but to identify the source of the goods and distinguish it from the competitors. Additionally, trademarking the portrait may not necessarily provide sufficient protection as portraits can be made in an incalculable number of ways and it will be impossible to register all those variations for trademark protection.

Alternatively, if the portrait is found non-actionable under the Copyright Act 1912 or the unauthorised use relates to other aspect of persona which are not considered to form a *portrait*, celebrities can resort to the Dutch Civil Code Article 6:162 to prevent unauthorised use of their persona as an 'unlawful act'. Under the Civil Code, celebrities have been afforded protection against unauthorised commercial exploitation of their name. *Floris Jan Bovelander*¹⁰¹¹ illustrates a fitting example of this, where a famous Dutch hockey player Floris Jan Bovelander successfully prevented the Defendant sports company from using his name in the slogan 'Floris Johan Crujff' in advertising hockey shoes. The court clarified that such (mis)use of the famous hockey player's name will lead the public to associate the player with the advertised product as if he is approving and/or authorising it himself and that would constitute an unlawful act for the purpose of Article 6:162 of the Civil Code.

To sum up, even in the absence of a distinct and standalone personality or publicity right like the US or Italy, the Netherlands is offering protection to celebrity persona, through various statutory instruments, quite comprehensively. Though the most prominent one of protective instruments is exceedingly focused on protecting the image, portrait and/or likeness of celebrity and not the other indicia of persona, the other instruments, particularly, Article 6:162 of Dutch Civil Code, with its broad ambit of application has the potential to cover the gaps likely to be created by the Copyright Act. Most significantly, the right afforded caters strongly for the protection of economic

¹⁰¹¹ President of the District Court in 's-Hertogenbosch, 18 November 1997, PRG 1998, 4887.

values of a celebrity persona and not just the non-economic ones of privacy, dignity and reputation.

4.3.6: Sweden

The Swedish legal system does not recognise any right of publicity or personality. It, however, recognises a right to protect an individual's (and by extension, celebrity's) name and picture (i.e., aspects of his persona) against unauthorised commercial use through the Names and Images in Advertising Act (1978:800) – the '*Names Act*'. An individual also has the option to protect private/personal data under the Swedish Data Protection Act (2018:218).

4.3.6(a) *Swedish Data Protection Act:*

The Data Protection Act, which applies in conjunction with the Swedish Data Protection Ordinance (2018:219) was founded on the premise of EU General Data Protection Regulation¹⁰¹², prohibits unauthorised processing, collection and publication of personal data. Any personal data/information of the celebrities/famous persons would fall within the ambit of data protection; but, as the wording suggests quite clearly, protection is explicitly targeted at private 'information/data' and not to the person himself or the persona therein. As such, misappropriation or (mis)uses of celebrity persona is unlikely to be caught under the data protection net. Additionally, infringement of the Act may avail damages to the aggrieved celebrity for injury to feelings and/or integrity suffered due to the data loss; the Act does not recognise the need to compensate for the injuries caused to the celebrity's commercial interests that may also result from such misappropriation.¹⁰¹³ The Data protection regime, as such, appears to be unhelpful in cases of unauthorised commercial exploitation of celebrity persona and for the purpose of this Chapter and the thesis as a whole, this limb of supposed protection, will not be explored any further.

4.3.6(b) *Swedish Names Act:*

With the data protection regime kept aside the only other limb of the Swedish legal system that offers protection to celebrity persona is the Section 1 of the Names Act. The Names Act necessitates obtaining of explicit consent prior to the use of a celebrity's name and/or image in the context of marketing/advertising. Section 2 of the Act mandates that any intentional or negligent breach of Section 1 may attract a fine. Section 3 provisioned for payment of reasonable compensation to the individual (by extension, celebrity) whose name or picture has been used without consent in breach of Section 1; such damages are likely to increase if the violation has been intentionally or negligently done, and both economic and non-economic harms will be considered

¹⁰¹² Regulation (EU) 2016/679.

¹⁰¹³ Ian S. Blackshaw, C Robert & R. Siekmann, *Sports Image Rights In Europe* (TMC Asser Press 2005).

when measuring such damages. In Blackshaw's words, therefore, the Names Act is designed to safeguard an individual's integrity as well as his right to control the exploitation of his name and image in marketing/advertising contexts, and also provision for compensation if that right is breached through misappropriation by others.¹⁰¹⁴ Such rationale closely mirrors the German personality model, which not only enables protection of non-economic values of persona but also the commercial values of it.

For the celebrities, the test to qualify for this right, therefore, is one of identification/depiction; in that, the celebrity must be identified from the impugned marketing act where his name/image has been used without consent. As to the use of 'name', there is rarely any uncertainty as to who is being referred/identified through the impugned use, so this qualifying requirement appears to be conveniently realisable¹⁰¹⁵. In any event, the Court accepts use of surnames and nicknames, and does not require the name to be unique, so a commonly used name may also be actionable, as long as the relevant celebrity is identifiable¹⁰¹⁶.

As to the use of 'image/picture' of the celebrity, the depiction in the impugned marketing must be of such quality that it clearly refers to the celebrity in question or he/she is identifiable from that use or depiction. If the image is unclear enough to negate such identification but the accompanying text, coupled with the unclear image, can lead to the recognition of the celebrity, such use would still breach the rights under the Act. As confirmed in the case of *Kroppsbysgarfallet*¹⁰¹⁷, the Court would take into account factors such as the skin colour, facial expression, body constitution, posture and also the actual subject matter of the image in question, to ascertain whether there is a 'reliable basis of identification' of the celebrity. If the answer is in the affirmative, the right has been infringed, otherwise, there would be no liability under the Act.¹⁰¹⁸ These logically meant any images, old or new, direct or indirect, taken from the front or behind may qualify, if there are such elements present in the image that evoke an image of the celebrity in the eyes of viewers. This, indeed, offers a broad scope of protection for the celebrities under the Act. The test of reliable basis of identification was successfully applied in the case of *Anja Pärson*¹⁰¹⁹, where an image, which reliably identified Anja Pärson, a popular Swedish ski-racer, was used without her consent, by Eurosport (a sports channel), in advertising at 21 metro stations in Stockholm. The Court found such use to be in breach of Anja's section 1 rights under the Act and was awarded damages in the sum of SEK 80,000 in compensation of such violation. Similar conclusions were reached in respect of unauthorised use of image of famous Swedish actor, Robert Gustaffson on the last page of the Aktuell Rapport

¹⁰¹⁴ Ibid.

¹⁰¹⁵ See cases, *Anja Pärson*, Stockholms Tingsrätt Mål nr 16669-05; ; Patrik Sjöberg, Hovrätten för Övre Norrland Mål nr T 146/94.

¹⁰¹⁶ Ibid.

¹⁰¹⁷ Svea Hovrätt, Mål nr T 5273-00.

¹⁰¹⁸ Ibid.

¹⁰¹⁹ *Anja Parson* (n 1015).

magazine and the actor was awarded both damages and equitable compensation for such unauthorised use.¹⁰²⁰

In addition, section 4 further added that the Court can also order at the request of the celebrity himself, to change, remove or withdraw the impugned marketing materials or advertisement that included the celebrity's name or image from public domain, or even order destruction of such materials or its return to the celebrity in question. Interestingly, by virtue of section 5 of the Act, such unauthorised use of celebrity name or image may also attract separate criminal prosecution if the aggrieved celebrity files a criminal complaint or if such prosecution is necessary in the public interest. This is illustrated in the case of *Kjell-Olof Feldt I-II*, where the unauthorised use of the photograph of the then Swedish Minister of Finance, Kjell-Olof Feldt by an accounting firm and a bank in a newspaper advertisement was found in breach of his section 1 right and the infringers were prosecuted criminally under section 5, and fined for the misappropriation.¹⁰²¹ These clearly shows that the celebrities in Sweden can enforce their rights pertaining to their name and image both through the civil courts, gaining compensation and also through the criminal courts, getting the infringer criminally punished and creating a deterrent effect.

The right(s) under the Act, however, are not absolute or can automatically impose liability on the infringer. Sweden has ratified the European Convention of Human Rights by incorporating the convention rights into their domestic legislations, and therefore, the Swedish courts are required to balance the rights under the Names Act with the rights of freedom of expression and freedom of press.¹⁰²² In *Robert Gustaffson* case¹⁰²³, involving Robert Gustaffson's image, the court was required to balance his rights under the Act with the Article 10 rights of the publishers of the magazine, before ruling in favour of the actor. The Court in this case and also, subsequently in *Skådespelarkalender* case¹⁰²⁴, clarified that in achieving the balance, the Court would assess the purpose of the tradesman in using the celebrity's name or picture. If the purpose has been purely commercial in nature, in that, the tradesman's intention was to increase the product appeal and therefore, the overall turnover by associating the celebrity, then there is no room for Article 10 right to freedom of expression on the part of the tradesman to prevail. The Act only detects commercial uses on its radar and therefore, if the unauthorised use was aimed at making undue gains, it will become an object of intervention under the Act.

The right, however, only detects misappropriation of the celebrity's name and image; misappropriation of other and equally valuable indicia of celebrity persona, like voice, signs, autographs, character, etc are not protected under the Act. Malmsten argues that celebrity voice should be at least afforded protection under the Act, as celebrity

¹⁰²⁰ *Robert Gustafsson*, NJA 1999 s 749 (NIR 2000 s 108); see also, *Patrik Sjöberg* (n 1015).

¹⁰²¹ *Kjell-Olof Feldt I-II*, Svea Hovrätt, RH 1993:20 (I och II).

¹⁰²² See also, Tryckfrihetsförordning 1949 (Freedom of the Press Act 1949) and Yttrandefrihetsgrundlag 1991 (Freedom of Expression Act 1991).

¹⁰²³ *Robert Gustafsson* (n 1020).

¹⁰²⁴ NJA 2003 s 25 (NIR 2003 s 402, 2003 s 408).

voice is equally familiar to the public, just as their names and images, and misappropriation of that voice could as be as damaging as the same with name or image.¹⁰²⁵ Blackshaw, on the other hand contend, that the right is broad and sufficiently encompassing a wide number of celebrity characteristics, having now expanded to include nicknames and even jersey number of famous sportspersons¹⁰²⁶. Moreover, under the right, the level of compensation depends on the aggrieved celebrity's current or prior engagement in the marketing/advertisement industry. Cases like *Patrik Sjöberg*¹⁰²⁷, clearly shows that damages for violation of the concerned celebrity's right under the Act was significantly reduced due to the celebrity's limited presence in the marketing industry, regardless of the level of fame or popularity he held. Further, oddly, the Act did not provide for any post-mortem rights to the celebrities, meaning that the right(s) afforded under the Act extinguishes on the death of the celebrity.

To conclude, the protection available to celebrities in Sweden under this Act appears promising, attracting civil and even criminal liabilities, like some of its European counterparts; but it fails to apply to various other indicia of celebrity persona. Despite its restrictive application, celebrities in Sweden can still protect their personality rights and it can be done quite well, so long the misappropriation involves their name or image. It is true that other aspects of persona are not protected under the Names Act, but the same may be protected through other protective limbs within the legal system e.g., the Swedish Trademark regime. In any event, any form of marketing use, be it endorsement, merchandising, general advertisement are all covered under the right, so majority of (mis)use of celebrity name and image are likely to get caught under the Act. Overall, there is protection available in specific situations and in those specific situations, the protection is quite effective.

4.3.7: Norway

In Norway, there is no general right of personality or publicity, *per se*. It provides for the protection of celebrity persona through two distinct statutory instruments. There is an established image right, under the Norwegian Copyright Act 2018 and further safeguarding available under the unfair competition provisions stipulated in Market Control Act 2009. Each of these sources of protection will be considered separately, as follows.

¹⁰²⁵ Krister Malmsten, 'Idrottsutövares Namn Och Bild I Reklam, Idrottsjuridisk Skriftserie (Athletes' names and images in advertising)' (2001) 6 Artikel samling 161.

¹⁰²⁶ Ian S. Blackshaw, Robert C. R. Siekmann, *Sports Image Rights In Europe*, (TMC Asser Press 2005) 294.

¹⁰²⁷ *Patrik Sjöberg* (n 1015).

4.3.7(a) '*Retten Til Eget Bilde*' – Right to one's own image:

The notion of one's right to his own images got foothold of the Norwegian legal system as the early as beginning of the 20th century with the Photography Act 1909, which acknowledged such rights and the protection it requires. The right continued with the enactment of the Photography Act 1960 (section 15), being grounded on 'privacy', to supplement privacy provisions contained in the Norwegian Penal Code (s.390) and aimed at safeguarding an individual from unauthorised use/publication of his image/likeness. Subsequently, the right was incorporated into the Copyright Act 1995 (Section 45c), *now* superseded by the Copyright Act 2018, which carried forward the majority of 1995 Act provisions, including the right of image in Section 104, as '*Retten Til Eget Bilde*' –i.e., right to one's own image.

Section 104 of the 2018 Act, to be read in conjunction with sections 33 and 37 of the Act, stipulates that an image or photograph that depicts a person may not be circulated, published, reproduced or displayed publicly without the depicted person's consent, subject to certain exceptions.¹⁰²⁸ The right, therefore, affords an individual with an exclusive right/ control over his image/photographs, and to decide when and where those images/photographs will be used by third parties. Interestingly, from the wording of the statute, it is clear that the right does not require any goodwill or '*fame*' as a pre-requisite or qualifying factor – this effectively means that protection is available for both famous and 'not' famous individuals. Further interestingly, the right is not targeted at commercial activities only, meaning any non-commercial uses, such as casually posting another's image or likeness in Facebook¹⁰²⁹ or Instagram, would be caught under this right. In the context of commercial use, the Court has clarified that a special duty of care/caution should be exercised as 'consent' to the photograph being taken does not automatically extend to its subsequent commercial use (e.g. in advertisement or endorsements) and that a further consent would be required if such subsequent uses are intended.¹⁰³⁰

Significantly, the liability under the right is based on *misappropriation* only and unlike the English tort of passing off, there is no requirement for deception of public or misrepresentation for liability; rather, the decisive criterion for the court is whether the concerned individual is identifiable in the impugned picture which is being used without consent. A clear example of this is *The Arctic Challenge AS and Andy Finch v Tromsø 2018 AS*¹⁰³¹, where Andy Finch, a famous snowboarder, was successful in preventing the use of his photograph in an advertisement, even though his face was made invisible in the photo and it was taken from behind. The test, as such, for the Court was not whether the use of this image has deceived or confused the public in connecting the Andy with the subject matter being advertised; instead, the test was

¹⁰²⁸ Copyright Act 2018, S.104.

¹⁰²⁹ See, LH-2018-144282 (The publication of a picture on Facebook infringed the right in Copyright Act §104).

¹⁰³⁰ Rt. 1983 s. 637.

¹⁰³¹ HR-2009-2318-A – Rt-2009-1568.

whether Andy was identifiable from the photograph and if so, whether the photograph has been used without his consent, i.e., misappropriated.

In addition, the compensation awarded to Andy also reflected that the Norwegian Court's recognises the significant economic value attached to one's persona and that, section 104 would also extend protection to such values. Given the extensive commercialisation and commodification of famous persons, such recognition marked a significant development in the regime as it was framed on *privacy* to protect personal non-economic interests only. This outcome further complemented Jonger's¹⁰³² earlier contention, that the right should have a dualistic purpose and should safeguard both economic and non-economic interest embedded in one's image/photograph. The court's inclusion of pure economic interest under his right is also evident from the recent case of *Norwegian Football Association v Trannel International Ltd*¹⁰³³, involving unauthorised use of photographs of famous Norwegian footballers Earling Haaland and Marin Ødegaard. In this case the Defendant, a betting company, has used these footballers' photographs in their five different Instagram stories without consent, which was uploaded on the match day and was viewed by 400 people in a span of 24 hours (the lifetime of such Instagram stories). Although the Defendant had obtained permission from the photographer of the images (who held copyrights on them) but it did not the obtain consent from the players themselves, who were depicted on those images. Theses player has already licensed their rights on their images to the Norwegian Football Association, who initiated the claim against the Defendant. The Court, finding in favour of the Football association, held that, the Defendant has obtained a significant value, commercial or otherwise, from associating itself with, "...two national treasures in football boots just before a national match, and with links to and advertisements for gambling". The unauthorised use of these players' images was in breach of their section 104 rights and the Court awarded 900,000NOK as lost fees of participating in social media advertising campaigns of this nature that likes of Haaland or Ødegaard would have charged given their profile.

In contrast to recognising this exclusive right, section 104 also recognises the need to balance the same with other competing interests, namely, freedom of expression, media and public interest and therefore, has enumerated a number of ways how this balance can be achieved. The statutory instrument, as such, accounts for those instances where consent from the depicted person will not be required, namely, if the use is for the purpose of current and general interest; the image is an insignificant and incidental part of another image and is not the main content; the image is used as a reference to public assemblies, procession or events with general interest; image is used by the photographer taking it to advertise his skill but without any objection from the depicted person; and the image is used for educational, scientific or biographical purposes or the use is required under any other statutory instruments in force, like

¹⁰³² Maria Jongers, 'Retten til eget bilde' (2006) Oslo: Complex nr. 5, Senter for rettsinformatikk, 26.

¹⁰³³ TOSL-2022-34583.

Freedom of Information Act, etc. In all of these exceptions, preservation of public interest will be prioritised over the preservation of the exclusive image right.¹⁰³⁴

The law further stipulates that the right will be recognised throughout the lifetime of the individual and also for a further period of 15 years post-mortem; thus, recognising the need to safeguard a deceased individual's reputation, dignity and memories even after his demise and allowing descendibility of the right so that the estate of the deceased can raise objections against any unauthorised and immoral exploitation of the deceased persona. At the expiry of 15 years post-mortem, the right lapses bringing the image on the domain for public use, but the estate could still prevent such use through other protective rights, e.g. defamation.

Indeed, for celebrities in Norway, section 104 and the underlying regime offers a broad spectrum of protection. The framework detects misappropriation as actionable, with a relatively low threshold of 'identifiableness' of the persona in (mis)use. It protects celebrity persona from both commercial and non-commercial (mis)uses. Its dualistic model would enable the celebrities to prevent unauthorised uses if such use is contrary to the reputation and dignitarian values in their persona and also allow the celebrities to enjoin sales or recuperate loss of licensing fee or earnings if their persona has been commercially exploited without consent. The significance of such dualistic protection, as seen in the previous Chapter, is undeniable, as celebrity personality is built on both economic and non-economic values, and effective safeguarding would mean protection of both. Cases like *Andy Finch* and *Haaland & Ødegaard* further underscores the Norwegian courts' inclination towards safeguarding both the economic and non-economic interest under the section 104 right.

The exceptions to the right, on the other hand, may mean that celebrity photographs or likeness can be used without consent for news reporting or dissemination of information in the public interest - like, Haaland scoring goals for the national team or for Manchester City FC. Such public interest exceptions, however, has not been extended to commercial uses of celebrity persona, as confirmed in the *Haaland* case, since the court found such uses to be for the purpose of increasing the product appeal only and not for catering to any current debate or public interest. Keeping commercial uses outside the purview of the exception renders substantial leverage to the Norwegian celebrities to capitalise on their persona, through endorsement deals or granting licences, etc, and safeguard against any form of unauthorised commercial appropriation.

Overall, section 104, with its dualistic model, to cater for both privacy and personality interests, forms the first line of defence for celebrities against unauthorised exploitation of their persona in Norway.

¹⁰³⁴ See case, HR-2009-2318-A – Rt-2009-1568.

4.3.7(b) *Unfair Competition:*

The second line of defence for the celebrities comes with section 25 of the Marketing Control Act 2009¹⁰³⁵, which prohibits such commercial acts done in the course of trade that conflicts with good business practices among traders. Historically, Norwegian legal system had inbuilt safeguards to ensure fair trading practices. The Marketing Control Act 1972, now succeeded by the Marketing Control Act 2009, comprehensively prohibits unjust exploitation of another's goodwill and reputation. Section 25, as complemented by sections 26 and 30 of the Act, reinforces the need to ensure fairness in trade with an open-ended scope of protection against various exploitative marketing tactics and stunts. The wording of these provisions imply that these are aimed at safeguarding the underlying public interest in being not deceived or misrepresented through marketing and gives the overall impression that undue benefits from freeriding on another's reputation is prohibited. Resultantly, any unauthorised commercial exploitation of celebrity persona for advertisement, promotion, endorsement or merchandising purposes, where the exploiter is taking unfair advantage of that celebrity's fame or goodwill for making undue gains, will breach section 25. Lund further underscored this by stating that the notion of 'good business practice' in the provision has a scope broad enough to include protection of one's interest in the exploitation of his own character (persona).¹⁰³⁶ The rationale behind celebrity personality being afforded protection under this provision appears grounded on the fact that such (mis)uses will give an unfair advantage to the exploiter, which otherwise they would to pay to obtain (through obtaining license or offering endorsement deals). Such unfair advantage would undermine good business practices and ethics that section 25 is designed to ensure.

Same as section 104, liability under section 25 in the context of celebrity persona is dependent on 'misappropriation' and no public deception or misrepresentation is required. A fitting example of a section 25 liability involving misappropriation of celebrity persona is the case of *Bjørø Håland*¹⁰³⁷, where the famous Norwegian singer Bjørø Håland's name and the title of his signature song 'I love Norwegian Country' was used in a cheese advertisement by the Defendant. As a pun on the singer's song title, the Defendant added the slogan of 'I love Norvegia Country' to their advertisement. The singer invoked section 25, claiming that the Defendant has freerode on his name and goodwill to make unjustified economic gains. The Court found in favour of the singer, ruling that the misappropriation of Bjørø's persona for such commercial gains is against the notion of 'good business practice' and the financial benefit that this unauthorised use has conferred on the Defendant is precisely the unfair advantage that section 25 forbade.

Interestingly, the court, through this case extended the protection of section 25 to celebrity name and identity, which is not available under the section 104 right as it

¹⁰³⁵ Marketing Control Act 2009; <<https://lovdata.no/dokument/NLE/lov/2009-01-09-2?q=Marketing%20control>> accessed 27 January 2025.

¹⁰³⁶ Tore Lunde, *Good Business Practices Among Business People* (Bergen, 2000) 313.

¹⁰³⁷ RG-1995-151.

targets celebrity images only. This essentially meant that section 25 may be infringed by the exploiters in many ways and not just by using the celebrity's image or likeness. The case of *Pål Bang-Hansen*¹⁰³⁸, illustrates this better, as in this case the imitation of the voice of a famous TV personality, Pål Bang-Hansen was found by the court as an unfair capitalisation of his fame and goodwill for undue gains. Although this case was decided before the enactment of the 2009 Act, the decision aligned perfectly with the spirit of section 25, and therefore, been absorbed within it as an applicable precedent.

In general, the threshold of 'good business practice' also appears to be extremely flexible, allowing the potential to cover novel situations or even those that may fall outside the ambit of protection under the contemporary intellectual property rights regime in Norway like the Copyright Act 2018 as seen above. As such section 25 can be very adaptive to the everchanging commercial practices, particularly in the context of celebrity persona exploitation. Whilst this flexibility is a strength, it is at the same time, a weakness. Flexibility means no set standard and therefore, outcome will be very case specific, turning on facts and therefore, less predictable, and probably inconsistent at times. Regardless of no set standard, the test, safely presumed will be whether a celebrity's name, voice, likeness, identity or images has been unfairly exploited by another for making undue profits.

To conclude, with the two-tier safety measure applicable in full-swing, celebrity personalities appear to be strongly protected within the Norwegian legal system. Section 104 specifically protect image and likeness of celebrities, whereas Section 25 technically protects all indicia of celebrity persona, including images, as long as the unfairness aspect is satisfied. The threshold in all of these defensive mechanisms is relatively low and easily qualifiable, with both of them recognising misappropriation of persona as actionable. The legal system, therefore, not only allows a negative right – that prevents unauthorised uses of persona based on non-economic reasons like privacy, dignity or control, but also a positive right to safeguard their economic interest in licensing their persona or invest it on endorsement/merchandising ventures. All in all, Norway is offering a cohesive and effective regime that recognises celebrity persona as a high value commercial asset which is worthy of legal protection and simultaneously, provides for that legal protection to the standard required.

4.4: So, Who's better and who's not?

Based on the foregoing analysis of different forms of rights/protective tools available to celebrities across various common law and civil law jurisdictions, the jurisdictions discussed can be classified in three (3) categories. The first category comprises of those jurisdictions that have adopted/introduced a standalone, general right of publicity or personality. USA, Italy and Germany will fall in this category. The second category will include those jurisdictions, where no such standalone general right of publicity or

¹⁰³⁸ RG-1999-1009.

personality has been adopted; but some form of rights, commonly termed as 'right of image' has been introduced to safeguard some specific indicia of celebrity persona. Spain, France, Netherlands, Sweden and Norway, will be classed in this category. The final category will entail those jurisdictions, which did not introduce any such rights but has attempted to accord protection by using the existing legal doctrines (like in the UK) or has devised a new tort or improved an existing one to accord protection to celebrity personality/publicity rights. Canada and Australia will conveniently fit in this category.

Now that the necessary categorisation is in place, the safeguarding mechanisms that these jurisdictions have been offering to their respective celebrities, can be weighed/compared with each other, but within the category, so as to ascertain which of the jurisdictions in their respective class is providing most effective and adequate form of protection to celebrities. For the convenience of this weighing exercise, characteristics/ features of the protective tools of these jurisdictions, including but not limited to scope, qualifying threshold and descendibility will be pitted against one another.

As to the first category, the jurisdictions classed herein offers the most comprehensive form of protection compared to the rest of the categories, at least in theory, since they have recognised the concerned right as a self-sufficient, standalone and fully enforceable legal right. Despite being branded together, there is at least one prominent difference between these three jurisdictions; in that USA and Italy has embraced a right of publicity and Germany has embraced the broader version of publicity, that is, the right of personality. In essence, both versions of the right have been applied to safeguard the commercial value of celebrity persona; both versions has been given a broad scope of application, covering nearly all indicia of celebrity persona and all forms of appropriation; even both the versions have a relatively low threshold, being based on 'misappropriation' and requiring the test of identifiability to qualify. However, the publicity counterpart, as seen above, in theory and also in practice – particularly in the context of USA – are more focused on protecting the economic values of celebrity persona and the non-economic values like dignity, reputation and goodwill are given little or no attention. Whereas the personality counterpart is capable of protecting both as seen in Germany. Interestingly, in Germany, the right has been over-extended to cover even pure cases of privacy, defamation and even cases involving publication of personal information, which, in fact, it was never intended to cover. It just shows how flexible, broad and expansive personality rights can be. In Italy, however, the right of publicity has been applied to safeguard both values of celebrity persona – which indicates that publicity version can protect non-economic values too; but the trend in US is currently contrasting - perhaps because it has a well-established right of privacy in force to deal with issues of dignity and goodwill – and unless the Court decides to change the trend, such an application is likely to continue. Moreover, in terms of allowing descendibility, USA and Germany appears to side together but not Italy, since the issue of descendibility is yet to be fully determined by the Italian courts – probably by the further application of *analogia legis*. Until such time, these three jurisdictions cannot be harmonious in respect of descendibility but remain so in many other aspects

of its application. Overall, given the significant overlapping and/or similarities in the extent of application and protection, it is a very tough call to decide which jurisdiction champions this category. USA has been called the torch bearer in this particular area of law, with nearly all aspect of the rights being settled/determined. Italy has followed in the footsteps of USA to come this far but still has its bounds to be fully determined and being in the realm of common law, it is likely to be ever-evolving. On the other hand, Germany has introduced a 'jack of all trades' type right, which is definitely promising, but its limit of application, particularly in respect of the competing interests like public interest/freedom of expression, are yet to be clarified. Collectively, as such, the USA would continue to remain a step ahead of the Germany (and also Italy), until such grey areas within the German regime is clarified.

As to the second category, all the countries herein have accorded protection to celebrity persona by introducing some form of a special 'right' that functions towards safeguarding personality/publicity rights as protected in the first category. Invariably all the rights, although known by different names, as seen above, have been applied to protect both the economic and non-economic values of celebrity persona. Except for Sweden, the rest of the five countries in this group allowed descendibility of the right, although the position in France is somewhat still controversial, but it still allows. All of the five countries have based liability on a misappropriation model and the test is still one of identifiability. All of them are required to carry out the same balancing exercises in respect of Article 10 ECHR rights and also with other similar domestic competing rights. The rights, however, largely varies as to its true parameters of application and protection. Spain here leads the race, with its extreme interpretation of the term 'commercial use' and by covering nearly all indicia of celebrity persona as actionable. The Spanish right can be alleged to run toe-to-toe with the US right of publicity (Californian model, especially), given its broad coverage, extra-expansive definition of commercial use, low threshold and confirmed postmortem rights. Second comes Norway, with both right of image and unfair competition legislation, it also covers nearly all aspect celebrity persona. France comes third in the race, with its dualistic right that also covers various indicia of persona, very close to that of in Norway. Netherlands's approach is restrictive since it only finds unauthorised use of celebrity image/likeness actionable but not the taking of other indicia. So, Netherlands comes forth after France. Sweden, however, bottoms the list. Although it would have been the contender for the fourth spot, as the Swedish right covers more aspects of persona compared to just image/likeness as covered in the Dutch right, the Swedish right currently does not allow descendibility, which the Dutch right does, and hence compensated that deficit. Notwithstanding this comparison, all of these countries have offered their respective celebrities' praiseworthy tools of protection, majority of them being grounded in the Civil Code of the country, in the absence of a distinctive right of personality or publicity.

As to the final category, Canada has not, either federally or provincially adopted any right of publicity or personality. It has devised, provincially, a tort, specifically for the purpose of protecting such rights that are protected by the standalone

publicity/personality rights as seen in the first category. The tort protects both economic and non-economic values of celebrity persona, covers various indicia of personality, is based on a misappropriation model, and the common law version of it allows descendibility. On the other hand, Australia has mirrored UK, in that, it did not adopt any general right of publicity/personality, neither did it introduce any special rights as seen with the jurisdictions in the second category. It has used its existing right of actions, particularly, that in passing off and competition laws to offer protection to the celebrities. Australia has in fact improvised by expanding the doctrine of passing off to a significant extent (unlike the UK) to allow protection against unauthorised exploitation of persona. It is, however, still very restrictive, since liability depends on the proof of misrepresentation and not misappropriation, which the basis of the right in all the countries so far discussed. Overall, it is apparent that Canada champions this category quite convincingly. It, in fact, fosters the ability to match the US version even.

4.5: Conclusion

Above discussed are some of the many countries that have embraced and/or adopted personality rights within their legal system. To name a few more, countries like India, Japan, Russia, etc among others also recognises such rights. The increasing number of countries adopting the right alludes to the fact that such rights are quickly rising in the ranks of significance, just as intellectual property rights have, over the years. As the purpose of this Chapter was to analyse the nature and depth of protections available to celebrities in other countries, the comprehensive study on country-by-country basis has now sufficiently met the purpose. The nature and depth of protections that is apparent from the analysis above simply reinforces the fact that UK celebrities are far from getting even the most basic form of protection through the piecemeal approach available in the UK to protect their persona. This was first showcased in Chapter 2. Even Australia, who mirrored UK's piecemeal approach, had the opportunity to adopt a right in personality/publicity in case like *Henderson* and *Hogan*, but it chose to improvise (although restrictively) and accorded some protection to their celebrities, making such improvisation count. It is not that UK has not been blessed with a similar opportunity to adopt the right. In fact, UK was given this opportunity thrice, in *Irvine*, *Douglas* and *Fenty*, but it chose not to, rather it focused on expanding its existing tools, only to restrict those subsequently, making such improvisation pointless. With sufficient clarity on the non-existing personality rights in the UK in Chapter 2, the rationalities underscoring the need for such rights in Chapter 3 and Chapter 4, exhibiting the prime examples of such rights established in other jurisdictions, the thesis can now step into its final chapter, where prospective models for a right of personality will be proposed based on such rationalities and borrowing ideas from such exhibited jurisdictions.

CHAPTER - 5

5.1: Introduction

This Chapter is the final instalment of this thesis, which builds on the premise of Chapter 4, where several jurisdictions that offers personality rights or similar protections to their celebrities have been analysed. Having showcased that UK does not currently offer any effective and adequate means of protection to its celebrities, whereas its European counterparts and western cousins does, the thesis is now mobilised to make recommendations/proposals to the UK so that the gap created can be covered. The aim is not just to fill in the lacunae in law. It is also to provide recommendations that would design the regime to meet the commercial reality of celebrity persona and at the same time balance the right with competing public interest and Article 10 rights.

In the following sections of this Chapter, several proposals/recommendations in the form of models will be provided, where each will separately and specifically address its nature, scope, liability structure, qualifying test, and the issues of transferability and descendibility. It will then focus on potential defences/exceptions to the proposed right and common remedies, generally applicable to all the models advanced. Throughout the proposed models, the broader concept of 'personality' is recommended over the US's (and also Italy's) concept of 'publicity'. The publicity model is often viewed as a right that is more focused on the protection of the economic interest of celebrity persona.¹⁰³⁹ Whereas, Beverley-Smith accurately remarks, "...*personality right is regarded as one single right, which protects both economic and non-economic interests.*"¹⁰⁴⁰. Therefore, recommending a right of personality, instead, aligns well with the essence of this thesis, as it rationalises the protection of celebrity personality on the need to safeguard both the economic and non-economic values of persona. Germany is a working and fully functional personality right model, where both of these values are being protected. Canada has introduced a tortious model (both at common-law and in statute) to protect both values. European civil law countries like Spain and France have introduced image rights, but such rights now encompass a broad range of persona and lowkey serves as right of personality that protects both the embedded values. Support to the models proposed, therefore, will be drawn from comparative analysis of these jurisdictions and also from various English case precedents and English IP law regime. Once the proposals have been illustrated, the thesis will attempt to answer/clarify some of the incidental issues pertaining to the proposed models and the personality rights therein.

¹⁰³⁹ See, *Haelen* (n 408); J. McCarthy, *Rights of Publicity and Privacy* (2nd Ed New York: Clark Boardman Callaghan, 2001) 3.

¹⁰⁴⁰ Beverley-Smith, (n 290) 133. See generally, Waelde and Whitty (n 358).

5.2: Proposed Models

5.2.1: Right of Personality in *Statute*

A statute-based model would entail the enactment of a distinct, standalone and dedicated right of personality statute or an Act of parliament, that accords famous individuals/celebrities an 'exclusive' right to control the use/exploitation of their persona and the indicia therein. In a legislative/statutory form, the personality rights could receive the much-needed clarity, uniformity and certainty in terms of its framework, and would definitely supersede the existing patchwork of protective tools, which have been proved to be inadequate and ineffective, already. Such a statutory model would also resonate with the Californian model, as discussed in Chapter 4.

5.2.1(a) *Nature/Basis of the proposed Right:*

The statutory right of personality could be framed as an exclusive *property* right with roots in the realm of intellectual property, mirroring the footing given to copyrights, patents and trademark in the UK. The conceptual and contextual fitment of personality rights as property rights has been tested in Chapter 3 of this thesis, and despite there being contrary views¹⁰⁴¹ against the merger of these rights, framing personality rights as such appears to be practically possible.¹⁰⁴² Most significantly, the US's publicity right stands as the best example of a workable and fully functional model where personality rights have been classified/framed as a property right, allowing further justifications to be drawn for such a proposition. Framing it as a property right would have advantages of its own; in that, it would provide for the transferability of the exclusive right of exploitation to third-parties, in the form of 'license' (as seen in *Douglas*) in multi-faceted commercial enterprises and thus, correspond well with the commercial reality pertaining to celebrity persona. In addition, it would create the scope for post-mortem rights for a definite period of time, by way of making the right descendible/inheritable upon death of the celebrity. Basing the right, however, on any other classification, e.g., purely in privacy, would not allow for the right to be transferable throughout the lifetime of the celebrity, since it would be considered 'inalienable', and based on the same ideology, the right would extinguish on the death of the celebrity, hence rendering any post mortem rights impossible.

5.2.1(b) *Scope of the proposed Right:*

The proposed model would expressly define what constitutes as 'persona' for the purpose of protection under the statutory right. For maximum clarity, the definition should be clear and unequivocal, and at the same time broad and flexible to include such indicia of persona from which a celebrity can be identified/recognised. At the minimum, the right should cover the name, image, likeness and similar distinctive

¹⁰⁴¹ See, Black (n 47) 370-372.

¹⁰⁴² See Westfall & Landau (n 503); Armstrong (n 6).

indicia of celebrity persona – as these are the usual attributes that makes a celebrity famous.¹⁰⁴³ However, the vast jurisprudence analysed in Chapter 4 alludes to a much different reality. The purview of celebrity persona is no longer limited to his name, image or likeness; it has now extended to voice, signatures, pseudonyms, stage names, slogans, unique mannerisms/gestures, special characters traits and even caricatures. Italian courts have held celebrity's signature/distinctive character traits as actionable persona¹⁰⁴⁴. US courts have recognised unique catch-phrase¹⁰⁴⁵ as an indicium of persona as well. Then there are other established but extreme examples, where sound-alikes¹⁰⁴⁶ and look-alikes¹⁰⁴⁷ were also covered by the right. Based on such working examples, even the extreme ones, the proposed model should, at the maximum, be inclusive of all of these indicia of persona as object of protection under the right. Anything falling short would render the right deficient compared to the commercial practicality of celebrity persona.

Nevertheless, there would still be difficulties in engrossing all aspects of persona under the model, e.g., fictional characters played by celebrities as these are likely to be displaced due to the dignitarian justifications of the right.¹⁰⁴⁸ As discussed in Chapter 3, dignitarian justifications portray that the right covers the inherently *personal* image and reputation of the celebrity, and by analogy, fictional characters are not inherently personal and/or the 'actual' self of the celebrity in question. So, fictional characters used in the case of *TheTurtles* are unlikely to qualify for protection under the right, in theory, but use of real characters would, as in *Irvine* and *Fenty*. In practice, however, fictional characteristics can be so closely intertwined with the actual self of the celebrity that he be commonly referred by it and thus, being clearly identified from any unauthorised use. Consider the fictional character of 'Iron Man' played by Robert Downey Jr and 'James Bond' by Daniel Craig.¹⁰⁴⁹ Unauthorised use of such fictional characters, let's say in commercials/merchandising would undoubtedly paint the picture of these celebrities on the minds of the public and increase the commercial appeal, just as the use of their name or other distinctive indicia would. As, ultimately, the crucial part of the goal underlying this right is to prevent marketers/publishers from freeriding on a celebrity's fame, the proposed right should be justified in covering fictional characters in addition to other indicia of personality.

In any event, caution needs to be exercised in not making the definition too rigid or restrictive by enumerating an exhaustive list of indicia that will be covered. This can be seen in similar legislations in California (although this rigidity is compensated by the common law version of the right, running parallelly there) and New York.¹⁰⁵⁰ Rather, the definition should be drafted flexibly and expansively, with such qualifiers

¹⁰⁴³ See also, Amin (n 265) 119.

¹⁰⁴⁴ *Dalla* (n 936).

¹⁰⁴⁵ *Carson* (n 680).

¹⁰⁴⁶ *Midler* (n 279); *Waits* (n 280).

¹⁰⁴⁷ *White* (n282); *Onaisis*(n 33).

¹⁰⁴⁸ See, Black (n 47) 142.

¹⁰⁴⁹ See also, *Hogan* (n 794) for the Australian example of Paul Hogan & Crocodile Dundee character.

¹⁰⁵⁰ See also, Guernsey's Image Rights Ordinance (which has not been discussed in this thesis, but is an interesting reference).

that detects clear identifiers, any unique elements, signature expressions/styling or special character traits as actionable persona, to accord maximum protection. Furthermore, with the enumeration of a non-exhaustive list of actionable indicia and a flexibly formulated definition, celebrities could be offered protection against all forms of creative attempts of misappropriation, which may not involve the literal use of name or image, or the indicia already listed. Moreover, a flexible approach towards what constitutes actionable persona would allow the statutory regime to adapt with the ever-changing facets of celebrity personality and keep it relevant with the fast-evolving commercial practice involving celebrity persona.

5.2.1(c) Test, Liability Model and Defences under the Right:

The liability structure under the statutory model will be essentially of three folds; in that there must be an appropriation i.e., unauthorised use of persona, the unauthorised use must be for commercial purposes and the use must be such that the celebrity is identifiable from the use.

A purely 'appropriation' based model would ideally mean that no proof of misrepresentation or intention to deceive or confuse the public on the part of the exploiter will be required to establish liability. The mere '*taking*' and/or '*use*' of the persona without consent/authorisation should suffice for liability, provided it has been used for commercial purposes and subject to the exceptions allowed in the statute (to be discussed below, in general). Under the appropriation-based model, therefore, any entity which has appropriated persona, would be liable regardless of whether it honestly believed that the use was lawful¹⁰⁵¹, regardless of using clear disclaimers¹⁰⁵² and regardless of whether it actually intended to imply endorsement/association with the celebrity. This model will also not require proof of prior goodwill to qualify for protection, as required in passing off. As such, the new or '*lesser*' celebrities who are famous but are yet to market their persona or even those '*higher*' celebrities who does not want to market their persona (and may not have an established commercial goodwill), would be eligible for protection under the right. Furthermore, following the Canadian provincial versions of the right, proof of actual financial loss/harm would not be required as a pre-requisite since the proposed right would also protect dignitarian interests, which might be harmed even where no financial losses has been sustained from the unauthorised use. Although proof of financial losses will have a direct impact on the levels of damages awarded and that, it may be nominal if no actual financial losses can be demonstrated, proof of such damage will not be strictly necessary for establishing liability. Moreover, in this way the proposed model would eliminate the very deficiencies that exists in the action of passing off, which has rendered it as an ineffective and inadequate tool of protection against misappropriation of celebrity persona. With only requiring proof of appropriation to establish liability, the model can prove to be a powerful and straightforward tool for the celebrities. Support for a purely

¹⁰⁵¹ See, *Bogajewicz* (n 743).

¹⁰⁵² See, *Vitti* (n 940).

misappropriation model can be obtained from the functioning models in practice as discussed in Chapter 4. Invariably all the jurisdictions discussed (except Australia) overlaps, to the very least, on the point of having a purely appropriation-based model for liability. Further support for a such model can be obtained from the existing intellectual property regime in the UK pertaining to copyrights and patents, where the mere unauthorised use or taking is sufficient to attract liability.¹⁰⁵³

The model should, however, include a ‘minimal fault’ requirement to avoid catching purely inadvertent, accidental or incidental use of celebrity persona as actionable. It can borrow ideas from the Californian statute which includes *knowing* uses only as actionable or from the Canadian provincial statutes (except British Columbia), which requires the appropriation to be done intentionally or knowingly. Use of such terms in the statutory provisions would ensure that only deliberate and intentional (mis)use of persona is penalised under the right, which is self-evident when appropriation is done in the context of advertising/merchandising/endorsing as the exploiter has knowingly chosen to use the persona to benefit himself from it. In any event, uses which are inadvertent or accidental are likely to fall within the ‘incidental’ use exceptions, which will be discussed below together with other likely exceptions.

The model would require the appropriation or unauthorised use to be purely commercial in nature – another feature where all the jurisdictions discussed in Chapter 4, invariably, overlaps. The proposed statutory provisions should meticulously define what would be construed as an actionable commercial use, as the definition would dictate the actual ambit of the right and draw the line between actionable uses and non-actionable uses. In doing so it will play a crucial role in balancing this right with other competing rights/interests (to be discussed below). The majority of the established models, generally, constricts commercial uses to advertising, merchandising and/or endorsement of goods/services only; the fact that there can be invisible and/or ulterior commercial element in uses such as publication under the guise of news-reporting or entertainment are often overlooked.¹⁰⁵⁴ To avoid this, the proposed model can embrace the broad interpretation of ‘commercial use’ from the Spanish version of the right. Following Professor Llari’s¹⁰⁵⁵ articulation (made in the context of Spain), the UK definition should include any use that results in or is intended to bring financial/economic gains to the exploiter as an actionable use, instead of just restricting it to advertising and similar marketing activities. Adopting the Spanish definition for commercial use may also mean penalising even those publications which does not entail any commercial gains as the Spanish right deems such publications of persona actionable under the right. However, caution needs to be exercised in not embracing it fully, particularly where it makes non-commercial publications automatically actionable. As the proposed version of the right protects dignitarian values of persona as well, non-commercial uses may only get attached, and that too

¹⁰⁵³ See CDPA 1988.

¹⁰⁵⁴ María Eulalia Amat Llari, *The right to one's own image and its advertising value* (Wolters Kluwer Spain, 1992).

¹⁰⁵⁵ Ibid.

as an exception, if the impugned use is found to be injurious to the celebrity's dignity, reputation and public perception. This is particularly important, as otherwise, non-commercial uses causing such harm would remain un-remedied, since not all such uses would be derogatory/libelous in nature or entail private information and therefore, the celebrity may not qualify for protection under the UK's defamation laws or privacy rights. With a broad definition, like actionable 'persona', the model will be versatile in capturing all forms of commercial uses, explicit or implicit, and will be adaptive to the fast-evolving forms of commercial appropriation of celebrity persona. Furthermore, stipulating only one specific exception to commercial use, in that, non-commercial use that prejudices the dignitarian interest being actionable, the model will be provide clarity as to its actual ambit of protection and safeguard both economic and non-economic values of persona, effectively.

Finally, the model would require that the relevant celebrity is identifiable, recognisable or referable from the unauthorised use in order to establish liability. This is another point of overlap between the jurisdictions that has introduced such a right in their legal system. Such test of identifiability would clearly complement the broad definition of persona that will be adopted in the model and would ensure that any identifiable aspect of persona, even those not already listed or recognised in the model, is brought under the right. The test, therefore, would simply require the unauthorised use to include such elements from which the relevant celebrity is recognisable or identifiable. Without this test, it would be impossible to accommodate uses like graphic representations¹⁰⁵⁶, sound-alikes, look-alikes or even uses of unique catch-phrases¹⁰⁵⁷ or special character traits within the parameters of protection under the right. Following the Dutch Court's ruling in the Louis Van Gaal case¹⁰⁵⁸, for the purpose of the identification/recognition test, the use will not be required to create a full image or representation of the celebrity depicted in the minds of the public; nor it will require every viewer to recognise the celebrity; only a reasonable number of viewers being able to reasonably identify the celebrity from the use, should be sufficient to attract liability. Therefore, a test based on *objectivity* would make it more effective, in that, it will be tested whether a reasonable person would recognise or identify the celebrity from the impugned use. Such an objective test will effectively cover circumstances where a well-known body part of a celebrity (see the example of Scarlett Johansson's eyes in Chapter 4) is appropriated (in isolation) in a use, which does not include the literal use of name or image of the celebrity. Furthermore, it will also help to avoid frivolous and trivial cases where the use of persona is *de minimis* or the celebrity is unrecognisable from the use, as seen in the Canadian case of *Joseph v Daniels*.

Lastly, in the statutory model, to attain clarity and coherence, the legislation must enumerate a non-exhaustive list of uses that are likely to suffice as a defence or as exceptions to the right. To allow further clarity and flexibility, the provision should include a clear definition/test for determining public interest, and factors to be taken in

¹⁰⁵⁶ *Emilio* (n 967).

¹⁰⁵⁷ *Carson* (n 680).

¹⁰⁵⁸ *Van Gaal* (n 997).

to account in balancing the freedom of expression under Article 10 of ECHR. Potential defences/exception of the proposed right will be discussed below, separately.

5.2.1(d) Duration, Transferability and Descendibility of the Right:

As under this model the right will be given a '*property*' footing, mirroring the US version of the right, the transferring of exclusive right of use of persona to third parties will be relatively straightforward. The statute, however, will have to enumerate the duration of such rights, both pre-mortem and post-mortem.

In terms of pre-mortem duration, i.e., the duration of the right during the lifetime of celebrities – the US publicity model typically allows for a lifetime duration as it is classified as a property, the right of which remains with the owner throughout his/her lifetime.¹⁰⁵⁹ However, such a proposition could be potentially challenged since in the UK, traditional intellectual property rights are time limited during the lifetime of the creator/author/inventor; in that, patent rights expires after 20 years and are not renewable; trademarks rights are accorded for a period of 10 years but are renewable, so technically can last indefinitely if renewed routinely. Advocators of a time-limited right, often base their argument on the need to restrict monopolistic rights such as these for the shortest possible of time¹⁰⁶⁰; others argue that the fixed time right would reduce the costs of tracing the holder of the right for consent.¹⁰⁶¹ Respectfully, however, arguments such as these fails to comprehend the real purpose of a personality right. This right will allow the celebrities to control their persona that is required if they are to safeguard both the economic and dignitarian values embedded therein. Any argument for a time-limited right to avert monopoly may apply to the economic side of the persona, but it cannot definitely apply to the dignitarian side, which would need protecting, at least, until the death of the celebrity.¹⁰⁶² As under the proposed model and in general, personality rights are a mix of both values and one cannot be alienated from the other, the pre-mortem duration of the right will be proposed for the lifetime. Support for a lifetime duration of right can be also drawn from nearly all the civil law jurisdictions discussed in Chapter 4.

As to the post-mortem rights, again, basing the right on property would allow inheritability or descendibility of the persona to the estate just like any other tangible and intangible property. For clarity, the proposed statute would be required to enumerate the duration of such post-mortem right, i.e., the duration of the right after the death of the celebrity and also who can enforce it. Taking inspiration from the Californian model (which allow 70 years post mortem)¹⁰⁶³, the proposed UK statute may stipulate that the right can be enforced for a specific number of years. UK may alternatively follow Spain, which allows post-mortem rights for the lifetime of the

¹⁰⁵⁹ See, McCarthy (n 44).

¹⁰⁶⁰ N MacCormick, 'On the Very Idea of Intellectual Property: an Essay According to the Institutional Theory of Law' [2002] IPQ 227, 237.

¹⁰⁶¹ WM Landes and R Posner, 'An Economic Analysis of Copyright Law' (1989) 18 J Legal Stud 325, 361.

¹⁰⁶² See also, Black (n 47) 161

¹⁰⁶³ California Civil Code, Article 3344(1).

beneficiaries, but arguments against a monopolistic right may strongly surface, if this is allowed. However, UK can definitely, follow Spain, where the State is allowed to enforce the rights for a fixed period of time post mortem if there are no heirs or beneficiaries to inherit the right.¹⁰⁶⁴ For further clarity, the statute may also prescribe who would hold the rights post-mortem; it may be either the estate, comprising of those who can qualify as beneficiaries following the laws of intestacy in the UK or may be the beneficiaries, named in the will left by the celebrity.

5.2.2: Tort of Appropriation at *Common Law*

Alternatively, or (better put as) prior to the enactment of a legislation as proposed above, the UK judiciary could recognise a right of personality at common law by carving out a new tort of appropriation or expanding an existing tort. The judiciary of the country is empowered with a wider discretion to interpret laws/rights as it deems fit and also invent one where the legislation is silent. Such discretion may not be as wide as Italy's *analogia legis* but has similar potential. This is prominently evident from *Campbel*, where judicial dexterity and creativity lead to the development of misuse of private information tort from the traditional doctrine of breach of confidence (as applied in *Douglas*). Under this model, which is basically allowing a right of action in tort, celebrities will be able to invoke such a cause of action to prevent unauthorised exploitation of their persona.

Now under this model, the UK court could either extend an existing tort or devise a new and independent tort of appropriation. If the UK court were to extend an existing tort, the doctrine of passing-off would appear to be the most suitable candidate given how this cause of action has been so far invoked to seek protection against misappropriation and more so, because in cases like *Irvine & Fenty*, the Courts have already nudged this doctrine in this direction.¹⁰⁶⁵ Doing so would be replicating what the Australian courts have done in cases like *Henderson* and *Hogan*. However, improvising and extending the doctrine will not ultimately remove the requirements of misrepresentation, goodwill and damage, as it is with Australia, and the deficits that rendered this doctrine inadequate and ineffective, would continue to subsist. As such, proposing so would not be in line with the spirit of this theses and hence, it is not preferred and will be discouraged full-heatedly.

The only other option, as such, that remains is to introduce/acknowledge a tort of appropriation of persona at common law. Now doing so is very much possible; a prime example is the Ontario Courts, acknowledging such a tort and recognising protection of personality rights through it in *Krouse* and subsequently affirming the same in *Athans*. Another reason is that the UK courts have been in the exact same position as the Ontario Courts, thrice, in *Irvine*, *Douglas* and *Fenty* where the Court could have embraced the tort of appropriation; the only difference was that the Ontario courts

¹⁰⁶⁴ See Organic Law of May 5, 1982, No. 1/1982 (1982/1197), Article 4.

¹⁰⁶⁵ See, Walsh (n 102); Beverley-Smith (n 141).

decided to cross that line, but the UK courts did not. Scholars and expert have critiqued these cases being covertly personality cases where the courts actually answered personality right concerns but overtly made it look a case of passing off (as in *Irvine* and *Fenty*) or privacy (as in *Douglas*).¹⁰⁶⁶

5.2.2(a) Nature/Basis of the proposed Tort:

Following the Canadian (Ontario) model, the tort can be formulated as an ‘economic tort’ which would recognise the proprietary interest of celebrities in the exclusive control of their persona and also the associated dignitary interest that rests with such control. Borrowing the justifications of the experts used in classifying personality rights as property rights in Chapter 3, at common law as well, the proposed tort can recognise personality right as a form of property right, just as goodwill of business is recognised as property under the tort of passing off. The proposed economic tort can be combined with the equitable notion of unjust enrichment, which collectively can prevent third parties from free-riding on celebrity fame and goodwill, without any compensation to the celebrities and getting unjustly enriched. Whilst, this is the preferred basis of the proposed tortious model, one can argue the same could be based on other established principles like Article 8 privacy interest (as attempted in *Douglas*) or as an extension of the tort of misuse of private information. For clarity, however, privacy could indeed protect the non-economic values of the persona, but not the economic values of it, rendering it unhelpful in achieving the ultimate goal of formulating this new tort. Also, founding it solely on privacy actions would make the right not transferrable/assignable during the lifetime of the celebrity or allow post mortem rights, which, collectively, will conflict with the commercial reality involving celebrity persona.¹⁰⁶⁷ In terms of the tort of misuse of private information, it will appear to be a doctrinal misfit since not all personality cases will involve appropriation of private information meaning that majority of such cases will be missed by the tort.¹⁰⁶⁸ Instead, an economic tort that would recognise personality rights as a property right and therefore, allow for both transferability and post-mortem rights would be the suitable basis for the new tort.

5.2.2(b) Scope of the proposed Tort:

The ultimate goal is to achieve the same extent/level of protection and coverage for the common tort as has been proposed for the statutory model. However, as the proposed tort will be shaped through judicial law making, the scope of the tort will be defined through case judgments, incrementally. As, unlike the statutory model, the UK courts are unlikely to enumerate a non-exhaustive list of actionable persona for the common law tort, at the first instance; recognising different indicia of persona and thus

¹⁰⁶⁶ See, Carty (n 289); Davies (n 133).

¹⁰⁶⁷ See also, Nimmer (n 157); Madow (n 59).

¹⁰⁶⁸ Ibid; See generally, Black (n 47).

filling up the list, would specifically depend on the facts of the case and the nature of appropriation, therein. Initially, the Courts may be able to rule names, image and likeness of celebrity as actionable persona, following the existing precedents of *Irvine*, *Douglas* and *Fenty*. The most convenient approach for the UK judiciary, however, would be, as proposed with the statutory model, to formulate a flexible definition of persona that would catch unauthorised use of any identifiers, special character traits and/or any unique features of the identity as actionable under the tort. Formulating such a workable definition would almost replicate the trend of the Ontario judges in the early personality cases of *Krouse* and *Athans*.

Moreover, common law often develops by analogy. As personality rights are still in the embryonic stage in the UK with very limited case precedents, the UK judiciary may well take ideas from the persuasive authorities in foreign cases, particularly those where similar tort or right has been introduced. Such is not uncommon, as the *Irvine* ruling was said to be influenced by the Australian decision of *Henderson*.¹⁰⁶⁹ In applicable cases, the UK judiciary could draw influence from the US cases like *White*, *Waits*, *Midler* and *Carson*, to recognise voice, sound-alike, lookalikes or catch-phrases as actionable persona. Italian cases like *Dalla* and Spanish cases like *Emilio*, can influence to accept use of unique character traits of celebrities as actionable under the tort. The flipside, however, is that expansion of the scope would have to wait until the judiciary is faced with cases involving novel uses of persona. Only then, the judges will be able to develop and expand the scope of the tort, further. Resultantly, the development of the common law tort can be relatively slow, and its true ambit of application may remain blurred.

5.2.2(c) Test, Liability Model and Defences under the Tort:

As with the proposed statutory model, the qualifying test for this proposed tort would entail proof of appropriation of celebrity persona without consent, the use was commercial in nature and lastly, the relevant celebrity is identifiable/ recognised from the unauthorised use. Similarly, the appropriation-based model, mirroring the common law version of the tort in Ontario, will not require any proof of public deception/misrepresentation as condition precedent for liability. It would also not require any proof of malice or intent of harm on the part of the exploiter; simply the intentional taking of persona will be actionable. Furthermore, with such an appropriation-based model, which would not require proof of misrepresentation, goodwill and damage, the tort could be developed distinctly and separately from that of passing off and a liability model akin to intellectual property rights can be established. As to the actionable use, it must be commercial, of course, with the exception of non-commercial use harming the dignitarian values of persona, as proposed with the statutory model. However, as the tort will be developed judicially, replicating the Spanish model particularly in defining commercial use will ultimately

¹⁰⁶⁹ David Tan, 'The Fame Monster Reloaded: The Contemporary Celebrity, Cultural Studies and Passing Off' (2010) 2010 Sing J Legal Stud 151, 155.

depend on the discretion of the judiciary; they might or might not be influenced by it. Lastly, the test would remain to be one of identifiability, as proposed with the statutory model. This would again complement the undefined/blurred scope of the tort, but positively, by allowing the judiciary to be creative in deciding which factors/elements make the celebrity identifiable/recognisable from the use. The test of identifiability would be also based on objectivity, so that trivial claims and 'de minimis' uses could be avoided from being penalised. Having said that, it must be remembered that the test and overall liability model under the common law tort will be developed incrementally; therefore, the full model may not come about through one ruling but may surface, in culmination of a series of case laws and as such, would take time to develop.

Under this common law model, the courts will be required to make room for plausible exceptions/defences, so that the competing public interest and exploiter's right to freedom of expression under Article 10 of ECHR are not arbitrarily displaced by the right protected under the tort. The recognition of likely defences/exceptions will be, therefore, incremental and depend on the circumstances of the case the court is faced with. If this model is adopted, the court will be mandatorily required to balance public interest/freedom of expression with the personality rights; in that, as the defences/exceptions discussed below, in general, will show that purely artistic, creative, informational and/or news worthy uses, which does not entail any commercial gains and also does not injure the non-economic values of persona, will tip the balance in favour of the exploiter and disapply the right.

5.2.2(d) Duration, Transferability & Post Mortem Protection under the Tort:

Given the development of the tort under this model is inherently incremental, transferability, duration and the descendibility would depend on the case precedents and in the absence of such precedents on the prospective rulings of the Court. *Douglas* could be used as a precedent to allow transfer/assignment of the right under the common law model. Post mortem enforcement, however, may seem to be uncertain, absent any relevant English precedent or absent any legislative framework. A creative justification can be borrowed from the Ontario Court's ruling in *Gould*, in respect of a similar tort, where the personality rights, particularly the economic side of it, were held to outlive the celebrity and thus, possibilities of post-mortem enforcement was affirmed. However, such a rationale could be applied and descendibility regularised only when a case posits the question of inheritability/descendibility of such rights. Until such questions are brought before the Court for judicial consideration, the common law tort model is unlikely to cover post-mortem aspects of the right. As to the duration of the right pre-mortem, the thesis will piggyback on the exact same rationales used in the statutory model above to have a lifetime right. For the post-mortem duration, when determining whether post-mortem enforcement will be allowed, the Court will be required to also state the duration for such enforcement and also, who could enforce it.

5.2.3: Right of Personality in a *Hybrid* model:

This model aims to stand on a combination of a statutory and common law regime so that the benefits of both can be harnessed together. This approach leverages a statutory regime to enact the right and other governing provisions. It, simultaneously, leverages the flexibility and adaptability of common-law by leaving room for judicial interpretation of the aspects of the enumerated statutory right and develop its parameters, without needing any further parliamentary interventions.

This hybrid model is inspired from the US (Californian) model, which shows that personality rights can have both statutory and common law dimensions, as in California such rights are recognised both in statute and at common law and, hence offering multi-layered protection. Like California, functioning hybrid models are present in Canadian provinces where some has introduced privacy based statutory tort of misappropriation (like Manitoba, Newfoundland, etc) and others like Ontario and Quebec has introduced similar torts at common law – collectively forming a patchwork in which the Canadian courts navigate drawing protections from both dimensions. In Italy, there are specific personality rights recognised in the statute and also, a general right of publicity has been introduced by judicial interpretation in cases, therefore, providing a working example that such rights can co-exists being based in both statute and at common-law.

5.2.3(a) *Nature of the Hybrid Model:*

In practice, the model would involve a statutory framework, which will dictate the general right of personality and broadly outline the category of uses the right prohibits, the classification of objects that it protects and circumstances where the right might not apply. The governing legislation would classify such rights as a property right (as proposed in relation to the statutory model above) in the context of intellectual property and in classifying so, would allow such rights to be transferrable by celebrity during his lifetime and also descendible upon death. The framework statute will simply codify the right of action and not list exhaustively every actionable scenario, unlike the statutory model proposed above. The legislation will also not specifically define what would constitute as actionable persona, commercial uses or list the exact defences/exceptions; rather it would be open for the Court to interpret the statute as need be depending on the facts of the case and thus, develop the nuances. The Courts, as such, will have a free hand to devise a case specific and purposive interpretation of actionable *persona* and actionable uses, and also flesh out the plausible exceptions/defences, in line with the competing public interests and freedom of expression. Such a hybrid model could be extremely effective in adapting and reacting to the fast-changing nature of misappropriation of persona and creative (mis)uses. The judiciary will have the option to interpret the scope and applicability of

the right, as and so they deem fit, based on the facts in front of them and does not have to remain fixated on the wording of the statute.

5.2.3(b) Scope of the Hybrid Model:

As to the scope of the right under the hybrid model, it is apparent that the judiciary will interpret and define what would ultimately constitute as an actionable persona. As such, the scope is likely to be defined incrementally, just as in the proposed common law model. The only difference here is that, as there will be a framework statute governing the model, it can enumerate, as a starting point, usual indicia like name, image, identity as actionable persona. These enumerated indicia are capable of being widely interpreted by the Court, in that, *name* can be expansively interpreted to include pseudonyms, stages names, call-signs; *image* as photographs, portraits, drawings, caricature; *identity* as special character traits, unique aspects of identity in distinctive styling, mannerisms, gestures, etc. The governing statute could also provide a broad and open-ended definition for actionable persona, which would be specifically interpreted by the Court and a non-exhaustive list of actionable indicia will be incrementally developed by the court at common-law to complement the framework statute. Collectively, these will ensure that the court maintains its ability to recognise new indicia of persona and accordingly bring the same within the ambit of the right.

5.2.3(c) Test, Liability and Defence under the Hybrid Model:

The test and liability model under the hybrid approach would be the same as proposed for both the statutory and common law model. For liability to accrue under the model, the plaintiff celebrity will have to prove that his persona has been appropriated without consent for the commercial use and that, he is identifiable from such use. The governing statute could stipulate that the liability is based on pure appropriation and that no proof of public confusion or misrepresentation will be required. The statute could also dictate that an objective test of identifiability/recognisability will be applicable to determine liability. However, what would constitute as a commercial use for the purpose of liability could be left to the court for further interpretation. The framework statute could provide a starting point by generally defining any use that entails commercial gains as actionable. The court would then be able to give specific and purposive interpretation of the broad definition provided and incrementally, devise a list of uses which are prohibited. The governing statute could, however, for clarity, expressly state that non-commercial uses could exceptionally be actionable, if it is found to injure the dignitarian aspect of the celebrity's persona.

Furthermore, the framework statute could also expressly mandate the courts to consider the Article 10 rights and other public interest when interpreting the qualifying factors of the right under the hybrid model. This would just formalise the exercise that the court are required to do anyways when determining the application of the proposed right. The statute could also broadly enumerate likely uses that serve legitimate public

interest and the freedom of expression of the exploiter but leave the interpretation of what use would fall under such freedom of expression or serve public interest to the courts. The court will then incrementally develop a list of defences through specific and purposive interpretation of these broad competing interests enumerated in the framework statute. The potential exceptions would be discussed below, generally, for all the proposed models.

5.2.3(d) Duration, Transferability & Post Mortem Protection under the Hybrid Model:

Under the hybrid model, the governing statute would enumerate the scope of transferability, duration and post-mortem rights, exactly as in the statutory model proposed above. For clarity, the framework legislation may allow transfer/assignment of the right but allow room for judicial interpretation on what constitutes as permitted transfer/assignment, allowing the law to adapt to the ever-changing nature of commercial practice of celebrity persona. In terms of duration, both pre and post mortem, the statute would stipulate the exact period, as otherwise, there could be lacunae created waiting to be resolved by the Court, which is obviously undesirable. The legislation would also dictate how the right will be inherited/descended and enumerate an exhaustive list of the beneficiaries. At common law, the judiciary will have the option of determining the validity of inheritance or eligibility as beneficiaries, in line the relevant English laws on intestacy and probate (if a will is left behind).

5.2.3(e) Other potential permutation of the Hybrid Model:

Alternatively (and rather ambitiously), the hybrid model can formally recognise the two parallel but intricately intertwined aspects of persona, i.e., the economic and dignitarian interests by merging the latter, which are often grounded on common law notions of privacy, and the former by legislating a right of publicity, like the US. This approach closely replicates the French and German version of the personality rights. In France, similar rights were initially based on privacy to protect the dignitary interest, and it continues to be so, but has evolved to cover the commercial interests as well¹⁰⁷⁰. In Germany, the general right of personality has been extended to recognise the economic values in addition to the non-economic values.¹⁰⁷¹ In this variant of the hybrid model, legislating a publicity right to safeguard economic interests of persona will align UK with the US, Canadian and Italian models, giving it a property right footing in the context of intellectual property. Acknowledgement and the subsequently merger of the common law privacy rooted dignitarian interests with statutory publicity right will align the UK with the European models of privacy and personality. The celebrities under this variant, would be accorded a protectable economic asset in their persona and also a personal right in their dignity. The merger of these values would provide for the enforceability of both by the Courts, in that, the economic value will be enforceable

¹⁰⁷⁰ *Pascuito v Kantor* (n 913).

¹⁰⁷¹ *Marlene Dietrich* (n 823).

as a property, with potentials of transferability and descendibility upon death; the non-economic value, as an inalienable right which could not be transferred during lifetime and would extinguish on death. As these parallel values are separately recognised, autonomy of the celebrity is not traded away – he can transfer the property rights but will hold on to the personal rights, with which he can continue to regulate/control how the persona is used even after the assignment.

As to the scope of this variant, the legislative vessel for right of publicity will clearly stipulate a non-exhaustive list of actionable indicia of persona and enumerate actionable commercial (mis)uses. In terms of the liability model, the statute would provide for a cause of action in commercial appropriation, with an objective test of identifiability to exact liability for economic losses suffered from the unauthorised use. A separate cause of action could be introduced at common law to safeguard dignitary interests, or use an existing privacy based common law tort to do the same. The framework legislation could also provision for likely exceptions to the right and/or necessitate the balancing exercise with competing public interests and freedom of expression.

5.2.4: Possible Defences/Exceptions to the Right/Tort

One of the main reasons why the English Judiciary did not embrace a right of personality or a tort of appropriation to safeguard such rights in the covert personality cases of *Irvine*, *Douglas* and *Fenty*, is that the Judiciary was against introducing a monopolistic right in one's persona. Any monopolistic right could have the unwarranted effect of rendering celebrity persona excessively inaccessible, ultimately diminishing the very value that the right was intended to protect. As celebrity persona is capable of carrying social and cultural meanings, dictate the artistic and literary works and even allow a vent for release of social tension through humour filled commentaries, there are sufficient public and social interest underpinning such uses. These uses are often the outward manifestation of one's freedom of expression and speech. Any monopolistic right could have the effect of shunning these interests, and trump free and creative expression. As such, any proposed model for a personality right must have an inbuilt check and balance system that would cater for these competing interests but, of course, not at the expense of the very right that the proposed models are upholding. What follows are a number of likely uses of persona that operate as defences/exceptions to the personality rights in order to balance it with the competing interest. These possible defences/exceptions have been extracted from the analysis of personality rights regime in effect in the jurisdictions discussed in Chapter 4. The exceptions, as follows, are intended to suit all three models proposed above.

5.2.4(a): Article 10 Right of freedom of Expression:

Use of persona for the purpose of receiving and/or imparting information may form an object of protection under the exploiter's right of freedom of expression pursuant to

Article 10 of ECHR. Preservation of such rights are prominently used to justify the premise for rejecting a right of personality in the UK.¹⁰⁷² Analysis of how such rights are usually found in crossroads with personality rights and how it posits the biggest impediment towards the recognition of such rights has been done at length in Chapter 3. The same will not be repeated here. It must be noted that Article 10 would undoubtedly craft exceptions/defences and hence, restrict the application of personality rights, once it has been incorporated, regardless its model or framework. All the other potential defences/exceptions to personality rights to be discussed below, will one way or the other have overlaps with the Article 10 rights and the underlying public interests. Article 10 rights, however, are not absolute and as required under Article 10(2), these rights need to be balanced with other competing rights like the one here, i.e., personality rights. If the UK adopts the proposed statutory model, the legislation must, for clarity and coherence, not only codify the balancing exercise but also enumerate factors that may be taken in account by the courts when balancing these rights. If a common-law tort model is accepted, the Court will be required, although incrementally and by judicial reasoning, to device a functioning balancing mechanism or test. The UK courts can definitely follow the established English precedents in *Irvine* and *Campbell* in achieving such a balancing test/mechanism and could incorporate the notions of public interest in such mechanism to strike a fair balance. Nevertheless, in the hybrid model, UK can either chose to have the governing legislation to dictate how the balancing exercise would be done or leave with it to the interpretive discretion of the judiciary. Regardless of the model chosen, as all three proposed models are prescribed to protect both the economic and non-economic values of celebrity persona. Any unauthorised use of persona, that is purely commercial in nature or if not commercial but such that it injures the dignity of the persona, may logically tip the balance in the favour of the aggrieved celebrity.

5.2.4(b): *News-reporting, informational publication & political speech:*

Use of celebrity persona for the purpose of news reporting, journalism, political speech or commentary may be exempted from liability provided such uses serve legitimate public interest¹⁰⁷³ and does not entail any commercial gain or is an advertisement in disguise. The assessment of what qualifies as a matter of public interest will, however, depend on an objective test¹⁰⁷⁴ and the UK IPSO Code (see Chapter 2) could provide a helpful insight to what may ensue as public interest for the purposes of this defence. Invariably, all the jurisdictions discussed, which have introduced personality rights or similar protections have recognised such uses as an exception to the right. This exception can be also extended to include purely informational uses or publication as allowed in Germany¹⁰⁷⁵. Likewise, publications involving use of celebrity persona, which serves historical, scientific or cultural interest could be also exempted following

¹⁰⁷² Walsh (n 102); See generally, Pinckaers (n 2).

¹⁰⁷³ *Hoffman* (n 696).

¹⁰⁷⁴ *Mosley v News Group Newspapers Ltd* [2008] EWHC 1777 [138].

¹⁰⁷⁵ See *Becker* (n 839).

the Spanish variant of the right.¹⁰⁷⁶ This exception, as such, would aim to safeguard and balance the freedom of press and right to information of legitimate public interest.¹⁰⁷⁷ However, any such balancing would be strictly subject to protection of dignitary values embedded in celebrity persona. Therefore, if such uses are proved to be non-commercial and purely informational serving public interest but not injuring the dignity or goodwill of celebrity persona, the balance will tip in the favour of the exploiter and not of the celebrity. On the other hand, if the use is commercial in disguise or non-commercial but is adverse to the dignity, then the exception will not apply, and the use will be actionable.

5.2.4(c): Artistic, Creative & Entertainment Works:

Use of celebrity persona in artistic or literary works like biographies, paintings, novels, depiction on tribute memorabilia, etc may be exempted from liability if such uses are purely artistic in nature and not commercial advertisement in disguise.¹⁰⁷⁸ Both the German and French versions of the right explicitly recognises artistic work as exceptions to the personality rights.¹⁰⁷⁹ Following the US First Amendment, this exception could also cover use for purely entertainment purpose as long as it is not a commercial speech masquerading as entertainment.¹⁰⁸⁰ Further following the First Amendment, and France and Spain, creative works such as parody, satire, caricature or even commentary on celebrity lives may also qualify as an exception to the right.¹⁰⁸¹ Parody is often viewed as a method of social venting and/or creative criticisms or public discussions. It may, therefore, engross sufficient social and public interest. Black employs a South African case of *Laugh It off v SAB*¹⁰⁸² to articulate that if it is a genuine parody of celebrity persona and is a 'take-off, not a rip-off', then the social/public interest in the parody work can outweigh the personality rights, when balanced. However, parodical or satirical use will not qualify as an exception if it is aimed at making commercial gains/increasing sales, implicitly. Moreover, any literary description or literary portrait that describes the celebrity or communicates his image in words may also qualify as an exception.¹⁰⁸³ US courts have been witnessed to often apply the test of *transformative use* to determine whether the use qualifies as an artistic, literary or entertaining work.¹⁰⁸⁴ If such a defence is recognised by the UK then the same test could be adopted in determining these exceptions. Most significantly, such artistic, literary or entertainment works are also considered to serve wider public interest in communicating cultural meaning.¹⁰⁸⁵ Such public interest in creative

¹⁰⁷⁶ See, Article 8 of the Organic Law; See also, *Zarzuela Case* (n 982).

¹⁰⁷⁷ *Beckenbauer* (n 836).

¹⁰⁷⁸ *Gould* (n 751).

¹⁰⁷⁹ See, *Brandt* (n 844); *Kaymer* (n 845); TGI Paris (ref.) 17.9.1984, D.1985.

¹⁰⁸⁰ *Rogers* (n 670).

¹⁰⁸¹ See also, J. Brown, 'Defending the Right of Publicity: A Natural Rights Perspective', (2005) 10 Intell. Prop. L. Bull. 131; *Diego* (n 963).

¹⁰⁸² 2006 (1) SA 144 [109]; *Black* (n 47) 180.

¹⁰⁸³ See also, *Diego* (n 963).

¹⁰⁸⁴ *Comedy III* (n 687)

¹⁰⁸⁵ See, *Grandpre* (n 415); *Madow* (n 59); *Coombe* (n 418).

expression appears to be one of the most prominent interests (in addition to Article 10 rights) that are employed to counter the justifications in favour of recognising a right of personality. The same can also apply here to justify these uses as an exception to the right if it is introduced. The analysis of public interest in creative expressions and cultural communication has been conducted already in Chapter 3, as interests against personality rights, and need not be reiterated here to avoid repetition.

5.2.4(d): Incidental or De Minimis Use:

Use of celebrity persona, which is incidental to another purpose, or appears incidentally in a publication or in another image (but not as a centrepiece, subject matter or in the main content) may be exempted from liability. The use needs to be strictly incidental and cannot imply endorsement, as otherwise, the exception will fail.¹⁰⁸⁶ Depiction of celebrity in photographs of public events, where he is not the focal point but an incidental or inadvertent part of it, in a movie scene where the celebrity has accidentally become a part of crowd being filmed, or use of celebrity name as a reference in a larger expressive work, are likely to fall within this exception, if given a broad interpretation. This exception may also cover use of persona for charitable purposes as in those instances, the use may be justified as incidental to the underlying purpose and not as a form of endorsement (as seen in *Horton*). In addition, trivial and de minimis uses of persona may also qualify as an exception to the right.¹⁰⁸⁷ Such uses are highly likely to fall short of the identifiability test as proposed with the models above and therefore, fall out of the right, in any event.

5.2.4(e): Use of Photographs taken in Public Places:

Use of photographs of celebrities taken in public places may be exempted from liability as long as the photograph does not solely focus on or single out the celebrity depicted and the photograph is of the celebrity engaged in public and not private activities.¹⁰⁸⁸ This exception has been allowed by the French courts under the French version of the right, with emphasis being drawn on the necessity of the photograph being taken in a public place for the defence to trigger. If UK was to recognise such an exception mirroring France, it could adopt the working definition of public place as applied by French courts and as discussed in Chapter 4.¹⁰⁸⁹ Such an exception, however, is unlikely to stand if the photograph taken in a public place is used for commercial purposes.¹⁰⁹⁰ This exception may also get displaced if the photograph is used to ridicule the person depicted or disparaging captions has been used in conjunction with the photograph.¹⁰⁹¹

¹⁰⁸⁶ *Krouse* (n 732) *Horton* (n 742).

¹⁰⁸⁷ *Joseph* (n 747).

¹⁰⁸⁸ Paris, Feb. 27, 1981, Gaz. Pal. 1981.; See also Beverley-smith (n 290) 173.

¹⁰⁸⁹ See also Logeais (n 866) 526.

¹⁰⁹⁰ T.G.I. Nancy, June 8, 1973, D. 1974, 126.

¹⁰⁹¹ CA Paris, 1^{re} ch. A, Sept. 27, 1988, Gaz. Pal. 1989.

5.2.4(f): *Consent*:

Logically, as the liability model across all the proposed versions of the right is based on appropriation, i.e., unauthorised/unconsented use of persona, any proof of 'consent' or authorised use would function as a complete defence. If the UK adopts the statutory model, the legislation must enumerate the requirement of express prior consent, in *writing* (ideally), for any use to be deemed permissible under the statutory right. Consent could be implied in certain circumstances, e.g., where the celebrity impliedly consents to the use of his image for the movies where he is casted to play a role/character. If the common-law tort model is adopted, existence of consent would be a matter of evidence, and the court would be required to devise a workable definition of what constitutes valid consent and how to determine its scope. In the hybrid model, which is flexible having both statutory and common law dimensions, either one of these two techniques could be followed in adopting a defence in consent.

5.2.5: Common Remedies under the Proposed Models

5.2.5(a) *Injunctions*:

Under the proposed model, injunctive relief would be available to the celebrities as a remedy against the unauthorised appropriation of their persona by third parties. Same relief should be also available to such other persons/entities who have been assigned or licenced the exclusive right to exploit the persona by the celebrity (like in *Haelen* and *Douglas*). Beverley-Smith contextualised the availability of such reliefs, by stressing that any 'encroachment' to personality rights justifies a remedial action to prevent it pre-emptively or stop it from continuing.¹⁰⁹² He added that such a remedy should not be contingent on the materialisation of the unauthorised use, proof of actual harm/damage or causation; the mere fact that celebrity persona has been appropriated without consent and the impugned use does not qualify for any of the proposed exceptions/defences, should suffice for the evocation of this remedy.¹⁰⁹³ Observing cases, e.g., *Douglas*, *Oliver Kahn*, *Jaqueline Onassis*, etc., preventing/stopping the misappropriation seems to be the first priority/primary objective of the aggrieved celebrities, and thus, further underscoring the relevance and suitability of this remedy in personality cases.

Injunctive reliefs are 'equitable remedies' in nature in the English legal system and is subject to the Court's discretion. Celebrities shall have the option to apply for an injunction, which can be prohibitory, i.e., to prevent an anticipatory or imminent unauthorised exploitation (as in *Douglas*) or mandatory, i.e., to require the abuser/exploiter to cease the use or withdraw the publication, merchandise or commercials where the persona has been misused (as in *The Turtles*). Such

¹⁰⁹² Beverley-Smith (n 290) 181.

¹⁰⁹³ Ibid.

injunctions can be sought on an interim basis¹⁰⁹⁴ (which are common in these type of cases) which shall be effective until the substantive claim is determined by the Court, following which, a final injunction order may be awarded by the Court, as it did in *Fenty*.

To be awarded this remedy on an interim basis, the burden of proof is on the aggrieved celebrity to show that granting of an injunction would be '*just and proportionate*'¹⁰⁹⁵ and satisfy the test enshrined in *American Cyanamid Co v Ethicon Ltd*.¹⁰⁹⁶ In that, among various factors, prominently the celebrity will have to show that there is a serious question to be tried¹⁰⁹⁷; this should suffice owing to the alleged breach of personality rights or the misappropriation tort introduced under the proposed models. The celebrity will then be required to demonstrate that the harm/damage sustained or to be sustained cannot be adequately compensated by damages alone. As the proposed models safeguard dignity, autonomy and reputation which are embedded in celebrity persona and are extremely *personal* to him, any harm done to such non-economic values cannot, invariably, be compensated adequately in damages.¹⁰⁹⁸ This may allude to the fact that if the harm is caused purely to the economic value and not to the non-economic ones, the Court may find damages to be an adequate remedy and deny interim injunction. However, this is speculative, as loss of *control* over persona is being remedied here, and *control* is said to be the 'linchpin' of both the economic and non-economic interests of persona.¹⁰⁹⁹ So loss of control would entail injury to both the interests and ultimately, damages may not be an adequate remedy in such circumstances. In addition, the celebrity will be further required to provide cross undertaking in damages, so that the exploiter/abuser can be compensated if the interim injunction subsequently transpires to be wrongly granted. Such may be the case if the exploiter manages to justify the use as one that serves legitimate public interest, or his freedom of expression is found to prevail over the relevant celebrity's personality right. Most significantly, the court may also require the celebrity to satisfy the balance of convenience test, in that, the court would ascertain whether there would be irreparable prejudice in granting or refusing the remedy and to what extent.¹¹⁰⁰ As irreparable prejudice is the focal point here, it seems logical that presence of any harm to non-economic values is highly likely to tip the balance in favour of the celebrity if the impugned use is such that it will malign the celebrity's dignity/public perception significantly. Irreparable prejudice can also take place even if the dignitarian side of the persona is unharmed, if, for example, the impugned use is found to be diluting the exclusivity of the persona and/or crowding out high artistic opportunities, as seen in *Waits*. Nevertheless, the balance of convenience exercise can be challenging, particularly when the impugned use is allegedly serving legitimate public interest (e.g., news reporting) or the user's Article 10 ECHR rights. In such cases, the harm that

¹⁰⁹⁴ *Haelen* (n 408).

¹⁰⁹⁵ Senior Courts Act 1981, s.37(1); See also, *South Bucks DC v Porter* [2003] 2 AC 558.

¹⁰⁹⁶ [1975] AC 396.

¹⁰⁹⁷ *Mothercare Ltd v Robson Books Ltd* [1979] FSR 466

¹⁰⁹⁸ Black (n 47) 182.

¹⁰⁹⁹ *Ibid* 92.

¹¹⁰⁰ *National Commercial Bank Jamaica Ltd v Olint Corporation Ltd* [2009] UKPC 16.

would be caused to the public interest by delaying the news-reporting through injunction, cannot be undone or be reparable even if a cross undertaking is in place.¹¹⁰¹

5.2.5(b) Damages:

Any award of compensatory damages is justified on the basis that such damages compensate the celebrity by putting him back in the position where he would have been in if his persona was not appropriated without consent. This rationale forms the basis of the compensatory awards made against the breach of English intellectual property rights¹¹⁰² and the same can be conveniently adopted by the models proposed above in provisioning for similar damages to recompense breach of personality rights. Most importantly, availing financial compensatory damages adequately addresses any harm done to the economic value of celebrity persona from the unauthorised use.

The most common measure of compensatory awards in personality cases are loss of license fees, i.e., what the exploiter would have paid the celebrity for using the persona or simply, the amount that the celebrity could have made in licensing the use himself. Such awards are based on restitutionary principles and could be calculated applying the '*fair market value*' as commonly done by the US courts, in the absence of a demonstrable market value of the persona by the aggrieved celebrity.¹¹⁰³ Support for the payment of damages in lost license fee could be drawn the established precedent of *Irvine*, where (although under passing-off) Irvine was awarded such damages and the Court gracefully defined it as '*fee which would have been arrived at as between a willing endorser and a willing endorsee*'¹¹⁰⁴. Although the quantification of license fees in *Irvine*, quite oddly, fails to be even one-tenth of similar awards made in cases like *White*, *Waits* or *Midler*, under the proposed models, the UK courts will be required to quantify license fee in a way that truly reflects the harm done to the economic values embedded in the persona. Any award must commensurate the reasonable '*going rate*' of persona licensing by taking into account the concerned celebrity's existing license fees. In absence of such references, fair market value in comparison with other celebrities in the same popularity level and field of expertise can be used for quantification purposes.

Further compensatory award in the form of 'additional damages' could be allowed under the proposed models, as are also allowed under section 97(2) of CDPA. Provisions for such additional damages have been enacted in order to penalise flagrant breaches of the right and so that the compensation can be made '*as the justice of the case may require*'¹¹⁰⁵. Such damages may be suitable in cases where the

¹¹⁰¹ *Douglas* (n 333); See also, *Weber* (n 527) 202.

¹¹⁰² W Cornish and D Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 5th edn (London, Sweet & Maxwell, 2003)

¹¹⁰³ See, *Cher* (n 36).

¹¹⁰⁴ *Irvine v Talksport Ltd* [2003] 2 All ER 881 [70]; See also, *General Tire and Rubber Company v Firestone Tyre and Rubber Company Ltd* [1975] FSR 273.

¹¹⁰⁵ See, Hector MacQueen, *Contemporary Intellectual Property* (Oxford University Press, 2007; See also, *Black* (n 47) 190.

exploiter has used the celebrity persona in an egregious manner like an endorsement which implies that the celebrity approves a harmful or extremely controversial product. Similarly, additional damages will be suitable in cases where the unauthorised use has the apparent effect of diluting the exclusivity of persona and also where low-value and repetitive unauthorised uses crowds out high value artistic opportunities, as acknowledged in *Waits* and *Woody Allen*.

Moreover, compensatory award in the form of ‘*solatium*’ could be also awarded to address any injury caused to the dignitarian side of celebrity persona. The quantification of solatium would depend on the judge’s assessment of seriousness of the mental distress or reputational harm suffered from the impugned use.¹¹⁰⁶ UK could also adopt for such solatium under the models proposed above and in doing so, could provision for financial compensation for both economic and non-economic losses. It must be, however, noted that the levels of solatium may not be as substantial as other financial awards made in the form of lost license fee or market use. It may constitute the only form of financial compensation, if the Court is satisfied that the concerned celebrity would never have involved himself in persona licensing, making the assessment of a hypothetical license fee based on market standard, impossible.¹¹⁰⁷

Further additionally, damages can be awarded to vindicate the personality rights breached. The English courts already harbour the view, that the purpose of the law is to enable rights to be vindicated and provide remedies when such rights are breached.¹¹⁰⁸ As such, the fact that a right has been breached, should be sufficient in itself to justify compensation. Precedent of making such awards, although in privacy matters, can be seen in *Mosley*, which can be followed by the UK courts, if they intend to award such damages in addition to the compensatory ones, under the proposed models of the right.

5.2.5(c) Account of Profits:

The proposed models could also provide for the equitable remedy of accounting for profit on the part of the exploiter to prevent unjust enrichment. Such remedies are well recognised under the English intellectual property law regime. This remedy mandates that the exploiter/infringer disgorges any commercial gains made from the unauthorised use of celebrity persona. In Cornish and Llewelyn’s word, such remedies are ‘*not a notional computation as with damages, but an investigation of actual accounts*’¹¹⁰⁹; in that, it is not the lawful cost of using the persona, which is awarded as lost license fees, rather it is the profit which has been made from the use, and which the infringer will be stripped of in order to remedy the infringement. As making profits from unauthorised use of persona is often the case, availability of accounting of profit

¹¹⁰⁶ See, Black (n 47), 185; *M’Callum v Paterson* (1968) SC 280, 284.

¹¹⁰⁷ BGHZ 35, 363 – *Ginsengwurzel*. See also, Beverley-Smith (n 290) 143.

¹¹⁰⁸ *Chester v Afshar* [2005] 1 AC 134 [87]; See also Black (n, 47) 185.

¹¹⁰⁹ Cornish and Llewelyn (n 1102) para 2–43.

as a remedy in the context of personality rights is well justified.¹¹¹⁰ Moreover, this remedy will be particularly relevant in cases of unauthorised merchandising, where (mis)use of persona has a direct bearing on the levels of sale of the merchandise. To adopt/incorporate this remedy, UK can, not only draw support from the existing intellectual property right framework, but also from *Douglas*¹¹¹¹, where the court has endorsed the relevance and suitability of the remedy in the personality cases.

5.2.5(d) Apology or Corrective Advertising:

Under the proposed models, this remedy can be allowed strictly to address the dignitarian and reputational harm to a celebrity persona. This remedy would require apologies to be issued by the infringer if egregious or disparaging use of persona is established. Furthermore, retractions could be ordered under this right, to remove celebrity persona from publications, which may or may not be commercial in nature, but is injurious to its dignitarian values. As such, given the nature of the remedial action under this remedy, it is apparent that, it is designed to restore the dignity and reputation of celebrity personality. Illustratively, if an infringer has falsely implied the association of endorsement of product/service through the (mis)use of celebrity persona, the infringer can be made to issue corrective statements/advertising to clarify the unauthorised use, possibly redact all the likely references to the celebrity persona and also issue a public apology. These remedies are synonymous to remedies like 'offer to make amends' available under the English defamation laws, and necessary support can be drawn from such regimes, by UK, to rationalise the legal basis of this remedy, if it is adopted under the proposed models.

5.2.5(e) Erasure, return or Destruction:

Through this remedy/relief, any merchandise or publications bearing celebrity persona could be ordered to be seized, withdrawn from the public domain, returned to the celebrity, or even destroyed – all that at the expense of the infringer. These remedies are analogous with the remedies available under English trademark laws.¹¹¹²

5.2.6: Is 'Registration' required under the proposed models for liability?

The requirement of registration can be seen as a condition precedent to liability in the English intellectual property rights regime underlying trademarks and patents. The registration system has been deemed to have revolutionised the modern IP platforms and has several advantages of its own. Reading from the system that is already in force, registration brings clarity and certainty over the identity of the person holding the right. It marks priority over the right, as it shows which party acquired the right at

¹¹¹⁰ Black (n 47) 190.

¹¹¹¹ *Douglas v Hello!* [2006] QB 125 [249].

¹¹¹² See, Trade Mark Act 1994, sections 14, 15, 16 and 19.

first. Most importantly, the registration creates a legal right over an intangible and abstract object/asset. A registration system, thus, lead to the creation of a register, maintained by the Intellectual Property Office (IPO) and is publicly accessible, with clear details of the object being protected, owner's details and may also include the details of current licensees. It can be, therefore, tempting to include a registration formality with the proposed models, but its actual suitability and practicality needs to be tested first.

In the context of personality rights, the deemed benefits of registration may not be fully applicable. Provided the nature of object of protection under this proposed right, i.e., celebrity persona, there will be hardly any confusion as to the identity of the holder of the right and there will hardly be any need to establish priority. Anyone who knows/follows a celebrity would invariably know about the celebrity's indicia and from where to get consent/permission to use it. Scholars of personality rights strongly (and accurately) argues that the personality rights are inherent rights of identity which comes into existence with the birth of the celebrity.¹¹¹³ As such, it will be counter intuitive to set registration as a precondition to enjoy a right which is already inherent to the celebrities from birth.¹¹¹⁴

Most importantly, a registration requirement for liability may not serve the essence of this thesis, which advocates for a personality right that the current English Legal system fails to provide to its celebrities. In that, the registration system would only accord protection to those celebrities who have registered their persona; it will not protect those who did not register. Now, a lot of celebrities, who does not actively (or at all) engage in persona exploitation, may not deem registration necessary but their persona would continue to hold the economic and non-economic values which this proposed right is designed to protect. If protection under the models is dependent on registration, celebrities such as these may fall out of protection and may have to resort to the other rights of action, which have been already proved to be insufficient and inadequate. As such, a registration system can potentially deter the very benefit and rationale for the creating this right. Resultantly, this thesis, therefore, stands against a requirement of registration under any of the models proposed. The thesis will further draw support for this from the absence of such a requirement in other established personality rights regimes (as discussed in Chapter 4). If it was indeed necessary and practical, these jurisdictions which has full-heartedly embraced personality rights, that too several decades ago, would have definitely incorporated it in their liability model. Furthermore, the English copyrights regime also demonstrates that effective protection to such intangible rights can be ensured without needing any prior registration. As Black beautifully articulated, “...as copyright comes into existence with the expression or fixation of the idea, publicity [personality] rights should come into existence with the individual;” so, a need for registration in personality right frameworks is indeed unnecessary and remotely optional.

¹¹¹³ T McCarthy (n 43) 688; Neethling (n 510) 534; Logeais (n 866) 168.

¹¹¹⁴ Black (n 47) 158.

However, for the sake of argument, if a registration requirement is adopted by the UK, it can draw inspiration from a functioning and pioneering registration model that is in force in the Guernsey¹¹¹⁵. As proposing a registration mechanism is not supported in this thesis, the Guernsey version of personality rights introduced under the Image Rights (Bailiwick of Guernsey) Ordinance, 2012 (as amended by Image Rights (Bailiwick of Guernsey) (Amendment) Ordinance, 2017) has not been discussed in this thesis. Nevertheless, following the Guernsey model, UK could adopt a similar registration mechanism and construct a Personality Rights Register, to be maintained, regulated and updated by the UK IPO. Most importantly, the statutory and hybrid models proposed would be able to include such a registration regime. The legislation would enumerate the requirements and the eligibility criteria for registration, providing a non-exhaustive list of indicia which can be registered, stipulate the fee for registration, duration and rules for subsequent renewals (if a time limited registration is adopted, which is not preferred). The common-law tort model may find it at odds with such a registration regime, since such to be effective and comprehensive, a codified set of rules will be required.

5.2.7: Who would ultimately qualify under the *Right*? – the Great Debate!

This thesis has been upfront about its concentration on protecting celebrity/famous people's persona. The reason why such individuals require protection more than anyone else has been convincingly justified in the preceding chapters. This thesis prominently voices for a personality right in the UK that is dedicated and tailor-made to the needs of the celebrities and well-known individuals but contrasting arguments for a right that applies to both celebrities and non-celebrities cannot be overlooked.

Looking at the nucleus of the right, i.e., protection of both economic and non-economic values embedded in persona – it can well be argued that the right should apply to non-celebrities as well; in that, they might not have marketable value in their persona that needs protection, but they would still have dignitarian values in their persona that would. Scholars of personality rights have advocated for a universal right applying this same premise. McCarthy said, *“Does the right of publicity [personality] cover only celebrities? The answer is clearly no...while the commercial value of a celebrity's identity is understandably greater than that of a non-celebrity, this does not mean that only celebrities have a right of publicity [personality].”*¹¹¹⁶ Nimmer added, *“...it is impractical to attempt to draw a line as to which persons have achieved the status of celebrity and which have not; it should rather be held that every person has the property right of publicity [personality]”* Both Vaver and Logeais commented that the protection under the right should not depend on the fame status. In practice, the civilian jurisdictions like Germany, France, Norway, Sweden, Netherlands which have either incorporated such rights or introduced something akin to it like ‘image/portrait’ rights,

¹¹¹⁵ See, Sam Shires, ‘Guernsey image rights exposed’ (AO Hall 2015).

<www.lexology.com/library/detail.aspx?g=9829178f-e93d-4ead-94d0-bfbfaa81f8b7> accessed 20 March 2025.

¹¹¹⁶ See, McCarthy (n 43) 688.

have accorded protection to the both famous and not-famous sections of the society. Interestingly, the US and Canadian model could be interpreted (on the basis of their inclination towards safeguarding commercial interests of persona) to state that it was designed keeping famous individuals in mind but has been given universal application regardless. By contrast, the Italian model only accords protection to well-known individuals showcasing that even without universal application the right can still be effective and justified.¹¹¹⁷

This thesis accepts these arguments but will not advocate for a universal right. One of the prominent reasons is the possibility of trivial and frivolous claims flooding the court if non-celebrity persona is attached with the right. Inclusion of non-celebrity persona could prove to be pointless, since many unauthorised uses that only injures the element of 'control' (and therefore, dignity and autonomy) may stand immune when balanced with public interest and/or Article 10 rights of the exploiter; the only time the balance will tip in favour of non-celebrities if the impugned use was egregious, disparaging or derogatory. In such cases, non-celebrities could suitably avail protection under defamation or privacy, and a separate right of action in personality may not be needed after all. So long any personality rights adopted in the UK accords protection to celebrity persona, it will serve the essence of this thesis and will be in parity with everything that has been advocated so far. It will not concern itself with who else has been afforded the same protection. The proponents of personality rights, who advocates for the protection of both celebrities and non-celebrities, will be deemed to be in line and supporting the notion of this thesis as well. Nevertheless, if UK choses to adopt such rights to address the celebrities only, the liability models in the proposed variants should include a requirement of proof of fame/marketable persona, based on a both objective and subjective test. A threshold of fame will have a direct implication on the quantification and/or level of damages to be recovered by the celebrity once liability is established.

5.2.8: Are there any other likely models of the *Right*?

Based on the analysis of the jurisdictions in Chapter 4, another model/option for the UK would be to recognise separate and individual rights in celebrity names, image and/or likeness instead of a general, sui generis right of personality. This approach has been mostly adopted in the civil law jurisdictions in Europe like France, Spain, Norway, Sweden and Netherlands. These jurisdictions have recognised the most common/usual forms of indicia i.e., name and image, and the respective courts have been witnessed to provide a broad interpretation of this common indicia to include other indicia of celebrity persona. France recognised 'right of image' but through robust development it now covertly functions just as a general right of personality would. Spain, on the other hand, has given such an expansive application of its right of image, that its scope can easily parallel the scope of the US right of publicity. Despite such

¹¹¹⁷ See, Martuccelli (n 935) 558.

potential, this model is not preferred by this thesis and hence not proposed. Having a specific right on one indicium of persona ultimately constricts the application of the right to that particular indicium, as evident in Sweden and Netherlands. In Sweden¹¹¹⁸, the protected indicia of *name* have been given a broad interpretation to include surnames, nicknames but even with the widest of interpretation other important indicia like voice, character, signs, etc could not be brought within the right. This is a significant deficit and does not concur with the spirit of this thesis. Moreover, it is also not practically possible to recognise all the actionable indicia of persona by making separate specific rights. Marketable indicia are an ever-evolving element and not necessarily fixed, so countless number of rights will have to be introduced to afford comprehensive protection. So, proposing a model that would require multiple other models to function properly seems illogical and unwarranted. Moreover, these civil law jurisdictions have based such separate rights borrowing authority mostly from their Civil Code or their respective Constitution. Doing so, would not be possible for the UK as it lacks both a civil code and a codified constitution. If UK seeks to adopt a statute, it would be more convenient to recognise a general right of personality with sufficient qualifications and criteria to achieve comprehensive protection (as proposed above) then to enact separate rights on individual indicium. Doing so might be possible in the absence of a statute, under the common-law model proposed above, but obviously at the expense of coherence and uniformity in application with a bundle of separate personality rights being recognised. Instead, adopting a general and all-encompassing right of personality will be suitable and would bring forth the much-needed coherence and uniformity in application.

5.3: Conclusion

This Chapter was aimed at pitching proposals of likely models for introducing/incorporating personality rights in the UK. Multiple proposals have been advanced – all being formulated by filtering out the best practices, characteristics and features of other established personality rights regime, analysed in Chapter 4. In proposing these models, caution has been exercised in not covertly proposing to replicate one of those analysed jurisdictions and their version of the right. Proposing to replicate would have been a convenient and hence tempting way of making recommendations, when the models, possible to be replicated are fully functional and effective; but doing so was not in line with the aims of this thesis. The aim was to analyse other established examples and take the best out of them and arrange it in a way so that best possible options could be recommended for the UK. This Chapter has made a full-hearted attempt to simply achieve that aim.

The models proposed, each has its own merits. The statutory model offers a coherent, fully defined and predictable regime. With a statute explicitly enumerating what is covered, what is prohibited, what is exempted and lastly, what would be the remedy,

¹¹¹⁸ See cases, *Anja Pärson* (n 1015); *Patrik Sjöberg* (n 1015).

a clear set of rules could be achievable under this model which reinforces clarity and consistency in practice. But consistency and coherence are often achieved at the expense of rigidity and inflexibility – which could surface if the legislative framework proposed fails to adapt and react to the ever-changing nature of personality appropriation. The common-law tort model could offer this flexibility but that would be at the expense of consistency and coherence, as much of the development of the law would depend on judicial innovation and creativity, which can be slow and unpredictable. Furthermore, the incremental approach under this model will allow the legal regime to be highly adaptive to the changing nature of the practice, keeping it relevant and applicable to novel situations. The hybrid model on the other hand, attempts to propose the best of both statutory and common-law dimensions. It could offer flexibility and consistency at the same time. The hybrid model could be set up in various forms, this thesis has given two examples – implying the overall creative potentials of the hybrid model as long as the core ideology of protecting both economic and non-economic values of persona are served. All models proposed carefully instils a mechanism for balancing competing public interests and Article 10 rights by creating the scope of several likely exceptions/defences to the right. Tailor-made remedies are also proposed to align with the underlying rationales/justifications of the right.

Collectively, a well-planned and crafted right of personality in the UK - be it done by the legislatures or judges or both, could comprehensively fill in the lacunae in English law created in the absence of such a right, and due to the inadequacy and ineffectiveness of the existing legal doctrines. Such rights would ensure that celebrities have an exclusive control over the use of their persona and get compensated fairly when used – which is currently non-existent and/or not guaranteed in the UK. The global jurisprudence clearly indicates that protection of celebrity persona is not just a matter of economic prominence but also of individual dignity, autonomy and goodwill. It also suggests that UK has been lagging far behind in acknowledging so, which has been done by some of the countries over half a century ago. By adopting the right through the models proposed here or otherwise, UK would be able to align itself with the commercial reality of the 21st century pertaining to celebrity persona. Given its richness in celebrity culture, a right of personality introduced will ensure that their fame and well-knownness is not encroached by commercial predators but remains within the remit of the celebrities who has earned it painstakingly.

CONCLUSION

With the turn of the century, attaining the status of a celebrity has become relatively straightforward. This thesis has demonstrated that it is no longer necessary to possess any particular skill-set/talent or belong to a particular profession to become famous. As such, the term 'celebrity' has been broadly interpreted to include the categories of ascribed and attributed celebrities with the traditional achieved celebrities. Given the development of internet, technology and social media platforms, such a broad definition adequately commensurate the new horizon (and the endless possibilities, therein) of building fame that these advancements have created. With the surge in the number of individuals rising to fame and their countless creative pathways, the spectrum of indicia of persona, by which such celebrities are remembered and celebrated, has also expanded. This thesis has clearly showcased that it is no longer possible to restrict indicia of identity to literal names, images and/or likeness of a celebrity. It must be accepted that, in today's world, celebrities can be popular for literally anything that public finds unique about them; it can be how they stylise themselves, their mannerisms, voice, fictional roles they play in the movies, etc. As such, whatever traits, features or outward manifestation of their celebrity-self that the public loves to remember them with, qualifies as the indicia of personality. Now, the same advancements have also made exploitation of such celebrity persona easier than it was ever before. In doing so, it has made it more difficult for celebrities to control the use of their persona, thus necessitating the need for strict regulations and countervailing mechanisms.

The English law, as the thesis demonstrated, fails to cater for this increased need of regulation and countervailing, as it does not offer any designated right of personality or any tailor-made cause of action to its celebrities to combat against unauthorised use of their persona. The piecemeal approach that the UK has adopted has been shown to be ineffective and inadequate, leaving the celebrities with little or no protection at all. The routinely stretched protean tort of passing-off is unable to keep-up with the modern ways of persona misappropriation by remaining fixated on the misrepresentation requirement. Other torts, particularly, breach of confidence has been proved to be a doctrinal misfit, and torts like defamation and malicious falsehood offers very little to the cause. The attempts of shoehorning personality rights into other legal doctrines, ultimately proved to be unfruitful with majority of genuine misappropriation cases slipping away, leaving aggrieved celebrities with no remedy, simply because the definitional requirements of such legal doctrines could not be satisfied. There are few cases where the piecemeal approach has produced satisfactory results, but the inherent limitations of this approach resulting in its inadequacies and ineffectiveness, as demonstrated, must be acknowledged. The IP regimes are also seen to falter, with its qualifying requirements posing serious impediments in achieving the desired protection. These regimes were not designed to accommodate personality rights in the first place and so, its failure to accommodate

such rights should not come as a surprise. With all its outdated and unfitting arsenals at play, the English legal system has for long tried to push a square peg in a round hole, when it came to personality cases and continuing so, is not accepted by this thesis. Commentators, regardless of their view on personality rights, also accepts that the current measures of protection in the UK are unsatisfactory. The modern reality of practice pertaining to celebrity persona, necessitates a tailor-made approach to protection, which, as the thesis proposed, can be achieved by adopting a standalone and distinct right of personality within the legal system.

The incorporation of personality rights has been rationalised, predominantly, on the basis of both economic and non-economic reasons. It must be accepted that personality rights are often misconceived as being focused on protecting economic interests only (thanks to its publicity variant in force in the US), but, in reality, it entails much more than that. A right of personality seeks to safeguard a celebrity's 'control' over of his persona, and 'control' is the lynchpin of both economic and non-economic interests that a celebrity's persona holds. Any misappropriation of celebrity personality may not only prejudice him commercially but may also adversely affect his dignity, reputation and goodwill, and downgrade the commercial and social magnetism of such personas. It has been revealed that these interests can co-exist and coupled together, can advance compelling justifications for the right. It has been clearly voiced that any personality rights must be constructed by factoring in both of these interests, otherwise, it would lose the very effectiveness and adequacy that it is aimed at ensuring. This thesis, however, rejects other traditional and incidental justifications like the Lokean labour theory, consumer protection, etc. in preparing a strong case for adopting personality rights due to its defective inherent rationalities; but it accepts the pragmatism of filling in the gap created in the absence of an adequate, effective and coherent system of protection as a further justification for the right. All these accepted rationales/justifications not only lay the foundation for such a right but can be seen to be also shaping the right itself.

Unlike the UK, many common law and civil law countries, have responded to the modern reality, and embraced personality rights or has in place, protective mechanisms that safeguards such rights. This thesis has conducted a thorough analysis of several established and functioning personality rights regimes. The analysis not only showed how personality concerns are treated in those legal systems, but also its true effectiveness and adequacy, and most importantly, how those jurisdictions have balanced such rights with competing public interests and freedom of expression/free speech. The analysis further underscored the unsatisfactoriness of UK's piecemeal basis and demonstrated how far behind UK currently is in comparison to its western and European counterparts. Based on the experience and practice of such rights in other countries, this thesis has recommended several likely models for a personality right in the UK. The proposed models have drawn inspiration from the current IP regime of the UK and borrowed the best features from the jurisdictions analysed. The recommendations have been carefully crafted to avoid complete replication of any particular jurisdiction, as the thesis understands that each of the

regimes have shortcomings of their own and replication would bring in with it all those shortcomings, which is not preferred. Furthermore, the models proposed has been devised to include all the modern forms of exploitation and all variations of personality indicia, taking into account the prevalent practice of persona exploitation. The proposals set clear parameters of the right by employing uniform terminologies and most significantly, by clarifying the nature, scope, qualifying tests and liability schematics under the recommended models. This thesis ensures that the recommended models address the core rationales that justifies a personality right by acknowledging both economic and non-economic values of celebrity persona as objects of protection under the proposed right.

Most significantly, this thesis acknowledges that there are various obstructions in the form of public interest and freedom of expression/free speech in the path of adopting personality rights in the UK and its subsequent application. It further acknowledges that concerns of creating a monopoly over persona has been the nucleus of the English court's continuous rejection of personality rights. This thesis, however, takes a pragmatic approach by advocating ways of balancing such competing interests with the proposed right. The recommendations made, clearly provisions for exempted uses of celebrity persona which predominantly serves public interest and/or the exploiter's freedom of expression or free speech. The ideology has been that pure commercial uses cannot serve such competing interests/rights, but non-commercial uses may, as long as it is not at the expense of the concerned celebrity's dignity and goodwill. Such an ideology is particularly useful in drawing the distinction between uses which will be prohibited under the proposed right and uses which will be permitted to allow public interest/free speech to prevail. In this way, the thesis seeks to minimise the concerns of establishing a monopolistic right as uses for legitimate public interest and free speech will be given a leeway under proposed right.

Additionally, the thesis has clarified its position as to why a right of publicity (like in the US), is not recommended for the UK. It must be accepted that that the goal here is to propose a right that safeguards both economic and non-economic values of celebrity persona. Introducing a right of publicity mirroring the US would also bring the desired protection, but only to the commercial side of personality and not the dignitarian side. The thesis also clarified that privacy, solely, cannot also form the basis of protection for personality rights. Although it cannot be denied that personality is often seen as the underbelly of privacy or its spin-off, this thesis has clearly demonstrated how *privacy* is a clear misfit in according the desired relief/remedy in personality cases, despite such foundational overlaps.

Notwithstanding the apparent optimism of this thesis of having a standalone and distinct right of personality in the UK, it is also acknowledged that the traditional attitude of the English judiciary and the legal system, as a whole, may not be conducive for the emergence of such a right. The judiciary has been very conservative about allowing any exclusive right over one's personality on the reasoning that it otherwise creates a monopolistic right. Their orthodox 'hands off approach' to another's private business

has equally denied the codification of similar private rights like *privacy* as a standalone general right in the UK. Rather, such privacy rights have been contorted and shoehorned into other legal doctrines whenever the Court was faced with privacy concerns. Such an attitude could effectively imply that, the judiciary would continue with its shoehorning exercise that it has been so far doing in personality cases by stretching other legal doctrines to accord protection. Additionally, the political reality of the country could also mean that such a right, in a legislative form or otherwise, may not surface anytime soon or may not be in the agenda of the legislatures at the moment. This thesis, however, strongly posits that even if its adoption is not imminent, it definitely is inevitable. Regardless of legal recognition, the celebrities and their personalities would continue to remain relevant to the public, their culture and the society as a whole. Celebrity persona would continue to bear social and cultural meanings, dictate human choices and influence their lives. As long as the wheel of such influence propels, the practice of persona exploitation would only grow and never diminish. Such enduring commercial, social and cultural significance and magnetism of celebrity persona would inevitably compel the English legal system to adapt to modern realities rather than remain tied up with the legal categories of the past. The IP regime in the country stands as the perfect example of English law being compelled into adapting to new realities and even creating monopolistic private rights such as this one. So, the thesis being ambitious about UK following the same trajectory for adopting a personality right in the foreseeable future, is not unjustified. Until such a trajectory is followed and the required reforms are brought about, this thesis will remain optimistic with its recommendations and will boldly continue to advocate for a distinct right of personality for the celebrities in the UK.

TOTAL WORD COUNT: 117,653

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