Lifeline for leading lights?

Two recent cases suggest a more European approach is being taken on the protection of personalities. Nick Aries offers an overview

"Whatever may be the position elsewhere in the world, and however much various celebrities may wish there were, there is today in England no such thing as a free-standing general right by a famous person (or anyone else) to control the reproduction of their image."

These were the words of His Honour Justice Birss QC, deciding in the Rihanna case last summer (Fenty and others v Arcadia Group Brands Limited (t/a Topshop) and another [2013] EWHC 2310 (Ch)). Of course, Birss J went on to find that Rihanna did have the right to prevent the reproduction of her image in that case. A subsequent judgment of the same Judge in the Betty Boop case earlier this year (Hearst Holdings Inc and another v A.V.E.L.A. Inc and others [2014] EWHC 439 (Ch)) also addressed the reproduction of famous images – this time centring on a cartoon character. This article considers the implications of these two UK decisions in particular, and aims to also give an overview of the image rights position in France, Germany and Spain.

Pop start

In March 2012, retail giant Topshop began selling a T-shirt with an image of the singer Rihanna on it without Rihanna's permission. Rihanna objected to the use of her image on the product on grounds of passing off, and succeeded at first instance (the case is currently on appeal). Before this case, it was generally thought that merely placing a celebrity's image on goods without permission did not infringe the celebrity's rights. Where there is a precedent for preventing use of a celebrity's image on advertising material (Edmund Irvine Tidswell Limited v Talksport Limited [2002] FSR 60), this is the first reported modern case in which a celebrity successfully prevented use of their image on goods.

Why did Rihanna win? The image at issue was itself famous – it was taken during a video shoot that had garnered lots of publicity for being controversial. Topshop had previous associations with celebrity fashion icons, such as Kate Moss, and had in the past run a competition offering a shopping appointment with Rihanna. Rihanna had cultivated a brand in the world of fashion, not just music. In the Judge's mind, these factors enhanced the likelihood in the purchaser's mind that the garment had been authorised by Rihanna.

The Betty Boop case was somewhat different. It can be seen as a merchandising case, rather than one about endorsement, and involved a fictional character rather than a real person. In this case, the Defendants were licensing and selling T-shirts and bags bearing an image of the cartoon character Betty Boop. The Claimants were the successor of the originator of that character, and claimed to be the only legitimate source of Betty Boop merchandise in the UK. The Claimants also owned UK and Community Trade Marks for BETTY BOOP and the device shown on page 13.

Birss J found that the Defendants' activities amounted to passing off, and infringed the trade marks under sections 10(1), 10(2) and 10(3) of the Trade Marks Act 1994 (and their Community equivalents). The Judge held that the Defendants' goods were likely to lead the public into thinking that they originated from the same source of Betty Boop merchandise that consumers were familiar with (ie the Claimants – who had been able to show they had been the sole source of such merchandise for 20 years). The public had been educated by the Claimants to see BETTY BOOP as a mark of origin and that there was a single official source of such goods. The presence of an additional mark (RADIO DAYS) did not assist the Defendants as the public did not regard RADIO DAYS to be an alternative source of genuine Betty Boop merchandise. In the Judge's view, the words "Official Licensee" or "Officially Licensed Product" on the labels significantly enhanced the assumption by a purchaser that the goods were official Betty Boop merchandise.

Although the Judge agreed with the Defendants that the use of a picture of Betty Boop and/or the word "Boop" were also decorative, they were not purely so. Although some purchasers would buy the goods without caring whether they were official Betty Boop merchandise or not, a significant portion of the purchasers wanted Betty Boop merchandise from the official source.

The Judge rejected a defence of use of indications concerning the kind or quality of the goods in accordance with honest practices. The use was not descriptive, particularly given the words "officially licensed" on

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Image: © Ikon Images 2014

the labels. According to the Judge, there were also several reasons against the use being within honest practices.

Although, in this decision, the Judge was at pains to repeat what he had said in the Rihanna case (no free-standing right by a famous person to control the reproduction of their image), a second success for a Claimant within a few months in an image rights-type case has certainly caught the eye. Interestingly, the Judge observed that it is probably easier to educate the public to believe that goods relating to an invented character derive from a single official source than it might be for a real person, not least because copyright may give the ability to control the reproduction of the character for a long period. In each case, the Judge has emphasised that the decisions turned on their particular facts. However, it is easy to see how they could widen the scope of quasi-image rights in the UK. The key thing is what the public perceives when confronted with goods bearing famous images. The rise in official celebrity endorsements and the number of spin-offs outside the celebrity's original field means consumers are arguably increasingly likely to expect such goods to be officially licensed.

French evolution

Image rights were introduced in France by case law as a component of personality rights, which are protected under Article 9 of the Civil Code: "one is entitled to have his private life respected." The concept of image rights has, however, evolved over time. Case law has granted a specific status to image rights, as based on Article 9, but distinct from privacy.

Although traditionally considered as a non-economic right, certain cases began to recognise the commercial component of image rights when celebrities began to grant (and monetise) authorisations to third parties to exploit their image commercially: "one has an exclusive right over one's image and can oppose its reproduction or use, even for commercial purposes, without one's authorization" (Versailles Appeal Court, 2 May 2002). This evolution was more concerned with creating a commercial monopoly in an individual's image than preventing an intrusion into one's private life. The Paris Court of Appeal confirmed this development in a case concerning the image of a famous singer, Henri Salvador, stating that: "when the image of an individual acquires a commercial value because of the notoriety of said individual, the reproduction of the image concerned, without his authorisation, constitutes an infringement of his patrimonial rights, even though it does not relate to his private life/privacy" (Paris Appeal Court, 14 Nov 2007).

Accordingly, French courts have considered that celebrities could validly grant exclusive licences to the commercial exploitation of their image in relation to goods and services. The Paris Appeal Court has also confirmed the validity of sub-licences with regard to the commercial component of a person's image rights (Paris Appeal Court, 22 Nov 2006).

In a recent violation of image rights case, the Versailles Appeal Court applied the indemnification mechanism traditionally applied to IP infringement (Versailles Appeal Court, 8 Nov 2012). In that case, a French celebrity's image had been used in Mercedes-Benz adverts without his prior consent. The damages awarded to the celebrity were calculated by estimating what licence fee Mercedes would have paid to the celebrity to obtain his authorisation. Some commentators consider that such a decision blurs the lines between image rights and IP, and therefore affects the essence of image rights.

The Cour de Cassation (French Supreme Court) regularly recalls that image rights are to remain within the scope of Article 9 of the French Civil Code. In particular, as with any other personality right, image rights cease to exist upon the death of the individual and cannot be claimed by their heirs (Cour de Cassation, 22 October 2009).

German tradition

Under German Law, there is a long-standing tradition of protecting image rights. The German right to one's own image is a characteristic form of the "general right of personality" (*Allgemeines Persönlichkeitsrecht*) developed by the German Federal Court based on Article 1 and 2 of the German Constitution (*Grundgesetz*) and governed by the German Art Copyright Act (KUG), dated 1907.

> *The combination of privacy rights, defamation and rights in passing off mean that an individual is not necessarily without redress in the UK, depending on the circumstances*

According to these provisions, images of an individual may be spread or published only with the consent of the person, subject to various exceptions. The most important exception applies when persons of "contemporary history" are shown in an editorial context. The German courts then have to balance the interests of the individual and the public interest for information.

Over time, the courts recognised the commercial interest a person may have in their own image and therefore granted stronger protection. In one

famous case, the daughter of Marlene Dietrich sued for damages because of the unauthorised use of her (deceased) mother's image in an advert for a musical about her life. The German Federal Court stated that the general right of personality and the right to one's own image also protects interests of financial value, especially for famous individuals, and that patrimonial interests were also protectable. As a consequence, the right to one's own image may be affected by an unauthorised commercial use. An individual affected by commercial misuse can claim damages based on the usual licence fee.

In a case decided in 2012, the weekly tabloid *Bild am Sonntag* had to pay a licence fee of €50,000 for publishing an image of photographer and author Gunter Sachs reading the publication in a private situation on his yacht with the caption: "Gunter Sachs reads *Bild am Sonntag* – so do more than eleven million Germans." The German Federal Court deemed the publication unlawful because the caption and pictures were connecting Gunter Sachs to the tabloid, creating the impression he was recommending it – which he never did.

According to German First Instance and Appellate Court decisions, the image right also covers an altered and rather artistic use of one's image in the form of pop art paintings. Furthermore, athletes may commercialise their image for use in computer games. The Higher Regional Court of Hamburg held that famous former German goalkeeper Oliver Kahn can control the use of his picture in the FIFA World Championship computer game. The commercial components of the image right can even be asserted by one's heirs.

Spain's structure

The Spanish Constitution of 1978 protects image rights as personality rights, along with privacy and honorability rights (Article 18.1). The right protects against unauthorised taking and use of the physical features of an individual (Organic Law 1/1982 on the protection of honour, privacy and image rights).

The scope of protection will vary according to the boundaries set by the individual based on their own acts of reliance or estoppel. There is no unlawful act where it is expressly authorised by law or by consent of the individual concerned. This consent – if given – may be reversed at any time, but any damages flowing would need to be compensated (including justified expectations of the person using the image). The right of action belongs to the person whose image rights have been violated, and can be passed on to beneficiaries under a will. If no such designation is made, action can be taken by the spouse, offspring, ancestry or siblings and, ultimately, the Public Prosecutor (*Ministerio Fiscal*).

Unauthorised use of the person's image, voice or name for marketing or commercial (or similar) purposes is expressly prohibited. Image rights are construed broadly, including any feature of appearance – a feature that would permit the person in question to be identified, including fictional characters played by that person. In the Emilio Aragon case (Constitutional Court decision 81/2001), the Defendant was ordered to stop reproducing, in a deodorant advert, the costume of a widely known Spanish singer, consisting of a tuxedo and white sneakers, as the public associated such attire with the Claimant.

Celebrities' privacy rights may be limited when compared with individuals whose ordinary life or business activities are not exposed to the public gaze. However, while capturing a celebrity's image might be legal under certain circumstances (for example during a public performance or in a public place), the commercial use of such an image may still be prohibited. The Supreme Court decision in case 11/2014, Mrs Sara et al v Hachette Filipacchi SL (*Qué me dices* case) concerned whether the use of a photograph containing the image of a female actor strolling in a public area with her husband, taken without consent, was legitimate for a make-up advert. The Court considered that, although the Claimant's privacy rights were not infringed, the image was being used to make the product appealing to consumers to increase sales. As such, such a use fell within the prohibition and was banned.

The protection of personality rights is well established in the laws of France, Germany and Spain. In each case, the scope of the right has widened over the years to encompass protection against unauthorised commercial use. In contrast to continental European jurisdictions, there is no formal codified image right in the UK. However, the combination of privacy rights, defamation and rights in passing off mean that an individual is not necessarily without redress in the UK, depending on the circumstances. The Rihanna and Betty Boop decisions illustrate that the English Courts are prepared to step in where they perceive that commercial activities leveraging a famous image have crossed the line.

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