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IMAGE ADVERTISING
Unauthorised Commercial Exploitation
of Personality

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INTELLECTUAL PROPERTY LAW (LAWS 541)

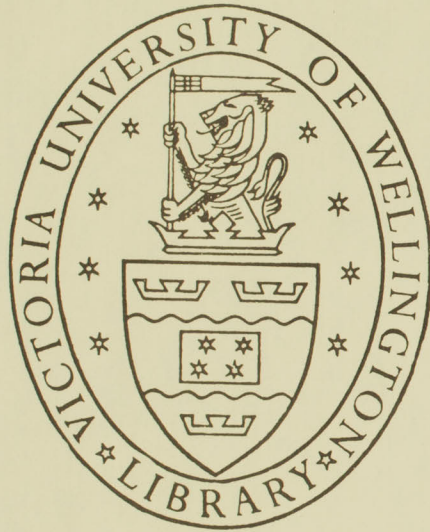
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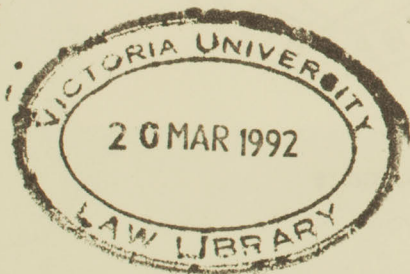
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IMAGE ADVERTISING

INTRODUCTION

Tremendous commercial advantage may be obtained by the use of celebrities and other public profiles in the marketing and advertising of a product. In particular, actors and actresses, singers and sports celebrities are often seen on television and in magazines promoting various products. For example, Liz Smyllie, the Australian tennis player advertising 'Extra' chewing gum; John Kirwan, 'All Black' rugby player, advertising bananas; Linda Evans from 'Dynasty' advertising 'Krystle' perfume; and M C Hammer promoting 'Pepsi'. Use of the image of a celebrity in advertising is effective.¹

"The benefits which may arise from merchandising, licensing contracts and endorsements can potentially yield an income far greater and longer lasting than the primary fields in which public recognition was achieved".² "The practice of character merchandising is an entrenched feature of contemporary marketing and is becoming increasingly familiar to the Federal Court of Australia".³ "Character merchandising exploits the fact that modern buying habits are "highly responsive to image-related advertising" and the rights to use a personality or character are extremely valuable".⁴

There may or may not be a connection between the personality and the products they are promoting. Product endorsement ranges from actual support of the product to a mere association or connection with the product ("subliminal effect"). Support of the product may be by virtue of a professional or occupational link. For example, a racing car driver and motor oil, or hairdresser and shampoo. The motive behind such advertising is the express or implied professional knowledge and expertise portrayed to the public. The endorser does not actually need to state it is the best product. The association may imply this.

The subliminal effect of an advertisement may be harder to prove.⁵ However, it can be equally successful at boosting sales. Either way there can be no doubt that image advertising, and the connection of a product with a famous person, can boost revenue and give the product an advantage over and above the competition. This is evidenced by the increasing use by competitors of such product endorsement in a world of "bland" brand names and undistinguished products,⁶ and the corresponding increase in litigation resulting in recent developments in legal protection.

This paper is concerned with the unauthorised commercial exploitation of a celebrity's personality and image. Celebrities usually establish notoriety by actively seeking public or media attention. This in turn provides an avenue of secondary income to a celebrity who contracts use of their public profile to endorse a product. This takes further commercial advantage of the popularity of an image or character which may be short-lived.

With each unauthorised use of image in product endorsement, the value to the celebrity is reduced both by virtue of lost royalties and further, by the ability to profit ('the more exploited, the less sought after will be the image'). That is, the image is worth more to a select few.

This paper discusses the protection afforded to real persons in the jurisdictions of the United States, the United Kingdom, Australia and Canada. It is concerned with "personality merchandising" of celebrities, and "image merchandising" being the merchandising of a fictional character by a real person. An example of image merchandising is the use of Paul Hogan's image as 'Mick Dundee' in the Crocodile Dundee films, to sell shoes. This paper does not discuss the additional protection afforded to caricatures such as copyright and trademarks. The term "character merchandising" is used in its broader sense to describe the licensing of real or fictional characters on or in relation to goods or services with which the character usually has little or no connection. This is most often by way of

licence. The commercial pragmatism of modern marketing does not demand any inherent connection between the image or character and the product, nor between the licensor and the licensee.⁷ Character merchandising in its broad sense, occurs by way of the name, image or distinguishing features of a popular figure being presented in association with a particular product to make it more attractive to consumers or draw attention to it.

Image or personality refers to a person's name, likeness, voice, or other characteristic of identity. Appropriation usually concerns use of a photograph, printed publication of name, or impersonation. In the commercial context, this commonly takes the form of advertisements invariably implying endorsement of a product.

Due to the considerable volume of case law, particularly in the United States, a loose focus or theme is made throughout this paper on cases involving artists famed for vocal attributes.

There has been considerable development in the law protecting the value of the celebrity in the United States. An individual's right to privacy is recognised. By virtue of celebrities seeking publicity, there is a corresponding decline in their right to privacy. Consequently, a right to publicity has arisen providing a property right to exploit their own personality. Unauthorised commercial exploitation is equivalent to a misappropriation of intangible property. Some States have given this statutory recognition.

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The infringing uses of personal identity for commercial purposes has been defined as "the uncommitted use of personal identity in the advertising of commercial goods and services (that) forms the core of acts which trigger liability for invasion of appropriation, privacy and infringement of the right of publicity".⁸

The main form of protection in the United Kingdom, Australia and New Zealand is the common law tort of passing-off. The

Canadian Courts recognise a tort of misappropriation of personality separate and distinct from the tort of passing-off.

The United Kingdom does not recognise a right of publicity to protect personality. It is also one of the few jurisdictions in which no right of privacy is legally recognised. Adherence to the classic action of passing-off requiring a common field of activity, has resulted in limited protection in the field of character merchandising. Recently, the English Courts have approved the development of Australian law in this area.

Australian Courts have recognised the commercial reality of character merchandising and the need for protection against unauthorised use. The Australian Courts are more advanced in their development of protection than their English counterparts.⁹ They have developed away from the English requirement of a common field of activity by recognising that in the area of character merchandising, use of the character usually has little or no connection with the goods or services endorsed.

In recent times, the provisions against misleading and deceptive conduct and false representation as to product approval or endorsement pursuant to the Australian Trade Practices Act 1974 (Sections 52 and 53(c)), have been pleaded. The extent to which they protect character merchandising has not been fully determined.

New Zealand's Fair Trading Act 1986 is modelled directly on the Australian Trade Practices Act 1974. Many instances of misappropriation of identity are now covered by Section 9 (false and misleading conduct) and the more specific Section 13(e) (prohibiting false representation as to sponsorship, approval, endorsement or affiliation).¹⁰ New Zealand case law on the Fair Trading Act 1986 draws largely on the Australian equivalent, so it is submitted New Zealand is likely to draw on the Australian precedents in relation to character merchandising.

UNITED STATES LAW

Significant development of the law with respect to commercial exploitation of personalities has taken place in the United States and, in particular, the States of California and New York, being the centres of show-business, through the right of publicity and the general tort of misappropriation of personality.

Some States, such as New York and California, have also given statutory recognition to the right of publicity, although statutory protection may vary between States.

It is generally accepted that this right of publicity is a property right.

Right of Privacy

The right to publicity has arisen out of the general tort of invasion of privacy.¹¹ Nearly every State now recognises some form of right to privacy, either based on statute or common law.¹² The terms "privacy" and "publicity", to a certain extent, are contradictory. Although two separate legal doctrines have effectively developed, the privacy roots remain.¹³ The separate development of the respective rights of privacy and publicity creates some problems as to cohesiveness of the law,¹⁴ with some States recognising both rights, but others only one of them.

The right of privacy is aimed at protecting unwanted publicity, that is, confidential information about a private person, and is not proprietary. It is socially granted to an individual by virtue of legal and political concepts.¹⁵ It is different from the commercial interest a celebrity seeks to protect. With publicity, the right to prevent others publicising details of private life diminishes, and the private sphere becomes more public.¹⁶ A celebrity's image is created by publicity such that a total loss of privacy becomes the price for media

publicity but at the same time, attracts economic value.¹⁷ In the United States, the right of publicity to protect the commercial value of personality is an intangible property right to prevent misappropriation of the Plaintiff's name or likeness to the Defendant's advantage. It recognises an individual's right to profit from their own image. Emphasis is made on the commercial aspect of preventing the Defendant getting something for nothing, or "reaping without sowing", so that damage to the Plaintiff is not necessarily a requisite element.¹⁸

Privacy is difficult to define and would be dependant upon each community or society to which it applies for its interpretation. It has been broadly defined as "the right to be left alone",¹⁹ and this was adopted by *Warren & Brandeis*. The *Younger Committee on Privacy (1972)*,²⁰ did not consider "the right to be left alone" should be unqualified, as it is inherent in our society for individuals to interrelate. The definition, "the right to be left alone", has been stated as insufficient to form the basis of a legal right and, arguably, does not cover appropriation of personality,²¹ which may take place without any physical interference with the subject's peace or solitude.

One of the most influential legal works recognising a personal right to privacy was an article written in 1890 by *Warren & Brandeis*.²² This has been cited in many American cases, especially those where a right of privacy was being created.²³ The *Warren & Brandeis* article is the basis upon which State Courts in the United States came to recognise a tort for the invasion of privacy.²⁴

Warren & Brandeis argued for the recognition of a right of privacy based on a variety of English cases. They relied significantly on *Prince Albert v Strange*,²⁵ as showing recognition of a right of privacy by the common law. Prince Albert restrained the Defendant from publishing a catalogue describing unpublished etchings made by Queen Victoria and Prince Albert. *Lord Cottenham* granted an injunction on the basis of breach of confidence as well as for "surreptitious

acquisition" of information.

The right to control the use of one's own image arises out of recognition of a personal right to privacy.

Twelve years after the publication by *Warren & Brandeis*, the New York Court of Appeal refused to recognise a right of privacy in *Roberson v Rochester Folding Box Co.*,²⁶ for unauthorised use of a photograph in an advertisement. This led to the New York Civil Rights Act being passed which provided criminal and civil sanctions in respect of appropriation of personality.²⁷ *Pavesich v New England Life Ins. Co.*²⁸ recognised that the concept of privacy did not protect celebrities, and recognised a common law personal right to privacy which led to the further recognition of a personal right to exploit publicity.

The right of publicity was expressly recognised in 1953 in *Haelan Laboratories v Topps Chewing Gum Inc.* 202 F.2d 866 (1953).

Therefore, American Courts now distinguish between the appropriation of a private person's personality from that of a celebrity or public figure.

In a famous article written in 1960, Prosser²⁹ analysed the common law tort of infringement of privacy, and came up with four categories of the tort constituting invasion of privacy:

- (i) intrusion upon the Plaintiff's seclusion or solitude, or into his private affairs;
- (ii) public disclosure of embarrassing private facts about the Plaintiff;
- (iii) publicity which places the Plaintiff in a false light in the public eye; and
- (iv) appropriation, to the Defendant's advantage, of the

Plaintiff's name or likeness.

In New Zealand, the third category will almost always be covered by the tort of defamation³⁰ and the fourth by the Fair Trading Act 1986.³¹

Development of Right of Publicity

Prosser categorises appropriation of the Plaintiff's name or likeness, as one of the four main torts constituting invasion of privacy. This has become known as the right of publicity in the United States. That is, an individual's right to profit from their own image. In comparison, the law of privacy is aimed at protecting unwanted publicity. The *Prosser* classification has had a marked influence on American Court decisions on appropriation of personality.³²

To some extent, the privacy foundations are evidenced in the right of publicity.³³ There are a number of definitions of privacy which extend to cover appropriation of personality where others do not include such protection.³⁴

Frazer,³⁵ suggests a definition of appropriation of personality as an aspect of privacy such that privacy includes the interests a person has in determining the use to which his or her personality will be put; it is an aspect of a person's interest in determining the social sphere or context in which he or she wishes to appear.

Where a right of publicity is recognised as a right independent to privacy, the Plaintiff must show that he or she is a public figure with a valuable personality.³⁶

The precise definition of the right of publicity is not settled at law. The right of publicity may be loosely defined as the right of a celebrity over all the aspects of his or her image, and over which he or she has control as over his or her property.³⁷ It is limited by public interest concerns such as freedom of information and speech.

First Amendment to the US Constitution

In comparison with the Commonwealth jurisdictions of New Zealand, Australia, Canada and England, the United States provides an overriding constitutional guarantee of freedom of information in the public interest. This provides a freedom to the Press to gather "news". Australia does not view protection from a personal rights angle or in terms of property, but does from a commercial viewpoint.³⁸

One of *Prosser's* main critics, *Bloustein*,³⁹ regards privacy in terms of individual dignity. He rationalises that appropriation is only wrongful when it takes place in a commercial context. The First Amendment necessarily confines the rule against appropriation of personality to a commercial context. *Frazer* however, indicates that this does not necessarily restrict the definition to concepts of human dignity.⁴⁰

New Kids on the Block v Gannett Satellite Information and News America Publishing,⁴¹ is one of the more recent cases where the overriding constitutional rights favoured the public interest in free expression over and above the public interest to avoid consumer confusion. The case concerned use of the pop group's name and likeness in connection with surveys using "900" telephone numbers. The Defendants obtained answers to survey questions on the pop group by callers dialling telephone numbers beginning with "900"; the callers were charged a fee for participating.

The New Kids alleged dilution of their trademark, service mark, trade name and commercial misappropriation. The claim was based on an allegation that such use involved dissemination of false and misleading information to the public and was likely to confuse the public as to the relationship between the Plaintiffs and the Defendants. Further causes of action were based on the Lanham Act, and Californian unfair competition and false advertising laws.

The Court held that the Plaintiffs' claims were barred by the First Amendment to the Constitution providing freedom of news gathering and dissemination of information.

The Court found that use of the New Kids' name and likeness was related to news gathering and not mere commercial exploitation. The commercial venture was such as not to outweigh the right to exercise freedom of speech. There is a balancing between the values protected by the First Amendment and misappropriation of a Plaintiff's intangible property rights.

Statutory Right of Publicity

With respect to trademark infringement and the Lanham Act, the Court adopted the test used the previous year in the case *Rogers v Grimaldi*,⁴² a suit Ginger Rogers lost in respect of the film "Ginger & Fred". The Lanham Act "should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression".⁴³ With respect to use of celebrity names, the Lanham Act is only concerned with titles that explicitly mislead as to the source or content of the work.

The Lanham Act only applied if the New Kids had been falsely and explicitly represented as having sponsored or endorsed the use of the "900" number.

The Lanham Act, at 15 USC paragraph 112(a) (1982) section 43(a) states:

"Any person who shall affix, apply, or annex, or use in connection with any goods or services a false designation of origin, or any false description or representation shall be liable to a civil action by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

Visual Likeness

The New York District Court in Woody Allen v Mens World Outlet Inc.,⁴⁴ found this provision of the Lanham Act was breached by the unauthorised use of a Woody Allen look-a-like in an advertisement.

No Common Field of Activity

In the Woody Allen case, the Court confirmed that the Lanham Act could be used in look-a-like cases even though the Plaintiff and the Defendants were not in competition with each other. There was no competition but the use of the image was directed at the same audience so there was a factor of recognition. This led to a likelihood of confusion under the Lanham Act.

Likelihood of Confusion Test

The Court found six factors required to prove likelihood of confusion under the Lanham Act:

- strength of mark or characteristic
- similarity
- proximity of products
- confusion
- sophistication of audience
- bad faith

Right to Exploit Own Image and Persona

The Court held that the Plaintiff's right to exploit his own image and persona was infringed by the use of a look-a-like. This right is akin to trademark protection and the same standards are applicable. The use of look-a-like models has been very popular in the United States and this case should sharply curtail the activity.⁴⁵ Further, the Lanham Act offers good prospect for future claims in respect of vocal imitation.⁴⁶ The development of the Lanham Act to protect

against sound-a-likes "makes a valuable contribution to the effective protection of performers".⁴⁷

Vocal Likeness as a Common Law Right of Publicity

In *Midler v Ford*⁴⁸, the Defendants' advertisement promoting a Ford motorcar made use of a sound-a-like who purposely imitated the voice of Bette Midler to a song she had popularised, "Do you Want to Dance?".

Neither the voice nor the picture of Midler were used in the commercial, and no express reference was made to her. The Defendants' had obtained copyright permission to use the lyrics and music but had imitated Midler without her consent. The evidence showed that viewers thought it was Midler singing.

Midler was prevented from raising a Lanham Act claim on procedural grounds. However, on the basis of the *Allen* decision, she would have had a good chance of success despite not being in competition with Ford,⁴⁹ as long as overlap of audience existed (which is likely since the advertisement was aimed to appeal to an audience familiar with her arrangement of the song). There was evidence of confusion that it was in fact her.

Tort of Appropriation of Personality

The United States Court of Appeal for the 9th Circuit found Midler enjoyed common law property rights in her distinctive voice. There had been an appropriation of the Plaintiff's likeness. Her voice was an attribute of her identity and:

- (i) Midler's voice was of value to the Defendants and that was why they used an imitation. The value was the market value that would have been paid had she sung in person;
- (ii) That which had been appropriated (an imitation of her voice) attracted protection as an aspect of

personality;

Limits of Protection

The Court placed limits on the protection of this particular aspect of personality; of distinctiveness, publicity and deliberate use.

Distinctiveness

Not every voice imitation would be protected. In particular, the voice was distinctive. "The human voice is one of the most palpable ways identity is manifested The singer manifests herself in the song. To impersonate her voice is to pirate her identity".

Publicity

She was a professional singer and widely known nationally as an actress and singer. She had won a Grammy, had been nominated for an Academy Award and had been described by the media, as an "outrageously original singer/comedian".

Deliberate Use

There was also found, on the facts, to be a deliberate imitation for marketing purposes. The actual singer had previously been a back-up singer for Midler for ten years, and was told to "sound as much as possible like the Bette Midler record". A number of people had told Midler the commercial sounded exactly like her, and people thought it was her singing the commercial.

No Unfair Competition or Damage

The Court was concerned with the misappropriation of part of Midler's identity for the Defendants' own profit in selling their product. Midler had been asked to do the commercial but refused. The District Court described the Defendants' conduct

as that of "the average thief". They decided, "if we can't buy it, we will take it". The US Court of Appeal found no requirement of financial loss. There was no finding of unfair competition. Midler did not do television commercials and was not in competition with the Defendants. Because she was not in the advertising market, it was no loss on her record sales.

The Court having found in favour of Midler for misappropriation referred the case back to the District Court for a jury trial. The jury came back with a \$400,000.00 verdict in favour of Midler.⁵⁰

Since the Midler case, a number of celebrity suits have followed against advertisers including⁵¹ the Estate of singer Bobby Darren suing McDonalds over its 'Mac Tonight' advertisements for similarities with 'Mack the Knife', and Adam West who used to play 'Batman' claiming that the actor playing 'Batman' in an advertisement had copied his voice, mannerisms and likeness.

The Court, in Midler, referred to Nancy Sinatra,⁵² who sued a tyre company in respect of an advertising campaign, by the same advertising company that Midler sued, for featuring the song "These Boots are Made for Walkin'". The song closely identified with her. She alleged the singers had imitated her voice, style and dress, and were made-up to look like her. The basis of her claim was unfair competition and that the song and arrangement had acquired a secondary meaning. The Defendants had paid a substantial sum to the copyright proprietor to obtain a licence for the use of the song and all its arrangements. Sinatra lost the case on the basis that to do otherwise would conflict with copyright laws.

Sinatra's objection concerned the imitation of her arrangement of a particular song; Midler's objection was to the imitation of her voice. She did not seek protection for a particular song. "Do you Want to Dance?" was merely the vehicle for the imitation of her voice. However it is interesting to note, that the District Court rejected for lack of evidence, her

claim that "her voice alone was so unique that upon hearing a voice anything like her's the public would think that it was no-one but Midler".

Association

The Court found authority in the case of Motschenbacher v R J Reynolds Tobacco Company,⁵³ where a famous racing car driver and his car were used in a tobacco company's advertisement. He made a living out of giving commercial endorsements. The Californian Courts recognised an injury from "an appropriation of the attributes of one's identity". It was irrelevant that he could not be identified. It was sufficient that the advertisement suggested that it was him by associated signs and symbols. Similarly, the Defendants admittedly used an imitation to convey the impression that Midler was singing for them.

Motschenbacher was a case where the Plaintiff appeared but was not recognisable. In Midler, the Plaintiff did not appear at all, but in both cases the Court held the Plaintiff's likeness had been appropriated because the public inferred the Plaintiff's willing participation⁵⁴.

The American cases reflect the view that "No social purpose is served by having the appropriator get for free some aspect of the individual that would have market value and for which he would normally pay".⁵⁵ This attitude of unjust enrichment is not one which is reflected in United Kingdom law.

Problems with Attributing Property Value to Personality

Problems may arise by attaching a property element to personality, in drawing the distinction between that right and the rights of others, such as copyright. The Midler case emphasised the notion of the value of Midler's vocal characteristics to others. The Defendants had copyright in the lyrics. A conflict arises; although the copyright owner had rights in the song itself, the singer's property rights in her

vocal attributes were infringed because it sounded like the singer herself. The District Court in Midler was concerned that such protection may be at the expense of the copyright holder. The copyright holder may have to purchase additional rights to perform a song to avoid being involved in litigation.

Therefore, in the context of a sound-a-like claim, the Court must be careful to distinguish between precise and generic similarities.⁵⁶ It is submitted this is also of relevance to look-a-likes, such as allegations that Madonna is trying to snatch the image of Marilyn Munroe.⁵⁷ Madonna may be taking advantage of Marilyn's popularity, but Madonna also has genetic similarities. Had the vocalist's natural voice sounded like Midler, the result in that case may have been different. The alternative view is that deliberate use of such a voice to draw the association with Midler is wrongful appropriation.

Is the Right of Publicity Inheritable or Assignable ?

The proprietary interest in personality has significant ramifications. For example, does this mean that it has an inheritable quality along with the other property comprised in an estate. It is interesting to note that Elvis Presley and Marilyn Munroe are worth more dead than alive. Their images command licensing and merchandising fees for appearing on posters, T-shirts and other memorabilia, which fees their heirs receive. Marilyn Munroe's estate was worth US\$500,000 at the time of her death in 1962. It is now worth US\$2,000,000 per annum. Elvis Presley's estate was worth US\$5,000,000 when he died in 1977 and it is now worth US\$15,000,000 per annum.⁵⁸

Therefore, it is not surprising to learn the estate of Presley brought several actions in the United States for use of his image.

The issue of whether the right of publicity ceases with the death of the celebrity or whether it survives death and can be passed onto heirs by will or even licence, has been considered by various States in America due to the recognition of the

right of publicity as property, rather than as a personal right. A question arises as to descendability and assignability, and the ability generally to realise the property value in the market place (alienability).⁵⁹

Issues arise as to the duration of the descendants' monopoly over the image, and rights to exploit the image of the celebrity if he or she has not done so during their lifetime.

Some of these features of the right of publicity have not, as yet, been fully resolved.

Assignability

With respect to assignability of publicity, the Courts held in the preliminary injunction case of *Estate of Elvis Presley v Russen*,⁶⁰ that a celebrity can assign the right to use a name or likeness although, given the personal nature of goodwill attaching to the celebrity, that cannot be assigned. The estate had shown a likelihood of success of the right of publicity claim against the Defendants for a live stage imitation of the singer. There was also likelihood of success as to the Defendants' unauthorised use of the singer's likeness on the cover or label of records, or pendants sold or distributed by the Defendants.

The death of the singer did not preclude the finding that the Defendants' theatrical presentation was infringing.

The estate had standing in respect of the deceased singer, pursuant to the Lanham Act in respect of the use of image or likeness of Elvis, or names associated with him in rendering musical services. The estate had an economic interest in protection of future ability to generate income from property rights associated with the singer's entertainment services.

Further, the tort of right of publicity provided a right to control the commercial value and exploitation of Elvis' name or picture or likeness, or to prevent others from unfairly

appropriating that value for their commercial benefit.⁶¹

The effect of the First Amendment to improve the flow of commercial information to the consumer was not aided in this case. That is, the usefulness of such information was minimal to the public.⁶²

The Court stated,⁶³ that the show, "A Tribute to Elvis Presley" served primarily to commercially exploit the likeness of Elvis Presley without contributing anything of substantial value to society. It was found that entertainment, being a copy or imitation, does not have its own creative component and does not have a significant value as pure entertainment; not even where it was skillfully or accurately carried out.

Inheritability

The question of whether the right of publicity may be inherited is more complex than with respect to assignability.⁶⁴ Various United States Courts have either treated publicity rights as dying with the celebrity, or alternatively, as being capable of transmission to a beneficiary.

In the Elvis Presley case of *Memphis Development Foundation v Factors Inc.*,⁶⁵ the US Court of Appeal's sixth circuit held that the right of publicity was not inheritable. Similarly, in *Lugosi v Universal Pictures*,⁶⁶ the Californian Supreme Court took the same approach. The wife of the actor who had played "Dracula" was unsuccessful in seeking to prevent Universal Pictures granting additional licences merchandising the actor's portrayal of Dracula, on the basis that she had inherited those rights not contracted to Universal Pictures when the movie was made.

The latter case is interesting in light of the California Civil Code, Section 990(b) which statute protects the use of a deceased persons name, voice, signature, photograph or likeness, and expressly recognises those rights as "property rights". The statute was referred to in the *Midler* case and

in that case, the Court drew the analogy that common law rights are also property rights, and appropriation of such common law rights is a tort in California.

However, both Courts in the Elvis Presley case and the Lugosi case were concerned with problems arising if a right of publicity was recognised after death. For example, the length of time that the right would survive death; whether it could be devised by will a second time; what would happen where an artist portrayed a likeness of a famous person, for hanging in a public place and was paid for it - did this breach the right of publicity? Also, did the right extend to elected officials and military heroes whose fame was gained on the public payroll?.⁶⁷

In contrast, in 1983 the Supreme Court of Georgia held that the right of publicity did survive the death of its owner. Further to this, there was no reason to protect the right after death, only for those who had taken commercial advantage of their fame during their lifetime; Martin Luther King Jr. Centre for Social Change Inc. v American Heritage Products.⁶⁸ However,⁶⁹ it has been suggested in order for the publicity right to succeed on death, the right must have been exercised or exploited commercially during the lifetime of the individual concerned, for the reason that if a right of publicity is to have any substantive meaning, it should be consummated by publicity.

The United States' treatment of personality as property raises issues as to assignability and inheritability similar to other intangible property rights. Also, issues arise as to competing rights. It is submitted these factors can be addressed by Parliament enacting legislation as for copyright and trademarks; for example, limiting the time for monopolising personality attributes to lifetime, plus 50 years.

ENGLISH LAW

Unlike the United States, English law does not recognise a right to publicity, not even to privacy.⁷⁰ However in 1983, a commentator surveyed a number of London law firms to discover what he described as a new tort of appropriation of personality.

Early English Law

Early English cases alleging appropriation of personality involved unauthorised use of names. One such case involved the use of a medical practitioner's reputation and unauthorised endorsement of a medical treatment.⁷¹ These cases involved professionals whose names were appropriated for advertising purposes. In *Dockrell v Dougall*,⁷² the Court found a person does have property in their own name provided it is in conjunction with some other cause of action such as libel. However, a person does not have property in their name *per se* "unless the Plaintiff can show that the Defendant has done something more than use his name without authority".⁷³ Unauthorised use of another's name resulting in injury to property, business or profession was however recognised as an actionable part of such a combined cause of action; for example, interference with pecuniary advantage.

Defamation

In *Tolley v Fry*,⁷⁴ the House of Lords expressly rejected the idea of tortious liability for appropriation of personality. It was confirmed that unauthorised use had to be linked with a cause of action in defamation. The conclusion can be drawn "that the Courts have not accepted that a property or any other right exists in a person's personality *per se*, so that no injunction will lie for the appropriation of personality unless the circumstances give rise to defamation or to injury to property, business or profession".⁷⁵

Given that no independent action lies for appropriation in English law, the most extensively used existing tortious liability is that of passing-off.

Passing-Off in its Classic Form

The classic action for passing-off protects trading goodwill in situations where a Defendant misrepresents the source of goods or services.⁷⁶ The classic action has been summarised to three requirements:⁷⁷

- (i) The Plaintiff must have a reputation;
- (ii) The Defendant must have made a misrepresentation; and
- (iii) There must be a likelihood of confusion.

The criteria of likelihood of confusion has given rise to the requirement of a "common field of activity" between the Plaintiff and the Defendant. The classic case cited in support of this doctrine is the early English authority of McCulloch v Lewis A May (Produce Distributors) Ltd.⁷⁸ This case involved the presenter of a childrens radio programme (by the radio-name of "Uncle Mac") and the Defendant's use of that name for a breakfast cereal. The defence that the marketing of the product did not interfere with the Plaintiff's field of activity was successful. The Plaintiff was not engaged in producing or marketing cereals. There was no likelihood of confusion between the goods of the two traders unless they were in a common and competing field. Therefore, although there was plain appropriation of the Plaintiff's name and personality for its commercial advantage, the Plaintiff suffered no property or financial damage.

Vocal Imitation

There is only one reported case in the English Courts concerning vocal imitation, that being the case of Sim v Heinz.⁷⁹ Similar statements to those in the McCulloch case

were made in that case. The case was an interlocutory application for an injunction against a television advertisement for Heinz products which deliberately imitated the distinctive voice of a well-known actor. The Plaintiff claimed that "in the case of a professional man like an actor, his reputation in the mind of the public, based upon his performances, is a right of property capable of invasion, just as the right of property contained in a particular kind of goods or method of get-up of goods".⁸⁰ The Court did not rule on whether an action in passing-off could be sustained for vocal imitation. However, McNair J. stated it would be "a grave defect in the law if it were possible for a party, for the purpose of commercial gain, to make use of the voice of another party without his consent".⁸¹ Due to the common field of activity requirement under the English law of passing-off however, it is likely that the actor would need to have been involved in the advertising industry.

The Common Field of Activity Requirement

An interesting analysis of the Midler case is how that fact situation would be treated under the UK law of passing-off.⁸² Damages are required to be proved in an action for passing-off, and there must be a misrepresentation causing injury to the goodwill of the Plaintiff. Therefore, the parties need to be engaged in activities that are closely connected so that the Plaintiff's goodwill is likely to suffer as a result of the misrepresentation. Midler would not succeed because she was not engaged in selling cars or advertising generally. However, if she had been involved in the business of trading her voice for advertising purposes, the imitation of her voice in the Ford advertisement would have reduced its value to her.

Nancy Sinatra's claim in passing-off was defeated for similar reasons. The Midler case referred to that case. The Court found that "there is no competition between Nancy Sinatra and Goodyear Tire Company. (Sinatra) is not in the tyre business and Goodyear is not selling phonographic records. There is no passing-off by the Defendant of the Plaintiff's product as its

own either by simulation of name, slogan, device or other unfair trade practice" (*Sinatra v Goodyear Tire Company*).⁸³

Recent statutory protection in the UK does not protect vocal imitation. Moral rights were introduced by the Copyright, Designs and Patents Act 1988. Section 84 of that Act gives a right to a person not to have a literary, dramatic, musical or artistic work falsely attributed to him as an author. However, this does not extend to the authorship of sound recordings.

The common field of activity requirement achieved the status of a "near doctrine"⁸⁴ in a series of character merchandising decisions in which protection was denied; *Wombles Ltd v Wombles Skips Ltd*,⁸⁵ *Walton J.* (licensing the Wombles characters and leasing rubbish skips); *Tavener Rutledge Ltd v Trexapalm Ltd*,⁸⁶ *Walton J.* (licensing of the Kojak television character and making lollipops). In the *Kojak* case the authorised licensee of Kojak lollipops was stopped by an unlicensed Plaintiff who had got into the market first. This case highlights the English Courts' approach to the free market, but fails to recognise the reality of licensing.⁸⁷ The Defendant had been authorised by the owner of the rights. The Defendant's claim that members of the public would assume the right to have use of the name had been given by the licensor to the Plaintiff, and the Plaintiff was taking advantage of the name and misrepresentation, was rejected by *Walton J.* He did so on the basis that the system of character merchandising was not sufficiently well-known to allow the public to make the necessary connection between the trader who sells merchandised goods and the rights of owners in the merchandised character itself. Although "unimpressed" by such a defence, he did continue:

"There may come a time when the system of character merchandising will have become so well known to the man in the street that immediately he sees "Kojakpops" he will say to himself: "They must have a licence from the person who owns the rights in the television series"". ⁸⁸

Walton J.'s prediction has been confirmed recently in the Teenage Mutant Ninja Turtles case⁸⁹ where such a basis for passing-off was upheld. This case is of significant development to English law in this area and is discussed further later in this paper.

Walton J., in the Kojak case, was prepared to accept⁹⁰ that the use of the name of a real person, as opposed to that of a fictional character, "does undoubtedly suggest or may suggest in proper circumstances an endorsement which may or may not exist".⁹¹

Real Personality

A claim for passing-off and unauthorised commercial exploitation of a pop group's attributes was unsuccessful in the case of Lyngstad v Anabas Products Ltd.⁹² That case involved the pop group "Abba". The Defendants marketed memorabilia including T-shirts imprinted with the image, name and logo of Abba. The Plaintiff claimed this created the impression that they licensed or endorsed the goods being sold. In the interlocutory case however, Oliver J. was not satisfied that a real possibility of confusion existed, or whether the public would draw the reasonable implication that approval had been given to the goods. There was no damage to the reputation of the group trading as a pop group. The pop group were not in the business of selling T-shirts; in other words, they were not trading in a common field of activity. Oliver J. said:

"The expression "common field of activity" is not, I think, a term of art, but merely a convenient shorthand term for indicating the need for a real possibility of confusion, which is the basis of the action. This necessity, the need to show that reasonable people might think that the Plaintiffs' activities were associated with the Defendants' goods or business, at least to the extent of implying some sort of approval on the part of the Plaintiffs, is something which might, I suppose, be said

to cause damage to the Plaintiffs', for instance, if the goods were defective in quality".⁹³

However, Oliver J.'s attempts to ratify the then recent decisions in the Wombles and Kojak cases by equating the common field of activity doctrine with a likelihood of confusion has been described as an uneasy reconciliation.⁹⁴

Oliver J.'s attitude that he did not believe the Defendants were "doing anything more than catering for a popular demand among teenagers for effigies of their idols" illustrates the English Courts' conservative approach to the free market, and against the monopoly provided by intellectual property rights.

The case illustrates a failure to provide for commercial reality particularly in relation to franchising and licensing.

Contrary to the observations in the Abba case, the Turtles case found the public did make a connection between a character and its "owner", so that the use of such a character on goods would lead the public to believe it was licensed, and therefore genuine. This amounted to a misrepresentation; the Plaintiffs' loss was not simply in royalties foregone, but in diminution of the character's image as a whole, if it became associated with inferior goods which, through being unlicensed, had no quality control exercised over them.⁹⁵ The Turtles case involved character merchandising and in future remains to be applied to personality or image merchandising. It is submitted the same direction of the law is applicable.

Extended Formulation of Passing-Off

While the classic formulation of passing-off protects trading goodwill in situations where a Defendant misrepresents the source of goods or services, its extended formulation protects promotional goodwill in situations where the Defendant misrepresents that goods or services have a particular association, quality, or endorsement.⁹⁶ The Leading House of Lords authority on the requirements of an action in

passing-off, the Advocaat case,⁹⁷ discusses the previous history of such actions and rationalises the increasingly liberal authorities. In doing so, Lord Diplock referred to the extended passing-off action. This is the modern leading case on passing-off. In the United Kingdom, it has recently been recognised as the overriding authority on passing-off without qualification by earlier cases.⁹⁸

In the Advocaat case, Lord Diplock specified five criteria for establishing passing-off:

- (i) a misrepresentation;
- (ii) made by a trader in the course of trade;
- (iii) to prospective customers of his, or ultimate consumers of goods or services supplied by him;
- (iv) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence); and
- (v) which causes actual damage to the business or goodwill of the Plaintiff, or will probably do so.

The extended action of passing-off has important ramifications in terms of protection of character merchandising. The first three elements of Lord Diplock's test are likely to be easily shown in cases of appropriation for commercial purposes, such as advertisements. The misrepresentation would be the inference that the products are recommended or associated with the person whose personality has been used.⁹⁹

However, the last two elements require the person whose personality is appropriated to be a "trader" in the sense that he or she has a business or goodwill capable of damage by the appropriation, that is, persons who have or are reasonably likely to have a business in the licensing of their personality for commercial purposes, such as stage and sporting

celebrities. Such use could clearly injure their business. The common field of activity requirement, would however limit secondary exploitation of a famous person's primary field of activity; for example, a sporting personality who did not also sell sportswear, would have no action.

Lord Diplock was concerned with limiting the scope of passing-off so as not to run the risk of hampering competition based on a "free market" approach to competition. However, His Lordship also referred to an extension of passing-off in circumstances where "the increasing recognition by Parliament of the need for more rigorous standards of commercial honesty"¹⁰⁰ was not overlooked.

Lord Diplock's five requirements for passing-off do not make specific reference to any requirement of a "common field of activity". A Plaintiff must show the Defendant's misrepresentation is calculated or will injure the goodwill of another "trader", and that it will cause actual or probable damage to the business or goodwill of the Plaintiff.¹⁰¹ However, there is no automatic application of a common field of activity and the significance of this was adopted by Falconer J. in Lego System A/S v Lego M Lemelstrich.¹⁰² The case suggested that a common field of activity was no longer of primary importance. That case did not involve appropriation of a celebrity's name or likeness. It concerned Lego (the manufacturer of childrens plastic toys) and the use of that name by the Defendants in the manufacture of plastic garden equipment. In granting an injunction, Falconer J. found a real risk that the public would believe a business connection existed between the parties despite being involved in substantially different areas. There was evidence that a number of people believed the Defendants' products were made by the Plaintiffs, or its subsidiary, or were licensed by it.

The Judge expressly recognised the limitation on Lego, by the Defendants' actions, to license or franchise its mark and expand into such an area. It would destroy the Plaintiffs' ability to do so pursuant to its goodwill to allow the

Defendants to continue, and the Plaintiffs would lose the ability to control their trademark.

This assumption of licensing or franchising on the evidence represents "a very clear recognition by a United Kingdom Court of the fact that goodwill can be and is known by the public to be exploited by licensing or franchising outside its immediate field of a trader".¹⁰³

This recognition of merchandising was also adapted by the High Court in the *Judge Dredd* case.¹⁰⁴ Goulding J. was prepared to accept that consumers would make the connection between a famous personality (in that case, a fictional character called "Judge Dredd") and merchandise bearing his name, being a record which referred to his character and related to his imaginary world of science fiction. Goulding J. stated:

"At the present time the public know something about the prevalent practice of character merchandising a substantial number of people will infer that the record has been authorised and approved by the Plaintiff".¹⁰⁵

Judge Dredd had been the subject of character merchandising agreements, but the Defendants had no licence from the Plaintiffs. There was a probability of confusion and likely misrepresentation,¹⁰⁶ but rather than grant an injunction, damages calculated on a royalty basis were considered an adequate remedy.

Similar assumptions that the public know something about character merchandising and that an inference would be made by the public as to the use of character marketing being authorised and approved by the Plaintiffs were made in *The Eastenders* case.¹⁰⁷

However, both cases were interlocutory and limited by the American *Cyanamid* requirements,¹⁰⁸ which are usually determinative of character merchandising cases due to the short commercial life of some characters and the inability of the

unsubstantial Defendant to give an undertaking as to damages or inadequacy of damages to compensate.¹⁰⁹

Development of the passing-off action to protect unauthorised image endorsement has therefore been hampered by the Courts' concentration on the procedural requirements of the American *Cyanamid* decision as most of the English caselaw is concerned with interlocutory decisions.¹¹⁰

These interlocutory cases may be encouraging recognition that character merchandising and licensing is a business, and that there may be misrepresentation involved in using character endorsements because the public will infer the Defendants' product has been authorised, approved or licensed.¹¹¹ However *Stringfellow v McCain Foods (GB) Ltd*¹¹² is the only major reported action that proceeded beyond interlocutory stage and went to trial, and that case restricted damages to actual damage indicating the need for a common business activity. The English Court of Appeal held that where the Plaintiff did not license the image of his business (a nightclub), he could not prove that he had suffered damage by simply showing survey evidence of confusion. The onus rested strongly on the Plaintiff to demonstrate evidence of confusion as well as actual damage suffered as a result of the Defendants' misrepresentation.

The English caselaw is therefore characterised by the clear principles of *Advocaat* and merchandising cases will be treated in the same way as other passing-off cases requiring misrepresentation and damage. Mere loss of the royalty or fee which a character could have charged for the use of his name is not regarded as sufficient proof of damage.

Right of Privacy

There is no right of privacy in the United Kingdom.¹¹³

In June 1990, the Calcutt Committee Report recommended no right of privacy. It looked at two categories of intrusion by the

Press into privacy:

- (i) physical intrusion by reporters and/or photographers; and
- (ii) publication of intrusive material.

In respect of a tort of infringement of privacy, the Committee did not feel that an overwhelming case had been made out for the introduction of such a tort.

A new self-regulating Committee was recommended in relation to the Press. This Committee was to investigate complaints of unjust or unfair treatment by newspapers or periodicals, and of unwarranted infringements of privacy through published material or in connection with the obtaining of such material.

Two months before the Calcutt Committee Report, the Court of Appeal found no cause of action for invasion of privacy in English law: *Kaye v Robertson*.¹¹⁴ The Plaintiff, Gordon Kaye, was a well-known actor from the television comedy series "'Allo 'Allo". He suffered head injuries when a piece of wood smashed through the windscreen of his car during a storm. He had been on a life-support machine, and in intensive care but was recovering in a private room in a Hospital. A journalist and photographer from the 'Sunday Sports' newspaper entered his Hospital room, despite notices on the Ward door to the contrary, took several photographs, and also managed to interview him.

Because there is no right of action in English law for breach of privacy, the Plaintiff brought the action under the heads of libel, malicious falsehood, trespass to the person and passing-off.

The Plaintiff based his case largely on libel, relying on the Leading House of Lords' decision in *Tolley v Fry*.¹¹⁵ That case involved a famous golfer and an advertisement for chocolate. It made a comparison of the excellence of the

chocolate with Mr Tolley's drive. The Plaintiff succeeded in his claim for libel because there was found to be an implication that he was being paid for use of his image in the advertisement when he was an amateur golfer. This lowered him in the minds of the public and consequently defamed him. The Defendants had made unauthorised use of his image.

Limit on Cause of Action in Defamation

Defamation is a possible but highly uncertain cause of action in this area.¹¹⁶ Protection is limited in that it does not provide for a celebrity who licenses the use of his or her name because unauthorised use of that likeness or name is unlikely to lower his or her reputation in the eyes of the public. Further, the Courts will not grant an interim injunction to restrain a libel when the issues are the live issues for a final determination such as whether or not there has been libel, whether it is justified, or whether the words are capable of a defamatory meaning.¹¹⁷

In the Kaye case, an injunction could not be based on libel. Whilst libel was arguable and probable, it was not inevitable.

Malicious Falsehood

It was argued by the Defendants that the Plaintiff had agreed to the interview and photographs. However, medical evidence showed he was incapable of giving his consent. The Court did grant limited interlocutory relief based on malicious falsehood because the Defendants intended to publish words to the effect that the Plaintiff consented to the interview and photographs, and that was not the case.

The most important feature of the proposed article was the implication that the Plaintiff had consented to be interviewed and photographed.¹¹⁸

The Court of Appeal allowed publication on the condition that the readers were told that the Defendants had acted without the

Plaintiff's permission.

Passing-Off

The Plaintiff was unsuccessful in his claim for passing-off. He was not in the trade whereby he would sell the story about his accident. Therefore, he failed to satisfy the requirements of the Advocaat case. Yet, the cause of action in malicious falsehood included the element of special damages as a direct and natural result of publication. These special damages were for the loss of opportunity for the Plaintiff to sell the story of his accident, and to such publication as he chooses.

While the Court of Appeal held there was no right of action for breach of privacy, the Court strongly disapproved of the way in which the Defendants had obtained the interview and alerted Parliament to the need to introduce legislation to protect privacy of individuals. Bingham L.J. commented on the failure of both the common law and statutory law of England to protect privacies:

"If ever a person had a right to be left alone by strangers with no public interest to pursue, it must surely be when he lay in Hospital recovering from brain surgery and in no more than partial command of his faculties".

In the United Kingdom, the Younger Committee on Privacy,¹¹⁹ noted that the right of privacy should not be equated with an unqualified "right to be let alone" because it is inconsistent with the notion of a society in which people interrelate .

Lord Justice Glidwell stated:

"The facts of the present case are a graphic illustration of the desirability of Parliament considering whether and in what circumstances statutory provision can be made to protect the privacy of individuals".

The Calcutt Committee Report however, failed to be persuaded of an overwhelming need to introduce a tort of infringement of privacy.

In the result, the article and photographs were still published despite Mr Kaye's wishes, and the Court of Appeal wishing to help him. Some answers have been suggested to prevent the 'Sunday Sport' reaping of its ill-gotten gains.¹²⁰

In terms of remedy, the Hospital would have an action in trespass and could be joined as a co-Plaintiff. However, damages may be difficult to quantify.

The Court still has an ancillary equitable jurisdiction to prevent wrongdoers retaining the fruits of their wrongdoings. This is recognised in the United States where it is also related to a Plaintiff's loss of commercial opportunity; that is, unjust enrichment.

The Press made use of Mr Kaye's public image in order to boost their sales. It is likely the Press were anxious to publish the story because of Mr Kaye's notoriety as a 'star' of a popular television comedy show. It is unlikely to have been as an effective marketing technique had Mr Kaye been an infamous person or ordinary member of the public.

Frazer,¹²¹ concludes "that English law, as presently expressed, is incapable of regulating appropriation of personality except in some tangential way". Although the Courts have expressed a dislike of the practice, the common law has not yet developed to regulate it. However, the *Turtle* case discussed later, makes a significant break-through in this area of English law.

The *Kaye* case illustrates the conflict between freedom of the Press and the right to control one's own image. There is the news aspect in respect of a famous actor being involved in an accident. There is also the point that his notoriety was established through the media in the first instance, and

therefore he has lost any right of privacy. However, an important point emphasised in the case was the unauthorised use. Mr Kaye has certain publicity rights due to the time and money expended by him as an actor to establish his reputation. This case illustrates the overlap between privacy and publicity law.

Members of the public in New Zealand have come to accept and expect freedom of speech, the Press and the public's 'right to know' as part of a democratic society.¹²² An example of statutory recognition of this is the Official Information Act. There is however law limiting this principle, such as the laws of defamation, passing off and certain state secrets.

New Zealand is lacking any substantial common law right of privacy and in 1984 a report on privacy was prepared.¹²³ A Privacy of Information Bill is currently before a Parliamentary Select Committee.

However, the 1986 *Tucker* decisions,¹²⁴ sow the seeds for a tort of invasion of privacy in New Zealand (1989) 7 *Otago Law Review* 31 at 32, Laster: "Breaches of Confidence and of Privacy by Mis-use of Personal Information".

Involuntarily Notorious

Tucker was to be the first heart transplant patient to be operated on in New Zealand. This involved much publicity and political debate resulting in the cancellation of the operation taking place in New Zealand. A public campaign raised funds to pay for the transplant to take place in Australia. This again involved much publicity and the fund-raising placed Tucker in the public eye. Just before the Australian operation was confirmed, a reporter discovered that Tucker had prior convictions.

Tucker sought and obtained an interim injunction against Newsmedia preventing it from publishing any information about his prior convictions.

Tucker claimed relief on the basis of the tort of intentional infliction of distress and alternatively, the tort of invasion of privacy. A serious question to be tried was established on both claims in the High Court and the interim injunction was granted. Jeffries J. recognised the right of a person living an ordinary private life to be left alone without being subjected to unwarranted, or undesired, publicity or public disclosure. In Mr Tucker's case, it was not to be expected that a very serious heart condition would bring about such publicity.

His Honour recognised that such an action, unlike defamation, is not injury to character or reputation, but to one's feelings and peace of mind. It concerned unwarranted publication of intimate details of the Plaintiff's private life outside the realm of legitimate public concern. It is therefore, no defence to a person's right of privacy, that the publication is correct or published without malice.

Jeffries J. went on to state:

"In my view the right to privacy in the circumstances before the Court may provide the Plaintiff with a valid cause of action in this country. It seems a natural progression of the tort of intentional infliction of emotional distress and in accordance with the renowned ability of the common law to provide a remedy for a wrong".

The Court of Appeal dismissed Newsmedia's appeal as there were "seriously arguable questions". Cooke P. quoted from *Salmond & Heuston on Torts* on the invasion of privacy as an "emergent tort".

On the Defendants' application to discharge the injunction, McGechan J. did discharge it for the primary reason that the prior indecency convictions had been published in an Australian newspaper and on two New Zealand radio stations, thereby substantially changing the circumstances since the rulings of Jeffries J. and the Court of Appeal.

McGechan J. did find a serious question to be tried as in the previous decisions, and went further in recognising the invasion of privacy at least in respect of public disclosure of private facts. Further, the legislature had already recognised this in terms of the Human Rights Commission Act 1977 and the Wanganui Computer Centre Act 1976, as examples.

AUSTRALIAN LAW

Australian law has developed away from the conservative English Courts' approach in the Advocaat case. In Hogan v Koala Dundee Pty. Ltd.,¹²⁵ Pincus J. referred to protection of images in the United Kingdom as "embryonic".

No Common Field of Activity

The High Court in Moorgate Tobacco Ltd v Philip Morris Ltd.,¹²⁶ specifically rejected the existence of any general tort of unfair trading or unfair competition. However, the Court did approve the development of the tort of passing-off to meet new circumstances requiring protection. One such area requiring protection is the unauthorised use of images to endorse a product for marketing purposes.

Recognition that the classic action for passing-off was not in line with commercial reality with respect to image merchandising was established in 1960 in Henderson v Radiocorp Pty. Ltd.¹²⁷ The Court expressly recognised the reality of professional endorsement. It was established that no common field of activity was required and the Court specifically rejected McCulloch v May. The case involved two professional ballroom dancers who successfully sued the Defendant for depicting the Plaintiffs on their dance record cover. There was no common field of activity between recording and dancing but this was not necessary. The High Court found use of the photographs amounted to passing-off. The Defendant used the business or professional reputation and likeness of the Plaintiffs and wrongfully represented the Plaintiffs'

recommendation of the Defendants' record. This amounted to damage since it misappropriated fees or royalties. The main requirement was to prove deception and damages without requiring a further element as to common field of activity. Evatt C.J. summarises passing-off as follows:

"In our view, once it is proved that A is falsely representing his goods as the goods of B, or his business to be the same as or connected with the business of B, the wrong of passing-off has been established and B is entitled to relief".¹²⁸

The Plaintiffs were entitled to damages, although not an injunction. The High Court in the Henderson case, when discussing that no common field of activity was required, found that passing-off necessarily existed only where the parties were engaged in business in its widest sense, thereby rendering the common field of activity test redundant.

Representation as to Licensing Arrangement

A major part of business income may be derived from royalties received from the licensing of "spin-off" businesses or goodwill. Loss of royalties due to unlicensed use causes damage, as does the association of goods of inferior quality by discouraging potential licensees and deterring consumers. Many licences contain clauses allowing the originator to control the quality of merchandise.

The various businesses of licensees are usually far removed from that of the originator and therefore difficulties arise in establishing a misrepresentation that the Defendant's goods are connected to the originator.

The general tenor of Australian law,¹²⁹ is to accept a misrepresentation in terms of a link between the character or image and the product endorsed pursuant to some licensing agreement.

In the Woolworths case (Childrens Television Workshop Inc. v Woolworths (NSW) Ltd),¹³⁰ Helsham C.J. held that the mere presence of unlicensed goods at the same marketplace as those produced by the Plaintiffs, together with the deception as to their authenticity, led to the inference that the Plaintiffs' business was bound to be adversely affected.

An injunction was granted preventing the sale by the Defendants of "Muppet" character puppets on the basis that there was an association in the minds of the public between the reputation of the Plaintiff producers of the show "Sesame Street", and the replicas of its characters. In that case, the Plaintiffs and Defendants were regarded as being in the same field of activity in that the Childrens Television Workshop was in the business of marketing and selling its character reproductions and it was irrelevant that this was done pursuant to licensing arrangements.

Similarly, the fact that the pop group 'INXS',¹³¹ were involved in licensing arrangements with respect to the use of their image on T-shirts as part of the spin-off of their singing business was irrelevant. What was important, was the association in the minds of the public that they approved of the Defendants' T-shirts as they contained various of the INXS marks, and almost exactly copied the approved merchandise. The Court held that the public was likely to assume the merchandise sold by the Defendants' was approved by the Group in return for a royalty.

The affect on the public is an important aspect in these cases, as in the United States. In the INXS case, the relevant cross-section of the public affected by the association in their minds, was found to be teenagers or people in their 20's, but also represented a fair cross-section of the community. This case discusses the popularity of the Group, as the US Court also found to be an important element in the Midler case. INXS had won seven awards including one voted from within the rock industry and one voted by the public. "The success of INXS has generated, and no doubt in turn has been

further stimulated by, considerable media publicity"¹³². The Group planned a world tour in 1985 and had played to an audience of more than 129,000 in its Australian tour of that year. This was the relevant time when the Defendants' "Bootleg" T-shirts were being sold.

A similar Australian case not referred to in the INXS case, is that concerning Bruce Springsteen¹³³ the year before. This case also involved a 1985 Australian tour by the popular American rock star Bruce Springsteen. His popularity had been likened to that of Elvis Presley and his audience reaction to that of "Beatlemania", with considerable newsmedia coverage. His album "Born in the USA", sold in excess of eight million copies in the twelve months prior to the tour, which sales record placed him in the top five performers throughout the world.¹³⁴

Again, merchandising licences had been granted providing a massive business in itself. One newspaper¹³⁵ reported more than \$100,000.00 was spent in one day on Bruce Springsteen T-shirts, programmes and other merchandise.

It was also a case where unauthorised traders produced T-shirts at a corresponding time to an Australian tour in order to take advantage of the popularity generated.

Bruce Springsteen, and a licensed merchandising company who had paid to use his image and identity, sought injunctions against the unauthorised selling of T-shirts bearing his name, or words from his songs.

Part of the claim had been that the Respondents undercut the licensee company by selling cheaper and lower quality merchandise, and by not having paid for the rights in the first instance. This low quality product led to damage to the singer's goodwill. Mention was also made of reaping without sowing; that is, taking advantage without any expenditure or effort. The proceedings were brought under passing-off and the Trade Practices Act.

Interlocutory relief was granted and the proceeding went no further.

In *Fido Dido Inc. v Venture Stores*,¹³⁶ M L Foster J. emphasised the "state of knowledge in the buying public". That is, a sufficient link was found where there was an awareness that the characters would have been created by someone who would have had a business interest in putting them onto the market. The public need not necessarily know that person's precise identity. That case concerned characters created solely for the purpose of aiding sales of products, as opposed to a "spin-off" business.

Limitations on the Australian Action for Passing-Off

The value attributed to a celebrity is going to be dependant on the established reputation of that celebrity. Consequently, damage to reputation will also vary accordingly. A sufficient reputation needs to be established before eligibility for protection: *Honey v Australian Airlines*.¹³⁷

Therefore, the appropriate cross-section of the public representing the state of knowledge of the public, is significant.

In *10th Cantanae and Others v Shoshana Pty. Ltd and Another*,¹³⁸ a well-known television personality, Sue Smith (a not unusual name), failed to show that a sufficient segment of the public would draw an association between a young woman only slightly resembling the celebrity, as a reference to her. This was despite the statement "Sue Smith just took total control of her video recording". Pincus J. stated:

"It should not be too readily accepted that the mere mention of a name in an advertisement necessarily connotes that the goods advertised have any characteristic - for example that they have been approved, or even examined, by the person named".¹³⁹

This tends to imply that more than a mere association is required, rather than apparent approval, of the quality of a product. Therefore the use of an image in association with a product, coincidentally, is simply not enough.

Similarly, there was an insufficient link in the Honey v Australian Airlines Ltd case. In that case, Honey (a well-known long jumper) failed in an action for passing-off. Australian Airlines produced a poster with a photograph of Honey in action, without his permission. The test of representation in the minds of the public as to a licensing arrangement was not satisfied because Honey had not demonstrated that a significant number of people seeing the poster, would conclude that he had endorsed Australian Airlines. A mere association was insufficient and an additional element was required. It was held that most people would not infer from the circumstances and the look of the advertisement, that it represented approval by the celebrity. The onus rests on the Plaintiff to prove a significant segment of the public would make an association.

It has been suggested,¹⁴⁰ that the activities of professional entertainers or sportsmen are considerably easier to protect than amateur entertainers or sportsmen on the basis of Honey v Australian Airlines Ltd. This is on the basis that the representations still need to create an impression of endorsement or approval.

Attention Attracting Value

In Olivia Newton-John v Scholl Plough (Australia) Ltd,¹⁴¹ an advertisement appeared in a magazine advertising "Maybelline" make-up products. It pictured an image of a woman look-a-like of Olivia Newton-John and stated "Olivia ? - No Maybelline !". She brought an action in the Federal Court of Australia pursuant to the Trade Practices Act for misleading and deceptive conduct pursuant to Section 52, and unauthorised endorsement pursuant to Section 53. Although it was not actually Olivia, the Court found the woman had a considerable

resemblance to her.

However, the Court found the association with Olivia did not go far enough to protect her. The disclaimer stating that in fact it was not Olivia Newton-John, in the Court's view, made it perfectly clear that the product did not have any relevant association with the Applicant. This was despite the finding of a clear inference that there had been appropriation of the appearance of the Applicant and that the advertiser had made use of her reputation to the extent of gaining attention. To this end, advantage was taken of her name and reputation built up in the entertainment world over the years.

The desired effect of character merchandising was achieved; that is, attention was drawn to the product by using Olivia's image thereby making the product more attractive.

The case does not specifically address the issue of the value obtained by the Respondents in using the image for attracting attention. The Midler case turned to that issue as opposed to any requirement of damage to the Plaintiff.

It was found by the US Court of Appeal, that a voice is a distinctive and personal attribute, and as distinctive and personal as a face. Neither the name nor a photograph of Midler was used in the commercial, but to impersonate her voice was to pirate her identity. In Australia, the same principles did not apply to a look-a-like of Olivia Newton-John.

It is submitted that the use of Olivia's face was the attractive value or "grab" value which is partially the purpose of image advertising. This was referred to in the later case Hogan v Koala Dundee Pty. Ltd¹⁴² where Pincus J. stated¹⁴³ in respect of association:

"The personality or the character used to promote a product is intended to assist the promotor in jolting the minds of those viewing the advertisement to a happy or memorable association, so that the product gets the

"rub-off" associated with the personality or character".

In contrast to the adequacy of the disclaimer in the Maybelline advertisement, the earlier case of INXS did not regard the disclaimer to be sufficient. In the Olivia Newton-John case, the Court disposed of the INXS case in one sentence:

"I accept the proposition in that decision, but I think this case is one where the connection has been negated".¹⁴⁴

The proposition the Court was referring to was the necessity, where a reputation is taken advantage of, for the Respondent to show clearly that any connection has been negated.

Defence of Disclaimer

In the INXS case, the defence of disclaimer failed. The Respondent tried to argue that a small sign stating that the T-shirts were genuine "Bootleg" products which had not been authorised, and the inclusion of a label or adhesive sticker containing the words "The manufacturer does not warrant the depiction hereon has been authorised", was enough to prevent purchasers being deceived. However, the sign was small and it was not always there. The labels were underneath a larger manufacturing label and unlikely to have been seen before purchase. "Those cases where the effect of otherwise misleading or deceptive conduct may be neutralised by an appropriate disclaimer are likely to be comparatively rare". Further, there was no evidence that the public was familiar with the word "Bootleg". It would be quite "a brave assumption that the meaning of the words such as "warrant", "depiction", and "authorised" would be readily appreciated by all but an insignificant proportion of potential T-shirt buyers". This statement was made in relation to the defence of disclaimer. It is interesting to note that these people were a relevant cross-section of the public making an association between the parties, for the purpose of passing-off and misleading and deceptive conduct pursuant to the Trade

Practices Act.

The extension of the tort of passing-off beyond a common field of activity to where the relationship between the parties is not between competitors in the same field of commerce, has necessitated certain adaptations and limitations as illustrated by the *Olivia Newton-John*, *Honey* and *Sue Smith* cases, all of which failed.¹⁴⁵

The test seems to be heading towards a requirement that a reasonably significant number of people should infer from the advertisement that the celebrity had some willing association with the product concerned. It is a flexible test which seeks the balance between use, where an element of approval is present, and merely informative, incidental or the skit-style use of an aspect of the image (including the name).¹⁴⁶

Trade Practices Act 1974

As well as the extended tort of passing-off, Section 52 of the Australian Trade Practices Act 1974 ("TPA") is increasingly relevant.¹⁴⁷ That section states:

"A corporation shall not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive".

Cases concerning passing-off have been used to interpret Section 52 but do not appear to add anything to the action for passing-off, which has been used more comprehensively and for a longer time.

The New Zealand Fair Trading Act 1986 ("FTA") is modelled closely on the TPA. Section 9 of the FTA is the equivalent provision relating to misleading and deceptive conduct. New Zealand case law draws heavily on the Australian precedents.

*Caenegem*¹⁴⁸ states an advantage of use of the TPA is that there is no need to prove damage nor the existence of a

reputation to achieve injunctive relief, making the test lighter than passing-off.

However, the Crocodile Dundee cases,¹⁴⁹ discussed later, also indicate there is no need to prove damage pursuant to the extended action of passing-off.

Section 53(c) of the TPA is even more specific in relation to this area of law in that:

"A corporation shall not, in trade or commerce, represent that goods or services have sponsorship, approval, performance or affiliation that it does not have".

Although this would seem to cover misrepresentation that a celebrity has approved of a product, passing-off is the more common claim and if the elements of passing-off are made out, it would be unnecessary to bring an action pursuant to this section. Further, Section 53 attracts criminal penalties. It has also mainly be used in relation to corporations which falsely present themselves as having the approval of a standards authority or board. Section 13(e) of the FTA is the New Zealand equivalent to Section 53(c) of the TPA.

However, the proceedings in the Bruce Springsteen, INXS and Olivia Newton-John cases, were brought not only pursuant to actions in passing-off, but also under Sections 52 and 53 of the Trade Practices Act.

The Court in the INXS case, found there was considerable overlap between all three claims.

It is interesting that the Australian Court at first instance, in Hogan v Pacific Dunlop Ltd, refers to the United States' cases concerning the similar provision in the Lanham Act, as directly relevant in the interpretation of the Australian trade practice provisions.

Section 52 - TPA - Misleading/Deceptive Conduct

Pursuant to Section 52 of the TPA, there was a real, and not a remote, chance or possibility of misleading or deceptive conduct on an objective test. The Respondents adopted the name and other symbols of the Applicant for the purposes of marketing their own merchandise which was almost an exact replica of the INXS licensee's merchandise. There was implied approval and likelihood of deceit. The Court referred to the evidence of the impression given by a picture, word or appearance on the instinct or judgement of rival traders as not to be lightly rejected in assessing likelihood of deceit.

Although the genuine article was sold at concerts, as opposed to the Bootleg's being sold at "Paddy's Market" in Sydney, the Court considered confusion would still arise in satisfaction of Section 52.

Section 53 - TPA - Sponsorship/Approval

The Court found that many members of the public would assume an approval, in return for a financial benefit but this was not necessary on the basis of *Nostac Enterprises Pty. Ltd v New Concept Import Services Pty. Ltd.*¹⁵⁰ There was no evidence in that case that the public would assume a financial association. However, an injunction was granted because the use of "Mr Men" characters and words, represented some likely association between the product and the Mr Men books and television series. The inference of approval just made out a stronger case.

Consequently, there was found to be representation that the T-shirts were produced with the approval of the Group pursuant to Sections 52 and 53(c) and further, a false representation that the goods had sponsorship or approval contrary to Section 53(c) of the TPA.

Murumba¹⁵¹ indicates that although the *Springsteen* cases do not go beyond the interlocutory stage, judicial willingness to

recognise the possibility of Section 53 applying to unauthorised commercial appropriation of personality, likeness and reputation was apparent.

The Hogan v Koala Dundee Pty. Ltd case found liability in respect of passing-off, and therefore it was not necessary to consider the Section 52 TPA claim.

The later Crocodile Dundee case¹⁵² found passing-off and breach of Section 52 of the TPA, but the alleged breach of Sections 53(c) and (d) required establishing the commission of misdemeanour which had not been satisfied.

The Crocodile Dundee cases are of significant authority in this area of law which has become more litigious over recent years.

In Australia, eight Federal Court cases involving character merchandising had been reported between 1986 and June 1990 (Terry, p.220) in the Australian Trade Practices Reports.

The Crocodile Dundee cases involved Paul Hogan, the star of the Crocodile Dundee series of films. The first case¹⁵³ concerned use of the term "Dundee Country". The store at Surfers Paradise had made extensive use on its goods, and outside the shop, of a koala bear character wearing the Crocodile Dundee hat and sleeveless vest. The word "Dundee" was also prominently and repeatedly displayed. The Defendants did so in order to "cash in" on the film by using the images from it. This was held to constitute passing-off and infringement of Section 52 of the TPA.

In that case, Pincus J. described the Henderson case as going some distance to cover misappropriation. The Koala Dundee case rejected the standard Advocaat approach to passing-off in relation to character merchandising and found no representation was required as to the producer of goods. The Advocaat doctrine has thus been discredited in the Australian decision.

Pincus J. accepted the Respondents had intended to take advantage of the likelihood that people who went to the Respondents' shops and saw the name "Dundee Country" and the koala images would immediately be reminded of the films, but stated that:

"It cannot be held that the public had been led to think that there is a precisely known kind of commercial connection with Paul Hogan or the film".¹⁵⁴

No Business At All

The Court in the *Koala Dundee* decision went even further than the extended formula of passing-off, which protects promotional goodwill against misrepresentation of a particular association or quality likely to injure business. The case was based on the use of images which say nothing about the origin or history of goods and services. Pincus J. found a passing-off suit could be brought in respect of an image unconnected with any business at all. Liability was based on the misrepresentation of association with image, without authority. This appears contrary to the *Henderson* requirement of carrying on business, and *Bloustein's* proposal that unauthorised image endorsement is only illegal in the commercial context.

In terms of protection in Australia, the right to use a personality or character will be protected if there has been a clear and deliberate use.¹⁵⁵

The Court held that the deliberate (but not innocent or accidental) and wrongful misappropriation of a reputation or image belonging to the Plaintiffs, was actionable under the extended passing-off action developed in the *Henderson* case. Pincus J. stated:

"The case was argued before me on behalf of the Applicants on the assumption that it is possible to bring a passing-off suit in respect of an image, including a name, unconnected with any business at all. That assumption

appears to me correct. I think the law now is, at least in Australia, that the inventor of a sufficiently famous fictional character having certain visual or other traits may prevent others using a character to sell the goods and may assign the rights so as to use the character. Furthermore, the inventor may do these things even where he has never carried on any business at all, other than the writing or making of the work in which the character appears".¹⁵⁶

Far reaching consequences may result from an extended passing-off action in Australia. If the Plaintiff is not in business, then it has been suggested that he cannot suffer loss by diversion of sales, or suffer loss as a result of the Defendant's action where the Plaintiff has never previously licensed his image.¹⁵⁷ It means that actual damage may not exist or may be negligible if based on a notional licence fee, in respect of the image, or the diminution of his reputation. It leaves open the potential for a Plaintiff to recover the unjust enrichment acquired by the Defendant. This is in line with the United States' law in this area. Unjust enrichment may be seen as the wrongful appropriation of property. *Hull* suggests that protection of images in this way may arguably have taken matters too far.¹⁵⁸ *Burley* also suggests that it is taking the doctrine one step too far by saying that the Plaintiff need never have traded and therefore seemingly moving away from goodwill. This is because allowing a claim in unjust enrichment, conflicts with free marketing and monopolises an idea not yet exploited by the Plaintiff.

Representation as to Licensing Arrangements

Pincus J. in the *Koala Dundee* case rejected the standard approach to misrepresentation in passing-off in respect to character or image merchandising. His Honour found a degree of artificiality in the finding of a misrepresentation as to misleading the public about licensing arrangements:

"In practise, the ideas of the buying public as to licensing arrangements are very much in the back of their minds and necessarily vague and inaccurate. They have no reason to be interested in the question of licensing. Unlike a representation as to the origin or quality of goods, use of mere images in advertising, although presumably effective to generate sales, does not necessarily do so by creating, or relying on, any specific conclusions in the minds of the buying public".¹⁵⁹

What was important was a representation of association with the film's images without authority.

Paul Hogan was equally successful in protecting his image in *Hogan v Pacific Dunlop Ltd*.¹⁶⁰ This case concerned an advertisement for a shoe company, which was based on the famous knife scene from *Crocodile Dundee I*. The central actor in the advertisement only had a slight physical resemblance to Hogan, but was wearing all the characteristic "Dundee" clothing such as the hat, band of teeth, and leather sleeveless vest.

Instead of using the famous phrase "you call that a knife?", the actor in the advertisement stated "you call those leather shoes? Now these are leather shoes - they're Grosby leather, soft, comfortable, action-packed leather".

The advertisement was really a skit or parody of the famous knife scene in the film. However, *Gummow J.* upheld an action in passing-off, and under Section 52 of the TPA. In relation to passing-off, the action:

"is concerned with misrepresentation, and with a particular type of misrepresentation involving use of the image or indicium in question to convey a representation of a commercial connection between the Plaintiff and the goods or services of the Defendant, which connection does not exist In each case, the damage to the goodwill of the Plaintiff is actionable only because of apprehended or actual disception of the relevant section of the public by

the Defendant's conduct".¹⁶¹

The Federal Court of Appeal upheld Gummow J's decision on appeal and found that the cause of action in passing-off occurs as soon as the relevant misrepresentation is made "even though no actual disception and damage to the Plaintiff can be shown to have resulted from it".¹⁶² The essence of the action was whether a significant section of the public would be misled into believing, contrary to the facts, that a "commercial arrangement" had been concluded between the Plaintiffs and the Defendants which would permit the Defendants to apply the Plaintiffs' distinctive image to its products or marketing campaign.

Representation as to Licensing Arrangements

Burchett J. observed:

"To ask whether the consumer reasons that Mr Hogan authorised the advertisement is to ask a question which is a mere side issue, and far from the full impact of the advertisement. The consumer is moved by a desire to wear something belonging in some sense to Crocodile Dundee (who is perceived as a persona, almost as an avatar of Mr Hogan) The whole importance of character merchandising is the creation of an association of the product with the character; not the making of precise representations".¹⁶³

It appears therefore, that the Australian tort of passing-off in this area will require a commercial connection between the Plaintiffs' image or character and the goods or services of the Defendants in the minds of the public.

These recent applications of the law of passing-off to character merchandising may also raise doubts as to the link between what is being protected, and the ultimate use. In the Crocodile Dundee cases, there was no attempt to associate the product with an actual picture or voice of the personality. A

typical phrase was adopted and the attributes of Crocodile Dundee created an association in the minds of the buying public. Similarly, in *Carson v Here's Johnny Portable Toilets*,¹⁶⁴ a typical phrase "Here's Johnny" on the walls of portable toilets associated them with a well-known phrase used to announce Carson's television show. The phrase was Carson's trademark. The right of publicity gave Carson the exclusive right to use his own name and personality in the promotion of products. It had been appropriated to the Defendants' commercial advantage despite Carson's name not being explicitly used. Therefore, the links between the actor or public personality and the representation, are fairly tenuous. It is the association with the actor's public-acquired image which is important.¹⁶⁵

The Australian cases illustrate the protection provided by the extended action for passing-off to celebrities whose name, likeness or image is employed to enhance sales of products without their consent. The protection of image is extended to include virtually any characteristic recalling the celebrity in the minds of a sufficient number of consumers.

In this sense, compared with their English counterparts, the Australian Courts have been more realistic about the commercial aspect of character merchandising, and in their development of protection of a reputation in a real or fictional character.

RECENT UK DEVELOPMENTS

The recent *Teenage Mutant Ninja Turtles* case indicates that the United Kingdom could be starting a trend to follow the Australian law and a consequent decline in the common field of activity requirement.

The *Turtles* case involved the merchandising of drawn characters, and therefore copyright issues. Its application of the extended action of passing-off remains to be applied to future cases of image and personality merchandising.

That case involved the teenage mutant hero turtles of considerable fame and popularity. Over 150 merchandising licences had been granted in the United Kingdom in respect of various merchandise.

The Plaintiffs brought an application for an interlocutory injunction. The Court recognised that in effect, granting the injunction would bring the matter to an end because the Defendants would go out of business and could not afford to take the case to trial. Therefore, Browne-Wilkinson VC assessed the strength of the Plaintiffs' case and not simply the issue of an arguable case.

The Defendants did not attempt to replicate the genuine turtle articles. They produced turtles of a human-like resemblance which unwittingly resembled the genuine turtles, but used less imaginative names. These images were imprinted on clothing.

The Court found the Plaintiffs were in the business of licensing their image (the teenage mutant ninja turtle), and the Defendants' use of imitation turtles caused the Plaintiffs actual damage in the form of lost royalties and loss of control over the quality of the licensed goods.

Representation as to Licensing Arrangement

A crucial distinction was made with previous English authority in that the Court accepted that the public do make an association between the appearance of a character and a licence authorising its appearance. There was critical evidence as to the public making a link between a character and its owner. In this regard, Browne-Wilkinson, VC held that:

"The law as developed in Australia is sound. There is no reason why a remedy in passing-off should be limited to those who market or sell the goods themselves. If the public is misled in a relevant way as to a feature or quality of the goods as sold, that is sufficient to find a cause of action in passing-off brought by those people

with whom the public associate that feature or that quality which has been misrepresented".¹⁶⁶

In approving the Australian law, the classical form of passing-off referred to in the Advocaat case was ostensibly expanded. The Judge did so by following Childrens Television Workshop Inc. v Woolworths (NSW) Ltd (the Muppet case) and Fido Dido Inc. v Venture Stores (Retailers) Pty Ltd¹⁶⁷ in preference to the English Wombles, Kojak and Abba cases.

Common Field of Activity

The Vice-Chancellor however, while approving the Australian authorities prior to the Crocodile Dundee cases, made the point of adhering to the Advocaat criteria, but added two additional factors to the finding of a mere representation:

- (i) The Plaintiff was in the business of licensing the turtles' image and was recognised by the public as doing so; and
- (ii) The Plaintiff had suffered actual damage and could show this would continue in the form of lost royalties and loss of control over the quality of licensed goods if the Defendant continued marketing its turtles.

Although the case extends the existing law by stating that non-traders or manufacturers may now sue in passing-off where they are in the business of granting merchandising licences, the Court still expressly based its decision on the "classical" form as purpounded by Lord Diplock, despite the express approval of the development of the Australian law of passing-off.

English law is therefore, still significantly more restricted than Australian law in two ways:

- (i) The English cases continue to rely on the notion of "goodwill" as opposed to "reputation" as the property protected by passing-off; and
- (ii) Whereas actual or potential damage to the Plaintiff by misappropriation of his goodwill remains an essential element of the English tort, in Australia a relevant misrepresentation as to a commercial connection between the image-owner and the Defendant will constitute the tort, and an additional requirement of actual or foreseeable damage is not essential.¹⁶⁸

It is significant that despite Counsel for the Defendant referring to the Wombles, Kojak and Abba cases, it was readily conceded that the common field of activity doctrine was "discredited" and could not be relied on simpliciter. The case therefore confirms the similarity between English and Australian law in this respect.¹⁶⁹

In the Hogan v Koala Dundee case, Pincus J. had regarded the results of decisions in the United Kingdom as "showing clearly enough that protection of images simpliciter is but embryonic there".¹⁷⁰

The decision in the Turtles case endorses acceptance that the public recognises the rights of an owner of a popular fictional character to license and protect its image, thereby extending the parameters of misrepresentation. This provides an important link between the originator of a character or image and the licensee, whereby a misrepresentation can be shown.¹⁷¹ However, the public do not necessarily turn their minds to the use of an image pursuant to a licensing arrangement.¹⁷²

The misrepresentation in the case may be described as the public's mistaken belief that the Defendants' goods were the 'genuine' article. This led to the implication that they were licensed.

In the result, the decision provides the most advanced protection for licensing, manufacture and trading in character merchandise in England. It also confirms the basis of the common field of activity test and combines its relevance to the degree of confusion.

It remains to be seen whether English Courts will parallel the Australian law, especially in the realm of real, as opposed to fictional, characters.¹⁷³

CANADIAN LAW

The Canadian Courts recognise a common law cause of action of appropriation of personality.

This is protection against the misappropriation of photographs and the likenesses of sportsmen and celebrities.

The base from which this cause of action arises is the case of *Krouse v Chrysler Canada Ltd.*¹⁷⁴ The case concerned a famous sports celebrity, Krouse. The Defendants, a car manufacturer, distributed a "spotter" which identified the names and numbers of professional football players to assist television viewers to identify the players. It featured an action photograph of Krouse in a football game, who was easily identifiable by the number on his uniform. Krouse had not consented to such use of the photograph. The spotter also advertised the Defendants' cars.

The Court of Appeal found no cause of action in passing-off because there was no common field of business activity. There was no possibility of confusion that the Chrysler cars, or the spotter, were designed or manufactured by Krouse.

The Court of Appeal did however "contemplate a concept in the law of tort which may be broadly classified as an appropriation of one's personality".¹⁷⁵ On the facts of the Krouse case, the Court found the Defendants had not committed such a tort

since they were attempting to take commercial advantage of the football game itself, as opposed to the Plaintiff's personality.

The Court attempted to make an association between such a tort of appropriation of personality and defamation on the basis of *Tolley v Fry* which, in the end, protected a public athlete figure from unauthorised commercial advantage. That case however, also linked such protection to defamation.

The Court re-interpreted the *Henderson* case "into an artificial accommodation of the common field of activity requirement in *McCulloch's* case which it had expressly rejected".¹⁷⁶ In fact, *Henderson's* case would have been more helpful in creating proprietary rights in personalities. The Court erroneously viewed *McCulloch's* case as a House of Lords decision. This has been suggested as the reason for the rather strained application of *Tolley v Fry* and so putting the more workable alternatives in *Henderson's* case out of reach.¹⁷⁷

The Court in *Krouse* did conclude that:

"There may well be circumstances in which the Courts would be justified in holding a Defendant liable in damages for appropriation of a Plaintiff's personality, amounting to an invasion of his right to exploit his personality by the use of his image, voice or otherwise with damage to the Plaintiff".¹⁷⁸

This statement has been adapted by subsequent Canadian Courts in *Racine v CJRC Radio Capitale Ltd.*¹⁷⁹ *Athans v Canadian Adventure Camps Ltd.*¹⁸⁰ and *Heath v Weist-Barron.*¹⁸¹

The *Racine* case also involved a former professional football player. Racine had been employed as a football games commentator on the Defendants' radio station.

The Plaintiff brought an action for wrongful dismissal, including a claim for payment for the benefit to the radio station of the association with his personality and

exploitation of his professional image, based on the Krouse case.

There was evidence that increased popularity ratings of the station were directly attributable to Racine. Damages were awarded for appropriation of the Plaintiff's personality in addition to his other claims, but with some hesitation.

The Canadian Adventure Camps case fully accepted wrongful appropriation of personality as a tort in its own right.

An action photograph of a professional water-skier was used without permission on the Defendants' advertising brochures for a summer camp. The Plaintiff used the photograph himself in contracts promoting various water-skiing equipment.

A case in passing-off was not made out because it was unlikely to cause deception or confusion since the relevant section of the public that would know it was Athans in the photograph, would not associate him with the holiday camp business. This was despite there being a common field of activity in that both to a greater or lesser extent were involved in the business of exploiting the sport of water-skiing commercially.¹⁸²

Athans did succeed on the tort of appropriation of personality. Although Krouse v Chrysler was referred to as an authority, the Court also pointed out that:

"The concept of appropriation of personality has moved from its place in the tort of defamation, as exemplified by Tolley v J S Fry & Sons Ltd to a more broadly based common law tort".

The essence of the tort lay in two important factors:

- (i) Possession of a distinctive public image by the Plaintiff; and
- (ii) Representation of a false and deceptive association between the Defendants' venture and the Plaintiff's

said image or personality.¹⁸³

However, the Plaintiff succeeded despite the finding that no-one was likely to be deceived. This appears to be on the basis that Athans himself used the photograph as his distinctive identity and for commercial purposes. This invaded his exclusive right to market his personality. Effectively, this amounted to treatment of the photograph as a trademark or copyright.

The tort of misappropriation has been recognised in the *Heath* case. The claim for unauthorised use of a six-year old professional actor's photograph and identity by the Defendants was held to disclose a reasonable cause of action by Montgomery J. recognising an action for appropriation of personality on the basis of *Racine*, *Krouse* and *Athans*.

Therefore, Canadian law is now recognising a separate tort of misappropriation of personality in a commercial context; distinct from the tort of passing-off, and rather like a distinctive mark of persona or indicia.

CONCLUSION

Whether or not the value of celebrity endorsement should be protected is dependant on reputation (*Honey*) and a number of variables such as the intention of the endorser (the person using the image in the advertisement), the nature and strength of the endorsement given to the product, and the manner of associating the image with the product such as name, image, typical trait or attribute, or voice (*Midler*). Links may be tenuous as illustrated by the *Carson* and *Crocodile Dundee* cases.

A problem inherent in intellectual property protection is balancing the free market approach with encouraging individual commercial development by monopoly. A suggested solution to this balancing exercise, is a compulsory licence scheme for use of images where both consenting and non-consenting subjects share in economic benefits via royalties.¹⁸⁴ However, if the revenue from celebrity endorsement is a value worth protecting, then control of the advertising and merchandising industry has been more effective by the Federal Court of the United States' treatment of the right of publicity as a property right.¹⁸⁵ If protective controls are to be placed on the advertising and merchandising industry, "then it is imperative that the right of publicity be recognised as property".¹⁸⁶ Although this approach has inherent problems, it certainly provides an effective measure against trading off, without paying for, someone's reputation built up at least in part themselves although necessarily involving media and publicity; that is, the idea of unjust enrichment.

The crucial issue in analysing protection against an unauthorised use of name and likeness is whether the protection is concerned with misrepresentation or, rather, misappropriation.

In jurisdictions such as Australia and New Zealand, protection pursuant to an action in passing-off requires a

misrepresentation.

In comparison, in the United States, the right of publicity is a property right. Therefore, unauthorised use of image is treated as misappropriation of property. The parties do not need to be in competition.¹⁸⁷ Arguably, treatment as property is the more appropriate protection.

The tort of passing-off has been adapted so as to produce flexible definitions of misrepresentation in a move towards what is really misappropriation.¹⁸⁸ This has resulted in a degree of artificiality in the finding of a misrepresentation as to misleading the public about licensing arrangements (which was endorsed in the *Turtles* case) when the public necessarily turn their minds to the use of an image pursuant to a licensing arrangement as was found in the *Crocodile Dundee* cases. The key to use of image in product endorsement is the association in the minds of the public between the product and a desirable personality or fictional character.¹⁸⁹ Analysis of the Australian decisions suggests a movement away from the meaning of misrepresentation as leading the public to believe a licensing arrangement exists between the parties, and moves towards misrepresentation as to an association with, or connection between, the image and the product.¹⁹⁰ The misrepresentation is not an actual endorsement or a statement as to particular quality, but is a misappropriation itself of something that could have been used to the person's own commercial advantage, and thereby resulting in unjust enrichment of the Defendant. This tends towards a recognition of property rights.

The essential complaint in unauthorised use of personality for merchandising purposes is really a misappropriation of something belonging to someone. It is intangible property. The association of the image with the goods or services is "wrongful appropriation of a reputation, or more widely, wrongful association of goods with an image properly belonging to the applicant";¹⁹¹ that is, a connection rather than quality or endorsement. "The reality of character

merchandising is that the Plaintiff has lost a commercial opportunity for exploiting his character or reputation".¹⁹² That is, "the name was used other than pursuant to an "endorsement" agreement involving a fee": Sue Smith.¹⁹³ That case tended to treat "misappropriation of reputation as enough, at least where the complaint is by one who might otherwise have been able to get money for licencing the use of his name".¹⁹⁴

The "property" traditionally protected by passing-off is the goodwill which has been developed by a trader. This is defined as "the attractive force which brings in custom".¹⁹⁵

To sustain an action in passing-off, the English Courts continue to require a misrepresentation resulting in damage to goodwill. Even since the significant recent development in this area in the United Kingdom in the Turtles case, "the English cases continue to rely on the notion of "goodwill" as opposed to "reputation" as the property protected by passing-off".¹⁹⁶ Consequently, this destroys the link between the originator and the secondary exploitation such as product endorsement. The role of the originator of a character is divorced from the actual manufacturer; the Court needs to be satisfied that a special link exists between the two. Goodwill as opposed to reputation indicates that the originator needs to be trading in the secondary market, or at least, is reasonably likely to be. This is limiting on the notion of treatment of personality as property. The Australian Courts in the Crocodile Dundee cases extended protection beyond the notion of goodwill, such that a commercial connection was sufficient.

Burley¹⁹⁷ states that property in goodwill is a nebulous thing, but property in the broader notion of reputation is more nebulous still. Questions such as its geographical limits, the length of time which it attaches to the image-maker and the degree to which reputation may be said to belong to one person, remain to be answered. Similar questions arise in the treatment, in the United States, of a celebrity's image as property. It is submitted these criteria could be addressed by

statute in the same way as copyright and trademark law.

The requirement of misrepresentation in passing-off is limiting on the development of the action of passing-off into a more general tort of unfair trading or unfair competition.

Many commonwealth commentators have indicated the need to recognise privacy actions along the line taken in the United States; the accepted doctrine being that no such explicit right exists, and resort must be had to trespass, conversion, nuisance, breach of confidence and other actions. Recently, the cases pursuant to the Lanham Act have been used to interpret the meaning of the Australian Trade Practices Act.

Recent developments in Australia recognise the ability of a celebrity to take commercial advantage of his or her public image without proving damages. Loss of commercial advantage is misappropriation of the image the celebrity had a right to exploit, thus effectively amounting to damage. No actual confusion is required. This is more in line with the United States' tort of misappropriation of personality as a property right.

It is submitted that, rather than distort the action of passing-off to incorporate artificial definitions of misrepresentation, a separate tort of misappropriation of personality be recognised as the Canadian Courts have done. The Australian Courts are moving away from misrepresentation towards misappropriation. All jurisdictions emphasise the sufficient public profile requirement. The requirement of a commercial connection or association in the minds of the public may be viewed as equivalent to the deceptive association attribute of the Canadian cases.

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