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Robert G. Howell

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PUBLICITY RIGHTS IN THE COMMON LAW PROVINCES OF CANADA

*Robert G. Howell**

I. INTRODUCTION

When considering a specific topic of legal development in Canada, regard must be given to Canada's unique constitutional, legal, and political structure. Canada is comprised of ten provinces, nine of which are common law provinces,[1] as well as two common law territories.[2] Quebec is a civil law province, a legacy of French colonization of North America.[3] It is distinct from the common law provinces because civil law is the source of private law in Quebec. This Article is limited to describing publicity rights in the common law provinces of Canada, although common law policy comparisons are made with developments in Quebec civil law.

The primary vehicle for protecting personality and publicity interests in Canadian common law jurisdictions is the tort of "appropriation of personality." This tort originated in the Ontario Court of Appeal in 1973 in the case of *Krouse v. Chrysler Canada Ltd.*[4] Any fledgling area of common

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* Professor of Law, University of Victoria, B.C., Canada. I would like to thank Mr. Kerry Hillier, University of Victoria, B.C., 1998, who provided research assistance, and Mrs. Sheila Talbot, who provided secretarial assistance.

1. The nine common law provinces are Alberta, British Columbia, Manitoba, New Brunswick, Newfoundland, Nova Scotia, Ontario, Prince Edward Island, and Saskatchewan.

2. The two common law territories are the Yukon and Northwest Territories.

3. *See* Robert G. Howell, *Important Aspects of Canadian Law and Canadian Legal Systems and Institutions of Interest to Law Librarians and Researchers in Law Libraries, in* LAW LIBRARIES IN CANADA: ESSAYS TO HONOUR DIANA M. PRIESTLY 42–48 (J.N. Fraser ed., 1988).

4. [1973] 40 D.L.R.3d 15 (Ont. Ct. App.) (Can.). By comparison, publicity rights in Quebec are protected as an element of "privacy" by the Quebec Civil Code and the *Quebec Charter of Human Rights and Freedoms*. *See* Civil Code, S.Q. ch. 64 (1991) (Can.); Charter of Human Rights and Freedoms, R.S.Q. ch. 12, §§ 4, 5 (1977) (Can.) (protecting dignity, honor, reputation, and privacy); *see also* Aubry v. Duclos [1996] 71 C.P.R.3d 59 (Que. Ct. App.), *aff'd*, [1998] S.C.J. No. 30 (Can Sup. Ct., Apr. 9, 1998) (concerning the photographing of a non-celebrity woman and the publication of the photograph in an artistic magazine); Louise Potvin, *Protection Against the Use of One's Likeness in Quebec Civil Law, Canadian Common Law and Constitutional Law*, 11 INTELL. PROP. J. 203 (Part I), 295 (Part II) (1997) (Can.); H. Patrick Glenn, *Civil Responsibility—Right to Privacy in Quebec—Recent Cases*, 52 CAN. B. REV. 297

law, however, necessarily draws comparatively upon similar developments in other common law jurisdictions in British Commonwealth countries and the United States.[5] Therefore, this Article references principles and authority found in the common law countries of Australia, New Zealand, the United Kingdom, and the United States.

Publicity rights in Canadian and British Commonwealth common law can be seen as part of a broader economic and legal activity known as "character merchandising," the practice of using a celebrity's image or identity to sell a product.[6] The benefit of character merchandising is the persuasive influence on consumers that linking a celebrity (or a celebrity item) with a consumer product or service may engender.[7] The advantage this provides to a seller or supplier is the market value in the image or identity of the celebrity to whom reference is made. This market value, however, is a "commodity" that properly belongs to the celebrity or owner of the item.[8]

In contrast to the proprietary interest in this commodity, a person also has a privacy interest in protecting his or her image from being commercially exploited. A privacy interest can be violated by the use of a person's name or likeness and may also cause the person mental anguish and suffering.[9] Accordingly, because the violation of a publicity interest can cause both economic injury and mental anguish,[10] "publicity" and "privacy" notions are intertwined.

This Article discusses the rights of celebrities to protect their image and identity from unauthorized exploitation in Canada. The Article reveals that protection for one's image and identity is generally available under Canadian common law, and that its evolution has been and continues to be influenced by other common law countries' treatment of this right, especially the closely related "right of publicity" under United States laws. Although the scope of this Article is limited to the publicity rights of celebrities,[11] it

(1974).

5. *See* Gould Estate v. Stoddart Publ'g Co. [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.), *aff'd on different grounds*, [1998] O.J. No. 1894 (Ont. C.A., May 6, 1998); Staniforth Ricketson, *Character Merchandising in Australia: Its Benefits and Burdens*, 1 INTELL. PROP. J. 191 (1990) (Austl.); Michael D. Pendleton, *Character Merchandising and the Proper Scope of Intellectual Property*, 1 INTELL. PROP. J. 242 (1990) (Austl.).

6. *See* Robert G. Howell, *Character Merchandising: The Marketing Potential Attaching to a Name, Image, Persona or Copyright Work*, 6 INTELL. PROP. J. 197 (1991) (Can.).

7. *See id.*

8. *Id.*

9. *Id.*

10. *Id.*

11. This Article does not consider the more broadly based sources of proprietary protection available to the creators of "fictitious, non-human characters," such as "Wombles," "Teenage

also discusses the potential value celebrities derive from prohibiting commercial exploitation of fictional characters they may have portrayed in films and television.[12]

Part II of this Article examines the tort of appropriation of personality, beginning with its historical development along similar principles as the American right of publicity, and its subsequent development in Canadian case law. This Part discusses how the tort of appropriation of personality exists largely in response to the failure of the business tort of "passing off" to provide an adequate remedy for unauthorized uses of an individual's persona or identity. Part III contemplates the need to balance celebrities' publicity and privacy rights with the public interest in the publication and dissemination of information. This Part reveals that, as in the United States, freedom of expression is a highly valued right that often contradicts the right of publicity.

Part IV focuses on the issue of descendibility of one's personality interest. This Part highlights the need to ground the right in proprietary notions rather than privacy notions in order to allow it to be inherited. This Article concludes that although Canadian common law jurisdictions currently recognize a fledgling tort of appropriation of personality, the right to protect one's persona and identity from commercial exploitation continues to progress with influence from American jurisprudence.[13]

Mutant Ninja Turtles," "Cabbage Patch Kids," "Mickey Mouse," "Muppets," or "Ewoks." Protection of such characters can be found in copyright, including moral rights, the tort of passing off and registered trademark. *See* Howell, *supra* note 6, at 200. My colleague, Professor Diana Belevsky, has pointed out to me that animals portraying "animal characters" may have the same real name as the character, in which case there would be another category of "non-fictitious, non-human characters" for example, if the dog portraying "Lassie" was known by that name outside of the role. It is an interesting issue, absent any contract, as to whether the owner of the dog or the creator of the character would have rights to the merchandising potential of the dog.

12. For example, it is interesting to speculate whether the Australian actor Paul Hogan has been assimilated with the character "Crocodile Dundee," or whether British actor Rowan Atkinson is assimilated with the character "Mr. Bean." In order to protect this fictional persona, a requisite question of fact in each instance is certainly whether the performer's actual (or real-life) persona is sufficiently assimilated with the character. *See* Howell, *supra* note 6, at 200. An assimilation involves more than simply playing the character. California Supreme Court Justice Stanley Mosk's well known concurrence in *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979), illustrates this point, noting that if merely playing a role were sufficient, "Gregory Peck . . . could possess . . . exclusivity to General MacArthur, George C. Scott to General Patton, James Whitmore to Will Rogers and Harry Truman, or Charlton Heston to Moses." *Id.* at 432 (Mosk, J., concurring). Currently, there are no authorities on this in Canadian common law appropriation of personality proceedings. *Cf.* Hines v. Winnick, 1 Ch. 708 (Ch. 1947) (Eng.) (holding that in an action for the tort of "passing off," the name "Dr. Crock" had become part of the plaintiff's "stock in trade" and was sufficiently identified with him such that he was entitled to enjoin the defendant from using that name to designate another). For a discussion of the tort of passing off, see *infra* Part II.

13. The use of the term "persona" in this Article refers generally to any indication of a celebrity, including such personal attributes as one's name, likeness, and photograph.

II. HISTORICAL CONTEXT

Although they share many of the same principles, the Canadian right of publicity developed from different theories than the American right. The right of publicity in the United States developed from a large body of statutory and common law focusing on protecting individual privacy, a component of which was the misappropriation of one's name and likeness. The right to privacy was first discussed by American scholarly articles at the turn of the century and continued to be the primary source of publicity protection through the 1950s.[14]

Canadian law, by contrast, has no similar foundation in privacy, apart from four relatively recent privacy statutes in the provinces of British Columbia, Manitoba, Newfoundland, and Saskatchewan.[15] Publicity rights in Canada developed in the context of British Commonwealth attempts to provide relief against unauthorized character merchandising through the business tort of "passing off."[16] This tort provided an action against a business for falsely representing that its goods or services were either endorsed by or the same as goods made by the plaintiff.[17] Unlike the privacy-based right of publicity, the tort of passing off is unquestionably proprietary, focusing on protecting the business goodwill of the plaintiff. The key issues for the tort of passing off include determining: (1) the requisite level or content of the association between the plaintiff's and defendant's goods or services; and (2) whether the public could be confused as to the plaintiff's endorsement of the defendant's goods or services.[18]

Prior to the 1980s, the tort of passing off was an unsuccessful cause of action in the context of character merchandising, primarily because the

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14. *See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). The American privacy tort flows from the Warren-Brandeis seminal theory of privacy. Subsequent acceptance of a classification of privacy interests and the identification of "appropriation of name or likeness" as a particular category or even separate tort, followed the classic commentary. *See* William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960). By the 1950s, however, protection was being claimed by celebrities who thrived on publicity but wanted to be paid for use of their persona for merchandising activities. The remedy in privacy could not readily be seen as an accurate concept to provide such relief, eventually leading to the development of a proprietary right termed the right of publicity. *See* Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2nd Cir. 1953).

15. *See* Privacy Act, R.S.B.C. ch. 373 (1996) (Can.); Privacy Act, R.S.M. ch. P-125 (1987) (Can.); Privacy Act, R.S.S. ch. P-24 (1978) (Can.); Privacy Act, NFLD. R.S. ch. P-22 (1990) (Can.).

16. *See* Robert G. Howell, *The Common law Appropriation of Personality Tort*, 2 INTELL. PROP. J. 149, 151–52 (1986) (Can.).

17. *See* National Hockey League v. Pepsi-Cola Can. Ltd. [1992] 42 C.P.R.3d 390, 401 (B.C. Sup. Ct.), *aff'd*, [1995] 59 C.P.R.3d 216, 222–23 (B.C. Ct. App.) (Can.).

18. *See* Howell, *supra* note 16, at 153–54.

courts were not prepared to acknowledge character merchandising as a business.[19] More importantly, the courts did not recognize that the use of a celebrity's persona could confuse consumers as to whether the plaintiff actually endorsed the defendant's products or whether the defendant misrepresented the origin of its goods sufficient to constitute passing off.[20] The test applied by the courts prior to the 1980s to determine misrepresentation and confusion was simply not applicable to character merchandising because it required the celebrity to prove a "common field of activity" between the defendant's product and the celebrity's persona—a requirement rarely satisfied by a celebrity plaintiff.[21]

Over time, Canadian courts developed various tests to determine whether a plaintiff endorsed the defendant's product or business, but difficulties remained in establishing the requisite level of association.[22] In 1973, the Ontario Court of Appeal recognized the need to focus on the "taking" or "misappropriation" aspect of the plaintiff's claim and created the new tort of "appropriation of personality."[23]

A. The Appropriation of Personality Tort

In 1973, the Ontario Court of Appeal created the appropriation of personality tort in *Krouse v. Chrysler Canada Ltd.*[24] In *Krouse*, a Canadian football player sued the automobile manufacturer Chrysler, claiming that Chrysler had misappropriated his personality for commercial purposes by using his photograph in an advertisement without his permission.[25] The photograph featured the plaintiff with his back turned toward the camera, but his jersey number was clearly displayed.[26] The court held that the

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19. *See id.*

20. *See* Ciba-Geigy Can. Ltd. v. Apotex, Inc. [1992] 44 C.P.R.3d 289 (Can.) (listing the modern elements of the tort of passing off); Consumers Distrib. Co. Ltd. v. Seiko Time Can. Ltd. [1984] 1 C.P.R.3d 1 (Can.); Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd., App.Cas. 731 (appeal taken from Can.) (H.L. 1979) (Eng.).

21. *See* McCulloch v. May (Produce Distribs.), Ltd., 2 All E.R. 845 (Ch. 1947) (Eng.) (holding that where no common activity between the plaintiff and defendant's business existed, the defendant's use of the plaintiff's name did not constitute passing off). *But see* Annabel's Ltd. v. Schock, R.P.C. 838, 844 (C.A. 1972) (Eng.); *see also* Jeremy Phillips & Allison Coleman, *Passing Off and the "Common Field of Activity,"* 101 LAW Q. REV. 242 (1985). The presence of a common field of activity is more properly seen as just one factor to be considered in establishing the likelihood of public confusion. *See id.*

22. Howell, *supra* note 16, at 154 (setting out various tests including: "endorsing," "quality control," "association," and "authorizing or approving").

23. *See* discussion *infra* Part II.A.

24. [1973] 40 D.L.R.3d 15 (Ont. Ct. App.) (Can.).

25. *Id.* at 16.

26. *Id.*

tort of passing off did not apply to Krouse's claim because he was not engaged in the same business as Chrysler.[27] Addressing Krouse's claims that the photograph constituted unauthorized commercial exploitation of his likeness—or at least some form of trespass or invasion of privacy—the court recognized that "[t]here is indeed some support in our law for the recognition of a remedy for the appropriation for commercial purposes of another's likeness, voice or personality."[28] The court considered several fields of torts, including passing off, trespass, defamation, and privacy, and concluded that "the common law does contemplate a concept in the law of torts which may be broadly classified as an appropriation of one's personality."[29] The court refused, however, to award damages to Krouse because it was the game of professional football that was being utilized and the photograph was authorized by the professional football league for whom Krouse played. Furthermore, the plaintiff should expect "some minor loss or privacy and even some loss of potential for commercial exploitation . . . as a by-product of the express or implied license to publicize the institution of the game itself."[30]

The *Krouse* decision was followed in 1977 by the Ontario High Court in *Athans v. Canadian Adventure Camps Ltd.*[31] In *Athans*, a well-known water-skier, George Athans Jr., sued Canadian Adventure Camps for a misappropriation of his image. The camps used a photograph of Athans to create a line drawing that was subsequently used in their advertising materials.[32] The photograph, the court determined, was the same photograph used by Athans as a self-promotional tool.[33] The Ontario High Court determined that those individuals involved in creating the line drawing were aware that the photograph was a distinctive image of Athans, easily recognizable by those familiar with the sport of water-skiing.[34]

After examining both the photograph and the drawing, the court concluded that the distinctive nature of the photograph was preserved in the drawing.[35] The court held that the use of Athans' image in the drawing

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27. *Id.* at 26.

28. *Id.* at 27.

29. *Id.* at 28.

30. *Krouse*, 40 D.L.R.3d at 29.

31. [1977] 80 D.L.R.3d 583 (Ont. H.C.) (Can.). *See generally* Howell, *supra* note 16; *see also* Robert W. Judge, *Celebrity Look-Alikes and Sound-Alikes or Imitation is Not the Highest Form of Flattery*, 20 C.P.R.3d 97 (1988) (Can.); Tim Frazer, *Appropriation of Personality—A New Tort?*, 99 LAW Q. REV. 281 (1983) (Can.); Howell, *supra* note 3, at 150 n.1.

32. *Athans*, 80 D.L.R.3d at 584.

33. *Id.* at 589.

34. *Id.*

35. *Id.* at 588.

without his consent was an infringement on his exclusive right to market his personality.[36] It distinguished its holding from the *Krouse* case by stating that the defendant in *Krouse* did not target a particular athlete's personality, but merely intended to depict an anonymous football player as part of a promotional campaign.[37] Finally, the court concluded that an action based on the infringement of one's personality is distinct from a cause of action based on trademark or copyright law.[38]

The policies underlying the court's decision in *Krouse* included: (1) reserving a right to celebrities comparable to the American right of publicity (acknowledging that such a tort had not at that stage been recognized in Canada or the United Kingdom);[39] and (2) acknowledging that a historical basis for an appropriation of personality tort existed in the commonwealth law for action on the case.[40]

Arguably, the formulation of the appropriation tort in *Krouse* was a hybrid of the passing off tort and the right of publicity, while the formulation in *Athans* was a pure "taking" or "misappropriation." By referring to the plaintiff's apparent endorsement of the defendant's product, the *Krouse* court seemed to apply the classic test of passing off.[41] However, the court did not adhere to the passing off analysis, which required an express reference to an element of misrepresentation or to a likelihood of public confusion.[42] Instead, the court's reference to an "endorsement" factor may be seen as part of a factual element constituting the "sufficiency" of a "taking" or "a threshold issue establishing a sufficient degree of nexus before the defendant [could] be said to have culpably usurped the plaintiff's personality."[43]

The *Krouse* analysis can therefore be interpreted as providing a remedy for wrongs in the nature of a taking or misappropriation, an interpretation subsequently applied in *Athans*.[44] Similarly, in *Zacchini v. Scripps-Howard Broadcasting Co.*,[45] the United States Supreme Court, interpreting Ohio common law, held the right of publicity is a proprietary—

36. *Id.* at 595.

37. *Id.* at 593.

38. *Athans*, 80 D.L.R.3d at 595.

39. *Krouse*, 40 D.L.R.3d at 23–31.

40. *Id.* Formulated as a modern form of "trover or conversion" and requiring proof of damage.

41. *Id.*

42. *Id.* at 25–26; *see also* Howell, *supra* note 3, at 170–71.

43. Howell, *supra* note 3, at 170.

44. *See Athans*, 80 D.L.R.3d at 595 (referring to the plaintiff's "exclusive right to market his personality" and noting any infringement to constitute "the tort of appropriation of personality").

45. 433 U.S. 562 (1977).

as opposed to a privacy—right. Thus, the right of publicity can be termed a discrete category of the general proceeding for misappropriation of business values.[46] The *Zacchini* Court also found that this type of wrongful taking may constitute unjust enrichment.[47] Subsequent authorities in Canada have also taken the approach of a wrongful taking.[48] This may implicitly present recognition of an unjust enrichment theory in Canada. Although the historical basis for such a proceeding is tenuous, this approach will enable the tort to develop according to contemporary needs "without encumbrance from 19th century English law which itself was decided in contexts and for purposes quite different from that of our present situation."[49]

The elements of this fledgling tort have not been expressly clarified beyond the holding in *Krouse*. The courts have, however, delineated factors analogous to the right of publicity in the United States, including: (1) the plaintiff must be identified in the depiction or other indicia;[50] (2) the defendant's use of the plaintiff's persona should be more than incidental or

46. *See Zacchini*, 433 U.S. at 572–73, 576. The general tort concerning "misappropriation of business values" arises from the classic authority of *International News Serv. v. Associated Press*, 248 U.S. 215 (1918). *See generally* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10.47 et seq. (4th ed. 1997).

47. *See Zacchini*, 433 U.S. at 576.

48. *See* Racine v. C.J.R.C. Radio Capitale Ltee. [1977] 17 O.R.2d 370 (Ont. County Ct., D. Ottawa-Carleton) (Can.); Heath v. Weist-Barron Sch. of Television Can. Ltd. [1981] 34 O.R.2d 126 (Ont. H.C.) (Can.); Joseph v. Daniels [1986] 4 B.C.L.R.2d 239 (B.C. Sup. Ct.) (Can.); Dowell v. Mengen Inst. [1983] 72 C.P.R.2d 238 (B.C. Sup. Ct.) (Can.) (appearing to have applied the tort in a context of privacy). *See* Howell, *supra* note 16, at 179, 187. Recent authorities include *Gould Estate* v. *Stoddart Publ'g Co.*, [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.), *Shaw* v. *Berman* [1997] 72 C.P.R.3d 9 (Ont. G.D.) (Can.), and *Horton v. Tim Donut Ltd.*, [1997] 75 C.P.R.3d 451 (Ont. G.D.), *aff'd*, No. C26845 (Ont. Ct. App. Oct. 10, 1997) (Can.). I thank Lerner & Associates, Toronto, for bringing the *Horton* proceedings to my attention.

49. *See* Robert G. Howell, *Is There an Historical Basis for the Appropriation of Personality Tort?*, 4 INTELL. PROP. J. 263, 300 (1989) (Can.). The historical context of this tort has received seminal attention by D.L. Mathieson in *Passing Off of Actor's Voice—Appropriation of Another's Personality Without His Consent—An Equitable Right of Privacy?*, 39 CAN. B. REV. 409 (1961). *See also* John Irvine, *The Appropriation of Personality*, *in* ASPECTS OF PRIVACY LAW: ESSAYS IN HONOUR OF JOHN M. SHARP (D. Gibson ed., 1980); S.K. MURUMBA, COMMERCIAL EXPLOITATION OF PERSONALITY (1996); Clifford L. Pannam, *Unauthorized Use of Names or Photographs in Advertisements*, 40 AUSTL. L.J. 4 (1966).

50. *See Joseph*, 4 B.C.L.R.2d at 244 (noting the defendant used a model's torso only to avoid identification of the plaintiff). The failure to identify the plaintiff precluded any proceeding for appropriation of personality. In *Krouse*, the court denied recovery because the defendant's poster identified and exploited the game of football, rather than the plaintiff himself. *See Krouse*, 40 D.L.R.3d at 29–30; *see also* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 4.15[A] et seq. (1987) (discussing "identification" and providing numerous recent examples showing how identification can be established from not merely the direct indicia that is used but from the whole of the circumstances of the presentation including captions and accompanying commentary).

de minimis;[51] (3) there is no express requirement of an intent to misappropriate, though all cases to date in Canada have involved intentional conduct; (4) there must be damage;[52] and (5) there cannot be a public interest in publication that would counter any action for misappropriation.[53]

While the courts and legislature have considered various factors in attempting to define the tort of appropriation of personality, uncertainty remains. For example, the courts have not thoroughly explained the relationship between the proprietary and privacy interests in publicity. The conceptual formulation of the tort of appropriation of personality is broad enough to encompass the protection of both publicity and privacy interests. The substantive element of the tort should focus upon the act of taking, recognizing an injury as either publicity or privacy being as distinct elements of loss.[54]

In *Dowell v. Mengen Institute*,[55] the Ontario High Court, without discussing privacy, considered providing relief by way of appropriation of personality to unemployed plaintiffs who participated in a group discussion

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51. This element is a prerequisite or "threshold" issue for the right of publicity proceeding in the United States. It is suggested that the "endorsement" factor in *Krouse* reflects this element of requiring some greater degree of usage of the celebrity's persona to constitute a "culpable" taking. *See supra* notes 24–31 and accompanying text. It is also comparable to developments in Australia requiring some "embedded" (as opposed to "mere") caricature of a celebrity before there can be said to be a culpable or remedial taking. *See* Pacific Dunlop Ltd. v. Hogan, (1989) 87 A.L.R. 14, 43–44 (Austl.); Robert G. Howell, *Personality Rights: A Canadian Perspective: Some Comparisons With Australia*, 1 INTELL. PROP. J. 212, 218 (1990) (Austl.). Similarly, proceedings under provincial privacy statutes, require an intention "to exploit." *See* Privacy Act, R.S.B.C. ch. 373, § 3(2) (Can.); Privacy Act, R.S.M. ch. P-125, § 3(c) (1987) (Can.); Privacy Act, R.S.S. ch. P-24, § 3(c) (1978) (Can.); *see also* Privacy Act, NFLD. R.S. ch. P-22, § 4(c) (1990) (Can.).

52. For the extent to which damage may be implied or to which equitable unjust enrichment may be applicable in this context, see Howell, *supra* note 16, at 179–86. *See also supra* text accompanying note 46, concerning the remedy of unjust enrichment for right of publicity violations in the United States under *Zacchini*.

53. The need for a "public interest" exception to preclude an application of the tort was expressly recognized in *Krouse*, but without providing any detail as to how a public interest would relate to the propriety interest in publicity. *Krouse*, 40 D.L.R.3d at 30. An appropriate analogy can be drawn with developments in the right of publicity proceeding in the United States. *See* Howell, *supra* note 3, at 192–96; *see also* Howell, *supra* note 16, at 226–27.

54. A *privacy* injury is in the nature of an infliction of mental suffering from a violation of seclusion or solitude. An injury to *publicity* is the usurpation of the defendant's persona without payment for the value of such use. It is an economic injury flowing from an unauthorized use of an asset. An incident may involve both types of loss, but this is unusual. *See, e.g.*, Douglass v. Hustler Magazine, Inc., 769 F.2d 1128 (7th Cir. 1985); Howell, *supra* note 6, at 210–13; *see also* David Vaver, *What's Mine Is Not Yours: Commercial Appropriation of Personality Under the Privacy Acts of British Columbia, Manitoba and Saskatchewan*, 15 U.B.C. L. REV. 241, 256–61 (1981).

55. [1983] 72 C.P.R.2d 238 (B.C. Sup. Ct.) (Can.).

concerning their unemployment.[56] The defendant videotaped the proceedings, which included reportedly emotional and possibly seditious responses about the participants' employer.[57] Although a finding of consent to the recording and later screening of the videotape denied application of the tort,[58] the purely private nature of the injury sustained by the plaintiffs was not a deterrent to finding liability.[59] A similar question as to whether publicity damage might be included under provincial privacy statutes awaits authoritative determination.[60]

The determination of any privacy interest in the tort is important for four reasons. First, an interest in privacy is personal, rather than proprietary. A privacy-based tort, therefore, is non-inheritable and non-descendible because, as no one can assert a privacy claim of another, the right to the cause of action expires with the person. Second, while any natural person can claim a privacy interest,[61] a proprietary interest, on the other hand, may require the plaintiff to establish some value in his or her persona resulting from the investment of his or her labor and capital.[62] This position is also held by the majority of jurisdictions in the United States with regard to the right of publicity.[63] The status of this issue currently awaits clarification in Canada.[64]

In another case involving disputed uses of a person's photograph and the claim that the use constituted a privacy violation, the plaintiff failed to

56. *Id.*

57. *Id.*

58. *Id.*

59. *Id.*

60. *See* Howell, *supra* note 3, at 190–92 (noting British Columbia to be the only jurisdiction that provides for two statutory torts: (1) a general privacy tort, similar to the tort provided for in the provinces of Manitoba, Saskatchewan, and Newfoundland; and (2) a tort concerning specifically the use of "the name or portrait of another for the purpose of advertising or promoting the sale or other trading in, property or services"). Privacy Act, R.S.B.C. ch. 373, § 3 (1996) (Can.) (appearing to cover "publicity" as well as privacy, despite a provision (§ 5) denying the descendibility of the interest protected under the tort); *see also* Joseph v. Daniels [1986] 4 B.C.L.R.2d 239 (B.C. Sup. Ct.) (Can.). In *Joseph*, had the plaintiff been sufficiently identified, the provisions of Section 3 would have applied alongside of common law appropriation of personality in a publicity context. The court did not consider any possible argument of preemption of common law relief. *Id.*

61. *See* Dowell v. Mengen Inst. [1983] 72 C.P.R.2d 238 (B.C. Sup. Ct.) (Can.) (involving relief sought by an unemployed person.).

62. *Id.*

63. MCCARTHY, *supra* note 50, § 4.1[C][3].

64. This issue was raised in *Gould Estate v. Stoddart Publ'g Co.* [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.), but left open. The emphasis was, however, toward limiting the tort to a merchandising context.

succeed on this claim. In *Joseph v. Daniels*,[65] the defendant paid the plaintiff, a locally known body-builder, to photograph his torso for a magazine advertisement.[66] Without the plaintiff's knowledge, the defendant used the photograph on posters and greeting cards.[67] Because the defendant used the photograph for purposes beyond the initial magazine advertisement, the plaintiff brought suit alleging wrongful appropriation of personality, breach of the Privacy Act, and breach of contract.[68]

The court held that the defendant did not misappropriate the plaintiff's personality because he did not use or benefit from the reputation, image, or name of the plaintiff.[69] Furthermore, the court held that the defendant was not in violation of the Privacy Act because that law specifies that the plaintiff be recognizable from the alleged infringing photograph, clearly not the case here because only the torso of the plaintiff was photographed.[70] Finally, the court held that the defendant did violate his contract with the plaintiff because both parties agreed that the photograph would only be used for the magazine advertisement.[71] The court awarded the plaintiff $550 as compensation for the "extra usage" of the photograph.[72] Quite apart from the apparent privacy initiative presented in *Dowell*, the plaintiff in *Joseph* can hardly be said to have been a celebrity figure. All other Canadian common law cases did, however, involve a plaintiff of some celebrity status.[73]

Third, when compared to a publicity interest, a privacy interest may produce a different and more difficult balance between the public interests in publication and free speech and the protection of privacy and publicity.[74] As

65. [1986] 4 B.C.L.R.2d 239 (B.C. Sup. Ct.) (Can.).

66. *Id.* at 241.

67. *Id.* at 242.

68. *Id.* at 242–43.

69. *Id.* at 244.

70. *Id.* at 245.

71. *Joseph*, 4 B.C.L.R.2d at 245.

72. *Id.*

73. *See, e.g.*, Gould Estate v. Stoddart Publ'g Co. [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.) (involving a famous pianist); Athans v. Canadian Adventure Camps Ltd. [1977] 80 D.L.R.3d 583 (Ont. H.C.) (Can.) (involving a famous water skier); Krouse v. Chrysler Can. Ltd. [1973] 40 D.L.R.3d 15 (Ont. Ct. App.) (Can.) (involving an at least marginally famous professional football player). Arguably, the presence or absence of any celebrity status could be seen as merely a matter of *quantum*, with the tort protecting, in a substantive sense, all persons. This would be consistent with the analogy in the formulation of the tort as being in the nature of "trover or conversion" involving no notion of reputation or status. *See supra* notes 40–43 and accompanying text.

74. The trend in the United States has been to diminish the public interest, or "free speech implications," when proceeding in a publicity (proprietary) context, as opposed to situations of privacy. *See* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 571–78 (1977); *see also* Howell, *supra* note 16, at 192–96. In particular, the United States Supreme Court (applying Ohio

in the United States, the public interest in free access to the press and in the dissemination of information plays an important role in Canadian society. This interest is certainly hindered when individuals have the ability to enjoin such activities by claiming that the publication, by incorporating the plaintiff's image or identity, constitutes a violation of one's privacy or privacy-based appropriation right.

Finally, an interest in privacy may also assist in limiting the ultimate scope of the tort. To date, the tort has been limited in application to human characters[75] and has not encompassed fictitious, artificial or non-human characters.[76] If the tort was broadened to include fictitious or non-human characters, it would not be readily distinguishable from the American misappropriation of business values tort.[77] Such a broad-based misappropriation theory has not been accepted in Canada[78] or elsewhere in the British Commonwealth,[79] but it does have a limited application in the United States.[80] In some jurisdictions, the element of misrepresentation in the tort of passing off has been diminished.[81] Appropriation of personality would lose the inherent justification it has as a limited application of a

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common law) declined to apply, in a publicity context, an immunity by way of a qualified privilege (in the absence of proof of "actual malice") as provided in the United States for defamation and privacy as a result of the First Amendment principle in *New York Times Co.* v. *Sullivan*, 376 U.S. 254 (1964). *See generally* MCCARTHY, *supra* note 46, § 10.47. This principle was rejected in Canada, in a defamation proceeding. *See* Hill v. Church of Scientology of Toronto [1995] 126 D.L.R.4th 129 (Can.). However, the scope of *Hill* is yet to be determined. *Cf.* Lange v. Atkinson & Austl. Consol. Press N.Z. Ltd. [1997] 2 N.Z.L.R. 22 (N.Z.).

75. *See generally* Howell, *supra* note 6, at 218.

76. *Id.*

77. *See generally Zacchini*, 433 U.S. at 571–72.

78. The misappropriation theory was referred to by Chief Justice Laskin for the majority in *MacDonald v. Vapor Can. Ltd.*, [1977] 2 S.C.R. 134, 149 (Can.), noting that this type of theory would, in an unfair competition context, be within the Trade Marks Act, R.S.C. ch. T-13, § 7(e) (1985), that seeks to proscribe any act or business practice "contrary to honest industrial or commercial usage in Canada." This provision presents issues of considerable difficulty concerning constitutional validity of federal legislation as determined by the Supreme Court of Canada in *MacDonald* and is discussed in numerous appeal and trial court decisions. *See* Canada Safeway Ltd. v. Manitoba Food & Commercial Workers Local [1983] 5 W.W.R. 327 (Man. Ct. App.) (Can.) (finding an "action on the case" in favor of an employer to prevent a union from using the employer's logo in circumstances where such usage did not fall into any established category of cause).

79. *See* Cadbury Schweppes Pty. Ltd. v. Pub Squash Co. Pty. 1 All E.R. 213 (P.C. 1981) (Eng.); Moorgate Tobacco Co. v. Philip Morris Ltd. [1984] 56 A.L.R. 193, 209–14 (Austl.); Victoria Park Racing & Recreation Grounds v. Taylor [1938] 58 C.L.R. 479 (Austl.); [Lorimar Prods., Inc. v. Sterling Clothing Mfr. (Pty.) Ltd.] [1982] R.P.C. 395, 418–22 (S. Afr.).

80. *See generally* MCCARTHY, *supra* note 46, § 10.47 et seq. Particular difficulties have occurred in regard to the relationship between this tort and areas of federal protection of intellectual property, especially copyright and trademark protections.

81. *See infra* text accompanying notes 89–99.

misappropriation theory if it were applied beyond "human" or "real" persons.

Justice Fisher of New Zealand's High Court, commenting on personality and character merchandising in Canada and the United States and applying their principles to New Zealand, noted that "a distinction should immediately be drawn between the promotional use of the names, reputations and images of real persons and artificial character merchandising. Few would dispute that real persons should generally have the right to prevent the unauthorized promotional use of their persona."[82] Justice Fisher also acknowledges that New Zealand law might contemplate for real persons the North American causes of action for appropriation of personality and/or breach of rights of privacy and publicity.[83]

B. Subsequent Developments in the Passing Off Tort and Its Viability to Remedy Infringements of Publicity Rights

In the early case of *Lyngstad v. Anabas Productions*,[84] the English Chancery Division denied relief to the musical group Abba.[85] The court noted that the element of association between the plaintiff and the defendant's goods or services, required to prove the tort of passing off, would need to be narrowed in content to determine if the public merely believed that Abba consented to have the group's image on the defendant's products.[86] Such a diminished level of content was unacceptable as the test of association.[87] It was, however, subsequently found to be sufficient in Australia during the 1980s in litigation initiated by the Australian actor Paul Hogan for misappropriation of his likeness as the title character in the *Crocodile Dundee* movies.[88]

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82. Tot Toys v. Mitchell [1993] 1 N.Z.L.R. 325, 363 (N.Z.).

83. *Id.*

84. F.S.R. 62 (Ch. 1977) (Eng.).

85. *Id.* at 70.

86. *Id.* at 67.

87. *See id.* at 68.

88. CROCODILE DUNDEE (Paramount Pictures Corp. 1986); CROCODILE DUNDEE II (Paramount Pictures Corp. 1988); *see* Pacific Dunlop v. Hogan (1989) 87 A.L.R. 14, 43–44 (Austl.) (holding that a cause of action in passing off is complete as soon as the relevant misrepresentation is made, even if no actual deception or damage to the plaintiff is proven to result therefrom). Courts adopting this test have dispensed it in favor of a more or less intuitive misappropriation approach, on the basis that the consuming public responds more by instinct than by any reasoned or conceptual thought process. *See id.*; *see also* Hogan v. Koala Dundee Pty. Ltd. (1988) 20 F.C.R. 314 (Austl.).

In *Hogan v. Koala Dundee Pty. Ltd.*,[89] the Australian Federal Court ruled that the element of association was not required to be proven.[90] Hogan sought to enjoin the Koala Dundee stores from using the name "Dundee" on signs inside and outside their shops, on T-shirts, shopping bags, and tags attached to items for sale in their stores.[91] The stores, originally called "Dundee Country," featured a koala bear wearing a "bush hat," a sleeveless vest, and a knife, purposely meant to bear a resemblance to Hogan.[92] In finding for Hogan on the passing off claim, the court stated that the stores "deliberately sought to take advantage of the reputation of Paul Hogan as the leading character in the film, and that of the film."[93]

In *Pacific Dunlop Ltd. v. Hogan*,[94] the Australian Federal Court found for Hogan again in another suit to enjoin the commercial unauthorized exploitation of the "Dundee" character.[95] Hogan claimed that Pacific Dunlop's advertisements misappropriated his character "Mick Dundee" from the *Crocodile Dundee* films. The company's television advertisements featured a rough-looking male character wearing a hat with a band of animal teeth and vest similar to "Mick Dundee."[96] The character in the advertisement, however, wore jeans and "Grosby Leatherz" shoes—the subject of the advertisement.[97] The television advertisement depicted the Dundee look-alike fending off a would-be mugger by kicking him with his "Grosby Leatherz," much the same as "Mick Dundee" fends off a would-be mugger with a knife in the film.[98] With regard to the necessity of association between Hogan and Pacific Dunlop, both at trial and on appeal before the Full Court, a minimal level of content was adopted for this test.[99]

The Australian *Hogan* test presents some difficulties as a passing off proceeding because the absence of any test of association or the minimal content of any such test amounts to misappropriation under the guise of passing off.[100] The principle and analysis set out in the Australian *Hogan*

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89. (1988) 83 A.L.R. 187 (Austl.).

90. *Id.* at 196.

91. *Id.* at 188.

92. *Id.*

93. *Id.* at 201.

94. (1989) 87 A.L.R. 14, 43–44 (Austl.).

95. *Id.*

96. *Id.* at 61.

97. *Id.*

98. *Id.*

99. *See id.* at 30; *see also* Howell, *supra* note 51 at 217–19. Of the two majority judges on appeal, Justice Beaumont stipulated elements of "consent," "approval," or a "commercial arrangement" as meeting this test. *See id.* at 42–47 (Beaumont, J.). Justice Burchett went further, rejecting any need to establish an association at a conceptual level. *See id.* 44–46 (Burchett, J.).

100. Howell, *supra* note 6, at 206–07; *see also* Howell, *supra* note 51, at 221.

cases were nevertheless accepted in Ontario in *Paramount Pictures Corp. v. Howley*,[101] also involving Paul Hogan and the character "Crocodile Dundee," and in the United Kingdom in *Mirage Studios v. Counter-Feat Clothing Co. Ltd.*[102]

In *NHL v. Pepsi-Cola Canada Ltd.*,[103] also involving issues of character merchandising, the British Columbia Supreme Court found the tort of passing off comprises two broad categories of situations. The first involves a traditional context where the parties are competitors in a common field of activity and the defendant has presented its product or business to be that of the plaintiff.[104] The second situation falls short of the first. It involves the defendant promoting its product or business as "in some way approved, authorized or endorsed by the plaintiff or that there is some business connection between the defendant and the plaintiff."[105] This formulation parallels the recent developments in Australia, Ontario, and the United Kingdom.[106] However, under the *NHL* test, it is still "the product or business" of the defendant that must be seen to be "approved, authorized or endorsed" by the plaintiff.[107] In contrast, under the Australian *Hogan* test, it is sufficient if the public perceives that the celebrity consented to the use of his or her persona.[108] While the requirement of association for the purpose of a misrepresentation is slight under the Canadian test, the concept is still present in most jurisdictions.[109] In the Australian *Hogan* cases, this requirement was subsumed into the misappropriation test.[110]

If the passing off tort in Canada evolves to encompass the Australian *Hogan* test in the area of character merchandising, the scope and purpose of the tort of appropriation of personality would need to be considered. However, if the tort of appropriation of personality retains its exclusive

101. [1991] 5 O.R.3d 573, 582 (Can.).

102. 18 F.S.R. 145, 157 (Ch. 1990) (Eng.) (involving the fictitious, non-human "Teenage Mutant Ninja Turtles" characters). An "association" would be sufficient if "there should be a public awareness that the character . . . would have been created and licensed by someone who had a business interest in putting them on the market." *Id.* at 157.

103. [1992] 42 C.P.R.3d 390, 401 (B.C. Sup. Ct.), *aff'd*, [1995] 59 C.P.R.3d 216, 222–23 (B.C. Ct. App.).

104. *Id.*

105. *Id.*

106. *See Hogan*, 20 F.C.R. at 314; *Paramount Pictures*, 5 O.R.3d at 573; *Mirage Studios*, 18 F.S.R. at 145.

107. *See NHL*, 42 C.P.R.3d at 401.

108. *See Hogan*, 20 F.C.R. at 314.

109. *See NHL*, 42 C.P.R.3d at 401.

110. *See Hogan*, 20 F.C.R. at 314.

human focus, then it is valuable as a separate and discrete tort, covering both proprietary[111] and privacy injuries.[112]

Fortunately, the tort of appropriation of personality has continued in Canada with respect to celebrities. Indeed, the recent cases of *Gould Estate v. Stoddart Publishing Co.*,[113] *Horton v. Tim Donut Ltd.*,[114] and *Shaw v. Berman*[115] have presented, for the first time in Canadian common law jurisprudence, the issues of a public interest limit upon protection of personalities and the descendibility of personality rights.[116] Each of these cases saw the appropriation of personality claim denied in favor of a public interest in the use of the plaintiff's identity.[117]

III. THE PUBLIC INTEREST IN PUBLICATION

In *Gould Estate*, the court noted that the *Krouse* court recognized the need, in some circumstances, to find an otherwise infringing publication to be in the public interest and therefore not actionable. The Ontario Court of Appeal in *Krouse* offered little guidance as to the exact nature, scope, and circumstances of this interest.[118] Inevitably this has led to a comparison with the First Amendment "free expression" jurisprudence in the United States.[119] *Gould Estate*, *Shaw*, and *Horton* are the only Canadian common

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111. Proprietary injury refers to the taking of publicity values in a celebrity's persona even if the celebrity has not, himself or herself, engaged in marketing his or her persona.

112. Privacy injury refers to the taking of the persona of a person (whether or not of celebrated status) for some purpose (possibly limited to a business or professional purpose of the usurper).

113. [1996] 30 O.R.3d 520 (Ont. G.D.) (Can.) (holding that the publisher and author of a book about the plaintiff did not appropriate his personality in light of the fact that he was a famous Canadian pianist).

114. [1997] 75 C.P.R.3d 451 (Ont. G.D.), *aff'd*, No. C26845 (Ont. Ct. App. Oct. 10, 1997) (Can.) (holding that the appropriation of personality tort did not allow the widow of a famous hockey player to enjoin the use of a picture of the player where the defendant had acquired the rights previously).

115. [1997] 72 C.P.R.3d 9, 18 (Ont. G.D.) (Can.) (holding that the tort of appropriation of personality arises only where the plaintiff's identity is commercially exploited but does not arise where the plaintiff is the actual subject of the defendant's work).

116. The Civil Code in Quebec may well enable an estate or next of kin to bring proceedings for the violation of a privacy interest with respect to the deceased. Civil Code, S.Q. ch. 64 (1991) (Can.).

117. *See supra* notes 113–115.

118. *See Gould Estate*, 30 O.R.3d at 525 (regarding the analysis of the public interest defense in *Krouse*).

119. *See* U.S. CONST. amend. I. In Canada, section 2 of *The Canadian Charter of Rights and Freedoms*, (sections 1–34 inclusive of the *Constitution Act 1982* being Schedule B to the *Canada Act of 1982* (U.K.), reproduced in R.S.C. 1985, Appendix II, No. 44) provides for "freedom of . . . expression, including freedom of the press and other media of communication." However, this provision will not directly apply in disputes that do not involve some "government"

law authorities balancing these interests in a personality context. *Gould Estate* provides a complete analysis and presents the issue as "sales vs. subject." This issue reflects the distinction between usurpations primarily for commercial or merchandising purposes, where public interest in publication cannot displace the proprietary claim of the celebrity, and usurpations that are more in the nature of reporting on facts, ideas and newsworthy events, where the public interest in publication has greater weight.[120]

A more illustrative example of the public's interest in publication is found in a United States case, *Zacchini v. Scripps-Howard Broadcasting Co.*[121] This case involved a "human cannon-ball" act performed by the plaintiff at various fairs. The defendant broadcaster telecast the plaintiff's entire act in a news bulletin. The Ohio state courts essentially applied a public interest test and upheld the airing of Zacchini's act.[122] However, the United States Supreme Court reversed the state court decision, emphasizing two main points. First, the court found that the newsworthiness of the plaintiff's act could have been achieved by broadcasting only part of the act to the public.[123] Second, the court found a distinction between privacy and publicity interests—the public interest in publication is stronger in a privacy context. Conversely, publicity or proprietary interests are afforded greater weight in any balancing of interests.[124]

In Canada, support for the "sales vs. subject" distinction is found in British Columbia's statutory cause of action for use of "the name or portrait of another." To be actionable, the usage must be primarily for the defendant's benefit, as opposed to the reporting of "current or historical events or affairs, or other matters of public interest."[125] The unauthorized

involvement. *See generally*, PETER W. HOGG, 2 CONSTITUTIONAL LAW OF CANADA § 34.2(g) (1997). Common law "public interest" principles have, in related contexts, been interpreted and developed consistently with *Charter* principles and jurisprudence. *See* Hill v. Church of Scientology of Toronto [1995] 126 D.L.R.4th 129, 147- 70 (Can.).

120. *See Gould Estate*, 30 O.R.3d at 526–27; *Shaw*, 72 C.P.R.3d at 18 (following *Gould Estate* in the context of the American celebrity Artie Shaw and the making of a documentary film of his life); *see also Horton*, 75 C.P.R.3d at 451.

121. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977).

122. Specifically, the Ohio courts have applied, in this "publicity" context, the "public figure" analysis of *New York Times Co.* v. *Sullivan*, 376 U.S. 254 (1964), to deny recovery. This principle originated in defamation and later was extended to encompass certain privacy contexts.

123. *See Zacchini*, 433 U.S. at 574–75.

124. *Id.* at 571–78, 581; *see* Source Perrier (S.A.) v. Fira-Less Mktg. Co. [1983] 70 C.P.R.2d 61, 66–67 (Fed. Ct. Trial Div.) (Can.); R. v. James Lorimer & Co. [1984] 1 F.C. 1065, 1079 (Fed. Ct. App. Div.) (Can.) (upholding intellectual property rights as against the public interest in "free expression").

125. *See* Privacy Act, R.S.B.C. ch. 373, § 3(4), (5) (1996); *see also* Howell, *supra* note 16, at 196.

publication of the photographic biography in *Gould Estate*, for example, was found to have met a public interest by providing a "glimpse into Gould's solitary life" and "knowing more about one of Canada's musical geniuses."[126] The result is amply supported by authorities in the United States, assuming the biography presents a reasonably accurate depiction of the subject.[127] The context in *Horton* is less clear because the plaintiff's portrait was in a doughnut store where sales were taking place. The court found, however, that the display of the portrait did not involve merchandising.[128]

IV. THE DESCENDIBILITY OR SURVIVABILITY OF PERSONALITY INTERESTS

Only two cases in the Canadian common law jurisdictions have involved the assertion of personality rights by the estate of a deceased celebrity.[129] In *Gould Estate*, the court found that Gould's publicity rights were descendible and exercisable by the estate, subject to the public interest in publication. The court's rationale was threefold. First, the court drew a distinction between privacy and publicity interests. The court noted that whereas privacy interests are non-descendible or non-inheritable because of their nature as personal interests "in dignity and peace of mind," publicity interests, by contrast, are descendible or inheritable as property rights "akin to copyright or patent."[130]

Second, the court avoided the issue of a "durational limit" on the inheritance, an issue also difficult to determine in the United States. The court noted that "Gould passed away in 1982, and it seems reasonable to conclude that whatever the durational limit, if any, it is unlikely to be less than 14 years."[131] Third, the court found the statutory preclusion of descendibility of personality rights under provincial Privacy Acts in British Columbia, Newfoundland, and Saskatchewan to be inconsequential. The

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126. Gould Estate v. Stoddart Publ'g Co. [1996] 30 O.R.3d 520, 527 (Ont. G.D.) (Can.).

127. *See* MCCARTHY, *supra* note 46, § 8.8[E][1]. The example of the unauthorized biography of the celebrity recluse Howard Hughes bears some similarity to the situation in *Gould Estate*. *See Gould Estate*, 30 O.R.3d at 520. However, in *Aubry v. Duclos*, [1996] 71 C.P.R.3d 59 (Que. Ct. App.), *aff'd*, [1998] S.C.J. No. 30 (Can. Sup. Ct., Apr. 9, 1998), a case concerning the right of privacy under the Quebeç Charter of Human Rights and Freedoms, the Supreme Court of Canada rejected a "sales v. subject" approach. No reference was made to Canadian common law developments and any impact of the decision beyond the context of the Quebec Charter and a clear "privacy" interest is a matter for future determination.

128. Horton v. Tim Donut Ltd. [1997] 75 C.P.R.3d 451 (Ont. G.D.), *aff'd*, No. C26845 (Ont. Ct. App. Oct. 10, 1997) (Can.).

129. *Gould Estate*, 30 O.R.3d at 520; *Horton*, 75 C.P.R. at 451.

130. *Gould Estate*, 30 O.R.3d at 520.

131. *Id.*

court reasoned that because statutory actions were separate from common law proceedings, being the creation of legislatures, they could be limited as any legislature sees fit. Furthermore, because Canadian provincial statutory rights of action are found in the Privacy Acts, whatever statutory restrictions there may be on rights of action for privacy violations and unauthorized use of personality should not be applied to the common law tort of appropriation of personality.[132]

The first element of the *Gould* rationale distinguishes between privacy and property in the general law applicable to inheritance.[133] The second element is a pragmatic response to an issue of some conceptual difficulty. The third element is a determination that the statutory privacy torts are distinct from the common law tort of appropriation of personality and do not preempt the common law proceeding. In British Columbia, the proceeding in section 3 of the Privacy Act for the use of "the name or portrait of another" is a tort separate from the general statutory tort of "privacy." This is consistent with *Joseph v. Daniels*,[134] where the British Columbia Supreme Court viewed section 3 of the Privacy Act as available in addition to the common law tort.[135] Thus, the possibility of statutory preemption seems unlikely, although there is still a possibility for appellate review.

While a limitation on descendibility in any statutory context does not conclusively foreclose the opportunity to claim that element in a common law proceeding, it does, however, provide a factor of comparison and policy influence.[136] On the other hand, a positive comparison might be made with the descendibility of moral rights in copyright law.[137] As part of copyright protection, moral rights are proprietary, but by their nature present elements that can be compared with rights in defamation being partially directed to

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132. *Id.* at 527–29 (following the United States reasoning).

133. While this distinction between privacy and property (publicity) can be rationalized conceptually, whether a particular instance is properly categorized as one or the other is not always easy to determine. In *Gould Estate*, the claim of the estate could be readily seen as one of privacy because the pianist Glenn Gould is reported to have led and valued a very private life. Indeed, a factor in establishing a public interest in the publication by the defendant was that it gave a "glimpse into Gould's solitary life" and met a public interest in "knowing more about one of Canada's musical geniuses." *See supra* note 4 and accompanying text; *see also Gould Estate*, 30 O.R.3d at 520. Subsequently, on May 6, 1998, the Ontario Court of Appeal found Glenn Gould to have consented to the publication. *See* Gould Estate v. Stoddart Publ'g Co. [1998] O.J. No. 1894 (Ont. C.A., May 6, 1998). The case proceeded on the on the basis of ownership of the copyright in the photographs and interview notes.

134. [1986] 4 B.C.L.R.2d 239 (B.C. Sup. Ct.) (Can.).

135. *See generally id.* at 243–46. *See supra* note 60 and accompanying text.

136. *See* Howell, *supra* note 16, at 190–92 (discussing the potential interrelatedness of common law appropriation of personality and the privacy statutes).

137. Moral rights are stipulated in sections 14.1, 14.2, 28.1, and 28.2 of the Copyright Act. *See* Copyright Act, R.S.C. ch. C-42 (1985) (as amended) (Can.).

the dignity of an author.[138] They concern the right of an author: (a) to the integrity of the work protected by copyright; and (b) in specified circumstances to be associated with the work by name or under a pseudonym; or (c) to remain anonymous.[139]

The moral right of integrity is most significant in the context of personality and is closely linked with a dignity interest of the author. Under the Copyright Act, moral rights are infringed if "the honour or reputation of the author" is prejudiced by any (a) "Distortion, mutilation or other modification" to the work; or (b) use of the work "in association with a product, service, cause or institution."[140]

An infringement arising from the association of a work with a product is very similar to the tort of appropriation of personality, except that moral rights relate to the use of a work of an author or creator, whereas personality rights relate to the use of the celebrity's persona. Since 1988, the Copyright Act has expressly provided that the term or duration of moral rights is the same as that for the economic rights of copyright namely: (1) the life of the author; (2) the remainder of the calendar year of the author's death; and (3) an additional fifty years after the author's death.[141] In addition, the Copyright Act provides that moral rights are descendible.[142] Section 14.2(2) stipulates:

> The moral rights in respect of a work pass, on the death of its author, to:
>
> > (a) the person to whom those rights are specifically bequeathed;
> >
> > (b) where there is no specific bequest of those moral rights and the author dies testate in respect of the copyright in the work, the person to whom that copyright is bequeathed; or (c) where there is no person described in paragraph (a) or (b) the person entitled to any other property in respect of which the author dies intestate.[143]

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138. *See, e.g.*, COPYRIGHT AND THE INFORMATION HIGHWAY, FINAL REPORT OF THE COPYRIGHT SUB-COMMITTEE TO THE INFORMATION HIGHWAY ADVISORY COUNCIL 18 (Information Highway Advisory Council Secretariat, Ottawa ed., 1995) (Can.) (describing moral rights as "akin to an action in defamation").

139. Copyright Act, R.S.C. ch. C-42, § 14.1 (1985), *amended by* R.S.C. ch. C-15 (1988) (Can.).

140. *Id.* § 28.2.

141. *Id.* § 14.2(1).

142. *Id.* § 14.2(2).

143. *Id.* The Copyright Amendment Act 1997, S.C. ch. 24, § 13 (1997), added as § 14.2(3) that § 14.2(2) would apply "with such modifications as the circumstances require, on the death of any person who holds rights." *Id.* § 14.2(3).

This provision in a federal statute may be seen as an attempt to deal federally with a provincial jurisdiction in "succession" as opposed to the federal jurisdiction in "copyright."[144] However, this is unlikely because the provision simply links moral rights with economic copyright or ensures that moral rights will pass by intestacy to the person who is entitled to them under provincial statutory succession. This does not, therefore, present an attempt to legislate federally beyond a "copyright" context. Moral rights have long been recognized internationally as part of copyright[145] and in Canada since 1931.[146]

The analogy to moral rights of copyright might also assist with the difficult and somewhat arbitrary issue of duration of publicity rights in the estate of the deceased personality. Although there are many statutory periods of duration in the United States,[147] when these periods do not prevail, the copyright period of "life plus 50" has been suggested as the most appropriate term.[148]

In Canada, there has been no attribution of any jurisprudential theory to copyright law. Rather, copyrights remain simply defined as "statutory

144. Copyright is exclusively under federal jurisdiction. Constitution Act, 1867, § 91(23), (U.K.), *reproduced in* Copyright Act, R.S.C. ch. C-42 § 67.2 (1985) (Can.). For a possible comparative focus of constitutional conflict in an intellectual property context, consider the difficulties that have been raised by the apparent codification of provincial common law torts and contract in Trademark Act, R.S.C. ch. T-13 § 7 (1985) (Can.).

145. Moral rights are European in origin and were formally recognized in Article 6 of the Berne Convention (Rome, 1928). *See* Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, revised at Rome on June 2, 1928 art. 6 *bis*, 123 L.N.T.S. 235, 249.

146. Canada first enacted moral rights as part of its federal Copyright Law in 1931 in order to implement the 1928 Rome Revision of the Berne Convention. *See* Copyright Amendment Act, Stats. Can. 21–22 Geo. V. § 5 (1931), R.S.C. ch. C-30, § 12(7) (1970), *replaced by* R.S.C. ch. C-42, § 14(4) (1985), *revised by* R.S.C., ch. 10, § 1(3) (1988) (Can.); *see also* R.D. Gibbens, *The Moral Rights of Artists and the Copyright Act Amendments*, 15 CAN. BUS. L.J. 441, 444–45 (1989).

147. *See* MCCARTHY, *supra* note 46, § 9.4 (listing all state initiatives with varying periods of duration).

148. *Id.* (preferring this analogy, although considering ten to fifteen years to be enough). McCarthy rejects using trademark duration by analogy because he argues that publicity rights are "an inherent right owned by all persons at birth." *Id.* This suggests a "natural rights" theory, but such a theory would tend to deny any durational limitation. For example, common law copyright had no durational limit. In Canada, common law copyright lasted until 1924, but was incorporated in the 1921/1924 Copyright Act to allow copyright in perpetuity for an unpublished work. *See* Copyright Act, R.S.C. ch C-42 § 7 (1985) (Can.). However, section 6 of the 1997 Copyright Amendment Act amended section 7 of the principal act and now provides durational limits for unpublished works. *See* Copyright Amendment Act, S.C. ch. 24 § 6 (1997) (Can.). Likewise, protection at common law and equity for trade secrets can last forever if the security of the information giving it the quality of confidentiality is maintained. Furthermore, an analogy with trademark duration might indeed be appropriate if the personality rights depend upon actual "use" by the celebrity during his or her lifetime providing some "distinctiveness" to the celebrity.

rights," analogous to the right of publicity only by reference to moral rights, which enjoy the same durational term as the economic rights of copyright.[149]

V. CONCLUSION

This Article has noted the Privacy Acts in four common law provinces: British Columbia, Manitoba, Newfoundland, and Saskatchewan.[150] In Manitoba, Newfoundland, and Saskatchewan, only one general "privacy" tort has been created.[151] Only British Columbia has a separate tort, actionable without proof of damage and available to prohibit the unauthorized use of a person's name or portrait for the purpose of advertising or promoting the sale of, or other trading in, property or services.[152]

The primary common law cause of action protecting publicity or personality rights in Canada is the tort of appropriation of personality. This tort was developed in Ontario to overcome the difficulties and inability of the passing off tort to provide an effective remedy in a character merchandising context. While it is still a fledgling area of Canadian law, this Article illustrates a growing stream authorities supporting its use. More analysis is needed from the appellate courts, however, to completely define the elements and scope of the tort. The appropriation of personality tort has been favorably compared with the right of publicity proceeding in the United States. Canadian courts and legal scholars are currently addressing important issues within this area of law, such as how to balance this tort

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149. *See* Compo Co. v. Blue Crest Music, Inc. [1980] 1 S.C.R. 357, 373 (Can.) (holding a company that merely manufactured unlicensed records liable for violating the recording owner's copyrights, stating "[T]he right to do each [act provided under the Copyright Act] is . . . a separate statutory right, and anyone who without the consent of the owner of the copyright does any of these acts commits a tort; if he does two of them, he commits two torts, and so on."). The Copyright Act provides: "Moral rights in respect of a work subsist for the same term as the copyright in the work." Copyright Act, R.S.C. ch. C-42, § 14.2(1) (1985), *amended by* R.S.C. ch. C-15 (1988) (Can.). The general term for copyright in Canada is "the life of the author, the remainder of the calendar year in which the author dies, and a period of fifty years following the end of that calendar year." Copyright Amendment Act, S.C. ch. 24, § 6 (1997) (Can.).

150. *See supra* note 15 and accompanying text.

151. *See* Privacy Act, R.S.M. ch. P-125, § 3(c) (1987) (Can.); Privacy Act, NFLD. R.S. ch. P-22, § 4(c) (1990) (Can.); and Privacy Act, R.S.S. ch. P-24, § 3(c) (1978) (Can.).

152. Privacy Act, R.S.B.C. ch. 373 § 3(1) (1996) (Can.). This section provides detailed provisions concerning identification of the plaintiff and an intent "to exploit" by the defendant. *Id.* §§ 3(2)–(3). Furthermore, it includes defenses relating to news reporting and incidental usages of the name or portrait. *Id.* § 3(4). The provision is limited to a "name" or "portrait." The term "portrait" is defined as: "mean[ing] a likeness, still or moving, and includes a likeness of another deliberately disguised to resemble the plaintiff, and a caricature." *Id.* § 3(5). This definition would seem to exclude "sound-alikes" and the use of a model who "naturally" resembles the plaintiff.

with the public interest in publication and free expression, as well as the descendibility of personality rights. As this tort evolves, jurisprudence on the right of publicity in the United States, as well as similar rights in other common law countries, will likely be used as persuasive authority.