PUBLICITY RIGHTS IN THE U.K. AND THE U.S.A.: IT IS TIME FOR THE UNITED KINGDOM TO FOLLOW AMERICA'S LEAD

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I. INTRODUCTION

The right of publicity has been defined as the inherent right of every human being to control the commercial use of his or her identity.[1] Theoretically this right applies to all, but in reality the right of publicity is only applicable to a small percentage of society.[2] Similarly to how dilution claims only benefit famous marks,[3] a person must be a celebrity before right of publicity claims have any

1. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 28:1 (4th ed. 2014).

2. 2 Thomas D. Selz, Melvin Simensky, Patricia Acton, Robert Lind, Entertainment Law 3d: Legal Concepts and Business Practices § 13:5 (2013) ("The likelihood of a limited damage award for non-celebrities, as a practical matter, has made the right of publicity action one primarily for individuals who are celebrities.").

3. 15 U.S.C. § 1125(c)(1) (2012) ("Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.").

value.[4] For example, a first year law student may have the right to control the commercial use of her identity, but what is her identity worth in commerce? It is probably not worth much. So there would be little incentive to steal her image, and even if someone did misappropriate her likeness, her remedy would more likely lie in a right of privacy suit, rather than a Right of Publicity claim.[5] In contrast, Tiger Woods has the same right as the law student, but his image and identity are commercially valuable to him because of his fame. He has many companies that are willing to pay handsomely to use his image and likeness in various ways.[6] Partially because it is celebrities who really use the Right of Publicity, opinions on whether the right is good or bad for society will likely correlate with one's opinion of celebrity culture. Still, love it or hate it, the Right of Publicity has expanded in the U.S. over the past several decades. Like the U.S., many countries have extensive protection for the Right of Publicity; however, not all countries recognize the right.[7] First and foremost among those that do not provide significant Right of Publicity protection is the United Kingdom.[8]

In the area of protecting likenesses, the U.K. has chosen a very different path from the U.S. This comment will first argue that publicity rights are good and should be protected. It will then summarize both the United States' and the United Kingdom's protection for Publicity Rights. Finally, it will conclude by summarizing and arguing that the United States has the better approach to the Right of Publicity, and the United Kingdom should follow its lead.

4. Memphis Development Foundation v. Factors Etc., Inc., 616 F.2d 956, 957 (6th Cir. 1980) ("The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality.").

5. *See* Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford, A Global Perspective on the Right of Publicity*, 15 Tex. Intell. Prop. L.J. 239, 246 (2007) (explaining that one of the main reasons for developing a Right of Publicity in the first place is because the tort for invasion of privacy was only available to those who were not placing themselves in the public eye, so for someone who is not in the public eye there is little need or use for the Right of Publicity).

6. *See* Kurt Badenhausen, *Tiger Woods Is Back On Top Of The World's Highest-Paid Athletes*, Forbes.com, June 24, 2013, http://www.forbes.com/sites/kurtbadenhausen/2013/06/05/tiger-woods-is-back-on-top-of-the-worlds-highest-paid-athletes/ (showing that in 2012, Tiger Woods made 65 million dollars in revenue from endorsements alone. Clearly, his identity has more commercial value than a first year law student's).

7. Matthew Savare, *Publicity Rights: Image is Everything*, Intellectual Property Magazine, March 2013, at 53, 54 (France, Spain, Italy, and Germany, all have well-established publicity rights for celebrities, but the United Kingdom does not).

8. *See* Lapter, *supra* note 5, at 278.

II. ARE PUBLICITY RIGHTS BAD OR GOOD?

Not everyone has the direct need for the Right of Publicity.[9] As indicated in the example of the first year law student, most people have no commercial value in their identity. But does that mean that the right is bad for society? The answer is complex, but there are both economic and moral reasons to keep and value the Right of Publicity.

Alain Lapter, an expert in intellectual property, submits that the right of publicity "encapsulates protection of market value, economic incentive, and the internalization of externalities."[10] Specifically, Lapter argues that celebrities are best suited to protect the market value of their images because they have the most interest in doing so.[11] The Right of Publicity enables them to do this. He adds that, without protecting their value, celebrities would lose incentive to excel in their chosen fields, and the economy, as a whole, would suffer.[12] When Lapter uses the term internalization of externalities, he means that by embracing the Right of Publicity celebrities are forced to internalize responsibilities for their decisions.[13] In other words, if celebrities make unwise choices that negatively impact their professional or financial lives, the Right of Publicity helps ensure that the credit or blame comes back to them.[14]

In additional to the economic justification, celebrities' fame can be seen as the fruits of their labors. Though some scholars dispute this,[15] most celebrities become famous because they put in a lot of work and creativity into something—whether that is sports, music, movies, business, politics or something else.[16] This argument aligns itself with Locke's labor theory; if a person works hard to build

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9. *See supra* note 2.

10. Lapter, *supra* note 5, at 251.

11. *See id.*

12. *See id.* at 252.

13. *Id.*

14. *Id.*

15. Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 Calif. L. Rev. 125, 179 (1993) ("plenty of people become famous nowadays through sheer luck, through involvement in public scandal, or through criminal or grossly immoral conduct. More to the point, even commercially marketable fame can be achieved in this fashion.").

16. *Compare* Lapter, *supra* note 5, at 257 (asserting that there are many celebrities who put significant work into their craft or occupation. For these individuals the media only sheds light on that work; it does not do the work for the celebrities. Furthermore, he points out that those who help a celebrity become famous are already paid for their efforts, so the celebrity does not owe them, or anyone else a portion of the celebrity's likeness or image), *with* Madow, *supra* note 15.

his or her image, that person should be able to decide how it is used and who profits from it.[17]

Celebrity culture is probably here to stay. The question is, when celebrities try to protect their likeness and identity from commercial misappropriation and exploitation, will they have a fitting legal remedy for the wrong suffered?

III. PROTECTION UNDER U.S. LAW

Individuals, and especially celebrities, have two general options in the U.S. legal system to protect the commercial use of their likenesses.[18] The first option goes through the Lanham Act, which is primarily the federal statute regulating trademarks in the U.S.[19] The other option is state right of publicity laws.[20] Because the purposes of the claims are different, each requires the plaintiff to prove somewhat different elements.[21] Thus, as discussed below, state right of publicity laws provide protection in areas that would not be protectable under a Lanham Act claim. Still, between the two options, celebrities in the United States have a robust legal scheme that they can turn to protect their Publicity Rights.

A. *The Lanham Act*

The first of the two paths, the Lanham act, has two primary purposes: "to protect consumers from misrepresentations or deceptions and to protect trademark owners from the misperception that they are associated with or endorse a product."[22] Because of those goals, individuals bringing a Right of Publicity claim under the Lanham Act must show that consumers thought the celebrities were associated with or endorsed the defendant's product.[23] Despite the Lanham Act's narrow scope, celebrities have frequently tried to use it as a basis for protecting their likenesses.[24] This is largely due to the fact that there is

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17. *See* Lapter, *supra* note 5, at 253.

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

19. *See id.* at 1206.

20. *Id.* at 1204 ("The right of publicity branch of the privacy tort separated itself from the other privacy claims in 1953 when the United States Court of Appeals for the Second Circuit coined the term 'right of publicity.'").

21. *See id.* at 1214.

22. *Id.* at 1206.

23. *See id.*

24. *See, e.g.*, Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983); *see also* Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992); *and* Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407 (9th Cir. 1996).

no federal right of publicity; so if a celebrity wants to file the suit in federal court, bringing the suit under the Lanham Act provides the subject matter jurisdiction needed to do so.[25] Section 43(a)(1) of the Lanham Act states:

> Any person who, . . . in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.[26]

This language is broad enough to allow individuals, trying to protect their likenesses under the Lanham Act, to choose from two different federal claims. They can either file a claim of false endorsement or a claim of infringement of an unregistered mark.[27] Different circuits have different tests for evaluating false endorsement claims,[28] but the 9th Circuit, which tends to see more Publicity Right cases due to the large number of celebrities residing in the circuit (primarily California), uses a slightly modified likelihood of confusion test.[29] The modified likelihood of confusion test is designed to gauge whether "consumers are likely to be confused and think that the plaintiff has endorsed the product."[30] Thus, the focus of the false endorsement claim is in measuring consumer reaction rather than protecting the celebrity's identity.

For the infringement of an unregistered mark claim, courts require "plaintiffs [to] show that they own a valid, legally protectable trademark and that the defendant's subsequent use of a similar mark is likely to cause confusion as to

25. Brandon Johansson, *Pause the Game: Are Video Game Producers Punting Away the Publicity Rights of Retired Athletes?*, 10 Nev. L.J. 784, 790 (2010) (asserting that if the Lanham Act does not provide relief, individuals must look to state law for a remedy).

26. 15 U.S.C. § 1125(a)(1)(A)-(B) (2013).

27. Johansson, *supra* note 25, at 790.

28. Solomon, *supra* note 18, at 1214.

29. *See id.* (asserting that California uses the likelihood of confusion test, and stating, "[a]s these factors do not neatly apply where the use of a likeness is at issue the courts have had to make certain adjustments. Thus, the 'mark' refers to the celebrity's likeness or persona; 'strength' refers to the celebrity's level of fame or recognition, including the degree of fame among the consumers of defendant's goods; and the 'similarity of the goods' requires a comparison between the reasons for the celebrity's fame and the alleged infringer's products.").

30. Johansson, *supra* note 25, at 791.

the origin of the goods."[31] This is different from the first claim under the Lanham Act because the first deals only with false endorsement, while under the second claim the plaintiff is trying to show that consumers are confused as to who produced the product or service. This is the least common of the two claims under the Lanham Act because its elements are more difficult to prove than a false endorsement claim.[32] The elements are more difficult to prove because "[f]or a likeness to be protected as a trademark it must have a meaning independent of the person; it must refer not just to the individual but to the goodwill of a commercial enterprise."[33] Since it is less common for a celebrity to also be the source of goods or services, claims for infringement of an unregistered mark are rare.

Though the primary purpose of the Lanham Act is to protect consumers, courts have said that it also "protect[s] commercial parties against unfair competition."[34] Because of courts' occasional willingness to interpret Lanham Act protection broadly, celebrities are occasionally successful using the Lanham Act to protect Publicity Rights.[35] In *Waits v. Frito-Lay*, for example, the professional singer Tom Waits was successful in a false endorsement claim against Frito-Lay for using a sound-alike in one of its commercials.[36] Waits argued that "by using an imitation of his distinctive voice in an admitted parody of a Tom Waits song, the defendants misrepresented his association with and endorsement of SalsaRio Doritos."[37] The 9th Circuit agreed, concluding that there was sufficient evidence that "consumers were likely to be misled by the commercial."[38] In another false endorsement claim, the 9th Circuit established that a celebrity has the right to control the commercial use of his or her former name.[39] In that case, GMC referred to the accomplishments of the famous basketball player, Kareem Abdul-Jabbar, during a commercial, analogizing the quality of the car to Abdul-Jabbar's basketball talent.[40] Even though GMC used Abdul-Jabbar's former name, Lew Alcindor, in the commercial, the court reasoned that the Lanham Act protected Abdul-Jabbar's commercial interest in

31. *Id.*
32. Solomon, *supra* note 18, at 1215.
33. *Id.*
34. Waits v. Frito-Lay, 978 F.2d 1093, 1108 (9th Cir. 1992).
35. Solomon, *supra* note 18, at 1207.
36. *Waits*, 978 F.2d at 1106-07.
37. *Id.*at 1106.
38. *Id.* at 1111.
39. Abdul-Jabbar v. GMC, 85 F.3d 407, 413 (9th Cir. 1996).
40. *Id.* at 409-410.

his former name because its use was likely to make consumers believe that the plaintiff was endorsing or associated with GMC's products.[41]

While several celebrities have found success filing Right of Publicity claims under Lanham Act, it often proves to be a poor fit.[42] One reason is because, even though courts recognize that the Lanham Act can protect against unfair competition, the measurement for violations and infringement is based on consumer reaction and confusion. For example, in 1982, the 6th Circuit denied an unfair competition claim under the Lanham Act in *Carson v. Here's Johnny Portable Toilets, Inc.*[43] In that case, the famous television personality Johnny Carson, alleged that the defendant violated section 43(a) of the Lanham Act by using the well-known phrase "here's Johnny" in the name of its products.[44] The court ruled in favor of the defendant on the Lanham Act claim, reasoning that the plaintiff failed to show a likelihood of confusion among consumers as to the plaintiff's association with the product.[45] This is significant because even though there was no likelihood of confusion, it was still clear that the defendant was commercially exploiting the plaintiff's identity. Thus, generally the stronger protection in the United States for the Right of Publicity is found in state common laws and statutes.[46]

B. *State Right of Publicity Laws*

The common law right of publicity began in the United States as a subcategory of the right of privacy.[47] The first case to recognize a separate right of publicity from the traditional right of privacy was *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*[48] In *Haelan*, Haelan Laboratories had exclusive

41. *Id.* at 411-413.

42. Solomon, *supra* note 18,. at 1206; Additionally there are several defenses (these are beyond the scope of this paper and will not be addressed other than here) that can come in to play under Lanham Act claims, making it harder for a plaintiff to prevail in a lawsuit. *See generally, e.g.,* Brown v. Elec. Arts, Inc., 724 F.3d 1235 (9th Cir. 2013) (The use of Jim Brown's likeness in a video game was protected because it was part of EA Sport's artistic expression in their videogame, protected under the 1st Amendment Fair Use Defense).

43. 698 F.2d 831 (6th Cir. 1982).

44. *Id.* at 833. The court called the claim "unfair competition" without specifying whether it was false endorsement or infringement of an unregistered mark, but based on the court's analysis it was likely combining both.

45. *Id.* at 834.

46. Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996).

47. *Id.*

48. 202 F.2d 866, 868 (2nd Cir. 1953).

contracts to use several baseball players' photographs on baseball cards.[49] Topps Chewing Gum, a competitor of Haelan, used a player's photograph during the duration of his exclusive contract with Haelan.[50] The court held Topps violated Haelan's interest in the player's right of publicity.FN50-1 For the first time the court recognized that the players had a right in "the publicity value of [their] photographs" or, in other words, they a right "to grant the exclusive privilege of publishing [their] pictures" to Haelan Laboratories.[51] Though federal courts, including the Supreme Court,[52] often hear and decide Right of Publicity cases, the right is usually found in state laws. As one commentator explains,

> [t]he right of publicity is a creature of state law, and the creature takes many forms. Well over half the states have either a statute or common law doctrine that provides a basis for a right of publicity claim, and most of the remaining states recognize a right to privacy that covers appropriation of one's name or likeness. The legal basis, elements of proof, and scope of allowable claims vary state by state, but most recognize a claim based in misappropriation, unfair competition or the right to privacy.[53] [54]

A big difference between Lanham Act claims and state right of publicity claims, and the reason that a state Right of Publicity claim is generally easier to prove, is that state Right of Publicity claims exist to "protect an individual's right to remuneration and prevent misappropriation and unjust enrichment from the theft of good will," while Lanham Act claims are measured by—and created for the primary purpose of—preventing consumer confusion.[55] State Right of publicity claims vary significantly in scope from state to state, but the elements stay basically the same.[56] The standard common law right of publicity claim requires that a plaintiff prove "(1) the defendant's use of the plaintiff's identity;

49. *Id.* at 867.

50. *Id.*

50-1 *Id.* at 869.

51. *Id.* at 868.

52. *See e.g.* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 569 (1977).

53. 1 Anne Gilson LaLonde, Gilson on Trademarks § 2B.03 (2013).

54. If an individual tries to bring a right of publicity claim in federal court, the court will only hear it if it has diversity or supplemental jurisdiction. *See e.g.*, Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 833 (6th Cir. 1983). Many athletes bring a right of publicity claim along with the federal Lanham Act claim; however, as seen in *Brown*, infra, if the Lanham Act claim is dismissed, the remaining claim will be sent to state court, as the federal court will lose its supplemental jurisdiction. Brown v. Elecs. Arts, Inc., No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387, at *15-16 (C.D. Cal. 2009).

55. Gilson, *supra* note 53.

56. Lapter, *supra* note 5, at 272.

(2) the appropriation of the plaintiff's name or likeness to the defendant's advantage, commercially or otherwise; (3) the lack of consent; and (4) a resulting injury."[57] State Right of publicity *statutes* are often worded similarly.[58] For example, California's statutory protection states that "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise . . . goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereofFalse"[59] Though the elements of the common law right of publicity appear virtually identical to the California codified version, California has made it clear that they are two distinct claims.[60] Thus, a celebrity can bring both claims at once.

Frequently, celebrities who bring Lanham Act claims in federal court will include state Right of Publicity claims with them.[61] For example, when Johnny Carson filed his Lanham Act claim against Here's Johnny Toilets, he included a state Right of Publicity claim.[62] Even though he lost on his Lanham Act claim, he won on his Right of Publicity claim because he did not have to prove consumer confusion.[63] As the court in *Carson* stated, "the right of publicity protects the celebrity's pecuniary interest in the commercial exploitation of his

57. Abdul-Jabbar v. GMC, 85 F.3d 407, 413-14 (9th Cir. 1996) (*quoting* Eastwood v. Superior Court for Los Angeles County, 198 Cal. Rptr. 342, 347 (Cal. App. 1983)). The court, in *Abdul-Jabbar*, added that the appropriation was not limited to the name or likeness, but extended to the plaintiff's identity. *Abdul-Jabbar* at 414.

58. Cal. Civ. Code § 3344(a) (2013). California's statute provides strong protection for Publicity Rights.

59. *Id.*

60. *See* Newcombe v. Adolf Coors Co., 157 F.3d 686, 691-92 (9th[th] Cir. 1997) (making it clear that the California statute "neither replaces nor codifies the common law cause of action"). Defendants can raise three affirmative defenses to try and avoid liability under the Lanham Act: consent, first amendment, and fair use. Solomon, supra note 15, at 1216. Consent and First Amendment defenses are available in right of publicity claims, but fair use is not. *Id.* Solomon explains that "built into the Lanham Act are defenses not applicable to right of publicity claims and that have the tendency to limit the ability of the Lanham Act to redress claims for misappropriation of one's persona." *Id.* The reason that the fair use defense is not available in right-of-publicity claims directly flows from the purpose of the Lanham Act (to prevent consumer confusion) as opposed to the purpose of the right of publicity, which is to protect an individual's right to profit off his or her likeness. *Id.* The Lanham Act contains a statutory fair use exception to liability, 15 U.S.C. § 1115(b)(4) (2012), and a nominative fair use defense, Johansson, supra note 25, at 794, either of which, if successfully raised, will remove the defendant's liability.

61. *See, e.g.,* Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 832 (6th Cir. 1982); *see also* Waits v. Frito-Lay, 978 F.2d 1093, 1093 (9th Cir. 1991); *and* Abdul-Jabbar, 85 F.3d at 409.

62. *Carson*, 698 F.2d at 832.

63. *Carson*, 698 F.2d at 834.

identity."[64] In another state Right of Publicity case, the 9th Circuit held Samsung liable for using, in one of its commercials, a robot that was dressed like Vanna White in a Wheel of Fortune setting.[65] The court there reasoned that "[c]onsiderable energy and ingenuity are expended by those who have achieved celebrity value to exploit for profit. The law protects the celebrity's sole right to exploit this value."[66] As shown in *Carson* and *White*, courts in the U.S. are willing to give broad protection to celebrities' identities. The United States' approach to the Right of Publicity isn't perfect, but through the courts' liberal interpretations of the Lanham Act and states' willingness to address the Right directly, celebrities are usually able to control the commercial use of their identities.

IV. PROTECTION IN THE UNITED KINGDOM

In contrast to the United States, the United Kingdom recognizes no specific right of publicity.[67] As a result, celebrities who try to protect their images and likenesses are forced to choose between several different legal routes.[68] Yet, trying to protect the right of publicity through the various related laws in the United Kingdom is like trying to put a square into a round hole. As one commentator accurately said, "the English courts have narrowly construed publicity protection under these devices."[69] Some celebrities have had limited success, but the laws do not provide a comprehensive solution.[70]

A. *Copyright Law*

The Copyrights, Designs and Patent Act of 1988 (CDPA) states that:

> A person who for private and domestic purposes commissions the taking of a photograph or the making of a film has, where copyright subsists in the resulting work, the right not to have copies of the work issued to the public, the work exhibited or shown in public, or the work communicated to the public.[71]

64. *Id.*
65. White v. Samsung Elecs. Am., 971 F.2d 1395, 1396 (1991).
66. *Id.* at 1399.
67. Lapter *supra* note 5, at 278.
68. *Id*.
69. *Id.* at 279.
70. *Id.* at 282.
71. Copyrights, Designs & Patents Act, 2003, c. 48 § 85 (Eng.).

Based on the wording in the statute, an individual should be able to protect her likeness when it is fixed in a photograph or film. Of course, this is only true if that individual "commissioned" the work to begin with.[72] And even if the celebrity owns the copyright in a photograph or film, the law only prevents an infringer from copying all of, or a "substantial part" of, the original work.[73] Proving that an infringer copied a substantial part of the original work can be challenging. For example, in *Bauman v. Fussell*, where an artist created a painting based on a copyrighted photograph, the court held that there was no infringement because the artist creatively infused originality into it, and therefore the painting was not substantially similar to the original photograph.[74]

In addition to the inherently subjective nature of measuring infringement, U.K. courts have a disposition against protecting individuals' likenesses. This attitude is reflected in *Re: Elvis Presley Trademarks, Inc.*,[75] where Elvis Presley Enterprises was trying to register three marks as trademarks in the United Kingdom.[76] All three were denied for lack of distinctiveness, but more relevant here is the court's opinion on copyright protection and its application to celebrity identities:

> Elvis Presley did not own his name so as to be able to prevent all and any uses of it by third parties, so Enterprises can have no greater rights. Similarly, Elvis Presley did not own his appearance. For example, during his life he could not prevent a fan from having a tattoo put on his chest or a drawing on his car which looked like the musician simply on the basis that it was his appearance which was depicted. For the same reason under our law, Enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any of the myriad of photographs, including press photographs, and drawings in which it

72. Carrie Rainen, Current Development, *The Right of Publicity in the United States and the United Kingdom*, 12 New Eng. J. Int'l & Comp. L. 197, 216, 218 (Though commissioned photographs and videos are not usually the works with a high likelihood of being copied, the CDPA may be more applicable for those who have authorized works exploited on the Internet.).

73. Copyrights, Designs & Patents Act, 2003, 48 § 16(3)(a); Rainen, *supra* note 72, at 216, 217 (Quantifying a "substantial amount" can be an extremely subjective determination, which puts a lot of discretion in the hands of the justice.).

74. 1978 R.P.D. & T.M. 485-86 (C.A.) (Eng.) (*Bauman* was a case dealing with a picture of two roosters fighting. According to the majority of the court, the colors were more intense in the painting than in the photograph reflecting the artist's creativity. Thus the court affirmed the lower court's decision that there was no infringement because a "substantial amount" of the original work had not been copied.).

75. Re: Elvis Presley Trademarks, Inc., [1997] R.P.D.T.M.C. 543 (Ch.) (Eng.).

76. *Id.*

> does not own the copyright simply by reason of the fact that they contain or depict a likeness of Elvis Presley.[77]

With this attitude, it is no surprise that U.K. copyright law provides little hope for likeness protection. U.S. copyright law does not provide protection for an individual's likeness either,[78] but the difference is that in the United Kingdom there is no per se Right of Publicity. This makes the courts' reluctance to embrace a broad application of the CDPA more damaging to celebrities.

Based on the current U.K. approach to publicity rights under the CDPA, the only protection for celebrities' identities will come in the scenario where they authorize a photograph or recording, own the copyright, and have it copied completely or in substantial part. Unfortunately, this means that a very small fraction of cases involving publicity rights will be actionable. Therefore, celebrities must look elsewhere for protection.

B. *Trademark Law*

Unfortunately, celebrities looking to protect their images and likenesses in the U.K. through trademark law will probably be disappointed because it does not cover many more scenarios than the CDPA covers. Though U.K. trademark law seems to give celebrities hope at first, in reality it does little for them.

The Trade Marks Act of 1994 (TMA) allows "any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking form those of other undertakings" to be registered as a trademark.[79] It even expressly allows personal names to be registered as long as they distinguish the applicant's goods.[80] However, because only *registered* trademarks are protected under the TMA[81], the protection does not do anything

77. *Id.*

78. 17 U.S.C. § 102 (2014). (In the U.S. Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include . . . literary works; musical works, including any accompanying words; dramatic works, including any accompanying music; pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works. In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work. Just like in the United Kingdom, celebrities can protect their likeness if it is fixed in or on something, but are unable to assert copyrights in their likeness alone.)

79. Trade Marks Act 1994, c. 26 § 1(1).

80. *Id*.

81. § 2(1) (The statute also states that it does not prevent or bar a passing off claim.).

for celebrities unless they can register their names. Furthermore, it is nearly impossible for celebrities to get their names registered as trademarks in the U.K. because the more famous the celebrities are the less distinctiveness their names possess.[82] For example, in *Re: Elvis Presley Trademarks, Inc.*, the court refused to register the name "Elvis Presley" because it was so commonly known that it possessed no distinctive quality to identify goods.[83]

Even if a celebrity is fortunate enough to have his or her name registered, he or she will only be able to enforce trademark rights against identical or similar goods.[84] This makes the TMA a poor fit for publicity rights because it essentially only offers protection against direct competitors.[85]

C. *The Common Law Tort of Passing Off*

When compared to the protection available through U.K. copyright and trademark law, the common law tort of passing off offers celebrities a fair amount of protection. One commentator has observed that "the most common action used to enforce image rights in the U.K. is the tort of passing off."[86] The passing off tort requires a plaintiff to prove that she has goodwill attached to the goods, the defendant has misrepresented her, and she has suffered damage as a result.[87] Though no trademark registration is required to bring a claim of passing off, in other respects it is very similar to trademark infringement.[88] U.K. courts

82. Hayley Stallard, *The Right of Publicity in the United Kingdom*, 18 Loy. L.A. Ent. L.J. 565, 569 (1998).

83. Re: Elvis Presley Trademarks, Inc., [1997] R.P.D.T.M.C. 543 (Ch.) (Eng.) (Laddie, J reasoned that: The distinctiveness addressed by the Act is not a quality of the mark which exists in a vacuum. It is a particular type of distinctiveness, namely the ability to distinguish the proprietor's goods from the same or similar goods marketed by someone else. The more a proposed mark alludes to the character, quality or non-origin attributes of the goods on which it is used or proposed to be used, the lower its inherent distinctiveness.)

84. Trade Marks Act 1994, c. 26 § 10(1-3) (Technically, section 10(3) is worded to prevent would-be infringers from "using a mark that takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the owners trade mark," but case law does not address this section as applied to celebrity names serving as trade marks (probably because such few celebrities have their names registered in the first place that there have been no cases on point).

85. Copyrights, Designs & Patents Act, 1988, Ch. 48 § 85 (Eng.) (2003).

86. Jeremy Blum and Tom Ohta, *Personality Disorder: Strategies for Protecting Celebrity Names and Images in the U.K*, Journal of Intellectual Property Law & Practice (2014).

87. *Id.* at *2.

88. Rainen, *supra* note 72, at 222. ([Passing off] is similar to the concepts of unfair competition and trademark infringement in the United States, where the goods of one person are misrepresented in a way that may adversely affect a proprietary right of another.).

have traditionally been hesitant to apply the protection available through passing off claims to individuals' likenesses, but have shown more willingness to do so recently.

Several decades ago, in 1976, the group ABBA was turned down in its attempt to enjoin Anabas Products from putting the group's picture on t-shirts and pillowcases.[89] The court did not believe that the consuming public would really be confused that ABBA was selling the products when they were not in the business of selling t-shirts and pillowcases.[90] Acknowledging that Anabas may be profiting off of the reputation that the group had earned[91], the court was still unwilling to give protection to the group in its image and likeness when no consumer confusion was likely.[92]

More recently, however, a celebrity was successful in a claim of passing off when he filed a lawsuit against a radio station that used his likeness in an advertisement.[93] The plaintiff, Eddie Irvine, was a famous racecar driver in the United Kingdom.[94] He had participated in endorsement deals with various companies.[95] The defendant, Talksport, Ltd. (TSL) was one of the largest commercial radio stations in the U.K. and had recently switched its primary coverage from news to sports.[96] In that case, TSL took a photograph of Mr. Irvine while he was talking on his phone.[97] TSL then digitally inserted its radio station logo into the photograph to make it look like Mr. Irvine was holding a device with the TSL logo on it.[98] TSL then placed the doctored photograph on an advertising brochure sent to various businesses.[99] The court there was clear in determining that TSL misrepresented that Mr. Irvine was endorsing or associated

89. Lyngstad v. Anabas Pros. Ltd., [1977] F.S.R. 62, 70 (Eng.).

90. *Id.* at 67-68.

91. *Id.* at 65.

92. *Id.* at 67-68 (In holding against Abba, Oliver J reasoned: I am entirely unsatisfied that there is here a real possibility of confusion. I do not think anyone reading the advertisements of which complaint is made or indeed receiving the goods described in them could reasonably imagine that all the pop stars named in the advertisements were giving their approval to the goods offered or that the defendants were doing anything more than catering for a popular demand among teenagers for effigies of their idols. There is no business of the plaintiffs here with which in my judgment the defendants' goods could possibly be confused. To suggest that there is some proprietary right in the plaintiffs' name which entitled them to sue simply for its use is contrary to all the English authorities.).

93. Irvine v. Talksport Ltd., [2002] EWHC 367 (Ch).

94. *Id.* at ¶ 2.

95. *Id.* at ¶¶ 52-54.

96. *Id.* at ¶ 3.

97. *Id.* at ¶ 7.

98. *Id.*

99. *Id.* at ¶ 8.

with the station in some way.[100] More important, however, was the reasoning that, in the decision, the court expanded the scope of passing off claims.[101] It acknowledged that when a celebrity endorses a product the value that the celebrity has is not limited to being a source of a product, but includes "the lustre of a famous personality."[102]

This expansion in the scope of the tort of passing off was a significant improvement for celebrities, and will likely provide remedies for many more cases of likeness appropriation. So would ABBA have been successful if its case had been decided in 2002 instead of 1976? The answer is unclear, because as good as it is for celebrities to have protection to their identities used in endorsements, not all commercial uses deal with endorsements.[103] Putting a celebrity's picture on a product, like what Anabas Products, Ltd. did in the '70s is not necessarily misrepresenting that the celebrity is endorsing the product, yet it is still exploiting the celebrity's image for commercial purposes.[104]

This issue was addressed in the 2013 case of *Fenty v. Arcadia Group Brands, Ltd.*, a court in the U.K. held a clothing company liable for placing Rihanna's face on a t-shirt without her permission.[105] Even though that case was not about

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100. *Id.* at ¶ 73.

101. *Id.* at ¶¶ 39-46. Laddie J reasoned that,

> The court can take judicial notice of the fact that it is common for famous people to exploit their names and images by way of endorsement. They do it not only in their own field of expertise but, depending on the extent of their fame or notoriety, wider afield also. It is common knowledge that for many sportsmen, for example, income received from endorsing a variety of products and services represent a very substantial part of their total income. The reason large sums are paid for endorsement is because, no matter how irrational it may seem to a lawyer, those in business have reason to believe that the lustre of a famous personality, if attached to their goods or services, will enhance the attractiveness of those goods or services to their target market. In this respect, the endorsee is taking the benefit of the attractive force which is the reputation or goodwill of the famous person. . . . Manufacturers and retailers recognise the realities of the market place when they pay for well known personalities to endorse their goods. . . . The law of passing off should do likewise. It follows from the views expressed above that there is nothing which prevents an action for passing off succeeding in a false endorsement case.

Id.

102. *Id.* at ¶ 39.

103. *See, e.g.,* Lyngstad v. Anabas Pros. Ltd., [1977] F.S.R. 62 (Eng.) (dealing with pictures of the group on t-shirts as merchandise).

104. *Id.* at 65.

105. *See* Fenty v. Arcadia Group Brand, Ltd., [2013] EWHC 2310 (Ch.). Topshop had permission from the photographer, who owned the copyright, but not from Rihanna. *Id.* In that case Justice Birss re-emphasized the U.K.'s position regarding image (publicity) rights when he said:

false endorsement like *Irvine*, the court reasoned that consumers were likely to be confused that the t-shirt was official Rihanna merchandise.[106] The court's expansion of the tort of passing off into merchandising cases was yet another step towards the United States Right of Publicity, yet the court was clear that it was not embracing what it called "image rights."[107]

Based on the *Fenty* decision, ABBA may be more successful today then it was in 1976, but the court is far away from a scenario like the one in *White v. Samsung*, where a company did not use the celebrity or a photograph of the celebrity, but a robot dressed in a way that reminded the consumers of the celebrity.[108] Even the broadest view of the *Irvine* and *Fenty* decisions would likely not protect against that type of commercial use because the focus in the U.K. is still on the likelihood that consumers will be confused.[109] With this in mind, the tort of passing off, though significantly better than thirty years ago, falls short of the kind of likeness protection celebrities need in the U.K.

D. *Breach of Confidence*

For many years, the United Kingdom, like most developed nations, has enforced protection from image exploitation when included in the terms of a contract.[110] This, however, was not significantly helpful because it only protected

> It is important to state at the outset that this case is not concerned with so called 'image rights'. Whatever may be the position elsewhere in the world, and how ever much various celebrities may wish there were, there is today in England no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image.

Id. at *74. Still, the court in *Fenty* concluded that, just as in *Irvine*, [2002] EWHC 367 (Ch), the tort of passing off is expanding, and now includes merchandising. *Fenty*, [2013] EWHC 2310 (Ch.) at *79-80. It reasoned that because Topshop made an effort to link itself to Rihanna, it was likely that consumers would think the products were the official Rihanna products. *Id.* at *88.

106. *Id*.

107. *Id.*

108. *See generally* White v. Samsung Electronics Am., Inc., 971 F.2d 1395 (9th Cir. 1991).

109. Stallard, *supra* note 82, at 570.

110. *Id.* Stallard points out that,

> When a personality has entered into a specific promotional contract with a product manufacturer for the right to use the person's name or image in connection with the promotion or sale of particular merchandise for a set term, and the contract contains a promise not to exploit the right after the term has expired, the manufacturer would be in breach if it uses the name or image after the end of the term.

Id. at 574. As an example, she references Creation Records Ltd. V. New Group Newspapers Ltd., [1997] E.M.L.R. 444 (Eng.), where a music group was successful in preventing a

likeness misappropriation if committed by one of the parties of the contract.[111] Another closely related remedy was found in the concept of confidence, which could provide a claim for likeness appropriation as long as the parties were in a pre-existing relationship.[112] However, when the United Kingdom enacted the Human Rights Act of 1998, it gave effect to Article 8 of the European Convention on Human Rights, which states, "[e]veryone has the right to respect for his private and family life, his home and his correspondence." Moreover, in 2005, the U.K. House of Lords (U.K.'s equivalent to the U.S. Supreme Court) decided a breach of confidence case that appears to be broadening the tort's applicability to more than pre-existing relationships, by allowing other surrounding circumstances to be considered.[113]

In *Douglas v. Hello! Ltd.*, Michael Douglas and Catherine Zeta-Jones sued Hello! Magazine for publishing unauthorized pictures of the couple's wedding in New York.[114] The two celebrities, in deciding between Hello! and Ok!, had contracted with Ok! Magazine to exclusively photograph and cover their wedding.[115] The couple took great precautions to prevent photographs from being taken by anyone else, including posting "no photography" signs and hiring a security team.[116] In a complex case that went all the way up to the highest court in the United Kingdom, the court held Hello! liable for breach of confidence and privacy, when it published the unauthorized pictures.[117] In summarizing its decision, the court reasoned that,

> Where an individual ('the owner') has at his disposal information which he has created or which is private or personal and to which he can properly deny access to third parties, and he reasonably intends to profit commercially by using or publishing that information, then a third party who is, or ought to be, aware of these matters and who has knowingly

photographer under contract from publishing his pictures of the group in a newspaper without the group's permission. Still, this goes to basic contract law, and doesn't add much to the independent right of publicity. *Id.*

111. Stallard, *supra* note 82, at 575.

112. *Id.*

113. *See* Douglas v. Hello!, [2005] EWCA Civ 595 (on appeal from the Queens Bench, England Division). As said by Blum and Ohta, "the law of [breach of confidence] has evolved to protect image rights where there has been unjustifiable publication of private information or breach of privacy and also in the context of the economic exploitation of image rights." Stallard, *supra* note 82, at 6.

114. *See generally, Douglas*, EWCA Civ 595.

115. *Id.* at 609, 610.

116. *Id.* at 621.

117. *Id.* at 260.

> obtained the information without authority, will be in breach of duty if he uses or publishes the information to the detriment of the owner.[118]

This decision synthesized the law of confidence and privacy to protect Douglas and Zeta-Jones.[119] This was another large step in protecting celebrities' identities, but even this decision stopped short of embracing a full transferable property interest in like the one articulated in *Haelen Laboratories*.[120] The court's stretching and adapting of passing off and breach of confidence claims evinces the strong need for the United Kingdom to develop a law that addresses the Right of Publicity head on.

V. COMPARING THE U.S. AND THE U.K.

Even with how far the United Kingdom has come in providing protection for celebrities' likenesses, it still provides less protection than the United States did in 1953.[121] The United States system is not perfect; its Right of Publicity laws vary across the fifty states, some providing protection through statutes, others through common law, and others through the right of privacy. Yet, U.K. courts have consistently refused to extend their *laws* to actually address the Right of Publicity head on. U.K. copyright protection under the CDPA can potentially grant protection in photographs, but offers nothing more. Trademark protection in the U.K, codified in the TMA, offers very little practical help because it limits protection to registered marks and generally considers celebrity names to be unregistrable. The common law tort of Passing Off, as extended by *Irvine*, provides celebrities with the right to prevent misrepresentation of endorsement or merchandising, but clearly stops short of giving celebrities a right in controlling the reproduction of their likeness altogether.[122] Finally, in a breach of confidence claim, celebrities may be successful if they make an attempt to

118. *Id.* at ¶¶ 118-119. It is significant that, while the court broadly interpreted confidence and privacy, it limited the claim to situations where the individual was intending to commercially exploit his or her information. This would prevent plaintiffs from being successful in scenarios like *Waits v. Frito-Lay*, where the singer was not interested in using his voice for commercial purposes outside of his concerts and records. 978 F.2d 1093, 1098 (9th Cir. 1991) (Waits had a "publicly avowed policy against doing commercial endorsements and . . . disaprov[ed] of artists who did.").

119. Douglas v. Hello!, [2005] EWCA Civ 595, 630.

120. The court reasoned, "[w]e have concluded that confidential or private information, which is capable of commercial exploitation but which is only protected by the law of confidence, does not fall to be treated as property that can be owned and transferred." ¶ 119. *Compare with* Haelen Laboratories v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2nd Cir. 1953) (explaining that a man can assign his image rights "in gross" to a third party).

121. *See supra* note 120.

122. Irvine v. Talksport Ltd., [2002] EWHC 367 (Ch).

keep the information private and intend to commercially exploit it later, but the highest court in the U.K. has refused to treat the right as "property that can be owned and transferred."[123]

In important contrast, the United States has created significant protection for any commercial misappropriation of celebrities' identities.[124] The two paths that the United States provides are generally interpreted broadly to provide as much protection as possible.[125] The Lanham Act is not alone in providing remedies to celebrities. The states' Right of Publicity laws give a direct focus on the appropriation itself rather than trying to stretch and adapt a different law to cover publicity rights.[126] Protecting the commercial value of celebrities' identities is important economically and morally,[127] and it is time for the United Kingdom to follow America's lead and embrace the right of publicity to provide the proper legal protection.

123. *See supra* note 120.

124. White v. Samsung Electronics Am., 971 F.2d 1395, 1398 (9th Cir. 1991); *See* Moschenbacher v. R.J. Reynolds Tobacco, 498 F.2d 821 (1974); *and* Carson v. Here's Johnny Portable Toilets, 698 F.2d 831 (1982).

125. *See generally White*, 971 F.2d 1395; *see also Carson*, 698 F.2d 831.

126. *See supra* pp. 9-10.

127. *See supra* pp. 2-4.