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EUROPEAN INTELLECTUAL PROPERTY CONSULTANCY

Rights of Publicity and Personal Portrayal in Ireland

In the age of the Internet and global marketplace, there is a growing recognition of the underlying commercial value which attaches to the image and identity of personalities. Recently, it was reported¹ that many actors are rushing to protect their images from ‘digital resurrection’ after they die. It therefore seems surprising that many countries, including Ireland, have still no standalone statutory laws to prevent the unauthorised use of a celebrity’s image rights.

To date, Guernsey has the world’s only registration system for image/personality rights. The British Crown dependency has thus made it considerably easier for personalities to control and monetise the valuable characteristics emanating from their personalities. Until Ireland introduces a similar statutory measure, personalities seeking to protect their rights in Ireland must rely on traditional forms of Intellectual Property protection. Notwithstanding the already limited jurisprudence in Ireland on the protection of personality rights, a celebrity who relies on one or more recognisable causes of action may nonetheless still be able to prevent the unauthorised exploitation of their image. The manner in which this can be done is outlined and explained below.

‘Image’ or ‘Personality’ Right’?

There appears to be divergence of opinion amongst many legal practitioners as to what exactly is an ‘Image Right’. The Intellectual Property Office of Guernsey defines ‘Image Rights’ as “the expression of personality in the public domain”. Arguably, this may be somewhat akin to the umbrella term, ‘Personality Right’, which is commonly used in the United States of America. ‘Personality Right’ in effect encompasses both a ‘Right of Privacy’ and a ‘Right of Publicity’. In Ireland, a ‘Right of Privacy’ is already protected as an implied Constitutional right. It is therefore unlikely to be considered by the Irish courts to fall within the realm of what most legal practitioners would consider an ‘Image Right’. Instead, an ‘Image Right’ in Ireland is more likely to be considered akin to the US ‘Right of Publicity’, which is intended to not only protect a personality’s image, but also their name, mannerisms, voice and gestures. The term ‘Image Right’ is therefore a misnomer and does not fully capture all aspects of a personality’s distinctive attributes. Hence, for this reason, and for the purposes of this article, I will use the more accurate and better encompassing term, ‘Right of Publicity.’

Right of Personal Portrayal protection

Notwithstanding the lack of statutory protection for Rights of Publicity in Ireland, it is necessary to bear in mind that, in Ireland² and the European Union³, a Right of Personal Portrayal is protectable and recognised in law.

¹ Daily Mail – December 31st 2016.

² Under section 10(4)(b) of the Trade Marks Act, 1996, a ‘Right of Personal Portrayal’ can prevent the registration of a trade mark filed by a third party.

³ EU Directive 2015/2436 - Trade Mark Harmonisation Directive

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A demonstration of how a Right of Personal Portrayal has been applied in the past arose in a case which came before the French Regional Court in Nanterre in 1999⁴. In this case, a model was able to prevent the unauthorised publication on the Internet of photographs portraying her clothed and partially clothed. In delivering its judgement, the Court referred to the absolute right of any individual to “personal portrayal”. The fact that the model had previously agreed to be photographed nude was irrelevant. The Court held that any further publication was a breach of the model’s Right of Personal Portrayal.

There have been no ‘Right of Portrayal’ cases in Ireland, but it seems likely that such a cause of action would be strictly limited to how an individual can prevent unauthorised portrayal of their image and not other characteristics of their personality, e.g. their voice.

The Old Approach – Reliance on traditional areas of Intellectual Property

Historically, traditional forms of Intellectual Property have played a helpful, although not entirely satisfactory, role in the recognition and enforcement of the various aspects of what a Right of Publicity encompasses. Copyright, registered and un-registered design right, passing off, registered trade marks and, to a small extent, breach of confidence have assisted individuals in protecting their rights.

A. Copyright – images

Bearing in mind that a Right of Publicity covers both identity and image, copyright has only really been of use in protecting images. While copyright subsists in original literary works, it has long been recognised in Ireland that there is no copyright in a name⁵. Copyright is therefore of no help to a celebrity who wants to enforce rights in his/her name.

Copyright may be of more assistance in protecting personality images or photographs. If the personality or his/her management company owns the copyright in a photograph of their image, then it should be possible to prevent unauthorised production and use of that photograph. However, the limits of copyright in such a situation should be recognised. In *Merchandising Corporation of America Inc V Harpbond Ltd*⁶, it was held that the copyright in a portrait image of the 1980’s singer ‘Adam Ant’ wearing his signature ‘Prince Charming’ outfit and makeup was not infringed. The court found that there had not been substantial taking from the photograph.

Of course copyright will not be able to prevent the independent taking and creation of a photograph of a celebrity. In such a situation, a celebrity would have to try and rely on Passing off or, in circumstances where a breach of privacy is concerned, breach of confidence. This happened in the case of *Robyn Rihanna Fenty and others v Arcadia Group Brands Ltd*⁷ where the well-known singer and songwriter, Rihanna, was able to prevent a High Street store, from selling t-shirts displaying her image based on a photograph taken by a third party.

⁴ TGI Nanterre 1^{re} ch.Sec. A, 8th December 1999.

⁵ Exxon Corpn v Exxon Insurance Consultants International Ltd [1981] 3 All ER 241

⁶ 1983] FSR 32

⁷ [2015] EWCA Civ 3

B. Registered Designs and Unregistered Designs

Under the European Union Designs Directive⁸, a design is defined as being ‘the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the products or its ornamentation. To be validly registered, a design must be ‘new’ and have ‘individual character’; the requirement of ‘individual character’ being assessed through the eyes of an ‘informed user’ who, in the case of merchandise, is likely to be a wholesale buyer. Given that ‘novelty’ is the key requirement of a valid Design registration, a problem would appear to arise if the design in question was of the likeness of a celebrity who is already well known. In a case from the UK Intellectual Property Office, the pop group, The Spice Girls,⁹ sought to cancel a series of registered designs in the name of an unconnected third party on the grounds that the designs in question were not new. However, the UKIPO held that the key requirement of ‘prior publication’, needed to destroy novelty, had to be of a design applied to an article. The case showed that images of celebrities would not be considered designs unless they are actually applied to articles. So, unless it can be shown that the articles bearing the offending design have been previously made available to the public on offending articles, the key requirement of novelty will not be destroyed.

The other avenue that a celebrity may have recourse is unregistered design right, which allows the holder of such a right to prevent third parties from using the same or similar designs. Under EU law, protection is valid for a period of three years from the time that the design was first made available to the public (in Ireland this must be after 6 March 2002 when unregistered design right was introduced into law). Like registered designs, there is a requirement of novelty in order to claim a valid right and infringement can only be brought in cases of direct copying. On balance, in view of the requirement of novelty, unregistered design right is likely to be of limited use to celebrities wishing to protect their image.

C. Registered Trade Mark protection

It would seem that seeking to register images or identity of celebrities as Trade Marks might afford the strongest form of protection and some notable celebrities have already chosen to rely on this form of protection in the United Kingdom¹⁰.

The one advantage that Trade Mark protection has over other forms of Intellectual Property is that it can be used to register both names and images. Insofar as names are concerned, it is necessary to examine how the name of a celebrity can perform the key ‘indicator of origin’ requirement that is implicit in a trade mark. Two cases demonstrate the difficulties here. In *TARZAN*¹¹, the English Court of Appeal held that the name ‘Tarzan’ constituted a direct reference to the character or quality of the goods for which registration was sought; this even though ‘Tarzan’ was an invented name at the time Edgar Rice Burrows wrote his book about the character of the same name. Similarly, in *ELVIS PRESLEY Trade Marks*¹², it was held that the ‘Elvis’ name did not indicate to the consumer that there was a connection in the course of trade between the goods for which registration was sought

⁸ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs [1988] OJ L 289/28

⁹ 16 August 1999

¹⁰ Gareth Bale’s ‘Eleven of Hearts’ goal celebration gesture.

¹¹ 1970] RPC 450

¹² [1999] RPC 567

(toiletries) and the successors of the famous singer. In essence, it was held that the ELVIS mark merely commemorated the singer rather than identifying the origin of the goods in question.

In *Arsenal Football Club v Matthew Reed*¹³, the ELVIS decision was turned on its head. In responding to a reference from the English Court of Appeal, the European Court of Justice ruled that where a third party used, in the course of trade, a sign which was identical to a validly registered trademark on goods which were identical to those for which it was registered, the proprietor was entitled to prevent that use. It did not matter that the defendant's sign was perceived as a badge of support for loyalty or affiliation to the proprietor. Use of a trademark, which affected or was likely to affect the essential 'indicator of origin' function of a trademark could be prevented by a trademark proprietor.

If a trade mark can be infringed, even if a consumer sees the infringing sign as a 'badge of loyalty', the names of deceased personalities could be registered and protected in cases where the defendant raises the defence that the infringing sign is merely there to serve the purpose of commemoration.

Sometimes celebrities or their successors will seek to exploit their image in three dimensional formats in the form of dolls or figures. While the Irish Trade Marks Act, 1996 (TMA) includes provisions on the registrability of shapes, it seems likely that any attempt to register the representation of a celebrity in the form of a doll or figurine would be met with the objection that the shape gives substantial value to the goods for which registration is sought. In a nutshell, the average consumer would buy the doll because of the image that it represents and not necessarily because they believe the doll has a particular commercial origin.

D. Passing off

Very often celebrities and their successors overlook the benefits of trade mark registration; be it through ignorance or perceived high cost. In the absence of a trade mark registration, a celebrity would still have possible recourse to a claim for Passing off. So long as a celebrity can satisfy the classic trinity of 'reputation', 'misrepresentation' and 'damage', it would seem that a claim in passing off is the most suitable route a celebrity could choose to stop un-authorised use of his or her images or other character features. However, while not necessary for a successful claim in passing off, many cases involving Publicity Rights very often fail because a lack of competition between the plaintiff and defendant means that it is not possible to prove 'misrepresentation'. If there is 'misrepresentation', then there is likely to be no harm/damage to the plaintiff's goodwill/reputation, again because of a lack of a competitive relationship with the defendant. This has certainly been the case in the United Kingdom. In *Wombles v Wombles Skips*¹⁴, the producer of the children's television series was unable to prevent a waste disposal company trading under the name 'Wombles Skips'. The lack of a common field of activity meant that there was no harm to goodwill. Likewise, in *Lyngstad v Anabas Products*¹⁵, the pop group ABBA was unsuccessful in preventing the sale of memorabilia bearing their name because they were unable to show that they were in the business of producing such goods. The court held that even if ABBA was able to demonstrate that they were in the business of producing memorabilia, it is unlikely that consumers would be deceived into thinking that the defendant's goods were produced under licence from ABBA.

¹³ [2002] ECR I-10273

¹⁴ [1977] RPC 99

¹⁵ [1977] FSR 62

Another case which highlights the extent to which an action in Passing off may be useful to celebrities is *Irvine v Talksport Ltd*¹⁶ where the well-known Formula One driver Eddie Irvine sued for the unauthorised use of his image in sales promotional material for a new radio station. While Irvine succeeded in his action, commentators have suggested that his case shows that use of Passing off is limited to cases of false endorsement rather than actual misappropriation of image per se.

E. Breach of Privacy

As Ireland is a signatory to the European Convention on Human Rights¹⁷, an aggrieved personality may, in certain circumstances, also be able to rely on the 'Privacy' provisions of the Convention. Article 8 provides a right to respect for one's 'private and family life, his home and his correspondence'. To succeed, a litigant would have to show that what they are seeking to protect is in fact 'private' and that the right to privacy outweighs the right to freedom of expression set out in Article 10.

In *Douglas v Hello Ltd*¹⁸ photographs were taken of the plaintiff and his bride at a private wedding ceremony. It was held that, as the photographs were taken in breach of the wishes of the plaintiff, this constituted a breach of his rights under Article 8. The plaintiff's Article 8 rights took precedence over the defendants 'freedom of expression' rights under Article 10.

In *Campbell v MGN Ltd*¹⁹ the famous model Naomi Campbell was photographed leaving a drug rehabilitation clinic despite denials from her that she was undergoing such treatment. It was held by the House of Lords that the photographs that were taken by the defendant infringed Campbell's right to privacy and that publication could not be justified in the public interest.

F. Constitutional Protection

A discussion about Personality Rights in Ireland would be incomplete without examination of the protection that may be available to personalities under the Irish Constitution²⁰; albeit recognising that protection would only be available to Irish citizens and entities.

Article 40.3.2 of the Constitution recognises that a citizen has the right to his/her good name and the right to a livelihood. While there is no explicit provision recognising a citizen's right to privacy, numerous cases over the years have implied a right to privacy.

In a case with Personality Rights implications, photographs were published by the defendants of the plaintiff in the course of an affair with a Roman Catholic priest. The Court in *Herrity v Independent Newspapers Ltd*²¹ held the purpose behind the publication of the photographs and other materials violated the plaintiff's right to privacy.

It is however important to stress that Constitutional protection of celebrity images and identity has severe limitations. In *Kennedy and Arnold v Ireland*²² the Court indicated that a right to privacy was not absolute and is, in any case, subject to requirements of public order and morality. It is also

¹⁶ [2002] 2 All ER 414

¹⁷ 3rd September 1953

¹⁸ [2003] 3 All ER 996

¹⁹ [2004] 2 All ER 995

²⁰ Constitution of Ireland, 1937

²¹ [2008] IEHC 249

²² [1987] IR 587

necessary to consider the issue of the clash between competing constitutional rights, e.g. the contrasting right of freedom of expression.

The closest the Irish courts came to recognising that an individual's personality is a tradable commodity was in *O'Keeffe v Ryanair Ltd*²³ where the Plaintiff agreed to the use of her image as part of a promotion run by the airline, Ryanair. The Court found against the Plaintiff, primarily on the basis that she had contractually given up her rights of privacy in return for participating in the promotional campaign.

To date, there have been no successful 'Right of Publicity' cases in the Irish courts. However, in one recent case²⁴ the famous Manchester and Irish football coach and player, Roy Keane, sued a well-known chain of high street bookies for use of his image where he was portrayed as the Scottish historical leader, William Wallace, superimposed over the face of Mel Gibson from the film *Braveheart*. The case was settled before it reached trial.

In another case²⁵, the Olympic gold medallist, Mary Peters, sued a life assurance company for unauthorised use of her image as part of a promotional campaign. This case was also settled out of court.

G. Unfair Commercial Practices

Unauthorised use of Publicity Rights may also be caught by the provisions of the European Unfair Commercial Practices Directive²⁶, transposed into Irish law by the Consumer Protection Act, 2007. The Act prohibits a range of unfair, misleading and aggressive trading practices if they essentially result in consumers being deceived and confused. Importantly, a commercial practice is deemed to mislead if *inter-alia* it provides 'false information or deceives consumers about the 'existence, extent or nature any approval or sponsorship (direct or indirect) of the product by others'. This could typically cover a case of misleading endorsement through use of a celebrity's image on products. It should however be borne in mind that the Directive and Act are not intended to offer redress to the owner of a Publicity Right. Instead, the remedies and penalties are only available in the case of a direct consumer complaint.

H. Enforceability from the courts in Guernsey

Another possible option is to seek to enforce a judgement from a court in Guernsey on foot of a successful claim for infringement of a registered Image Right under that island's legislation. While Guernsey has reciprocal enforcement arrangements with some countries, it does not have one with Ireland. Moreover, an attempt to enforce a judgement from a Guernsey court under the Brussels Regulation²⁷ is also likely to fail as the Regulation does not extend to the Channel Islands, of which Guernsey is one.

²³ [2003] 1 ILRM 14

²⁴ <https://www.theguardian.com/media/greenslade/2015/jul/10/roy-keane-sues-paddy-power-over-braveheart-poster-image>

²⁵ <http://www.rte.ie/news/2001/0301/12958-peters/>

²⁶ Directive 2005/28/EC of 11 May 2005

²⁷ <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:351:0001:0032:En:PDF>

As Ireland is a signatory to the Brussel's Regulation, a judgement from an Irish court on foot of a claim for infringement of a registered Right of Publicity could, in the right circumstances, be enforced in other European Union member States.

Summary

While not without its limitations, it would seem that an action in Passing off, be it on its own or in combination with other causes of action, offers a celebrity the most effective way to legally prevent the unauthorised use of their image in Ireland. This is not however satisfactory. It is therefore now time for Ireland to catch up with modern commercial realities and introduce a statutory Right of Publicity. Failing this, it is perhaps time for the European Union to consider introducing a pan EU Right of Publicity, similar to the European Union Trade Mark and Registered Community Design.

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