

Edwards Wildman Palmer UK LLP

# The famous, the unknown and the deceased

Until Parliament legislates on the issue, UK rights holders are subject to uncertain protections for publicity and image rights

The protection of image rights – namely, the right to exploit and prevent others from using one’s name, image or likeness – does not come under a codified body of law in the United Kingdom and instead relies on various sources for enforcement. As a result, it can prove difficult to identify suitable protection in this area and, on occasion, can even yield less than desirable outcomes.

One would expect that the more famous a person is, the more protection the law would afford to that person’s image. However, this is not always the case. This is because, despite an increasing obsession with celebrity and image, there is no recognised exclusive proprietary right of personality in the United Kingdom. To obtain protection, one must resort to various causes of action, such as copyright, defamation, data protection, privacy and confidential information, advertising and press complaints codes, trademark law and passing off. However, these causes of action – in particular, trademark law and passing off – offer varying levels of protection depending on whether the individual concerned is an average person, a celebrity or a decedent.

## Elvis, Diana and Picasso: trademark protection of images

It is possible to register one’s name, signature and image as a trademark. For example, Paul Newman’s name, signature and portrait are registered for various foods and drinks. However, as the usual conditions for registrability still apply, celebrities can often encounter problems with obtaining registration as a result of their name or image being considered descriptive.

In relation to certain good and services, a celebrity’s name and image will be perceived in a descriptive or decorative sense only, as opposed to a source of origin.

This is particularly the case with respect to goods and services which are traditionally used for memorabilia, and image carriers such as posters, photographs and figurines.

For example, in *Elvis Presley Trade Marks* [1999] RPC 567 it was held that the marks ELVIS and ELVIS PRESLEY had little inherent distinctiveness in relation to toiletries. The court went so far as to say that had it been almost any surname other than Presley, the ELVIS PRESLEY mark would have been distinctive, but the addition of ‘Presley’ simply confirmed the descriptive character of the mark. It is also irrelevant whether the person’s name is unique (eg, *Diana, Princess of Wales* [2001] ETMR 25) or fanciful (eg, *Linkin Park* [2006] ETMR 74); such a name may still be considered descriptive of memorabilia and image carriers.

If a celebrity’s name and image are used during his or her life on a wide range of mementoes and souvenirs by several third parties – none of which implies a trade connection with that celebrity – then after the celebrity’s death it will be difficult for his or her estate to obtain registration of his or her name and image without evidence that consumers would attribute the use of these to the estate.

Even if an application for a famous name and image successfully overcomes a descriptiveness objection, it may still be opposed by the proprietor of an earlier similar mark. Although the UK Intellectual Property Office (UKIPO) may raise a bad-faith objection to applications by third parties for celebrity names, a third party may nevertheless have legitimate reasons for registering the name of a celebrity (eg, if it shares the same name).

Even when registered, famous names and images may prove difficult to enforce. For example, the Court of Justice of the European Union (ECJ) upheld a decision

rejecting the Picasso estate’s opposition action against Daimler-Chrysler’s application for PICARO, even though the PICASSO mark was registered for identical goods. The ECJ agreed with the lower court’s finding that the mark PICASSO was sufficiently famous as the name of a well-known painter, such that the public would not see it as a mark for motor vehicles. In particular, the ECJ was of the opinion that the conceptual differences between the respective signs counteracted any similarities between them. Further, the ECJ agreed with the lower court’s finding that the PICASSO mark was devoid of any highly distinctive character with respect to motor vehicles.

Consistent use with respect to specific products can assist registration for famous names. For example, George Foreman is a famous boxer, but his name, signature and image have been used consistently for years as a brand for electric grills, such that consumers would view them arguably as a simple brand. The same applies to Fred Perry, which is a brand of clothing in its own right.

Ultimately, what celebrities seek to prevent is unauthorised use of their name or image by third parties. However, a person may use his or her own name without such use constituting trademark infringement. Also, third parties may legitimately use a celebrity’s name to describe goods and services without infringing the celebrity’s trademark registration. Finally, use of an image with dissimilarities from that registered may not be an infringement of the image registered. However, the law of passing off may afford an additional cause of action.

## *Irvine v Talksport*

Unlike trademarks, passing off does not protect the name or image of the average

person, unless it is used in trade and has acquired goodwill, and it can be shown that the defendant's act constituted a misrepresentation, which caused the person loss.

In the past, famous persons tried to prevent the unauthorised use of their name or image by arguing that such use falsely implied that they endorsed the defendant's products. Until *Irvine v Talksport* [2002] 1 WLR 2355, such claims usually failed on the ground that the claimant and defendant were not in direct competition. In *Irvine* it was confirmed that for a false endorsement claim to succeed, the claimant need prove only that he or she enjoyed a significant reputation or goodwill at the time of the defendant's actions, and that the defendant had created a false message which would lead consumers to believe that the claimant endorsed, recommended or approved the defendant's products. There is no need for a common field of activity.

However, passing off does not protect against all unauthorised use of a celebrity's name or image. In *Halliwel v Panini SpA*, the Spice Girls' application for an injunction to prevent the sale of an unauthorised sticker collection which featured their name and photographs failed. The court was not convinced that without a notice stating that the stickers were unofficial, consumers would believe that the Spice Girls had endorsed them. Therefore, the courts continue to adopt a similar approach to the UKIPO in relation to image carriers.

Furthermore, passing off may still not protect celebrities who have not attempted to license their name or image or endorse products, since there would be no likelihood of damage. In particular, passing off may not help a celebrity's estate if a long period of time has passed between his or her death, or last endorsement when alive, and the unauthorised use of the celebrity's name or image.

For example, if a company used in its advertising the image of a famous actor who has been dead for many decades, there could well be no action in passing off. This would be due to the fact that any goodwill in the actor's name or image may have dissipated in the years since his or her death.

### **The future of image rights**

It is clear that trademark law and passing off do not adequately protect image rights. However, there is no question that the UK courts refuse to recognise any right of personality. Therefore, individuals can only hope that Parliament will intervene and legislate on this issue. Until then, one must



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continue to rely on the uncertain protections that trademark law and passing off offer.

Under current UKIPO practice, names or images belonging to the average person are considered inherently more distinctive, and may be registered in relation to a wider range of goods than celebrity names. It is unfortunate that the average person is unlikely to seek to register his or her name or image on the off-chance of fame. Moreover, unless the average person uses his or her name in trade, he or she will have no claim in passing off.

For celebrities to obtain the widest possible protection under trademark law and passing off, particularly after they have died, it is important that they exploit their name and image during their life and in a manner which denotes a trade source. This can be assisted by use of the registered trademark symbol (™) or legal notices. It is also necessary to maintain strict control in order to prevent unauthorised use by third parties, which would erode the distinctiveness of the person's name and image for the goods in question. [WTR](#)