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# **A RIGHT OF PUBLICITY IN SCOTS LAW**

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## ABSTRACT

This thesis examines publicity exploitation in practice and the possible legal response of Scots law to that exploitation. It argues that the common law in Scotland is not capable of providing a coherent and principled right of publicity for individuals, and that a statutory right is instead required. By examining the nature of publicity exploitation and the activities that constitute publicity, it becomes clear that there are a number of different methods by which an individual's "persona" – name, image, identity and reputation – can be used to enhance the goods and services of others, and that this enhancement is something for which other parties are willing to pay. The first part of this thesis explores publicity in practice, in order to derive a framework and vocabulary on which to build the subsequent legal analysis. One conclusion reached here is that, whereas much case law and academic commentary focuses on the unauthorised use of persona, authorised exploitation is more common and more lucrative for the individual. Both authorised and unauthorised use therefore need to be represented in a publicity right. The second part explores justifications for establishing a legal right to regulate the exploitation of publicity and to enable the control of such exploitation by the individual in question. These justifications reflect the dual interests at stake in publicity rights, being dignitarian interests in the use and control of one's persona, and economic interests in the financial value of such use. The third part of the thesis draws upon the findings of the first two parts in order to assess the most appropriate legal classification of a right of publicity. The conclusion reached is that publicity cannot be sufficiently protected through established real rights or personal rights. Instead, the hybrid nature of publicity, comprising dignitarian and economic interests, should most appropriately be protected through a right in the nature of exclusive privilege (a concept already known in Scots law). This right is capable of enabling the necessary control of persona for the individual, subject to appropriate limitations to recognise the competing interests of other parties. These limits include freedom of expression and cultural communication. The final conclusion is that such a statutory right of exclusive privilege would be best placed to give principled and coherent effect to a right of publicity in Scots law.

**DECLARATION**

In accordance with Regulation 2.5 of the University of Edinburgh's Postgraduate (Research) Assessment Regulations 2008-09, I hereby declare (a) that this thesis has been composed by me, and (b) that the work is my own, and (c) that the work has not been submitted for any other degree or professional qualification.

\_\_\_\_\_ Gillian Black

\_\_\_\_\_ Date

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**Gillian Black**  
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## A NOTE ON CASE CITATIONS

Case citations in footnotes have been given with reference to the official Law Reports where possible. The neutral citation (if one exists) for these cases has also been included in the bibliography.

Other cases have been cited by the relevant volume of law reports, such as FSR, or by their neutral citation, where available.

Unreported cases have been cited by neutral citation.

In all instances, the first citation listed in the bibliography is the one that has been used in footnotes.

Several recent cases (including, notably, *Douglas v Hello!* and *Irvine v Talksport*) have raised different issues on appeal from the issues debated in, and decided by, the lower courts. For accuracy, the case citation given on each occasion will refer to the case report for the relevant issue under discussion, rather than the case report for the highest court involved in the litigation. By way of example, *Douglas v Hello!* raised issues of privacy when it was heard in the Court of Appeal and issues of commercial confidence in the House of Lords. The Court of Appeal citation will therefore typically be used when referring to the privacy elements of the case, while the House of Lords citation will be used when referring to the commercial aspects of the litigation.

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## ABBREVIATIONS

AC	Law Reports, Appeal Cases
AJ	Acta Juridica
All ER	All England Law Reports
Beav	Beavan's Roll Court Report
BGB	<i>Bürgerliches Gesetzbuch</i>
BGHZ	Entscheidungen des Bundesgerichtshofes in Zivilsachen
Bro PC	J Brown's Cases in Parliament
CA	Court of Appeal, England & Wales
Cal L Rev	California Law Review
Can J.L. & Jurisprudence	Canadian Journal of Law and Jurisprudence
Cardozo Arts & Ent LJ	Cardozo Arts and Entertainment Law Journal
CDPA 1988	Copyright, Designs and Patents Act 1988
Ch	Law Reports, Chancery Division
Ch D	Chancery Division, England & Wales
CILSA	Comparative and International Law Journal of Southern Africa
Cl	Clause
CLJ	Cambridge Law Journal
CLR	Commonwealth Law Reports
Cmnd	Command Papers
Colum-VLA JL & Arts	Columbia-VLA Journal of Law and the Arts
Comm All ER	All England Law Reports (Commercial)
Comms L	Communications Law
CSIH	Court of Session, Inner House
CSOH	Court of Session, Outer House
d.	Deceased
CTLR	Computer and Telecommunications Law Review
DePaul-LCA J Art & Ent L	DePaul-LCA Journal of Art and Entertainment Law
ECHR	European Convention on Human Rights
ECHR (in the context of	European Court of Human Rights Series A: Judgments

case reports)	and Decisions
ECtHR	European Court of Human Rights
Edin LR	Edinburgh Law Review
EHRLR	European Human Rights Law Review
EHRR	European Human Rights Reports
EIPR	European Intellectual Property Review
EJCL	Electronic Journal of Comparative Law
EMLR	Entertainment and Media Law Reports
Eng Rep	English Reports
Ent LR	Entertainment Law Review
EWCA Civ	England and Wales Court of Appeal (Civil Division)
EWHC	England and Wales High Court
Exch	Exchequer Reports
F 2d.	Federal Reporter, Second Series
F.	Fraser's Court of Session Cases, Fifth Series
FCA	Federal Court of Australia
Fordham Intell Prop Media and Ent LJ	Fordham Intellectual Property, Media and Entertainment Law Journal
FSR	Fleet Street Reports
Ga L Rev	Georgia Law Review
GWD	Green's Weekly Digest
Harv JL & Pub Pol'y	Harvard Journal of Law and Public Policy
Harv L Rev	Harvard Law Review
HL	House of Lords
ICCLR	International Company and Commercial Law Review
ICLQ	International and Comparative Law Quarterly
IH	Inner House, Court of Session
ILJ	Industrial Law Journal
IPQ	Intellectual Property Quarterly
JBL	Journal of Business Law
JR	Juridical Review
KB	Law Reports, King's Bench

L Rev	Law Review
La L Rev	Louisiana Law Review
Law & Contemp Probs	Law and Contemporary Problems
LC	Law Commission, England and Wales
LJ	Law Journal
LQR	Law Quarterly Review
Mer	Merivale's Chancery Reports
MLR	Modern Law Review
Mor	Morison's Dictionary
New Eng L Rev	New England Law Review
Nw U Law Rev	Northwestern University Law Review
NY	New York Reports
NZCA	New Zealand Court of Appeal
OH	Outer House, Court of Session
OJLS	Oxford Journal of Legal Studies
PC	Judicial Committee of the Privy Council
PL	Public Law
Pt	Part
QB	Law Reports, Queen's Bench
R	Rettie, Crawford and Melville, Session Cases, Fourth Series
RabelsZ	Rabels Zeitschrift fur Auslandsches und Internationales Privatrecht
RPC	Reports of Patents, Designs and Trade Mark Cases
s.	Section
S	Shaw's Session Cases, First Series
SA (CC)	South African Constitutional Court
SC	Session Cases (Sixth Series)
Sch	Schedule
Scot CS	Scottish Court of Session Decisions
SCR	Supreme Court Reports, Canada
SE	South Eastern Reports

Sh Ct	Sheriff Court
Sh Pr	Sheriff Principal
SLC	Scottish Law Commission
SLT	Scots Law Times
SME	<i>The Laws of Scotland: Stair Memorial Encyclopaedia</i>
Tex L Rev	Texas Law Review
TLR	Times Law Reports
TMR	Trade Mark Reports
Tul Eur & Civ LF	Tulane European and Civil Law Forum
U Brit Colum L Rev	University of British Columbia Law Review
UCLA Ent L Rev	UCLA Entertainment Law Review (University of California, Los Angeles)
UKHL	United Kingdom House of Lords
US	US Supreme Court
Va J Int'l Law	Virginia Journal of International Law
Va L Rev	Virginia Law Review
WLR	Weekly Law Reports
Yale JL & Human.	Yale Journal of Law and the Humanities



*Jeeves: It has been my experience, sir, that the normal person enjoys seeing his or her name in print, irrespective of what is said about them. I have an aunt, sir, who a few years ago was a martyr to swollen limbs. She tried Walkinshaw's Supreme Ointment and obtained considerable relief – so much so that she sent them an unsolicited testimonial. Her pride at seeing her photograph in the daily papers in connexion with descriptions of her lower limbs before taking, which were nothing less than revolting, was so intense that it led me to believe that publicity, of whatever sort, is what nearly everyone desires.*

From *Carry On, Jeeves* by PG Wodehouse. First published 1925, this edition published by Penguin Books, London, 1999, page 23.

# CHAPTER 1: INTRODUCTION

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## 1. INTRODUCTION

The celebrity image is a cultural lode of multiple meanings, mined for its symbolic resonances and, simultaneously, a floating signifier, invested with libidinal energies, social longings, and political aspirations.<sup>1</sup>

The image of any individual in general – and of celebrities in particular – can be a powerful instrument, whether used to add to our shared cultural experience, to pass political comment, to raise awareness of social issues, to promote goods or services, or simply to illustrate the latest gossip and tittle-tattle. One consequence of the social use and versatility of personal image is the price that it can command: Catherine Zeta Jones and Michael Douglas sold their wedding photographs to OK! magazine for £1 million in 2000,<sup>2</sup> while David Beckham was allegedly paid \$20 million in 2007 for his Emporio Armani advertising deal.<sup>3</sup> The market for personal images – or indeed, for any signifiers of the individual – can be referred to as publicity practice.

<sup>1</sup> RJ Coombe, “Author/izing the celebrity: Publicity rights, postmodern politics, and unauthorized genders” (1991-1992) 10 *Cardozo Arts & Ent LJ* 365 (henceforth Coombe, “Author/izing the celebrity”), at 365.

<sup>2</sup> *Douglas v Hello!* [2008] 1 AC 1.

<sup>3</sup> Evidence of such deals can be hard to come by: online articles and blogs give this figure for the Emporio Armani deal. (<http://www.adpunch.org/entry/david-beckham-signs-underwear-deal-for-giorgio-armani/>) (accessed 4 November 2008). For a more general comment on the commercial value of such deals, see D Westfall and D Landau, “Publicity Rights as Property Rights” (2005-2006) 23 *Cardozo Arts and Ent. LJ* 71 (henceforth Westfall and Landau, “Publicity Rights as Property Rights”), at 73, note 3.

In turn, the *practice* of publicity leads to the desire for *legal* control over use of image.

Courts and legal commentators, however, have struggled to identify and agree a common legal response to publicity. Confusion ranges from terminology to taxonomy. How should we refer to the practice of “buying” and “selling” image or reputation or gossip? How should we analyse the rights or assets in question? Do breaches raise issues of publicity, privacy,<sup>4</sup> breach of confidence,<sup>5</sup> goodwill,<sup>6</sup> property rights – or nothing at all? Should legal development be influenced by concerns for personal dignity and autonomy<sup>7</sup> or economic considerations,<sup>8</sup> or both?

Any review of publicity rights thus comes up against a considerable range of problems from the outset. Yet this does not mean that a coherent legal response cannot or should not be sought. To borrow an observation from MacCormick, made in the context of privacy yet nonetheless relevant:

The [Younger] committee, having rightly noted that there are many rival versions of such a right [of privacy], all vying for legislative or judicial adoption, concluded that the right was indefinable and thus not a fit topic for legislation in and of itself. This is a good case of deriving false conclusions from true premises. That there are disputes between rival conceptions of such a right is actually a reason for seeking to give it definite import by intelligent legislation based on some coherent conception of the right, not a reason for rejecting it as indefinable.<sup>9</sup>

This thesis aims to assess the practice and theory of publicity to draw out, if possible, a coherent conception of the right of publicity, and thereafter to assess the appropriate legal regulation, if any, of such a right.

<sup>4</sup> *Douglas v Hello!* [2006] QB 125; *Campbell v MGN* [2004] 2 AC 457.

<sup>5</sup> *Douglas v Hello!* [2006] QB 125.

<sup>6</sup> *Irvine v Talksport Ltd* [2003] 2 All ER 881.

<sup>7</sup> As in the Civilian approach – see Chapter 2 and, for example, H Beverley-Smith *et al*, *Privacy, Property and Personality*, 2005, (henceforth Beverley-Smith *et al*, *Privacy, Property and Personality*), chapters 4 and 5.

<sup>8</sup> As in the American right of publicity – see Chapter 2 and, for example, O Goodenough, “The price of fame: The development of the right of publicity in the United States: Part 1 and Part 2” [1992] EIPR 55 and [1992] EIPR 90 (henceforth Goodenough, “The price of fame, Part 1” or “The price of fame, Part 2”); Beverley-Smith *et al*, *Privacy, Property and Personality*, chapter 3.

<sup>9</sup> N MacCormick, *Stair Memorial Encyclopaedia Reissue* “General Legal Concepts”, 2008, (henceforth MacCormick, *SME Reissue* “General Legal Concepts”), para 94, footnote omitted.



## 2. TRACING THE DEVELOPMENT OF PUBLICITY PRACTICE

It is helpful to start this assessment by considering briefly the development of the practice of exploitation of publicity.<sup>10</sup> A number of factors combined in the UK in the late eighteenth and early nineteenth centuries<sup>11</sup> to create the first mass markets and mass marketing. At least five relevant developments can be identified, as: (i) the ability to mass-produce goods, and (ii) a newly-emerging middle class with disposable income to buy them, together with (iii) the coming of the railways which provided increased and improved communications, thereby assisting (iv) the growth of an increasingly national press, all of which combined to create (v) the need for, and importance of, advertising. Goods could be produced in sufficient quantities in Edinburgh to be distributed for sale not merely in the immediate vicinity but throughout the whole of the United Kingdom, and the railways which enabled rapid transportation of those goods also carried the national newspapers which could advertise those same goods.

Personal endorsement becomes an added boon to businesses attempting to market a product throughout the country, when the supplier's local reputation can no longer be relied upon to do the job: “[a]s mass market products become functionally indistinguishable, manufacturers must increasingly sell them by symbolically

<sup>10</sup> Other writers who have considered this include M Madow, “Private ownership of public image: Popular culture and publicity rights” (1993) 81 Cal L Rev 125 (henceforth Madow, “Private ownership of public image”), at 156-158; H Beverley-Smith, *The Commercial Appropriation of Personality*, 2002, (henceforth Beverley-Smith, *The Commercial Appropriation of Personality*), at 3-4; GM Armstrong, “The reification of celebrity: Persona as property” (1990-1991) 51 La L Rev 443 (henceforth Armstrong, “The reification of celebrity”), at 452; O Goodenough, “Rethorising privacy and publicity” [1997] IPQ 37 (henceforth Goodenough, “Rethorising privacy and publicity”), at 38-39; VM de Grandpre “Understanding the market for celebrity: An economic analysis of the right of publicity” (2001-2002) 12 Fordham Intell Prop Media and Ent LJ 73 (henceforth de Grandpre, “Understanding the market for celebrity”), at 82; and M Richardson and L Hitchens, “Celebrity Privacy and Benefits of Simple History”, in A Kenyon and M Richardson (eds), *New Dimensions in Privacy Law*, 2006, (henceforth Richardson and Hitchens, “Celebrity Privacy”), at 256 and 266-267. The following summary is drawn from all these sources.

<sup>11</sup> For an excellent (if controversial) survey of the development of Western society through the Industrial revolution see E Hobsbawm, *The Age of Revolution 1789-1848* (1977), *The Age of Capital 1848-1875* (1997), and *The Age of Empire 1875-1914* (1994).

associating them with the aura of celebrity – which may be the quickest way to establish a share of the market.”<sup>12</sup>

Evidence of personal endorsements can be detected in “Champagne Charlie”, a persona George Leybourne maintained not only in Victorian music halls but also offstage, under a contractual obligation to do so,<sup>13</sup> and in a number of cases emerging from the courts throughout the nineteenth century. These included *Byron v Johnston*<sup>14</sup> – use of the poet Byron’s name on a publication of poems (allegedly) written by another; *Wilkie v McCulloch*<sup>15</sup> – use of the name of a designer of ploughs on a plough made by another; *Clark v Freeman*<sup>16</sup> – use of the name of a leading physician on pills dispensed by an unconnected party; and *Williams v Hodge*<sup>17</sup> – use of the name of another leading physician on a surgical implement manufactured by a third party.<sup>18</sup> The key element in the cases cited is the use of a famous name to *promote* goods. Even the testimony of unknown individuals had a value to manufacturers of goods, as can be seen in the nineteenth century advertisement in Appendix C. These examples of personal endorsements reveal the changing face of marketing and promotion of goods and services, and indicate the start of a practice that has expanded ever since. One particularly important development was the increased acceptance over time of such practices, overturning earlier notions that exploitation of an individual in commerce was degrading or socially unacceptable.<sup>19</sup>

Press advertising also evolved during this period, with the development of photography and by continuing improvements in technology. The increased role of the press during this period, both in printing advertising and in catering to the interests of the reading public, is discussed by Warren and Brandeis in their seminal

<sup>12</sup> Coombe, “Author/izing the celebrity”, at 368.

<sup>13</sup> J Flanders, *Consuming Passions: Leisure and Pleasure in Victorian Britain*, 2006, at 377.

<sup>14</sup> (1816) 2 Mer 29.

<sup>15</sup> 1822-1824 2S (SC) 413.

<sup>16</sup> (1848) 11 Beav 112.

<sup>17</sup> (1887) 4 TLR 175.

<sup>18</sup> Although misrepresentative or fraudulent use of, for example, an artist’s name has a longer history than this: see <http://www.artcult.fr/EN/Forgeries/Fiche/art-0-1011646.htm?lang=EN> (accessed 18 June 2008).

<sup>19</sup> Westfall and Landau, “Publicity Rights as Property Rights”, at 78, note 26; Armstrong, “The reification of celebrity”, at 459.

article, published in 1890.<sup>20</sup> Their analysis of the indignities suffered by individuals when the press intrudes upon their lives is credited with creating a right of privacy in the United States. Nimmer states their article is “the most famous and certainly the most influential law review article ever written” and refers to Roscoe Pound’s claim that it added a chapter to US law.<sup>21</sup> Warren and Brandeis’s description of the average contents of the daily papers in 1890 destroys any notion that the celebrity gossip we see and hear daily is a modern development:

Gossip is no longer the resource of the idle and of the vicious, but has become a trade, which is pursued with industry as well as effrontery. To satisfy a prurient taste the details of sexual relations are spread broadcast in the columns of the daily papers. To occupy the indolent, column upon column is filled with idle gossip, which can only be procured by intrusion upon the domestic circle.<sup>22</sup>

Over 100 years later, celebrity appearances in gossip columns – both printed and online – are pursued with ever more industry and effrontery. Nor is this an exclusively American problem: the UK’s daily press could easily be described in similar terms.<sup>23</sup> However, although the US and the UK have a largely shared experience of advertising culture and fascination with celebrity gossip, there is a marked divergence between the legal analyses and responses of the two countries. A right to privacy developed in the US within a matter of years following the publication of the Warren and Brandeis article<sup>24</sup> and this right led in turn, 50 years

<sup>20</sup> SD Warren and LD Brandeis, “The right to privacy” (1890-1891) 4 Harv L Rev 193 (henceforth Warren and Brandeis, “The right to privacy”).

<sup>21</sup> MB Nimmer, “The right of publicity” (1954) 19 Law & Contemp Problems 203 (henceforth Nimmer, “The right of publicity”), at 203. For a rather less flattering appraisal of Warren and Brandeis’s contribution to the literature, see D Bedingfield, “Privacy or publicity? The enduring confusion surrounding the American tort of invasion of privacy” (1992) 55 MLR 111. DL Zimmerman assesses the contribution of Warren and Brandeis to American scholarship in “Requiem for a heavyweight: A farewell to Warren and Brandeis’s privacy tort” (1982-1983) 68 Cornell LRev 291.

<sup>22</sup> Warren and Brandeis, “The right to privacy”, at 196.

<sup>23</sup> Examples abound in recent English litigation, and will be considered in Chapter 5.

<sup>24</sup> The failed attempt in *Roberson v Rochester Folding Box Co* 171 NY 538 (1902), led to a 1903 statute in New York to remedy the problem, while the Supreme Court of Georgia recognised a common law right in their 1905 decision in *Pavesich v New England Life Insurance Co* 50 SE 68 (1905): see Prosser, “Privacy”, at 384-389; Beverley-Smith, *The Commercial Appropriation of Personality*, at 146; Armstrong, “The reification of celebrity”, at 443 and 453-457; and Nimmer, “The right of publicity”.

later, to the emergence of a right of publicity based on property in *Haelan Laboratories v Topps Chewing Gum Inc.*<sup>25</sup>

In contrast, law in the UK remains largely uncertain of the appropriate response to publicity situations. This position exposes three distinct groups to legal uncertainty: the individuals – usually celebrities – who are willing to market their image and identity; the parties who are willing to pay to use this (celebrity) persona; and the third parties who are prepared to take a chance on unauthorised use but cannot be sure of the legal risks involved.<sup>26</sup> This is highly unsatisfactory from a legal perspective – albeit the very fact of non-regulation may also be regarded as empowering by some in the commercial world.

### 3. THE SCOPE OF THIS THESIS

Legal writing on publicity has tended to fall into one of two camps. In one, the focus falls on the commercial practice of publicity, and less attention is paid to the legal and theoretical bases and justifications of the right. Authors in this tradition tend to seek the most pragmatic and readily-available solution for this valuable and pervasive practice. In the other camp, theoretical analyses tend to focus on the doctrinal legal basis of publicity rights, while overlooking the commercial reality which is driving the practice forward.

Both theory and practice are of equal importance, since any right of publicity would operate not in the abstract but in the reality that is Scots law. This thesis therefore seeks to bring both camps together. Critically, while an analysis of existing legal protection (such as it is) is a necessary part of this exercise, the main objective will not be to provide a doctrinal review of existing rights, but to focus on finding the

<sup>25</sup> 202 F 2d 866 (2<sup>nd</sup> Cir 1953). As Nimmer pointed out, “although the concept of privacy which Brandeis and Warren evolved fulfilled the demands of Beacon Street in 1890, it may seriously be doubted that the application of this concept satisfactorily meets the needs of Broadway and Hollywood in 1954.” Nimmer, “The right of publicity”, at 203. Beacon Street is a prominent thoroughfare in Boston: [http://en.wikipedia.org/wiki/Beacon\\_Street](http://en.wikipedia.org/wiki/Beacon_Street) (accessed 14 November 2008).

<sup>26</sup> For example, there is a high probability that Talksport would not have predicted the outcome of Irvine’s action against them: *Irvine v Talksport Ltd* [2003] 2 All ER 881.

most appropriate legal taxonomy of *future* legal development in Scotland. This thesis therefore aims to understand the global practice of publicity and to use this understanding in the specific context and framework of Scots law, to enable future legal development to accommodate the needs of all interested parties. One consequence is that this thesis is more normative than discursive in its approach, seeking to delineate the recommended scope of a future publicity right.

The two primary aims of this study therefore are (i) to provide a review of the practice of publicity, grounded in evidence of commercial practice and (ii) to assess and identify the most appropriate legal response to this publicity practice for Scots law.

In doing so, this review must be understood in the context of the “autonomous mixed system”<sup>27</sup> of Scots law. Just as Armstrong can observe of capitalism that “we who live in capitalist societies are marinated in the market to the extent that our religion, friendship, concept of self and understanding of morality are deeply influenced”<sup>28</sup> by the capitalist market, so too is the present interpretation and application of law in the context of publicity influenced by this mixed legal tradition, which recognises and interacts with both Civilian and Common law<sup>29</sup> theories of law. Scots law benefits from the systematic structure of its Civilian heritage, while drawing on the influential case law tradition of Common law systems. Both elements are of great importance, not least the ability to draw on the significantly larger body of case law in England.<sup>30</sup> This mixed background has undoubtedly shaped the approach to publicity rights taken in this thesis, not least through reference to key Civilian and Common law texts on publicity rights, personality rights and intellectual property rights. These

<sup>27</sup> In the words of Whitty: NR Whitty, “Overview of Rights of Personality in Scots Law”, in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009 (henceforth Whitty, “Overview of Rights of Personality in Scots Law”), para 3.1.1.

<sup>28</sup> Armstrong, “The reification of celebrity”, at 451.

<sup>29</sup> Adopting a convention used by Reid, for example, I shall use initial capitals for “Civilian” and “Common” law when referring to the Romanistic-European and Anglo-American legal traditions respectively. When used in lower case, civil law can be taken to indicate private law, while common law indicates those non-statutory rules of law. See E Reid, “Protection for rights of personality in Scots law: a comparative evaluation” 2007 EJCL 11.4, para 1.1, footnote 8.

<sup>30</sup> This is particularly the case in developing areas such as publicity and privacy, as evidenced for example by the references by the Court of Session in *X v BBC* 2005 SLT 796 to the English decision of *Campbell v MGN* [2004] 2 AC 457.

include work by Beverley-Smith,<sup>31</sup> Madow,<sup>32</sup> Carty,<sup>33</sup> Coombe,<sup>34</sup> McCarthy,<sup>35</sup> Neethling,<sup>36</sup> and the comparative material in the SCRIPT Personality Rights Database.<sup>37</sup> In particular, Huw Beverley-Smith's contribution to the literature has been invaluable. His first major publication, *The Commercial Appropriation of Personality*, appeared in 2002 and remains the starting point for any academic work in this area. In it, Beverley-Smith provides an exhaustive review of the current English legal treatment of "personality", and a comparative study of publicity rights in a number of jurisdictions, most notably America, Canada, Australia, France and Germany. It was followed in 2005 by a co-authored text, written by Beverley-Smith, Ohly and Lucas-Schloetter on *Privacy, Property and Personality*, which provides a comparative review of the legal treatment of publicity and privacy in England, France and Germany. This thesis does not attempt to repeat Beverley-Smith's analyses, but to use these texts, and others, as an advanced starting point for continuing the debate and, where possible, rooting it firmly in commercial reality.

One way in which I sought to anchor this review in commercial reality and an understanding of the practice of publicity was by conducting empirical research, to determine attitudes and beliefs towards publicity rights. The questionnaire used in

<sup>31</sup> *The Commercial Appropriation of Property*, and Beverley-Smith *et al*, *Privacy, Property and Personality*.

<sup>32</sup> Madow, "Private ownership of public image".

<sup>33</sup> Primarily H Carty, "Advertising, publicity rights and English law", [2004] IPQ 209; "The Common law and the quest for the IP effect" [2007] IPQ 237; "Personality Rights and English Law", in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009. (Henceforth respectively: Carty, "Advertising, publicity rights and English law"; Carty, "The quest for the IP effect"; and Carty, "Personality Rights and English Law").

<sup>34</sup> Primarily "Author/izing the celebrity"; *The Cultural Life of Intellectual Properties: Authorship, Appropriation, and The Law*, 1998, (henceforth Coombe, *The Cultural Life of Intellectual Properties*); and "Critical cultural legal studies" (1998) 10 Yale JL & Human. 463.

<sup>35</sup> JT McCarthy, *The Rights of Publicity and Privacy*, 2<sup>nd</sup> ed, 2000, (henceforth McCarthy, *The Rights of Publicity and Privacy*); "Public personas and private property: The commercialization of human identity" (1989) 79 TMR 681 (henceforth McCarthy, "Public personas and private property"); "The human persona as commercial property: the right of publicity" (1995) 19 Colum-VLA JL & Arts 129 (henceforth McCarthy, "The human persona as commercial property").

<sup>36</sup> J Neethling, "Personality Rights" in JM Smits (ed) *Elgar Encyclopaedia of Comparative Law*, 2006, (henceforth Neethling, "Personality Rights"); and "Personality rights: a comparative overview" (2005) XXXVIII CILSA 210.

<sup>37</sup> This has been set up as a wiki: [http://personalityrightsdatabase.com/index.php?title=Main\\_Page](http://personalityrightsdatabase.com/index.php?title=Main_Page) (accessed 18 November 2008). An overview and analysis of contributions to this project has been provided by C Waelde and NR Whitty, "A Rights of Personality Database", in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009, (henceforth Waelde and Whitty, "A Rights of Personality Database").

this survey can be found in Appendix A, while graphs illustrating the data relied on (in Chapter 7) are appended at Appendix B.

The questions addressed in this thesis are:

1. What should be the subject matter of a right of publicity?
2. Is there a need for such a right? Is its creation or recognition justified?
3. What should be the legal taxonomy of this right? And what should be its scope, its limits and its associated remedies?<sup>38</sup>

These questions will form the foundation of the following study, and reflect the division of my thesis into three parts.

Part I, comprising Chapters 2 and 3, will explore the existing understanding of publicity rights in theory and in practice, to attempt to delineate the subject matter of publicity. The thesis starts with a review of the publicity rights literature in Western jurisdictions (Chapter 2). It then examines the practice of publicity, including a review of some typical contracts for exploitation of publicity (Chapter 3). In Part II, Chapter 4 starts the cross-over from practice to theory, by considering what justifications can be advanced in favour of a legal right in the commercial practice outlined in Part I. In addition to examining the possible justifications that can be made for the introduction of such rights, the Chapter attempts to respond to some of the criticisms advanced against them. Part III provides a review of rights in Scots law, to determine whether legal protection should best be grounded in the jurisprudence of privacy (Chapter 5), or whether publicity should be recognised as an independent right (Chapter 6). Having concluded that such a right could be recognised, and explored the nature of this right, Chapter 7 reviews its scope, drawing on the conclusions reached in the foregoing chapters to explore a number of questions regarding the limit of the right, and the possible remedies for the holder of the right. Chapter 8 concludes the thesis, drawing its findings together.

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<sup>38</sup> These questions can be thought of as “what, why and how?”



## PART I

Before any attempt can be made to frame a legal right – or to assess whether or not a right is necessary – it is essential to have a clear grasp of the practice that constitutes the subject of the right. This Part is intended to explore the current practice of “publicity”, firstly by reviewing juridical responses to publicity rights and secondly by setting out the scope of publicity practice. Thus, Chapter 2 considers the legal and academic understanding of publicity in a number of Western jurisdictions. Chapter 3 then looks at what individuals and companies do when they exploit someone’s publicity: what is the subject matter and what is the use to which it is put?



## CHAPTER 2: THE THEORY OF PUBLICITY RIGHTS

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### 1. THE LEGAL LANDSCAPE OF PUBLICITY RIGHTS

The social practice of publicity exploitation and the subsequent legal recognition of publicity rights has generated a vast literature. Articles and case commentaries abound in the Western world, from jurisdictions as far apart as Finland and New Zealand, California and Italy. Despite, or perhaps because of, the quantity of literature in this area, it is very difficult to draw together a comprehensive review of the theory and practice in this area, and the jurisprudence remains “disturbingly unsettled”.<sup>1</sup> The purpose of this chapter is to identify the key theoretical approaches to publicity rights through an analysis of publicity rights across Western jurisdictions.

<sup>1</sup> JV Muhonen, “Right of publicity in Finland” [1997] Ent LR 103, at 103. Matters have not changed markedly since 1997, at least in the UK.

Perhaps the only unifying factor in the field of publicity rights is the lack of unity. In contrast, contract law provides an idea of the sort of coherence which can be achieved in more established areas of law.<sup>2</sup> The concepts of agreement and legally enforceable duties are present in most legal systems. Although the Common law systems<sup>3</sup> prefer the promissory analysis which is rejected in most Civilian jurisdictions in favour of mutuality and agreement,<sup>4</sup> this is still a distinction that all jurisdictions can understand and discuss. This common terminology and understanding enables analysis and development of the law to take place in a transnational and comparative framework.

When one turns to publicity, however, there is seemingly little common ground, despite the wealth of literature, academic commentary and case law. For some, publicity is the “commercialisation of popularity”<sup>5</sup> or the right to control commercial use of identity,<sup>6</sup> while for others it is media exploitation of privacy.<sup>7</sup> Case law reveals a wide range of publicity-type circumstances, from the publication, without consent, of an innocent photograph of a young girl taken without her consent,<sup>8</sup> to the interference with a commercial licence for use of a baseball player’s image, arising from the defendant’s use of the player’s image with his consent.<sup>9</sup> The opinions, terminology and conclusions resulting from the practice of publicity are far from harmonious.

<sup>2</sup> For leading definitions from a range of jurisdictions see: Scotland: WW McBryde, *The Law of Contract in Scotland*, 3<sup>rd</sup> ed, 2007, para 1-03, quoting from H McGregor “European Code of Contract” (2004) 8 Edin LR art 1(1); England: HG Beale (ed), *Chitty on Contracts, Volume 1 General Principles*, 29<sup>th</sup> ed, 2004, para 1-001; Germany: BS Markesinis, H Unberath and A Johnston, *The German Law of Contract a Comparative Treatise* 2<sup>nd</sup> ed, 2006, at 25; and the United States: The American Law Institute’s Restatement of the Law, Contracts 2d, para 1.

<sup>3</sup> Notably England and the United States.

<sup>4</sup> For example C von Bar, E Clive and H Schulte-Nolke (eds), *Draft Common Frame of Reference*, 2008, at II-1:101) and O Lando and HG Beale (eds), *Principles of European Contract Law*, 2000, Art 2.101.

<sup>5</sup> J Klink, “50 years of publicity in the US and the never-ending hassle in Europe” [2003] IPQ 363 (henceforth Klink, “50 years of publicity in the US”), at 364.

<sup>6</sup> McCarthy, *The Rights of Publicity and Privacy*, para 1:3.

<sup>7</sup> J Morgan, “Privacy, confidence and horizontal effect: “Hello” trouble” (2003) 62 CLJ 444 (henceforth Morgan, “Privacy, confidence and horizontal effect”).

<sup>8</sup> *Aubry v Les Editions Vice-Versa* (1998) 1 SCR 591.

<sup>9</sup> *Haelan Laboratories v Topps Chewing Gum Inc* 202 F 2d 866.

Nevertheless, it is possible to construct five broad interpretative categories in which to site the academic and judicial material. These categories attempt to recognise that authors are not necessarily tackling exactly the same thing under the umbrella term of “publicity rights”. While it is possible (and desirable) to rationalise their approaches, it is not possible to do so within a single scheme. These categories should not be seen as mapping directly on to different jurisdictions, but as reflecting higher-level, theoretical understandings which can be illustrated by material from a range of Civilian and Common law jurisdictions.

## 2. FIVE APPROACHES TO PUBLICITY RIGHTS

With the caveat that any reductionist approach risks over-simplification, and with the acknowledgment that there will always be overlaps, five approaches<sup>10</sup> to publicity rights can be identified as follows:

- (a) the property approach to publicity rights;
- (b) publicity as a subset of personality rights;
- (c) appropriation of personality;
- (d) character merchandising; and
- (e) privacy and publicity

### 2.1. The “Publicity as Property” Approach

The emphasis in the “publicity as property” approach is very much on commercial exploitation of identity *as a whole* and on the commercial interests at stake in exploitation of popularity. The three key unifying factors in this category are (i) the treatment of the commercial value in identity as a property right; (ii) the centrality of commercial use; and (iii) a tendency to define in wide terms the “asset” being exploited, typically “identity”, rather than narrower notions of name or image. The commentators whose work fits into this broad canon are primarily American, and certainly Common lawyers.

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<sup>10</sup> They will be referred to, interchangeably, as approaches to or categories of publicity rights.

This approach can be regarded as the culmination of legal developments since the early 1950s, stemming from two critical events at that time: the judgment of Justice Frank in *Haelan Laboratories v Topps Chewing Gum*<sup>11</sup> in 1953 and the seminal article by Nimmer on “The right of publicity”,<sup>12</sup> published a year later.<sup>13</sup>

In 1954, Nimmer recognised that

although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.<sup>14</sup>

Where the only legal rights available to the well-known personality look to privacy interests, he is unlikely to achieve the legal protection he seeks. Nimmer examined the doctrines of privacy, unfair competition and contract, and concluded that they were all inadequate to protect this publicity interest.<sup>15</sup> Instead, he argued that the right of publicity “must be largely determined by two considerations: first, the economic reality of pecuniary values inherent in publicity and, second, the inadequacy of traditional legal theories in protecting such publicity values.”<sup>16</sup>

Comprehensive legal protection for such values had been granted in a judgment of the “highly respected Second Circuit”<sup>17</sup> the year before, *Haelan Laboratories v Topps Chewing Gum*.<sup>18</sup> The influence of this case has been strongly felt ever since, with the words of Justice Frank echoing through much academic work in this area:

We think that, in addition to and independent of the right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph... Whether it be labelled a “property” right is immaterial; for

<sup>11</sup> (1953) 202 F.2d 866.

<sup>12</sup> (1954) 19 Law & Contemp Probs 203. The importance of Nimmer’s contribution should not be underestimated. Grady says “[h]is great contribution was to provide the first reliable glosses of a new and unruly body of case precedent and thereby provide a solid foundation for the whole field.” MF Grady, “A positive economic theory of the right of publicity” (1994) 1 UCLA Ent L Rev 97 (henceforth Grady, “A positive economic theory of the right of publicity”), at 109.

<sup>13</sup> See McCarthy, *The Rights of Publicity and Privacy*, paras 1:26-1:27.

<sup>14</sup> (1954) 19 Law & Contemp Probs 203, at 204.

<sup>15</sup> This is to some extent a foregone conclusion, since the heading for each of these sections is “Inadequacy of...” *Ibid.*, at 204, 210 and 214.

<sup>16</sup> *Ibid.*, at 215.

<sup>17</sup> *Ibid.*, at 222.

<sup>18</sup> (1953) 202 F.2d 866.

here, as often elsewhere, the tag “property” simply symbolizes the fact that courts enforce a claim which has a pecuniary worth.<sup>19</sup>

In the decades since *Haelan*, the right of publicity has “matured and taken on its own distinctive identity as an altogether separate legal category.”<sup>20</sup> By 2001, McCarthy was able to state that “the right of publicity is simply this: it is the inherent right of every human being to control the commercial use of his or her identity.”<sup>21</sup> This wide concept of “identity”, whereby “certain celebrity identities can be appropriated as effectively or even more effectively via other means”<sup>22</sup> and not merely their name and image, is an inherent part of this approach to publicity. Westfall and Landau suggest that the “vague principle initially underlying the right... as expressed in *Haelan*”<sup>23</sup> has meant that there have been no obvious parameters to the right to guide (or limit) judicial or legislative development,<sup>24</sup> resulting in protection being extended to ever-wider elements of identity.

This wide approach to publicity regards it as a “commercial and business right”<sup>25</sup> which is properly viewed as a kind of intellectual property right and is very clearly, in McCarthy’s view, a property right.<sup>26</sup> Academic writing in this category is rich in the language of property and commodification,<sup>27</sup> while legislation also reflects this

<sup>19</sup> *Ibid.*, at 868, per Frank CJ.

<sup>20</sup> McCarthy, “Public personas and private property”, at 685.

<sup>21</sup> McCarthy, *The Rights of Publicity and Privacy*, para 1:3.

<sup>22</sup> Westfall and Landau, “Publicity Rights as Property Rights”, at 94.

<sup>23</sup> *Ibid.*, at 93.

<sup>24</sup> *Ibid.*, at 93-96.

<sup>25</sup> McCarthy, “Public personas and private property”, at 687. For the centrality of commercial use see also, for example, HR Gordon, “A right of property in name, likeness, personality and history” (1960-1961) 55 *Northwestern University Law Rev* 553; and DL Zimmerman, “Who put the right in the right of publicity?” (1998-1999) 9 *DePaul-LCA J Art & Ent L* 35 (henceforth Zimmerman, “Who put the right in the right of publicity?”), at 36; *contra* Goodenough, “Retheorising privacy and publicity”, at 42.

<sup>26</sup> *Ibid.*, at 687; also McCarthy, “The human persona as commercial property”, at 134. See also Armstrong, who stated in 1990 that persona was not only treated as a property right, but that it *was* the subject of property rights: “[c]elebrity persona has become a heritable, alienable “thing” from which the owner may arbitrarily exclude others. In other words, it has become property.” Armstrong, “The reification of celebrity”, at 444.

<sup>27</sup> As well as McCarthy, see generally: Armstrong, “The reification of celebrity”; Goodenough, “The price of fame, Parts 1 and 2”; Westfall and Landau, “Publicity Rights as Property Rights”; Madow, “Private ownership of public image”; and Zimmerman, “Who put the right in the right of publicity?”.

approach. In those American states that have passed legislation to regulate publicity rights, a number of them have explicitly stated that publicity is a property right.<sup>28</sup>

Coombe has stated that “personality rights” extends

to encompass the tort of appropriation of personality as it has developed at common law, the proprietary right of publicity that has developed in American law, and rights to prevent the appropriation of, *inter alia*, names and likenesses that have been enacted in provincial and state statutes as well as federal trademark legislation.<sup>29</sup>

Coombe relies not only on legislation and case law to inform her understanding, but also on urban legend and popular perceptions of publicity,<sup>30</sup> and this is typical of the Common law approach in its breadth and practical scope. One distinction that is highlighted by Coombe is the difference between the “right of publicity” *per se* and appropriation of personality. This distinction is reflected in the American Law Institute’s Restatements: the Restatement of Torts deals with appropriation of personality (see section 2.3 below), while the Restatement of Unfair Competition deals with the publicity right currently under review, focusing on commercial use and trade values.<sup>31</sup>

One consequence of the emphasis on commercial use and proprietary interests is reflected in the attributes of the publicity right. In the words of McCarthy, “[a]s property, the right of publicity can be licensed and can be devised in a will to continue after death.”<sup>32</sup> The duration, alienability and descendibility of the right, together with remedies for breach, are all influenced by this property focus. This is referred to as the “property syllogism” by Westfall and Landau, who argue that the recognition of the transferability of publicity imbued it with property status, with the result that other attributes of property ownership then followed as a matter of

<sup>28</sup> See for example Illinois’s Right of Publicity Act 765 ILCS 1075/15; Indiana’s Publicity law IC 32-36.16; Kentucky Statute 391.170(1); Oklahoma Stat. tit 12, para 1448B; Washington Chapter 63.60 RCW Personality Rights, section 030(1). For more detail, see McCarthy, *The Rights of Publicity and Privacy*, chapter 6, part II.

<sup>29</sup> Coombe, “Author/izing the celebrity”, at 365, note 2.

<sup>30</sup> See for example Coombe, *The Cultural Life of Intellectual Properties*, particularly chapter 2; Coombe, “Author/izing the celebrity”.

<sup>31</sup> American Law Institute’s Restatement of the Law, Unfair Competition, 3d, chapter 4, paras 46-49.

<sup>32</sup> McCarthy, “Public personas and private property”, at 687. See also Nimmer, “The right of publicity”, at 216; HR Gordon, “A right of property in name, likeness, personality and history” (1960-1961) 55 Northwestern University Law Rev 553.

course.<sup>33</sup> These elements are now accepted features of the right: for example, most (but not all) states in the US provide a statutory publicity right which includes a certain post mortem duration, rather than terminating the right on death, thus allowing protection and exploitation following the death of the individual.<sup>34</sup> Similarly, remedies are available not just for the injured celebrity, but for any authorised licensees – a recognition of the proprietary nature of the publicity right.<sup>35</sup> Klink is very much in favour of “the construction of the publicity right as a property right [which] ensures more effectively the compatibility with business needs by allowing the right to be assigned per se or to be licensed.”<sup>36</sup>

It would be a mistake, however, to claim that this is an entirely homogenous category. There are undoubtedly divisions between certain authors on certain points. To take one example, although both McCarthy and Goodenough are agreed on the core elements of this broad right of publicity, centred on protection through property rights for the commercial exploitation of identity, McCarthy claims that publicity rights are distinguishable from the four Restatement rights of privacy,<sup>37</sup> while Goodenough believes that “the separation between rights of privacy and publicity is largely accidental and artificial.”<sup>38</sup> Further, not all those who discuss publicity in terms of property favour this approach to legal protection, Madow being a key example.<sup>39</sup>

<sup>33</sup> Westfall and Landau, “Publicity Rights as Property Rights”, at 74 and 83 *et seq.*

<sup>34</sup> McCarthy notes that most states which recognise a post mortem right do so with reference to copyright law as to the term of this right, per “Public personas and private property”, at 694. See also Klink, who discusses and approves of these measures in California, per “50 years of publicity in the US”, at 387. Goodenough takes a more sceptical view in his discussion of descendibility of publicity right in the US, per “The price of fame, Part 2”, at 90-91. Post mortem protection is discussed in more detail below in Chapter 7, section 3.3.

<sup>35</sup> *Haelan Laboratories v Topps Chewing Gum Inc* 202 F 2d 866.

<sup>36</sup> Klink, “50 years of publicity in the US”, at 385.

<sup>37</sup> McCarthy, “Public personas and private property”, at 684.

<sup>38</sup> Goodenough, “Re-theorising privacy and publicity”, at 69. In discussing the development of rights in the US, Vaver suggests a middle ground: acknowledgment that the right of publicity “was catapulted into the law on the strings of commercial appropriation” of privacy, but that they were separated by the court in *Haelan Laboratories v Topps Chewing Gum*. See D Vaver, “What’s mine is not yours: Commercial appropriation of personality under the Privacy Acts of British Columbia, Manitoba and Saskatchewan” (1981) 15 U Brit Colum L Rev 241 (henceforth Vaver, “What’s mine is not yours”), at 258-259.

<sup>39</sup> Madow, “Private ownership of public image”.



One factor which this approach typically lacks, and which is more prominent in Civilian jurisdictions, is an element of protection for the dignitarian or personality-based interests.<sup>40</sup> One American writer who advanced quasi-personality rights here is Kwall. She suggests that “a careful look at right of publicity litigation reveals that many decisions actually are more concerned with redressing rights of integrity over the images of the celebrity”,<sup>41</sup> and argues that this implicit concern must be made explicit. Her solution is to advance a role for moral rights, in the manner of such rights in copyright works, by protecting the “damage to the human spirit”<sup>42</sup> which can arise. The importance of her work is that it straddles one of the central distinctions between the broad publicity as property approach, which focuses primarily on the economic interests, and the Civilian “rights of personality approach”, considered at section 2.2 below, which places much greater emphasis on dignitarian considerations. Despite Kwall’s attempt to reconcile the two, there remains a gap between protection for commercial and dignitarian interests in most jurisdictions. This tension plays a key role in shaping the right and the debate in this area, as will be seen throughout this thesis.

## 2.2. Publicity as a Subset of Personality Rights

This approach is most closely associated with Civilian jurisdictions, which treat personality rights as “a separate category of rights, distinguishable from real, personal and immaterial property rights”.<sup>43</sup> Personality rights are intimately connected with the individual, and “recognize a person as a physical and spiritual-moral being and guarantee his enjoyment of his own sense of existence”.<sup>44</sup> Thus, personality rights in this context are fundamental rights belonging to each individual. Personality is a “convenient portmanteau term”<sup>45</sup> used to refer to, amongst others, “the rights to life, physical integrity, bodily freedom, reputation, dignity, privacy,

<sup>40</sup> McCarthy, for example, is very clear that publicity is a commercial right: *The Rights of Publicity and Privacy*, para 1:3.

<sup>41</sup> RR Kwall, “Preserving personality and reputational interests of constructed personas through moral rights: a blueprint for the twenty-first century” 2001 U Ill L Rev 151, at 158.

<sup>42</sup> *Ibid.*, 152.

<sup>43</sup> Neethling, “Personality Rights”, at 535.

<sup>44</sup> *Ibid.*, at 530.

<sup>45</sup> E Reid, “Protection for rights of personality in Scots law: A comparative evaluation” 2007 EJCL 11.4, para 1.1.



identity (including name and image) and feelings.”<sup>46</sup> As Reiter observes, these are the “various attributes of personality that the modern world has erected on this premodern foundation”.<sup>47</sup> The importance of these long-standing personality rights in Civilian jurisdictions should not be under-estimated: German law, for example, places the right to dignity at the very heart of its constitutionally protected personality rights.<sup>48</sup> Civilian personality rights have been delineated on a pan-jurisdictional basis by Neethling,<sup>49</sup> while a comparative review of French and German rights (together with Common law jurisdictions) is provided by Beverley-Smith *et al.*<sup>50</sup> More generally, insight can be drawn from the SCRIPT personality rights database.<sup>51</sup>

It is possible to identify common themes that arise from the treatment of publicity rights as a subset of personality rights. The first of these is the emphasis on dignitarian rights. Concepts such as privacy and human dignity are central to any legal protection for the individual’s personality rights. Consequently, the *commercial* significance of infringement in publicity situations may be marginalised. In German law, for example, claims for damages for breach of personality rights require either evidence of a loss or the calculation of a hypothetical reasonable licence fee.<sup>52</sup> This latter measure would compensate damage to the claimant’s commercial interests – yet it will not be available where it can be shown that the claimant would never have been prepared to license the use complained of, as in the case of “the professor of ecclesiastical law, who had been alleged to propagate the ginseng root as a sexual stimulant, [and who] could not recover substantial damages

<sup>46</sup> Neethling, “Personality Rights”, at 530.

<sup>47</sup> EH Reiter, “Personality and patrimony: Comparative perspectives on the right to one’s image” (2001-2002) 76 Tulane L Rev 673 (henceforth Reiter, “Personality and patrimony”), at 680.

<sup>48</sup> Neethling, “Personality Rights”, at 563: “German doctrine thereby accords all human rights the same status (apart from human dignity, which is regarded as the most fundamental value)” and this is protected by the German Constitution of 1949.

<sup>49</sup> Neethling provides an excellent summary of personality rights in “Personality Rights”.

<sup>50</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*.

<sup>51</sup> Available at: [http://personalityrightsdatabase.com/index.php?title=Main\\_Page](http://personalityrightsdatabase.com/index.php?title=Main_Page) (accessed 18 November 2008). See also Waelde and Whitty, “A Rights of Personality Database”.

<sup>52</sup> Also referred to as the notional licence fee, this is calculated according to the hypothetical sum that the pursuer and defender would have agreed upon for the defender’s otherwise unauthorised use. It will be discussed in more detail in Chapter 7.

but only a solatium”.<sup>53</sup> Because the court held he would never have been prepared to license his image for this use there was no basis upon which to award him a reasonable licence fee.<sup>54</sup> The end result is that in many cases only *solatium* will be available, and thus “the courts deny adequate compensation in the most serious cases of personality right infringement.”<sup>55</sup>

A further consequence of the focus on dignitarian interests in this approach is greater controversy about the right continuing post mortem,<sup>56</sup> in comparison with the broad “publicity as property” approach, which does accommodate post mortem protection. Difficulties arise because of the tension between the dignitarian and commercial interests, such that post mortem protection may be more readily recognised to enable surviving relatives to protect *their* dignitarian interests, but not necessarily the commercial interest in the deceased’s image.<sup>57</sup>

Although Civilian jurisdictions as a whole treat publicity within the framework of personality rights, the specific treatment of publicity and personality rights in each jurisdiction varies. One possible reason for this is the tension that results from protecting a commercial, economic interest within a dignitarian framework of extra-patrimonial interests. Reiter notes that “while the attributes of human personality, like name, reputation, image, voice, and privacy, have traditionally been seen as extrapatrimonial rights without monetary value, today these rights are being increasingly patrimonialized and brought into commerce.”<sup>58</sup> Consequently, the courts and commentators have had to reconcile two opposing interests, with the result that a “patrimonialized extra-patrimonial right” emerges.<sup>59</sup> Accommodating the divergence between dignitarian rights and commercial interests has produced

<sup>53</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 143.

<sup>54</sup> A similar conclusion was reached in the first of the “Caroline” cases, raised by Princess Caroline in Germany: since she would never have consented to the publication of the fictional interview in question, her claim for disgorgement of profits failed: BGHZ 128 – *Caroline von Monaco I*, as discussed by Beverley-Smith *et al*, *Privacy, Property and Personality*, at 103.

<sup>55</sup> *Ibid.*, at 143.

<sup>56</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(b).

<sup>57</sup> See Chapter 7; also Beverley-Smith *et al*, *Privacy, Property and Personality*, at 124 and 200-205; Neethling, “Personality Rights”, at 544-545.

<sup>58</sup> Reiter, “Personality and patrimony”, at 673.

<sup>59</sup> *Ibid.*, at 673.

various responses in Civilian jurisdictions, often categorised as either “monistic” or “dualistic”.<sup>60</sup>

The dualistic model<sup>61</sup> requires two different rights, one (positive) patrimonial and one (negative) extra-patrimonial, to protect the interests in exploitation and protection of publicity. As Logeais observes, in the context of the debate in France, the

general analysis is to consider that the right to the image is a “Janus” right displaying a negative extra-patrimonial aspect which is in fact absorbed by personality rights (mainly the rights to privacy and dignity), and a “positive” patrimonial aspect, the right to capitalise on the use of one’s image.<sup>62</sup>

The distinction made in French law is between the right *to* one’s image, which is an “inherent part of the person”, and the right *over* one’s image, which is “a commodity to be exploited”.<sup>63</sup> The consequence of this is that “a general personality right does not fit into French law.”<sup>64</sup> Instead, protection is achieved through dual rights protecting material and subjective interests respectively.<sup>65</sup>

The monistic approach offers an alternative and is favoured, for example, in Germany.<sup>66</sup> Here, one right, such as the general personality right,<sup>67</sup> protects both the economic and dignitarian interests in publicity. This was specifically addressed by

<sup>60</sup> For a broad summary of these differences, see Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9.

<sup>61</sup> See, for example, Beverley-Smith *et al*, *Privacy, Property and Personality*, at 11; Neethling, “Personality Rights”, at 543; and Whitty, who notes that the American approach can also be regarded as dualistic, “Overview of Rights of Personality in Scots Law”, para 3.4.9.

<sup>62</sup> E Logeais, “The French right to one’s image: a legal lure?” [1994] Ent LR 163 (henceforth Logeais, “The French right to one’s image”), at 165.

<sup>63</sup> Both quotations from Reiter, “Personality and patrimony”, at 684-685. Reiter also equates the extrapatrimonial right to a negative right, and the patrimonial and commercial right to a positive right, at 685. See also Logeais, “The French right to one’s image”, at 165.

<sup>64</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 153.

<sup>65</sup> *Ibid.*, at 154-157; also Logeais, “The French right to one’s image”, at 165.

<sup>66</sup> Neethling, “Personality Rights”, at 543. See also Beverley-Smith *et al*, *Privacy, Property and Personality*, chapter 4; Klink, “50 years of publicity in the US”, at 380; Waelde and Whitty, “A Rights of Personality Database”, para 11.4.2.

<sup>67</sup> This was developed by the judiciary through case law, emanating from the constitutional right to dignity. German law also recognises a number of specific statutory rights which protect aspects of personality, such as the right to one’s name (§12 BGB) and to one’s image (§22 KUG). See Beverley-Smith *et al*, *Privacy, Property and Personality*, at 105-124; Neethling, “Personality Rights”, at 530, 539-540. Beverley-Smith *et al* also note that the general personality right can act as an interstitial right where the specific rights fail (at 110).

the Bundesgerichtshof in the *Marlene Dietrich* case,<sup>68</sup> brought by her daughter against a producer who had sold various items of “Marlene” merchandising. In reaching its decision, the court “stressed the two aspects of the personality right which protected not only ideal, but also economic interests.”<sup>69</sup> Consequently, unauthorised use of name, image or reputation could give rise to a claim for damages or unjust enrichment,<sup>70</sup> as well as claims for *solatium*.

Despite the differing monistic and dualistic responses to publicity in Civilian jurisdictions, it is nonetheless possible to group together these responses to publicity, derived from the over-arching doctrine of personality rights – a doctrine which is “firmly established”<sup>71</sup> in Civilian jurisdictions.

### 2.3. Appropriation of Personality

Arguably the most influential and popular approach taken by English academics is the “appropriation of personality” classification. At the outset, it needs to be appreciated that “personality” in this context means the identifying elements of an individual, typically their name, likeness and voice. It is thus akin to the colloquial notion of someone’s personality being their character, and must be distinguished from the very different meaning accorded to “personality rights” in the Civilian approach discussed above.

The three features common to this approach are (i) the notion of (mis)appropriation, typically for commercial uses, of personality; (ii) the understanding of personality as the identifying elements of the individual; and (iii) a recognition that a number of discrete actions, typically torts, are the most appropriate, or at least the most practicable, home for publicity actions, rather than a single property or personality rights doctrine. Further, the focus on appropriation gives rise to an implicit, yet common, understanding that the use made of personality be *unauthorised*, rather than

<sup>68</sup> BGHZ 143, 1 December 1999, cited in Beverley-Smith *et al*, *Privacy, Property and Personality*, at 104 et seq.

<sup>69</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 104.

<sup>70</sup> *Ibid.*

<sup>71</sup> Neethling, “Personality Rights”, at 530.

authorised. There is thus a risk that exploitation by the individual remains unaddressed by this analysis.

Perhaps the origins of this approach can be traced to Prosser's 1960 article "Privacy",<sup>72</sup> wherein he attempted to synthesise American judicial decisions and writing, starting from Warren and Brandeis' 1890 article on "The Right to Privacy".<sup>73</sup> While it would not necessarily be accurate to regard Warren and Brandeis' article as the foundation of this category, since its interest was most certainly with the "right to be let alone", the evolution of publicity practice was such that, 70 years later, Prosser could no longer ignore the commercial practice in "selling" privacy. Accordingly, when he formulated his tort of privacy, the four limbs he identified covered a range of invasions, concluding with the fourth: "Appropriation, for the defendant's advantage, of the plaintiff's name or likeness".<sup>74</sup>

This four-part tort protecting privacy was incorporated into the American Restatement of Torts, 2d, where the second limb stated: "The right of privacy is invaded by... (b) the appropriation of the other's name or likeness as stated in para 652C".<sup>75</sup> It is this limb which forms the starting point for this category of publicity protection.<sup>76</sup>

A clear lineage of writers in this canon can be traced from Prosser onwards, across jurisdictions. Vaver provides an analysis of the incorporation of this tort in privacy statutes in three Canadian provinces,<sup>77</sup> while Frazer's<sup>78</sup> and Beverley-Smith's<sup>79</sup> contributions form the starting point for any study of publicity rights in English law. Quotations from Vaver, Frazer and Beverley-Smith illustrate their common

<sup>72</sup> "Privacy".

<sup>73</sup> (1890-1891) 4 Harv L Rev 193.

<sup>74</sup> Prosser, "Privacy", at 389. See also McCarthy, *The Rights of Publicity and Privacy*, paras 1:19-1:24.

<sup>75</sup> American Law Institute's Restatement of the Law, Torts, 2d, para 652A.

<sup>76</sup> Contrast the commercial emphasis of the right of publicity protected by the American Law Institute's Restatement of the Law, Unfair Competition, 3d, which focuses on the appropriation of trade values, rather than personality. Discussed in section 2.1 above.

<sup>77</sup> Vaver, "What's mine is not yours".

<sup>78</sup> Frazer, "Appropriation of personality – a new tort?" (1983) 99 LQR 281 (henceforth Frazer, "Appropriation of personality").

<sup>79</sup> Beverley-Smith, *The Commercial Appropriation of Personality*.

approach, and echo Prosser's earlier formulation. Thus, Vaver's 1981 article addresses the issue of the "commercial appropriation of personality" and the question of "how far an individual may control use of his personality (his name, likeness and voice) for commercial purposes, especially advertising."<sup>80</sup> Frazer set out to "examine the extent to which the law has developed, or ought to develop, to take account of one particular form of commercial practice – the use, without consent, of the name, likeness or voice of another."<sup>81</sup> Beverley-Smith opens his analysis with a succinct definition:

The essence of the problem of appropriation of personality may be put very simply: if one person (A) uses in advertising or merchandising the name, voice or likeness of another person (B) without his or her consent, to what extent will that person (B) have a remedy to prevent such an unauthorised exploitation?<sup>82</sup>

Interestingly, Beverley-Smith's definition appears at first sight to be narrower than the others, being limited to advertising and merchandising uses, but this is not in fact the case. His analysis discloses a wider range of publicity activities, including unauthorised media use, such as that in the *Douglas v Hello!* litigation.<sup>83</sup> Thus, Beverley-Smith's focus is, as the title of his monograph suggests, on the (unauthorised) commercial appropriation of personality.<sup>84</sup>

As already noted, the appropriation of personality approach does not rely on a single legal doctrine to protect personality. This is due in no small measure to the fact that "unlike both the Continental European and American approaches, the English common law has traditionally been mistrustful of generalised rights."<sup>85</sup> Instead, a pragmatic approach to litigation has seen a range of doctrines employed in the

<sup>80</sup> Vaver, "What's mine is not yours", at 241.

<sup>81</sup> Frazer, "Appropriation of personality", at 281.

<sup>82</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 3.

<sup>83</sup> Although his work predates the substantive judgments in this case, the Court of Appeal ruling on the injunction in this case is cited on 16 pages of his text, according to the case list (p.xviii).

<sup>84</sup> This terminology reflects that of Prosser, Vaver and Frazer, as discussed in the preceding paragraphs, and is repeated and rephrased in countless other articles. See, for example, S Boyd and R Jay, "Image rights and the effect of the Data Protection Act 1998" [2004] Ent LR 159; S Bains, "Personality rights: should the UK grant celebrities a proprietary right in their personality? Parts 1, 2 and 3" [2007] Ent LR 16, 205 and 237; Carty, "Advertising, publicity rights and English law"; J Hull, "The merchandising of real and fictional characters: an analysis of some recent developments" [1991] Ent LR 124; G Scanlan and A McGee, "Phantom intellectual property rights" [2000] IPQ 264; and Robinson, "How image conscious is English law?" [2004] Ent LR 151.

<sup>85</sup> Carty, "Personality Rights and English Law", para 7.2.1.

English courts, including passing off,<sup>86</sup> registered trade mark protection,<sup>87</sup> and privacy actions.<sup>88</sup> These actions are used to protect various aspects of the individual's personality where this has been "misappropriated".<sup>89</sup> "Personality" is broadly seen as the individual's name, likeness and voice.

However, a number of problems with this category can be identified. In the first place, the use of the term "appropriation" suggests a taking of *property*, yet the use of property in this context in English law is more likely to be metaphorical than indicative of the rights in question.<sup>90</sup> The Second Restatement in the US does state that the right so created is "in the nature of a property right",<sup>91</sup> but clearly this does not mean that the right *is* one of property.<sup>92</sup>

Secondly, if the wrong done is *appropriation*, the focus is on the taker, rather than the "victim" or individual in question. This seems to envisage only unauthorised use of the individual's personality by other parties. Does this mean that there is no right for the individual to exploit his own publicity value? A definition which centres round the "appropriation" of personality potentially (although not necessarily<sup>93</sup>) excludes an individual's own exploitation of his personality from its scope. This is perhaps not surprising in Common law jurisdictions, since these systems typically draw their rules from the outcomes of decided cases and focus very much on remedies rather than rights. Accordingly, the right of self-exploitation is less of a

<sup>86</sup> *Irvine v Talksport Ltd* [2003] 2 All ER 881.

<sup>87</sup> *Jane Austen Trade Mark* [2000] RPC 879, *Elvis Presley Trade Marks* [1997] RPC 543, on appeal, [1999] RPC 567; see also Carty, "Advertising, publicity rights and English law", at 210-211.

<sup>88</sup> *Douglas v Hello!* [2006] QB 125.

<sup>89</sup> And Carty notes that the language of misappropriation is "creeping into" the actions for passing off and breach of confidence: Carty, "Advertising, publicity rights and English law", at 242.

<sup>90</sup> For example, in *Douglas v Hello!*, it was stated that English law "does not depend on treating confidential information as property, although it is often referred to, loosely or metaphorically, in those terms": [2008] 1 AC 1, para 276, per Lord Walker.

<sup>91</sup> American Law Institute's Restatement of the Law Second, Torts Volume 3, para 652C(a), at 381. This can be used to further refute McCarthy's point, although it is possible that the commercial benefit of this could be taken to accrue only to exclusive licensees.

<sup>92</sup> There is a question mark over whether or not "personality" can be the subject of property rights, and this will be examined in greater detail in Chapter 6.

<sup>93</sup> It could be argued that authorised use is unobjectionable, and does not need to be addressed, although silence on the point is not entirely satisfactory. The rights and remedies, if any, of exclusive licensees also remain uncertain in this situation.



concern for writers in this category than are the remedies for individuals where there has been unauthorised (or wrongful) use.

Despite these potential hurdles, the appropriation of personality category offers the most comprehensive review of publicity rights in English law to date. It will play a prominent role in the debate to follow.

Although Scots law has not so far produced any case law in this area, both MacQueen, Waelde and Laurie's *Contemporary Intellectual Property*, and Colston and Middleton's *Modern Intellectual Property Law* have assessed publicity in broadly these terms. That they have done so indicates the practical impact of English law in Scotland, while doctrines such as passing off have developed together north and south of the border<sup>94</sup> and trade mark law is governed by UK-wide legislation.<sup>95</sup> Similarly, the English privacy actions have been founded on the Human Rights Act 1998, which applies equally in Scotland as in England. Thus, whatever a Scots court may ultimately decide, it is almost unimaginable that an advocate would not attempt to follow a similar line of argument as has been successfully pursued south of the border, thus bringing Scots law within the "appropriation of personality" scheme, rather than the categories examined above.

## 2.4. Character Merchandising

This category, like the one following, is slightly different from the previous three. It has a narrower focus and can be arguably seen as a product of its time. It is perhaps misleading, therefore, to claim that this is an entirely discrete category. Rather it reflects a series of cases in England in the 1970s, 1980s and 1990s, which dealt with the practice of character merchandising, but which are now gradually becoming, by

<sup>94</sup> The leading English cases (*Erven Warnink BV v J Townend* [1979] AC 731 and *Reckitt & Coleman Products Ltd v Borden Inc* [1990] 1 All ER 873) were followed in the leading Scottish case, *William Grant v Glen Catrine Bonded Warehouse* 2001 SC 901. Although Reid notes that the doctrinal basis of passing off is very different in Scotland and England, she acknowledges that, in Scots law, "considerable weight has been accorded to English authority in this field", especially in modern cases. E Reid, "Protection of personality rights in the modern Scots law of delict", in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009 (henceforth Reid, "Personality rights in the modern Scots law of delict"), para 4.4.1.

<sup>95</sup> Trade Marks Act 1994.



virtue of decisions such as *Irvine v Talksport*,<sup>96</sup> subsumed within the broader classification of “appropriation of personality” – not least because of the shared reliance on tort law in both categories.

Case law in England in the 1970s onwards started to reflect the commercial practices of “character” merchandising,<sup>97</sup> with actions being raised to recover for infringements under the tort of passing off<sup>98</sup> and, later, breach of registered trade mark rights.<sup>99</sup> Writers in the 1980s and 1990s reacted to these cases, and the plethora of articles and case notes generated in these two decades reflect this development and the reaction to it.<sup>100</sup> In particular, academics observed the changing commercial practice of merchandising and advertising goods using celebrities, and, equally importantly, society’s changing understanding of it. There was therefore a drive to interpret and perhaps influence the legal recognition and analysis of the changing marketplace. This understanding of merchandising is thus united round the idea of the promotion of goods or services through the use of the name or image of a “character”, with or without that character’s endorsement.

<sup>96</sup> [2003] 2 All ER 881.

<sup>97</sup> Although this examination proceeds on the basis that merchandising featuring individuals can be distinguished from merchandising which uses fictional characters and/or actors who have a very strong association with a particular character (such as Paul Hogan/Crocodile Dundee and Telly Savalas/Kojak), this distinction has not always been clear or explicit. The literature and case law referred to reflects both practices, albeit the focus in this section will be on merchandising use of an individual rather than use of a fictional character.

<sup>98</sup> *Lyngstad v Anabas* [1977] FSR 62; *Wombles Limited v Wombles Skips Limited* [1975] FSR 488; *Taverner Rutledge v Trexapalm Clothing* [1977] RPC 275 (featuring a fictional character portrayed by an actor); *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145.

<sup>99</sup> One of the earliest English trade mark cases was the *Holly Hobbie* decision, *Re American Greetings Corporation’s Application* [1984] 1 All ER 426, which involved use of a fictional character. Later cases involved real, but deceased, persons: *Elvis Presley Trade Marks* [1997] RPC 543 and, on appeal, [1999] RPC 567; *Jane Austen Trade Mark* [2000] RPC 879. See also G Davies, “The cult of celebrity and trade marks: the next instalment” (2004) 1:2 *SCRIPT-ed* 230.

<sup>100</sup> See for example, SCG Burley, “Passing off and character merchandising: Should England lean towards Australia?” [1991] EIPR 227; J Holyoak, “United Kingdom character rights and merchandising rights today” 1993 JBL 444; J Hennigan, “Altered image rights” [2003] Ent LR 161; G Scanlan, “Personality, endorsement and everything: the modern law of passing off and the myth of the personality right” [2003] EIPR 563; P Jaffey, “Merchandising and the law of trade marks” [1998] IPQ 240; H Porter, “Character merchandising: Does English law recognise a property right in name and likeness?” [1999] Ent LR 180; J Hull, “The merchandising of real and fictional characters: an analysis of some recent developments” [1991] Ent LR 124; SM Maniatis and M Chong, “The Teenage Mutant Hero Turtles case” [1991] EIPR 253; M Lewis and M Elmslie, “Passing off and image marketing in the UK” [1992] EIPR 270.

Since 1991, academics and practitioners have had the advantage of one of the most important English judgments in this area, the decision of the Vice Chancellor in the passing off action *Mirage Studios and Others v Counter-Feat Clothing Company Limited and Another*.<sup>101</sup> In this case, the Vice Chancellor accepted that use of cartoon characters on clothing could infringe the rights of the copyright holder, not necessarily by infringement of copyright (a point which was not decided), but through the tort of passing off. The importance of this decision stems from its effective reversal of two earlier passing off cases where a remedy was refused for the use of an individual's image in merchandising.<sup>102</sup> This was achieved, in part, through the Vice Chancellor's recognition of the fact that "[c]haracter merchandising is an industry which has grown in sophistication over the comparatively recent past"<sup>103</sup> together with society's increasing awareness of that industry.<sup>104</sup>

Such was the prevalence of merchandising in the latter part of the twentieth century that the 1995 Congress of the International Association for the Protection of Intellectual Property (AIPPI) recognised the role of merchandising as "the use of distinctive elements to enhance the promotion or sale of products and services."<sup>105</sup> As Ruijsenaars observes, the AIPPI's eventual description "could have been more precise, [but] problems arise from the diversity of the subject-matter of

<sup>101</sup> [1991] FSR 145 (Ch).

<sup>102</sup> *McCulloch v Lewis A May Ltd* (1948) 65 RPC 58 and *Lyngstad v Anabas Products* [1977] FSR 62.

<sup>103</sup> [1991] FSR 145 (Ch), at 148.

<sup>104</sup> Walton J referred to the commercial practice of merchandising in *Wombles Limited v Wombles Skips Limited* [1975] FSR 488 and *Tavener Rutledge Limited v Trexapalm Limited* [1975] FSR 479, and the House of Lords did likewise in *In Re American Greeting Corporation's Application* [1984] 1 WLR 189, indicating a growing awareness of merchandising through the 1970s and 1980s. It was not until *Mirage Studios* in 1991, however, that this recognition appeared to have an explicit impact on the application of the law. The importance of changing social practice was also commented upon by G Scanlan, "Personality, endorsement and everything" [2003] EIPR 563, at 568; SM Maniatis and S Chong, "The Teenage Mutant Hero Turtles case" [1991] EIPR 253 at 257; and H Porter, "Character merchandising: Does English law recognise a property right in name and likeness?" [1999] Ent LR 180, at 180. Porter however also draws attention to the views expressed by Laddie J in *Elvis Presley Trade Marks* [1997] RPC 543, to the effect that members of the public do not care who has manufactured the goods they buy, in contrast with the Vice-Chancellor's belief, in *Mirage Studios* at 159, that the public would not buy goods which they knew to be counterfeit. Nonetheless, Hull suggests that "[p]laintiffs who are not assiduous in gathering such evidence [of public confusion] may find courts veering back to the *McCulloch v May* line of case law, but there is now some realistic hope that the cycle of negative decisions built around *McCulloch's* case may finally have been broken." J Hull, "The merchandising of real and fictional characters: an analysis of some recent developments" [1991] Ent LR 124, at 129.

<sup>105</sup> HE Ruijsenaars, "Legal aspects of merchandising: the AIPPI resolution" [1996] EIPR 330, at 330.

merchandising, as the large variety of merchandising symbols makes it difficult to issue general statements concerning all merchandisable elements.”<sup>106</sup> This is particularly the case when the merchandising symbol is an individual’s image.

One point of terminology which arises here is the difference between “character merchandising” and “image” or “personality” merchandising. In general, “character merchandising” can be seen as the use of fictional characters, whereas “image” or “personality” merchandising is the use of real individuals on goods.<sup>107</sup> Although this distinction is not universally made, it is a helpful one and will be observed below where either term is used. Since the focus of this thesis is on the use of individuals, rather than fictional characters, the term “merchandising” will be used when referring to image or personality merchandising, in contrast to character merchandising which will signify the use of fictional characters.

The literature which addresses this phenomenon can be distinguished from the previous approaches outlined, particularly the “publicity as property” and appropriation of personality categories. The key differences are (i) the more limited scope of the publicity activities, being restricted to merchandising and (ii) the recognition of the value of the character not just to the unauthorised exploiters, but also to the character himself, through licensing and commercial deals, which is often absent from accounts of appropriation of personality. As noted at the outset, however, character merchandising is capable of being subsumed (at least in English law) within the wider category of appropriation of personality.

## 2.5. Privacy and Publicity

This final category of writing has emerged in England and Scotland predominantly since 2000<sup>108</sup> and arises from the analysis of publicity in the context of breach of

<sup>106</sup> *Ibid.*

<sup>107</sup> Hector MacQueen, Charlotte Waelde and Graeme Laurie, *Contemporary Intellectual Property et al*, *Contemporary Intellectual Property*, 2007 (henceforth MacQueen *et al*, *Contemporary Intellectual Property*), para 17.30.

<sup>108</sup> Writers include C Michalos, “Image rights and privacy: After *Douglas v Hello*” [2005] EIPR 384, and “*Douglas v Hello*: The final frontier” [2007] Ent LR 241 (henceforth respectively Michalos, “Image rights and privacy” and Michalos, “*Douglas v Hello*: The final frontier”); D Howarth,

confidence and the Article 8 right to privacy under the European Convention on Human Rights<sup>109</sup> (ECHR), and the Human Rights Act 1998. The privacy protection offered by Article 8 of the ECHR has been heavily influenced by Civilian concepts of personality, as discussed in section 2.2 above, but now plays an increasingly important role in Scottish and English jurisprudence.<sup>110</sup>

Whereas the focus in the previous category was on character merchandising, the activity in question here is intrusive media use of personal information: “[t]he gravamen of invasion by the media is non-consensual dissemination of information about individuals.”<sup>111</sup> This invasion of privacy can be viewed as unwanted “publicity”, not least because in some cases the individual in question has willingly sought the publication of the very same facts where such publication is done in a controlled, and lucrative, manner. While the media intrusion may result in a claim for breach of privacy the exploitation is, on one interpretation, really a form of publicity.

This was the situation in *Douglas v Hello!*,<sup>112</sup> where the claimants recovered for invasion of their privacy, yet most commentators are agreed that if we “ask what is *Douglas v Hello* really about?, common sense tells us that it is actually about commercial exploitation of image”.<sup>113</sup> Although the eventual remedy was found in breach of confidence and Article 8,<sup>114</sup> the “dispute is arguably not about privacy at all. It is about the way in which celebrities and others in the public eye are entitled to

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“Privacy, confidentiality and the cult of celebrity” (2002) 61 CLJ 264; HL MacQueen, “Protecting privacy” (2004) 8 Edin LR 248 and 420; R Mulheron, “A potential framework for privacy? A reply to *Hello!*” (2006) 69 MLR 679; Richardson and Hitchens, “Celebrity Privacy”; Morgan, “Privacy, confidence and horizontal effect”; V Jones and A Wilson, “Photographs, privacy and public places” [2007] EIPR 357 (henceforth Jones and Wilson, “Photographs, privacy and public places”); J Gibson, “A Right to My Public: Copyright, Human Right or Privacy?” in F MacMillan and K Bowrey (eds), *New Directions in Copyright Law Volume 3*; NA Moreham, “Privacy in public places” (2006) 65 CLJ 606 (henceforth Moreham, “Privacy in public places”).

<sup>109</sup> Convention for the Protection of Human Rights and Fundamental Freedoms, Rome, 4.XI.1950.

<sup>110</sup> This is despite fears that the concept of personality “might be thought to be Continental psychobabble”, Jones and Wilson, “Photographs, privacy and public places”, at 358.

<sup>111</sup> Morgan, “Privacy, confidence and horizontal effect”, at 445.

<sup>112</sup> *Douglas v Hello!* [2006] QB 125.

<sup>113</sup> Michalos, “Image rights and privacy”, at 385.

<sup>114</sup> The role of breach of confidence since 1990 will be considered in detail in Chapter 5.

make money by publishing aspects of their private lives.”<sup>115</sup> Thus, although *Douglas* was argued as a privacy case, it is frequently classed as an example of publicity exploitation.

If the appropriation of personality category (in section 2.3) reflects the second limb of the American privacy tort in the 2d Restatement, this category can more readily be equated to the third limb: “unreasonable publicity given to the other’s private life”.<sup>116</sup> This category also has closer links with the category of (Civilian) personality rights discussed above (section 2.2), raising issues of privacy, identity and information.

Data protection law has also contributed in this field, both in case law<sup>117</sup> and in academic commentaries. For example, Boyd and Jay argue that use of an individual’s digital image without his consent will constitute unfair processing contrary to data protection principles.<sup>118</sup> However, the Data Protection Act 1998 regulates the processing of “personal data” rather than protecting economic or personal interests in them, and this focus limits the applicability of data protection in the broader field of privacy protection.<sup>119</sup>

The common themes in this canon are media publication, whether authorised or not, and the troublesome border between the concepts of privacy and publicity. Although there has been an explosion of privacy litigation in the UK since the Human Rights Act 1998 came into force<sup>120</sup> the exact nature of the privacy right, and its relationship

<sup>115</sup> N Gardner and K Brimstead, “Confidential information – damages” [2005] EIPR N190, at N191.

<sup>116</sup> American Law Institute, *The Restatement of the Law of Torts*, 2d, para 652A.

<sup>117</sup> Successful claims for breach of data protection law were made in *Campbell v MGN* [2004] 2 AC 457 and *Douglas v Hello!* [2006] QB 125.

<sup>118</sup> S Boyd and R Jay, “Image rights and the effect of the Data Protection Act 1998” [2004] Ent LR 159, at 162. This is supported by the use of data protection as one of the heads of claim in some of the leading cases, such as *Campbell v MGN Ltd* [2004] 2 AC 457, *Douglas v Hello!* [2006] QB 125, and *Murray v Big Pictures (UK) Ltd* [2008] EWCA Civ 446.

<sup>119</sup> Recent cases which have considered the definition of “personal data” include *Common Services Agency v Scottish Information Commissioner* [2008] 1 WLR 1550 and *Durant v Financial Services Authority* [2003] EWCA Civ 1746. See also G Black, “Data protection law in light of *Durant v Financial Services Authority*” 2004 JR 295.

<sup>120</sup> For example, *CC v AB* [2006] EWHC 3083 (QB); *McKennitt v Ash* [2008] QB 73; *A v B&C* [2002] 2 All ER 545; *X v BBC* 2005 SLT 796; *Campbell v MGN* [2004] 2 AC 457; *Mosley v News Group Newspapers Ltd* [2008] EWHC 1777 (QB); *Murray v Big Pictures* [2008] EWCA Civ 446.

with publicity, remains uncertain.<sup>121</sup> Nevertheless, the existence of a right to respect for one's private life together with the doctrine of breach of confidence offers a pragmatic solution for an individual who wishes to protect the exploitation of his image or reputation.

### 3. CROSS-OVERS AND CONCLUSIONS

The five approaches discussed above show that "publicity" is capable of a wide range of interpretations. It can mean an economic right to be exploited through a wide-ranging property right, or a dignitarian right to be protected through the right of personality. As well as these conceptual differences, "publicity" can be used to distinguish between different practices, such as character merchandising or privacy, for example.

While the above five categories can certainly be defended as identifiable trends in Western legal thinking, it would be erroneous to claim that they are absolute or mutually exclusive. Particularly in the Common law tradition, academics are prepared to cross categories. Thus, while Vaver is clearly engaged in the analysis of three statutory torts in Canada regulating publicity through the "appropriation of personality" category, he is also prepared to acknowledge the relevance of property to publicity rights, since "many modern definitions of property focus upon the existence of a right of exclusive enjoyment rather than upon whether the object of the right is tangible or intangible."<sup>122</sup> In cases like this, the boundaries between categories may become blurred, albeit not altogether erased.

One writer whose work neatly illustrates two problems with these attempted classifications is Carty. In the first place, her work demonstrates the ongoing evolution of academic thinking in this area. Her 2004 article on "Advertising, Publicity Rights and English Law"<sup>123</sup> placed emphasis on the merchandising and

<sup>121</sup> This will be further explored in Chapter 5.

<sup>122</sup> Vaver, "What's mine is not yours", at 260.

<sup>123</sup> [2004] IPQ 209.



advertising uses of the individual within the wider category of appropriation of personality, while her focus by 2007 marked a shift towards the broader “quest for the IP effect”.<sup>124</sup> In publicity terms, this is the idea that “the celebrity industry (including “licensees”) seek commodification of the celebrity image”,<sup>125</sup> which comes close to (while emphatically not endorsing) the broad publicity as property approach. This observation highlights the constant evolution and shifting of parameters that occurs in publicity rights.

A second challenge offered by Carty’s analysis is her insight into the role of the celebrity *as the product itself*.<sup>126</sup> This interpretation is shared by Colston and Middleton who argue that “[i]mage... comprises both a powerful marketing tool and creates a new product.”<sup>127</sup> This idea overlays a number of categories, most critically “publicity as property”, which treats the image or identity as the subject of property rights, and merchandising, which looks to the value in using image as a marketing tool. It is therefore a more nuanced interpretation, as it draws out the differing functions performed by an individual’s image in different circumstances. In addition to her contribution to the debate in this area, which will be drawn upon in the chapters to follow, Carty provides a valuable reminder that the suggested five categories are not exhaustive, nor are they definitive. There is no easy comparative classification of publicity rights.

Perhaps the key differences between the five approaches outlined can be summarised as:

- (i) economic interests versus dignitarian interests;
- (ii) property protection versus tort law; and
- (iii) exploitation by self versus exploitation (or “appropriation”) by others.

These differences can, to some extent, be mapped on to the split between Civilian and Common law analyses of publicity rights: whereas Civilian systems protect dignitarian interests through personality or quasi-delictual rights, Common law

<sup>124</sup> Carty, “The quest for the IP effect”.

<sup>125</sup> *Ibid.*, at 240.

<sup>126</sup> “Advertising, publicity rights and English law”, at 210.

<sup>127</sup> C Colston and K Middleton, *Modern Intellectual Property Law*, 2<sup>nd</sup> ed, 2005 (henceforth Colston and Middleton, *Modern Intellectual Property Law*), at 631.

systems focus primarily on the economic interests at stake, through property law or through torts which evolved in the context of market practices, such as passing off and breach of confidence. As Reiter has observed, “the classificatory angst that traditionally occupies civilians affected neither Prosser nor Judge Frank. For them, it was enough to note that the right has value, without worrying overly about its nature.”<sup>128</sup>

The Civilian/Common law differences are revealed most clearly in the divergence between the first two categories (property rights/ personality rights), although they are evident in all five categories to greater or lesser degrees. As will be seen time and again throughout this thesis, the pragmatic Common law approach to the subject tends to see a problem in need of a remedy and find that remedy in the existing structure of actions and remedies, if necessary adapting them to meet the circumstances of the particular case.<sup>129</sup> In contrast, Civilian systems respond to publicity claims with a scheme of extra-patrimonial rights, in which the patrimonial elements have no obvious home. They do, however, provide more extensive and principled protection for the dignitarian and moral interests inherent in an individual’s personhood than do the Common law systems. It is possible to have “[c]ertain rights of personality which are regarded as fundamental in the civil law tradition [but which] are not recognised in English law or Scots law, notably the right to one’s name; image (visual likeness); or voice.”<sup>130</sup> Such differences “reflect deep-seated cultural differences” between Anglo-American and European jurisdictions.<sup>131</sup>

These five approaches, and the similarities and differences they reveal, serve a valuable role by providing a clearer understanding of publicity rights, and suggesting a tentative shape and structure for the future development of legal discourse in this area. They also help to draw out some of the core social practices that are at the heart of “publicity” as a commercial and social activity. Defining publicity in practice is the aim of Chapter 3.

<sup>128</sup> Reiter, “Personality and patrimony”, at 716.

<sup>129</sup> See, for example, R Buxton, “How the common law gets made: *Hedley Byrne* and other cautionary tales” (2009) 125 LQR 60.

<sup>130</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.1.2.

<sup>131</sup> *Ibid.*, para 3.4.8.



## CHAPTER 3: THE PRACTICE OF PUBLICITY

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### 1. INTRODUCTION

As Chapter 2 sought to show, “publicity” is capable of a wide range of interpretations. Part of the problem with devising any coherent legal response to publicity is the lack of a single agreed definition or understanding of publicity in practice, coupled with the absence of common terminology. What is “publicity” or “personality”? Does “publicity” involve a property right over the individual’s identity or a personality right to protection of dignitarian interests? The principal aim of this chapter is to develop a more nuanced account of the social practice of publicity. Allied to this, a further aim is to use this account in order to devise a

framework and terminology to shape the analysis of publicity rights in future chapters.

Any publicity exploitation gives rise to two fundamental questions: what is being exploited and what form does the exploitation take? It is essential to appreciate that these are two separate aspects and require separate consideration. No contract can be drafted, no court can determine a case, and no writer can examine the right of publicity without having some idea of what is the subject matter of the contract, action or examination and to what use this subject matter has been put.

For example, the very fact that the claimants in two leading English “publicity” cases – *Irvine v Talksport*<sup>1</sup> and *Douglas v Hello!*<sup>2</sup> – used different types of action to achieve their ends indicates some degree of difference between the two situations. To what extent are these both publicity actions? What was the reason for suing for passing off in *Irvine* and for breach of confidence in *Douglas*? These divergent legal claims suggest that there is a correlation between the legal action used in English law and the *use* made of the individual’s image or identity, and this correlation will be explored in more detail when considering the manner of the exploitation. The *subject matter* of the exploitation is also important. For example, has the individual’s name been used, or is it his image, or both, or something else altogether? What role is played by other, less tangible elements, such as reputation or “glamour”?<sup>3</sup>

This chapter therefore seeks to construct a framework in which to analyse publicity cases. Without this framework, it is too easy to confuse arguments relating to one element with those relating to another and this, in turn, gives rise to confusion and artificial disagreement. One such example can be found in *Douglas v Hello!*<sup>4</sup> Whereas Lord Walker stated that the Douglases’ “claims come close to claims to a “character right” protecting a celebrity’s name and image such as has consistently

<sup>1</sup> *Irvine v Talksport Ltd* [2003] 2 All ER 881.

<sup>2</sup> *Douglas v Hello!* in the Court of Appeal [2006] QB 125; and in the House of Lords [2008] 1 AC 1.

<sup>3</sup> In the words of Carty, “Personality Rights and English Law”, para 7.2.6.

<sup>4</sup> [2008] 1 AC 1.

been rejected in English law”,<sup>5</sup> Lord Nicholls observed that “[n]or did Hello’s publication of pictures of this event constitute ‘character merchandising’”.<sup>6</sup> Regardless of the correct analysis, this reveals a divergence of classification at the very highest levels. A second example of this (potential) confusion can be taken from Holyoak’s discussion of *Kaye v Robertson*,<sup>7</sup> in which unauthorised photographs taken of the claimant in hospital were published in a national newspaper. While most commentators today would class this as an invasion of privacy, in 1993 Holyoak noted that “*Kaye* is an important decision in the evolution of recognition by the law of the practice of character merchandising”.<sup>8</sup> Whether the publication of photographs of an ill actor can indeed be seen as the same activity as the application of images of ABBA to pillowcases<sup>9</sup> requires further analysis.

Separating out the strands of subject matter and use allows a much clearer insight to be gained and also enables us to distinguish, with greater precision and confidence, between activities such as “character merchandising” and media publication. Once the subject matter and use have been identified, they can be used to provide a much more structured description of publicity in practice. This, in turn, leads to a considerably more accurate definition of publicity for legal purposes. Thus, the construction of a dual framework assists our understanding of publicity exploitation with reference to two key elements of the practice: *what* is being exploited and to what *use* it is being put. Each element complements and supports the other, by drawing out different elements of this complex area, thereby adding to the picture of the whole.

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<sup>5</sup> *Ibid.*, para 285.

<sup>6</sup> *Ibid.*, para 253.

<sup>7</sup> [1991] FSR 62.

<sup>8</sup> J Holyoak, “United Kingdom character rights and merchandising rights today” 1993 JBL 444, at 455.

<sup>9</sup> In *Lyngstad v Anabas Products Ltd* [1977] FSR 62.

## 2. THE DUAL CLASSIFICATION PART 1: THE USE APPROACH

### 2.1. Examining Publicity Uses

This approach focuses on the different uses that can be made of the subject matter. (The subject matter will be considered in section 3.1 below and involves the individual's identifying elements.)

Colston and Middleton deploy the uses of publicity as a framework for their review of image rights, based on a tripartite structure. The three uses that they identify are:

- “merchandising of memorabilia using ‘character’ as a decorative device [whether real or fictional];
- endorsement of products [by the well-known];
- individuals exploiting their image for the purposes of celebrity.”<sup>10</sup>

This classificatory scheme can also be detected in the work of other writers in two of the five publicity rights approaches identified in Chapter 2.<sup>11</sup> Like Colston and Middleton, Madow identifies three comparable categories of publicity, being “intense demand for information about the lives and doings of celebrities”; “a large and increasingly lucrative market for merchandise”; and enhancement of “the marketability of a wide array of collateral products and services.”<sup>12</sup>

Another American academic, Goodenough, observes that:

While the ways of turning humanity's innate fascination with personal identity to account are probably bounded only by humanity's ingenuity, five principal modes of use can be fruitfully isolated as encompassing most of the current activity in the market-place of the persona: (i) informational use; (ii) creative use; (iii) advertising use; (iv) icon use; and (v) performance use.<sup>13</sup>

These five uses can be fleshed out in greater detail.<sup>14</sup> The informational use is news reporting where, importantly, the reported story is factual. This can be contrasted

<sup>10</sup> Colston and Middleton, *Modern Intellectual Property Law*, at 632.

<sup>11</sup> These are publicity as property and appropriation of personality. The Civilian personality rights approach focuses primarily on the subject matter, and will be considered in section 3.1 below.

<sup>12</sup> Madow, “Private ownership of public image”, at 129.

<sup>13</sup> Goodenough, “Rethorising privacy and publicity”, at 41.

<sup>14</sup> *Ibid.*, at 41 to 42.

with the creative use, which is similar to informational use but where there is no longer a concern that the information is accurate. Fictionalised accounts of individuals would therefore be covered by the second category. The third use, advertising, is where an individual is used to help sell products or services “which are not themselves elements of the personality in question”.<sup>15</sup> This can be either through endorsement, where the individual is seen to use the product himself, or simply through drawing attention to the item. Icon use is where “the thing of value being used is the persona itself”, either through “pure representations”, such as posters and figurines, or through “utilitarian items,” where functional products are decorated with the image of the individual, such as t-shirts,<sup>16</sup> lunch boxes etc. The final category is the performance use, which arises where an actor performs in character or a singer or athlete performs in his own right. Legal concerns may arise where the performance is recorded and can then be replayed or transmitted, with or without the consent of the performer.<sup>17</sup>

As well as providing a detailed description of the uses of personal identity, Goodenough also sets out a convincing argument for rejecting profit and commerce as a central factor in publicity use.<sup>18</sup> Although commercial use is widespread and drives much publicity exploitation, it is “less helpful” as a defining trait since “[s]uch terms always need careful qualification and explanations... All of these uses can be, and in the relentlessly for-profit world of America generally are, carried on as commercial activities, for the purposes of trade.”<sup>19</sup> Accordingly, the notion of “commercial exploitation” of image and identity is not of great assistance as a defining factor of publicity, since it is capable of covering all publicity-type uses. Publicity use may often be commercial, but it need not be.

<sup>15</sup> *Ibid.*, at 41.

<sup>16</sup> Vaver observes that t-shirts “may have become the modern counterpart of the olden-day pamphlets”: Vaver, “What’s mine is not yours”, at 307. This is supported by the South African case of *Laugh it Off v South African Breweries* 2006 (1) SA 144, which involved the use of t-shirts to parody leading commercial brands.

<sup>17</sup> This recording and unpermitted broadcast of a performance was the focus of the dispute in *Zacchini v Scripps-Howard Broadcasting Company* (1977) 433 US 562.

<sup>18</sup> Commercial use is particularly prevalent in the “publicity as property” approach: see Chapter 2, section 2.1.

<sup>19</sup> Goodenough, “Rethorising privacy and publicity”, at 42 and at 62; also Zimmerman, “Who put the right in the right of publicity?”, at 61-62 and 67-68.

Carty identifies a “complex framework”<sup>20</sup> of image use, which consists of four different fact situations. These are: (i) the “allegiance” use of a celebrity, through the production of celebrity souvenirs or memorabilia such as t-shirts and posters; (ii) the “informational advertising use” of celebrity, which is effectively endorsement where the celebrity is used to provide a guarantee of the product or service concerned; (iii) the “enhancement advertising use” of celebrity, where the consumer’s attention is caught by the use of the celebrity, potentially including parody; and (iv) the “biographical information use” of celebrity, which is “attention-grabbing by media features about the celebrity himself” and which “lies somewhere between all three of the above uses as such [media] features are both selling the celebrity and selling themselves at the same time.”<sup>21</sup> Carty believes these four different publicity rights should be treated differently in law and only the “information advertising use” is worthy of legal protection.<sup>22</sup>

Beverley-Smith also addresses three types of use of persona. Although his initial definition focuses on the use of personality for merchandising and advertising purposes,<sup>23</sup> his subsequent review does include reference to a third category of use, being the privacy interests arising from media publication of information, in cases such as *Douglas v Hello!*.<sup>24</sup>

When these different analyses of publicity uses are compared directly, it can be seen that they all identify much the same uses, albeit using different terminology:

<sup>20</sup> Carty, “Advertising, publicity rights and English law”, at 216.

<sup>21</sup> *Ibid.*, at 216-217.

<sup>22</sup> *Ibid.*, at 258. In a later article (Carty, “The quest for the IP effect”) Carty discusses areas of commercial development which are pushing for the “IP effect”. The first of these areas is “the celebrity industry (including “licensees”) [who] seek commodification of the celebrity image” (at 240). This is a broader over-arching category which accommodates her four earlier categories. The analysis here will proceed on the basis of her four uses.

<sup>23</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 3.

<sup>24</sup> *Ibid.*, at 210-211.

<b>Goodenough</b>	<b>Colston and Middleton</b>	<b>Madow</b>	<b>Carty</b>	<b>Beverley-Smith</b>
Informational	Exploitation of image	Intense demand for information	Biographical information use	Privacy interests
Creative	<i>Not so relevant, but “exploitation of image” where it arises.</i>	-	<i>Not so relevant, but “biographical information use”, where it arises</i>	-
Advertising	Endorsement (by the well-known)	Enhancement of marketability of a product or service	Two rights: (ii) informational advertising use; and (iii) enhancement advertising use	Advertising
Icon use	Merchandising	A lucrative market for merchandise	Allegiance use	Merchandising
Performance	-	-	-	-

This table emphasises the coherence between the categories used or referred to by most writers and, critically, it underlines the terminological differences. All envisage Goodenough’s information, advertising and icon uses, yet apply a range of different labels to these uses. For example, Goodenough’s “icon use” is variously known as “allegiance use”, “merchandise” use, and “merchandising”.

The one exception is Goodenough’s final category of performance use (covering use of recordings of performances by actors, singers or athletes), which is not evident in the other accounts. McCarthy concludes that this type of use is not directly relevant to publicity, while noting that “many people have been misled into thinking that the right of publicity involves something else: something called “performance values”. That is, the unpermitted appropriation or imitation of an entertainer’s performance or performance style.”<sup>25</sup> He attributes this confusion to the Supreme Court case of *Zacchini v Scripps-Howard Broadcasting Company*,<sup>26</sup> where the plaintiff’s performance (being fired out of a cannon) was broadcast by a television station as a news feature, and this use was held to breach his right of publicity. McCarthy, however, argues that cases such as this constitute a “very, very small slice of the right of publicity.”<sup>27</sup> Further, “performance use” is most likely to be protected by copyright, which will subsist in the words, music, script, sound recording and/or performance as appropriate.<sup>28</sup> Performance use will therefore be excluded from the scope of this thesis.

With the performance use excluded, it can be seen from the above table that the majority approach provides a tripartite classification, which enables a meaningful distinction to be drawn between the uses without unnecessary fragmentation. This tripartite framework will be adopted, to recognise the division of publicity into (i) information or image exploitation, through news reporting; (ii) endorsement or enhancement of advertising; and (iii) merchandising or allegiance use.

## 2.2. The Tripartite Classification of Uses

These three uses can be outlined as follows:

### 1. An individual agrees to allow an entity (frequently a newspaper or a

<sup>25</sup> McCarthy, “Public personas and private property”, at 689.

<sup>26</sup> (1977) 433 US 562.

<sup>27</sup> McCarthy, “Public personas and private property”, at 690; also McCarthy, “The human persona as commercial property”, at 133. Zimmerman takes this further, claiming that *Zacchini* “bears very little relationship” to the typical publicity cases: “Who put the right in the right of publicity?”, at 45.

<sup>28</sup> Copyright, Designs and Patents Act 1988 (henceforth CDPA 1988), s1, supplemented by ss3 and 5, and s180.



**magazine) access to a particular area of his life, typically for a fee.** Examples can readily be given, whereby an individual “sells” photographs of his wedding day to a gossip magazine<sup>29</sup> or where a participant in a high-profile current event “tells all” to a newspaper in a (typically exclusive) deal.<sup>30</sup> Tabloid newspapers rely on a ready supply of gossip or scandal about “celebrities”: one need only inspect the news-stand in any newsagent, stationer or bookseller to appreciate that such celebrity tales are weekly events. This supply and demand for gossip and information can be thought of as an individual’s “**media information**” use-right. It relies on the name and image of the individual, together with some element of information about them. Any third party user, whether authorised or not, can be referred to as a “publisher”.

2. **An individual agrees to endorse, support or promote a particular product or service.** In these cases, the individual “tells the relevant public that he approves of the product or service or is happy to be associated with it. In effect he adds his name as an encouragement to members of the relevant public to buy or use the service or product.”<sup>31</sup> Note however that this use of name and image frequently comprises more than the provision of services, such as modelling or attending a photo shoot: the supplier wishing to benefit from this support will usually have chosen a specific individual not for his modelling abilities (or not exclusively so) but for the added value provided by his public status or reputation. Celebrity status or reputation therefore apparently has a role to play in most cases of this use.

What is critical in this use is that the individual advertises or endorses the

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<sup>29</sup> Recent examples include David and Victoria Beckham (to OK! in 1999 for £1million); Michael Douglas and Catherine Zeta-Jones (to OK! in 2000 for £1million); Jordan and Peter Andre (to OK! in 2005 for £2million); Ashley Cole and Cheryl Tweedy (to OK! in 2006 for £1million); and Wayne Rooney and Coleen McLoughlin (to OK! in 2008 for £2.5million). Since official details of such arrangements are not published, definitive authority is hard to produce: all details taken from BBC online or Wikipedia.

<sup>30</sup> Examples are numerous: the Royal Marines who were captured and held in Iran for two weeks in March and April 2007 sold their stories on their return to the UK. The publicist Max Clifford makes a living from brokering such deals: [http://en.wikipedia.org/wiki/Max\\_Clifford](http://en.wikipedia.org/wiki/Max_Clifford) (accessed 15 November 2008).

<sup>31</sup> *Irvine v Talksport Ltd* [2002] 1 WLR 2355, para 9, per Laddie J.

products or services *of another party*: it is not a self-promotion, nor is he the product himself. This essential distinction has already been referred to in Chapter 2, section 3, where Carty and Colston and Middleton recognise the difference between the individual's image which "comprises both a powerful marketing tool and creates a new product."<sup>32</sup> The advertising and endorsement use employs the individual as a marketing tool and not as a new product. It is therefore fundamental that the individual is used in conjunction with another party's goods or services.

There may be a link between the individual's fame and the goods or services he is promoting. This is the case, for example, with Jamie Oliver (chef) and Sainsbury's (food) or with Tiger Woods (golf professional) and Nike (sports equipment). This can be referred to as a "tools of the trade" endorsement.<sup>33</sup> Alternatively, the supplier may favour a "non-tools endorsement",<sup>34</sup> and simply wish to enjoy some "reflected glory" from the particular reputation or popularity of the individual in question, without there being a link between the activities of the individual and the product or service to be promoted. Thus, David Beckham's star status was valuable to Pepsi without him being involved in the soft drinks industry.<sup>35</sup> Beverley-Smith *et al* also identify a third type of advertisement, where the individual is chosen solely for the purpose of "grabbing the attention" of the public,<sup>36</sup> and there is no suggestion of endorsement of the product by the individual. Carty refers to these three classes of celebrity promotion, but groups both tools and non-tools endorsement together as one category, called "information advertising use", and treats the third non-endorsement use separately as the "enhancement advertising use" category.<sup>37</sup>

<sup>32</sup> Colston and Middleton, *Modern Intellectual Property Law*, at 631; also Carty, "Advertising, publicity rights and English law", at 210.

<sup>33</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 2.

<sup>34</sup> *Ibid.*,.

<sup>35</sup> As at 2004, Beckham's deal with Pepsi was apparently worth £3million: Milligan, *Brand it Like Beckham*, at 120.

<sup>36</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 2.

<sup>37</sup> Carty, "Advertising, publicity rights and English law", at 216-217.

This broader category admits not only use of an individual to endorse a product (whether relevant to the individual or not) but also use in attention-grabbing advertising, with no suggestion of approbation or endorsement by the individual involved. As Beverley-Smith notes, development of the law is not served “by drawing specious distinctions based on the inherently nebulous concept of an endorsement”<sup>38</sup> and thus all three situations will be treated as a single publicity “use”.

The division does, however, lead to a dilemma over the most appropriate name for this use of image and identity: “advertising” (as favoured by Goodenough, Carty and Beverley-Smith) signifies the attention-grabbing use, and could potentially operate to exclude cases where there is implied endorsement; conversely “endorsement” (as used by Colston and Middleton) is inappropriate for those cases where there is no indication of support from the individual. To divide the class into two separate categories would, however, unnecessarily complicate the analysis, given that the underlying aim in each case is the promotion of products and services through the attachment of the name and/or image of an individual. This use can therefore be thought of as the “**promotion use**”, while emphasising that the promotion by the individual is on behalf of a third party, referred to as the “supplier” – although where done with the consent of the individual, it may well promote the interests of both parties.<sup>39</sup>

3. **An individual agrees to produce or authorise production of goods which carry his name and/or image.** Common examples of these “mere image carriers”, as the Trade Marks Registry has termed them,<sup>40</sup> include posters, calendars, t-shirts and mugs. Here, the goods are not being bought solely because the purchaser wishes a new mug, nor are they being sold as trade marked items in the sense that the purchaser is specifically keen to buy a mug from a certain manufacturer as identified by its trade mark. Instead, they are

<sup>38</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 134.

<sup>39</sup> This element of mutual benefit will be apparent time and again throughout this investigation.

<sup>40</sup> G Black (published as G Davies), “The cult of celebrity and trade marks: the next instalment” (2004) 1:2 *SCRIPT-ed* 230.

seen as “badges of loyalty”;<sup>41</sup> souvenirs or indicia of support for, or interest in, the individual who features on the product. An example of merchandising was given in (the non-merchandising case of) *Irvine v Talksport*, where reference was made to “the sale of memorabilia relating to the late Diana, Princess of Wales. A porcelain plate bearing her image could hardly be thought of as being endorsed by her, but the enhanced sales which may be achieved by virtue of the presence of the image is a form of merchandising.”<sup>42</sup>

In these cases the individual effectively becomes the product:<sup>43</sup> when the consumer buys the David Beckham calendar or the Elvis Presley mug, they are “buying” David Beckham or Elvis Presley. The significant distinction between the promotion use outlined above and the merchandising use is the difference already alluded to, between, respectively, image as a marketing tool and as the product itself. In merchandising, the individual arguably becomes the product.<sup>44</sup>

Merchandising may involve products which are either a “pure representation” (for example, posters) or a “utilitarian” item (for example, t-shirts or calendars), as per Goodenough’s classification above. In some cases there may be a perception of endorsement by the individual involved, but this is not necessary: all that is required is that the product bears the image of the individual which renders it attractive to its target audience.<sup>45</sup> Whether authorised or not, the practice of production of mementoes is typically known as merchandising: where this practice is exploited, it will be referred to as the “**merchandising use**” and a third party exploiter (whether authorised or not) who produces goods bearing the image of the individual will be the “merchandiser”.

Together, the media information, promotion and merchandising uses can be seen as the most commonly cited (and evidenced) types of publicity activity. It is important

<sup>41</sup> As used in *Arsenal v Reed* [2003] 3 All ER 865. See also Zimmerman, “Who put the right in the right of publicity?”, at 63.

<sup>42</sup> *Irvine v Talksport* [2002] 1 WLR 2355, para 9, per Laddie J.

<sup>43</sup> See the distinction made above between the individual as a marketing tool and as the product itself: text and reference at note 32.

<sup>44</sup> Colston and Middleton, *Modern Intellectual Property Law*, at 632.

<sup>45</sup> *Irvine v Talksport* [2002] 1 WLR 2355, para 9.

to stress that the list cannot be treated as exhaustive, but should remain open. Cementing the types of use would risk stagnation and hamper development of the law, particularly as regards future evolution of commercial or social practices. However, the above three categories appear broad enough to cover “humanity’s ingenuity” to date.

One important qualification to all use types is that there must be “public” use: where the use of the image or identity is exclusively private, there will be no element of publicity to be indicted.<sup>46</sup> The requirement for public use is implicit in each of the three uses discussed above: none of these publicity uses could be achieved by keeping the relevant publication, promotion or merchandise private. This is not something which is explored by other writers<sup>47</sup> and no court has had to consider the nature of the use in these terms, yet it stands to reason that an action for infringement of “publicity rights” can only lie where the use made involves some element of communication to the public.<sup>48</sup> However, this requirement for public use does not equate to commercial or for-profit use since a charity, for example, could make use of an individual’s persona to promote its cause without directly raising income. The rejection of “commercial use” as a defining criterion in section 2.1 above therefore still stands.

### 2.3. The Paradigm Publicity Use Cases

It is possible to identify a leading case in English law which is illustrative of each of these three uses and which can be used as a convenient point of reference for future discussion. This section provides a brief summary of the paradigm publicity cases, without (at this stage) passing comment on the merits or otherwise of the legal actions.

<sup>46</sup> Private use may of course breach a different legal right, in which case it can be protected by that right.

<sup>47</sup> One exception is Halpern who notes that “[b]y its nature, the right of publicity implicates speech”: SW Halpern, “The right of publicity: Maturation of an independent right protecting the associative value of personality” (1995) 46 Hastings LJ 853 (henceforth Halpern, “Publicity: Maturation of an independent right”), at 867.

<sup>48</sup> This can be contrasted with privacy actions, where the invasion itself may be actionable, as will be seen in Chapter 5.

*Douglas v Hello!* typifies the media information use. In this case, a paparazzo photographer gained access to the Douglasses' wedding, which was held in private in the Plaza Hotel in New York in November 2000. The paparazzo managed to obtain a number of unauthorised photographs of Catherine Zeta Jones and Michael Douglas at their wedding, which he sold to Hello! magazine. Hello!'s publication of these photographs caused distress to the Douglasses<sup>49</sup> and destroyed the exclusive deal which the Douglasses had concluded with OK!, a rival magazine to Hello!. The Douglasses' successful action against Hello! was based upon the action of breach of confidence, as supplemented by the Article 8 right of privacy. The Court of Appeal's decision in favour of the Douglasses was handed down in 2005,<sup>50</sup> while the House of Lords' ruling in favour of OK!, as exclusive licensee of the wedding photographs, was delivered in 2007.<sup>51</sup>

The eventual award to the Douglasses at first instance (and confirmed on appeal), comprised three elements: (i) £3,750 each for distress; (ii) £7,000 in respect of "additional costs incurred by reason of their having to bring forward preparation, approval and provision of the authorised photographs so as to enable them to appear in OK! issue 241 as part of the Claimants' mitigation exercise";<sup>52</sup> and (iii) £50 each for breach of their data protection rights.<sup>53</sup> OK! were awarded £1,033,156 by Lindsay J – this was overturned by the Court of Appeal, but was reinstated on appeal to the House of Lords.<sup>54</sup>

In respect of the promotion use, the leading case is *Irvine v Talksport*.<sup>55</sup> This case arose from the unauthorised use by Talksport of a photograph of Eddie Irvine, the Formula 1 racing driver, to promote its radio station. The manner in which the (legally obtained) image of Irvine had been doctored by Talksport suggested that Irvine was endorsing Talksport radio. Irvine's successful claim against Talksport for

<sup>49</sup> They were left "devastated and shocked" according to their evidence at trial: [2003] EWHC 786 (Ch), paras 82-84, per Lindsay J.

<sup>50</sup> [2006] QB 125.

<sup>51</sup> [2008] 1 AC 1.

<sup>52</sup> *Douglas v Hello!* [2003] EWHC 2629 (Ch), para 57, per Lindsay J.

<sup>53</sup> *Ibid.*

<sup>54</sup> *Douglas v Hello!* [2003] EWHC 2629 (Ch); overturned [2006] QB 125; reinstated [2008] 1 AC 1.

<sup>55</sup> *Irvine v Talksport Ltd* [2002] 1 WLR 2355, on appeal [2003] 2 All ER 881.

this use relied on the tort of passing off, alleging misrepresentation and confusion resulting in loss to Irvine. The Court of Appeal affirmed the High Court's judgment in 2003, and increased the award of damages to Irvine from £2,000 to £25,000.<sup>56</sup> It is critical to note that the image at the heart of the dispute had been doctored. Whether Irvine's claim would have been successful had the legally obtained image been left undoctored remains uncertain – and this fact operates as a substantial limit on the applicability of the case in future promotion use cases.<sup>57</sup>

The merchandising use can be illustrated by two cases. The first involved the unauthorised use of the images of real persons, when members of ABBA sued a company for applying their images and the band name to pillowcases. *Lyngstad v Anabas*<sup>58</sup> was, like *Irvine*, argued on the grounds of passing off. Unlike *Irvine*, however, the band's action was unsuccessful in the High Court, in part because precedent was against the plaintiffs since an action for passing off had been dismissed in a similar situation in 1948, *McCulloch v Lewis A May Ltd*.<sup>59</sup> Nonetheless, *Lyngstad* remains the leading English case in relation to merchandising of real individuals which does not rely on registered trade mark protection.<sup>60</sup>

However, a 1991 decision of the High Court regarding the unauthorised use of fictional characters indicates increasing judicial awareness of the changing social and commercial practice of merchandising,<sup>61</sup> and suggests that there is no guarantee that

<sup>56</sup> [2003] 2 All ER 881.

<sup>57</sup> The use of passing off as a vehicle for enabling recovery has been questioned by a number of commentators, including Carty, "Advertising, publicity rights and English law" at 238-243; Beverley-Smith, *The Commercial Appropriation of Personality*; and Beverley-Smith *et al*, *Privacy, Property and Personality*, at 23. The utility of passing off will be assessed in Chapter 6 in the wider context of delict. For present purposes, *Irvine* can be accepted as illustrative of the publicity use that this thesis seeks to address, without accepting the merits of a passing off action to remedy that use.

<sup>58</sup> *Lyngstad v Anabas Products Ltd* [1977] FSR 62.

<sup>59</sup> *McCulloch v Lewis A May* (1948) 65 RPC 58.

<sup>60</sup> English cases such as *Jane Austen Trade Mark* [2000] RPC 879 and *Elvis Presley Trade Marks* [1999] RPC 567 have focused on trade marked names.

<sup>61</sup> Walton J referred to the commercial practice of merchandising in *Wombles Limited v Wombles Skips Limited* [1975] FSR 488 and *Tavener Rutledge Limited v Trexapalm Limited* [1975] FSR 479, and the House of Lords did likewise in *In Re American Greeting Corporation's Application* [1984] 1 WLR 189, indicating a growing awareness of merchandising through the 1970s and 1980s, but it was not until *Mirage Studios v Counter-Feat Clothing Company Limited* that this had an explicit impact on the development of the law. See also the discussion of this case in Chapter 2, section 2.4.



*Lyngstad* would be followed today.<sup>62</sup> In *Mirage Studios v Counter-Feat Clothing Company Limited*<sup>63</sup> the defendant applied imitations of the plaintiff's cartoon characters, the Teenage Mutant Ninja Turtles, to a range of clothing. The Vice Chancellor accepted that this could constitute passing off, particularly given the evidence of public confusion in this case. The scope of the Vice Chancellor's judgment therefore suggests that a similar result could be reached in respect of individuals, contrary to the decision of the High Court in *Lyngstad*. Taken together, these cases can be used to illustrate the category of merchandising use and provide some insight into the changing perception of merchandising practices.

Throughout this thesis, these cases will be used to provide a reference point for each of the three uses identified here. One feature of these cases which is worthy of note is that they all involved unsought and unauthorised use of the claimants' names, images and identities. It is therefore helpful to examine authorised and unauthorised use in greater detail.

## 2.4. Authorised and Unauthorised Use

The distinction between authorised and unauthorised use depends on the circumstances of the exploitation, rather than on the use made or the subject matter of that use. Essentially, it is the difference between the Douglasses' contract with OK! for authorised publication of their wedding photographs and their litigation against Hello! for unauthorised publication.

Despite the practice of authorised exploitation (which will be explored in detail in section 4 below), the judicial and academic focus has been very much on the unauthorised exploitation. This focus is perhaps not surprising, since the litigation has arisen from this unauthorised use.<sup>64</sup> Yet the real value of publicity lies in negotiated deals for authorised exploitation. Whereas the Douglasses were awarded less than £15,000 from Hello! by the High Court, the value of their contract with

<sup>62</sup> Although Laddie J made a clear distinction between the false endorsement practice in *Irvine* and the merchandising practice: *Irvine v Talksport Ltd* [2002] 1 WLR 2355, para 44.

<sup>63</sup> [1991] FSR 145. See also Chapter 2, section 2.4.

<sup>64</sup> I am not aware of any litigation to date in the UK arising out of a contract for authorised use.



OK! was £1 million. From press evidence as to the fees paid for other celebrity weddings in the UK, it would seem that £1 million was the standard rate for such publication deals in the decade 1998-2008, with some couples even managing to negotiate fees in excess of that.<sup>65</sup> Similarly, it has been suggested that of David Beckham's weekly earnings of £90,000 at Manchester United, £20,000 was attributable to the Club's use of his "image rights".<sup>66</sup> If true, this means that Beckham was earning more than £1 million per year for his image rights alone, from his club alone. The unauthorised use of persona may hit the headlines and occupy court time, but it is the authorised and controlled exploitation which is the focus of commercial practice.

A closer look at the concept of rights, however, reveals a small but important difference between authorised and unauthorised use of persona. MacCormick considers the "right" to do something and the "power" to do it.<sup>67</sup> Whereas *rights*, whether active or passive<sup>68</sup>, can be seen as "positions of benefit or advantage secured to persons by law"<sup>69</sup> which "make[s] it appropriate for a relevant constraint to fall on another person",<sup>70</sup> *powers* are a different type of legal concept:

The empowering aspect of law can be envisaged as involving a legally conferred capability to alter the legal situations or relationships of legal persons. Powers in law in their simplest form are powers to vary in some way what it is right or wrong to do.<sup>71</sup>

This distinction between legal rights and powers can be applied in the context of exploitation of image. If the law were to prohibit unauthorised use, an individual would have a passive *right* not to have his image and identity exploited without consent. As part of this, the individual would also have an *active* right of choice as to whether to enforce this right or not: "it is normally a matter of free choice whether

<sup>65</sup> See footnote 29 above.

<sup>66</sup> Colston and Middleton, *Modern Intellectual Property Law*, at 631.

<sup>67</sup> N MacCormick, *Institutions of Law: An Essay in Legal Theory*, 2007, (henceforth MacCormick, *Institutions of Law*), chapters 7 and 9.

<sup>68</sup> MacCormick explores the notion of active and passive rights in some details at 120 *et seq.* Note that his use of active and passive in relation to rights does not equate to my notion of the positive authorised use and the negative unauthorised use: this division is better characterised by rights and powers as will be discussed immediately below. Instead, an active right is the right of a right-holder to do, or not do, as he chooses, in respect of that right. *Ibid.*, 124-125.

<sup>69</sup> *Ibid.*, at 120.

<sup>70</sup> *Ibid.*, at 120.

<sup>71</sup> *Ibid.*, at 155.

or not to exercise any... remedial rights in case of breach".<sup>72</sup> On the other hand, where the law chooses to recognise the ability to exploit in person, that is authorised use. This is not a right, strictly speaking. Instead, authorised use is a *power* of the individual: the individual is enabled, if he so chooses, to contract for use or exploitation of his image, thereby transforming the otherwise wrongful action of the party into authorised, permitted use. It should be noted, however, that the individual does not have a *right* to do so, as no individual can demand that his image be used to promote products, for example.<sup>73</sup> All the individual can do is contract for its exploitation where the opportunity arises. For this reason, it is preferable to talk of a right *of* publicity, rather than a right *to* publicity.<sup>74</sup>

It is worth noting that the existence of a right does not equate to the obligation to exercise that right. MacCormick notes, in the context of privacy, that there is

nothing wrong with conferring or recognising human rights to things which not everyone (even not many people) wants; for, of course, to have a right is, normally, to have the option whether one exercises it or not. Those who don't want privacy are in no way inconvenienced by being given a right to it.<sup>75</sup>

This applies equally for all permissive rights: there should be no compulsion to exercise a right of publicity if one were to be granted.

Any analysis of publicity rights should therefore take account of the difference between attempting to prevent or recover for unauthorised use of persona (the negative right) and attempting to control the use of persona (the positive power). A balanced review of publicity requires consideration of both elements.

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<sup>72</sup> *Ibid.*, at 120; also 129.

<sup>73</sup> This analysis finds support from JE Penner, *The Idea of Property in Law*, 1997, (henceforth Penner, *The Idea of Property in Law*) at 91.

<sup>74</sup> This can be contrasted with fundamental human rights such as the right to life.

<sup>75</sup> N MacCormick, *Legal Right and Social Democracy*, 1982/1986 (henceforth MacCormick, *Legal Right and Social Democracy*), at 178.

### 3. THE DUAL CLASSIFICATION PART 2: THE SUBJECT MATTER APPROACH

#### 3.1. Identifying the Subject Matter

Whereas the use approach provides a way to distinguish between the *methods* for exploiting individuals for publicity purposes, it does not categorise *what* is being exploited. One benefit of considering what is being exploited is that it helps to distinguish publicity from other rights that can be enjoyed by individuals. For example, where an individual enters into a contract for the provision of services in return for a regular salary, we can identify this as a contract of employment. Similarly, where there is exploitation of an individual's painting, this is a matter for a copyright licence. Alternatively, where there is exploitation of a brand, such as coca-cola, we can distinguish this from the promotion use identified above, because the subject matter is a registered trade mark, rather than an individual. The subject matter of the exploitation in each case allows it to be distinguished from other types of exploitation.

We therefore need to identify what is being exploited in publicity cases, whether there is media information, promotion or merchandising use of an individual. All five of the conceptual approaches to publicity rights identified in Chapter 2 can be drawn upon here.

McCarthy, for example, writing in the publicity as property approach, asks (and answers) the question:

What aspects of human identity does the right of publicity protect? It protects anything by which a certain human being can be identified. This covers everything: personal names, nicknames, stage and pen names, pictures, and persona in a role or characterization. It can also include physical objects which identify a person... And the Bette Midler decision reaffirms that a person can be identified by voice.<sup>76</sup>

He notes that "persona" is preferable as the collective term used to describe the elements of human identity exploited, since "the traditional phrase "name and

<sup>76</sup> McCarthy, "Public personas and private property", at 689.

likeness” was inadequate to describe the many aspects of a person which can identify him or her.”<sup>77</sup>

Also writing in this tradition, Coombe gives a similarly broad definition of “celebrity image” which develops the theme of identifying the individual by referring to his recognition value. Publicity therefore affects “not only or exclusively a celebrity’s visual likeness but rather all elements of the complex constellation of visual, verbal, and aural signs that circulate in society and constitute the celebrity’s recognition value.”<sup>78</sup>

The all-embracing notion of what is covered by a right of publicity in the US is reflected in much of the state legislation which provides for a right of publicity or commercial exploitation of identity. To take two examples,<sup>79</sup> the Indiana right of publicity is defined as a property interest in name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms.<sup>80</sup> The State of Washington creates a property right over the name, voice, signature, photograph or likeness of the individual<sup>81</sup> and then defines each of these individual terms (except “voice”) in some detail.<sup>82</sup> The broad right of property in the US therefore extends over a broad concept of persona.

The Civilian personality rights approach refers to “appropriation of a person’s identity (name or likeness)”.<sup>83</sup> Although this does not expand in any detail on the concept of “identity”, it is helpful to cross-reference this with the (separate) notion of

<sup>77</sup> McCarthy, *The Rights of Publicity and Privacy*, para 4:45. See also Westfall and Landau, “Publicity Rights as Property Rights”, where they reflect on the expansive range of indicia, and the causes of this, at 91, and 93-96; see also Chapter 2, section 2.1.

<sup>78</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 89, note 5.

<sup>79</sup> For others, see The Florida Regulation of Trade, Commerce, Investments and Solicitations, Chapter 540, Section 08; The Illinois Right of Publicity Act (765 ILCS 1075); The New York Civil Rights statute, Article 5: Right of Privacy; Kentucky Acts 1984, 391.170; Massachusetts General Law, Part III, Title I, Chapter 214, Section 3A; The Nevada Right of Publicity, NRS 597.770 – 597.810; Oklahoma Stat. tit 12, paras 1448 – 1449; and Rhode Island Title 9, Chapter 9-1, Section 28.

<sup>80</sup> Indiana’s Publicity Law IC 32-36-1-7.

<sup>81</sup> Washington Chapter 63.60 RCW Personality Rights, section 010.

<sup>82</sup> *Ibid.*, section 020(4) – (9).

<sup>83</sup> Neethling, “Personality Rights”, at 543.

the right to identity.<sup>84</sup> Here, identity is defined as a person’s “uniqueness which individualizes him as a particular person and this distinguishes him from others... Identity is manifested in various indicia by which a person can be recognized, such as his name, image, voice, fingerprints, handwriting, etc.”<sup>85</sup> The two key elements which can be taken from this approach are first, a very broad notion of identity as a factor which distinguishes the individual from every other individual<sup>86</sup> and secondly, an extensive, yet non-exhaustive, list of the sort of factors which serve to distinguish the individual.

This definition of “identity” finds support from another writer in the Civilian tradition, Logeais, who notes that “fame is best conveyed through the name or picture which are inherent to the person”.<sup>87</sup> However, while she is prepared to accept personal attributes of the individual as part of his identity, she does not agree with the annexation of external objects to represent that individual.<sup>88</sup> Thus, she disputes the outcome of an Italian case which protected the “most distinctive elements of [the plaintiff’s] personality: a woollen cap and a pair of small round glasses”.<sup>89</sup> In contrast, an Italian commentator on this case notes (with apparent approval) that the plaintiff “had worn and still wore these accessories constantly and not occasionally, just to mark his personal identity, enriching it with *something peculiar* to be used as a recall of his features.”<sup>90</sup>

Vaver lends support to this wider interpretation, by noting that “[l]ikeness” cannot mean merely a person’s unadorned or nude appearance; a person’s characteristic dress may be as much a part of his personality as his face”.<sup>91</sup> Consequently, even where the individual cannot be identified in person but only from surrounding factors, such as his clothes or accessories, there is sufficient identification to

<sup>84</sup> The right to identity is infringed where identity is used “in a way which cannot be reconciled with his true identity”, per Neethling, “Personality Rights”, at 540.

<sup>85</sup> *Ibid.*, at 540.

<sup>86</sup> The potential problems posed by identical twins are not considered.

<sup>87</sup> Logeais, “The French right to one’s image”, at 169.

<sup>88</sup> *Ibid.*

<sup>89</sup> As discussed by S Martuccelli, “An up-and-coming right – the right of publicity: its birth in Italy and its consideration in the United States” [1993] Ent LR 109, at 109.

<sup>90</sup> *Ibid.*, at 110, emphasis in the original.

<sup>91</sup> Vaver, “What’s mine is not yours”, at 274.

constitute use of his image.<sup>92</sup> Vaver in fact returns to the idea of identification and recognition, which is present in both the Civilian and American interpretations of identity.<sup>93</sup> He extends the scope of protection to any aspect of the individual which can identify him in the minds of the public:

Betty Grable's legs were at least as valuable an asset to her as her face, and at least as recognizable by the crowds who flocked to see her movies... There should be no a priori exclusion even of a person's big toe if such has become sufficiently known as constituting part of his likeness.<sup>94</sup>

Recognisability and identification are therefore central aspects of exploitation of the individual. This leads to the possibility that the exploitation in fact relies on *reputation*: the fact that the individual can be recognised and identified by the public at large requires that individual to have a public status, or reputation. Support for the importance of reputation can also be derived from the fact that most of the claimants are famous. This notion of recognisability, deriving from reputation, will be considered in section 3.2 below.

Evidence of the elements of the individual that are exploited in publicity practice can also be taken from case law.<sup>95</sup> In three<sup>96</sup> of the paradigm cases identified above, the defendants had made use of (i) image and photographs, containing personal information about the subjects, in the case of *Douglas*; (ii) image, without name, in *Irvine*; and (iii) image and band name (ABBA) in *Lyngstad*. Turning to other cases, we can see a broad similarity in the subject matter in question. In Scotland, the name of an inventor of a new type of plough was used in advertising for ploughs designed and manufactured by the defender, and the court allowed the pursuer's claim for interdict to stop this use.<sup>97</sup> In England, a claim for unauthorised use of the nick-name of a popular children's broadcaster, "Uncle Mac", was rejected, because there was no

<sup>92</sup> *Ibid.*

<sup>93</sup> As per the quotations above. See also Reiter, for example, who refers to the celebrity's "recognition factor" which is "both marketable and valuable": "Personality and patrimony", at 726.

<sup>94</sup> Vaver, "What's mine is not yours", at 274.

<sup>95</sup> Whether every claim for unauthorised use has succeeded is not necessarily relevant at this stage, because all that is sought to be discerned here is a greater understanding of the subject matter of the exploitation.

<sup>96</sup> The fourth, *Mirage Studios v Counter-Feat Clothing*, involved fictional characters.

<sup>97</sup> *Wilkie v McCulloch* 1822-1824 2S (SC) 413. Interdict granted and upheld by the First Division, on the grounds that "although he [Wilkie] had not the exclusive privilege of making and vending these improved ploughs, yet he was entitled, at common law, to prevent any one from impressing his name on those which were not made by him, or under his authority." (at 414.)

common field of activity between the parties (radio broadcasting compared with breakfast cereals).<sup>98</sup> American cases cover the same indicia featured in the above cases – name, image, reputation – but have also introduced some more exotic indicia. Claimants in the United States have raised actions for use of a catchphrase,<sup>99</sup> sound-alikes,<sup>100</sup> and even a robotic look-alike.<sup>101</sup>

In addition to these elements of image and indicia, there is evidence from publicity practice and from case law which indicates that in some cases, private information has also been used and exploited. This is most obviously the case in the media information use. The photographs of the Douglases' wedding, for example, were important not just because they contained the image of the Douglases, but also because they conveyed information about the wedding: what the bride and groom wore, the flowers, the venue, and so on.

The picture that emerges is of the use of photographs and images, names and nicknames, sound-alikes and look-alikes. In some cases, these images and indicia will convey otherwise private, personal information. Typically, the key element appears to be use of image, followed by name. However, all these cases are linked by an underlying value. The focus on image and indicia and information is very much a physicalist approach: it considers *what* was physically used or exploited in the media information, promotion and merchandising uses. It is possible, and indeed necessary, to take a different approach, which asks *why* the image of one person is worth £1million while the image of another is worth nothing? What effects this value transformation? The following section will explore the underlying value which is arguably the unifying element in all publicity exploitation.

### 3.2. The Underlying Element: Reputation

There is plenty of evidence that the identity of, and personal information about, individuals is valuable. However, it is arguable that image, indicia and information

<sup>98</sup> *McCulloch v Lewis A May* (1948) 65 RPC 58.

<sup>99</sup> *Carson v Here's Johnny Portable Toilets Inc* 698 F 2d 831.

<sup>100</sup> *Midler v Ford Motor Company* 849 F 2d. 460 (9<sup>th</sup> Cir. 1988).

<sup>101</sup> *White v Samsung Electronic America Inc* 971 F.2d 1395 (9<sup>th</sup> Cir 1992).



are important because they can be *identified* with a particular individual. Out of the many women who gave birth to twins in February 2008, only one was offered \$6 million by People Magazine for the first pictures of the twins.<sup>102</sup> It can therefore be suggested that it is not the photograph of twins which is worth \$6 million to People Magazine, but the fact that the mother of the twins in this instance was Jennifer Lopez. Her celebrity-status is what endows the baby photographs with their interest to the media and the public, and which generates a price tag far beyond the typical media response (or lack thereof). Lord Nicholls referred to this idea in his opinion in *Douglas v Hello!*: “The identity of this couple made their wedding an eminently newsworthy event.”<sup>103</sup> Presumably other couples were married in New York on the weekend of 18 November 2000, but only Michael Douglas and Catherine Zeta Jones licensed use of their wedding photographs for £1 million.

In addition to these examples of media information use, the importance of identity – and recognisability – can also be seen in the promotion and merchandising fields. The reason that David Beckham is used by Police to promote sunglasses in preference to using a model is because the (majority of the) public recognise David Beckham and associate his fame and success with the product in question:

We identify with and buy into celebrities for the same reasons we buy into brands. They add colour and excitement to our life. They provide a promise or a reassurance of a particular experience. We admire what they do, how they look or what they represent. They offer a shared frame of reference that enables us to bond with other people.<sup>104</sup>

The colour and excitement and the shared frame of reference come not solely from image or indicia or information, but from the underlying reputation and fame: the “celebrity aura is a potent force”.<sup>105</sup> This is not the case with less- or non-famous individuals. As Holyoak notes “the world is not crying out for Jon Holyoak

<sup>102</sup> <http://news.bbc.co.uk/1/hi/entertainment/7272956.stm> (accessed 3 March 2008).

<sup>103</sup> [2008] 1 AC 1, para 253, per Lord Nicholls.

<sup>104</sup> A Milligan, *Brand it Like Beckham*, 2004, (henceforth Milligan, *Brand it Like Beckham*) at 31. This echoes the message which is drawn out time and again in the works of Madow and Coombe, amongst others: Madow, “Private ownership of public image”; Coombe, *The Cultural Life of Intellectual Properties*, chapter 2.

<sup>105</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 92. Coombe defines “celebrity image” as those elements which constitute the celebrity’s “recognition value”, at 89, note 5.



sweatshirts now nor, it seems likely, in the future”.<sup>106</sup> Absent a reputation which makes Holyoak readily identifiable by the public, there is little demand for use of his image.

The underlying element which apparently creates the value and the attractiveness of a celebrity image is the recognisability of the individual, and this stems from his reputation.<sup>107</sup> On this analysis, Beckham’s reputation becomes the core element which attracts Police sunglasses, just as Lopez’s reputation attracts People magazine and its chequebook. The role played by reputation – or celebrity, popularity, fame, notoriety, glamour or goodwill – in publicity exploitation thus requires further examination: to what extent is reputation essential to the exploitation, or is it simply one factor of many?

Given that the cases discussed in section 2.3 above all involved celebrities, it is reasonable to speculate that this fame has been the primary attraction for any third party exploiter. If so, then the subject of the use and exploitation could be the individual’s reputation rather than, or in addition to, his image or indicia or personal information.

Support for this arises from reliance by claimants in England upon passing off to recover for unauthorised publicity exploitation. Passing off is founded upon the reputation and goodwill of the claimant: Irvine’s case against Talksport succeeded because, in the words of Laddie J, “Mr Irvine has a property right in his goodwill which he can protect from unlicensed appropriation consisting of a false claim or suggestion of endorsement of a third party’s goods or business.”<sup>108</sup> Irvine’s recovery was thus not based upon unauthorised use of his image alone. In fact, Irvine only objected to the doctored image of him which created a false impression of endorsement: no action was pursued against Talksport for its use of the other (untampered) image of him on the winner’s podium. Rather, an essential element of

<sup>106</sup> J Holyoak, “United Kingdom character rights and merchandising rights today” 1993 JBL 444, at 456.

<sup>107</sup> At this stage it is sufficient to note that it is recognisability which is important, rather than whether the reputation or association is good or bad.

<sup>108</sup> *Irvine v Talksport Ltd* [2002] 1 WLR 2355, para 75, per Laddie J.

Irvine's claim was to demonstrate that he had goodwill in himself, which had been exploited through use of a falsified image.<sup>109</sup>

It is possible, however, to question the weight that can be attached to this example. A central factor in such litigation is likely to be the claimant's need to fit his *commercial or personal* grievance within an existing *legal* cause of action. Irvine's case relied on establishing that he had reputation and goodwill which he controlled and exploited in a series of other deals. But this emphasis on reputation and goodwill would have been driven by the requirements of the tort of passing off and can therefore be seen as a tactical and expedient approach. Passing off requires the claimant to prove the existence and appropriation of the claimant's goodwill, rather than "image": Irvine's case focused on goodwill rather than image. Arguably, the importance of goodwill in this case tells us no more than that a claimant needs to demonstrate goodwill to prove his claim of passing off.

Further, under this analysis, image or indicia are important because of the relationship between physical identity and intangible reputation. It does not make sense to exploit "reputation" in the abstract. Like goodwill, reputation is intangible, and must be represented in some tangible form. If I wish to take advantage of David Beckham's reputation, I *must* use some tangible representation of it, such as his name, signature or image. The image or identity exploited in each case can be seen as the physical manifestation of the reputation.

Logeais explores this point in her review of French case law. She recognises that "the image is protected because it is the closest reflection or personification of the person's fame achieved either because of artistic or professional skill or holding of positions entailing public exposure."<sup>110</sup> She expresses uncertainty, however, as to whether image is protected in order to protect the underlying fame or to recognise the

<sup>109</sup> The centrality of the doctored image in this case reflects Carty's point that passing off "remains a tort of misrepresentation, not misappropriation *per se*." Carty, "Personality Rights and English Law", para 7.2.3. It was the lack of misrepresentation that defeated a claim for unauthorised use of image by the Spice Girls, in *Panini SpA v Halliwell*, discussed in Carty, *ibid.*, para 7.2.4.

<sup>110</sup> Logeais, "The French right to one's image", at 168.

“efforts or personal or professional achievements which resulted in fame.”<sup>111</sup> However, since fame does not always result from personal or professional achievements (“accidental” heroes being one example), yet the French right still exists, it is perhaps the fame which is the underlying protected interest.<sup>112</sup> In any event, the method of achieving this protection is through the individual’s image or identity, which is the tangible representation of the underlying fame. Image and reputation are therefore inter-dependent and mutually reinforcing.

The majority of examples of exploitation have featured celebrities with a reputation to exploit, and will presumably continue to do so. Reputation is undoubtedly the magical ingredient which attracts the attention, and the fees, in the first place. Accordingly, reputation is the underlying, and inherent, element in all cases, and is exploited through use of the individual’s image or other indicia, together in some cases with personal information about him. This is the case even where the reputation is negative.<sup>113</sup> While there is a clear moral and social difference between a positive reputation and a negative or tarnished one, both may operate to bring the individual (and, of course, the goods or services in question) to the public’s attention.

Yet there are, as ever, exceptions. A number of cases, primarily from North America, suggest that it is not always reputation which is the underlying attraction. These cases involved unknown individuals who were used to advertise products, as in *Roberson*<sup>114</sup> and *Pavesich*,<sup>115</sup> or simply pictured in a magazine, as in *Aubry v Editions Vice-Versa*.<sup>116</sup> Only the image was exploited, without name or reputation, presumably because, as non-famous individuals, use of name would be meaningless,

<sup>111</sup> *Ibid.*

<sup>112</sup> This of course has consequences for the potential justifications of a publicity right, and will be discussed in Chapter 4.

<sup>113</sup> One example is the advertisement that Ryanair chose to run, featuring a picture of Major Charles Ingram, who found guilty of conspiring to cheat on a television game show. Despite his notoriety at the time, Ryanair used this to its advantage in its advertisement. A slightly different example of the marketability of negative press is provided by Kate Moss, whose reputation was tarnished when photographs of her using cocaine appeared in the press, and she subsequently lost a number of high profile modelling contracts. Since then, however, her career has revived, with significant deals with Topshop, for example: <http://news.bbc.co.uk/1/hi/business/5363414.stm> (accessed 23 December 2008).

<sup>114</sup> 171 NY 538 (1902).

<sup>115</sup> 50 SE 68 (1905).

<sup>116</sup> (1998) 78 CPR (3d) 289.

and there was no evidence of a pre-existing reputation. A distinction can therefore be drawn between cases which use an individual's image or indicia together with the benefit of reputation and those cases which simply rely on the indicia, typically image rather than name. Despite this lack of fame or notoriety, the claimants in two of these cases were successful, while the claimant in *Roberson* lost by a majority decision of 4-3 and, as Goodenough suggests, was probably the inspiration for the privacy legislation which was enacted shortly thereafter, and which "aimed quite directly at the facts of the *Roberson* case".<sup>117</sup> As Goodenough notes "[o]therwise anonymous people can provide images of value to wrap around products and services to draw attention and good associations to them."<sup>118</sup>

However, the successful actions were based on privacy in *Pavesich*,<sup>119</sup> and on the constitutionally-protected human right of privacy in one's image in *Aubry*.<sup>120</sup> This suggests that unauthorised exploitation of an individual's image can be prevented without the need to show an established reputation in some jurisdictions. Where such protection is afforded, however, it typically arises from privacy, rather than a publicity rights action.

Without an underlying reputation or public status, the use of the private individual is arguably no different from use of a model. Madow recognises this where he argues that "it is only because star images are sources and bearers of *meaning* that they have the power to "sell" commodities with which they are associated. Their economic value... derives from their *semiotic* power – their power to carry and provoke meanings."<sup>121</sup> Individuals without a public reputation, such as agency models, are not able to provide additional meaning to a promotion use, for example. Thus, where *Roberson* and *Pavesich* were used to advertise flour and insurance, the companies in

<sup>117</sup> Goodenough, "The price of fame, Part 1", at 58.

<sup>118</sup> Goodenough, "Rethorising privacy and publicity", at 41. An example of such an advertisement is included at Appendix C.

<sup>119</sup> *Pavesich v New England Life Insurance Co* 50 SE 68 (1905).

<sup>120</sup> *Aubry v Les Editions Vice-Versa* (1998) 1 SCR 591. See also Beverley-Smith, *The Commercial Appropriation of Personality*, at 225; Beverley-Smith *et al*, *Privacy, Property and Personality*, at 51-52; and Goodenough, "The price of fame, Part 1", at 57-58.

<sup>121</sup> Madow, "Private ownership of public image", at 185. Madow uses this to argue against a right of publicity, since the value is created by public awareness, not by the celebrity, and the celebrity does not "deserve" the value in his image. Madow's arguments against justifications for a publicity right will be considered in detail in Chapter 4.

question were not attempting to trade on their reputation or recognisability in the public mind: all that was being exploited was the image of the individual, without any sub-text. In this way, Roberson and Pavesich were effectively non-professional models, whose images were used without their consent. Further support for this analysis comes from Reiter, who refers to a case where

a young man was unknowingly photographed during a gathering in a public park and the image was used to advertise beer. The plaintiff claimed substantial sums for moral prejudice and unjust enrichment, because the brewery profited through the use of his image. The court granted modest awards for the violations to his privacy and reputation, but on the unjust enrichment claim, awarded only the small amount the brewery would have had to pay to procure a similar photo from an image bank.<sup>122</sup>

The quantification of the commercial element for this non-famous claimant was based on a quasi-modelling fee, not on the value of his “identity” to the brewery.

The problem with this analysis, which places the emphasis on the exploitation of fame and reputation, rather than image and indicia, is that it would risk precluding non-famous individuals from the scope of any available legal remedy enjoyed by their famous counter-parts. Whereas all individuals have an image and indicia, only the well-known have a “reputation”. Accordingly, private individuals would have to rely primarily on privacy-based remedies to seek redress for the unsought public exposure they have endured, or seek a lesser amount, such as a modelling fee, for the unauthorised use.

Yet it is not clear why famous people should enjoy an additional legal right which is denied to the majority. Although it would appear that most cases involve famous people this is not a reason for excluding the majority of the population from such protection. Further, reputation is a variable commodity: some may have “more” than others. Fame is not an all or nothing factor, but rather one which varies along a spectrum. It is something that everyone can attempt to cultivate, and to different degrees. If fame or reputation is central to publicity, we are faced with a definitional problem in delineating “fame”, as regards both the necessary quantity and quality. These observations make it difficult to determine, without more, whether a publicity

<sup>122</sup> Reiter, “Personality and patrimony”, at 701.

right should arise only for celebrities or for all individuals. This point will be considered in greater detail in Chapter 4.

Regardless of the ideological arguments for and against reputation as an essential element in any legal right, it certainly appears to play a pivotal role in publicity practice. Indeed, reputation and exploitation are bound up in a symbiotic relationship, whereby the publicity exploitation feeds and develops the reputation which is then increasingly valuable and desirable for future exploitation. Image, indicia and information can be seen as the physical manifestation of the individual's fame – or notoriety. Since reputation cannot be exploited without some physical representation, image, indicia and information still have an important role to play – albeit information appears more prevalent in the media information use.

#### 4. ANALYSIS OF CONTRACTS FOR PUBLICITY EXPLOITATION

Whereas the above review has drawn on case law and literature to produce a clearer understanding of use and subject matter, there is a third source of insight to publicity exploitation. Commercial contracts between the individual and the publisher, promoter or merchandiser for exploitation of his identity can provide a valuable understanding of the interests of both parties. What is particularly helpful here is that the focus shifts from unauthorised to authorised use. In contrast to case law, which generally arises from use made without the consent of the individual in question, commercial contracts for exploitation involve authorised use of the individual's identity.

One obstacle to the study of such contracts is that they are usually a private matter between the contracting parties. However, it is possible to derive some details of these contracts from other sources. First, law reports of those cases involving *unauthorised* exploitation often reveal valuable details of *authorised* contracts because, all too often, unauthorised use will be made against a background of controlled, authorised exploitation. Thus in *Douglas v Hello!*, details were discussed

in court of the contract between the Douglasses and OK! for authorised exploitation.<sup>123</sup> Similarly, in *Irvine v Talksport* the focus was on Talksport's unauthorised use, but the High Court and the Court of Appeal set out in some detail contracts between Irvine and other parties, including the F1 team for which he raced, Ferrari, for exploitation of his image and indicia. A second source of information is a *pro forma* "Personality Rights Agreement" prepared by a Scottish commercial law firm, for use by sports clubs and their players. Thirdly, evidence of such authorised deals can be drawn from the work of other academics in this area and from the media.

Turning firstly to the details that can be derived from *Douglas v Hello!*, the discussion by the Court of Appeal of the contract between the Douglasses and OK! was extensive. Clause 2 of that contract apparently stipulated that OK! was to have the exclusive right to publish the Photographs (as defined) for a period of nine months following the wedding.<sup>124</sup> Clause 6 defined the "Photographs" as colour photographs taken by a photographer at the Douglasses' wedding and clause 7 ensured that only pictures approved by the Douglasses would be published by OK!.<sup>125</sup> The Photographs were not the only subject of the contract, as clauses 4 and 5 authorised OK! to use, for the nine month period, the names, voices, signatures, photographs or likenesses of the Douglasses *in connection with the wedding for advertising purposes*.<sup>126</sup> The contract repeatedly refers to the subject matter being the wedding photographs and restricts the grant of other elements of image and indicia to use in connection with the wedding. The focus of this relationship was clearly the event of the Douglasses' wedding, rather than the Douglasses alone.

The second source is Club *pro forma*, which takes the form of a licence to the Club from the contracting player (by way of the company incorporated to manage his intellectual property rights). It is envisaged in the *pro forma* that the player will also have a separate service agreement with the Club for his sporting services, but this

<sup>123</sup> The most detailed discussion of the contract was in the Court of Appeal's decision: the House of Lords referred to the contract but not with such thoroughness.

<sup>124</sup> [2006] QB 125, para 5.

<sup>125</sup> *Ibid.*, paras 6 and 7.

<sup>126</sup> *Ibid.*, para 131.



remains unseen. The subject matter of the licence is very widely defined to cover (i) the player's name, likeness and image; (ii) photographs, recording, film, video footage and graphical images of the player; and (iii) any other information or images relating to the player, together with any intellectual property rights that exist in each of these categories. It is not immediately obvious from this definition whether the subject matter is connected to a particular event, as with the Douglases' wedding, or a particular product, as with some of Irvine's promotion deals. The focus of the agreement can in fact be discerned from the scope of the licence granted to the Club rather than the definition of the subject matter. This licence is exclusive and perpetual in relation to the player's Club activities and his provision of services to the Club, such as appearing in team kit. In relation to any non-Club activities the licence is non-exclusive and of limited duration.

While the subject matter to be exploited by OK! and the Club are similar – name, image and photographs – the scope of the two agreements is radically different. OK! benefited from an exclusive deal in relation only to the wedding photographs, and to material necessary to promote these photographs. This deal expired after nine months. The Club, however, is granted what amounts almost to an assignation: a perpetual, exclusive licence, which survives termination of the contract, in relation to images of the player in the team kit or performing his duties under the service agreement.<sup>127</sup> This means that the player himself has no right to control the use of his image when he is wearing the team kit or playing for the Club. As the term of this licence is stated to be perpetual, a calendar produced by the Club in future decades, featuring notable players from the Club's history, could feature a photograph of the player in the team kit, entirely at the discretion and will of the Club, with no reference to the (potentially now elderly or deceased) player or his surviving family. In other matters, outwith the parameters of the player's sporting career, the Club benefits from a non-exclusive licence which terminates when the player's service agreement terminates. Evidence from *Irvine v Talksport* suggests that Irvine's agreement with Ferrari was on broadly similar terms to the Club *pro forma*. For example, Laddie J's judgment refers to Irvine's contract with Ferrari

<sup>127</sup> It is, however, still only a licence: a perpetual and exclusive licence may be a powerful grant to the Club, but it does not equate to a full assignation.



which stipulated that Irvine “could not appear in the distinctive Ferrari red clothing in an endorsement save where that endorsement was through and on behalf of Ferrari.”<sup>128</sup> Even when not wearing his racing colours, Irvine stated that “I would always obtain the consent of the team I drove for in respect of any such endorsements or sponsorships.”<sup>129</sup> These restrictions mirror those imposed on the player by the Club *pro forma*.

The impression given by the Club *pro forma* and the brief insight we have into Irvine’s relationship with Ferrari is of a highly restrictive and controlling sporting body and a player or driver who has little bargaining power. This marks a powerful contrast to the terms of the Douglasses’ deal with OK!, which allowed the Douglasses to have full control over the photographs and text published, and even to refuse to provide any wedding photographs at all. Evidence from the Court of Appeal judgment in *Irvine v Talksport* does, however, suggest that these ongoing obligations are not as restrictive in practice as they might appear on paper: Irvine had a number of independent, non-Ferrari related promotion deals in 1999, worth at least £323,000.<sup>130</sup> Even if the contract with Ferrari was restrictive, it did not appear to preclude the addition of a considerable sum to his income. In fact, it is arguably thanks to this relationship with Ferrari, and his skill as a racing driver, that Irvine was able to command such sums in the first place. As with most publicity deals, both parties stand to benefit from the arrangement.

Little is revealed of Irvine’s other authorised promotion deals, but the Court of Appeal judgment does give some indication of what was provided by Irvine for his fee in each case. For example, his deal with Hilfiger, worth £125,000 in fees and free products, permitted “images of Mr Irvine to be used in advertising the product and for him to make personal appearances.”<sup>131</sup> For a mere £25,000, plus £63,000 of free products, Irvine agreed to “supply an image for promotional purposes and to wear the product”, the Bieffe racing helmets. And a fee of £75,000 bought

<sup>128</sup> *Irvine v Talksport* [2002] 1 WLR 2355, para 75.

<sup>129</sup> *Ibid.*, para 49.

<sup>130</sup> *Irvine v Talksport* [2003] 2 All ER 881, paras 53-58.

<sup>131</sup> *Ibid.*, para 55.

Valleverde footwear “an image of Mr Irvine to be used for print advertising, a personal appearance at a promotion, and an appearance in a television commercial in Italy.”<sup>132</sup> The focus in these brand-specific deals is on the use of Irvine’s image, together with an element of personal endorsement to promote the product.

All the contracts reviewed appear to include provision for much the same subject matter: elements of identity – name, likeness and image – together with information, photographs, footage or personal appearances. It is difficult to isolate one factor in any contract which operated as the key focus of the deal. This is in contrast to the paradigm cases of unauthorised exploitation discussed in section 2.3 above, where the focus was very often on one element – name or image, for example. Thus, in *Irvine v Talksport*, as noted, the use of a (doctored) photograph of Eddie Irvine was the subject of the action: there was no use of his name or any personal information or signature, for example. So too with *Douglas v Hello!* where Hello!’s unauthorised exploitation was of specific wedding photographs containing personal information, in contrast with the extensive subject matter granted to OK!, which included the names, voices, signatures, photographs or likenesses of the Douglases as well as their wedding photographs.

Part of the reason for the extensive grants made under these authorised deals, compared with the apparently more restricted scope of image used in unauthorised exploitation, may arise from the legal and commercial uncertainty surrounding this area of commercial practice. This leads to two related conclusions. As regards the agreements for authorised use, a cautious solicitor is likely to draft the terms of the licence as widely as possible, reflecting the fact that it is not certain how one successfully licenses name, image and reputation. Interestingly, despite the conclusion in section 3.2 above regarding the importance of reputation in most cases of commercial exploitation, none of the licences considered here was explicitly for use of reputation. This does not mean that reputation is *not* the underlying right that the parties are keen to exploit, but it does indicate that commercial practitioners do not wish to attempt to define it or explicitly trade in it. It is difficult to know how

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<sup>132</sup> *Ibid.*, para 57.

much significance to attach to its absence, but it is certainly worth noting. It is probably not possible to determine precisely the subject matter as being *either* reputation *or* image/indicia/information, and there is certainly no reason to think that parties would limit their licence to one or the other, even if this were possible. It is therefore not entirely surprising that contracts for authorised exploitation are drafted in such wide terms. Further, it is difficult to determine how reputation could be licensed without making reference to the tangible elements representative of that reputation, such as name and image.

The second conclusion to be drawn relates to the much narrower scope of the subject matter in cases of unauthorised exploitation. Here, uncertainty over litigation for unauthorised use suggests that claimants are likely to frame their claim more narrowly, in terms of existing actions, rather than casting the net too widely, thereby risking an unfocused and irrelevant claim. Thus, the Douglasses' claim against Hello! relied on breach of confidence and accordingly focused on use of the Douglasses' "information" in the wedding photographs, rather than use of reputation and goodwill or a more general claim for use of "image". Since information is the constituent element of the action for breach of confidence this is hardly surprising. Accordingly, as noted in section 3.2 above the more limited focus in litigation can be seen primarily as a tactical consideration, in fitting the facts of the case into the most appropriate cause of action.

This review demonstrates that contracts for authorised exploitation of image and indicia are too complex to be easily categorised by subject matter: it is not possible to pigeonhole them as contracts for use of name *or* image *or* information *or* reputation. Instead, the key difference between these deals arises from the use made of the subject matter. This is the primary difference between the media information deal struck by OK! for the (exclusive) right to publish the Douglasses' wedding photographs and the promotion right sought by Hilfiger and others to use Irvine to endorse their goods. Further, the focus of these agreements can be distinguished, especially when the longer-term contracts between sportsman and club are considered. The Irvine/Ferrari deal and the Club *pro forma* contract revolve around

an ongoing long-term relationship and involve a level of detail and control that is not required, or necessary, or even possible, in the one-off deals. In contrast, the one-off deals (such as Douglas/OK!, Irvine/Valleverde and Irvine/Bieffe) are fixed-term agreements providing the benefit of the individual to be exploited in relation to a specific event (a wedding) or a specific brand or product (Valleverde footwear, Bieffe helmets).

The complexities and uncertainties discussed above, regarding the subject matter, have been confirmed by this review of contracts for exploitation. It is not possible to reduce publicity practice to the use of one element of the individual. Instead, information, such as wedding photographs, together with name and image and indicia (perhaps including racing colours) are all important elements. Further, underlying all these constituent parts is the intangible, yet ever-present, reputation of the famous individual in question. The one distinction that can be drawn more clearly is the *use* to be made of the individual, using the tripartite classification of media information, promotion and merchandising uses.

## 5. CONCLUSION

This chapter has sought to build upon the analysis of legal responses to publicity in Chapter 2 by assessing the practice of publicity in a commercial setting. The primary objectives of this chapter arose from the need to understand more clearly what the social and commercial practice of publicity is and how this affects the legal response to it. Chapters 2 and 3 are therefore intended to work together to provide a foundation for the rest of the thesis.

This review of practice relied upon evidence from case law, contracts and commentaries to develop a more structured understanding of the practical reality of exploitation of “publicity”. From this, it has been possible to construct a coherent framework of publicity uses and to gain an understanding of the subject matter of these uses. The three uses are:

- Media information use: The use of an individual's persona in the media, usually by way of an "exclusive" story;
- Promotion use: The use of an individual's persona to advertise or endorse or otherwise promote the goods or services of another party;
- Merchandising use: The use of an individual's persona on goods, where the individual effectively becomes the product himself, whether as a pure representation or a utilitarian item.<sup>133</sup>

They can be represented by the three English cases of *Douglas v Hello!*, *Irvine v Talksport*, and *Lyngstad v Anabas* respectively.

Together, the three uses can be thought of as the core of publicity practice. Any publicity right should therefore be capable of addressing the exploitation – whether authorised or not – of these three uses. A further defined term is therefore "**publicity**", meaning the use of persona in public through the media information, promotion or merchandising uses, as defined above.

The subject matter is more complex. It can be thought of as the individual's persona, which can be broken down into the narrower elements of image, indicia and information. However, these can also be regarded as the physical manifestation of the underlying "asset" which is being exploited: reputation. Without reputation – fame and public status – it is arguable that much of the publicity practice would not exist. The relevant defined terms for subject matter are:

- Image: The individual's image in any format from which he can be identified, such as a photograph, drawing, computer generated image, some other graphical representation, or look-alike;
- Indicia: Any element of the individual which can be used to

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<sup>133</sup> As per the distinction at section 2.1 above.

identify the individual, whether (i) an inherent part of that individual, including but not limited to name, nickname, image and voice, including sound-alikes, or (ii) an adopted act or phrase or costume;

- Information: Personal information regarding the individual which can be divulged or not, at his choosing, but which is otherwise not in the public domain (such as wedding photographs);
- Reputation: The public reputation of the individual, whether negative or positive.

Together, these elements can be thought of as an individual's "**persona**" – and persona will be used as a defined term in the remainder of the thesis to refer to the individual's image, indicia, information and reputation.

A further distinction can be made as regards authorised and unauthorised exploitation. The use classes and the subject matter are neutral, in the sense that they are present in both authorised and unauthorised exploitation. There is no legal wrong involved in publicity use *per se*: instead the focus turns to whether the use is authorised or unauthorised. The media information use can just as easily be exploited by the individual through an authorised deal as it can by the unauthorised publication of the image and information by another party. So too with the promotion and merchandising uses. Cases such as *Douglas v Hello!* demonstrate this very neatly, with a contract for authorised use between the Douglases and OK! sitting alongside the litigation against Hello! for unauthorised use. The authorised use can be regarded as a **positive power** of the individual to control and exploit, while the individual's legal right to prevent or claim for unauthorised use can be thought of as a **negative right**. The positive/negative distinction is therefore a critical one to make. Together, the use classification and the positive/negative classification provide a clearer framework in which to locate this study.

## PART II

The previous chapters sought to explore the practice and academic analysis of publicity to understand *what* is being exploited, in what way, and by whom. Now that the “what” has been identified, it is possible to address two further questions: the why and the how. This requires consideration of whether legal recognition of publicity rights is justified (the “why”) and, if a justification can be found, an assessment as to how best these rights should be recognised in law (the “how”).

The purpose of this Part is to consider the “why”, by assessing justifications for and against a legal right of publicity. Chapter 4 identifies the interests of the individual which would be protected by a right of publicity, together with the wider social interests which would potentially be threatened by such a right. Thereafter, three justifications in favour of such a right are advanced and a number of criticisms of other justifications are assessed.

# CHAPTER 4: JUSTIFYING A RIGHT OF PUBLICITY

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## 1. INTRODUCTION

If a legal right of publicity is advocated, it must be justified. It is not enough simply to assert this, as:

the defence of any legal, economic or social institution should be backed up by reasons or considerations likely to sway the free understanding of the participants in social life in favour of the institution that is being defended.<sup>1</sup>

Such justifications are particularly important when the matter in question is a legal right which would impose duties as well as benefits, and which would be supported by the sanction of the civil law against those in breach. It has been said that when governments make decisions about intellectual property rights they should allow change “only if a rigorous analysis clearly demonstrates that it will promote people’s basic rights and economic well-being”.<sup>2</sup> A new right of publicity thus requires rigorous analysis, to provide the reasons and considerations in favour of such a right.

Before turning to review relevant justifications, there are two initial points to be made. The first arises from the placing of this chapter at this stage of the thesis, when it is not yet clear what form (if any) a right of publicity should take. Justifying a legal right would be a very different task if the right were to be founded in delict rather than in property, for example, or unjustified enrichment rather than intellectual property. So too with defences and remedies: the strength of the right may impact upon the strength of the justification sought. There are thus a number of known unknowns at this stage, which prevent a review of justifications directed towards a

<sup>1</sup> HM Spector, “An outline of a theory justifying intellectual and industrial property” [1989] EIPR 270, at 270.

<sup>2</sup> The Adelphi Charter, adopted by the Royal Society for the Arts, 13 October 2005.

specific legal right. Instead, the justifications considered below will seek to support a legal right to control the use of persona.<sup>3</sup> The precise nature of that right, and its limitations, will emerge from this justificatory project and the following chapters, which will consider the legal classification of publicity.

This approach is necessary because there are compelling reasons in favour of assessing the justifications at this early stage. In the first place, any review of publicity rights is meaningless unless the right can be justified. To proceed with a detailed analysis of the scope, content and limitations of a publicity right based only on a *presumption* of eventual justification requires a considerable amount of goodwill from the reader. Further, if it is not possible to justify publicity rights, then there is no further work to be done: defining the nature and scope of the right becomes unnecessary. It is also likely that the nature of the justifications – or lack of them – will play an important role in shaping any eventual legal right, its defences and remedies. For these reasons, justifications will be dealt with at this stage in the thesis.

The second introductory point is that writers appear to be capable of accepting or rejecting justifications for publicity rights, regardless of which of the conceptual categories<sup>4</sup> their work falls into. It would be wrong to conclude, for example, that those writers who discuss publicity rights in the broadest category of “publicity as property” are united in advocating such rights, whereas those who are classed in the personality rights approach reject them. Although Madow has suggested that in the American tradition (which is broadly the “publicity as property” approach) there is “a solid, indeed an overwhelming consensus... that the right of publicity is a good thing”,<sup>5</sup> there are plenty of writers in this approach who take a critical line. Madow’s own analysis, for example, falls within this broad category of an all-encompassing publicity right, yet he has written a comprehensive critique of publicity right

<sup>3</sup> Persona being an individual’s image, indicia, information and reputation, as defined in Chapter 3.

<sup>4</sup> Outlined in Chapter 2.

<sup>5</sup> Madow, “Private ownership of public image”.

justifications.<sup>6</sup> Writers in each category are capable of maintaining either a healthy scepticism or a pro-right conviction.

A more problematic trend seems to be the varying rigour of the arguments advanced by those in the opposing camps. As Carty notes, the pro-celebrity industry seems to think it is “‘obvious’ that the commercial worth of the celebrity magnet (particularly in advertising) belongs to them and that unauthorised use should be prevented by law.”<sup>7</sup> This assumption by pro-publicity rights writers frequently results in a brief or sketchy consideration of the justifications for such an “obvious” right.<sup>8</sup> In contrast, those who claim that publicity rights are insufficiently justified<sup>9</sup> usually make their case against publicity in compelling detail. Existing writing therefore tends to challenge rather than support any search for justifications<sup>10</sup> – albeit Madow, who makes a highly persuasive case against publicity rights, observes that: “[i]t may be possible to make a coherent and convincing case for the right of publicity. But that case has yet to be made.”<sup>11</sup> What follows is an attempt to address these challenges.

## 2. BENEFITS AND HARMS: IDENTIFYING THE INTERESTS AT STAKE

Rights in law typically have one of two aims: to enable individuals to advance their interests as they see them, or to protect them from harm.<sup>12</sup> Part of the task of justifying legal protection for persona is to consider the benefits that a right of publicity would bring to the individual, and the interests it would protect. It is

<sup>6</sup> Madow, “Private ownership of public image”. Fisher identifies Madow as one of a “small group of commentators” who “began drawing explicitly on theories of intellectual property to criticize the right of publicity” in the 1990s: W Fisher, “Theories of Intellectual Property”, available at <http://cyber.law.harvard.edu/people/ffisher/iptheory.pdf> (accessed 15 November 2008) at 37.

<sup>7</sup> Carty, “The quest for the IP effect”, at 240-241.

<sup>8</sup> Madow also recognises this point: Madow, “Private ownership of public image” at 136.

<sup>9</sup> Including Madow, “Private ownership of public image”, Beverley-Smith, *The Commercial Appropriation of Personality*, and Carty, “Advertising, publicity rights and English law”.

<sup>10</sup> A notable exception is Westfall and Landau, who conclude that “it is difficult to either support or criticize the existence of publicity rights all that strongly.” Westfall and Landau, “Publicity Rights as Property Rights”, at 117, and also 118.

<sup>11</sup> Madow, “Private ownership of public image”, at 135.

<sup>12</sup> This duality is reflected in the difference between contract (an enabling tool) and delict (a protective/ defensive tool).

therefore helpful to consider the legal and commercial interests at stake in publicity practice. What interest would be harmed by unauthorised use of persona? What interest would be protected by the grant of a publicity right?

This task becomes particularly important because, for many writers, it is the apparent lack of harm to the individual which is their primary objection to the case for publicity rights. Carty, in particular, is a strong proponent of the need for the existence of a harm to justify the grant of any legal right. In her discussion of the broader “IP effect”<sup>13</sup> she argues that

The IP effect would offer claimants wider protection, not intrinsically based on “harm” or “wrongs”. Rather, it would provide redress where the defendant has benefited from the claimant’s creation or effort. So it is the prevention of unjust enrichment or misappropriation which is the nub of the IP effect.<sup>14</sup>

This, Carty argues, is flawed, since legal protection must respond to a harm rather than to a (harmless) transfer: it is insufficient to point to a benefit which has been transferred. Instead, it must be possible to demonstrate that there has been harm caused through the unauthorised use of persona. Consequently, “in the absence of specific wrongs such as trade mark infringement or defamation, the use of the celebrity magnet is open to all.”<sup>15</sup> And Carty is quite clear that “no wrong *per se* resulted from the unauthorised exploitation of the persona of a celebrity, however “unfair” this may appear to the celebrity industry.”<sup>16</sup> The need for law to respond to wrongs, protected by specific actions, rather than to assert general rights, is a much stronger tradition in Common law jurisdictions than in Civilian ones.<sup>17</sup> Nonetheless, identifying the legal and commercial interests which are protected by publicity rights, and which are harmed by the lack of a publicity right, should be seen as an essential element of any consideration of justifications.

<sup>13</sup> That is, the idea that there is ever-increasing pressure for legal protection for intangibles, outwith the traditional categories. Publicity, she argues, is one such example. See Carty, “The quest for the IP effect”.

<sup>14</sup> *Ibid.*, at 239. See also Carty, “Personality Rights and English Law”.

<sup>15</sup> Carty, “Advertising, publicity rights and English law”, at 211.

<sup>16</sup> *Ibid.*, at 238.

<sup>17</sup> For example, J Gordley, *Foundations of Private Law: Property, Tort, Contract, Unjust Enrichment*, 2006, at 164; Carty, “Personality Rights and English Law”, para 7.2.1.

Two relevant interests can be discerned from the jurisprudence and academic writing. These are (i) economic or commercial interests and (ii) dignitarian interests, which include, but are broader than, privacy interests.

## 2.1. The Dual Interests in Publicity Literature

One of the most detailed analyses of the economic and dignitarian interests comes from Beverley-Smith, whose work can be located primarily in the “appropriation of personality” approach.<sup>18</sup> He defines dignitary<sup>19</sup> interests as “a generic term for the essentially non-pecuniary interests that a person might have in his own personality: reputation, personal privacy and freedom from mental distress.”<sup>20</sup> He also notes, however, that there is no single recognised definition of this term, which he believes reflects the “fact that there is no coherent notion of human dignity as a legal value.”<sup>21</sup> This view is reflective of the Common law tradition, in contrast with Civilian legal systems which *would* recognise a “coherent notion” of human dignity in law.<sup>22</sup>

In the case of economic interests, however, Beverley-Smith is able to give a more extensive definition, centred round the concept that “a finite sum of money can provide complete recompense”<sup>23</sup> for wrongful use of personality, such that the claimant feels “no further sense of loss, having received a sum of money which accurately reflects the value of what has been lost.”<sup>24</sup> The economic value of publicity is derived from the commercial value individuals have to advertisers and the media, amongst others, allowing them to grant licences or otherwise trade in their persona.<sup>25</sup> De Grandpre explains it rather neatly, by noting that “[f]amous people offer advertisers relationships with which they can communicate with the purchasing

<sup>18</sup> See Chapter 2. Prosser, another writer in this category, also discusses these interests: see Prosser, “Privacy”, particularly at 406.

<sup>19</sup> Beverley-Smith uses slightly different terminology, referring to dignitary interests instead of dignitarian ones in *The Commercial Appropriation of Personality*, Part III. I shall use the term “dignitarian” predominantly, but treat the two interchangeably.

<sup>20</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 141.

<sup>21</sup> *Ibid.*, at 10. Although he accepts, at 141, that this is not the case in those jurisdictions which recognise *injuria*.

<sup>22</sup> See for example Neethling, “Personality Rights”, at 530; Whitty, “Overview of Rights of Personality in Scots Law”; and Chapter 2, section 2.2 above.

<sup>23</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 8.

<sup>24</sup> *Ibid.*, at 8.

<sup>25</sup> *Ibid.*, at 8.

public”<sup>26</sup> and that “[i]n the market for eyeballs, people who have the ability to deliver public attention are in high demand.”<sup>27</sup> This creates the economic interest and, critically, should be capable of being objectively valued leaving no room for subjective values and beliefs, according to Beverley-Smith. It is this objectivity which results in full compensation for economic harms being found in a “finite sum of money”: only where there is a subjective loss (such as harm to a dignitarian interest) may this no longer be possible for the pursuer, and the interest will be compensated with an award of *solatium*.

An earlier review of these interests can be found in Frazer’s article on “Appropriation of Personality”.<sup>28</sup> Using slightly different terminology from Beverley-Smith, he concludes that

privacy and property interests in personality may exist together or separately and should be treated accordingly, but without attracting the disadvantages of treating the two interests as the subject of different *torts*... [T]he courts [would] award damages in respect of the distress and annoyance suffered *and/or* the financial loss incurred (or reasonably expected to be incurred) by the plaintiff.<sup>29</sup>

These co-existent grounds for damages arise from the privacy and property interests that Frazer discusses, and can be mapped onto the dignitarian and economic interests respectively.<sup>30</sup>

Those writers who fall within the broad “publicity as property” category identified in Chapter 2 are more likely to focus on the economic interest, at the expense of the dignitarian.<sup>31</sup> Nimmer observes that actions such as privacy are generally unsatisfactory for publicity protection because there is often no infringement of dignitarian interests in such actions.<sup>32</sup> Where a claimant has to rely on privacy-based

<sup>26</sup> de Grandpre, “Understanding the market for celebrity”, at 95. See also Klink, “50 years of publicity in the US”, at 365 and Coombe, *The Cultural Life of Intellectual Properties*, at 88-92.

<sup>27</sup> de Grandpre, “Understanding the market for celebrity”, at 94.

<sup>28</sup> Frazer, “Appropriation of personality”.

<sup>29</sup> *Ibid.* at 312, emphasis in the original.

<sup>30</sup> In Civilian terminology, Frazer appears to advocate a monistic right, that is one which protects both interests, rather than two separate rights. See Chapter 2, section 2.2, particularly the discussion of the monistic right in German law.

<sup>31</sup> A good example here is Halpern, “Publicity: Maturation of an independent right”, at 857-860.

<sup>32</sup> Nimmer, “The right of publicity”, at 204.

actions he may struggle to find redress since he has not suffered any harm to his dignitarian interests, yet the action is not intended to protect his economic interests, which may well have suffered harm. Thus, the following situation can arise:

plaintiff [a famous performer] frankly admitted that the use of his name and picture by the defendant did not subject him to any ridicule or cause him any humiliation whatever. The court held there was a technical violation of the New York privacy statute but since the use of the plaintiff's name and picture was non-offensive to him, plaintiff received nominal damages in the sum of six cents. Plaintiff might well have taken the position that the use of the name and picture of a famous performer on the defendant's program was worth a great deal more to defendant than six cents.<sup>33</sup>

The emphasis here is undeniably on the economic interests of the plaintiff, rather than any dignitarian ones arising from loss of control or dignity. Note, however, that the absence of humiliation was specific to the facts of this case: there is no suggestion by the court that such unauthorised commercial use could *never* give rise to ridicule.<sup>34</sup>

In fact, both Nimmer and McCarthy can be seen to distinguish between dignitarian privacy harms and economic publicity harms. In McCarthy's analysis "certain unpermitted uses of a person's identity in advertising can give rise to one, or both, of these rights of privacy and publicity. But while privacy is a personal and mental right, publicity is a commercial and business right."<sup>35</sup> The individual would presumably have a claim for breach of both rights, under McCarthy's analysis, but they would remain separate rights and interests.<sup>36</sup>

Even in the approach which focuses most strongly on the inherently personal nature of publicity, the (predominantly Civilian) personality rights category, the economic interest is now increasingly recognised in addition to the dignitarian one. In German law, for example, Beverley-Smith *et al* point to a long history of judicial protection for ideal interests which is now, gradually, being supplemented by recognition of the

<sup>33</sup> *Ibid.* at 208.

<sup>34</sup> Indeed, one does not have to look far to find an example of such a use: the "Gentleman rider" case from Germany involved the use of the image of a professor of ecclesiastical law in an advertisement for a sexual stimulant: BGHZ 26, 349, as cited in Beverley-Smith *et al*, *Privacy, Property and Personality*, at 144 and discussed in Chapter 2, section 2.2.

<sup>35</sup> McCarthy, "Public personas and private property", at 687.

<sup>36</sup> This reflects the dualistic protection favoured in France, for example. See Chapter 2, section 2.2.



economic aspects of personality rights, albeit “[s]ome uncertainties remain.”<sup>37</sup> Similarly, in France, the “traditional assertion, according to which personality rights are extrapatrimonial on the basis that the person is not a marketable commodity, seems to be giving way, however, since some attributes of the personality are increasingly being marketed.”<sup>38</sup> As Neethling explains, the traditional division between patrimonial and non-patrimonial interests is problematic in cases where an individual’s identity “has a market or advertising value”<sup>39</sup> since this use “infringes not only his personality, but also a patrimonial interest.”<sup>40</sup> Where there is a patrimonial loss, Neethling states that this “can only mean that, in such instances, apart from personality harm, a patrimonial interest connected to the personality has also been damaged.”<sup>41</sup> Both interests are acknowledged and are apparently of growing importance in Civilian jurisdictions, although the economic interest cannot be so easily accommodated within the scheme of dignitarian-based personality rights.<sup>42</sup>

The tension caused by the duality of interests is emphasised by Carty’s approach, which sees the exercise of personal choice in publicity as the assertion of an economic interest, rather than a dignitarian one. Although “dignitary interests may be encompassed within a publicity right – part of the publicity right may indeed involve the ability to *control* commercialisation of the image rather than simply to *profit* by it”<sup>43</sup> she argues that these are not “personal” dignitary interests but “commercial” ones:

Rather than impacting on the private space of the celebrity they impact on celebrity as brand...At the heart of such objections based on controlling dignitary interests are essentially commercial concerns: the celebrity seeks to control the use of his persona in order to maintain full impact in its further and future commercial use.<sup>44</sup>

<sup>37</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 95. These economic uncertainties include whether substantial damages will always be available, and whether personality rights can be licensed (also at 95).

<sup>38</sup> *Ibid.*, at 154.

<sup>39</sup> Neethling, “Personality Rights”, at 543.

<sup>40</sup> *Ibid.*, at 543.

<sup>41</sup> *Ibid.*, at 535.

<sup>42</sup> And Neethling suggests economic interests can be “controversial”: *Ibid.*, at 535. See also Chapter 2, section 2.2.

<sup>43</sup> Carty, “Advertising, publicity rights and English law”, at 212, emphasis in the original.

<sup>44</sup> *Ibid.*, at 213. Also Carty, “Personality Rights and English Law”, para 7.3.1.



Control here is not primarily a dignitarian concern, but a commercial one. However, this analysis does not necessarily undermine the underlying dichotomy. Control, even for commercial purposes, can still be seen as a dignitarian interest, allowing the individual to make his own life choices. My ability to choose whether to be a solicitor or an athlete is a commercial choice in that it determines how I will earn a living, yet it is also a dignitarian choice in that I can opt for the career that will offer personal rewards and fulfilment. Carty's emphasis on the commercial relevance of control in publicity is indisputable, but the dignitary element of control also remains central to the right. Arguably, her work serves to highlight just how tightly entwined these two interests are. As Beverley-Smith *et al* conclude "an ability to control the commercial exploitation may be seen both as an economic right in maintaining commercial exclusivity and as an aspect of an individual's dignity or autonomy."<sup>45</sup> Control is therefore the lynchpin of both interests.

## 2.2. The Dual Interests in Publicity Practice

These dual dignitarian and economic interests can also be seen in practice. Milligan's case study of David Beckham provides an insight into the world of celebrity branding and publicity practice. By reviewing Beckham's key endorsement deals from the late 1990s to 2003, Milligan assesses what each deal offered Beckham, implicitly revealing the control and management behind each endorsement contract. Beckham appears to have decided which brands to endorse not solely on the basis of the fees offered, but also according to his image and priorities.<sup>46</sup> Thus, whereas Beckham's deal with Brylcreem was "a good launch pad",<sup>47</sup> his subsequent deal with Pepsi was "an ideal commercial opportunity"<sup>48</sup> because "it gave him global distribution... and it sat with his mildly rebellious image".<sup>49</sup> In the case of Police sunglasses the "deal was important in being the first commercial contract that didn't

<sup>45</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 3.

<sup>46</sup> This can be thought of as the difference between the value of the deal (£) and its added value (a good fit with his personal brand).

<sup>47</sup> Milligan, *Brand it Like Beckham*, at 120.

<sup>48</sup> *Ibid.*

<sup>49</sup> *Ibid.*, at 122.

draw on Beckham's image as a footballer, but promoted his looks and fashion sense instead.... In terms of brand building, it was a clever move."<sup>50</sup> The increasing value and scope of these deals provides an insight into the level of control and planning that underlies the commercial exploitation of a celebrity brand. This exploitation demonstrates the need for protection of dignitarian interests, through control and autonomy in managing Beckham's publicity career, as well as the obvious economic interests advanced by these deals.

Evidence in support of these dual interests can also be drawn from two of the paradigm English publicity cases, *Irvine v Talksport*<sup>51</sup> and *Douglas v Hello!*<sup>52</sup> In *Irvine*, "control of the use of [Irvine's] identity in giving endorsements enables him to enhance his image as a racing driver, and that in consequence he charges less for endorsing a fashionable product than an unfashionable one."<sup>53</sup> Control of persona, in itself a dignitarian interest, is also a critical part of future financial gain. *Irvine* also provides us with guidance as to the longer-term implications of unauthorised use. Laddie J was prepared to accept that it "is possible that the damage already done to Mr Irvine may be negligible in direct money terms but the potential long term damage is considerable."<sup>54</sup> Thus, economic harm can be distinguished from non-economic (or dignitarian) harm, and the longer-term consequences of *both* have been judicially recognised.

The Douglases licensed exclusive publication of their wedding photographs for £1million, apparently placing them in the commercial-interest bracket. In the House of Lords, Lord Nicholls noted that "Mr Douglas said his name and likeness are valuable assets to him. It is important for him, for professional reasons, to protect his name and likeness and prevent unauthorised use of either."<sup>55</sup> However, the action against Hello! was primarily for the emotional distress caused. Regardless of the

<sup>50</sup> *Ibid.*, at 105.

<sup>51</sup> [2003] 2 All ER 881.

<sup>52</sup> [2006] QB 125.

<sup>53</sup> *Irvine v Talksport* [2003] 2 All ER 881, para 59.

<sup>54</sup> *Irvine v Talksport* [2002] 1 WLR 2355, para 74, per Laddie J.

<sup>55</sup> *Douglas v Hello!* [2008] 1 AC 1, para 252. Carty refers to this ongoing control as a "collateral concern" in publicity: Carty, "Advertising, publicity rights and English law", at 210.

scepticism of some commentators,<sup>56</sup> it is certainly the case that “whilst the Claimants’ case is now chiefly for money it was not always so and it was not by their choice that it became so.”<sup>57</sup> The action for financial compensation became necessary only when the Douglases’ application for an injunction was refused, indicating that their priority was to prevent publication rather than to recover economic compensation for use of the images. Here, loss of control of their dignitarian interests resulted in a successful claim for compensation for the “real distress” they suffered from the publication of paparazzo photographs which left them “devastated and shocked”.<sup>58</sup> Dignitarian interests and economic interests appear to co-exist for these claimants.

### 2.3. The Economic and Dignitarian Interests in Other Areas of Law

Legal recognition of these interests is not novel, as dignitarian and economic concerns are protected by law in other contexts. Perhaps the closest analogy is with copyright. Here, a statutory right protects an intangible asset, the copyright. The copyright is created by the individual and can frequently be seen as a personal expression of the individual and his creativity. The author’s dignitarian interests are protected by the moral rights granted. These rights, which are inalienable, entitle the author to object, for example, to derogatory treatment and false attribution of the work.<sup>59</sup> The statutory regime also offers protection for the author’s economic interests, as copyright can be exploited for commercial gain through assignation<sup>60</sup> and licensing<sup>61</sup> of the right to copy. Further, the very fact that no-one is entitled to copy the work without the *owner’s*<sup>62</sup> consent<sup>63</sup> arguably recognises the economic and

<sup>56</sup> Their claims in court have been described as “witness-box performances”, indicating that they were perhaps aware of the need to convince the court of this element of personal distress. W Cornish and D Llewellyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 5<sup>th</sup> ed, para 8-59, note 58.

<sup>57</sup> *Douglas v Hello!* [2003] 3 All ER 996, para 10.

<sup>58</sup> *Ibid.*, paras 82-84.

<sup>59</sup> CDPA 1988, ss80-84.

<sup>60</sup> *Ibid.*, s90.

<sup>61</sup> *Ibid.*

<sup>62</sup> It is necessary to distinguish between author (as creator of the work) and owner (who has control of the work, subject to the author’s moral rights).

<sup>63</sup> As per s16 *et seq*, subject to the permitted uses in Chapter III, CDPA 1988.

dignitarian interests of the owner. Whether the work is plastered on every hoarding in the country or left languishing in a cupboard is, to some extent, a matter for the owner, and this choice can be exercised for dignitarian as well as economic reasons.

Contract law similarly enables an individual to further his economic interests and to fulfil his dignitarian interests by living his life in the manner of his choosing, through the control and certainty that derives from enforceable contracts. So too with property rights, which are most commonly equated with economic interests. Thus, the right of ownership enables the owner to use his land or goods in the manner of his choosing, including to make money. However, property rights are also capable of respecting the individual's dignitarian interests. The fact that the law enables an individual to control the use of his possessions or land enables him to make his own choices, thus respecting his autonomy. Indeed, earlier justifications for the recognition of private property were based on notions of respect for the individual and the necessity of some means for him to express his personality.<sup>64</sup>

The interests that would be protected by a publicity right are recognised and protected in other areas of law. There can be nothing controversial *per se* about the protection of (i) economic or commercial interests, looking to realise the value in persona and control its future economic potential; and (ii) dignitarian interests, looking to dignity, autonomy, and control.

## 2.4. Dignitarian and Economic Interests: Mutually Exclusive or Mutually Compatible?

Although there is widespread recognition of both economic and dignitarian interests in publicity, one question is whether a single right of publicity could or should protect *both* the dignitarian and economic elements. This is reminiscent of the debate between monistic and dualistic protection, but must be considered here in

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<sup>64</sup> For an analysis of Lockean and Hegelian justifications for property see for example J Hughes, "The philosophy of intellectual property" (1988) 77 *Georgetown Law Journal* 287 (henceforth Hughes, "The philosophy of intellectual property"); M Radin, "Property and personhood" (1982) 34 *Stanford Law Review* 957; and CB MacPherson, *Property – Mainstream and Critical Positions*, 1978.

light of the different legal systems in the UK. This question arises in English law in part because of the very nature of current protection. Where a celebrity has attempted to shoehorn his claim for infringement of a “publicity right” into a breach of confidence/Article 8 action, concerns arise as to whether this inherently personal privacy-based action should be used to protect what is seen as an economic interest.

This concern was reflected in Lord Walker’s dissenting speech in *Douglas v Hello!*:

it is not obvious why a claimant should be able to invoke the law’s protection for the confidentiality of his or her private life (this claim being based on the high principle of respect for human autonomy and dignity) and also to invoke its protection for the commercial confidentiality of the same or similar material, as a trade secret, until it is to be disclosed for profit at a time of his or her own choosing.<sup>65</sup>

These concerns are legitimate so far as they go. Whilst it is indeed “not obvious” why a legal right designed to protect one set of values should be used to protect others which are apparently “at odds” with them, this does not mean that both types of value can never co-exist. Indeed, the monistic right in German law proves that it is possible for one right to protect both economic and dignitarian interests.<sup>66</sup> And as copyright illustrates, it is possible for both interests to be protected in one legal scheme, where that scheme has been specifically developed to address them.<sup>67</sup> The concern here arguably arises only where there is no such tailored scheme and individuals instead manipulate an existing legal action to meet their needs. This is a valid concern, but it does not mean that no such tailored protection can ever exist. Instead, it could be addressed by the creation of a coherent scheme of publicity rights in law specifically intended to protect the interests involved. This would enable individuals to protect both their economic and dignitarian interests, as appropriate, without attempting to shoehorn a claim for one into an action designed to protect the other.

<sup>65</sup> [2008] 1 AC 1, para 275, per Lord Walker. See also the written submissions, “Case for the Respondents”, para [21], J Price QC, G Fernando, November 2006.

<sup>66</sup> See the analysis of the monistic and dualistic protection in Civilian jurisdictions in Chapter 2, section 2.2.

<sup>67</sup> CDPA 1988.

My conclusion therefore is that the two interests are not mutually exclusive: they are equally relevant and compatible. This reflects the reality of publicity practice: “looking at the problem purely from a commercial appropriation perspective, or from an exclusively dignitary right of privacy perspective, distorts the true picture. Both economic and dignitary interests have to be taken into account.”<sup>68</sup>

### 3. THE COMPETING INTERESTS

Although academic attention has traditionally focused on individuals and unauthorised exploiters, the interests of other parties – such as licensed exploiters and the public in general – can be discerned through some of the arguments made against publicity rights. In fact, two such interests soon become apparent. The first of these is the right to freedom of expression, as embodied in Article 10 ECHR or in the American first amendment right to free speech: “one of the most difficult areas of this body of law is when the right of publicity must be balanced against the free speech concerns of the first amendment.”<sup>69</sup> The second competing interest is that of the creative commons, specifically the commons of cultural imagery. Celebrities derive their meaning from, and contribute meaning to, the cultural tradition, such that “celebrities often cannot be viewed as a separate phenomenon, a discrete item of creativity.”<sup>70</sup> In borrowing from and becoming part of our “cultural commons”,<sup>71</sup> celebrities and their persona become part of the public domain and should arguably be available for others to draw upon, without the restrictions created by a right of publicity. Both these interests will now be examined in more detail.

#### 3.1. Freedom of Expression

Freedom of expression, or free speech, is fundamental in our society. The grant of an enforceable right of publicity could operate to deprive certain parties in certain

<sup>68</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 62.

<sup>69</sup> McCarthy, “Public personas and private property”, at 696.

<sup>70</sup> Carty, “Advertising, publicity rights and English law”, at 252.

<sup>71</sup> *Ibid.*, at 252.

situations of the right to use persona in their own speech or expression, thus curtailing freedom of expression. The two interests are therefore apparently in competition. In assessing the merits of a right of publicity, it becomes necessary to consider the relationship between a private right to control persona and the fundamental right to freedom of expression. The need to strike a balance is recognised by most writers in this area.<sup>72</sup> Even those who support a right of publicity accept the importance of freedom of expression. Goodenough, for example, suggests that it would be wise “to allow unfettered freedom for the expression of information about people on matters of public interest, no matter whose ox it gores, and considerable freedom for the creative use of persona.”<sup>73</sup>

However, free speech does not entail the right to say freely *anything* one wishes.<sup>74</sup> Civil rights and criminal wrongs exist to prevent or deter the making of untruthful statements, by way of defamation and perjury for example, while misrepresentations can be challenged by way of an action for passing off. Yet there is still a grey area to negotiate between a blatant lie and the purest truth; an area of half truths, misleading associations and even silence. For Hughes, the right to freedom of expression should exist only on the truthful side of this divide: “*freedom of expression is meaningless without assurances that the expression will remain unadulterated. Free speech requires that speech be guaranteed some integrity.*”<sup>75</sup> Where the unauthorised use of persona is misleading, we should be slow to protect it through freedom of expression. In *Irvine v Talksport*<sup>76</sup>, for example, the image of Irvine used by Talksport was misleading because it had been doctored. Talksport’s use of Irvine’s image was

<sup>72</sup> One exception is Halpern, who believes that free speech issues are at the “outer edge” of publicity rights, since exploitation of “the hard economic commercial value of an individual’s identity” is primarily commercial. Consequently, free speech issues “have little impact on the avowedly commercial appropriation of identity”: Halpern, “Publicity: Maturation of an independent right”, at 868.

<sup>73</sup> Goodenough, “Re-theorising privacy and publicity”, at 70.

<sup>74</sup> For an analysis of post-HRA case law regarding “insulting” expressions (of controversial religious or political beliefs), see R Reed and J Murdoch, *A Guide to Human Rights Law in Scotland*, 2<sup>nd</sup> ed, 2008 (henceforth Reed and Murdoch, *Human Rights Law in Scotland*), para 7.44; A Geddis, “Free speech martyrs or unreasonable threats to social peace? – “Insulting” expression and section 5 of the Public Order Act 1986” [2004] PL 853.

<sup>75</sup> Hughes, “The philosophy of intellectual property”, at 359, his emphasis, footnote omitted.

<sup>76</sup> [2003] 2 All ER 881.



therefore an adulterated expression which could not, and should not, be protected by a defence of freedom of expression.

The converse of course is that the individual cannot hide behind a publicity right in order to project a misleading persona. This forms the basis of one of Carty's objections to the grant of a publicity right:

the celebrity image may be used as a vehicle for social comment or criticism. Free speech is threatened when the publicity right is seen as allowing the celebrity to impose his "preferred meaning" not allowing different interpretations by others, though those interpretations may be used for powerful social criticism.<sup>77</sup>

This use of persona to project a "preferred meaning" is well illustrated by the case of *Campbell v MGN*,<sup>78</sup> where Campbell's lies regarding her use of drugs were exposed by the defendant newspaper. The need to correct the misleading impression projected by Campbell formed a fundamental part of the Daily Mirror's defence.<sup>79</sup> In doing so, the right to freedom of expression under Article 10 ECHR was balanced against Campbell's rights under Article 8.<sup>80</sup>

The right to freedom of expression is an important interest, which must be weighed against the individual's interests in a publicity right. Any publicity right should be subject to a proportionate restriction arising from the public interest in freedom of expression, although this in turn should be subject to the individual's right to protect persona and interests such as reputation and privacy.

### 3.2. Creative and Communicative Use

The second relevant public interest is the cultural "creative commons". Celebrities are a critical part of the creative commons in popular culture, since "star images are widely used in contemporary American culture to create and communicate meaning

<sup>77</sup> Carty, "Advertising, publicity rights and English law", at 252, footnote omitted.

<sup>78</sup> [2004] 2 AC 457.

<sup>79</sup> Although see Gordley's alternative contention that in some cases a lie to promote virtue is preferable to the honest disclosure of vice. See J Gordley, *Foundations of Private Law: Property, Tort, Contract, Unjust Enrichment*, 2006, at 236.

<sup>80</sup> This balancing process will be discussed in greater detail in Chapter 5.



and identity.”<sup>81</sup> Celebrity images are therefore not simply marks of identity or commodities, but “are constitutive of our cultural heritage”.<sup>82</sup> Use of existing cultural imagery (whether of individuals or otherwise) is at the core of postmodernist music and art, where “pre-existing works and images are consciously and openly appropriated, reworded and recycled.”<sup>83</sup> In this world, celebrities “provide meaningful resources for the construction of identity and community.”<sup>84</sup> Coombe cites a number of examples, including Judy Garland, who “had a special place in gay culture as the symbol gay men used in the pre-Stonewall period to speak to each other about themselves.”<sup>85</sup>

Against this background, the right of publicity “chills commercial, expressive uses of already famous people. In this light, a central challenge of the right of publicity consists in balancing rights in personal identity with the necessity of allowing everyone to dip into a rich common cultural pool.”<sup>86</sup> Madow expresses the concern that a right of publicity (certainly where it is cast as a property right) fails to achieve this balance, and instead transfers this “semiotic value” of celebrity image into private ownership.<sup>87</sup>

To illustrate the damage that this transfer to private ownership would potentially cause, Madow explores the use of celebrity persona to create and communicate meaning, and the resultant conflict between different interest groups:

popular culture remains what it long has been: a struggle for, and over, meaning. It is a contest in which dominant groups try to naturalize the meanings that best serve their interests into the “common sense” and “taste”

<sup>81</sup> Madow, “Private ownership of public image”, at 142; see also discussion at 143; see also Carty’s reference to image as a “vehicle for social comment or criticism”, “Advertising, publicity rights and English law”, at 252.

<sup>82</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 89.

<sup>83</sup> Madow, “Private ownership of public image”, at 198. See also W Gordon, “On owning information: Intellectual property and the restitutionary impulse” (1992) 78 Va L Rev 149 (henceforth Gordon, “On owning information”), at 157-158

<sup>84</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 89.

<sup>85</sup> RJ Coombe, “Publicity rights and political aspiration: Mass culture, gender identity, and democracy” (1991-1992) 26 New Eng L Rev 1221 (henceforth Coombe, “Publicity rights and political aspiration”), at 1256. Other examples provided by Coombe include Madonna, Elvis Presley and (although not directly relevant to this thesis) Star Trek.

<sup>86</sup> de Grandpre, “Understanding the market for celebrity”, at 106. See also Coombe, “Publicity rights and political aspiration”, at 1234.

<sup>87</sup> Madow, “Private ownership of public image”, at 142.

of society as a whole, while subordinate and marginalized groups resist this process with varying degrees of effort and success.<sup>88</sup>

The two groups who are competing to annexe popular culture and impose their own meanings upon it are identified by Madow as the “culture industries” and subcultures. Some of the latter can be “relatively powerless” yet still able to generate meanings to compete with the “dominant ideology”<sup>89</sup> promoted by the culture industries. In this contest it is impossible, Madow argues, for the law to remain neutral: it can act either to

strengthen the already potent grip of the culture industries over the production and circulation of meaning, or it can facilitate popular participation, including participation by subordinate and marginalised groups, in the processes by which meaning is made and communicated.<sup>90</sup>

Creating a legal right over the substance of the cultural commons – the celebrity images which populate it – denies the subordinate groups access to that commons and thereby deprives them of the ability to create and communicate cultural meaning. De Grandpre shares Madow’s concerns “for what he [Madow] perceived to be the courts’ privatization of popular culture through the commodification and appropriation to celebrities of socially constructed meanings.”<sup>91</sup> While the public at large apparently stands to lose, celebrities and the big-business interests of the culture industries appear to gain through such a right.

On this analysis, protection of publicity rights interferes with freedom of expression and creative expression, not least by removing celebrity persona from the “rich pool” of the cultural commons. Given these competing interests against publicity rights, it becomes necessary to seek some factor which will justify favouring one set of interests over the other, that is to say granting the legal right of publicity or withholding it. The remainder of this chapter will explore possible justifications in support of the individual’s interests in publicity rights and address arguments made against them.

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<sup>88</sup> *Ibid.*, at 141.

<sup>89</sup> *Ibid.*, at 141.

<sup>90</sup> *Ibid.*, at 141-142. This emphasises the control exercised by corporations in the intellectual property arena.

<sup>91</sup> de Grandpre, “Understanding the market for celebrity”, at 123.

#### 4. ACCEPTING THREE REBUTTALS OF PUBLICITY RIGHTS

Before turning to justifications in support of publicity rights, it is necessary to acknowledge and reject three arguments which are commonly advanced *in favour* of a right of publicity, but which in fact fail to justify such a right. These are the incentive justification, the labour-desert justification, and the consumer protection justification. In brief, these justifications contend that:

- (i) individuals will not develop valuable identities unless there is an incentive to do so, and legal protection provides that incentive by ensuring that control and the potential for commercial gain is vested in the individual;
- (ii) the individual has laboured to create a valuable persona, and a legal right is the individual's desert or reward for doing so;
- (iii) control by the individual over use of his persona in advertising, merchandising and the media is necessary for public protection, to ensure that consumers are not misled by false advertising or publicity.

Part of the problem with the first two of these arguments is that there is a tendency to confuse the subject matter under review. While the analysis in Chapter 3 showed that the subject matter of protection is persona – name, image, and reputation – these incentive and labour-desert arguments often look to justify protection for the *value* in persona. Instead, as we shall see, the value is a separate consideration which does not affect the existence of the persona (since we all have a persona), nor the recognition of a right of publicity.<sup>92</sup>

Madow's dismissal of the incentive argument is comprehensive. The idea that people will labour for some end only if there is a sufficient incentive, or "some measure of assurance that they will be able to reap what they sow"<sup>93</sup> does not apply in publicity. McCarthy appears to advance this justification, on the basis that even a

<sup>92</sup> As with copyright, where the value of the work may vary enormously, the existence of the copyright, and justifications for it, are not predicated on that value. Instead, the value of the copyright work is relevant when assessing remedies.

<sup>93</sup> Madow, "Private ownership of public image", at 205.

slight inducement enriches us all, but concedes that it is “hypothetical” since the degree of incentive “can probably never be proven either in the abstract or in any particular case.”<sup>94</sup> Madow, however, shows that the incentive justification is severely flawed:

Farmer Brown might give up growing corn and turn to hunting if marauders were free to invade his land and steal his crop. Novelist Brown might give up writing mysteries and turn to investment banking if others were free to copy and sell his books. But will Quarterback Brown give up professional football and his multimillion dollar salary if others are free to use his picture on posters or T-shirts without paying him for the privilege? Not likely.<sup>95</sup>

Vaver also questions the incentive justification on a broader front when he asks whether the incentive of copyright protection has really made any difference to creative output:

Are we sure that much of what the law vigorously protects would not have been created anyway, with no, or at least much less vigorous, protection? In crude terms, would I write less or worse letters or articles if my work was protected for, say, only 10 years? Or even not protected at all?<sup>96</sup>

The need for an incentive is frequently lacking in publicity, and therefore cannot act as a justification for recognition of a legal right.<sup>97</sup> Further, the opportunity to profit from publicity often arises – as Vaver and Madow recognise – regardless of whether or not there is a specific legal right of publicity. There is therefore nothing to be gained from anchoring the grant of a right of publicity to claims that an individual needs such a legal right to act as an incentive to develop his persona.

Closely related to the incentive justification is that of labour-desert, whereby a legal right to exploit persona is seen as the individual’s reward for his labour in creating a valuable persona.<sup>98</sup> An initial point to note is that this justification is also frequently

<sup>94</sup> McCarthy, *The Rights of Publicity and Privacy*, para 2:6. A further weakness is that he accepts that the incentive justification only operates in the case of celebrities, rather than non-famous individuals (para 2:6).

<sup>95</sup> Madow, “Private ownership of public image”, at 210. See also de Grandpre, “Understanding the market for celebrity”, at 102; Carty, “Advertising, publicity rights and English law”, at 251; and Westfall and Landau, who point out that the incentive effect is reduced when celebrities are already wealthy, in “Publicity Rights as Property Rights”, at 119.

<sup>96</sup> D Vaver, “Intellectual property: the state of the art” (2000) 116 LQR 621, at 631.

<sup>97</sup> And even less so for the portion of the right that endures post mortem: see Westfall and Landau, “Publicity Rights as Property Rights”, at 88.

<sup>98</sup> The fact that we are all born with a particular image does not preclude individuals labouring to enhance that image – thus there may well be labour in particular cases.

tied to the value in persona whereas, as mentioned above, publicity rights can arise in any persona, not only valuable ones.

In any event, the labour-desert justification fails to support a publicity right because there is frequently no evidence that the individual has laboured to create his persona.<sup>99</sup> Justifications based on Locke's theory of labour are inappropriate since "[t]he labor justification cannot account for the idea whose inception does not seem to have involved labor".<sup>100</sup> A popular persona is "sometimes the result of hard work towards securing a public image based on an internal vision. But quite often they are creations of pure chance, perhaps the only "intellectual property" without intentionality."<sup>101</sup> Labour may well play a critical role in creating the value in the persona, as demonstrated by industry players such as Milligan: in *Brand it Like Beckham*, he makes very clear reference to the level of labour and effort that goes into creating and maintaining the valuable Beckham brand. For every Beckham, however, it is possible to point to other individuals who have exploited their persona on the back of little or no effort.<sup>102</sup> As Madow suggests, such justifications are "a bit quaint", being tied "normatively and conceptually, to a picture of individual creation and originality, and of self-authorship as well".<sup>103</sup> Further, even for those individuals who do labour at their persona, Madow suggests that their attempts may not succeed in such a direct manner:

No matter how long and conscientiously he "labors" to create and maintain a preferred public image, and no matter how adept and shrewd his advisors and handlers are, he cannot make his persona "mean" precisely and solely what he wants it to mean.<sup>104</sup>

Thus, the value in persona is not always within the individual's control and the product of his labour. While evidence reveals that some individuals do labour very

<sup>99</sup> Coombe notes the distinct lack of empirical data on this point: *The Cultural Life of Intellectual Properties*, at 94 and more generally at 92-100.

<sup>100</sup> Hughes, "The philosophy of intellectual property", at 365.

<sup>101</sup> *Ibid.*, at 341, note 220.

<sup>102</sup> Typical examples are winners of Big Brother, and celebrities such as Paris Hilton, who are commonly said to be "famous for being famous". For US examples, see Coombe, "Publicity rights and political aspiration" at 1229. The Ninth Circuit has noted that celebrities may achieve fame "out of rare ability, dumb luck, or a combination thereof": *White v Samsung Electronic America Inc* 971 F.2d 1395, at 1399.

<sup>103</sup> Madow, "Private ownership of public image", at 198.

<sup>104</sup> *Ibid.*, at 192.

carefully to maximise the appeal of their persona, it is hard to deny that in other instances “[t]he notion that a star’s public image is nothing else than congealed star labour is just the folklore of celebrity, the bedtime story the celebrity industry prefers to tell us and, perhaps, itself.”<sup>105</sup>

Further, the correlation between the labour and the fame is too uncertain and unreliable to operate as a suitable incentive, since there is usually no direct correlation between labour invested and celebrity status. As Madow notes, “Fame does not play fair; it plays favorites”.<sup>106</sup> The economic consequence of this is that “the market structure will often make it nearly impossible for a contestant to assess rationally the marginal revenue of an additional hour of training.”<sup>107</sup>

Another concern is that highlighted by Coombe, amongst others. She points to the “studios, the mass media, public relations agencies, fan clubs, gossip columnists, photographers, hairdressers, body-building coaches, athletic trainers, teachers, screenwriters, ghostwriters, directors, lawyers and doctors”<sup>108</sup> who are all involved in the “creation” of the persona – especially the fame – of celebrities. With reference to Marilyn Monroe, she also assigns some of the credit for persona to the general public.<sup>109</sup>

As this very brief review shows, individual labour may often be present and it may often be extensive, but it need not be. Even where labour can be demonstrated, it does not follow that it was exclusively the labour of the individual in question, nor can it be proven that there is a direct correlation between labour invested and the resulting persona. Labour therefore cannot operate to justify a general right of publicity.<sup>110</sup>

<sup>105</sup> *Ibid.*, at 184.

<sup>106</sup> *Ibid.*, at 189.

<sup>107</sup> de Grandpre, “Understanding the market for celebrity”, at 102.

<sup>108</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 94; endorsed by Beverley-Smith, *The Commercial Appropriation of Personality*, at 295-296. Also Klink, “50 years of publicity in the US”, at 365; Carty, “Advertising, publicity rights and English law”, at 249.

<sup>109</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 94. Also Madow, “Private ownership of public image”, at 193-196; Carty, “Advertising, publicity rights and English law”, at 249.

<sup>110</sup> A detailed analysis of the role of the labour justification in intellectual property in general is provided by Gordon. One of the points she makes in criticising over-reliance on labour as a

Consumer protection justifications on the other hand turn the focus from the individual to the public at large. On this analysis, publicity rights are needed to “protect consumers from deceptive trade practices, especially false representations of endorsement or sponsorship”<sup>111</sup> or to clamp down on “advertisers of dangerous or shoddy products... manipul[at]ing consumers by exploiting powerful celebrity images.”<sup>112</sup> While a publicity right would ensure that all exploitation would be authorised, and therefore not confusing in that regard, Madow disputes the need to introduce a publicity right simply for these purposes. Members of the public are no longer, if they ever were, likely to believe wholeheartedly that a celebrity uses or believes in the product he advertises.<sup>113</sup> Madow also notes that a right of publicity would far exceed the consumer protection function ascribed to it, by applying in a much wider range of situations.<sup>114</sup> A further objection is that protecting consumers is a concern, and therefore a justification, only where they are exposed to *unauthorised* exploitation: in instances where the individual agrees to the use of his persona then there can be no risk of consumer confusion through false or misleading use of persona.<sup>115</sup>

Thus, consumer protection concerns alone cannot justify the creation of a publicity right,<sup>116</sup> and especially not in the case of the positive power to exploit. Where publicity is otherwise justified, however, then its contribution to consumer protection can be seen as an additional advantage. Although consumer protection may be one

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justification is that labour can be destructive as well as constructive: “in the abstract [labour] yields no necessary claim to reward.” Gordon, “On owning information”, at 170.

<sup>111</sup> Madow, “Private ownership of public image”, at 228.

<sup>112</sup> *Ibid.*, at 228. Although consumers are presumably still at risk of such practices where the celebrity *does* consent to use of his persona to promote such shoddy products.

<sup>113</sup> *Ibid.*, at 229, note 478. This is a point also made by Milligan who notes a sea-change in the style and public perception of advertising: “Gone are the days of ‘Hi, I’m Kevin Keegan. Let me tell you why I use Brut.’ The Pepsi ads [featuring Beckham] were far more sophisticated.” *Brand it Like Beckham*, at 122. See also de Grandpre, “Understanding the market for celebrity”, at 89.

<sup>114</sup> Madow, “Private ownership of public image”, at 233.

<sup>115</sup> Although the advertisement itself may still be false or misleading – such practices are regulated through, for example, the Consumer Protection from Unfair Trading Regulations 2008 (SI 2008/1277) or by the Advertising Standards Agency’s Codes of Practice (available online at <http://www.asa.org.uk/asa/codes/>) (accessed 21 June 2008).

<sup>116</sup> McCarthy accepts that the falsity justification operates as a very limited justification of publicity, if at all: *The Rights of Publicity and Privacy*, para 2:8.



consequence of a right of publicity, it should properly be regarded as an incidental benefit rather than a driver for the right.

While each of these justifications may have something to offer in support of a right of publicity, it is clear that they are insufficient as they stand. Other justifications must be sought.

## 5. JUSTIFICATIONS FOR PUBLICITY RIGHTS

### 5.1. Introduction

With the rejection of three commonly-advanced arguments now agreed, we can turn to those justifications which seek to demonstrate that a carefully constructed publicity right can be justified and is certainly desirable, not least when contrasted with the two alternatives: the unsystematic status quo or no right at all.

At the outset, it should be acknowledged that publicity is not a right which is especially easy to justify. It is not a right which is clearly “good” or beneficial: it is not a right which tackles poverty or outlaws torture or makes a notable contribution to scientific endeavour. On the other hand, neither is it a prejudicial or dangerous or oppressive right. It does not promote racial segregation or discrimination against women, for example. A publicity right is, all things considered, a right to regulate a specific practice – and that practice benefits all parties concerned: the individuals who retain control of their persona, while gaining a financial advantage; their commercial exploiters whose custom and reputation is increased; and the populace at large who enjoy the “fun”,<sup>117</sup> colour and human interest that exploitation brings. As McCarthy observes “the human mind is more fascinated by people than by ideas... most of our social conversation concerns people.”<sup>118</sup> A publicity right may not feed

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<sup>117</sup> Carty, who is opposed to a publicity right, accepts that the use of a celebrity in advertising can be fun and eye-catching - “but that is all”: “Advertising, publicity rights and English law”, at 258.

<sup>118</sup> McCarthy, “Public personas and private property”, at 682. He demonstrates this by starting his article with the tale of the dispute between Bette Midler and Ford, to awaken the reader’s interest in the legal issues at stake.



the world, but nor is it intrinsically harmful.<sup>119</sup> This is a useful perspective to maintain throughout this chapter.

The first justification takes a rather pragmatic approach, by recognising the reality of the practice and the uncertainty of the existing unsystematic legal response. The second and third justifications look respectively to the dignitarian and economic interests inherent in publicity, to demonstrate why a right is necessary. Although objections to these justifications have been made, and will be considered below, it is submitted that these are not fatal but instead provide a basis for recognising limitations to a right of publicity. While acknowledging that a right of publicity must be limited by certain counter-interests, these three justifications operate to show that a publicity right is legally and practically desirable.

## 5.2. Ordering the Chaos

Publicity exploitation is something which happens extensively, as was seen in Chapter 3. The available evidence shows that individuals and exploiters treat publicity exploitation as a valid commercial practice like any other. There is a large industry built around brand management, licensing, celebrity endorsement, and public relations. The positive practice of publicity exploitation is alive and well. Conversely, there is also a visible trend of unauthorised use followed by litigation to prevent or recover for this use. The courts have been willing to protect the interests of both the individual<sup>120</sup> and the authorised exploiter.<sup>121</sup> The door to publicity rights protection is therefore ajar, if not wide open.

This can be seen as the logical progression of legal development. De Grandpre, who provides an economic justification for publicity, refers to “the evolution of the right of publicity in the last one hundred years or so, from not being recognized at all, to

<sup>119</sup> See also Westfall and Landau, who state that the right of publicity is “both hard to object to and hard to support”: in “Publicity Rights as Property Rights”, at 121.

<sup>120</sup> In England: *Douglas v Hello!* [2006] QB 125; *Irvine v Talksport Ltd* [2003] 2 All ER 881. In the US: *Midler v Ford Motor Company* 849 F 2d. 460 (9<sup>th</sup> Cir. 1988).

<sup>121</sup> In England: *Douglas v Hello!* [2008] 1 AC 1. In the US: *Haelan Laboratories v Topps Chewing Gum Inc* 202 F 2d 866 (2<sup>nd</sup> Cir 1953).

being recognized as an inalienable personal right, to becoming, in many jurisdictions, a form of property.”<sup>122</sup> The social practice has driven the legal change, and with the increasing practice of publicity comes a crystallisation of the law, as “general principles of fairness and equity... give way, in their maturity, to more certain legal rules.”<sup>123</sup> This need for certainty results in the drawing of

... ever sharper lines around our entitlements so that we can identify the relevant players and so that we can trade instead of getting into confusions and disputes – confusions and disputes that would otherwise only escalate as the goods in question became scarcer and more highly valued.<sup>124</sup>

Although publicity is not tangible, it is potentially exposed to scarcity and exhaustion nonetheless, as will be examined in section 5.4.2 below. Thus, in publicity, as in other areas of law, the evolution of social practice can be seen to drive the evolution of law.

Law as a response to social reality arguably takes us only a limited way towards a justification for publicity. Indeed, some would contend that it does not even achieve that, since reliance on commercial practice alone is on one view “hardly a satisfactory basis on which to analyse the development of the law.”<sup>125</sup> It is certainly the case that other activities are prohibited by law despite the brisk trade and social participation that they generate. The fact that there is supply and demand for cocaine and heroin is, on its own, unlikely to convince the public that these drugs should be legalised. There are of course arguments that legalisation of these drugs would enable more effective control by the government, as some arguably “undesirable” activities (such as the production and sale of alcohol) are licensed to enable them to be regulated. This analogy is not exact, however, since publicity is not obviously socially undesirable in the same manner as drugs, even if the desirability of legal protection is not universally accepted. Nonetheless, it does demonstrate that there must be more to a legal right than the simple fact of social and commercial practice in that area. In the words of Coombe (in the context of property): “the decision to allocate particular property rights is a prior question of social policy that requires

<sup>122</sup> de Grandpre, “Understanding the market for celebrity”, at 78. Also Westfall and Landau, “Publicity Rights as Property Rights”, at 72-74.

<sup>123</sup> de Grandpre, “Understanding the market for celebrity”, at 76.

<sup>124</sup> CM Rose, *Property and Persuasion*, 1994, at 199-200.

<sup>125</sup> Carty, “Advertising, publicity rights and English law”, at 246, footnote omitted.

philosophical and moral deliberations and a consideration of social costs and benefits.”<sup>126</sup>

Consideration of the social costs and benefits follows in sections 5.3 and 5.4 below but, for the present, law’s response to the practice of publicity provides the first justification for a right of publicity. The fact that most legal systems have, so far, recognised a right of publicity through a wide range of causes of action, produces a twin-pronged justification for a clearer, more coherent right.

In the first place, publicity rights do exist in many jurisdictions, and even in those jurisdictions where there is no publicity right, claimants can usually obtain some measure of protection through an amalgam of rights, including registered trade marks, passing off and privacy laws.<sup>127</sup> If the onus is on the “advocates of change” to prove the benefits<sup>128</sup> then this works both ways: not only do those in favour of a right of publicity have to prove why such right is necessary, but those who are opposed to publicity rights have their own justificatory mission, in order to show why these existing rights should be withdrawn altogether. Those who wish to reject publicity entirely must make a case for this.<sup>129</sup> Even Madow, who persuasively argues *against* the justifications for a publicity right, acknowledges this and claims that “[t]here is work to do on the other side of the question as well. A definite argument for the outright abolition of the right of publicity cannot be made on the present state of the record.”<sup>130</sup> It is not sufficient to do this simply on the grounds that the existing method of protection is inappropriate for the task of protecting publicity. For example, many English commentators argue that passing off is not suited to protect publicity interests.<sup>131</sup> I would agree with this assertion, but not with the subsequent

<sup>126</sup> Coombe, “Author/izing the celebrity”, at 368.

<sup>127</sup> As for example in England. See Chapters 2 and 3.

<sup>128</sup> As advocated by the Adelphi Charter, adopted by the Royal Society for the Arts, 13 October 2005.

<sup>129</sup> Westfall and Landau note that the critics of publicity rights are “good at tearing down positive arguments for the right of publicity, [but] they are not nearly as good at building their own positive case against those rights.” “Publicity Rights as Property Rights”, at 121.

<sup>130</sup> Madow, “Private ownership of public image”, at 239.

<sup>131</sup> Leading critics of this use of passing off are Beverley-Smith *et al*, *Privacy, Property and Personality*, at 15-34 and Carty, “Advertising, publicity rights and English law”, at 235-237, but note her acceptance of the use of passing off where “real endorsement is being misrepresented in the advertising”, at 258. At the Fordham Intellectual Property Conference, 28 March 2008, Professor

claim that rejecting passing off (or any other specified doctrine) as a home for some element of publicity rights equates to the rejection of publicity rights in all circumstances. Rejecting a specific doctrine does not equate to rejecting the underlying premise of protecting publicity rights. It is therefore not sufficient for critics of publicity rights to challenge them on the basis that the current method of protection is inappropriate: legal protection *per se* must be addressed.

Closely allied to this is the second prong of this justification. Both proponents and opponents of publicity rights point to the typically chaotic and incoherent nature of current publicity protection. The current UK and US approaches – the latter reliant on a wide range of state legislation, case law, federal jurisprudence, tort and unfair competition restatements – are certainly not an ideal coherent whole. The protection for publicity rights in the US is not necessarily to be envied or emulated.

Yet this does not mean that publicity rights could never have such coherence. Although some critics use the unsystematic or chaotic nature of legal protection as an argument to reject publicity rights in principle,<sup>132</sup> the opposite conclusion is at least equally valid. Instead of being advanced as an argument *against* publicity rights, these concerns of chaos and incoherence can be seen as an argument *for* a publicity right. The dangers of allowing rights to develop through *ad hoc* litigation, as is currently the case in the UK, and the advantages of strategic and deliberate legislative development are demonstrated by Hughes in his consideration of intellectual property in general:

There is a very simple reason why the legal doctrines of unfair competition and trade secret protection are inherently oriented toward the value-added theory: they are court-created doctrines and people rarely go to court unless something valuable is at stake. *When intellectual property is created more systematically, such as through legislation, the resulting property doctrines seem less singularly oriented toward rewarding social value.*<sup>133</sup>

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Laddie stated in person that he viewed *Irvine* as a straightforward passing off case and that it did not involve issues of publicity (a right with which he disagreed).

<sup>132</sup> A stance adopted by Professor Lionel Bently, for example, at the Fordham Intellectual Property Conference, 28 March 2008, in response to a paper I gave advocating recognition of a publicity right.

<sup>133</sup> Hughes, “The philosophy of intellectual property”, at 306, emphasis added.

Any rejection of publicity rights based on its incoherent development to date can be countered by advocating the advantages of legislation. Criticism of the *status quo* should not result in the automatic rejection of publicity rights as a whole.

It is possible to advance a counter-argument, by claiming that the rationalisation of the existing *ad hoc* protection through legislation only holds good where there is a prior justification in favour of a statutory right. However, this argument is capable of working equally for and against statutory protection: the chaos and incoherence of *ad hoc* measures cannot be advanced as a ground for abolishing any such right(s) without a prior justification for the abolition either.

The reality is that publicity practice – and legal acceptance of that practice – is a feature of life. This operates as a justificatory sword *and* shield. The internal incoherence of that “right”, or series of rights, demonstrates just why a single, purpose-built right is needed, thereby attacking the status quo. But the current practice also shields publicity rights from opponents who wish to cut it down altogether, since they too must provide a justification for such a course of action.

This rather pragmatic justification, based on the need to impose some order on the incoherence that is existing publicity rights protection, is supported by two substantive justifications, which appeal to dignitarian and economic considerations.

### 5.3. The Dignitarian Rationale for Publicity

The second justification in favour of a right of publicity is based upon fundamental notions of autonomy and dignity which are inherent to each individual, coupled with the fact that publicity rights enable control of persona, which is also inherent to each individual.

### 5.3.1. *Autonomy and Dignity*

Autonomy is the notion that individuals should be free to make their own life choices, with as little regulation from external sources as possible, subject to the need for each individual to respect the self-respect and bodily integrity of others.<sup>134</sup> The exercise of autonomy enables each individual to take responsibility for his own life choices and pursuit of the “good life”.<sup>135</sup> Such is the importance of autonomy in the Western legal tradition that MacCormick says “[i]f there is any fundamental moral value, that of respect for persons as autonomous agents seems the best candidate for that position.”<sup>136</sup> The role of law is, in part, “to prevent the violation of a citizen’s autonomy, dignity and self-esteem.”<sup>137</sup>

In fact, MacCormick argues that the fundamental human right to privacy is based on the prior acceptance of individual autonomy: “the value upon which privacy rests is, surely, the value of autonomy in shaping a personal, as distinct from a public, dimension of one’s life. The wrong of intrusion is the wrong of infringing that aspect of an individual’s autonomy contrary to his wish and without his permission.”<sup>138</sup> This argument is made in the context of privacy, and it is not my intention to predicate a right of publicity on a prior right of privacy. Nonetheless, the recognition of autonomy as the principle underlying privacy, and its importance in enabling the individual to control that right of privacy together with recognition of the corresponding wrong done by unauthorised intrusion, is of relevance when justifying a right of publicity, as will be examined below.

Alongside autonomy, and complementing it, is the notion of dignity.<sup>139</sup> The right to autonomy is seen as contributing to an individual’s dignity:

<sup>134</sup> And also (although of less relevance in this context) to avoid causing damage to public institutions. See MacCormick, *Legal Right and Social Democracy*, at 37.

<sup>135</sup> See MacCormick, *Institutions of Law*, chapter 14, especially at 249.

<sup>136</sup> MacCormick, *Legal Right and Social Democracy*, at 35.

<sup>137</sup> *Mosley v News Group Newspapers Ltd* [2008] EWHC 1777 (QB), para 7.

<sup>138</sup> MacCormick, *Legal Right and Social Democracy*, at 178. See also *Campbell v MGN* [2004] 2 AC 457, para 51, per Lord Hoffmann.

<sup>139</sup> Oliver identifies five key values which she claims underlie both public and private law, as being dignity, autonomy, respect, status and security: D Oliver, “The Underlying Values of Public and Private Law”, in M Taggart (ed), *The Province of Administrative Law*, 1997, at 218.

The right to make one's own decisions about many aspects of one's fate, and to contribute to decisions made by others which affect one's life can be seen as a major contribution to an individual's dignity, likening the notion [of dignity] to a Kantian perspective on morality.<sup>140</sup>

In this way, dignity works to “bolster individual freedom by making it desirable to enhance autonomy and moral integrity or to provide social and political rights to an infrastructure which enables people to live in a dignified way.”<sup>141</sup>

The correlation between autonomy and dignity – and their fundamental place in our society – gains further support from Article 8 ECHR, which states that “[e]veryone shall have respect for his private and family life, his home and correspondence.” Eady J recently affirmed the correlation between privacy and dignity in *Mosley v News Group Newspapers Ltd*, wherein he held that the infringement of Mosley's privacy by the *News of the World* “has taken away or undermined the right of another – in this case taken away a person's dignity and struck at the core of his personality.” As Moreham argues, the Convention jurisprudence on Article 8 reveals five sub-categories of private life interest and one of these is the “right to live autonomously”.<sup>142</sup> Although Moreham's focus is on infringement of autonomy and personal freedom in sexual and familial relationships and medical treatment,<sup>143</sup> she recognises that “all interferences with private life will affect autonomy to some extent”.<sup>144</sup> Thus, anything which interferes with my autonomy interferes with my right to respect for my private life and, indeed, with other rights guaranteed by the ECHR.<sup>145</sup>

<sup>140</sup> D Feldman, “Human dignity as a legal value: Part 1” [1999] PL 682, at 685.

<sup>141</sup> *Ibid.*

<sup>142</sup> NA Moreham, “The right to respect for private life in the European Convention on Human Rights: a re-examination” [2008] EHRLR 44 (henceforth Moreham, “Respect for private life”), at 71.

<sup>143</sup> For further detail on personal autonomy in the context of medical treatment, see K Mason and G Laurie “Personal autonomy and the right to treatment” (2005) Vol 9 Edin LR 123; G Laurie, “Personality, Privacy and Autonomy in Medical Law”, in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009.

<sup>144</sup> Moreham, “The right to respect for private life”, at 71.

<sup>145</sup> This interpretation is echoed in Feldman's analysis of dignity in the context of human rights, where he notes that Article 8 is as much about protecting autonomy as dignity, but that this affords indirect protection for dignity. See D Feldman, “Human dignity as a legal value: Part 1” [1999] PL 682, at 694.



Respect for autonomy is not restricted to human rights: it affects every area of life. Radin assesses the relationship between property and personhood, in particular in relation to objects so “closely related to one’s personhood [that] its loss causes pain that cannot be relieved by the object’s replacement.”<sup>146</sup> Objects which fall into this class “could be described as simply a category of property for personal autonomy or liberty.”<sup>147</sup> Although she goes on to develop this theory in much greater detail than can be related here, her starting point is worth noting, whereby individuals can become connected with the external world through being bound up with external “things” which “they feel are almost part of themselves.”<sup>148</sup> Property can therefore be a very necessary expression of an individual’s autonomy and dignity.

However, autonomy is not sacrosanct: not all interferences with the exercise of autonomy will be prohibited. In some cases there may be a valid (albeit potentially paternalistic) restriction on individual actions, in order to protect the interests of other individuals or society in general.<sup>149</sup> A good example of this is the French ban on dwarf-throwing competitions, because “it was an affront to human dignity to put on a spectacle devoted to allowing spectators to throw a person selected by reason of his suffering from a physical handicap”.<sup>150</sup> The need to respect the human dignity (of society in general) was given priority over the interests of the dwarf in question, who was in fact keen to participate in such competitions in order to make a living. Accordingly, dignity here was placed “above the freedom of an individual member of the group to choose how to exploit his or her physical form.”<sup>151</sup> Objective conceptions of dignity can therefore be used as a ground on which to interfere with the exercise of (possibly subjective standards<sup>152</sup> of) personal autonomy.

<sup>146</sup> M Radin, “Property and personhood” (1982) 34 Stanford Law Review 957, at 959.

<sup>147</sup> *Ibid.* at 960.

<sup>148</sup> *Ibid.* at 959.

<sup>149</sup> See for example MacCormick, *Legal Right and Social Democracy*, at chapters 2 and 9.

<sup>150</sup> D Feldman, “Human dignity as a legal value: Part 1” [1999] PL 682, at 701.

<sup>151</sup> *Ibid.*

<sup>152</sup> For example, Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.11.



### 5.3.2. *Autonomy and Dignity in the Context of Publicity*

How does this understanding of autonomy and dignity apply to publicity rights? Central to the exercise of autonomy and dignity are the notions of personal choice and control, and these are the very notions which are jeopardised where there is no right of publicity. Lacking a right of publicity, an individual can attempt to control when and where his persona – his very identity – is used, and by whom, but there is no certainty of success. Coombe acknowledges the fundamental connection between an individual and his persona, whereby individuals “never lose their autonomy from the objects that circulate in their likeness.”<sup>153</sup> Critically, lack of control makes it difficult to prevent unauthorised or unsought use of persona. It is the *unsought* intrusion which MacCormick identifies (above) as the heart of intrusion into privacy, and there seems to be no reason for reaching a different conclusion in the case of publicity. Thus, autonomy and dignity operate to justify a right for each individual to control use of persona.<sup>154</sup>

Control, and thus autonomy, lies at the heart of McCarthy’s justification of a publicity right:

the [justification] that appeals the most to me is the simplest and most obvious. It is the natural right of property justification. It is an appeal to first principles of justice. *Each and every human being should be given control over the commercial use of his or her identity.* Perhaps nothing is so strongly intuited as the notion that my identity is mine – it is my property, to control as I see fit. Put simply, my identity is “me”. The existence of a legal right to control identity would seem to be essential to any civilized society.<sup>155</sup>

This is a powerful and emotive argument, and underlies the “natural rights of property” school of thought. I am not seeking to advocate a natural right of property for publicity however: whether or not property is indeed the most appropriate legal classification will be examined in Chapter 6. Nonetheless, as the added emphasis in

<sup>153</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 102.

<sup>154</sup> Interestingly, Carty’s main objection to this justification is that it is “not part of the Anglo-American tradition” – an objection which loses much of its force in the mixed Common/Civilian jurisdiction of Scots law. Carty, “Advertising, publicity rights and English law”, at 250.

<sup>155</sup> McCarthy, “Public personas and private property”, at 685, emphasis added. See also *The Rights of Publicity and Privacy*, para 2:5, where he repeats this and adds that, if this control is denied, then “the law is an ass”. (Quoting Dickens, *Oliver Twist*.)

the above quotation shows, McCarthy identifies *control of identity* as the core notion to be protected, and this is inherent in the rights to autonomy and dignity.<sup>156</sup>

McCarthy's justification is made in the context of a Common law jurisdiction, and there is likewise evidence of the primacy of the individual and personal choice in Civilian jurisdictions. Neethling starts his review of personality rights by noting that they "recognize a person as a physical and spiritual-moral being and guarantee his enjoyment of his own sense of existence."<sup>157</sup> In the context of German law, Beverley-Smith *et al* explain that §823 I BGB, which protects absolute subjective personality rights,<sup>158</sup> is "based on a theory of subjective rights which has its roots in the legal philosophy of Immanuel Kant and the legal theory of Savigny: subjective rights delimit certain spheres in which each individual can act according to his or her free will."<sup>159</sup>

Further, the protection of autonomy and dignity can be seen clearly in the protection of other intangible attributes of personhood: one's beliefs, emotions and relationships, and education. These are attributes that Western legal systems – both Civilian and Common law – are committed to protecting, and they all enable autonomous action and self-determination. Article 8 (respect for family and private life), Article 9 (right to freedom of thought, conscience and religion), and Article 2, Protocol I (right to education) ECHR guarantee these intangible aspects of an individual.

An analogy can also be drawn between *persona* and the *tangible* aspects of each individual. Just as my hands and kidneys are mine to control,<sup>160</sup> so is my *persona*.

<sup>156</sup> This argument is also made by O Weber, "Human dignity and the commercial appropriation of personality: towards a cosmopolitan consensus in publicity rights?" (2004) 1:1 SCRIPT-ed 160.

<sup>157</sup> Neethling, "Personality Rights", at 530.

<sup>158</sup> Comprising the rights to life, body, health, freedom, property or "any other right of another person". See §823 I BGB and the analysis thereof in Beverley-Smith *et al*, *Privacy, Property and Personality*, at 97.

<sup>159</sup> *Ibid.*, at 97, footnote omitted.

<sup>160</sup> At least, this is certainly the case while they are still attached to me and I am still alive. (For discussion as to ownership after severance, see NR Whitty, "Rights of personality, property rights and the human body in Scots law" (2005) 9 Edin LR 194.) Whether *persona* can be separated and whether it can survive post mortem will be examined in Chapters 6 and 7.

Although this raises the spectre of ownership of the body and body parts,<sup>161</sup> it can in fact be addressed without resolving this complex moral and ethical question. Whether or not I can truly be said to “own” my hands or my kidneys does not detract from the fundamental principle that no-one else has any better right to control what I do with them than I do. My right to dignity and autonomous action necessitates that I have control over my hands and my kidneys, and my body in general. Thus, whether hands or kidneys are susceptible to ownership does not need to be definitively answered to be able to answer the primary question: who controls them? I do.<sup>162</sup>

Not only do autonomy and dignity require each individual to have control of his life and his life choices, but they also illustrate the harm caused when that right to control is denied, unless there is a legitimate reason for such denial, as in the case of the dwarf-throwing competition. Whether or not such good reasons exist in cases of publicity will be considered in section 7 below. The present examination will focus on the consequences of denying the individual the right to control the use of his persona.

### **5.3.3. Denial of Autonomy and Dignity in Publicity**

Where an individual is unable to control the use of his persona, it impacts on both his negative right to prevent use and his positive power to exploit his persona. Since there is no right for the individual to give or withhold such consent, persona becomes freely available for use by others,<sup>163</sup> without the need to seek the consent of the individual.

Yet a specific wrong occurs where the individual’s persona is used without his consent. Spence analyses the consequences of unpermitted use of a trader’s brand

<sup>161</sup> See further Chapter 6, section 4.2.1.

<sup>162</sup> Although slavery has existed in different societies at different times, thereby showing that “ownership” and control of one’s body *can* be asserted by another person, in the twenty-first century it is non-controversial to assert that the only person who *should* control the use of a body is that individual himself. This is enshrined in Article 4(1) ECHR: “No one shall be held in slavery or servitude.”

<sup>163</sup> MacCormick, *Institutions of Law*, at 126. See also Chapter 6, sections 3.2 and 3.3.

name in the context of passing off.<sup>164</sup> Although the current discussion does not focus on use of corporate identity in passing off, the points he makes hold good. The starting point for Spence's argument is that where a company uses a rival trader's brand without the consent of that trader, it is making an untruthful representation and "a community that claims to value truthfulness, must be reluctant to allow one party to suffer harm, or indeed another party to benefit, as a consequence of an untruthful statement."<sup>165</sup>

In a passionate claim, Spence emphasises the attack on autonomy that results where unauthorised (and therefore "untruthful") use is made of the rival brand, such that it becomes a mask that is used by the unauthorised exploiter:

The maintenance of a society of autonomous persons must involve at least some prevention of others, unauthorised, speaking on their behalf. In this way, the wrong in passing off not only parallels the wrong in plagiarism, it also somehow parallels the wrong in torture. As De Grazia has pointed out, one of the wrongs involved in torture is the appropriation of another's voice, the unauthorised assumption of the right to speak on his behalf. It is arguably precisely this right that is involved when one trader claims to speak through the identity of even a corporate rival.<sup>166</sup>

The claim here is that just as torture is used to subjugate the voice of the victim to that of the torturer, so the unauthorised use of the brand suppresses the brand owner's voice and imposes upon his brand the voice or "message" of the unauthorised user.<sup>167</sup>

What is particularly interesting about Spence's argument is that it is made in the context of one company passing itself off as another *juristic* person, yet it can be applied to the use of an individual's brand – his persona – as well. Where this happens, the individual has lost control of his persona and thus his autonomy is infringed, because his persona is used to convey the message of another party without his consent or control. Further, although passing off is traditionally seen as an action to protect the economic interests of the trader, Spence's arguments here

<sup>164</sup> M Spence, "Passing off and the misappropriation of valuable intangibles" (1996) 112 LQR 472 (henceforth Spence, "Passing off and the misappropriation of valuable intangibles").

<sup>165</sup> *Ibid.*, at 497.

<sup>166</sup> *Ibid.*, at 498.

<sup>167</sup> McCarthy refers to a similar analogy drawn by Justice Cobb, whereby the unauthorised use of image enslaves the individual: his loss of control means he is no longer free. *The Rights of Publicity and Privacy*, para 2:5, and references therein.

reveal the dignitarian interests that are also present in a misrepresentation of the company through misuse of its trade mark. These arguments, made in the context of passing off disputes between companies, arguably apply with even greater force in the case of publicity rights, where the subject of the misrepresentation is a natural person whose very identity is being abused and misappropriated.

Nonetheless, it is difficult to accept that, at a practical level at least, there is much in common between Eddie Irvine and victims of torture throughout the world. While the analogy between torture and passing off put forward by Spence is thought-provoking, it is arguably too extreme to command much sympathy in this context. Its underlying message can instead be applied through a less emotive analogy.

The real harm done in such cases, Spence argues, is the unauthorised use, and consequent suppression, of someone else's voice. This results in harm both to the individual, or company, and to the society which receives the "untruthful" message. A similar, yet less extreme, analogy for the suppression of voice and subsequent harm can be found in the right to vote. This is an intangible right of every adult, and is recognised as fundamental in a democratic society. The unauthorised "use" of someone else's vote would deprive that individual of his voice in a democratic society and be an affront to his autonomy. If an individual's vote were to be commandeered or confiscated, harm would be done to the individual and to the wider society and the process of democracy. Not only would the individual have lost his voice and, consequently, his ability to speak on his own behalf and his autonomy, but society's interest in truthfulness (and democracy) would also be tarnished if it failed to stop the misuse.

The association of identity with truthful communication which underlies Spence's argument can also be found in the Civilian right to identity. Neethling defines the right to identity as arising from a person's "uniqueness which individualizes him as a particular person and this distinguishes him from others... A person's identity is infringed by falsification, i.e. where indicia are used in a way which cannot be

reconciled with his true identity.”<sup>168</sup> Although the identity right which Neethling is discussing is a personal, non-patrimonial right, the importance of the right of the individual to prevent false use is evident here.

This concept of using persona to deceive can also be found in Logeais’ analysis of the French image right. She states:

fame is best conveyed through the name or picture which are inherent to the person and therefore their use or perfect imitation makes identification certain. *Because these intrinsic “marks” are so personal and inseparable from the person, their use implies some necessary deliberate involvement of the person, that is, the likelihood of deception or implied endorsement, unless the use is too blatantly inconsistent with their status or position to imply a likely consent on the part of the celebrity.*<sup>169</sup>

This echoes Spence’s concern that, unless the use is blatantly false, it is potentially deceptive and harmful to society and to the individual. Even Madow accepts that use which *does* constitute a misrepresentation is not to be permitted, since he argues (in the context of a specific example) that the actor Robert Young cannot “cry foul when someone markets a T-shirt emblazoned with his smiling, benign face and the slogan “Father Knows Nothing” – *provided, of course, it is clear to consumers that Young himself has neither approved nor sponsored the product.*”<sup>170</sup> Thus, Madow appears to concede that use which is misrepresentative, and purports to use the individual’s persona – his “voice” – where there has been no consent, should not be permitted. However, where there is no misrepresentation then, on this analysis, we should be slower to accept that there is a problem. One situation where Madow would contend that there is no misrepresentation would be where the publicity use is “blatantly inconsistent” with the individual’s status. This might arise in some cases of subversive or parodic cultural communication, discussed in section 3 above as one of the competing interests to the individual’s interests in persona.

Madow also questions the contention that celebrities suffer dignitarian harm from the unauthorised use of their persona where they actively seek publicity. Whereas unknown individuals could legitimately protest at unwanted publicity:

<sup>168</sup> Neethling, “Personality Rights”, at 540.

<sup>169</sup> Logeais, “The French right to one’s image”, at 169, emphasis added.

<sup>170</sup> Madow, “Private ownership of public image”, at 200, emphasis added.

Claims of such emotional injury were not nearly as convincing when they came from celebrities, however. After all, how could a movie star or professional athlete, who had deliberately and energetically sought the limelight, complain of embarrassment or hurt feelings when an advertiser or merchandiser simply gave his face some *additional* publicity?<sup>171</sup>

Yet this is contradicted by the evidence of celebrities such as Irvine and the Douglases, already noted in section 2 above. Even if allowance is made for the possibly strategic motivations of the parties in asserting this dignitarian distress, it does seem unlikely that there will never be embarrassment or distress. Furthermore, such reaction is deeply subjective, and it is difficult to legislate for this. Although not all celebrities will be embarrassed on all occasions, we should not rule out the potential for such emotional distress and dignitarian harm.

The right to control use of persona is essential in any society which professes to respect dignity and autonomy. Failure to protect this harms the individual and society as a whole.

#### **5.3.4. *Autonomy and Dignity in the Economic Interest***

Although this justification relies on fundamental notions of each individual's personhood, and innate rights, it should not be taken to limit a right of publicity to protection of dignitarian interests. Protection of autonomy and dignity enables control of economic as well as dignitarian interests.

This stance contrasts with Madow's, for example. As shown in the previous section, he is prepared to accept that justifications based on personal interests could operate to justify a publicity right, but declines to consider them, since they "can at most, I think, justify a *personal* right against certain kinds of unauthorized commercial appropriation."<sup>172</sup> Madow's primary reason for reaching this conclusion appears to be that the damage done to interests such as dignity is not damage to the individual's

<sup>171</sup> *Ibid.*, at 168-169.

<sup>172</sup> *Ibid.*, at 181, note 271, emphasis in the original.



wallet, or economic interests, “but to her interest in not being misrepresented or cast in an offensive “false light.””<sup>173</sup>

However, it is not obvious that the economic and dignitarian interests can be so clearly separated. As discussed in section 2 above, they are parts of the same whole, and that whole is the individual’s persona. Where there is control there can be exploitation (for profit or otherwise) as well as the right of non-exploitation. To some extent, this is the same as the basis for employment. Where an individual has the right to control the use of his hands and intellect, he can choose to exploit them commercially by seeking employment, and he has control over the nature of that employment. No other private party<sup>174</sup> has the right to control the individual’s choice of employment or unemployment, and whether the individual chooses to pursue the highest salary, the most rewarding career, or the most interesting lifestyle is a matter for the individual. It does not make sense to say that where the individual controls his body and intellect for the purposes of a career which meets his dignitarian interests then that control will be respected, but not where he chooses to exercise that control for the economic rewards that employment brings. Further, economically- and emotionally-fulfilling careers are not mutually exclusive, and this also applies to publicity rights. The ability to control the use of my persona – to publish in OK! instead of Hello! – may be as rewarding to my dignitarian as to my economic interests. The fact that both OK! and Hello! offered the Douglases the same fee suggests that there was indeed an additional, non-monetary, deciding factor between the two magazines: a dignitarian factor, perhaps? Support for the protection of dignity and autonomy in an economic context can also be drawn from the Restatement of the Law on Unfair Competition, 3d, which focuses on the commercial value in identity and states that “[l]ike the right of privacy, the right of publicity protects an individual’s interest in personal dignity and autonomy.”<sup>175</sup>

<sup>173</sup> *Ibid.*, at 182, note 271.

<sup>174</sup> Article 4(3) ECHR does recognise that the state may impose work on an individual in the course of detention or as part of compulsory military service (or, for conscientious objectors, as an alternative to that military service).

<sup>175</sup> American Law Institute’s Restatement of the Law, Unfair Competition, 3d, chapter 4, para 46.



### 5.3.5. Summary

Respect for autonomy and dignity are two principles at the heart of our legal tradition, and reflect the importance of allowing each individual to make his own life choices and pursue his own concept of the morally good life. In the context of publicity rights, autonomy and dignity require that each individual has control over something as inherently personal and inseparable as persona.

The denial of a right of publicity therefore interferes with autonomy and dignity in two ways, reflecting the positive and negative aspects of publicity identified in Chapter 3. In the first place, the individual loses the certainty of control in cases of self-exploitation of persona. While it is always open to the individual to enter into contracts for exploitation of persona, the legal right behind such agreements remains uncertain, absent a recognised publicity right.<sup>176</sup> Secondly, the lack of a right effectively places each individual's persona in the public domain, where it can be used by anyone, without seeking the consent of the individual. As Spence shows, the misrepresentation that arises from use of an individual's persona – his “voice” – without his consent harms society as well as the individual, not least because of the infringement of the individual's autonomy and dignity. However, it would be erroneous to conclude that a justification based on autonomy and dignity can only justify use of persona in a dignitarian context. As was shown, the right to control persona results in protection for the individual's economic interests as well as his dignitarian interests.

### 5.4. The Economic Rationale for Publicity

In addition to the dignitarian justification considered above, two separate, but mutually re-enforcing, arguments can be made to show why a right of publicity is also necessary on economic grounds. The first draws on considerations of economic efficiency, while the second relates to the benefits derived from striking a balance

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<sup>176</sup> See Chapter 6, section 3.1.

between private rights and the public domain. This economic rationale constitutes the third justification to be advanced in favour of a publicity right.

#### **5.4.1. Economic Efficiency**

This justification is predicated on the argument that the practice of publicity is economically and socially valuable, and that formalised legal protection will enhance these values through certainty and order, to ensure the maximum utility of persona. Economic arguments in the context of intellectual property were most famously advanced by Posner.<sup>177</sup> However, they have been applied to publicity by Grady<sup>178</sup> and de Grandpre,<sup>179</sup> in two key articles which show why a right of publicity is justified on economic grounds.<sup>180</sup> In the words of Grady:

Under the theory presented in this article, the right of publicity is needed to ensure that publicity assets are not wasted by a scramble to use them up as quickly as possible. The right of publicity privatizes a public good (in publicity) and thus encourages a more sensible use of this type of social asset.<sup>181</sup>

This is akin to the tragedy of the (traditional) commons, whereby the scramble to use resources adversely impacts on their long-term availability. The first challenge for this justification therefore is to identify the “social asset” or “public good” that will be protected from such over-consumption through a publicity right, and the second is to assess whether over-consumption of this asset is likely.

In respect of the first question, the social asset to be protected is persona. As discussed in Chapters 2 and 3, persona is valuable for the “eyeball appeal” it engenders and the economic value of that appeal. It is also socially valuable, for the

<sup>177</sup> See for example, WM Landes and R Posner, “An economic analysis of copyright law” (1989) 18 *Journal of Legal Studies* 325; R Posner “Trademark law: An economic perspective” (1987) 30 *Journal of Law and Economics* 265; and more generally, R Posner, *Economic Analysis of Law*, 7<sup>th</sup> ed, 2007, particularly para 3.3.

<sup>178</sup> Grady, “A positive economic theory of the right of publicity”.

<sup>179</sup> de Grandpre, “Understanding the market for celebrity”.

<sup>180</sup> McCarthy also discusses the economic justification for publicity, drawing heavily on Grady’s work, amongst others. He concludes that “[t]o many people, the economic justification for a right of publicity... is of marginal persuasiveness... But to those who demand rigorous social utility logic, the economic justification may be just their cup of tea.” *The Rights of Publicity and Privacy*, para 2:7. Since McCarthy’s analysis largely rehearses the works of others, it will not form the primary focus of this review.

<sup>181</sup> Grady, “A positive economic theory of the right of publicity”, at 98.

central role that persona plays in our cultural commons, both through the creation and communication of meaning<sup>182</sup> and by the addition of common human interest.<sup>183</sup> Given the extensive social and commercial use of celebrity persona by corporations and by the public, they are correctly regarded by Grady as “socially valuable publicity assets.”<sup>184</sup> The available evidence also suggests that such exploitation is not limited to celebrity persona.<sup>185</sup>

The second question, regarding the likelihood of over-consumption, requires more detailed analysis.

#### **5.4.2. Over-Consumption Leading to Tragedy?**

Just as fish can be safeguarded by requiring a licence to fish, Grady argues that a “legal right of publicity can be understood as a fishing license designed to avoid races that would use up reputations too quickly.”<sup>186</sup> Whereas uncontrolled public use of persona would lead to this exhaustion, a right for the individual to control such use would minimise this risk. Evidence in support of this can be drawn from Milligan’s comparison between George Best and David Beckham. Milligan shows that, even lacking a formal legal right, Beckham’s greater awareness of the need for management of image has successfully avoided Best’s rapid burnout of the value and meaning in his image through overexposure.<sup>187</sup>

Madow, however, challenges this notion of the tragedy of the commons as applied to individuals. He concludes that there is no comparable limited commons which could be exhausted: advertisers will always be able to find a new celebrity or individual to promote their goods. Thus, in Madow’s words “there would be no “tragedy” in the classic parable if the herdsman, after depleting their common pasture, could simply

<sup>182</sup> See section 3.2 and Madow, “Private ownership of public image”, at 143-145; de Grandpre, “Understanding the market for celebrity”, at 96 and 123; Coombe, *The Cultural Life of Intellectual Properties*, and “Author/izing the celebrity”.

<sup>183</sup> See section 3.2, and McCarthy, “Public personas and private property”, at 682-683; Carty, “Advertising, publicity rights and English law”, at 258.

<sup>184</sup> Grady, “A positive economic theory of the right of publicity”, at 126.

<sup>185</sup> See for example Chapters 2 and 3 and Appendix C.

<sup>186</sup> Grady, “A positive economic theory of the right of publicity”, at 103.

<sup>187</sup> Milligan, *Brand it Like Beckham*, at 61-63.

move on to another one.”<sup>188</sup> Celebrities act as “pastures” for the herdsmen advertisers and publishers, and the grazing public can be moved from one pasture to another, with no limitation or depletion of the herdsmen’s supply. Given the limitless number of celebrities and individuals in general, there would seem to be no risk of exhaustion – and, in any event, Madow asks whether exhaustion of *all* the available celebrities would be any cause for concern.<sup>189</sup>

Yet this approach is open to challenge. In the first place, Madow queries whether total exhaustion of all available celebrities would be problematic, since “the promotional values”<sup>190</sup> attaching to celebrities could be replaced by “the myriad other techniques”<sup>191</sup> currently used by advertisers to attract attention. However, he does not address the loss to the public arising from such over-exhaustion. He himself has drawn attention to the valuable social role played by persona, in allowing the communication of meaning in social and cultural contexts. If all available personas are over-exploited to the point of becoming meaningless, there will be no cultural commons left to provide a stock of communicable meaning. Thus, if we accept the role that Madow assigns to celebrities in the creation and communication of meaning, it *would* be a cause for concern if, in extreme circumstances, all available celebrity personas were to be exhausted. Importantly, this cultural concern remains even if the advertising value of persona could be replaced by another technique. The likelihood of complete exhaustion may be remote, but the question remains: if celebrity persona is so valuable to cultural communication, surely it is in the public interest to ensure that this source of meaning and expression is not devalued through over-exposure and exhaustion?

The second objection to Madow’s challenge is that it relies on addressing scarcity from the angle of the herdsman, which in this case would be the user or advertiser. This is the approach in the classic parable, not least because the pasture is inanimate. But in our case, the “pasture” of the commons is an individual and it is possible to

<sup>188</sup> Madow, “Private ownership of public image”, at 224.

<sup>189</sup> *Ibid.* This argument is repeated and apparently endorsed by Westfall and Landau, “Publicity Rights as Property Rights”, at 120.

<sup>190</sup> Madow, “Private ownership of public image”, at 225.

<sup>191</sup> *Ibid.*

exhaust his persona, to that individual's detriment. Over-grazing and exhaustion becomes a more serious concern when the pasture itself has interests and rights. The advertisers, or herdsmen, may be free to move on to fresh pastures, but the individual/pasture is left with a depleted, and valueless, identity if it is over-exploited. The ongoing individual behind the persona is acknowledged by Coombe:

Arguably the celebrity evokes the fascination she does because however endlessly her image is reproduced, her substantive duration, that is, her life, never becomes wholly irrelevant. *She never loses her autonomy from the objects that circulate in her likeness.*<sup>192</sup>

If the objects that circulate in her likeness become depleted and valueless, the celebrity behind them also suffers, since the persona and celebrity are inextricably linked.

While this over-grazing may not be a tragedy for the herdsman-exploiters, it is still arguably a loss to two other parties: the wider community and the individuals/pastures themselves. Frazer, for example, takes a very decided stance on this: "In economic terms, personalities should be regarded as scarce resources since, although there is a fairly high degree of substitutability, the use of a personality by one person will diminish its usefulness to other users."<sup>193</sup> If its usefulness to others is diminished, its economic value also diminishes. This analysis is supported by a number of sources providing an insight into the practical side of exploitation. Evidence presented to the Court of Appeal in *Irvine v Talksport* included a statement from Irvine that "an endorser cannot in practice endorse more than one product or service in any one particular field."<sup>194</sup> Where unauthorised use is made of an individual's persona in one field, it effectively closes the gate on other, authorised, exploitation in that same field. In this sense, the individual's persona is exhausted in much the same way as the original pasture. Individuals have a vested interest in preventing exhaustion resulting from unauthorised use and in ensuring that the meaning and value attached to their persona is preserved. Again, this management can be seen in Milligan's comparison between the (mis)management of George Best

<sup>192</sup> Coombe, "Author/izing the celebrity", at 375, emphasis added.

<sup>193</sup> Frazer, "Appropriation of personality", at 303.

<sup>194</sup> [2003] 2 All ER 881, para 91.

in the 1960s and the more controlled approach taken by and on behalf of David Beckham in recent years.<sup>195</sup>

To this extent, the tragedy of the commons becomes the “tragedy of the pastures”: an argument which may have little relevance where the pasture is inanimate, but which deserves more serious consideration where the pasture has rights and interests. Whereas Madow argues that the celebrity pasture is (effectively<sup>196</sup>) inexhaustible, it is in fact the case that, although the total number of pastures may be limitless, each individual pasture is certainly exhaustible.<sup>197</sup> For Frazer, this individual scarcity provides a reason to protect identity:

Purely in terms of economic efficiency, therefore, there may be a justification for converting personality from no-ownership to private property. Since an over-use of personality may permanently depress its value, it is most important that such property right be protected by way of injunction as well as by damages.<sup>198</sup>

As the law has responded to protect tangibles from over-exploitation, so it can also respond to the risk of over-exploitation of persona: “[w]e can ration the use of highways by imposing tolls. We grant celebrities a property right to ration the use of their names in order to maximise their value over time.”<sup>199</sup>

Doing so also recognises the dignitarian value, as well as the economic value, of persona to the individual. While it may not be a great tragedy to an individual advertiser if Beckham’s persona is rendered meaningless through over-exploitation, it is most certainly a personal tragedy for Beckham – and arguably a tragedy for that section of the population which uses his persona for “informative and recoding” uses, in Coombe’s terminology. This over-exploitation would negatively impact on Beckham’s dignitarian interest identified above, regardless of the consequences for his economic interest.

<sup>195</sup> Milligan, *Brand it Like Beckham*, at 61-63; and see text at note 187 above.

<sup>196</sup> Although note his position regarding the possibility of complete exhaustion – a position I have sought to challenge above. See text at notes 190 and 191 above.

<sup>197</sup> Grady, “A positive economic theory of the right of publicity”, at 101.

<sup>198</sup> Frazer, “Appropriation of personality”, at 306.

<sup>199</sup> Grady, “A positive economic theory of the right of publicity”, at 112, citing a 1994 decision of the Fifth Circuit.

Whereas Madow favours the unprotected free use of such valuable imagery, de Grandpre and Grady argue that unprotected use typically results in a net loss to society, since over-exploitation results in the degradation and exhaustion of any meaning in that image to the detriment of the individual, the public, and ultimately the exploiters:

the public also tires of celebrities; many become stale, the buzz surrounding them giving way to fatigue and even contempt. For this reason, becoming and remaining a celebrity requires careful management, for it depends on constantly evoking the right impressions and remaining in the public's unaided memory.<sup>200</sup>

### **5.4.3. Allowing Net Positive Externalities**

However, this economic argument does not necessarily produce a right of publicity which creates a private stranglehold. Madow makes the point that not all uses of persona will necessarily result in a diminution in the value of that persona.<sup>201</sup> In fact, with reference to the property right of publicity in the US, de Grandpre claims that “the current right of publicity is overbroad”<sup>202</sup> and grants more protection than is required to satisfy the economic case for a publicity right. Instead, any right to control must be balanced against positive uses of publicity which promote or enhance the value, or at least which do not cause damage to it. De Grandpre challenges the need for publicity to be recognised as a property right, since this gives excessive control to individuals. He thus disputes Coase's view:

As Ronald Coase suggested, why not simply give everyone an absolute property right in her identity and let the market decide who should control what rights over whose identity? As one might suspect, the problem lies with transaction costs, which can be sizable and may not be passed on to consumers.<sup>203</sup>

These transaction costs include, for example, negotiating a licence with the individual and the fee to be paid. Instead, transaction costs for “beneficial” uses can be minimised or excluded by enabling the public to use persona in certain cases without breaching the prior publicity right. This, in effect, acts as a defence to a

<sup>200</sup> de Grandpre, “Understanding the market for celebrity”, at 100.

<sup>201</sup> Madow, “Private ownership of public image”, at 221-222.

<sup>202</sup> de Grandpre, “Understanding the market for celebrity”, at 79.

<sup>203</sup> *Ibid.*, at 109.



claim for breach, or operates to remove any individual right in that situation. In the language of economic analysis, “the law of publicity should prohibit unauthorized uses of identity that harm it – that result in net negative externalities – but would allow unauthorized uses that result in net positive externalities – informative or recoding uses, for example.”<sup>204</sup>

This is a balancing exercise, in order to achieve the promotion of “net positive externalities” while preventing “net negative externalities”. A right to control use of persona is necessary on economic grounds to prevent the exhaustion of these valuable social images as discussed in the previous section, but the economic justification also recognises that any such right should not be absolute. Exceptions are necessary to enable certain beneficial or net-gain uses. Not only would such exceptions for “beneficial” uses be to the public’s advantage, but in some cases they would benefit the individuals too. This is because an absolute right of control “is unlikely to result in an optimal production of fame *because our understanding of celebrity suggests that the media must be able to publicize it and the public must have meaningful opportunities to use it creatively*, in formal and informal contexts.”<sup>205</sup> These balances will be considered in section 7 below.

#### **5.4.4. Maximising Efficiency Through a Balance of Rights**

The need for a balance to be struck between private interests and public interests is also reflected in the second economic justification to be considered. Commentators typically favour either control of property through private rights or the freedom of public use associated with the public domain. An alternative to the either/or approach is posited by Howkins, who disagrees with the view that private rights are the “sole source” of innovation and economic growth:

I regard both the public domain and private rights as capable of generating economic activity. They are both economically efficient. They are both tools. They are not ends in themselves. They are tools to achieve ends – creativity, innovation, growth and knowledge.<sup>206</sup>

<sup>204</sup> *Ibid.*, at 114.

<sup>205</sup> *Ibid.*, at 115, emphasis added.

<sup>206</sup> J Howkins, “Is it possible to balance creativity and commerce?” in F MacMillan (ed), *New Directions in Copyright Law Volume 2*, 2006, at 312.



Treating private rights and the public domain as tools to be used to achieve certain ends makes it easier to understand that neither one nor the other is always the best or most efficient answer: instead, a balance is required. Where an appropriate balance is achieved, the ends served by these tools will be enhanced. Thus, as Howkins argues, it is “the balance that is efficient (or not): neither the public domain nor a private right on its own.”<sup>207</sup> This approach is echoed in the Adelphi Charter, which states that “[t]he public interest requires a balance between the public domain and private rights. It also requires a balance between the free competition that is essential for economic vitality and the monopoly rights granted by intellectual property laws”.<sup>208</sup>

In searching for justifications for a publicity right, it is important to remember that seeking an either/or outcome may not be the most efficient one: public and private interests may both be best served through a balance of rights and freedoms. This reflects the conclusion drawn in the previous section that a property right of publicity is “overbroad”, and that net positive externalities should be recognised as limitations or exceptions to the right.

In fact, the interaction of rights and freedoms is arguably essential for *both* camps, as Coombe demonstrates. She discusses the role of legal regulation of private rights in enhancing and advancing the interests of the public domain. Her analysis of the role of celebrity in popular cultural expression (a use which she undoubtedly supports) highlights the complexity of the interaction between private rights and cultural use:

The law of publicity rights, by prohibiting reproductions of the celebrity image for another’s advantage, promotes the mass circulation of celebrity signifiers by ensuring that they will have a market value. If the image were freely available for mass reproduction, there would, presumably, be less of an incentive to engage in the investments necessary to disseminate it through media channels. *Ironically, then, the law creates the cultural spaces of postmodernism in which mass media images become available for signifying practices.* It produces fixed, stable identities authorised by the celebrity

<sup>207</sup> *Ibid.* For an analysis of the “contours of copyright” and the balance with human rights, see C Waelde, “Copyright, corporate power and human rights: Reality and rhetoric”, in F MacMillan (ed), *New Directions in Copyright Law Volume 2*, 2006.

<sup>208</sup> The Adelphi Charter, adopted by the Royal Society for the Arts, 13 October 2005, para 3.

subject, but simultaneously creates the possibility of places of transgression in which the signifier's fixity and the celebrity's authority may be contested and resisted.<sup>209</sup>

Coombe's analysis suggests that de-regulation would not lead to a freeing up of celebrity image for general cultural consumption, but that it would lead to an increased scarcity not only through over-use (as addressed above) but also through reduced production.<sup>210</sup> Arguing for persona to be part of the public domain would not necessarily bring the advantages of free use that its advocates seek. Without the legal regulation to create "the cultural spaces of postmodernism" in which celebrity persona flourishes, the possibility of cultural re-configuration of that persona will be diminished<sup>211</sup> – something which Madow would, presumably, regret.

#### **5.4.5. Summary**

If the economic aspect of publicity practice is accepted (and even opponents of publicity rights concede the practical economic value of persona), there is considerable support for striking a balance between private and public interests. A legal right of publicity can help to engender the very social and cultural practice which Coombe, Carty and Madow support. As Grady and de Grandpre acknowledge, however, an exclusive private right of publicity is not necessarily the answer either. Howkins suggests that striking a balance can be the most efficient solution. In the case of publicity, this would recognise the value of persona to the public domain where freedom of expression or cultural communication is at stake, but enable the necessary private control to ensure that over-exploitation does not diminish either the economic or dignitarian interests in persona.

<sup>209</sup> Coombe, "Author/izing the celebrity", at 386-387, emphasis added. Note that this theory holds good even in the absence of a specific publicity right, so long as there is some legal mechanism for enforcing these interests, such as passing off or privacy.

<sup>210</sup> Although, as shown in section 4 above, Madow takes a different approach.

<sup>211</sup> A point Coombe also makes in "Critical cultural legal studies" (1998) 10 Yale JL & Human. 463, at 469: "The rights bestowed by intellectual property regimes... play a constitutive role in the creation of contemporary cultures and in the social life of interpretive practice." See also 479-481.

## 5.5. Two Further Objections Considered

Two arguments which are commonly used to deny a right of publicity are the arguments from free-riding and from wealth allocation. These objections can also be challenged, thereby strengthening the case in favour of publicity rights.

### 5.5.1. *The Argument from Free-riding*

The argument from free-riding is expressed by Madow as the idea that “society has a strong and independent moral interest in preventing people from free riding.”<sup>212</sup> If such misuse is not prevented, then the exploiter will receive something for nothing, or, in classic intellectual property terminology, will have reaped without sowing.<sup>213</sup> According to Madow, the problem with such contentions is that “there is still no *general* common law prohibition against benefiting from the commercial efforts of others.”<sup>214</sup> He provides several examples of situations where one person’s creativity is enjoyed and exploited by others since, once it has been voluntarily placed in the market, it effectively becomes freely appropriable.<sup>215</sup> Gordon makes the point that there is at least a balance to be struck: where all free riding is identified as wrongful, such “a prohibition is itself potentially destabilizing, and, though it may express one community norm, important contrary community norms exist as well.”<sup>216</sup>

Although Madow notes there may be no common law rule against free-riding in the abstract, it is nevertheless a practice which the World Intellectual Property Organisation (WIPO) has criticised. The WIPO Intellectual Property Handbook deals with unfair competition<sup>217</sup> and the problem of free-riding, which it defines as “any act that a competitor or another market participant undertakes with the intention

<sup>212</sup> Madow, “Private ownership of public image”, at 200.

<sup>213</sup> See for example, A Kamperman Sanders, *Unfair Competition Law: The Protection of Intellectual and Industrial Creativity*, 1997, at 13-15. See also Carty, “Advertising, publicity rights and English law”, at 247.

<sup>214</sup> Madow, “Private ownership of public image”, at 201.

<sup>215</sup> *Ibid.*, at 201-203.

<sup>216</sup> Gordon, “On owning information”, at 278.

<sup>217</sup> Free-riding can be seen as one aspect of unfair competition, which Kamperman Sanders describes as the “misuse of another’s exploits” (at 22). For a detailed analysis of unfair competition in Common law and Civilian jurisdictions, see A Kamperman Sanders, *Unfair Competition Law: The Protection of Intellectual and Industrial Creativity*, 1997.

of directly exploiting another person's industrial or commercial achievement for his own *business* purposes without substantially departing from the original achievement."<sup>218</sup> WIPO addresses this problem principally from the perspective of free-riding on a competitor's achievements, rather than specifically the problem of free-riding on an individual's persona. However, whether a business free-rides on a juristic person's reputation or a natural person's reputation, through persona, the action remains the same, and the free-rider's business is insufficiently distinguished from the original "achievement". WIPO states that unfairness arises from "the obvious exploitation of the notoriety of the indication [that is, trade mark]... without any proper effort being made to depart substantially from the characteristic features of that particular achievement, but also from the risk of damage to the reputation of the existing business."<sup>219</sup> There is therefore a two-fold wrong: (i) the initial undifferentiated use by the exploiter and (ii) the subsequent risk of damage to the individual's reputation.

Applying the language of economic analysis used by Grady and de Grandpre above, the net economic costs of commercial free-riding on persona are negative, that is to say, the exhaustion or degradation of the particular identity, together with the potential consumer confusion, will outweigh any benefit to the public. Free-riding is therefore not an activity that should constitute a permitted exception to a right of publicity.

This argument against free-riding reflects the core private law concern with the prevention of unjustified enrichment which, as Gordley argues,<sup>220</sup> can be seen to underlie contract and delict. Whether unjustified enrichment is the most effective way to prevent free-riding in publicity cases will be explored in more detail in Chapter 6.

There is also a moral or dignitarian ground on which to reject free-riding, reflecting the concerns expressed above regarding honest use and the dangers of taking

<sup>218</sup> WIPO Intellectual Property Handbook: Law, Policy and Use, para 2.843.

<sup>219</sup> *Ibid.*, para 2.842.

<sup>220</sup> J Gordley, "Contract and delict: Toward a unified law of obligations" (1997-1998) 1Edin LR 345.

another's voice. WIPO states that free-riding is "contrary to honest business practice".<sup>221</sup> While free competition is encouraged by WIPO, unfair competition is not.<sup>222</sup> WIPO thus sanctions measures to combat unfair competition, which would arguably include measures to prevent free-riding on another's reputation, even where that does not cause consumer confusion. The connection between free-riding and unfair competition in this context is emphasised by the recognition of a right of publicity in the Third Restatement of the Law of Unfair Competition.<sup>223</sup>

Further, free-riding can be challenged in the particular context of publicity, where there is use of part of the individual against his will. Here, the unauthorised use does not exploit a separate creation in which I have invested my personhood: the thing exploited *is* my personhood. Regardless of the additional "meaning" which fame, celebrity or society may have imposed upon an individual's persona, it remains a representation of a human being which is used for gain by another without any consideration for that individual's interests, whether commercial or dignitarian. A comparison can be drawn here with slavery: "we cannot alienate the whole of our labour because then we would be made slaves".<sup>224</sup> It is difficult to justify an institution which condones the commercial exploitation of another individual without that individual's consent, and free-riding does just that. As one American court stated in a publicity case: "Let the word go forth – there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet."<sup>225</sup>

### **5.5.2. The Argument from Wealth Distribution**

The second counter-justification is that of wealth distribution. Madow questions the role of publicity in distributing wealth *upwards*, to those who already have wealth:

<sup>221</sup> WIPO Intellectual Property Handbook: Law, Policy and Use, para 2.847.

<sup>222</sup> *Ibid.*, para 2.751.

<sup>223</sup> American Law Institute Restatement of the Law of Unfair Competition, 3d, Chapter 4, paras 46-49.

<sup>224</sup> S Maniatis, "Trade mark rights – a justification based on property" [2002] IPQ 123, at 158. See the reference above to this point, made by McCarthy with reference to Justice Cobb, *The Rights of Publicity and Privacy*, para 2:5.

<sup>225</sup> Grady, "A positive economic theory of the right of publicity", at 110, citing a 1994 decision regarding Jackie Onassis.

Why, we may properly ask, should the law confer a source of additional wealth on athletes and entertainers who are already very handsomely compensated for the primary activities to which they owe their fame?<sup>226</sup>

This rhetorical question is echoed at a much later stage in his article, where he addresses the issue of whether the law should play a role in allocating wealth.<sup>227</sup> Questions such as this were considered by economists like Smith, who conceded that limited monopolies might have a beneficial role in allowing creators and inventors to reap the economic rewards, if any, of their creation or invention.<sup>228</sup>

Two observations can be made in response to Madow's objection. In the first place, it is arguably not solely the law that confers this additional source of income. The social practice and corresponding market demand – the fact that there are willing “buyers” and “sellers” of publicity, even if there is nothing in law to buy and sell – creates the value. As Madow himself accepts, if

sneaker makers were free to use Michael Jordan's picture in their advertisements... Jordan would still be able to command a price, maybe a hefty one, for wearing a particular brand of sneaker in the Big Game or for touting or demonstrating its virtues in a television commercial. Or suppose T-shirt makers were free to use Bruce Springsteen's picture without his permission. Some consumers would probably choose to purchase the T-shirt “officially authorized” by Springsteen – because they would expect him to monitor its quality, because they would want their money to go to him, or because they would derive a closer sense of identification with him in this way.<sup>229</sup>

As I demonstrated in Chapter 3, publicity value is predominantly derived from authorised exploitation, and this exploitation is not solely reliant on legal sanction, as we have seen. It is not the legal right but the marketplace which creates the value.<sup>230</sup> a commercial practice does not need the sanction of law to “create” the value. Law may provide certainty, which in turn may *enhance* the value,<sup>231</sup> but this is not the

<sup>226</sup> Madow, “Private ownership of public image”, at 137.

<sup>227</sup> *Ibid.*, at 220 et seq.

<sup>228</sup> RL Meek, DD Raphael and PG Stein, *Adam Smith, Lectures on Jurisprudence*, 1978/1987 (henceforth Meek *et al*, *Adam Smith Lectures*) at ii.31-ii.34.

<sup>229</sup> Madow, “Private ownership of public image”, at 211.

<sup>230</sup> Halpern, “Publicity: Maturation of an independent right”, at 858.

<sup>231</sup> Users may be prepared to pay higher prices for a right which they know can be enforced, particularly where the right is good against third parties.

same as creating the initial value.<sup>232</sup> A clear example of a lucrative market without the sanction of law is the cocaine trade. Not only is cocaine not recognised as a legitimate trade, it is positively prohibited. Despite this, it is still worth a staggering amount of money.

Thus, to suggest that it is the legal protection which creates and confers the publicity value appears to be misleading. Legal recognition may well benefit individuals by creating certainty in their dealings for authorised exploitation, but the commercial evidence suggests that law is not solely or even primarily responsible for creating that value in the first place. The only additional source of wealth for individuals that would arise from a legally-sanctioned right of publicity comes from compensation for unauthorised exploitation. Although these figures may be high in the US, in the UK the Douglases' compensation for unauthorised use was less than £15,000, compared with the £1 million price tag for the authorised deal.<sup>233</sup> Madow's claim that adopting a legally enforceable right is responsible for this value can therefore be disputed: it may *enhance* it by the greater legal and commercial certainty which would come from a legal right, but it does not *create* the value at the outset.

A second observation about Madow's wealth distribution point is that it is made in isolation about publicity. He questions why we should expect the state to provide publicity rights which would "operate to channel additional dollars to the very people – Einstein rather than Bohr, Vanilla Ice rather than Too Short – who happen to draw first-prize tickets in the fame lottery."<sup>234</sup> But arguably a patent right rewards people who have drawn winning tickets in the intelligence lottery, while those who are blessed with sporting prowess are rewarded in preference to those who are not, no matter how hard the latter may try to gain that coveted Olympic gold. The capitalist economy is not concerned with the equal or communal distribution of wealth. As McCarthy argues, if we accept Madow's argument in respect of publicity, "consistency would demand that we refuse property rights in Rolls Royce and Mercedes automobiles, personal swimming pools, expensive personal jewelry, and

<sup>232</sup> See McCarthy, *The Rights of Publicity and Privacy*, para 2:2.

<sup>233</sup> *Douglas v Hello!* [2006] QB 125.

<sup>234</sup> Madow, "Private ownership of public image", at 189.



the like.”<sup>235</sup> McCarthy raises a further objection in relation to Madows’s assertion that publicity channels wealth to stars who are already wealthy. Giving the example of a former Olympian whose name is being used to promote cereal, McCarthy points out that allocating the value to the retired athlete rather than the cereal conglomerate is not a redistribution “upwards”.<sup>236</sup> Madow’s argument may therefore have a certain egalitarian appeal but, in the context of a capitalist society, it is insufficient to operate as an argument against publicity rights.

## 6. IDENTIFYING THE INDIVIDUAL

Accepting the justification from autonomy and dignity impacts upon the question of who can exercise a publicity right in two important ways. In the first place, it operates to exclude fictional characters. Where a right of publicity is justified on the grounds that it protects the inherently personal image of an individual, it operates to exclude fictional characters from its scope. Thus, the cartoon Teenage Mutant Ninja Turtles<sup>237</sup> would be excluded from publicity rights, whereas Eddie Irvine would not. As noted in Chapter 2, this boundary is somewhat blurred in the case of individuals who are strongly identified with a particular fictional character, such as Paul Hogan and Crocodile Dundee. Although the distinction may be less clear-cut in these cases, nonetheless the right of publicity would extend to Paul Hogan as an individual, thereby encompassing his activities in character (subject always to any copyright issues arising).

The second consequence of the justification from personhood is that it answers the question whether the right should be limited to celebrities or available to all. So far in this thesis, I have deliberately used “individual” to refer to the holder of any publicity right, while recognising that the majority of those who will benefit and exercise the right will be celebrities: the signal importance of reputation was

<sup>235</sup> McCarthy, *The Rights of Publicity and Privacy*, para 2:3. Also Westfall and Landau, “Publicity Rights as Property Rights”, at 121, who ask why publicity should be singled out in this way.

<sup>236</sup> McCarthy, “The human persona as commercial property”, at 141.

<sup>237</sup> The subject of *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, discussed in Chapters 2 and 3.



discussed in Chapter 3.<sup>238</sup> The lure of fame transforms persona into a valuable “asset” and reputation is at the core of publicity exploitation. On this analysis, the conclusion would be that only celebrities could or should benefit from a publicity right. Yet it has already been noted (section 4) that the subject matter is persona, not the value in that persona. The consequence of this, together with the justification from autonomy, is that *every* individual should benefit from any legally recognised publicity right in his persona.

As would be expected from his emphasis on the inherently personal nature of a publicity right, McCarthy is very strongly in favour of a universal right:

Does the right of publicity cover only celebrities? The answer is clearly no. The right of publicity is an inherent right of identity possessed by everyone at birth. While the commercial value of a celebrity’s identity is understandably greater than that of a non-celebrity, this does not mean that only celebrities have a right of publicity.<sup>239</sup>

And as Nimmer rather pragmatically notes “[i]t is impractical to attempt to draw a line as to which persons have achieved the status of celebrity and which have not; it should rather be held that every person has the property right of publicity”.<sup>240</sup>

Vaver also agrees that “personality protection surely should not depend on how rich or famous a person is”.<sup>241</sup> Unsurprisingly, authors in the Civilian personality rights camp also favour a universal right. As Logeais says, “[e]veryone gets an image at birth... there is no reason to discriminate between a celebrity and an anonymous individual.”<sup>242</sup> Neethling couches this in even stronger terms: personality rights are highly personal and are therefore “non-transferable, uninheritable, incapable of being relinquished or attached, they cannot prescribe, *and they come into existence with the*

<sup>238</sup> Chapter 3, section 3.2.

<sup>239</sup> McCarthy, “Public personas and private property”, at 688; also McCarthy, *The Rights of Publicity and Privacy*, paras 1:3 and 4:15-4:16.

<sup>240</sup> Nimmer, “The right of publicity”, at 217. Halpern notes that the right is “peculiarly celebrity based” but concludes that a final resolution is perhaps unnecessary since the debate is “largely academic”, “Publicity: Maturation of an independent right”, at 854.

<sup>241</sup> D Vaver, “Advertising using an individual’s image: A comparative note” (2006) 122 LQR 362, at 365.

<sup>242</sup> Logeais, “The French right to one’s image”, at 168.

*birth and are terminated by the death of a human being.*<sup>243</sup> There is certainly no suggestion that such rights are exercisable by some persons but not by others.

It is an equitable and fair proposition to assert that if publicity rights are to be recognised by virtue of their inseparable link to the individual upon whose persona they depend, then they should be recognised equally for all individuals. The personhood justification has this consequence: it ensures the availability of the right to all individuals.

However, while all individuals are entitled to a publicity right by virtue of their inherent image, the impact of fame potentially makes itself felt when it comes to assessing damages. This can be seen in arguments advanced by McCarthy, Nimmer and Vaver, amongst others. Thus, McCarthy accepts that the commercial value of the celebrity's persona is "understandably greater" than that of an anonymous individual. Nimmer's position is revealed by the full extent of the quotation used above, where he goes on to argue that:

... it should rather be held that every person has the property right of publicity, *but that the damages which a person may claim for infringement of the right will depend upon the value of the publicity appropriated which in turn will depend in great measure upon the degree of fame attained by the plaintiff.*<sup>244</sup>

So too with Vaver who observes that, in New York at least, "it did not matter one jot on the issue of liability whether the plaintiff was a private person or a public person. *When one came to consider damages, the factor was relevant;* the nature and extent of recovery could quite properly differ depending upon the circumstances of a particular plaintiff."<sup>245</sup> These sentiments are also echoed by Madow in a footnote, where he notes that

[s]trictly speaking, everyone, obscure as well as famous, "has" a right of publicity... As a practical matter, however, as Nimmer himself conceded, the right of publicity "usually becomes important only when the plaintiff (or potential plaintiff) has achieved in some degree a celebrated status"... this is because the damages recoverable for infringement of the right depend on the commercial value of the publicity that has been appropriated... Very rarely

<sup>243</sup> Neethling, "Personality Rights", at 534, emphasis added.

<sup>244</sup> Nimmer, "The right of publicity", at 217, emphasis added.

<sup>245</sup> Vaver, "What's mine is not yours", at 257, emphasis added.

will the economic value of a noncelebrity's persona be sufficient to support a lawsuit for infringement.<sup>246</sup>

The justifications in support of publicity rights therefore serve to shape the extent of the right in two ways. In the first place, they demonstrate that the right should be available to all individuals, by virtue of the universal nature of personhood and persona. In the second place, they draw out a secondary factor which impacts at the stage of compensation for unauthorised use and licence fees for authorised use. Reputation may affect the size of the licence fee and the calculus of damages, but it should not impact on the prior creation of the right. The role of reputation in the quantum of damages will be discussed in more detail in Chapter 7.

## 7. BALANCING THE INTERESTS: SHOULD THERE BE A RIGHT OF PUBLICITY?

The above review demonstrates that the justifications from autonomy and dignity and the economic analysis operate to support a legal right granting control of persona to the individual. The nature of the dignitarian justification means that such a right of control should be available to all individuals.

However, the precise legal nature of this right remains to be determined. I have consciously sought to avoid justifying a particular type of legal right, and instead focused on the need to control use of persona. Determining the legal nature of a publicity right will be undertaken in Chapters 5 and 6, where it will be unavoidably shaped by the conclusions reached in this chapter. The fact that competing interests have also been identified must be taken into account. Even an economic analysis in favour of a publicity right recognises that there is an economic case for limiting any right, so that permitted uses may be made. Individuals' interests in the grant of a right can be contrasted with the public interest in freedom of expression and use of the cultural commons, as discussed in section 3 above. There is thus the critical issue of the balance to be struck.

<sup>246</sup> Madow, "Private ownership of public image", at 137, note 39, references omitted.

In fact, balancing freedom of expression with private interests is not a new endeavour, and courts in Europe and the US are now well versed in this exercise. (As McCarthy observes, “such line drawing is the stock in trade of the law.”<sup>247</sup>) Since the Human Rights Act 1998 introduced (to all intents and purposes) the ECHR with direct horizontal effect in the UK, Scottish and English courts have balanced Articles 8 and 10 in order to protect the privacy of individuals and the rights of publishers, as will be examined in Chapter 5.

What is clear is that Article 10 does not automatically trump other rights.<sup>248</sup> Instead, it can, and should, have an important role to play to “balance new limits on the use of persona”.<sup>249</sup> Freedom of expression can therefore be accommodated as a balancing interest, allowing the courts to weigh the competing interests of publicity and freedom of expression where they arise. For this reason, freedom of expression shall be considered in Chapter 7 in the context of the scope of the publicity right, rather than at this prior stage of justifying or denying publicity rights.

The same conclusion applies in the case of the second competing interest: the need to preserve the cultural commons. It is possible to recognise publicity rights *and* the interests of the genuine cultural commons, by creating a publicity right and then recognising certain creative or cultural uses as defences. This would protect the interests of those who used persona to create new meaning or pass quasi-political comment on existing meaning, in the manner of *Laugh It Off v South African Breweries*.<sup>250</sup> This balance can be achieved by recognising a right of publicity for individuals, to enable them to control use of persona, which is then countered by a

<sup>247</sup> McCarthy, *The Rights of Publicity and Privacy*, para 2:4.

<sup>248</sup> *Campbell v MGN* [2004] 2 AC 457, para 113, per Lord Hope. More generally, see H Fenwick and G Phillipson, *Media Freedom under the Human Rights Act*, 2006, (henceforth Fenwick and Phillipson, *Media Freedom*) at 691; Reed and Murdoch, *Human Rights Law in Scotland*, paras 6.36 *et seq* and 7.21 *et seq*.

<sup>249</sup> Goodenough, “Re-theorising privacy and publicity”, at 70.

<sup>250</sup> 2006 (1) SA 144 . The applicant company printed t-shirts bearing an image and slogan based on the registered trade mark of the respondent, having changed certain words in order to parody them and pass social comment. Thus, the words “Black Label” in “Carling Black Label” were replaced with the words “White Guilt”, while “America’s lusty lively beer” was changed to “Africa’s lusty lively exploitation since 1652”. The respondent unsuccessfully sought to rely on its registered trade marks to stop the use of its marks on these t-shirts.

defence of parody and fair use. Again, this will be examined in more detail in Chapter 7, in looking at limitations to a publicity action.

## 8. THE ALTERNATIVE QUESTION

Whereas this chapter has so far sought to justify the recognition of a right of publicity, there is in fact an alternative question that can be posed. It is possible to suggest that this entire justificatory project can be replaced with this question such that, even if all the above arguments advanced in favour of publicity rights were to be rejected, this question and answer can resolve the matter in favour of the creation of a publicity right. By addressing both the primary question and this secondary question, and by answering both in favour of a right of publicity for the individual, the case in favour of publicity rights becomes even stronger.

This alternative question is posed by Reiter:

the crucial question for the law is not the unanswerable moral question, “Do celebrities deserve the earning power their status commands?” but rather the factual question, “Given that celebrities command considerable commercial power, who should benefit?”<sup>251</sup>

Goodenough chooses to address this question and provides a rational, and personal, answer:

If there were no control over the persona, as Madow advocates, then the values inherent in it would be at the full disposal of capital-rich companies... *as between a star whose name is to be used and a huge manufacturing company making the use, I, at least, would rather see the star control the value of the use of her identity than leave the benefit solely to the company.*<sup>252</sup>

There cannot be many who would disagree with Goodenough here.<sup>253</sup> Even Madow acknowledges that “caution” is required since “in a “free use” world... it is not only *popular* cultural practice that would be liberated. Large corporate actors would also

<sup>251</sup> Reiter, “Personality and patrimony”, at 726.

<sup>252</sup> Goodenough, “Re-theorising privacy and publicity”, at 60, emphasis added.

<sup>253</sup> Support also comes from McCarthy, *The Rights of Publicity and Privacy*, para 2:2; and Halpern, who, in a choice between “scavengers”, favours the “scavenger who has at least some colourable connection to the phenomenon”: “Publicity: Maturation of an independent right”, at 871-872.

be set free to “graze” on the celebrity commons.”<sup>254</sup> While these corporate actors would still seek to differentiate themselves from the rest of the herd, the unlimited use of persona would be a part of that – especially for companies, like Talksport, Hello! and Anabas, which are keen to exploit the popular figures of the day.

Denying a legal right of publicity does not cancel out the commercial value inherent in persona or award it to some party who is more deserving (however such a party could be identified). Instead, it means that the value becomes a free-for-all and this, in turn, means that, realistically, it is most likely to be annexed for the benefit of “capital-rich companies”. In the absence of legal protection, the commercial value in persona is as likely to fall to the “huge manufacturing company” or the media enterprise – neither of which are likely to be more deserving or have any greater demands on our sympathy than the individual in question. It is certainly most unlikely to benefit the man in the street or the small creative enterprise.

The practical reality of the creation of a legal right is that it assigns whatever value there may be in persona to the individual. This is echoed in Hughes’ work on intellectual property, where he observes that “[p]roperty rights in the persona *give the individual the economic value derived most directly from one’s personality*. As long as the individual identifies with his personal image, he will have a personality stake in that image.”<sup>255</sup>

On this analysis, the question of justification becomes an issue not of determining whether or not we need a right, but how we respond to the undeniable commercial practice which exists. As Reiter contends, the question under this analysis moves from the moral to the factual. Despite this, the answer to his factual question, as with the moral one, remains the same: the individual is entitled to the control (both economic and dignitarian) of persona which a right of publicity would formally recognise, subject always to the balances noted above, to respect freedom of expression and the creative use of the cultural commons.

<sup>254</sup> Madow, “Private ownership of public image”, at 240, footnotes omitted. Emphasis in the original.

<sup>255</sup> Hughes, “The philosophy of intellectual property”, at 341, emphasis added.

## 9. CONCLUSION

In this chapter I have sought to explore the “reasons or considerations likely to sway the free understanding of the participants in social life in favour of the institution that is being defended.”<sup>256</sup> This has involved examining the interests that would be protected by a right of publicity and balancing these against the competing interests. It is clear that justifying a right of publicity is a very complex task and, as demonstrated (in section 8 above), can depend to some extent on the question that is asked. Nonetheless, whether one looks to the question of whether an individual should be entitled to a right of publicity, or the alternative question of who should benefit from the undeniable value of the commercial practice, the answer is the same: a right of publicity, vested in the individual, can demonstrably be justified.

Individuals, whether famous or not, have certain dignitarian and economic interests in their persona, which can be protected through control. Where their persona is used without consent, they suffer harm to those interests. Not the least of these harms is the risk of adulterated “free” speech through misuse of persona, which challenges the integrity of persona and the very notion of free speech or freedom of expression. A society which professes to respect autonomy and dignity cannot deny the individual’s right to control and protect something as inherently personal as his image, indicia, information and reputation. Parallels have been drawn between the harm resulting from unconsented use of persona and the harm arising from unauthorised use of one’s vote, where the individual’s “voice” is appropriated for unauthorised purposes.

These justifications do not, however, claim that a publicity right is inviolate and should trump all other interests at stake: an unfettered property right in publicity is “overbroad”, as de Grandpre recognised. In particular, the right to freedom of expression should be recognised as an important limitation on such a right. However, its proper role is as a counter-balance to any publicity claim, and not as a

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<sup>256</sup> HM Spector, “An outline of a theory justifying intellectual and industrial property” [1989] EIPR 270, at 270, as quoted at note 1.

basis for rejecting the validity of such a right. So too with the need for creative expression, through parody or other creative works, to communicate new cultural meanings and challenge existing ones. Instead, exceptions and limitations should and must be recognised. These competing interests do not operate to defeat claims to publicity, but are correctly to be viewed as limitations to any such right, and accordingly, the scope of such interests will be considered in more detail in Chapter 7. Before that stage is reached, the scope of the right itself needs to be examined.



## PART III

Now that the examination of publicity rights in Chapters 2, 3 and 4 has provided a clearer understanding of publicity and justified a publicity right, it is possible to move to an evaluation of the most appropriate “home” for a right of publicity, which poses the third question: *how* are such rights to be protected in Scots law?

As the law currently stands, a number of legal actions could be pressed into service to enable the protection and exploitation of different elements of the right of publicity. The discussion in Chapter 3 showed that individuals in England have sought to protect their negative right to prevent or recover for unauthorised use primarily through tort, and pursuers in Scotland are likely to attempt to use such actions. Statutory rights such as data protection have also been pressed into service. The positive power to exploit the value in persona has been explored by commercially motivated individuals through contracts, as was seen in Chapter 3 regarding, for example, Irvine’s relationships with Ferrari and Hilfiger, and the Club *pro forma* contract.

The rest of this thesis will assess where a right of publicity should lie in Scots law. First, publicity’s relationship with privacy will be examined, in Chapter 5. The focus of Chapter 6 will move to a consideration of real and personal rights in Scots law, to see if either of these categories of right could provide a home for publicity rights. Chapter 7 seeks to identify the limits of the right, together with appropriate remedies when the right (within those limits) has been breached.

The conclusions reached in the previous chapters will be central to this examination:

1. Exploitation of persona can be authorised or unauthorised. The rights or powers enjoyed by the individual differ between the negative right to prevent exploitation and the positive power to engage in authorised exploitation, either in person or through a third party.

2. Exploitation of persona can usefully be distinguished according to three different methods of exploitation: the media information use, the promotion use, and the merchandising use. Each of these is capable of both authorised and unauthorised exploitation.
3. The subject matter of exploitation is a complex amalgam of name, image and identity, voice, gestures and characteristics, frequently supplemented by some personal information and, in most cases, reliant upon an underlying reputation – collectively referred to as the individual’s “persona”.

The interests which are at the heart of a right of publicity are both dignitarian and economic. Control of persona is central to enabling the individual to exercise autonomy in deciding what use, or not, to make of his persona.

# CHAPTER 5: PRIVACY AS A BASIS FOR PUBLICITY

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## 1. INTRODUCTION

The close relationship between privacy and publicity has already been highlighted in previous chapters, most notably in Chapter 2. As Cornish and Llewelyn observe, “all but the most unremittingly secretive can be induced to reveal home truths at some price”<sup>1</sup> and it is also true to note that commercial organisations, almost without exception, are prepared to exploit these same home truths and to pay the price to do

<sup>1</sup> Cornish and Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 6<sup>th</sup> ed, 2007 (henceforth Cornish and Llewelyn, *Intellectual Property*), para 9-04.

so. For the right fee, privacy can give way to publicity. On this analysis, publicity is the other side of the privacy coin.

This chapter will start with an examination of the concept of privacy in the UK, before going on to assess whether publicity truly is derived from, or dependent upon, privacy rights. In this examination, privacy is not a generic concept, but is the legal concept of respect for one's private life arising from Article 8 ECHR.<sup>2</sup> In turn, publicity is the notion of the media information, endorsement and merchandising uses of persona, as defined in Chapter 3, whether in their authorised or unauthorised context.

## 2. THE RIGHT TO PRIVACY IN THE UK

### 2.1. Introduction

Cornish and Llewelyn define privacy as “the desire of an individual to be free of intrusion”.<sup>3</sup> This echoes the basis of privacy as expressed by MacCormick, who additionally notes the importance of *control* of privacy to the individual:

some kind of desire for seclusion... This desire for seclusion should not be construed in all cases as a desire to exclude all other human beings from one's life or some aspect of it; rather it is a desire to have the last say on which other human beings will be brought within the circle of one's seclusion for certain purposes.<sup>4</sup>

While this may be the conceptual basis of privacy, it does not address how that desire is to be achieved in law.<sup>5</sup>

As recently as 1983, Frazer could state that, in law, the “concept of ‘privacy’ is so subjective that there is substantial disagreement among writers as to its nature and

<sup>2</sup> For a review of privacy pre-ECHR see Kilbrandon, “The law of privacy in Scotland” (1971) 2 *Cambrian L Rev* 35.

<sup>3</sup> Cornish and Llewelyn, *Intellectual Property*, para 9-01.

<sup>4</sup> MacCormick, *Legal Rights and Social Democracy*, at 175.

<sup>5</sup> Moreham also draws this distinction between the theoretical desire underlying privacy and the objective standard applied in law: see Moreham, “Privacy in public places”, at 617.

scope.”<sup>6</sup> While there is still no specific tort of privacy,<sup>7</sup> consequently forcing Scots and English law to protect such interests “in a piecemeal fashion in several disparate areas”,<sup>8</sup> it would nevertheless be fair to say that the law has moved on considerably since 1983. Privacy in the UK, while still evolving, owes its current existence to the ECHR and to the Human Rights Act 1998.<sup>9</sup>

Article 8 of the ECHR, as incorporated into Scots law by section 1(2) of the Human Rights Act 1998, ensures that “[e]veryone has the right to respect for his private and family life, his home and his correspondence.”<sup>10</sup> It is this which offers individuals the right to prevent, or subsequently recover for, an invasion of their privacy.

## 2.2. Breach of Confidence

The problem facing pursuers both in Scotland and in England in privacy actions has been how to introduce Article 8 ECHR into court in the absence of direct horizontal effect<sup>11</sup> or a specific action for privacy. Indirect horizontal effect has resulted in the

<sup>6</sup> Frazer, “Appropriation of personality”, at 295. This level of disagreement reflects MacCormick’s comment about the consequent need for achieving certainty through “intelligent legislation”: see Chapter 1, page 2.

<sup>7</sup> And never will be at common law, according to Wacks, in part because of the “notorious judicial inertia in this field”: R Wacks “Why There Will Never be an English Common Law Privacy Tort”, in A Kenyon and M Richardson (eds), *New Dimensions in Privacy Law*, 2006, at 155. See also *Wainwright v Home Office* [2004] 2 AC 406, paras 51 and 52, per Lord Hoffmann.

<sup>8</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 77. These areas include data protection, the Protection From Harassment Act 1997, defamation, and breach of confidence, amongst others. See HL MacQueen, “A Hitchhiker’s Guide to Personality Rights in Scots Law, Mainly with Regard to Privacy”, in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009. Note, however, that the disparate areas may differ north and south of the border: Whitty, “Overview of Rights of Personality in Scots Law”, paras 3.4.6-3.4.8.

<sup>9</sup> This came into force in the UK on 2 October 2000: helpfully, this was just in time for the Douglasses, whose wedding took place the following month (18 November 2000).

<sup>10</sup> Convention for the Protection of Human Rights and Fundamental Freedoms, Rome, 4.XI.1950, Article 8(1).

<sup>11</sup> Section 6 of the Human Rights Act 1998 restricts the application of the Act to “public bodies”. A human rights claim cannot be raised directly against a private body, but human rights issues must be considered by the courts (which are public bodies) in any case brought before them. In any action against a private body, therefore, there must be a prior cause which enables the claim to reach court, where human rights issues can then be considered. For a brief review of the problems of horizontal application and privacy in England see NA Moreham “Privacy and horizontality: Relegating the common law” (2007) 123 LQR 373. An earlier and more detailed analysis in this field is Morgan, “Privacy, confidence and horizontal effect”. There is no longer any doubt over the availability of the remedy in horizontal relationships, and this approach was underscored by Resolution 1165 of the Council of Europe (passed against the background of the death of the Princess of Wales in a car crash following pursuit by reporters) which emphasised that Article 8 privacy rights should be enforceable

creative use of existing Scottish and English doctrines, some of which have been extensively “developed”, almost beyond recognition. The most obvious example in this area is the doctrine of breach of confidence. Restated by Lord Goff in the *Spycatcher* case<sup>12</sup> in 1990, it has since taken some interesting turns as lawyers have made it the most likely vessel for introducing privacy concerns of this nature in court. The extent of the development of this action can be illustrated by the contrast between the law in 1984 as stated by the Scottish Law Commission, and in 2004 as stated by the House of Lords. The Scottish Law Commission’s view in 1984 was that breach of confidence in Scotland required some relationship of confidence between the parties, and was typically “based in express or implied contractual obligations, there being very few cases which can clearly be discerned to derive from some other branch of the law such as delict”.<sup>13</sup> By 2004 the House of Lords was able to state (at least in relation to English law) that in privacy cases the action for breach of confidence:

has now firmly shaken off the limited constraint of the need for an initial confidential relationship... The essence of the tort is better encapsulated now as *misuse of private information*.<sup>14</sup>

This approach was also present in the Court of Appeal’s 2005 decision in *Douglas v Hello!* where they stated: “In so far as private information is concerned, we are required to adopt... the cause of action formerly described as breach of confidence”.<sup>15</sup>

This use of breach of confidence as the “home” for privacy has caused considerable problems<sup>16</sup>, since information which is confidential is not necessarily private, and

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against private persons, including the media. See para 12 of the Resolution, available at <http://assembly.coe.int/Main.asp?link=/Documents/AdoptedText/ta98/ERES1165.htm> (accessed 17 September 2007); and HL MacQueen, “A Hitchhiker’s Guide to Personality Rights in Scots law, Mainly with Regard to Privacy” in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009, para 12.2.

<sup>12</sup> *Attorney-General v Guardian Newspapers* (No 2) [1990] 1 AC 109.

<sup>13</sup> SLC No. 90, Breach of Confidence, 1984, para 2.1.

<sup>14</sup> *Campbell v MGN* [2004] 2 AC 457, para 14, per Lord Nicholls, emphasis added; also para 17 where Lord Nicholls says: “The time has come to recognise that the values enshrined in Articles 8 and 10 are now part of the cause of action for breach of confidence.” See also *Murray v Big Pictures* [2008] EWCA Civ 446, para 24.

<sup>15</sup> [2006] QB 125, para 53. Is this possibly an oblique reference to another entertainer?!

<sup>16</sup> Not least in relation to the scope of the action in cases of commercial confidence. See Carty’s analysis of the current role of commercial confidence following these Article 8 developments: “An

*vice versa*. Thus, confidential information is that which is secret, yet to “confine the law of privacy to cases involving secrets of some kind would, however, be to ignore both the result in the *Hannover* case, and the fact that the privacy interest is different from the interest in preserving confidentiality.”<sup>17</sup> Nevertheless, since 2000, a number of individuals have relied on the “revised” doctrine of breach of confidence shored up by Article 8 ECHR to claim against the media and other parties for invasion of their private lives, seeking either an interdict or injunction<sup>18</sup> or damages.<sup>19</sup> The European Court of Human Rights (“ECtHR”) has also been involved in Article 8 cases involving intrusion into private life, most notably *Peck v The United Kingdom*<sup>20</sup> and *von Hannover v Germany*.<sup>21</sup> These developments in the UK and at Strasbourg have generated a considerable body of literature.<sup>22</sup>

Infringement of privacy under Article 8 can now arise where the information in question is either (i) protected by a relationship of confidentiality, as in cases such as *Spycatcher*,<sup>23</sup> *McKennitt v Ash*,<sup>24</sup> and *Mosley v News Group Newspapers Limited*<sup>25</sup> or

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analysis of the modern action for breach of commercial confidence: when is protection merited?” [2008] IPQ 416 (henceforth Carty, “The modern action for breach of commercial confidence”).

<sup>17</sup> Jones and Wilson, “Photographs, privacy and public places”, at 360. See also Michalos, “*Douglas v Hello: The final frontier*”, at 204.

<sup>18</sup> For example, *CC v AB* [2006] EWHC 3083 (QB); *McKennitt v Ash* [2008] QB 73; *A v B&C* [2002] 2 All ER 545; *X v BBC* 2005 SLT 796; *Lord Browne of Madingley v Associated Newspapers Limited* [2008] 1 QB 103; *Murray v Big Pictures* [2008] EWCA Civ 446.

<sup>19</sup> For example, *Campbell v MGN* [2004] 2 AC 457; *Mosley v News Group Newspapers Ltd* [2008] EWHC 1777 (QB).

<sup>20</sup> Application No 44647/98, 28 January 2003.

<sup>21</sup> Application No 59320/00, 24 June 2004. See also *Sciacca v Italy* (no. 50774/99).

<sup>22</sup> See, for example, Richardson and Hitchens, “Celebrity Privacy”; Michalos, “*Douglas v Hello: The final frontier*”; Michalos, “Image rights and privacy: After *Douglas v Hello*”; Morgan, “Privacy, confidence and horizontal effect”; R Mulheron, “A potential framework for privacy? A reply to *Hello!*” (2006) 69 MLR 679; T Aplin, “The development of the action for breach of confidence in a post-HRA era” [2007] IPQ 19; A McLean and C Mackey, “Is there a law of privacy in the UK? A consideration of recent legal developments” [2007] EIPR 389; T Pinto, “A private and confidential update – not for publication” [2007] Ent LR 170; H Delany and C Murphy, “Towards common principles relating to the protection of privacy rights? An analysis of recent developments in England and France and before the European Court of Human Rights” [2007] EHRLR 568 (henceforth Delany and Murphy, “Towards common principles relating to the protection of privacy rights?”); Jones and Wilson, “Photographs, privacy and public places”; J Gibson, “A Right to My Public: Copyright, Human Right or Privacy?”, in F MacMillan and K Bowrey (eds), *New Directions in Copyright Law Volume 3*, 2006; Moreham, “Respect for private life”; Moreham, “Privacy in public places”. Wacks laments that the “voluminous literature... has failed to produce a coherent or consistent meaning” of the notion of privacy: R Wacks, “Why There Will Never be an English Common Law Privacy Tort”, in A Kenyon and M Richardson (eds), *New Dimensions in Privacy Law*, 2006, at 175.

<sup>23</sup> *Attorney-General v Guardian Newspapers* (No 2) [1990] 1 AC 109.

<sup>24</sup> [2008] QB 73.

<sup>25</sup> [2008] EWHC 1777 (QB).



(ii) where it is protected by virtue of its private nature, as in cases such as *Campbell v MGN*,<sup>26</sup> *CC v AB*,<sup>27</sup> and *Murray v Big Pictures*.<sup>28</sup> As Eady J noted in *Mosley v News Group Newspapers Limited*, the reason the law protects information which is private even if there is no relationship of confidence is “because the law is concerned to prevent the violation of a citizen’s autonomy, dignity and self-esteem.”<sup>29</sup>

In light of the fact that breach of confidence is now only part of the story, it is essential to consider when protection will arise absent an obligation of confidence.

### 2.3. A Reasonable Expectation of Privacy

Information will be protected under Article 8 where the recipient is subject to a duty of confidence<sup>30</sup> or where the information is private. The question then arises as to what constitutes private information. Judicial development – heavily influenced by Strasbourg jurisprudence – has moved away from assessing the existence of a right of privacy based on whether or not the incident or information was publicly available, and instead looks to whether the individual had a reasonable expectation of privacy. For example, in *Peck v The United Kingdom*<sup>31</sup> the reproduction on television and in the press of CCTV footage of Peck carrying a knife in Brentwood was an invasion of his right to privacy.<sup>32</sup> The ECtHR held that Peck “was in a public street but he was not there for the purposes of participating in a public event and he was not a public figure.”<sup>33</sup> The media publication of the CCTV images meant that his presence in the street “was viewed to an extent which far exceeded any exposure to a passer-by or to security observation... and to a degree surpassing that which the applicant could possibly have foreseen”.<sup>34</sup> The scope of the public dissemination of these images contravened Peck’s reasonable expectation of the degree of public exposure to which he would be subject. Similarly, the Court of Session in *X v BBC*

<sup>26</sup> [2004] 2 AC 457.

<sup>27</sup> [2006] EWHC 3083 (QB).

<sup>28</sup> [2008] EWCA Civ 446.

<sup>29</sup> [2008] EWHC 1777 (QB), para 7.

<sup>30</sup> As per the test in *Attorney General v Guardian Newspapers Limited (No 2)* [1990] 1 AC 109.

<sup>31</sup> Application No 44647/98, 28 January 2003.

<sup>32</sup> *Ibid.*

<sup>33</sup> *Ibid.*, para 62.

<sup>34</sup> *Ibid.*, para 62.



was prepared to accept that the pursuer had a stateable case in her privacy action, despite the fact that part of the personal information in question related to proceedings in open court.<sup>35</sup> As a result of cases such as these, “[i]t is no longer possible to draw a rigid distinction between that which takes place in private and that which is capable of being witnessed in a public place by other persons... a decision excluding privacy protection simply because the claimant was in public could now be subject to challenge in Strasbourg.”<sup>36</sup>

In *Campbell v MGN*,<sup>37</sup> however, the House of Lords was prepared to accept that there might be circumstances when a *public* figure in a public place could have no reasonable expectation of privacy:

We have not so far held that the mere fact of covert photography is sufficient to make the information contained in the photograph confidential. The activity photographed must be private. If this had been, and had been presented as, a picture of Naomi Campbell going about her business in a public street, there could have been no complaint. She makes a substantial part of her living out of being photographed looking stunning in designer clothing. Readers will obviously be interested to see how she looks if and when she pops out to the shops for a bottle of milk. There is nothing essentially private about that information nor can it be expected to damage her private life. It may not be a high order of freedom of speech but there is nothing to justify interfering with it.<sup>38</sup>

Following the decision of the ECtHR in *von Hannover*<sup>39</sup> and subsequent Court of Appeal decisions in England<sup>40</sup> this idea that “popping out for a bottle of milk” may be unprotected by privacy can no longer be said to be an accurate statement of the law. The decision in *von Hannover* indicated that even a public person in a public

<sup>35</sup> 2005 SLT 796.

<sup>36</sup> Moreham, “Privacy in public places”, at 610. See also *Hosking v Runting* [2004] NZCA 34, para 19.

<sup>37</sup> [2004] 2 AC 457.

<sup>38</sup> *Ibid.*, para 154, per Baroness Hale. This approach was explicitly influenced by the New Zealand judgment of *Hosking v Runting* [2004] NZCA 34. The contents of the photograph for which an injunction was sought and refused in *John v Associated Newspapers* were “akin to “popping out for a pint of milk”” and did not give rise to a reasonable expectation of privacy. [2006] EWHC 1611 (QB), paras 15 and 18.

<sup>39</sup> *Von Hannover v Germany* App no 59320, 24 June 2004.

<sup>40</sup> The difficulty of reconciling *Campbell* and *von Hannover* was grappled with by Patten J in *Murray v Big Pictures*, but his attempts to do so were not expressly followed by the Court of Appeal in that case, which instead focused on the fact that the claimant here was a child, distinguishing it from *Campbell* and *von Hannover*. For Patten J’s reasoning, see [2007] EWHC 1908 (Ch), especially paras 60-66; for the Court of Appeal see [2008] EWCA Civ 446, para 47 *et seq.*

place would have a reasonable expectation of privacy if she was not carrying out public duties, such that “the mere fact that someone is in some sense a public figure does not mean that she has no right of privacy when in a public place.”<sup>41</sup> Thus, whether or not one has a reasonable expectation of privacy no longer turns upon the distinction between

on the one hand, a person’s private recreational activities and, on the other hand, routine activities such as a walk down the street or a trip to the grocer’s to buy milk since, in some circumstances, the latter could also attract a reasonable expectation of privacy.<sup>42</sup>

Recent guidance from the Press Complaints Commission echoes this conclusion, by stating that photographs should not be taken of people in private places without their consent, and it defines “private places” as “public or private property where there is a reasonable expectation of privacy”.<sup>43</sup>

Only where the information in question is already widely available will a particular remedy be denied, as in *Mosley*, where it was held that there could be no reasonable expectation of privacy, sufficient to warrant an injunction, in respect of images which were already widely available, although damages were still available.<sup>44</sup> Further, Lord Phillips in *Douglas v Hello!* in the Court of Appeal, opined that the publication of images could infringe the claimant’s privacy, even where these images had previously been published:

Insofar as a photograph does more than convey information and intrudes on privacy by enabling the viewer to focus on intimate personal detail, there will

<sup>41</sup> Jones and Wilson, “Photographs, privacy and public places”, at 357.

<sup>42</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.4.4(b). A recent example of just such a trip to the shops being protected is *Murray v Big Pictures* [2008] EWCA Civ 446. In an earlier case, *John v Associated Newspapers*, Eady J did make reference to the position of the claimant’s feet in the photograph in question, noting that “his feet are still on the public street”, but this observation was caveated with the words “[i]nsofar as it still matters”, [2006] EWHC 1611 (QB), para 4.

<sup>43</sup> See the Press Complaints Commission’s Code of Practice at Article 3 and the Note thereto: <http://www.pcc.org.uk/cop/practice.html> (accessed 24 June 2008).

<sup>44</sup> [2008] EWHC 687 (QB). This was the (unsuccessful) action for an injunction to stop the News of the World from posting video footage of the S&M session on its website. The subsequent action by Mosley for infringement of privacy raised, amongst other issues, a different question as to loss of the right to privacy because of the extent of prior public exposure: Eady J was asked to consider the argument that “the Claimant forfeited any expectation of privacy partly because of the numbers involved; that is to say, with so many participants [in the S&M session] it should not be regarded as private. This was coupled with reliance upon the fact that he liked to record these gatherings on video, with the consent of all those present, so as to have a “memento”.” Eady J rejected this argument and upheld the claimant’s privacy action, awarding damages of £60,000. [2008] EWHC 1777 (QB), paras 109 and 236.

be a fresh intrusion of privacy when each additional viewer sees the photograph and even when one who has seen a previous publication of the photograph, is confronted by a fresh publication of it.<sup>45</sup>

Whether repeated publication will infringe an individual's reasonable expectation of privacy is likely to depend on the facts of the case, particularly the extent of the previous circulation:<sup>46</sup> a noticeable divergence from "pure" breach of confidence actions.<sup>47</sup>

Even in circumstances where the party attempting to disclose has a connection with the event or information in question, the courts have been prepared to uphold the claimant's reasonable expectation of privacy and refuse the right to publish. In *CC v AB*<sup>48</sup> the information in dispute was highly personal, but arguably not particularly worthy of protection: the intimate relationship to be disclosed in the tabloids was adulterous. As Eady J. observed "even an adulterous relationship may attract, at least in certain respects, a legitimate expectation of privacy."<sup>49</sup> In addition, as is clear from *Mosley v News Group Newspapers Limited*, the party seeking to disclose may be subject to a duty of confidentiality, as per "pure" breach of confidence cases, even where she is also involved in, or part of, the information to be disclosed. Thus, a member of an S&M group was in breach of her duty of confidence to all other participants by recording and selling details of an S&M session, regardless of her wish to disclose it.<sup>50</sup> In the very different factual circumstances of *McKennitt v Ash*<sup>51</sup> there was also an "old-fashioned breach of confidence by way of conduct inconsistent with a pre-existing relationship".<sup>52</sup> Ash's claim that the information also concerned her was insufficient to overcome this obligation of confidence.<sup>53</sup>

<sup>45</sup> [2006] QB 125, para 105.

<sup>46</sup> See Moreham, "Privacy in public places", at 612 and 615-616.

<sup>47</sup> *Ibid.*; Michalos, "*Douglas v Hello: The final frontier*".

<sup>48</sup> [2006] EWHC 3083 (QB).

<sup>49</sup> *Ibid.*, para 30. In fact, the judge appeared to have considerably more sympathy for the adulterous claimant than for the defendant who sought "revenge" and "some financial gain" (para 10) and who demonstrated "remarkable hypocrisy" (para 28).

<sup>50</sup> [2008] EWHC 1777 (QB), paras 105-108. This presumably overturns, or can be distinguished from, Ouseley J's view that prostitutes do not owe a duty of confidentiality to their clients: *Theakston v MGN Ltd* [2002] EWHC 137 (QB), paras 73-75.

<sup>51</sup> [2008] QB 73.

<sup>52</sup> *Ibid.*, para 8.

<sup>53</sup> *Ibid.*, paras 28-32.

Not all commentators have welcomed these developments. In Michalos's analysis "[w]here the image is actually private, privacy should be respected, but there is a slow creep into the right to take photographs of people in public places that is not to be welcomed."<sup>54</sup> Even where the photographs are taken in a private or controlled place – as in *Douglas* – such that the information in them is inaccessible, Michalos queries whether the law should protect something which is trivia and thus not inherently private. Yet the Court of Appeal did not assess the privacy of these images according to their nature as "trivial tittle-tattle"<sup>55</sup> but rather according to the ECtHR approach of determining whether there was a reasonable expectation of privacy.<sup>56</sup> It is suggested that this is in fact the correct approach when the action is based on Article 8 privacy rights,<sup>57</sup> although different considerations may arise when the action of breach of confidence is used in a commercial context.<sup>58</sup>

A final factor is likely to be the nature of the information, with the highly personal details of Campbell's medical treatment for drug addiction and the sexual predilections of Mosley, for example, both being regarded as intimate matters which carried a high expectation of privacy. As Fenwick and Phillipson note, based on such factors of sensitivity and intimacy, the "Article 8 interest can thus be weighted."<sup>59</sup>

These cases indicate that the basis for enforcing one's Article 8 privacy rights, as most recently affirmed by the Court of Appeal in *Murray*<sup>60</sup> and by Eady J in

<sup>54</sup> Michalos, "Image rights and privacy: After *Douglas v Hello*", at 387.

<sup>55</sup> *Ibid.*, at 386.

<sup>56</sup> See *Ibid.*, at 387 for her analysis of *von Hannover* and its impact on English law.

<sup>57</sup> While it could be argued that the more trivial something is, the less likely it will be that a reasonable expectation of privacy will arise, nonetheless it is suggested that this test is not relevant in cases of privacy. It arises in breach of commercial confidence to ensure that protection is granted to material which "merits protection because it is potentially of value" (per Carty, "The modern action for breach of commercial confidence", at 436), yet value is not the rationale for protecting information under Article 8.

<sup>58</sup> For an analysis of the role of breach of confidence in protecting commercial or trade secrets, see Carty, "The modern action for breach of commercial confidence".

<sup>59</sup> Fenwick and Phillipson, *Media Freedom*, at 779.

<sup>60</sup> *Murray v Big Pictures* [2008] EWCA Civ 446, para 39. See also paras 35 and 36. Leave to appeal this decision to the House of Lords was refused on 27 October 2008:

<http://www.publications.parliament.uk/pa/ld200708/minutes/081028/ldordpap.htm#judbus> (accessed 8 November 2008).

*Mosley*,<sup>61</sup> is whether the individual has a reasonable expectation of privacy. This is influenced by factors such as the nature of the information, the nature of any relationship between the parties,<sup>62</sup> particularly whether or not a duty of confidence was owed,<sup>63</sup> the way in which the information was obtained,<sup>64</sup> and the location.<sup>65</sup> The *Murray* case also suggests that children (or their parents on their behalf) will have a higher expectation of privacy.<sup>66</sup>

One element which may operate to reduce (albeit not necessarily to negate<sup>67</sup>) the reasonable expectation of privacy is the prior conduct of the claimant. Where the information sought to be disclosed is intended to correct a prior lie that the claimant has propagated, the courts are likely to recognise the public interest in the publication.<sup>68</sup> This was the situation in *Campbell v MGN*, where the House of Lords agreed that MGN were at liberty to publish the fact that Campbell used illegal drugs, since this revelation would correct the prior misleading image created by Campbell's adoption of an anti-drugs stance. The use of photographs of Campbell outside the Narcotics Anonymous venue to illustrate the story was, however, excessive and thus infringed her privacy.<sup>69</sup>

Case law over the last eight years has shown a gradual convergence of contrasting European approaches to privacy.<sup>70</sup> Whereas French law has traditionally afforded

<sup>61</sup> [2008] EWHC 1777 (QB), para 7.

<sup>62</sup> Delany and Murphy, "Towards common principles relating to the protection of privacy rights?", at 580, citing *Browne v Associated Newspapers Ltd* [2008] 1 QB 103.

<sup>63</sup> As for example in *McKennitt v Ash* [2008] QB 73.

<sup>64</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777 (QB), para 17, per Eady J. The covert nature of the photography in *Douglas* and *Campbell* arguably points towards the claimants' reasonable expectations of privacy. See also Moreham, "Privacy in public places", at 628-632.

<sup>65</sup> Moreham, "Privacy in public places", at 621-623.

<sup>66</sup> [2008] EWCA Civ 446. Contrast *Hosking v Runting* [2004] NZCA 34, where the court looked for evidence of a "serious risk" to the children (para 159).

<sup>67</sup> See for example the analysis by A McLean and C Mackey, "Is there a law of privacy in the UK? A consideration of recent legal developments" [2007] EIPR 389, at 393.

<sup>68</sup> Gordley puts forward an interesting critique of this, suggesting that in some cases hypocrisy is preferable to the disclosure of vice: *Foundations of Private Law: Property, Tort, Contract, Unjust Enrichment*, 2006, at 236.

<sup>69</sup> Photographs may well be treated as particularly intrusive, as Campbell illustrates. This is echoed in *John v Associated Newspapers Ltd*, where the claimant only sought to restrain publication of a photograph, and not the accompanying text. [2006] EWHC 1611 (QB), para 3.

<sup>70</sup> Although differences do remain. For analysis of both convergence and continuing differences see, for example, Waelde and Whitty, "A Rights of Personality Database", para 11.8.2; Delany and Murphy, "Towards common principles relating to the protection of privacy rights?".

“almost startlingly high levels of protection”<sup>71</sup> for privacy, it now gives increased recognition to the importance of the freedom of the press, influenced in part by the ECtHR. Conversely, the traditionally media-friendly approach in English law, and even the more balanced German approach to privacy, is being strengthened in favour of the private life of the individual as a result of the Strasbourg jurisprudence.<sup>72</sup>

Article 8 will therefore be engaged if there is “a reasonable expectation of privacy in the sense that a reasonable person in [the claimant’s] position would feel that the Photograph should not be published.”<sup>73</sup> If Article 8 is engaged, “the next question would be how the balance should be struck as between the individual’s right to privacy on the one hand and the publisher’s right to publish on the other”,<sup>74</sup> thereby taking account of the defendant’s Article 10 right to publish. It is thus necessary to examine the right of freedom of expression under Article 10.

## 2.4. Freedom of Expression

Article 10 guarantees the right to freedom of expression, but this right is subject to “such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society... for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence”.<sup>75</sup> Thus, Article 8 can operate to limit the extent of the Article 10 right. Conversely, Article 8 may be limited by such interference as is necessary in a democratic society, for example for the protection of the rights and freedoms of others.<sup>76</sup> Both rights are of equal importance, and both must recognise limitations arising from the other.<sup>77</sup>

<sup>71</sup> Delany and Murphy, “Towards common principles relating to the protection of privacy rights?”, at 569.

<sup>72</sup> *Ibid.*, paras 572-574 and 581-582.

<sup>73</sup> *Murray v Big Pictures* [2008] EWCA Civ 446, para 39. See also paras 35 and 36.

<sup>74</sup> *Ibid.*, para 40.

<sup>75</sup> Convention for the Protection of Human Rights and Fundamental Freedoms, Rome, 4.XI.1950, Article 10(2).

<sup>76</sup> *Ibid.*, Article 8(2).

<sup>77</sup> *Campbell v MGN* [2004] 2 AC 457, para 113, per Lord Hope; *In re S* [2005] 1 AC 593, para 17, per Lord Steyn. For commentary on this point, see Delany and Murphy, “Towards common principles relating to the protection of privacy rights?”, at 570; HL MacQueen, “A Hitchhiker’s Guide to Personality Rights in Scots Law, Mainly with Regard to Privacy”, in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009; Fenwick and Phillipson, *Media Freedom*, at 691.



This legal background can be contrasted with that in America, where the First Amendment right to free speech is typically paramount at the expense of other interests: “[t]he un-balanced American approach flows from factors peculiar to that jurisdiction, namely the absolute nature of the First Amendment, and the fact that it is not balanced by any constitutional right to *informational* privacy.”<sup>78</sup>

In the UK, and indeed in Europe, once the claimant’s Article 8 right has been engaged the courts are required to balance it with Article 10, to determine if the defendant’s right to freedom of expression justifies the intrusion into the claimant’s privacy. Since neither right takes priority, the courts must assess the interests at stake on each occasion, and this balancing process involves

what is sometimes called an “intense focus” on the facts, that is, a sensitive, nuanced and contextually specific examination of the particular factual circumstances of each case, incorporating an evaluation and attachment of weight to both of the competing interests.<sup>79</sup>

Eady J has expressly stated that broad generalisations of the kind used in the past – such as “public figures must expect to have less privacy” – are now incompatible with this process. Such “generalisations can never be determinative. In every case “it all depends” (i.e. upon what is revealed by the intense focus on the individual circumstances).”<sup>80</sup>

When carrying out this balancing exercise, however, one of the key tests is the public interest.<sup>81</sup> It has been observed that “what interests the public is not necessarily in

<sup>78</sup> G Phillipson and H Fenwick, “Breach of confidence as a privacy remedy in the Human Rights Act era” (2000) 63 MLR 660, at 686. See also *Hosking v Runting* [2004] NZCA 34, para 73. *Contra* Coombe, who fears that “[w]hen “public” speech interests come up against “private” property interests, the latter almost invariably triumph, ensuring that “the law insulates vast sectors of the social hierarchy from official scrutiny and public accountability””, “Author/izing the celebrity”, at 390, footnote omitted.

<sup>79</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.5. The language of “intense focus” comes from *In re S* [2005] 1 AC 593, para 17, per Lord Steyn. For an analysis of this balancing process, and the divergence between the common representation of it as “a bout between two bruisers” and the more nuanced theoretical basis, see R Wacks, “Why There Will Never be an English Common Law Privacy Tort” in A Kenyon and M Richardson (eds), *New Dimensions in Privacy Law*, at 169-173.

<sup>80</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 12.

<sup>81</sup> Fenwick and Phillipson assert that “the weight of any claim under Article 10 should be assessed by reference to the contribution that the publication in question makes to a debate of serious public

the public interest”.<sup>82</sup> Instead, “[t]he judge will often have to ask whether the intrusion, or perhaps the degree of the intrusion, into the claimant’s privacy was proportionate to the public interest supposedly being served by it.”<sup>83</sup> Whether publication is in the public interest will depend on a number of factors, the first being whether the information can be said to “contribute to any debate of general interest to society”.<sup>84</sup> Eady J applied this test in *Mosley*, noting that the “debate” prompted by the *News of the World’s* publication of the story in question was unlikely to be that envisaged by the ECtHR in *von Hannover*.<sup>85</sup>

The public interest may also depend upon a number of specific factors, including the disclosure of criminality,<sup>86</sup> the need to correct lies,<sup>87</sup> and the nature of the use to be made of the information in order to serve the public interest. As a general rule, political speech can expect to be afforded greater weight (and therefore be more likely to be protected against competing rights by Article 10) than that attaching to artistic expression or commercial expression.<sup>88</sup> However, even where such public interest factors are present, disclosure will not always be justified. In the words of Eady J:

Would it justify installing a camera in someone’s home, for example, in order to catch him or her smoking a spliff? Surely not. There must be some limits and, even in more serious cases, any such intrusion should be no more than is proportionate.<sup>89</sup>

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concern”, *Media Freedom*, at 780. See also Moreham, “Privacy in public places”, at 627; T Aplin, “The development of the action for breach of confidence in a post-HRA era” [2007] IPQ 19, at 44-51.

<sup>82</sup> *McKennitt v Ash* [2008] QB 73, para 66. See also *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 114; and *Douglas v Hello!* [2006] QB 125, para 254, where the public interest is contrasted with “public curiosity”.

<sup>83</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 14.

<sup>84</sup> As formulated by the ECtHR in *Von Hannover v Germany* App no 59320, 24 June 2004, para 65, and see also paras 60, 63, 66 and 76.

<sup>85</sup> [2008] EWHC 1777, para 132.

<sup>86</sup> *Ibid.*, paras 110-121.

<sup>87</sup> *Campbell v MGN* [2004] 2 AC 457, para 58 and also para 117, where it was accepted that the public had an “undoubted” right to know that Campbell had misled them as regards drug taking.

<sup>88</sup> *Ibid.*, para 117, per Lord Hope, with reference to *Clayton and Tomlinson: The Law of Human Rights*, 2000. In a pre-*Campbell* article, Munro notes that “[i]n the Strasbourg case law, it appears that the necessity of a legitimate interference is more readily accepted when the instance of expression is categorised as commercial speech”, “The value of commercial speech” (2003) 62 CLJ 134, at 141. He then concludes that it would be preferable for the “English courts to treat issues of freedom of expression on their merits *without* engaging in a classification of the subject matters as involving “commercial speech” or not and without, therefore, allowing anything to turn upon such a distinction.” (at 158, his emphasis.) See also Fenwick and Phillipson, *Media Freedom*, at 689-690.

<sup>89</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 112.



And respecting privacy itself has been recognised to be in the public interest.<sup>90</sup>

Despite judicial and academic guidance on the nature and extent of the public interest, “there continues to be a difference of opinion on the extent to which certain material, particularly relating to the private lives of celebrities, contributes to debate on matters of legitimate public concern.”<sup>91</sup> In all cases, the balancing test will come down to what is proportionate in the circumstances. However, recent decisions have tended to favour the individual’s right of privacy at the expense of freedom of expression: “despite the continuing theoretical presumption of equality as between the two articles, significant restrictions have been placed on the enjoyment of Art. 10 rights in order to protect a right to privacy.”<sup>92</sup>

## 2.5. Summary

In 2009, judicial protection of privacy can thus be said to arise under breach of confidence and Article 8 in one of two ways, depending on whether the information is confidential or whether it is allegedly private and the individual had a reasonable expectation of privacy. Once Article 8 is engaged, the court will usually have to balance the pursuer’s Article 8 interests with the defender’s Article 10 interests, to determine, on the facts of each case, which right should be protected.

The alliance of breach of confidence and Article 8 has not only been used to protect against unwelcome dissemination of details of private lives. It has also featured successfully in one case which involved the *commercial* exploitation of an individual’s private information: *Douglas v Hello!*. Here, the Douglases sought to use privacy to claim against Hello! for its unauthorised publication of their wedding photographs (that is, enforcing their negative right) while at the same time granting

<sup>90</sup> *Ibid.*, para 130.

<sup>91</sup> Delany and Murphy, “Towards common principles relating to the protection of privacy rights?”, at 574.

<sup>92</sup> *Ibid.*, at 570. Similarly, Fenwick and Phillipson refer to the current Strasbourg jurisprudence as revealing “a strikingly restrictive view of the role of the press”: *Media Freedom*, at 695.

the right to OK! to publish photographs of the same event (that is, exploiting their positive power). This evidence of commercial exploitation of publicity on the one hand and an attempt to restrict publication on the other, has led to the conclusion that *Douglas* is a publicity action masquerading as a privacy action.<sup>93</sup> Can privacy, as developed under Article 8, operate to protect the publicity interests of individuals?

### 3. PUBLICITY AS A PRIVACY RIGHT

#### 3.1. Introduction

Having established the parameters of the right to privacy, it is now possible to assess whether or not this right can operate as the basis for a right of publicity in Scots law. Waelde and Whitty assert that privacy and publicity are “fundamentally two sides of the same coin, namely, the right to prevent and to control the dissemination of one’s image.”<sup>94</sup> Whereas privacy is based on the need to protect dignitarian interests, however, publicity is the “extra-patrimonial right to privacy and identity or image... [which] entails the right to prohibit others from disclosing or disseminating it and a right of a patrimonial character to commercial exploitation of the personal information by waiver or licensing.”<sup>95</sup>

Publicity can be seen as a daughter of privacy or, less flatteringly, as privacy’s “underbelly”,<sup>96</sup> its key trait being the commercial exploitation, by waiver or licence,

<sup>93</sup> This is a popular claim: see for example J Phillips and A Firth *Introduction to Intellectual Property Law*, 4<sup>th</sup> ed, 2001, para 20.21, where they claim that the role of breach of confidence in this case was “perhaps more akin to a right of publicity than to a right of privacy”. Whitty describes use of privacy in cases such as the *Douglasses*’ as a “mere pretence”, in “Overview of Rights of Personality in Scots Law”, para 3.4.9. Carty refers to the *Douglasses*’ “hidden agenda” in “The quest for the IP effect”, at 253. See also R Mulheron, “A potential framework for privacy? A reply to *Hello!*” (2006) 69 MLR 679, at 700; Michalos, “Image rights and privacy: After *Douglas v Hello!*”, at 385; Richardson and Hitchens, “Celebrity Privacy”, at 251; and N Gardner and K Brimstead, “Confidential information – damages” [2005] EIPR N190, at N191.

<sup>94</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.4.5; *contra* Carty, “Advertising, publicity rights and English law”, at 212-215.

<sup>95</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9. This definition owes much to the Civilian understanding of such rights, see Chapter 2, section 2.2.

<sup>96</sup> To use Cornish and Llewelyn’s phrase: *Intellectual Property*, para 9-04.

of personal information and identity which could otherwise be kept private, at the option of the individual.

When the Douglases sought to recover from Hello! for publication of unauthorised photographs of their wedding, it was this newly-emerging concept of privacy upon which they relied. In the words of the Court of Appeal:

Applying the test propounded by the House of Lords in *Campbell v MGN*, photographs of the wedding plainly portrayed aspects of the Douglases' private life and fell within the protection of the law of confidentiality, as extended to cover private or personal information.<sup>97</sup>

This view was upheld, albeit not as the direct subject of the appeal, in the House of Lords.<sup>98</sup> Further, the initial publication of the authorised photographs by OK! did not operate to deprive the Douglases of their privacy regarding the unauthorised images.<sup>99</sup>

*Douglas* also demonstrates the dual aspects of publicity, both of which must be examined against our understanding of privacy established above. In enforcing the *negative* right to prevent unauthorised use, what role does the current privacy action have to play? And can waiver of privacy constitute the *positive* power to exploit? Three areas will be considered below in order to determine whether the right of publicity identified in Chapter 3 can be protected through the right of privacy.

### 3.2. The Need for a Reasonable Expectation of Privacy

Whether an Article 8 remedy is available depends on whether there is a reasonable expectation of privacy. As with *Douglas*, where the claimant can demonstrate this, the unauthorised use will, on the face of it, be remediable.

<sup>97</sup> [2006] QB 125, para 95.

<sup>98</sup> [2008] 1 AC 1. Even Lord Walker, in the minority, was prepared to indicate support for the decision of the Court of Appeal: "I should not be taken as expressing the view that the judge and the Court of Appeal were wrong about the modest awards of damages made in their [the Douglases'] favour." (para 295.)

<sup>99</sup> See section 2.3 above. Michalos points out that this decision has granted the Douglases what is in effect a permanent injunction against publication of the unauthorised images: "*Douglas v Hello: The final frontier*", at 245-246.

When this test is applied to two of the cases advanced as paradigm publicity cases in Chapter 3, we see the limits of Article 8 as a basis for publicity cases. In *Irvine v Talksport Ltd*,<sup>100</sup> the element of persona used (Irvine's image) was a publicly available photograph, which was not provided in circumstances of confidence nor was it such as to give rise to a reasonable expectation of privacy. So too with the subject matter in *Lyngstad v Anabas*, where the photographs used on the badges and pillowcases were obtained by way of copyright licence from the studios responsible.<sup>101</sup> Even if the claimants in these cases had tried to demonstrate a reasonable expectation of privacy in respect of the particular images used, the defendants would have been able to avail themselves of the defence that the images, and the information they contained, were already widely known.<sup>102</sup> There could therefore be no privacy-based action in these instances, yet the claimants suffered a wrong which, in Irvine's case, was remediable under another tort.

An Article 8 action is relevant where the aim is to keep information out of the public domain – even if, as in *Douglas*, the claimant intends to make subsequent use of that information through his own exploitation of it. Where the publicity action arises from a fact situation in which there could be no claim for privacy,<sup>103</sup> then the basis for the publicity action must be sought elsewhere, as indeed happened in *Irvine* and *Lyngstad*.

Moreover, Article 8 is concerned with personal information, yet the subject matter of a publicity right is *persona*. This concept, as defined in Chapter 3, includes personal information, but also extends to name, image, indicia and reputation. While an image or representation of an individual is undoubtedly capable of conveying information – as in *Douglas v Hello!* – in many cases the “information” in question

<sup>100</sup> [2003] 2 All ER 881.

<sup>101</sup> [1977] FSR 62, at 65, per Oliver J.

<sup>102</sup> This is in contrast to *Douglas v Hello!*, where the unauthorised images were not publicly available – a (controversial) factor which played a key role in the House of Lords decision. See section 3.4.3 below.

<sup>103</sup> The alternative principle of inaccessibility under the “traditional” doctrine of breach of confidence has been analysed by Carty, “The modern action for breach of commercial confidence”. However, this is of limited value since, as Carty notes, the two actions have very different rationales (at 428).

will be negligible, as in *Irvine v Talksport*. A further obstacle to raising a privacy action in *Irvine* would therefore be the lack of information which was exploited by Talksport: the focus of the action was the image and associated reputation.<sup>104</sup> Privacy actions, which protect information that gives rise to a reasonable expectation of privacy, are therefore too narrow in scope to accommodate use of material which may not be private and may only constitute information in the loosest sense. Even where no private information is conveyed by an image, its use may impact upon the individual's autonomy and dignity, and may have a commercial value to authorised exploiters.

Thus, privacy under Article 8 is too narrow a basis for publicity rights. The publicity use, as identified in Chapter 3, stretches further than infringement through the unauthorised dissemination of private information. Instead, it encompasses unauthorised public use of *persona*, whether or not that persona is subject to an obligation of confidence or a reasonable expectation of privacy, and whether or not that persona constitutes "information" *per se*.

### 3.3. Private Information: Invasion versus Dissemination

The taking of the photograph, private possession of the photograph and the publication of the photograph are entirely separate. So far it is publication that has been enjoined but we may be moving into a world where delivery up of the original images is on the cards if the complaint is the actual act of photography.<sup>105</sup>

One distinction which is not always made explicit in privacy cases under Article 8 is whether the infringement arises from the *invasion* or from the subsequent *dissemination* of the private elements. For example, Eady J in *Mosley* refers to the action being "breach of confidence and/or the unauthorised *disclosure* of personal information".<sup>106</sup> Although "[m]ost of the decided cases are concerned with the

<sup>104</sup> *Irvine & Others v Talksport Ltd* [2003] 2 All ER 881.

<sup>105</sup> Michalos, "Image rights and privacy: After *Douglas v Hello*", at 385.

<sup>106</sup> [2008] EWHC 1777 (QB), para 3, emphasis added. See also, for example, the judgment of Patten J in *Murray v Big Pictures (UK) Ltd* [2007] EWHC 1908 (Ch), where he observed that such Article 8 claims call upon the courts to prevent dissemination by "imposing limitations on the publication of events which were visible to any member of the public who happened to be around at the time." (para

publication of the offending photographs... in some cases there may be antecedent acts which ought also to be wrongful.”<sup>107</sup>

This distinction undoubtedly needs to be made, since the Article 8 right to private life has been used in much wider circumstances than publication of private information. Such cases have involved invasions of privacy arising from, for example, strip-searching,<sup>108</sup> covert surveillance,<sup>109</sup> or stalking.<sup>110</sup> Even the simple act of taking a photograph could, in theory, breach an individual’s privacy.<sup>111</sup> These diverse ways in which privacy can be infringed, together with the cases already examined in this Chapter, reflect Prosser’s analysis of privacy, wherein he identified four distinct ways in which privacy can be invaded:<sup>112</sup>

1. Intrusion upon the plaintiff’s seclusion or solitude, or into his private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation, for the defendant’s advantage, of the plaintiff’s name and likeness.

Only the last of these can be aligned to the publicity right under investigation.

The breadth of this privacy action is in marked contrast to a publicity action which, by its nature, arises from the unauthorised dissemination, rather than the antecedent invasion. As noted in Chapter 3, it is a key element of the publicity right (and wrong) that the use must involve an element of public use. This can be illustrated by an unreported Scottish criminal case from 2008. The accused pled guilty to a breach of the peace arising from his actions in photographing a young woman in a street in

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20, emphasis added.) This was followed in the Court of Appeal, which referred to the principles in cases of “wrongful publication of private information.” *Murray v Big Pictures* [2008] EWCA Civ 446, para 27.

<sup>107</sup> Jones and Wilson, “Photographs, privacy and public places”, at 359. See also Moreham, “Privacy in public places”; Morgan, “Privacy, confidence and horizontal effect”.

<sup>108</sup> *Wainwright v Home Office* [2004] 2 AC 406, albeit the Human Rights Act 1998 did not apply retrospectively in this case. Note also Lord Hoffmann’s observation in this case that the courts have refused to formulate a general principle of “invasion of privacy”, para 19.

<sup>109</sup> *Martin v McGuinness* 2003 SLT 1424; *Howlett v Holding* [2006] EWHC 41 (QB).

<sup>110</sup> *Ward v Scotrail* 1999 SC 255.

<sup>111</sup> Moreham, “Privacy in public places”, at 633-635.

<sup>112</sup> Prosser, “Privacy”, at 389.

Edinburgh. Feeling unwell, the woman had left a bar in the city centre and gone outside for air, where the accused took photograph(s) of her.<sup>113</sup> Sheriff Hogg apparently commented that “[t]he lady concerned was entitled to her privacy and not to have a passing stranger take a photograph”.<sup>114</sup> While this may or may not constitute a civil wrong under the law of privacy, it is difficult to see where any *publicity* complaint could lie, unless or until the photographer disseminated the image. Merely taking the photograph would not infringe the media information, promotion or merchandising uses.

This distinction highlights one of the differences between privacy and publicity: while privacy can be breached by the invasion *or* the subsequent dissemination of information, a publicity action is concerned only with the dissemination or public use of persona. Privacy is effectively concerned with inward-looking actions as well as their external communication, whereas publicity’s concern is control of the external-facing persona, being what is brought to the public attention. Article 8 privacy rights are therefore in this sense much broader than the right sought by publicity – in contrast to the test of a reasonable expectation of privacy, which was concluded to be too narrow to support a publicity action. While this does not necessarily preclude privacy as the basis of a right of publicity, it does indicate that there is not a terribly close fit between the two rights.

### 3.4. Positive Exploitation

While the previous two sections have considered problems with using privacy rights to protect the negative right of publicity, or unauthorised use, this section assesses whether or not privacy can offer a route to enable positive exploitation of persona, through consensual use. This requires analysis of the right as between the individual and the exploiter, and between the exploiter and unauthorised users.

<sup>113</sup> This case was reported by the BBC on 3 October 2008: [http://news.bbc.co.uk/1/hi/scotland/edinburgh\\_and\\_east/7651107.stm](http://news.bbc.co.uk/1/hi/scotland/edinburgh_and_east/7651107.stm) (accessed 8 October 2008). To date, no case report has been located, and given the guilty plea there may not be one.

<sup>114</sup> As per the BBC report: [http://news.bbc.co.uk/1/hi/scotland/edinburgh\\_and\\_east/7651107.stm](http://news.bbc.co.uk/1/hi/scotland/edinburgh_and_east/7651107.stm).



### 3.4.1. *Waiving the Right to Privacy*

Once an individual has a right to exclude others from a sphere of his life, a potentially lucrative market then arises in which to *waive* the right, in return for a fee. The control of private information which results from breach of confidence/Article 8 enables the individual to exploit this control as he chooses. Morgan observes that “an injunction... would naturally place the protected party in a position to exploit his image commercially – by negotiating payment to release it”.<sup>115</sup> Such controlled waiver of privacy arguably creates the possibility of publicity in respect of any material covered by confidence and privacy. Where an individual is willing to reveal truths for a price, as in *Douglas*, there is no breach of confidence and no interference with the individual’s private life, because the individual has consented to this dissemination of information: he has waived his right to be let alone. However, whether this is sufficient to constitute a *right* of publicity remains to be seen.

Certainly, this interpretation of the logical consequence of privacy protection (in practical terms, at any rate) has considerable attraction for those keen to exploit any interest in their personal lives. Yet it perhaps ignores the commercial basis of such deals: “in reality, advertisers would not pay famous people such as sports and entertainment personalities for giving up their privacy, but would pay because such persons’ images already had a “recognition value”.”<sup>116</sup> It is this recognition value which was identified<sup>117</sup> as being a key ingredient in much publicity practice, exploited through use of physical representations such as name, image and information.

This leads to an initial obstacle with waiver of privacy rights, arising from the slightly different subject matter of privacy and publicity rights, noted earlier. Whereas privacy offers protection for private information, publicity seeks protection for *persona*. Thus, a positive power to exploit publicity cannot be constituted by the waiver of a privacy right in respect of non-private images (such as those in *Irvine*).

<sup>115</sup> Morgan, “Privacy, confidence and horizontal effect”, at 450. See also Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9; Colston and Middleton, *Modern Intellectual Property Law*, para 18.7.5.

<sup>116</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 59, footnote omitted.

<sup>117</sup> Chapter 3, section 3.2.



Nevertheless, it is necessary to consider whether waiver can operate to provide a positive power to exploit.<sup>118</sup> Those who advocate the derivation of the right of publicity from the prior right of privacy effectively argue for a right to exploit the interest in private images or information through waiver: if “either English or Scots law were to recognise a common law or delictual right to privacy against individuals, it would enable anyone to protect information and images concerning them, and indirectly allow a right to publicity”.<sup>119</sup> But if the right to privacy cannot be waived, then no positive power can be derived from this right. Although the private law right of breach of confidence *could* be waived, it is less easy to separate out the human rights aspect of this right, and the question of whether or not human rights can be waived is not an easy one to answer.

Some writers believe that “[h]uman rights, by doctrine, can – and in fact should – not be transferred, waived or inherited”<sup>120</sup> and certainly it is troubling to conceive of the right to life or to freedom from torture being capable of waiver: no-one is likely to advocate consent or waiver operating as a defence to murder.<sup>121</sup> However, it remains the case, as stated by Reid and Blackie in the context of personal bar, that “[t]here is no rule that rights enshrined in the ECHR may in no circumstances be waived.”<sup>122</sup> It is therefore possible in theory for an individual to contract to waive his right to privacy.

It has, however, been recognised that it is difficult (and often undesirable) to establish *implied* waiver:

the fact that an individual has disclosed personal information on one or more occasions cannot readily be taken to signify that he or she has abandoned the

<sup>118</sup> This discussion takes place in the context of waiver of rights in Scots law in general, and against the specific background of waiver of a right to privacy derived from Article 8 ECHR. For an analysis of waiver of Civilian personality rights, see Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(b), (c), and (d).

<sup>119</sup> Colston and Middleton, *Modern Intellectual Property Law*, para 18.7.5.

<sup>120</sup> Klink, “50 years of publicity rights in the US”, at 381.

<sup>121</sup> EC Reid and J Blackie, *Personal Bar*, 2006, (henceforth Reid and Blackie, *Personal Bar*) para 18-10.

<sup>122</sup> *Ibid*, para 18-10. See also para 5-17.

right to protect the confidentiality of similar matters on an open-ended basis.<sup>123</sup>

It is therefore perfectly possible for an individual to court publicity in relation to one personal issue, while rigorously maintaining his privacy (and the commercial value of that privacy) in another.<sup>124</sup> Using waiver cannot defeat an ongoing right but, at the same time, it does demonstrate a potential ability for an individual to control what elements of privacy they will waive, and when. Despite this, it is hard not to sympathise with the view that “human rights based concepts... are not well suited to protect comprehensively the value of popularity. They fail to secure damages and can stand in the way of essential trade requirements”.<sup>125</sup>

Further, waiver operates to remove the granter’s right of action against the “infringer”, rather than making the use legal.<sup>126</sup> The third party user therefore only gains the right as against the person granting the waiver, and would have no defence against any other individual who may have an action, such as a second person featured in the private images.<sup>127</sup> Waiver of a privacy right may be a pragmatic response to publicity exploitation, but it is less satisfactory than the positive grant of a publicity right.

### **3.4.2. Third Party Rights Derived from Waiver**

Even if waiver were to be accepted as a valid method of enabling the dissemination of otherwise private information, it is also necessary to consider the extent of the grant and the consequences of this for the third party. Specifically, where a third party (such as a newspaper) has paid for the exclusive right to publish otherwise

<sup>123</sup> *Ibid.*, para 18-11. This applies with even greater force when the publicity sought comes *after* the infringement of privacy: *Peck v UK*, Application No 44647/98, 28 January 2003, para 86.

<sup>124</sup> As for example per *McKennitt v Ash* [2008] QB 73; see also Moreham, “Privacy in public places”. The same applies in Civilian jurisdictions: Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(c).

<sup>125</sup> Klink, “50 years of publicity rights in the US”, at 381.

<sup>126</sup> For example, see *Haelan Laboratories v Topps Chewing Gum Inc* 202 F 2d 866 (2<sup>nd</sup> Cir 1953), at 867, Beverley-Smith *et al*, *Privacy, Property and Personality*, at 130-131, and Milligan, *Brand it Like Beckham*, at 130.

<sup>127</sup> Where the exploiter seeks to use images regarding two people, he would need to see consent of the second person (also through waiver) in order to avoid this situation.

private information, what is the extent of its rights against an unauthorised publisher of the same (or similar) information?

It is submitted that the *power* to waive does not constitute a particularly strong legal basis for granting an enforceable *right* to the authorised user. Reid and Blackie note that “personal bar is a doctrine which suppresses rights rather than creates them”,<sup>128</sup> which suggests that waiver (being a personal bar to the enforcement of the privacy right) may be capable of acting as a shield but not as a sword.<sup>129</sup> While this will aid the authorised user in a direct claim with the individual, it is far less likely to help where the user wishes to claim against another party and needs a sword, rather than a shield, to do so.<sup>130</sup>

The grant of a waiver thus does not place the third party exploiter in an ideal position in law, although large sums will frequently have been paid for this privilege.<sup>131</sup> Part of the problem arises from the fact that a “licence only makes an action lawful which would otherwise have been unlawful.”<sup>132</sup> The same can be said for a waiver, since as noted above it is in effect a form of personal bar.<sup>133</sup> It is therefore not clear that the grant of a waiver provides the third party with an enforceable right against any other infringer.

### 3.4.3. Third Party Rights: An Exclusive Licence

If rights based upon waiver are troublesome, there is no indication that a third party right based upon a purported exclusive licence is any more satisfactory. This is well illustrated by *Douglas v Hello!*<sup>134</sup> in the House of Lords – a decision which encapsulates the considerable difficulties of attempting to found a licensable

<sup>128</sup> Reid and Blackie, *Personal Bar*, para 5-21.

<sup>129</sup> *Ibid.*

<sup>130</sup> The English concept of equitable estoppels may, however, be more effective in such situations: *Ibid.*, paras 5-22 – 5-23.

<sup>131</sup> See Chapter 3, section 4

<sup>132</sup> Michalos, “*Douglas v Hello: The final frontier*”, at 243. Where the licence is supported by a statutory scheme, an exclusive licensee may benefit from an enforceable right, as for example with copyright under s92 of the CDPA 1988.

<sup>133</sup> Reid and Blackie, *Personal Bar*, para 18-10.

<sup>134</sup> [2008] 1 AC 1.

commercial interest on a right of privacy. Nonetheless, the case is the leading authority in England for the existence of the legally enforceable right of an authorised exploiter against an unauthorised one.<sup>135</sup>

In order to determine whether OK! had an enforceable right against Hello!, the Lords had to consider three issues: (i) whether the Douglases' wedding photographs amounted to confidential information; (ii) whether OK! benefited from that confidence; and, if so, then (iii) whether Hello! had infringed that confidence by publishing the unauthorised images, or whether OK! had already placed the information in the public domain by publishing authorised photographs, thereby destroying any confidentiality in those images.<sup>136</sup>

Lord Hoffmann, for the majority, concluded that these wedding photographs did constitute confidential information.<sup>137</sup> Given that the wedding photographs qualified as confidential information, the second issue to be determined was the nature of OK!'s right in the Douglases' photographs, that is to say, what right was granted to OK! under its contract with the Douglases? A significant factor for the court appears to have been the high value of the information<sup>138</sup> to both contracting parties:

The point of which one should never lose sight is that OK! had paid £1m for the benefit of the obligation of confidence imposed upon all those present at the wedding in respect of *any* photographs of the wedding. That was quite clear. Unless there is some conceptual or policy reason why they should not have the benefit of that obligation, I cannot see why they were not entitled to enforce it. And in my opinion there are no such reasons. Provided that one

<sup>135</sup> The Douglases' claim was disposed of by the Court of Appeal in favour of the Douglases, and Hello! chose not to appeal the outcome to the Lords. Thus, the Lords only required to consider the rights of OK! vis-à-vis Hello!: "this appeal is not concerned with the protection of privacy. Whatever may have been the position of the Douglases, who, as I mentioned, recovered damages for an invasion of their privacy, OK!'s claim is to protect commercial confidential information and nothing more." [2008] 1 AC 1, para 118, per Lord Hoffmann.

<sup>136</sup> Although the facts were novel, their Lordships were clear that the principles to be applied were those previously established in the leading breach of confidence cases in England, *Coco v AN Clark (Engineers) Ltd* [1969] RPC 41 and *Attorney General v Guardian Newspapers Limited (No 2)* [1990] 1 AC 109.

<sup>137</sup> [2008] 1 AC 1, para 118.

<sup>138</sup> Carty observes that the focus on the fee paid meant that the debate moved "from protecting "secrecy" to protecting the value of OK's investment", "The modern action for breach of commercial confidence", at 448.

keeps one's eye firmly on the money and why it was paid, the case is, as Lindsay J held, quite straightforward.<sup>139</sup>

In the absence of any conceptual or policy reasons against protection, OK!'s interest in the confidentiality of the wedding photographs, derived from the high value contract with the Douglasses, was one that the Law Lords were prepared to protect.

This conclusion leaves a number of questions unanswered. If the Douglasses had not charged a fee at all, or if they had charged a lesser sum, would the law still have protected OK!'s exclusive right? The commercial value of the deal might be negligible, yet the facts and subject matter would otherwise remain the same. Since the value of the deal appears to form the basis in law of OK!'s enforceable right (described by Michalos as a "jurisprudential leap"<sup>140</sup>), it is essential to have as much clarity about the scope and extent of this alleged right and the means of creating it – clarity which is currently lacking. As Reid observes, if "an obligation between A and C is to be recognised in Scots law, it will require a more principled foundation than the assertion that A has paid a great deal of money to B."<sup>141</sup>

The third issue was whether Hello!'s publication breached that confidence. Baroness Hale and Lord Brown agreed with Lord Hoffmann's analysis that OK!'s publication of certain authorised images meant that *those* images were in the public domain<sup>142</sup> but "no other pictures were in the public domain and they did not enter the public domain merely because they resembled other pictures which had."<sup>143</sup> Noting that he could not understand Lord Nicholls' view that publication of *approved* photographs rendered publication of *unapproved* photographs acceptable,<sup>144</sup> Lord Hoffmann (and the majority) concluded that OK! had an enforceable right of confidence in the

<sup>139</sup> [2008] 1 AC 1, para 117, per Lord Hoffmann, his emphasis. Lord Hoffmann was supported by Lord Brown: "Having paid £1m for an exclusive right it seems to me that OK! ought to be in a position to protect that right and to look to the law for redress were a third party intentionally to destroy it." (*Ibid*, para 325).

<sup>140</sup> Michalos, "*Douglas v Hello: The final frontier*", at 243.

<sup>141</sup> Reid, "Personality rights in the modern Scots law of delict", para 4.4.2.

<sup>142</sup> Any unauthorised reproduction of the approved images would thereafter be a breach of copyright rather than breach of confidence.

<sup>143</sup> [2008] 1 AC 1, para 122, per Lord Hoffmann.

<sup>144</sup> *Ibid.*, para 121, per Lord Hoffmann.

authorised photographs.<sup>145</sup> Nonetheless, the distinction between the *information* contained in the two sets of images is rather slender, and exposes the final outcome to the suspicion that what was protected was not information (as per a privacy action) but specific (valuable) images.<sup>146</sup>

This decision arguably makes commercial sense, by reflecting the intentions of the Douglases and OK!. In determining whether or not OK! had an interest recognised in law, the majority were clearly influenced by the fee paid by OK! for use of the wedding photographs. There is certainly merit in a legal system which is grounded in the reality of commercial practice: Laddie J endorsed this approach in the context of passing off (rather than privacy), where he said “passing off is closely connected to and dependent upon what is happening in the market place... [it] responds to changes in the nature of trade.”<sup>147</sup>

Yet this very appeal to commercial reality is the weakest part of the judgment,<sup>148</sup> and one that was opposed by Lord Walker, who argued that “the confidentiality of any information must depend on its nature, not on its market value.”<sup>149</sup> Relying on the commercial value of a deal to determine its status as a legally protected right is intellectually troublesome, and creates considerable legal uncertainty.<sup>150</sup> There can certainly be no assurance that a Scottish court would follow this decision,<sup>151</sup> and the

<sup>145</sup> It is clear, however, that Lord Hoffmann was content to apply the established principles of breach of confidence in reaching this decision. For example, he considered two of the other elements of the action and acknowledged that, even if OK! had an enforceable right, it would not be breached if the information used by Hello! was obtained otherwise than in breach of confidence or if publication of the information was in the public interest (*Ibid.*, para 120).

<sup>146</sup> Carty, “The modern action for breach of commercial confidence”, at 451; Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9.

<sup>147</sup> *Irvine v Talksport Ltd* [2002] 1 WLR 2355, paras 13-14. This can be seen in the context of other developments in passing off in the character merchandising cases of the 1980s and 1990s: see Chapter 2, section 2.4. See also the arguments typical of legal realism, which advance the view that law is “a means to social ends and not... an end in itself; so that any part needs constantly to be examined for its purpose, and for its effect, and to be judged in the light of both and of the relation to each other.” K Llewellyn, “Some realism about Realism – responding to Dean Pound” (1930-1931) 44 Harv L Rev 1222, at 1236.

<sup>148</sup> And has been criticised by Michalos, “*Douglas v Hello: The final frontier*”, and Carty, “The modern action for breach of commercial confidence”, and questioned by R Arnold, “Confidence in exclusives: *Douglas v Hello!* in the House of Lords” [2007] EIPR 339, at 343.

<sup>149</sup> [2008] 1 AC 1, para 299.

<sup>150</sup> Other criticisms have been advanced by Carty, “The modern action for breach of commercial confidence”.

<sup>151</sup> Reid, “Personality rights in the modern Scots law of delict”, para 4.4.2.

evidence suggests that it should not be adopted, since “OK!’s right was said not to arise because of a proprietary interest but by reason of a licence in Equity (a concept impossible to translate into Scots law).”<sup>152</sup>

The rather unprincipled manner by which the solution was reached in *Douglas v Hello!*, and the uncertain impact of the judgment of the House of Lords in Scots law, tend to support the pressing need for a principled response to clarify the legal interests of the individual, the authorised user as licensee, and the unauthorised user as defendant.

#### 4. CONCLUSION

The above analysis has examined the connection between the existing right of privacy and the proposed right of publicity. Although privacy actions are available as a rather pragmatic basis for publicity type actions, as in *Douglas*, the attempt to rely on privacy is unsatisfactory, on both theoretical and practical grounds. Although there may be similarities between the two actions, not least as regards the desire to control public access to private image and information, shoe-horning publicity into privacy does not benefit either interest. Whitty argues that “[r]ecognising the different natures of privacy and publicity is more intellectually honest than trying to subsume the latter into the former.”<sup>153</sup> This sentiment is also expressed by Michalos:

The courts need to deal with the fact that trade secrets, commercial property in images and genuinely private personal information are different animals and need different causes of action. It may be that, whilst decreed undesirable, legislation is the only way out of the mire.<sup>154</sup>

Carty supports this conclusion, noting that “the creation of some form of image or publicity right needs to be expressly debated as a possible separate right, not slipped

<sup>152</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9.

<sup>153</sup> *Ibid.*

<sup>154</sup> Michalos, “Image rights and privacy: After *Douglas v Hello!*”, at 387. See also Wacks: “The solution, as I have said, plainly lies in clearly drafted legislation that provides a remedy in tort for unwanted publicity.” R Wacks, “Why There Will Never be an English Common Law Privacy Tort”, in A Kenyon and M Richardson (eds), *New Dimensions in Privacy Law*, 2006, at 183.



under the radar of the action for breach of confidence by the celebrity industry.”<sup>155</sup> But absent such a debate, privacy appears to be one course of action the celebrity industry is taking, as in *Douglas*.

Two separate short-falls with shoe-horning publicity into privacy actions are apparent. The first relates to the negative right to prevent publicity exploitation. Where the persona exploited does not constitute private information, then Article 8/breach of confidence can have no role to play, since there will be no reasonable expectation of privacy. Privacy is too narrow a basis on which to protect material which may not be private and may not be “information”, other than in the broadest sense. Any unauthorised use of persona which does not infringe the individual’s reasonable expectation of privacy will remain unprotected under a privacy action. Secondly, where the publicity sought is in fact the positive power to exploit, an action which is derived from privacy will be reliant on waiver. As demonstrated, this may be commercially viable, but is not a particularly satisfactory legal solution, not least as regards the rights of any third parties involved.

The following chapter will examine other rights in Scots law, to determine if an alternative right can be found to protect persona as a whole, in all publicity situations – the promotion and merchandising uses as well as media information – and whether through negative or positive exploitation.

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<sup>155</sup> Carty, “The modern action for breach of commercial confidence”, at 453 – although she goes on to say that a “public merit” basis for image rights is “conspicuously lacking” (at 453). See also “Advertising, publicity rights and English law”, at 215.



## **CHAPTER 6: REAL RIGHTS AND PERSONAL RIGHTS: PUBLICITY IN SCOTS LAW**

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## 1. INTRODUCTION

In light of the limitations, explored in Chapter 5, of the current privacy action it is necessary to consider other rights in Scots law to determine where a right of publicity should most appropriately be located. The following section will consider the nature of real and personal rights in Scots law against the key features of publicity, as summarised in the introduction to Part III.

## 2. THE NATURE OF RIGHTS IN SCOTS LAW

As there is no legislative or judicial precedent for a publicity right *per se* in Scotland, any such right in Scots law can be written on a clean slate, albeit a slate with pre-existing lines ruled on it to shape the writing. In analysing publicity in the context of Scots law, it is critical to bring a clear understanding of these ruled lines, its taxonomy, which is the product of Scots law's mixed heritage: “[i]n Scots law... the continental and English approaches to taxonomy intersect.”<sup>1</sup>

Although a detailed review of the history of Scots private law is beyond the scope of this thesis, a brief summary of its mixed roots is helpful to place real rights and personal rights in context. The first (and arguably greatest) “systematizing influence”<sup>2</sup> was provided by Viscount Stair, who “fused the sources of the Scottish common law, going back to Celtic and Saxon law, and variously influenced by Anglo-Norman feudal law, canon law, and Roman law, he stamped this rich amalgam with the pattern, the grid of the civilian tradition.”<sup>3</sup> Since Stair, the ever-increasing influence of the English Common law has, unsurprisingly, diluted this

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<sup>1</sup> D Visser and NR Whitty, “The Structure of the Law of Delict in Historical Perspective”, in K Reid and R Zimmermann (eds), *A History of Private Law in Scotland Vol II*, 2000, (henceforth Visser and Whitty, “The Law of Delict in Historical Perspective”), at 427.

<sup>2</sup> *Ibid.*, at 431.

<sup>3</sup> *Ibid.*

Civilian tradition,<sup>4</sup> leaving Scots law as a mixed legal system, open to influences from both traditions.

Stair, following Grotius (closely but not exactly<sup>5</sup>), distinguished between a real right, *jus in re*, and a personal right, *jus ad rem*.<sup>6</sup> This real/personal division has been retained to the present day, such that the Stair Memorial Encyclopaedia has a volume for Property (real rights) and a separate one for Obligations (personal rights).<sup>7</sup>

In his *Institute*, Erskine defines the real/personal division as follows:

the essential difference may be perceived between rights that affect a subject itself, which are called *real*, and those which are founded in obligation, or, as they are generally styled *personal*. A real right, *jus in re*, whether of property or of an inferior kind – as servitude – entitles the person vested with it to possess the subject as his own; or, if it be possessed by another, to demand it from the possessor, in consequence of the right which he hath in the subject itself; whereas the creditor in a personal right or obligation has only a *jus ad rem*, or a right of action against the debtor or his representatives, by which they may be compelled to fulfil that obligation, but without any right in the subject which the debtor is obliged to transfer to him.<sup>8</sup>

Erskine's definition of these rights highlights a fundamental difference between the two: the focus of the real right is a "thing", whereas a personal right typically arises from obligation and exists in respect of a particular individual or his representatives. The obligation creating the personal right can be (to use Stair's terminology) conventional, arising from consent, or it can be obediencial, whereby it is imposed by law. In Scots law, a contract is a conventional obligation, while delict and unjustified enrichment are obediencial obligations.<sup>9</sup> One consequence of the distinction between conventional obligations and obediencial ones is that, whereas

<sup>4</sup> *Ibid.*, at 427.

<sup>5</sup> *Ibid.*, at 434.

<sup>6</sup> Stair, *The Institutions of the Law of Scotland*, DM Walker (ed), 1981, at II, 1, I. The term *jus in personam* is also used for personal rights, see R Feenstra, "Real rights and their classification in the 17<sup>th</sup> Century: The role of Heinrich Hahn and Gerhard Feltmann" 1982 JR 106, at 106-107.

<sup>7</sup> See K Reid (ed), *The Laws of Scotland: Stair Memorial Encyclopaedia vol XVIII "Property"*, (henceforth Reid (ed), *SME Vol XVIII*), para 1.

<sup>8</sup> J Erskine, *An Institute of the Law of Scotland*, JB Nicolson (ed), 8<sup>th</sup> ed, 1871, at III, I, 2.

<sup>9</sup> This division is only one, albeit the most common one, of the various possibilities for such classification. For a detailed analysis of the divisions of personal rights and their historical origins, see Visser and Whitty, "The Law of Delict in Historical Perspective", particularly at 434-436. See also MacCormick, *SME Reissue "General Legal Concepts"*, paras 31-32.

obligations under contract are typically owed only by the parties to the contract,<sup>10</sup> obediencial duties are more broadly owed.

As Visser and Whitty point out, “rights *in personam* not to be harmed by delict, have, as their correlative, obligations owed by an indefinite class of people.”<sup>11</sup> However, once the obligation has been breached in a specific instance, the right which then arises is “a right against another person or against a determinate, and usually small, number of other persons”.<sup>12</sup> In contrast, real rights are derived from a “thing” and are therefore “enforceable against any person who challenges [their] existence”.<sup>13</sup> They are commonly said to be good against the world. The correlative duty to the real right is the duty not to interfere and it is owed by the rest of the world to *whoever* owns the real right: it is not based upon a personal relationship.<sup>14</sup> A further important feature is that the real right is a *right* rather than a *power*: whether one chooses to enforce this right is optional,<sup>15</sup> but the fact of its enforceability is not.

In the sections that follow, the right of publicity will be assessed against personal rights and real rights, to determine how best a right of publicity should be classified in Scotland’s mixed legal system, taking into account both the nature of publicity and the nature of rights in Scots law. This will ensure, as far as possible, that the development of a right of publicity follows the ruled lines provided by the established taxonomy.

<sup>10</sup> Subject to any third party rights arising under a *jus quaesitum tertio*.

<sup>11</sup> Visser and Whitty, “The Law of Delict in Historical Perspective”, at 473.

<sup>12</sup> Reid (ed), *SME Vol XVIII*, para 3.

<sup>13</sup> *Ibid.*

<sup>14</sup> Penner, *The Idea of Property in Law*, at 25-27.

<sup>15</sup> See Chapter 3, section 2.4.

### 3. PERSONAL RIGHTS

As Friedmann observes, in the context of the English Common law, the “causes of action and the rights of recovery in torts and restitution presuppose the existence of some initial entitlement which they are meant to protect against certain events.”<sup>16</sup>

If protection for publicity rights is to be found in the fields of delict or unjustified enrichment it is necessary to ascertain the “initial entitlement” which can be vindicated through these doctrines. A pursuer cannot hope to succeed in an action for infringement of publicity rights in delict or unjustified enrichment without first establishing his legally-protected interest nor, it is submitted, can he be entirely certain that any contract for the authorised exploitation of persona will be enforced.

It is my submission therefore that personal rights are suitable as vehicles for protecting a right of publicity, but that the right itself must be established as an existing entitlement, or prior right. Once a prior right of publicity – being a right to control the use of one’s persona in the media information, promotion and merchandising uses – has been recognised either by the legislature or judiciary, then personal rights have an important role to play. This section will explore the reasons why publicity cannot be located solely within contract, delict or unjustified enrichment without an “initial entitlement”, before assessing the protection that personal rights do offer once an initial right has been established.

#### 3.1. Conventional Obligations: Contract

A contract is a voluntary agreement between two parties<sup>17</sup> and can therefore be used to good effect where there is consensus between parties as to the subject matter of the contract and the use to be made of it. Where the two parties are in agreement, there

<sup>16</sup> D Friedmann, “The protection of entitlements via the law of restitution – expectancies and privacy” (2005) 111 LQR 400, at 400; see also 406 and 409. A similar idea of protected interests is expressed in German law, §823 BGB.

<sup>17</sup> Definitions of “contract” from a number of jurisdictions, including Scotland, are referred to in Chapter 2, section 1.

can be little doubt that contract is ideally placed to regulate their relationship. The principle of freedom of contract enables the parties to determine their own terms,<sup>18</sup> negotiated to suit their purposes and to reflect their bargaining positions within the open market. Any breach of contract can be resolved either through agreed contract provisions or by appeal to the courts.

It is difficult to see, however, what role contract has to play in the case of the negative publicity right where there is very definitely no relationship or consensus between the parties. Further, the doctrine of privity of contract also restricts the application of contract in publicity rights: a contract may grant a right for an authorised party to exploit persona, but cannot confer upon that authorised party any right against a subsequent unauthorised user of persona.<sup>19</sup> The exception is where the contract takes the form of a licence of a real right, which enables the licensee to raise an action against an infringer where the licensor would have that right. This of course requires a real right to be the subject of the licence, and whether persona can be protected by real rights will be examined in section 4 below. In the absence of a real right to be licensed, however, contract plays an essential role in regulating the relationship between willing parties, but cannot regulate or impose an obligation on an unconnected (and therefore unconsenting) third party.<sup>20</sup>

A secondary consideration is the subject matter of a contract for the exploitation of persona. Even absent a prior right of publicity in Scots law, there is nothing to prevent willing parties from contracting to use persona (howsoever they choose to define it) for publicity purposes. Nonetheless, a prior right of publicity would provide a much more certain basis for the contract. There is a risk, however slight, that any licence or contract for exploitation could be unenforceable lacking a prior publicity right. This is particularly the case if the authorised exploiter were to sue for specific implement of the contract, since the “terms of the order for specific

<sup>18</sup> HG Beale (ed), *Chitty on Contracts*, Vol 1, 29<sup>th</sup> ed, 2004, para 1-012. This principle is of course subject to statutory regulation, such as the Unfair Contract Terms Act 1977.

<sup>19</sup> Although the House of Lords appears to have allowed something very like this in *Douglas v Hello!*, by allowing OK! to recover by virtue of a licence in equity, [2008] 1 AC 1. See Chapter 5, section 3.4.3.

<sup>20</sup> WM Gloag and RC Henderson, *The Law of Scotland*, (eds) Coulsfield and MacQueen, 12<sup>th</sup> ed, 2007 (henceforth Gloag and Henderson, *The Law of Scotland*), para 8.02.

implement must be precise”<sup>21</sup> and no decree will be pronounced “if the contract itself leaves it uncertain what the defender must do.”<sup>22</sup>

Thus, contract is an enabling tool but not a creating one. In response to the positive power to exploit, contract is well placed to regulate the relationship where there is a prior right of publicity. When faced with unauthorised exploitation, contract is powerless to assist the aggrieved individual.

### 3.2. Obediential Obligations I: Delict

The case of delict is more complex. Here, reparation must be made for loss caused by a legal wrong, as reflected in the maxim *damnum injuria datum*. All three elements must be shown, such that if there is no loss, no legal wrong or no causal connection between the two, there can be no recovery.<sup>23</sup> In ascertaining whether delict could protect publicity rights it is necessary to establish whether unauthorised use of persona could amount to a legal wrong causing a loss recognised by law.

It is submitted that, while delict would certainly have a role to play where a publicity right was already recognised (Friedmann’s “initial entitlement”), it is harder to identify the role that delict could play without such a right in Scots law. There is certainly no publicity delict *per se* in Scots, or indeed in English, law, although, as with English law, there is a reasonable chance that the nominate delicts of passing off and breach of confidence (or misuse of personal information) could operate to protect some of the interests infringed through unauthorised use of persona.<sup>24</sup> Whether a general delictual action for publicity could be recognised is unclear. Two

<sup>21</sup> W McBryde, *The Law of Contract in Scotland*, 3<sup>rd</sup> ed, 2007, para 23-13.

<sup>22</sup> *Ibid.*, para 23-14.

<sup>23</sup> Gloag and Henderson, *The Law of Scotland*, para 26.01.

<sup>24</sup> As discussed in Chapters 3 and 5, and used, for example, in the cases of *Douglas v Hello!* and *Irvine v Talksport*. Reid comments (generally favourably) on the extent to which protection for personality rights as a whole can be provided by delict: Reid, “Personality rights in the modern Scots law of delict”; E Reid, “Protection for rights of personality in Scots law: a comparative evaluation” 2007 EJCL 11.4. *Contra* Whitty, who acknowledges that personality interests, as a wider category, “do not align exactly with the delicts which protect those interests”, “Overview of Rights of Personality in Scots Law”, para 3.3.

separate observations provide insights to the nature of the delictual obligation in Scots law.

The first is provided by Visser and Whitty, in their review of the structure of the law of delict in Scotland and its historical background. They note that the future development and understanding of delict will depend on “a proper understanding of what the purpose of the law of delict should be”<sup>25</sup> but that “this sense of purpose has never been fully developed in Scots law. Until this happens anomalous categorizing will tend to persist and it will be difficult to classify evolving species.”<sup>26</sup> Lacking this sense of purpose, it is difficult to determine whether publicity is the sort of right that delict is intended to protect. Are the interests at stake relevant interests for the purposes of delictual liability? And if so, how should they be classified?

If publicity rights can be protected by delict, then help can be derived from a second observation, from Norrie this time, that

The law of Scotland has never operated within strict and exclusive classes of action and, so long as the defender is made aware of the claim he is being called upon to answer, it matters really very little whether his culpability is founded on intent or neglect.<sup>27</sup>

Indeed, Norrie speculates that the distinction between the intentional delicts and negligence is of diminishing relevance and the two categories may eventually collapse into one, based on a general concept of fault.<sup>28</sup> Norrie also makes the point that, in Scots law, there is a traditional “distrust of *nomina juris*: [instead] the wrong is actionable if it infringes a legally recognized interest and it does not matter whether the wrong has an appropriate name.”<sup>29</sup> If it can be established that the dignitarian and economic interests in publicity are legally recognised, and that infringement of those interests is a wrong, then it is not necessarily fatal to an action in delict that there is no appropriately named delictual action for publicity. Similarly,

<sup>25</sup> Visser and Whitty, “The Law of Delict in Historical Perspective”, at 476.

<sup>26</sup> *Ibid.*

<sup>27</sup> KM Norrie, “The Intentional Delicts”, in K Reid and R Zimmermann (eds), *A History of Private Law in Scotland Vol II*, 2000, at 479.

<sup>28</sup> *Ibid.*, at 480 and 482.

<sup>29</sup> *Ibid.*, at 508.



whether the unauthorised use is intentional<sup>30</sup> or negligent is likely to be of increasingly little importance.

While comfort can be taken from Norrie's recognition of the flexible approach to delict in Scots law, such that culpability is at the heart of the action (whether through intent or neglect), it is still essential to show that the harm resulting from the unauthorised use of persona is harm to an interest protected by delict, and that the unauthorised use is itself a legal wrong. In the absence of a recognised right of publicity, it is submitted that these are both stumbling blocks for a pursuer in Scotland.

In the first place, we are required to identify a relevant interest which is harmed by wrongful use of persona. Visser and Whitty refer to the protected interests identified by Stair as “(a) life, (b) members and health, (c) liberty, (d) fame, (e) content, delight and satisfaction, and (f) goods and possession.”<sup>31</sup> An expanded version of this list is provided in Gloag and Henderson,<sup>32</sup> where the right to life is regarded as the ultimate interest. Personal security and liberty are the next mentioned, including the right of an individual to be “safeguarded from unfounded aspersions on his character”.<sup>33</sup> Fraud and invasion of property rights (including both corporeal and incorporeal) follow, where the harm may be either direct or indirect, the latter through delicts such as nuisance. Thereafter, things become harder to define:

The extent to which a person has a right to protection of his general economic interests, as distinct from specific items of property, is, however, problematic. Such interests are protected against fraud but difficulties surround questions of remedy for other forms of intentional harm as for negligence... Cases in which there is no liability for harming economic interest, whether intentionally or through lack of care, may be classified as instances of *damnum absque injuria*.<sup>34</sup>

<sup>30</sup> There is a debate in Scots law as to whether the necessary intent is the intent to carry out the act or to cause the end harm: Norrie discusses this and appears to favour the latter approach. See KM Norrie, “The Intentional Delicts”, in K Reid and R Zimmermann (eds), *A History of Private Law in Scotland Vol II*, 2000, at 478.

<sup>31</sup> Visser and Whitty, “The Law of Delict in Historical Perspective”, at 435. See also Whitty, “Overview of Rights of Personality in Scots Law”, para 3.2.2 and section 3.4.

<sup>32</sup> Gloag and Henderson, *The Law of Scotland*, para 26.02.

<sup>33</sup> *Ibid.*

<sup>34</sup> *Ibid.*

Gloag and Henderson then explain that *damnum absque injuria*, or loss without legal wrong, can arise from the “invasion of a mere liberty, or advantage enjoyed on sufferance”.<sup>35</sup> Unless publicity rights protect an interest or right recognised as such, then it is likely that the invasion of publicity rights through unauthorised use will be regarded as *damnum absque injuria*.

A review of these protected interests suggests that it is not at all clear that they extend to the interests affected by publicity rights, as identified in Chapter 4, namely dignitarian and economic interests. In respect of the dignitarian interests in autonomy and control, the delictual interests appear to require insult or defamation, rather than loss of control of, or misuse of, identity. MacCormick recognises the uncertainty here, suggesting that personality rights are still dependent on earlier notions of personal honour:

The emergence of rights of personality in Scots law in the early twenty-first century is still, however, somewhat conjectural, though there is no doubt that the *actio iniuriarum* is available in cases of extreme insult, even without the falsehood normally inherent in defamation, and even without any quantifiable pecuniary loss.<sup>36</sup>

A pursuer whose persona has been exploited without his consent may well be able to recover in delict for any insult arising (for example, if he is associated with an unsavoury product, or the use is in some way derogatory). Whether dignitarian harm arising from loss of control, without more, would be encompassed by these delictual interests remains doubtful.

The outcome is even less certain in respect of the individual’s economic interests. Although delict does encompass some economic interests, these are often limited to specific interests, such as trade or employment, and redress in these cases is further limited because the law will recognise the harmful act as a “wrong” only where it was carried out in an illegal way<sup>37</sup> or by parties acting in concert<sup>38</sup> or it consists of inducing the individual to breach a contract.<sup>39</sup> The publication of an advertisement

<sup>35</sup> *Ibid.*, para 26.03.

<sup>36</sup> MacCormick, SME Reissue “General Legal Concepts”, para 95.

<sup>37</sup> Gloag and Henderson, *The Law of Scotland*, para 26.07.

<sup>38</sup> *Ibid.*, para 26.06.

<sup>39</sup> *Ibid.*, para 26.08.

featuring David Beckham with a claim that he enjoys using a particular product could not conclusively be said to constitute a recognised delictual economic harm.

Although significant questions remain over the ability of the general delictual duty of care to protect publicity interests, nominate actions could potentially provide protection for pursuers in individual cases. The action of passing off, for example, was used in the English case of *Irvine v Talksport*.<sup>40</sup> Yet there has been considerable criticism of the expansive interpretation required to fit the facts within the established action,<sup>41</sup> and doubts about its specific applicability in Scots law have been raised.<sup>42</sup> A further possibility, albeit arguably a remote one, is the *actio iniuriarum*. In addition to support from MacCormick, above, the *actio iniuriarum* has recently been favourably considered by Whitty,<sup>43</sup> while in *Stevens v Yorkhill NHS Trust*,<sup>44</sup> the Court of Session also made reference to this doctrine. Yet “although there is no doubting its importance as a source, it is questionable whether it offers a sustainable model for the modern development of personality right protection”.<sup>45</sup> Further, MacQueen observes that, in general, the judicial response has been “at best tentative”.<sup>46</sup> It is not entirely surprising, therefore, that pursuers have not sought to invoke the *actio iniuriarum*. These practical considerations, and uncertainties, suggest that the *actio iniuriarum* is unlikely to be relied upon in litigation in Scots law.

<sup>40</sup> [2003] 2 All ER 881.

<sup>41</sup> Carty, “Advertising, publicity rights and English law” at 238-243; Beverley-Smith *et al*, *Privacy, Property and Personality*, at 23; Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9

<sup>42</sup> Reid questions whether Scottish courts would follow this decision, partly because the historical basis for delictual actions is different from that in tort, and partly because she concludes there is no obvious loss suffered – although this latter concern has arguably been addressed by my discussion of the interests harmed in Chapter 4. Nonetheless, Reid’s concerns add another layer of doubt to the efficacy of using delict as a home for such interests. See Reid, “Personality rights in the modern Scots law of delict”, para 4.4.1.

<sup>43</sup> NR Whitty, “Rights of Personality, Property Rights and the human body in Scots law”, (2005) 9 Edin LR 194; also Whitty, “Overview of Rights of Personality in Scots Law”, particularly section 3.2.

<sup>44</sup> 2006 SLT 889. Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.13. In *Martin v McGuinness* the court reflected, but did not comment, on the possible role of the *actio iniuriarum*, 2003 SLT 1424.

<sup>45</sup> Reid, “Personality rights in the modern Scots law of delict”, para 4.5.4(b).

<sup>46</sup> HL MacQueen, “A Hitchhiker’s Guide to Personality Rights in Scots Law, Mainly with Regard to Privacy”, in NR Whitty and R Zimmermann (eds), *Rights of Personality in Scots Law: A Comparative Perspective*, forthcoming 2009, para 12.5.

Alternatively, there may be cases where unauthorised use of persona constitutes defamation,<sup>47</sup> or causes extreme insult or ridicule, giving rise to an action for verbal injury,<sup>48</sup> or possibly *convicium*.<sup>49</sup> While the utility of these nominate delicts<sup>50</sup> is not questioned, the advisability of basing protection for publicity rights as a whole on existing delictual actions and interests is questionable. The lack of a clear “initial entitlement” gives rise to uncertainty and risks shoe-horning an action for one grievance into an existing cause designed for another. As Vaver notes, the problem of such shoe-horning is

less one of fitting an outgrown foot into a size too small; it is that the shoe keeps getting repaired until nothing much is left of the original. Sometimes old shoes last longer and work better if they are kept for their old job, and new pairs are acquired for new and different jobs.<sup>51</sup>

Further, such *ad hoc* protection is often fortuitous.<sup>52</sup> Whether a pursuer can recover, and whether a defender can make use of an appropriate defence, is dependent on whether the pursuer’s claim can – fortuitously – be shoe-horned into an existing action, potentially one which was never designed with such a publicity claim in mind. For example, a nominate delict which affords protection for dignity will operate where the unauthorised publicity use also injures dignity, but not otherwise. This *ad hoc* protection violates principles of legal certainty and coherence, and is damaging not only to those who wish to assert their publicity rights, but also to those who are called upon to defend such claims. A final concern is how a pursuer can protect both dignitarian and economic interests arising from the same use of persona, without invoking two or more delictual actions.

<sup>47</sup> *Tolley v Fry* [1931] AC 333.

<sup>48</sup> Whitty, “Overview of Rights of Personality in Scots Law”, paras 3.2.2 – 3.2.5.

<sup>49</sup> The Hon. Lord Kilbrandon reviewed a number of actions relevant to protecting an individual’s dignity in 1971, albeit he noted that these actions were rare in Scots law, and their usage has not noticeably increased since then. Thomson’s view that it is now too late to revive *convicium* is therefore highly persuasive. See Lord Kilbrandon, “The right of privacy in Scotland” (1971) 2 *Cambrian LRev* 35 at 38-39; J Thomson, *Delictual Liability*, 3<sup>rd</sup> ed, 2004, at 278. See also Whitty, “Overview of Rights of Personality in Scots Law”, para 3.2.6.

<sup>50</sup> Subject to the elements of liability (including in some cases injury, wrongfulness and fault) being fulfilled: Whitty, “Overview of Rights of Personality in Scots Law”, section 3.5.

<sup>51</sup> D Vaver, “Advertising using an individual’s image: a comparative note” (2006) 122 *LQR* 362, at 368. See also Klink “50 years of publicity in the US”, at 387.

<sup>52</sup> See Beverley-Smith’s commentary on *Tolley v Fry* in *The Commercial Appropriation of Personality*, at 253-254.

Whether delict is capable of protecting the interests affected by publicity rights, as identified in Chapter 4, therefore remains unclear. However, in extending any protection to publicity interests, Visser and Whitty's warning is relevant: the lack of a sense of purpose does not assist with the classification of evolving species of delict.

Even if unauthorised use of persona results in a harm recognised by delict, there is a second potential hurdle to be overcome. This is the need to show that unauthorised use of persona is a legal wrong. Again, it is not clear that, on the present state of the law, this is the case. A pursuer would have to show that he has an exclusive right to his persona, which conversely means that use of persona by others must be proscribed. Yet, as MacCormick notes, an action against Neil Armstrong in a Scottish court for trespass on the moon should not succeed: "the absence of any prohibition in Scots law entails a (passive) right in Mr Armstrong that the action against him be summarily dismissed".<sup>53</sup> The absence of a prohibition creates a right to walk on the moon, and this analysis holds good "in all less fanciful or trivial cases."<sup>54</sup>

A further obstacle to situating publicity within delict arises from the nature of the awards available. In cases of negligently caused harm, the only remedy (other than interdict) is "a monetary compensation of the hurt, that is to say damages."<sup>55</sup> Yet in the publicity cases, the nature of the harm caused may be wider than economic loss or injury to feelings, particularly in light of the longer term damage that may be caused to reputation (as was explored in Chapter 4, section 2.2). Consequently, a monetary award may be insufficient in all cases to repair the damage done to the individual's persona and a wider and more creative palette of remedies, including retraction, an apology or an account of profits, may be necessary.<sup>56</sup>

<sup>53</sup> MacCormick, *Institutions of Law*, at 126.

<sup>54</sup> *Ibid.*

<sup>55</sup> KM Norrie, "The Intentional Delicts", in K Reid and R Zimmermann (eds), *A History of Private Law in Scotland Vol II*, 2000, at 515, and see also 496. See also Gloag and Henderson, *The Law of Scotland*, para 26.01; M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, para 3.03.

<sup>56</sup> See further Whitty, "Overview of Rights of Personality in Scots Law", section 3.7, particularly para 3.7.2. Appropriate remedies will be discussed in more detail in Chapter 7, Part B.

The next issue is whether delict, in its current form, is capable of protecting the positive power to exploit. Delict is concerned with the need to protect individuals from harm – as is clearly illustrated by the wording of the Protection from Harassment Act 1997, which creates a statutory delict of harassment with the words “Every individual has a right to be free from harassment”.<sup>57</sup> This is not a right to control how or when you wish to be harassed: it is a right to ensure you are not subjected to harassment. The publicity right sought, however, is not a comparable right to be free from publicity, but to ensure that any publicity is controlled.

Control, through the positive exploitation of delictual rights, could be achieved through the use of waiver.<sup>58</sup> For example, it is possible for an individual to waive his right to seek an interdict for trespass, and to require a fee for doing so: this is, in effect, what the lease of a flat achieves. Waiving rights in, or consenting to, a delictual wrong for a fee is therefore at least a possibility to be explored, as is implied waiver or personal bar.<sup>59</sup>

However, waiver is not an entirely satisfactory method of permitting authorised exploitation of persona. Where an individual grants a waiver in respect of some action, this does not mean that the action becomes legal; rather it modifies the grantor’s right of action against the infringer.<sup>60</sup> Other pursuers may exist, against whom the infringer would have no defence of consent.<sup>61</sup> In addition, any flaw in the consent granted would invalidate the waiver, rendering the defender liable. Even where a valid waiver was granted, the authorised user would still face problems in enforcing it against third parties.<sup>62</sup> Thus, waiver of a right to enforce is far less satisfactory for authorised users than would be a positive grant of a right, enforceable against the grantor and third parties.

<sup>57</sup> Protection from Harassment Act 1997, section 8(1).

<sup>58</sup> Waiver of a right in delict can be distinguished from waiver in the context of human rights, as discussed in Chapter 5 – but similar problems arise.

<sup>59</sup> See further Reid and Blackie, *Personal Bar*, chapter 18, particularly paras 18-03, 18-04 and 18-06.

<sup>60</sup> For example, see *Haelan Laboratories v Topps Chewing Gum Inc* 202 F 2d 866 (2<sup>nd</sup> Cir 1953), at 867; Beverley-Smith *et al*, *Privacy, Property and Personality*, at 130-131, and Milligan, *Brand it Like Beckham*, at 130.

<sup>61</sup> A possible example would be a prior authorised user, if some degree of exclusivity had been “granted” or conferred by the earlier waiver.

<sup>62</sup> See this discussion of this in the context of privacy rights in Chapter 5, section 3.4.2.

Despite these objections, it is submitted that delict is a valuable supporting tool for those trying to enforce their publicity rights. Specifically, if a publicity right were recognised in Scots law, then delict would provide a vehicle for enforcing and protecting that right. The grant of a right to control use of persona would provide an identifiable “wrong” in the event of interference with that right, especially if this publicity right were to be a class of real right, since interference with property rights is explicitly regarded as a wrong by Stair and by Visser and Whitty.<sup>63</sup> It would also make harm to the individual much easier to identify, thus helping to fulfil the requirements of *damnum injuria datum*.

In addition to protecting a specific right of publicity, delict would also have an ongoing role to play in protecting pursuers in cases where the facts of their complaint fall within existing delictual actions or protected interests. (Leading examples of such use to date, in England, are *Irvine v Talksport* and *Douglas v Hello!*.) Delict would therefore provide a valuable interstitial or “default” right to protect dignitarian interests, specifically where there is defamation or insult.

### 3.3. Obediential Obligations II: Unjustified Enrichment

For a claim in unjustified enrichment to exist, the defender must have been enriched as a result of his acquisition of some objective value at the expense of the pursuer, and that this acquisition be unjustified. This definition introduces three different elements: the need to show (i) that there is an enrichment of the defender; (ii) at the expense of the pursuer; and (iii) that the retention of the enrichment is unjustified. The pursuer must also show that it is equitable for the defender to redress (or for the courts to compel the redress of) the enrichment.<sup>64</sup> The enrichment of the defender

<sup>63</sup> As per the text at notes 31 and 32 above.

<sup>64</sup> This definition is provided by R Evans-Jones, *Unjustified Enrichment: Enrichment by Deliberate Conferral: Conductio, Volume 1*, 2003, para 1.02. Similar definitions are provided by H MacQueen, *Unjustified Enrichment LawBasics*, 2004 (henceforth MacQueen, *Unjustified Enrichment*”), at 1; M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, at 207-216. See also NR Whitty and D Visser, “Unjustified Enrichment” in R Zimmermann, D Visser and K Reid, (eds), *Mixed Legal Systems in Comparative Perspective: Property and Obligations in Scotland and South Africa*, 2004, at 405-407, where they



can arise from a transfer from the pursuer to the defender or from the imposition of goods or services by the pursuer on the defender – both acts in which the pursuer is the active party. Alternatively, the defender may be the active party, where he is enriched through the taking of an entitlement of the pursuer.<sup>65</sup> Since we are dealing with unauthorised use of persona, it is more likely that the defender will be the active party, where he “takes” or uses the persona without consent.

Unauthorised use of persona appears at first sight to meet these criteria: it involves the enrichment of the defender, through the use of the pursuer’s persona without having paid for such use. Such enrichment is at the expense of the pursuer, who has lost control of that persona. Further, the lack of consent suggests that there is no justification for the “taking” of the pursuer’s persona by the defender. Yet although this initial assessment sounds very promising, closer examination suggests that unjustified enrichment may fail to assist a pursuer in the absence of a prior legal right of publicity. This is because, as MacQueen makes clear, whether something is an unjustified enrichment depends on principles of law, rather than an intuitive response to the demands of justice on the part of the court.<sup>66</sup> A pursuer who wishes to recover for unauthorised use of his persona must therefore satisfy all elements of the definition of the unjustified enrichment action, rather than simply seeking to show that the use was unfair and unpermitted. And, when applying these three parts of the definition to publicity, it becomes apparent that at least two of them are likely to pose problems for unjustified enrichment – albeit both would, arguably, be overcome if there were a recognised legal interest in persona or publicity, which would constitute Friedmann’s “initial entitlement”.

The first hurdle is the need for the pursuer to show that the enrichment has been made at his expense. This generally, but not always, requires the pursuer to be able to show a loss.<sup>67</sup> In straightforward cases of taking of property by the defender, the pursuer’s loss mirrors the defender’s gain. Yet it is not clear that taking persona

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suggest that the final element of this definition is not part of the action, but rather goes towards any defence to be advanced against the claim.

<sup>65</sup> MacQueen, *Unjustified Enrichment*, at 16-18.

<sup>66</sup> *Ibid.*, at 1.

<sup>67</sup> Gloag and Henderson, *The Law of Scotland*, para 25.03.



creates a mirror loss, nor that it would be recognised as a loss in the absence of a recognised right or initial entitlement to one's persona. An alternative to showing loss is to demonstrate that the defender has interfered with or invaded a right of the pursuer, since "it does not appear proper that the defendant should be allowed to benefit from interfering with a right which the legal system has assigned specifically to the plaintiff."<sup>68</sup> Here, "the loss can usually be seen as the inability of the impoverished person to make, or bargain for the, use of its own property or rights, or the diminution in value of the property following its unauthorized use."<sup>69</sup> Gloag and Henderson notes that the reversal of an enrichment arising from this invasion or interference "is usually explained on the basis that it supports property rights"<sup>70</sup> and indeed intellectual property rights. However, in order to rely upon this the pursuer would need to demonstrate the legal right which has been interfered with by the defender's action. Blackie and Farlam argue that, although Scots law "contains particular examples [of such claims]...., it has yet to develop a general rule. What is needed is a wide definition of a "patrimonial right" as invaded."<sup>71</sup> Thus, where there has been an interference with an established right, there will be a legal basis for the action for unauthorised taking or interference. In other situations, and absent a wide concept of patrimonial rights or a specific publicity right, it is not clear what specific right will have been invaded by the defender.

For a pursuer to show that the unauthorised use of his persona has been at his expense, he would therefore require to demonstrate either that there has been an objective "loss" which mirrors the defender's gain, or that there has been an invasion of his rights. This latter category of loss is more likely to apply in cases of publicity, but it is not fully developed in Scots law, and there is no evidence at this stage that the courts would recognise "publicity" as the necessary right invaded. Scots law therefore appears to need the recognition, by the courts or legislature, of a prior legal

<sup>68</sup> R Zimmermann, "Unjustified enrichment: The modern civilian approach" (1995) 15 OJLS 403, at 418.

<sup>69</sup> Gloag and Henderson, *The Law of Scotland*, para 25.03.

<sup>70</sup> *Ibid.*, para 25.20, footnote omitted. Zimmermann also notes that this category is important to protect legal positions which confer an exclusive right on the pursuer: see R Zimmermann, "Unjustified enrichment: The modern civilian approach" (1995) 15 OJLS 403, at 418.

<sup>71</sup> J Blackie and I Farlam, "Enrichment by Act of the Party Enriched", in R Zimmermann, D Visser and K Reid (eds), *Mixed Legal Systems in Comparative Perspective: Property and Obligations in Scotland and South Africa*, 2004, at 490.

right in publicity before a claim could be founded in unjustified enrichment. We are thus led to the conclusion that unjustified enrichment is capable of providing an appropriate cause of action for breach of a publicity right – but we are still without the necessary prior publicity right.

The second obstacle for the pursuer is the need to show that the enrichment is without legal cause: an enrichment only “falls to be reversed if its retention is supported by no legal ground.”<sup>72</sup> Examples of acts which constitute a legal ground for the enrichment include a valid contract, a court order, a legacy or donation.<sup>73</sup> However, there is some uncertainty as to whether Scots law currently requires the absence of any legal basis for the transfer or enrichment, or whether, in line with the English approach,<sup>74</sup> the pursuer must show “unjust factors” involved, such as mistake, duress or exploitation.<sup>75</sup> MacQueen<sup>76</sup> posits the existence of a third way in Scots law, whereby *both* elements must be shown, since “absence of a legal ground can only be a necessary rather than a sufficient basis for identifying reversible enrichment”<sup>77</sup> – the unjust factor may therefore operate to help identify a reversible enrichment. There is no clear answer to this at present in Scots law, but Hogg suggests that the “third way” can perhaps “be equated with the wider concept of absence of legal ground which has been suggested in this text [*Obligations*] as of the essence of the ‘third way’.”<sup>78</sup> Further, MacQueen suggests that the burden of proof reflects the need for more than a simple absence of legal basis, since “it is for the

<sup>72</sup> H MacQueen, “Peter Birks and Scots Enrichment Law”, in A Burrows and A Rodger (eds), *Mapping the Law: Essays in Memory of Peter Birks*, 2004, at 413. Critically, it “is for the person who wants to reclaim an enrichment to show reasons why that should be allowed.” (at 413.)

<sup>73</sup> Gloag and Henderson, *The Law of Scotland*, para 25.07.

<sup>74</sup> As detailed for example in R Zimmermann, “Unjustified enrichment: The modern Civilian approach” (1995) 15 OJLS 403, at 414-416; G Dannemann, “Unjust Enrichment as Absence of Basis: Can English Law Cope?”, in A Burrows and A Rodger (eds), *Mapping the Law: Essays in Memory of Peter Birks*, 2004; M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, paras 4.02-4.04. In looking at the role of unjust enrichment in intellectual property cases in American law, Gordon suggests that the simple fact of “reaping without sowing” should not entitle the claimant to relief without more: “On owning information: Intellectual property and the restitutionary impulse” (1992) 78 Va L Rev 149, at 221.

<sup>75</sup> R Zimmermann, “Unjustified enrichment: The modern Civilian approach” (1995) 15 OJLS 403, at 415.

<sup>76</sup> And also NR Whitty and D Visser, “Unjustified Enrichment”, in R Zimmermann, D Visser and K Reid (eds), *Mixed Legal Systems in Comparative Perspective: Property and Obligations in Scotland and South Africa*, 2004, at 412.

<sup>77</sup> H MacQueen, “Peter Birks and Scots Enrichment Law”, in A Burrows and A Rodger (eds), *Mapping the Law: Essays in Memory of Peter Birks*, 2004, at 413.

<sup>78</sup> M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, para 4.03, note 5.

person who wants to reclaim an enrichment to show reasons why that should be allowed.”<sup>79</sup>

Thus, whether pursuers have to prove the absence of legal ground with or without an unjust factor remains uncertain. Demonstrating the unjust factor may be less of a concern, however, in the case of unauthorised taking or interference, since the defender’s acts will be wrongful if there is no legal basis for them. Nonetheless, this requirement, even on a minimalist interpretation, could be a hurdle too far for pursuers in publicity cases at present. Without a prior right of publicity, it is not obvious that the defender’s use is without legal cause: rather, it is arguable that it is the pursuer’s claim that lacks a legal basis. As discussed in section 3.2 above, with reference to Neil Armstrong, if there is no prior right to use persona, then surely there is no reason why the defender should not use it?

It is submitted that the lack of a clear right of publicity would undermine an attempt to use unjustified enrichment to seek restitution for unauthorised use of persona. Although such a claim cannot be ruled out on the current state of Scots law, it is fair to say that the recognition of a prior right of publicity would significantly enhance the pursuer’s claim.

The discussion so far has focused on the use of unjustified enrichment to protect the negative right, in the context of unauthorised use. Where a claim in unjustified enrichment could be made out, it would also assist the individual’s exploitation of the positive power, through authorised use. If the above two objections can be overcome in order to enable a claim for *unauthorised* use (that is, where a recognised loss and a lack of legal basis for the use can be shown), then these elements would equally provide the foundations of a contract for *authorised* use. Since unjustified enrichment is founded upon the notion of an enrichment without legal cause, any contract for use of persona would provide the necessary legal basis for the defender’s use.<sup>80</sup>

<sup>79</sup> MacQueen, *Unjustified Enrichment*, at 26.

<sup>80</sup> M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, para 4.41.

A final complication is the doctrine of subsidiarity, which would, if applicable, require the pursuer to exhaust other remedies before turning to unjustified enrichment. Whitty analyses a number of cases where subsidiarity has been accepted, such that “claims to redress enrichment arising from the act of the enriched party are excluded by possessory actions or delictual claims for damages”,<sup>81</sup> and concludes that “generally these cases were wrongly decided.”<sup>82</sup> The better view, he submits, is that the subsidiarity of enrichment actions to other actions “should have a restricted role in the future”.<sup>83</sup> In fact, it may be of relevance primarily in cases where the enrichment has been imposed by the pursuer on the defender and the pursuer then seeks compensation for his actions, rather than takings cases. Nevertheless, the existence of subsidiarity adds a further layer of doubt to a pursuer’s claim in unjustified enrichment in publicity cases.

While unjustified enrichment has much to offer as an action for the negative right and as a basis for the positive power, it is currently hampered by the absence of a discrete right of publicity which would, if recognised, provide a strong basis for reliance on unjustified enrichment. Additionally, the Scots law of unjustified enrichment is still in a state of transition, following the considerable academic and judicial contributions to the field in the two decades from 1985.<sup>84</sup> “The revision of Scots enrichment law is far from complete”<sup>85</sup> albeit “the stage is set for the law of unjustified enrichment to be developed to its full potential”.<sup>86</sup> Questions therefore exist to which there are no clear answers in this field and this, coupled with the uncertainty of the current legal status of publicity rights, suggests that it would be an

<sup>81</sup>NR Whitty, “*Transco plc v Glasgow City Council: developing enrichment law after Shilliday*” (2006) 10 Edin LR 113, at 131.

<sup>82</sup> *Ibid.*

<sup>83</sup> *Ibid.*, at 132. See also H MacQueen, “Unjustified enrichment, subsidiarity and contract”, forthcoming.

<sup>84</sup> For an account of this recent history, including the impact of Birks’ contribution in the mid-1980s, through the judicial decisions in the mid-1990s, and the academic contributions thereafter, see H MacQueen, “Peter Birks and Scots Enrichment Law”, in A Burrows and A Rodger (eds), *Mapping the Law: Essays in Memory of Peter Birks*, 2004; NR Whitty and D Visser, “Unjustified Enrichment”, in R Zimmermann, D Visser and K Reid (eds), *Mixed Legal Systems in Comparative Perspective: Property and Obligations in Scotland and South Africa* 2004.

<sup>85</sup> H MacQueen, “Peter Birks and Scots Enrichment Law”, in A Burrows and A Rodger (eds), *Mapping the Law: Essays in Memory of Peter Birks*, 2004, at 414.

<sup>86</sup> NR Whitty and D Visser, “Unjustified Enrichment”, in R Zimmermann, D Visser and K Reid (eds), *Mixed Legal Systems in Comparative Perspective: Property and Obligations in Scotland and South Africa* 2004, at 401.

optimistic pursuer who would hope to find a remedy for infringement of a publicity right in unjustified enrichment at present.

### 3.4. The Role of Personal Rights

The above review has sought to show that personal rights could play an important role in enabling the positive exploitation and negative enforcement of a right of publicity, through contract, delict and unjustified enrichment. However, in all cases, the cause of action would be immensely strengthened by the recognition of an “initial entitlement”, constituted by a prior right of publicity.

Thus, a recognised publicity right could be licensed by way of a contract between willing parties, while unauthorised use of persona would amount either to a delict, whereby the wrongful use of persona causes harm to the individual, or an unjustified enrichment for the defender, in “taking” and using a right for which he would otherwise have had to seek consent.

In the absence of a specific right of publicity, the use of personal rights remains valid, but suffers from a lack of clarity. Persona could be licensed or assigned through contract in the exploitation of the positive power. An action in delict or unjustified enrichment could be raised to recover for unauthorised use but, in each case, the pursuer would have to be able to shoehorn his rights and interests into existing rights and interests protected by these branches of the law – and the problems inherent in this approach have been explored in the preceding sections. However, this undoubtedly remains a valid approach where the pursuer is able to do so, such that personal rights could provide interstitial support for publicity rights, in much the same way that the action for passing off supports registered trade mark rights, while breach of confidence supplements the statutory right of copyright and protects trade secrets, which can be relied upon in the absence of a patent right.

The conclusion of this examination is that the use of personal rights to protect persona would be strengthened significantly by the recognition of a right of publicity. Is such a right a real right?

## 4. REAL RIGHTS

### 4.1. Introduction

Whereas personal rights are concerned with rights against persons, real rights exist in “things”. A key advantage of this is that a real right can be enforced against any individual who interferes with the thing, as the subject matter of the right. In the context of publicity it is necessary to identify the “thing” that is the subject matter of the real right and also to outline the real rights recognised in Scots law, to determine whether any of them is appropriate for the protection of publicity rights. If a suitable right does exist, the next step is to identify the thing that would be the subject of that right.

The current examination takes place against the backdrop of Scots law where, following the Civilian or Roman taxonomy:

a real action protecting the thing (*res*) can be exercised against everybody, since a property right imposes duties of abstention to everybody in the world. In contrast, a personal action protecting the person can be exercised only against the particular person that is subject to the obligation... Therefore, real actions have an *erga omnes* (against everybody) characteristic when contrasted with personal actions.<sup>87</sup>

With the caveat that “[a] definitive list of the real rights recognised in Scots law has never been attempted”,<sup>88</sup> Reid lists eight real rights established in Scots law: ownership (*dominium*); right in security; proper liferent; servitude; lease; possession; rights held by the public; and exclusive privilege.<sup>89</sup> Of these, ownership is the “main

<sup>87</sup> U Mattei, *Basic Principles of Property Law*, 2000, at 9.

<sup>88</sup> Reid (ed), *SME Vol XVIII*, para 4.

<sup>89</sup> Note that not all eight have always been recognised in Scots law or by Civilian jurists. See Reid, *SME Vol XVIII*, paras 4 and 5. Although the category is not irrevocably closed, the principle of *numerus clausus* applies in Scots law, as in the Civilian tradition: Gloag and Henderson, *The Law of Scotland*, para 31.03; Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9. Whitty

right”<sup>90</sup> and the others are subordinate real rights or “*jura in re aliena*, that is to say, property in the rights of another.”<sup>91</sup> Thus, ownership is the primary real right and the other real rights typically exist in relation to the thing owned by another, as limitations on it. These subordinate real rights are therefore dependent on there being a pre-existing right of ownership held by another, and can only exist where the real right of ownership has previously been constituted.

Further, only ownership is “a permanent and residual right. For usually the subordinate real rights are temporary in nature. They are burdens on the ownership of another, and if and when they come to an end, the residual right of ownership may be enjoyed unfettered.”<sup>92</sup> Thus, the holder of a subordinate real right has a more curtailed right than the owner of a thing. Although ownership must be capable of subsisting over every thing, not all things need be susceptible to all other real rights. To give an example, a car is capable of being owned and possessed, but could not be the subject of a servitude.

The exception to this is the “subordinate” real right of exclusive privilege, which is not a *jus in re aliena*. Rather, exclusive privilege is “an exclusive, and valuable, right to do something and, hence, to stop others from doing the same thing.”<sup>93</sup> The best example of exclusive privilege today is – for those who do not view it as property – intellectual property. Hume, following Adam Smith, classed intellectual property as a right of exclusive privilege<sup>94</sup> and Reid agrees that, as it is not a personal right, then there is merit in adopting Hume’s analysis.<sup>95</sup> He does, however, express concern that “Hume’s view cannot be accepted without a certain amount of damage to the core idea of real rights. For a real right is a right in a thing, and in the case of exclusive privilege it is not clear that there is a separate thing in respect of which a

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therefore concludes that a real right of publicity in Scots law could only be introduced by statute (para 3.4.9).

<sup>90</sup> According to Stair, cited in Reid (ed), *SME Vol XVIII*, para 5.

<sup>91</sup> *Ibid.*, para 6.

<sup>92</sup> *Ibid.*

<sup>93</sup> *Ibid.*, para 5.

<sup>94</sup> GCH Paton (ed), *Baron David Hume’s Lectures 1786-1822 Vol IV*, 1955 (henceforth *Hume’s Lectures IV*), at 64 *et seq.*

<sup>95</sup> Reid (ed), *SME Vol XVIII*, para 5. See also discussion at section 4.3.2 regarding exclusive privilege and intellectual property rights.



right can arise.”<sup>96</sup> Exclusive privilege, and the classification of intellectual property, merit further attention and will be discussed in section 4.3 below.

## 4.2. Owning Persona

The right of ownership is defined by Reid as “a right to use, or to prevent others from using, a thing”,<sup>97</sup> and he quotes from Hume who tells us that real rights impose an “obligation upon all the world... to respect that right of his, and abstain from troubling him in the use and enjoyment of that thing”.<sup>98</sup> It is the right to *control* the use of the thing, whether by exploiting or using it in person, by licensing it to others, by preventing use, and ultimately by selling or assigning it.

The positive and negative publicity uses can thus be met by recognising a real right in the individual’s persona. A real right in persona would constitute the prior right or initial entitlement identified in section 3 above. This right could be vindicated, if infringed, through delict or unjustified enrichment, or could form the subject matter of a contract for authorised exploitation.

If real rights are in theory capable of protecting publicity, it becomes necessary to determine whether persona can be treated as a “thing”. We therefore need to know how Scots law defines “things”.

### 4.2.1. Defining Things in Scots Law

If the law is to grant and enforce the right to exclude the world, it must ensure that the world knows exactly from what things it is being excluded: the *res* that are the subject of property rights must be clearly identified. Honoré makes the observation that “it is clear that to stare at the meaning of the word ‘thing’ will not tell us which

<sup>96</sup> Reid (ed), *SME Vol XVIII*, para 5.

<sup>97</sup> *Ibid.*, para 3.

<sup>98</sup> *Hume’s Lectures vol II*, at 2, cited in Reid (ed), *SME Vol XVIII*, para 3.



protected interests are conceived in terms of ownership”.<sup>99</sup> We must therefore look for other means of identifying our things.

MacCormick considers the right to a horse, to shares in a company and to a house, all of which are things or *res* in the eyes of the law: they

are conceived as durable objects existing separately from and independently of other objects and of persons, subject to being used, possessed, and enjoyed by persons, and capable of being transferred from one person to another without loss of identity as that very thing.<sup>100</sup>

This definition of a thing gives us three criteria to be met before thinghood can be demonstrated: (i) it must be durable; (ii) it must exist separately from and independently of a person; and (iii) it must be capable of being transferred from one person to another without loss of identity.

Each of these three elements can be considered in turn. Firstly, a thing must endure. MacCormick explains that this requires that a thing must have “a continuing identity over a period of time”<sup>101</sup> and in some cases it will also have a location in space. Defining durability in this manner means that incorporeals can be things, as they endure in time, albeit not in space, while corporeals have both a spatial and a time vector.

The second requirement, that of separate existence, continues the process of reification and allows us to draw a more definite line between things and non-things. Separability operates to exclude from property certain “things” which may demonstrate typical markers of objects of property, such as value, control, exploitation and exclusion, but which are not things. As Penner argues, I can value or even exploit a friendship, and I can control and exclude others from a talent I possess, yet friendship and talents are not typically classed as “things” within the scope of real rights. The difficulty “lies in treating these things as separate from us in any straightforward way.”<sup>102</sup> This need for separate and independent existence

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<sup>99</sup> A Honoré, “Ownership”, in AG Guest (ed) *Oxford Essays in Jurisprudence*, 1961, at 130.

<sup>100</sup> MacCormick, *Institutions of Law*, at 136, note omitted.

<sup>101</sup> *Ibid.*

<sup>102</sup> Penner, *The Idea of Property in Law*, at 111.

thus excludes certain things of value or aspects of my body, such as friendship or my eyesight, from the sphere of property, as they cannot exist independently of me. As Penner memorably puts it, “[w]e do not... pay taxes with our eyesight.”<sup>103</sup>

The requirement for a “thing” in property to have an existence independent from the owner does not exclude intangibles *per se*, but it does help to resolve questions of ownership of persons, whether in whole or in part, or their incorporeal elements. Whereas classification of things as corporeal or incorporeal allows us to categorise our bodies as corporeal but does not provide guidance as to thinghood, MacCormick’s definition now determines that our own bodies are not things for the purposes of property law, as they are not capable of separate existence from us, or from our persons. Yet although MacCormick’s definition helps us reach this conclusion, the question of ownership of human bodies remains a complex and ethically-charged one.<sup>104</sup>

From MacCormick’s definition, Penner concludes that although an individual cannot be said to own his own body, this does not exclude the possibility of owning *other* people, as their bodies do exist separately and independently of our own and may therefore be capable of being owned.<sup>105</sup> In contrast, however, Whitty believes that it is not possible for anyone else to own you, but that you may be able to “own” yourself.<sup>106</sup> It is suggested that MacCormick’s analysis is to be preferred. Although owning other human beings is a concept unacceptable to our society, it is not an impossible one: slavery was “an institution which permeated [Roman] law and society but which is so alien to ours.”<sup>107</sup> It is therefore not correct to conclude that a

<sup>103</sup> *Ibid.*, at 112.

<sup>104</sup> Underkuffler rehearses some of the arguments for and against it: *The Idea of Property*, 2003, at 103-108.

<sup>105</sup> Penner, *The Idea of Property In Law*, at 124-125. “The slave-owner can own my body, or own a right to all my actions... But I cannot be the owner of my body or actions since they are inextricable tied to my personality”, at 123.

<sup>106</sup> NR Whitty, “Rights of personality, property rights and the human body in Scots law” (2005) 9 Edin LR 194, at 219-223 and, in the context of the right to bodily integrity in respect of separated parts, see Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.2.

<sup>107</sup> A Rodger, “A very good reason for buying a slave woman?” (2007) 123 LQR 446. Lord Rodger also points out that the Abolition of the Slave Trade Act was passed only 200 years ago, although in an earlier article, Whitty notes that slavery was rejected in Scots law nearly 30 years prior to that, in *Knight v Wedderburn* (1778) Mor 14545: see NR Whitty, “Rights of personality, property rights and the human body in Scots law” (2005) 9 Edin LR 194, at 222, note 197.

legal system *cannot* recognise a human body as susceptible to ownership, although society may have very cogent reasons for deciding that a human being *should not* be owned by another.

The criterion of separability and independent existence also allows a second point to be made, relating to corporeality. It is not possible to reject intangibles as things by arguing that, unlike corporeal objects, their independent existence is a product of statute or the operation of law. MacCormick accepts this proposition but denies it is unique to intangibles:

It is certainly true that the existence, identity, and mutual separateness of incorporeal things such as copyrights, patents, company shares, servitude rights, contractual benefits and the like depend entirely on conventions of thought and speech constituted by legal rules. But it cannot be supposed that the identity and separateness of corporeal things is something utterly independent of human conventions.<sup>108</sup>

For example, a ton of coal is correctly regarded as a corporeal moveable, but whereas the coal itself is naturally occurring, the measurement of it is entirely a product of highly regulated human conventions.<sup>109</sup> So too with land, which is naturally occurring but is frequently identified in Land Certificates and legal documents by imaginary lines which have no physical representation on the ground itself and are only reproduced as grid references on maps.<sup>110</sup> Thus, corporeal things which are frequently held up as paradigm examples of pre-existing things are in fact subject to the same rigorous quantification, measurement and delineation, often statutory, as intellectual property or other intangibles.

Returning to the notion of separation, the philosopher T.H. Green, writing in the nineteenth century, conceived of private property as being not separate but *part* of an individual. Appropriation, according to his analysis (which echoes Hegel's), involves man taking and fashioning

certain external things, certain things external to his bodily members. These things, so "taken and fashioned", cease to be external as they were before.

<sup>108</sup> MacCormick, SME Reissue "General Legal Concepts", para 98.

<sup>109</sup> MacCormick, *Institutions of Law*, at 137.

<sup>110</sup> See the National Galleries of Scotland Act 2003, which defines the "relevant land" according to four grid references.

They become a sort of extension of the man's organs, the constant apparatus through which he gives reality to his ideas and wishes.<sup>111</sup>

The point remains however that the things which are taken and fashioned must start out as being "external to his bodily members" – further evidence of the need for separate and independent existence as a criterion of thinghood.

The final requirement in MacCormick's definition of things is that of transferability without loss of identity. This requires that the thing maintains its character, and is capable of being the same, regardless of who owns it. This emphasises the *erga omnes* character of real rights: because real rights impose a duty of exclusion on third parties which is not person-specific but thing-specific, the duty owed by the third party in respect of the thing remains the same no matter who the owner is. A thing must have a continuing identity regardless of how often it is transferred, or to whom.

One helpful test at this stage as to whether something is separable and transferable (and therefore capable of ownership) involves asking whether it can be treated with other corporeal and incorporeal property in certain situations. Thus, it is possible to ask what things may be attached by creditors in the event of insolvency. Shifting the focus from the individual to creditors raises the much more complex question of whether and how *creditors* could harness the latent or future value of such "assets". This approach thus operates to highlight the distinction between separability and transferability, as it is possible to conceive of something which is separable but not always transferable. Asking whether a creditor could appropriate the thing may therefore help to clarify what can be treated as a thing to be owned: it may be "a better test of the property status of our right to our kidneys to ask, not whether we may sell them, but whether they can be removed and sold by our trustee in bankruptcy to pay our debts."<sup>112</sup>

<sup>111</sup> Green, extract from "Lectures on the Principles of Political Obligation", and reproduced in CB Macpherson, *Property Mainstream and Critical Positions*, 1978, at 105, para 214.

<sup>112</sup> Penner, *The Idea of Property in Law*, at 117. See also Westfall and Landau, "Publicity Rights as Property Rights", at 99-117.

This becomes particularly problematic in the field of publicity rights, where the question arises as to how (and indeed whether) a publicity right should be

integrated into the Scottish system of real rights and personal rights and whether it is or ought to be a real right and as such assignable to singular successors, attachable by the diligence of creditors, adjudgable in bankruptcy sequestration and transmissible to executors on death.<sup>113</sup>

If persona were to be recognised as a “thing” could it fulfil the tripartite definition?

And could it be passed to creditors or inherited on the death of the individual?

#### **4.2.2. Persona as a Thing**

For an individual’s persona to be the subject of a real right of ownership, it must meet the criteria of durability, separability and transferability. If this is the case, then the persona becomes subject to the usual consequences of property ownership. Both these aspects of property are problematic in the case of persona.

As regards the tripartite definition, only the durability criterion presents no problems (at least during life): both the separability and transferability criteria do. It is meaningless to talk of one’s image, for example, being separate or separable from one’s corporeal body or capable of transfer without loss of identity. The very notion of persona is so clearly bound up with the individual that to attempt to separate out, and transfer on, the constituent (and intangible) elements of a publicity right is a thankless task. The relationship between persona and the individual is fundamental – and fatal, since “for a thing to be held as property, we must not conceive of it as an aspect of ourselves or our ongoing personality-rich relationships to others.”<sup>114</sup>

Further, if persona were to be treated as a thing in Scots law, it would be subject to the usual consequences of property ownership. Thus it could be assigned outright (not simply licensed) or used to satisfy the debts of a creditor. Yet to contend that an individual’s persona could form part of his estate on bankruptcy fails to reflect the reality of the situation. The considerable problems experienced in the US from

<sup>113</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.4.9.

<sup>114</sup> Penner, *The Idea of Property in Law*, at 126.

treating publicity as a property right in this context have been examined in detail by Westfall and Landau, who conclude that “it seems relatively clear that publicity rights should not be treated as property for purposes of bankruptcy.”<sup>115</sup> Yet the pragmatism of this approach, whereby publicity is property for some purposes but not for others, does not sit comfortably with the principles of property law in Scotland.

As we saw in Chapter 4, *persona* is an inherent part of each individual. During life, *persona* is not separable from the individual, nor can it be transmitted without loss of identity – quite literally, in this case. Consequently, it fails to meet the criteria for thinghood under Scots law and thus falls outwith the scope of ownership.

Curiously, this does allow us to conclude that *persona* may be transmissible on death, because at that point the personhood justification ceases to operate to protect the individual (although it may operate in favour of their heirs) and *persona* will be incapable of further change or development at the hands of the individual.<sup>116</sup> Thus, Marilyn Monroe and James Dean are still iconic figures today, decades after their deaths, and, while the public perception of them may evolve over time, their names and images remain fixed as they were at the time of their deaths. A problem does arise post mortem however as regards the durability of *persona* after the death of the individual. This may result in *persona* no longer being regarded as durable, unless it can be shown that the *persona* as fixed in the public consciousness does endure, as with Monroe and Dean.<sup>117</sup>

The rejection of *persona* as a thing in Scots law means that publicity rights cannot be subject of ownership in Scotland, despite their treatment as such in the value-focused Common law system of the United States, for example.<sup>118</sup> This conclusion in Scots law denies individuals the benefit of the most comprehensive legal right, the real

<sup>115</sup> Westfall and Landau, “Publicity Rights as Property Rights”, at 117, and see discussion at 99-117, in the context of divorce and bankruptcy.

<sup>116</sup> Society’s “interpretation” or attitude towards the deceased may, of course, continue to evolve.

<sup>117</sup> The existence of a post mortem right will be discussed in Chapter 7.

<sup>118</sup> The judicial approach to property in the US can be summed up by Judge Frank: “here, as often elsewhere, the tag “property” simply symbolizes the fact that courts enforce a claim which has a pecuniary worth.” *Haelan Laboratories v Topps Chewing Gum* (1953) 202 F.2d 866, at 868.

right of ownership. Although individuals may regret this conclusion, there would be very serious concerns with treating persona as a thing subject to ownership (not least the subset of persona which comprises personal information). Doing so would create a far-reaching right, beyond any requirement of publicity rights. Concerns about the consequences of this were central to many of the arguments discussed in Chapter 4, which were made *against* a property right in publicity. Even those writers who were in favour of a publicity right accepted that a property right granted “overbroad”<sup>119</sup> protection for publicity.

If individuals were to be granted property rights in their name, stage name, nickname, image, voice, characteristics and “trade mark” gestures or catchphrases, private information, together with reputation and goodwill, if any, then their right to control would far exceed anything currently recognised or even required. The analysis of publicity rights so far emphasises the value of these attributes when they are exploited, typically commercially. Yet to recognise them as property would take legal protection far beyond the exploitation of persona in the publicity uses. Instead, a property right would enable an individual to control *any* use of his persona, including use in a wide range of government, administrative, health, and employment contexts, and in news reporting.<sup>120</sup> This would be an extreme and unprecedented development, and would require extensive exceptions, defences and permitted uses. The advantage of providing an individual with a strong right to control the use of his persona is far out-weighed by the damaging impact that would be caused by the grant of such a right, or the complications involved in minimising this impact. The repercussions would be much wider than simply the protection of an individual’s publicity rights.

#### **4.2.3. Summary of Rights in Things**

The above analysis has demonstrated that the real right of ownership can only be exercised in respect of a “thing”: for publicity to be protected through ownership the

<sup>119</sup> de Grandpre, “Understanding the market for celebrity”, at 79.

<sup>120</sup> The US limits protection by requiring “commercial use” of persona, but reliance on the notion of commercial use to delineate the right is not satisfactory, as explored in Chapter 3, section 2.1.



subject of publicity exploitation, persona, would require to be classified as a “thing”. Yet the concept of things in Scots law is such that persona does not qualify as a thing. Regardless of its treatment in other jurisdictions, the persona of an individual is neither separable nor transferable.

However, as noted above, the eighth real right is peculiar since it does not depend on the prior existence of a thing. Instead, exclusive privilege is a right which enables the holder of the exclusive right to do something, and to prevent others from doing that thing.

### 4.3. Exclusive Privilege

#### **4.3.1. The Right of Exclusive Privilege – Advantages and Obstacles**

Exclusive privilege is a monopoly right,<sup>121</sup> being “an exclusive, and valuable, right to do something and, hence, to stop others from doing the same thing.”<sup>122</sup> It is identified by Reid as the eighth real right.<sup>123</sup> Its status as a real right is supported by earlier writers in Scots law, including Adam Smith<sup>124</sup> and David Hume.<sup>125</sup> Smith classes exclusive privileges as real rights through an analogy with the rights of the heir to inherit: “[i]f therefore we account the right of inheritance to be a real right, as it certainly is, all other exclusive priviledges will for the same reason be accounted real rights”.<sup>126</sup> Hume notes that the right of the heir to take up the succession “is not, by any means, a full and perfect right of property”<sup>127</sup> but that nonetheless the features of the right are such that it “is thus marked with all the characters of a proper legitimate and real right.”<sup>128</sup>

<sup>121</sup> Meek *et al*, *Adam Smith Lectures*, at i.20 (at 11).

<sup>122</sup> Reid (ed), *SME Vol XVIII*, para 5, with reference to Smith and Hume.

<sup>123</sup> *Ibid.*

<sup>124</sup> Meek *et al*, *Adam Smith Lectures*, at i.16-17, i.20 (at 10-11) and ii.27 – ii.41 (at 81-85).

<sup>125</sup> *Hume’s Lectures IV*, chapter IV.

<sup>126</sup> Meek *et al*, *Adam Smith Lectures*, at i.20 (at 11). Note however that Reid suggests that the classification of the right of the heir as a real right is “doubtful”, Reid (ed), *SME Vol XVIII*, para 5.

<sup>127</sup> *Hume’s Lectures IV*, at 38.

<sup>128</sup> *Ibid.*

Despite its historical pedigree, exclusive privilege is frequently overlooked in Scots law today,<sup>129</sup> and perhaps with some justification: many of the examples of exclusive privilege given by Smith and Hume are no longer terribly relevant to current society. For example, Hume provides considerable detail of the privileges of the Royal Burghs and the Merchant Guilds<sup>130</sup> – both of which he asserts “are proper instances of real right”.<sup>131</sup> While monopoly rights over port and ferry facilities<sup>132</sup> are still exercised today, the privileges of the Burghs and Guilds, the right of thirlage,<sup>133</sup> the right to hunt down game once the chase has started,<sup>134</sup> and the right of the heir between the death of the last proprietor and the inheritance<sup>135</sup> are not rights which could be said to play a primary role in daily life in the twenty-first century.

Although the historical classes of exclusive privilege may have lost much of their relevance, the concept is potentially of considerable utility for the protection of more modern rights, including publicity. Of primary importance is the fact that it is the only real right in Scots law which does not have a “thing” as its subject. This is significant for publicity where, as demonstrated, *persona* cannot be classified as a thing. While this excludes *persona* from ownership it is not a handicap in the context of the real right of exclusive privilege. Further, Reid’s definition of exclusive privilege – an exclusive and valuable right to do something and to prevent others from doing the same thing – sounds very much like the right that individuals try to exploit and protect in publicity situations.

From this initial analysis, it appears that publicity could well be classed as a right of exclusive privilege in Scots law, since the focus is on the right to do (and prevent others from doing) a particular act, rather than on an identifiable and transferable thing. Yet although publicity appears to fit within this notion of exclusive privilege, a potential problem arises. In light of the typical subject matter of such rights

<sup>129</sup> For example, there is no reference to it in the index of the latest edition of Gloag and Henderson, while Reid (ed), *SME Vol XVIII* devotes one paragraph to it, para 5.

<sup>130</sup> See *Hume’s Lectures IV*, at 39-54, and for the privileges of Corporations see 39-58.

<sup>131</sup> *Ibid.*, at 39.

<sup>132</sup> Reid (ed), *SME Vol XVIII*, para 336.

<sup>133</sup> Meek *et al*, *Adam Smith Lectures*, at ii.37-38; *Hume’s Lectures IV*, at 38.

<sup>134</sup> Meek *et al*, *Adam Smith Lectures*, at i.20 and ii.28.

<sup>135</sup> *Ibid.*, at i.20 and ii.27; *Hume’s Lectures IV*, at 38.

historically, it is not entirely clear whether a right of exclusive privilege can be assigned or licensed or whether it inheres only to the person granted the privilege. For example, where a miller was granted a right of thirlage, was it open to him to exploit this right by sub-contracting the milling – effectively licensing the right – or was his exploitation of the right limited to working it himself? If rights of exclusive privilege cannot be assigned or licensed, this would adversely affect the value of classing publicity as a right of exclusive privilege since, as shown, the positive exploitation of publicity frequently occurs through licensing.

Hume’s analysis of the exclusive privileges of the day does not clarify whether the exclusive privilege of freemen of Royal Burghs to export the staple goods<sup>136</sup> could be assigned by a freeman to another individual. The same doubt applies to the privilege of “the exercise of crafts or mechanical trades within Burgh, which is confined to the freemen of the Burgh’s incorporated trades.”<sup>137</sup> Although these and similar privileges are the subject of fifteen pages of discussion in Hume’s Lectures, there is no direct insight into whether such exclusive rights can, in themselves, be traded. The grant of the right, from the King or through power delegated to the Magistrates and Council,<sup>138</sup> was the primary source of the right. In some circumstances, ex-soldiers were able to take up a restricted trade and if this happened “the privilege is extended to the wives, widows, and children of such old soldiers”<sup>139</sup> but only where they could carry out the trade themselves. Aside from these references to a limited right to transfer or extend the right, and then only to personal rather than commercial assignees, it is not at all obvious that there was any trade in the privilege itself: the inference is very much that the exclusive privilege was personal to the holder. The value of the privilege came from being entitled to carry out the privileged act, and not from the value of assigning or licensing it.

One class of exclusive privilege which does derive considerable value from the ability to assign or license it, as well as to exploit it in person, is intellectual property.

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<sup>136</sup> *Hume’s Lectures IV*, at 40.

<sup>137</sup> *Ibid.*, at 43.

<sup>138</sup> *Ibid.*, at 43-44.

<sup>139</sup> *Ibid.*, at 58.

What insights, if any, can be derived from intellectual property's role as a right of exclusive privilege?

#### **4.3.2. Intellectual Property: A Right of Ownership or a Right of Exclusive Privilege?**

As Bell noted, a patent right:

is useful as property in these respects: 1. It secures to a patentee the profits of the sale of the thing invented. 2. The privilege may be assigned in whole or in part. The patent generally bears a restriction not to be communicated to more than five. But the whole privilege may be sold.<sup>140</sup>

Similarly, copyright can be enforced by assignees or successors of the author,<sup>141</sup> as well as being exploited by the author in person. Intellectual property therefore allows for exploitation in person, and the correlative right to prevent unauthorised exploitation, as well as the right to exploit through transfer, through assignation or licensing, to third parties.

The question therefore arises whether intellectual property is indeed a right of exclusive privilege, being a limited monopoly, or whether its transferability indicates that it is in fact a thing subject to ownership. This debate arises from the historical origins of intellectual property<sup>142</sup> since today there is less doubt<sup>143</sup> that intellectual property can be classed as "property" in the sense of ownership. The current statutory bases of the various intellectual property rights assert their status as property. Thus, the Copyright, Designs and Patents Act 1988 opens with the statement that "Copyright is a property right".<sup>144</sup> Under the Trade Marks Act 1994 a "registered trade mark is a property right",<sup>145</sup> and the Patents Act 1977 states that, in

<sup>140</sup> GJ Bell, *Commentaries on the Law of Scotland*, (ed) J McLaren 7<sup>th</sup> ed, 1878, at 105. For the current law, see the Patents Act 1977, s31(3) and (4).

<sup>141</sup> GJ Bell, *Commentaries on the Law of Scotland*, (ed) J McLaren 7<sup>th</sup> ed, 1878, at 116, paras 2 and 5. For the current law, see the CDPA 1988, s90.

<sup>142</sup> See H MacQueen, "Intellectual property in Scotland c.1700-1850" (forthcoming).

<sup>143</sup> Although there is still some doubt – there are those who favour the view of intellectual property as distinct from tangible property. Beverley-Smith, for example, concludes that "in the case of intellectual property, the term "property" is used in a purely metaphorical way." Beverley-Smith, *The Commercial Appropriation of Personality*, at 278 and more generally at 277-283.

<sup>144</sup> CDPA 1988, s1(1).

<sup>145</sup> Trade Marks Act 1994, s2(1).

Scotland, any “patent or application for a patent, and any right in or under any patent or any such application, is incorporeal moveable property”,<sup>146</sup> and that such right can be licensed, assigned or be made the subject of a standard security.<sup>147</sup>

Academic work, particularly in the Common law tradition, frequently equates intellectual property with corporeal property: a patent, for example, grants “a right to exclude, just as the law of trespass does with real property. Intellectual property is intangible, but the right to exclude is no different in principle from General Motors’ right to exclude Ford from using its assembly line”.<sup>148</sup> The current leading work on property in Scots law, the Stair Memorial Encyclopaedia, observes of intellectual property that “nearly all the rights are treated as a form of incorporeal moveable property, transferable by assignation”.<sup>149</sup> MacCormick observes that there is certainly no conceptual problem with treating intellectual property rights as “things” susceptible to ownership, since the “existence of incorporeal things, requires durability in time, not extension in space.... On this view, there is no special problem about applying the Gaian scheme to items of intellectual property as to other incorporeal things.”<sup>150</sup>

Historically, matters were not always so clear. Smith referred to the concept of state-granted monopolies as real rights in his introductory lecture, and then devoted part of his second lecture to these exclusive privileges – yet also used the language of property. He stated that

the property one has in a book he has written or a machine he has invented which continues by patent in this country for 14 years, is actually a real right. During that time he can claim restitution, or shew for damages from any one who prints his book or copies his machine, so that he may be considered as having a real right to it.<sup>151</sup>

<sup>146</sup> Patents Act 1977, s1(2).

<sup>147</sup> *Ibid.*, ss31(3) and 31(4).

<sup>148</sup> F Easterbrook, “Intellectual Property is Still Property”, in A Moore, *Information Ethics Privacy, Property, and Power*, 2005, at 114.

<sup>149</sup> Reid (ed), *SME Vol XVIII*, para 802.

<sup>150</sup> MacCormick, SME Reissue “General Legal Concepts”, para 121, footnote omitted. The Gaian scheme referred to is that of “persons, things, actions”.

<sup>151</sup> Meek *et al*, *Adam Smith Lectures*, at i.20. See also A Smith, *Wealth of Nations*, (ed) K Sutherland, 1998, for further analysis, particularly at 60, 352 onwards and 418.

Hume classed patents and copyright as exclusive privileges<sup>152</sup> and concluded that these rights were not founded on common law. Instead, “the copyright of authors rests intirely upon statute, upon the Statute the 8<sup>th</sup> of Queen Anne”.<sup>153</sup> This opinion is based in large measure upon the English case of *Donaldson v Beckett*<sup>154</sup> heard in 1774, wherein a 6-5 majority of the House of Lords held that

Whatever encouragement may be due to authors, the common law cannot, after the silence of ages, pronounce at once upon a new species of rights which has been hitherto property, not properly known... The statute of Ann was not declaratory of the common law, but introductive of a new law, to give learned men a property which they had not before.<sup>155</sup>

The Court of Session had reached the same conclusion the previous year<sup>156</sup> and applied it in a series of copyright cases in the final decades of the eighteenth century.<sup>157</sup>

Of the historical debate, MacQueen has stated that in Scotland “the firm view came to be that copyright was not a right of property but a form of statutory monopoly, restricting for reasons of public policy what would otherwise be the natural liberties of mankind.”<sup>158</sup> Deazley’s analysis of the origins of copyright supports this assessment. He concludes that the evolution of copyright in the eighteenth century from the Statute of Anne to the case of *Donaldson v Beckett*<sup>159</sup> has been subject to a “back-reading”.<sup>160</sup> This has created a myth regarding the origin of copyright, which advances the view that the Statute of Anne was passed to protect the labour of authors and their property in that labour. In doing so, the Statute allegedly over-

<sup>152</sup> *Hume’s Lectures IV*, at 59-72.

<sup>153</sup> *Ibid.*, at 66.

<sup>154</sup> (1774) 2 Bro PC 129.

<sup>155</sup> *Ibid.*, at [139-140].

<sup>156</sup> *Hinton v Donaldson* (1773) Mor 8307.

<sup>157</sup> Two of interest are: (i) *Thomas Payne and Thomas Cadell v William Anderson and John Robertson* (1787) Mor 8312, in which the pursuers’ failure to comply with the Statute of Anne deprived them of any action against the defenders for unauthorised publication, there being no common law right of redress (albeit their claim for an early form of passing off was successful), see 8316; and (ii) *Her Majesty’s Printer & Stationer v Messrs Bell & Bradfute, and Others* (1790) Mor 8316, where the Court confirmed the Royal prerogative to grant the exclusive right to publish bibles.

<sup>158</sup> H MacQueen, *Copyright, Competition and Industrial Design*, 2<sup>nd</sup> ed, 1995, at 3.

<sup>159</sup> (1774) 2 Bro PC 129 at [139-140], and the Scottish case on the same point: *Hinton v Donaldson* (1773) Mor 8307.

<sup>160</sup> Deazley, *On the Origin of the Right to Copy*, at xxiii.

turned the “common law” notion of copyright in published works<sup>161</sup> and replaced it with a limited monopoly right for authors of 14 years. Deazley seeks to show that there was no comparable concept of copyright or author’s rights prior to the Statute of Anne, and that this notion of the common law rights of authors has been constructed, post-legislation, in the eighteenth century and thereafter.<sup>162</sup> He concludes that “[a] statutory phenomenon, copyright was fundamentally concerned with the reading public, with the encouragement and spread of education, and with the continued production of useful books.”<sup>163</sup> Copyright was therefore never intended to protect the proprietary interests of the author, but was indeed a limited statutory grant of a right to encourage the dissemination of learning. What came after was an attempt to impose sense and order on the complex and non-linear progression of copyright in the eighteenth century,<sup>164</sup> coupled with the evolving scope of copyright, and drew strength from the notions of property in one’s labour, as popularized by Locke.<sup>165</sup> Deazley’s analysis would support the notion of copyright as a right of exclusive privilege, created by statute, rather than a property right arising at common law.

Yet the Statute of Anne, and cases such as *Donaldson v Beckett*, were concerned only with regulating the use of published works. Copyright in *unpublished* works, which Deazley argues<sup>166</sup> was effectively created by implication in *Donaldson v Beckett*, remained a matter for the common law until the Copyright Act 1911.<sup>167</sup> As Richardson and Hitchens note “the right of publication of such texts [that is, private writings and etchings] was reserved to the author on the basis of a property right in the unpublished work, supplementing the various statutory copyrights in published

<sup>161</sup> Unpublished works remained subject to different principles until their regulation under the Copyright Act 1911 and their eventual assimilation to published works in the CDPA 1988. See, for example, R Deazley, *On the Origin of the Right to Copy*, 2004 (henceforth Deazley, *Origin of the Right to Copy*) at 220; MacQueen *et al*, *Contemporary Intellectual Property*, paras 2.4-2.6.

<sup>162</sup> Deazley, *Origin of the Right to Copy*, at 221-226.

<sup>163</sup> *Ibid.*, at 226.

<sup>164</sup> *Ibid.*, particularly at 221-226.

<sup>165</sup> *Ibid.*

<sup>166</sup> *Ibid.*, at 220.

<sup>167</sup> Common law copyright in unpublished works was abolished by the Copyright Act 1911, section 31. See Cornish and Llewelyn, *Intellectual Property*, para 10.08, note 34; Deazley, *Origin of the Right to Copy*, at 220; G Davies, *Copyright and the Public Interest*, 2<sup>nd</sup> ed, 2002, (henceforth Davies, *Copyright and the Public Interest*), paras 4-001 – 4-005; Richardson and Hitchens, “Celebrity Privacy”, at 254; and MacQueen *et al*, *Contemporary Intellectual Property*, para 2.6.



works.”<sup>168</sup> There is also evidence that copyright in both published and unpublished works (that is, copyright arising from statute and by operation of the common law) was treated as “property” rather than a monopoly right. Morison’s Dictionary, for example, records a number of cases in the eighteenth century under the heading “Literary Property”, some of which related to the right of the author in works which were intended to remain unpublished.<sup>169</sup> The historical debate may partly be coloured by the increasing importance of the terminology of property in the nineteenth century, as the market economy grew in importance. Accordingly, “[t]rade secrets were often labelled “property”. So too were unpublished texts, including texts of a more personal kind”.<sup>170</sup>

Given the complex (and, according to Deazley, partly mythologized) origins of copyright and other intellectual property rights, it is beyond the scope of this thesis to attempt to reach a definitive conclusion as to the legal status of intellectual property rights in the twenty-first century.<sup>171</sup> It is arguable that two factors mean that the resolution of this issue, while instructive, is not essential for current purposes. In the first place, the reality is that intellectual property rights have been capable of transfer from the outset as, for example, Bell makes clear.<sup>172</sup> Thus, their ultimate classification in theory as rights of ownership or of exclusive privilege does not impact upon whether or not they can be assigned or licensed in practice. The second point is that intellectual property is entirely dependent on statute for its existence. To this extent, its classification as property or exclusive privilege is over-ridden by its statutory basis. Where the legislation does not cover either the creation or the particular act of copying, then there is no remedy in copyright for the creator.<sup>173</sup>

<sup>168</sup> Richardson and Hitchens, “Celebrity Privacy”, at 254.

<sup>169</sup> For example, *Dodsley v McFarquhar*, (1775) Mor 8308.

<sup>170</sup> Richardson and Hitchens, “Celebrity Privacy”, at 253, footnote omitted.

<sup>171</sup> For further discussion on this point, see H MacQueen, *Copyright, Competition and Industrial Design*, 2<sup>nd</sup> ed, 1995, chapter 1; Reid (ed), *SME Vol XVIII*, para 931 (re copyright); Deazley, *Origin of the Right to Copy*; B Sherman and L Bently, *The Making of Modern Intellectual Property Law: the British Experience 1760-1911*, 1999 (henceforth Sherman and Bently, *The Making of Modern Intellectual Property Law*); and Davies, *Copyright and the Public Interest*.

<sup>172</sup> See text at notes 140 and 141.

<sup>173</sup> For a very clear example of this see *Norowzian v Arks Ltd* (No 1) [1999] EMLR 57; *Norowzian v Arks Ltd* (No 2) [2000] EMLR 67.

Perhaps the final word for the present review should go to Reid who acknowledges the complexities in classifying intellectual property rights:

there are obvious points of resemblance between intellectual property rights and real rights in the traditional sense, in particular the fact that both types of rights are enforceable against the world at large, and it is plain that intellectual property rights cannot be classified as personal rights. Consequently, unless they form a third category of right *sui generis*, as in some legal systems, it may be that Hume's classification [as exclusive privilege] ought to be accepted.<sup>174</sup>

Whether viewed as rights of exclusive privilege or ownership, or indeed in some third class as *sui generis* rights, modern intellectual property rights are powerful economic tools which protect the valuable intangible output of an individual, together with his moral or dignitarian interests. Further, they rely upon a statutory grant to determine their full extent. The right to assign and license is therefore the result of their statutory basis rather than their classification as either property or exclusive privilege.

## 5. THE NATURE OF A PUBLICITY RIGHT IN SCOTS LAW

### 5.1. Introduction

Having looked at personal and real rights, it is now possible to address the question of where a right of publicity fits in Scots law. Publicity is a difficult right to classify, in part because of the tension caused by the need to protect its economic and dignitarian interests equally. From the foregoing analysis of publicity rights and Scots law, it is submitted that neither ownership nor personal rights reflect the complex right revealed: a right which is non-separable but requires to be good against the world; which is personal to the individual, but of considerable commercial importance; and which can be licensed but not assigned.

It is submitted that the most appropriate classification of any right of publicity in Scots law is as a right of exclusive privilege. While personal rights may be used to

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<sup>174</sup> Reid (ed), *SME Vol XVIII*, para 5, footnotes omitted.

enforce an individual's right against a particular party, the right of publicity needs to be good against the world and capable of being licensed. This would suggest that publicity is a real right, yet the real right of ownership cannot be engaged, since *persona* is not a "thing" in Scots law. Thus, publicity rights fall most appropriately into the curious category of rights of exclusive privilege, which recognises real rights in monopolies, without the need for a thing. Further strength for this conclusion can be drawn from a brief comparison of publicity with the closest monopoly right, intellectual property.

## 5.2. Intellectual Property and Publicity Rights

For present purposes, intellectual property rights demonstrate a very valuable characteristic: the ability to recognise and protect economic and dignitarian interests at the same time. Copyright, for example, grants a transferable economic right and a non-transferable moral right. The commercial value in intellectual property can be exploited through licensing or assigning.<sup>175</sup> With regard to copyright, MacQueen notes that "licensing comes into its own and gives the copyright owner considerable power to control the market in his work."<sup>176</sup> Further, "[c]opyright is not simply about earning a reward for the owner, as might still happen with a compulsory licence; it embraces the author's moral right to control reproduction."<sup>177</sup> Both the economic and dignitarian interests enable *control*, albeit subject to internal regulation through the statutory grant of the right and external regulation through, for example, competition law.<sup>178</sup>

Moral rights are intended to allow the creators of works to "control the treatment and presentation of their work by others"<sup>179</sup> and, critically, "these rights remain with the

<sup>175</sup> See for example Cornish and Llewelyn, *Intellectual Property*, chapter 7 (exploitation of patents); chapter 13 (exploitation of copyright).

<sup>176</sup> H MacQueen, *Copyright, Competition, and Industrial Design*, 2<sup>nd</sup> ed, 1995, at 3.

<sup>177</sup> *Ibid.*, at 21.

<sup>178</sup> For example, through the grant of compulsory licences. The interface between intellectual property and competition is explored in a series of articles in the December 2005 edition of *SCRIPT-ed*, (Vol 2, Issue 4), available at <http://www.law.ed.ac.uk/ahrc/script-ed/issue2-4.asp> (accessed 22 June 2008).

<sup>179</sup> E Adeney, *The Moral Rights of Authors and Performers*, 2006, para In.01.

author or performer even after economic rights have been alienated.”<sup>180</sup> Although their recognition in the UK “can best be described as defensive, with most [moral rights] aimed at addressing perceived threats to industry”<sup>181</sup> rather than perceived threats to authors, it remains the case that authors of copyright works have the right to be identified as the author of the work; to object to derogatory treatment of the work; and to prevent false attribution of the work.<sup>182</sup> These are all rights aimed at protecting the author’s moral or dignitarian interests in his work and accordingly in the UK they remain with the author for the duration of his life and with his assigns for the duration of the copyright in the work,<sup>183</sup> although they can be waived.<sup>184</sup> Copyright therefore demonstrates the critical attribute of control and exclusion which characterises property rights and gives them value, both economic and moral. This duality is similar to that sought for publicity rights, whereby the economic value can be exploited through licensing or personal use while the dignitarian interests of the individual are also protected.

A final point of interest is the support that writers such as Hume and Smith gave to intellectual property monopolies. Despite being opposed to monopolies in general, as being “extremely detrimental”<sup>185</sup> and tending to “promote the poverty or, which comes to the same thing, the uncomeatibleness of the thing so monopolized”,<sup>186</sup> Smith acknowledged that the privileges of copyright and patents “can do no harm and may do some good, [and] are not to be altogether condemned”.<sup>187</sup> Hume likewise appeared to support these rights, despite criticising the abuse of other

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<sup>180</sup> *Ibid.*, para In.05.

<sup>181</sup> *Ibid.*, para 14.02. Again, this reflects the control exercised by the industry, as raised in Chapter 4.

<sup>182</sup> These rights are contained in the CDPA 1988, ss77-79 (identification as author), 80-83 (derogatory treatment) and 84 (false attribution).

<sup>183</sup> CDPA 1988, s86(1), subject to the exception in s86(2) which provides that the right to object to false attribution only lasts for the life of the author plus 20 years. Note that in some jurisdictions, such as France, the *droit moral* is believed to last indefinitely following death: see Adeney’s comment on this in *The Moral Rights of Authors and Performers*, 2006, para 2.52.

<sup>184</sup> CDPA, s87.

<sup>185</sup> Meek *et al*, *Adam Smith Lectures*, at ii.33. See also N MacCormick, “On the very idea of intellectual property: an essay according to the institutionalist theory of law” [2002] IPQ 227, at 237.

<sup>186</sup> Meek *et al*, *Adam Smith Lectures*, at ii.34. The use of “uncomeatibleness” in these lectures is probably a neologism referring to the exclusivity of any item subject to a monopoly. Thanks to Professor John Cairns for his help with my interpretation of the *Lectures* in this regard.

<sup>187</sup> *Ibid.*, at ii.33.

monopolies in particular commodities.<sup>188</sup> However, the support given to a monopoly right of copyright by Hume, Smith and others, was qualified by the need to ensure that the monopoly was as short as possible, while still securing the benefits of the right.<sup>189</sup>

### 5.3. Creating a Right of Publicity in Scots Law

The question then arises how such a right of exclusive privilege in persona could be recognised in Scots law. It is suggested that any such right would require to be statutory.<sup>190</sup> It is not entirely clear that a new common law monopoly right could be recognised through judicial development. Although there is no clear guidance either way, the primary rights of exclusive privilege in evidence today have their basis in statute. Earlier rights, such as thirlage or hunting down game, may well have had a common law origin, but the basis for this is no longer obvious in Scots law.<sup>191</sup> Whether classed as a right of exclusive privilege or as property subject to ownership, intellectual property rights arise from statutory grants, as was discussed above, and any increase in the scope of these rights results from legislative amendment, rather than judicial development.

A statute creating a right of publicity would enable a holistic, coherent and consistent approach to this new right, framed within the established category of exclusive privilege. This would be in contrast to the *ad hoc*, and often opportunistic, development of new rights through litigation which, of necessity, is limited by the scope of the individual action before the court.<sup>192</sup> A legislative solution would be capable of recognising both the economic and dignitarian interests in the monopoly

<sup>188</sup> *Hume's Lectures IV*, at 60.

<sup>189</sup> For example, Davies, *Copyright and the Public Interest*, para 4-005, citing Lord Macaulay's speeches in the Houses of Parliament, 1841. See also the discussion of this point in Chapter 7, section 3.

<sup>190</sup> This raises a question as to legislative competence. It is suggested that the Scottish Parliament would have competence to introduce a new statutory right of exclusive privilege, since "private law" is not reserved, although intellectual property matters are, as per The Scotland Act 1998, s126, and Schedule 5, Head C4. See also Whitty, "Overview of Rights of Personality in Scots Law", para 3.4.9, note 322.

<sup>191</sup> Neither Hume nor Smith are explicit on this point.

<sup>192</sup> For an account of the serious limitations of development of the common law in this way, see R Buxton, "How the common law gets made: *Hedley Byrne* and other cautionary tales" (2009) 125 LQR 60; also Westfall and Landau, "Publicity Rights as Property Rights".

right, as copyright demonstrates. The scope of the right, its limitations, the method for exploitation, and remedies for breach could all be clearly specified, thus accommodating both authorised and unauthorised exploitation in one measure. A statutory grant would also address the slight question that remains as to whether rights of exclusive privilege are susceptible to transfer, since it would be in the power of the statute expressly to enable, or prohibit, any assignation or licence of persona.<sup>193</sup> Further, a statutory grant could provide that any licensee of persona acquires an enforceable right against the world through that licence. A final advantage of a statutory monopoly is that the right could be framed in such a way to ensure it is considerably more limited in scope than a property right, thereby avoiding the dangers of an “overbroad” right of ownership in persona.<sup>194</sup>

Reference to the various US statutes which create a right of publicity is also instructive. Although the wide scope of these (largely property-based) rights is not advocated, they do show the degree of creativity which can be achieved through legislation. For example, the State of Washington distinguishes between an “individual” and a “personality”, enabling it to grant differential post mortem rights to those it regards as personalities and who have a commercial standing.<sup>195</sup> This example is not intended to advance the merits of this provision, but rather to demonstrate the flexibility and degree of precision that can be achieved in a statutory right, features which are often lacking in the *ad hoc* development of a right through litigation.

In drafting a monopoly right, however, the legislature will need to consider the scope of the publicity right in greater detail than has so far been done. The next, and final, Chapter will seek to delineate the scope of the right in greater detail.

<sup>193</sup> Whether persona, as something inherently connected with and to the individual, is a suitable subject for assignation or licensing will be examined in Chapter 7.

<sup>194</sup> As per my conclusions in section 4.2.2 above and Chapter 4 in general. See also Westfall and Landau, “Publicity Rights as Property Rights”, for an account of the expansionist tendencies of common law property rights, arising from the “property syllogism”.

<sup>195</sup> Washington Chapter 63.60 RCW Personality Rights, sections 020 and 040. A different example can be seen in the statutory publicity rights of Illinois and Indiana, which both have rather creative provisions for recognising the right post mortem: The Illinois Right of Publicity Act (765 ILCS 1075), section 25; Indiana’s Publicity law IC 32-36-1-19.

## **CHAPTER 7: THE SCOPE OF THE RIGHT OF PUBLICITY: LIMITS AND REMEDIES**

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## 1. INTRODUCTION

The purpose of this chapter is to consider the limits and remedies appertaining to the monopoly right of publicity that has emerged from the foregoing study. Since monopolies can be detrimental<sup>1</sup> and any property right risks being “overbroad”,<sup>2</sup> the limits on a right of publicity are therefore extremely important, and help to balance the interests of the individual with the competing interests of other parties.<sup>3</sup> Part A of this Chapter seeks to provide a clearer insight to the limits of the right of publicity. Once these limits have been more clearly defined, it is necessary to consider the remedies for the individual in the event of infringement and Part B will, therefore, explore appropriate remedies.

In addressing these issues, this Chapter draws on a small-scale piece of empirical research conducted in the course of writing this thesis. The conclusions from my online survey, carried out in 2006 (the “2006 Online Survey”<sup>4</sup>), are illustrative of opinion as to some of the limits and remedies discussed below.

<sup>1</sup> As per Smith: Meek *et al*, *Adam Smith Lectures*, at ii.33-ii.34.

<sup>2</sup> In the words of de Grandpre: “Understanding the market for celebrity”, at 79.

<sup>3</sup> As identified in Chapter 4 and considered also below.

<sup>4</sup> The questionnaire used can be found in Appendix A.

## PART A: LIMITS

While the thesis thus far has focused upon identifying a right of publicity for the benefit of the individual, it has been acknowledged that the grant of such a right impacts upon the interests of other parties. Consequently, the right should go no further than is required to protect the individual's dignitarian and economic interests.<sup>5</sup> The limits of the right, and the countervailing interests which balance the right, must therefore be examined. There are five elements which operate to limit the extent of the right or its exercise:

1. formalities in respect of creation;
2. duration of the right;
3. transfer and transmission of the right;
4. countervailing rights; and
5. permitted uses.

In the case of an action for publicity infringement, these five elements operate to establish: (i) whether or not there is a right (have all formalities been complied with?); (ii) whether there is any limitation on enforcement (has the right expired or been transferred?); (iii) whether there is a countervailing right which operates to prevent reliance on the right; and (iv) whether there is a defence to the infringement claim, based upon permitted uses. The following sections will consider each of these in turn, and the rights of authorised users will, where relevant, also be considered.

The resolution of these issues depends to a large extent on the purpose to be fulfilled by the new right and the justifications for that right. There is therefore a considerable crossover between this chapter and the review of justifications in Chapter 4.

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<sup>5</sup> See Chapter 4, section 9 and Chapter 6, section 5.3, with reference to Smith and Hume. In the context of copyright, Davies notes that Chafee's fourth ideal of copyright requires that protection "should not extend substantially beyond the purposes of protection." Davies, *Copyright and the Public Interest*, para 9-002.

## 2. FORMALITIES

The law often imposes formalities which must be complied with before a right comes into existence. For example, certain contracts are legally binding only where statutory formalities regarding writing have been met<sup>6</sup> while, in the case of land, the real right of ownership arises only once the title has been registered in the Land Register:<sup>7</sup> until that point, the purchaser will have a personal right against the seller – and then only if the formalities of contract have been fulfilled. With patents and trade marks, registration is necessary to benefit from statutory protection.<sup>8</sup> What formalities, if any, should apply in the case of publicity?

### 2.1. Labour or Creativity

One option, which can be swiftly dismissed, would be the need for a minimum standard of labour or creativity in “creating” the persona which is to be protected by the right of publicity. As was shown in Chapter 4, the need for prior labour, and the extent and quality of that labour, are problematic concepts, and it is frequently impossible to determine in any given case whether there has been labour expended in creating the persona and, if so, by whom.<sup>9</sup> More fundamentally, a labour or creativity prerequisite is contrary to the justification for the right of publicity, which refers not to the need to protect (or provide an incentive for) labour expended on persona, but to protect the individual’s autonomy in his persona.<sup>10</sup>

Further, even if we were to assume that (a) a labour requirement could be defined and (b) an identifiable point of creation could be determined, we would still be faced

<sup>6</sup> Requirements of Writing (Scotland) Act 1995, s1.

<sup>7</sup> Land Registration (Scotland) Act 1979, s3.

<sup>8</sup> See for example the Patents Act 1977, ss7-9 and 14-20; the Trade Marks Act 1994, s2(1).

<sup>9</sup> See Chapter 4, section 4. Madow says that “[t]he notion that a star’s public image is nothing else than congealed star labour is just the folklore of celebrity, the bedtime story the celebrity industry prefers to tell us and, perhaps, itself.” Madow, “Private ownership of public image”, at 184.

<sup>10</sup> See Chapter 4, section 5.3

with the issue of an ever-evolving image for each individual. Would the right be re-created with each new achievement or hairstyle of the individual?<sup>11</sup>

In any event, as copyright shows, where there is a requirement for some degree of labour or creativity (or originality in the case of copyright), this requirement is frequently eroded over time to a bare minimum.<sup>12</sup>

## 2.2. Registration

An alternative formality, and one which requires more detailed consideration, is whether or not the right of publicity should come into existence only on the registration of persona, in a manner similar to the trade mark and patent registration systems. In their analysis of the emergence of modern intellectual property law, Sherman and Bently argue that the evolution of the modern system of registration for designs, patents and trade marks is one of the hallmarks of the modern intellectual property regime.<sup>13</sup> Focusing on the administrative aspects of registration (such as form-filling, providing a two-dimensional representation of the mark or design, and so on), means that registration becomes an end in itself, rather than being seen as “a poor imitation of the “true” property – one which was twice removed from the essence of the intangible property”.<sup>14</sup> So long as the invention, design or trade mark could be reduced to the required descriptive and illustrative form, protection would be granted: theoretical debates as to the role of creativity and the merits of treating intangibles as property were superseded by this administrative “closure” of intangible property rights.<sup>15</sup> Intellectual property disputes likewise moved away

<sup>11</sup> Madonna, for example, is well known for re-working her image. The consequences of extending a right through re-working the original subject matter can be seen in early copyright debates. MacQueen notes that Sir Walter Scott was able to extend copyright protection until at least 1870 as a result of revising and re-issuing his works: H MacQueen, *Copyright, Competition and Design*, 2<sup>nd</sup> ed, 1995, at 3. Copyright duration was finally tied exclusively to the life of the author by the Copyright Act 1911. See also WM Landes and R Posner, “An economic analysis of copyright law” (1989) 18 J. Legal Stud. 325, at 363; R Posner, *Economic Analysis of Law*, 7<sup>th</sup> ed, 2007, para 3.3.

<sup>12</sup> “Mundane” compilations such as a timetable index and the listing of programmes to be broadcast have been held sufficient: Cornish and Llewelyn, *Intellectual Property*, para 11-05, and cases cited therein.

<sup>13</sup> Sherman and Bently, *The Making of Modern Intellectual Property Law*, at 180-186. See also 67-76.

<sup>14</sup> *Ibid.*, at 185.

<sup>15</sup> *Ibid.*, at 180 and see also 182-183.

from matters of creativity and originality, to concentrate on interpretation of the registration documents.<sup>16</sup>

In turning the focus from the abstract to the concrete, registration performs a number of beneficial functions. First, it marks the creation not of the intangible but of the legal right over the intangible. The subject of the patent or trade mark may exist, but the existence of the legally enforceable right is dependent on registration. Secondly, registration marks priority, making it easier to determine which party was first to acquire the legal right (if not the underlying subject).<sup>17</sup> The third advantage is that registration enables the owner of the right to be identified with some certainty.<sup>18</sup> A final benefit – and one often cited as the rationale behind granting the legal right in patent cases – is that registration of the patent, design or trade mark provides a source of public information to inform and inspire future work in the field.<sup>19</sup>

Registration often works in tandem with unregistered rights at common law. For example, where an inventor chooses not to register his invention to obtain a patent, he can, in certain circumstances, rely on commercial confidence in trade secrets to protect the invention.<sup>20</sup> Similarly, the law of passing off provides a remedy for misrepresentative use of an unregistered trade mark. One option for publicity rights would therefore be to restrict the exercise of the right to those who have registered their personas, while common law rights (such as passing off and the Article 8 right to privacy<sup>21</sup>) could operate to provide protection insofar as they can in unregistered cases. This would have the advantage of providing certainty as to when a statutory (registered) right of publicity could be exercised, albeit with the risk that the unregistered right may develop over time to offer wider protection than that of the registered right.<sup>22</sup>

<sup>16</sup> *Ibid.*, at 186.

<sup>17</sup> *Ibid.*, at 68.

<sup>18</sup> *Ibid.*, at 68.

<sup>19</sup> *Ibid.*, at 69. See also, for example, Cornish and Llewelyn, *Intellectual Property*, para 3-37; MacQueen *et al*, *Contemporary Intellectual Property*, paras 10-16 – 10-18.

<sup>20</sup> See, for example, Cornish and Llewelyn, *Intellectual Property*, chapter 8.

<sup>21</sup> As discussed in Chapters 3 and 5.

<sup>22</sup> Carty discusses the risks of an expansive application of the doctrine of breach of confidence, whereby it offers wider protection for inventions than that offered by patents: “The modern action for breach of commercial confidence”, particularly at 433.

There are four arguments against imposing a registration requirement for a statutory right of publicity, however. The first consideration is derived from the personal nature of the subject: the individual's persona. As was concluded in Chapter 4, persona is something which inheres to the individual. Writing in the Common law tradition, McCarthy says "The right of publicity is an inherent right of identity possessed by everyone at birth."<sup>23</sup> This attitude is even more strongly held in Civilian systems, where Neethling argues that personality rights, as a category, "come into existence with the birth and are terminated by the death of a human being."<sup>24</sup> Since every individual has, from birth, a persona, it is counter-intuitive to impose a registration requirement before a right over persona can be enjoyed.<sup>25</sup>

A further consequence of the personal nature of the subject is that the main benefits of registration are not easily applied to a right which is so intimately associated with the individual. Unlike patents, designs and trade marks, for example, publicity rights do not give rise to doubt as to the original owner,<sup>26</sup> nor is there any need to establish priority or to share information about the subject for the benefit of the world at large. The typical benefits of registration (which help justify its use) are therefore lacking in publicity rights.

Thirdly, the need for a *sui generis* right of publicity is, in part, based on the lack of protection at common law and the need to ensure a more coherent, rational system of protecting economic and dignitarian interests. To limit this system to those who have chosen to register their persona is disadvantageous to individuals and to other parties alike. Where there has been no registration, both the individual and prospective (or actual) users are left with the incoherent and potentially *ad hoc* protection and liability provided for by passing off and Article 8 – protection which was criticised on a number of grounds in Chapters 4, 5 and 6. There may also be judicial doubts as to the merits of allowing a pursuer to recover through doctrines

<sup>23</sup> McCarthy, "Public personas and private property", at 688.

<sup>24</sup> Neethling, "Personality Rights", at 534. Also Logeais, "The French right to one's image", at 168.

<sup>25</sup> This can be distinguished from the administrative requirement to registers births and deaths: subsequent rights, such as the right to life, are not dependent on having registered one's birth.

<sup>26</sup> The position of subsequent owners, if any, will be considered in section 3.3.

such as passing off, where he could have achieved the legal protection he seeks through registering his persona. These factors add to the already existing uncertainties as to the availability and extent of such common law rights.

The fourth objection is that registration brings costs for both parties: the individual who has to pay to register his persona<sup>27</sup> and, to a lesser extent, the user who has to check the register to see if there has been a registration. These costs are particularly problematic in the case of a right which is intended, in part, to protect dignitarian interests. Requiring an individual to register (and to pay for such registration) in order to protect these interests contradicts the basic need to safeguard them.

Simplicity and certainty have much to offer all interested parties and, given that all individuals have a persona which can be the subject of publicity rights, that simplicity and certainty is more likely to be found by creating a standard right applicable to all. The universal nature of persona and publicity requires a universal right.

The analogy has already been drawn between the right of publicity and copyright and it is interesting to note that copyright is one of the few intellectual property rights not dependent on registration. There are two practical obstacles to imposing a registration requirement on copyright works, namely the large volume of copyright works and the low value of many of them.<sup>28</sup> These objections are also relevant to publicity where, for many individuals, persona will have a low (albeit rarely negligible) economic value. Further, since all individuals have a persona, the large volume of possible applications would prove a considerable administrative burden if registration were required. A third reason why copyright is not well suited to registration is that “unlike the situation with patents, designs and trade marks where applicants had to describe what it was that they were claiming, in the case of copyright it was the object *itself*, the libretto, the score, or the book, rather than a representation of it, which was deposited at Stationers’ Hall.”<sup>29</sup> Copyright is not

<sup>27</sup> And will often incur legal costs, as well as the registration costs, in doing so.

<sup>28</sup> Sherman and Bently, *The Making of Modern Intellectual Property Law*, at 183-184.

<sup>29</sup> *Ibid.*, at 184, emphasis in original. Footnote omitted.



susceptible to further reduction.<sup>30</sup> Again, the same can be said of publicity, where the persona is not easily reduced to registrable criteria in the same manner as patents, designs or trade marks. Further, unlike any of the other intellectual property rights, no guarantor of originality is required, since persona, by its very nature, cannot be pirated. Individuals may imitate another person<sup>31</sup> but they cannot *be* another person.

It is therefore suggested that there should be no formalities as to either labour or registration attaching to the proposed statutory right of publicity. In the same way as copyright comes into existence with the expression or fixation of the idea, publicity rights should come into existence with the individual.<sup>32</sup> A further advantage of this joint birth date is that the date of creation of the right can be ascertained with precision.

### 3. DURATION

#### 3.1. Introduction

Careful consideration must be given to the term of a right of publicity. Whereas the real right of ownership has no fixed term, subordinate real rights frequently expire on the occurrence of a certain event, although the thing over which the right is held will endure. Rights of exclusive privilege, especially statutory monopolies,<sup>33</sup> typically have an expiry date after which there is no right and no remaining control.

<sup>30</sup> This difference between copyright and the other intellectual property rights is indicative, according to Sherman and Bently, of the “pre-modern” nature of copyright protection: *The Making of Modern Intellectual Property Law*, at 193. The differences between copyright and trade marks and patents become more explicit if one uses the term “industrial property” rather than intellectual property, since the origins and rationales for legal protection of industrial property do not easily apply to copyright. For a discussion of these differences see Reid (ed), *SME Vol XVIII*, paras 801-802.

<sup>31</sup> For example, Coombe, *The Cultural Life of Intellectual Properties*, at 96-97; Madow, “Private ownership of public image”, at 197; Carty, “Advertising, publicity rights and English law”, at 249-250. The consequences of fraudulent imitation are examined in cases such as *Morrisson v Robertson* 1908 SC 332 and *Shogun Finance Ltd v Hudson* [2004] 1 AC 119.

<sup>32</sup> Infancy is no barrier to publicity: see the advertisement in Appendix C; also Suri Cruise: <http://www.out-law.com/page-7274> (accessed 4 January 2009).

<sup>33</sup> See CDPA 1988, ss12-15; the Patents Act 1977, s25; and the Trade Marks Act 1994, s42.

Adam Smith believed that monopolies in general were extremely detrimental.<sup>34</sup> Giving the example of a company set up to pursue trade with a “remote and barbarous nation”, he concedes that some trade advantages may be necessary and that

[a] temporary monopoly of this kind may be vindicated upon the same principles upon which a like monopoly of a new machine is granted to its inventor, and that of a new book to its author. *But upon the expiration of the term, the monopoly ought certainly to determine.*<sup>35</sup>

The expiry of the monopoly right was essential to ensure that the benefit to the individual was not procured at society’s expense, because the “privilege involved should be seen as a derogation from the order of natural liberty, and thus as one to be extended only so far as the justification for it runs.”<sup>36</sup> Once the term of the monopoly expires, the subject of the right will lapse into the public domain to be available to all.<sup>37</sup> In creating a new monopoly to protect publicity rights, it is necessary to consider what time limits should be placed upon that monopoly to protect the “order of natural liberty”.

### 3.2. Duration in Life

Determining the duration of the right requires the identification of both the start date and the end date. These are separate issues but, in the case of publicity, are inextricably linked to the life of the individual. As was concluded above, the date of creation of the right should be the date of birth of the individual.

The next issue to be determined is therefore the duration of the right. In America, where publicity is regarded as a property right, the various statutory rights of publicity provide for a lifetime duration.<sup>38</sup> This should not necessarily be the case here, however, when it is recommended that the right of publicity should be

<sup>34</sup> But see also Chapter 6, section 5.2, referring to Smith’s and Hume’s support for limited monopoly rights in the case of intellectual property.

<sup>35</sup> A Smith, *Wealth of Nations*, (ed) K Sutherland, 1998, at 418, emphasis added.

<sup>36</sup> MacCormick, *Institutions of Law*, at 236.

<sup>37</sup> Hughes, “The philosophy of intellectual property”, at 324.

<sup>38</sup> See the US legislation cited below; a detailed analysis of the statutory protection is given by McCarthy, *The Rights of Publicity and Privacy*, chapter 6. He notes that each statutory response is “one of a kind”, para 6:6.

recognised as a monopoly right, rather than as property. Assistance can instead be sought from the statutory monopoly rights of intellectual property. These rights all have fixed terms, but each is different not only in length but also in its potential for renewal. Patents expire 20 years after the application was made and are non-renewable.<sup>39</sup> In contrast, trade marks have a shorter lifespan of 10 years, but this is subject to the right to renew the registered mark for a further period of 10 years, which is exercisable indefinitely.<sup>40</sup>

When copyright was first introduced as a monopoly right by the Statute of Anne 1709, the grant was limited to 14 years, followed by a renewed grant of a further period of 14 years if the author was still alive at the expiry of the first period. In the 300 years since then, the duration of the copyright has been revised and now currently exists for the life of the author plus 70 years.<sup>41</sup> Landes and Posner state that these fixed terms not only reduce the adverse consequences of monopolies, they also reduce tracing costs, being the costs incurred with the necessary effort and expense to trace the owner of a prior intellectual property right in order to seek consent to use the right.<sup>42</sup>

Where should publicity rights fall on this spectrum of term? It seems clear that, as monopoly rights, they should have a fixed duration. Although this provides the need for a limit, it does not provide any further guidance as to what that limit should be. There is no underlying principle which dictates that monopolies must expire after  $x$  years, although Smith would argue that any monopoly created should be of the

<sup>39</sup> The Patents Act 1977, s25(1), states that the 20 year period shall begin with the date of filing the application for the patent “or such other date as may be prescribed”.

<sup>40</sup> Trade Marks Act 1994, ss42 and 43. However, marks which are not used can be removed on application, if 5 years’ non-use can be proved, per s46(1). Subject to this, it is possible for trade marks to last indefinitely: Trade Mark 1, registered on 1 January 1876, is still in force today: <http://www.ipo.gov.uk/tm/t-find/t-find-number?detailsrequested=C&trademark=1> (accessed 18 July 2007).

<sup>41</sup> CDPA 1988, s12. Note that this is in fact the length of copyright protection for literary, dramatic, musical or artistic works: other periods are in place for sound recordings and films, as per ss13A, 13B, 14 and 15. Moral rights have separate terms (s86). Until the CDPA 1988 came into force, there were a limited number of rights which lasted in perpetuity. These were unpublished literary, dramatic and musical works, together with unpublished engravings and photographs. The CDPA 1988 implied an expiry date of 31 December 2039 for the copyright in any such works in existence at the time of the Act, per Schedule 1, para 12(4).

<sup>42</sup> WM Landes and R Posner, “An economic analysis of copyright law” (1989) 18 J. Legal Stud. 325, at 361.

shortest possible duration to fulfil its intended purpose,<sup>43</sup> and Landes and Posner point to the costs involved in tracing the right's owner several decades after the first creation. Thus a patent should secure a viable return to the inventor within 20 years and is also one of the hardest rights to trace, given its likely incorporation and development in many other products. Trade marks, in contrast, protect the trading name and goodwill of a business and therefore need to last for as long as the business name does, but with the proviso that they lapse where the business fails to renew it or use it. Other than making reference to these economic factors, the duration of intellectual property rights is entirely a matter for the legislature, dependent on the purpose to be served by the monopoly and the competing interests.

As demonstrated above, the purpose of publicity rights is to enable individuals to control and manage their persona, thereby protecting their dignitarian *and* economic interests. Publicity is therefore a right which combines the personal values and economic values arising from the individual's persona. Although the economic interests could be met with a time-limited monopoly, a fixed term duration does not reflect the dignitarian element of the right. This leads to the conclusion that publicity rights should endure for the life of the individual.<sup>44</sup>

### 3.3. Post Mortem Duration

While the right of publicity should endure for the life of the individual, the extent of any post mortem duration requires separate consideration. It has been observed that the exploitation associated with publicity does not necessarily cease when the individual does:

A person may not live for long, but his or her beliefs, personality and image can live on and be passed down from one generation to another. Decades

<sup>43</sup> See Chapter 6, sections 4 and 5; N MacCormick, "On the very idea of intellectual property: an essay according to the institutionalist theory of law" [2002] IPQ 227, at 237.

<sup>44</sup> This reflects both the statutory right of publicity in the US and the Civilian personality rights approach: see Chapter 2.

after their deaths, the images of Marilyn Monroe and James Dean continue to sell posters and T-shirts.<sup>45</sup>

The question then arises whether there should be any post mortem right over persona.<sup>46</sup> If so, how long should such rights last and who should enjoy and enforce them?

There is certainly truth in Beverley-Smith's comment that "reputation and injured dignity are generally of no concern to a deceased person".<sup>47</sup> It is also true to say that *nothing* is of concern to a deceased person yet, nonetheless, both dignitary and economic issues which may occur after his death may concern an individual while still alive. It is presumably this which motivates people to leave wills which deal with both financial and personal matters after their death.<sup>48</sup>

The Civilian position is summarised by Waelde and Whitty, as being that "personality rights generally are not actively transmissible by succession on the victim's death but that after death relatives (or universal successors) of the deceased may have remedies in their own rights under rules prohibiting any interference with a deceased person's body or reputation."<sup>49</sup> However, while this may be the starting point, Beverley-Smith *et al* note that:

A trend is emerging in French case law according to which the non-economic element of personality rights is indescendible, but the economic element devolves on the heirs in accordance with the ordinary rules of the law of succession.<sup>50</sup>

In Germany there is a division between the economic and non-economic interests. Following the leading case regarding the rights of Marlene Dietrich's heirs, it has been accepted that "personality rights, as far as they protected economic interests,

<sup>45</sup> Milligan, *Brand it Like Beckham*, at 177. For a short commentary on post mortem celebrity, see [www.forbes.com/media/2008/10/27/death-career-move-biz-deadcelebs08-cx\\_ns\\_1027steinberg.html](http://www.forbes.com/media/2008/10/27/death-career-move-biz-deadcelebs08-cx_ns_1027steinberg.html) (accessed 23 December 2008).

<sup>46</sup> This is different from the right of the individual's successors to continue, or to initiate, any legal action for wrongs committed while the individual was alive, which is a valid course of action.

<sup>47</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 124.

<sup>48</sup> Wills often provide for matters such as funeral instructions and the distribution of items of sentimental value as well as financial and material matters, indicating that most individuals do wish to plan for some element of ongoing economic and dignitary autonomy even after death.

<sup>49</sup> Waelde and Whitty, "A Rights of Personality Database", para 11.4.3(e).

<sup>50</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 204.

were descendible.”<sup>51</sup> In contrast, the non-economic, or ideal, interests can be enforced post mortem but only by relatives, rather than being freely available for testamentary disposal.<sup>52</sup> This approach in German law is supported by Beverley-Smith *et al.*<sup>53</sup>

Neethling, in his review of personality rights, gives brief consideration to personality rights post mortem. He contrasts the approach of what he terms the “traditional school” of France and Switzerland, whereby all personality rights are terminated by death and “the idea of post-mortem personality rights is rejected”,<sup>54</sup> with the German and Austrian approaches, for example, whereby (as discussed above) an individual’s personality rights “continue after his death and are maintained by his relatives as fiduciaries.”<sup>55</sup> In the specific case of publicity rights, Neethling concludes that “[i]n so far as this right or interest is patrimonial”<sup>56</sup> it should fall into the owner’s estate on death, but this should be seen as “part of the immaterial property right to the advertising image (of the deceased)”,<sup>57</sup> thus meriting different treatment from his extra-patrimonial personality rights.

The US approach, unsurprisingly, is willing to embrace a post mortem right, reflecting the predominant classification of publicity as a property right.<sup>58</sup> Westfall and Landau argue that the classification of publicity as a property right resulted in syllogistic reasoning, which drove the recognition of post mortem protection for publicity.<sup>59</sup> This was despite considerable arguments against post mortem protection, including the difficulties of “durational line-drawing” after death, and the increasing conflict between private rights and free speech the longer the right lasts.<sup>60</sup> The best policy argument in favour of a post mortem duration is, they conclude, the risk that the right could be suddenly cut off at any time as a result of the death of the

<sup>51</sup> *Ibid.*, at 104, referring to BGHZ 143, 1 December 1999 – *Marlene Dietrich*.

<sup>52</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 126-127.

<sup>53</sup> *Ibid.*, at 128.

<sup>54</sup> Neethling, “Personality Rights”, at 243.

<sup>55</sup> *Ibid.*, at 243.

<sup>56</sup> *Ibid.*, at 240.

<sup>57</sup> *Ibid.*, at 240.

<sup>58</sup> See Chapter 2, section 2.1 and the US state legislation referred to therein.

<sup>59</sup> Westfall and Landau, “Publicity Rights as Property Rights”, at 83 *et seq.*

<sup>60</sup> *Ibid.*, at 86.

individual, harming the economic interests of the individual and licensees.<sup>61</sup> Landes and Posner also advance an economic justification in favour of a post mortem right. Although the heir to an individual is unlikely to need post mortem protection to recoup the initial investment in that individual's persona, the heir could "argue that, unless there is a property right in the public figure's name and likeness, there may be congestion, resulting in a loss of value."<sup>62</sup>

Despite, or because of, the over-reliance on the property syllogism, post mortem rights are now firmly established in the US. Of those states that have judicially considered the matter, most "have recognised that the right is descendible and has a limited post mortem duration of between 10 and 100 years."<sup>63</sup> Statutory provision also allows a post mortem duration. In Florida, for example, the right expires 40 years after the death of the individual,<sup>64</sup> while Kentucky favours 50 years<sup>65</sup> and Indiana extends protection for 100 years post mortem.<sup>66</sup> Washington takes a slightly different approach, and offers post mortem protection for 10 or, in the case of a "personality"<sup>67</sup> 75, years post mortem.<sup>68</sup>

Support for a post mortem right can be drawn from the 2006 Online Survey, where respondents were generally in favour of a post mortem right. The level of enthusiasm amongst respondents appeared to depend on whether they thought that the right should be classed as a real right or a personal right. Of the 27 respondents who favoured a property right, 17, or 63%, believed that the "ownership" of an individual's persona should be capable of transfer, and therefore enforcement, on death.<sup>69</sup> 71 of the respondents who viewed persona as a personal right answered the "post mortem" questions and, of these, 56.3% believed that the right to enforce

<sup>61</sup> *Ibid.*, at 87-88.

<sup>62</sup> WM Landes and R Posner, "An economic analysis of copyright law" (1989) 18 J. Legal Stud. 325, at 362-363.

<sup>63</sup> Beverley-Smith, *The Commercial Appropriation of Personality*, at 184. See also Westfall and Landau, "Publicity Rights as Property Rights", at 83.

<sup>64</sup> The Florida Regulation of Trade, Commerce, Investments and Solicitations, Chapter 540, Section 08 (5).

<sup>65</sup> Kentucky Acts 1984, 391.170(2).

<sup>66</sup> Indiana's Publicity law IC 32-36-1-8.

<sup>67</sup> Defined as an individual whose name and likeness has a *commercial* value.

<sup>68</sup> Chapter 63.60 RCW Personality Rights, section 040(1) and (2).

<sup>69</sup> Graph 1, Appendix B.



protection should be transferred on death.<sup>70</sup> This slight difference in response reflects the nature of the two rights being considered by the two response groups. Those who saw persona as a property right were more likely to favour a post mortem right, in line with the standard consequences of property, whereas those who classed it as a personal right were not.

Nonetheless, allowing the right of publicity to continue post mortem adversely impacts upon the use of persona by the public in general, conflicting with the principles of freedom of expression and cultural communication, identified in Chapter 4. To prevent persona from falling into the public domain on death is a considerable extension of any publicity right. This is particularly the case since publicity rights are predicated in part on the personal nature of persona yet, after the death of the individual, persona can only ever be of interest to other parties, whether heirs or other users. Although the publicity value does not necessarily cease on death, the personal interest in protecting it does. There is therefore a strong case for terminating a right of publicity on the death of the individual, not least because the subject of the right is so closely tied to the existence of the individual in question. This also has the practical advantage of ensuring the date of expiry of the right can be determined with clarity.

One further option is to find a “middle way” for post mortem protection. In Nevada, for example, the commercial use of a deceased person’s name, voice, signature, photograph or likeness does not require consent where the publicity right has not been conveyed by the person in life to another party and where that person has no surviving successor.<sup>71</sup> Thus, if there is no one with a direct interest, derived from the deceased, to enforce the publicity right it will lapse on the death of the individual. Further, even where there is a surviving successor, the publicity right can only be asserted where the successor’s claim has first been registered with the Office of the Secretary of State, on payment of a filing fee.<sup>72</sup> This mechanism ensures that the

<sup>70</sup> Graph 2, Appendix B.

<sup>71</sup> The Nevada Right of Publicity, NRS 597.800(2).

<sup>72</sup> *Ibid.*, NRS 597.800(3) and (4). The filing fee is \$25: the relevant form is at <http://sos.state.nv.us/business/trademarks/pdf/mark-publicity.pdf> (accessed 24 December 2008).

publicity right does not endure post mortem when there is no-one with any interest or title to enforce it. Similar provisions have been adopted, minus the requirement to register, in Illinois,<sup>73</sup> Indiana,<sup>74</sup> and Oklahoma.<sup>75</sup>

A compromise would therefore be to allow a post mortem duration for the right where the individual has specifically sought such protection, for example, by specifically including it in a testamentary disposition. However, it is suggested that a more restrictive approach, providing greater certainty, would be to grant a post mortem right only on registration of the persona by the individual prior to death. Whereas registration was deemed to be undesirable for the exercise of the right during life, given the dual considerations of universal application and accessibility, these issues do not apply to a right which is to operate after the death of the individual. Individuals who have a track record of exploiting their persona or who desire to protect it post mortem would be able to ensure its limited continuity by registering their persona in much the same way as a trade mark (for example, by specifying their name, any pseudonyms, and evidence of their image and indicia). One considerable advantage that registration would bring would be the increased ease with which it would allow tracing of rights' holders.<sup>76</sup> Further, the imposition of a registration fee, which would seem inappropriate for a right which protects dignitarian interests, is far less objectionable when the registered publicity right would be used primarily for commercial gain by the surviving relatives or beneficiaries.

The need for registration prior to death raises the question of what happens if the individual dies, perhaps unexpectedly, without registering but surviving relatives nevertheless wish to exercise the right post mortem.<sup>77</sup> Should a period of grace be

<sup>73</sup> The Illinois Right of Publicity Act (765 ILCS 1075), section 25.

<sup>74</sup> Indiana's Publicity law IC 32-36-1-19.

<sup>75</sup> Oklahoma Stat. tit 12, para 1448E.

<sup>76</sup> As noted above, although tracing costs are minimised during life, since the right holder is the individual, this is not the case post mortem: requiring registration makes it considerably easier to trace the holder of the right post mortem.

<sup>77</sup> This consideration also applies to individuals who die before any statutory right is introduced. Would the surviving relatives of Rikki Fulton (d. 2004) be entitled to register his name and image?

recognised in which to allow for post mortem registration?<sup>78</sup> Although surviving relatives may understandably desire such a period, it is not clear that there is a pressing need for it. Those whose persona is likely to have an ongoing significance post mortem are likely to be well advised (wide-ranging celebrity trade mark registrations<sup>79</sup> provides evidence of this), and thus in a position to register for a post mortem right as soon as they feel the need for it. Where the individual has not seen fit to register his persona, thereby allowing it to lapse into the public domain on death, it is not clear why relatives should be able to over-ride this position. Further, providing that only the individual is entitled to register his persona ensures that he can make the necessary testamentary provision for it, consequently avoiding the practical difficulties of determining which surviving relative is entitled to register and thereafter exercise the right post mortem.<sup>80</sup>

The only remaining question is how long this registered right should last. This is ultimately a question of policy,<sup>81</sup> but there seems no need for the lengthy protection offered in some US states. Given the greater emphasis on commercial interests following the death of the individual, it is not inappropriate to compare the duration post mortem with the industrial intellectual property rights: trade marks and patents. This would suggest a post mortem duration of between 10 and 20 years, with the option, if there is evidence of a need, for an extension of term through re-registration in the manner of trade marks, rather than through the initial grant of a right. Thus, if the right is exploited and enforced post mortem, it would be open for the beneficiaries to re-register the right: in the absence of this, the persona would lapse into the public domain. A shorter post mortem right based on these economic

<sup>78</sup> Similar to the period of grace in US patent law (but not in Europe), allowing inventions to be patented within a limited period of the invention being disclosed publicly. See Cornish and Llewelyn, *Intellectual Property*, para 5.10 *et seq.*

<sup>79</sup> G Black (published as G Davies), "The cult of celebrity and trade marks: the next instalment" (2004) 1:2 SCRIPT-ed 230.

<sup>80</sup> Entitlement of surviving relatives to register persona is likely to be a particularly thorny problem post mortem.

<sup>81</sup> Davies refers to Macaulay's comment in the House of Commons in 1841, regarding the post mortem duration of copyright, and his observation applies equally here: "this is a point which the legislature is free to determine in the way which may appear to be most conducive to the public good". Davies, *Copyright and the Public Interest*, para 10-006, citing Macaulay, in *Hansard*, House of Commons, Vol. 56, February 5, 1841, col. 365.

considerations also reflects the dignitarian approach reflected in the post mortem treatment of personality rights in Civilian systems.

## 4. TRANSMISSION AND TRANSFERABILITY

The review thus far has recognised that the publicity right is inherently connected to the individual, with the consequence that it should be exercised by the individual and last for his lifetime and potentially, subject to registration, for a fixed period thereafter. Two subsequent questions derive from this conclusion: can the right be transferred during life and can the right be transmitted after death?<sup>82</sup>

### 4.1. Transfer of the Right in Life: Assignment and Licensing

Regardless of the post mortem extent of a publicity right, the individual will be faced with more immediate concerns regarding the transfer of the right during his lifetime.

As MacQueen notes in relation to intellectual property:

Although each of the rights confers on the owner an ability to stop activity using the property in question, *in most cases the owner will prefer that such activity take place*. A major purpose of the laws of intellectual property is to provide a legal framework under which the inventive, creative and entrepreneurial will be remunerated for their work.<sup>83</sup>

This juxtaposition of the right to prevent with the need to enable third party activity arises in the context of publicity rights, reflecting the positive and negative uses. Individuals will be best able to exploit the value in their persona if they are able to share that with other parties, and control this external use of it. However, as seen in Chapters 4 and 6, publicity is inherently connected to the individual and therefore inalienable. The practical reality of commercial exploitation comes up against the theoretical analysis which confines publicity to the individual.

<sup>82</sup> This section is concerned with the transmission of the right of publicity as a primary right: for a detailed analysis of the transmissibility of secondary rights in personality rights as a whole, see Whitty, “Overview of Rights of Personality in Scots Law”, section 3.6.

<sup>83</sup> Reid (ed), *SME Vol XVIII*, para 802, emphasis added.

This is most evident in the Civilian tradition. It has been stated that “[n]one of the civil law systems seek to abandon the traditional doctrine of the inalienability of personality rights.”<sup>84</sup> Yet the tension between theory and practice is well illustrated by Beverley-Smith *et al*'s review of French and German law, where strong statements of principle are later modified by an awareness of the practice. Thus the statement that “[i]t is traditionally asserted in France that personality rights are inalienable, that is can neither be waived nor assigned”<sup>85</sup> is followed six pages later with the recognition that, in France, agreements are made “daily” for the “commercial exploitation of personal attributes”.<sup>86</sup> Although it is not clear whether consent to use of personality rights “operates merely as an enforceable promise not to sue or as the transfer of a right, in the nature of a property right... enabling the licensee to sue third parties”<sup>87</sup> such commercial agreements are nonetheless concluded. Similarly, for German law, the authors discuss four different methods for allowing third party use of an allegedly inalienable right,<sup>88</sup> concluding that the “attempt to reconcile the inalienability of personality rights with the demands of the advertising and merchandising business is hard to sustain doctrinally.”<sup>89</sup>

This problem is not so evident in the US, where publicity is treated as a property right, with all the consequences that entails. The pragmatism of the American “publicity as property” approach is evident in the words of Judge Frank:

a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture... Whether it be labelled a ‘property’ right is immaterial; for here, as often elsewhere, the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has a pecuniary worth.<sup>90</sup>

As Madow observes, it “seemed natural and obvious to the court that celebrity personas should be treated as garden variety commodities, to be bought and sold in

<sup>84</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(d).

<sup>85</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 191.

<sup>86</sup> *Ibid.*, at 197.

<sup>87</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(d).

<sup>88</sup> These are waiver, medical law consent, irrevocable consent and licensing: see Beverley-Smith *et al*, *Privacy, Property and Personality*, at 130-137.

<sup>89</sup> *Ibid.*, at 132.

<sup>90</sup> *Haelan Laboratories v Topps Chewing Gum* 202 F.2d 866, at 868, per Frank J.

the market like any other... The court was simply giving legal form (and protection) to preexisting commercial practice.”<sup>91</sup>

Yet this approach, which reflects the commercial reality of transfer and exploitation of publicity rights, is not without its problems either. Whether or not one classes persona as property does not alter the fact that it is not separable from the individual in the sense that one’s house, shares and patents are separable and could be permanently alienated.<sup>92</sup>

There is therefore a risk that courts and academics become entrenched on one side or other of the debate, determined either to reflect the reality of exploitation by allowing transfer or to uphold the sanctity of legal taxonomy by refusing to countenance the transfer of a right so inherently bound to the individual.

However, a transfer of rights does not have to be outright, but could be constituted by the grant of a temporary right to use the persona by way of a licence. Whereas sale or, in intellectual property, assignation<sup>93</sup> transfers full ownership, a licence ensures that control remains with the owner, subject to the terms of the licence. While an inalienable aspect of an individual, such as persona, could not be assigned, there is no reason why its use could not be licensed for a particular purpose.

Licensing offers a very flexible solution, where matters such as the duration, the territory, and the purposes for use can all be specified, subject to any necessary provisions for termination or revocation if required by the licensor.<sup>94</sup> In the words of Beverley-Smith *et al*, regarding German law,

the personality right is regarded as one single right, which protects both economic and non-economic interests. A licence transfers one piece of this cake to the licensee. However, since the licence can be revoked under

<sup>91</sup> Madow, “Private ownership of public image”, at 174, but note he should not be taken to endorse this view.

<sup>92</sup> See Chapter 6.

<sup>93</sup> In Scots law, typically only personal rights are assigned: R Anderson, *Assignation*, 2008, para 1-01. However, the statutory terminology of assignation applies to intellectual property rights, see for example the CDPA, s90. The terminology of assignation will be used here.

<sup>94</sup> See, for example, Cornish and Llewelyn, *Intellectual Property*, para 7-25 regarding patents, but applicable to all licences.

exceptional circumstances and since the licence usually expires after a certain time, the ‘daughter right’ granted to the licensee is not entirely separated from the ‘mother right’.<sup>95</sup>

This split between “mother” and “daughter” rights is arguably what all licences seek to achieve, whether in this field or any other, and conveys the duality of a grant of a right together with the retention of control by the licensor.

The study of authorised exploitation in Chapter 3 demonstrated that most contracts in Scotland and England for authorised exploitation of publicity are constituted by licence, rather than an attempt to assign the rights. Some of these licences, such as the *pro forma* licence between the sportsman and the Club or the agreement between Irvine and Ferrari, are drawn in such broad terms as to be close to a full assignation, but stop short of a full transfer.<sup>96</sup> Indeed, a licence can be drafted in such a way that the *practical* outcome for the licensee is almost the same as if he had taken a full assignation, but the distinction remains, since “an assignment is in essence a transfer of ownership (however partial), while a licence is in essence permission to do what otherwise would be infringement.”<sup>97</sup>

The results of the 2006 Online Survey demonstrate support for a temporary transfer, through licensing. Whether or not persona should be capable of transfer was asked twice; once of those respondents who classed persona as a property right and once of those who classed persona as a personal right. The 27 respondents who viewed persona as a *property* right were asked “should an individual be entitled to transfer or sell on his persona to a third party?”. Of these, 55.6% favoured an outright transfer, compared with 37% who did not and 7.4% who did not know.<sup>98</sup> When the question was asked of these respondents whether there should be a right for the owner to permit others to use it, by way of a licence, the response was unequivocal: 92.6% of respondents favoured the right to do so and to charge a fee, while the remaining 7.4% were split evenly between those who thought there should be a right to license but

<sup>95</sup> Beverley-Smith et al, *Privacy, Property and Personality*, at 133. See also Waelde and Whitty, “A Rights of Personality Database”, para 11.4.3(d).

<sup>96</sup> See Chapter 3, section 4.

<sup>97</sup> Cornish and Llewelyn, *Intellectual Property*, para 13-11.

<sup>98</sup> Graph 3, Appendix B.



not to charge a fee (3.7%), and those who did not know (3.7%).<sup>99</sup> No-one answered the question in the negative. Although support for assigning was high (at 55.6%), support for licensing was nearly unanimous at 96.3%. Even though respondents classed publicity as a property right, they were apparently more comfortable with the idea of licensing, rather than assigning, *persona*.

For those respondents who classed *persona* as a *personal* right, the question asked was “should the individual/ enforcer of the right of commercial *persona* be entitled to waive their right to enforce? And should there be a right to charge a fee for granting a waiver?”<sup>100</sup> The answers open to respondents were: (i) to allow waiver and the right to charge a fee; (ii) to allow waiver but not for a fee; (iii) to refuse the right to waive (making it in effect an entirely inalienable right, more akin to a human right such as the right to life); (iv) to opt for no enforceable right at all; or (v) don’t know.<sup>101</sup> Of the 73 “personal rights” respondents, 87.7% were in favour of the right to waive this personal right, with 68.5% opting for the right to charge a fee for this waiver and 19.2% favouring a gratuitous waiver. A much smaller proportion (8.2%) favoured prohibiting the individual from waiving his right to enforce.

Classification of publicity rights as a statutory monopoly is capable of enabling some degree of transfer, which stops short of full assignation. This conclusion reflects both current commercial practice and the views evidenced in the 2006 Online Survey. The distinction between assignation and licensing is particularly important in light of the problems identified with an outright transfer of *persona*, which by nature is an inherently personal “asset”, tied to the individual. This restricts any transfer of *persona* to a (temporary) licence to use, rather than an (outright) assignation. The conclusion that can be drawn is that the monopoly right of publicity should be capable of being licensed but not assigned.

<sup>99</sup> Graph 4, Appendix B.

<sup>100</sup> The question was asked slightly differently for personal rights respondents, to reflect the different legal basis in question.

<sup>101</sup> Graph 5, Appendix B. Note that a total of only three respondents of 73 chose the last two options.

## 4.2. Transmission of the Right Post Mortem

Whether or not the right can be transmitted to heirs, or transferred on thereafter, has largely been answered by the foregoing analysis at section 3.3 above. Where the persona has been registered, successors in title to the individual should benefit from a publicity right and, since the right is no longer tied to the individual upon whose persona it depends, there is no theoretical obstacle to recognising the right as fully transferable. This alters the attributes of the right in two ways.

In the first place, as was discussed above, it diminishes the justifications for the right, so that the right should continue in existence only if specific steps have been taken to that end, namely registering the persona. Further, the duration of the right becomes tied to the statutory period. The second consequence however is that the right can be transmitted on death in accordance with the individual's testamentary wishes, and thereafter becomes freely transferable, by assignation as well as licensing, for the duration of the right post mortem.

Thus, on death, the right of publicity becomes a more explicitly economic right, and falls to be treated with other economic monopoly rights, such as trade marks. Only by registering the mark in life can a post mortem right be created, to take effect on death, for the benefit of the beneficiaries according to the deceased's will. This reflects the conclusion in Chapter 6, section 4.2.2, whereby the problems with transferring persona in life were held not to apply after death: although persona is inalienable from the individual in life, this restriction does not apply post mortem.

## 5. COUNTERVAILING RIGHTS

One of the fundamental conclusions of Chapter 4 was that any right of publicity must be balanced against the legitimate competing interests of the wider public in the use of persona. This section aims to consider and delineate the necessary counter-rights which would operate as exceptions to the right of publicity. These are often implicit

in the literature, but need to be made explicit. Two such rights have already been identified: freedom of expression and cultural communication.

### 5.1. Freedom of Expression

The right to freedom of expression, as protected by Article 10 ECHR, provides for the right to receive and impart information and ideas. It acts as a balance to the exercise of the proposed right of publicity, since the right to impart information can be exercised through the use of persona to communicate. There is precedent for countering publicity rights in this way in the United States, for example, where the constitutional right to free speech under the First Amendment acts as a defence to, amongst other things, a claim for infringement of publicity rights.<sup>102</sup>

Although Article 10 is accorded “a conspicuously elevated status in the human rights framework”,<sup>103</sup> it is not an automatic trump over other rights.<sup>104</sup> Article 10(2) does recognise the existence of other rights which may require to be balanced against the right to freedom of expression. As has been seen in previous chapters, English case law to date has involved the courts in carrying out a balancing exercise between the right to privacy under Article 8 and the right to freedom of expression under Article 10.<sup>105</sup> This jurisprudence has clearly established that once the claimant’s Article 8 right is engaged, there must be a balancing between that Article 8 right and the defendant’s Article 10 right. In each case, the question of which right takes precedence is dependent on the particular circumstances and facts of that case.<sup>106</sup>

Whilst this need for balance is well-established as regards Article 8, we are not directly concerned with privacy here, as was concluded in Chapter 5. The question

<sup>102</sup> See, for example, McCarthy, *The Rights of Publicity and Privacy*, section 3:6 and 3:47; Goodenough, “Re-theorising privacy and publicity”, at 51-53; and Carty, “Advertising, publicity rights and English law”, at 223.

<sup>103</sup> C Angelopoulos “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328, at 329.

<sup>104</sup> *Campbell v MGN* [2004] 2 AC 457, para 113, per Lord Hope; *In re S* [2005] 1 AC 593, para 17, per Lord Steyn.

<sup>105</sup> Chapter 5, section 2.4.

<sup>106</sup> See for example *Mosley v News Group Newspapers Limited* [2008] EWHC 1777 (QB), para 11; Chapter 5, section 2.4.

becomes what other rights, if any, must be balanced against Article 10? Article 10(2) allows for restrictions on the exercise of freedom of expression to accommodate, amongst other things, the rights of others.<sup>107</sup> This would include intellectual property rights, for example, since the very purpose of intellectual property is to regulate the use (and prevent unauthorised use) of literary works, trade marks and otherwise publicly available icons and culture.<sup>108</sup>

Thus intellectual property rights may necessitate legal protection for one individual (by way of copyright, for example) which adversely interferes with the freedom of expression of others. Freedom of speech will clash with copyright where “it might be necessary – because adequate alternative means of expression do not exist – to use a protected text to achieve an expressive goal that it would not otherwise be possible to achieve.”<sup>109</sup> Where this is also the case with publicity (that is to say, where the particular speech required can be achieved only through the use of a particular individual’s persona) then Article 10 should enable this. This is subject, however, to balancing Article 10 against the publicity right since, in Spence’s words (regarding intellectual property in general): “[i]t may be that I can only contribute to public debate if I have the right both to be identified with my speech and to prevent it from being distorted.”<sup>110</sup> Any distortion of persona in this speech may thus reduce the weight to be accorded to freedom of expression.

As with privacy, there is no single answer to the problem of balancing private rights with the right to freedom of expression, and it is never possible to provide a definitive guide as to which right takes precedence on any occasion.<sup>111</sup> Instead, the

<sup>107</sup> For a detailed discussion of the scope of the Article 10(2) provision for interference with the right, see Reed and Murdoch, *Human Rights Law in Scotland*, paras 7.29 *et seq.*

<sup>108</sup> Angelopoulos provides an analysis of why copyright and freedom of expression are capable of working together “like a well oiled machine, enhancing each other in the process”. C Angelopoulos, “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328, at 353.

<sup>109</sup> M Spence, “Intellectual property and the problem of parody” (1998) 114 LQR 594, at 610, footnote omitted.

<sup>110</sup> *Ibid.*, at 609.

<sup>111</sup> Section 12 of the Human Rights Act 1998 appears to encourage the courts to give priority to freedom of expression, but this reading would run into difficulties since, as Reed and Murdoch note, “if the courts were to construe the provision as adversely affecting the application of countervailing Convention guarantees (for example, Article 8’s requirement of respect for private life), a litigant who was unsuccessful in the domestic courts could bring proceedings in Strasbourg.” Reed and Murdoch,

courts would need to balance the rights of each party on a case-by-case basis, by making “a sensitive, nuanced and contextually specific examination of the particular factual circumstances of each case, incorporating an evaluation and attachment of weight to both of the competing interests.”<sup>112</sup> If the balance is not achieved, there is a risk that “tenuous property interests [may be allowed] to outweigh substantial expression rights.”<sup>113</sup>

Two final observations reinforce the point that the Article 10 right is strong but not unlimited. In the first place, Article 10(2) expressly states that the exercise of the right “carries with it duties and responsibilities”. This encompasses, for example, the duty to ensure that any opinions have a reasonable factual basis.<sup>114</sup> Secondly, even where the unauthorised user successfully relies upon his Article 10 right to counter the individual’s publicity right, the court may still award compensatory damages to the individual for the use made of his persona, since “Freedom of expression should not normally carry with it the right to make free use of another’s work”, to profit from it without compensation.”<sup>115</sup> Article 10 is an important limit on the right of publicity, but it remains a qualified limit.

## 5.2. Cultural Communication

Creative or cultural communication, as explored in Chapter 4, was identified as an important use of persona where that use created new meaning or passed quasi-political comment on the existing meaning of a persona. In the words of de Grandpre, “a central challenge of the right of publicity consists in balancing rights in personal identity with the necessity of allowing everyone to dip into a rich common

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*Human Rights Law in Scotland*, para 7.33. Reed and Murdoch provide a detailed discussion of judicial consideration of section 12 at para 7.34.

<sup>112</sup> Waelde and Whitty, “A Rights of Personality Database”, para 11.5.

<sup>113</sup> *Laugh if Off v SAB* 2006 (1) SA 144, para 74.

<sup>114</sup> Reed and Murdoch, *Human Rights Law in Scotland*, para 7.32.

<sup>115</sup> C Angelopoulos, “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328, at 342. The unattributed quotation is from *Ashdown v Telegraph Group* [2002] Ch 149, para 46.

cultural pool.”<sup>116</sup> The cultural commons has a role to play as a countervailing right to a monopoly right over persona.<sup>117</sup>

Perhaps the first point to note is that where the use of persona is necessary to enable the communication of opinions and ideas, this is likely to be protected by Article 10 ECHR. Thus, where there is a genuine communicative purpose served by the use of persona, which cannot be met in any other way, then the individual’s publicity right will be matched by the countervailing right of expression, as discussed in the previous section.

In other cases, where the use is indeed part of cultural communication, intended for social or subversive comment, this should be recognised as a valuable contribution to our society. This is articulated in the copyright debate by MacMillan, who supports “a distinction between productive and reproductive uses of another’s copyright work. The former involving a creative use of existing copyright work, whilst the latter involves a merely exploitative use of someone else’s intellectual property.”<sup>118</sup> This distinction can also be applied to publicity to help protect genuine creative use of persona.

Nonetheless, as discussed in Chapter 4, section 5.4.4., Coombe and Howkins refer to the need to be wary of over-reliance on the concept of cultural communications at the expense of the prior private right. Use of publicity – on both sides of the fence – needs a framework in which to flourish. It is submitted that, since the practice of cultural communication depends upon the prior practice of publicity, this exception to publicity should be treated not as a countervailing right, which exists on its own merits, but as a subsequent right, being a permitted use of persona. Only where a right of publicity is first recognised is it necessary or possible to recognise a right of cultural communication dependent on use of persona.

<sup>116</sup> de Grandpre, “Understanding the market for celebrity”, at 106.

<sup>117</sup> This also reflects the fifth ideal of copyright as identified by Chafee, being that copyright “should not stifle independent creation by others.” Cited in Davies, *Copyright and the Public Interest*, para 9-002.

<sup>118</sup> F MacMillan, “Striking the copyright balance in the digital environment” 1999 ICCLR 350, at 351, footnote omitted.

Accordingly, the public interest in cultural communication will be examined through a series of permitted uses, most notably the public interest, which allow unauthorised use of persona to be defended on certain grounds. Uses which are capable of accommodating the creative use of persona will be considered in the next section.

## 6. PERMITTED USES

Since publicity is not an absolute right, it is necessary to consider those uses of persona which will not infringe the individual's publicity right: in the words of copyright legislation, for example, these are the permitted uses.

### 6.1. Private Use

A straightforward example of a permitted use is one which is entirely private. As discussed in Chapter 3 above, the focus of publicity rights is the public use of persona, and the definition of media information, promotion and merchandising uses reflects this element. Where the use made of persona is private, then there will be no breach of the proposed right of publicity – although there may be other legal grounds upon which to challenge the use.<sup>119</sup>

### 6.2. Public Policy

Public policy can operate to deny legal protection to a claimed private right, thus ensuring that there can be no infringement of the so-called right. In the field of copyright, for example, public policy considerations may arise where it is determined that certain types of work “are undeserving of the protection of copyright”.<sup>120</sup> Since

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<sup>119</sup> Such as breach of the individual's Article 8 right to private life, albeit not by dissemination. See the discussion on this point in Chapter 5, section 3.3.

<sup>120</sup> MacQueen *et al*, *Contemporary Intellectual Property*, para 5.47. The authors give the examples of pornography and material published in breach of an obligation of secrecy. See also A Sims, “The denial of copyright protection on public policy grounds” [2008] EIPR 189.



no protection is granted to them, there can be no infringement by unauthorised use.<sup>121</sup> However, this exception to the grant of copyright depends on the nature or content<sup>122</sup> of the work in each case, whereas a publicity right protects only one type of “work” – the persona. It is therefore difficult to see how public policy could apply to deny protection of persona in some circumstances but not in others. There is nothing inherent in any individual persona (that is name, image and reputation) which could in some cases give rise to a public policy objection over the grant of the right in the first place. There may, however, be good reason why unauthorised use of a persona should be permitted, but it is submitted that the right of publicity should always be recognised in that persona, even if it is subsequently curtailed on one of the grounds considered below.

### 6.3. Public Interest

The notion of the public interest often provides a catch-all defence, by permitting the infringement of a private right where this would benefit or advance a “public interest”. In the case of publicity, it is suggested that unauthorised use of persona should be permitted where it is in the public interest.

Although there is no single definition of the public interest, it operates in a number of spheres: in privacy actions, by informing the Article 10 right to freedom of expression;<sup>123</sup> in cases concerning confidential information, by operating to justify the breach of confidence,<sup>124</sup> with specific provision in cases of breach of confidence in medical circumstances<sup>125</sup> and employment relationships;<sup>126</sup> and in copyright where it exists in its own right and arguably underlies the permitted uses of copyright.<sup>127</sup>

<sup>121</sup> This is emphasised by Sims, where she also brings out the difference between public policy and public interest in copyright: “The denial of copyright protection on public policy grounds” [2008] EIPR 189, at 190.

<sup>122</sup> Cornish and Llewelyn, *Intellectual Property*, para 12-57.

<sup>123</sup> See Chapter 5, section 2.4, regarding freedom of expression.

<sup>124</sup> See for example Cornish and Llewelyn, *Intellectual Property*, paras 8-15 *et seq*; MacQueen *et al*, *Contemporary Intellectual Property*, paras 18.58-18.61.

<sup>125</sup> See, for example, J Chalmers, *Legal Responses to HIV and AIDS*, 2008, at 64-65.

<sup>126</sup> The Public Interest Disclosure Act 1998 allows “whistleblowing” if this is in the public interest.

<sup>127</sup> See Davies, *Copyright and the Public Interest*.

The public interest therefore plays a broad and vital role in allowing exceptions to the grant or enforcement of certain private rights.

While what qualifies as a matter in the public interest “must be capable of being tested by objectively recognised criteria”<sup>128</sup> the precise nature of those criteria remains uncertain.<sup>129</sup> Crime and wrongdoing appear to be two fairly straightforward grounds on which to engage the public interest,<sup>130</sup> and Eady J refers to a number of elements in *Mosley* which may have justified (but on the facts did not) the publication of Mosley’s sexual activities by the News of the World. These included the allegedly criminal nature of the activity,<sup>131</sup> the alleged Nazi theme,<sup>132</sup> and the depravity of Mosley’s actions and adultery.<sup>133</sup> Criminal activity is also a ground for employee disclosure in the public interest under the Public Interest Disclosure Act 1998, along with considerations such as whether a miscarriage of justice has occurred, whether the health or safety of any individual is endangered, whether the environment is being damaged, or indeed whether any of these events is likely to occur.<sup>134</sup> Similar considerations relating to the health and safety of individuals apply to the disclosure of patient details by the medical profession.<sup>135</sup>

Even in copyright cases, where there is not necessarily a relationship based on confidence, the public interest defence has arisen in respect of copyright-protected works.<sup>136</sup> Section 171(3) of the CDPA 1988 states that nothing in the Act regarding copyright “affects any rule of law preventing or restricting the enforcement of copyright, on grounds of public interest or otherwise.” With reference to *Hyde Park Residence v Yelland*, Davies suggests that this affords the courts discretion to refuse to uphold an action for copyright infringement “but such jurisdiction is limited to cases where enforcement of the copyright would offend against the policy of the law.

<sup>128</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 138.

<sup>129</sup> See for example, in copyright, MacQueen *et al*, *Contemporary Intellectual Property*, para 5.47.

<sup>130</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 234.

<sup>131</sup> *Ibid.*, paras 110-121.

<sup>132</sup> *Ibid.*, paras 122-123.

<sup>133</sup> *Ibid.*, paras 124-134.

<sup>134</sup> The Employment Rights Act 1996, s43B, as inserted by the Public Interest Disclosure Act 1998.

<sup>135</sup> J Chalmers, *Legal Responses to HIV and AIDS*, 2008, para 61-68.

<sup>136</sup> The public interest defence in copyright cases is complicated by the existence of specific statutory defences. For an analysis of the interaction between these and the public interest, see Davies, *Copyright and the Public Interest*, paras 4-033 – 4-035.

Public interest does not extend beyond misdeeds of a serious nature and importance to the country.”<sup>137</sup>

The Press Complaints Commission’s Code of Practice provides a definition of the public interest as regards media publication, setting out when publication of otherwise unpublishable material will be justified:

1. The public interest includes, but is not confined to:
  - i) Detecting or exposing crime or serious impropriety.
  - ii) Protecting public health and safety.
  - iii) Preventing the public from being misled by an action or statement of an individual or organisation.<sup>138</sup>

While such interests are laudable, the courts have made clear in questions of media publication that catering to the public curiosity for gossip is not on a par with the above interests: “what interests the public is not necessarily in the public interest”.<sup>139</sup>

The Press Complaints Commission’s guidance is particularly helpful since the role of the media in publishing matters in furtherance of “the public interest” is perhaps one of the most controversial elements of this defence. In *W v Edgell*, the public interest was found to justify the disclosure by the doctor in question of a psychiatric report to the medical officer at the plaintiff’s secure hospital, but the judge suggested that disclosure to the press, especially for a price, would have breached the doctor’s duty of confidence to his patient, the plaintiff.<sup>140</sup> Similarly, in the employment context, it has been observed of the Public Interest Disclosure Act 1998 that “the stringency of these requirements [regarding disclosure to the media] is a clear signal that reporting to the media is intended to be a last resort”.<sup>141</sup> This suggests that even where *disclosure* can be justified in the public interest, publication in the media may be

<sup>137</sup> Davies, *Copyright and the Public Interest*, para 4-034, citing *Hyde Park Residence v Yelland* [2001] Ch 143. See also Cornish and Llewelyn, *Intellectual Property*, para 12-58; C Angelopoulos, “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328, at 335-336.

<sup>138</sup> Available at <http://www.pcc.org.uk/cop/practice.html> (accessed 12 October 2008). The Code also notes that the interests of children under 16 are “paramount” and that there must be an “exceptional public interest” to override their private interests.

<sup>139</sup> *McKennitt v Ash* [2008] QB 73, para 66. See also *Mosley v News Group Newspapers Limited* [2008] EWHC 1777, para 114; *Douglas v Hello!* [2006] QB 125, para 254, where the public interest is contrasted with “public curiosity”.

<sup>140</sup> [1990] Ch 359, as discussed by J Chalmers, *Legal Responses to HIV and AIDS*, 2008, at 65.

<sup>141</sup> E Callahan, T Dworkin and D Lewis, “Whistleblowing: Australian, UK and US approaches to disclosure in the public interest” (2003-2004) 44 Va J Int’l Law 879, at 894.

unjustified, if the public interest can be served by disclosing to the appropriate authority, such as the police, rather than to the world at large.<sup>142</sup> In some cases, however, where there are large numbers of entitled recipients, disclosure in the press may be appropriate in order to communicate that information to them.<sup>143</sup>

This distinction draws out one of the potential difficulties inherent in applying the public interest defence in publicity situations. Since many of these cases focus on preventing criminal or wrongful conduct, it is difficult to see the precise role to be played by the public interest in publicity cases where, as Chapter 3 sought to show, most publicity is intended to promote goods or services or enable media publication of aspects of celebrities' lives. A further distinction between the public interest situations discussed above and the right of publicity is that many of the above public interest disclosures were made in breach of a duty of confidence – yet not all (or indeed many) publicity infringements will be made in breach of such a duty. Where any use of persona breaches existing rights which recognise a defence of the public interest, then that defence will of course be available.

The question for consideration here is whether there is any role for the public interest defence in a publicity right action, that is to say, separate from these existing grounds of action. It is certainly true, as Beverley-Smith *et al* observe, that “[u]sing the portrait of a celebrity in advertising, however, usually only serves the advertiser’s interest.”<sup>144</sup> Where use of persona is intended to benefit the interests of the party using it, rather than a wider public interest, then the defence should not be available.

However, it is submitted that there *is* a specific ground of public interest which should be recognised in the context of publicity rights: the cultural communication interest. Where use of persona is necessary to communicate cultural meaning, as advanced by Madow, Coombe, Carty and de Grandpre, amongst others,<sup>145</sup> then it

<sup>142</sup> Although note Ouseley J’s comment in *Theakston v MGN Ltd* that the “free press is not confined to the role of a confidential police force; it is entitled to communicate directly with the public for the public to reach its own conclusion.” [2002] EWHC 137 (QB), para 69.

<sup>143</sup> See *Lord Browne of Madingley v Associated Newspapers Limited* [2008] 1 QB 103, para 55.

<sup>144</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 107, in the context of German law.

<sup>145</sup> See section 5.2 above and Chapter 4, section 3.2.

should be permitted, on the basis of the public interest in allowing such use. Whereas the public interest is typically cited in the context of criminal behaviour or iniquity or public protection, this alternative ground would see it employed in a more creative and positive context. It is reliant on a broader concept of the “public interest”, but it is one which is very relevant to the publicity debate, as Coombe and others demonstrate.

Coombe gives an absorbing example of the extent of cultural communication through imagery – not all of it reliant on persona – in her depiction of a typical walk to work through downtown Toronto.<sup>146</sup> Where individuals make use of persona to communicate a cultural or sub-cultural meaning, such as the use of Nancy Sinatra’s name by a lesbian band in Coombe’s example, this use should be permitted – subject to other existing (non-publicity) rights, such as defamation or privacy. Thus, where the use of an individual’s persona would not breach existing legal protection and where it contributes to cultural (and typically non-commercial) communication of ideas or criticisms, it should not constitute an infringement of the individual’s publicity right, by virtue of being in the public interest.

As with all public interest defences, the extent to which the use in question amounts to a genuine cultural communication will depend on the facts of each individual case, and it is, unfortunately, difficult to generalise. It is also likely that there will be an overlap between this and the permitted uses of fair dealing and parody. Nonetheless, it is submitted that a genuine cultural communicative use of persona is in the public interest and should be recognised as a permitted use.

#### 6.4. Fair Dealing

The CDPA 1988<sup>147</sup> provides for certain permitted uses to be made of copyright work where such uses constitute “fair dealing”.<sup>148</sup> Sections 29 and 30 of the CDPA 1988

<sup>146</sup> Coombe, *The Cultural Life of Intellectual Properties*, at 1-6.

<sup>147</sup> As amended by the Copyright and Related Rights Regulations 2003 (SI 2003/2498).

<sup>148</sup> A detailed analysis of the “fair dealing” exceptions in copyright is beyond the scope of this Chapter. See further MacQueen *et al*, *Contemporary Intellectual Property*, paras 5.19–5.36; Cornish and Llewelyn, *Intellectual Property*, paras 12-36 – 12-55; K Garnett, G Davies and G Harbottle,

allow fair dealing for the purposes of research and private study, criticism, review and news reporting, provided that the use is “accompanied by a sufficient acknowledgement and provided that the work has been made available to the public.”<sup>149</sup> Where a use falls within one of these categories, has been acknowledged and is also “fair”,<sup>150</sup> it will be an excepted use, and not constitute copyright infringement. There is a great deal of merit in ensuring that similar permitted uses are available in cases of publicity rights.

For example, section 31 of the CDPA 1988 provides an exception for “incidental inclusion” of the copyright work in an artistic work, sound recording, film or broadcast. As the authors of *Copinger and Skone James on Copyright* note, the provisions on incidental inclusion “have a great deal of importance for photographers, advertisers, film makers and broadcasters”<sup>151</sup> since they allow, for example, a report to be filmed in front of a work of art, play, or even a building, all of which would otherwise benefit from copyright protection as regards the film or broadcast. Where a camera crew captures celebrities spectating at a sporting or charity event as part of a wider report on the event, for example, the dissemination of those images should be permitted as constituting incidental inclusion.<sup>152</sup> Similarly, reference to individuals, their image and reputation for the purposes of private study or non-commercial research should be permitted, unless there is a breach of their Article 8 right to privacy. Finally, individuals should accept that there is a legitimate need for criticism or review of their persona, whether that is academic, artistic or political. Where the criticism or review is untrue, existing doctrines such as defamation are capable of supplying a remedy.

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*Copinger and Skone James on Copyright*, 15<sup>th</sup> ed, 2005, (henceforth *Copinger and Skone James on Copyright*) paras 9-19 – 9-63; C Angelopoulos, “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328, at 336-341.

<sup>149</sup> CDPA 1988, s30(1).

<sup>150</sup> For details of the sort of considerations that are relevant to determining fairness, see *Copinger and Skone James on Copyright*, para 9-55.

<sup>151</sup> *Ibid.*, para 9-56.

<sup>152</sup> A similar exemption exists in German law regarding privacy to allow photographs of assemblies and crowd scenes to be publicly exhibited: A Vahrenwald, “Photographs and privacy in Germany” [1994] Ent LR 205, at 215.

Fair dealing as delineated in the CDPA 1988 therefore provides a useful, and carefully drawn, set of exceptions to copyright, which could usefully be replicated to act as defences to a claim for infringement of publicity rights. As with fair dealing in copyright, the court should be able to consider the motives of the alleged infringer: “was the use merely dressed up in the guise of criticism or review?”<sup>153</sup> Yet viewed against the concerns expressed in Chapter 4, fair dealing alone is too narrow: the public interest in using persona extends further than these exceptions, to encompass the public interest in cultural communication, as discussed above, and arguably also parody.

## 6.5. Parody

A further possible acceptable use of persona is provided by parody. Although there is no fixed definition of parody, a comprehensive overview is provided by Maniatis and Gredley. For them, parody can be defined as follows:

Unlike other forms such as satire, parody uses the preformed material of its source “as a constituent part of its own structure”. It involves at first an imitation and then a change of the style, subject-matter or vocabulary of another work, achieving its effect through comic incongruity between the original and the parody work.<sup>154</sup>

It is this comic incongruity which is at the heart of parody: “the parodist relies on the audience’s awareness of the target work or genre; in turn, the complicity of the audience is the *sine qua non* of its enjoyment.”<sup>155</sup> Critically, if “parody does not prick it does not work”,<sup>156</sup> but when it does work, it is “for the most part a form of healthy social and artistic criticism.”<sup>157</sup>

The importance of parody is well recognised<sup>158</sup> as it potentially impacts upon a range of intellectual property rights, including copyright, moral rights, passing off and

<sup>153</sup> *Copinger and Skone James on Copyright*, para 9-55.

<sup>154</sup> S Maniatis and E Gredley, “Parody: A fatal attraction? Part 1: The nature of parody and its treatment in copyright” [1997] EIPR 339, at 339, footnote omitted.

<sup>155</sup> *Ibid.*, at 340.

<sup>156</sup> *Laugh it Off v SAB* 2006 (1) SA 144, para 75.

<sup>157</sup> C Rutz, “Parody: a missed opportunity?” [2004] IPQ 284, at 314, footnote omitted.

<sup>158</sup> Recent articles include: C Rutz, “Parody: a missed opportunity?” [2004] IPQ 284; M Spence, “Intellectual property and the problem of parody” (1998) 114 LQR 594; and S Maniatis and E



trade marks. Opinion is divided, however, as to whether it ought to be afforded special treatment as a distinct genre or defence.<sup>159</sup> This wider question can however be left aside in the present discussion, to focus instead on the role that could be played by parody as a defence to publicity rights infringement.

Perhaps the leading judgment on parody in any jurisdiction is that of Justice Sachs in the Constitutional Court of South Africa, in the trade mark infringement case of *Laugh it Off Promotions CC v South African Breweries International (Finance) BV*<sup>160</sup> when the appellant company printed t-shirts featuring parodies of well known trade marks. In a comprehensive legal, social and political review of trade mark law and social commentary, he reflected on the vital role that parody can play in society. Specifically, branding can operate to level the playing field between the corporations on the one hand and the cultural communicators, such as those identified by Madow,<sup>161</sup> on the other:

[i]n our consumerist society where branding occupies a prominent space in public culture, one does not have to be a ‘cultural jammer’ to recognise that there is a legitimate place for criticism of a particular trademark, or of the influence of branding in general or of the overzealous use of trademark law to stifle public debate.<sup>162</sup>

This comment applies equally to publicity, whereby overzealous use of publicity rights could stifle public debate and criticism, in the way Madow feared. Where the genuinely parodic use of a trade mark was prevented by the trade mark owner’s intellectual property rights, then the “result was inappropriately to allow what were

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Gredley, “Parody: A fatal attraction? Part 1: The nature of parody and its treatment in copyright” [1997] EIPR 339 and “Parody: A fatal attraction? Part 2: Trade mark parodies” [1997] EIPR 412; C Angelopoulos, “Freedom of expression and copyright: the double balancing act” [2008] IPQ 328. In particular, the distinction between weapon parody (where the original work is parodied to comment on other aspects of culture) and target parody (where the parody comments upon the original work), which is drawn in several of these commentaries, is not made here in relation to publicity, since both may be equally valid in a publicity context, especially in light of the “cultural communication” use of persona.

<sup>159</sup> Contrast M Spence, “Intellectual property and the problem of parody” (1998) 114 LQR 594, at 601 and 615–617, who does not think so, with S Maniatis and E Gredley, “Parody: A fatal attraction? Part 1: The nature of parody and its treatment in copyright” [1997] EIPR 339, at 344, who do.

<sup>160</sup> 2006 (1) SA 144.

<sup>161</sup> See the discussion at Chapter 4, section 4.2.

<sup>162</sup> *Laugh it Off v SAB* 2006 (1) SA 144, para 86.

tenuous property interests to outweigh substantial expression rights.”<sup>163</sup> It is critical that the same cannot be said of publicity rights.<sup>164</sup>

Parody is necessary to provide a vent for society and a method of enabling discussion:

A society that takes itself too seriously risks bottling up its tensions and treating every example of irreverence as a threat to its existence. Humour is one of the great solvents of democracy.<sup>165</sup>

Where there is genuine parody of an individual’s image or identity – “a take-off, not a rip-off”<sup>166</sup> – then the right of the parody artist must outweigh that of the individual. It may be that the individual has a claim under defamation, for example, or through Article 8 privacy rights, but these are separate actions and do not affect the conclusion reached here: parody should not be capable of being struck down through a *sui generis* publicity right.

## 6.6. Other Possible Permitted Uses

To finish this review of permitted uses of persona, it is necessary to touch upon two uses which are, it is submitted, largely protected by the foregoing exceptions to the right.

The first is the need to use persona to “set the record straight” – a factor which played a key role in MGN’s defence in *Campbell v MGN*.<sup>167</sup> Such a claim would allow use of an individual’s persona where it was necessary to correct a lie or hypocritical stance adopted by the individual in question. In fact, insofar as such a use is necessary,<sup>168</sup> this is likely to be covered by the general “public interest” ground, since disclosure of lies and the need to ensure the public knows the truth

<sup>163</sup> *Ibid.*, para 76.

<sup>164</sup> The brief and largely dismissive treatment of the parody defence by the Ninth Circuit in *White v Samsung Electronic America Inc* suggests that parody is given insufficient consideration in American courts: 971 F.2d 1395, at 1401.

<sup>165</sup> *Laugh it Off v SAB* 2006 (1) SA 144, para 109.

<sup>166</sup> *Ibid.*, para 102.

<sup>167</sup> [2004] 2 AC 457.

<sup>168</sup> And there are those such as Gordley who suggest it is not a beneficial defence, at least in the case of privacy, on the basis that hypocrisy is preferable to the disclosure of vice: *Foundations of Private Law: Property, Tort, Contract, Unjust Enrichment*, 2006, at 236.

certainly falls within this category. Further, such use is likely to be protected by the Article 10 right to freedom of expression, as indeed was the case in *Campbell v MGN*.<sup>169</sup>

The second possible use which could be permitted is where there is “fair comment”. This is one of the available defences to an action for defamation, and arises where the allegedly defamatory comment is in fact a statement of opinion. Liability will not attach in defamation where the defender can demonstrate that his opinion was based upon true facts and concerned a matter of public interest, and that there was no intention to harm the pursuer.<sup>170</sup> It is submitted that non-defamatory<sup>171</sup> use of persona to express an opinion is likely to be protected, where necessary, by Article 10 and should, to this extent, be permitted.

## PART B: REMEDIES

Now that the limitations of the right of publicity have been more thoroughly explored, one final element remains: the remedies available for breach. If an individual successfully establishes that his persona has been used for the media information, promotion or merchandising use without his consent and without the benefit of any of the countervailing rights or limits examined in Part A, then he will be entitled to a remedy for this infringement.

### 7. REMEDIES FOR BREACH

Remedies for unauthorised exploitation fall into two camps, being those directed at preventing the unauthorised use and those intended to provide redress for it. Under

<sup>169</sup> See section 5.1 above and Chapter 5, section 2.4.

<sup>170</sup> J Thomson, *Delictual Liability*, 3<sup>rd</sup> ed, 2004, at 269-270.

<sup>171</sup> If the opinion *was* defamatory, the individual would have a claim under the delict of defamation instead of, or as well as, the publicity rights claim.

the heading of prevention are interdict and interim interdict. If an individual is able to prove a proposed use of his persona would breach his publicity right and cannot be defended, then there would seem to be no reason why he could not raise an action for an interim or permanent interdict.<sup>172</sup> The test for these remedies in Scotland requires a *prima facie* case and satisfaction of a test of balance of convenience, in the case of the former, or proof of a continuing or apprehended wrong for the latter.

Where the unauthorised use has already been made, the individual may wish to seek redress in court. The following sections will examine the measure of damages and other disposals that might be appropriate in an action by the individual. An authorised exploiter, whose rights under an exclusive licence have been breached, may also seek a remedy from the unauthorised exploiter, and this aspect of liability to licensees will be dealt with in the final section.

It would be possible to make express provision for these remedies in a statutory right of publicity, particularly where publicity-specific remedies are contemplated.<sup>173</sup>

## 7.1. Damages

### 7.1.1. Introduction

Infringements of rights in both Scotland and England are frequently remedied by the court with an award of damages<sup>174</sup> and it is well established that damages are intended to compensate the pursuer for his loss, by putting him in the position he

<sup>172</sup> As Whitty notes, “There is (fortunately) no Scottish parallel to the technical English rule of Equity that an injunction will not be granted if damages would be an appropriate remedy; Lord Cairns’s Act does not apply in Scotland; and the judicial discretion to refuse permanent interdict (if indeed it exists) is more limited than in England.” Whitty, “Overview of Rights of Personality in Scots Law”, para 3.7.3, note 521. For the Anglo-American approach see, for example, Zimmerman, “Who put the right in the right of publicity?”, at 66.

<sup>173</sup> See for example section 7.2 below.

<sup>174</sup> In Scotland, the acknowledged primary remedy is an award of specific implement. Although this frequently defers to damages in practice, there are cases where the Scottish courts have granted this remedy while the English courts have refused specific performance on near identical facts. See L Macgregor, “The expectation, reliance and restitution interests in contract damages” (1996) JR 227, at 229.

would have been in but for the breach, rather than to punish the defender for his wrongful action or breach.<sup>175</sup>

In addition to this compensatory function, there may be an amount of damages awarded to vindicate the right infringed. This is supported by evidence from a number of English tort law cases, most notably those which also protect human rights under the ECHR. Lord Hope of Craighead, for example, explains that the “function of the law is to enable rights to be vindicated and to provide remedies when duties have been breached. Unless this is done the duty [to warn in medical cases] is a hollow one, stripped of all practical force and devoid of all content.”<sup>176</sup> Eady J has applied this principle in a privacy case, by acknowledging that an award can be necessary “to mark the fact that either the state or a relevant individual has taken away or undermined the right of another – in this case taken away a person’s dignity and struck at the core of his personality.”<sup>177</sup>

Where there is a dignitarian loss, compensation could be granted by an award of *solatium* to compensate for distress, anxiety and mental suffering of the pursuer resulting from the unauthorised use of his image or identity.<sup>178</sup> *Solatium* recognises a personal loss rather than a patrimonial loss and, according to the Court of Session, should be calculated with reference to “such sum of money as will reasonably mark the jury’s (or the judge’s) sense of the seriousness of the suffering, or as a reasonable recognition of its seriousness.”<sup>179</sup>

<sup>175</sup> In the context of remedies for intellectual property rights, see MacQueen *et al*, *Contemporary Intellectual Property*, para 21.97; Cornish and Llewelyn, *Intellectual Property*, para 2-39. Eady J considered and rejected an award of exemplary (or punitive) damages in *Mosley v News Group Newspapers Limited* [2008] EWHC 1777 (QB), paras 172-211, for example. For further analysis of the possible role of exemplary damages, see J Edelman, “In Defence of Exemplary Damages” in C Rickett (ed), *Justifying Private Law Remedies*, 2008, but note that punitive damages for personality rights are exceptional in Civilian systems: Waelde and Whitty, “A Rights of Personality Database”, para 11.6.

<sup>176</sup> *Chester v Afshar* [2005] 1 AC 134, para 87.

<sup>177</sup> *Mosley v News Group Newspapers Limited* [2008] EWHC 1777 (QB), para 216. Interestingly, *Mosley* is now appealing to the ECtHR on the basis that the award of damages in this case was not a satisfactory remedy: [www.guardian.co.uk/world/2008/oct/04/humanrights.pressandpublishing](http://www.guardian.co.uk/world/2008/oct/04/humanrights.pressandpublishing) (accessed 8 November 2008).

<sup>178</sup> See Whitty, “Overview of Rights of Personality in Scots Law”, para 3.7.6.

<sup>179</sup> *The Laws of Scotland: Stair Memorial Encyclopaedia vol XV “Obligations”*, para 922, citing *M’Callum v Paterson* 1968 SC 280, at 284.

Compensating the economic loss is likely to prove more troublesome, however, since it will require to be calculated according to some quantifiable loss. Where the pursuer can show that he has lost some or all of his licence fee with an *authorised* exploiter as a result of the *unauthorised* use, as per examples given by Lord Brown in *Douglas v Hello!*,<sup>180</sup> this lost fee could be recoverable from the unauthorised user. However, in some cases there may be no obvious financial loss, yet the defender will still have had the benefit of the pursuer's publicity right, for which he would otherwise have had to pay. In order to address this problem a remedy in unjustified enrichment may be appropriate.

### **7.1.2. Unjustified Enrichment: The Notional Licence Fee**

In Chapter 6, the lack of a clear prior right was identified as a hurdle to protecting publicity rights through unjustified enrichment. A statutory monopoly right would create this prior right and thus any unauthorised use or "taking" of persona would fulfil the criteria for unjustified enrichment: (i) that there is an enrichment of the defender, which would arise from use of persona; (ii) at the expense of the pursuer, since his right to control (granted by the statutory right) would have been circumvented; and (iii) that the retention of the enrichment is unjustified, which would be the case where the right of publicity had been breached without justification. The question then arises as to the measure of damages to be awarded.

Unjustified enrichment looks to the gain made by the defender rather than the loss suffered by the pursuer, which can be calculated with reference to a "reasonable sum" for the use of the thing or right taken.<sup>181</sup> A good example of such a measure is the "notional licence fee" award, known variously as the hypothetical release measure,<sup>182</sup> the *quid pro quo* measure<sup>183</sup> or, as a wider category, gain-based

<sup>180</sup> [2008] 1 AC 1, para 328.

<sup>181</sup> H MacQueen, *Unjustified Enrichment LawBasics*, 2004, at 49; Whitty, "Overview of Rights of Personality in Scots Law", para 3.7.7.

<sup>182</sup> *Wrotham Park Estate Co v Parkside Homes Ltd* [1974] 1 WLR 798; *Experience Hendrix v PPX Enterprises* [2003] 1 Comm All ER 830. See also Whitty, "Overview of Rights of Personality in Scots Law", para 3.7.7, note 578.

<sup>183</sup> *Wrotham Park Estate Co v Parkside Homes Ltd* [1974] 1 WLR 798.

damages.<sup>184</sup> It is calculated according to the fee that the defender would have had to pay for the unauthorised use made, and has been the subject of much academic debate.<sup>185</sup> The remedy has been pressed into service in a number of breach of contract cases<sup>186</sup> where there has been no quantifiable loss suffered by the claimant as a result of the defendant's breach of contract.

The notional licence fee is often sought where the contract creates a monopoly in favour of the claimant, which is destroyed by the defendant's action in breach of contract with no hope of restoring the *status quo ante*. For example, where the breach arises from building additional houses<sup>187</sup> or producing recordings<sup>188</sup>, it cannot be reversed, that is, the newly built houses cannot (for reasons of public policy) be torn down, nor can the records sold to the public be unsold. This is equivalent to the position with publicity rights, where any breach of the right cannot easily be reversed: once Hello! had published the unauthorised wedding pictures of the Douglases, there was no way to undo the publication; once Talksport had circulated brochures featuring Irvine, there was no way to reverse the circulation. In the words of Eady J, in cases such as these, the "dam has effectively burst."<sup>189</sup>

Although not a breach of contract, infringement of a statutory right of publicity would likely be, by its very nature, irreversible in this way. The notional licence fee therefore has a role to play in providing financial compensation for breaches which cannot otherwise be undone (whether through unjustified enrichment or breach of restrictive covenant). It allows the pursuer to recover compensation, calculated according to the notional fee that the defender would have had to pay to make authorised use of the persona, under licence.

<sup>184</sup> J Edelman, *Gain-Based Damages: Contract, Tort, Equity and Intellectual Property*, 2002, especially chapter 3.

<sup>185</sup> For a Scottish perspective on this debate, see G Black "A new experience in contract damages? Reflections on *Experience Hendrix v PPX Enterprises Ltd*" 2005 JR 31, in response to D Campbell and P Wylie, "Ain't no telling (Which circumstances are exceptional)" (2003) 62 CLJ 605.

<sup>186</sup> See, for example, *Wrotham Park Estate Co v Parkside Homes Ltd* [1974] 1 WLR 798; *Attorney General v Blake* [2001] 1 AC 268; *Experience Hendrix v PPX Enterprises* [2003] 1 Comm All ER 830.

<sup>187</sup> *Wrotham Park Estate Co v Parkside Homes Ltd* [1974] 1 WLR 798.

<sup>188</sup> *Experience Hendrix v PPX Enterprises* [2003] 1 Comm All ER 830.

<sup>189</sup> *Mosley v News Group Newspapers Ltd* [2008] EWHC 687 (QB), para 36.



The notional licence fee award has been recognised in personality cases in the Civilian jurisdictions of France and Germany. French courts will award compensation “in the amount which would have been paid if the person concerned had asked for permission.”<sup>190</sup> German law recognises this measure as a head of damages, where there has been fault,<sup>191</sup> and under unjust enrichment.<sup>192</sup>

It has also been the subject of judicial consideration in England, in the two leading cases, *Irvine v Talksport* and *Douglas v Hello!*.<sup>193</sup> In fact, the award of damages to Irvine was exactly this measure. The Court of Appeal overturned the *amount* of Laddie J’s original award, but endorsed the *basis* of it, which was stated to be the “fee which would have been arrived at as between a willing endorser and a willing endorsee”.<sup>194</sup> Laddie J’s award of £2,000, calculated on the somewhat curious basis of £2 per brochure,<sup>195</sup> was replaced with an award of £25,000 which was explicitly based on Irvine’s current fee for endorsing products at the time that Talksport used his image.<sup>196</sup> Further, the Court of Appeal emphasised that the award should be based on what the defendant “*would have had to pay*... It is not the fee which [Talksport] *could have afforded to pay*”.<sup>197</sup> The end result was that

the unchallenged evidence leads ineluctably to the conclusion that [Talksport] would in all probability have had to pay at least £25,000 in order to enable it to do lawfully that which it did unlawfully, that is to say represent by means of the image appearing on the front of the leaflet that Mr Irvine had endorsed Talk Radio.<sup>198</sup>

Although the Court of Appeal’s assessment of the amount of the notional licence fee differed from Laddie J’s, the underlying principles were approved. Importantly, both courts noted the difficulties inherent in attempting to calculate a licence fee when

<sup>190</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 191.

<sup>191</sup> *Ibid.*, at 142-143.

<sup>192</sup> *Ibid.*, at 141-142.

<sup>193</sup> Damages calculated on this basis are also apparently being sought by Madonna in a privacy action in relation to photographs of her wedding, published by the Mail on Sunday in October 2008 following her divorce: <http://news.bbc.co.uk/1/hi/entertainment/7771732.stm> (accessed 8 December 2008).

<sup>194</sup> *Irvine v Talksport Ltd* [2003] 2 All ER 881, para 70, citing [2002] EWHC 539, para 9.

<sup>195</sup> The Court of Appeal noted that this result “bears no relation at all to the evidence before him [Laddie J] as to what [Talksport] would have had to pay”. See *Irvine v Talksport Ltd* [2003] 2 All ER 881, para 115.

<sup>196</sup> *Ibid.*, paras 111-116.

<sup>197</sup> *Ibid.* para 106, their emphasis.

<sup>198</sup> *Ibid.*, para 114.

neither party would have reached agreement in reality. It was acknowledged that Irvine would never have agreed to permit his image to be used in such a non-prestigious context, compared with his existing portfolio of glamorous high-profile endorsements and deals.<sup>199</sup> Talksport would equally have refused to enter into an agreement with Irvine based on his standard fee, when it could have achieved the same result by using a different photograph,<sup>200</sup> such as one posed by a model. Despite these difficulties, both the High Court and the Court of Appeal adopted the reasonable endorsement fee approach. The Court of Appeal affirmed that this was to be calculated according to the fee that the defendant would have had to pay, as demonstrated by the claimant's evidence, for use of that image.

The claim for a notional licence fee or reasonable royalty had considerably less success in *Douglas*. This was partly because the Douglases had committed themselves to an exclusive licence with OK!. Any grant of a licence by them to Hello! would therefore have left them in breach of contract as regards OK!. Accordingly, there was no notional licence fee to be calculated here: the Douglases could not have granted rights to Hello! without breaching their prior contract with OK!. It is therefore arguable that if the Douglases had chosen not to exploit their wedding photographs though OK!, they would have been able to claim a lost licence fee against Hello!.

The Court of Appeal raised a second objection to the award of a notional licence fee to the Douglases, by observing that “the Douglases would never have agreed to any of the unauthorised photographs being published. The licence fee approach will normally involve a fictional negotiation, but the unreality of the fictional negotiation in this case is palpable.”<sup>201</sup> However, it is not obvious that the Douglases were any less likely to grant consent than Irvine was, or, perhaps more accurately, evidence from the case reports seems to indicate that both Irvine and the Douglases would have been equally adamant in refusing consent. If the Court of Appeal was able to

<sup>199</sup> *Ibid.*, para 111.

<sup>200</sup> *Ibid.*, para 70, citing with approval Laddie J's comments at [2002] EWHC 539, para 9.

<sup>201</sup> *Douglas v Hello!* [2006] QB 125, para 246.

deal with the fiction of a negotiation between Irvine and Talksport, it is not clear why it was unable to deal with it as between the Douglases and Hello!.

A further obstacle identified by the Court of Appeal was that “while it is not a sufficient reason for rejecting the notional licence fee approach, there is the difficulty of assessing a fee.”<sup>202</sup> The Court of Appeal arguably over-stated this difficulty. Again, evidence from *Irvine*, together with the commercial cases which endorse the notional licence fee approach, can be referred to in order to provide guidance as to this assessment. As with *Irvine*, there was direct evidence available of the sort of fees that the Douglases would charge or that magazines such as Hello! and OK! would be prepared to pay for the exclusive right to publish celebrity wedding photographs. The complicating factor here – that Hello! would have needed to negotiate a fee to publish *unauthorised* photographs – is not dissimilar from *Irvine*, where the Court of Appeal accepted that Irvine would never have agreed to endorse a company such as Talksport, yet was still able to assess a notional licence fee for the purposes of damages.

The notional licence fee approach is fraught with obstacles if one takes it literally and looks at what the two warring parties would have tried to agree, pre-breach. However, if one treats it as a method of calculating damages where no other quantifiable financial loss is demonstrable, then it is a valuable tool for dealing with unauthorised use of intangibles, whether that unauthorised use breaches a contract or amounts to an unjustified taking of a monopoly right. Attempting to quantify the licence fee is no more of a fiction than attributing a specific value to lost or damaged body parts, as the courts frequently do in personal injury actions.<sup>203</sup> Criticisms of the approach as being too subjective can also be dismissed for this reason. All breaches giving rise to litigation will have a subjective value for the pursuer, yet the courts are prepared to impose a “reasonable” or objective sum, determined by accepted rules on quantification. There is no reason why the courts should be reticent about what is in

<sup>202</sup> *Ibid.*, para 248.

<sup>203</sup> See A Paton, *McEwan and Paton on Damages for Personal Injuries in Scotland*, 2<sup>nd</sup> ed, 1989. This lists current awards of damages for bodily injuries and can be used as a basis for future claims.

effect another exercise in calculating loss, based on a notional licence fee, using the best evidence available.

It is submitted that this measure should, however, be subject to a defence where the individual could never have granted a licence to the unauthorised user because of a prior grant of an exclusive licence to an authorised user. This was of course the outcome of *Douglas v Hello!*, where the Douglases' claim against Hello! was limited to their dignitarian interest in the personal information, while the commercial claim was brought by OK!, to whom the Douglases had effectively licensed the economic value. The Court of Appeal rejected the notional licence fee claim because

having sold the exclusive right to publish photographs of the reception to OK!, the Douglases would not have been in a position to grant a licence to Hello!... Accordingly, an award of a notional licence fee would involve the Douglases being unjustly enriched: they have already been paid £1m for the exclusive right to publish photographs of the reception. As was said in argument, they have thereby exhausted their relevant commercial interest.<sup>204</sup>

By exercising the positive power to exploit the information, via their contract with OK!, the Douglases had exploited, and exhausted, their commercial interest in the information. Their claim against Hello! could only be for the loss sustained, and no loss of a licence fee was sustained, because OK! still paid the agreed fee for the exclusive. Accordingly, in this situation, the claim against the unauthorised user for the economic interests will come from the exclusive licensee, as considered in section 7.3 below.

### **7.1.3. Additional Damages**

There is a specific provision in the CDPA 1988 which entitles the court to take into account all the circumstances of the breach of copyright, particularly the flagrancy of the infringement, and to award additional damages for these circumstances “as the

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<sup>204</sup> [2006] QB 125, para 247. The Court also had concerns that the Douglases' action was founded upon “upset and affront at invasion of privacy, not loss of the opportunity to earn money” (para 246) and that the practicalities of assessing a notional licence fee would have involved an element of “unreality” (para 246). The former difficulty has been acknowledged already in this thesis, not least in relation to the dangers of “shoehorning” a publicity foot into another boot, while the latter has been addressed and, it is submitted, overcome in this section.

justice of the case may require”.<sup>205</sup> A non-statutory equivalent of this can be detected in Eady J’s decision in *Mosley v News Group Newspapers Limited*, where he referred to similar awards in defamation actions and stated “[i]t must be recognised that it may be appropriate to take into account any aggravating conduct in privacy cases on the part of the defendant which increases the hurt to the claimant’s feelings or “rubs salt in the wound”.”<sup>206</sup> It is submitted that the possibility of awarding additional damages should be recognised in publicity cases.

#### 7.1.4. Account of Profits

English law recognises a further remedy which is particularly prevalent in intellectual property cases. An account of profits is an equitable remedy “based on the principle that the infringer has carried out the infringing act on behalf of the right owner.”<sup>207</sup> Cornish and Llewelyn note that this remedy “is not a notional computation as with damages, but an investigation of actual accounts”.<sup>208</sup> Support for awarding an account of profits in publicity cases can be derived from the judgment of the Court of Appeal in *Douglas v Hello!*. The Court stated:

If, however, Hello! had made a profit on the publication, we would have had no hesitation in accepting that the Douglases would have been entitled to seek an account of that profit. Such an approach would not run into the difficulties of principle which their notional licence fee argument faces. Such an approach may also serve to discourage any wrongful publication, at least where it is motivated by money.<sup>209</sup>

An account of profits is likely to be particularly relevant in respect of the merchandising use, where there is frequently a direct correlation between the use of an individual’s image on t-shirts, for example, and the profits made from selling those t-shirts.

<sup>205</sup> CDPA 1988, s97(2). See also MacQueen *et al*, *Contemporary Intellectual Property*, paras 21.100-21.101.

<sup>206</sup> [2008] EWHC 1777 (QB), para 222.

<sup>207</sup> MacQueen *et al*, *Contemporary Intellectual Property*, para 21.102. In Scots law, it is sometimes referred to as “count, reckoning and payment”: M Hogg, *Obligations*, 2<sup>nd</sup> ed, 2006, para 6.16, and references therein.

<sup>208</sup> Cornish and Llewelyn, *Intellectual Property*, para 2-43.

<sup>209</sup> [2006] QB 125, para 249.

Where the claimant successfully establishes an infringement of intellectual property rights, English law requires that he must claim either damages (including, where appropriate, additional damages) or an account of profits, since he cannot seek to be reimbursed both through an account and compensated through damages for the same infringement.<sup>210</sup>

It is submitted that any profit made by the defender should be taken into account in an award of damages to remedy an unjustified enrichment arising from breach of publicity.<sup>211</sup>

### **7.1.5. The Calculation of the Award**

One final point is the calculation of the award in individual cases, regardless of the basis on which the award is made. Although the same right and remedy(ies) should be available to all, this does not lead to the conclusion that the calculation of the monetary award will be the same for all. Whether compensatory damages or a notional licence fee is awarded, there can be a presumption that an individual with celebrity status is likely to suffer more economic loss than unknown claimants. Likewise, “A-list” celebrities may well be able to demonstrate a greater loss or a higher notional licence fee than “C-listers”.<sup>212</sup> As McCarthy notes of publicity “[l]ike all other property, that value may be great or small, as the marketplace determines.”<sup>213</sup> The value of persona, and the loss suffered, is likely to depend on the status of the individual – as determined by the marketplace.

This is hardly a novel concept, nor is it restricted to publicity. Anything which can be traded on the open market will typically have its price set by market conditions: supply and demand creates a price differential which is not reflective of the use value

<sup>210</sup> Cornish and Llewelyn, *Intellectual Property*, para 2-43.

<sup>211</sup> Hogg supports the recognition of this as a head of damages under unjustified enrichment in the context of breach of confidence: *Obligations*, 2<sup>nd</sup> ed, 2006, para 6.17. See also MacQueen *et al*, *Contemporary Intellectual Property*, at 903.

<sup>212</sup> It should be noted that this would not apply where the award is an account of profits, since this looks to the profit made by the party in breach, and not the loss suffered by the pursuer. However, it is likely that the profit in question would be greater in the case of a higher-profile individual.

<sup>213</sup> McCarthy, *The Rights of Publicity and Privacy*, para 1:39.

of the thing or any value other than market value.<sup>214</sup> Thus, although made in the context of publicity as property, Nimmer's assessment of the situation applies to the calculation of the award here:

the damages which a person may claim for infringement of the right will depend upon the value of the publicity appropriated which in turn will depend in great measure upon the degree of fame attained by the plaintiff.<sup>215</sup>

### **7.1.6. Concluding Points**

Regardless of whether respondents to the 2006 Online Survey favoured a property approach or a personal rights approach, support for some measure of remedy was high: 92% of "property" respondents<sup>216</sup> and 80% of "personal right" respondents<sup>217</sup> favoured a remedy for the individual in cases of unauthorised exploitation. When asked to choose which remedies from a given list should be available,<sup>218</sup> both sets of respondents were in favour of damages to compensate for financial loss and an account of profits. Whereas the property respondents were clearly in favour of compensatory damages, reflecting their property classification of the right, those who saw persona as a personal right were less convinced. This can be seen from the fact that 70.4% of property respondents favoured this measure,<sup>219</sup> compared to only 56.6% of the personal rights respondents.<sup>220</sup> However, when they were both asked if an account of profits should be available, support dropped slightly amongst property respondents (down to 66.7%<sup>221</sup>) whereas it rose amongst personal rights respondents (up to 62.3%<sup>222</sup>). This suggests that those who view persona primarily as a dignitarian or human right are more supportive of measures which strip unauthorised users of their gain, than measures which try to quantify the loss suffered by the

<sup>214</sup> See, for example, the discussion of the role of the market and persona in Armstrong, "The reification of celebrity".

<sup>215</sup> Nimmer, "The right of publicity", at 217. See also Chapter 4, section 6.

<sup>216</sup> Graph 6, Appendix B.

<sup>217</sup> Graph 7, Appendix B.

<sup>218</sup> The listed remedies were: (i) an interdict; (ii) damages to compensate for financial loss; (iii) an account of profits; (iv) some other sum of money calculated on another basis; (v) some other remedy; (vi) don't know. These options were cumulative and not exclusionary, thus respondents could opt for more than one remedy.

<sup>219</sup> Graph 8, Appendix B.

<sup>220</sup> Graph 9, Appendix B.

<sup>221</sup> Graph 10, Appendix B.

<sup>222</sup> Graph 11, Appendix B.



individual from this unauthorised use. That said, the percentages in all cases indicate strong support for financial compensation for unauthorised use.

In summary, financial compensation should be available to individuals where there has been unauthorised use of their publicity rights. This could take the form of an award to vindicate the right, an award of *solatium* to compensate for the damage to dignitarian interests, and/or a sum to compensate for the economic loss suffered. Where there is no quantifiable financial loss, the pursuer may choose to seek a measure based on the notional licence fee or, in cases where the defender has made a profit from his unauthorised use, an account of profits.

## 7.2. Other Disposals

A practical response for a pursuer would be to seek an order *ad factum praestandum* to seek, for example, the delivery up or destruction of documents or merchandise which infringe, or are likely to if made public, his publicity right.<sup>223</sup>

Continental jurisdictions typically offer a wider range of remedies for infringement of personality rights, which reflect the greater emphasis placed on protection of dignitarian interests than economic interests. Thus, in France, damages are not necessarily widely available but a range of other remedies are designed to restore the dignity of the individual.<sup>224</sup> Such remedies include the award of the *franc symbolique*,<sup>225</sup> designed to indicate the liability of the defendant and condemn his conduct, while recognising the lack of identifiable harm caused to the claimant.<sup>226</sup>

Other remedies include destruction of the infringing material, undertakings not to

<sup>223</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.7.4.

<sup>224</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 188. The authors also observe that even where monetary remedies are awarded, the level of compensation tends to be lower than in Germany or England.

<sup>225</sup> This is of course now a symbolic euro instead, and was awarded to French President Nicolas Sarkozy following an advert run by Ryanair which used a photograph of Sarkozy and his wife Carla Bruni. Note that Bruni was awarded 60,000 euros, being a notional licence fee calculated according to what she would usually seek, as a model, for appearing in such an advert, albeit this was a considerable reduction from the 500,000 euros she claimed:

<http://news.bbc.co.uk/1/hi/world/europe/7228457.stm> (accessed 25 May 2008).

<sup>226</sup> Beverley-Smith *et al*, *Privacy, Property and Personality*, at 187. The authors cast doubt on its efficacy, since such a minimal award suggests that the harm itself was minimal or even of dubious standing, and there is not necessarily any public awareness of the award once made.

publish it, anonymisation of the individual's features, and rectification of an untruthful passage or the addition of a statement to avoid public confusion.<sup>227</sup> Similar options are available under German law, including destruction, correction, the award of *solatium*, and the publication of a counter-statement by the individual.<sup>228</sup>

A final remedy which is worth consideration, particularly to address dignitarian damage caused, is derived from the remedy of the palinode.<sup>229</sup> As Whitty explains, this remedy “required a person who had defamed another to apologise and to retract the defamatory imputation.”<sup>230</sup> Although it was never abolished in Scotland, Whitty notes that it had “withered away” by the middle of the nineteenth century,<sup>231</sup> there is a statutory form of palinode in section 2 of the Defamation Act 1996, which provides for an “offer to make amends”.<sup>232</sup> This could operate as a useful template for a similar remedy in publicity rights. Further, published retractions have also been endorsed recently by the Council of Europe in Resolution 1165. Paragraph 14 obliges governments to ensure that a number of legal measures are in place, and that “when editors have published information that proves to be false, they should be required to publish equally prominent corrections at the request of those concerned.”<sup>233</sup> The use of a published apology or retraction may help to address dignitarian concerns in publicity rights – although it may of course work to generate further publicity for the defender and keep the infringement fresh in the public eye, contrary to the individual's wishes. For this reason, any such retraction should be awarded, where appropriate, only at the request of the individual concerned.

<sup>227</sup> *Ibid.*, at 181-185.

<sup>228</sup> *Ibid.*, at 138-146. *Solatium* will be awarded in Germany where the court refuses to award the notional licence fee on the grounds that the individual would never have granted a licence because of the degrading use made of the individual, for example the use of someone in an advertisement for a sexual stimulant (at 145). See also Whitty, “Overview of Rights of Personality in Scots Law”, para 3.7.6, note 555.

<sup>229</sup> This can be equated to remedies such as retraction and apology, which are often available: see Waelde and Whitty, “A Rights of Personality Database”, para 11.6.

<sup>230</sup> Whitty, “Overview of Rights of Personality in Scots Law”, para 3.7.2.

<sup>231</sup> *Ibid.*

<sup>232</sup> Section 2 of the Compensation Act 2006 enables an apology to be made by the defendant without this constituting an admission of liability.

<sup>233</sup> Council of Europe Resolution 1165 of 1998, para 14(iii).

The advantage of these disposals is that they reflect the dignitarian or moral interests protected by such rights, which are a key part of the proposed publicity right. While an award of damages may address the economic loss suffered, a sum of money may be less appropriate to resolve damage to the individual's right to control use of persona. It is not unreasonable to suppose that the Douglasses, who spent £60,000 on the pre-wedding party alone,<sup>234</sup> were more comforted by the vindication of their rights by the Court of Appeal than with the award of less than £15,000 in compensation. In this situation, a non-monetary remedy may well be appropriate in reversing some of the harm caused to the claimant's personal interests. An order compelling the defendant to publish an apology or retraction may therefore serve the interests of the claimant more effectively than a financial award.

### 7.3. Remedies for Authorised Users

In brief, it is worth noting that an exclusive licensee, as authorised user, may have two different claims, against: (i) the individual, for breach of the licence terms; and (ii) an unauthorised user where that unauthorised use breaches the grant in the licence. In the case of an action against the individual for breach of the licence, this will be a fairly straightforward action for breach of contract, and may be limited by the terms of the licence itself.

A statutory right for authorised users against unauthorised users would allow the issues to be addressed directly, thus avoiding the rather dubious (if commercially sensible) decision of the House of Lords in *Douglas v Hello!*.<sup>235</sup> In doing so, guidance can be drawn from the comparable rights of an exclusive licensee under the CDPA 1988. This provides that the exclusive licensee shall have the same rights and remedies as if the licence had been an assignment,<sup>236</sup> and that these rights and remedies are concurrent with the copyright owner's rights.<sup>237</sup> Any remedies

<sup>234</sup> Hello! Number 639, November 28, 2000, at 87-91.

<sup>235</sup> For commentary on this see Michalos, "*Douglas v Hello!*: The final frontier"; G Black, "OK! for some: *Douglas v Hello!* in the House of Lords" (2007) 11 Edin LR 402; and Carty, "The modern action for breach of commercial confidence".

<sup>236</sup> Section 101(1).

<sup>237</sup> Section 101(2).

exercisable by the defender against the copyright owner will also be applicable against the exclusive licensee.<sup>238</sup> A statutory grant to an exclusive licensee, that is to say an authorised user, against an unauthorised user is therefore a natural consequence of the right to grant an exclusive licence.

Further, there should be no danger of a double award against the unauthorised user. As *Douglas v Hello!* demonstrates,<sup>239</sup> and as discussed above, it is not possible for both the individual and the authorised user to have the same claim against the unauthorised user in a privacy action, and it is submitted that the same should inhere for publicity. Instead, the effect of an exclusive licence should be that the commercial element of the individual's claim is transferred to the exclusive licensee. The net extent of the defender's liability remains unchanged: the grant of a remedy to the authorised user simply re-allocates the distribution of it.

Thus, a statutory provision for exclusive licensees in publicity would provide some much-needed clarity and certainty in this area.

## 8. CONCLUSION

It is not necessary to draw any concise conclusions from a chapter of this nature, which has considered a number of areas which play an important role in shaping the right of publicity. The primary aim of the Chapter has been to sketch out the scope of a statutory publicity right in order to reflect both the commercial practice and the legal consequences of classifying the right as a monopoly/ real right of exclusive privilege.

The key features that have been identified are as follows:

- (i) the right should come into existence on the birth of the individual, with no prerequisite of registration or other formality;

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<sup>238</sup> Section 101(3).

<sup>239</sup> *Douglas v Hello!* [2006] QB 125.

- (ii) the right should endure for the life of the individual;
- (iii) the right should be inalienable during life, such that it can be licensed but not assigned;
- (iv) post mortem transmission and subsequent transfer should however be possible, subject to a qualifying registration during life;
- (v) freedom of expression should operate to permit use which would otherwise be unauthorised;
- (vi) additional permitted uses should allow for private use, the public interest, fair dealing and parody, to ensure that the cultural communicative use of persona is not unnecessarily hampered;
- (vii) the available remedies for unauthorised use should look to prevent such use by way of interdict, as well as compensating for wrongful use;
- (viii) compensatory awards should reflect the dignitarian and economic interests that are relevant in publicity, through financial compensation and non-monetary remedies;
- (ix) where no quantifiable financial loss can be shown, the courts should be able to look to unjustified enrichment, to award a notional licence fee; and
- (x) authorised users should have remedies against either the individual for breach of licence or unauthorised users for breach of the right.

## CHAPTER 8: CONCLUSION

To draw the foregoing analysis together, it is helpful to consider a hypothetical scenario. Imagine a future advertising campaign for a brand of malt whisky, featuring a paparazzo shot of Andy Murray holding a bottle of the whisky during a public celebration in his home town following his first title win at Wimbledon. Sales of the whisky rocket on the back of this campaign, but Murray did not give his consent – and, in fact, it potentially conflicts with an existing endorsement deal with a rival brand. What are the legal rights and wrongs arising?

Scots law so far remains litigation- and legislation-free as regards publicity use. In contrast, English law is edging towards a range of options, derived from the torts of passing off and breach of confidence, yet even those cases in English law which have tackled publicity-type use of name and image do not provide for every scenario. This thesis has sought to show that, as the law stands, there is very little that Murray could do to contest unauthorised use of his persona in an advertising campaign such as this. There is no evidence of misrepresentation, in contrast with *Irvine v Talksport*, and thus no likelihood of success in a passing off action. There is nothing defamatory about the use of the photograph and, in any event, the defence of *veritas* would permit the use. And his public celebration does not give rise to any breach of confidence or reasonable expectation of privacy.

Despite the legal lacuna, Murray would arguably have suffered through (i) loss to his dignitarian and economic interests, resulting from the unauthorised use and (ii) lack of certainty as to the scope of the licence for authorised exploitation with the rival brand. In the first place, he has lost control over his name and image, which was used publicly and prominently, without his consent. This infringement of his autonomy cannot be justified by reference to freedom of expression (the advertising message could be conveyed by other means and no other message is apparently conveyed), nor by reference to any cultural communication (since there is no evidence of an attempt to pass comment or of parody). Murray may also have

suffered economic harm if, for example, his existing whisky endorsement was not renewed. The risk to his existing authorised deal also draws attention to the uncertainty surrounding such arrangements: what is being licensed and what rights does this convey to the authorised exploiter?

This thesis has addressed how Scots law might best accommodate this scenario and similar publicity-type uses – and to show why a response is necessary and justified. Importantly, by looking to practice as well as theory, I have tried to ensure that the new right proposed is grounded in commercial reality as well as being doctrinally appropriate. The taxonomy sought for the proposed right of publicity in Scots law is thus one which fits within the Scots classification of rights, while also reflecting the reality of publicity practice.

The route to this proposed right has been by way of addressing the three questions posed in the Introduction. These were:

1. What should be the subject matter of a right of publicity?
2. Is there a need for such a right? Is its creation or recognition justified?
3. What should be the legal taxonomy of this right? And what should be its scope, its limits and its associated remedies?

By addressing these questions, a much clearer idea of the problem, and the most satisfactory solution, has emerged.

The three questions can be mapped on to Parts I, II and III of this thesis. Part I addressed the first question, in Chapters 2 and 3, by exploring the concept of publicity practice and the responses to this practice in a number of jurisdictions. As Chapter 3 demonstrated, this exploitation can arise through use of persona – the individual's name, identifying indicia, and reputation – in the media information, promotion and merchandising uses. Importantly, the definition of publicity itself is neutral as regards the nature of the exploitation in each case, thereby accommodating both authorised and unauthorised exploitation.



Part II tackled the second question: Chapter 4 assessed justifications for a right of publicity. By recognising the dignitarian and economic interests that are inherent in the use of persona, it is possible to identify rationales for protecting its use, since any interference with persona potentially impacts on autonomy and dignity and on economic interests. Yet while there is a case to be made in favour of publicity rights, arising from these interests, there are also concerns on the other side of the debate which must be addressed. Chapter 4 concluded that any grant of publicity rights must not be overbroad. There must be scope for the legitimate use of one's persona by others, through the right to freedom of expression and in the cultural creation of meaning and the communication of that meaning. These interests must be recognised through limitations on the right of publicity.

Part III addressed the third question, concerning the legal taxonomy and scope of a publicity right in Scots law. Rather than starting with existing doctrines and measuring publicity against each to identify the “best fit” solution, this review tried to map the characteristics of publicity onto the general scheme of rights in Scots law. In doing so, I concluded in Chapter 5 that the right of privacy, as currently developing through Article 8 ECHR, did not provide a best fit with publicity. While the possibility of pragmatic *ad hoc* use was certainly viable in some cases, the theoretical bases of the two rights remain distinct. The analysis in Chapter 6 moved on to real and personal rights. This revealed that the tension inherent in publicity, resulting from its dual economic and dignitarian aspects, meant that a publicity right could not exclusively be either a real right *or* a personal right. The key element in publicity was the individual's need to control the use of the intangible “asset” of persona, to protect and promote his economic and dignitarian interests. This control could be achieved through a right of exclusive privilege, categorised in Scots law as a real right but which does not exist over a “thing” and which focuses very much on the control that monopoly provides. This monopoly control allows for authorised use by the individual and for his prevention of unauthorised use – thereby recognising the positive and negative classification identified in Chapter 2. Further, the right proposed is designed to ensure that all individuals are able to control the use and exploitation of their persona: it is not a “celebrities charter”.

Having concluded that publicity practice can best be protected in Scots law as a right of exclusive privilege, the final element of this thesis was to flesh out the details of the right. Chapter 7 considered the boundaries of the right, including its duration, post mortem rights, transfer, and permitted uses, together with the remedies that should be available for individuals and licensees where the right is infringed. In assessing these limits and remedies, reference was made to the empirical data generated by the 2006 Online Survey.

This analysis has sought to recognise and reconcile the tensions inherent in publicity – tensions which are apparent from the study of publicity in other jurisdictions. The American literature reveals a decided emphasis on property concerns, which accommodates the commercial exploitation and transfer of persona, but which tends to overlook the dignitarian elements of control and autonomy which underlie the right. The property focus is reflected in typical justifications sought which, in common with intellectual property justifications, look to labour, desert and incentive principles. Yet these do not sit comfortably with the highly personal subject matter of publicity and have been the subject of comprehensive challenges, as was seen in Chapter 4. On the other hand, Civilian jurisdictions place a greater emphasis on the extra-patrimonial elements of publicity, arising from the inherently personal nature of name, image and identity. While justifications derived from these dignitarian concerns are convincing, this focus tends to obscure the commercial practice in exploiting persona as a patrimonial right. This results in rather pragmatic responses to enable the exploitation of persona, despite its classification as an inalienable personal right.

Although the creation of a statutory right of publicity would be a novel development in Scots law, I believe the foregoing analysis has shown that such a right would allow for the development of the right in accordance with established principles. While the content of the right may be new, the form would not be a departure from the existing doctrine of exclusive privilege.

Thus, the publicity right proposed for Scots law is a statutory right of exclusive privilege, which reflects the economic and dignitarian interests of each individual through the right to control the use of persona, and recognises the legitimate interests of other parties in using that persona to communicate and to share cultural meaning. This right would be balanced and coherent, thereby protecting the interests of all parties involved and providing much needed clarity and certainty in the field of publicity.

# APPENDIX A

## COMMERCIAL PERSONA IN THE 21<sup>ST</sup> CENTURY

### QUESTIONNAIRE

1. Cover Email
2. Initial Text box
3. Introductory Questions
4. Questionnaire

#### Cover Email

David Beckham is famous for advertising Police sunglasses. Jamie Oliver is the face of Sainsbury's.

Celebrities can earn significant sums of money from allowing third parties to use their name, reputation and image – and the third parties benefit from the support and endorsement of the celebrity.

When individuals treat their persona – their name, reputation and image – as a commercial asset we can think of it as their **commercial persona**. So commercial persona can be used to describe the aspects of an individual's personality that can be exploited for commercial benefit.

I am a Lecturer in Commercial Law at Edinburgh University and I am investigating the current importance of commercial persona for individuals, for the companies that seek endorsement deals, and for the press. I would therefore be very grateful if you could click on [this link](#) and complete the short online questionnaire about commercial persona. It should take about 10 minutes to complete.

The results of this questionnaire will be used solely for academic research purposes, and not by or for any commercial organisation.

This questionnaire has been sent to you because of your experience in this field – your email address was obtained from your employer's website or from the website of your regulatory body, where you are listed as a specialist in this area or as having a professional involvement in it.

All information provided will be used solely for the purpose of informing this academic research project and any subsequent publications arising from it. Neither the individual answers provided nor the identities of respondents (if provided) will be disclosed in publications or to third parties. Strict ethical guidelines will be adhered to in using the information provided and all reasonable measures will be taken to protect it.

The questionnaire will close on MONDAY 18 SEPTEMBER 2006, at 11.59pm BST. Please submit your answers before then.

If you have any queries about the questions or about this research project please feel free to contact me via email on [gillian.black@ed.ac.uk](mailto:gillian.black@ed.ac.uk) or by phone: 0131 650 9541.

Many thanks,  
Gillian Black

## QUESTIONNAIRE

### Initial Text box

This questionnaire should take no longer than 10 minutes to complete.

Each section starts with a short introduction. Instructions on answering each question – for example, how many boxes to tick, or which question or Section to answer next – are provided throughout the questionnaire, as appropriate. Some of the questions are asked twice: firstly in relation to the **current** legal position and secondly to ask what you believe the law **should be**.

In many cases, there are no right answers – the questionnaire is intended to find out about the commercial beliefs of people involved in this area.

Although your participation in this survey is greatly valued, you are not required to participate. You can stop at any time or choose not to answer any particular question.

### Introductory Questions

1 What is your job/ in which of the following industries do you work? (please tick one)

1. celebrity
2. celebrity manager/ agent
3. brand manager/ sponsor
4. solicitor
5. advocate / barrister
6. academic
7. media/publishing
8. other (please specify) \_\_\_\_\_

→ 2

2. Approximately how many years have you been in your current industry or profession?

- 1 year or less
- 1 – 2 years
- 2 – 5 years
- 5 – 10 years
- 10 – 20 years
- 20+ years

3. Where do you work?

1. Scotland
2. England or Wales
3. Northern Ireland
4. Throughout the UK
5. Continental Europe
6. USA
7. Australia/NZ
8. Canada
9. Elsewhere: \_\_\_\_\_

→ A1

## Section A – An Individual’s Commercial Persona

When individuals treat their name, reputation and/or image as a commercial asset, they are exploiting an aspect of their persona, and we can call this their “commercial persona”.

So, commercial persona is the attractive element of fame or reputation that certain individuals have, and which they can commercially exploit, as an asset – third parties are willing to pay in order to associate the individual’s name and reputation and image with their goods or services.

This section considers what constitutes an individual’s identity or image, and whether commercial persona does or should have legal protection.

A1. Do you think the law **currently** protects any aspects of an individual’s identity or image as their commercial persona, i.e. as a commercial asset?

Yes → go to A2

No → go to A4

Don’t know → go to A4

A2 Which of the following aspects of an individual’s identity or image do you think the law **currently** protects?

The individual’s...

1. Name
2. Looks
3. Voice
4. Signature
5. Attitude or behaviour in public (for example, the difference between cultivating a “bad guy” or a “Mr Nice Guy” persona.)
6. “Trade mark” gesture (for example, Winston Churchill’s famous V salute)
7. Catchphrase
8. An identifiable style of dress
9. Other → (please state): \_\_\_\_\_

→ A3

A3 What makes you think this? Give brief reasons for your answer, if possible.

[Text box]

→ A4



A.4 Do you think the law **should** protect any aspects of an individual's identity or image as their commercial persona, i.e. as a commercial asset?

Yes → go to A5

No → go to A6

Don't know → go to A7

A5 Which of the following aspects of an individual's identity or image do you think the law **should** protect?

The individual's...

1. Name
2. Looks
3. Voice
4. Signature
5. Attitude or behaviour in public (for example, the difference between cultivating a "bad guy" or a "Mr Nice Guy" persona.)
6. "Trade mark" gesture (for example, Winston Churchill's famous V salute)
7. Catchphrase
8. An identifiable style of dress
9. Other → (please state): \_\_\_\_\_

→ A7

A.6 Why do you think there **should be no** legal protection for an individual's commercial persona?

1. anyone should be entitled to use an individual's commercial persona – it should not be removed from the public domain
2. it is not possible to define an individual's commercial persona
3. don't know
4. Other (please state) [text box]

→ A7

A.7. Which of the following statements do you most agree with? *Please tick **one** only:*

(a) Individuals who are famous invest time and effort in that activity, and they are rewarded for it. They **do not** invest time and effort in their image or reputation, and therefore any value in their image or reputation is accidental. It should be treated as an incidental benefit.

OR

(b) In addition to working at the activity that makes them famous, individuals also work to cultivate their image and reputation. The image and reputation they achieve is not accidental, and it should not be treated as an incidental benefit.

OR

(c) Don't know

→ A8

A.8 Who do you think **should** have a commercial persona? *Please tick **one** only.*

1. Everyone → A8A
2. Only celebrities/ famous people → A8A
3. No-one → A8A
4. Don't know → A10

A.8A Do you think that commercial persona should only arise where the individual cultivates their name, image and reputation?

For example, David Beckham actively manages his persona and image, and has been in the public eye for over a decade. In contrast, Guy Coma found 15 minutes of fame after accidentally appearing on BBC News 24, instead of attending an interview in the same building.

Does this make a difference?

1. Yes – an individual has to actively cultivate their name/image/reputation to deserve legal protection.
2. No – legal protection should be available to everyone, even where the reputation arises from an event beyond their control, e.g. being involved in a current affairs/news event.
3. Don't know

→ A10

A.10 An individual's right to exploit their commercial persona could be recognised in law in different ways. Which of the following do you think is **currently** the legal status of commercial persona?

Please tick **one** only

1. A **property** right, capable of being owned in the same way as a piece of jewellery or copyright in a poem. → A11
2. A right to prevent harm or interference by others, like right to prevent defamation or trespass – a **personal** right of action → A11
3. A right that everyone has, like to the right to privacy or the right to freedom of speech – a **human** right → A11
4. A combination of some or all of the above, i.e. in part a **property** and/or a **personal** and/or a **human** right. → A11
5. It does not currently have any legal status. → A11
6. Don't know → A11

A.11 Which of the following do you think **should be** the legal status of an individual's commercial persona?

Please tick **one** only

1. A **property** right, capable of being owned in the same way as a piece of jewellery or copyright in a poem. → **Section B**
2. A right to prevent harm or interference by others, like right to prevent defamation or trespass – a **personal** right of action → **Section C**
3. A right that everyone has, like to the right to privacy or the right to freedom of speech – a **human** right → **Section C**
4. A combination of some or all of the above, i.e. in part a **property** and/or a **personal** and/or a **human** right. → **A13**
5. It should not currently have any legal status. → **Section D**

6. Don't know → **Section D**

A13 If an individual's commercial persona **should be** protected by more than one type of legal right, do you support...

1. ... the primary right being a **property** right, and the secondary right being a **personal and/or human** right? → **Section B**

OR

2. ... the primary right being a **personal and/or human** right, and the secondary right being a **property** right? → **Section C**

NB You may favour a 50/50 split, or believe that it is not possible to answer this question in the abstract, but it is important for the purposes of this survey to choose one or the other, even if it is as close as 51/49 in favour of the primary right over the secondary right.

## Section B – A Property Right

[Text box: The questions in this section ask what you think the law **should be**, rather than what the law is.]

B1. If an individual's commercial persona should be treated like any item of property, then **who do you think should own it?**

Please tick **one** only

1. The individual
2. His/her manager
3. His/her agent
4. His/her sponsor
5. His/her club or team, if applicable (for example, in the case of a sportsman or woman)
6. The press
7. No-one
8. Other (please state) \_\_\_\_\_
9. More than one person – if so, who and what % share should they each have?  
\_\_\_\_\_
10. Don't know

→ B2

B2. Ownership of property usually entitles the owner to sell it on: for example, you can sell a house or assign a patent, and transfer the house or patent to a third party.

Should an individual be entitled to transfer or sell his commercial persona to a third party?

1. Yes
2. No
3. Don't know

→ B3

B3. Ownership of property frequently entitles the owner to rent or hire it out, either gratuitously or for a fee. For example, you can rent a house or license a patent, and this entitles you to use the house or the patent for a certain period of time.

**Should the owner of commercial persona be legally allowed to permit others to use the commercial persona?**

To give an example, this would allow a cereal manufacturer to enter into a licence to use a celebrity's name and image on its cereal boxes, to advertise and promote the cereal.

Please tick **one** only

1. Yes – and should be able to charge for this use
2. Yes – but should not be able to charge for this use
3. No.
4. Don't know

→ B4

B4. Do you think the individual should be legally entitled to prevent other people from using his commercial persona?

For example, if an individual is photographed in public drinking a brand of soft drink could this photo be used in an advertising campaign for that brand of soft drink, without the individual's consent? Or should the individual be entitled to stop this use?

Please tick **one** only

1. Yes – stop the use in all cases.
2. Yes – stop the use **but only** where the third party is making a profit from their use of it.
3. Yes – stop the use except for purposes of news reporting.
4. No – other people should have free use of other people's commercial persona
5. Don't know.

→ B5

B5. If there is unauthorised use of an individual's commercial persona by a third party, **should** the individual be entitled to any legal remedy for this unauthorised use? *Please tick one only.*

1. Yes → B6

2. No → B7
3. Don't know → B7

B6. Which of the following legal remedies do you think the owner should be able to obtain in court? *Tick all that apply.*

1. An order to stop the third party using the commercial persona (known as an injunction or interdict)
2. Damages to compensate for any financial loss
3. An award of the sum of money that the third party has made through its unauthorised use of the commercial persona, e.g. increased profits
4. Some other sum of money calculated on a different basis from options 2 or 3 above
5. Some other remedy
6. Don't know

→ B7

B7. Do you think the legal right of ownership of commercial persona should continue after the death of the individual? *Please tick **one** only.*

1. Yes → B8
2. No → Section D
3. Don't know → Section D

B8. Who do you think should own the right to an individual's commercial persona after the death of the individual? *Please tick **one** only.*

1. The individual's family or relatives/ next of kin
2. The individual should be able to specify someone in his/her will (a testamentary beneficiary)
3. The individual's manager
4. The individual's sponsor
5. The individual's club or team, if applicable (for example, in the case of a sportsman or woman)
6. The owner, if the owner is a different person from the individual
7. The press
8. No-one
9. Other (please state) \_\_\_\_\_
10. Don't know

→ Section D



### Section C – An Enforceable Right

[Text box: The questions in this section ask what you think the law **should be**, rather than what the law is.]

C1. If there should be a right to stop unauthorised use of an individual's commercial persona, **who do you think should be able to enforce the right?** *Please tick **one** only.*

1. The individual → C5
2. Someone else → C3
3. Don't know → C5

C2 [Delete]

C3 Who else should have the right to enforce it? Why?

[Text box]

→ C4

C4 [Delete]

C5 If a third party does infringe an individual's commercial persona by using it without consent, should the individual or enforcer be entitled to **stop** this use?

For example, if an individual is photographed in public drinking a brand of soft drink could this photo be used in an advertising campaign for that brand of soft drink, without the individual's consent? Or should the individual be entitled to stop this use?

1. Yes – stop the use → C5A
2. No – no right to stop the use → C7
3. Don't know → C7

C5A In addition to stopping this use, should the individual/enforcer be entitled to a legal remedy for the unauthorised use?

1. Yes → C6
2. No → C7
3. Don't know → C7

C6 Which of the following legal remedies do you think the individual/enforcer should be able to obtain in court? *Tick all that apply.*

1. An order to stop the third party using the commercial persona (known as an injunction or interdict)
2. Damages to compensate for any financial loss
3. An award equal to the sum of money that the third party has made through its unauthorised use of the commercial persona, e.g. increased profits
4. Some other sum of money calculated on a different basis from options 2 or 3 above
5. Some other remedy
6. Don't know

→ C7

C7 Should the individual/enforcer of the right of commercial persona be entitled to **waive their right to enforce**? And should there be a right to charge a fee for granting a waiver?

For example, a soft drinks manufacturer could not use a photo of an individual drinking their product as part of an advert, **unless the individual waived their right to stop such use**, i.e. the individual gave consent to such use. In this case, would the soft drinks manufacturer have to pay for the consent?

*Please tick one only.*

1. Yes – should be able to waive the right to enforce AND be able to charge a fee for this waiver → C8
2. Yes – should be able to waive the right to enforce BUT not be able to charge a fee for this waiver → C8
3. No – should never be able to waive the right to enforce. → C8
4. Neither – there should not be an enforceable right at all → Section D
5. Don't know. → C8

→ C8

C8 Do you think the right to enforce protection of commercial persona should continue after the death of the individual? *Please tick one only*

1. Yes → C9
2. No → Section D
3. Don't know → Section D

C9 Who do you think should be able to enforce protection of commercial persona after the death of the individual? *Please tick **one** only.*

1. The individual's family or relatives/ next of kin
2. The individual should be able to specify someone in his/her will (a testamentary beneficiary)
3. The individual's manager
4. The individual's sponsor
5. The individual's club or team, if applicable (for example, in the case of a sportsman or woman)
6. The enforcer, if the enforcer is a different person from the individual
7. The press
8. No-one
9. Other (please state) \_\_\_\_\_
10. Don't know

→ **Section D**

## Section D – Exploitation of Commercial Persona in Practice

[Text box:] [This section is designed to find out more about the current practice in relation to marketing and exploitation of commercial persona – whether authorised or not!]

D1. Have you ever been a party to, or negotiated or drafted, a contract or licence concerning the commercial exploitation of an individual's commercial persona?

1. Yes → **D2**
2. No → **D2A**

D2. What was your role in this contract or licence?

I was...

1. The publisher who paid for the right to use an element of an individual's commercial persona in a publication
2. A representative of the company/ sports club/ organisation who paid for the right to use an element of an individual's commercial persona in a sponsorship or endorsement deal
3. The celebrity manager/agent involved in negotiating or drafting such an agreement for my client, but not a party to the agreement
4. The solicitor involved in negotiating or drafting such an agreement, but not a party to the agreement
5. Other (please state) \_\_\_\_\_

→ D3

D3. Approximately how many such contracts or licences have you been a party to, or negotiated/drafted?

1. 1
2. 2-5
3. 6-10
4. 11-15
5. 16-20
6. 20+
7. Don't know

→ D4

D4 What was the approximate value of the most recent of these contracts or licences?

1. No financial value – it was a charitable arrangement
2. No quantifiable financial value
3. Up to £10,000
4. £10,000 - £25,000
5. £25,000 - £50,000
6. £50,000 - £100,000
7. £100,000 - £250,000
8. £250,000 - £500,000
9. £500,000 - £1,000,000
10. More than £1,000,000
11. Don't know

→ D5

D5 What was the approximate duration of this contract or licence?

1. A one-off event
2. 1 month
3. 2-6 months
4. 7-12 months
5. More than 12 months
6. The duration was connected to a contract of employment or similar
7. Don't know

→ D6

D6 Can you describe briefly the nature of the contract or licence?

[Text box]

→ D7

D7 Have you ever had any personal experience of **unauthorised** exploitation of commercial persona?

For example, has a third party used an aspect of your commercial persona without your consent? Or have you/ your company used an individual's commercial persona without their consent?

1. Yes →D8
2. No → **D2A**

D8 Could you provide brief details of your experience(s) of this unauthorised use?

[Text box]

→ **D2A**

**D2A.** Have you ever represented a client in litigation concerning an individual's commercial persona?

1. Yes → **D9**
2. No → **Section E/ END**

D9. Approximately how many such cases have you been involved in (either advising on at a pre-litigation stage or representing a client in court)?

1. 1
2. 2-5
3. 6-10
4. 11-15
5. 16-20
6. 20+

→D10

D10 What was the approximate value of the most recent dispute?

1. No quantifiable financial value
2. Up to £10,000
3. £10,000 - £25,000
4. £25,000 - £50,000
5. £50,000 - £100,000
6. £100,000 - £250,000
7. £250,000 - £500,000
8. £500,000 - £1,000,000
9. More than £1,000,000
10. Don't know

D11

Were you representing...

1. ... an individual?
2. ... a commercial organisation?
3. ... the media?

D12

Who were the litigants?

1. Two parties to an existing contract for endorsement/ sponsorship
2. An individual and a third party infringer
3. A commercial organisation and a third party infringer
4. An individual and the media
5. A commercial organisation and the media
6. Other – please specify \_\_\_\_\_

D13 Did the matter settle out of court?

1. Yes
2. No

D.14 Is there anything further you are able to add about this dispute?  
[text box]

→ **Section E/ End**

**E – End**

Thank you very much for completing this questionnaire.

Although this questionnaire is anonymous, if you would be willing to be contacted by Gillian Black to answer further questions by email or over the phone, please provide your name and contact details here: [text box]. Gillian may not be able to contact everyone who does provide contact details.

Please hit the submit button now to submit your answers. You will then be automatically redirected to the homepage of the School of Law.

If you would like more information about this research please email Gillian Black at [gillian.black@ed.ac.uk](mailto:gillian.black@ed.ac.uk)

**Gillian Black**  
**University of Edinburgh**



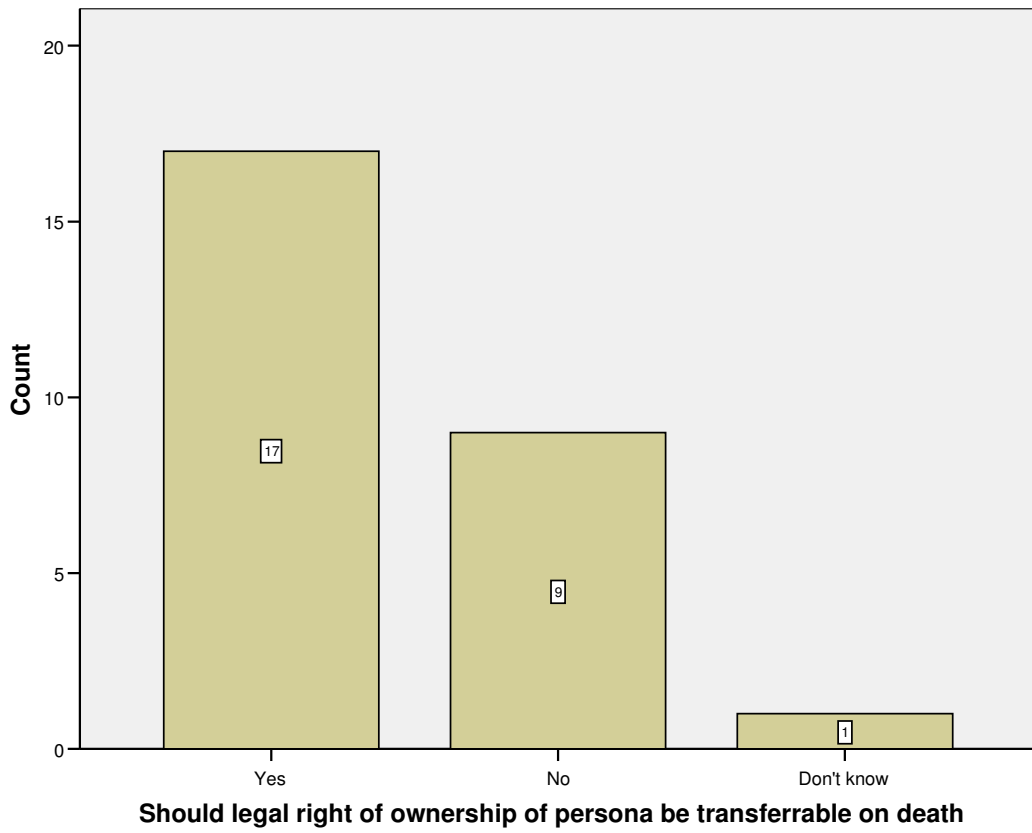
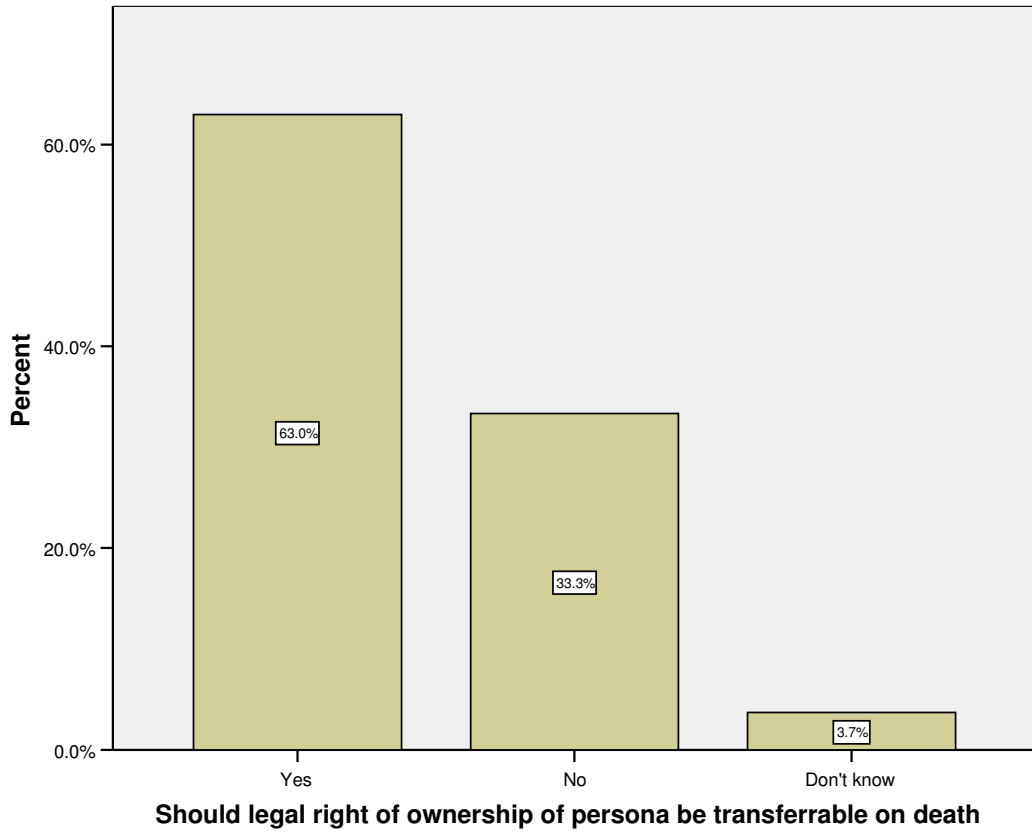
## APPENDIX B

This appendix contains the graphs referred to in Chapter 7, showing the data collected in the 2006 Online Survey.

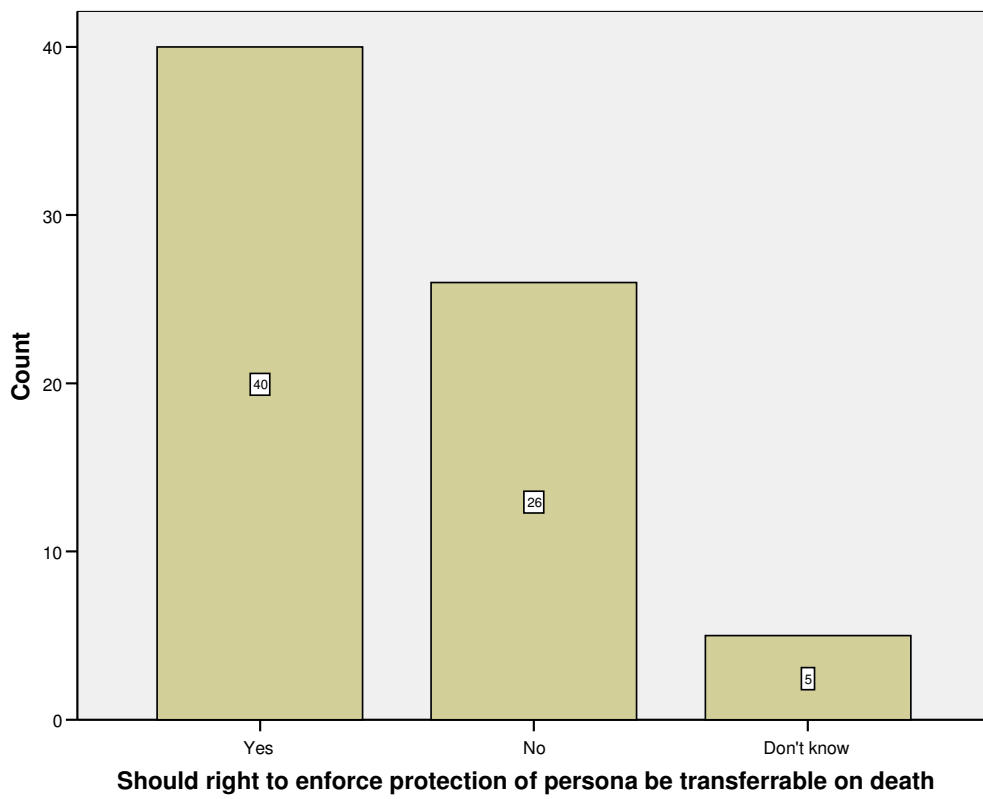
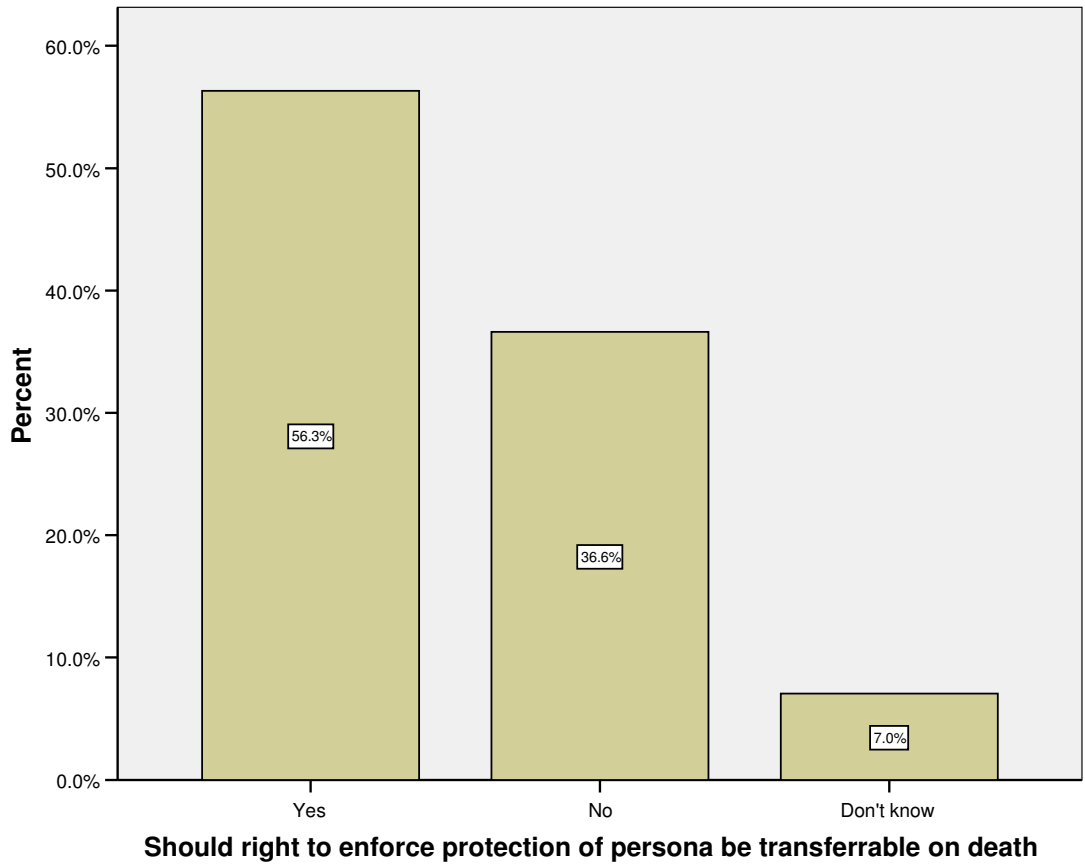
For each point illustrated, the same information is represented in two different ways:

1. the first graph shows the number of respondents as a percentage of the total answers to that question;
2. the second graph shows the number of respondents who selected that answer as a whole number.

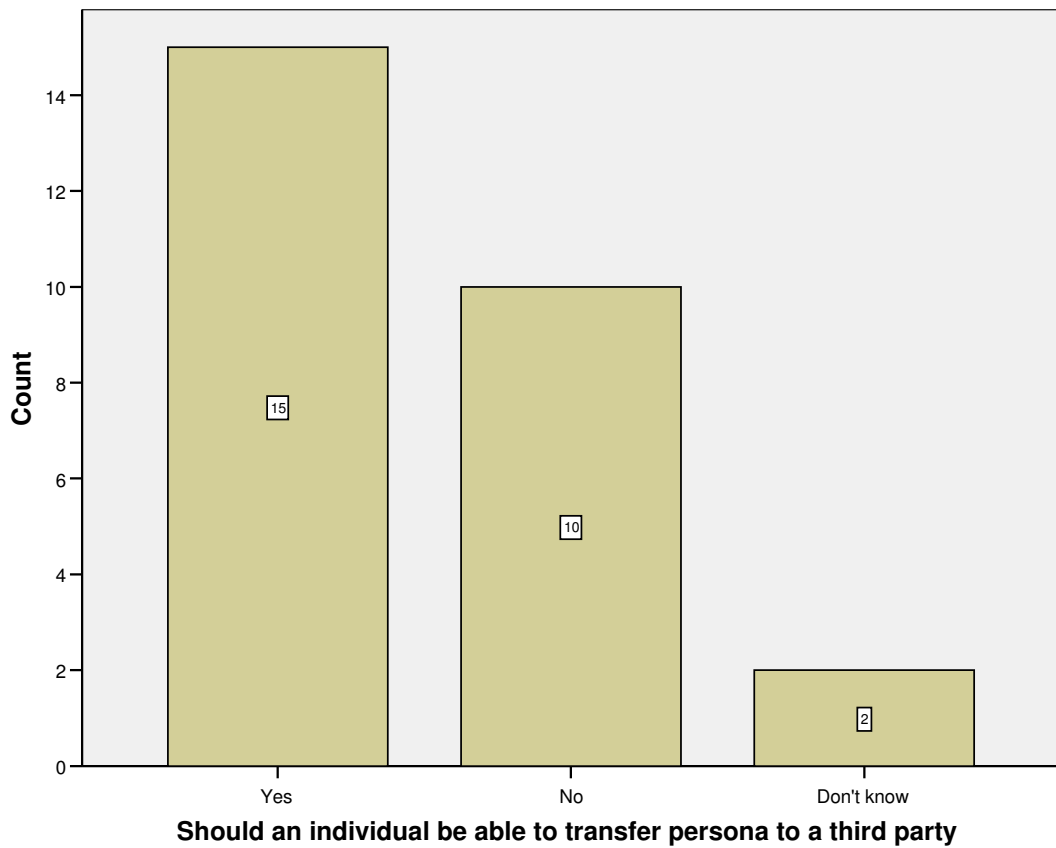
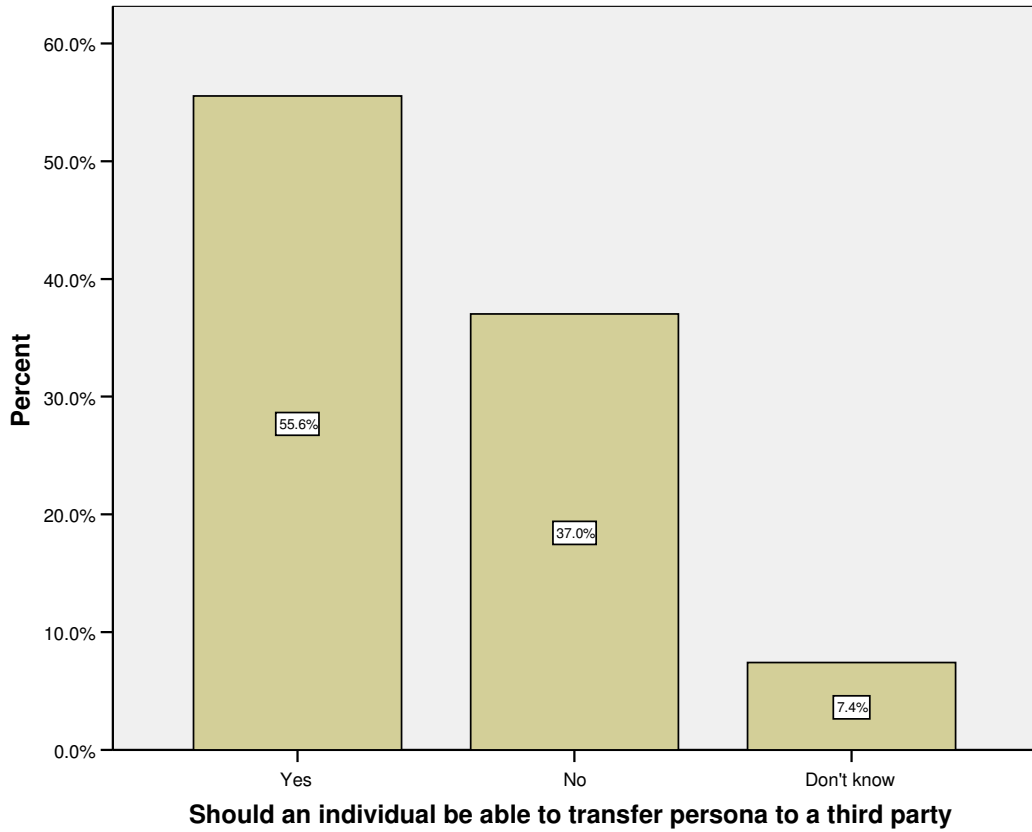
Graph 1



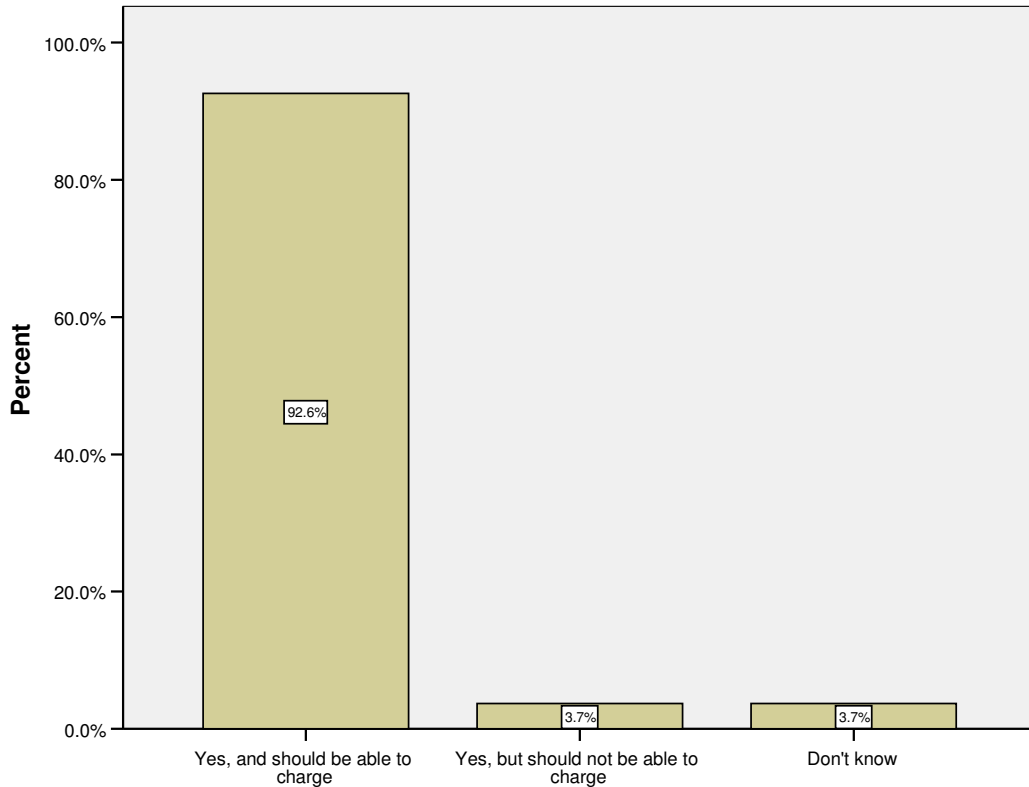
**Graph 2**



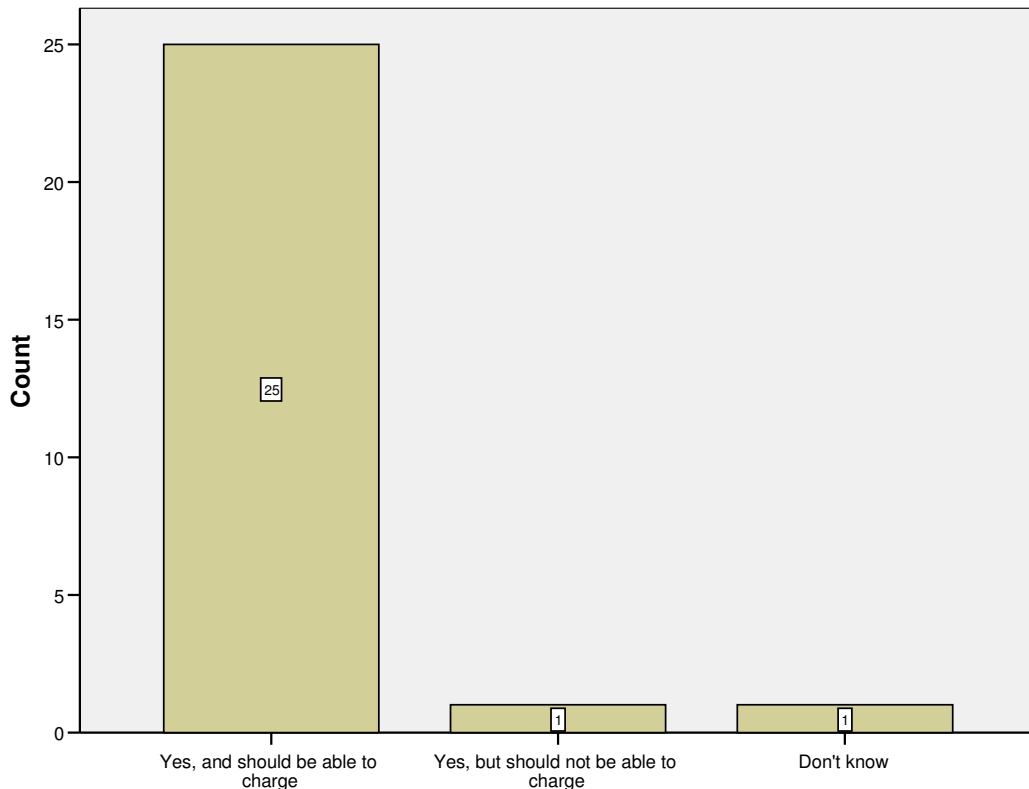
**Graph 3**



**Graph 4**

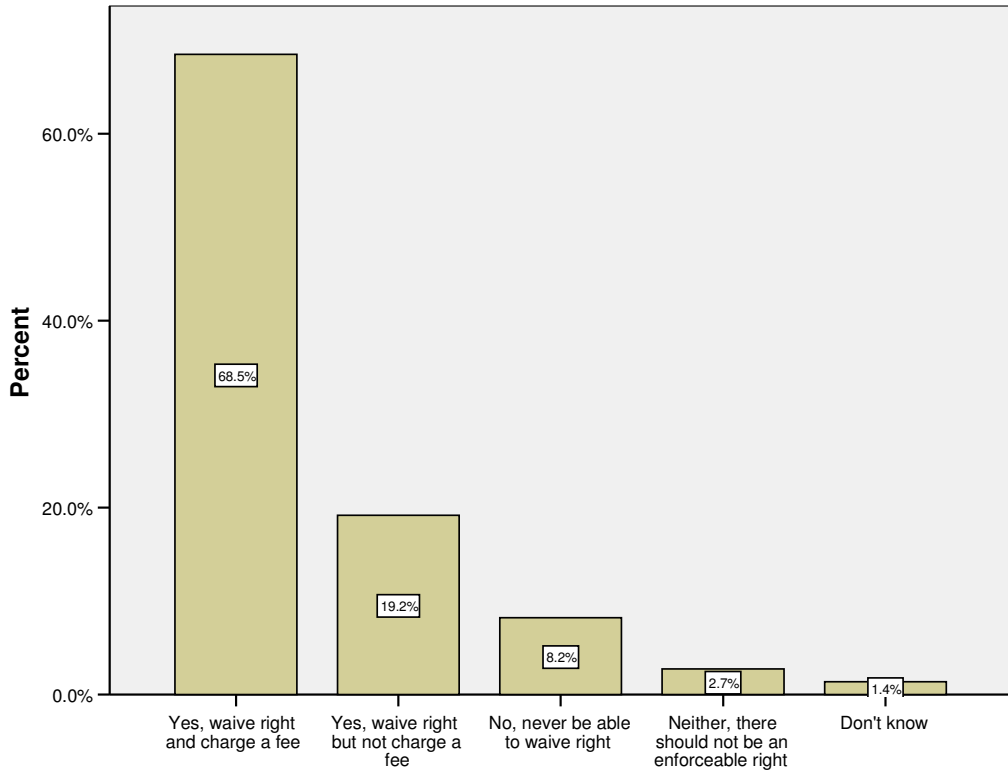


**Should an individual be able to permit a third party to use persona**

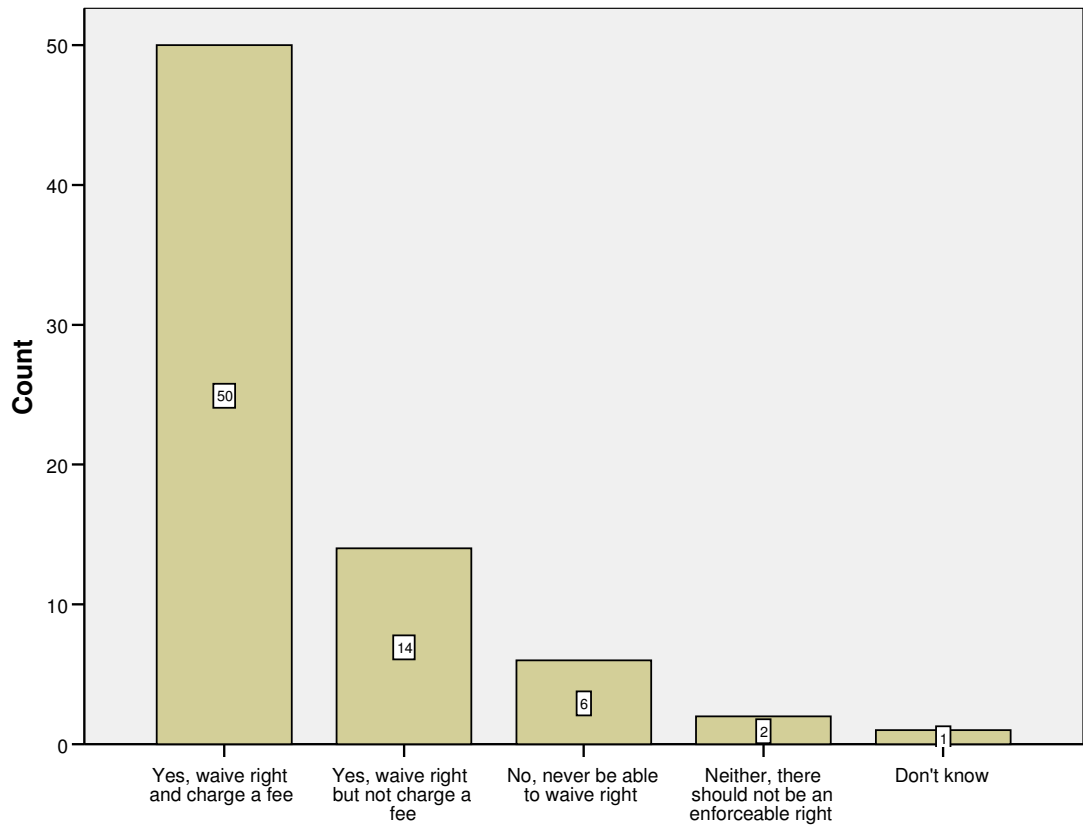


**Should an individual be able to permit a third party to use persona**

Graph 5

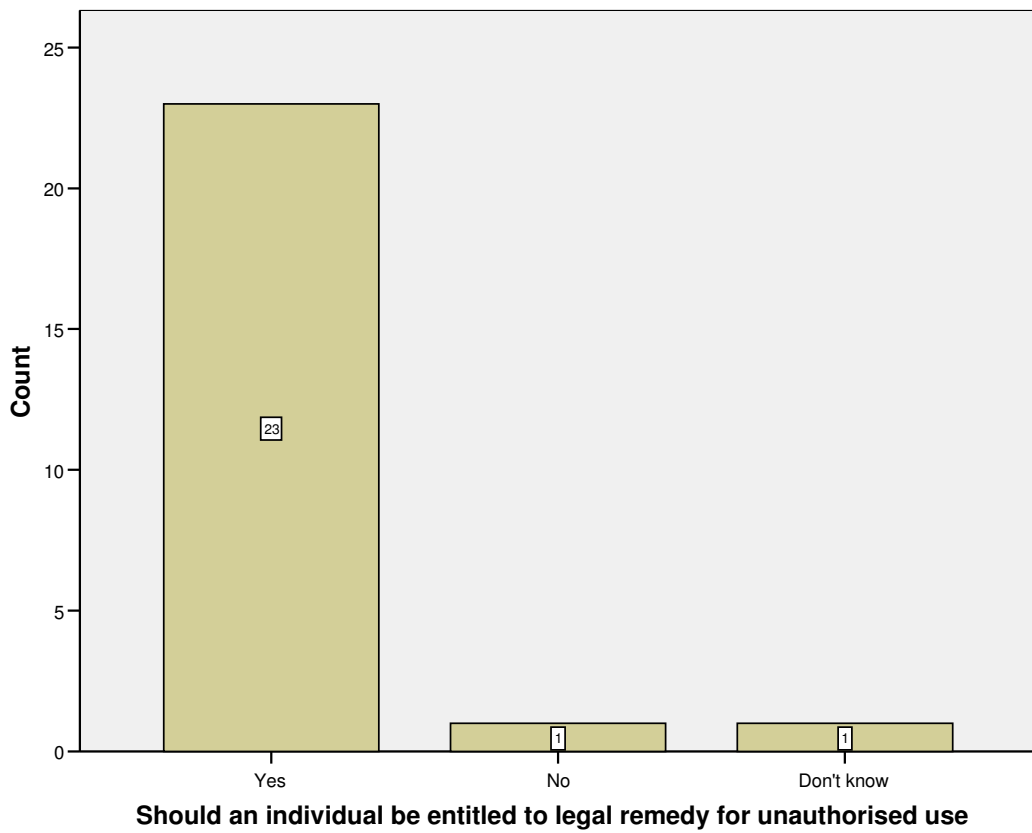
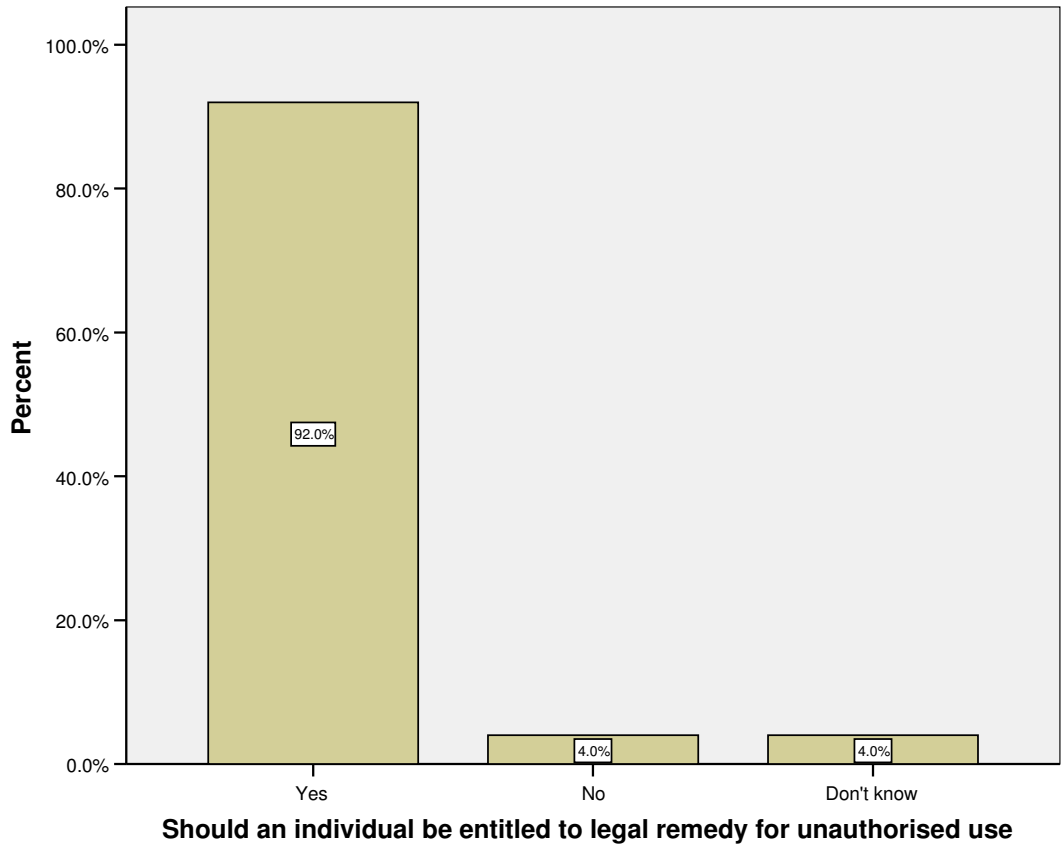


Should individual be able to waive right to stop use, and charge a fee

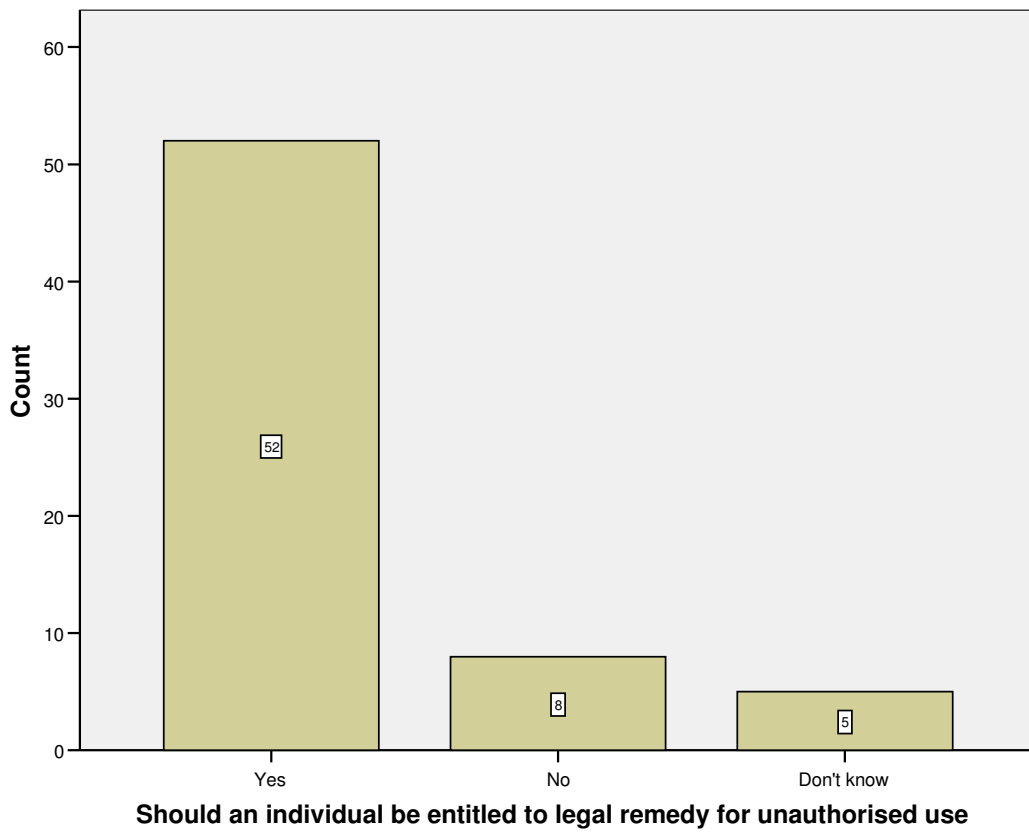
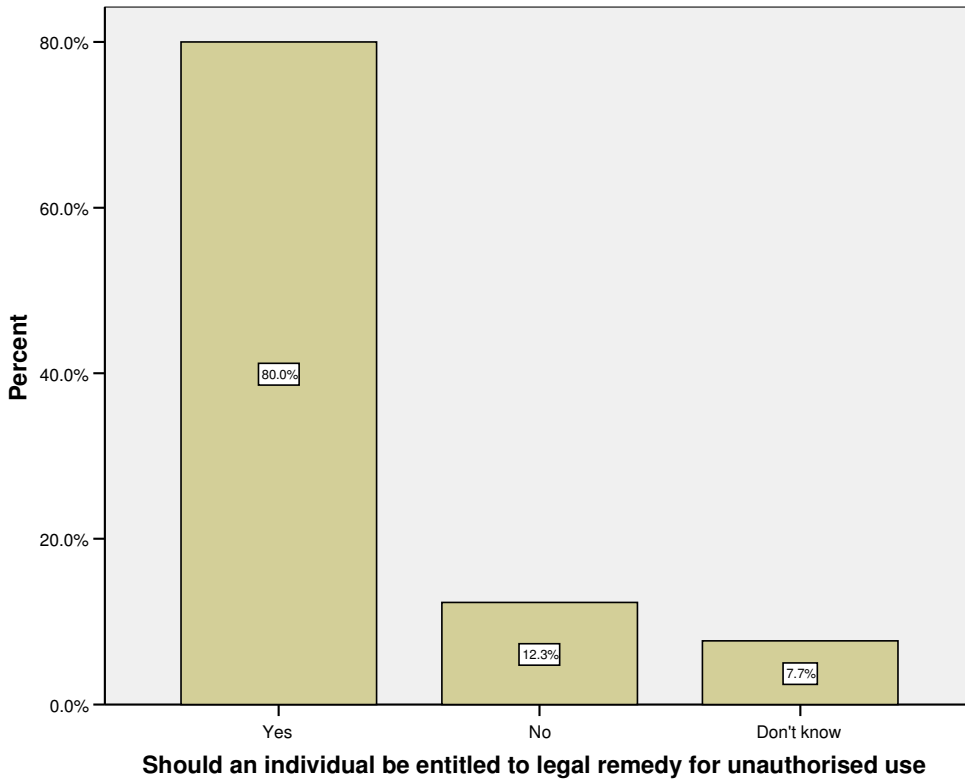


Should individual be able to waive right to stop use, and charge a fee

Graph 6

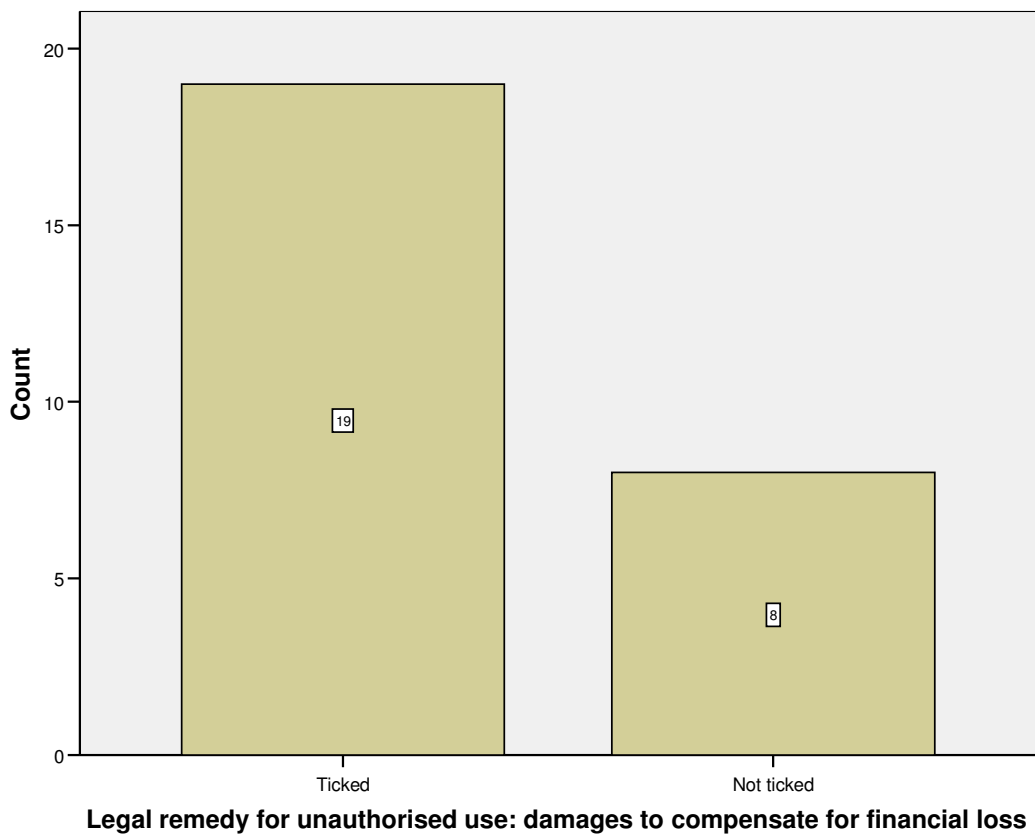
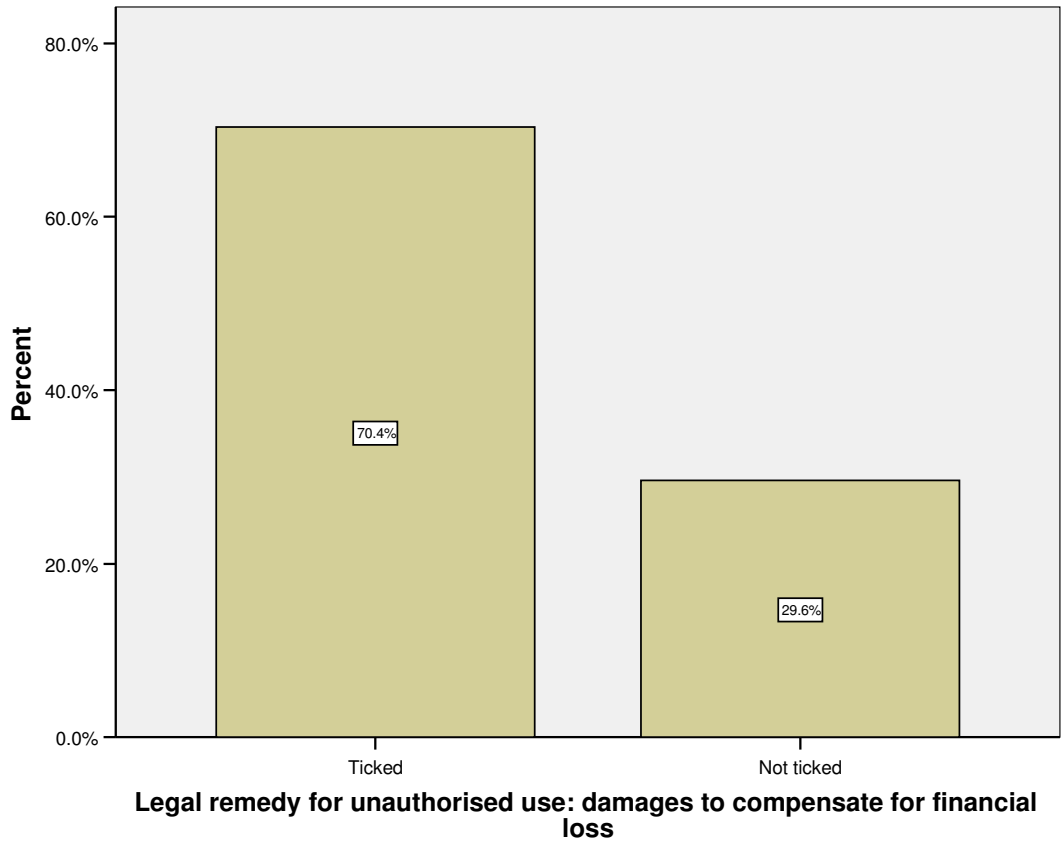


Graph 7

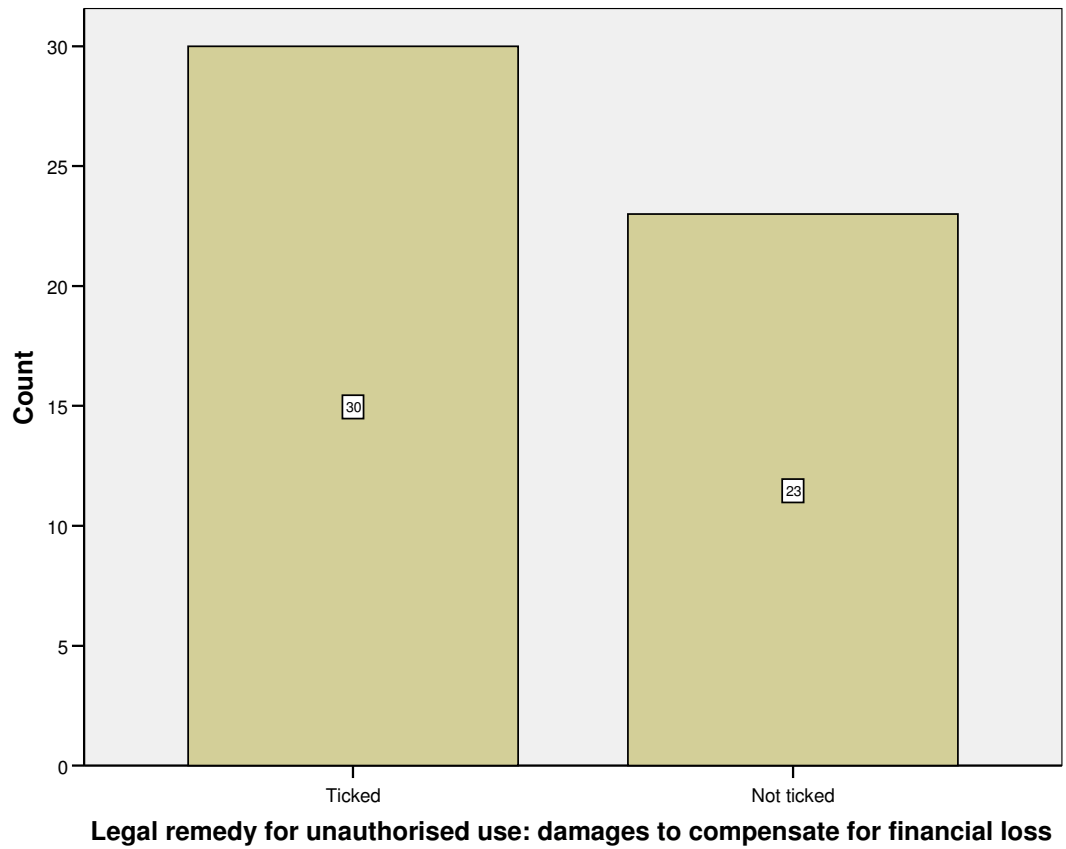




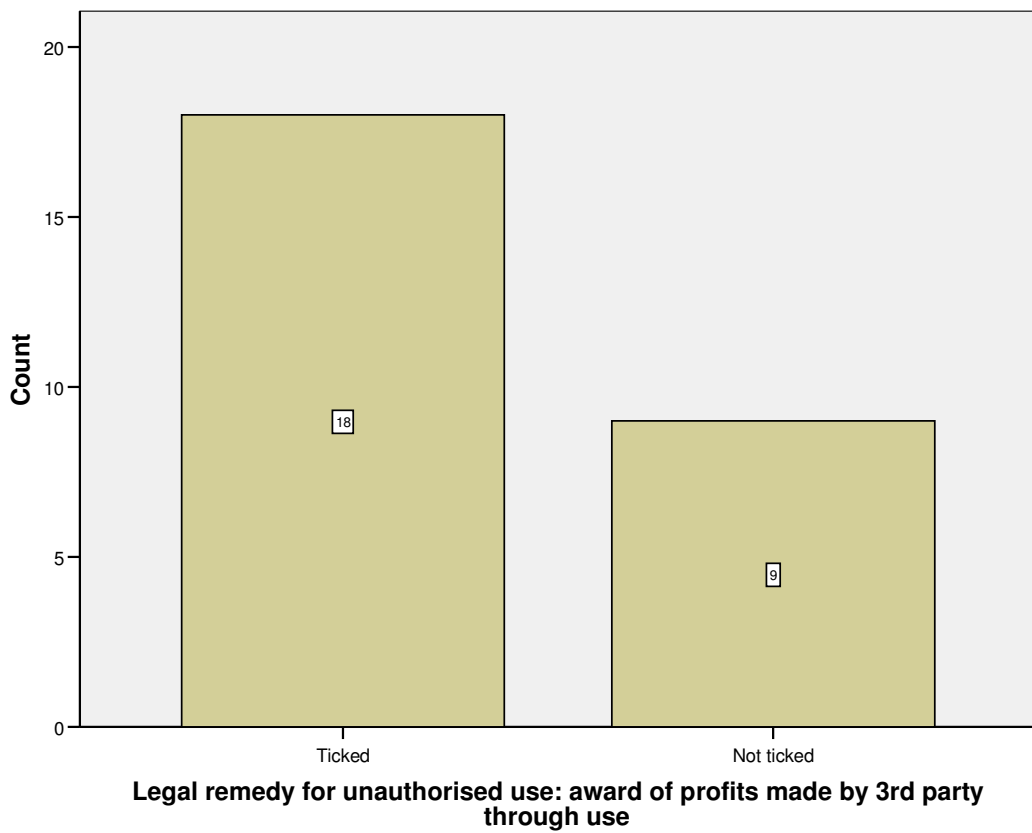
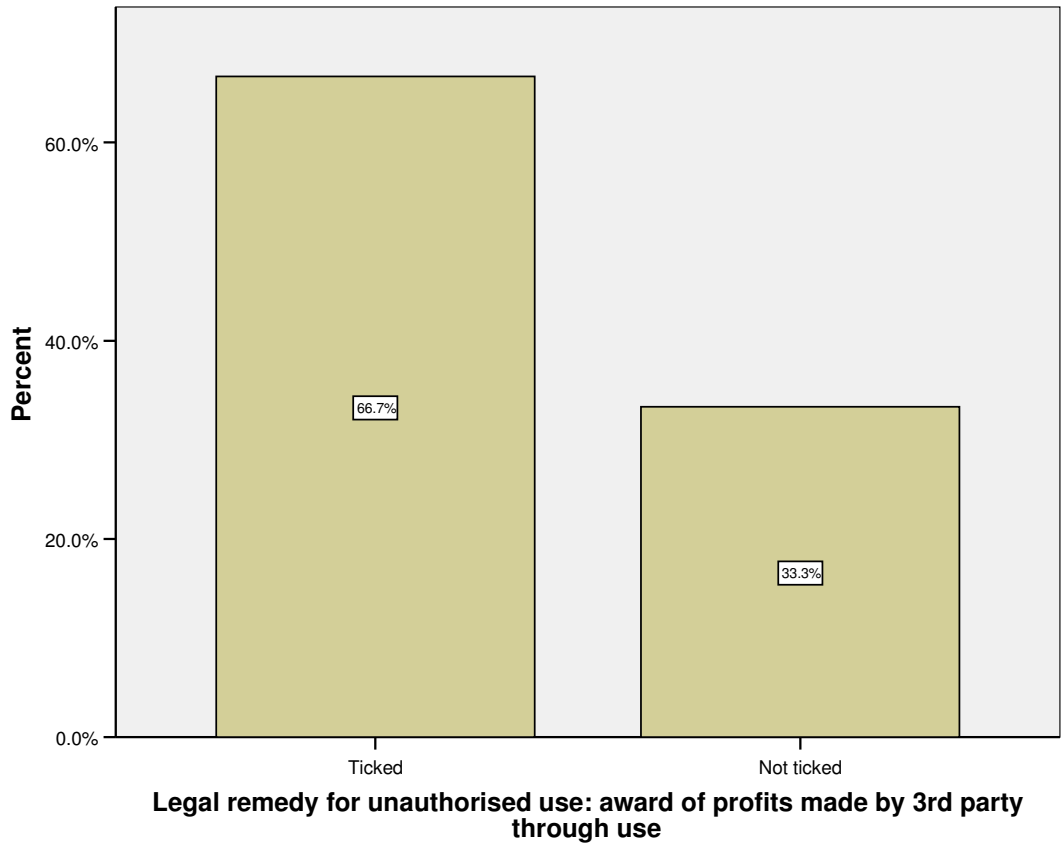
**Graph 8**



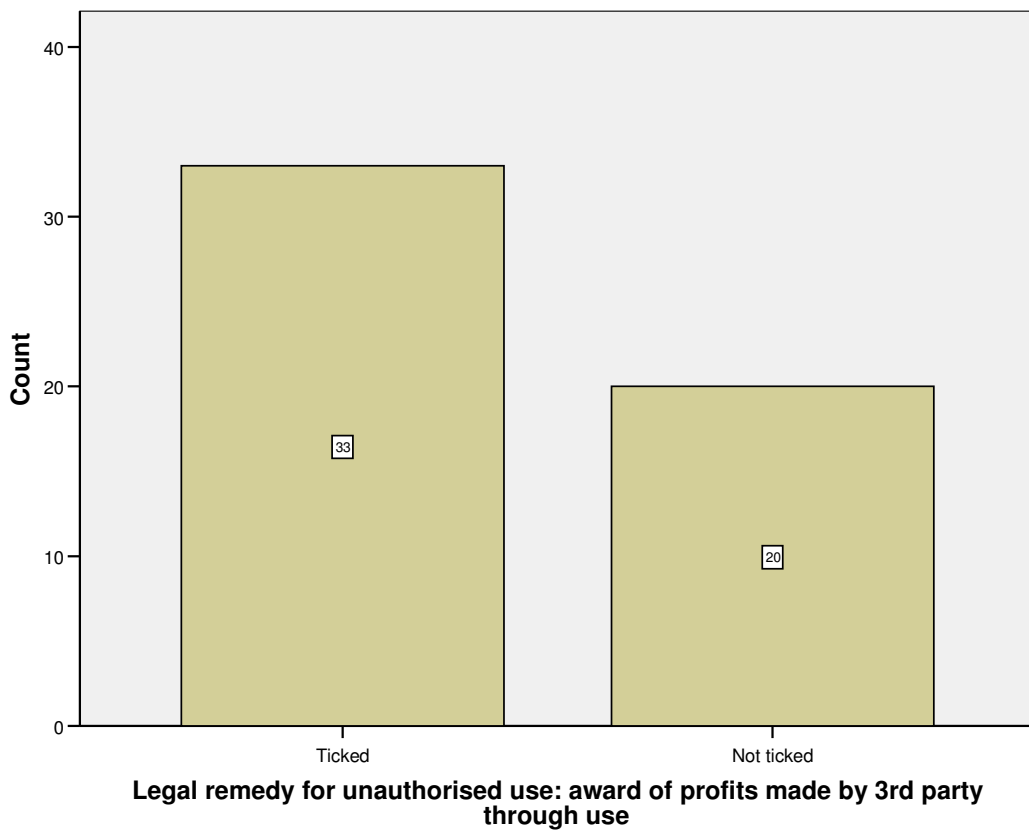
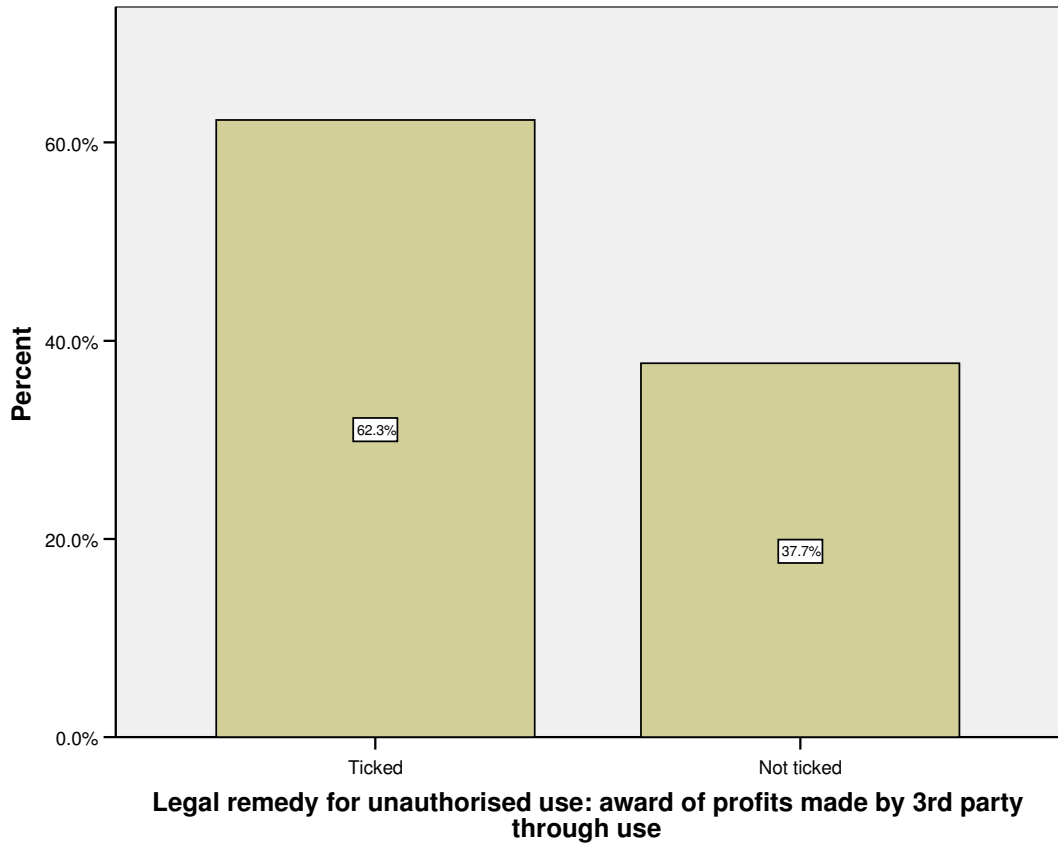
Graph 9



Graph 10



Graph 11



## APPENDIX C

FOUR GOLD MEDALS.  
*Appointed Purveyors to the Sovereign in 1825.*

# MACLEANS' REVALENTA FOOD

*Is the Best Strength-giving,  
and, at the same time,  
The most easily digested Food for  
Children and Invalids,  
and especially for Dyspeptics.*

Photo of Miss SHAW, nourished to complete health on MACLEANS' REVALENTA FOOD, although suffering from intense weakness of digestive organs.

"PICTURE OF HEALTH."

**REVALENTA** is FIVE TIMES as nourishing as Cow's Milk, and compared with Liebig's Extract of Meat, it is nearly SIX TIMES as nourishing and digestible for Infants, Invalids, and Convalescents.

**TO BE OBTAINED OF ALL CHEMISTS  
AND ITALIAN WAREHOUSEMEN.**

The text above the photograph of Miss Shaw (a "Picture of Health") reads: "Photo of Miss SHAW, nourished to complete health on MACLEANS' REVALENTA FOOD, although suffering from intense weakness of digestive organs."

Photograph © Callum Black, September 2008

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