THE RIGHT OF PUBLICITY: A COMPARATIVE PERSPECTIVE

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I. INTRODUCTION

What do Martha Stewart, the impresario of good living, Tiger Woods, a dominate sports figure of our time, and Paul Newman, the film actor and owner of a line of food products, have in common? The answer is that these celebrities enjoy powerful rights in their public persona. The identity rights of celebrities include their names, faces, voices, and practically any other distinguishing characteristic. This phenomenon is not new. In U.S. law, celebrities have enjoyed strong property rights in their persona under a number of legal bases such as federal trademark law, federal unfair competition law, dilution law, state trademark and unfair competition, not to mention perhaps the most powerful basis of all—state right of publicity law. This multifaceted protection has created a synergetic effect, resulting in an uninhibited and seemingly unlimited property right of celebrities in their persona. On the whole, the law in the United States has been particularly solicitous in the protection of celebrities.

Who should reap the benefits of celebrity images and how rights should be allocated in their use is more than of passing curiosity. Certain recent tendencies in the law, both in the United States and abroad, that create ever more expansive protections for identity interests are a troubling development for many.[1] Celebrity images, such as those mentioned above, have entered into the common lexicon, permeating the public discourse imbued with an enduring and ever evolving symbolic meaning. Celebrities as public figures are an integral part of democratic dialog and the iconic significance

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[1] *See, e.g.*, Rochelle Cooper Dreyfuss, *We are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 156 (1996).

of Elvis Presley, Marilyn Monroe, and Brigitte Bardot transcend their fame as entertainers. As professor Dreyfuss has stated: "They are amusing. They set moods and communicate status. They represent how their utilizers see themselves (or wish to have themselves seen) politically and culturally."[2] Thus, I believe, as do many others, that the law must balance the celebrity's interest in controlling their image with the public's interest in using those images as a means of communication.

Unlike the United States, which has embraced a very far reaching right protecting personas, other countries in the common law world are only beginning to entertain such protection. For example, plaintiffs in the U.K. have, until recently, been unsuccessful in attempting to persuade the courts that unauthorized commercial exploitation of personality can come within the tort of passing off; that is, liability based on a misrepresentation leading to public confusion that damages plaintiff's business goodwill.[3] The British situation is of particular interest because it represents one instance of a developed country resisting the inexorable creation of new and expansive intellectual property rights, at least in this one domain.

Is the lack of specific protection for celebrity personas an anachronism in today's world given the enormous economic stakes in merchandising famous identities? Celebrity markets transcend national boundaries, and it is perhaps no coincidence that both common law and civil law countries are reassessing the issue, resulting in initial steps toward some kind of international norm on the issue of "publicity rights."[4] But what should that norm be? Is a legal doctrine that accepts human identity as a commodity warranted or desirable?

Countries, such as the U.K., whose laws are in flux, naturally look to the United States's laws whose experience with full-fledged publicity protection began over fifty years ago.[5] In the United States, the right of publicity is now found in most states either by statute or by common law interpretation, and it is based on a

[2] *See id.* at 124.

[3] Catherine Seville, *Peter Pan's Rights: "To Die Will Be an Awfully Big Adventure,"* 51 J. COPYRIGHT SOC'Y U.S.A. 1, 12–13, 29 (2003).

[4] Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469, 494–95 (2000).

[5] Two articles establishing the extent of the right are Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204–10 (1954) (arguing for a separate right divorced from privacy law) and William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 406 (1960) (basing the protection of purely commercial interests on "not so much a mental [interest] as a proprietary one").

copyright like-moral rights model.[6] U.S. publicity law, with its ever expanding contours and, in my opinion, lack of sound theoretical justification, has been the object of much controversy and scholarly criticism.[7] The purpose of my article is to revisit the justifications for the right of publicity and to do so in comparative context with a particular emphasis on developments in the United Kingdom. If British lawmakers asked my advice (which they certainly will not), I would tell them that protection of celebrity personas is well administered by current law—particularly that of unfair competition. Sometimes doing nothing is the best approach to law-making in the domain of intellectual property.

The following discussion traces the development of this ever expanding right and the incoherency that comes from applying quasi-copyright law protection to the personas of celebrities. In short, my position is this: U.S. law concerning the right of publicity is based on dubious and incoherent principles and has led to thorny practical problems of application. As suggested above, it is overly broad, and vaguely contoured. My overall conclusion is that identity interests are better tailored to an action for false endorsement based on trademark concepts of consumer confusion. Actions for false endorsement, based on section 43(a) of the Lanham Act,[8] have been a part of U.S. law for some time now and similar doctrines are beginning to develop in the U.K. as well.[9] Before I turn to the British situation, I will review the growth of the right of publicity (albeit with a jaundiced eye) as it stands in the United States.

II. UNITED STATES AND THE RIGHT OF PUBLICITY

A. The New Right

The "right of publicity" was first adopted in 1953, by Judge Frank, in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*[10] with

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[6] The leading treatise on the subject is 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 2:1–:2, 6:3, 6:8 (2d ed. West Group 2003) (1937) [hereinafter MCCARTHY].

[7] *See, e.g.*, Prosser, supra note 5, at 389 (noting that "[t]he law of privacy comprises four distinct kinds of invasion of four different interests of the plaintiff" and because of the different rules which correspond to each interest, confusion may follow)

[8] Lanham Act, 15 U.S.C § 1125(a) (2000).

[9] Carrie Rainen, *The Right of Publicity in the United States and the United Kingdom*, 12 NEW ENG. J. INT'L & COMP. L. 197, 214–22 (2005).

[10] 202 F.2d 866 (2d Cir. 1953) (concerning the use of baseball player images on cards).

brief explanation of it as an economic, not a personal right:

> We think that, in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph . . . [and] to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross' . . . .
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> This right might be called a 'right of publicity.'[11]

In *Haelen*, the right of publicity issue arose almost by accident because the case was brought as an intentional interference with contractual relations case.[12] The decision does not specify the theoretical basis for the new publicity right or why a right of publicity was necessary at all.[13] Judge Frank could have opted for a broadening of federal unfair competition law, an approach that could have achieved the same result. Instead, he fashioned what is easily characterized as a de facto property right in personality, and one that was not constrained by the limits of privacy rights claims. From the opinion, Judge Frank did not wish to establish a right having all the attributes of property but was only interested in establishing an assignable right.[14] Despite Judge Frank's functionalist approach to a practical problem, the right of publicity soon became a formalized property right, eventually acquiring all the attributes of property, including the transferability of the rights via legacy though will or intestacy.[15]

Since *Haelan*, the right of publicity has taken hold in dramatic fashion, and is now recognized by statute or common law in a majority of states.[16] In its various forms, the right of publicity has materialized into a virtually unlimited, descendible, and assignable property right. The subject matter of the right and its transferability vary significantly among the states.[17] From time to

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[11] *Id.* at 868.

[12] *Id.* at 867.

[13] *Id.* at 868.

[14] *Id.* ("Whether it be labeled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth.").

[15] *See, e.g.*, Robert C. Post, *Rereading Warren and Brandeis: Privacy, Property, and Appropriation*, 41 CASE W. RES. L. REV. 647, 667–68 (1991).

[16] *Cf.* Barabara A. Solomon, *Can the Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper Substitute for a Federal Right of Publicity,* 94 TRADEMARK REP. 1202, 1202 (2004) ("While the majority of U.S. states recognize a statutory or common law right of publicity to protect against the appropriation of one's likeness for commercial purposes, the laws provide, at best, patchwork relief.").

[17] *Id.* at 1202–03.

time, attention has turned to some form of harmonization of the right under a federal statute but nothing seems imminent at this moment.[18]

B. Ossification of Publicity Rights as Property

Categorization of the right of publicity as a pure property right has won the day but has lead to unexpected, perhaps even perverse, consequences. As David Westfall and David Landau have shown, the property analogy has been pushed to the limit, leading to thorny and even intractable problems of application in proceedings involving divorce and bankruptcy.[19] Once publicity rights are characterized as property, the "property syllogism" inevitably kicks in and it is hard not to fall into its inexorable logic. The deductive formula goes like this: if the right is transferable, it must be assignable. And if assignable, it must be *property,* and since it is property it must have attribute X (which is shared by all property). Thus, it should be descendible like all property and must be subject to apportionment in divorce and disposition in bankruptcy proceedings.

As mentioned above this ossification of publicity rights as property has stained traditional notions of property dispositions in settings such as bankruptcy and divorce proceedings. As for bankruptcy, absent a state exemption statute, publicity rights could be sold to the highest bidder to pay creditors. But what would creditors acquire? Could a trustee in bankruptcy force performance of services? Professors Jacoby and Zimmerman noted how the right of publicity, involuntarily transferred in a bankruptcy proceeding, could result in forced labor by requiring the celebrity to perform in advertisements and other commercial ventures.[20]

Divorce proceedings have also highlighted the problems that arise when publicity rights become an issue in marriage dissolution.[21]

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[18] *See* ABA SECTION OF INTELLECTUAL PROP. LAW, COMM. ON FED. TRADEMARK LEGISLATION, ANNUAL REPORT, 2001–2002, PROPOSED FEDERAL RIGHT OF PUBLICITY ACT § 3, at 22–33, *available at* http://www.abanet.org/intelprop/annualreport06/content/01-02/COMMITTEE%20NO%20201.pdf; Solomon, *supra* note 16, at 1203; Therese Evans, A Call for a Federal Uniform Law on the Right of Publicity 24–27 (2006) (unpublished comment, on file with Brooklyn Law School).

[19] David Westfall & David Landau, *Publicity as Property Rights*, 23 CARDOZO ARTS & ENT. L.J. 71, 99–117 (2005).

[20] *See* Melissa B. Jacoby & Diane Leenheer Zimmerman, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right of Publicity*, 77 N.Y.U. L. REV. 1322, 1351 (2002).

[21] *See id.* at 1338–40; Westfall & Landau, *supra* note 19, at 99–112.

One issue that has plagued the courts is how to treat earning capacity developed during marriage in the context of marital property.[22] Another related set of problems which has divided the courts is whether a claim to alimony limits the obligor's freedom to choose a less remunerative occupation or retirement.[23] In general, the issues that have arisen in the divorce and bankruptcy contexts are a function of reification of publicity rights as property. The problems are also compounded by the increasing inclusiveness of indicia of identity that have become the subject matter of publicity rights.

C. The Expanding Right Includes Every Indicia of Identity

Since its appearance in U.S. law in 1953, the subject matter contours of the right of publicity have expanded to encompass not only name and likeness, but also anything that vaguely relates to identity. These include objects related to the celebrity's fame such as a racecar driver's car,[24] a football player's nickname,[25] and a catch phrase identified with a talk show host.[26] These examples are relatively banal compared to more creative extensions of identity which have encompassed a distinctive voice (Bette Midler),[27] the likeness of a television personality (Vanna White),[28] and a pitcher's stance (Don Newcombe)[29] to name a few instances. The case law is replete with other examples and we are sure to see the collection grow, nurtured by the unimpeded imagination of the courts and the intellectual property bar.[30] Why is there no break in the persistent march to incorporate more attributes of identity covered by the right of publicity? Again one must look to the relentless logic of the property syllogism: once identity is formalized as property, it is difficult to limit its boundaries.

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[22] Westfall & Landau, *supra* note 19, at 99–110.

[23] *Id.* at 110–12.

[24] Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 827 (9th Cir. 1974).

[25] Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129, 130 (Wis. 1979) ("Crazylegs" Elroy Hirsch, football star).

[26] Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 836 (6th Cir. 1983) ("Here's Johnny" Johnny Carson, television host).

[27] Midler v. Ford Motor Co., 849 F.2d 460, 461, 463–64 (9th Cir. 1988).

[28] White v. Samsung Elect. Am., Inc., 989 F.2d 1512, 1514 (9th Cir. 1993).

[29] Newcombe v. Adolf Coors Co., 157 F.3d 686, 692–93 (9th Cir. 1998).

[30] For an exhaustive list of persons and things protected under the right of publicity, see MCCARTHY, *supra* note 6, §§ 4:45–:87.

D. First Amendment Exemptions and Exceptions

As the right of publicity has increased in scope, those who have been sued for uses of celebrity identity have turned to the First Amendment as the *major* limitation to the right. Clearly, the right of publicity creates a tension with First Amendment values—namely, the preservation an uninhibited marketplace of ideas and the furtherance of the individual right of self expression. As one court phrased it, matters of public interest are "constitutionally protected and must supersede any private pecuniary considerations . . . even by those who urge more widespread recognition of a distinct property right of publicity."[31] But the courts, in trying to engraft exceptions to this expanding right, have created a disordered and incoherent body of First Amendment case law.

Various and sundry First Amendment balancing tests can be found in the case law, the most controversial of which pertain to the artistic use of celebrity images. Here, the problem is that the right of publicity has arisen in contexts that transcend the use of a celebrity image in contexts other than commercial advertising. Right of publicity cases that involve sculptures,[32] paintings,[33] photographs,[34] and t-shirt inscriptions[35] are hard cases and their resolution is less than satisfactory.[36] Most would acknowledge that the right of publicity needs to be reigned in when it burdens free expression, but no one convenient legal format has been found to set those limits. The multiplicity and vagueness of these legal tests reveal their emptiness. For example, one such test would ask whether the proprietary interests of the owner of the right of

[31] Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501, 508–09 (Sup. Ct. Spec. Term 1968).

[32] *See* Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 703 (Ga. 1982) ("[T]he appropriation of another's name and likeness, whether such likeness be a photograph or sculpture, without consent and for the financial gain of the appropriator is a tort . . . .").

[33] Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 809 n.11 (Cal. 2001).

[34] *Cf.* Cabaniss v. Hipsley, 151 S.E.2d 496, 503 (Ga. Ct. App. 1966) (finding that falsely picturing the plaintiff entering an Atlanta club was insufficient to authorize a verdict for general damages).

[35] *Comedy III Prods.*, 21 P.3d at 799, 800–01, 811 (applying the right of publicity to t-shirt likenesses of the Three Stooges).

[36] *See, e.g.*, Ayres v. City of Chicago, 125 F.3d 1010, 1017 (7th Cir. 1997) (granting a preliminary injunction preventing Chicago from enforcing a prohibition on street peddling because such a prohibition violated free speech).

publicity outweigh the value of free expression.[37] Another, borrowed from copyright law, is known as the transformative use test and would ask whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness.[38] The fact is that no judicial consensus has been reached on the contours of the First Amendment vis-à-vis the right of publicity.

Reconciling the right of publicity with the First Amendment is a murky process, not to mention the lack of certainty for those asserting their First Amendment rights. At the same time, it requires courts to make ill-considered aesthetic judgments about artistic value. By contrast, trademark law reduces these speech concerns while protecting celebrity good will by limiting itself to the use of commercial speech that is false or misleading. There are, of course, First Amendment issues that arise in the trademark context as well, but trademark law, at least, provides a body of law based on coherent principles, and it accommodates the tension between commercial and speech interests in a more direct fashion.

E. Theoretical Elusiveness

I have argued that the right of publicity was born out of expediency, and has evolved in an explosive if not haphazard manner, leaving it to the courts and commentators to provide a sound justification for the right.[39] The literature is voluminous and this varied grab-bag of normative theories justifying an all-inclusive right for the misappropriation of personas is uniformly unpersuasive. On review of the literature, I am more convinced than ever that whatever interests the publicity right serves, it is difficult to see how those interests cannot be supplied by the application of trademark law, unfair competition law, and the growing law of false endorsement under section 43(a) of the Lanham Act.[40]

I would like to concentrate on two instrumentalist justifications

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[37] Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 461 (Cal. 1979).

[38] *Comedy III Prods.*, 21 P.3d at 808.

[39] For two pioneering studies on the right of publicity see Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853 (1995); and Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VANDERBILT L. REV. 1199 (1986).

[40] 15 U.S.C. § 1125(a) (2000).

for the right of publicity. In doing so, I am omitting a discussion of the natural rights justifications for the right of publicity such as Lockean labor theory, unjust enrichment, and various concepts of human dignity which have been exhaustively analyzed in the literature.[41]

The first of these economic approaches could be characterized as the "incentive-based theory" and has been acknowledged by the courts and some commentators.[42] The incentive is based on justifications in support of copyright and patent.[43] In this perspective, a property right of publicity "is needed to encourage [the] investment in the development of a public persona,"[44] much as copyright law promotes investment in original expression or the patent monopoly encourages inventive activity. In short, the incentive theory posits that property rights in personas encourage individuals to expend more effort in achieving greater success in public endeavors such as music, acting, or athletics.[45] Of course, it is debatable whether the marginal incentive provided by a right to publicity really encourages a Tiger Woods to become a great golfer. It also is debatable whether those same incentives will have any positive effect on already wealthy celebrities to become more proficient at what they do. All this is speculation and not one shred of empirical evidence exists proving the incentive effect of publicity rights. At best, the right of publicity adds a small increment of protection beyond other claims brought under section 43(a) of the Lanham Act.[46]

Not everyone is persuaded by the incentive effect of publicity rights. The search continues for a more rational basis justifying publicity rights from an instrumental standpoint. In this regard, some scholars have opined that publicity rights efficiently allocate scarce resources.[47] The crux of this distributional efficiency

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[41] *See generally* Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1, 35–40 (1997). For a spirited critique of natural law justification of the right of publicity, see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 178–79 (1993).

[42] *See, e.g.*, Kwall, *supra* note 41, at 35.

[43] *Id.*

[44] Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn From Trademark Law*, 58 STAN. L. REV. 1161, 1186 (2006).

[45] *Id.* at 1186–87 (citing Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977) ("[The right of publicity] provides an economic incentive for him to make the investment required to produce a performance of interest to the public.")).

[46] 15 U.S.C. § 1125(a) (2000).

[47] *See, e.g.*, Jonathan Kahn, *Bringing Dignity Back to Light: Publicity Rights and the Eclipse of the Tort of Appropriation of Identity*, 17 CARDOZO ARTS & ENT. L.J. 213, 245–46

justification is that overexposure dissipates wealth embodied in the creation of identity. In other words, unless we provide exclusive rights over celebrity personas, its value will become exhausted through overexploitation. A variation on the "tragedy of the commons" justification for private property, this "face wear-out" argument asserts that a persona is a scarce resource, one that would be destroyed by overuse absent property protection. As Landes and Posner have stated: the rationale for providing strong publicity rights "is not to encourage greater investment in becoming a celebrity (the incremental encouragement would doubtless be minimal), but to prevent the premature exhaustion of the commercial value of the celebrity's name or likeness."[48] But is this true? It is arguable whether consumers lose their interest in a certain persona because of overexposure. But one finds too many counter examples. In many instances, overexploitation leads to even more fame and an increased value for the cultural icon whether a person or object like the Eiffel Tower.[49]

Even assuming that face wear-out can take place, this distributional efficiency argument fails to consider the "non-rivalrous" nature of information as a public good which cannot be depleted by overuse. Unlike land or personal property, celebrity images cannot be used up. Of course, the right of publicity reduces the use of celebrity images and raises their price, but it is unclear how consumer welfare is enhanced by suppressing the competition in the use of these images. It all comes down to how one thinks of the incentive effect encouraged by the right of publicity, which I believe is a dubious proposition. As Dogan and Lemley state: "We might have to accept such a market distortion if we thought that the control we granted over price would encourage new creation, as we believe in patent and copyright law, but there is no such justification for the right of publicity."[50]

(1999).

[48] WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 223 (2003) (citations omitted).

[49] *See generally* Justin Hughes, *"Recoding" Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 960–61 (1999).

[50] *See* Dogan & Lemley, *supra* note 44, at 1186.

III. THE PROTECTION OF PUBLICITY RIGHTS IN THE U.K.

A. Privacy and Publicity Rights

The protection of celebrity personas, under privacy or publicity rights, has hardly achieved the status of an international norm. Rights of publicity in European countries run the gamut, and no directive harmonizing such rights has been promulgated. For example, French law confers robust identity rights while Germany is less protective.[51] Nor is there any worldwide standard of publicity rights protection. In the European Community, no country has taken a more minimalist approach to the protection of both privacy and publicity than the U.K., providing a stark contrast with the United States.

The comparison between the U.K. and United States is dramatic. As compared with the United States, British law has taken a radically different path in protecting rights of identity and publicity. As for privacy rights, the U.K. has no statutory or common law tort of invasion of privacy analogous to that of the United States In fact, U.K. privacy rights had not been recognized in any manner until the incorporation into British law of the European Convention of Human Rights Act in 1998.[52] Engrafting the Human Rights Convention proved to be controversial and it took several years for British law to acknowledge its obligation under the Convention.[53] Recognition of the Convention, however, may well be a pivotal moment in the development of privacy and publicity rights in the U.K.

As for publicity rights, British law recognizes nothing resembling the right as it has been known in the United States for more than fifty years. Although publicity rights have been given no statutory or common law recognition, British law has protected aspects of one's identity and its commercial value in piecemeal fashion through traditional trademark law and passing off. [54]

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[51] For an overview see Eric H. Reiter, *Personality and Patrimony: Comparative Perspectives on the Right to One's Image*, 76 TUL. L. REV. 673, 681–94 (2002).

[52] *See* Lorna Brazell, Confidence, Privacy and Human Rights: English Law in the Twenty-First Century, E.I.P.R. 2005, 27(11), 405, 405–07.

[53] Campbell v. MGN Ltd., [2004] 2 A.C. 457, 465–66 (H.L.).

[54] *See, e.g.*, Reckitt & Colman Products Ltd. v. Borden Inc., [1990] 1 W.L.R. 491, 510 (H.L.) (defining a passing off action as an action to recover goodwill damaged by the misrepresentation of "passing off one person's goods as the goods of another").

B. Bringing British Law into the Merchandizing Age: The Eddie Irvine Case

Trademark law and the law of passing off has been the preferred method of protecting identity interests in the U.K. The usefulness of the passing off concept was for many years limited by the British courts, which required that the plaintiff and defendant be engaged in a common field of activity.[55] By comparison, the U.S. law of passing off is much more accommodating to merchandizing rights where the likelihood of confusion may be based on confusion of sponsorship, affiliation, or connection. The breakthrough case under British law occurred in 2002 in *Irvine v. Talksport Ltd*.[56]

Eddie Irvine, a well-known Formula One racing driver, sued Talksport Radio for the use of his image in the radio station's advertising brochure without obtaining his consent.[57] Talksport had sent promotional materials to persons and companies within the advertising industry.[58] The brochure contained an image of Irvine holding a radio bearing the Talksport name.[59] Talksport had taken a previous photo of Irvine holding a mobile phone and "doctored" the picture by superimposing the Talksport radio image in place of the phone.[60] Irvine argued that this amounted to false endorsement, a form of passing off.[61]

The court took "judicial notice of the fact that it is common for famous people to exploit their names and images by way of endorsement."[62] Judge Hugh Laddie held that there is nothing which prevents an action for passing off succeeding in a false endorsement case if the claimant proves two interrelated facts:[63]

> First, that at the time of the acts complained of he had a significant reputation or goodwill. Second, that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved

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[55] *See, e.g.*, Tavener Rutledge Ltd. v. Trexapalm Ltd., [1975] F.S.R. 479, 484 (Ch. D.) (requiring an "overlap in the fields of activity" of the plaintiff and defendant to secure a favorable judgment in a passing off action).

[56] [2002] 1 W.L.R. 2355 (Ch.D.).

[57] *Id.* at 2358–59.

[58] *Id.* at 2358.

[59] *Id.* at 2359.

[60] *Id.*

[61] *Id.*

[62] *Id.* at 2368.

[63] *Id.* at 2369.

of by the claimant.[64]

The court did not say that Irvine had a right to control the commercial use of his name or image. Mere "misappropriation" remains not actionable in the U.K. But the court thought that Irvine's case went beyond that. He had substantial goodwill in his name and image that he could protect against a false innuendo of endorsement. The radio station's promotion had falsely traded on his celebrity by suggesting he had endorsed their new product, and it had to pay for that lie. The case was upheld on appeal, resulting in a healthy damage recovery for Irvine.[65] The recovery was based on quantifying what would constitute a reasonable endorsement fee, defined as the fee which on a balance of probabilities Talksport would have had to pay in order to obtain "lawfully that which it did unlawfully."[66]

C. Privacy Rights and the European Convention on Human Rights

Privacy rights have finally crept there way into British law though the European Rights Convention. Some have questioned whether this is a backdoor way to the adoption of publicity rights similar to those found under the U.S. model. Privacy rights in a person's likeness have received increasing recognition both nationally and at the European level. The key legal justification for this change is Article 8(1) of the European Convention on Human Rights ("ECHR"), which provides a right to respect for a person's private and family life.[67] The U.K. courts, which have long refused to recognize any common law right to privacy, have looked to this provision to extend to celebrities the power to control when and how the media may publish their image and report on their private lives.[68]

These decisions do not suggest that the ECHR requires publicity rights to be recognized in member states. The ECHR has. However, been potent in expanding the notion of privacy for both ordinary people and also celebrities in a way that may go beyond U.S. notions of privacy. It now provides a basis by which courts may eventually

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[64] *Id.* at 2369–70.

[65] Irvine v. Talksport Ltd., [2003] 35 F.S.R. 619, 646 (Ch. App.).

[66] *Id.*

[67] Convention for the Protection of Human Rights and Fundamental Freedom, art. 8, Nov. 4, 1950, 213 U.N.T.S. 232, *available at* http://conventions.coe.int/treaty/en/Treaties/Html/005.htm.

[68] *See, e.g.*, Campbell v. MGN Ltd., [2004] 2 A.C. 457, 459–60 (H.L.).

extend standard principles of civil liability to encompass publicity rights. Those who use personalities in media advertising typically obtain consent from the people or estates involved. We may wonder how long it will take for law to gravitate toward recognition of publicity rights similar to the U.S. model. In sum, there have been major developments on the privacy front in the U.K. Equitable action for breach of confidence developed into action for misuse of private information, including semi-public photographs under the influence of the Human Rights Act of 1998 and the European Convention on Human Rights.[69]

Actions for breach of confidence have been extended to protect a celebrity's commercial interest in private information, including photographs of a private occasion, by treating it as analogous to a trade secret.[70] Michael Douglas and Catherine Zeta-Jones married amidst strident security precautions.[71] Douglas and Zeta-Jones granted *OK!* Magazine exclusive right to publish photographs of their wedding taken by their photographer and approved by them for £1 million after *Hello!* bid unsuccessfully for the same right.[72] Their wedding was infiltrated by a paparazzo photographer who surreptitiously took unauthorized photographs, six of which were published by *Hello!*[73] In their action against the magazine, a judgment was sustained for Douglas and Zeta-Jones.[74] The court held that the publication of photographs was a misuse of private information, justifying damages for distress, and was a misuse of commercially confidential information, justifying damages for injury to their commercial interests.[75] The judgment in favour of *OK!* was reversed.[76] Under the contract *OK!* had no right other than an exclusive license to publish the approved photographs.[77]

English courts have found a breach of confidence where the published information is deemed confidential—either based on the reasonable expectations of the person whose right was violated, or if the disclosing party had knowledge of the confidentiality of the information. Under the breach of confidence rationale, the House of

[69] *Id.*
[70] Douglas v. Hello! Ltd., [2005] 3 W.L.R. 881, 914 (Ch. App.).
[71] *Id.* at 891.
[72] *Id.* at 890.
[73] *Id.* at 891–92.
[74] *Id.* at 915–16.
[75] *Id.* at 913, 915–16.
[76] *Id.* at 918.
[77] *Id.*

Lords confirmed that a well-known model could get damages against the newspaper which published photographs of her leaving a drug rehabilitation center.[78] These photos were taken with a telephoto lens of model Naomi Campbell outside a drug rehabilitation center and the court found that the publisher knew or should have known that Campbell had a reasonable expectation that the information regarding her drug addiction and treatment would remain private even though she was on a public street.[79]

These developments parallel those at the European level, where the European Court of Human Rights in 2004 found that Germany had failed to vindicate the privacy rights of Princess Caroline of Monaco against newspapers that had printed paparazzi shots of her enjoying quiet moments with friends and going about her daily business in public by herself or with her children.[80] This material did not contribute to public debate on any matter of public interest and so was not justified under the media's right to freedom of expression.[81]

It has taken the English courts a long time to recognize the right of personality, but if they remain on the path recently paved in *Campbell* and *Douglas*, they are well on their way towards creating rights similar to those currently protected in Germany and France. German[82] and French[83] laws distinguish the private and the public spheres of the lives of celebrities. They protect their right to keep personal activities private, and provide remedies for the misappropriation of their name, image, and likeness for commercial gain.

IV. THE ACTION FOR FALSE ENDORSEMENT AS AN INTERNATIONAL NORM

Celebrity images transcend national boundaries. Famous golfers, basketball stars, and soccer players have international recognition. A coalescence toward an international norm that would protect the goodwill that celebrities have developed as to their fame would be a wholesome development for transnational commerce. The advantages of an international norm for the protection of

[78] *See* Campbell v. MGN Ltd., [2004] 2 A.C. 457, 490–93 (H.L.).
[79] *Id.* at 499.
[80] *See* Von Hannover v. Germany, [2005] 40 E.H.R.R. 1, 5–6, 29.
[81] *Id.* at 26–27.
[82] *See* MCCARTHY, *supra* note 6, § 6:152.
[83] *See* Reiter, *supra* note 51, at 681–86.

personality right based on false endorsement would be substantial. Protection would be anchored in commercial uses of a celebrity persona that mislead the public into believing that the celebrity endorsed a commercial product. An action for false endorsement serves the dual purpose of protecting the consumer against deception in the marketplace while safeguarding the goodwill and commercial value that celebrities have developed in their identities. It enjoys a firm theoretical basis. An action in false endorsement based on principles of unfair competition circumvents the practical problems emanating from the formal "propertization" of publicity rights and avoids the more cumbersome issues in applying free speech principles. The British court in the *Irvine* case got it right and its reasoning should be the current standard.

A section 43(a) suit for false endorsement is based on the unauthorized use a celebrity's identity,[84] which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product. False endorsement is a particularly effective cause of action for the use of a celebrity's image. The reason is that a celebrity's image, no matter how famous it may be, does not necessarily function as a trademark in the classic sense of that term. Although images of a person can function as a trademark (and can also be registered), not every image of a person functions as trademark. The trademark owner must prove that the mark distinguishes its goods from others to qualify as a trademark. In general, a person's image or likeness, per se, will not function as a trademark unless it is recognized as an indicator of origin. As one court observed, "[u]nder some circumstances, a photograph of a person may be a valid trademark—if, for example, a *particular* photograph was consistently used on *specific* goods."[85] Thus, Tiger Woods could not assert trademark rights over the use of his image in an artistic rendering of his image.[86] On the other hand, the court implied that trademark rights could be asserted if one particular image of Woods had been consistently used in the advertising and sale of goods or services for the purpose of identifying those goods and services.[87]

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[84] 15 U.S.C § 1125(a) (2000).

[85] Pirone v. Macmillan, Inc., 894 F.2d 579, 582–83 (2d Cir. 1990) (rejecting plaintiff claim for the use of Babe Ruth's likeness in three photographs) (emphasis added).

[86] *See* ETW Corp. v. Jireh Publ'g., Inc., 332 F.3d 915, 922 (6th Cir. 2003); *cf.* Estate of Presley v. Russen, 513 F. Supp. 1339, 1363–64 (D.N.J. 1981).

[87] *ETW*, 332 F.3d at 922 n.5.

The gist of a false endorsement claim is somewhat different than that under traditional trademark law. It operates as a mild expansion of traditional trademark law to accommodate the current marketing environment for celebrity images. It is based on the implication that the plaintiff somehow endorses a product or service even though the plaintiff has never engaged in that activity.[88] Thus, a plaintiff need not plead or prove competitive injury to succeed on such a claim. Also, standing to bring an action for false endorsement does not require actual competition in the traditional sense; it extends to a purported endorser who has an economic interest akin to that of a trademark holder in controlling the commercial exploitation of his or her identity. In short, a false endorsement cause of action recognizes the interest of a celebrity to prevent the wrongful use of his or her identity to promote a product with which he or she has no association.

V. CONCLUSION

I have maintained throughout that protection of celebrity identity should be based on a misrepresentation trademark model and an action for unfair competition rather than a misappropriation publicity model. The U.K. is at a crossroads in the protection of identity rights, but the trajectory of the case law is clearly tending toward greater rights. Time will tell whether the recent developments in privacy law in the U.K. will mutate into a de facto right of publicity. Unfortunately, the U.K. and other European countries, by enlarging the notion of privacy rights governed by the ECHR, may create a regime similar to the U.S. right of publicity. In the U.K., a trend toward recognition of publicity rights is already occurring through expansive notions of privacy based on a theory of breach of confidence. In my opinion, this would be a regrettable development and those adopting such a regime would suffer the same perverse consequences engendered by publicity rights in U.S. law.

With the Eddie Irvine case, British law has adopted the action for false endorsement derived from principles of passing off. The action for false endorsement could be the basis for an international norm for the protection of the identity interests of celebrities—a norm that would avoid the excesses and problems of a full property

[88] *Id.* at 925–26.

regime.