



To what extent are personality rights and the celebrity image protected in English law?

*A study of **Fenty v Arcadia Group Brands Ltd** [2015]*

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Introduction

In an age in which the celebrity image has become more valuable than ever, the argument for the widening in scope of its protection has increased in importance. Modern-day media empires are built on the reputation of celebrities and the products and brands they endorse. The benefits of celebrity endorsement are undeniable: Forbes (2016) indicates that “just one endorsement can spell an increase in sales by 4%, almost immediately” (Olenski, 2016). Through social media, many celebrities have been given a platform to cultivate their own brands and, in turn, develop their social status as ‘influencers’. This is particularly pertinent to the music industry when considering singers, bands and artists have long been recognised as influencers across wider fields than just their own. A 2013 report compiled by performing rights organisation PRS for Music found that the amount spent on music in the UK by brands exceeded £100m in the previous year (Mugan, 2015). This eye-watering figure, which has no doubt since increased, included anything from “festival sponsorship to syncing tunes for adverts” as well as an estimated £4.7 million for artist endorsement (Mugan, 2015). The fashion, beauty, media, motoring and technology industries have all, at times, relied upon the image of musicians to promote their products, goods and services. However, this concept, known as personality merchandising, is one that is recognised but not fully protected by the law. At present, there is no free-standing general right in English law to exclusive character or personality exploitation by a celebrity (Dolley-mores, 2017). In light of recent scandals across a number of industries, in particular Hollywood and the film industry (Silverman, 2017), it has arguably become imperative that the degree of legal protection for this right be broadened.

This essay will scrutinise the current legal position in regards to trademarks, personality merchandising and so-called ‘image rights’. In order to do this most effectively, it is essential that this essay examines the crucial case of *Fenty v Arcadia Group Brands Ltd* [2015]. After reviewing the facts of this case, this essay will attempt to reflect on the implications of the judges’ decisions on the wider industry. Lastly, the possibility of any future legal developments that may widen the scope of protection will be considered. This essay concludes by restating the belief that personality rights are inadequately protected in England and Wales, leaving musicians and other celebrities in an unfavourable position.

Personality Merchandising

Registered marks

The legal concept of personality merchandising falls under the umbrella of a common law doctrine known as 'passing off'. Whilst statute law requires trademarks to be registered, the doctrine of passing off is informally referred to as 'the law of unregistered marks'. Although the Trade Marks Act (TMA) 1994 (s. 2) distinctly expresses the fact that no such concept subsists, this doctrine is still commonly recognised by the courts of England and Wales. The TMA 1994 (s. 1) indicates that a registrable trade mark must have the capacity to be "represented graphically" in order to facilitate the distinction of "goods or services of one undertaking from those of other undertakings." A registrable mark may therefore consist of anything ranging from "words (including personal names), designs, letters, numerals or the shape of goods or their packaging" (1994, s. 1(1)). In relation to the commercial music sector, trademarks are therefore generally registered to protect the use of the name of an artist or band, their logo and their lyrics on merchandise. Most people are familiar with the range of t-shirts, hats and hoodies bearing the logos of bands from Metallica to AC/DC that fill the stores on our high-streets. However, whilst the doctrine of passing off extends this protection to branding and design features that would not fall within the confines of the legal requirements for registration, it does not safeguard the use of the celebrity image.

Requirements for a claim in passing off

In the landmark case of *Reckitt & Colman Products Ltd v Borden Inc. (No. 3)* [1990], often referred to as the 'Jif Lemon' case, Lord Oliver built upon the decisions in earlier cases such as *Reddaway v Banham* [1896] to outline the elemental requirements for a successful claim under the doctrine of passing off. This "Classical Trinity", as it has come to be known (Wadlow, 2011, p. 10), requires a claimant to show: (1) that he or she has business goodwill attached to the good or service, (2) that there has been a misrepresentation by the defendant "leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff" (1990, p. 880) and, (3) that there has been damage, or a significant possibility of damage, to his or her business goodwill as a result of the misrepresentation. With regards to musicians and artists, the damage caused to their business goodwill by a misrepresentation can often have long-lasting effects to both their reputation and, in turn,

their finances. As the contracts become more lucrative and the stakes become higher, the argument for an increased scope of protection has intensified. Whilst an independent legal right to the protection of a character was rejected in 1977 by the Whitford Committee on Copyright (Leopold, 1977, p. 686), recent court decisions have reopened the debate on whether the doctrine of passing off should be allowed to extend into personality merchandising or whether these 'image rights' should be given their own standing.

Fenty v Arcadia Group Brands Ltd [2015] EWCA Civ 3

Facts of the case (adapted from Butterworths Intellectual Property and Technology Cases, 2015)

The claimant, Fenty, better known as Rihanna (R), was a popular and highly-successful recording artist and performer. Aside from her career in music, R also ran her own product merchandising and endorsement business. Much, but not all, of the authorised merchandise was emblazoned with R's distinctive "R slash" logo in order to distinguish the goods from other products or services. The defendants, Arcadia Group Brands Ltd, were the owners and operators of the popular high-street retailer, Topshop (T). T began selling a t-shirt displaying an image of R. The image used was taken by a freelance photographer in Northern Ireland on the set of a video shoot for the single 'We Found Love' from R's forthcoming album. However, whilst the photographer had given licence to T to use the image on their product, similar images had been used in promotion of R's album. R, and her group of companies, then issued legal proceedings against T under the doctrine of passing off. Despite the fact that T had obtained a licence from the photographer to use the image, it was claimed that the use of her image in relation to fashion items was not licensed and that a vast number of people who purchased the t-shirt would assume it to be an endorsed product. In his decision, the judge considered R to be a 'style icon', in particular in relation to her fan base of young females aged 13 to 30. Their interest in R's sense of style meant that if she was pictured wearing or approving of an item, this would be deemed as an endorsement in their minds; a decision that allowed her goodwill to extend from artistry into the realm of fashion. A misrepresentation was therefore made by T as many of R's fans would purchase a product in the belief that it was an approved endorsement. As that meant the claimants' goodwill had been damaged, the claim was consequently allowed and an injunction was granted in their favour. However, T appealed on the grounds that the law of passing off does not protect a person's image and that the case should therefore have been decided upon the rules of contract and copyright law. The case was ultimately sent to the Court of Appeal.

How was the case decided?

The Court of Appeal (2015, EWCA Civ 3) upheld the High Court's decision. Lord Justice Kitchin (para. 11) agreed with the original judgement that determined goodwill to exist as R was a global star who was considered a "style leader" amongst her audience. Kitchin LJ also believed the misrepresentation to be enhanced by two past interactions between Rihanna and Topshop. The first of these was a competition in 2010 in which T offered entrants the chance to win a personal shopping appointment with R at their flagship Oxford Street store (para. 17). The second of these (para. 18) concerned a visit by R to T's flagship store shortly before the t-shirt was first made available. It was the judges' belief that T had "sought to take advantage of Rihanna's public position" (para. 19) by promoting the visit through their Twitter and social media feeds. Lastly, it was agreed that the damage caused "would result in a loss of sales to her merchandising business and also represent a loss of control over her reputation in the fashion sphere" (para. 23). Lord Justices' Richards and Underhill concurred, meaning that the appeal would be dismissed and this was considered to be passing off.

The effects of the ruling in *Fenty* on the wider industry

The decision in *Fenty* has undoubtedly aided the position of rights holders in cases concerning image rights. Whilst it is not ordinarily considered passing off to sell a t-shirt bearing the image of a famous person, the judges' arrived at their decision based on the merits of the case. In fact, as of 2018, Topshop still offers a range of t-shirts from artists and bands such as Judas Priest, Wham, Metallica, AC/DC, Johnny Cash and more (Topshop, 2018), albeit likely properly licensed. However, the status of these artists and bands as modern 'style leaders' is questionable to say the least.

Academics such as Fletcher and Mitchell (2015, p. 403) are of the opinion that the decision in *Fenty* represents "a glimmer of hope for image rights protection under English law." However, despite the clear importance of the decision, there is a belief that "it leaves as much unanswered as it does settled in relation to image rights protection in England" (Fletcher & Mitchell, 2015, p. 405). This view is shared by Trimmer (2015, p. 400), who states that the "close to the borderline" ruling leaves a confusing message: "there is no absolute right for celebrities to prevent the use of their image on goods—but there is also no positive right for a business to market goods bearing a celebrity's image." Others (Boyes, 2015, p. 81) are harsher in their conclusions and consider the "piecemeal nature" of image protection in English law to be unsatisfactory. Nevertheless, there is still optimism that image rights are edging ever closer towards full recognition in English law (Fletcher & Mitchell, 2015, p. 405).

The standard for a successful claim in passing off has generally been higher than that in a trademark dispute. Whereas the TMA 1994 (s. 56) provides the owner of a registered mark with the remedy of an injunction against an infringing party in the event of possible confusion, misrepresentation in the case of personality merchandising must have been the result of intentional deception (*Fenty*, para. 50). Whilst deception was found in *Fenty* as a result of their previous dealings together, other instances, both in the UK and overseas, would prove more difficult to establish (Nevins, 2017; Perot, 2016). It is therefore put forward that whilst the courts have resolved to extend image protection for musicians and other celebrities, there has been insufficient statutory action to provide adequate coverage in the modern era.

Future implications

Trademarks

The European Trade Marks Directive (2015/2436) has laid out amendments that will perhaps widen the narrow range of requirements for the registration of a mark. As opposed to the current requirement for graphical representation, future registrable marks may be “represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect” (2015/2436, note 13). The Directive also newly facilitates the registration of signs as both sounds or colours (2015/2436, Article 3); a distinction that is especially relevant with regards to the music business. However, it must be noted that this Directive has yet to be transposed into English law. This position is made further unclear when considering the UK’s impending divorce from the European Union and the laws that it imposes.

Personality rights

In the year of her successful claim, Forbes reported Rihanna’s earnings to be an estimated US\$26 million (O'Malley Greenburg, 2015). Therefore, with regards to the doctrine of passing off, the economic perspective cannot be ignored. It should, however, be highlighted that the courts have traditionally been cautious in their approach towards free market intervention. In his judgment in the case of *Erven Warnink BV v J. Townend & Sons (Hull) Ltd* [1979], Lord Diplock took the view that passing off was not always a viable route towards legal protection and that it was the “policy of the common law not to run the risk of hampering competition” (1979 2 All ER 927, p. 934). The growing importance of social media and artists’ status as ‘influencers’ is also pertinent. Recent studies (Paul & Bhakar, 2017) reinforce the understanding that celebrity endorsements serve to “improve credibility of the advertisements as well as consumer attitudes towards advertisements.” In an era in which the image of artists and bands are used more than ever before to promote products and services, one can be left mystified that there has not been further statutory intervention to properly enshrine these rights into law. It can therefore be stated that despite recent efforts to widen the scope of image rights, there is presently insufficient protection for the image of the modern-day artist and celebrity. It remains to be seen whether this will change as time passes.

Summary

The music industry has grown to become one of the most vital aspects of the economy. As a result, brands have sought to capitalise on artists' engagement with their audiences by utilising their services to promote products. However, alignment with problematic brands and products can have long-lasting economic effects on the reputation of artists and celebrities. It is therefore essential that the law moves to protect these rights.

The courts have become increasingly flexible in their application of the doctrine of passing off in order to provide adequate protection for personality rights in English law. The recent ruling in the case of *Fenty v Arcadia* indicates a shift in the courts' previous reluctance to interfere in economic matters. However, as the requirement for further protection heightens, so too does the scrutiny placed upon those in power to act accordingly.

Lastly, the implications of the decision in *Fenty* are far-reaching. The status of much of the law in the UK will be cast in to doubt come March 2019. Thus, with the influence of artists and bands steadily growing amongst their fan bases, it is crucial that the concept of image rights and their protection be enshrined in law before significant economic damage is caused.

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