

Protecting Publicity Rights by Claiming Passing Off

A recent decision of U.K Chancery Division allowed an action by Rihanna relating to a claim of false endorsement resulting from the sale of a garment bearing an image of her.

The Facts

Rihanna is a world famous pop star with a cool, edgy image. The evidence showed that she is a style icon and trend setter with a core following of women from their teens to their thirties. It was also shown that Rihanna and those associated with her go to great lengths to seek to control her image. Rihanna was working hard to identify herself as a serious fashion designer and items such as the t-shirt in issue did not support that goal.

Through her companies she runs a very large merchandising and endorsement operation. She has or has had endorsement agreements with NIKE, GILLETTE, CLINIQUE and LG MOBILE. Her merchandising business was managed by an independent company called Live Nation. Live Nation paid a significant sum for the right to sell Rihanna merchandise, including clothing.

The defendant was a major reputable high street retailer. The defendant purchased the garments in issue from a major clothing design and manufacturing company.

The t-shirt featured a large image of Rihanna. Customers bought it because they liked the product and the image for their own qualities. There was at the time a trend for image t-shirts. There is nothing on the t-shirt which represented it is an item of official Rihanna merchandise. It was a high quality fashion garment, a “boyfriend style tank” (i.e. an oversized sleeveless t-shirt). The image has been printed using sublimation rather than screen printing, an expensive process which enhances its high quality nature. This was very different from standard pop star merchandise. Nothing on the swing tag or other labelling makes any suggestion it is a Rihanna authorised garment.

A representative of the design and manufacturing company explained how image licensing works from his point of view and mentioned his company’s relationships with major licensors such as Walt Disney, Warner Bros, Lucas Films and David Bowie. He distinguished between artist authorised products and “third party images”. Artist authorised products include those sold pursuant to arrangements with the major licensors referred to. In these cases the use of the image has been authorised by the person (assuming it is a person) who appears in the picture. Third party images are images placed on garments for which a copyright licence has been obtained from an independent “third party” photographer but no licence from the person depicted.

Passing Off

Unlike Canada and the United States in England there is no free standing general right of a famous person (or anyone else) to control the reproduction of their image. A celebrity may control the distribution of particular images in which they own the copyright but that right is specific to the particular photographs in question.

Merchandising rights can be controlled through the law of passing off. To establish passing off three things had to be proved by Rihanna. She must show that she has goodwill and reputation amongst relevant members of the public; the conduct complained of must be shown to make a misrepresentation, i.e. to be likely to mislead those members of the public into buying the product because they think it is authorised by her; and that misrepresentation must cause damage to her goodwill.

The judge found that the plaintiff had shown ample goodwill at the time of the trial to succeed in a passing off action of the kind presented. The scope of her goodwill was not only as a music artist but also in the world of fashion as a style leader.

The judge said the relevant public are not fools. They have thoughts and views of their own and do not simply react in a Pavlovian, unthinking, fashion to whatever was presented to them. They are well aware of authorised merchandising by music artists and are well aware of the idea that a celebrity such as a musician might seek to engage in endorsement and merchandising activity in the clothing market. However the public do not always want to buy artist authorised products. In some cases they may want to buy a t-shirt with a picture on it because they like the look of it. These t-shirts fall within the third party image category.

The judge concluded that while a good number of purchasers bought the t-shirt without giving the question of authorisation any thought at all, a substantial portion of those considering the product were induced to think it is a garment authorised by the artist. For those persons the idea that it is authorised will be part of what motivates them to buy the product. Many will buy a product because they think she has approved of it. Others wish to buy it because of the value of the perceived authorisation itself. In both cases they have been misled.

The fact that a substantial number of purchasers are likely to be misled into buying the t-shirt because of a false belief that it has been authorised by Rihanna herself, damaged the plaintiff's goodwill. It resulted in sales lost to her merchandising business. It also caused a loss of control over her reputation in the fashion sphere.

Comment

When it is necessary to seek to protect the right of publicity a claim of passing off can add another string to the bow.