

**Court of Appeal found no love for Topshop tank:
the image right that dare not speak its name**

Susan Fletcher

Senior Lecturer in Law, University of Central Lancashire

Justine Mitchell

Associate Lecturer in Law, University of Central Lancashire

Subject: Passing Off. **Other related subjects:** Torts. Image rights. Personality rights. Publicity rights. Passing off. Trade connections. Intellectual property.

Keywords: passing off, image rights, personality rights, publicity rights, trade marks, goodwill, misrepresentation, merchandising, endorsements, English law, comparative law, unfair competition, freeriding, unjust enrichment, dilution, monopoly, social media, photograph, Rihanna, Topshop, Fenty, Arcadia

Abstract: This article contains an analysis of the first instance and appeal decisions of the “Rihanna case”. In particular, the authors consider the substantive law of passing off in the context of the unauthorised use of a celebrity's image on a Topshop tank vest top. This is followed by a discussion of the consequences of the case for celebrities, consumers and stakeholders in the entertainment and fashion industries.

*Every time you see me it's a different colour, a different shape, a different style.
....because it really...I/we just go off of instinct. Whatever we feel that very moment,
we just go for it. Creatively, fashion is another world for me to get my creativity
out.¹²*

¹Rihanna quote from the *Talk That Talk* music video available at www.youtube.com/watch?v=cVTKxwO2UnU

² All websites accessed and correct as at 13 February 2015.

Introduction

Just as Rihanna says she uses fashion as an outlet for her creativity, the tricky field of "image rights" provides ample opportunity for lawyers to demonstrate their own resourcefulness, especially in England where there is no *sui generis* law against unauthorised exploitation. The term "image rights"³ is used by the authors to refer to control over the exploitation of identifiable attributes of real people.⁴ Absent specific image rights legislation, lawyers working in branding and reputation management must pick through a jacket of statutory and common law pockets of law in an attempt to achieve some measure of protection for their, often famous, clientele.

In this article, the authors will consider the latest image-type case in which the global pop star and fashionista known as "Rihanna" sued high street retailer, "Topshop", for selling tank vest tops⁵ depicting her face without her permission. After examining the first instance⁶ and appeal⁷ decisions, we will consider their influence in the wider context of image rights protection. We will also look at the practical consequences of the case for celebrities, consumers and other stakeholders in the entertainment and fashion industries.

Background

The notion of protecting a person's image from unauthorised exploitation in this country is not a new one. It could be said to date back to the early confidence case won by Prince

³ Also known as "personality rights"

⁴ Attributes include: name, image, voice, signature, mannerisms and other unique characteristics. The courts tend to view fictional characters in a different way: *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch); [2002] 1 WLR 2355 (Laddie J) [9]

⁵ Hereinafter "vest"

⁶ *Fenty & Ors v Arcadia Group Brands Ltd (t/a Topshop) & Anor* [2013] EWHC 2310 (Ch); [2013] WLR(D) 310

⁷ *Fenty & Ors v Arcadia Group Brands Ltd & Anor* [2015] EWCA Civ 3

Albert who was concerned to protect an etching of the Royal family from unsanctioned distribution.⁸

However, the subsequent development of image rights *per se* has been stunningly slow in this jurisdiction compared to other countries such as the United States, France and Germany. Very close to home, the first image registration system was launched in Guernsey in 2012.⁹ In relation to the “image”, you can register ‘the real you’ (the ‘personnage’) or ‘the public perception of you’ (the ‘personality’).¹⁰¹¹ The extent of image protection under this Ordinance is not limited to a particular image,¹² although the precise scope of protection and effectiveness of enforcement outside the Bailiwick has not yet been tested in the courts.

Such discrepancies in legal protection amongst different jurisdictions tend to operate as barriers to international trade, especially in the world of entertainment, including sport. As Tugendhat QC explains, ‘[w]hen sporting celebrities moved to the UK, to play for English teams, they expected the same legal protection for their valuable images, and the same income from endorsements.’¹³

⁸*Prince Albert v Strange* (1849) 18 LJ Ch 120, 41 ER 1171; see also: *Pollard v Photographic* (1888) 40 Ch D 345

⁹The Image Rights (Bailiwick of Guernsey) Ordinance, 2012. “Image” is defined in section 3 as-

(a) the name of a personage or any other name by which a personage is known,

(b) the voice, signature, likeness, appearance, silhouette, feature, face, expressions (verbal or facial), gestures, mannerisms, and any other distinctive characteristic or personal attribute of a personage, or

(c) any photograph, illustration, image, picture, moving image or electronic or other representation (“picture”) of a personage and of no other person, except to the extent that the other person is not identified or singled out in or in connection with the use of the picture.

¹⁰Personnage and Personality Explained, Intellectual Property Office - Guernsey Registry, 2012 available at <http://ipo.guernseyregistry.com/CHttpHandler.ashx?id=79059&p=0>

¹¹There are currently 52 registrations which include artificial entities as well as natural persons such as professional tennis player and native Guernesian, Heather Watson, Intellectual Property Office - Guernsey Register at www.guernseyregistry.com/ipo. “Rihanna” is not yet registered under the Guernesian image rights system.

¹²Unlike registered trade marks.

¹³Michael Tugendhat QC [as he was then], ‘Exploitation of Image Rights in the UK’ 29.01.03 available at <http://fbls.eu/wp-content/uploads/2013/03/2002-Exploitation-of-Image-Rights-in-the-UK-by-Michael-Tugendhat-QC.pdf>, 3

In both common and civil law jurisdictions, the unauthorised appropriation of image has generally been approached from two perspectives: (1) unfair competition/intellectual property and (2) human rights, especially privacy.¹⁴ The English case of *Douglas*,¹⁵ concerning the unauthorised publication of wedding photographs, provides an interesting hybrid. Both perspectives are applicable due to the rather different interests of and harm suffered by the claimants: the privacy of the claimant couple and the commercial information purchased from them by the claimant magazine. It was also apparent, from the arguments raised by the defendants in this case, that concepts of human dignity and commercial interests make uneasy bedfellows. This is also evident in the confidence/privacy case, *Terry* (previously “LNS”) *v Persons Unknown*,¹⁶ which concerned an application for an interim injunction to restrain the publication of information relating to a personal relationship of the then English football captain. Tugendhat J dismissed the application, partly on the basis that ‘the nub’¹⁷ of the applicant’s complaint was damage to his commercial reputation rather than safeguarding his privacy.

Privacy and commercial exploitation have been reconciled in over half the states of the US which recognise a well-developed, *suigeneris* “publicity right”. This is defined as ‘the inherent right of every human being to control the commercial use of his or her identity’.¹⁸ According to Thomas McCarthy, the publicity right was ‘carved out of the general right of privacy[...] like Eve from Adam’s rib.’¹⁹ In fact, the true genesis of the right involved years of legal wrangling,²⁰ not unlike what we are witnessing in England over half a century later.

¹⁴Huw Beverley-Smith et al, *Privacy, Property and Personality, Civil Law Perspectives on Commercial Appropriation* (Cambridge University Press 2005) 206

¹⁵*Douglas and others v Hello! Ltd and others (No 3)* [2007] UKHL 21; [2008] 1 AC 1

¹⁶ [2010] EWHC 119 (QB); [2010] EMLR 16

¹⁷ *ibid* [149]

¹⁸J Thomas McCarthy, *The Rights of Publicity and Privacy* 2nd edn (Thomson /West 2008) vol 1 [1.3]

¹⁹ *ibid* [5.8]

²⁰Culminating in the recognition of a publicity right independent of the right to privacy in a case decided under the jurisdiction of New York, *Healan Laboratories, Inc v Topps Chewing Gum, Inc* 202 F.2d 866 (2d Cir 1963); see also

Apart from the law of confidence, bolstered by Article 8 of the *Human Rights Act 1998* (HRA), other pockets of limited protection for aspects of image include: data protection,²¹ copyright,²² commissioners' right to privacy of certain photographs and films,²³ performers' rights,²⁴ registered trade marks,²⁵ advertising standards codes,²⁶ trading standards,²⁷ defamation,²⁸ malicious falsehood,²⁹ unlawful interference with contractual relations³⁰ and the economic tort of passing off which is the cause of action in the Rihanna case. We will now consider the purpose and ingredients of passing off followed by an analysis of its application in the Rihanna decisions.

Passing Off: Purpose and Ingredients

In its simplest form, passing off protects the goodwill of one trader from damage caused by the misrepresentation(s) of another trader.³¹ Misrepresentation, damage and goodwill are therefore the three essential elements of the tort, and are often referred to as the "classical

David S Wellkowitz et al, *Celebrity Rights: Rights of Publicity and Related Rights in the United States and Abroad* (Carolina Academic Press 2010) Ch 1 Introduction: The Origins of Rights of Publicity

²¹ Data Protection Act 1998

²² Copyright, Designs and Patents Act 1988 (as amended), Part I

²³ Copyright, Designs and Patents Act 1988 (as amended), section 85

²⁴ Copyright, Designs and Patents Act 1988 (as amended), Part II

²⁵ Trade Marks Act 1994. For example, see: UK registration of Alan Titchmarsh name and image (UK00002277288) for 12 classes of product available at www.ipo.gov.uk/tmcase/Results/1/UK00002277288

²⁶ For example, see: David Bedford (complainant), Advertising Standards Code Ofcom decision, 27 January 2004 available at <http://stakeholders.ofcom.org.uk/enforcement/advertising-complaints-bulletins/appeal-the-number-david-bedford/>

²⁷ For example, Trade Descriptions Act 1968

²⁸ For example, the now discredited, former professional road racing cyclist, Lance Armstrong, successfully used libel laws to protect his professional reputation after the *Sunday Times* published an article suggesting it was right for questions about his performance to be both 'posed and answered'.. *Armstrong v Times Newspapers Ltd & Others (No.3)* [2006] EWHC 1614 (QB); see also *Tolley v Fry* [1930] 1 KB 467

²⁹ As seen in *Kaye v Robertson* [1991] FSR 62.

³⁰ *Douglas* n 15

³¹ *Reddaway v Banham* [1896] AC 199 (Lord Halsbury LC) 204. For modern definitions see: ("Advocaat") *Erven Warnink Besloten Vennootschap and Another Appellants v J Townend & Sons (Hull) Ltd and Another* [1979] 3 WLR 68; [1979] AC 731; ("Jif Lemon") *Reckitt & Colman v Borden* [1990] 1 WLR 491 (HL)

trinity³² in its modern application. The tort only applies as between “traders”, but the term has been given broad interpretation in the case law.³³ It also shields customers from deception, albeit indirectly. This dual protection provides a strong justification for the tort. The mental state of the defendant is irrelevant as liability is strict, although evidence of a defendant's innocence precludes the equitable remedy, account of profits.³⁴ The elements of passing off interact with each other, limiting the scope of the tort, as we shall see in the next section.

Passing Off: the Chaotic ‘Continuum of Elements’³⁵

One of the advantages of a common law cause of action, such as passing off, is its capacity to adapt to modern business practices and their concomitant deceptions. Described as the ‘most protean’³⁶ cause of action for unfair trading, it is ‘closely connected to and dependent upon what is happening in the market place’.³⁷ For example, in *Irvine v Talksport Ltd*,³⁸ the precursor to *Rihanna*, Laddie J recognised the ubiquity of celebrity endorsement arrangements. One of the downsides to an ever evolving tort is that the ingredients of passing off are contained within a multitude of definitions that derive from precedents. Moreover, as Wadlow states in his seminal text:

³²Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* 4th edn (Sweet & Maxwell 2011) para 1-014, 10

³³*Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145. See also: *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch); [2002] 1 WLR 2355.

³⁴W Cornish et al, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 7th edn (Sweet & Maxwell 2010) 678 citing the *Edelsten* case (1863) 1 De GJ & S 184

³⁵Clive Lawrence, *Brands: Law, Practice and Precedents* (Jordan's Ltd 2008) 166

³⁶*Erven Warnink Besloten Vennootschap and Another Appellants v J Townend & Sons (Hull) Ltd and Another* [1979] 3 WLR 68; [1979] AC 731 (Diplock LJ) 240

³⁷*Irvine v Talksport Ltd* [2002] EWHC 367 (Ch); [2002] 1 WLR 2355 (Laddie J) [13]. For example, passing off was invoked to deal with early internet domain name cybersquatting cases such as *British Telecommunications Plc v One in a Million Ltd* [1998] FSR 265; *Direct Line Group Limited v Direct Line Estate Agency Ltd* [1997] FSR 374; *Glaxo Plc v Glaxo-Wellcome Limited* [1996] FSR 388

³⁸[2002] EWHC 367 (Ch); [2002] 1 WLR 2355: This case concerned the digital manipulation of a photograph of Eddie Irvine, a successful, Formula 1 racing driver. The mobile 'phone Mr Irvine was holding to his ear in the original picture was replaced with a radio prominently displaying the defendant's brand.

The cause of action has suffered from a lack of consistent and precise vocabulary to describe its fundamental legal concepts. Certain recurrent words appear to be used as if they were terms of art, but on closer inspection turn out to bear a variety of inconsistent meanings which are not always correctly distinguished.³⁹⁴⁰

The modern approach is the classical trinity stated above which was applied in both the first instance and appeal decisions of *Rihanna*. It was necessary for Rihanna's lawyers to bring to the court sufficient evidence to satisfy each inter-related element of the classical trinity to the satisfaction of the court on a balance of probabilities. It is, therefore, worth considering each element in more detail, recognising the strong interaction between them, before discussing their application to the facts of *Rihanna*.

The First Element: Goodwill

Goodwill encapsulates brand loyalty. It has been defined as '[t]he attractive force which brings in custom'.⁴¹ In today's celebrity culture, fame itself is an attractive force which draws in the consumer. It is for this reason that traders often ask well known personalities to promote their products, hoping that the popularity of the celebrity will rub off on their product (the 'halo effect'⁴²).⁴³ Various aspects of a star's personality, including his or her physical image, are also used in merchandising.

In the majority of passing off cases, the claimant trades under a sign or "badge" which is sufficiently distinctive to be recognised by consumers as an indicator of the

³⁹ Wadlow, n 32 [1-29] 17

⁴⁰ Indeed, misrepresentation is sometimes conflated with misappropriation in celebrity cases: Hazel Carty, 'Passing Off: frameworks of liability debated' (2012) IPQ (2) 106

⁴¹ *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HL), 224

⁴² Edward L Thorndike, 'A constant error in psychological ratings', *Journal of Applied Psychology* (1920) 4 (1) 25-29, 28

⁴³ Indeed, Rihanna's endorsement deals currently span ten years starting from her very first endorsement in perfume in October 2005, expanding to fashion and men's aftershave.

claimant's products⁴⁴; the more distinctive the badge the easier it is to prove passing off if the defendant uses a similar badge on the defendant's product. The badge is often a name, a logo or the "get-up" (e.g. packaging) of a product. In *Rihanna*, it is her face. However, it is important to recognise that, in the context of passing off, unlike registered trade mark protection, it is not the badge *per se* which is protected. Rather, it is the goodwill appurtenant to the badge which is, in turn, inextricably linked to the claimant's underlying business.⁴⁵

Goodwill, itself, is a form of property⁴⁶ and it has been suggested that the continuum of the "classical trinity" may be undermined by the substitution of "reputation" for "goodwill". Hazel Carty suggests, 'though reputation lurks behind goodwill... such substitution of concepts may weaken the linkage of the trinity ingredients'.⁴⁷ Yet the terms are used interchangeably.⁴⁸ When assessing the third element (damage) in *Rihanna*, the trial judge referred to the claimant's 'loss of control over her *reputation* in the fashion sphere'.⁴⁹ In fact, reputation gives rise to a broader, non-proprietary right which can exist independently of a business,⁵⁰ although injury to reputation can obviously have an adverse effect on goodwill.

⁴⁴In this article, the term 'product' covers goods and services.

⁴⁵*Burberry's v Cording* [1900] 26 RPC 693 (Parker J); cited in *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch); [2002] 1 WLR 2355 (Laddie J) [31]. See also: *Inland Revenue Commissioners v Muller* [1901] AC 217 (Lord Macnaghton) 223; *Star Industrial Company Limited v Yap Kwee Kor (Trading As New Star Industrial Company)* [1976] FSR 256 (PC), (Lord Diplock) 269

⁴⁶*Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] ETMR 26 (Lewison LJ) [123]

⁴⁷Hazel Carty, 'Passing Off: frameworks of liability debated' (2012) IPQ (2) 106, 108

⁴⁸Indeed, Lord Oliver refers to 'goodwill or reputation' in "Jif Lemon" (*Reckitt & Colman v Borden* [1990] 1 WLR 491 (HL)) ("Jif Lemon") (Lord Oliver) 499 where the distinctive lemon-shaped packaging of the claimant's lemon juice was held to have been misrepresented by a similar lemon shaped packaging); as does Nourse LJ in "Parma Ham" (*Consorzio del Prosciutto di Parma v Marks & Spencer Plc* [1991] RPC 351 (CA) (Nourse LJ) 368. Marks & Spencer Ltd marketed ham as "Parma Ham" even though it had been sliced and packed in the UK, rather than in the Parma region as required under Italian law. Hence, it was a non-genuine "Parma Ham" product, similar to the Greek yoghurt in *Fage* n 45); and Laddie J in *Irvine* (n 37 (Laddie J) [34])

⁴⁹*Fenty* n 6 [74] (authors' emphasis)

⁵⁰For example, Rihanna almost lost her goodwill for the purpose of celebrity endorsement when she reconciled with musician, Chris Brown, after he assaulted her (Katrina K Wheeler, 'Rihanna's endorsements reportedly in danger; Gucci ad may not be renewed (watch video/documentary)' (14 Mar 2009, US) available at www.examiner.com/article/rihanna-s-endorsements-reportedly-danger-gucci-ad-may-not-be-renewed-watch-video-documentary). However, it is unlikely this would have affected her reputation as a super star in the eyes of the relevant consumer.

The fuzziness of the judges' distinction between the concepts of goodwill and reputation in passing off cases suits the protection of a celebrity's image.

The Second Element: Misrepresentation

The classic misrepresentation is that the defendant does a positive act to make it appear that the defendant's product originates from the claimant.⁵¹ The cause of action has also evolved to protect against subtler forms of deception such as the defendant suggesting a "relevant connection" to the claimant.⁵² That said, for many years, passing off claims failed in relation to "character merchandising"⁵³ and "false endorsement" cases: the claimants were unable to satisfy the *sine qua non* of the claimant and defendant being commercially involved in the 'same field of activity'.⁵⁴ The subsequent dismantling of this hurdle, at least as an absolute requirement, was confirmed in *Irvine*.⁵⁵ This expands the tort considerably as the parties no longer need to be direct competitors in the marketplace. The judge also took a broad view of the scope of "relevant connection".⁵⁶

Unlike US-style publicity rights, the purest form of passing off is limited to misrepresentation, not misappropriation on its own. Yet, Laddie J stated that '...Mr Irvine has a property right in his goodwill which he can protect from *unlicensed appropriation* consisting of a false claim...'.⁵⁷ The use of "(mis)appropriation" terminology has been

⁵¹Reddaway n 31

⁵²Such as quality control under licence; see: *Bulmer Ltd v Bollinger SA (No 3)* [1978] RPC 79 (Buckley LJ) 99 and (Goff LJ) 177. See also: *Harrods v Harrodian School* [1996] RPC 697 (Millet LJ) 713 re sufficiency of "relevant connection".

⁵³*Elvis Presley Trade Marks* [1999] RPC 567 (Simon Brown LJ) 597

⁵⁴For a potted history in the area of a "common field of activity" see: *McCulloch v May* (1947) 65 R.P.C. 58; *Wombles Ltd v Wombles Skips Ltd* [1975] FSR. 488; *Lyngstad v Anabas Products Ltd* [1977] FSR 62.

⁵⁵It was dispensed with in a series of cases culminating in *Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] FSR 155; and the false endorsement case of *Irvine* n 37 [29]

⁵⁶In contrast to *Harrods* n 52 where the majority subscribed to a narrow view in the requiring quality control.

⁵⁷*Irvine* n 37 (Laddie J) [75] (authors' emphasis), embracing the principles enunciated in *Henderson v Radio Corporation Pty Ltd* [1969] RPC 218 in the High Court of New South Wales sitting in its appellate jurisdiction.

criticised. Carty claims that it compromises the internal balance of the classical trinity.⁵⁸ In other words, passing off is wholly associated with the deception that lies at the heart of misrepresentation, not the defendant's capacity to be unjustly enriched by freeriding on the claimant's goodwill. Indeed, according to the Rt Hon Sir Robin Jacobet al:

...the heart of this wrong is telling lies to the public. If the court thinks that is going on, it is going to want to stop it - in reality this general rule is often more important than all the technical rules of the law of registered trade marks put together.⁵⁹

Telling words indeed. Sir Robin has made his views regarding "misappropriation" crystal clear: 'to use the word in the context of a debate about the limits of the tort of passing off and its interface with legitimate trade is at best muddling and at worst tendentious'.⁶⁰ Wadlow, however, believes that misappropriation has always been at the very heart of passing off.⁶¹ Indeed, it is the inherent pecuniary value of the claimant's proprietary⁶² interest in goodwill and the 'lustre of association'⁶³ that the defendants wish to "cash in on". As stated in *Irvine*, 'the law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others to so use goodwill as to reduce, blur or diminish its exclusivity'.⁶⁴ This reasoning in *Irvine* represents a distinct step forward on the evolutionary pathway to image rights protection in England via an expanded concept of passing off, influenced by concepts of misappropriation and dilution.

⁵⁸ Carty n 47

⁵⁹ Robin Jacob LJ [as he was then] et al, *A Guidebook to Intellectual Property: Patents, Trade Marks, Copyright and Designs* 5th edn (Sweet and Maxwell 2004) 124

⁶⁰ *L'Oréal V Bellure* [2007] EWCA Civ 969; [2008] RPC 8 (Jacob LJ) [160]; see also: *Hodgkinson* FSR 169 (Jacob LJ) 175

⁶¹ Dialogue between Wadlow and Carty see: Christopher Wadlow, 'Passing off at the crossroads again: a review article for Hazel Carty, An Analysis of the Economic Torts' (2011) 33(7) EIPR 447, 449-50; Hazel Carty, 'Passing off: frameworks of liability debated' (2012) IPQ (2) 106

⁶² 'In the traditional perception of common law, one of the irreducible components of a proprietary right is a general entitlement to exclude others from enjoyment of, or from interfering with one's own mode of enjoyment of, the resource in which the property is claimed' (Kevin Gray et al, *Land Law* 4th edn (Oxford University Press 2007) 41); Laddie J in *Irvine* [34]: 'instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it'. It follows that the proprietary right in goodwill should cover not only damage (or likelihood of damage), but also misappropriation of goodwill. For a contrary view setting out the repugnance for a 'property right' approach and the danger of creating 'obnoxious monopoly', see: Wadlow n 62, 453

⁶³ Transcript of Court of Appeal hearing (day 1)

⁶⁴ *Irvine* n 37 [38]. On this point the authors are keenly aware of the contention surrounding the use of words like "blur" in passing off claims which also suggest "dilution". Their place more rightly belongs in that of unfair competition. However, it is yet another example of how passing off is expanding when image-related claims are at issue and how terminology overlaps in this complex area of law. See also: Wadlow n 62, 453

The Third Element: Damage

Actual (or the likelihood of) damage to the goodwill caused by misrepresentation is the third element which completes the classical trinity. In support of the continuum theory, if the first two elements of the classical trinity are successfully proven, the third will generally follow.⁶⁵Wadlow argues that the expansion of the tort to cover non-competing⁶⁶traders extends it into the realms of unjust enrichment and speculative damage. He questions whether Mr Irvine should have been compensated for the loss of an opportunity he may not have wished to take. However, the remedy in image-type cases is limited: 'if the [claimant] is in the business of licensing out his name or image, the law so far has only recognized damage in the form of lost royalties and licensing fees'.⁶⁷

Through the advancement of judicial interpretation of the classical trinity in the context of commodification of celebrities, it seems inevitable that the courts will recognise that damage extends beyond the mere loss of opportunity to endorse a rival product or diversion of sales away from official merchandise. In *Irvine*, Laddie J stated that had the law of passing off not developed sufficiently to protect against false endorsements, it would have been necessary to consider the effect of Articles 8 and 10 HRA to 'give the final impetus' to reach the desired result.⁶⁸Human rights considerations may also extend the scope of contemplated loss in the future. The first instance decision in *Rihanna* refers to

⁶⁵*Fentyn* 6 [33]

⁶⁶ This was because there is no longer a requirement for a common field of activity and the parties need not be in direct competition with each other.

⁶⁷Peter M Bryniczka, 'Irvine v Talksport Ltd: Snatching Victory from the Jaws of Defeat – English Law Now Offers Better Protection of Celebrities' Rights' (2004) 11 Sports Law, J, 171, 180

⁶⁸*Irvine* n 37 (Laddie J) [77], citing Sedley LJ in *Douglas v Hello!* [2001] FSR 732

'loss of control of reputation' under the heading "damage" which also amplifies the extent of injury envisaged.⁶⁹

In summary, the looser the definitions of the classical trinity elements, the wider the scope of the tort. Pressure to extend its application can be attributed to the lack of a 'general unfair competition' law which was called for in submissions informing the Gowers Review of Intellectual Property.⁷⁰ Gowers recognised that there was insufficient protection from misappropriation for 'brands and designs'.⁷¹ Contrarily, Jacob LJ warned that the introduction of a general tort of unfair competition would be like letting 'the genie out of the bottle' because 'it would be of wholly uncertain scope'.⁷² It might be instructive to consider the German experience.⁷³

We will now rehearse the facts of *Rihanna* in some detail as they are crucial to the outcome.

The Rihanna Case: Summary of Facts

Rihanna, a global pop star and 'fashion icon',⁷⁴ was "papped" during the shooting of her "We Found Love" music video in September 2011. The corresponding single was subsequently released on her *Talk That Talk* album on 18 November 2011. The filming attracted global publicity.⁷⁵⁷⁶

⁶⁹*Fentyn* 6 [74] (there is no damages award to date in *Rihanna*)

⁷⁰Gowers Review of Intellectual Property (December 2006) [5.86] available at www.gov.uk/government/uploads/system/uploads/attachment_data/file/228849/0118404830.pdf

⁷¹*ibid* [5.84]

⁷²*L'Orealn* 60; [2008] ECC 5 (Jacob LJ) [161]

⁷³Germany introduced a new Unfair Competition Act in July 2004 to modernise its law to comply with European Union requirements: Gesetz gegen den unlauteren Wettbewerb vom 3. Juli 2004 (BGBl. I 2004 32/1414).

⁷⁴*Fentyn* 6 [45]

⁷⁵John Burns and Francesca Angelini, 'Rude boy? You're a fine one to talk' *The Sunday Times* (2 Oct 2011, London) www.thesundaytimes.co.uk/sto/news/ireland/article789204.ece

Topshop is a major fashion retail chain which has been described as 'signifying youth and modernity and evoking cool London'.⁷⁷The paparazzo licensed use of the photograph to Topshop's supplier, hence there was no copyright infringement. Although Rihanna did not consent to the photograph being taken, neither privacy nor breach of confidence were pleaded in the main proceedings.

On 6 March 2012, Topshop began selling online and in its stores a number of vests each featuring a different living being. One of these was the vest in issue which featured the "papped" image of Rihanna. The passing off claim, brought by Rihanna and her trading companies⁷⁸ against the Arcadia Group,⁷⁹ was issued in the High Court on 30 March 2012.⁸⁰

The Rihanna Case: First Instance Decision

In the High Court (Ch) between 17 and 21 July 2013, Birss J relied on the classical trinity of elements discussed above. It was easy for the Claimant to establish ample goodwill by reference to Rihanna's music sales, tours, awards, extensive merchandising and endorsement activities. She also produced collaborative clothing collections with other enterprises such as fashion designer, Armani. At the time the vest was put on sale, she

⁷⁶ This was after it was reported that, on the 26 September, the owner of the property where the music video was being recorded insisted that the singer leave his property. Allegedly, he did not approve of her risqué conduct in his corn field (Caroline Westbrook, 'Rihanna fans blast farmer who asked singer to leave his land' *Metro* (3 Oct 2011, London) available at <http://metro.co.uk/2011/10/03/rihanna-fans-blast-farmer-who-asked-singer-to-leave-his-land-170420/>). The landowner received hate mail whilst other Rihanna fans contacted him offering to buy corn touched by the super star (Yasmin Alibhai-brown, 'Farmer Graham was right to stand up to Rihanna's antics' *Mail Online* (29 Sep 2011, London) available at www.dailymail.co.uk/femail/article-2043026/Rihanna-We-Found-Love-video-Farmer-Alan-Graham-right-stand-her.html)

⁷⁷ *Fenty* (CA) n 7 (Kitchin LJ) [12]

⁷⁸ Hereinafter known as "the Claimant"

⁷⁹ Trading as Topshop and hereinafter known as "the Defendant"

⁸⁰ Claimant issues HC proceedings against Arcadia Group Brands available at Alex Rees, 'RiRi takes on Topshop' *Scribd* (23 May 2013, San Francisco) available at www.scribd.com/doc/143299252/Fenty-v-Arcadia-Group-Brands

also had a “tie-up” with Topshop rival, River Island, albeit pre-launch. The most contentious issue was the misrepresentation element of the classical trinity. There was no evidence of actual confusion which Birss J ruled was ‘desirable but not determinative’.⁸¹ However, he found for Rihanna predominantly due to the public links between Topshop and famous stars in general and, more importantly, Rihanna in particular.⁸²

Topshop had previously attempted to connect itself to Rihanna by running a national competition offering consumers the chance to win a personal styling consultation with her in its flagship store. Its staff had also endeavoured to make it known when the super star was shopping there. Indeed, it was the parties’ ‘symbiotic’⁸³ relationship which was fatal to Topshop’s defence. In the context of the factual matrix of Rihanna’s music and fashion business and the Topshop connection, Birss J found that ‘the sale of this image of this person on this garment by this shop in these circumstances’⁸⁴ deviated from the fact that ‘the mere sale by a trader of a t-shirt bearing the image of a famous person was not, without more, an act of passing off’.⁸⁵

The particular image used also affected the outcome; it was ‘striking’ according to Birss J.⁸⁶ The larger than life-sized face and shoulders of Rihanna occupied most of the front of the vest and in particular, the hair “up do” with the scarf was highly distinctive.⁸⁷ It had been taken during a highly publicised video shoot; similar images were included on an album

⁸¹*Fenty* n 6 [50]

⁸²*ibid* [71]

⁸³*Fenty* n 6 [60]

⁸⁴*ibid* [75]

⁸⁵*ibid*

⁸⁶*Fenty* n 6 [67]. The image shows Rihanna ‘face on’ to the camera. It is a posed shot featuring a very similar fashion style to those included in the cover booklet of the CD album and approximately 10 seconds of the song’s video. Her hair is tied up with a scarf and the two straps of a ‘bralet’ are just discernible.

⁸⁷*Fenty* n 6 [67]

cover which reached number ten of the hundred top selling albums of 2011⁸⁸ whilst the single to which the actual photograph relates topped charts in twenty-seven countries worldwide.⁸⁹ Furthermore, the album with the featured image coincided with the singer's "Loud" tour which ranked at number seven of the 25 best-selling tours worldwide of 2011.⁹⁰ Rihanna made history when her tour sold out on all ten nights at the O2 arena in London.⁹¹ Crucial to the first instance decision 'was the relationship between this image and the images of Rihanna for the album and the video shoot'⁹² which Birss J thought would be noticed by the "relevant consumer".⁹³⁹⁴ He concluded that 'fans are particularly likely to think that the image came from promotional material for the album, single or video'.⁹⁵ Upon viewing the video, the authors noted that Rihanna's get-up in the "We Found Love" four minute video changes constantly. The get-up in issue (the bralet, headscarf and up-do) features for approximately ten seconds. However, it could be argued that this is qualitatively sufficient if it is the most recognisable part of the relevant video.⁹⁶

In terms of damage, the judge found that Rihanna suffered 'a loss of control over her reputation in the fashion sphere' and that '[s]ales [were] lost to her merchandising business'.⁹⁷ Although the Claimant sought a broad injunction prohibiting Topshop from selling any Rihanna image on any clothing, Birss J deemed that an injunction in qualified form would suffice: Topshop was not to market a T-shirt bearing this particular image

⁸⁸Dan Lane, 'The Top 20 biggest selling albums of 2011 revealed!' (2 Jan 2012, UK) available at www.officialcharts.com/chart-news/the-top-20-biggest-selling-albums-of-2011-revealed/

⁸⁹Author and publisher unknown, available at <http://acharts.us/song/65699>

⁹⁰Pollstar (US) available at www.webcitation.org/64I05wGYs. It was the most sold out show for a female artist in the venue's history.

⁹¹Capital FM, 'Rihanna Breaks O2 Arena Record With Final 'Loud' Tour Gig' *Capital FM* (22 December 2011, London) available at www.capitalfm.com/artists/rihanna/news/o2-arena-record/

⁹²*Fenty* n 6 [69]

⁹³ Her female fans aged 13 to 30

⁹⁴*Fenty* n 6 [61]

⁹⁵*Fenty & Ors v Arcadia Group Brands Ltd & Anor* [2013] EWHC 1945; [2013] FSR 37 [83] [expert evidence hearing before first instance]

⁹⁶Akin to the concept of substantiality in copyright law.

⁹⁷*Fenty* n 6 [74]

‘without clearly informing prospective purchasers that the garment [had] not been approved by or on behalf of [Rihanna].’⁹⁸

The Rihanna Case: the Appeal

The main appeal was heard by three Lord Justices⁹⁹ on 18 and 19 November 2014.¹⁰⁰ Displayed in Court 68 of the Court of Appeal, amongst 18 celebrity and “non-entity” image Topshop vests, was the now infamous ‘boyfriend style tank’¹⁰¹ vest top bearing Rihanna’s image. Immediately before the hearing commenced, it was separated from the others (with which it was sold at the time)¹⁰² as the subject of the appeal by the high street giant.¹⁰³

Creation of an Image Right Monopoly through Assumption of Undisclosed Licences

It is well established that ‘there is today in England no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image’.¹⁰⁴ The fundamental argument of the Appellant was that the court should not derogate from that legal principle by allowing a passing off claim to succeed on the basis of the erroneous assumption of the existence of an “undisclosed licence” or similar association; especially where there was no indication of such licence on the part of the Appellant. ‘If you start from the premise that there are no image rights, you must remain

⁹⁸Transcript of Court of Appeal hearing (day 1)

⁹⁹Richards, Kitchin and Underhill LJ

¹⁰⁰There was also a “costs” appeal held after the main appeal wherein Rihanna succeeded against Topshop: *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 38

¹⁰¹*Fenty* n 6 [47]

¹⁰²The same substrate with a parrot whose provenance is unknown and the music artist, Prince, and others

¹⁰³Hereinafter, Arcadia Group/Topshop will be referred to as “the Appellant” and Rihanna (and her trading companies) as “the Respondent”.

¹⁰⁴*Fenty* n 6 [2]; see also: *Elvis* n 53; *Douglas* n 15

loyal to that premise'.¹⁰⁵In his submission, Geoffrey Hobbs QC, for the Appellant, illustrated the point by analogy to a toll bridge:

The right to levy a toll does not follow simply because the people you encourage to pay the toll are induced to pay it because they (wrongly) assume you have the right to impose it. That right has to be established first. Otherwise the argument becomes circular. Hence, you cannot then avoid the creation of a monopoly.¹⁰⁶

Kitchin LJ regarded this submission as tantamount to claiming 'a positive right to market goods bearing an image even if the use of that image in particular circumstances to particular customers gives rise to a misrepresentation'.¹⁰⁷The argument was dismissed as it would sanction deceptive practices.¹⁰⁸ Surprisingly, the undisclosed licence point was not addressed directly and yet, it is precisely that point which creates the potential for paradox. Only time will tell but, following this precedent, the authors would not be surprised to see alleged assumptions of undisclosed licences and associations cropping up everywhere in future. This may well be the evolutionary pathway which takes us a step further towards an image right monopoly, albeit limited in scope and one which the Court of Appeal suggested can be mitigated by the use of disclaimers.¹⁰⁹It is the authors' contention that this flies in the face of their application of the European Court's ruling in *Arsenal v Reed*.¹¹⁰ Although this was a case concerning registered trade marks, the rationale for the appeal decision in *Arsenal* mirrors *Rihanna*. In other words, disclaimers may dispel confusion in relation to the original point of sale, but may not be sufficient to prevent deception in the context of wider circulation when the goods are taken away.¹¹¹ Essentially, this affects 'the ability of the...[badge] to guarantee the origin of the goods'.¹¹² Furthermore, this also disregards entirely the view of Jacob J in *Asprey*: '[d]isclaimers to

¹⁰⁵ibid

¹⁰⁶Transcript of Court of Appeal hearing (day 1)

¹⁰⁷*Fenty* (CA) n 7 [48]

¹⁰⁸ ibid

¹⁰⁹Defendant must always do enough to avoid deception to escape liability: *Hodgkinson & Corby Ltd and Another v Wards Mobility Services Ltd* [1994] 1 WLR 1564 (Jacob J as he was then) 1572

¹¹⁰ [2003] EWCA Civ 96; [2003] 2 CMLR 25. This case concerned the sale of unlicensed football merchandise in relation to trade mark infringement and passing off.

¹¹¹*Arsenal v Reed* [2003] EWCA Civ 96; [2003] 2 CMLR 25 (Aldous LJ) [43]-[48]

¹¹² ibid [45]

avoid confusion which would otherwise occur unless they are massive and omnipresent, hardly ever work'.¹¹³Indeed, evidence was presented in *Jif Lemon* which suggested that disclaimer labels were insufficient to avoid deception; consumers generally disregard them as they are less prominent than other features of the product. Labels are also discarded after purchase and are hardly memorable.¹¹⁴Unless any disclaimer is as permanent and prominent as the badge itself, it is unlikely to quell the likelihood of deception.¹¹⁵

'Origin Neutral' Starting Point / Lack of Distinctiveness

According to Hobbs QC, if there is no inherent proprietary right over an image *per se*, the starting point is that the image is 'origin neutral'.¹¹⁶He submitted that the Respondent had not produced evidence that, as a badge, the relevant image was sufficiently distinctive to individualise it to Rihanna's business.¹¹⁷Although he accepted that Rihanna is well known and widely recognised as a person, he maintained this was a get-up case. The image forms part of the traded article itself, like the 'millions and millions'¹¹⁸ of other such unauthorised merchandise featuring the singer; it is not an indicator of source or connection with Rihanna's business. Essentially, consumers buy it because they like the look of it and it is trendy, not because it conveys a message of provenance. As Laddie J commented in *Irvine*, the purpose of merchandising enables consumers to buy products depicting a subject, be it film characters, music stars or 'some other famous person such as the late Diana, Princess of Wales that they find enjoyable' and wish to remember.¹¹⁹

¹¹³*Asprey and Garrard Ltd v WRA (Guns) Ltd* [2002] FSR 30 (Jacob J) [26] 483-4. This case concerned a family member who endeavoured to use the family name "Asprey" (known worldwide for its association with luxury goods) as a sign for marketing guns. The defendant's company could not plead an 'own name' defence and the court held that its use was deceptive.

¹¹⁴*Jif Lemon* n 48 (Jauncey LJ) 516

¹¹⁵*ibid* (Bridge LJ) 495

¹¹⁶Transcript of Court of Appeal hearing (day 1)

¹¹⁷*Jif Lemon* n 48 (Oliver J) 406

¹¹⁸Transcript of Court of Appeal hearing (day 1)

¹¹⁹*Irvine* n 37 [9]

Kitchin LJ dismissed the origin neutral argument on the basis that it 'would require this court to shut its eyes to [the] reality'¹²⁰ of previous associations between Topshop and Rihanna. Where there are previous tie-ups with a celebrity, traders will have to be extra careful.

Misrepresentation by Omission

The second element of the trinity, misrepresentation, is not sufficient on its own: it must be material¹²¹ and operative. In court, the two questions posed by Jacob J in *Hodgkinson*¹²² were considered in the context of the instant facts: (1) has the Respondent proved that this image of Rihanna is a crucial point of reference for those who want a Rihanna-authorized vest? and (2) has it proved that persons wishing to buy an authorized vest are likely to be misled into buying the vest in issue? How QC for the Respondent stated that 'you have to take the public as you find them'.¹²³ In other words, it is necessary to enter the mindset of 13 to 30 year old female Rihanna fans who shop at Topshop. The entries to the styling competition provide some insight into that mindset:

'I want to get this thing [styling consultation] because Rihanna is so inspirational'

'I'm hoping Rihanna can spice me up a little and bring my sparkle back'

¹²⁰*Fenty* (CA) n 7 [50]

¹²¹Lack of materiality caused the claim to fail in *Halliwell v Panini* (Unreported, High Court, Chancery Division, 6 June 1997). The globally-known pop group phenomenon, the "Spice Girls" endeavoured to obtain an injunction preventing Panini from distributing an unauthorised sticker collection, called "The Fab Five," featuring their images. See also: Hayley Stallard, 'The Right of Publicity in the United Kingdom' 18 *Loy LA Ent L Rev* 565 (1998).

Available at <http://digitalcommons.lmu.edu/elr/vol18/iss3/7>

¹²²*Hodgkinson* n 109

¹²³Transcript of Court of Appeal hearing (day 1)

‘She is a true style icon, who many people can learn from’.¹²⁴

Addressing the first question, having regard to that target market, the Lord Justices appear to have been convinced that a sufficient number of fans would recognise the particular image used on the vest due to the album cover and video shoot. Such recognition could lead them to assume it was endorsed by Rihanna, although there was no evidence that it had.¹²⁵ This is notwithstanding the finding by Birss J at first instance that the vest is actually a fashion garment, not the type of T-shirt normally associated with music tours.¹²⁶ The risk of this confusion was increased by the contemporaneity of the release of the album, the hype surrounding the filming of the music video and the sell-out tour and the sale of the vest. It was offset, to some extent, by the lack of her registered trade mark logo, (the ‘R’ slash) , on the swing tag or other indicia of officialdom which, at first instance, Birss J recognised was ‘[a] very important point in [Topshop’s] favour’.¹²⁷ However, this did not negate the risk of the likelihood of confusion,¹²⁸ amplified by the previous trade connections between the parties and the fact that Topshop was, and is, a major player in the context of celebrity endorsements. Ironically, Topshop is a victim of its own success and reputation. It is ‘not a market stall’¹²⁹ which leaves it at a disadvantage in these circumstances. As Hobbs QC submitted in the appeal:

If we accept that a party who has had a previous tie-up with an artist/celebrity cannot sell anything with the image of that celebrity, then this creates a disability on that party against someone who has never had a tie-up and can freely sell the same image.¹³⁰

¹²⁴*Fenty* (CA) n 7 [51]

¹²⁵ *ibid* [63]

¹²⁶*Fenty* n 6 [47]

¹²⁷ *ibid* [64]

¹²⁸ Although confusion is not, in itself, determinative of misrepresentation in passing off (*Fenty* n 6 [50])

¹²⁹ *ibid* [55]

¹³⁰ Transcript of Court of Appeal hearing (day 1)

Hobbs QC also relied on the evidence of Ms Kaikobad (for River Island) and pointed out that:

If you have some form of tie-up with one of the world's leading celebrities, you don't just sit mute about it. You stand there and you trumpet it from the rooftops. You have a big splash; you make it positively known that you have that tie-up.¹³¹

Hobbs QC also made the point that it is Topshop's failure to take positive steps to make it clear that the vest was unofficial that constituted the misrepresentation. In other words, it was a misrepresentation by omission. This argument was run in *Halliwel* 17 years earlier but, in that case, the judges agreed that the lack of indicia representing that the stickers were official was fatal to a finding of misrepresentation.¹³² This suggests that *Rihanna* moves us towards greater protection for celebrity image. However, does this place too high a burden on traders? Will it adversely affect competition, the 'mainspring of the economy'?¹³³

The second *Hodgkinson* question was also answered in the affirmative i.e. that Rihanna's "apparent" approval of the vest would have induced a not insignificant number of her fans to buy it. However, absent any evidence of actual confusion or, indeed, any evidence that the authenticity of the vest was a motivating factor in the purchasers' decision to buy it, there appears to be a "leap of faith" to the proposition that the allegiance of fans to Rihanna played any part in their decision to buy the vest. Indeed music piracy analytics suggest otherwise.¹³⁴

¹³¹ *ibid*

¹³² *Halliwel* n 121. Again, this disregards both Jacob J in *Aspreyn* 112 and the European Court as applied by the CA in *Arsenal* n 111.

¹³³ *L'Oreal* n 60 (Jacob LJ) [141]

¹³⁴ Rihanna was the world's second most pirated music artist in 2013 according to a Musicmetric analysis of data from peer-to-peer file sharing on Bit Torrent. Her music was downloaded more than 5m times over the course of the year. James Titcomb, 'Bruno Mars and Rihanna most pirated artists in 2013' *The Telegraph* (30 Dec 2013, London) available at www.telegraph.co.uk/technology/internet/10541876/Bruno-Mars-and-Rihanna-most-pirated-artists-in-2013.html

Merchandising or Endorsement?

Hobbs QC argued that Birss J wrongly treated this as an endorsement case whereas, in contradistinction to *Irvine*, it is a merchandising case. Reference was made to Laddie J's distinction between the two in *Irvine*:

When someone endorses a product...he tells the relevant public that he approves of a product or is happy to be associated with it whereas merchandising involves exploiting images ...which have become famous.¹³⁵

The authors have some sympathy with the view of Hobbs QC as the facts in this case seem more in keeping with merchandising than endorsement; the image of Rihanna herself forms part of the product. The sales figures of 12,000 units demonstrate that the presence of the image undoubtedly made the vest attractive to its target audience.¹³⁶ This is not sufficient on its own: Hobbs QC relied on dicta which suggest that, in a merchandising case such as this, it is necessary to establish that the consumer is aware of the claimant's practice of granting licenses to use images;¹³⁷ moreover those licenses guarantee quality. In other words, 'the relevant connection must be one by which the plaintiffs would be taken by the public to have made themselves responsible for the quality of the defendant's goods or services'.¹³⁸ The Court of Appeal judges endorsed Birss J's view that Topshop had misrepresented a connection of the relevant kind i.e. that Rihanna was 'materially responsible' for the quality of the vests.¹³⁹

¹³⁵*Irvine* n 37 [9]

¹³⁶*Fenty*(CA) n 7 [12]

¹³⁷*Bulmer* n 52 (Goff LJ) 11

¹³⁸*Harrods* n 52 (Millet LJ) 712-3

¹³⁹*Fenty*(CA) n 7 [61]

In this case, we are confronted with an indistinct borderline between merchandise and endorsement. The vest is third party Rihanna merchandise¹⁴⁰ but, as this case shows, it is possible for merchandise to carry the perception of endorsement. The precise facts in *Rihanna* appear to have created a hybrid situation making it the first of its kind to be scrutinised by the Court of Appeal in recent times. The authors agree with McCarthy: '[a] rigid classification [of endorsement and merchandising activities] would risk stagnation and hamper development of the law, particularly as regards future evolution of commercial or social practices.'¹⁴¹ Either way, *Rihanna* significantly lowers the bar to proving misrepresentation in false merchandise and, indeed, false endorsement passing off cases.¹⁴²

Damage

A somewhat surprising complaint from Rihanna was that the image was unflattering.¹⁴³ Surely an unflattering image is less likely to be conceived as an authorised image? Notwithstanding this, it could increase the damage suffered as highlighted by Catherine Zeta Jones in *Douglas*¹⁴⁴ when she asserted that unflattering images were damaging to her career prospects as an actress, hence the need to control the mediated image.

Rihanna had to demonstrate that she suffered, or in a *quasi* *in rem* action, was likely to suffer damage by reason of the erroneous belief engendered by Topshop's misrepresentation. 'If the public believes the licensor to exercise quality control over licensed products then it becomes more plausible that a misrepresentation that the defendant is licensed will

¹⁴⁰The second half of the 'interface' as referred to by Hobbs QC in the transcript of Court of Appeal hearing (day 1), as opposed to Rihanna's official Rihanna merchandise (the first half of the 'interface').

¹⁴¹*McCarthy* n 18, 38

¹⁴²Jeremy Roberts, 'Face off: Rihanna wins "image rights" case' (2013) 24(8) Ent LR 283, 283

¹⁴³*Fentyn* 6 [67]. Birss J dismissed this and referred to it as 'striking'.

¹⁴⁴*Douglas* n 15 (Lord Nicholls) 72

influence its choice.¹⁴⁵Notwithstanding this, as Hobbs QC submitted, can quality control really be exercised by a super star and is the mere collection of royalties sufficient for the purpose of establishing a 'relevant connection'?¹⁴⁶

CONCLUSION

Image Rights and English Law: a Glimmer of Hope

The 22nd of January 2015 was a significant day for highly successful, well-known retailers marketing celebrity-image clothing, but the judgement delivered in Court 65 of the Royal Courts of Justice may well have more wide-ranging implications. The decision of Birss J in *Rihanna* was the first of its kind. When the Lord Justices upheld it, a glimmer of hope for image rights protection under English law could be discerned. It is spawned through the assertion of undisclosed licenses.¹⁴⁷ It is a very limited right; it is fact-specific; it is not even described as an image right. We are reminded by Kitchin LJ that '[t]here is no "image right" or "character right" which allows a celebrity to control the use of his or her name or image'.¹⁴⁸ However, his Lordship does recognise the "piecemeal" protection that is available: '[a] celebrity seeking to control the use of his or her image must therefore rely on some other cause of action...'¹⁴⁹ Is this appropriate in England in 2015 having regard to the investment in celebrity culture, the internationalisation of entertainment, sport and fashion plus the tremendous value of merchandising and endorsement deals?

¹⁴⁵ Wadlow, n 32 309 [5-020]

¹⁴⁶ Transcript of Court of Appeal hearing (day 1); *Bollinger* n 135; *Harrods* n 136

¹⁴⁷ Hobbs QC in the transcript of Court of Appeal hearing (day 1)

¹⁴⁸ *Fenty* (CA) n 7 [29]

¹⁴⁹ *ibid* [33]

Uncertainty

The consequence of lawyers having to resort to causes of action not designed with image rights protection in mind results in the attempted “shoehorning” of image-related claims into ill-fitting shoes, yielding unpredictable results. Despite the evident, substantial commercial value of a celebrity's image,¹⁵⁰ the uncertainty of the legal outcome is illustrated by the words of Underhill LJ in the Court of Appeal judgement: ‘...I regard this case as close to the borderline.’¹⁵¹ Whilst interesting for lawyers, the incremental evolution of image rights via the common law leads to speculation in relation to judicial interpretation of fact-specific cases. For stakeholders, especially retailers (like Topshop) and celebrity merchandising/endorsement companies (like those connected to Rihanna), it means delay, expense and uncertainty. For lawyers, it demands continued scrutiny of the nature and ambit of passing off in a modern setting. Is it the appropriate vehicle for preventing unfair competition more generally¹⁵² or should it be confined to deceptive practices? Moral and ethical questions arise and it is difficult to reconcile the different interests of established traders, newcomers to market and consumers.

Image Rights and Misappropriation: Unjust Enrichment

The artificiality of relying on a miscellany of causes of action not designed to protect image rights also skews the evolution of torts such as passing off. The authors contend that the beauty of the tort is its versatility, but the price is the high evidential burden which only the

¹⁵⁰For example, OK! magazine paid £1 million to Michael Douglas and Catherine Zeta Jones to publish authorised photographs of their wedding: *Douglas* n 15 (Lord Nicholls) [243]. In the instant case, Rihanna reportedly sought damages to the sum of £3 million: Dorothea Thompson, ‘Rihanna and image rights’ *Law Gazette* (3 Feb 2015, London) available at www.lawgazette.co.uk/law/legal-updates/rihanna-and-image-rights/5046507.article. Rihanna also succeeded in a £1.5 million claim against Topshop for her costs (Jordan Strauss, ‘Rihanna wins £1.5m costs from Topshop’ *The Times* (4 Feb 2015, London) available at www.thetimes.co.uk/tto/life/celebrity/article4343626.ece)

¹⁵¹*Fenty* (CA) n 7 (Underhill LJ) [63]

¹⁵²Akin to the general unfair competition laws (concurrency déloyale) of the French Civil Code (Arts 1382 and 1383) which can be used in conjunction with the notion “parasitisme” to prevent these types of parasitic commercial practices.

already successful are able to discharge. The outcome is also uncertain as 'every case depends upon its own peculiar facts' as well as the interpretations of the classical trinity elements by the judiciary. Some clearly favour an expansionist approach which others view with barely concealed contempt.¹⁵³

It will be interesting to see how *Rihanna* is considered in future claims for false endorsement or, indeed, false merchandise.

Commercial Considerations

During the appeal hearing, Hobbs QC produced a photograph of Rihanna wearing a top sold by Topshop featuring an image of Elizabeth Taylor as Cleopatra from the 1963 film. The snapshot was taken only one month before the star issued proceedings against the same high street store.¹⁵⁴ The irony was not lost on the authors. Notwithstanding this, we think that the lack of *sui generis* image rights is bad for business. Hobbs QC stated that Rihanna's original claim was generalised and unspecific: he compared its breadth to 'a barn door'.¹⁵⁵ This, in itself, illustrates the pressure courts are under to provide image rights protection. After all, the stakes are high. Even as this conclusion was being written, the magic of endorsement was illustrated when the children's author, JK Rowling, responded to a "Tweet" asking her to reveal her favourite brand of tea.¹⁵⁶ According to the director of

¹⁵³*L'Oreal* n 60 (Jacob LJ)

¹⁵⁴Allen O, 'Rihanna wearing a Topshop Pixelated Elizabeth Taylor Cleopatra Print Sweater by Unique' *Upscale Hype* (27 Feb 2012) available at www.upscalehype.com/2012/02/rihanna-wearing-a-topshop-pixelated-elizabeth-taylor-cleopatra-print-sweater-by-unique/

¹⁵⁵Transcript of Court of Appeal hearing (day 1)

¹⁵⁶BBC News at Six programme broadcast at 18.00 hours on 9.2.2015

the company marketing the lucky brew, the company's daily website hits grew from 25 to over 4000 immediately following the correspondence.¹⁵⁷

It is worth remembering that England does not exist in isolation; its laws are influenced by international treaty obligations¹⁵⁸ and European Union laws.¹⁵⁹ Against the single market hypothesis are barriers to trade, offering widely differing levels of protection to a person's attributes and widely differing perspectives in relation to unfair competition.

Human Rights Considerations

There are also the dignitarian arguments. In his judgement, Birss J talks about Rihanna's 'loss of control of her reputation' under the third element of the classical trinity.¹⁶⁰ Control over the use of one's image or reputation is bound up with human rights as recognised by Laddie J in *Irvine*.¹⁶¹ Furthermore, private life, in the view of the European Court of Human Rights, includes a 'person's physical and psychological integrity';¹⁶² the guarantee afforded by Article 8 of the Convention is primarily intended to ensure the development, without outside interference, of the personality of each individual in his or her relations with other human beings.¹⁶³ Consequently, there is a 'zone of interaction'¹⁶⁴ of a person with others,

¹⁵⁷ According to Paul Needham, Director of Lancashire Tea Supplies Ltd, who said he referred to analytical data in relation to the company's website: BBC News at Six programme broadcast at 18.00 hours on 9.2.2015

¹⁵⁸ Such as the International Convention for the Protection of Industrial Property ("Paris Convention"); see 10bis on Unfair Competition section 3 (3) which compels signatories to prohibit "indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods".

¹⁵⁹ Such as Directive 2005/29/EC on Unfair Commercial Practices.

¹⁶⁰ *Fenty* n 6 [74]. Although in support of Clive Lawrence's continuum argument (n 34), the 'loss of control' could apply to all three elements of the classical trinity.

¹⁶¹ *Irvine* n 37 [77]

¹⁶² *Botta v Italy*, judgment of 24 February 1998, Reports of Judgments and Decisions 1998-I, 422, § 32.

¹⁶³ See: *mutatis mutandis*, *Niemietz v Germany*, judgment of 16 December 1992, Series A no. 251-B, 33, § 29; and *Botta* *ibid*

¹⁶⁴ *Von Hannover v Germany* [2004] ECHR 294 [50]

even in a public context, which may fall within the scope of “private life”.¹⁶⁵ Yet the long standing reticence of the English courts is evident even in *Rihanna*: we are reminded that ‘monopolies should not be so readily created’,¹⁶⁶ hence the extremely limited scope of the injunction.

Practical Consequences for Rights Holders, Retailers and Consumers

Post *Rihanna*, wise retailers will use indelible disclaimers to make it clear, where relevant, that their wares are not official or produced in collaboration with the artist;¹⁶⁷ otherwise they will no doubt trumpet the tie-up from the rooftops.

Celebrities ought not to turn away with ‘the chink of the distant till’ ringing in their ears. This expression was coined by the late Anthony Walton QC¹⁶⁸ to indicate the receipt of royalties without supervisory control.¹⁶⁹ In our view, it is difficult to prove that consumers will buy a product just because they think that royalties are being paid to the famous person depicted on merchandise (unless, perhaps, if it is associated with fund raising for charity). Therefore, it is vital that celebrities and rights holders exercise quality control over licensed merchandise to make it easier to prove material misrepresentation in relation to unauthorised products. At the very least, they should be on the lookout for the lack of the above disclaimers and refer to this case as a precedent for protecting the goodwill appurtenant to a famous name or image. Even where there are disclaimers, we believe they can be challenged on the basis of the reasoning in *Arsenal*.

¹⁶⁵ See: *mutatis mutandis*, *PG and JH v the United Kingdom*, no. 44787/98, § 56, ECHR 2001-IX; and *Peck v the United Kingdom*, no. 44647/98, § 57, ECHR 2003-I

¹⁶⁶ *Kitchin* citing *Elvis* n 53 (Lord Simon) 598; see also: Wadlow discussion concerning the ‘evils’ of monopoly, n 61 447

¹⁶⁷ Note the authors’ caveat above in the light *Arsenal* n 110 and *Asprey* n 112

¹⁶⁸ *Latterly* of Hogarth Chambers, London

¹⁶⁹ *Elvis* n 53 (Lord Simon) 598

For fans wanting to purchase official merchandise: they should listen out for the trumpeting of authentication or, at the very least, the 'chink of a distant till'.¹⁷⁰In their absence, they should check the label. But, what of the extension of the tort in *Irvine* and *Rihanna*? Passing off has been described as 'harness[ing] the self-protective energy of competitors to the protection of consumers'.¹⁷¹ Paradoxically, the extension may work to the detriment of consumers in terms of higher prices and less choice of merchandise.

Rihanna is of paramount importance, yet it leaves as much unanswered as it does settled in relation to image rights protection in England. This article suggests that by the upholding of the first instance decision by the Court of Appeal, image rights are advancing ever closer into English law and conversely, the more successful the user/owner of such right, the more likely infringement. Whilst the arguments for and against *sui generis* image rights protection (both philosophical and pragmatic) rage on, the pecuniary value of a famous persona and the commercial reality of licensing and endorsement contracts demand greater protection against misappropriation. However, passing off may not be the appropriate means to achieve this if you subscribe to the narrower interpretation of the classical trinity supported by Jacob and Carty.

Effective image protection will also require law makers to reconcile the commodification of real human beings with their dignitary rights, including their autonomy and privacy as broadly defined by the European Court of Human Rights in *Von Hannover*.¹⁷² After all, image may be everything¹⁷³ but, without protection, it is nothing.

¹⁷⁰Transcript of Court of Appeal hearing (day 1)

¹⁷¹ W R Cornish, 'The International Relations of Intellectual Property' CLJ (1993) 52(1) 46, 53

¹⁷²*Von Hannover* n 164 [50]

¹⁷³Based on the Canon slogan "Image is everything" used in the 1990 advertising campaign in which professional tennis player, Andre Agassi, endorsed Canon cameras, but was criticised for endorsing style over substance. The video is available on YouTube at <http://youtu.be/WpuFEpbE0d0>