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SHERLOCK HOLMES' SOUL IS AT RISK. THE GAME IS AFOOT.

Dr Angela Adrian

What does it mean to be a Celebrity? Or a Personality? There was a time when the answer to that question was fairly clear to most people. However, the technology boom that began during the second half of the 20th century changed all of that, and the laws regarding the protection of a person's name, portrait, picture, likeness, or voice have struggled to keep up with the evolving media in which these types of intellectual property can be exploited. In the United States, the term "right of publicity" was coined in the decision *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). However, the first state to pass a law prohibiting the use of a living person's "name, portrait or picture" was New York in 1903.¹

Elsewhere, this right of publicity developed into a concept of image rights. Image rights involve the commercial appropriation or exploitation of a person's identity and associated images linked to that person. Similar to publicity rights, they are related to the distinctive expressions, characteristics or attributes of, or associated with, a personality made available to public perception. Image rights are an integral part of artistic expression and a product of celebrity. Image Rights (Bailiwick of Guernsey) Ordinance 2012 establishes a new form of intellectual property, previously unrecognized in a registrable form. Two key concepts anchor the legislation: (1) the "registered personality", and (2) "images" which are associated with or registered against that registered personality. The core right is the registered personality.

The US right of publicity law shares some similarities with trademark and copyright law. For example, a shared common goal with the Lanham Act is to protect the consuming public from confusingly similar trademarks and to protect the owners of famous brands from the dilution of their marks.² The Lanham Act also contains provisions for redressing unfair competition based on false advertising, misappropriation, or passing off.³ Right of publicity laws in many states target the same type of harm. They provide a mechanism for protecting the value of a celebrity's name, likeness, and/or voice which may function as a "brand" of sorts. Such laws are designed to allow a person to control the exploitation of his or her image in a commercial way and otherwise. Likewise, an example of copyright similarity is the notion of

¹ N.Y. Civ. Rights Law § 50 (McKinney 2009).

² 15 U.S.C. §§ 1051 *et seq.*

³ *Id.* § 1125(a).

"transformative use" in assessing claims of fair use in right of publicity cases.⁴ However, the right of publicity does not have a fixation requirement, unlike copyright; and publicity rights can last longer than a copyright in those states affording generous post-mortem protection.⁵

Notwithstanding these similarities, right of publicity law remains a fluid and erratic area of protection due in part to the fact that not all states have enacted laws specifically protecting the right of publicity.⁶ This is why the Guernsey Image Right legislation can be so useful in the protection of personality. Firstly, it requires fixation; and as such, secondly, it can be registered.

According to Section 2(1) Image Rights Ordinance (IRO), "A registered personality is a property right obtained by the registration of a personality in the Register in accordance with the provisions of this Ordinance." Personality refers to the personality of the following types of person or subject which is described in the Image Rights Ordinance as the "personage". Section 1(1) IRO describes a "personage" as follows:

- (a) a natural person,
- (b) a legal person,
- (c) two or more natural persons or legal persons who are or who are publicly perceived to be intrinsically linked and who together have a joint personality ("joint personality"),
- (d) two or more natural persons or legal persons who are or who are publicly perceived to be linked in common purpose and who together form a collective group or team ("group"), or
- (e) a **fictional character** (emphasis added) of a human or non-human ("fictional character"),

whose personality –

- (i) is registered under this Ordinance (and is accordingly a "registered personality" for the purposes of this Ordinance), or
- (ii) is the subject of an application to be so registered.

"Personality" is defined in Section 1(2) IRO as "the personality of the person, two or more persons or character referred to in subsections (1)(a) to (e)." Section 1(5) IRO defines a "natural person" as a human being who - (a) is alive, or (b) has died within the period of 100 years preceding the date of

⁴ David Leichtman, Yakub Hazzard, David Martinez & Jordan S. Paul, *Transformative Use Comes of Age in Right of Publicity Litigation*, 4:1 *Landslide* 28 (Sept./Oct. 2011).

⁵ See Oklahoma's statute allowing for 100 years of protection after the protected individual's death. Okla. Stat. Ann. tit. 12, § 1448(G) (West 2012); see also Ind. Code Ann. § 32-36-1-8(a) (West 2012). A full listing of all of the right of publicity statutes in the United States can be found on Jonathan Faber's Right of Publicity website at <http://rightofpublicity.com/statutes>.

⁶ To date, 28 states offer common law right of publicity protection, but only 19 states have implemented right of publicity statutes, and of those, only a dozen protect this right postmortem. In addition, the scope of that postmortem protection differs dramatically in each state that treats right of publicity as a descendible right (10–100 years postmortem). Leichtman et al, *supra*.

filing the application for the registration of the personality. So, Robert Downey, Jr. would be a natural person, and so would, the deceased, Charlie Chaplin or Sir Arthur Conan Doyle. Moreover, Section 1(6) IRO defines a "legal person" as a body corporate or other body having legal personality that – (a) is currently in existence, registered or incorporated, or (b) has ceased to be in existence, registered or incorporated, for example by reason of having been liquidated, dissolved, wound up or struck off, within the period of 100 years preceding the date of filing the application for the registration of the personality. An example from the Ten Stories reveals that after Watson moved out of Baker Street, Holmes converted his practice into an "Agency" employing various informants and a "general utility man" named Mercer "who looks up routine business" for Holmes's Agency.⁷

Joint personalities and groups are also accounted for; for example, Holmes and Watson may be joint personalities; whereas, the Baker Street Irregulars may be both joint personalities and a group. Section 1(3) IRO clarifies this: "(3) A person who forms part of a - (a) joint personality, cannot be replaced by another person, (b) group, can be replaced by another person. (4) The persons forming a - (a) joint personality, may not change from time to time, (b) group, may change from time to time." Finally, examples of human fictional characters would be Sherlock Holmes and Dr John Watson⁸, and examples of non-human fictional character would be Shrek, Snoopy and Mickey Mouse.

"Image rights" are defined in s5(1) IRO as "exclusive rights in the images associated with or registered against the registered personality." Section 3(1) IRO defines "image" 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.”

Note that there is no requirement to register specific images associated with the registered personality beyond the personality's name itself. However, for there to be a benefit in registering and for easier enforcement, specific images are useful. A registered image is presumed to be distinctive and of value, which are requirements for infringement, whereas these qualities must

⁷ *Klinger v Conan Doyle's Estate*, Case No.: 1:13-cv-01226, US Dist. Ct. Nth Dist. Ill East. Div. (2013), Conan Doyle's Stmt. of Add'l Mat. Facts, ¶¶ 6(f).

⁸ Dr Joan Watson, from *Elementary*, may also be registerable.

be specifically proven in order to enforce rights in an unregistered image. The term 'image' is used in an extremely broad context.

Further, infringement damages or an account of profits will not be awarded where the defendant proves that at the date of infringement he did not know and had no reasonable grounds for knowing that the image was a registered personality's image. These conditions do not apply where the image infringed is registered. In this respect, think of Holmes's address, 221b Baker Street, the expression "Elementary, my dear Watson." or the ever changing images of Holmes, whether in disguise or with a magnifying glass crawling along the ground looking for spent matches. Even his style of detection could possibly be incorporated as an 'image' representing his personality.

"[A] complex literary personality can no more be unraveled without disintegration than a human personality."⁹ A society defines itself by a limited number of stories. These stories have their own icons and are particular to that society. In ancient Greece, it was the *Iliad* and the *Odyssey*; in the modern world, it is *Sherlock Holmes*. "There is currently a strong trend to 'propertize' everything in the realm of information. Intellectual property law is expanding on an almost daily basis as new rights are created or existing rights are applied to give intellectual property owners rights that they never would have had in an earlier time."¹⁰

Paul E. Thomas glibly describes the Estate of Conon Doyle's (CDE) argument as wanting the court to rule that Holmes and Watson have souls. "The souls of these characters are unitary, indivisible and so they cannot be divided from the entire series of 60 stories: "The arc of the character exists complete only in the series"¹¹ and therefore, the CDE argues, "it is impossible to split the characters into public domain versions and complete versions."¹² If this is accepted as a thesis, then it follows that the souls of Holmes and Watson must be protectable under copyright separate from the works in which they exist because the majority of those works are now so old that they lie in the public domain and out of copyright protection. Is this argument just self-serving, fanciful metaphysics on the part of the CDE?"¹³

US legal precedent exists for protecting characters separately from the works they inhabit. The theory originated with Judge Learned Hand who said, that "the less developed the characters, the less they can be copyrighted,"¹⁴ and it has been applied to protect not only cartoon characters such as Mickey Mouse (clearly copyrightable as a work of graphic art), but also the

⁹ *Klinger v Conon Doyle's Estate*, Case No.: 1:13-cv-01226, US Dist. Ct. Nth Dist. Ill East. Div. (2013)

¹⁰ Lemley, M (1997) *Romantic Authorship and the Rhetoric of Property*, 75 Tex. L. Rev. 873

¹¹ *Klinger, supra*

¹² *Id.*

¹³ Thomas, P (2013) *The Soul of Sherlock Holmes* available at

http://www.fredlaw.com/articles/ip/copy_1309_pet.html?goback=%2Egde_36621_member_276237809#%21

¹⁴ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (1930)

character personalities of James Bond, Rocky Balboa and Rhett Butler.¹⁵ The problem for the CDE in grounding its metaphysical argument in US law is that the line of precedent is thin.

One could then ask how can a Guernsey registration protect an American personality? As seen earlier, there is a move to a broader right of publicity which would include “likeness”. The case was brought by Vanna White against Samsung.¹⁶ In that case, Vanna White filed suit under the right of publicity against Samsung for using a robot in an evening gown and blond wig in an advertisement that evoked the aura of the *Wheel of Fortune* game show set. The robot was obviously not Vanna White, nor was it a look-alike human woman, so the conventional statutory right of publicity definition of “likeness” did not apply. However, the court held that under the common law right of publicity, a broader interpretation of “likeness” was appropriate—one that encompassed a commercially valuable identity brought to mind by the images depicted in the Samsung advertisement.¹⁷

Nowadays, our cultural icons are privately produced and privately owned by large corporations, like Disney. There is an impulse to fight against this. To not want Disney to be allowed to sue people for using Mickey Mouse in social satire occasionally. Likewise, we want to protect the moral rights of artists to ensure their artistic integrity against corporate rapacity.¹⁸ This impulse should be fought against. It is not a bad thing that Disney still owns the rights to Mickey Mouse; nor is it a bad thing that the Guernsey Image Rights Ordinance will allow them to extend this ownership. It will give Disney the incentive to preserve their icon. Likewise, it would not be bad for the Estate of Sir Arthur Conan Doyle to retain the ownership of the icons Sherlock Holmes and related characters and preserve them as they deem fit. Without these new forms of intellectual property protection, there would be nothing to stop dilution, tarnishing and cheap reproductions of these icons. Our world is not a better place if anyone can show Mickey Mouse shooting heroin.¹⁹

Private property rights in intellectual property goods are a simple result of changes in economic value that stem from the development of new technology and the opening of new markets. In providing for ownership of personas, it should be remembered why this is being done. The world of artistic expression is a marketplace in which resources are scarce. Sherlock Holmes should take advantage of the new law to protect his world and his soul.

¹⁵ *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287, 1296 (C.D. Cal. 1995)

¹⁶ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *petition for reh'g en banc denied*, 989 F.2d 1512 (9th Cir. 1993).

¹⁷ *Id.* at 1398.

¹⁸ Baird, D (2001) *Does Bogart still get scale? Rights of Publicity in the Digital Age*, 4 Green Bag 2d 357

¹⁹ *Walt Disney Productions v Air Pirates*, 581 F.2d 751 (9th Cir 1978)

This note is only intended to give a brief summary and general overview of this area of law. It is not intended to be, nor does it constitute, legal advice and should not be relied upon as doing so.

Dr Angela Adrian, BBA, MIM, JD, LL.M, PhD

Angela is a dual-qualified lawyer (US Attorney and English Solicitor). She is a leading authority on Intellectual Property and is the editor of the International Journal of Intellectual Property Management. Angela is respected academic, having published numerous papers and books and having taught IP at several international universities. Angela is a director and Chief Knowledge Officer of Icondia

Icondia comprises a team of experts that focus exclusively on the registration and management of image rights for an international customer base.

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