

Mickey Mouse Wants to Live Forever: Guernsey's Image Rights Ordinance Will Make that Possible

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☞ Deceased persons; Defences; Fictional characters; Guernsey; Image rights; Infringement; Public figures; Registration

The Image Rights (Bailiwick of Guernsey) Ordinance establishes a new form of intellectual property, previously unrecognised 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. Mickey Mouse can now register his image and be protected forever.

Introduction

The Image Rights (Bailiwick of Guernsey) Ordinance (IRO) establishes a new form of intellectual property, previously unrecognised in a registrable form anywhere else in the world. 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. Mickey Mouse can now register his image and be protected forever.

Image rights involve the commercial appropriation or exploitation of a person's identity and associated images linked to that person. 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 or sporting achievement in the 21st century. Sportsmen and sportswomen, film stars, pop stars, television personalities and many other well-known people successfully commercialise their images and enjoy large incomes from such exploitation. For example, by allowing their images to be associated with goods which are being sold or services being rendered, many modern celebrities earn more from this exploitation than from the “performance” fees in the activity which initially brought them to general notice. Further, there can be value in the fame of a celebrity long after that person's death. Therefore the value of image rights is such that they are already being actively managed and traded, despite the lack of clear legal recognition and the lack of clarity as

to the extent of the rights. There are several similarities between the infringement principles for image rights and those surrounding trade marks. This will be very useful from a case law perspective. As such, image rights are commercially valuable and build upon international standards for intellectual property.

Registered personality

According to s.2(1) 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 “personnage”. Section 1(1) IRO describes a “personnage” 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 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 s.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 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. Moreover, s.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”. Joint personalities and groups are also accounted for; for example, Laurel and Hardy may be joint personalities, whereas Van Halen 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 James Bond and Tintin, and examples of non-human fictional character would be Shrek, Snoopy and Mickey Mouse.

“Image rights” are defined in s.5(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 be specifically proven in order to enforce rights in an unregistered image. 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 Usain Bolt’s pose after he has won a race, the expression “Go ahead. Make my day” or the ever-changing images of Madonna.

Who can register?

There is provision made in the Image Rights Ordinance for the register to be publicly searchable. The main details that will be recorded on the Register of Personalities and Images are the name and address of the proprietor of the personality and image rights, together with date of registration (Pt III IRO). The date of application will be the date upon which all of the appropriate paperwork for an application has been received by the Registry (s.17(2) IRO). This may be important as the ultimate registration

date will be the application date—if there is a late filing of certain requirements this will affect when a proprietor can backdate any claim for damages for infringement.

Also entered on the register will be a list of any registrable transactions against a particular personality or image (ss.51–64 IRO). Such transactions would be:

- licence;
- assignment;
- assent by a representative;
- order of court; or
- other transactions as may be prescribed (such as security granted over the image rights).

The starting point is therefore to be registered as the proprietor of a registered personality. That proprietor has the image rights and other rights and remedies provided by the Image Rights Ordinance s.2(2). The person registered as the proprietor is, by reason of the fact of registration alone, the legal owner of the registered personality and the image rights and other rights in that registered personality. Further, “the name of a personality does not have to be the same as the name of the personage” (s.1(7) IRO). Lady Gaga would be a good example of this.

Under the Image Rights Ordinance s.2(3), the proprietor of the registered personality and associated image(s) can be different from the actual personage. In many cases the personage will have assigned the rights to exploit their image to a third party. Hence the application process under the Image Rights Ordinance allows for the registered proprietor and the personage to be different persons. As such, the legal owner of the rights to exploit the personality’s images is the person entitled to be registered as the proprietor of the registered personality; if the personage has retained rights in their image, they (or their personal representative) are entitled to be registered as the proprietor.

As to fictional characters, the creator of the fictional character is, generally, the prospective proprietor of the fictional character’s personality, together with any image rights therein. A legal person’s personality can be registered, so arguably, therefore, Disney could be a registered personality, thereby getting protection for cartoon characters associated with Disney, such as Mickey Mouse, Donald Duck and Winnie the Pooh, and/or these characters could be registered personalities in their own right.

Why an image may not be registered

The Image Rights Ordinance ss.6–10 set out various grounds for refusal of registration of a personality or an image. These effectively either complement or mirror existing trade mark laws and rules and fall into two categories—absolute grounds for refusal and relative grounds for refusal. It should be noted that the Image Rights Ordinance additionally allows for grounds which may be determined by the Registrar (s.6(g) IRO).

Absolute grounds

An absolute ground is one where the Registry itself fundamentally objects to the registration of the right. Such an objection may be raised on the following grounds:

- what is applied for does not satisfy the definition of a personality or image (s.6(a) IRO);
- it is contrary to public policy or morality (e.g. Jesus) (s.6(b) IRO);
- it is deceptive to the public (s.6(d) IRO);
- the image or personality includes a representation of a protected emblem, such as a national flag, the Olympic symbol, image of the Queen (ss.6(d)(i) and 7 IRO);
- use is prohibited by Guernsey law (s.6(e) IRO);
- the application is in bad faith (s.6(f) IRO);
- the application includes any statement, information, or document which constitutes an intellectual property offence under Guernsey law (s.6(g) IRO); and/or
- the image has, or in the case of a personality, the images associated with the personality have, become so customary or generic as to no longer identify a specific personality (s.6(h) IRO).

Section 6(h) IRO may be a difficult concept in relation to image rights. For example, registering XXXL for clothing would not be possible. However, how this applies to images is not so obvious.

Relative grounds

According to ss.8 and 9 IRO, a relative ground for refusal is where the personality or image applied for is deemed to be identical or confusingly similar to an existing registered personality or registered image, or similar to an existing registered personality or registered image where use without due cause would take unfair advantage or be detrimental.

The notion of what is identical or similar is much more difficult than it seems. Trade mark courts have been struggling for decades over what “confusingly similar” and “likelihood of association” may mean in practice. Would Stig’s eyes through a visor be similar to his face on its own? Would any two people wearing a crash helmet look the same if photographed from the same angle? If so, would it cause confusion?

Another relative ground for refusal is where there is an earlier right in relation to the personality or image applied for, whether this be trade mark rights, copyright, design rights or otherwise. In practice, it is likely that the Registrar will not examine applications for relative grounds but will rely on the declaration that the applicant is required to make that the registration of the personality or image applied for is not, to the best of its knowledge,

prohibited by virtue of any existing registered personalities, existing registered images or other earlier rights (s.10 IRO).

What do you get?

As explained above, the registration of a personality gives the registered proprietor exclusive rights in the images associated with or registered against the registered personality. This is a step forward in intellectual property rights from the more amorphous right of publicity. The right of publicity has lacked the analytical support of most intellectual property rationales. Those who oppose a right of publicity say it is a threat to a robust public domain, creative outputs and freedom of expression. The digital image right granted in Guernsey avoids these issues by substantiating the recognition of personhood interests of a dignitary nature.¹ This new right will assist artists who find their performance undervalued and appropriated without redress as well as assisting non-celebrities who have found themselves with a right but no remedy for the misappropriation of their image.

Further, this new law allows these rights to be transferable. A registered personality and the image rights in it are personal or movable property (s.51 IRO). As such, it is transmissible by assignment provided that certain requirements are met, namely that an assignment is not effective unless it is in writing signed by or on behalf of the registered proprietor (s.52 IRO). There are provisions requiring registration of certain transactions affecting registered personalities and image rights. These include, most importantly, assignment and granting of a licence (ss.61–64 IRO).

The registration of a personality lasts for a period of 10 years from the date of registration and may be renewed for further periods of 10 years. Where a specific image has been registered against the registered personality, the registration of that image lasts for three years and may be renewed for further periods of three years (ss.18 and 19 IRO).

Until the application has been made for registration of the registrable transaction, the transaction is ineffective as against a person acquiring a conflicting interest. This is subject to the provision that there are no reasonable grounds of knowledge. The “licensee” has no rights or remedies in relation to infringement (s.63 IRO). Upon registration, the licensee acquires certain rights to call on the proprietor to bring infringement proceedings and/or bring infringement proceedings itself. This is a very important step in the protection of image rights. As they currently only relate to the individual and are currently drafted on a purely contractual basis, the licensee has to rely on the individual themselves to enforce the right. With registered image rights the club or the brand as licensee will be able to enforce the rights directly under certain circumstances. This mirrors trade mark principles.

¹ K.J. Greene, “From Second Life to the Afterlife: Intellectual Property Expansion” (2008) 11 Chap. L. Rev. 521.

Infringing the image right

The similarities to the infringement principles surrounding trade marks are very useful from a case law perspective. There is an additional layer of complication to the infringement provisions. Only a “protected image” can be infringed (s.27(2) IRO). To be a protected image, at the time of the alleged infringement the image has to be “distinctive” (s.28 IRO), have “actual or potential value” (s.29 IRO) and satisfy the registrability requirements of an image (whether or not it is in fact registered, s.27(2)(c) IRO).

An image is “distinctive” if it is recognised as being associated with the registered personality by a wide or relevant sector of the public in any part of the world, and various factors are provided for determining whether an image is distinctive. Notably, a registered image is presumed to be distinctive. This presumption can be rebutted. An image has “actual or potential value” if it can or has the potential to be exploited for valuable consideration. Again, a registered image is presumed to have actual or potential value; likewise, this can be rebutted.

A registered personality’s image rights are infringed by the use for a commercial purpose or a financial or economic benefit, without the consent of the proprietor of the image rights, of an image:

- “(a) Which is identical or similar to a protected image and because of that there exists a likelihood of confusion on the part of the public (which includes the likelihood of association with the registered personality); or
- (b) Which is identical or similar to a protected image and the use without due cause (i) takes unfair advantage of the distinctive character or repute of the personage, or (ii) is detrimental to the distinctive character or repute of the personage, or the value of the registered personality or its images.”(s.27(1) IRO)

Unauthorised use

The Image Rights Ordinance s.27(3) provides a wide and non-exhaustive definition of what constitutes unauthorised use of an image, including:

- use of the image in a communication to the public (communication being broadly defined as any form of communication including without limitation personal appearances, exhibitions, artistic works, drawings, documents, photographs, pictures, recordings, motion pictures, films, broadcasts, publications, websites and electronic communications);

- use of the image in connection with sponsorship or for the purposes of marketing or endorsing goods, services, activities or events;
- use of the image in relation to goods or image carriers;
- use of the image as a domain name or as a company name.

The Guernsey Court may analogise to English copyright and trade mark law in the interpretation of the concepts of “use” and “communication to the public”. These are wide-ranging definitions for infringement and they do not limit the use to particular goods or services as with a trade mark. As a result, this is a powerful right which is particularly attractive to brand owners.

Defences

There are provisions (ss.23 and 24 IRO) in the Image Rights Ordinance dealing with invalidity and revocation of registrations. Sections 31–40 IRO detail a number of public interest defences or exceptions to infringement, including:

- comparative advertising, provided the use is in accordance with honest practices in trade, industrial, commercial or not-for-profit matters;
- incidental use;
- merely descriptive use where used fairly and in good faith only to identify something other than the personage;
- fair dealing for the purposes of research;
- fair dealing for the purposes of news reporting, commentary and satire;
- fair dealing for the purposes of the arts;
- things done for the purposes of education;
- fair dealing for any other purpose;
- acts of public administration and law enforcement or done under statutory authority;
- making of temporary copies (internet);
- subject to any agreement to the contrary, use of an image by the personage, or a person’s use of their own image; and
- exhaustion of rights in goods put on the market.

Is this law really a good idea?

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 modern America, it is *Fantasia* and *Pirates of the Caribbean*:

“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.”²

Some feel that this is not a good idea:

“If a man has any natural rights, not the least must be a right to imitate his fellows, and thus reap where he has not sown. Education, after all, proceeds from a kind of mimicry, and progress, if it is not entirely an illusion, depends on a generous indulgence of copyright.”³

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.⁴ 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. 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.⁵

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. For example, a producer should not be able to cast a young Sean Connery in a new James Bond film without having contracted for the right, either in the past or in the present, with the Sean Connery of today. This is not about moral rights, artistic integrity or Sean’s sensibilities; it is about markets.

The world of artistic expression is a marketplace in which resources are scarce. The right question to ask about image rights is whether crafting this law has made the world a better place.

² M. Lemley, “Romantic Authorship and the Rhetoric of Property” (1997) 75 *Tex. L. Rev.* 873.

³ B. Kaplan, *An Unhurried View of Copyright* (New York: LexisNexis, 1967).

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

⁵ *Walt Disney Productions v Air Pirates* 581 F. 2d 751 (9th Cir. 1978)