

Trademark Dilution, Right of Publicity, Image Rights: A Comparative Analysis of US, UK, Australian and Japanese Law

I. Introduction

During the past 20 years, the cult of the celebrity has grown to such an extent that celebrities and personalities are able to generate wealth through their images. Traditionally, the celebrity was controlled by the corporations to which they were contracted - whether these are movie studios, record companies, sports clubs, and so on. Now, the individual has been able to take control of his/her affairs and how his/her image rights and other intellectual property generally has become ever more valuable.¹ This inevitability of recognition of personality rights is compounded by the commercial practice of ‘image rights’ contracts.

1. Background

Historically, copyright, trademark, and unfair trade practice laws were used to prevent unauthorized use of creative work or distinctive logo associated with an individual. These tools are purpose-specific and limited in their application. For example, “[t]rademark dilution is defined as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition between the owner of the famous mark and other parties or of likelihood of confusion. This typically occurs as the result of blurring or tarnishment of the famous mark.”² Individuals, however, are unable to trademark their personalities.

Thus far, there has been no mechanism for an individual to control who may benefit from an association with a celebrity personality. The perception by others of our own person is what imbues us with ‘personality’.³ This personality is unique and distinctive to the individual concerned. If that person is a recognized celebrity, then there is value for other parties in being associated with that personality. This value, and the rights associated with it, is generally what are known as ‘image rights’.⁴

¹ Evans, D & Stone, E (2013) *What is an Image?* Guernsey Finance available at <http://www.mondaq.com/x/222628/Trademark/Whats+In+An+Image>

²“Dilution developed from the concept that some marks are so well-known and ‘famous’ that they deserve an extra level of protection beyond the likelihood of confusion analysis. Dilution theory seeks to prevent the coexistence of marks that are sufficiently similar to a famous mark regardless of the goods/services associated with the allegedly diluting mark.” International Trademark Association, *Fact Sheets: Protecting a Trademark* available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkDilution.aspx>

³ Adrian, A (2010) *Law and Order in Virtual Worlds: Exploring Avatars, their Ownership and Rights*. Hershey, PA: IGI Global

⁴ Adrian, A (2013) *Image is Everything* available at <http://icondia.com/wp-content/uploads/2014/01/Image-is-Everything.pdf> [hereinafter, Adrian (2013a)]

There have been numerous cases where recognized celebrities have attempted to use copyright or trademark laws to prevent the unauthorized benefit by others of characteristics unique to the personality concerned. A justification for image rights could be based on the notions of human dignity and unjust enrichment. Individuals should not be exploited even if the exploitation costs them nothing, and even if the image right gives individuals a personal gain with no corresponding economic benefit to the public. Laws have been slow to see the implications of the need for respect for human dignity and private life.⁵ As such, publicity rights are an inconsistent or non-existent theory of law in many jurisdictions.⁶ The Bailiwick of Guernsey filled this gap by passing a law in December 2012 to specifically protect Image Rights.

2. Celebrity & Publicity

Sportsmen, film stars, pop stars, television personalities, and many other well-known people successfully commercialize 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.⁷ Further, there can be value in the fame of a celebrity long after that person’s death.⁸ 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. Nonetheless, image rights are commercially valuable and build upon international standards for intellectual property.⁹

Traditionally, there are two aspects of image rights that a celebrity is concerned with, namely:

1. exploitation of image rights through sale and transfer (e.g. licensing arrangements);
and
2. protection of the image rights (and therefore their inherent value) through possible registration and (if necessary) infringement proceedings.¹⁰

⁵ Tugendhat, M (2003) *Exploitation of Image Rights in the UK* available at <http://fbis.eu/wp-content/uploads/2013/03/2002-Exploitation-of-Image-Rights-in-the-UK-by-Michael-Tugendhat-QC.pdf>

⁶ Trademark dilution also offers confused and unpredictable results. “The law protects marks from the existence of subsequent ‘confusingly similar’ marks. Claiming a likelihood of confusion requires a showing of similarity of the marks in sight, sound or meaning, combined with evidence that the marks being compared are associated with identical, competing, similar or related goods/services. Under this analysis, similar and possibly even identical marks used with distinguishable goods/services or goods/services traveling in different channels of trade may coexist in the same market.” International Trademark Association, *Fact Sheets: Protecting a Trademark* available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkDilution.aspx>

⁷ Elberse, A & Verleun, J (2012) *The Economic Value of Celebrity Endorsements*, *Journal of Advertising Research* Vol. 52, No. 2, p 149

⁸ Caulkins, N (2001) *A Trustee’s Duties when a Celebrity Persona is the Asset*, 83 *J. Pat. & Trademark Off. Soc’y* 31

⁹ Adrian, A (2013) *Mickey Mouse wants to live forever: The Guernsey Image Rights Ordinance may allow that*, *European Intellectual Property Review*, Vol. 35, No. 7 at 397 [hereinafter Adrian (2013b)]

¹⁰ Adrian (2013a) *supra*

The Guernsey law provides several similarities between the infringement principles for image rights and those surrounding trademarks. This is very useful from a case law perspective. The ability to record one’s legal property in an image right through registration aids both the economic exploitation of the right and also its protection. For those attempting to stop another person actually trading on their image or personal goodwill without consent, a combination of the current legal remedies often has been used together to build a less than perfect case to restrain an offending party and account for profits earned.

In short, there has been a demonstrable void in the law prior to the *Image Rights (Bailiwick of Guernsey) Ordinance 2012* (IRO) to enable a person to adequately exploit and protect distinctive attributes of a person’s character, or personality.

(1) United States

The United States has perhaps the most complete and straightforward set of laws and policy considerations with regard to the right of publicity which grew out of an economic policy framework.¹¹ The Restatement of Unfair Competition defines the right of publicity as the appropriation of trade values. “One who causes harm to the commercial relations of another by appropriating the other’s intangible trade values is subject to liability to the other for such harm only if . . . the actor is subject to liability for an appropriation of the commercial value of the other’s identity.”¹² Section 46 of the Restatement states that “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for the purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.”¹³

The right of publicity is a state-based right, as opposed to a federal right; although, it interacts closely with 1st Amendment rights.¹⁴ In most state jurisdictions without a specific statute, the right may still be recognized at common law.¹⁵ The rights are based in tort law, and the four causes of action are:

- intrusion upon physical solitude;

¹¹ Grant, E (2006) *The Right of Publicity: Recovering Stolen Identities under International Law*, 7 San Diego Int’l L. J. 559

¹² Restatement (Third) of Unfair Competition 38 (1995)

¹³ Restatement (Third) of Unfair Competition 46 (1995)

¹⁴ United States Constitution, Amendment 1: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.”

¹⁵ US states that recognize rights of publicity: Alabama (common law); California (statute and common law); Connecticut (common law); Florida (statute); Georgia (common law); Hawaii (statute); Illinois (statute); Indiana (statute); Kentucky (statute and common law); Massachusetts (statute); Michigan (common law); Minnesota (common law); Missouri (common law); Nebraska (statute); Nevada (statute); New Jersey (common law); New York (statute); Ohio (common law); Oklahoma (statute); Pennsylvania (common law); Rhode Island (statute); Tennessee (statute); Texas (common law); Utah (statute and common law); Virginia (statute); Washington (statute); Wisconsin (statute and common law)

- public disclosure of private facts;
- depiction in a false light; and
- appropriation of name and likeness.¹⁶

Fundamentally, the right of publicity is an individual's right to prevent others from commercially exploiting his/her identity without permission. Given the growth in this area of law, the right is available to nearly everyone, not just celebrities. If you, as an individual or company, violate another person's right of publicity, whether or not they are well-known, you can be forced to remove the content in question and/or pay monetary damages to that individual.¹⁷

A recent case, *Fraleley v. Facebook, Inc.*,¹⁸ is a class action lawsuit against Facebook[®] over its 'Sponsored Stories' advertising services. This lawsuit arose because certain Facebook[®] users were upset when they discovered that their names and user profile photographs were arranged by Facebook[®] in the perimeter of newsfeeds viewed by their friends based on their 'likes' of various branded products.¹⁹ Noteworthy were Facebook's[®] own admissions that such advertising has approximately double the value of an advertisement without an accompanying 'testimonial' allowed the case to survive a motion to dismiss.²⁰ Given that the plaintiffs in *Fraleley* were able to show a "direct, linear relationship between the value of their endorsements of third-party products, companies, and brands to their Facebook[®] friends, and the alleged commercial profit gained by Facebook[®]," they have been allowed to continue their right of publicity case.²¹

(2) United Kingdom

In the United Kingdom, while not specifically recognized by statute, image rights are conceptually recognized and dealt with by the legal system on a daily basis. The standard Premier League Football[®] Players Contract specifically defines and deals with the ownership and commercial exploitation of a club footballer's image rights in great detail.²² However, because there is no public registration creating a property right like a trademark for image rights in the United Kingdom, only the parties to an image rights contract will be aware of and privy to the ownership rights created and dealt with therein. This may be desirable in some cases, but in others

¹⁶ Adrian, A (2013a) supra; see also, Boisineau, L (2012) *The Right of Publicity and the Social Media Revolution*, Landslide[®] 5:2

¹⁷ Ibid

¹⁸ 11-CV-01726 (N.D. Cal., Apr. 4, 2011)

¹⁹ Ibid

²⁰ Ibid

²¹ Although a Preliminary Approval Order has been made (*Fraleley v. Facebook, Inc., et al.*, no. 11-CV-01726 (N.D. Cal., Apr. 4, 2011), Amended Settlement Agreement, October 5, 2012), the Court held a Fairness Hearing in San Francisco on June 28, 2013. The Court issued its Order Granting Motion for Final Approval of Settlement Agreement on August 26, 2013, and the Final Judgment on September 19, 2013. However, appeals have been filed. Before any settlement payments can be made, all appeals filed must be resolved. To follow this case go to <http://www.fraleleyfacebooksettlement.com/>

²² *Proactive Sports Management Ltd v Rooney* [2011] EWCA 1444 Civ; [2012] FSR 16, Wayne Rooney's 'Off-Field' image case considered the application of the doctrine of restraint of trade.

the owner of such a valuable right by way of assignment or license may want to publicly record and protect that ownership interest.²³

There have been two significant developments in the cases of *Irvine v Talksport*²⁴ and *Douglas v Hello!*²⁵ In brief, the protection for publicity rights in the UK can be seen to derive from two torts: passing off and breach of confidence. These two torts reflect different elements of the commercial and personal practice of exploiting image and identity; and, they correspond to the prevailing philosophies of the US business concerns and the European dignity concerns.²⁶ Nonetheless, this is a simplification of the position in all jurisdictions.

(3) Australia

Australia tends to follow the traditional United Kingdom approach and does not currently embrace a discrete legal category known as a ‘right of publicity’.²⁷ As such, there is no comprehensive protection of the commercial value attaching to features of celebrity identity such as name, likeness and image.²⁸ This is despite calls for the statutory development of such a right.²⁹ Nor does Australia protect ‘personality rights’ of individuals on the basis of privacy.³⁰ In order to prevent the use of or to be compensated for said use of his/her identity, a celebrity must seek to fit his/her claim within one of the common law or statutory intellectual property regimes such as trademark,³¹ copyright and design law,³² trade practices legislation,³³ and/or passing off.³⁴

²³ Adrian (2013a) supra

²⁴ Reported in the High Court at [2002] EWHC 367 (Ch) and, on appeal, *Irvine & Ors v Talksport Ltd* [2003] EWCA Civ 423

²⁵ Reported in the High Court at [2003] EWHC (Ch) 786, on appeal to the Court of Appeal at [2005] EWCA Civ 595, and on appeal to the House of Lords at [2007] UKHL 21

²⁶ Black, G (2011) *Exploiting Image: Making a Case for the Legal Regulation of Publicity Rights in the United Kingdom*, 5 European Intellectual Property Review 413

²⁷ Weathered, L (2000) *Trademarking Celebrity Image: The Impact of Distinctiveness and Use as a Trademark*, 12 Bond Law Review 161

²⁸ Harvey, C (1996) *The Medium Is the Message*, 1 Media & Arts Law Review 182

²⁹ Black, H M (2000) *Corporations Law Goes into Bat for Bradman*, 4 Telemedia 97; Ricketson, S (1990) *Character Merchandising in Australia: Its Benefits and Burdens*, 1 Intellectual Property Journal 191

³⁰ Harvey (1996) supra. Further, *Australian Broadcasting Corporation v Lenah Game Meats* (2001) 208 CLR 199 (‘*Lenah Game Meats*’), has re-opened the debate over the protection of individual privacy interests at common law, thought to have been long settled by the decision in *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479 (‘*Victoria Park*’). In *Lenah Game Meats*, Gaudron, Gummow, Hayne and Callinan JJ expressed the view that *Victoria Park* does not necessarily preclude the development of a tort of unjustified invasion of privacy. (*Lenah Game Meats* at 248 (Gummow and Hayne JJ), 231 (Gaudron J agreeing), 320–4 (Callinan J)). Interestingly, Callinan J, reflecting on the decision in *Victoria Park*, states that: ‘It may be that the time is approaching ... for the recognition of a form of property in a spectacle. There is no reason why the law should not, as they emerge, or their value becomes evident, recognize new forms of property’. (Ibid at 321) See also the case of *Grosse v Purvis* [2003] Aust Torts Reports 81, where the District Court of Queensland granted the plaintiff damages for breach of privacy, with Skoien J stating: “. . . in my view within the individual judgments [of the *Lenah Game Meats* decision] certain critical propositions can be identified with sufficient clarity to found the existence of a common law cause of action for invasion of privacy. . . . It is a bold step to take ... [b]ut I see it as a logical and desirable step.” Zapparoni, R (2004) *Propertizing Identity: Understanding the United States Right of Publicity and Its Implications - Some Lessons for Australia*, 28(3) Melbourne University Law Review 690

³¹ Black, H M (2002) *The Role of Trademark Law* 7 Media & Arts Law Review 101

³² Catanzariti, T (2001) *Swimmers, Surfers, and Sue Smith: Personality Rights in Australia*, available at <http://www.13wentworthselbornechambers.com.au/pdfs/personalityrights.pdf>

³³ Section 52 of the *Competition and Consumer Act 2010* (CCA) (formerly the *Trade Practices Act 1974*) prohibits a corporation, in trade or commerce, from engaging in misleading or deceptive conduct, or conduct likely to mislead or deceive. See, *Talmax Pty Ltd*

However, this protection is limited, being ‘incidental, in the sense that it is a by-product of the protection of some other subject-matter.’³⁵

As such, passing off was broadened to “meet new circumstances involving the deceptive or confusing use of names, descriptive terms or other indicia”³⁶ In *Henderson v Radio Corp.*, the appropriation of reputation was considered “an injury in itself, no less, in our opinion, than the appropriation of . . . goods or money”.³⁷ The tort of passing off is a mechanism for commercial purposes. It ignores any aspects of human dignity. In its traditional form as a cause of action, it was useless for the protection of commercial personality rights.³⁸ Now, however, the cause of action has become more appropriate,³⁹ at least as long as it involves famous people. Non-celebrities have a much more difficult time.⁴⁰

(4) Japan

Despite Japan’s civil law tradition, Japanese courts acknowledge privacy and publicity rights as constitutional, moral rights even though they are not explicitly mentioned in either the Constitution or specific legislation.⁴¹ Names, likenesses and signatures may be protected. However, there is no judicial precedent or academic opinion regarding the protection of a person’s voice or persona; these may not be protected.⁴² The Japanese courts acknowledge that a celebrity’s right of publicity arises out of an economic interest, and protects that right under tort law even without a showing of mental suffering.⁴³ Liability has sometimes been found even where the unauthorized use of a person’s likeness occurs in a news reporting context.⁴⁴

Japan recognizes that celebrities have both a right of publicity - an economic right, and a right of privacy - a moral right.⁴⁵ A celebrity’s moral right is infringed if his/her name or likeness

v Telstra Corporation Ltd [1997] 2 Qd R 444. This case involved the use of a photograph of well-known sporting personality, Kieren Perkins, in association with a Telstra advertisement. The Full Federal Court granted a remedy which in part sought to compensate for the fact that the unauthorized publication ‘diminished [Perkins’] opportunity to exploit his name, image and reputation.’ *Ibid*

³⁴ Crennan, S (1995) *The Commercial Exploitation of Personality*, 8 Australian Intellectual Property Law Bulletin 10

³⁵ Ricketson (1990) *supra*

³⁶ *Moorgate Tobacco v Philip Morris*, 156 CLR 414, at 445 [1984]

³⁷ Supreme Court of New South Wales per Evatt CJ and Myers J., *Henderson v Radio Corporation Pty Ltd*, SR (NSW) 567, at 595 [1960]

³⁸ Elmslie, M & Lewis, M (1992) *Passing Off and Image Marketing in the UK*, 8 EIPR 270

³⁹ Sloper, K & Cordery, J (2002) *Personality Endorsement New Brands Hatch*, 13(5) Ent. Law Review 106

⁴⁰ Goodenough, O (1997) *Re-Theorizing Privacy and Publicity*, 1 IPQ 37-70

⁴¹ LaFrance, M & Cline, G (2008) *Identical Cousins: On the Road with Dilution and the Right of Publicity*, 24 Santa Clara Computer & High Tech. L.J. 641. Nevertheless, the right is recognized by reference to the Constitution, the Civil Code, the Copyright Act, or a combination of the three.

⁴² Kasahara, C (2013) *Right of Publicity in 22 Jurisdictions, Japan*, Getting the Deal Through available at http://www.aplaw.jp/file/Getting_the_Deal_Through_Right_of_Publicity2013.pdf

⁴³ *Mark Lester v. Tokyo Daiichi Film*, 817 HANREI JIHO 23 (Tokyo D. Ct., June 29, 1976)

⁴⁴ Henry, M (2000) *International Privacy, Publicity and Personality Laws*. London: Butterworths

⁴⁵ LaFrance & Cline (2008) *supra*

is used in a way that harms his/her fame or reputation.⁴⁶ Absent such harm, only the economic right is infringed. Finally, the right of publicity is not limited to name or likeness. The Tokyo District Court has held that “the essence of the right to publicity is the power to attract public attention,” and that the right extends to “any matter with economic value, arising out of that celebrities’ [sic] fame or reputation due to the attraction of public attention.”⁴⁷

(5) International Conventions

Until now, anyone wanting to try and protect their image rights from unauthorized infringement had to rely on a collection of statutory and common law causes of action, which are often not entirely suitable for the job at hand. There are two intellectual property treaties which closely approximate protection for the right of publicity but which fail to properly address infringement of the celebrity persona. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) requires its members to enact laws with a variety of intellectual property rights, including service marks.⁴⁸ Although many publicity rights claims coincide with trademark or service mark infringements, the two doctrines serve different purposes and different rights. This forces litigants to shape and twist their claims in order to recover damages or injunctive relief.

Publicity rights fare no better under the Berne Convention for Protection of Literary and Artistic Works. This convention covers copyrights and moral rights which are usually tangential to publicity rights claims.⁴⁹ The convention protects copyrightable ‘works of authorship’ which has a very narrow interpretation which does not sit well with a persona; although the underlying rationales are very similar, the right of publicity is not protected.⁵⁰

II. Differentiation between Trademark Dilution and Publicity Rights

The function of trademarks in society has evolved as business and society has changed.⁵¹ Originally, trademarks indicated the source of origin for manufactured goods which had passed through many middlemen before their ultimate purchase by a consumer. This later developed into a general source of origin indicator for consumers. However, with the development of licensing and

⁴⁶ Ibid

⁴⁷ *King Crimson* case, 1644 HANREI JIHO 141 (Tokyo D. Court, January 21, 1998)

⁴⁸ Agreement of Trade-Related Aspects of Intellectual Property Rights, Apr 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments-Results of the Uruguay Round vol. 31, 33 I.L.M. 81 (1994)

⁴⁹ Berne Convention for Protection of Literary and Artistic Works, Sept 9, 1886, 828 UNTS 221 (last revised at Paris, July 24, 1971)

⁵⁰ Grant (2006) supra

⁵¹ Ibid

franchising the ‘origin’ function of trademarks declined.⁵² Today, trademarks perform a variety of economic functions. They fulfill both a product-identifying function and a communication function. Some trademarks have an intrinsic reputation. As such, these two concepts suggest a utilitarian justification of the dilution doctrine which, in turn, ensures that trademarks can fulfill their economic and social functions.⁵³

“In the United States, the dilution doctrine and the right of publicity have a great deal in common - not in their origins, but in their current application.”⁵⁴ This next section compares and contrasts these parallel concepts in the United States, United Kingdom, Australia and Japan.

1. United States

The right of publicity acknowledges that a property right exists in one’s identity, whether it is his/her likeness, voice, or other distinguishing characteristic. “The right of publicity, the recognition of a property right in the commercial use of a person’s indicia of identity, appears to be an invention of US judges and lawmakers Initially based on a perceived ‘natural right’ of privacy and nurtured by judicial concern for deterring unfair competition through consumer deception.”⁵⁵ J. Thomas McCarthy explained that the right of publicity was “the inherent right of every human being to control the commercial use of his/her identity.”⁵⁶

The ‘right of publicity’ was first adopted by Judge Frank, in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*⁵⁷ with brief explanation of it as an economic, not a personal right: “We think that, in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph . . . [and] to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made ‘in gross’ This right might be called a ‘right of publicity.’”⁵⁸ This is not just a property right; it is a personal right. The right of publicity should protect a person’s right to privacy as well as the economic and commercial value in their likeness or other discernible characteristics.⁵⁹

Some have argued that the structure and content of trademark law provides a theoretical

⁵² Ohbhai, R (2001) *Traditional and Contemporary Functions of Trademarks*, 12 J. Contemp. Legal Issues 16

⁵³ Strasser, M (2000) *The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context*, 10 Fordham Intell. Prop., Media & Ent, L.J. 375

⁵⁴ LaFrance & Cline (2008) *supra*

⁵⁵ Dougherty, F.J. (1998) *Foreword: The Right of Publicity—Towards a Comparative and International Perspective*, 18 Loy. L.A. Ent. L. Rev. 421

⁵⁶ *Intellectual Property and CyberLaw at the University of San Francisco*, J. Thomas McCarthy Institute for Intellectual Property and Technology Law at the University of San Francisco School of Law, available at <http://www.usfca.edu/law/mccarthy/>;

McCarthy, J.T. (2007) *The Rights of Publicity and Privacy* (2d ed) § 1:26, New York: Thomson

⁵⁷ *Haelan Laboratories, Inc. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953)

⁵⁸ *Ibid*

⁵⁹ *Ibid*

justification for a bounded right of publicity.⁶⁰ Neither law is concerned with the encouragement of new creation, as is the case with other forms of intellectual property rights. Both laws deal with the protection of names in the context of commercial uses. Despite the fact that the majority of right of publicity cases fit within the established *framework* of trademark law, they apply the *doctrine* in ways that diverge significantly from what the trademark analogy would suggest.⁶¹

Traditional trademark doctrine only protects against the use of the same or a similar mark as a brand - generally by competitors - in situations where the consuming public would be confused.⁶² The rationale for such protection is straightforward. Trademarks allow companies to build goodwill in their products, reduce the searching cost to consumers and reward manufacturers with a return on investments in product quality.⁶³ The consumer confusion rationale is fundamental to a variety of legal doctrines in trademark law. Consumer reactions are sought for diverse reasons including: whether a mark is protectable at all, whether a once-protected mark should be denied protection because it is generic⁶⁴, whether a defendant's mark is sufficiently similar to be infringing, and what remedy is appropriate if it is infringing.⁶⁵ Consumer reactions also affect other doctrines such as who is entitled to priority of trademark use and whether it is permissible to parody a mark.⁶⁶ Consumer confusion justifies the establishment of a right of publicity only to the extent that there is actual consumer confusion. If a defendant uses a celebrity's persona in a manner that calls to mind his/her name but does *not* confuse consumers, this justification will not apply.⁶⁷ Unfortunately and typically, courts in these cases do not ask whether, in fact, consumers are confused.⁶⁸

Nonetheless, trademark law is cited whenever consumers would believe that there is an affiliation, sponsorship, or other association between the trademark holder and someone else selling goods under a similar mark. The law is no longer restricted to cases of 'passing off' goods as produced by the trademark holder.⁶⁹ Celebrities, unlike trademark owners, do not typically sell

⁶⁰ Cf. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003): noting that "[t]he elements of a Lanham Act false endorsement claim are similar to the elements of a right of publicity claim".

⁶¹ Dogan, S & Lemley, M (2006) *What the Right of Publicity can Learn from Trademark Law*, 58 Stan. L. Rev. 1161

⁶² See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992): "The Lanham Act was intended to make actionable the deceptive and misleading use of marks and to protect persons engaged in commerce against unfair competition." (internal quotations omitted); Brown, R (1948) *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L.J. 1165

⁶³ Dogan, S & Lemley, M (2004) *Trademarks and Consumer Search Costs on the Internet*, 41 Hous. L. Rev. 777

⁶⁴ Ingram, J D (2004) *The Genericide of Trademarks* 2 Buffalo IP Law Journal 154

⁶⁵ See, e.g., *Zatarain's Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983) (stating that consumer surveys are important to determine protectability of descriptive marks); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (regarding consumer surveys important to find infringement); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577, 579 (2d Cir. 1963) (asserting that views of public are determinative of generic-ness).

⁶⁶ See, e.g., *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497 (2d Cir. 1996); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490 (2d Cir. 1989): both cases relate to confusion relevant to the legality of parody.

⁶⁷ *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 1070 (D.N.J. 1987), *aff'd*, 834 F.2d 368 (3d Cir. 1987): "The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source."

⁶⁸ See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989): "[T]he right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement . . ."; *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983): finding that the right of publicity can be violated even without a likelihood of confusion; Restatement (Third) Unfair Competition § 46 cmt. b (1995): "Proof of deception or consumer confusion is not required . . ."

⁶⁹ Congress codified this expansion in the Lanham Act, providing a cause of action against any person who falsely implies an

products themselves. As such, confusion about affiliation or sponsorship, in these cases, tends to correspond to right of publicity cases.⁷⁰ In many instances, a defendant used a celebrity's name, image, or identity in an advertisement in a manner that insinuated that the celebrity was endorsing the product.⁷¹ An example would be when Ford® hired an unknown singer to impersonate the vocal style of Bette Midler®⁷² for its commercial.⁷³ As a matter of principle, Ms Midler refuses to lend her songs to commercials or to endorse products. She sued Ford® for infringing her right of publicity. The court ruled in her favor. They found that the defendant obtained an advantage in the marketplace by giving the impression that she had endorsed their products.⁷⁴

Another rationale for the continued need for the right of publicity is due to uncommon dilution-type publicity cases. In 1926, Frank Schechter coined the term 'dilution' in his article for the Harvard Law Review.⁷⁵ Seventy years later, the concept was incorporated into section 43(c)(1) of the Lanham Act which provides that "[t]he owner of a famous mark shall be entitled . . . to an injunction against another person's commercial use in commerce of a mark . . . if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark."⁷⁶ Section 45 of the Lanham Act defines the term 'dilution' as "the lessening of the capacity of a famous mark to identify and distinguish goods, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or likelihood of confusion, mistake, or deception."⁷⁷ Among the factors that the law considers relevant to the inquiry into whether a mark is famous or not are 'the degree of inherent or acquired distinctiveness of the mark' and 'the duration and extent of advertising and publicity of the mark.'⁷⁸

Unlike the Lanham Act's general unfair competition provision,⁷⁹ the federal dilution statute applies only to 'famous' and distinctive trademarks.⁸⁰ The categorical language of the Federal Trademark Dilution Act (FTDA) makes it unlikely that the statute would apply to the blurring or tarnishment of a celebrity's identity. It should be noted that the Second Circuit excludes personal

'affiliation, connection, or association' with a trademark holder, or causes confusion 'as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities. . . .' 45 U.S.C. § 1125(a) (2006)

⁷⁰ See *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 879 (S.D.N.Y. 1973): calling the right of publicity 'somewhat akin' to trademark law; Ausness, R (1982) *The Right of Publicity: A 'Haystack in a Hurricane,'* 55 Temp. L.Q. 977: "Analytically, the right of publicity could be classified as a form of unfair competition."

⁷¹ Or at the very least was paid to lend their name to the product.

⁷² BETTE MIDLER: Registration No. 2408531; Registration Date: 28 November 2000; (REGISTRANT) Midler, Bette Individual, United States

⁷³ 849 F.2d 460 (9th Cir. 1988)

⁷⁴ Ibid

⁷⁵ Schechter, F (1926) *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813

⁷⁶ 15 U.S.C. § 1125(c)(1) (1994 & Supp. 1998)

⁷⁷ 15 U.S.C. § 1127 (1994 & Supp. 1998)

⁷⁸ See, *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 1418 (2003); *WAWA, Inc. v. Haaf*, 40 U.S.P.Q.2d 1629 (E.D. Pa. 1996), aff'd without op., 116 F.3d 471 (3d Cir. 1997); *Panavision Int'l L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996): examining how a famous mark is advertised

⁷⁹ 15 U.S.C. § 1125(a) (2006)

⁸⁰ 15 U.S.C. § 1125(c) (2006)

names from dilution protection altogether.⁸¹ As such, the right of publicity should play a continuing role in those cases. Sarah Kinsky suggested that a right of publicity dilution should prohibit the most harmful uses of a person's name or likeness without chilling valuable commentary.⁸²

She proposed that the same trademark standards be used for the right of publicity. To recover under the right of publicity dilution, a person must meet three requirements: (1) a person must prove that his/her mark was famous, (2) that it was used in commerce without his/her authorization, and (3) that the use actually diluted his/her mark.⁸³ Currently, a right of publicity action requires the use of a person's name or likeness.⁸⁴ This raises the question of what should be considered a mark for purposes of the proposed publicity dilution standard. The law could adopt trademark standards, with necessary modifications to deal with differences between personas and trademarks.

Just as trademarks are registered, so then famous persons could register their personas. Similarly, if Congress creates a separate cause of action for publicity dilution, it could create a registry of protected personas.⁸⁵ However, even in the absence of a registry system, a celebrity persona could become protected through active use of the persona. Courts could then read the mark requirement broadly in the publicity dilution context. The mark inquiry is intrinsically intertwined with the dilution inquiry, which asks whether the person's image was blurred or tarnished. Does the offending mark clearly and specifically identify a person in a way that blurs or tarnishes that person's image? For example should an advertisement with a caricature that loosely resembles a celebrity be considered a use of the celebrity's mark?⁸⁶ The nature of the use will be addressed by a blurring inquiry: If the caricature is not sufficiently similar to the celebrity's image, then the public will not associate the celebrity with the advertisement. Therefore, use of a person's name or likeness will not blur the person's identity. A broad definition of mark avoids unnecessary duplication of the dilution inquiry.⁸⁷

The aforementioned differences justify the existence of a right of publicity independent of trademark law with somewhat divergent rules. Nonetheless, they do not undermine the power of the trademark analogy. Rather, they are better understood as adaptations designed to achieve

⁸¹ *TCPIP Holding Co. v. Haar Commc'ns, Inc.*, 244 F.3d 88 (2d Cir. 2001): requiring inherent distinctiveness for protection against dilution. Because personal names are treated as descriptive, they will not meet this standard regardless of their fame.

⁸² Kinsky, S (2005) *Publicity Dilution: A Proposal for Protecting Publicity Rights*, 21 Santa Clara Computer & High Tech. L.J. 347

⁸³ Ibid

⁸⁴ Restatement (Third) of Unfair Competition § 46 (1995); Courts have adopted a broad reading of likeness. See, *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983)

⁸⁵ See, *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, infra

⁸⁶ This example is drawn from the facts of *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978), which granted a preliminary injunction because plaintiff Mohammed Ali proved he was likely to prevail on the claim that his right of publicity had been violated when Playgirl published a caricature of a nude African-American man in a boxing ring and identified the man in the caricature as 'The Greatest'.

⁸⁷ Kinsky (2005) supra

trademark-related goals like preventing confusing false endorsements in the somewhat different context of personal names.⁸⁸

2. United Kingdom

In Britain, statutory recognition of trademark infringement without confusion occurred when Parliament passed a comprehensive new trademark statute in 1994.⁸⁹ With regard to trademark dilution, most of the crucial language from the Directive is contained in sections 10(2) and 10(3) of the 1994 Trade Mark Act.⁹⁰

“(2) A person infringes a registered trademark if he uses in the course of trade a sign where because

(a) the sign is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered, or

(b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trademark.

(3) A person infringes a registered trademark if he uses in the course of trade a sign which—

(a) is identical with or similar to the trademark, and

(b) is used in relation to goods or services which are not similar to those for which the trademark is registered,

where the trademark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.”⁹¹

Putting aside the issue of ‘uses in the course of trade,’ the language limits the applicability of section 10(2) to an offending mark used on ‘identical’ goods or ‘similar’ goods to the ones listed in the registration. Section 10(3) only applies where the goods are not similar. Thus, the infringement portion of the statute creates two seemingly non-overlapping categories - infringement by the same or similar goods, and infringement by non-similar goods - with separate standards for

⁸⁸ Ibid

⁸⁹ See, First Council Directive 89/104/EEC of 21 December 1988 to Approximate the Laws of the Member States Relating to Trademarks

⁹⁰ Section 10 TMA defines the circumstances of trademark infringement. Sections 10(2) and 10(3) set forth the most common circumstances. TMA section 5 designates the circumstances under which registration of a mark may be denied. Sections 5(2) and 5(3), in relevant part, mimic the language of sections 10(2) and 10(3), respectively. Thus, cases interpreting sections 10(2) and 10(3) can be used to interpret sections 5(2) and 5(3) and vice versa.

⁹¹ TMA ss 10 (2) & (3)

infringement.⁹² This distinction is ‘foreign’ to a British standpoint. Because section 10(2) contains the traditional test for trademark infringement - likelihood of confusion - it would appear that the statute only imposes that requirement in similar goods situations. Initially, some British courts refused to interpret these provisions in a way that dispensed with the traditional confusion requirement.⁹³ Later decisions acknowledged that confusion was no longer required,⁹⁴ but expressed varying degrees of uncertainty as to the other requirements of section 10(3).⁹⁵ After a string of ECJ precedents that interpreted the corresponding provision of the Trade Mark Harmonization Directive,⁹⁶ British courts began to apply section 10(3) more liberally, but continued to express uncertainty as to its scope.

Possible clarification could be acquired by bringing an action for passing off. This classic common law tort was originally intended to prevent rival traders in the same field of business ‘passing off’ their products as the products of another competitor (‘trading goodwill’), with its rationale being the deterrence of commercial dishonesty.⁹⁷ Consequently, passing off was expanded to protecting goodwill “not in its classic form of a trader representing his goods as the goods of somebody else, but in an extended form”⁹⁸ as “the attractive force which brings in custom”.⁹⁹ Mr Justice Laddie in *Irvine v Talksport Ltd* stated: “the extended action of passing off today does not require the plaintiff to prove a common field of activity.”¹⁰⁰ Further, it is possible for an action for passing off to protect the goodwill or valuable reputation of a person or business against any unauthorized claim of association or connection by another (‘promotional goodwill’).¹⁰¹ Moreover, a passing off action is “a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation.”¹⁰²

⁹² Welkowitz, D (2000) *Protection Against Trademark Dilution in the U.K. and Canada: Inexorable Trend or will Tradition Triumph?* 24 *Hastings Int'l & Comp. L. Rev.* 63

⁹³ See, *Baywatch Prod. Co. Inc. v. Home Video Channel*, [1997] F.S.R. 22, 27 (Ch. 1996), holding that s10(3) requires a likelihood of confusion in cases involving similar marks on dissimilar goods, because it would be ‘illogical’ to apply a more demanding standard to similar goods than to dissimilar goods.

⁹⁴ *Sihra's Trademark Application*, [2003] R.P.C. 44: holding that confusion as to origin is not required to oppose registration under s10(3)

⁹⁵ *Mars UK Ltd. v. Burgess*, [2004] EWHC (Ch) 1912, 2004 WL 1476759: noting that s10(3) is ‘a powerful protection for the trademark owner since it allows an infringement claim without proof of confusion,’ but rejecting plaintiff’s s10(3) claim because plaintiff failed to establish that its color mark, used in product packaging, had a reputation in the United Kingdom.

⁹⁶ E.g., Case R 308/2003-1, *Mango Sport Sys. S.R.L. Socio Unico Mangone Antonio Vincenzo v. Diknah S.L.*, [2005] E.T.M.R. 5; Case C-408/01, *Adidas-Salomon AG v. Fitnessworld Trading Ltd*, 2003 E.C.R. I-12537; Case C-251/95, *SABEL BV v. Puma AG*, 1997 E.C.R. I-6191

⁹⁷ See, eg, *Reddaway (Frank) & Co Ltd v George Banham & Co Ltd* [1896] AC 199; *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] AC 731; *Irvine v Talksport Ltd* [2002] 1 WLR 2355

⁹⁸ *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] AC 731. One commentator has argued that the early cases revealed ‘clear signs of the courts’ willingness to protect valuable personal reputations ... [and] it is apparent that the law of passing off has not changed substantially since these early times’. Tregoning, I (2008) *What’s In A Name? Goodwill in Early Passing-Off Cases*, 34 *Monash University Law Review* 75

⁹⁹ *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217

¹⁰⁰ *Irvine v Talksport Ltd* [2002] 1 WLR 2355

¹⁰¹ *Arsenal FC plc v Reed* [2001] RPC 922

¹⁰² *Star Industrial Co Ltd v Yap Kwee Kor* (1975) 1B IPR 582

Recently, this cause of action was put to the test by Rhianna¹⁰³, a famous pop star, who sued high street fashion chain, Topshop® for deceiving the public by giving the false impression of endorsement of a product by a celebrity.¹⁰⁴ Unfortunately, English law has never recognized a distinct ‘image right’, one that celebrities and other high-profile individuals can rely upon to exploit and protect their image. Instead, those with valuable personalities have had to rely on one or more of the following causes of action: trademark, passing off, breach of confidence, copyright and/or privacy laws. This decision developed the tort of passing off a little further while emphasizing that, in each case, the facts are central to the outcome.¹⁰⁵

Mr Justice Birss applied the doctrine of passing off on very particular facts and established a general principle that goes against any celebrities who might have hoped to see the beginnings of a general image right. These facts included the following:

- Robyn Fenty, aka Rihanna®, is a famous pop star.
- High Street fashion chain, Topshop®, licensed an image of her face from a photographer and printed it on a T-shirt.
- Rihanna's® permission was neither sought nor obtained. She sued for passing off.
- The T-shirt was sold in stores and online. Twelve thousand units were sold, most at £22 each. It was sold online first as ‘RIHANNA TANK’ and ‘Photographic Rihanna motif tank’, with the word RIHANNA later removed, likely because Rihanna® owned a registered trademark for RIHANNA® for clothing.¹⁰⁶

Passing off is proved by establishing the ‘classical trinity’ of elements stated in *Reckitt v Colman Borden*.¹⁰⁷ Thus, Rihanna® had to show that:

1. the placing of her face on a T-shirt made a misrepresentation, in that it was likely to deceive those members of the public into buying the product because they thought it was authorized by her;
2. she had a goodwill and reputation among relevant members of the public; and
3. that misrepresentation must have caused damage to her goodwill.¹⁰⁸

There were no claims under the other areas of law referred to above: there was no suggestion of a breach of Rihanna's® privacy, and she held no relevant copyright in the photograph. For the most part, the RIHANNA® trademark registration was not relied upon. The judge was keen to

¹⁰³ RIHANNA: Registration No. 3621108; Registration Date: 12 May 2009; (REGISTRANT) Roraj Trade, LLC, New York, 400 South Hope Street c/o Holland & Knight, 8th Floor Los Angeles California 90071

¹⁰⁴ *Fenty & Ors v Arcadia Group Brands Ltd (t/a Topshop) & Another* [2013] EWHC 2310 (Ch), Chancery Division, England and Wales, 31 July 2013

¹⁰⁵ Meale, D (2013) *Rihanna's face on a T-shirt without a licence? No, this time it's passing off*, 8 (11) *Journal of Intellectual Property Law & Practice* 823

¹⁰⁶ *Fenty* [2013] *supra*

¹⁰⁷ [1990] 1 WLR 491

¹⁰⁸ *Ibid*

point out that this case did not concern any debate around, or attempt to develop, an independent image right.¹⁰⁹

Mr Justice Birss deemed there were two reasons why the public would buy a T-shirt with Rihanna's® image on it. One, they wanted clothing with an image of the pop star on it. If so, there was no misrepresentation; and thus, no passing off here. Deception, distinct from merely drawing a connection, was crucial to any finding of passing off.¹¹⁰ Two, there would be deception if the public bought the T-shirt because they thought it was authorized by Rihanna®; or so reasoned Justice Birss. Pulling all this together, he concluded that a substantial portion of those considering the product - namely, Rihanna® fans - would think the garment authorized. As fans, they regard Rihanna's® endorsement as important. 'She is their style icon', the judge remarked.¹¹¹

As to goodwill, similar to Apple's® tablet design in *Apple v Samsung*,¹¹² Rihanna® was cool and world famous. She ran a very large merchandising and endorsement operation. She authorized her name and image to be used in respect of a variety of goods, including clothing. Some of these items were 'fashion garments' rather than traditional merchandising.¹¹³ She has worked with H&M®, Gucci®, Armani® and River Island® to collaborate on and/or design clothing. The judge was convinced Rihanna's® identity, as a style leader, had a tangible value in the world of high street fashion. She, therefore, had ample goodwill.¹¹⁴

Damages were clearly present. Rihanna® had lost sales and control over her reputation in the fashion world. With all three ingredients present, the judge found passing off.¹¹⁵ Mr Justice Birss's summed up by saying: 'The mere sale by a trader of a t-shirt bearing an image of a famous person is not, without more, an act of passing off.'¹¹⁶ Although celebrities may view the decision as bolstering their efforts to control their image, the judge was determined to elucidate that the general rule was still against them.¹¹⁷

3. Australia

Australian trademark law contains no explicit dilution provisions, nor is Australia a party to any international agreement requiring dilution protection.¹¹⁸ Australia's trademark statute omits

¹⁰⁹ Meale (2013) supra

¹¹⁰ *Hodgkinson v Wards Mobility* [1995] FSR 169 and *Harrods v Harrodian School* [1996] RPC 697

¹¹¹ *Fenty* [2013] supra

¹¹² [2012] EWHC 1882

¹¹³ The latter might include a T-shirt with a pop star's image on the front and tour dates on the back.

¹¹⁴ *Fenty* [2013] supra

¹¹⁵ *Ibid*

¹¹⁶ *Ibid*

¹¹⁷ Meale (2013) supra

¹¹⁸ This includes the 2004 US - Australia Free Trade Agreement available at <http://www.ustr.gov/trade-agreements/free-trade-agreements/australian-fta>

the crucial language referring to unfair advantage or detriment.¹¹⁹ Until 1995, Australia provided an infringement cause of action only where a mark was used on similar or related goods.¹²⁰ Section 120(3) of Australia's Trademarks Act of 1995 now satisfies Article 16(3) of TRIPS with respect to registered well-known marks, but it still requires the trademark owner to show that the defendant's use of the mark on unrelated goods suggests 'a connection' between the defendant's goods and the owner of the registered mark. It is useful to set out section 120 in full in order to appreciate the context in which sub section (3) appears.

Section 120 provides that:

“(1) A person infringes a registered trademark if the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark in relation to goods or services in respect of which the trademark is registered.

(2) A person infringes a registered trademark if the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark in relation to:

- (a) goods of the same description as that of goods (registered goods) in respect of which the trademark is registered; or
- (b) services that are closely related to registered goods; or
- (c) services of the same description as that of services (registered services) in respect of which the trademark is registered; or
- (d) goods that are closely related to registered services.

However, the person is not taken to have infringed the trademark if the person establishes that using the sign as the person did is not likely to deceive or cause confusion.

(3) *A person infringes a registered trademark if:*

- (a) *the trademark is well-known in Australia; and*
- (b) *the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark in relation to:*
 - (i) *goods (unrelated goods) that are not of the same description as that of the goods in respect of which the trademark is registered (registered goods) or are not closely*

¹¹⁹ Australia's close neighbor New Zealand enacted a dilution law for well-known marks in its Trademarks Act of 2002, closely tracking the language of the EU Trademark Harmonization Directive.

¹²⁰ *Campomar Sociedad, Limitada v. Nike Int'l Ltd.*, (2000) 202 C.L.R. 45 P P 36

related to services in respect of which the trademark is registered (registered services);

(ii) services (unrelated services) that are not of the same description as that of the registered services or are not closely related to registered goods; and

(c) because the trademark is well-known, the sign would likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trademark; and

(d) for that reason, the interests of the registered owner are likely to be adversely affected.

(4) In deciding, for the purposes of paragraph 3(a), whether a trademark is ‘well-known in Australia’, one must take account of the extent to which the trademark is known within the relevant sector of the public, whether as a result of the promotion of the trademark or for any other reason.”¹²¹

There is little case law applying section 120(3).¹²² In 1997, it was stated by one of Australia’s leading trademark writers that: “Australia has no law of dilution.”¹²³ From this point onwards, the position has been maintained without justification or reference to the text of section 120(3).¹²⁴ The perception that section 120(3) requires proof of a likelihood of confusion seems to be the source for other Australian commentators to contend that section 120(3) is not an anti-dilution remedy.¹²⁵ This theory was document in a report by the Committee of the International Trademark Association.¹²⁶ Their view, without any support or analysis, is deemed prevailing wisdom in Australia, because they said that section 120(3) is ‘generally regarded’ as

¹²¹ Trademarks Act, 1995, Act No. 119, s120 emphasis added

¹²² Only nine cases have been reported.

¹²³ Shanahan, D (1997) ‘Australia’ in Mostert, F (ed.), *Famous and Well-known Marks: An International Analysis*. London: Butterworths

¹²⁴ In an Issues Paper published in February 2002 by the Australian Government’s Advisory Council on Intellectual Property, the Council asserted, without analysis, that subsection 120(3) and 120(4) of the Act are: ‘limited in the scope of the protection they provide and fall far short of the anti-dilution provisions which are now included in the Lanham Act in the United States.’ Advisory Council on Intellectual Property, *Review of Enforcement of Trademarks*, s 4.8.3, available at www.acip.gov.au/review.htm. It then called for submissions on, among other things, what rights should flow to a mark accorded ‘well-known’ or ‘famous’ status.

The submission made by the Law Council of Australia in response to the Issues Paper also asserted, without analysis, that ‘no anti-dilution remedy’ existed in the Act and that to succeed under section 120(3) “the owner of a well-known trademark must prove the likelihood of confusion between the defendant’s goods and services and the trademark owner.” available at www.acip.gov.au/submissions/council.pdf

¹²⁵ For example, in 2004, Trevor Stevens declared that section 120(3) does not provide a ‘direct’ anti-dilution remedy, and that the section requires a likelihood of confusion, because of the ‘connection requirement.’ Stevens, T (2004) *Dilution in Australia: waiting in the wings* 16(8) Australian Intellectual Property Law Bulletin 129. This appears to contradict an earlier view expressed by Stevens and Mostert in a 1996 article: “since indicating a connection appears to be something less than actual deception or confusion, and given that the section specifically refers to the use of trademarks in relation to unrelated goods, it is not unreasonable to argue that s 120(3) may herald the introduction of statutory protection against the dilution of well-known trademarks.” Stevens, T & Mostert, F (1996) *The Protection of Well-known Trademarks on Non-competing Goods* 7 Australian Intellectual Property Law Journal 76

¹²⁶ International Trademark Association (2004) ‘Australia’ in *The Protection of Well-known Marks in Asia-Pacific, Latin America and Africa* available at www.inta.org/membersonly/downloads/ref Asian.pdf

requiring likelihood of confusion.¹²⁷

Nonetheless, and quite confusingly, not all commentators share this restricted view of section 120(3).¹²⁸ Some commentators suggest that the provision is already broad enough to protect well-known marks against dilution.¹²⁹ Although a decision by the Australian High Court suggested, obliquely and in dictum, that section 120(3) might protect a mark from “*dilution of its distinctive qualities or of its value to the owner,*”¹³⁰ no case has interpreted section 120(3) so broadly.¹³¹ The adoption of the statutory phrase ‘indicating a connection,’ in contrast to taking ‘unfair advantage of’ or causing ‘detriment to’ the value of mark, suggests that a plaintiff seeking relief under section 120(3) must show a likelihood of confusion or deception as to origin, endorsement, or association.¹³²

In effect, the Trademarks Act 1995 does offer a broad anti-dilution remedy for trademarks which are well-known in Australia generally, or which are well-known among a particular segment of the public in Australia. However, enforcement is only successful when passing off and section 52 of the *Competition and Consumer Act 2010* (CCA) are also pleaded.¹³³ The Australian High Court, following the lead of the UK House of Lords, indicated that: “the adaptation of the traditional doctrine of passing off to meet new circumstances involving the deceptive or confusing use of *names, descriptive terms or other indicia* to persuade purchasers or customers to believe that goods or services have an association [with], quality or endorsement [of] ... another ...”¹³⁴

The courts have conceded that ‘goodwill’ was ‘a thing very easy to describe, very difficult to define.’¹³⁵ As in the UK, the threshold issue is whether the plaintiff has the requisite local goodwill or reputation to support an action in passing off where it is shown that a substantial number of

¹²⁷ Advisory Council on Intellectual Property, Review of Enforcement of Trademarks available at www.acip.gov.au/review.htm

¹²⁸ For example, in its submission to the Review of Enforcement of Trademarks conducted by the Advisory Council on Intellectual Property, the Intellectual Property Research Institute of Australia concluded that “subsection 120(3), even as currently drafted, has the potential to offer significant anti-dilution protection to well-known or famous trademarks.” available at www.acip.gov.au/submissions/lpria.pdf

¹²⁹ See, Stevens, T & Mostert, F (1996) fn 104 supra

¹³⁰ *Campomar Sociedad, Limitada v. Nike Int'l Ltd.* (2000) 202 C.L.R. 45, P 42. In discussing the importance of confusion or deception under other provisions of Australian trademark law, the Court observed in passing that: “In this decade, legislation in the United States, the United Kingdom, and now in Australia to varying degrees has extended the infringement action to restrain activities which are likely adversely to affect the interests of the owner of a ‘famous’ or ‘well-known’ trademark by the ‘dilution’ of its distinctive qualities or of its value to the owner.”

¹³¹ In applying s 120(3) to a defendant’s unauthorized use on coffee products of a well-known mark which the plaintiff had registered for pasta products, the Federal Court of Australia tacitly assumed that confusion as to association was required, pointing out that “it is well-known that food and beverage manufacturers make a variety of different products and that brands are extended over different products.” *San Remo Macaroni Co. v. San Remo Gourmet Coffee Pty Ltd.* (2001) 50 I.P.R. 321

¹³² LaFrance & Cline (2008) supra

¹³³ Note, for the purposes of this discussion s 52 of the CCA (formerly the Trade Practices Act, 1974) will be considered together with the passing off action. Although conceptually distinct, the two actions have been described as ‘coextensive’ and displaying ‘considerable overlap’ in the character merchandising context: Terry, A (1989) *Exploiting Celebrity: Character Merchandising and Unfair Trading* 12 UNSW Law Journal 204

¹³⁴ *Campomar* (2000) 202 CLR 45, 88–9 (quoting *Moorgate Tobacco (No 2)* (1984) 156 CLR 414, 445) (emphasis added). The House of Lords, in *Cadbury-Schweppes* [1981] 1 WLR 193, recognized the tort of passing off is ‘wide enough to encompass other descriptive material, such as slogans or visual images ... provided always that such descriptive material has become part of the goodwill of the product’.

¹³⁵ See, *Murry* (1998) 193 CLR 605; *Muller* [1901] AC 217

people would consider the name, get-up or other indicia to be distinctive of the goods or services of the plaintiff.¹³⁶ In advertising or merchandising involving celebrity personalities, as the proprietary right protected in passing off is property in the goodwill or reputation which *attaches* to the name, likeness or other indicia of identity rather than property in those indicia themselves, the passing off action, unlike the right of publicity, does not protect any commercial exploitation right per se in the indicia of identity.¹³⁷ As the Australian High Court has called attention to, “goodwill is not something which can be conveyed or held in gross; it is something which attaches to a business.”¹³⁸

In a passing off claim, a celebrity must demonstrate that they have a protectable commercial goodwill or reputation within a particular area or location in which the relevant misrepresentation is alleged to have taken place. In Australia, it is not necessary for the plaintiff to have a business presence in Australia.¹³⁹ It is sufficient that he has a reputation among the persons there.¹⁴⁰ The terms ‘goodwill’ and ‘reputation’ are used interchangeably so that the reputation of a plaintiff in a certain place is the source of his potential business there; and a ‘sufficient reputation’ exists in order to be actionable ‘requires something more than a reputation among a small number of persons’.¹⁴¹ For most individuals who have become well-known to the public through their endeavors in the fields of sports, entertainment or popular culture, it appears that they will have no problem satisfying the first element of a common law passing off claim.¹⁴²

There is a general recognition that one may have a proprietary interest in goodwill that may be vindicated through a passing off action. This language is evocative of the concept of misappropriation in a right of publicity claim. Nevertheless, courts are adamant that ‘there is still a need to demonstrate a *misrepresentation* because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant’s reputation’.¹⁴³ Australian courts have also established that the finding of deceptive conduct must be assessed taking into consideration all the circumstances and the overall effect or impression on the consumers or potential consumers; the courts rely on ‘a combination of visual impression and judicial estimation of the effect likely to be produced’ by the defendant’s conduct on consumers.¹⁴⁴

¹³⁶ *Reckitt & Colman* [1990] 1 All ER 873

¹³⁷ Tan, D (2010) *The Fame Monster Reloaded: The Contemporary Celebrity, Cultural Studies and Passing Off*. 32 Sydney L.R. 291

¹³⁸ *Murry* (1998) 193 CLR 605, citing *Geraghty v Minter* (1979) 142 CLR 177

¹³⁹ See, eg, *Conan Doyle v London Mystery Magazine Ltd* (1949) 66 RPC 312: goodwill only in existing stories and not generally in all aspects of Sherlock Holmes character.

¹⁴⁰ See, eg, *ConAgra* (1992) 33 FCR 302. The specific thing in which goodwill is vested must be identified.

¹⁴¹ *ConAgra* (1992) 33 FCR 302

¹⁴² See, eg, *Irvine* [2002] 1 WLR 2355 (F1 driver Eddie Irvine); *Crocodile Dundee case* (1989) 25 FCR 553 (actor Paul Hogan); *Hutchence v South Sea Bubble Co Pty Ltd* (1986) 6 IPR 473 (‘Hutchence’) (pop music group INXS); *Talmax* [1997] 2 Qd R 444 (swimmer Kieren Perkins); *Honey v Australian Airlines* (1990) 18 IPR 185 (athlete Gary Honey); *Newton-John v Scholl-Plough (Australia) Ltd* (1986) 11 FCR 233 (singer Olivia Newton-John).

¹⁴³ *Irvine* [2002] 1 WLR 2355

¹⁴⁴ *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641: Evidence of actual deception is not conclusive; ultimately it was ‘a question of fact to be decided by considering what [was] said and done against the background of all surrounding circumstances’.

This second element of misrepresentation has been expanded following relaxation of the ‘common field of activity’ doctrine in *Radio Corporation Pty Ltd v Henderson*.¹⁴⁵ In this expanded form, ‘the ability to *recommend* or *promote* . . . goods and services - or merchandising rights’ is protected. This is also called ‘promotional goodwill’.¹⁴⁶ Briefly, passing off may be established where a celebrity’s image or name is used on a defendant’s goods or services so as to *deceive* consumers that there is a ‘business connection’ between the celebrity and the defendant. Thus, the action requires the plaintiff to establish a *misrepresentation* which creates a false belief in the minds of consumers that the parties have a ‘commercial arrangement’.¹⁴⁷ In *Henderson v Radio Corp*, the Supreme Court of New South Wales concluded that the professional ballroom dancing couple had the requisite protectable reputation. It further examined the ‘publicity [the plaintiffs] received through their public performances, personal and on television, through their lectures and demonstrations, and by means of articles, photographs and advertisements which have appeared in the press.’¹⁴⁸ It does not matter to the courts how the goodwill of a celebrity has become fixed in the minds of the relevant section of the public, as long as it has gained a distinctive character recognized by the public through repeated exposure in the entertainment and communications media.¹⁴⁹

Ultimately, Australian courts reject a model that provides protection against *all* unauthorised uses of celebrity identity in favour of a model based largely on misrepresentation and the requirement of public deception or confusion.¹⁵⁰ Nonetheless, in the absence of an explicit misrepresentation, it appears that courts are increasingly open to accepting that the overall or ‘gestalt’¹⁵¹ impression of the defendant’s use can constitute misleading or deceptive conduct. As Burchett J commented in the *Crocodile Dundee*® case, ‘[i]t would be unfortunate if the law merely prevented a trader using the primitive club of direct misrepresentation, while leaving him free to employ the more sophisticated rapier of suggestion, which may deceive more completely’.¹⁵²

4. Japan

¹⁴⁵ [1960] NSW 279

¹⁴⁶ *10th Cantanae Pty Ltd v Shoshana Pty Ltd* (1987) 79 ALR 299: The majority required that the plaintiff be ‘unequivocally’ or ‘plainly’ identified from the defendant’s advertisement. See also, Murumba, S (1986) *Commercial Exploitation of Personality*, Sydney: Law Book Co.

¹⁴⁷ *Newton-John v Scholl-Plough (Australia) Ltd* (1986) 11 FCR 233. The nature of the ‘association’ or ‘arrangement’ required to be established between the parties is an area of uncertainty. It is not entirely clear from the cases whether the public needs to be likely to believe that the celebrity is ‘endorsing’, ‘sponsoring’ or ‘licensing’ the product in question, or whether it is sufficient that there is a misrepresentation that the celebrity ‘approved’, ‘authorised’ or was ‘associated’ commercially with the defendant or his or her product: Howell, R (1990) *Personality Rights: A Canadian Perspective: Some Comparisons with Australia* 1 Intellectual Property Journal 212

¹⁴⁸ (1960) SR(NSW) 576

¹⁴⁹ *Hutchence* (1986) 6 IPR 473; *Twentieth Century Fox Film Corp v South Australian Brewing Co Ltd* (1996) 34 IPR 225, 230–2 (‘Duff Beer case’)

¹⁵⁰ Howell, R (1986) *The Common Law Appropriation of Personality Tort* 2 Intellectual Property Journal 149

¹⁵¹ *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 55 IPR 354

¹⁵² (1989) 23 FCR 553

“Japanese trademark dilution jurisprudence is in a state of confusion. In an otherwise highly rational, highly developed system, this scattered jurisprudence is unexpected.”¹⁵³ Unlike several civil law countries in Europe, Japan has espoused dilution type legislation that protects both registered and unregistered marks. “According to Professor Port, Japanese law distinguishes between well-recognized (*hiroku ninshikisareteiru*) appellations, as to which confusion must be shown, and famous (*chomei*) appellations, as to which the statute imposes no such requirement.”¹⁵⁴

Japan’s Trademark Act denies registration of a mark that is similar to another person’s well-known mark if it is used for “the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes.”¹⁵⁵ This language was added in 1996 in response to “the increased demand for clarification of the protection of well-known and famous trademarks,” and to “prevent the use of trademarks that are widely known in Japan or other countries with unfair intent.”¹⁵⁶ The statutory language indicates that the prohibition applies only when the applicant is trying to free-ride on a well-known brand. This intent requirement follows pre-1996 case law in which Japanese courts utilized concepts such as plagiarism and trademark abuse to disallow registration to parties that deliberately imitated famous marks.¹⁵⁷

The Trademark Examination Manual of the Japan Patent Office (JPO) clarifies these dilution principles:

“Well-known and famous trademarks, which have become widely known and have gained a high reputation, credit and popularity among consumers as a result of the company's long, hard efforts and a considerable amount of advertising costs, can be considered to possess sufficient capability to attract consumers and to have worthy property values themselves. The use of such well-known and famous trademarks by a third party may not necessarily cause confusion over the source of goods etc., but it may weaken the source indicating function or harm the reputation of these well-known and famous

¹⁵³ Port, K (2008) *Judging Dilution in the United States and Japan*, 17 *Transnat'l L. & Contemp. Probs.* 667

¹⁵⁴ Janis, M.D. & Yu, P (2008) *International and Comparative Aspects of Trademark Dilution*, 17 *Transnat'l L. & Contemp. Probs.* 603. The Japanese word ‘*hyoji*’ can also mean ‘expression.’ Prof Port believes that ‘appellation’ is a more fitting translation, because it evokes the intent of the word. An ‘indication’ is what a thing might *be*; an ‘appellation’ is what something might *be called*. As such, using ‘indication’ here seems inappropriate. Port, K (2006) *Trademark Dilution in Japan*, 4(2) *Nw. J. Tech. & Intell. Prop.* 228. An alternative translation is ‘business designation.’ Curci, F.X. & Takura, T. (1995) *Selected Aspects of Japanese Intellectual Property Law*, 8 *Transnat'l Law.* 63. The UCPA speaks only of ‘appellations’ and not of ‘marks’ or ‘trademarks.’ The reason for this is to clarify the distinction between ‘trademarks’ (*shyohyo*), which by definition are registered, and non-registered indicators of source (*hyoji* or appellations). Port (2006) *supra*.

¹⁵⁵ *Shohyo-Ho* [Trademark Act], Law No. 127 of 1959, art. 4-1(xix) (amended 2005) in Sata, K ed (2010) *Original Texts and English Translations of Japanese Laws and Acts Related to Intellectual Property*. Tokyo: The Ministry of Justice of Japan

¹⁵⁶ LaFrance & Cline (2008) *supra* citing Japan Patent Office, Trademark Examination Manual s 42.25(1) (2001), available at http://www.jpo.go.jp/quick_e/index_sh.htm

¹⁵⁷ Suzuki, M (2001) *The Trademark Registration System in Japan: A Firsthand Review and Exposition*, 5 *Marq. Intell. Prop. L. Rev.* 133

trademarks. Therefore, it is necessary to sufficiently protect these trademarks from illicit use, bearing in mind such purposes.”¹⁵⁸

The Trademark Examination Manual construes Article 4-1(xix) as encompassing both blurring and tarnishment concepts. This article is intended to prevent the registration of trademarks identical or similar to those that are ‘famous nationwide’ because, even though the second registration ‘may not necessarily cause confusion of the source of goods,’ it ‘may weaken the source-indicating function or harm the reputation of the said famous trademark.’¹⁵⁹ Further, this disqualification applies only where the applicant has ‘unfair intent’, and not where the similarity of the marks arises ‘by chance’.¹⁶⁰ On the other hand, where the marks are very similar and the well-known mark is unusual, there is a presumption of unfair intent.¹⁶¹

Likewise, the JPO's Trademark Examination Guidelines provide that Article 4-1(19) prevent the registration of:

“A trademark identical with or similar to a trademark well-known throughout Japan, for which an application has been filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner; however, the trademark of that application per se is not liable to cause confusion over the source of the goods.”¹⁶²

Accordingly, registration of a trademark is prohibited only if the dilution or tarnishment of reputation is deliberate and intentional.

When an examiner is determining whether a mark is used for ‘unfair purposes,’ he/she must take into account “materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, and consumer-appeal built up in a well-known trademark.”¹⁶³ This language indicates that the examiner should only be bothered by trademark uses that have a tarnishing effect. This is as opposed to uses which damage the distinctiveness of the well-known mark or ‘free-ride’ on the notoriety and favorable associations of the mark.¹⁶⁴ The Trademark Examination Manual, on the other hand, indicates that both blurring and tarnishment are grounds for refusing

¹⁵⁸ Japan Patent Office, Trademark Examination Manual s 42.25(1) (2001) 42.119.03 *Examination concerning Article 4(1)(xix)*, available at http://www.jpo.go.jp/quick_e/index_sh.htm

¹⁵⁹ LaFrance & Cline (2008) supra citing Ibid

¹⁶⁰ Ibid s 42.25(2)

¹⁶¹ Japan Patent Office, Examination Guidelines for Trademarks ch. III, pt. 17, B 5 (2007), available at http://www.jpo.go.jp/quick_e/index_sh.htm

¹⁶² Ibid s 1(b). Although ‘well-known’ is not defined in this context, the section of the Guidelines that addresses defensive registrations indicates that ‘well-known’ means ‘famous.’ Ibid ch. XIII, s 1. With respect to Art. 4-1(19) of the registration statutes, the JPO's Trademark Examination Manual equates ‘trademarks widely recognized by consumers’ with ‘famous’ trademarks. See Trademark Examination Manual, s 42.14

¹⁶³ Examination Guidelines for Trademarks, s 4(f)

¹⁶⁴ The concept of ‘free-ride’ is important to publicity rights as well.

registration.¹⁶⁵ Nevertheless, both the Manual and the Guidelines clearly interpret Article 4-1(xix) as preventing registration only where the applicant has some kind of predatory intent. Finally, while neither the Manual nor the Guidelines recommend that registration should be denied based on free riding alone without proof of tarnishing or blurring, the statutory reference to ‘gaining unfair profits’ appears to support this additional ground for denial.¹⁶⁶

In 1993, the Japanese legislature (‘Diet’) amended the Unfair Competition Prevention Act (UCPA).¹⁶⁷ The two provisions of the UCPA that courts have used to deal with trademark dilution are as follows:

“Article 2-1: As used in this Law, the term ‘unfair competition’ shall mean:

- 1) the act of using the Goods or Other Appellations (which means a name, trade name, trademark, mark, or container or package of goods used in relation to a person's business, or any other indication of a person's goods or business; the same shall apply hereinafter)¹⁶⁸ which is identical with, or similar to, another party's Goods or Other Appellation that is well-known among the consumers, . . . and causes confusion with the goods or business of that other parties.
- 2) the act of using Goods or Other Appellations of another that are identical with, or similar to, another person's famous Goods or Other Appellations”¹⁶⁹

A notable omission from these statutory provisions is the word ‘dilution’ (*kishakuka*). Japan has no statute containing the term ‘dilution’ that provides a cause of action for an owner of a famous trademark to prevent the subsequent use of that trademark on dissimilar goods in a non-competing manner.¹⁷⁰ Japan is a civil law country and courts must only apply the law as stated. As such, by using this term, the courts generate new options through their opinions, and any dilution case in Japan is judge-made law.¹⁷¹ Interpretations of the statute, needless to say, remain varied to the point that “[t]rademark dilution jurisprudence in Japan is in a state of confusion.”¹⁷²

Japanese courts often do not make the critical distinction between a provision that requires a

¹⁶⁵ Japan Patent Office, Trademark Examination Manual B 42.25(1) (2001), available at http://www.jpo.go.jp/quick_e/index_sh.htm

¹⁶⁶ LaFrance & Cline (2008) supra

¹⁶⁷ Fusei kyoso boshiho [Unfair Competition Prevention Act], Law No. 47 of 1993, translated in EHS Law Bull. Ser. no. 6895 (1998) [hereinafter ‘UCPA’]. The original law is Fusei kyoso boshiho [Unfair Competition Prevention Act], Law NO. 14 of 1934. The 1993 update ensured that Japan would be in compliance with the TRIPs Agreement signed in 1994. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Annex 1C, 33 I.L.M. 1197 (1994). Article 16(3) of the TRIPs Agreement is said to be a dilution provision.

¹⁶⁸ Many translate this word (*hyoji*) as ‘indication’ rather than ‘appellation.’ See, e.g., Heath, C (2001) *The System of Unfair Competition Prevention in Japan*, Boston: Kluwer Law International. See also, Port (2006) and (2008) supra

¹⁶⁹ UCPA, Article 2.1 as translated by Port (2006) supra.

¹⁷⁰ Port (2008) supra

¹⁷¹ Port (2006) supra citing Foote, D (1996) *Judicial Creation of Norms in Japanese Labor Law: Activism in the Service of – Stability?*, 43 U.C.L.A. L. REV. 635

¹⁷² Port (2006) supra

showing of confusion (Article 2-1-1) and one that does not (Article 2-1-2).¹⁷³ Professor Port explains that the 1993 unfair competition amendments’ legislative history specifies the intention to prevent ‘free riding;’ because “consumers might become confused that this newcomer is the same as the company that endeavored to obtain high trust and repute.”¹⁷⁴ Does this mean that consumers will believe that the goods or services are from the same company, or merely that they are the same in their characteristics and quality? The answer is unclear. Although a confusion requirement is indicated, the report suggests elsewhere that a dilution claim should not depend on consumer confusion.¹⁷⁵ Prior the 1993 amendments, Japanese courts would assume confusion even where it was unlikely so that marks could be protected from free riding.¹⁷⁶ They did so by employing the concept of ‘confusion in the broad sense.’¹⁷⁷ It appears that the Japanese courts, of their own initiative, were prepared to extend their traditional legal and ethical concepts of confusion and fairness in order to protect trademarks against uses which violated the courts’ innate sense of business morality.¹⁷⁸

Professor Port suggests that “Japanese judges have an inherent distrust of the notion of dilution.”¹⁷⁹ Moreover, due to the broad mandate of Article 2-1(2), “Japanese judges seem reluctant to apply the language as written and, instead, seek other options to attempt to confine the expansion of the trademark right.”¹⁸⁰ Nonetheless, Japan has requested that the dilution laws of other countries, particularly in Asia, be strengthened in order to reduce ‘free riding on the house marks of Japan’s well-known companies.’¹⁸¹ Japan’s Industrial Property Council has encouraged global harmonization efforts.¹⁸²

In Japan, there is no express legal basis for publicity rights, but it is generally recognized as the right to be respected as individuals and/or the rights concerning the pursuit of happiness under the Constitution of Japan. These rights are protected to some extent even in the private sector. However, it was not clear exactly what the rights are, and to what extent publicly rights are protected as legal rights.¹⁸³

¹⁷³ This is similar to the United States where courts often require ‘confusion’ before they will find dilution, even though confusion is not an element of the claim. See, e.g., *Pharmacia Corp. v. Alcon Labs., Inc.*, 201 F. Supp. 2d 335 (D.N.J. 2002) (arguing no confusion, then handling the claim of dilution); *Circuit City Stores, Inc. v. Office Max, Inc.*, 949 F. Supp. 409, 418 (E.D. Va. 1996) (asserting that confusion is not required to be found under the Dilution Act); *PPG Indus., Inc. v. Clinical Data, Inc.*, 620 F. Supp. 604, 607 (D. Mass. 1985) (claiming that even though confusion is argued, it is not necessary for a dilution claim).

¹⁷⁴ Port (2006) supra (citing Sangyo Kozo Shingikai Chiteki Zaisan Seisaku Bukai Hokokusho [Report of the Intellectual Property Policy Committee of the Industrial Structure Council] (1992))

¹⁷⁵ Ibid

¹⁷⁶ This was especially so in relation to identical marks. Ibid.

¹⁷⁷ Port (2008) supra

¹⁷⁸ LaFrance & Cline (2008) supra

¹⁷⁹ Port (2006) supra

¹⁸⁰ Ibid

¹⁸¹ Int’l Affairs Comm., Indus. Prop. Council, Towards the International Harmonization of Industrial

Property Rights Systems in the 21st Century ch. 2, pt. II.3(2)(A) (1999), available at <http://www.jpo.go.jp/shiryoe/index.htm>

¹⁸² Ibid. For example, the WIPO Joint Recommendation and revision of TRIPS which would require WTO countries to adopt dilution laws.

¹⁸³ See, *Pink Lady* case, supra. Watanabe, Y (2012) *Supreme Court of Japan recognizes publicity rights*, Global Information

The right of publicity as distinct from privacy was first recognized in Japan in *Mark Lester v. Tokyo Daiichi Film*.¹⁸⁴ Film footage of English actor Mark Lester was used in a TV advertisement for Lotte chocolate without his consent along with the phrase in the soundtrack ‘Mark Lester likes it, too.’¹⁸⁵ The court awarded Lester ¥500,000 for economic loss and an equal amount for harm to his reputation.¹⁸⁶ In the subsequent *Steve McQueen* case, the Tokyo District Court denied judgment for McQueen¹⁸⁷ because even though footage of his performances were used in an advertisement without his consent, there was no implication that he endorsed the products.¹⁸⁸ The court seemed to deny a proprietary right of publicity type approach.¹⁸⁹

However, the Tokyo High Court did recognize the right of publicity as a property right in the *Oniyanki Club* case.¹⁹⁰ Here, a group of popular television actors’ likenesses were used in a calendar without their consent. The court reversed the lower court’s finding of an infringement of privacy since there was no showing of harm to the actors’ reputation or personality, but granted an injunction and damages for the economic harm, saying that, “analogous to property rights, it should be the artists’ exclusive right to be in control of the commercial exploitation of the benefits and value of their attraction to consumers.”¹⁹¹ Nonetheless, it appeared that the right was considered available only to ‘famous artists.’¹⁹² All of the above cases were brought under Article 709 of the Japanese Civil Code, which provides liability for damages for intentional or negligent acts.¹⁹³

In 2012, the Supreme Court of Japan made its first official ruling on the meaning of publicity rights and provided guidance for the recognition of such rights.¹⁹⁴ Pink Lady, a well-known Japanese female duo of the 1970s, sued the Japanese publisher of the magazine *Jyosei-Jishin* for compensatory damages due to the alleged infringement of their publicity rights. In the lawsuit, the plaintiffs claimed that the defendant violated their exclusive rights to use their name and pictures for commercial purpose by using their images in the magazine without their consent. The magazine

Technology & Communications by Baker Mackenzie available at <http://www.lexology.com/library/detail.aspx?g=279ebef1-e669-451a-9373-5a0ba6bb450a>

¹⁸⁴ See Tokyo Dist. Ct., 29 June 1976, 817 Hanrei Jiho 23

¹⁸⁵ Ibid

¹⁸⁶ Ibid

¹⁸⁷ STEVE MCQUEEN: IC 041. US 100 101 107. G & S: Entertainment services, namely, the presentation of live musical performances, theater, variety, comedy or recorded music; casino and gaming services; Serial No. 85240748; Filing Date: 11 February 2011; Registration No. 1070625; The Terry McQueen Testamentary Trust, a California trust The Trustee, Neile McQueen Toffel, a Citizen of the United States TRUST CALIFORNIA c/o Corbis Corporation 710 2nd Street, Suite 200 Seattle WASHINGTON 98104 and (APPLICANT) McQueen, Chadwick INDIVIDUAL UNITED STATES c/o Corbis Corporation 710 2nd Street, Suite 200 Seattle WASHINGTON 98104

¹⁸⁸ See Tokyo Dist. Ct., 10 November 1980, 981 Hanrei Jiho 19

¹⁸⁹ Note that in both of these cases, the plaintiff was a non-Japanese national. Japanese courts apparently apply Japanese law to a claim involving violation of these rights in Japan.

¹⁹⁰ See Tokyo High Court, 26 September 1991, 1400 Hanrei Jiho 3-14

¹⁹¹ Ibid

¹⁹² Ibid

¹⁹³ The basic provision in the Japanese Civil Code for tort liability, article 709, provides: “A person who violates intentionally or negligently the right of another shall compensate for damages arising there from.”

¹⁹⁴ Supreme Court Decision on 2 February 2012, H21(Ju)No.2056

article described a weight-loss method using dance routines to the duo's songs.¹⁹⁵

The Court ruled that the right of publicity - that is, the exclusive right to attract customers by using a name, image or similar characteristic in connection with the promotion of sales of a product - is one of the rights derived from moral rights, as it is based on the commercial value of the name, image or similar element.¹⁹⁶ Moreover, publicity rights are a prominent figure's promotional powers exclusively. An infringement of publicity rights will be recognized if the unauthorized use of prominent figures' name, pictures, and so on, is primarily for free riding on their promotional value.¹⁹⁷ The Supreme Court of Japan further held that prominent figures may be required to accept the use of their names and images for topical news, op-ed pieces, literary works and the like which are the legitimate exercise of the right of freedom of expression.¹⁹⁸ The Supreme Court provided three typical acts which may fall under the standard, "the purpose of such act is solely to utilize the powers of portraits [and other personality indicia] to attract customers" as follows:

- (i) Usage of portraits [and other personality indicia] themselves independently as commercial products which are subject to appreciation;
- (ii) Attachment of portraits etc. on commercial products for the purpose of distinguishing such products from others; and
- (iii) Usage of portraits [and other personality indicia] as advertisements for commercial products.¹⁹⁹

As for the results of the *Pink Lady* case, the Supreme Court of Japan did not recognize the infringement of the plaintiffs' publicity rights on the grounds that the publisher used their pictures in their magazine only for the purpose of recapturing people's memories of the era when the Pink Lady were active, and the magazine's main purpose was not to free-ride on the duo's promotional value.²⁰⁰

5. Conclusion

Given the enormous economic investment in merchandising famous identities, why is there an equally enormous gap in specific protection for said celebrity personas? Celebrity markets transcend national boundaries. Perhaps, it is no coincidence that both common law and civil law countries are re-visiting and re-evaluating the issue. Hopefully, these initial steps will result in

¹⁹⁵ See Tokyo Dist. Ct., 4 July 2008, Heisei 19 (wa) No. 20986 and Intellectual Property High Court, 27 August 2009 Heisei 20 (ne) No. 10063

¹⁹⁶ Supreme Court Decision on 2 February 2012, H21(Ju)No.2056

¹⁹⁷ Ibid

¹⁹⁸ Ibid citing, Article 21(1) of the Constitution which guarantees freedom of assembly and association, as well as freedom of the press and freedom in speech and all other forms of expression.

¹⁹⁹ Ibid. The author has emphasized [and other personality indicia].

²⁰⁰ Watanabe (2012) supra

some kind of international model on the issue of ‘publicity rights.’²⁰¹ “The recognition of a proprietary interest in the identity of a well-known individual in right of publicity doctrine is analogous to the recognition of a proprietary interest in goodwill or reputation of the celebrity in a common law passing off claim. Both actions acknowledge that the law should protect the commercial interests of these individuals and prevent unlawful profiting.”²⁰² Furthermore, a right of publicity claim does not require consumer confusion as to the plaintiff’s association with, or endorsement of, the defendant’s use.²⁰³ This caveat makes it seem more extensive in its protection against an unauthorized use of identity as opposed to a common law passing off claim. Celebrities in the United Kingdom and Australia generally must rely on passing off actions and equivalent statutory claims if their identities have been used without their consent because the right of publicity is not recognized in these jurisdictions. In a passing off claim, as opposed to a right of publicity claim, is necessary to demonstrate that consumers have been misled or deceived as to the celebrity’s endorsement of, or association with, the defendant’s products.²⁰⁴

“Trademark law is designed to protect the integrity of a mark’s meaning by preventing uses of the mark that confuse consumers or, for famous marks, uses that interfere with consumers’ mental association between mark and good. That goal also seems a legitimate justification for the right of publicity. If people are misled by the use of a celebrity name or likeness, both they and the celebrity are injured. Given that the only ones who benefit do so through deceit, such use almost certainly creates a net social harm.”²⁰⁵ By investigating these doctrines, two conclusions emerge: (1) the similarities between the doctrines does not lead countries to adopt or reject them in tandem; and (2) the stable and successful establishment of each doctrine in any given country depends on whether that doctrine has emerged as a natural evolution from the nation’s legal and cultural traditions.²⁰⁶

III. Image Rights as a Solution

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

²⁰¹ Dinwoodie, G (2000) *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. Pa. L. Rev. 469

²⁰² Tan, D (2010) *The Fame Monster Reloaded: The Contemporary Celebrity, Cultural Studies and Passing Off*, 32 Sydney L.R. 291

²⁰³ Restatement (Third) of Unfair Competition §§ 46 cmt c, 47 cmt a (1995)

²⁰⁴ See, eg, *Irvine v Talksport Ltd* [2002] 1 WLR 2355; *Pacific Dunlop Ltd v Hogan* (1989) 25 FCR 553; *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314; *Henderson v Radio Corporation Pty Ltd* (1960) SR(NSW) 576; see also, Tan (2010) *supra*

²⁰⁵ Dogan & Lemley (2006) *supra*

²⁰⁶ LaFrance & Cline (2008) *supra*

achievement in the twenty-first century. The *Image Rights (Bailiwick of Guernsey) Ordinance 2012* (IRO) 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.²⁰⁷

On 3 December 2012, the Bailiwick of Guernsey introduced a registration system for image rights. The IRO facilitates the registration of personality and any image rights (including rights in characteristics, mannerisms or traits) unique to that personality. The ability to carry out such a registration and obtain a property right in one’s image is a watershed and allows one to effectively register and protect one’s personality and image rights as a matter of public record for the first time. With this registration, the appropriation by others of a Registered Personality or associated characteristics, for unauthorized economic benefit may give rise to statutory infringement proceedings under the IRO.²⁰⁸

Hitherto, there has been no means for the legal registration of personality and image rights anywhere. The ability to publicly assert, exploit and protect image rights has instead depended on the use of a number of laws that seek to protect specific types of intellectual property, but where none are specifically designed for protecting such rights. In contrast to the existing legal concepts, ‘personality’ has now become a *property* right – i.e. not just something that happens to a person, but something that can be commercially exploited by, but also stolen from, a person. The IRO provides a legal framework which protects both economic and dignitary interests, without having to sacrifice one for the other.²⁰⁹

The benefits are numerous: any person, be they a natural person or a legal entity, can register their personality as a unique and exploitable asset. Moreover, the term ‘personality’ includes fictional personalities or the personalities of persons who have died within the last 100 years. It also permits joint and group registrations. Accordingly, Walt Disney Studios[®], for example, could choose to register Mickey Mouse[®] as a personality, or the estate of Albert Einstein[®] could choose to register Einstein’s[®] personality.²¹⁰ The registration of a personality immediately captures all present, historic *and future* images associated with that personality. In the context of the law, ‘image’ is framed extremely widely and means the name of the person and includes:

“...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...”

²⁰⁷ Adrian (2013a) supra

²⁰⁸ Ibid

²⁰⁹ Ibid

²¹⁰ Adrian (2013b) supra

*...any photograph, illustration, image, picture, moving image or electronic of other representation ('picture') of a personage and of no other person ...*²¹¹

Therefore, if the personality concerned is capable of expressing something unique by any means, it can be protected as a 'registered image' under the law. Moreover, as registered, protected intellectual property, a registered image (or the entire registered personality) can be sold or licensed for the authorized use by others recognizing the value that was hitherto difficult to clearly define and capture.²¹²

1. The Guernsey Image Rights System

The IRO operates in conjunction with a searchable database, The Image Rights Register – the IRR. This is operated and maintained by the Guernsey Intellectual Property Office and public access to it can be obtained subject to the creation of a simple username and password account.²¹³ The viewable information is limited to details concerning the registered personality and any associated registered images, the registered agent, whether any licenses have been granted and registered, whether the moral rights of the personality have been asserted and the renewal dates of the registration. However, details of the proprietor (i.e. the registered owner) are not viewable on this database. Applications for registration on the IRR are published weekly on the 'Journal' section of the Register website²¹⁴ and are viewable for twenty working days. Any objections to the proposed registration must be lodged with the Registrar within this timeframe. If no objections are received during this period, the application for registration should then be automatically approved.

2. Registered Personality

“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.”²¹⁵ Personality refers to the personality of the following types of person or subject which is described in the Image Rights Ordinance as the 'personage' and 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

²¹¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s3(1)(b) and (c)

²¹² Adrian (2013b) supra

²¹³ See <http://ipo.guernseyregistry.com/article/103845/Login?returnarticleid=104530>

²¹⁴ See <http://ipo.guernseyregistry.com/article/104630/Image-Rights-Journal>

²¹⁵ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s2(1)

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.²¹⁶

‘Personality’ is defined as “the personality of the person, two or more persons or character referred to in subsections (1) (a) to (e).”²¹⁷ A ‘natural person’ is 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.²¹⁸ So, Robert Downey, Jr.[®] would be a natural person, and so would, the deceased, Charlie Chaplin.[®] Moreover, 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.²¹⁹ Football clubs, like Arsenal F.C.[®], could be registered as a legal person, i.e., a corporation, or as a group. Joint personalities and groups are also accounted for; for example, Laurel & Hardy[®] may be joint personalities; whereas, The Rolling Stones[®] may be both joint personalities and a group.²²⁰ Finally, examples of human fictional characters would be James Bond[®] and Tintin[®], and examples of non-human fictional character would be Shrek[®], Snoopy[®], Hatsune Miku[®] and Mickey Mouse[®].

‘Image rights’ are defined as “exclusive rights in the images associated with or registered against the registered personality.”²²¹ ‘Image’ is defined 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

²¹⁶ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s1(1)

²¹⁷ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s1(2)

²¹⁸ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s1(5)

²¹⁹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s1(6)

²²⁰ 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.”

²²¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s5(1)

(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.²²²

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[®].²²³

(1) Who can register?

As noted earlier, the Image Rights Registry is publicly searchable. The main details recorded on the Register of Personalities and Images are the name and address of the proprietor of the personality and image rights, together with the date of registration.²²⁴ The date of application will be the date upon which all of the appropriate paperwork for an application has been received by the Registry.²²⁵ 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 back date any claim for damages for infringement.

The starting point is to be registered as the proprietor of a registered personality.²²⁶ 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.'²²⁷ Lady Gaga[®] would be a good example of this. Stefani Joanne Angelina Germanotta is the

²²² *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s3(1)

²²³ Adrian (2013b) *supra*

²²⁴ Part III *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*

²²⁵ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s17(2)

²²⁶ That proprietor has the image rights and other rights and remedies provided by the Image Rights Ordinance s 2(2)

²²⁷ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s1(7)

personnage better known by her personality and stage name Lady Gaga[®].²²⁸

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, Disney[®] could be a registered personality, getting protection for cartoon characters associated with Disney[®], such as Mickey Mouse[®], Peter Pan[®] and Winnie the Pooh[®], and/or these characters could be registered personalities in their own right.

(2) Why an image may not be registered

The Image Rights Ordinance lists various grounds for refusal of registration of a personality or an image.²²⁹ These effectively either complement or mirror existing trademark laws and fall into two categories – absolute grounds for refusal and relative grounds for refusal. Further grounds may be determined by the Registrar.²³⁰

(i) 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;²³¹
- contrary to public policy or morality (e.g. Jesus or Budha),²³²
- deceptive to the public;²³³
- the image or personality includes a representation of a protected emblem, such as a national flag, the Olympic symbol, image of the Queen;²³⁴
- use prohibited by Guernsey law;²³⁵
- bad faith application;²³⁶
- the application includes any statement, information, or document which constitutes

²²⁸ Under the IRO, the proprietor of the registered personality and associated image(s) can be different from the actual personage. (*The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s3(2)) In many cases the personage will have assigned the rights to exploit their image to a third party. Hence, the application process under the IRO 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.

²²⁹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss 6 - 10

²³⁰ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(g)

²³¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(a)

²³² *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(b)

²³³ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(d)

²³⁴ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss6(d)(i) & 7

²³⁵ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(e)

²³⁶ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(f)

an intellectual property offence under Guernsey law²³⁷; 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.²³⁸

Section 6(h) IRO may be a difficult concept in relation to image rights. For example, a trademark is said to become *genericized* when it began as a distinctive product identifier but has changed in meaning to become generic.²³⁹ This occurs when it has acquired substantial market dominance or mind share such that the primary meaning becomes the product or service itself rather than an indication of source for the product or service.²⁴⁰ However, how this applies to images is not so obvious. The travails of the House of Gucci[®] provide internationally contradictory insight into this issue.

Gucci[®] has been struggling with maintaining its brand images vis-à-vis its trademarks.²⁴¹ There have been claims that the ‘G’[®] logo is generic as well as having fallen out of use. Gucci[®] first filed a lawsuit against Guess[®] in 2009 - in both New York and Milan - accusing the brand of counterfeiting, unfair competition and trademark infringement, with particular reference to the use of a similar ‘G’ stamp appearing on shoes and accessories. Gucci[®] lost a four-year legal battle against Guess[®] in Milan.²⁴² Not only did Guess[®] ask the Tribunale di Milano dismiss Gucci’s[®] claims, but also declare its trademarks invalid on absolute grounds of non-registrability or,

²³⁷ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(g)

²³⁸ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s6(h)

²³⁹ The following list contains marks which were originally legally protected trademarks, but which have subsequently lost legal protection as trademarks by becoming the common name of the relevant product or service, as used both by the consuming public and commercial competitors. Some marks retain trademark protection in certain countries despite being declared generic in others.

App Store: Trademark claimed by Apple Inc. for their digital distribution platform. Apple filed a lawsuit against Amazon.com over *Appstore for Amazon*, but abandoned the trademark and the lawsuit after an early rejection of Apple’s false advertising claim in the lawsuit by the judge.

Aspirin: Still a Bayer trademark name for acetylsalicylic acid in about 80 countries, including Canada and many countries in Europe, but declared generic in the US.

Escalator: Originally a trademark of Otis Elevator Company.

Heroin: Trademarked by Friedrich Bayer & Co in 1898.

Lanolin: Trademarked as the term for a preparation of water and the wax from sheep's wool.

Laundromat: Coin laundry shop. Westinghouse trademark, registered in the US in the 1940s (automatic washing machine) and 1950's (coin laundry) but now expired.

Linoleum: Floor covering, originally coined by Frederick Walton in 1864, and ruled as generic following a lawsuit for trademark infringement in 1878; probably the first product name to become a generic term.

Sellotape: A British brand of transparent, cellulose-based, pressure-sensitive adhesive tape, and is the leading brand in the United Kingdom. Sellotape is generally used for joining, sealing, attaching and mending. The term has become a genericized trademark in Britain, Ireland, Australia, the Netherlands, New Zealand, Israel, India, Serbia, Japan, Croatia, Greece, Turkey, Macedonia, and Zimbabwe, and is used much in the same way that Scotch Tape came to be used in Canada and the United States, in referring to any brand of clear adhesive tape.

Thermos: Originally a Thermos GmbH trademark name for a vacuum flask; declared generic in the US in 1963.

Videotape: Originally trademarked by Ampex Corporation, an early manufacturer of audio and video tape recorders.

Weibo: 微博, which means microblog in Chinese, is a microblog service provided by Sina.

²⁴⁰ Ingram, *supra*

²⁴¹ Richardson, C (2014) *Gucci Loses GG Trademark: An important lesson in keeping records and evidence*, available at http://www.mondaq.com/x/287386/Trademark/Gucci+loses+GG+trade+mark&email_access=on

²⁴² *Guccio Gucci Spa v Guess? Inc, and Guess Italia Srl*, Tribunale di Milano, Sezione specializzata in materia di impresa (Sez A), Sentenza no. 6095/2013, RG 36857/2009, Judgment of 10 January 2013

alternatively, loss of distinctive character. The Italian court agreed by not only confirming that Guess[®] copied none of Gucci's[®] trademarks, but also declaring some of Gucci's[®] trademarks invalid for lack of distinctive character, including the Gucci[®] Flora-related trademarks (national trademark no 971291, and Community trademarks 4462735 and 5172218) invalid.²⁴³

The case in New York proceeded to a bench trial before Judge Shira A. Scheindlin, where Gucci[®] largely won its claims against Guess[®] based on trademark infringement and dilution claims, obtained a permanent injunction against Guess[®] and its licensees, and the cancellation of one of Guess[®] marks.²⁴⁴ "Gucci[®] firmly believes that the decision of the court of Milan is extremely incorrect, in particular because, in Gucci's[®] view, such decision does not take into account that Guess[®] use of trademarks similar to Gucci's[®] ones - famous, well-known and appreciated around the world - displays an unlawful and parasitic free-riding on Gucci's[®] trademarks and, in general, on its brand image," read a release from the fashion house.²⁴⁵

Nonetheless, in a decision by the UK Intellectual Property office of 5 November 2013, Gucci's[®] trademark for its interlocking GG[®] logo has been revoked in certain classes on the grounds of non-use. The mark was registered in 1984 for goods in classes 3 (broadly for cosmetics, perfumes and toiletries), 14 (jewelry), 18 (bags and purses etc.) and 25 (for various items of clothing in addition to scarves, socks, belts and shoes).²⁴⁶ The applicant was fashion brand Gerry Weber, who made their application on the basis that there had been no use of the mark during a five year period.²⁴⁷

This is a very important case as it is relevant to the on-going international battle over what will constitute genericide.²⁴⁸ Likewise, this will have huge ramifications on counterfeiting. If a major label like Guess[®] can copy Gucci[®], so can anyone else. A Registered Image becomes the last bastion once trademarks have failed through generification. Generification presents difficulties for the Image Rights Registry with regards to the difficulty in implementing 6(h). Hence, registering before one enjoys universal recognition is so important. Guess is heading towards a major come-uppance because they are obliterating clothing brand cache. People buy cheap 'G's to give the impression of buying a Gucci[®] 'G'[®].²⁴⁹ The Guernsey Registry would be in a difficult position determining which images would be acceptable representations of the Gucci[®] personage.²⁵⁰

²⁴³ Ibid

²⁴⁴ *Gucci v. Guess?*, 2012 U.S. Dist. LEXIS 70833 (S.D.N.Y. May 21, 2012)

²⁴⁵ Karmali, S (2013) *Gucci Loses Legal Battle Against Guess*, Vogue News available at <http://www.vogue.co.uk/news/2013/05/07/gucci-loses-guess-lawsuit---logo-copyright-case>

²⁴⁶ Richardson (2014) *supra*

²⁴⁷ s46(1)(b) Trademarks Act 1994: a trademark registration can be revoked if use has been suspended for an uninterrupted period of five years, without proper reason.

²⁴⁸ Ingram, *supra*

²⁴⁹ This is exactly the same as driving a Shaughuan Sceo instead of an actual BMW X5. See, <http://www.carscoops.com/2007/07/shuanghuan-sceo-chinese-bmw-x5-copy-cat.html>

²⁵⁰ While waiting for the Italian appeal, it is worth noting that parallel lawsuits have also been filed by Gucci in Paris and Nanjing.

(ii) Relative Grounds

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.²⁵¹ The notion of what is identical or similar is much more difficult than it seems. This iterates the trademark dilution framework discussed earlier; and as seen, where trademark courts struggle 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?²⁵²

Another relative ground for refusal is where there is an earlier right in relation to the personality or image applied for, whether this be trademark 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.²⁵³

(3) Protections

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.²⁵⁴ 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

²⁵¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss8 & 9

²⁵² This was vigorously argued in court by the first White Stig, Ben Harper. *BBC v Harper Collins* (2010) EWHC 2424

²⁵³ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s10

²⁵⁴ Greene, K J (2008) *From Second Life to the Afterlife: Intellectual Property Expansion*, 11 Chap. L. Rev. 521

image rights in it are personal and movable property.²⁵⁵ 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.²⁵⁶ There are provisions requiring registration of certain transactions affecting registered personalities and image rights. Such transactions would be:

- license;
- assignment;
- assent by a representative;
- order of court; or
- other transactions as may be prescribed (such as security granted over the image rights).²⁵⁷

The registration of a personality lasts for a period of ten years from the date of registration and may be renewed for further periods of ten years in perpetuity. 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.²⁵⁸

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.²⁵⁹ Upon registration, the licensee acquires certain rights to call on the proprietor to bring infringement proceedings and/or bring infringement proceedings itself.²⁶⁰ 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 directly under certain circumstances. This mirrors trademark principles.

(i) Infringement

The similarities to the infringement principles surrounding trademarks are very useful from a case law perspective. There is an additional layer of complication to the infringement provisions.

²⁵⁵ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s51

²⁵⁶ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s 52

²⁵⁷ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss51 – 64

²⁵⁸ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss18 & 19

²⁵⁹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s 63

²⁶⁰ *Ibid*

Only a ‘protected image’ can be infringed.²⁶¹ To be a protected image, at the time of the alleged infringement the image has to be ‘distinctive’²⁶², have ‘actual or potential value’²⁶³ and satisfy the registrability requirements of an image (whether or not it is in fact registered).²⁶⁴

An image is ‘distinctive’ if it is recognized 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.²⁶⁵ 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.²⁶⁶

“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.’²⁶⁷

(ii) Unauthorized Use

The Image Rights Ordinance provides a wide and non-exhaustive definition of what constitutes unauthorized 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);

²⁶¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s 27(2)

²⁶² *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s28

²⁶³ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s29

²⁶⁴ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s 27(2)(c)

²⁶⁵ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s28

²⁶⁶ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s29

²⁶⁷ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s27(1)

- 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; and
- use of the image as a domain name or as a company name.²⁶⁸

The Guernsey Court may analogize to UK copyright and trademark 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 trademark. As a result, this is a powerful right which is particularly attractive to brand owners.²⁶⁹

(iii) Limitations

The IRO recognizes that there are circumstances in which it is of a wider benefit to all to permit limited use of a registered personality or image without seeking consent from the registered proprietor in question. There are provisions in the Image Rights Ordinance dealing with invalidity and revocation of registrations.²⁷⁰ Fair dealing for parody, satire and responsible news reporting²⁷¹ is permitted. For example, as the law deals with matters of economic benefit rather than privacy, it is likely that the controversial photographs of the Duchess of Cambridge published in 2012 would have been permitted initially – as being of ‘general or public interest’, but the subsequent twenty-eight page special supplement published by an Italian magazine would almost certainly have infringed the Duchess’s Image Rights (had these been available at the time) on the basis of ‘unauthorized economic benefit’.

Section 31 deals with matters which do not constitute an infringement of image rights.

- “(1) A registered personality's image rights are not infringed by -
- a. the use of an image for comparative advertising provided that the use is in accordance with honest practices in trade, industrial, commercial or not for profit matters,
 - b. the use of a picture of a *personnage* solely as a member of the public where the *personnage* is not identified or singled out in or in connection with the use of the picture,
 - c. the use of a registered personality's image that is merely descriptive and used fairly and in good faith only to identify or describe something other than the *personnage* attributed to the image (including, without limitation,

²⁶⁸ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s27(3)

²⁶⁹ Adrian (2013b) *supra*

²⁷⁰ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, ss23 & 24

²⁷¹ *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s32

- to describe or identify a place, a legacy, or a style),
- d. fair dealing for the purposes of research,
- e. fair dealing for the purposes of news reporting, commentary and satire (see section 32),
- f. fair dealing for the purposes of the arts (see section 33),
- g. fair dealing for any other purpose (see section 34),
- h. the incidental inclusion of an image (see section 35),
- i. things done for the purposes of education (see section 36),
- j. acts of public administration and law enforcement, or done under statutory authority (see section 37),
- k. the making of temporary copies (see section 38),
- l. subject to any agreement to the contrary, the use of an image by the *personnage*, or a person's use of their own image (see section 39), or
- m. goods or services put on the market (see section 40).

(2) The provisions of this section set out the specific acts which may be done and uses which are permitted in relation to a registered personality's images notwithstanding the subsistence of image rights.

They relate only to the question of infringement of image rights and do not affect any other right or obligation restricting the doing of any of the specified acts or uses.

(3) For the avoidance of doubt -

- (a) the use of an image which is not a protected image does not infringe a registered personality's image rights, and
- (b) a registered personality's image rights are not infringed by the use of an image-
 - (i) by the proprietor of the image rights, or
 - (ii) with the consent of the proprietor of the image rights.²⁷²

These fair dealing provisions are important, not just because they are intrinsically reasonable, but because they help to ensure that the IRO is fully compliant with various international agreements regarding Intellectual Property, and this enhances the likelihood that the law will be internationally recognized and upheld.²⁷³

IV. How Image Rights can fit into the Japanese Intellectual Property System

To propose that property rights form part of the standards of international law seems

²⁷² *The Image Rights (Bailiwick of Guernsey) Ordinance 2012*, s31

²⁷³ Adrian (2013b) *supra*

uncontroversial. Through practices and treaties, property rights of citizens as well as non-citizens are routinely recognized. Without this recognition international commerce would not be possible. Complications arise when determining their nature and scope. Is it a negative right (the right not to have possessions interfered with) or a positive right (the right to acquire property)? Property rights can be divided into different categories (real, personal, equitable, tangible, intangible, etc).²⁷⁴ Although intellectual property is protected extensively by international agreements, the commercial appropriation of human indicia has never been addressed on such a global level, until now. The Guernsey Image Right Ordinance can be used as a blueprint for the protection of human indicia and can redress this gap in international law.

Prof Drahos poses the following questions about international property law norms: “Does the recognition of a right of property in international law apply with equal force to all the different types of property that can be identified? Do all, some or any of these different kinds of property rights qualify as fundamental human rights?”²⁷⁵

The Universal Declaration of Human Rights (the UDHR)²⁷⁶ has been described as an international constitution for a human rights regime.²⁷⁷ Article 27 illustrates the familiar tension in intellectual property law - the friction between protecting creators of information and allowing the use and dissemination of information. Section 1 states: “Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.”²⁷⁸ On the other hand, section 2 states: “Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.”²⁷⁹ The recognition of the interests of authors in the UDHR is balanced by the proclamation in Article 17 of a general right of property. Article 17(1) states: “Everyone has the right to own property.”²⁸⁰ Article 17(2) states: “No one shall be arbitrarily deprived of his property.”²⁸¹ The consequence of Article 17(2) is that states do have a right to regulate the property rights of individuals, but must do so according to the rule of law.²⁸²

Hegel’s personality justification for property rights - one’s personality is inherently linked to one’s identity – suits this philosophy. He explains property as an ‘expression of the self,’ which appears to exactly describe the concept of personality rights.²⁸³ For him, property is the

²⁷⁴ Drahos, P (1999) *The Universality of Intellectual Property Rights: Origins and Development* in Intellectual Property and Human Rights, Geneva: World Intellectual Property Organization, 13 - 41

²⁷⁵ Drahos (1999) *supra*

²⁷⁶ The Universal Declaration of Human Rights (1948) available at <http://www.un.org/en/documents/udhr/>

²⁷⁷ Drahos (1999) *supra*

²⁷⁸ UDHR (1948) Article 27(1)

²⁷⁹ UDHR (1948) Article 27(2)

²⁸⁰ UDHR (1948) Article 17(1)

²⁸¹ UDHR (1948) Article 17(2)

²⁸² Drahos (1999) *supra*

²⁸³ Hughes, J (1988) *The Philosophy of Intellectual Property*, 77 The Georgetown Law Journal 287

externalisation of personality into an object. This must remain external and not personal.²⁸⁴ This is rationalized further by Hegel's acknowledgment that "... attainments, talents, and so on are, of course, owned by the free mind and are something internal and not external to it; but even so, by expressing them it may embody them in something external and alienate them."²⁸⁵ By alienating these talents and attainments, the celebrity establishes characteristics of proprietary rights in them, which allows for the potential to buy and sell them as marketable commodities.

"One fascinating aspect of publicity rights is the idea that they actually protect privacy in the public realm; one can choose to broadcast or publicise certain elements of one's identity, yet reserve the right to control and limit them within the scope of privacy and economic torts. Indeed, once one alienates these aspects of identity, one's privacy in certain respects can be bought and sold as a commodity. However, a radical thought is that because the right to privacy is inalienable, it remains within the control of the individual in question."²⁸⁶ The right of personality or image right is a valuable property right. This form of intellectual property should be afforded protection from being misused by the media for commercial purposes as it was in the Pink Lady case. Image Rights, like other property rights, carry pecuniary value which is created by individuals in their personality by their best efforts.

The institutional design issue raised by this new right is not simply an issue of legal or economic technicality, but a profound political philosophy. Property regimes should serve those values, needs and interests identified as fundamental to our moral and political philosophies.²⁸⁷ The institution of personality rights as an intellectual property right is globalizing. Without some set of shared understandings concerning the role that that institution is to play in the culture of citizens around the world, success is unlikely. Linking personality rights to human rights would help to articulate theories and policies that will guide the adjustment of existing intellectual property rights and the creation of new ones.

The universal concept of human rights provides a common starting point for the analysis as to how Japan could incorporate an Image Rights law. Japan's reasons behind protecting personality rights could be based either on continental jurisdictional jurisprudence which stresses human dignity, or on common law jurisprudence which concentrates on an economic analysis. The Japanese legal system is truly unique: it is a mixture of civil and common law systems that have been grafted onto a system based on customs and values which have held paramount importance in

²⁸⁴ Stillman, P (1989) *Hegel's Analysis of Property in the Philosophy of Right*, 10 *Cardozo Law Review* 1042

²⁸⁵ *Ibid*

²⁸⁶ Anon (unknown) *Personality As Property: An Exploration and Comparison of Publicity Rights in the United States and United Kingdom, European Confederation of Art Critics* available at <http://www.europeanartcritics.org/index.php?q=content/personality-property-exploration-and-comparison-publicity-rights-united-states-and-united-ki>

²⁸⁷ Waldron, J (1987) 'Nonsense upon stilts? - a reply' in J. Waldron (Ed.), *'Nonsense Upon Stilts': Bentham, Burke and Marx on the Rights of Man*, London: Methuen

Japan for centuries and remain vibrant today. As is true in so many other facets of their system, the Japanese have been incredibly successful in absorbing features of foreign legal systems without sacrificing their own indigenous values.²⁸⁸

An important lesson to be learned from the Japanese legal system is that it is possible to adopt features of other legal systems and yet, by taking care, not sacrifice important values.²⁸⁹

V. Conclusion

“A legal tradition . . . is not a set of rules of law Rather it is a set of deeply rooted historically conditioned attitudes about the nature of law, about the role of law in society and in the polity, about the proper organization and operation of a legal system, and about the way law is or should be made, applied, studied, perfected and taught. The legal tradition relates the legal system to the culture of which it is a partial expression. It puts the legal system into cultural perspective.”²⁹⁰

An examination of the social, philosophical, and other influences on any individual, group, or nation is an invaluable tool in the process of exposing the effects that culture has upon the ways people conceptualize and categorize experiences and events at both a personal and a community level. From a central social perspective, themes in globalization have highlighted the need to better understand the greater world community. This is especially so with regard to the cult of celebrity and the growing trends in social media.

Never has the world of media been so pervasive and accessible in almost every facet of modern life. Visual image, sound bites and the cult of the celebrity are powerful forces, which can determine success or failure in nearly every aspect of public life, be it politics, performing arts or social communication. The commoditization of image has real value, both directly - for the individual concerned – and indirectly, in terms of generating income for firms specializing in hosting social media.²⁹¹

The registration of a personality immediately captures all present, historic *and future* images associated with that personality. Therefore, if the personality concerned is capable of expressing something unique by any means, it can be a protected image under the IRO. Moreover, as registered intellectual property, a registered image (or the entire registered personality) can be sold

²⁸⁸ Hahn, E (1983) *An Overview of the Japanese Legal System*, 5 Nw. J. Int'l L. & Bus. 517 “Today’s Japanese commercial legal system is a unique hybrid of civil law (Germany) and common law (United States) systems grafted onto a legal system based on the customs and values that has existed in Japan for hundreds of years.” Ibid

²⁸⁹ Ibid

²⁹⁰ Merryman, J H & Pérez-Perdomo, R (2006) *The Civil Law Tradition: An Introduction to the Legal Systems of Europe and Latin America*, 3rd ed. Stanford, CA: University of Stanford Press

²⁹¹ Adrian, A (2013a) *supra*

or licensed for the authorized use by others recognizing the value that was hitherto difficult to clearly define and capture.

Not only will the image rights register list key details of the registered personality and associated registered images, but it may also list key details of any licensing agreements entered into regarding the registered personality and associated images. Consequently, by choosing to register, an individual is effectively asserting to the world that their personality and any associated images are already registered and therefore potentially protected by law, thus helping to ensure that unintentional infringements do not occur.²⁹²

Furthermore, there are some lessons that have been usefully learned from the way other intellectual property rights have historically operated: a registered patent or trademark will take priority over an earlier, but unregistered process or product. Consequently there is no latitude for someone to subsequently argue in court that his/her image pre-dated one already registered. To a certain extent therefore, registration on the Image Rights Registry will be fuelled by positive feedback: as more people choose to register, the pressure on those who have not yet registered will increase through a fear of missing out to someone else.²⁹³

“Redefining, rethinking, redistributing property has always been one way in which political ideas and philosophies have made themselves concrete in the world.”²⁹⁴ This legal structure would be the most effective way to develop a new internationally-recognized intellectual property right as it embraces the Anglo-American common law economic rationale for the right, based on the commercial value of the persona, and the European civil law social values of the right which derive from the idea of personal autonomy, dignity and moral rights. By encompassing both policies, it is more likely that other countries and cultures will accept and integrate this new right into their existing intellectual property regimes.

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.

This paper was prepared for and on behalf of the Japanese Institute of Intellectual Property during January to March, 2014. Angela is a dual-qualified lawyer (US Attorney and English Solicitor). She is a leading authority on Intellectual Property and was the editor of the International Journal of Intellectual Property Management for several years.

²⁹² Adrian, A (2013b) supra

²⁹³ In practice this is more likely to drive the registration of registered images (i.e. specific characteristics or mannerisms) than the registration of personality. When dealing with real person registrations (as opposed to fictional characters) then each personality is of course unique.

²⁹⁴ Drahos (1999) supra

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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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