Image is everything

Lowenstein Sandler's **Matthew Savare** gives a comparative examination of publicity rights in the US and western Europe

Comedian Steven Wright once joked, "It's a small world, but I wouldn't want to paint it". Over the last decade, the proliferation of digital technologies has not made the world smaller or easier to paint, but it has significantly hastened the globalisation of content. This transformation, coupled with the developed world's insatiable fascination with fame, has spurred the hyper commoditisation of celebrity.

Despite the universality of celebrity, the laws governing the commercial exploitation of one's name, image, and likeness differ widely between the US and the nations of western Europe. In light of the increased trafficking in celebrity personas between the two continents, a brief comparative analysis is warranted.

A primer on US right of publicity law

The right of publicity is the "inherent right of every human being to control the commercial use of his or her identity".[1] A person's right of publicity is violated when an individual or entity "appropriates the commercial value of ... [the] person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade".[2] Countless athletes and celebrities have brought right of publicity suits in the US, including Michael Jordan, Tiger Woods, and Arnold Schwarzenegger.

Although there is no federal statute in the US governing the right of publicity, 31 states, including New York and California, currently recognise the right (19 by statute, 21 by common law, and 9 by a combination of the two). Wide variations between these state laws often lead to choice of law disputes and disparate results for both plaintiffs and defendants. Here is a sampling of some key differences:

- **Scope of protection** – the protectable elements of a person's identity vary from state to state. For example, Wisconsin's statute protects only name and likeness, while New Jersey's common law has been interpreted to cover name, photograph, image, likeness, performance characteristics, biographical data, vocal style, and screen persona. Generally, the right of publicity protects celebrities and non-celebrities, although celebrities typically receive higher damages awards.
- **Post mortem protection** – one controversial area of publicity law is whether – and for how long – a deceased persona can be protected. Many states, including California, recognise a post-mortem right of publicity, ranging from 10 years in states like Tennessee (although this term can be extended if commercial use continues) to 100 years in states like Indiana. Other states, however, such as New York, do not afford any post-mortem rights. Adding to the complexity, some courts have held that publicity rights survive death only if the individual exploited the right during his or her lifetime. At least one state statute affords longer post-mortem protection – 75 years – if the person's identity has "commercial value" versus only 10 years for those whose identity does not.
- **Remedies** – the remedies available to plaintiffs also vary from state to state. For example, New York's statute provides for injunctions, compensatory damages, and discretionary punitive damages. Ohio's statute, which offers the most remedies of any state statute, permits injunctions; a choice of either actual damages, "including any profits derived from and attributable to the unauthorised use of an individual's persona for a commercial purpose" or statutory damages between $2,500 and $10,000; punitive damages; treble damages if the defendant has "knowledge of the unauthorised use of the persona"; and attorney's fees.

  Courts have used primarily three methodologies or some combination thereof to value compensatory damages. First, the most obvious measure of damages is the fair market value of the appropriated identity, which is often awarded as an imputed licence fee or royalty. Secondly, plaintiffs have also recovered damages to their future earning potential or future publicity value. Finally, courts have awarded some or all of the profits the defendant made in using the misappropriated identity in order to prevent unjust enrichment.

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- **Defences** – defendants have a panoply of defences available to them in right of publicity actions, including consent, *de-minimis* usage, and traditional equitable defences such as laches and acquiescence. However, in light of the nation's First Amendment and analogous state statutes and constitutional provisions, the most widely-proffered defence is that a particular use of an individual's persona is protected by free speech. Many state statutes, such as the one in California,

expressly exempt news, media, and entertainment usages from right of publicity protections. Significantly, New York's statute does not include such a carve out. Courts in many of the states that recognise publicity rights through common law have created exemptions for political, newsworthy, and entertainment-related speech. Further complicating any free speech analysis, the unauthorised use of an identity to advertise an entertainment work is generally not protected.

The intersection of free speech protections with the right of publicity doctrine is the most nuanced and fact-intensive area of publicity law in the US, particularly with the rise of so-called "hybrid speech", which blends commercial messages with editorial, entertainment, and/or news content. Cases from across the country demonstrate how dissimilarly courts have addressed this issue, often employing different tests to distinguish between protectable speech and impermissible uses. First Amendment defences have been proffered in some of the seminal right of publicity cases in the US, including cases involving the Three Stooges, Tiger Woods, and, most recently in *Hart v Electronic Arts, Inc*, collegiate football players.

A primer on western European publicity law

A brief survey of the laws of the major media centers in western European, namely, England, France, Spain, Italy and Germany is offered here.

England

England does not recognise the right of publicity or any distinct right designed to protect an individual's name, image or likeness from unauthorised use. Accordingly, individuals have had to rely on a patchwork of doctrines – such as defamation, trespass, breach of contract and confidence, and self-regulatory codes such as the British Code of Advertising Practice – in attempt to protect their personality from commercial misappropriation. The most widely-used theory of recovery in British personality cases is the tort of "passing off", which is analogous to trademark infringement in the US.

Under this cause of action, a plaintiff must establish that the defendant's unauthorised use of his or her name, image or likeness creates a likelihood of confusion as to the source of the goods or services that damages the plaintiff's established goodwill or reputation. Although English courts have traditionally interpreted this tort narrowly, more recent cases have acknowledged claims for passing off based on false endorsements. For example, in *Irvine v Talksport Ltd,* Eddie Irvine, the famous Formula 1 racer, sued Talksport Radio after the broadcaster used a photograph of Irvine holding a mobile phone that had been altered to appear that he was holding a radio with the words "Talk Radio" on it. Irvine successfully sued, claiming that this manipulation of the photo created a false endorsement that affected his goodwill and reputation. Irvine's compensatory damages were based on imputing a reasonable endorsement fee for the promotional use. The Court of Appeals affirmed.

Despite Irvine's victory, there are many more examples of failed passing off claims. For example, in *Halliwell v Panini SpA*, the pop group Spice Girls were denied an injunction to prevent the defendant from distributing an unauthorised sticker collection featuring their images. Matters are even more difficult for the estates of deceased celebrities. For example, in 1997, a British court upheld the UK Intellectual Property Office's refusal to register several Elvis trademarks filed by Elvis Presley Enterprises, the owner of the late singer's post-mortem publicity rights. And, in 1999, an attempt to trademark the face of Princess Diana by her memorial fund was rejected, leading to a bevy of merchandise bearing her likeness. Although some living people – such as David Beckham and Russell Brand – have obtained trademarks in connection with their identity, these trademarks are for specific goods and services and do not empower their owners to stop all uses of their names and likenesses.

France

France recognises and protects a right of image, *droit a l'image*, which covers "likeness, voice, photograph, portrait, or video reproduction".[3] The right of image has evolved from initially protecting only privacy-based principles into now addressing economic-based (or patrimonial) principles as well. Consequently, it is usually described as a bundle of personality rights that generally consist of "the moral rights of authors; the right to privacy, the right to protect one's honour and reputation, and the right to control the use of one's image".[4]

French case law affords several defences to claims involving the unauthorised use of a person's image. First, an individual's image may be used with his or her prior, express consent for a specific, delineated purpose. Secondly, allowances are made for photographs taken in public places, although the bounds of the definition of "public" are often contested, and use cannot be made to ridicule the person or for commercial purposes. Thirdly, France's law on the freedom of the press safeguards freedom of speech, including news and other information of legitimate public interest, subject to individuals' right to human dignity. Finally, analogising to French copyright law, an image may be used for purposes of parody, provided the use is for humorous, non-offensive, and informative purposes.[5]

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Punitive damages are generally not available in image cases. However, French courts often award enhanced damages if a celebrity has not previously exploited his or her image in order to account for the economic and moral harms suffered.

For living persons, the right of image is transferrable with written consent. The descendibility of image rights and the scope of post-mortem protections are amorphous and fact-specific, however, often turning on whether the rights to be enforced sound in privacy or economic considerations. For example, in a case involving the image rights of deceased French actor Raimu, his widow was awarded compensatory damages after an advertising company used a caricature of her husband in a promotional campaign, but was denied dignitary damages based on her invasion of privacy claim. In order to recover damages for a deceased individual's image rights under French law, it appears that the image must have acquired some economic value during the person's life.

Spain

Spain offers robust protections to personality rights. In fact, at least one scholar argues that Spain affords even broader publicity rights than the US, which is widely regarded as the most protective in the world.[6]

Article 18 of Spain's Constitution guarantees "the right to honour, personal and family privacy, and one's own image". Article 1 of the Organic Law of 5 May 1982 deems these rights "fundamental". Articles 7.5 and 7.6 broadly prohibit "the taking, reproduction, or publication, by photography, film, or any other process, of a person's image captured in places or moments of his private life or outside of those settings" and

"the use of the name, voice, or picture of a person for purposes of advertising, business, or of a similar nature". However, Article 8 of the Organic Law does permit actions in which there is a "predominant and relevant historical, scientific, or cultural interest".

In cases where violations of these protections have been established, economic harm will be presumed and moral damages are recoverable. Spain also recognises a post-mortem image right. Specifically, Article 4 states that absent a will, a person's image right can be enforced by family members alive at the time of the person's death, arguably creating a post-mortem term measured by the lives of those family members. In the absence of legatees or heirs, the Ministry of Justice may enforce a person's image rights for up to 80 years after death.[7]

Italy

Under the laws of Italy, the right of publicity is a judicially-created right, emanating from the Italian Civil Code, which protects a number of personality rights, such as the right to privacy, image, and name.[8]

In *Dalla v Autovox SpA*, an Italian court extended the rights protected under the Civil Code by holding that the defendant misappropriated singer Lucio Dalla's persona by using two of the most distinctive elements of his appearance, a woolen cap and a pair of small, round glasses, in a commercial poster. Other Italian publicity cases have held that names (both real and stage names), images, signatures, and other indicia are protectable persona rights.

In order to state a claim for a right of publicity action under Italian law, a plaintiff must allege: "(1) that he or she is a public figure, not simply an ordinary person; (2) that the defendant has used distinguishing characteristics of the celebrity; (3) that the unauthorised use of his or her popularity is for a commercial purpose, to convince the public that he or she endorses or sponsors the product; and (4) that the unauthorised use of the celebrity persona caused immediate damage."[9] Importantly, unlike the various state laws in the US, the right of publicity laws in Italy extend only to celebrities and public figures.

Damages are calculated by either measuring the economic gain of the defendant or by evaluating the fair market value of the unauthorised use. As in France, Italian courts place higher values on personas that have not been overly exploited, which is in stark contrast to Britain, where establishing a reputation as an endorser was a predicate to establishing a passing off claim.

Whether the right of publicity is descendible under Italian law has been the subject of much debate, with different scholars opining that the right dies with the person, survives life plus 50 years, or that it should survive only if it has been commercially exploited during the celebrity's lifetime.[10]

Germany

German law protects against the unauthorised commercial uses of an individual's picture, name, voice, and other persona elements. In fact, certain personality protections – such as the right to a name – have been extended to legal entities as well. Section 22 of the German Act on the Protection of the Copyright in Works of Art and Photographs (KUG) states that "pictures or portraits may be distributed or displayed only with the consent of the person portrayed". German courts have interpreted the term "picture" broadly to cover various methods of depicting a person, including photographs, portraits, drawings, comics, and video game characters. Section 23(1) of the KUG lists four types of pictures that do not require consent:

1) Those of contemporary history.
2) Those where the persons appear only incidentally.
3) Those of gatherings where the persons portrayed have participated.
4) Those whose distribution or display would be in the higher interests of art.

Section 12 of the German Civil Code (BGB) protects the right to one's name, which extends to surnames, well-known pseudonyms, and nicknames. Unlike the protections afforded to one's picture, use of another's name is unlawful only if it creates a likelihood of confusion, which depends on the distinctiveness of the name and also the specific fields in which the plaintiff enjoys recognition. Other elements of an individual's persona, such as voice and famous quotations, fall within the judicially-created "general right of personality".

German courts frequently must evaluate the competing interests of an individual's personality rights against freedom of expression, information, and art. For example, in one of the more often cited cases, the German Federal Supreme Court held that the unauthorised use of a picture of the well-known footballer, Franz Beckenbauer, on the front page of a football calendar was permissible, reasoning that the public's need for information outweighed the legend's commercial interests.

Generally, the right to personality is neither transferable nor descendible, because it is considered a personal right. However, the right to one's image may be protected by a deceased person's relatives for a 10-year post-mortem period, during which time the family can demand licensing fees. Aggrieved parties may seek injunctions and compensatory damages, and in cases where the misappropriation constitutes defamation, damages for pain and suffering as well.

Although the world is not getting any smaller, it is becoming increasingly interconnected at a greater pace than any other time in our history. As the global rise of the celebrity culture continues unabated, issues surrounding personality rights will continue to percolate. Although the laws among the various nations are converging – as they have in other areas of the law – pronounced differences do remain, which will continue to challenge advertisers, brands, celebrities, ordinary people, and practitioners alike for years to come.

Footnotes

1. J Thomas McCarthy, The Right of Publicity and Privacy 1:3, at 3 (2d ed 2012).
2. Restatement (Third) of Unfair Competition §46 (1995).
3. Elisabeth Logeais & Jean-Baptiste Schroeder, The French Right of Image: An Ambiguous Concept Protecting the Human Persona, 18 Loy La Ent LJ 511, 511 n1 (1998).
4. Id at 513.
5. Id at 531.
6. Stephen R Barnett, The Right to One's Own Image: Publicity and Privacy Rights in the United States and Spain, 47 Am J Comp L 555, 579-80 (1999).
7. Barnett, supra note 6, at 566.
8. Silvio Martuccelli, The Right of Publicity under Italian Civil Law, 18 Loy La Ent LJ 543, 548 (1998).
9. Martuccelli, supra note 8, at 557.
10. Id at 562.
11. Susanne Bergmann, Publicity Rights in the US and in Germany: A Comparative Analysis, 19 Loy La Ent LJ 479, 511 (1999).

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