



SALLIE SPILSBURY

# MEDIA LAW

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## CHARACTER MERCHANDISING AND ENDORSEMENTS

### CONTROLLING THE USE TO WHICH AN IMAGE IS PUT

Character merchandising means the use of the name or likeness of a well known celebrity or fictional character in order to increase the sales potential of goods or services. It is well accepted that the name and image of public figures and fictional characters can be used to promote, advertise and market products and services. Sponsorship and product endorsement agreements are a normal feature of the business activities of celebrities and sports personalities. The net result is that the fictional or living character in question often becomes a commodity in its own right and can demand large fees in return for product endorsement. The usual way in which a manufacturer of a product goes about using the name or likeness of a celebrity or fictional character is by obtaining a licence (or, in other words, permission) in return for payment. This is especially the case in relation to fictional characters such as *The Simpsons* or Disney characters. Commercial businesses invest large amounts of money to secure rights to use these names and likenesses for their products or services.

But not all advertisers or merchandisers are willing to pay large fees for a licence to use the personality or character. In 1997, a company produced a sticker album featuring images of the Spice Girls. No permission was sought for the use of their likenesses. In 1999, a radio station advertised itself using a poster part of which featured a photograph of the football player Jamie Redknapp. No licence was taken for the use of his image. These instances, and many others like them, raise the issue of whether a personality or the creator or owner of the rights to a fictional character can control the use to which the name, likeness and image are put and what steps (if any) can be taken to secure effective exclusivity for use of the image.

We shall see that it is generally more straightforward to restrain the unauthorised use of an fictional character (such as Bart Simpson) than it is for a living person.

#### *No personality right for living persons*

Under English law, there is no free standing *personality right* which a living person can exercise to control the commercial exploitation of his name, likeness or image. Personalities do not, therefore, have a directly enforceable legal right to exercise to restrain the use of their name and likeness. Their likeness or name may be used for commercial purposes *except to the extent* that

the use gives rise to a claim in intellectual property, defamation or trade description law.

On the other hand, the media industry codes – most notably, the Committee of Advertising Practice Code – (which are examined in more detail in Chapter 16) contain restrictions on the unauthorised use of people. For most practical purposes, it is the codes which govern the effective position on the use of famous personalities.

## THE LEGAL RESTRICTIONS

### (a) Defamation<sup>1</sup>

The law of defamation protects the *reputation* of a living person or of a corporation. Statements will be defamatory if they tend to make ordinary people think less of the subject. In order to bring a successful action for defamation, a personality has to show that the use or reference to his name or likeness has caused damage to his reputation. A defamation claim of this type will generally involve an allegation that the use of the name or likeness carries the implication of bad faith on the part of the personality or exposes the personality to ridicule. *The estates of dead people* cannot bring proceedings for defamation.

An example of a defamation claim arising from an unauthorised reference to a personality is the case of *Tolley v Fry*.<sup>2</sup> The claimant was a well known amateur golfer. He was caricatured in an advertisement for Fry's chocolate in such a way as suggested that he was endorsing the product. Mr Tolley had not given permission for his likeness to be used in the advertisement. He commenced proceedings on the basis that the advertisement was defamatory, in that it suggested that, despite his amateur status, he had agreed to advertise the product in return for payment. He alleged that this suggestion was damaging to his credit and reputation as an amateur golfer. The court upheld the claim, finding that the advertisement inferred that Mr Tolley was a hypocrite when he presented himself as an amateur golfer. The court made clear in its judgment that the unauthorised use of the likeness of Mr Tolley would not have been actionable in the absence of this defamatory inference.

Most of the defamatory meanings likely to arise in connection with the unauthorised use of a personality involve meanings that are not apparent from the face of the publication. The advertisement in *Tolley v Fry* would not

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1 Defamation was considered in detail in Chapter 3.

2 *Tolley v Fry* [1931] AC 333.

have had a defamatory meaning unless the audience was already aware of Mr Tolley's amateur status. That status was not apparent from the face of the advertisement.

This type of 'hidden' meaning is known as an *innuendo*. Care should be taken to assess material which refers to a personality for innuendo meanings. This exercise will involve knowledge the public stance of the personality on relevant issues so as to ensure that a committed animal rights activist is not shown wearing animal fur or a known teetotaler is not used to promote alcohol. Both of these scenarios would involve an inference that the personality in question is a hypocrite by suggesting they would disregard their publicly expressed opinions for the sake of personal gain. The fact that the publisher of the defamatory material did not intend to make a defamatory statement is irrelevant to liability.

Care should be taken where the personality is known to have an exclusive merchandising contract or an employment contract which forbids them to participate in promotional activities or product endorsements. The unauthorised use of the name and/or likeness could be defamatory if the personality is able to prove that *some* of the audience would have believed that he had agreed to appear in the advertisement in breach of contract.

### **(b) Malicious falsehood<sup>3</sup>**

Where a party makes a false representation about a personality knowing it to be false or reckless as to whether it is or is not true, it could be liable for malicious falsehood provided that the falsehood causes (or in some cases is likely to cause) the personality financial loss. In the case of *Kaye v Robertson*,<sup>4</sup> a newspaper which sought to portray as an exclusive an interview obtained without consent with the then gravely injured Gordon Kaye was held liable in malicious falsehood. The false portrayal of the interview as something which Mr Kaye had willingly consented to was held to be a falsehood, causing him a likelihood of pecuniary loss, because he might otherwise have been able to sell his story to the media.

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3 Malicious falsehood was considered in detail in Chapter 4.

4 *Kaye v Robertson* [1991] FSR 62.

### (c) Copyright and moral rights<sup>5</sup>

#### *The use of photographs or film footage of the personality for commercial purposes*

##### *A limited right of privacy*

A person who commissions photographs (or videotapes and films or stills taken from them) for private or domestic purposes has the right to prevent the unauthorised publication of the material.<sup>6</sup> The right applies only to material which is *commissioned* for private or domestic purposes. It will not apply to uncommissioned material which happens to be taken on a private occasion, for example, photographs taken by the paparazzi. The right is owned by the *commissioner* of the material, who may not necessarily be the subject of the photograph or film, and it cannot be transferred. This right was considered further in Chapter 8.

##### *Copyright in photographs*

Copyright subsists in photographs as artistic works. The unauthorised publication of a photograph will infringe copyright in the photograph, unless it falls within one of the permitted uses discussed in Chapter 6. In order to avoid infringement, the copyright owner should be approached for permission to use the photograph. Alternatively, the user might acquire copyright in the photograph by way of an assignment.

Copyright in photographs, whether commissioned or not, will belong to the *photographer*, unless copyright has been assigned to a third party. Unless the subject of the photograph has acquired the copyright by way of assignment, he will have no right to restrain the publication of the photograph on the ground that it is an infringement of copyright. A person can prevent reproduction of drawings and photographs of him in which he owns copyright, but has no right to prevent the reproduction or exploitation of any photographs and drawings in which he does not own copyright simply by reason of the fact that they contain or depict his likeness.

#### *Copyright and photographs comprising of stills of films*

The unauthorised use of a still from a film, television broadcast or cable programme is an infringement of copyright of the work from which it was taken.<sup>7</sup> A licence should therefore be obtained from the copyright owners (who will usually be the *production company and the principal director* in the case

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<sup>5</sup> Copyright and moral rights were considered in detail in Chapter 6.

<sup>6</sup> CDPA 1988, s 85(1).

<sup>7</sup> *Ibid*, s 17(4).

of a film and the *broadcaster* in the case of a broadcast or cable programme). The copyright owner will probably not be the individual(s) who appear in the still.

The film may also be a dramatic work for copyright purposes.<sup>8</sup> This was discussed further in Chapter 6. Where a substantial part of a dramatic work is reproduced without consent, it will infringe copyright in the dramatic work. It is arguable that the reproduction of a single still in the film might represent a substantial part of the *dramatic work* – especially as the Copyright, Designs and Patents Act (CDPA) 1988 expressly provides that a reproduction of a still infringes copyright in the film as a copyright work.<sup>9</sup>

Where the still is taken from a cartoon or other type of work of animation, the drawings will be artistic works for copyright purposes and the reproduction is likely to infringe copyright in the artistic work as well as the film or broadcast.

*Will photographs which are taken from stills infringe performance rights?*

A performer has the right to prevent the unauthorised exploitation of the recording of their performance. This right is a relatively recent introduction to English law. So far as the author is aware, an English court has not been called on to consider whether the use of a single still featuring a performer could be said to constitute an infringement of the performer's rights. In the author's opinion, a still is *capable* of infringing a performer's rights. In order to err on the side of caution, consent should be sought from the owner of the performance right. This may not be the performer. The rights can be, and often are, assigned: usually, in the case of a film, to the film production company.

*Copyright and the use of film footage*

The above observations apply equally to the use of footage as to the use of stills. A licence to use the footage will be required from the copyright owner. Performance rights should also be cleared.<sup>10</sup>

*Copyright in signatures*

An individual's signature may be protected under copyright law as an artistic work. If so, the unauthorised reproduction of the signature will infringe copyright. The name itself will *not* be protected by copyright; it is the *appearance* of the signature which is protected.

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8 *Norowzian v Arks (No 2)* [2000] EMLR 1. This case is considered in detail in Chapter 6.

9 CDPA 1988, s 17(4).

10 Clearance procedures are described in Chapter 18.

It should be remembered that copyright only subsists in works which are the product of skill, judgment and labour. An everyday signature of a rudimentary nature is unlikely to satisfy these requirements. Similarly, if the name were written in a simple form, say, in block capitals, the reproduction would not infringe copyright. The more elaborate the signature, the more likely that it will be protected by copyright.

### *Copyright in a name*

It is well established under copyright law that copyright does not exist in a name. For example, in the 1869 Privy Council case of *Du Boulay v Du Boulay*,<sup>11</sup> the court observed that:

... in this country we do not recognise the absolute right of a person to a particular name to the extent of entitling him to prevent the assumption of that name by a stranger.

This is so whether the name in question is the name of a living individual or an invented word for a fictional character. The name of the fictional character 'Kojak'<sup>12</sup> has been refused copyright protection under English copyright law, as has the real life surname of Burberry.<sup>13</sup>

### *Copyright in appearance*

There is no copyright in a living person's appearance, even if that person has a carefully crafted image. This was illustrated by the case of *Corp'n of America v Harpbond*.<sup>14</sup> The case concerned the unauthorised reproduction of the pop star Adam Ant's distinctively made-up face. The court found that no copyright existed in the pop star's appearance.

### *Copyright and the appearance of fictional characters*

Where the merchandising concerns cartoon or animated characters, copyright can exist in the drawings of the characters as artistic works (although design right may replace copyright where the character is an article, such as a puppet. This is discussed below).

It is a copyright infringement of a two dimensional artistic work to reproduce it in three dimensions and vice versa.<sup>15</sup> Hence, it will be an infringement of copyright in a drawing to produce a model of a cartoon character.<sup>16</sup>

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11 *Du Boulay v Du Boulay* (1869) LR 2, PC.

12 *Tavener Rutledge v Trexapalm* [1977] RPC 275.

13 *Burberrys v Cording* (1909) 26 RPC 693.

14 *Corp'n of America v Harpbond* [1983] FSR 32.

15 CDPA 1988, s 17(3).

16 *Eg, King Features Syndicate v Kleeman* [1941] AC 417, where the manufacturer of 'Popeye' dolls was held to have infringed copyright in the drawings of the Popeye figure.

### (d) Design rights and merchandising

The CDPA removed copyright protection from design drawings for functional articles created after 1 August 1989 and replaced it with design right. At first sight this may not seem to have implications for character merchandising. But the removal of copyright has been held to apply to the copying of three dimensional puppets and models. Design right might therefore have a wider scope than the protection of purely functional articles.

Section 51 of the CDPA provides that:

- (1) It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface to make an article to the design or to copy an article made to the design.
- (2) Nor is it an infringement of the copyright to issue to the public, or include in a film, broadcast or cable programme service, anything the making of which was, by virtue of sub-s (1) not an infringement of that copyright.
- (3) In this section:

‘design’ means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration; and

‘design document’ means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise;

the effect of the section is to remove copyright protection from what is potentially a wide category of articles and to replace it with a new right, design right.

The approach which should be adopted when determining whether a design is protected by copyright or design right is as follows:

- is the drawing/model for an article? If no, copyright applies;
- if yes, is the article an artistic work, for example, a work of sculpture, or a typeface? If yes, copyright will apply. ‘Artistic work’ includes a work of artistic craftsmanship;
- if the design is not for an artistic work, design right may apply. The definition of ‘design’ should be considered to ensure that the article falls within it.

#### *Key differences between copyright and design right*

The distinction between copyright and design right is important because design right affords a more limited protection than copyright law. Copyright subsists in an artistic work for the life of the author plus 70 years (unless the work has been exploited by an industrial process, in which case the period of



protection is reduced to 25 years from the end of the calendar year in which the goods are first marketed).<sup>17</sup> Design right, on the other hand, expires:

- (a) 15 years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever first occurred; or
- (b) if articles made to the design are made available for sale or hire within five years from the end of that calendar year, 10 years from the end of the calendar year in which that first occurred.<sup>18</sup>

Any person is entitled as of right to a licence to do anything which would otherwise infringe the design right in the last five years of the design right term.<sup>19</sup>

Under design right law, a designer can therefore have effectively only five years' protection for a commercially exploited design.

Another important difference between copyright and design right is that copyright subsists in original artistic works. As we have seen in Chapter 6, the test for 'originality' requires only that the design must not have been copied from something else.

Design right has a higher threshold than copyright. It will only apply if a design is original (in the copyright sense) *and if it was not commonplace in the design field in question at the time that the design was created*. The meaning of commonplace is considered below. It is a more stringent test than originality.

Recent cases have demonstrated the width of design right and, in particular, its application to character merchandising.

### BBC Worldwide Ltd v Pally Screen Printing Ltd<sup>20</sup>

The claimant alleged that it owned the intellectual property rights and associated merchandising rights in the TV programme 'Teletubbies'. The first and second defendants were respectively a printing company and its sole director. They printed pictures of the Teletubbies on items of clothing. This activity was not authorised by the claimant, which sought summary judgment for infringement of its copyright in the drawings of the Teletubby characters.

The defendants argued that the drawings of the Teletubbies which the claimant relied on to show infringement in its artistic works had been created for the purpose of creating the three dimensional puppets used in the programme. These puppets were articles for the purposes of the CDPA. It

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17 CDPA 1988, s 52.

18 *Ibid*, s 216.

19 *Ibid*, s 237(1).

20 *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665.

followed that, under s 51, it was not an infringement of copyright in the design documents to copy the puppets made to the design.

The judge found that the defendants had made out a clearly arguable case that design right law rather than copyright law was applicable in respect of the alleged copying of the puppets.<sup>21</sup> The case does not appear to have proceeded any further than this application. However, in a subsequent case concerning design right in circuit diagrams, Pumfrey J cited the judgment in the *Teletubbies* case, observing that 'it seems to me that [the judge] came to a clear construction for reasons which I find compelling'.<sup>22</sup>

It is therefore quite possible in the wake of the *Teletubbies* decision that protection for three dimensional characters such as puppets or models will fall under design right protection rather than copyright, unless the claimant can demonstrate that the puppets or models are artistic works for copyright law purposes.

### Jo-Y-Jo Ltd v Matalan Retail Ltd<sup>23</sup>

The shape of an item of clothing (a knitted vest) was held to be an article for the purpose of s 51 and was accordingly protected by design right, rather than copyright. This judgment has important repercussions for the fashion industry,<sup>24</sup> which may no longer be able to rely on copyright in relation to the shape of their designs.

#### *What is design right?*

The definition of design right is set out in the CDPA. The relevant provisions are as follows:

#### *Section 213(1)*

Design right is a property right which subsists in an original design.

*Design:* the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article.

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21 It might have been possible for the claimants to argue that the puppets were works of artistic craftsmanship and so were copyright works under s 51. The point does not appear to have been considered.

22 *Mackie Designs Inc v Behringer Specialised Studio Equipment (UK) Ltd* [1999] RPC 717.

23 *Jo-Y-Jo Ltd v Matalan Retail Ltd* (1999) unreported.

24 See, eg, *Jo-Y-Jo v Matalan: threadbare protection for clothing designs?* [1999] EIPR 627.

*Section 213(2)*

Design right does not subsist in:

- (a) a method or principle of construction;
- (b) features of shape or configuration of an article which:
  - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function ('must fit' exemption); or
  - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part ('must match' exemption); or
- (c) surface decoration.

*Section 213(4)*

A design is not original if it is commonplace in the design field in question at the time of its creation.

*Section 226(1)*

Primary infringement of design right.

The owner of the design right in a design has the exclusive right to reproduce the design for commercial purposes:

- (a) by making articles to that design; or
- (b) by making a design document recording the design for the purpose of enabling such articles to be made.

*Section 226(2)*

Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design ...

*Section 226(3)*

Design right is infringed by a person who authorises another to do anything which is the exclusive right of the design owner.

*Section 226(4)*

Reproduction may be direct or indirect.

Note that s 227 defines acts of secondary infringement equivalent to those affecting copyright under ss 22 and 23(a)–(c).

*Guidance on the above provisions*

As design right is a relatively new innovation, there have been a limited number of cases concerning the above statutory provisions. Such guidance that has emerged has established the following:

*'Original' and commonplace design – s 213*

Section 213 provides that a design is not original if it is commonplace in the design field in question at the time of its creation. The *Farmers' Build*<sup>25</sup> case laid down important guidance about the meaning of 'original' and 'commonplace' as follows:

- (a) 'original' has the same meaning as in Pt 1 of the CDPA relating to copyright in literary, dramatic, musical and artistic works;
- (b) designs which are original in the 'copyright sense' can cease to be 'original' for design right purposes where they are commonplace (s 213(4));
- (c) 'the approach of the court should be as follows:
  - compare the design of the article in which design right is claimed with the design of other articles in the same field at the time of its creation and with the alleged infringing article;
  - the court must be satisfied that the design for which design right is claimed has not simply been copied from the design of an earlier article. The court must bear in mind that, in the case of functional articles, one design may be very similar to or even identical to another design and yet not be a copy. If the court is satisfied that it has been slavishly copied from an earlier design, it is not 'original' in the 'copyright sense' and the commonplace issue does not arise;
  - if the court is satisfied that the design has not been copied from another design, the design is original in the 'copyright sense'. The court must then decide if it is 'commonplace'. For that purpose, it is necessary to ascertain how similar the design is to the design of similar articles by persons other than the parties to the litigation in the same field of design at the time when the design was created;
  - this is a comparative exercise to be conducted objectively in the light of the evidence (including expert evidence) pointing out the similarities and differences and explaining their significance. It is for the court to decide whether the design is commonplace. This is a question of fact and degree. The closer the similarity of the various designs, the more likely that the designs are commonplace (especially if there is no causal link – such as copying – to account for the similarity);

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25 *Farmers' Build v Carier Bulk Material* [1998] All ER (D) 681.

- if there are aspects of the claimant's design of the article not to be found in any other design in the field in question and those aspects are in the defendant's design, the court is entitled to conclude that the design in question was not commonplace. A commonplace article may have a shape and configuration which is not commonplace – it is the shape and configuration which is protected by design right, not the article itself;
- the burden is on the claimant to identify the relevant aspects of the shape and configuration of the article and what is original about the design. The burden is then on the defendant to allege and adduce evidence showing that, although the design is original in the 'copyright sense', it is commonplace in the field in question;
- there can be design right in the overall shape and configuration of an article, even if all the individual parts are commonplace provided the overall shape and configuration is different to other designs in the field in question.

In the *Jo-Y-Jo v Matalan* case,<sup>26</sup> the shape of a vest was held to be a commonplace design, which did not qualify for copyright protection.

#### *The meaning of 'design'*

The definition of 'design' is wide enough to include the shape or configuration of the individual parts of an item and of the item as a whole. The individual parts, combinations of those parts and the parts made up into the whole item are all 'articles' with a shape and a configuration for the purposes of s 213,<sup>27</sup> meaning that 'the proprietor can choose to assert design right in the whole or any part of his product. If the right is said to reside in the design of a teapot, it can mean it can reside in the whole pot design or the design of the spout or the handle or the lid – or part of the lid. So, design right can be trimmed to closely match what has been taken.'<sup>28</sup>

#### *Meaning of 'surface decoration' – s 213 of the CDPA (excluded from design right protection)*

Surface decoration includes decoration lying on the surface of the article and decorative features of the surface itself. It is not confined to features which are two dimensional.<sup>29</sup> In *Mark Wilkinson Furniture*, it included the painted finish, beading and 'v-grooves' in a fitted kitchen. These features were accordingly excluded from design right protection. The rounded cornice on kitchen

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26 *Jo-Y-Jo Ltd v Matalan Retail Ltd* (1999) unreported.

27 *Farmers' Build v Carrier Bulk Material* [1998] All ER (D) 681.

28 Laddie J in *Ocular Sciences v Aspect Visioncare* [1997] RPC 289.

29 *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63.

cupboards, on the other hand, was not surface decoration. It was part of the shape of the cupboard.

Surface decoration includes those decorative features which also serve a functional purpose.<sup>30</sup>

In the case of a knitted vest, design right would exist in the shape of the article (provided it is original and not commonplace), but not in the surface decoration. It was held that *the essence of surface decoration is the application of a decorative process to a pre-existing surface*, for example, embroidery applied to the knitted vest.<sup>31</sup> Seam lines and piping on a mobile phone case have been held to be surface decoration.<sup>32</sup>

*The 'must match' exclusion – s 213 of the CDPA (excluded from design right protection)*

The 'must match' exclusion did not apply to a fitted kitchen as a whole because the complete fitted kitchen was not an article itself, but instead was a series of matching articles, that is, separate cupboards, none of which formed an integral part of another article.<sup>33</sup> Each individual unit was therefore to be regarded as a separate entity. The same reasoning will probably apply to other constituent elements of a set: for example, the cups, sugar bowl, teapot, etc, making up a tea set, will each be an article in their own right.

*The 'must fit' exclusion – s 213 of the CDPA (excluded from design right protection)*

The fact that a breast prosthesis was flexible and compliant such that it could fit a number of different styles of bras was sufficient to take it outside the 'must fit' exemption. The exemption is concerned with a much more precise correspondence between the two articles, such as with a rigid plug and socket, where the functional requirement that one article should fit in or against the other displaces the original design work.<sup>34</sup>

In relation to the mobile telephone case, it was held that a basic function for a case is to enclose the telephone. Those aspects of the case which enabled it to be placed around the telephone so that either the telephone or the case could perform its function were excluded from design right protection.<sup>35</sup>

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30 *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63.

31 *Jo-Y-Jo Ltd v Matalan Retail Ltd* (1999) unreported.

32 *Philip Parker v Steven Tidball* [1997] FSR 680.

33 *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63.

34 *Amoena v Trulife* (1995) unreported.

35 *Philip Parker v Steven Tidball* [1997] FSR 680.

Any feature of shape and configuration which met the 'must fit' exemption is excluded from design right protection, even if it performed some other purpose.<sup>36</sup>

'Article' applies equally to animate and inanimate things for the purpose of this exception. Therefore, those features allowing a contact lens to fit against the eyeball to enable the lens to perform its function were excluded.<sup>37</sup>

#### *Infringement of design – making articles to the design*

The same general principles apply to infringement of design right as to copyright infringement.<sup>38</sup> First, there has to be objective similarity (excluding features of surface decoration) between the infringing article and the design, or a substantial part thereof. Secondly, there has to be causal connection between the design and the infringing article, that is, copying. Where copying is not established, there is no design right infringement.<sup>39</sup>

Similarity is to be assessed in the eyes of the person to whom the design was directed, that is, the potential user or acquirer of the claimant's products.<sup>40</sup> It is *not* necessary to show a deliberate intention to copy on the part of the defendant in order to give rise to a primary infringement,<sup>41</sup> nor is it necessary that the defendant must actually have the claimant's design in front of them when making the item complained of.<sup>42</sup> Mere changes in scale do not produce different designs.<sup>43</sup>

#### *Ownership of design right*

##### *Section 215*

The person who creates the design ('the designer') is the first owner of design right unless it is created in the course of a commission or the course of employment. Where the design is computer generated, the designer is the person who made the arrangements which were necessary for the creation of the design.<sup>44</sup>

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36 *Ocular Sciences v Aspect Visioncare* [1997] RPC 289.

37 *Ibid.*

38 *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63.

39 *Amoena v Trulife* (1995) unreported.

40 *Mark Wilkinson Furniture Ltd v Woodcraft Designs (Radcliffe) Ltd* [1998] FSR 63.

41 *Ibid.*

42 *Philip Parker v Steven Tidball* [1997] FSR 680.

43 *Ocular Sciences v Aspect Visioncare* [1997] RPC 289.

44 CDPA 1988, s 214(2).

*Section 215(2)*

Where the design is created in the course of a commission, the person commissioning the design is the first owner of design right in it. *This is the opposite to the position under copyright law.*

*Section 215(3)*

Where the design is created by an employee in the course of his employment, his employer is the first owner of design right in the design (unless the design is commissioned, in which case it is the commissioner pursuant to s 215(2)).

**(e) Passing off**

Although there is no copyright or other property right in a name, it can in theory be the subject of a passing off claim. As Parker J observed in *Burberrys v JC Cording and Co Ltd*:<sup>45</sup>

On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or goodwill which will be injured by its use.

The basis of a passing off action is the protection of in the claimant's goodwill (or trading reputation). Goodwill is usually generated by the claimant's use of a distinguishing feature, such as a name or logo. The English courts have resisted extending the law of passing off to include the unauthorised exploitation of a person or a character's identity, likeness or image. The reluctance has been justified on the ground that the individuals who have commenced proceedings in passing off have been unable to establish that they have used name and likeness to generate goodwill, which is likely to be damaged by the defendant's activities.

The elements of the passing off action were formulated in a useful way in the case of *Reckitt and Colman Products Ltd v Borden Inc* (the *Jif Lemon Juice* case)<sup>46</sup> as follows:

- the claimant must establish a *goodwill or reputation* attached to the goods or services in question. The goodwill should be present in the mind of the public to an extent that the identifying feature (such as the personality's name or image) under which particular goods or services are offered to the

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<sup>45</sup> *Burberrys v JC Cording and Co Ltd* (1909) 26 RPC 693.

<sup>46</sup> *Reckitt and Colman Products Ltd v Borden Inc* [1990] 1 WLR 491.



public is recognised by the public as distinctive of goods or services associated with the claimant;

- there must be a *misrepresentation* by the defendant to the public which leads, or is likely to lead, the public to believe that goods or services offered by him are the goods or services of the claimant or are associated with the claimant;
- there must be *damage* suffered, or likely to be suffered, to the claimant's goodwill by reason of the erroneous belief engendered by the defendant's misrepresentation. The damage is likely to be evidenced by confusion on the part of the public. The confusion should be shown to affect a substantial number of members of the public.

### *Goodwill or reputation*

As a prerequisite to a claim in passing off, a claimant has to establish its goodwill.

#### *What is goodwill?*

Goodwill is a nebulous concept. A useful definition was formulated in *IRC v Muller*,<sup>47</sup> in which goodwill was characterised as 'the attractive force which brings in custom'. It is essentially the commercial benefit that a good name and reputation brings with it. It is important to grasp that goodwill is *not* synonymous with 'fame' or public recognition.

Three decisions from the 1970s illustrate the court's approach to passing off in the context of merchandising rights.

In the case of *Lyngstad v Anabas Products*,<sup>48</sup> the court refused relief to members of the pop group ABBA who sought to restrain the reproduction of their name on items of clothing. There was little evidence of substantial exploitation by ABBA of any merchandising rights in the UK. ABBA's case was based on the argument that, by producing the item bearing the ABBA name, the defendants were giving the public the erroneous impression that the goods were in some way associated with the group, in the sense that the group must have in some way endorsed them.

Oliver J observed as follows:

Essentially, what the plaintiff complains of here is not that there is a possibility of confusion between the defendants' business activities and their activities as singers, but that their activities as singers have generated a public interest which has enabled the defendants to exploit for their own purposes the use of the plaintiff's photographs and names.

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47 *IRC v Muller* [1901] AC 217.

48 *Lyngstad v Anabas Products* [1977] FSR 62.

*But this public interest or recognition is not the same as 'goodwill'.*

A similar decision concerned *The Wombles*, the well known fictitious characters who appeared in a television series popular with children.<sup>49</sup> The defendant called his company *Womble Skips Ltd*. Its business was the provision of rubbish skips. The word 'Wombles' was printed on the sides of the defendant's rubbish skips. The claimant's business was the commercial exploitation of the *Womble* characters. Unlike the *ABBA* case, there was therefore evidence of merchandising activity on the part of the claimant. But Walton J held that the claimant did not even have an arguable case in passing off against the claimant. There was no common field of business activity between the claimant and the defendant. No one seeing a *Womble* skip would think that there was really any connection between the skip and the merchandising business carried on by the claimant. There was accordingly no likelihood of confusion and therefore no likelihood of damage to the goodwill.

The *Wombles* case was decided prior to the decision in *Lego Systems v Lego M Lemelstrich*.<sup>50</sup> The *Lego* case departed from the then orthodox view that, in order to establish a passing off, there had to be a common field of business activity between the claimant and defendant. In the *Lego* case, there was no common field of activity between the parties (the claimant made construction kit toys and building bricks and the defendant produced garden irrigation equipment). Nevertheless, the court held that the defendant's use of the *LEGO* brand was a passing off, because confusion or a real possibility of confusion existed, despite the fact that the parties operated in different spheres of business. The court held that the claimant's *LEGO* mark was so well known that the goodwill attached to it extended beyond the field in which the claimant had been engaged.

In the light of the *Lego* case, it may well be that the *Wombles* case would be decided differently. It might now be accepted that the goodwill of a claimant such as *Wombles*, whose business was the licensing of merchandising rights, could be damaged by the unauthorised use of the characters. The damage to the goodwill might typically take the form of the loss of licensing royalties, the depreciation of the value of the royalties due to the loss of exclusivity in the image or the tarnishing of the goodwill if the claimant is associated with goods of an inferior quality.

But the recognition that passing off can occur where there is no common field of activity does not remove the need for the claimant to establish goodwill generated by the use of the name or likeness and damage and the likelihood of damage to the goodwill as a result of the defendant's misrepresentations. The courts tend to be slow to find that these exist in character merchandising cases.

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<sup>49</sup> *Wombles v Wombles Skips* [1977] RPC 99.

<sup>50</sup> *Lego Systems v Lego M Lemelstrich* [1983] FSR 155.

The 1990s initially promised encouragement to claimants. An apparent shift in the court's attitude towards a recognition of the goodwill generated by merchandising activities occurred in a case concerning the unauthorised reproduction of pictures of the cartoon characters 'Teenage Mutant Ninja Turtles' on items of clothing.<sup>51</sup> The owners of the rights to the image of the Turtles alleged that the unauthorised clothing was a passing off. They produced evidence to show that they had carried out substantial merchandising activity in relation to the Turtles and that they had exploited the name and likeness of the Turtles on a wide variety of products.

The court found that an arguable case of passing off was made out in the light of evidence which was produced on the following matters:

- there was active licensing of the merchandising rights to the name and likeness of the Turtles. The judge accepted evidence that a substantial number of the buying public now expect and know that where a famous character is reproduced on goods, the reproduction is the result of a licence granted by the owner of copyright or other rights in the character;
- there was a connection in the public mind between the Turtles and the products bearing their likeness;
- a substantial number of people knew of and wished to acquire the product bearing the likeness of the Turtles.

The court appeared to recognise that character merchandising was a common and recognised activity and that the claimants had the necessary goodwill to support a passing off action. The judge noted that a major part of the claimant's business included the licensing of reproductions of the Turtles on goods sold by third parties. If others were to reproduce the characters without paying licence royalties, the value of the Turtle images would depreciate.

At the time of the judgment it was generally thought that whenever the factors set out above could be demonstrated in relation to unauthorised character merchandising, a case might succeed in passing off. But in more recent cases the courts have shown a tendency to limit the effect of the *Turtles* case. In *Re Elvis Presley Trade Marks*,<sup>52</sup> Laddie J said of the *Turtles* judgment: 'I do not read it as laying down a finding of fact of universal application that the products of the plaintiffs in similar circumstances are viewed by the public as "genuine" and that traders in competing goods are therefore making a misrepresentation.'

He noted that it was not the general public perception that goods bearing the image or name of a well known figure are 'genuine'. He said 'my own experience suggests that ... when people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care

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51 *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145.

52 *Re Elvis Presley Trade Marks* [1997] RPC 543.

who made, sold or licensed it. When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source'. The finding in the *Ninja Turtles* case that the public associated the Turtle images with the claimants cannot, therefore, according to Laddie J, be taken as read in every case. Specific evidence will be needed to show the public's awareness that products bearing a person's likeness come from a particular source which is associated with the celebrity.

This was confirmed in a 1997 case involving unauthorised pop merchandise featuring the likeness of members of the pop group, the Spice Girls.<sup>53</sup> The court said that the group was unable to demonstrate even an arguable case in passing off against Panini SpA, which was supplying an unauthorised sticker collection featuring the group. Using much the same type of arguments which had been successful in the *Ninja Turtles* case, the group argued that the reproduction of their images on Panini's product amounted to a misrepresentation that the Spice Girls had authorised the sticker collection. This argument did not find favour with the court, which held that, in the absence of special circumstances, the public would not be misled into buying Panini's product on the assumption that it was authorised by the group. The judge also queried whether the source of the product would be of concern to the public who would be more interested in buying a product which featured the image of their heroes (or heroines) than in where the product originated.

The judgment in the *Ninja Turtles* case was recently re-assessed by the Court of Appeal in *Re Elvis Presley Trade Marks*.<sup>54</sup> Robert Walker LJ stressed that the *Turtles* judgment 'does not give a green light to extravagant claims based on any unauthorised use of a celebrity's name, but makes clear the relatively limited scope of the principle on which it proceeds'. He drew attention to the fact that the finding of an arguable case in passing off in the *Turtles* judgment was closely linked to the judge's additional finding of copyright infringement in the drawings of the Turtle characters. In the light of his assessment of the *Turtles* decision, the following guidance can be extracted:

- (a) a claimant who owns copyright in drawings and which is in business licensing the use of the copyright in those drawings in the UK on a sufficiently large scale to generate a goodwill in the drawings might have an arguable case in passing off against someone who misrepresents that his drawings are the drawings of the claimant or are licensed by the claimant;
- (b) evidence should be produced to establish the points demonstrated in the *Turtles* case if the claim is to succeed, namely:

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53 *Halliwel and Others v Panini* (1997) unreported.

54 *Re Elvis Presley Trade Marks* [1999] RPC 567.

- there was active licensing of the merchandising rights to the name and likeness of the Turtles;
  - there was a connection in the public mind between the Turtles and the products bearing their likeness;
  - a substantial number of people knew of and wished to acquire the product bearing the likeness of the Turtles;
- (c) the position in relation to living celebrities who wish to make a claim in passing off is less optimistic.

A claim in passing off in relation to a living celebrity is unlikely to be successful unless it can be shown on the special facts of any case that the public are likely to be confused by the use of the claimant's name or likeness into believing that there is a connection between the claimant and the goods. Specific evidence will be required to support such a claim. Reliance on the fact that the use of merchandising agreements is now commonplace is unlikely in itself to be sufficient.

The court has not defined what type of 'special facts' will give rise to a connection in the mind of the public between the celebrity and the defendant/defendant's products. Marking products as 'official' may lead the public to an inference of association with the owner of the name or likeness – but it does not necessarily mean that if the word 'official' does not appear, members of the public would draw the inference that the product is not 'genuine'. In *Re Elvis Presley Trade Marks*,<sup>55</sup> Morritt LJ indicated that the celebrity must ensure 'by whatever means may be open to him' that the public associate his name with the source of the goods. The court will be very slow to infer such evidence. Simon Brown LJ stressed that there should be no assumption that only a celebrity or his successors may ever market (or license the marketing of) his own character. Monopolies should not be so readily created without compelling evidence to justify the position.

### *Passing off – the Australian position*

Australian passing off law is more favourable to celebrities who wish to restrain the unauthorised use of their image. In the field of character merchandising, the Australian courts do not regard goodwill (in the sense of a trading reputation) as a prerequisite to an action in passing off. The establishment of a general reputation or fame will be sufficient to give rise to a cause of action. It is sufficient that the claimant can show that the public would be confused into believing that a form of commercial arrangement exists between claimant and defendant under which the claimant has allowed

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55 *Re Elvis Presley Trade Marks* [1999] RPC 567.

his name or image to be used. There is no additional requirement that damage to goodwill must also be demonstrated.

The difference in approach between English and Australian law is illustrated by the Australian case of *Henderson v Radio Corp Pty Ltd*.<sup>56</sup> The Hendersons were well known professional ballroom dancers. The defendant made and distributed records one of which was entitled 'Strictly for dancing' and consisted of music which was suitable for ballroom dancing. The front cover of the record featured a ballroom scene in which the Hendersons were prominently featured. The Hendersons commenced proceedings in passing off. In the course of his judgment Manning J observed:

The plaintiffs in this case had acquired a reputation which doubtless placed them in a position to earn a fee for any recommendation which they might be disposed to give to aid the sale of recorded dance music of the type in question ... The result of the defendant's action was to give the defendant the benefit of the plaintiff's recommendation and the value of such recommendation and to deprive the plaintiffs of the fee or remuneration they would have earned if they had been asked for their authority to do what was done. The publication of the cover amounted to a misrepresentation of the type which will give rise to the tort of passing off, as there was implied in the acts of the defendant an assertion that the plaintiffs had 'sponsored' the record.

The judge said that he was satisfied that the unauthorised use by the defendant of the commercially valuable reputation of the claimants justified the intervention of the court.

The case of *Hogan v Koala Dundee Pty Ltd*<sup>57</sup> concerned a business selling 'Australian souvenirs', some of which were strongly reminiscent of the title character in the film *Crocodile Dundee*. The claimants, who respectively co-wrote and owned the merchandising rights in the film, brought proceedings for passing off in relation to the souvenirs. The Federal Court of Australia held that a person may bring a passing off action in respect of an image, including a name, which is not connected with any business carried on by that person.

Pincus J observed as follows:

I think the law now is, at least in Australia, that the inventor of a sufficiently famous fictional character having certain visual or other traits may prevent others using his character to sell their goods and may assign the right so to use the character. Furthermore, the inventor may do these things even where he has never carried on any business at all, other than the writing or making of the work in which the character appears.

If English law were to develop along the same lines, it would clearly provide an effective redress to well known personalities – whether fictional or not – whose image is associated with goods and services. But as matters currently

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56 *Henderson v Radio Corp Pty Ltd* [1969] RPC 218.

57 *Hogan v Koala Dundee Pty Ltd* (1989) 14 IPR 398.

stand, there seems little chance that the English judiciary will choose to follow the example set by the Australian courts.

### **(f) Registered trade mark registration**

For a lawyer, the primary function of a registered trade mark is to indicate the origin of a product or service (the so called badge of origin function). Trade marks can be thought of as identification symbols. As part of this function, trade marks serve to distinguish the goods or services of one business from those of other businesses. There is no reason in principle why a name or likeness of a personality cannot operate to distinguish goods and services from one source from those of others – provided that the use of the name and image is carefully policed from the outset of its commercial use to ensure that the public associate the name and likeness with the source of the goods for which registration is sought and with no other source.

The main reasons why marks fail to be distinctive are: (a) if they are too descriptive of a type of product as opposed to distinctive of a product from a particular source; or (b) if they become too commonplace or 'generic'.

#### *Applying for a registration*

Any sign that is capable of graphic representation can be registered as a trade mark, *provided that* it is capable of distinguishing the goods or services of the applicant from those of other undertakings. The mark must, therefore, earmark the goods and services in question as being distinct from those of other producers of such goods.

The name and likeness of an individual can, in theory, be registered as a trade mark, provided it operates as a badge of origin. By way of example, Alan Shearer, Paul Gascoigne and Damon Hill have all registered their names as trade marks. Eric Cantona and Alan Shearer have also registered their likeness.

In order to register a name, likeness, etc, as a trade mark it is not sufficient to show that a name, likeness or signature is well known and that it is associated with a personality. What must also be shown is that the public associates the name, etc, as a *badge of origin* for the goods or services for which registration is sought. If the mark is seen by the public as no more than a depiction of the personality, it will *not* be sufficient to secure a trade mark registration. The mark must be distinctive in that it enables the public to distinguish the trade mark owner's goods or services from identical or similar goods marketed by other parties. The difficulty is that, as we have seen in relation to the law of passing off, the name and likeness of a personality are often not distinctive of any particular source of goods.

*Example*

Elvis Presley Enterprises, the official merchandising company for Elvis Presley memorabilia, applied to register three trade marks as follows: ELVIS, ELVIS PRESLEY and ELVIS A PRESLEY (the latter as a signature). The principal object of Elvis Presley Enterprises was the exploitation of the name and likeness of the late Elvis Presley. The application to register was unsuccessful, because the applicant was unable to provide evidence that the public saw the Elvis marks as anything other than a depiction of the Elvis character. Members of the public would purchase merchandise because it carried the name and likeness of Elvis, rather than because it came from a particular source. In particular, no evidence was adduced to show that the marks served to delineate the applicant's goods from goods that came from another source. The judge rejected the applicant's argument that the public are now familiar with merchandising rights and would infer that an article bearing the name or likeness of Elvis Presley was authorised. He observed that the public would be indifferent to the source of the item in question, caring only that the article bears the name or likeness of their hero. The name and likeness was not therefore sufficiently distinctive to merit registration as a trade mark.<sup>58</sup> The Court of Appeal confirmed this judgment.<sup>59</sup> The Elvis marks did not denote a connection between the applicant and the products for which the application was sought (toiletries) so as to show that the marks served to distinguish its products from others.

A similar issue arose on an application to register the name TARZAN as a trade mark in respect of films and tape recordings.<sup>60</sup> It was held by the Court of Appeal that by the time the application to register the trade mark was made (1965), the word TARZAN had passed into the language and become a household word. It was no longer distinctive of any particular source. There was no longer anything in the word which suggested that goods bearing the TARZAN name necessarily had anything to do with the applicant for the trade mark. Those interested in exploiting the Tarzan character had waited until it was too well known by the public as a generic term before they sought the benefits of registered trade mark rights.

It is therefore important to apply to register a mark as soon as possible in order to avoid the loss of distinctiveness which will occur if the mark is used generally. It is distinctiveness at the date of application for registration which is relevant. The Trade Marks Registry has also rejected an application by the Princess of Wales Memorial Fund to register images of the face of Diana, Princess of Wales as trade marks. The fund sought trade mark registrations in order to try to control the memorabilia industry which has developed since

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58 *Re Elvis Presley Trade Marks* [1997] RPC 543.

59 *Re Elvis Presley Trade Marks* [1999] RPC 567.

60 *TARZAN*<sup>TM</sup> [1970] RPC 450.



Diana's death. The Trade Mark Registry's Workbook (which provides guidance on the registrability of trade mark applications) indicates that pictures of famous people on articles of memorabilia commemorating their life and work are *unlikely* to be understood as indications of the origin of the articles. This will be particularly so if the likeness has been widely used by a variety of manufacturers of memorabilia before the date of the trade mark application. The image would not, in such circumstances, serve to distinguish the source of such articles.

It remains to be seen how safe the existing registrations of names and likenesses will prove to be following the Elvis Presley and Diana, Princess of Wales decisions. The registrations could be challenged on the ground that they lack the necessary distinctiveness to remain on the register.

### *Signatures*

Signatures may be registrable as trade marks provided that they are sufficiently distinctive. If a distinctive signature is registered, it will usually be accompanied by a disclaimer stating that nothing in the registration will give exclusive rights in the actual words making up the name except if they are in substantially the script shown.

### *The rights that a trade mark owner has*

The owner of a trade mark has exclusive rights in the trade mark, which are infringed by the use of the trade mark without his consent.

### *What amounts to use for the purposes of infringement?*

The Trade Marks Act 1994 Act refers to use as being, in particular:

- affixing the sign to goods or packaging;
- offering goods for sale or offering or supplying services under the sign;
- importing or exporting goods under the sign;
- using the sign in business papers or advertising.

Those involved in the *preparation of* infringing material will be treated as infringers if they know or have reason to believe that the use of the mark is not authorised by the mark's owner. Use has to be in the course of trade to constitute an infringement.

### *What amounts to infringement?*

The following unauthorised acts amount to infringement:

- use of a sign which is *identical* to the trade mark in relation to goods and services which are *identical* with those for which it is registered (s 10(1) of the Act);
- use of a sign which is *identical* to the trade mark in relation to goods and services which are *similar* to those for which it is registered so that there is a likelihood of confusion or association on the part of the public (s 10(2) of the Act);
- use of a sign which is *similar* to the trade mark in relation to goods and services which are *identical* to those for which it is registered so that there is a likelihood of confusion or association on the part of the public (s 10(2) of the Act);
- use of a sign which is *identical or similar* to the trade mark in relation to goods or services which are *not similar* to the goods and services for which it is registered where the mark has a reputation in the UK 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 trade mark (s 10(3) of the Act).

Section 11(2) of the Act provides that a registered trade mark is not infringed by:

... the use by a person of his own name or address provided the use is in accordance with honest practice in industrial or commercial matters.

So, even if a name is registered as a trade mark, anyone else sharing that name would not infringe the registered mark if they used their name in the course of trade, provided that they did so in an honest manner.

### **(g) The Trade Descriptions Act 1968**

It is a *criminal* offence under the Trade Descriptions Act 1968 to give a false indication, direct or indirect, that goods and services are of a kind supplied to any person, for example, a well known personality (s 13).

It is also an offence to make false representations as to royal approval or award in relation to goods or services (s 12).

### **(h) The advertising codes of practice**

The various industry codes of practice offer the most effective avenue of complaint for celebrities to restrain the unauthorised use of their name or likeness in advertising or sales promotions. However, the codes are not a substitute for legal action. For example, none of the codes gives celebrities the right to compensation for unauthorised use and there are only very limited

grounds for appeal if a celebrity is unhappy with the decision of the regulatory authority.<sup>61</sup>

### *The Committee of Advertising Practice Codes*

#### *Protection of privacy – the portrayal of or referral to individuals*

The CAP Codes govern the use of individuals in advertisements and sales promotions to which the codes apply. The reader is referred to Chapter 16 for details of advertising/promotions to which the Codes apply.

Advertisers are *urged* to obtain permission in advance if they wish to portray or refer to individuals in advertisements. The requirement applies to any individual whether or not he/she is a public figure.

‘Urged’ is not defined in the code. In essence, it means that there must be a good reason for a failure to obtain permission. A permissible exception to the general rule has been held to be where a photograph depicted a crowd scene and the participants were not so well known that the advertiser could be expected to try to contact them before publication.<sup>62</sup>

Prior permission may not be needed under the codes when the advertisement does not contain anything that is inconsistent with the position or views of the person featured.

It is also unnecessary to obtain permission where the product being advertised is a book or a film and the individual who is referred to in the advertisement is the subject of the book or film.

Care should be taken when portraying, or referring to, people who are dead, to avoid causing offence or distress.

Where the individual who is portrayed or referred to without prior permission has a high public profile and specifically where he or she is an entertainer, a politician or a sports person, a further restriction applies. Advertisers should ensure that such persons are not portrayed in an offensive or adverse way.

#### *Example of an adverse and offensive portrayal*

An example of an adverse and offensive portrayal occurred when, as part of the 1997 election campaign, the Conservative Party used a national press advertisement that featured a photograph of the leader of the Labour party, Tony Blair. In place of Mr Blair’s eyes, the poster featured demonic looking eyes. The advertisement featured the caption ‘NEW LABOUR, NEW DANGER’.

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61 Judicial review of the decision might be available in some circumstances (see Chapters 2 and 16 of this book for more detail), but this is not necessarily a right of appeal. The courts will not substitute its decision for that of the decision maker.

62 *Halifax Building Society ASA Monthly Report*, No 77, October 1997.

Complaints were received, alleging that the advertisement portrayed Tony Blair, who had not given his permission for the use of his photograph, in an offensive way. The ASA upheld the complaints. It considered that the advertisement depicted Tony Blair as a sinister and dishonest figure and that this amounted to an adverse or offensive portrayal of Mr Blair.

### *Endorsements*

The code states that advertisers must not imply an endorsement of a product or service by people with a high public profile where none exists.

#### *What constitutes an endorsement?*

The mere appearance of a public figure in relation to a product will not necessarily be an endorsement. Each advertisement must be considered on its own merits.

An instance where endorsement was found related to an advertisement by Key 103 and Magic 1152 radio stations. Jamie Redknapp complained to the Advertising Standards Authority about a poster for a radio station headlined 'Who should get their kit off?' It showed the heads of David Beckham and Jamie Redknapp superimposed on very muscular bodies. The poster gave a telephone number for people to ring to place their vote. Jamie Redknapp objected to the poster, claiming that it implied that he endorsed the radio station, an implication that he believed would diminish his reputation and affect his future income from genuine endorsements. The complaint was upheld. The advertisers claimed that the poster was intended to be seen as good humoured and light hearted. They pointed out that it was one of a campaign that featured a host of celebrities who were used as the subject of phone polls. They said that Jamie Redknapp was chosen because he was a famous Liverpool footballer. The ASA considered that the poster could be seen to imply that Jamie Redknapp endorsed the radio station. The ASA concluded that the poster could diminish the reputation of Jamie Redknapp or affect his future income from genuine endorsements. The ASA asked the advertisers not to repeat the advertisement.<sup>63</sup> As we have seen, if Jamie Redknapp had brought proceedings in passing off over the use of his likeness, he would probably not have been successful. The CAP codes were therefore his only effective means of redress.

#### *References to the royal family*

References to members of the royal family or to the royal arms and emblems are not permitted under the code without consent from the Lord

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63 ASA Adjudication, June 1999.

Chamberlain's office. The use of royal warrants should be cleared with the Royal Warrant Holders' Association.

### *The Independent Television Commission Code*

The ITC Code provides that individual living persons must neither be portrayed nor *referred to* in advertisements without their permission having first been obtained except where the ITC approves the advertisement. Portrayal extends to impersonations (including impersonations of well known voices), parodies and caricatures.

Permission is required even where an individual is referred to indirectly, provided the reference enables the viewer to identify him/her clearly.

There is an exception to the rule for prior permission in relation to advertisements for books, films, particular editions of TV or radio programmes, newspapers, magazines, etc, which feature the person referred to in the advertisement, provided that the reference or portrayal is neither offensive nor defamatory.

In the case of generic advertising for news media, ITC licensees may waive the requirement for prior permission if it seems reasonable to expect that the individual concerned would not have reason to object. However, such generic advertising should be immediately withdrawn if individuals who are portrayed without their permission do object.

### *The Radio Authority Code*

The Radio Authority Code states that individual living persons must not normally be portrayed or referred to in advertisements without their prior permission.

Similar exceptions to those contained in the ITC Code exist in relation to advertisements for books, films, radio and television programmes, newspapers, magazines, etc, and generic news media advertising.

The code advises that advance permission be obtained where impersonations or soundalikes of well known characters are to be used.

References to, and portrayals of, people who are active in politics should be carefully worded to avoid falling foul of the rules which require that political matters should be treated impartially and that advertisements must not be directed towards any political end.