



Survey on

**Post-Mortal Protection of
Personality Rights**

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Questions

Does your jurisdiction provide post-mortal protection of personality rights of famous persons? Imagine that the client is the daughter of a famous american actor. The father - still famous today - died in 1995. The daughter wants to act against third parties who sell posters etc. with her father's name and image, and further asks whether trade mark protection for name and/or image (photography, painting) would be available/useful.

Very generally, with two/three sentences and without going into the details: Would you say your law provides, in cases like that one, for remedies against the use of name and picture (voice, etc.) of famous persons for commercial purposes, and even if the client's father died in 1995? And would you say trade mark protection could be a solution?



AUSTRALIA, Holman Webb, Jonathan Casson and Yvette Manettas

1.

In Australia, protection of a celebrity's name, image and/or personality has historically been achieved through actions under the common law tort of passing off and/or defamation, and the misleading or deceptive provisions of the *Trade Practices Act. 1974 (Cth)*. These actions remain available under the common law of Australia and the *Trade Practices Act 1974 (Cth)*. The types of the celebrity's image, name or personality (whatever the case may be).

2.

More recently, celebrities (of any description; being musicians, writers, actors, painters etc.) are relying on the provisions of the *Trade Marks Act 1995 (Cth)* to protect "celebrity personality", including such things as images, names, and slogans associated with the celebrity, provided those things are distinguishable.

3.

An application to register a trade mark for a deceased person may be made by a representative of the deceased person with authority and an interest in making the application, for example, a company running the deceased celebrity's business, a family member, or the estate of the deceased celebrity. A statutory declaration would be required to be filed by the representative with the application outlining the basis for the representative's authority.

4.

There is little case law in Australia testing the protection afforded to a celebrity, deceased or otherwise, by way of trade mark. Accordingly there is no binding precedent. However, it is clear that registration of a trademark for a celebrity image will offer some (if not great) protection due to the constraint that another's use of the trade mark will infringe the rights of the owner of the trade mark and entitle the owner to oppose the use of the trade mark.

AUSTRIA, Brandstätter Rechtsanwälte, Konrad Lenneis

According to the established case law of the OGH [Austrian Supreme Court] concerning Paragraph 43 Austrian General Civil Code (ABGB), rights of personality generally end upon death. Following death, rights of personality of close relatives having the same family name may, under certain circumstances, be affected because the same name is used. A postmortal right of personality is granted only insofar as it is a matter of protecting the deceased's privacy.

In the above case, it will therefore be difficult to take any action against the sale of (harmless) posters etc. on the basis of rights of personality.

Trade mark protection is an approach, which I think is worth trying. A photograph alone is probably not distinctive. However, there is probably no a priori reason for not registering the name or the name + photograph.

DENMARK, Forum Advokater, Karen Kaufmann

Denmark has no law that directly deals with this issue, but we do have general (mostly court made, but also to some extent in the penal code) rules about a persons right to his/her own picture and, of course, name.

I am rather confident that the same rules would apply even if the person in question is deceased, but as far as I know, no court cases exist (or if so, they have not been published).

However, if the deceased person is sufficiently famous, trade mark regulations could certainly also apply (in Denmark you do not need a registration to exert rights over a trade mark – the mere fact that it has been used as such will suffice).

Remedies would be an injunction which would then have to be confirmed in an ordinary court of law together with a possible claim for damages.



ENGLAND, Mundays, James O'Flinn

In the UK trade mark law may provide an important practical means of protecting image rights. In the absence of any other clear means of protection in the UK, it may well provide the best practical means of protecting a celebrity's right to exploit their image for commercial gain and/or preventing a third party from making unauthorised use of the registered image right in question (most commonly, a celebrity's name).

A person's name, likeness, signature, voice, or a nickname or slogan associated with them could be registered as a trade mark. Trade mark registrations for famous people's names are the image right most commonly applied for.

Many celebrities have registered their names and/or their images as UK or community trade marks in respect of certain goods. By way of example:

Names: David Beckham has registered his name as a community trade mark in relation to a range of goods, including perfumes, hair care cosmetics, key rings, figurines and jewellery (see CTM registration number 1796721). TIGER WOODS has been registered as a CTM in respect of various goods, including sportswear and golf balls, golf clubs, golf gloves, golf tees and golf club protectors (see CTM registration number 504704).

Images: The footballer Alan Shearer has registered his image (a photograph) in relation to goods such as clothing, bags and sports articles (see UK registration number 2117215).

However, the enforceability of such rights has yet to be tested in court. The relationship between the trade mark law requirement for distinctiveness, and the consequences of fame, in particular, is a difficult one. Ironically, a person's fame can be the very reason why it is not possible to register their name or image for certain classes of goods and, even where a famous name is registered as a mark, it can operate to limit the degree of protection afforded by the mark.

There is no right of personality in the UK. Accordingly, there is no presumption that the only person who can register a famous person's name in relation to goods or services is that person or their agents.

The approach taken by the trade mark registry here in the UK affords only a limited amount of protection for celebrities, providing that attempts by third parties to register the name of a

famous living individual or a recently deceased famous individual may be vulnerable to objection under UK trade mark law (which provides that a mark may not be registered if or to the extent that it is applied for in "bad faith") if the application covers goods or services with which the famous individual is or was associated.

When considering the registrability of a famous person's likeness or photograph it may be even more difficult to register pictures of famous persons since, while they present similar issues to famous names each case will be judged on its own merits. Depending upon the goods, pictures of famous persons or groups may be more likely (compared to a name) to be taken as mere decoration and therefore to lack a trade mark character.

Where a famous name is concerned (and where the reputation does not stem from a trade in the goods/services applied for) it is possible that, when used in relation to certain goods/services, the name may appear to the average consumer as an indication that the goods/services are *about* the person whose name it is rather than as an indication that the goods/services are supplied by, or under the control of, one undertaking.

The correct approach appears to be to consider whether the famous name put forward for registration is so descriptive in relation to the goods/services for which registration is sought that it could not be perceived by consumers as anything more than a description of the subject matter of the goods/services. The main areas of uncertainty are;

Media

The names of famous persons may serve as trade marks for printed publications, recorded sounds, films, videos, TV programs, musical or live performances etc as use of the mark on such goods or services would be likely to imply some form of control of, or guarantee from, the holder. Consequently, there will not usually be an objection to the registration of a famous name for these goods.

Mere Image Carriers

The name of a famous person is likely to be perceived as merely descriptive of the subject matter of posters, photographs, transfers and figurines. Names of famous persons or groups are therefore unlikely to be accepted by consumers as trade marks for these goods because they will usually be seen as mere descriptions of the subject matter of the product.

Badges of Allegiance

The name of a famous person may serve to identify the trade source of badges of allegiance (including T-shirts, mugs, scarves etc) even if the possibility of other traders producing unofficial merchandise cannot be ruled out. As a result, such marks will normally be accepted for such goods unless there is a particular reason to believe that the mark in question cannot fulfil the function of a trade mark.

Names of Deceased Famous Individuals

In these circumstances the name is more likely to be seen by consumers as merely an historical reference to the subject matter of the goods or services, rather than to the trade source of the goods. Each such case must be judged on its own facts taking account of the length of time that has passed since the person concerned died and the relationship (if any) between the goods/services in any trade mark application and those associated with the dead person.

Pictures of Famous Persons living and deceased

Pictures of famous persons present similar issues to famous names. Depending upon the goods, they may be more likely (compared to a name) to be taken as mere decoration and therefore to lack a trade mark character. Each case though will be judged on its own merits.

Alternatively, depending on the facts of each case there may be available actions in passing off, copyright infringement etc.

GERMANY, Graf von Westphalen, Kristofer Bott

Personality Rights

German law provides that name, image and/or other personal features of a famous person must not be used by third parties without - the concerned person's, or

- after his/her death, the heir's (not necessarily the legal successors!)

consent. The German Federal Supreme Court has decided, however, that the post-mortem protection of personality rights against commercial use of non-authorized parties ends after ten years. This is provided explicitly in sec. 22 of the Law on Copyright in Works of Art and Photography for the image of a person. The Supreme Court decided that said provision applies by way of analogy to any personality right (decision of October 5, 2006 I ZR 277/03 - Klaus Kinski). The decision has been criticized, but is still valid.

Other means of protection

Trade Marks

Protection against unauthorized use of personal features after the concerned person's death can be achieved to some extent by trade marks.

Images (photographs, paintings) and names can be subject of a trade mark right. The Patent- and Trade Mark Office - in line with the Federal Patent Court (FPC) and the Federal Supreme Court (FSC) - is very reluctant, however, in granting trade mark protection for those features. We have reached a positive decision of the FPC in 2005 in a case where we acted for the Sir Peter Ustinov Foundation and the son of Sir Peter Ustinov (decision of 11.10.2005 - 33 W (pat) 17/05 - Sir Peter Ustinov). The FPC, whose decision has been affirmed in principle by the FSC, ruled that a photography has "distinctive character" only in rare cases and usually not for goods and services which are linked, in the perception of the concerned trade circles, customers and/or end users of the respective goods/services, to the person whose name/image shall be protected as a trade mark (FSC decision of April 24, 2008 - I ZB 21/06 - Marlene-Dietrich-Bildnis, FPC decision of May 13, 2009 - 29 W (pat) 147/03 - Marlene-Dietrich-Bildnis, pending for further decision at the FSC (I ZB 62/09). If an image is protected as a trade mark, then the owner of the right in the trade mark may prohibit others from using the image *as a trade mark*. Other kinds of use, in particular descriptive use and any other use where the image does not distinguish goods and services, e.g. selling of

posters or other pictures showing the image which is subject of the trade mark, can not be prohibited. It is probable, however, that the registration of a trade mark and the fact that the registration is publicly available in the registry of the Trade Mark Offices (German, EU) have a deterrent effect on third parties who are not aware of the particularities and restrictions of the trade mark owner's rights under the applicable laws; EU and national law do not diverge in that regard. Hence it is always an option to register photographs as a trade mark, but one must be aware that the threshold to gain the protection is high, and that even if the image will be registered, there are still restrictions as regards the enforceability of the rights in litigation.

Copyright

All rights in copyright protected works - books, photographs, motion pictures etc. - are of course enforceable in case of unauthorized use, copying, distributing etc. The cover of a book, for example, or the pictures from a movie may not be exploited - within the duration of the respective right - without license.

ITALY, studio legale afferini crispo & c., Giorgio Schiano di Pepe

The matter at issue is regulated by art. 10 of the Civil Code, arts. 96 and 97 of Law No. 633 of 22nd April 1941 on Copyrights and art. 9 of Legislative Decree No. 30 of 10th February 2005 (Industrial Property Code).

Art. 10 of the Civil Code, which protects image rights, allows a person's portrait to be published only when it is specifically permitted by the law and provided that it does not damage his or her dignity or reputation.

Art. 96 provides that a person's portrait cannot be published: reproduced or put on the market without his/her consent; after his/her death such consent must be given by his/her heirs.

However, art. 97 provides that such consent is not necessary when the portrait represents a popular person since its circulation is justified by his/her fame.

The Case Law has forbidden the use of portraits of celebrities belonging to the show business or the sports world which may be used to promote or sell a product if this occurs without the concerned person's consent since it is detrimental to the person's exclusive right of image which is protected with regard to both its moral and patrimonial aspects (Cassazione No. 5790 of 10th November 1979).

Moreover, art. 8 of the Industrial Property Code does not allow a portrait to be registered as a trademark without the consent of the concerned person and in the event of his death without his/her spouse's or children's consent (Cassazione No. 4785 of 2nd May 1991).



SCOTLAND, Burness LLP, Colin Hulme

The law in Scotland provides remedies for the protection of image rights however there is not a general right of personality. Celebrities can apply to register as a trade mark their name, image, signature, nickname or slogan associated with them. The UK Trade Mark Registry (UK - IPO) might reject such an application if that person's name is not sufficiently distinctive to attract trade mark protection. It will generally be easier to register their signature, as this is more distinctive. If there is no trade mark then it is arguable that the person's name or image (as long as this is applied to character merchandising such as posters and t-shirts) will be protected under the common law of passing off.

Any third party is free to register a celebrity's name in relation to goods or services. However, any attempt by a third party to register the name of a famous person/or a deceased famous person will be assessed by the Trade Marks Registry. These are likely to face opposition if 'bad faith' is established, particularly if that person attempts to register the name in association with the goods/services the celebrity was famous for.

In this case, as the person applying for the trade mark would be the deceased's daughter it is unlikely that the application would face this resistance. While the daughter can apply for the trade mark there is the assumption that the deceased person's name is more likely to be seen by consumers as a historical reference. There is little case law in this area. It is therefore unclear if the applications would be granted. Each case would depend on their individual merits.

UNITED STATES OF AMERICA, Phillips Lytle LLP, Annabelle V. Irely

In the United States there is no uniform law regarding an individual's right of publicity (whether living or deceased). Rights of publicity are enforced through state law and are constantly changing. There are approximately 28 states which recognize either by statute or by common law through the court opinions some form of right of publicity. Some states such as California recognize post-mortem rights. New York only recognizes "the right of privacy" during an individual's lifetime.

This issue has been hotly contested in the courts involving celebrities such as Marilyn Monroe, Babe Ruth and Elvis Presley. In a recent famous case involving Marilyn Monroe the court determined that since she was "domiciled" in New York at the time of her death, New York law applied and all rights ended upon her death.

As for trademark protection as a possible solution, the United States does have a federal trademark statute applicable in all states, but this statute provides limited protection for the deceased celebrity's name as associated with the specific trademarked goods or if the use is disparaging or falsely suggestive of endorsement. The analysis is based on the facts and courts have been inconsistent. There is a case in New York which recognized the trademark rights in the name of a deceased celebrity (Babe Ruth – a baseball player), but given the factual analysis, the court held that the registered trademark did not protect the photos of the deceased celebrity in a calendar.
