Cambridge Law Journal, 55(1), March 1996, pp. 56-64
Printed in Great Britain

THE NEW TORT OF APPROPRIATION OF PERSONALITY: PROTECTING BOB MARLEY'S FACE

B. ST. MICHAEL HYLTON AND PETER GOLDSON*

As far back as 53 years ago, the adaptability of the common law to changing circumstances whereby new rights have been created by the courts, has been observed and accepted as a function of the judiciary. Scott L.J. in his dictum in *Haseldine* v. *Daw* stated:

> The common law has throughout its long history developed as an organic growth, at first slowly under hampering restrictions of legal forms of process, more quickly in Lord Mansfield's time, and in the last 100 years at an ever increasing rate of progress as new cases, arising under new conditions of society, of applied science and of public opinion, have presented themselves for solution.[1]

The categories or heads of tortious liability cannot therefore be considered closed but will develop in order to take account of "new conditions of society" which arise.

The business of marketing products by reference to an endorsement by a real or fictional character, with the aim of making the product more attractive to potential purchasers, either by drawing attention to it, or by indicating that the character approves or endorses the product, has become a major feature of contemporary marketing over the comparatively recent past. Consequently it has given rise to the need for protection from the unauthorised exploitation of personalities and characters in marketing goods and services. The conditions giving rise to the new tort of Appropriation of Personality would constitute just such a "new condition of society" justifying development in the law.

Historically, however, the common law has never treated a person as having a proprietary interest in his face. Although someone's face could have economic value (where you contract to allow the use of your image and likeness), generally speaking, the law has not traditionally allowed you to stop others from using it without

* Of Myers, Fletcher & Gordon, Kingston, Jamaica.
[1] [1941] 2 K.B. 343 at 362.

permission. Two generally accepted exceptions have nevertheless been permitted:

(i) if the use amounts to *defamation*, the courts have held that such use could be prevented;[2] or
(ii) if the use amounts to *passing off*, though this is applied to a limited extent as a result of the uncertain application of the narrow classical definition of such situations.

The willingness of the law to protect an individual's face has seen notable strengthening in the last few decades, however, as commerce has developed and changed. As Robert Howell has observed:[3] "The rapid growth of mass media communication in the climate of consumerism and materialism . . . has led to a vast commercial activity that focuses upon the creation of public perception of an association between a consumer product and a celebrity figure (whether real or fictitious, human or non-human) for the purpose of marketing the product." The law of various jurisdictions has therefore recognised the commercial value which has attached itself to a celebrity's persona and has allowed "legal recognition of an exclusivity of use and exploitation in the celebrity (or its creator in the case of fictitious character celebrities) in respect of his/her personality",[4] deeming any unauthorised exploitation "an invasion of the plaintiff's exclusive right to market his personality".[5]

This article will examine how Commonwealth courts and, in particular, a Jamaican court in the recent decision of *The Robert Marley Foundation Ltd.* v. *Dino Michelle Limited,*[6] have fostered the development of this new tort and extended the law of passing-off to meet changing social circumstances.

The "Extended" Tort of Passing Off

Though the classic law of passing off may have been considered inappropriate for dealing with situations of proprietary interest in the attributes of a person, English and Commonwealth courts have extended the test for the tort of passing off in a dramatic way so as directly to incorporate this new development. The essence of the tort of passing off is that it is an actionable wrong for a trader to conduct

[2] As in the case of *Dunlop Rubber Company* v. *Dunlop* [1921] 1 A.C. 367, where an injunction was given to prevent people from showing any pictures of the plaintiff which represented him in absurd or "unsuitable costumes".
[3] Robert Howell, "The Common Law Appropriation of Personality Tort" (1986) *Intellectual Property Journal* 150.
[4] *Ibid.*
[5] *Per* Clarke J. in *The Robert Marley Foundation* v. *Dino Michelle Ltd.*, unreported. (C.L. R115/1992), judgment 12 May 1994.
[6] Note 5 above.

his business so as to lead others to believe that his goods or business belong to or are associated with that of another, where consequent damage to the business of goodwill of the latter is foreseeable. The essential ingredients of a passing off action derived from the combined test put forth by Lords Diplock and Fraser in *Erven Warnink* v. *J. Townsend and Son*[7] and strongly approved by Clarke J. in the *Bob Marley* case,[8] have been clearly enumerated as follows:[9]

1. That the plaintiff's business comprised selling . . . a class of goods to which the particular trade name [face, likeness or image] applies.
2. That the name [face, likeness, or image] is distinctive of the plaintiff's goods.
3. That goodwill is attached to the name [face, likeness or image] and is the plaintiff's.
4. That the defendant has made a representation.
5. That he has done so in the course of trade to customers or ultimate recipients of the goods.
6. That the business or goodwill of the plaintiff is really likely to be damaged.

In many of the early decisions such as *Erven Warninck* v. *J. Townsend & Sons*[10] confusion arose because of exceptionally similar products. In that case, the plaintiff, the manufacturer of a popular alcoholic drink called "Advocaat", sought an injunction to restrain the defendant's manufacture and sale of a similar (but differently constituted) drink which was marketed as "Old English Advocaat" on the basis that the defendant was guilty of a passing-off. The plaintiff was ultimately successful, and an injunction was granted. Both the plaintiff and the defendant therefore engaged in the same type of business and the likelihood of confusion by the public was more real. The idea had therefore developed that both parties must be engaged in a common field of business activity in order to base an action. This would, however, essentially exclude from consideration most cases of unauthorised exploitation of personality.

The modern law of passing off has however extended this principle, if it ever was the law,[11] to cover cases where the parties are not in the same business. In *Mirage Studios* v. *Counter Feat Clothing Co. Ltd.*[12] (the *Turtles* case), the plaintiff had created and owned the copyright

[7] [1979] AC. 731.
[8] Note 5 above.
[9] In *Clerk & Lindsell on Torts* (Sweet & Maxwell, 1989) pp. 29–30.
[10] Note 7 above.
[11] Note however that, as the case of *British Legion* v. *British Legion Club (Street) Ltd.* [1931] 48 R.P.C. 555 shows, long before the *Advocaat* case a number of decisions involving charitable, professional and service organisations were already holding that a common field of activity was not an essential ingredient of the passing off action.
[12] [1991] F.S.R. 145.

in diagrams of the Teenage Mutant Ninja Turtles, and their business included the licensing and the reproduction of the turtles on goods sold by others. The defendants made drawings of humanoid turtles similar to the plaintiff's characters and licensed their drawings to clothing manufacturers for reproduction on casual wear. The plaintiff obtained an interlocutory injunction on the ground of infringement of copyright and passing off. The court held, *inter alia*, that there had been a misrepresentation to the public as to the identity of the turtles and a further misrepresentation that the products were licensed by the plaintiff:

> There is no reason why a remedy in passing off should be limited to those who market or sell the goods themselves. If the public is misled in a relevant way as to a feature or quality of the goods sold, that is sufficient to found a cause of action in passing off brought by those people with whom the public associate that feature or that quality which has been misrepresented.[13]

This extended formulation therefore allows the concentration of attention on the more fundamental questions involved, namely, confusion, and more importantly, on the wider notion of deception.[14]

The classic formulation of passing off in England and Australia, has developed in just this way, or as Clarke J.[15] has stated, in the *Bob Marley* case "at least to the point where it is considered enough that the misrepresentation is calculated to give one trader the benefit of another's goodwill". This is clearly demonstrated by two cases. First, *Radio Corporation Pty Ltd.* v. *Henderson*[16] in Australia, where the mere appearance of the plaintiff's photograph on the goods the defendant intended to sell constituted the tort of passing off. The photograph was considered sufficient misrepresentation as it intimated a connection with the defendant's business or approval by the plaintiffs of the defendant's endeavours, either of which would be misleading. And, second, *Mirage Studios* v. *Counter Feat Clothing Co. Ltd.*[17] (the *Turtles* case) in England, where the court held that the reproduction of drawings, the diagram of which was created and owned through copyright by the plaintiff, had been a misrepresentation to the public, as to the identity of the turtles and also that the products were licensed by the plaintiff, sufficient to constitute the tort of passing off.

In fact, in the case of *The Robert Marley Foundation* v. *Dino Michelle Limited*, the Jamaican courts have recently taken an important

[13] *Ibid.*
[14] The concept of deception becomes more important where there is no common field of activity which would normally cause confusion.
[15] In *The Robert Marley Foundation* v. *Dino Michelle Ltd.*, note 5 above.
[16] [1960] N.S.W.R. 279.
[17] Note 12 above.

step in joining England and Australia, in the development of the common law. In that case, the plaintiff, the successor-in-title of the late musician Robert Nesta Marley, who had the sole right to licence the commercial use of Mr. Marley's name or likeness, sought an injunction restraining the defendant from manufacturing, printing, distributing or in any way dealing in any T-shirts or other items bearing the name, likeness, signature, image, photograph or biography of Mr. Marley without the prior written consent of the plaintiff. The court, in its landmark decision, held that goodwill attached to Mr. Marley's name and likeness in connection with the plaintiff's business and belonged to the plaintiff. It further ruled that goodwill had been invaded by the defendant's unauthorised use of his name and likeness on its goods, whereby the public had been misled into believing that a commercial arrangement existed between the plaintiff and the defendant and therefore constituted sufficient misrepresentation to meet the requirements of the tort of passing off.

The extended tort of passing off therefore recognises the new commercial trend of character merchandising, endowing the courts with greater flexibility to offer its "protection to promotional goodwill"[18] in situations where the defendant misrepresents that goods or services have a particular association, quality or endorsement.[19]

Appropriation of Personality

In order to establish a passing off claim, even with the modern formulation, the plaintiff must first prove a misrepresentation. In character merchandising however, the essential complaint is that of misappropriation not misrepresentation. As Pincus J., has stated, "the plaintiff's real complaint, in a commercial sense, is not the falsity of the advertisement but that the name was used other than pursuant to an 'endorsement' agreement involving a fee".[20] As a result, therefore, outside of the extension of the law of passing off, a few common law jurisdictions, with a view to better handling the "much modern commercial activity (which) focuses upon the creation of a public perception, of an association, between a consumer product and a celebrity figure, for the purpose of marketing the product",[21] have developed a wholly independent tort known as appropriation of personality in Canada and in Jamaica or, in the United States, "breach

[18] Promotional goodwill relates not just to reputation attached to one's goods or services but extends also to the ability to recommend or promote other people's goods and services.

[19] Andrew Ferry: "Image—Filching and Passing Off in Australia: Misrepresentation or Misappropriation? *Hogan* v. *Koala Dundee Pty Ltd.* [1988] A.T.P.R. 40–902", [1990] 6 E.I.P.R. 219.

[20] *Sue Smith* (1988) A.T.P.R. 40–833 at 48, 987 (Full Federal Court of Australia).

[21] Robert Howell, "The Common Law Appropriation of Personality Tort" [1986] *Intellectual Property Journal* 150.

of the right of publicity". It constitutes: (i) an *appropriation*, or use without the owner's consent, which may arise through any medium, but normally through a photograph, drawing, printed publication of name or impersonation of; and (ii) *personality*, which usually comprises a natural person's name, likeness, voice or other indicia of identity[22] but can also include those of a fictitious "person" as in the *Turtles'* case.

In *Krouse* v. *Chrysler Canada Ltd.*,[23] although the plaintiff did not succeed, the decision remains an important one for the development of the tort of appropriation of personality. In that case, an action picture of a professional football game was used in a device for advertising cars. One of the football players who was identifiable by the number on his uniform had not consented to the use of the photograph and brought an action for damages against the car advertisers on the basis of passing off and appropriation of personality. The Ontario Court of Appeal in rendering its decision recognised that it is possible to establish the tort of appropriation of personality even if no passing-off is established. It is an independent tort. The case also defined the parameters of the new tort although it was held not to have been established on the facts.

In the case of *Athans* v. *Canadian Adventure Camps Ltd.*,[24] the application of this new tort was clearly demonstrated. The plaintiff was a professional water-skier whose photograph was used by the defendant in a brochure advertising a summer camp. The Ontario High Court held that although no case of passing off was established, the reproduction of the plaintiff's photograph for commercial advantage was an invasion of the plaintiff's exclusive right to market his personality and would therefore make the defendants liable for the tort of appropriating the plaintiff's personality. The court held that the measure of damages should be the amount he ought reasonably to have received in the market for permission to publish the drawings.

At least three other Canadian cases have recognised this tort. They are *Racine* v. *C.J.R. Radio Capitale Ltd.*,[25] *Heath* v. *Weist-Barron School of T.V. Ltd.*[26] and *Dowell* v. *Mengen Institute*.[27]

The "right of publicity" has been long recognised in the United States, from as far back as 1968. The cases related to its breach clearly demonstrate not only that this tort exists distinctly from that of passing off, but also that it can be established even when the celebrity is dead or has never himself exploited this right. In the *Martin Luther King Jr.*

[22] "Appropriation of Personality—A New Tort?" (1983) 99 L.Q.R. 281.
[23] [1973] 40 D.L.R. (3d) 15.
[24] [1977] 80 D.L.R. (3d) 583.
[25] [1977] 17 O.R. (2d) 370.
[26] [1981] 34 O.R. (2d) 126.
[27] [1983] 72 C.P.R. (2d) 238.

Centre for Social Change Inc. v. *American Heritage Products Inc.*[28] where the plaintiffs sued to enforce Dr. Martin Luther King Jr.'s "right to publicity", the US Court of Appeals for the 11th Circuit declared that the right of publicity is a recognised and distinct right and held that:

> for the reasons which follow we hold that the right of publicity survives the death of its owner and is inheritable and devisable . . . if the right of publicity dies with the celebrity, the economic value of the right of publicity during life would be diminished because the celebrity's untimely death would seriously impair, if not destroy, the value of the right of continued commercial use.[29]

The court went further to emphasise that it is not necessary that the owner must himself have commercially exploited this right before it can survive his death:

> That we should single out for protection after death those entertainers and athletes who exploit their personae during life, and deny protection after death to those who enjoy public acclamation but did not exploit themselves during life puts a premium on exploitation. Having found that there are valid reasons for recognising the right of publicity during life, we find no reason to protect after death only those who took commercial advantage of their fame.[30]

In *The State of Tennessee, Ex. Rel. The Elvis Presley International Memorial Foundation et al.* v. *Gentry Growell*,[31] the Court of Appeals of Tennessee also recognised the "right of publicity" and concluded also that its ability to descend would accord with principle in that:

(1) The Court recognises that an individual's right of testamentary distribution is an essential right. If a celebrity's right of publicity is treated as an intangible property right in life, it is no less a property right at death.
(2) One of the basic principles of Anglo-American jurisprudence is that "one may not reap where another has sown nor gather where another has strewn".
(3) Recognising that the right of publicity is descendible is consistent with a celebrity's expectation that he is creating a valuable capital asset that will benefit his heirs and assigns after his death.
(4) Concluding that the right of publicity is descendible recognises the value of the contract rights of persons who have acquired the right to use a celebrity's name and likeness. The value of this

[28] [1983] 694 F(2d) 674.
[29] *The Martin Luther King Jr. Centre for Social Change Inc.* v. *American Heritage Products Inc.* [1983] 694 F (2d) 674 at 682.
[30] *Ibid.* 683.
[31] [1987] 733 S.W. (2d) 89.

interest stems from its duration and its exclusivity. If a celebrity's name and likeness were to enter the public domain at death, the value of any existing contract made while the celebrity was alive would be greatly diminished.

(5) Recognising that the right of publicity can be descendible will further the public's interest in being free from deception with regard to the sponsorship, approval or certification of goods and services. Falsely claiming that a living celebrity endorses a product or service violates the law. It should likewise be discouraged after a celebrity has died.

(6) Recognising that the right of publicity can be descendible is consistent with policy against unfair competition through the use of deceptively similar corporate names.

Even in England, at least one decision has shown some recognition of the existence of this right: *Universal City Studios Inc.* v. *Mukhtar and Sons Ltd.*[32] In this case, three of the plaintiffs were companies responsible for the production and marketing of the movie "JAWS". The fourth plantiff was licensed to manufacture and sell T-shirts bearing on them representations including a distinctive view of a shark's head and the inscription "JAWS". Templeman J. granted the plaintiffs' application for an Anton Piller order that the defendants should deliver up all their stock of "JAWS" T-shirts on the basis that the plaintiffs' rights were being infringed.

The Jamaican Supreme Court in the *Bob Marley* case has also given full recognition to the new tort of appropriation of personality in "protecting Bob Marley's face". The Supreme Court established the existence of a property interest as distinct from a privacy interest attached to personality. As Clarke J. stated:

> Just as the law recognizes property in the goodwill of a business so must the law recognize that property rights attach to the goodwill generated by a celebrity's personality. On that basis those rights are violated where the indicia of a celebrity's personality are appropriated for commercial purposes.

The court went on to hold that Bob Marley, as a celebrity both at home and abroad, had an exclusive right, which would survive his death, to the use of his name, likeness or image, which could be commercially exploited by him or his assignees, and further that invasion or impairment of this exclusive right, resulting in damage[33] would constitute this distinct tort of appropriation of personality.

[32] [1976] F.S.R. 252.

[33] According to *Halsbury's Laws of England (4th Edition)* Volume 48 paragraph 168, the plaintiff is generally entitled to recover damages for all loss actually sustained by him as the natural and direct consequence of the defendant's wrongful act. Paragraph 168 states also that if the defendant's goods are inferior, the plaintiff may suffer additional damage to the reputation of his goods or services.

The recognition of the new tort of appropriation of personality represents an important development in the common law of Jamaica and indeed, of the Commonwealth generally. It emphasises not only the resilience of the common law itself, but also the strength and willingness of the Jamaican judiciary to lead in the development of the law in the Commonwealth Caribbean when new circumstances and "new conditions of society" justify either the application of recognised principles of law to new fact situations or the recognition of new rights.

The ever-increasing practice in advertising and promotion, whereby products or services are marketed by reference to real or fictitious characters so as to enhance their retail potential, represents not a sporadic movement but a new worldwide commercial trend requiring changes in the existing laws in order to protect the legitimate owners of rights to the name, image or distinguishing features of such characters, against their unauthorised exploitation. Decisions in the United States, Canada, and Jamaica have highlighted the path of development, other territories must now follow it in order to keep pace with the changing commercial environment.