Enrique Cavero

Image rights, publicity rights, free speech and trademarks

Enrique Cavero Safra, Hernández & Cía. Abogados, gives an in-depth analysis of different forms of image laws, thinking specifically about celebrities' images and catchphrases.

In countries of civil-law tradition, there are certain subjective rights, known as *personality rights*, protected at a constitutional level. Amongst them, we find the right to one's own image, voice and name, as well as the right to honour and the right to privacy. As *human rights*, these are inherent to people by birth and have the characteristic of being inalienable and unwaiverable. These "image rights" allow individuals to exclusively authorize or prevent others from using their image and voice, thus protecting the most external and, therefore, the most vulnerable facet of people, in alignment with privacy rights, from which they derive.

Image rights in civil law jurisdictions

In the civil-law tradition, image rights do not allow individuals to prevent others from using their likeness, representation, imitation or, in general, any other manifestation that requires intellectual mediation or transformation. Image rights, as such, only protect the individual's own image or voice: the physical, visible (or audible) external projection of the human being, as it is regarded a direct manifestation of their personality.

This does not mean that using a person's likeness or other forms of representation is unrestrictedly allowed to others. There is legal recourse when such use conflicts with other rights of the individual, such as their intellectual property (trademarks and copyrights), their right to honour (if the use is defamatory) or their reputation (if the use damages or unduly benefits from it).

Image and publicity rights in the Anglo-Saxon tradition

On the other hand, image rights (in the UK) or "publicity rights" (in the U.S.) protect individuals against unauthorized commercial use of their image, voice, name, likeness, or any form of representation (for instance, certain distinctive features, such as the signature, nickname or characteristic outfit). The development of publicity rights in Anglo-

Résumé

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Saxon countries has taken place based on, basically, the doctrines and rules of passing off, trademarks and, more recently, personal data protection (especially in Europe). For the most part, there are no specific statutes or codified legislation.

A common ground

At first sight, you could say that there are important differences between both systems. For instance, common law publicity rights cover a much broader scope than civil law image rights and, the latter protect against any form of unauthorized use, while the former only protect against commercial use. However, at the end of the day, protection in all jurisdictions is very similar and vested rights are pretty much the same.

Non-commercial use of a person's own image is often dealt with in Anglo-Saxon countries through privacy rights (a constitutional remedy) while the use of likenesses and other representations in civil law countries is contemplated in passing off (unfair competition), intellectual property and other laws (which are basically the same laws under which publicity rights have grown in Anglo-Saxon courts).

The common ground is actually of economic nature. From an economic standpoint, passing off and intellectual property rules seek to generate transparency in the marketplace, preventing false and misleading information from wrongly deviating the demand from where it should be, thus creating incentives for providers of better goods and services at better prices, by allowing them to generate reputation and goodwill. In addition, they serve to protect and facilitate the most efficient exploitation of goodwill after it is created, because a person's goodwill and reputation (like most intangible assets) may lose value due to damaging use or due to over-utilization.

Passing off

Passing off laws protect a person's goodwill or reputation against undue exploitation by third parties. In many jurisdictions, they are part of a broader set of rules against "unfair competition". The economic rationale lies beneath the concept of "free riding" or "negative externalities" as it benefits someone who does not bear the costs (in this case, the cost of building the reputation) while damaging the reputation and/or its owner.

Passing off normally requires three things: 1) that a certain goodwill or reputation exists, 2) that someone who is not the creator of the goodwill benefits from it, usually through misrepresentation, and 3) that a damage is caused to the owner of the goodwill and/or the goodwill itself.

Based on the above, it is common to believe that passing off applies only to celebrities. However, any person with a certain reputation or goodwill and a legitimate interest may have a case. One of the more iconic cases of publicity rights in the U.S., Zacchini v. Scripps-Howard Broadcasting, involves a circus acrobat that was not precisely a celebrity. Mr. Zacchini was a cannonball man who sued a TV station for filming and broadcasting his show without his consent. The U.S. Supreme Court ruled in favor of Zacchini, based on the need to provide him with the adequate economic incentive to make the investment (however small) that it meant to produce his act.

"Common law publicity rights cover a much broader scope than civil law image rights."

Intellectual property

The name of a celebrity is also a trademark (and should be protected as such) if used to identify products or services traded in the market. And the same goes to nicknames, pictures, outfits, catch phrases, and just about anything that the public may see, recognize and associate with the person/source. However, certain creative assets, such as an original outfit or "get up", or a catch phrase, and just about anything that involves a creative effort, may be protected under copyright laws.

Zacchini, for instance (assuming that his act was original enough), could have invoked a copyright to those of TV shows or theater plays. Interestingly, the U.S. Supreme Court´s argument of the "incentive" is not based in the fame or notoriety of the actor (which was not great, as we have seen) but on the cultural and artistic nature of his creation, which they regard of "public interest". A case of publicity rights, with close connections to the economic foundations of copyright.

Image rights and freedom of speech

As we have seen, likenesses and representations that involve intellectual mediation do not require the prior authorization of the represented individual. The main reason is that such representations are often protected by freedom of speech. However, as we have seen also, the represented person will often have recourses based on passing off, trademarks or other laws. But how does this play against freedom of speech?

It seems from the case development that freedom of speech is protected in first instance whenever there is an artistic creation involved and conversely, it would seem that plain commercial exploitation generally excludes artistic value.

Freedom of speech protects the flow of information in general. It is not absolute or unrestricted when it involves objective information (such as news and advertising claims), but it is pretty close to absolute when it comes to opinions, cultural manifestations and art. High courts all over the world (at least the western culture) including the U.S. Supreme Court[1] have made it clear that censorship is simply not admitted nowadays and that opinions, personal judgments, thoughts, ideas and artistic expressions have some sort of immunity against any form of censorship or test by anyone. However, such immunity does not seem to extend to those expressions where artistic relevance is merely incidental and secondary to a commercial purpose, or those that are misleading to consumers.

A great deal of subjectivity and an infinite variety of situations, conflicts and discussions appear in every case. Two of the most famous cases of publicity rights involve the impersonation or imitation of celebrities. In Midler v. Ford Motor Co. and in Waits v. Frito-Lay, Inc., Bette Midler and Tom Waits, respectively, had declined to lend their voices for advertising jingles. In view of that, the advertisers hired imitators to do the voices and styles so that the public would not hear the difference. Both courts ruled that there was a predatory exploitation of the fame and goodwill of the plaintiffs and awarded Bette Midler and Tom Waits indemnities of US$400,000 and $2,500,000, respectively.

Another interesting case is White v. Samsung Electronics America, Inc. , which involves the personification of the famous TV show host Vanna White by a Samsung robot that looked and acted like her. The

[1] Hustler Magazine, Inc. V. Falwell, 485 U.S. 46 (1988).

court ruled in favor of White and said that the act was deliberately put on in such a way that the public would "recognize" and identify White with the robot, thus benefitting from her fame and popularity.

A different situation, not involving the celebrity directly but something that the public relates to him, takes place, for example, in Carson v. Here's Johnny Portable Toilet, where the court ruled that the catch phrase "Here's Johnny" was identified by the public and associated directly with celebrity Johnny Carson and "The Tonight Show", thus making a misleading association between the advertised product and Johnny Carson, which did not exist. Also considering the particular kind of product involved (toilets), there was the issue of whether the association could be not only misleading but also damaging. Similarly, in Motschenbacher v. R.J. Reynolds Tobacco Co., the issue was the use of a characteristic, particular car, identifiable as belonging to famous pilot Lothar Motschenbacher for a tobacco advertisement.

We can see the variety. All the aforementioned cases take place in the context of a commercial advertising or of a TV show with a high degree of advertising content. In the first three cases, the vested interest is clearly a celebrity's reputation, taken advantage of by imitating their voice and looks. However, in Midler and in Waits, the imitation is aimed at deceiving consumers and make them believe that they were listening to the celebrities themselves. In White, the use of the robot is merely intended to create an association. And in Carson and in Motschenbacher, the issue at stake is much closer to a Trademark case, because the association is made though identifiers other than the celebrity himself or his look.

Regarding the need to balance freedom of speech and image/publicity rights in a context other than commercial advertising, the leading case in the U.S. is Rogers v. Grimaldi. It involves a fiction movie by Federico Fellini called "Ginger and Fred" where the two main characters had become famous very young as a dance couple, have now grown old and, after many years meet again. The fictional couple clearly refers to Ginger Rogers and Fred Astaire. Roger sued the producer and alleged that the movie benefitted from his image and name. However, the court ruled that there was no impediment to use a celebrity's name for a work of art. It also established that there were only two reasons that would make such use illegitimate: 1) that the use of the name had no artistic relevance for the work of art as a whole, or 2) irrespective of its artistic relevance, that the use of the name would mislead the public about the source of the work or would constitute, in fact, a form of disguised commercial advertising.

In general, the use of a person's likeness or representation by others will be allowed in the context of artistic creation, as long as it is "transformative work" and is not some form of commercial advertising for other products or services. In this context, freedom of speech somehow prevails.

> *"Freedom of speech is protected in first instance whenever there is an artistic creation involved."*

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