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THE RIGHT OF PUBLICITY IN THE UNITED KINGDOM

Hayley Stallard[*]

I. INTRODUCTION

This Article discuses the limited scope of the right of publicity as it exists in the United Kingdom.[1] Unlike in the United States, the law of the United Kingdom ("U.K.") does not recognize a right of publicity or even a distinct right to protect a person's image or likeness from unauthorized use. Despite the common practice of merchandising and endorsement within the United Kingdom, there is no easy or straightforward way under U.K. law to protect a personality from unauthorized commercial exploitation. As in many other countries, however, a person can find a limited amount of protection from other bodies of U.K. law, including various intellectual property laws and personal and business torts.[2]

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1. In this context, "publicity" refers to the exploitation of an individual's name or image. This Article is not concerned with the ability of an individual to prevent the publication of private or personal information. The Data Protection Act 1984 (which will be replaced in October 1998 by the Data Protection Act 1998 implementing EC Directive 95/46 on the protection of individuals with regard to the processing of personal data and on the free movement of such data) regulates the use of personal data within the United Kingdom. The 1997 Human Rights Bill (*see infra* note 149) and the White Paper on a Freedom of Information Act (published by the Stationary Office Limited CM 3818, Dec. 1997, *available in* <http://www.open.gov.uk/m-of-g/foihome.htm>) will provide individuals with protection against disclosures that could substantially harm their personal privacy and greater access than previous to personal information that the government holds on them.

2. *See, e.g.*, Guillermo Cabanellas, *The Right of Publicity Under Argentine Law*, 18 LOY. L.A. ENT. L.J. 449, 452 (1998) (describing the Argentine right of publicity as a product of the Argentine Federal Constitution, various international agreements on human rights, and Argentine copyright, trademark, and name laws); Robert G. Howell, *Publicity Rights in the Common Law Provinces of Canada*, 18 LOY. L.A. ENT. L.J. 487, 499 (1998) (describing the ability to protect publicity rights in the common law provinces of Canada as embodied in the business tort of passing off and, to a limited extent, Canada's intellectual property laws); Elisabeth Logeais & Jean-Baptiste Schroeder, *The French Right of Image: An Ambiguous Concept Protecting the Human Persona*, 18 LOY. L.A. ENT. L.J. 511, 518 (1998) (describing the French right of image, analogous to the right of publicity, as a product of the French Civil Code, Penal Code, and copyright laws); Silvio Martuccelli, *The Right of Publicity Under Italian Civil Law*, 18 LOY. L.A. ENT. L.J. 543, 548 (1998) (describing the Italian right of publicity as a product of judicial

Part II of this Article explains the historical background of publicity rights in the U.K. and its relationship to other bodies of law. Part III explores the viability of grounding the right of publicity in existing legal doctrine and suggests that the right of publicity can be somewhat indirectly protected through copyright law, trademark law, and by the tort of "passing off." Part III also describes the elements required to establish a cause of action under copyright law, trademark law, and the tort of passing off. Part IV details the defenses available to claims brought under copyright and trademark law. Part V sets forth the remedies for copyright and trademark infringements. Part VI discusses the transferability and descendibility of copyrights and trademarks. Part VII describes the conflicts of laws in the area of intellectual property law. Part VIII argues that the right of publicity may become more well defined in the United Kingdom in light of recent developments in the law concerning individual privacy rights.

II. THE RIGHT OF PUBLICITY: HISTORY AND RELATIONSHIP WITH OTHER BODIES OF LAW

A. History

Since at least 1869, U.K. copyright law has offered no protection to a person's name. In that year, the Privy Council stated in *Du Boulay v. Du Boulay*[3] that "we do not recognize the absolute right of a person to a particular name . . . whatever cause of annoyance it may be . . . ."[4] In a more recent case, *Re: Elvis Presley Trademarks, Inc.*[5] (the "*Elvis*" case), the court refused to grant an applicant trademark registrations for the name

interpretation of Italian statutory protection for a person's name, pseudonym, image, and the country's copyright laws); Deborah Fisch Nigri & Silvia Regina Dain Gandelman, *The Right of Publicity in the Brazilian Legal System*, 18 LOY. L.A. ENT. L.J. 469, 474 (1998) (describing the Brazilian right of publicity as a product of the Brazilian Constitution, copyright laws, and the concept of "neighboring rights").

3. 2 L.R.-P.C. 430 (1869). In *Du Boulay*, the illegitimate son of a female slave and her master adopted the master's surname. *Id.* at 431. The master's family sued to prevent the son from using the family name. The court rejected their arguments, holding that there is no exclusive right to the use of a family name. *Id.* at 439.

4. *Id.* at 441 (Phillimore, J.).

5. 1997 R.P.D. & T.M. 543 (Ch.) (Eng.) (Laddie, J.) (holding that "[t]here . . . [is] no copyright in a name").

"Elvis Presley" and variations thereof to be used on toiletry products.[6] The court commented:

> There is nothing akin to copyright in a name . . . . Even if Elvis Presley was still alive, he would not be entitled to stop a fan from naming his son, dog or goldfish, his car or his house "Elvis" or "Elvis Presley" simply by reason of the fact that it was the name given to him at birth by his parents.[7]

Furthermore, an individual cannot obtain a copyright in his own appearance.[8] The court noted that the entertainer could not prevent a fan from having a tattoo portraying him, merely because it conveyed his appearance.[9]

B. Relationship with Other Laws

Due to the absence of a personality right in the United Kingdom, public figures must rely on other protective rights. The primary methods of protection are based on intellectual property law, including copyright and trademark law, and the closely related tort of "passing off."[10] Other methods of protection include claims based on defamation, violation of advertising codes, and breach of confidence arising under contract law. This section will analyze each cause of action in turn.

1. Intellectual Property Rights

a. Copyright

Under the Copyright, Designs and Patents Act of 1988 ("CDPA"),[11] the copyright owner of an original artistic photograph, drawing, or caricature of an individual may prevent third parties from substantially reproducing or exploiting the work.[12] Therefore, a public figure who has

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6. *Id.*

7. *Id.* at 547.

8. *Id.*

9. *Id.*

10. The concept of "moral rights" also arises in certain categories of copyright works, including literary and artistic works and films. In the context of personality rights, a person who, for private and domestic purposes, commissions the taking of a photograph or film that is the subject of copyright has, subject to certain exceptions, the right to prevent that work from being published without his consent. *See* Copyright, Designs & Patents Act, 1988, ch. 48 § 85 (Eng.). It is unlikely, however, that the photograph, the use of which a personality complains about, will have been taken in these circumstances and therefore this right is of little practical effect.

11. Copyright, Designs & Patents Act, 1988, ch. 48 (Eng.).

12. *Id.*

acquired a copyright in photographs of him or herself may have the right to prevent them from being reproduced.[13]

Claims alleging that a drawing or painting infringes upon a copyrighted photograph can be difficult to prove. For example, in the case of *Bauman v. Fussell*,[14] the court held that the copyright in a photograph was not infringed upon by a painting of that photograph because the artist only used it as a reference and introduced his original style into the painting.[15] On the other hand, where the defendant has recreated the "feeling and artistic character"[16] of the plaintiff's work, a court may find an infringement if the defendant used "a substantial portion of the plaintiff's work."[17]

Copyright protection may also arise, albeit in a limited manner, where individuals create cartoon characters or other types of caricatures of themselves. Such characters could obtain copyright protection as artistic works.[18] However, establishing infringement may be difficult if only the concept or idea of this character has been taken, or if the copying is so imprecise that it bears no recognizable resemblance to the original.[19] Similarly, copyright may also protect a public figure's autograph and biography as artistic and literary works, respectively.[20]

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13. *Id.*

14. 1978 R.P.D & T.M. 485 (C.A.) (Eng.).

15. *Id.*

16. *Id.* at 487.

17. *Id.*

18. *See* Copyright, Designs & Patents Act, 1988, ch. 48, § 4 (Eng.). "Artistic work" includes any graphic work, sculpture irrespective of artistic quality, or a work of artistic craftsmanship. *See id.* "Graphic work" includes any painting, drawing, or diagram. *See id.* "Sculpture" includes a cast or model made for purposes of sculpture.

19. *See id.* § 16 (providing that the acts restricted by the copyright in a work are in relation to the work as a whole or any substantial part of it); *see also* Ladbroke (Football) Ltd. v. Hill (Football) Ltd., 1 W.L.R. 273, 276 (H.L. 1964) (Eng.) (Read, L.) ("What amounts to a substantial part must be assessed upon the basis of quality rather than quantity"). It has been argued that the true test of copy is whether the defendant has made a substantial use of those features of the plaintiff's work in which copyright subsists. *See* E.P. SKONE JAMES ET AL., COPINGER AND SKONE JAMES ON COPYRIGHT 8–20 (13th ed. 1991).

20. *See* discussion *supra* note 18. "Graphic work " includes any diagram, engraving, etching or similar work. Copyright, Designs & Patents Act, 1988, ch. 48, § 4 (Eng.). "Literary work" means "any work other than a dramatic or musical work that is written, spoken or sung . . . ." *Id.* § 3.

b. Trademarks

The enactment of the Trade Marks Act of 1994 relaxed U.K. trademark law.[21] After passage of the Act, numerous personality-related trademark applications have been filed.[22] This law also recognized merchandising as an accepted practice.[23] However, the *Elvis* case, which denied protection in the U.K. to the names "Elvis" and "Elvis Presley" on the basis that they lacked distinctiveness, challenges the validity of some of these recent applications.[24]

The *Elvis* decision is the latest in a long line of cases that firmly rejected the idea of protecting names through trademark law.[25] In the *Tarzan Trade mark Case*,[26] the Court of Appeal refused to recognize the registration of "Tarzan" as a trademark, finding that the word had passed into the common language.[27]

> From these cases, one can infer that the more famous a personality becomes, and as his or her name or nickname passes into common usage, the less likely it is that he or she will be entitled to claim an exclusive right to the name. As the *Elvis* court stated, "[W]hen a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a

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21. *See* Trade Marks Act, 1994, ch. 26 (Eng.).

22. For example, Alan Shearer, Paul Gascoigne, Damon Hill, and Eric Cantona, as well as the trustees acting on behalf of the estate of the late Diana, Princess of Wales, have registered or applied to register their names and nicknames, as well as certain images and signatures of themselves, as trademarks across a wide range of goods within which merchandising may be undertaken.

23. *See* Trade Marks Act, 1994, ch. 26 (Eng.).

24. *Elvis*, 1997 R.P.D. & T.M. at 543.

25. *See, e.g.*, Tarzan Trademark Case, 1970 R.P.D. & T.M. 450 (C.A.) (Eng.) (refusing to allow an American company to register a trademark for the name Tarzan); Lyngstad v. Anabas Prods. Ltd., 1976 F.S.R. 62 (Ch.) (Eng.) (the *Abba* case); *see also* Conan Doyle v. London Mystery Magazine Ltd., 66 R.P.C. 312 (Ch. 1949) (Eng.) (holding that there was no goodwill in the fictional character "Sherlock Holmes"); Tavener Rutledge Ltd. v. Trexapalm Ltd., 1977 R.P.D. & T.M. 275, 281 (Ch.) (Eng.) (the "Kojak" case) (holding that the plaintiffs who were using the slogan "Kojakpops" without permission from the owners of the rights in the television series were entitled to do so and that the defendant's license was a "writ in water"); Wombles Ltd. v. Wombles Skips Ltd., 1977 R.P.D. & T.M. 99 (Ch.) (Eng.) (holding that the plaintiffs were unable to prevent the defendants from using the name "Wombles" for a business of hiring out skips); *cf.* Lego System AS v. Lego M Lemelstrich Ltd., 1983 F.S.R. 155, 194 (Ch.) (Eng.) (Falconer, J.) ("Obviously, the possibility of licensing or franchising another trader to use 'Lego' in the gardening of equipment area would be lost if the defendants are allowed to continue using 'Lego' in this country in relation to their products.").

26. 1970 R.P.D. & T.M. 450 (C.A.) (Eng.) (refusing to allow an American company to register a trademark for the name Tarzan).

27. *Id.* at 453 (Salmon, L.J.).

particular source."[28] The court conceded that, because of the peculiarities of particular markets, one may infer an association with a particular trader, for example, if the word "official" is used in conjunction with a sponsor. In one justice's view, however, the general public does not perceive this association: "[O]n the contrary, my own experience suggests that such an assumption would be false. When people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care one way or another who made sold or licensed it."[29]

2. Passing Off

Where a personality is sufficiently well-known, the non-consensual use of his or her name, image, or voice may give rise to a misrepresentation that the personality endorses, or is connected with, the products or services in question. A plaintiff may bring an action for passing off if this misrepresentation is likely to cause confusion amongst consumers and a loss of income to the plaintiff.[30]

However, the plaintiff will have a difficult time proving damage to his licensing trade if he is not actively marketing, engaged in, or connected with the merchandising business.[31] This is particularly true where a disclaimer qualifies that the use of the personality's image is not an endorsement of the product.[32] Furthermore, although U.K. courts have applied passing off as a means of protection in the field of character merchandising, it is unlikely that

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28. *Elvis*, 1997 R.P.D. & T.M. at 554 (Laddie, J.).

29. *Id.*

30. *See* Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd., 2 All E.R. 927 (H.L. 1979) (Eng.).

31. *See id.* One of the requirements to establish a cause of action for passing off is the need to prove damage to a business or goodwill of the plaintiff. *See id.* at 933 (Diplock, L.); *see also* Reckitt & Colman Prods. v. Borden, Inc., 1 All E.R. 873, 890 (H.L. 1990) (Eng.) (Jauncey, L.) ("[A] plaintiff, to succeed, must establish . . . that his goods have acquired a particular reputation amongst the public . . . .").

32. *Id.* at 890.

> [I]n a case such as the present where what is in issue is whether the goods of A are likely to be passed off as those of B, a plaintiff, to succeed, must establish (1) that his goods have acquired a particular reputation amongst the public, (2) that persons wishing to buy his goods are likely to be mislead into buying the goods of the defendant and (3) that he is likely to suffer damage thereby.

Id. The second of this "classical trinity" may not be satisfied where a disclaimer is used to make it clear that the goods are not those of the defendant. *See, e.g.*, Saville Perfumery Ltd. v. June Perfect Ltd., 58 R.P.C. 147, 162 (1941).

the courts will apply these principles to a real person where there is no underlying copyright.[33]

Mirage Studios v. Counter-feat Clothing Co.,[34] the so-called "Teenage Mutant Ninja Turtles" case, gave apparent authority to the proposition that third party character merchandising constituted a misrepresentation that the owner had licensed the use of the characters.[35] However, the *Elvis* court firmly rebutted this proposition, stating that the *Ninja Turtles* case has no universal application, but was particular to its facts.[36]

In the high profile sporting case *Cantona v. Cantona French Wines Limited*,[37] the plaintiff, soccer star Eric Cantona, initiated proceedings against the defendants for associating themselves with Cantona and his soccer team, Manchester United.[38] The defendants had registered companies under the names "Cantona French Wines Ltd.," "Cantona French Brandy Ltd.," and "Cantona Pour Homme Ltd."[39] The defendants promoted wine and brandy in the sports pages of a local newspaper near Cantona's club in Manchester. The advertisement contained phrases often associated with the soccer player, such as "Ooh Aah!," and depicted Cantona's jersey number "7" on the bottle.[40] The parties settled the case before trial when the defendants agreed to change the company name and to end any association between Cantona and their merchandise.[41]

Whether this obvious association would have amounted to passing off is uncertain. Cantona may have been able to establish that he had a reputation as an endorser, and that his legitimate endorsements were

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33. *See* Mirage Studios v. Counter-feat Clothing Co., 1991 F.S.R. 145, 157–58 (Ch.) (Eng.) (Diplock, L.) (distinguishing the older cases on the basis that they were concerned with licensing of a "mere name" and that there was no underlying copyright or other right to support the public perception of license) ("[I]n relation to the drawings of Ninja Turtles as they appear in cartoons etc, . . . there is a copyright which can be infringed"); *see also* cases cited *supra* note 25; JOHN DRYSDALE & MICHAEL SILVERLEAF, PASSING OFF LAW AND PRACTICE 353 (2d ed. 1995):

> One of the key factors in all these cases was the fact that all that was claimed to be licensed was the name of the character. There was neither any underlying copyright or other proprietary right nor any commercial activity of the licensor in which there was relevant goodwill which could be said to support the license.

Id.

34. 1991 F.S.R. 145 (Ch.) (Eng.).

35. *See generally id.*

36. *Elvis*, 1997 R.P.D. & T.M. at 543.

37. *See Cantona Seeks to Protect His Name with the Patent Office*, MARKETING WK., May 29, 1997, at 7, *available in* LEXIS, News Library.

38. *See id.*

39. *See id.*

40. *See id.*

41. *See* Stephen Howard, *Cantona Wins Name Row*, PRESS ASS'N NEWSFILE, June 27, 1997, *available in* LEXIS, News Library.

damaged by the unendorsed products.[42] However, Cantona would also have had the difficult task of proving that a significant portion of the public believed that he endorsed the product.

In *Halliwell v. Panini SpA*,[43] the singing group "Spice Girls" applied for an injunction, under the claim of passing off, to prevent Panini from distributing an unauthorized sticker collection, called "The Fab Five," which featured their images.[44] The group contended that the public would be misled into believing that it was an authorized collection, because the collection did not contain a disclaimer.[45] The court made it quite clear that the plaintiffs were unlikely to succeed at trial.[46] The judge reasoned that the absence of the word "unofficial" on the defendant's product would not mislead the public.[47] The court then questioned whether a designation of "official" on a product is of any relevance to a purchaser.[48]

c. Designs

Generally, under the Registered Designs Act of 1949,[49] one can register a design[50] if it is original and unpublished.[51] For example, a surface decoration, such as a T-shirt design containing a person's image, could be registered.[52] This would protect against the reproduction of a substantially similar design.

3. Other Methods of Protection

a. Defamation and Malicious Falsehood

A plaintiff may bring a claim for defamation or malicious falsehood if the defendant has caused harm to the plaintiff's trade.[53] An unauthorized

42. *See id.*

43. 1997 LEXIS (Ch. June 6, 1997) (Eng.).

44. *See id.*

45. *See id.*

46. *See id.*

47. *See id.*

48. *See id.*

49. Registered Designs Act, 1949, 12, 13 & 14 Geo. 6, ch. 88, § 1(1)(b)(i), *amended by* Copyright, Designs & Patents Act, 1988, ch. 48, §§ 265–73 (Eng.).

50. Copyright, Designs & Patents Act, 1988, ch. 48, § 265 (1) ("[D]esign means features of shape, configuration, pattern or ornament applied to an article by any industrial process . . . ."). The Act also states limited exceptions to this definition. *See id.*

51. *See id.*

52. *See id.*

53. The law of libel and slander is primarily based on the common law, but there are now

endorsement could be defamatory if it is contrary to the known attributes of the individual, derogatory to his or her image, or harmful to his or her reputation.[54] In *Tolley v. J.S. Fry & Sons, Ltd.*,[55] for example, a well-known amateur golfer brought a defamation suit against the manufacturers of a chocolate bar that bore his image.[56] He successfully argued that the advertisement implied that he had "prostituted" his amateur status by accepting money for the endorsement.[57]

Other potential areas of defamation might include the use of a "tee-total" personality (i.e., a person known for never drinking alcohol) in connection with the sale of alcohol. For example, [need author to provide example or hypothetical]. However, merely proving exploitation is insufficient.[58] The circumstances must also be untrue and professionally or personally damaging to be considered defamatory.[59] Therefore, in practice the right is likely to be limited to extreme cases.

b. Advertising Codes

The U.K. advertising industry has devised various codes of practice on a self-regulating basis.[60] These codes afford personalities some protection against the unauthorized use of their names or images in any advertising or promotional campaign.[61]

The basic principle holds that advertisers should not portray or refer to living persons without authorization.[62] The codes do not have the direct

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major statutory modifications, principally the Defamation Acts of 1952 and 1996. See Defamation Act, 1952, 15 & 16 Geo., 6 & 1 Eliz. 2, ch. 66, § 5 (Eng.); Defamation Act, 1996, ch. 31 (Eng.). The common law of malicious falsehood is a closely related tort. Other overlapping causes of action include negligent misstatements, and false statements injuring property.

54. *See, e.g.*, Sim v. Stretch, 52 T.L.R. 669, 671 (H.L. 1936) (Eng.) (Atkin, L.); Youssoupoff v. Metro Goldwyn-Mayer, 50 T.L.R. 581, 584 (C.A. 1934) (Eng.); Parmiter v. Coupland, 151 Eng. Rep. 340, 341–42 (Ex. Ch. 1840) (Eng.) (Parke, B.).

55. 1931 All E.R. 131.

56. *Id.*

57. *Id.* at 132.

58. *See, e.g.*, cases cited *supra* note 54.

59. *See, e.g.*, cases cited *supra* note 54..

60. For example, the *British Codes of Advertising and Sales Promotion Practice* ("BCASP") was devised by the Committee of Advertising Practice ("CAP") and is enforced through the Advertising Standards Authority ("ASA"). The *Radio Authority Advertising and Sponsorship Code* ("RAASC") applies to all radio advertising, while the *Independent Television Commission Code of Advertising Standards and Practice* ("ITCCASP") applies to all non-radio broadcast media. Also, the Independent Committee for the Supervision of Standards of Telephone Information Services Code of Practice ("ICSSTISCP") applies to telephone promotions.

61. *See id.*

62. *See, e.g.*, BCASP, § 13.1 ("Advertisers are urged to obtain written permission in advance if they portray or refer to individuals or their identifiable possessions in an advertisement. . . .

force of law and do not provide a remedy to a personality for a breach of the codes.[63] However, non-compliance may, in practice, lead publishers to reject, or advertisers to withdraw, an advertisement from publication.[64]

In 1996, for example, Molson Beers used a "look-alike" of soccer star Eric Cantona in its advertisements. The look-alike wore a striped Manchester United soccer jersey, displaying Cantona's famous number "7," and turned-up collar, poised in a mid-air "can-can" style.[65] Cantona complained to the Advertising Standards Authority ("ASA") that the advertisement "distressed and exploited him."[66] The ASA upheld his complaint and, as a result, the advertisements were withdrawn.[67] It is uncertain in light of the *Elvis* case whether Cantona could have alternatively relied upon his trademark registrations to prevent such use today in court.

c. Contract and Confidence

When a personality has entered into a specific promotional contract with a product manufacturer for the right to use the person's name or image in connection with the promotion or sale of particular merchandise for a set term, and the contract contains a promise not to exploit the right after the term has expired, the manufacturer would be in breach if it uses the name or image after the end of the term.[68] Additionally, where a personality has

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Advertisements should not claim or imply an endorsement where none exists.").

63. *See id.* § 68 ("How the System Works"). The Codes are reinforced by the legal authority provided for the work of the ASA by the Control of Misleading Advertisements Regulations 1988. The Codes were designed and have been developed to work within and to complement these legal controls and provide an alternative means of resolving disputes. The Codes require advertisers and promoters to ensure that all their advertisements and promotions are legal, but the ASA is not a law enforcement body. Media owners can refuse space to advertisements that break the Codes. Complaints are investigated by the ASA and, if a complaint is upheld, advertisers will be asked to take action to avoid further harm. The sanctions that exist to counteract advertisements that conflict with the Codes are: the media may deny access to space; adverse publicity may result from rulings published in the ASA's monthly report; trading sanctions may be imposed or recognition revoked by the advertiser's, promoter's or agency's professional association; and financial incentives provided by trade, professional or media organizations may be withdrawn. If a misleading advertisement continues to appear after the ASA Council has ruled against it, the ASA can refer the matter to the Director General of Fair Trading, who can seek an undertaking from anyone responsible for commissioning, preparing or disseminating it that it will be discontinued. If this is not given or is not honored, the OFT can seek an injunction from the Court to prevent its further appearance. Anyone who defaults can be found to be in contempt of Court, and is liable to be penalized accordingly.

64. *See* discussion *supra* note 63.

65. *See Cantona Seeks to Protect His Name with the Patent Office*, *supra* note 37, at 7.

66. *See id.*

67. *See* Howard, *supra* note 41.

68. Assuming that a contract has been validly created, it is well established that the party signing will be bound by the terms. *See* Howatson v. Webb, 1 Ch. 1 (1908) (Eng.). The

imposed a term of confidence[69] on a third party, the third party would breach its duty of confidence if it ignored its obligations in this respect. Both contract and confidence require a pre-existing relationship for these contracts to be effective.[70]

For example, in *Creation Records Ltd. v. News Group Newspapers Ltd.*,[71] the pop group "Oasis" applied for an injunction to prevent photographs taken at a photo-shoot for an upcoming album from being published in *The Sun* newspaper.[72] Because the photographer knew that the photographs were for a specific purpose, it was arguable that he acted surreptitiously in taking them to the newspaper. The court thus held there was a sufficient case for breach of confidence.[73] Although the photographer was lawfully at the scene, his lawful presence did not give him the right to have the photos published in a newspaper.[74]

III. WHAT'S LEFT WITHOUT THE RIGHT OF PUBLICITY: ALTERNATIVE CAUSES OF ACTION UNDER INTELLECTUAL PROPERTY LAW

Because other causes of action are legally insufficient, and because the United Kingdom recognizes no "publicity right," one must turn to intellectual property law to protect a personality against exploitation. For example, defamation and malicious falsehood require a showing of falsity, an exceedingly difficult standard to prove.[75] Advertising codes have no direct force of law and provide no damages remedy.[76] Finally, breach of

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enforceability of a post contractual restriction will depend on whether the restriction is justifiable under the doctrine of restraint of trade. *See generally* J. HEYDON, THE RESTRAINT OF TRADE DOCTRINE (1971); M. TREBILCOCK, THE COMMON LAW OF RESTRAINT OF TRADE (1986); S.A. Smith, *Reconstructing Restraint of Trade*, 15(4) OXFORD J.L. STUD. 565 (1995).

69. The law of "confidence" refers to broad principles of equity arising from a contract. *See* LORD GOFF OF CHIEVELEY & GARETH JONES, THE LAW OF RESTITUTION 684 (4th ed. 1993); *see also* Moorgate Tobacco v. Phillip Morris (No. 2) (1984) 156 C.L.R. 414, 437 (Austl.).

70. The source of an obligation of confidence will commonly be the express or implied terms of a contract between the parties. *See* Attorney General v. Guardian Newspapers (No. 2), 1 A.C. 109, 281 (H.L. 1990) (Eng.). However, no contract is necessary for a duty of confidence to exist. *Id.*

> A duty of confidence arises when confidential information comes to the knowledge of a person in circumstances where he has notice, or is held to have agreed that the information is confidential, with the effect that it would be just in all the circumstances that he should be precluded from disclosing the information to others.

Id. (Goff, L.).

71. 1997 LEXIS (Ch. Apr. 25, 1997) (Eng.).

72. *See generally id.*

73. *See generally id.*

74. *See generally id.*

75. *See supra* notes 54–62 and accompanying text.

76. *See supra* notes 63–70 and accompanying text.

contract and confidences depends on a pre-existing relationship, which is usually not the case with unauthorized character merchandising.[77]

Thus, the rest of this Article will explore whether intellectual property laws in the United Kingdom are adequate to protect a personality against exploitation. It will address copyright laws, trademark laws, and the closely related business tort of passing off. Each section will discuss formalities, the elements of each cause of action, and durational requirements.

A. Copyright

Under the CDPA, a copyright automatically arises as soon as a work, such as an original artistic or literary work, film, or sound recording, is created in a material form that qualifies for copyright protection by reference to its author or the country of first publication.[78] In order to present a prima facie case for copyright infringement, the plaintiff must establish that: (1) he is the copyright owner; (2) the work in question qualifies for protection as a copyright work in that (a) it is original, and (b) either the author is a "qualifying person" by reference to domicile or residency (e.g., the author is a British citizen); or (c) the work was first published in the United Kingdom or a country to which the Act extends; (3) the work is still in copyright; (4) one of the acts restricted by copyright has been committed in the United Kingdom (e.g., the work, or a substantial part of the work, has been copied either directly or indirectly); and (5) none of the exceptions and defenses to copyright infringement apply.[79]

As a basic principle, copyright in artistic works lasts for the life of the author plus seventy years.[80] However, the period of protection may be reduced to twenty-five years if more than fifty copies are produced.[81]

B. Registered Trademarks

Generally, any sign that distinguishes goods or services of one undertaking from those of another and can be depicted graphically may be registered as a trademark under the Trade Marks Act of 1994.[82]

77. *See supra* notes 71–74 and accompanying text.

78. Copyright, Designs & Patents Act, 1988, ch. 48, § 1 (Eng.).

79. *Id.* §§ 17–18.

80. *Id.* § 12(1).

81. *Id.* §§ 6, 12, 52, sched.1.

82. Trade Marks Act, 1994, ch. 26, § 1, General Note (Eng.).

Trademarks are granted on a first-to-file basis. However, an application may be refused if another trader can establish an earlier right to the mark.[83]

In order to present a prima facie case for trademark infringement, a plaintiff must establish that: (1) he or she is the proprietor of a valid registered trademark in the United Kingdom;[84] (2) the defendant is using it in the course of trade in the United Kingdom: (a) a mark that is identical to the plaintiff's mark with respect to goods or services that are identical to the goods or services for which the plaintiff's mark is registered;[85] (b) a mark that is identical or similar to the plaintiff's mark with respect to goods or services that are identical or similar to the goods or services for which the plaintiff's mark is registered, and there exists a likelihood of confusion on the part of the public with the plaintiff's mark;[86] or (c) a mark that is identical or similar to the plaintiff's mark in relation to the goods or services that are not similar to the plaintiff's mark but where the plaintiff's mark has a reputation in the United Kingdom and the use of the mark by the defendant takes unfair advantage of, or is detrimental to, the distinctive character or repute of the plaintiff's mark;[87] and (3) none of the exceptions or defenses to trademark infringement apply.[88] While the initial duration of protection is ten years, the registration may be renewed indefinitely at ten-year intervals.[89]

C. Passing Off

The common law right of passing off is the only protection available for unregistered trade or service marks that do not qualify for copyright or registered design protection.[90] This protection depends on having an established reputation in the mark.[91] Therefore, commercial exploitation would be necessary before the right would apply.

The case of *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd.* (the "Advocaat Case")[92] established the criteria upon which an action for passing off may be brought in the United Kingdom. According to the court,

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83. *Id.* § 5.

84. *Id.* § 2.

85. *Id.* § 10(2)(a).

86. *Id.* § 10(2)(b)

87. *Id.* § 10(3)(a)–(b).

88. Trade Marks Act, 1994, ch. 26, §10 (Eng.).

89. *Id.* § 42(1)–(2).

90. The tort of passing off is based on the goodwill or reputation attached to the plaintiff's goods or services. *See* Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd., 2 All E.R. 927 (H.L. 1979) (Eng.). There is no requirement that the plaintiff's mark be registered as a trade mark. *See id.* at 932–33.

91. *See id.*

92. 2 All E.R. 927 (H.L. 1979) (Eng.).

the plaintiff must prove: (1) a misrepresentation; (2) made by a trader in the course of trade; (3) to prospective customers, or ultimate consumers of goods and services; (4) that is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonable consequence); and (5) that causes actual damage to the plaintiff's business or goodwill or, in a *quia timet* action, will probably do so.[93]

Because the plaintiff must establish the existence of goodwill and a likelihood of confusion in the minds of the public, an action for passing off can be more costly and time consuming than an action for trademark infringement. Furthermore, the courts are reluctant to prevent traders in different products from using the same name. For example, in *Lyngstad v. Anabas Productions Ltd.*,[94] the pop group "Abba" could not prevent the use of the name "Abba" on T-shirts and other merchandise because they had not marketed such goods themselves and therefore could not establish goodwill.[95] However, in the recent case of *United Biscuits (U.K.) Ltd. v. Asda Stores Ltd.*,[96] the manufacturers of "Penguin" biscuits successfully prevented the sale of "Puffin" biscuits in a deceptively similar "get-up."[97]

IV. DEFENSES: MEDIA AND OTHER "SPEECH PRODUCT" USES

A. Fair Dealing

In the context of publicity rights, the primary defense against a claim of a copyright violation is "fair dealing," which is not specifically defined in the CDPA.[98] Thus, the facts of each case will determine its outcome. The motive of the party raising the defense is relevant.[99] Fair dealing can be broken down into four categories: (1) a literary, dramatic, musical, or artistic work for the purposes of research or private study; (2) a work for the purpose of criticism or review, provided that it is accompanied by a sufficient acknowledgment; (3) a work, other than a photograph, for the purpose of reporting current events, provided that it is accompanied by a

93. *Id.* at 932–33 (Diplock, L.).

94. 1976 F.S.R. 62 (Ch.) (Eng.).

95. *Id.* at 66–70.

96. 1997 R.P.C. 513 (Ch.) (Eng.).

97. *Id.*; *see also* Daniel McGrory, *Asda's Wings are Clipped in Penguin Biscuit Battle*, FIN. TIMES (London), Mar. 19, 1997, at 22.

98. Copyright, Designs & Patents Act, 1988, ch.48, §§ 29–31 (Eng.).

99. *See id.*; *see also, e.g.*, Sillitoe v. McGraw-Hill Book Co. (UK) Ltd., 1983 F.S.R. 545, 558 (Ch. 1983); *see also* JAMES, *supra* note 19, ¶ 10-10.

sufficient acknowledgment;[100] and (4) an artistic work, sound recording, film, broadcast or cable program that incidentally includes a copyright work.[101] "Sufficient acknowledgment" will generally mean an acknowledgment that identifies the work by its title or other description.

B. Trade Marks Act

Under section 10(6) of the Trade Marks Act of 1994 ("1994 Act"),[102] it is not an infringement of a registered trademark to use the trademark for the purpose of identifying goods or services as those of the proprietor or licensee, provided that such use is in accordance with honest practices in industrial or commercial matters and does not take unfair advantage of, or is not detrimental to, the distinctive character or repute of the registered trademark.[103]

Section 11(2) of the 1994 Act provides that a registered trademark is not infringed upon by: (a) the use by a person of his own name or address; (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; or (c) the use of the trademark where it is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts), provided the use is in accordance with honest practices in industrial or commercial matters.[104]

The case of *Mercury Communications Ltd. v Mercury Interactive (U.K.) Ltd.*[105] confirmed the right of a person to use his or her own name notwithstanding a conflict with another's registered trademark.[106] However, that case was decided under the old law.[107]

In the more recent case of *Scandecor Development v. Scandecor Marketing*,[108] it was held that the defense applies to companies as well as to

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100. Copyright, Designs & Patents Act, ch. 48, § 30 (Eng.) (noting that no acknowledgment is required in connection with the reporting of current events by means of a sound recording, film, broadcast or cable program).

101. *See id.*

102. Trade Marks Act, 1994, ch. 26, § 10(6) (Eng.).

103. *Id.*

104. *Id.* § 11(2)(a)–(c).

105. 1995 F.S.R. 850 (Ch.) (Eng.) In *Mercury Communications*, the plaintiff, a telecommunications company, filed a motion for summary judgment in a trademark infringement case alleging that the defendant, a computer programming company, lacked sufficient grounds for establishing a defense. *Id.*

106. *See generally id.*

107. *See generally id.*

108. NEW L. DIG., Jan. 27, 1998, at 2 (Ch. Div., Jan. 23, 1998) (Unreported).

private individuals, and that a company name adopted for the purpose of trading on someone else's goodwill would not satisfy the honesty test.[109] However, a name adopted years before and used consistently in ordinary commercial ways can be a proper subject of the defense.[110] Section 11(2) is therefore unlikely to succeed as a defense when a person tries to cash in on his name by taking unfair advantage of the fame of a celebrity with a name that has been registered.[111]

Therefore, use of a registered trademark in a descriptive manner, rather than merely as a trademark, cannot be prevented by the proprietor of that registered trademark.[112] For example, a personality who has registered their name as a trademark could not prevent a newspaper or other trader from referring to him or her in a descriptive way.[113]

C. Laches and the Statute of Limitations

If the owner of a right becomes aware of an infringement and fails to take action, he may be said to have acquiesced and may lose his entitlement to bring an action for infringement.[114] No special statute of limitations is provided in infringement actions, so the six-year period provided for by the Limitation Act of 1980 applies.[115] The limitation period begins to run from the date on which the infringement occurred, but may be stayed when there has been a deliberate concealment by the infringer.[116]

V. REMEDIES

Any person whose trademark or copyright is infringed, whose goodwill is damaged, or whose trust or confidence is breached may apply to the court for relief.[117] An application may be granted in the form of specific performance, an injunction, damages, or an account of the defendant's profits and delivery up or destruction of infringing material and costs.[118]

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109. *See generally id.*

110. *See generally id.*

111. *See generally id.*

112. Trade Marks Act, 1994, ch. 26 (Eng.).

113. *Id.*

114. *See* Willmott v. Barber, 15 Ch. 96 (1880) (Eng.) (Fry, J.).

115. Limitation Act, 1980, ch.58 (Eng.).

116. *Id.*

117. *See, e.g.*, Copyright, Designs & Patents Act, 1988, § 96 (Eng.); Trade Marks Act, 1994, § 14 (Eng.).

118. *See, e.g.*, Copyright, Designs & Patents Act, 1988, § 96 (Eng.); Trade Marks Act, 1994, § 14 (Eng.).

Additionally, criminal proceedings may also be brought for copyright and trademark infringement.[119]

Where the advertising codes have been breached, the ASA may take action to prevent any further breach by requesting the media not to carry future advertisements.[120] As a last resort, the ASA may inform the Director General of the Office of Fair Trading, who may then bring an action under the Control of Misleading Advertisements Regulations of 1988.[121]

VI. TRANSFERABILITY

Trademarks, copyrights, and all other forms of intellectual property are fully transferable by assignment, testamentary disposition, or operation of law in the same way as any other personal or moveable property.[122] They may be transferred either together with, or independently of, the goodwill of a business, in whole or in part (e.g., by reference to a geographical location of specific goods, services, or uses).[123]

While licenses may be granted verbally or in writing, assignments must be in writing and signed by or on behalf of the assignor.[124] These rights may not be waived, but registered rights may be allowed to lapse.[125] Intellectual property rights are treated in the same manner as any other property right. These rights pass at death to the deceased's estate either by will or through intestacy.[126]

VII. CONFLICTS OF LAWS

A. Scope and Effect of U.K. Laws

Statutory intellectual property rights (such as copyright and trademarks) are territorial in their scope and effect. The Copyright, Designs and Patents Act of 1988 and the Trade Marks Act of 1994 provide that, in effect, each statute is limited in its operation to acts of infringement that take

119. *See* Copyright, Designs & Patents Act, 1988, § 107; Trade Marks Act, 1994, §§ 92–95.

120. *See* discussion *supra* note 63.

121. Statutory Instruments No. 915, at 1988 (Eng.).

122. Copyright, Designs & Patents Act, 1988, ch. 48, § 90 (Eng.); Trade Marks Act, 1994, §§ 22–24.

123. Trade Marks Act, 1994, ch. 26, § 24 (Eng.).

124. *Id.*; Copyright, Designs & Patents Act, 1988, ch. 48, § 90 (Eng.).

125. Trade Marks Act, 1994, ch. 26, §12 (Eng.).

126. 2 PAUL EDWARD GELLER & MELVILLE B. NIMMER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 4[2][a] (1997).

place within the United Kingdom.[127] Accordingly, irrespective of where a defendant is domiciled, a statutory U.K. right can by definition only be infringed upon by an act that takes place in the U.K.[128] In contrast, the torts of passing off and breach of confidence are not territorially limited in this way and, for example, the English courts have granted relief in the past to restrain passing off in Switzerland.[129] Thus, it is possible that a foreign defendant could conceivably pass himself off outside the United Kingdom as the plaintiff if the plaintiff has acquired a reputation outside the United Kingdom.

B. Applicable Law

It does not necessarily follow that U.K. laws will be applied to an unauthorized exploitation of identity in the United Kingdom. The Private International Law Act of 1995 applies to all cases of tort, including copyright infringement and defamation.[130] As a general rule, the applicable law will be the law of the country in which the event or the most significant elements of an event constituting the tort occurs, unless the dispute is more closely connected with another country.[131] U.K. courts may then determine that it would be more appropriate to apply the laws of the other country.[132]

C. Jurisdiction

The Private International Law Act of 1995 abolished the "double actionability" rule.[133] Previously, in order for a plaintiff in England to secure an injunction with extra-territorial effect, it was necessary to show that the act done in a foreign country would: (a) be actionable as a tort if it had been committed in the United Kingdom; and (b) be actionable according to the law of the foreign country where it was committed.[134]

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127. Copyright, Designs & Patents Act, 1986, ch. 48, § 16 (Eng.); Trade Marks Act, 1994, ch. 26, §§ 9, 10, 11 (Eng.).

128. *See infra* Parts VII.C–D.

129. In *Alfred Dunhill v. Sunoptic S.A.*, 1979 F.S.R. 337 (C.A.) (Eng.), Alfred Dunhill, a tobacco manufacturer, sought an interlocutory injunction against Sunoptic, a Swiss sunglasses manufacturer, to prevent it from using the name "Dunhill" as part of the Sunoptic trademark. The English court granted Dunhill an injunction valid in both the United Kingdom and Switzerland.

130. Private International Law (Miscellaneous Provisions) Act, 1995, ch. 42 (Eng.).

131. *Id.* § 11.

132. *Id.*

133. Phillips v. Ayres, 1870 L.R. 6 (Q.B.) (Eng.).

134. *See id.*

The Brussels Convention of 1968 and the Lugano Convention of 1989 ("the Conventions")[135] apply to actions in EEA countries and were introduced into U.K. law by the Civil Jurisdiction and Judgments Act of 1982.[136] They provide rules on the forum for disputes between parties of different member states.[137]

Under the Conventions, the primary rule is that, irrespective of nationality, a defendant must be sued in the country of his domicile.[138] However, in relation to tort proceedings, including those concerning infringement of an intellectual property right, an exception to the general rule applies.[139] Under the exception, an infringer may be sued *in the country where the harmful event occurred* (i.e., where the damage was suffered, or the infringing act took place).[140] Regardless of domicile, proceedings concerning the validity of patents, trademarks, designs, and other registered rights should be brought in the country of registration.[141]

Consequently, a U.K. court will have jurisdiction in relation to the infringement in the United Kingdom of U.K. copyright or a U.K. registered trademark even if the defendant is domiciled abroad. However the courts are also becoming more willing to assume jurisdiction in actions for infringement of foreign intellectual property rights where there is a basis for doing so, such as when either party resides in the United Kingdom.[142]

The rules also allow the courts to stay proceedings if there are proceedings currently pending in a court of another Convention state.[143] With regard to defendants domiciled outside the EEA, the Conventions do not apply and jurisdiction will generally be determined in accordance with traditional English rules.[144] A U.K. court will assert jurisdiction in any case

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135. *See* Brussels Convention on Jurisdiction and Enforcement of Judgments in Civil & Commercial Matters, Sept. 30, 1968, art. 8-11, 14, 1968 O.J. (L299) 32, *as amended by* 1978 O.J. (L 304/77) (assession of Greece), *as amended by* 1989 O.J. (L285) 1 (accession of Spain and Portugal), *reprinted in* 29 I.L.M. 1417, 1262 U.N.T.S. 153 [hereinafter 1968 Brussels Convention]; *see also* The Lugano Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, Sept, 16, 1988, art. 8-11, 14, 1988 O.J. (L319) 9, *reprinted in* 28 I.L.M. 620 (1989). The relationship between these two Conventions is regulated by article 54B of the Lugano Convention. *See id.* art. 54B.

136. Civil Jurisdiction & Judgments Act, 1982, ch. 27 (Eng.).

137. *See discussion supra* notes 135–136.

138. Civil Jurisdiction & Judgments Act, 1982, ch. 27 (Eng.).

139. *See id.*

140. *See id.*

141. *See id.*

142. *See, e.g.*, Fort Dodge Animal Health Ltd. v. Akzo Nobel NV, THE TIMES (London), Oct. 24, 1997 (Ch. Div. Oct. 16, 1997) (Eng.) (Laddie, J.).

143. *See* discussion *supra* note 135.

144. Civil Jurisdiction & Judgments Act, 1982, ch. 27 (Eng.); *see also* discussion *supra* note

where the court is the appropriate forum, notwithstanding that the alleged wrongdoing is committed abroad because, for example, the harm was sustained in the United Kingdom.[145]

D. Competent Courts

In the United Kingdom, disputes concerning copyright and claims for passing off may be heard by the County Court, but would more usually be heard by the High Court.[146] Proceedings for infrigement of registered trademarks must be brought in the High Court.[147] Contractual disputes may also be heard in the County Court or the High Court Queen's Bench Division. Appeals may be brought in the Court of Appeal and subsequently in the House of Lords.[148]

VIII. FURTHER INFORMATION AND NEW DEVELOPMENTS MAY SHAPE THE AVAILABILITY OF PUBLICITY RIGHTS IN THE U.K.

While the British Government does not have any plans to introduce a "publicity" law of the type found in the United States, the following changes are relevant to the way personalities are treated in this country.

A. The Human Rights Bill[149]

The Human Rights Bill was published on October 23, 1997 and, for the first time, will incorporate the European Convention on Human Rights[150] directly into British law. Individuals wishing to rely on the Convention will be able to take action in domestic courts, rather than having to go to the European Court of Human Rights in Strasbourg, France.[151]

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135. The jurisdiction of the Conventions only extends to the countries that are members of the European Economic Area.

145. *See generally* discussion *supra* note 142.

146. *See* 9(2) HALSBURY'S LAWS OF ENGLAND ¶ 417 (4th ed. 1998).

147. 48 HALSBURY'S LAWS OF ENGLAND ¶ 206 (4th ed. 1995); *see also* Bow v. Hart, 1 K.B. 592 (1905) (Eng.).

148. Appellate Jurisdiction Act, 1876, § 3(1) (Eng.).

149. Human Rights Bill, as approved by the House of Lords, 577 PARL. DEB., H.L. (5th ser.) 1726 (1997), introduced into the House of Commons, Feb. 6, 1998, 663 PARL. DEB., H.C. (5th ser.) 31 (1998), *available in United Kingdom Parliament* (visited Apr. 10, 1998) <http://www.parliament.the-stationery-office.co.uk/pa/cm199798/cmbills/119/1998119.htm> (on file with the *Loyola of Los Angeles Entertainment Law Journal*) [hereinafter Human Rights Bill].

150. *See* Frances Gibb, *The Human Rights Bill*, THE TIMES (London), Feb. 6, 1998, (Home News).

151. *See* Human Rights Bill, *supra* note 149, cl. 7 (providing that a person may bring a proceeding against the authority under the Act "in the appropriate court or tribunal").

As currently drafted, the Bill, when passed, will make it unlawful for any public authority, such as the Government, courts, and private bodies that perform public functions, to act in a way that is incompatible with the Convention.[152] Article 8 of the Convention provides for "a right to respect for his private and family life"[153] and states that (1) everyone has the right to respect for his family life, his home and his correspondence; (2) there shall be no interference by a public authority with the exercise of this right except such as in accordance with the law and is necessary in a democratic society in the interests of national security, public safety, or the economic well-being of the country, or for the prevention of disorder or crime, or the protection of health or morals or the rights and freedoms of others.[154]

Article 10 of the Convention provides for a right to freedom of expression against which the right to privacy will have to be balanced.[155] It will be for the courts to decide on a case-by-case basis how to interpret the existing law to ensure that basic human rights are not infringed. However, a declaration of "incompatibility" would almost certainly prompt the Government to change the law. The "right to privacy" will, therefore, be established on a case-by-case basis by judge-made law rather than by Parliament.[156]

There is currently some concern that the Bill may become a privacy law by default.[157] This result would occur if the Bill impinges on the freedom of the press or interferes with the decisions of the Press Complaints Commission.[158] Ministers are discussing the best way to amend the legislation so as to avoid such a result.[159]

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152. *See id.* cl. 6.

153. *See* European Convention on Human Rights, *available in* 15 HUM. RTS. L.J. 91, 98 (1994) [hereinafter European Convention].

154. *Id.*

155. *Id.* art. 10.

156. *See* Clare Dyer, *Privacy: The Media Take a Shot in the Dark; Britain is About to Gain a Right to Privacy; Will it Gag the Press?; That Depends Just How the Judges Enforce It*, GUARDIAN (London), Dec. 15, 1997, at 15.

157. *See* Michael White & Lucy Ward, *Straw Tries to Thwart 'Back Door' Tactics*, GUARDIAN (London), Feb. 17, 1998, at 3; Terry Waite, *Dangers of a Privacy Law*, DAILY MAIL (London), Dec. 15, 1997, at 13 ("Critics claim that the Bill to incorporate the European Convention on Human Rights into British law could usher in a privacy law by the back door.").

158. *See* Frances Gibb, *Court Doors 'Open for Privacy Cases,'* THE TIMES (London), Jan. 19, 1998, (Home News) (discussing the possibility that people will use the courts rather than the Press Complaints Commission to pursue privacy grievances).

159. *See Rights Bill Needs Further Revision*, THE TIMES (London), Jan. 27, 1998, (Features).

B. The Press Complaints Commission

The Press Complaints Commission ("PCC") is a self-regulatory body charged with enforcing its own Code of Practice,[160] a set of principles and guidelines framed by the newspaper and periodical industry and ratified by the PCC. Following the death of Diana, Princess of Wales, the PCC has amended the Code.[161] A new Code was published on December 19, 1997, and took effect on January 1, 1998.[162] Tighter provisions on privacy, harassment, intrusion into grief, children, and the public interest have been included.[163]

In particular, the new Code provides (1) for the first time that everyone is entitled to respect for his/her private and family life, home, health and correspondence;[164] (2) the use of long-lens photography to take pictures of people in private places without their consent is prohibited;[165] (3) the definition of "private place" has been extended to any "public or private property where there is a reasonable expectation of privacy;"[166] (4) for prohibition of journalists and photographers from obtaining, or seeking to obtain, information or pictures through intimidation, harassment, or persistent pursuit;[167] (5) individuals in private places may not be photographed without their consent;[168] (6) journalists must not interview or photograph children under the age of sixteen on subjects involving the welfare of any child without parental consent;[169] and (7) pupils must not be approached or photographed while at school.[170] While exceptions to the Code may be allowed where it is in the public interest, the fame, notoriety, or position of the child's parent or guardian would not alone be justification for publications.[171]

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160. PRESS COMPLAINTS COMMISSION CODE OF PRACTICE (1997) (on file with the *Loyola of Los Angeles Entertainment Law Journal*) [hereinafter CODE OF PRACTICE].

161. *See Press Watchdog Tightens Privacy Code*, DAILY MAIL (London), Sept. 26, 1997, at 2.

162. *See* Alison Boshoff, *New Code of Practice for the Press Unveiled*, DAILY TELEGRAPH (London), Dec. 19, 1997, at 17.

163. *See id.*

164. CODE OF PRACTICE art. 3(i).

165. *Id.* art. 3(ii).

166. *Id.*

167. *Id.* art. 4(i).

168. *Id.* art. 4(ii).

169. *Id.* art. 6(ii).

170. CODE OF PRACTICE art. 6(iii).

171. *Id.* art. 6(v).

Although a breach of the Code will not result in any financial penalty, the Code is taken very seriously by the industry. The PCC has expressed its confidence that editors and journalists will comply with the new provisions, which they believe are the toughest set of industry regulations in Europe.

IX. CONCLUSION

This Article has demonstrated the inadequacy of UK law to afford a right akin to a publicity right to personalities in the United Kingdom. The courts' traditional approach to trademarks in the *Elvis* case clearly fails to offer an appropriate level of protection. This is not a criticism of the decision in that case, which correctly preserves the true purpose of a trademark as a badge of origin. Similarly, the tort of passing off offers no protection to a personality against unauthorized merchandisers or others who, whilst commercially using the personality's persona, do not confuse the public as to the origin of the goods/services involved. Copyright is of little or no use. Defamation and breach of confidence are antiquated and ineffective remedies. The Advertising Codes provide no legal remedy. The Human Rights Bill is not intended to, and is unlikely to, resolve these concerns.

Given the commercial importance of endorsement and merchandising, and the aim to harmonize the laws across the European Union, it seems that there is a clear and obvious need for the creation of a new and distinct publicity right in the United Kingdom. A right available to all individuals to prevent their persona from being commercially exploited by unauthorized third parties—without the need to prove confusion or damage.

The adoption of such a new form of intellectual property right in the United Kingdom would afford an appropriate level of protection to a legitimate commercial interest of individuals in a straightforward and easily utilized manner. It would allow the courts to escape from their present dilemma of either clumsily (and somewhat unsuccessfully) adapting existing legal doctrine to protect these relatively new rights or affording them no protection at all.