

Guernsey Image Rights



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Introduction

Famous sportspeople, entertainers The Bailiwick of Guernsey, the small British Crown dependency in the English Channel known as an offshore tax haven, has achieved a 'world first' by establishing a unique registered image rights regime. This is a bold step for the tiny island, but are the new rights a useful tool for global personalities?

What can be registered?

The Image Rights (Bailiwick of Guernsey) Ordinance 2012, enables the registration of a personality and "images" associated with the personality.

A personality includes the personality of:

- Natural persons (either alive or who have died within the 100 years prior to the registration being filed);
- Legal persons (either existing or which have ceased to exist within the 100 years prior to the registration being filed);
- A "Joint Personality" (2 or more natural or legal persons who are intrinsically and publicly linked, eg Laurel and Hardy or Ant and Dec);
- A "Group" (2 or more natural or legal persons who are linked for a common purpose and together form a collective group or team, eg Coldplay or Manchester United), and note that the members of a Group can change; or
- A fictional character

"Images" which can be registered against the personality include not just images within their natural meaning (ie photos and illustrations), but also the personality's name(s), nick names, voice, signature, likeness, mannerisms or personal attributes, as well as film footage of the personality. Images can also include "distinctive characteristics" which we understand the registry has accepted might include a logo or shirt number, or artwork created by or associated with the personality.

What is protected?

The personality isn't protected per se, it is the "protected images" associated with the personality that are protected (but remember the wide definition of "image"). An image will be a protected image if it is distinctive and if it has actual or potential value. All registered images will be presumed to be distinctive and valuable, but other images will also be protected if they meet these criteria and crucially, an image will be distinctive if "it is recognised as being associated with the registered personality by a wide or relevant sector of the public in any part of the world."

Unlike trade marks, there is no requirement to register the images in relation to specified territories or particular goods or services: in essence the protection is universal (although see notes below re enforceability outside Guernsey). There is an option to limit the scope of a registration by territory and/or by goods and services, thereby allowing the original owner to carve up their assets, having different proprietors for different purposes.

Protection will continue for as long as the personality (and associated images) are registered, but renewals will be required every 10 years in the case of a personality and every 3 years in the case of an image.

Ownership and exploitation

The proprietor of the registered personality's image rights can be any person or entity that has the right to exploit the personality's image and who cannot be prevented from doing so by someone with prior rights (either under a prior registered image right or, for example, under trade mark law or the law of passing off). The proprietor may therefore be a celebrity themselves, their image rights company, the estate of a deceased star, or any other person or entity that has lawfully acquired the rights.

The registered personality's image rights are a form of property that can be exploited like any other. They can be licensed, assigned or used as security.

Infringement

A protected image is infringed if an image identical or similar to it is used without the proprietor's consent for "a commercial purpose or a financial or economic benefit". The use must create a likelihood of confusion or association with the registered personality, OR must take unfair advantage of, or be detrimental to the repute or economic value of the personality, without due cause.

A person is deemed to have "used" a protected image if, for example, they use it for: marketing or endorsing goods, services, activities or events; in connection with sponsorship; on business papers; or by affixing the image to goods or their packaging.



Importantly, there is no requirement of implied endorsement.

Exceptions

As expected there are a range of activities which will not constitute infringement including (amongst others): use of the personality in crowd shots where they are not singled out; in news reporting, commentary and satire; for education; in comparative advertising; and for the purposes of the arts.

There is also a defence which in some respects echoes the defence to trade mark infringement which allows use of a trade mark to indicate the characteristics of the goods or services. However the defence under the Guernsey image right is significantly narrower, only allowing use of an image “that is merely descriptive and used fairly and in good faith only to identify or describe something other than the [personality].” The legislation indicates that use to describe or identify “a place, a legacy or a style” would be acceptable. Presumably someone advertising a hotel in Edinburgh, Scotland would not then infringe an image right registered for Sean Connery by describing the city as “birth place of Sean Connery” along with other features of the city, but if they were to prominently use a picture of him, presumably this wouldn’t be “only” to describe the place and would not be considered “fair” use.

Comparisons to existing protections

Although celebrities are offered varying degrees of ‘personality rights’ in many US states and protection is high in several European jurisdictions, none offer a registered regime.

Under English law, no specific personality rights exist. Celebrities regularly rely on defamation, privacy, trade marks and the tort of passing off to protect their commercial rights, and under the UK Code of Broadcast Advertising, the use of living persons in television adverts without permission is controlled. There are however a number of situations (particularly where there is no suggestion of endorsement, no invasion of privacy, and no trade mark has been registered)

in which businesses are still able to ‘exploit’ the goodwill in a celebrity without compensating them. This was reiterated in the recent action brought by Rihanna in the English courts for unauthorised use of her image on t-shirts by Topshop. The Judge concluded that, due to Topshop’s prior promotional activities involving Rihanna, her status as a style icon and fashion designer/endorser, and the nature of the image used, at least some Topshop customers would have been deceived into believing the t-shirts were endorsed by Rihanna. She therefore succeeded in her claim for passing off. However, the Judge made clear that there is no freestanding image right in England and in many circumstances, the use of a celebrity’s image on merchandise would not amount to passing off.

Another example where it seems the English law offers limited protection, would be the use of an athlete’s image in an online advertisement promoting a betting company and the odds you can get on that athlete winning a race or scoring a goal etc.

The Guernsey right is very young and it is unclear how the exceptions will be interpreted but it seems that the intention is that the use of protected images on merchandise would infringe, without the need to show that there is any misrepresentation as to the product being endorsed or official. And while a betting company may be able to argue the factual use of an athlete’s name in relation to quoting odds is only descriptive and done fairly, in good faith, could they say the same about use of a picture of the athlete?

Remedies and enforceability

It seems likely that the courts of Guernsey will accept jurisdiction if there is actual use of a registered image in Guernsey. UK based businesses with outlets in, or which distribute to, and/or advertise in Guernsey will therefore need to be aware of the consequences of the new rights. Broadcasters within Guernsey (and the businesses that advertise on their channels) will also need to be alert. And of course, any online activities (unless geo-blocked) have the potential to be viewed, and therefore infringe, in Guernsey. Given the practical challenges of geo-blocking an area

like Guernsey, this is possibly the most difficult type of infringement for a business to avoid.

It’s unclear how damages will be assessed but at no time does the Act limit its scope to the Bailiwick and therefore a court may assess damages with a global outlook. It also has the right to consider the “flagrancy of the infringement” and can award “additional damages as the justice of the case may require”.

There is also the question of how to enforce any Guernsey judgment (assuming that it’s unlikely the infringer will go out of their way to go to Guernsey). Reciprocal enforcement legislation in the UK should mean that Guernsey judgments are enforced by UK courts. And if you obtain an injunction against an infringing party in Guernsey and have this ratified in the UK then they could potentially be held in contempt of court in the UK, if they continue to infringe in Guernsey.

Conclusion

Although there are still question marks over enforceability and the extent of damages likely to be awarded, it is clear that registering image rights could usefully provide greater certainty when licensing or assigning rights, or when succession planning. And, as a minimum, registering image rights in Guernsey could prove to be a useful deterrent, particularly with respect to businesses operating across the UK and the Channel Islands in cases where English law does not currently prevent use due to lack of implied endorsement.

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