SWIMMERS, SURFERS, AND SUE SMITH
PERSONALITY RIGHTS IN AUSTRALIA[1]

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It is somewhat of a misnomer to talk about personality rights in Australia. First, personality rights are not "rights" in the sense of positive rights, a right to do something, or in the sense of proprietary rights, property that can be assigned or mortgaged.
Second, personality rights are largely a US law concept, derived from US state law relating to the "right of publicity".

However, it is common commercial practice that Australian performers, actors and sportstars enter endorsement or sponsorship agreements.[3] In addition, the Australian Media and Entertainment Arts Alliance, the Australian actors union, insists that the film and television industrial agreements and awards don't cover merchandising and insist film and television producers enter individual agreements if they want to use an actor's image in merchandising.[4] This paper considers Australian law[5] relating to defamation, passing off, and section 52 of the Trade Practices Act,[6] draws parallels with US law relating to the right of publicity, and considers whether there is a developing Australian jurisprudence of "personality rights".

Protecting Personality

Acknowledging and protecting personality rights protects privacy. But protecting privacy is not the focus and is an unintended incidental. Protecting personality rights protects investment, and has more in common with unfair competition than privacy. Acknowledging and protecting personality rights protects investment in creating and maintaining a carefully manicured public image, an investment of time labour, skill and cash. This includes spin doctors and personal trainers and make-up artists and plastic surgeons and making sure some stories never get into the press.

Image management investment is critical in creative content based industries. The opportunities offered to performers, and the success of any film or play or band in which they perform, are often driven by how the public perceives the performer.

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[1] The title is a reference to leading cases in this area, namely swimmers (Kieren Perkins - Talmax Pty Ltd Telstra Corporation Ltd 1996 36 IPR 46; Tracey Wickham - Wickam v Association of Pool Builders 1988 12 IPR 567) surfers (Downing v Abercrombie and Fitch 13/9/2001 9th circuit) and Sue Smith (Shoshana Pty Ltd v 10th Cantanae Pty Ltd 1987 11 IPR 249)

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[3] In South Australian Brewing Company Pty Ltd v Carlton & United Breweries Ltd [2001] FCA 994 13/7/2001, Mansfield J noted that CUB had entered "sponsorship agreements" with the club captains of Adelaide Crows Football Club and Port Adelaide Power Football Club to use their images in CUB's "Showdown" promotional advertising

[4] see for example certified agreement MEAA / Fox Studios Australia – Employees Agreement 1999 clause 8.4(f)

[5] see further McMullan J "Personality Rights in Australia" (1997) 8 AIPJ 86; Sugden P "Protection of Identity Against Inappropriate Use (1998) 18 QldLawyer 155; Alderson, M "Privacy and publicity - whose life is it anyway?" (1996) 9 IPLB 110; Crennan S M "Commercial Exploitation of Personality" (1995) 8 IPLB 129; Howell "Personality Rights: A Canadian Perspective: Some Comparisons with Australia" 1990 1 Intellectual Property Journal 112; Ralston, S "Australian Celebrity Endorsements: the Need for an Australian Right of Publicity" Communications Law Bulletin, Vol 20, No 4 2001

[6] Trade Practices Act 1974 (Cth)

Increasingly however, the image itself is the product – the image is used to endorse commercial products or services. The performer does not have to act or sing or play basketball, they just have to stand there. Performer becomes celebrity, then star, then icon.

In Pacific Dunlop v Hogan[7], Justice Burchett described the appeal of a celebrity's image in this way

> "Character merchandising through television advertisements should not be seen as setting off a logical train of thought in the minds of television viewers. Its appeal is nothing like the insistence of a logical argument on behalf of a product, which may persuade, but also may repel. An association of some desirable character with the product proceeds more subtly to foster favourable inclination towards it, a good feeling about it, an emotional attachment to it. No logic tells the consumer that boots are better because Crocodile Dundee wears them for a few seconds on the screen ……but the boots are better in his eyes, worn by his idol."

However, the very reason that the image is effective to endorse or sell the product is because that image has become absorbed into our individual consciousness. The image is trusted and familiar. The image has also acquired separate meaning – the image and all it stands for has become commoditised and part of our cultural landscape. Consider Andy Warhol's lithographs of Marilyn Monroe and Elvis Presley lithographs. Andy Warhol and later Jeff Koons asks the question – are these individuals or have they become ciphers, shorthand signs for meaning, and public commodities. And if they have succeeded in becoming absorbed into our individual consciousness, should they then be entitled to exploit it? Every time I hear Abba songs brings back memories of dancing in front of the mirror using a hairbrush as a microphone. That memory, that feeling, has been created by me and belongs to me. Should Abba be entitled to exploit that feeling?

Passing Off

The tort of passing off protects a person's business, particularly its goodwill and reputation. The basis of the cause of action lies squarely in misrepresentation, for its underlying rationale is to prevent commercial dishonesty. [8]

The key elements[9] are:

- that a person has an established reputation or goodwill;
- there is a misrepresentation
- the misrepresentation causes damage

Historically, the tort of passing off protected a trader from another trader using the first trader's reputation by misrepresenting the other trader's goods as being the first trader's goods, "passing off" the other trader's goods as the first trader's goods In Henderson's case,[10] passing off was extended to protect a person who was not a trade in the traditional sense. In that case, a record label used a photograph of two prominent professional ballroom dancers on the front cover of the record album. The NSW Supreme Court held that there was a misrepresentation of an association between the ballroom dancers and the record, even though the ballroom dancers were not in the business of endorsing records.

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[7] Pacific Dunlop Ltd v Hogan (1989) 23 FCR 553
[8] ConAgra v McCain Foods (Aust) Pty Ltd 1992 23 IPR 193
[9] Reddaway v Banham 1896 AC 1999;
[10] Henderson v Radio Corp Pty Ltd 1960 SR (NSW) 576

However, there needs to be a misrepresentation of a commercial connection or some sort of association to succeed in passing off – misappropriation of reputation is not enough.[11] This means that it will not be useful in circumstances where it is clear there is no connection such as where there is a reasonably prominent, credible disclaimer of any consent,[12] or where it is just plain unlikely that there is a commercial connection. For example, in the Tabasco case,[13] Lehane J considered that it was unlikely that a person seeking an exhibition design service in Australia would wonder whether Tabasco Design had **a** commercial connection of some sort with the US based maker maker of the only product known as "Tabasco", a spicy and hot sauce. "The far more likely conclusion is, I think, that, without any association or permission the designer has - as the fact is - perhaps cheekily, used a name which, by reference to its only other known use, conjures up "hot" associations."

The courts have sometimes struggled to find a misrepresentation, and have sometimes resorted[14] to a circular legal fiction. The fiction is that members of the public assume that if an image of a person is used, there must be a commercial connection. This assumption is based in part on the fact that the public are aware of cases which provide that a person has to consent to their image being used. These cases are based in part on the assumption that if an image of a person is used, that there must be a commercial connection. And so on

Section 52 of the Trade Practices Act

Section 52 of the Trade Practices Act covers much of the same ground as passing off and has also been used to protect personality rights. The key elements are

- a corporation[15]
- in the course of trade or commerce
- engages in conduct that is misleading or deceptive or likely to mislead or deceive

The key issues are[16]

- whether misconceptions can properly be attributed to the ordinary or reasonable members of the classes of prospective purchasers, disregarding assumptions made by persons whose reactions are extreme or fanciful*;* and

- whether the misconception was attributable to the respondent rather than a person's own erroneous assumption which is not attributable to the respondent

It is sufficient that the conduct is likely to mislead members of the public into thinking that the respondent's product was in *some way* promoted or distributed or associated with the applicant, that there was some form of association, provided that it is beyond mere wonderment.

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[11] McIlhenny Co v Blue Yonder Holdings Pty Ltd 1997 39 IPR 187 ; see further McCabe B "When Trading Off Reputation of Others is Not Misleading or Deceptive" (1998) 6 TPLJ 51

[12] Twentieth Century Fox Film Corporation v The South Australian Brewing Co Ltd (1996) 34 IPR 225 ("**Duff Beer**" case)

[13] supra n15

[14] Hogan v Koala Dundee Pty Ltd (1988) 20 FCR 314; Hogan v Pacific Dunlop Ltd (1988) 83 ALR 403; (1989) FCR 553.

[15] If the protagonist is not a corporation, the conduct may still be subject to section 52 if it occurs within a territory, or the conduct involves the use of postal, telegraphic or telephonic services or takes place in a radio or television broadcast – section 6 TPA.

[16] Campomar Sociedad, Limitada v Nike International Limited 2000 46 IPR 481; Mark Foys Pty Ltd v TVSN (Pacific) Ltd 2000 49 IPR 303

If a person uses another person's image or identifying features without that other person's permission, the relevant misconception is that the other person endorses or is otherwise associated with the first person.

In some ways, section 52 is wider in scope than passing off in that it is not strictly necessary to establish reputation. However, it is difficult for a person to establish that the conduct is misleading and deceptive unless the person is sufficiently famous that the public would assume that the person would license the use of their image, so that the use of their image suggests that a licence in fact exists

Australian Cases Relating to Images

Apart from the Henderson highlight, in the early Australian passing off and section 52 cases, the courts did not restrain the use of images of people used without their consent. However, the decisions reveal the court's developing awareness of the practice of image licensing, and many of the cases where the applicant was unsuccessful can be distinguished on their facts.

In *Olivia Newtown-John's* case,[17] the performer Newtown-John unsuccessfully sought an injunction to stop a Maybelline cosmetics ad using a look-a-like model and the phrase "Olivia? No. Maybelline" The Federal Court held that the public may have the impression that Maybelline had used Newtown-John's reputation to gain attention but not to suggest any commercial connection, particularly as the words used were effectively a disclaimer.

In *Sue Smith's case*[18], the television journalist Smith unsuccessfully sought to prevent the use of her name to advertise televisions. The Full Federal Court held that the applicant failed to establish that readers would consider the reference to be a reference to the journalist Ms Smith as "Sue Smith" is a common name, and the model did not look like the journalist Ms Smith. However, Wilcox J noted that advertisers pay fees to well-known personalities in return for the right to use their names and photographs in advertisements.

In *Tracey Wickham's* case[19], the swimmer Wickham unsuccessfully tried to prevent the use of her name and photo to exploit swimming pools. The court said that there was no common field of activity, since Ms Wickham had no trade or business in swimming pools. This case is difficult to reconcile with the later Kieren Perkins case, and must be read in light of the fact that the balance of Australian authority rejects the common field of activity test.[20]

In *Gary Honey's case*,[21] Australian Airlines published a photo of the athlete Honey on an Australian Airlines poster to promote sport. Australian Airlines then gave a religious organization the right to use the photo on the cover of a Christian inspirational book. The Federal Court dismissed the claim against Australian Airlines as Honey was unable to establish that the poster was being used to promote Australian Airlines as opposed to being used to promote sport generally. The court also dismissed the claim against the religious publisher because, on the facts, it was "most unlikely" that the books' readers would think there was any connection between Honey and the religious publisher. Notably, there was evidence that the use of the image would not have stimulated sales because the book was only

[17] Newtown-John v Scholl-Plough (Aust) Ltd 1986 11 FCR 233
[18] Shoshana Pty Ltd v 10th Cantanae Pty Ltd 1987 11 IPR 249
[19] Wickham v Association of Pool Builders 1988 12 IPR 567
[20] Campomar Sociedad, Limitada v **Nike** International Limited 2000 46 IPR 481; see also Lahore "Patents, Trademarks and Related Rights" Butterworths, looseleaf [77,030] – [77,100]; McKeough and Stewart "Intellectual Property in Australia" Butterworths 1997 [17.18] - [17.19]
[21] Honey v Australian Airlines Ltd and House of Tabor Inc (1990) 18 IPR 185

supplied to current subscribers. This is in contrast to situations where the photo on the front cover of a magazine may significantly affect sales.

In *Kieren Perkins* case,[22] the Queensland Court of Appeal reversed the trial judge and granted an injunction against Telstra using Kieren Perkins name and image in a Telstra advertising supplement in Brisbane's "Courier-Mail" during the Optus / Telstra subscription ballot. This was on the basis that the "ordinary reader would have gained the impression that Mr Perkins supported [Telstra] in the "pre-selection process" by [Telstra's] use of its association with Perkins" particularly as this impression was the purpose of using the image, and the ordinary reader would have gained an impression that Perkins gave Telstra his consent to what was published. The publication misrepresented that Perkins was sponsored by Telstra, had consented to Telstra's use of his name, image and reputation in its advertising, and supported Telstra in the forthcoming preselection process.

These cases suggest that a person is more likely succeed the more commercial the context, and the more likely that the person, or the category of person, has a practice of endorsing such businesses, goods or services. This is because it is more likely that the court considers that the public would assume that there would be some commercial arrangement in place.

Defamation

The Defamation Act 1974 (NSW) provides that a person has a cause of action against another if[23]

- the other publishes a statement which makes an imputation which is defamatory of a person,[24] that is, that the statement is likely to cause the ordinary reasonable member of the community to think less of a person or to shun or avoid a person; and

- the person is identified as the subject of the statement.

The threat of a defamation claim may discourage the use of an image where a person's image is vulnerable to damage if it is associated with unsavoury goods or services. It could be argued that the publication of the image is an imputation that the person is the kind of person who would endorse such unsavoury products or services, and this is a defamatory imputation because members of the community would think less of the person.

This was the analysis used in *Ettingshausen*[25] – the plaintiff footballer argued that publishing a photograph of him naked in the shower raised an imputation that he was the type of person who would consent to having his photo taken while he was naked in the shower and who would consent to such photo being published in a magazine, and that ordinary reasonable members of the community would think less of him if they thought he was that type of person.

Defamation may also assist where a person's image is vulnerable to damage by being associated with *any* goods or services.

This was the analysis used in the English case Tolley v Fry.[26] Tolley was an amateur golfer. Fry used a cartoon likeness of Tolley with Fry's chocolate in his back pocket to promote the chocolate. This was found to be defamatory in that it raised an imputation that Tolley had

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[22] Talmax Pty Ltd v Telstra Corporation Ltd (1996) 36 IPR 46

[23] see further Tobin and Sexton "Australian Defamation Law and Practice" Butterworths, looseleaf service

[24] section 9 Defamation Act 1974 (NSW)

[25] Ettingshausen v Australian Consolidated Press (1991) 23 NSWLR 443

[26] Tolley v Fry [1931] AC 333.

been paid for the endorsement, and this was defamatory because Tolley had publicly held himself out to be an amateur golfer. This reasoning can be used to discourage the use of images of persons who have held themselves out as being impartial or independent, where the use of the image in association with certain goods or services makes an imputation that the person prefers those goods or services over other goods or services

However, both these cases rely on the circular legal fiction that if an image is used the public will assume that the person consented, because the public is aware of law that require that a person's image can only be used with consent. In addition, this analysis does not assist if it is made clear that the person did not consent.

Second, defamation only assists where a person's reputation is adversely affected. It does not prevent anyone exploiting a person's image in circumstances where there is no defamatory imputation because ordinary reasonable members of the community would not think less of the person from the other person's exploitation of the image. For example, it would not prevent a person using the image to endorse innocuous goods and services where the person has not held themselves out as eschewing endorsements

Third, defamation does not provide or protect any positive right for a person to enter tino agreements to exploit their own persona.

Fourth, defamation only applies during a person's life.

Tort of Invasion of Privacy

Privacy protects different interests from the interests protected by personality rights. An infringement of a person's personality rights deprives the person of the opportunity to commercially exploit their name or likeness for their own benefit, and causes financial loss. In contrast, a person's right to privacy protects the person's personal autonomy, seclusion from surveillance, and protects a person from intrusive behaviour which causes humiliation or personal distress.

There is no general right of privacy in Australia.[27] The interests protected by privacy are approximately protected by the equitable action for breach of confidence. In order to bring a claim for breach of confidence, it is necessary to establish first that the material is confidential and second, that there is a relationship of confidence, or the material has been improperly or surreptitiously obtained such as obtained by a trespasser. The difficulty is that a person may not be able to bring an action for breach of confidence even if the person is in a private context, on private property or in a private forum, because simple photographs or footage of a person without anything more may not possess the "necessary quality of confidence."

In a number of cases the court has suggested that an injunction may be available to prevent publication or broadcast of a photograph or film even if the information is not confidential. In some cases, the producer was a trespasser on private premises.[28] Other cases involved police officers abusing coercive powers by filming while executing a search warrant for purposes unrelated to investigation and prosecution of the crime, in circumstances where the broadcaster was a knowing participant[29] These cases have been explained on the basis that the producer is breaching the plaintiff's rights by trespassing, and the broadcaster or publisher is participating in the breach, or because the producer becomes a constructive trustee of the copyright in the film / photograph and publishing or broadcasting it would infringe the

[27] Victoria Park Racing and Recreation Grounds Co Ltd v Taylor (1937) 58 CLR 479

[28] Lincoln Hunt Australia Pty Ltd v Willesee (1986) 4 NSWLR 457; Emcorp Pty Ltd v Australian Broadcasting Corporation (1988) 2 Qd R 169

[29] Donnelly v Amalgamated Television Services Pty Ltd (1998) 45 NSWLR 570

plaintiff's equitable interest in copyright[30]. However, a broadcaster or publisher may not be restrained if they did not participate in the breach[31].

In addition, there were comments in a recent English breach of confidence case that the courts may explicitly recognise a right of privacy, and such protection may be in circumstances where the invasion of privacy does not cause humiliation or personal distress, but merely a risk of frustrating commercial arrangements. In *Douglas v Hello*,[32] Michael Douglas and Catherine Zeta Jones arranged that OK Magazine would have exclusive rights to their wedding photographs, and sought an interlocutory injunction against Hello Magazine publishing wedding photographs. The Court of Appeal said that the couple had an arguable claim for breach of confidence and maybe a cause of action for invasion of privacy, on the basis that English law will now recognise and protect unwanted intrusion into personal lives.

This case was considered by the Australian High Court in *ABC v Lenah Game Meats Pty Ltd.*[33] The court considered that it did not need to decide the question, particularly as the relevant party was a company rather than an individual. However, Gummow and Hayne JJ noted that

> "Whatever development may take place in that field will be to the benefit of natural, not artificial, persons. It may be that development is best achieved by looking across the range of already established legal and equitable wrongs. On the other hand, in some respects these may be seen as representing species of a genus, being a principle protecting the interests of the individual in leading, to some reasonable extent, a secluded and private life, in the words of the *Restatement*, "free from the prying eyes, ears and publications of others". Nothing said in these reasons should be understood as foreclosing any such debate or as indicating any particular outcome. Nor, as already has been pointed out, should the decision in *Victoria Park*. [34]

The recognition of a right of privacy in Australia will provide a way of protecting personality rights. However, because the interests protected by privacy are not the same as the interests protected by personality rights, the relief may not reflect the person's loss, that is the loss of opportunity to exploit their image.

Right of Publicity[35]

The "right of publicity" which exists in various states of the United States prohibits the unauthorised use of a person's name, voice, signature, photograph or likeness in advertising

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[30] Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd (2001) HCA 63 15 November 2001 para 101 – 103 per Gummow and Hayne JJ

[31] Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd 2001 HCA 63

[32] Douglas v Hello Magazine [2001] 2 WLR 289

[33] Australian Broadcasting Corporation v Lenah Game Meats Pty Ltd supra n 31

[34] ibid para 132

[35] see further Frackman R F and Bloomfield TC "The Right of Publicity – Going To The Dogs" September 1996 The UCLA Online Institute for Cyberspace Law and Policy http://www.gseis.ucla.edu/iclp/rftb.html; Barnett Stephen "A Critical Examination of the California Supreme Court's Decision in Comedy III Productions Inc v Saderup " Jurisnotes.com 17/5/2001 http://www.jurisnotes.com/articles/barnett05172001.htm; Smith, J M "Toot, Toot, Tootsie, Don't Cry, a Legal Analysis of the District Court's Opinion in Hoffman v. Los Angeles Magazine", Libel Defense Resource Center Newsletter, March, 1999, page 49; Smith J M "Ninth Circuit Permits Right of Publicity to trump First Amendment", Libel Defense Resource Center Newsletter, October 2001, page 15; Volokh, E "Freedom of Speech and Information Privacy: The Troubling Implications of a Right to Stop People From Speaking About You" (2000) 52 Stanford L Rev 1049

or products, merchandise or goods. It is a right created by state law, so it varies between states and is not part of the law of each state. However, the right appears in the Restatement (Third) of Unfair Competition,[36] and is recognised in at least 25 states, notably in New York[37] and California.[38] It is not pre-empted by federal copyright law, even if involves a copyright work, to the extent that the claim relates to the person's name or likeness incorporated in a work, rather than rights of copyright in the work itself.[39]

However, the right of publicity cannot restrict the communication of facts, so most state laws have exceptions for reporting news or commentary or incidental related advertising,[40] even if sold in commerce or trade.

In addition, the right of publicity is subject to the First Amendment right of free speech. Three recent cases have considered the balance between the right of publicity and the First Amendment.

In the *Three Stooges case*,[41] the Californian Supreme Court acknowledged that a person has the right under Californian law to stop others misappropriating the economic value generated by their fame. However, this right cannot be used to "control the celebrity's image by censoring disagreeable portrayals" or to control transformative expression. The case involved an artist who made charcoal drawings of the Three Stooges and sold them on lithographs and on t-shirts. He made $75,000 profit. The company which controls Three Stooges' images sued for breaching the Three Stooges right of publicity. The artist argued free speech. The court held that the right of publicity was subject to the right of free speech and said that "celebrities take on public meaning" so that "appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values". However, the court would only consider it protected by free speech if the artist had added significant creative elements to the likenesses, if there was a "transformative" use of the work, so that it had become primarily Saderup's expression.[42] It would not be protected by free speech if it was mere reproduction of the images

In the *Tootsie* case,[43] LA Magazine used computer technology to alter famous film stills to make it appear as if the actors were wearing Spring 1997 fashions. In particular, Dustin Hoffman's "Tootsie" character was remodelled to wear a Richard Tyler dress and Ralph Lauren shoes. The District Court (9th circuit) considered there was a fine line between non-commercial and commercial speech, but the core of commercial speech is that it does no more

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36 Restatement (Third) of Unfair Competition § 46 (Tentative Draft No.4, 1993) "One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability"

37 New York Civil Rights Law Article 5 Right of Privacy, § 50 "A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor."

38 California Civil Code § 3344(a) (previously Civil Code § 990) "Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof."

39 Zacchini v Scripps-Howard Broadcasting Co (1977) 433 US 562 (US Supreme Court); Downing v Abercrombie and Fitch 9th circuit 13/9/2001

40 for example California Civil Code § 3344(d) "…a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required.."

41 Comedy III Productions Inc v Gary Saderup Inc 21 P.3d 797 30/4/2001 Californian Supreme Court

42 This is a cross-application of the first fair dealing factor in s107 of the US Copyright Act 1976

43 Hoffman v L A Magazine 255 F 3d 1180 (9th cir. 2001)

than propose a commercial transaction. Hoffman's image was not used in a traditional advertisement printed merely for the purpose of selling a particular product, and it was not enough that Ralph Lauren advertised elsewhere in the magazine or that the dress and shoes were referred to in the magazine's "shoppers guide". "Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors"

In the *Surfer's case*,[44] the District Court (9th circuit) considered that the First Amendment defence is available if the publication deals with a matter in the public interest. However, there needs to be a link with the matter of public interest. Abercrombie and Fitch is an "upscale" retailer who published a subscription clothes catalogue which had a surfing theme and significant editorial relating to surf culture including a commissioned story relating to a famous Californian surfing beach. Following this article was a photograph of famous surfers taken at the beach in a 1965 surf championship. The catalogue offered t-shirts for sale similar to the surfer's t-shirts elsewhere in the catalogue. The court agreed that surfing and surf culture qualify as matters of public interest. However, there was only a tenuous link between the photograph and the surfing theme, and the use of the photograph was more commercial than the use of Hoffman's image in L A Magazine.

Parallels with Australian Law

First, the "right of publicity" is subject to exceptions for communication of facts and subject to the First Amendment right of free speech. There are no such balancing factors in passing off and s52 TPA. However, if an image is used in Australia for the communication of facts, or in a transformative work, or reporting news, it is less likely that the public would assume that there was some commercial connection or association between the user of the image and the image, so the court is less likely to find misleading and deceptive conduct or misrepresentation.

Second, s52 TPA and the "right of publicity" require a trade or commerce context. In addition, there is more likely to be passing off in image cases where there is a commercial context, because the public are more likely to assume that the person would have licensed the use of their image if there is a commercial context. The US cases largely relate to merchandising. However, one American professor[45] noted that the Three Stooges case may have "quietly rubbed out" the requirement of use for a commercial purpose in the sense of merchandising because the court did not require that the image was used in advertising or "on or in products" as required by the Californian code, because the court characterized the lithographs themselves as the products. He considered that this would mean that the mere sale of photographs would itself be enjoined by the right of publicity, rather than the right of publicity only covering images when they are *applied* to objects or used in advertising.

Third, the US state law does not require a misrepresentation or misleading and deceptive conduct – misappropriation of reputation is sufficient. In contrast, misappropriation is not sufficient in Australian law for passing off[46] or section 52.

Fourth, the US has laws which correspond to Australian s 52 / passing off law such as s43 (a) of the Lanham Act. The US also has defamation law. However, unlike Australia, the US has the tort of unfair competition,[47] and also has privacy laws[48] These complement and are in addition to the US state law right of publicity.

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[44] Downing v Abercrombie and Fitch 2001 WL 1045646(9th cir. 2001) 13/9/2001
[45] Professor Barnett, UC (Berkeley) supra n 5
[46] McIlhenny Co v Blue Yonder Holdings Pty Ltd 1997 39 IPR 187
[47] Moorgate Tobacco Co Ltd v Phillip Morris Ltd 1984 56 ALR 193

Risk Areas

The foregoing analysis indicates that there are four circumstances where a person's image or other identifying features should not be used without permission.

First, where using the image may constitute a misrepresentation that the other person has some sort of connection or association. Risk factors include:

- if the image or other identifying features are used in a commercial context, such as to advertise commercially available goods and services

- where the person has a practice of endorsing or associating themselves with a product or service for a fee, or belongs to a category of persons (such as actors or sportstars) who have a practice of endorsing or associating themselves with a product or service for a fee

- where there is a practice of the particular goods and services being endorsed or associated with a person for a fee, or where the goods and services belong to a category of goods and persons where there is a practice of such goods and services being endorsed or associated with a person for a fee

Second, where there is a binding agreement already in place between the parties which prohibits the other person's image or identifying features being used, or prohibits the image or identifying features being used unless a further fee is paid. This would include individual agreements as well as applicable industry wide agreements such as certified industrial agreements or awards.

Third, where it is intended to use the advertisement or exploit the product or service using the image and identifying features in Australia AND outside Australia which include jurisdictions where a person has a right of publicity.

Fourth, where it is a relatively famous person's image or other identifying features, and the person or their estate have Californian entertainment lawyers. You can attempt to explain to them that Californian laws do not apply in Australia. They will not listen. Why buy into a problem?

Personality Agreements

If a person wishes to use another person's image or identifying features, the person should enter into a written agreement with the other person or the person who controls the other person's image or identifying features. The agreement should confirm the scope of the use. This should include that the person has the right to use and exploit the other person's name, voice, signature, likeness, and sobriquet in relation to any merchandising, in any and all media, throughout the world, at no further cost.

The agreement may also include provisions which ensure that the other person does not do or omit to do anything which would damage the value of the rights that they have granted. For example, there may be a clause that the person must maintain a certain polished public image,

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[48] Second Restatement of the Law, Torts s652A "One who invades the right of privacy of another is subject to liability for the resulting to the interests of the other"

must maintain a discreet private life,[49] and must refrain from associating themselves with other products or services, or at least products or services which are competitive products or services.

The other person may limit the grant of rights. First, they may refuse to be associated with cigarette or alcohol or pornographic material.

Second, they person may request a right to approve any photographs and/or likenesses used, or the entire advertising campaign. The person using the image should ensure that the right of approval cannot be used to frustrate the grant of rights. In particular, they should ensure that the agreement provides that the person must approve a reasonable number of photographs and/or likenesses, and must approve within a reasonable period of time.

Third, the person may limit the grant of rights to particular territories. This is because it may damage their public image as a person "on the way up" if they are used in advertising campaigns, so they may only agree if the advertising is not used in the US or Australia.

Fourth, they may request a re-use fee rather than a flat payment, based on the number of times the advertisement is used. They may also request a profit share from the revenue generated from the endorsement.

The agreement should also include provisions about termination of the agreement and consequences of termination. It is important to negotiate and finalise termination arrangements at the beginning, when everyone is still keen to do business with each other, rather than at the time of termination when parties may be bitter and vindictive.

Importantly, the agreement should provide that the person using the image has no obligation to use the image or identifying features of the other person and exclude any liability for loss of publicity or loss of opportunity to enhance reputation or economic loss. This is because the other person may be relying on the endorsement to raise their public profile. In addition, the other person's image may be damaged if the endorsement is not used as it may send a signal to the industry that they are no longer "marketable" or they are "difficult". The person using the image should not be responsible for any of the other person's loss arising from these innuendos.

And now for something completely different …

Public personalities can become part of our cultural landscape. And yet sometimes a public personality can become so much a part of our cultural landscape that they take on a new meaning. The original person becomes a mere historical curiousity. In the Chifley case,[50] the registered owner of the mark relating to Chifley Tower at 2 Chifley Square, Sydney tried to stop someone using the word Chifley in relation to motels, in part arguing that it was trading off Chifley Tower's reputation. The applicant's evidence included that it targeted the exclusive end of the corporate and commercial markets when seeking tenants; advertised itself as offering superior accommodation, elegance and power; housed one of Sydney's finest restaurants; and the object of its advertising was to create an upper class image, almost a luxury image.

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[49] It was reported that Nike would be entitled to terminate its endorsement agreement with Wayne Carey, ex-captain of the AFL Kangaroos on the basis of a morality clause in the endorsement agreement "Scandal may be end of the Roo Boy deal" The Age 15 March 2002

[50] Australian Tourism Co Ltd v Mid Sydney Pty Ltd (1999) AIPC ¦91-452

Ironic really since the tower was named after Ben Chifley, the train driver who became one of the most respected yet most humble of Australian prime ministers. In the Chifley Square forecourt there is a sculpture of Chifley and the key words of his “light on the hill” address

> "I try to think of the Labour movement, not as putting an extra sixpence into somebody's pocket, or making somebody Prime Minister or Premier, but as a movement bringing something better to the people, better standards of living, greater happiness to the mass of the people. We have a great objective - the light on the hill - which we aim to reach by working the betterment of mankind not only here but anywhere we may give a helping hand." [51]

Luxury, elegance and power indeed.....

[51] D B Chifley Address to the NSW Labour Party Conference 12/6/1949 available at http://www.alp.org.au/about/light_on_hill.html