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Putting a Face to the Game: The Intellectual Property Implications of Using Celebrity Likenesses in Videogames

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The article

Licensing deals between videogame developers and celebrities for the use of the latter's likenesses in the former's products are becoming increasingly commonplace. These are activities that would be governed by the law relating to the 'right of publicity' in the US and by the law relating to the 'right of personality' in various continental European jurisdictions. However, no equivalent legal framework exists in the UK.

This article considers the extent to which the relevant intellectual property frameworks in the UK prohibit or permit the unauthorised use of celebrity likenesses in videogames, in particular copyright law, the law of passing off, and trade mark law.

The article concludes that, given recent developments within the law of passing off and the law of trade mark, it may no longer be untenable to suggest that such uses could be caught by these two legal regimes. In doing so, it also highlights how far the ambit of these two regimes has expanded in recent decades.

Introduction

Videogames have come a long way since the early days of Spacewar! and Pong. Nowhere has the march of technology been more evident than in their visual displays. Contemporary big-budget videogames are capable of rendering environments, objects and characters at tremendously high levels of detail and realism – a stark contrast to the flat backgrounds and simple shapes of their early predecessors. Among other things, these technological advances have enabled videogame developers to depict likenesses of individuals with an increasing degree of fidelity. It is now not uncommon to see videogame characters bearing the likenesses of well-known celebrities: the latest entry in Electronic Arts' FIFA football game series depicts players from the Premier League, the Bundesliga, Serie A and some 30 other leagues in almost photo-realistic detail; music rhythm games such as Guitar Hero and Rock Band feature highly recognisable – though somewhat stylised – depictions of well-known musicians.

Because of this, licensing deals between videogame developers and celebrities for the use of the latter's name and likeness are now commonplace. This has become an increasingly lucrative revenue stream for celebrities: in 2015, reality television personality Kim Kardashian was estimated to have received a net revenue of USD 20 million – or 45% of the total profits – from the mobile game Kim Kardashian: Hollywood, which, as the name suggests, prominently features a character who bears her likeness.¹ At the other end of the spectrum, videogame developers who have chosen not to secure licences for their use of the likenesses of well-known figures have increasingly found themselves the subject of legal action. Most recently, a group of retired National Football League players succeeded in their suit against Electronic Arts for the unauthorised use of their likenesses in the latter's Madden

¹ N Robehmed, 'No, Kim Kardashian Probably Didn't Make \$80 Million From Her iPhone Game' (Forbes, 8 March 2016) < <https://www.forbes.com/sites/nalierobehmed/2016/03/08/no-kim-kardashian-probably-didnt-make-80-million-from-her-iphone-game/>> accessed 8 August 2017.

NFL series,² while personalities as diverse as actress Lindsay Lohan and former military dictator Manuel Noriega have instituted legal proceedings against the developers of, respectively, *Grand Theft Auto 5* and *Call of Duty: Black Ops II* on the same basis.³ All of these were proceedings brought in the US, where the laws of some 28 states recognise, to varying degrees, the individual's so-called 'right of publicity', namely the right to control the commercial exploitation of their name, image, voice, and other aspects of their identity.⁴

Unlike these US states, the UK currently has no specific law granting individuals exclusive rights in the commercial use of their likeness.⁵ While a number of continental European jurisdictions do recognise a 'right of personality', which is founded on the protection of the individual's privacy, dignity and integrity,⁶ the law relating to privacy in the UK has not developed so as to confer similar levels of protection against the unauthorised use of an individual's name and image.⁷ Thus, while the UK courts are no strangers to the phenomenon of 'personality merchandising' – that is, the use of a celebrity's name and/or image to promote the sale of products and services – they have had to grapple with these cases through a variety of intellectual property frameworks, each of which is concerned with a different aspect of such exploitation.

The aim of this article, therefore, is to consider the extent to which the relevant intellectual property frameworks – copyright law, the law of passing off, and the law of trade marks – prohibit or permit the unauthorised recreation of a personal likeness in a videogame. It will demonstrate that, while the outcome of any specific case will of course depend on a

² *Davis v Electronic Arts Inc* 775 3 F 3d 1172 (9th Circuit, 6 January 2015). See also *In Re NCAA Student-Athlete Name and Likeness Licensing Litigation* 724 F 3d 1268 (9th Circuit, 31 July 2013).

³ *Gravano v Take-Two Interactive Software, Inc* 37 NYS 3d 20 (New York Supreme Court, 1 September 2016); *Manuel Noriega v Activision Blizzard Inc* No BC 551747 (California Superior Court, 15 July 2014).

⁴ For an overview, see D Gervais and ML Holmes, 'Fame, Property, and Identity: The Scope and Purpose of the Right of Publicity' (2014) 25 *Fordham Intellectual Property, Media & Entertainment Law Journal* 181.

⁵ See *Elvis Presley Trade Marks* [1999] RPC 567, 597 (Simon Brown LJ stating that there is no 'free standing general right to character exploitation enjoyable exclusively by the celebrity').

⁶ For an overview, see H Carty, 'Advertising, Publicity Rights and English Law' [2004] 3 *Intellectual Property Quarterly* 209, 224 – 227.

⁷ See *Campbell v MGN Ltd* [2004] UKHL 22, [11] (Lord Nicholls stating that '[i]n this country ... there is no over-arching, all-embracing cause of action for "invasion of privacy"').

number of different factors – including the identity of the individual whose likeness has been recreated, the context in which that likeness is used, and the way in which the videogame is marketed and advertised – in a typical case where the likeness of a celebrity in a field such as entertainment or sport has been recreated by a videogame developer without their permission, it is now no longer impossible for the celebrity to make out a claim in passing off, and to a lesser extent in trade mark infringement, against the developer. While cases of this kind would remain on the margins of these intellectual property regimes, the fact that these regimes cannot be dismissed out of hand as being inapplicable to an activity so far removed from the paradigmatic case of infringement is an indication of how far the courts have broadened the traditional remit of each of these regimes. Questions can therefore be raised as to the extent to which such expansion has destabilised the nature and scope of the protection conferred by these regimes, and the potential unintended consequences of such destabilisation.

Copyright law

Copyright infringement occurs where an unauthorised person carries out an act falling within the copyright owner's exclusive purview in relation either to the whole of a protected work or a substantial part of it.⁸ Where a videogame developer has recreated the likeness of an individual in a videogame, the question of whether this amounts to an infringement of copyright is thus the familiar one of whether, in the process of doing so, the developer has reproduced a substantial part of a protected work. In the vast majority of such cases, the answer to this question will almost certainly be in the negative. This is because there is no obvious work upon which such a claim might be founded. The facial appearance of an

⁸ Copyright, Designs and Patents Act 1988, s 16.

individual is not, in itself, a work capable of being protected by copyright; it would therefore not be an infringement for a videogame developer to recreate it in digital form.⁹

It is true that, in cases involving the unauthorised depiction of fictional characters, the courts have come to take an extraordinarily relaxed approach towards the need for the claimant to identify a specific work or works whose copyright is said to be infringed. In the early case of *King Features Syndicate, Inc v O and M Kleeman, Ltd*, the defendants were held to have infringed the claimants' copyright through the unauthorised production and sale of merchandise bearing the likeness of the popular character Popeye the Sailor, who was the protagonist of the claimants' comic strips.¹⁰ In keeping with orthodox copyright reasoning, the court was careful to emphasise that its decision was not based on the finding that the defendants had copied or misappropriated the Popeye character as such, but rather upon the finding that the defendants had, in doing so, reproduced a substantial part of a drawing in which the character was depicted. Fifty years later, however, in a case involving the unauthorised production of Teletubbies t-shirts, Laddie J was prepared to find that the garments in question were 'a substantial reproduction of one or other pieces of artwork which the plaintiffs have generated in designing the Teletubby programmes', even though the claimants themselves had conceded that there was no way of identifying a specific artistic work, out of the many then in existence, of which the defendants' t-shirts could be said to be an unauthorised reproduction.¹¹ Even more recently, the Court of Appeal in *R v Gilham* appeared satisfied simply to assume that the images of videogame characters that were shown on the screen or monitor during play were necessarily 'copies, and substantial copies' of the drawings in which those characters had originally been depicted.¹² This was despite the complete absence of any evidence that those characters had begun life as conventional

⁹ M Vitoria et al, *Laddie, Prescott and Vitoria: The Modern Law of Copyright and Designs* (4th edn, LexisNexis, 2011), [40.19].

¹⁰ [1941] AC 417.

¹¹ *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665.

¹² [2009] EWCA Civ 2293.

drawings created through traditional means – and, indeed, the complete absence of evidence as to the existence of any such drawings at all.¹³ It is unlikely, however, for the same line of reasoning to be extended to the unauthorised depiction of real individuals, as the facial appearance of a person cannot, even by the greatest stretch of the imagination, be said to originate from a copyright work.

The likeness of an individual can of course be captured in a photograph, which is capable of being protected by copyright as an artistic work. However, even if a videogame developer were to make unauthorised use of such a photograph as a basis for the recreation of its subject's likeness – and even if the owner of the copyright of the photograph were able to prove that it was that specific photograph, rather than any other, that had been used – it is still unlikely for a substantial part of the photograph to be reproduced in the process. In order to determine whether a substantial part of a work has been reproduced, the courts will look to whether the part taken contains elements through which the originality of the work is expressed.¹⁴ The originality of a portrait photograph, in turn, has been held to subsist in elements such as the choice of background, the pose of the subject, the lighting, framing and angle of view, and so forth.¹⁵ These elements are unlikely to be reproduced where the subject of such a photograph is recreated as a character in a videogame, as the character will typically be shown in a range of environments and poses, which will almost certainly differ from those in the photograph. In these circumstances, the most that the developer can be said to have taken from the photograph is the raw data relating to the facial appearance of the subject, such as the distance between the eyes, the width of the nose, the length of the jawline, and so on. As the originality of the photograph does not subsist in these features, the recreation of

¹³ For a similar critique, see D Booton and A MacCulloch, 'Liability for the Circumvention of Technological Protection Measures Applied to Videogames: Lessons from the United Kingdom's Experience' [2012] 3 *Journal of Business Law* 165, 185.

¹⁴ *Infopaq International A/S v Danske Dagblades Forening* EU:C:2009:465, [39]; *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482, [38].

¹⁵ *Painer v Standard Verlags GmbH* EU:C:2011:798, [91].

the subject's likeness in the form of a videogame character would not amount to an infringement of the copyright in the photograph.¹⁶

Passing off

In its classic form, the action in passing off enables the claimant to prevent the defendant from passing the latter's goods or services off as if they were the former's own. In order to make out a claim in passing off, the claimant must establish, first, that they have goodwill in relation to the goods or services in question, which is typically associated with the name or sign by which the source of the goods is indicated; second, that the defendant has made a misrepresentation that is likely to mislead the public into believing that the defendant's goods or services originate from the claimant; and third, that the claimant has suffered or is likely to suffer damage as a consequence of the defendant's misrepresentation.¹⁷

The courts have traditionally been reluctant to find passing off in cases involving unauthorised personality merchandising. Claimants in these cases found it difficult to establish that they had the requisite goodwill in the use of their likenesses. In particular, they had trouble persuading the courts that consumers were likely to regard the presence of a celebrity's likeness on a product as an indication of its source, rather than as an element of the product itself.¹⁸ As Laddie J put it: 'When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source'.¹⁹ As a consequence, claimants in these cases also had difficulty making out an actionable misrepresentation on the part of the defendant. This was especially the case where the claimants themselves were not engaged in the production and distribution of products of a

¹⁶ *Painer v Standard Verlags GmbH* EU:C:2011:798, [AG129].

¹⁷ *Reckitt & Colman Products Ltd v Borden Inc (No 3)* [1990] 1 WLR 491.

¹⁸ *Lyngstad v Anabas Products Ltd* [1977] FSR 62; *Halliwell v Panini* (Unreported, 6 June 1997); *Elvis Presley Trade Marks* [1999] RPC 567.

¹⁹ *Elvis Presley Trade Marks* [1997] RPC 543, 554.

similar nature. It was on this basis that Oliver J dismissed the Swedish pop group Abba's claim of passing off in *Lyngstad v Anabas Products Ltd*, a case involving the unauthorised sale of merchandise bearing the band members' likenesses.²⁰ He held that, as the band itself had not at any time marketed similar merchandise in the UK, it could not be said that the defendants were misleading the public into confusing their products with products manufactured by the band. He also took note of the fact that, at the time, there was no evidence of any general custom for merchandising licences to be granted by pop singers – indeed, such evidence as was available pointed to the contrary. In the circumstances, he concluded that no one 'could reasonably imagine that all the pop stars named in [the defendant's] advertisements were giving their approval to the goods offered or that the defendants were doing anything more than catering for a popular demand among teenagers for effigies of their idols'.²¹ Under this view of the law, it seems unlikely that the unauthorised recreation of a celebrity's likeness in a videogame would be treated as an act of passing off.

Over time, however, the elements in the 'classic trinity' of the action in passing off have been broadened in ways that have made the tort more and more capable of accommodating cases of personality merchandising, and the courts have shown an increased willingness to bring cases of this kind within its remit. This has taken place against the backdrop of an environment where merchandising and endorsement have become an important revenue streams for celebrities, and the purchasing public has become increasingly aware of this fact. The first shift in the direction of this more expansive approach occurred not in the context of personality merchandising itself, but in the related field of 'character merchandising', where the names and likenesses of fictional characters – rather than real celebrities – are used to promote the sale of products. In *Mirage Studios v Counter-Feat*

²⁰ [1977] FSR 62.

²¹ [1977] FSR 62, 68.

Clothing Co Ltd, the defendants were held to be liable in passing off for having licensed the manufacture and sale of garments bearing the image of four humanoid cartoon turtles which were said to resemble the claimant's cartoon characters, the Teenage Mutant Ninja Turtles.²² In doing so, the court broadened the scope of the elements of passing off in the following ways.

First, and for the first time, the court was prepared to acknowledge that consumers might, at least in certain circumstances, view the presence of a fictional character on a product as being an indication of its source. As Browne-Wilkinson VC noted, the evidence in the case showed that 'a substantial number of the buying public now expect and know that where a famous cartoon or television character is reproduced on goods, that reproduction is the result of a licence granted by the owner of the copyright or owner of other rights in that character'.²³ Second, the court took the position that, in order to establish that it had the requisite goodwill, the claimant need not show that it was directly engaged in the manufacture and sale of similar products; it was sufficient if the claimant was able to demonstrate that it was in the business of licensing the reproduction of the character in question on products made and sold by third parties. Third, the court accepted that an actionable misrepresentation could occur not only where the defendant had misled the public into believing that its goods were manufactured or sold by the claimant, but also where the defendant had misrepresented its goods as having been licensed or approved by the claimant in some way, which it had done on the facts. Fourth, the court recognised the claimant's potential loss of licensing revenue in these circumstances as an actionable head of damage.

At the time *Mirage Studios* was decided, most commentators were of the view that it would be treated as being limited to its particular facts, or at most, confined to cases of

²² [1991] FSR 145.

²³ [1991] FSR 145, 155.

character merchandising, rather than being extended to cases of personality merchandising.²⁴ This was especially the case given that Browne-Wilkinson VC had taken pains to distinguish Mirage Studios from the personality merchandising cases in which no passing off had been found, on the basis that the claimant in Mirage Studios both had copyright in its drawings of the Teenage Mutant Ninja Turtles and was in the business of licensing the reproduction of these drawings on a large scale, unlike the claimants in the personality merchandising cases. In a number of personality merchandising cases decided post-Mirage Studios, the courts did continue to find largely in favour of the defendant. Although a rare finding of passing off was made in the case of *Irvine v Talksport Ltd*, Laddie J was careful to distinguish the facts of that case, which he characterised as one of false endorsement, from those of a typical personality merchandising case.²⁵

In the most recent case to deal with personality merchandising, however, the courts have shown themselves prepared to make use of the flexibility developed through the character merchandising cases in the context of personality merchandising – and, in some respects, to take them even further. This was the high-profile case of *Fenty v Arcadia Group Brands Ltd (No 2)*, which arose from an action brought by the famous pop star Rihanna against the fashion retailer Topshop for the latter’s unauthorised sale of t-shirts bearing the former’s likeness.²⁶ At first instance, Topshop was found to be liable in passing off, and this decision was affirmed on appeal. Both Birss J at first instance and Kitchin J at the Court of Appeal were careful to emphasise that the law of the UK did not recognise a general right for a person, whether famous or otherwise, to control the use of their image. It was therefore necessary for Rihanna to make out the three elements of goodwill, misrepresentation, and damage, which on the evidence she was found to have done. Rihanna’s merchandising and endorsement operation, which included numerous arrangements entered into with fashion

²⁴ See generally L Bently and B Sherman, *Intellectual Property Law* (4th edn, OUP, 2014), 857.

²⁵ [2002] EWHC 367 (Ch). cf *Fenty v Arcadia Group Brands Ltd (No 2)* [2013] EWHC 2310 (Ch), [32] – [33].

²⁶ [2013] EWHC 2310 (Ch); [2015] EWCA Civ 3.

designers and retailers, was held to give rise to the requisite goodwill. Both the first instance and appellate judges also acknowledged that consumers would not automatically assume that all merchandise bearing the likeness of a celebrity had necessarily been authorised by the celebrity in question; accordingly, they took pains to emphasise that the mere presence of a celebrity's likeness on a product could not be regarded in all cases a representation that the product had been authorised by that celebrity. They did, however, agree that an actionable misrepresentation had been made by Topshop in this particular case, given Topshop's previous attempts at establishing a connection in the public mind between itself and Rihanna, as well as the nature of the image featured on the t-shirt, which showed Rihanna with the hairstyle featured in the marketing campaign for one of her albums.

The significance of the decision in *Fenty* is fourfold. First of all, and in a departure from the previous cases involving personality merchandising, the decision makes it very clear that the unauthorised use of a celebrity's likeness on a product can, in the right circumstances, amount to passing off. Second, it also provides a clear indication that the courts no longer perceive a sharp distinction between cases of character merchandising and cases of personality merchandising. As Birss J himself would go on to acknowledge in a subsequent case, the difference between the two is a matter of degree rather than kind:

...There is no law which provides that invented characters have stronger rights than real people in this regard but it does seem to me that it is probably easier to educate the public to believe that goods relating to an invented character derive from a single official source than it might be for a real person, not least because copyright law may give the inventor the ability to control the reproduction of the character for a very long time.²⁷

Third, the decision has in some respects expanded the concept of goodwill even further than the character merchandising cases have done. In *Mirage Studios*, the court made a positive finding in relation to goodwill on the basis that the claimant was in the specific business of licensing the reproduction of the copyright works in which those particular

²⁷ *Hearst Holdings Inc v AVELA Inc* [2014] EWHC 439 (Ch), [107].

fictional characters were depicted. By the time Fenty came to be decided, the court appeared to take this reasoning even further: the existence of the claimant's large merchandising and endorsement operation in the field of fashion generally, together with the claimant's status as a style icon, was sufficient for a finding of goodwill.

Fourth, and perhaps most importantly, the decision is likely to have something of a self-perpetuating effect. It is true that the judges were at pains to emphasise that their decision was based on the particular facts of the case, and should not be understood as laying down a general rule prohibiting all third-party sales of merchandise bearing a celebrity's likeness without a licence. Notwithstanding this, however, one very probable consequence of the decision is that a significant proportion of traders currently engaged in the production and sale of such merchandise will feel greater pressure either to regularise their activities by obtaining an appropriate licence, or to decrease them altogether. This would lead to a significant decrease in the amount of 'unlicensed' merchandise in the marketplace; over time, consumers would come to assume that a product bearing a celebrity's likeness would, more often than not, be made and sold under a licence from the celebrity in question. Should this come to pass, it might only be a matter of time before the courts came to accept that, as a general rule, the placing of a celebrity's likeness on a product would constitute a representation that the product in question had been authorised by that celebrity, unless circumstances indicate otherwise.

As the law currently stands, therefore, it would be unwise for a videogame developer to dismiss the possibility that the recreation of an individual's likeness in a videogame might amount to an actionable misrepresentation in passing off. Much will depend on the characteristics of the individual whose likeness has been used, as well as the context in which their likeness is used. Where the individual in question is a public figure who does not and would not be expected to engage in any sort of merchandise licensing, such as a political

leader, then it seems unlikely that the elements of goodwill and misrepresentation will be made out. In contrast, where the likeness that has been recreated belongs to a well-known figure in a field such as music, entertainment or sport, and who is engaged in the business of merchandising and endorsement, a claim in passing off can be made out much more easily. As explained previously, licensing deals between videogame developers and celebrities have become increasingly commonplace, and consumers are likely to be aware of this. Speaking in the context of the Kim Kardashian videogame, videogame designer and critic Ian Bogost has noted that, ‘like perfume or clothing ranges, mobile games are now an ordinary, expected product for fans of these stars to own’.²⁸ Where a character bearing the likeness of such a celebrity is featured in a videogame, therefore, it is well within the realm of possibility that a significant proportion of consumers will be left with the impression that the inclusion of that character must have been authorised by the celebrity in question. A possible exception would be where the celebrity is portrayed in an unflattering light by the videogame, as consumers might be less inclined to believe that such a portrayal had been authorised by the celebrity; however, this would not necessarily be conclusive.²⁹

One obstacle that might be faced by a claimant in such a case is that of establishing the existence of goodwill. Although a very broad view of goodwill was taken in *Fenty*, Birss J did place at least some weight on Rihanna’s merchandising and endorsement activities in the field of fashion. In contrast, a celebrity whose likeness has been recreated in a videogame without their authorisation might not have previously engaged in any merchandising activities related to videogames. However, given that so many celebrities whose core activities are similarly unrelated to the field of videogames have nevertheless concluded licensing agreements with videogame developers, a future court, if called upon to decide such

²⁸ K Wills, ‘Taylor Swift is the Latest Celebrity to Market Herself via a Mobile Game’ (Independent, 4 February 2016) <<http://www.independent.co.uk/life-style/gadgets-and-tech/taylor-swift-is-the-latest-celebrity-to-market-herself-via-glu-mobile-a6854251.html>> accessed 8 August 2017.

²⁹ [2013] EWHC 2310 (Ch), [66] (Birss J suggesting that ‘the less flattering the image the less likely it is that it would be thought to be authorised’).

a case, might well conclude that the element of goodwill would be made out if the claimant could show evidence of merchandising and endorsement activity generally, or at least a pattern of merchandising and endorsement activity that might lead consumers to believe that they had authorised the inclusion of their likeness in the defendant's videogame. This would, in many respects, represent a continuation of the expansionary trend begun in *Mirage Studios* and carried on in *Fenty*.

A second question that arises in cases of this kind is the point in time at which the actionable misrepresentation must occur, an issue that has remained largely unexplored. In a typical case of personality merchandising, the relevant misrepresentation occurs at the point of sale, as the likeness or name of the celebrity is featured on the products themselves. This will also be the case where the likeness of the celebrity is featured on the box art for the videogame, or the screenshots used to promote the videogame in an online marketplace. An issue arises, however, where the likeness of a celebrity is used in a videogame, but is not featured in its marketing materials. This means that consumers will encounter the celebrity's likeness only after they have purchased the videogame and have begun to play it; any misrepresentation will therefore occur only after the point of sale. In the few cases in which this issue has arisen, the courts have typically held that the actionable misrepresentation must occur at the point of sale.³⁰ However, this is not a blanket rule, and the courts have on a few occasions treated the relevant time as the time at which the products in question were used. This was the case in *Marengo v Daily Sketch and Sunday Graphic Ltd*³¹ and *Clark v Associated Newspapers Ltd*,³² two passing off actions brought in relation to the misrepresentation of the authorship of, respectively, several cartoons and a series of satirical articles, which had in each case been published in a newspaper belonging to the defendant. In each case, the actionable misrepresentation was held to have occurred at the point at which

³⁰ *Bostik Ltd v Sellotape GB Ltd* [1994] RPC 556.

³¹ [1992] FSR 1; (1948) 65 RPC 242.

³² [1998] 1 WLR 1558.

the cartoons were viewed and the articles were read, rather than at the point at which the newspapers were purchased. There is therefore precedent, should the courts choose to apply it, for holding that the actionable misrepresentation may occur at the point at which the videogame is played, rather than looking solely to the time at which it is purchased. This is particularly the case given that videogames, like cartoons and newspaper articles, are protected to at least some extent as copyright works under the law of the UK.³³

Equally, there are also grounds on which the cases such as *Marengo* and *Clark* might be distinguished from the general run of passing off cases. In particular, they can justifiably be regarded as *sui generis* examples of cases where the rules of passing off have been utilised to protect the rights of artists and writers to be identified as the authors of their works.³⁴ This would have been particularly significant for cases decided prior to the coming into force of the Copyright, Designs and Patents Act 1988, when the moral right of attribution had yet to find its way into the legislation on copyright. As the recreation of celebrity likenesses in videogames does not raise any particular issues concerning authorship, it can be argued that the principles applied in *Marengo* and *Clark* are not generalizable to such cases. Furthermore, the arguments that have been advanced in support of what has been termed ‘post-sale confusion’ are not particularly robust, nor do they appear particularly relevant in the context of videogames.³⁵ It remains to be seen whether the courts will, in such cases, take the opportunity to expand this dimension of the element of misrepresentation still further. While arguments can be made against such expansion, the possibility cannot be discounted lightly, particularly if the decision in *Fenty* is seen as marking the start of a more expansive judicial approach towards claims of passing off in the personality merchandising context.

³³ *Nova Productions Ltd v Mazooma Games Ltd* [2006] EWHC 24 (Ch); [2007] EWCA Civ 219. See also *Nintendo Co Ltd v PC Box Srl* EU:C:2014:25, [21] – [23].

³⁴ See C Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (4th edn, Sweet & Maxwell, 2011), [8-105].

³⁵ See the discussion below.

Trade mark law

An infringement of a registered trade mark occurs where an unauthorised third party, acting in the course of trade, either uses a sign that is identical to the registered mark in relation to goods or services that are identical to those for which the mark has been registered; or uses a sign that is similar to the registered mark in relation to similar or identical goods or services, leading to a likelihood of confusion. For the unauthorised recreation of a celebrity's likeness in a videogame to amount to infringement, therefore, it must first be shown that the recreation is identical or similar to a registered trade mark.

The successful registration of a trade mark capable of protecting against the unauthorised use of their likenesses remains something of a vexed issue for celebrities – or, in the case of celebrities who are deceased, their heirs and representatives. For a trade mark to be validly registered, it must be a sign that is capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of another.³⁶ The facial appearance of an individual is not, in itself, a 'sign' capable of registration. The closest that an individual would be able to come to obtaining a trade mark in their likeness would be to register a photograph of themselves as a trade mark. In the past, would-be registrants have found it difficult to establish that the image of a celebrity is capable of fulfilling the final requirement for registration, namely that of distinctiveness, for much the same reasons as the claimants in the earlier personality merchandising cases found it difficult to demonstrate that they possessed the requisite goodwill for a claim in passing off.

This, it appears, remains the official position of the UK Intellectual Property Office. Its Trade Marks Manual explains that a picture of a famous person presents similar issues as famous names in relation to registrability but, depending on the goods for which registration is sought, may be even more likely 'to be taken as mere decoration and therefore to lack a

³⁶ Trade Marks Act 1994, s 1(1).

trade mark character' compared to famous names.³⁷ In relation to famous names, meanwhile, the manual states that such names 'may appear to the average consumer as an indication that the goods/services are about the person whose name it is rather than as an indication that the goods/services are supplied by, or under the control of, one undertaking'.³⁸ At the same time, however, a number of well-known personalities have in more recent years succeeded in obtaining trade mark registrations for photographs of themselves. An example is former Formula One driver Damon Hill, who currently holds a trade mark in a photograph of his eyes looking out from the visor of his racing helmet.³⁹ This suggests that the hurdle of distinctiveness, while high in such cases, is not insurmountable.

In this regard, the decision in *Fenty* may well have the effect of making the task of establishing the distinctiveness of a celebrity image a less formidable one. While that case was decided in the context of passing off rather than trade mark infringement, it may nevertheless be indicative of an increased willingness on the part of the courts to recognise that the image of celebrity is capable of functioning as an indicator of origin, at least under certain circumstances. It has also been suggested that the decision may have something of a self-perpetuating effect and may, in the long run, significantly increase the likelihood of a celebrity image being perceived as an indicator of origin. Where trade mark examiners – and the courts – are called upon to assess the distinctiveness of a particular celebrity image on a trade mark application, therefore, there seems no reason why factors such as those at play in *Fenty* should not also be taken into account. Like the claimants in the passing off cases involving character merchandising and personality merchandising, applicants seeking the registration of such trade marks should be able to increase their likelihood of success if they are able to show that the photograph in question has been used in such a way as to cause a sufficient proportion of consumers to treat it as an indicator of origin, such as by using it

³⁷ Intellectual Property Office, *Trade Marks Manual* (Intellectual Property Office, 2016), 125.

³⁸ Intellectual Property Office, *Trade Marks Manual* (Intellectual Property Office, 2016), 124.

³⁹ Trade Mark No. UK00002036489.

consistently across a range of merchandise.⁴⁰ In the current commercial environment, this might be an easier task than was previously the case, given the ubiquity of personality merchandising and the public's increased awareness of such practices.

Where a photograph of an individual has been successfully registered as a trade mark, this does not mean that the recreation of the likeness captured in the photograph will necessarily amount to an infringement of the mark. It is still necessary for the owner of the mark to prove that, in recreating the individual's likeness in the form of a videogame character, the developer of the videogame has used a sign that is identical or similar to the registered mark in relation to similar goods or services which, by reason of the identity or similarity of the marks and the similarity of the goods or services to which they apply, gives rise to a likelihood of confusion on the part of the public. A key issue that arises here is the extent to which the likeness of the videogame character can, in a typical case, be said to be 'similar' to the photograph for which trade mark registration has been obtained. In the earlier discussion of such cases in the context of copyright law, it was explained that a videogame character in such a case would in all likelihood be portrayed in environments and poses different from those shown in the photograph; consequently, the recreation of the likeness depicted in the photograph would not amount to the taking of a substantial part of it. However, this does not necessarily also mean that no finding of similarity can be made in the trade mark context, as the legal tests are very different.

Several commentators have suggested that, even if a celebrity were to successfully register a photograph of themselves with a trade mark, they would still only be entitled to prevent the unauthorised use of either the same photograph or photographs that were not

⁴⁰ For suggestions to this effect, see *Elvis Presley Trade Marks* [1997] RPC 543, 551; A Story, 'Owning Diana: From People's Princess to Private Property' (1998) 5 *Web Journal of Current Legal Issues* <webjcli.ncl.ac.uk/1998/issue5/story5.html> accessed 8 August 2017.

significantly different from it.⁴¹ This, in turn, implies that there must be some minimum degree of visual similarity between the photograph for which trade mark registration has been obtained and the use made by the defendant of the celebrity's likeness, beyond the fact that they recognisably depict the same individual. A close analysis of the 'global appreciation' test laid down by the CJEU, however, suggests that this may not necessarily be the case.⁴² Under this approach, the focus of the legal enquiry is centred upon a single question: whether the defendant's use of the relevant sign is one that is likely to give rise to a likelihood of confusion on the part of the public – that is, whether it would cause the public to believe that the goods or services in question originate from the owner of the trade mark or an undertaking that is economically linked to the owner of the trade mark, such as a licensee or subsidiary. In addressing this question, the courts are called upon to undertake a global assessment of all relevant factors, including the degree of similarity between the claimant's and the defendant's marks, and the degree of similarity of the goods or services to which each mark is applied.

The Court of Appeal has made it clear that there is no minimum threshold of similarity that must exist between the two marks before the court will go on to consider whether a likelihood of confusion has resulted from the defendant's use.⁴³ It has also held that the question of whether the claimant's and defendant's marks are similar cannot be meaningfully isolated from questions concerning confusion. Furthermore, both the CJEU and the courts in the UK have held that the conceptual similarity between two marks may be sufficient to give rise to likelihood of confusion, even where the degree of visual similarity is

⁴¹ A Story, 'Owning Diana: From People's Princess to Private Property' (1998) 5 Web Journal of Current Legal Issues <webjcli.ncl.ac.uk/1998/issue5/story5.html> accessed 8 August 2017; L Weathered, 'Trade Marking Celebrity Image: The Impact of Distinctiveness and Use as a Trade Mark' (2000) 12 Bond Law Review 161, 182; H Carty, 'Advertising, Publicity Rights and English Law' [2004] 3 Intellectual Property Quarterly 209, 211.

⁴² *Sabel BV v Puma AG* EU:C:1997: 528, [22] – [23]; *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* EU:C:1998:442, [16] – [17].

⁴³ *eSure Insurance Ltd v Direct Line Insurance plc* [2008] RPC 34, [48] – [50]. cf *Ferrero SpA v OHIM* EU:C:2011:177, [66] (CJEU holding that, where there is no similarity between the marks, 'even faint', there is no basis upon which to carry out the global assessment).

low – or, in some cases, non-existent.⁴⁴ In *Hearst Holdings Inc v AVELA Inc*, the claimant held various trade mark registrations in the words BETTY BOOP, the name of a 1930s cartoon character, for certain categories of goods, including clothing and toys.⁴⁵ Birss J held that the claimant’s word marks had been infringed by the defendant’s use of an image of the Betty Boop character on various articles of clothing. This was because the average consumer, upon seeing the image, would call to mind the words ‘Betty Boop’; the conceptual similarity between the defendant’s image and the claimant’s word marks thus gave rise to a likelihood of confusion among consumers as to the origin of the goods, as consumers would assume that goods bearing the image had been licensed by the claimant.

Taking this to its logical conclusion, therefore, it seems at least possible to make out the argument that, even where the only point of visual similarity between the defendant’s videogame character and the claimant’s registered mark is the fact that they recognisably depict the same individual, this, taken together with the conceptual similarity between the two – in that they refer to the same person – might be sufficient to give rise to a likelihood of confusion on the part of consumers. This is especially the case where the factors that have already been discussed in relation to the element of misrepresentation are taken into account, in particular consumers’ awareness and expectations of contemporary merchandising practices. The extent to which the courts would be prepared to apply a line of reasoning developed in the context of character merchandising to a case that is much more akin to personality merchandising is, of course, not entirely clear. This is particularly the case given that such an approach would, in at least some circumstances, come very close to giving individuals a right in their own likeness, which the courts have consistently resisted. It is perhaps for this reason that the courts have been much more conservative about finding passing off in personality merchandising cases compared to cases of character merchandising.

⁴⁴ *Sabel BV v Puma AG* EU:C:1997: 528, [24].

⁴⁵ [2014] EWHC 439 (Ch).

Still, there seems to be nothing in the global appreciation test that would necessarily preclude such an outcome, given its over-arching focus on the likelihood of confusion on the part of the public, though a different outcome might be reached in those jurisdictions where a clearer conceptual distinction can be drawn between questions of similarity and questions of confusion.⁴⁶

As with passing off, a trade mark claim made on this basis may also raise the question of the time at which the relevant confusion must occur. Where the celebrity's likeness is not featured on any of the videogame's marketing materials, consumers will encounter it only after they have purchased the videogame and begun to play it. As with misrepresentation, therefore, any confusion will arise only after the point of sale. Two main arguments have been advanced in favour of the proposition that post-sale confusion should be capable of satisfying the requirement of a likelihood of confusion.⁴⁷ The first is that post-sale confusion is likely to have a negative effect on future consumer purchasing decisions. Where the defendant has used a mark similar to the claimant's on an item of inferior quality, so the argument goes, third parties who encounter the item after it has been removed from the point of sale may believe it to originate from the claimant and thus form a negative opinion of the claimant's goods, even though the purchaser of the item may not have been confused as to its origin at any point.⁴⁸ The second argument, which has been invoked primarily in the context of high-status luxury goods, is that post-sale confusion has the effect of devaluing the trade mark in some general sense: if third parties are unable to distinguish between a 'knock-off' and a 'genuine' article once the item has been removed from the point of sale, it is said, the prestige conferred by the mark will be eroded.

⁴⁶ See R Burrell and M Handler, *Australian Trade Mark Law* (2nd edn, OUP, 2016), 202 – 203.

⁴⁷ For an overview, see P O'Byrne and B Allgrove, 'Post-Sale Confusion' (2007) 2 *Journal of Intellectual Property Law & Practice* 315; JN Sheff, 'Veblen Brands' (2012) 96 *Minnesota Law Review* 769; MP McKenna, 'A Consumer Decision-Making Theory of Trademark Law' (2012) 98 *Virginia Law Review* 67.

⁴⁸ *Levi Strauss & Co v Shah* [1985] RPC 371; *Levi Strauss & Co v Kimbyr Investments Ltd* [1994] FSR 335.

Neither of these arguments is particularly robust, and they are of limited relevance to the present scenario. Videogames, even those endorsed by a celebrity, are not generally regarded as high-end or high-status products. Furthermore, gaming is typically a solitary activity, which significantly reduces any opportunities for bystander confusion; at most, it might be expected to take place within a small circle of friends and family members. It can be argued, of course, that a purchaser who encounters the unauthorised likeness of a celebrity within a low-quality videogame might, in the belief that the videogame had been endorsed or licensed by that celebrity, form a negative opinion of the goods and services emanating from that celebrity, and would refuse to purchase any such goods or services in the future. Again, however, this argument is not particularly strong: this is in part because there appears to be no expectation among consumers that videogames will necessarily be of high quality simply because they have been endorsed by a celebrity, and in part because the negative reception accorded to certain celebrity-linked videogames does not appear to have affected those celebrities' other revenue streams in any significant way. The mobile game Katy Perry Pop, for example, was widely derided as a 'flop'.⁴⁹ However, this does not appear to have had a significant negative impact on the eponymous pop singer's reputation on the whole: her most recent album debuted at the top of the Billboard 200 record chart, and she remains very much a household name.

While the arguments in favour of post-sale confusion are not particularly strong, the possibility that the courts may come to recognise it as an actionable form of confusion in such cases cannot be discounted. In recent years, both the CJEU and the courts in the UK have shown increasing willingness to acknowledge the relevance of post-sale confusion to cases of trade mark infringement. In *Arsenal Football Club plc v Reed*, the CJEU held that the defendant's use of the claimant's word mark ARSENAL on scarves and other football-related

⁴⁹ B Klinkenberg and S Maheshwari, 'Gaming Company Turns to Taylor Swift After Katy Perry App Flops' (BuzzFeed, 3 February 2016) <<https://www.buzzfeed.com/brendanklinkenberg/taylor-swift-has-a-smartphone-game-on-the-way>> accessed 8 August 2017.

paraphernalia amounted to an infringement of the mark, even though the defendant had placed at the point of sale a prominent notice informing customers that his goods were not goods officially manufactured or licensed by the claimant football club.⁵⁰ This was on the basis that third parties who came across the defendant's goods after the point of sale might be led to believe that the goods originated from the claimant. This, it was said, affected the essential function of the claimant's trade mark, namely as a guarantee of the identity of the origin of goods bearing it. Subsequently, in *DataCard Corpn v Eagle Technologies Ltd*, Arnold J held that in appropriate circumstances, post-sale confusion could be relied on as establishing the existence of a likelihood of confusion for the purposes of a trade mark claim.⁵¹ The example given by Arnold J of the harm that would accrue to the trade mark owner as a consequence of post-sale confusion relates to the diversion of trade from the claimant to the defendant, and once again, appears to be of limited relevance in a scenario involving the unauthorised use of celebrity likenesses in videogames; however, it has to be noted that Arnold J did not expressly confine his remarks to post-sale confusion relating to that specific type of harm.⁵² There is once again precedent, should the courts choose to apply it, for the recognition of post-sale confusion in the context of trade mark infringement. This is not a possibility that can be dismissed lightly, given the courts' current expansionary approach in this field of law.

In order to make out a successful claim of trade mark infringement, the owner of the trade mark will also have to show that the videogame developer, in recreating that individual's likeness, has 'used' a sign that is at least similar to the registered mark. In a number of jurisdictions, infringement will occur only where a defendant has used the

⁵⁰ EU:C:2002:651, [57]. See also *Anheuser-Busch v Budejovicky Budvar* EU:C:2004:717, [59] – [60].

⁵¹ [2011] EWHC 244 (Pat).

⁵² [2011] EWHC 244 (Pat), [288] (Arnold J giving the example of a scenario where there is no confusion at the time at which the consumer initially orders the goods from the defendant; however, because the goods that arrive are packaged in a manner that wrongly leads the consumer to believe that they emanate from the claimant, the claimant may subsequently order a fresh supply of goods from the defendant in the belief that they will receive goods originating from the claimant).

offending sign ‘as a trade mark’ – that is to say, where the sign has been used as a badge of origin.⁵³ Other types of uses, such as descriptive or decorative uses, will not give rise to infringement. In these jurisdictions, the requirement that the sign must have been ‘used as a trade mark’ has sometimes been treated as being conceptually separate from the question of whether consumers are likely to be confused by that particular use.⁵⁴ Were this the legal position in the UK, the videogame developer might be able to argue, for instance, that the recreation of an individual’s likeness in a videogame should not, in itself, be regarded as a use falling within the category of ‘use as a trade mark’, any more than a novelist’s description of a literary character as ‘wearing Nike trainers and carrying a Coca-Cola bottle’ should be regarded as using NIKE and COCA-COLA as trade marks.⁵⁵

The CJEU has, however, articulated a differently-worded test of what constitutes a potentially infringing use of a sign. In *Arsenal*, it held that trade mark infringement occurs in cases where ‘a third party’s use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of goods’.⁵⁶ While there was some initial uncertainty as to the extent to which this formulation differed from that of ‘use as a trade mark’,⁵⁷ the CJEU has, in its subsequent case law, identified a range of trade mark functions other than the ‘origin function’ expressly referred to in *Arsenal*.⁵⁸ These include the ‘quality function’, the ‘advertising function’, the ‘investment function’, and the ‘communication function’. Under the CJEU’s case law, therefore, the range of potentially infringing uses is indisputably wider than that of ‘use as a

⁵³ See e.g. Australian Trade Marks Act 1995, s 120; *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* [1963] HCA 66.

⁵⁴ See *Musidor BV v Tansing* [1994] FCA 1242.

⁵⁵ The position would be different if the individual’s likeness had been featured on the box art or other promotional materials for the videogame.

⁵⁶ EU:C:2002:651, [51].

⁵⁷ For an overview, see N Shemtov, ‘“Trade Mark Use” in Europe: Revisiting *Arsenal* in the Light of *Opel* and *Picasso*’ (2007) 2 *Journal of Intellectual Property Law & Practice* 557.

⁵⁸ *L’Oreal SA v Bellure NV* EU:C:2009:378, [58].

trade mark'. This, in turn, significantly increases the likelihood that the recreation of a celebrity's likeness in a videogame will be held to constitute an infringing use.

In Arsenal, the CJEU took a very broad view of what would amount to a use of a sign capable of affecting the origin function of the registered mark. In particular, it held that Reed's use of the ARSENAL mark did jeopardize the mark's essential function of guaranteeing the origin of the goods, as consumers coming across the goods after the point of sale would perceive the sign as denoting Arsenal Football Club as the source of the goods. In its subsequent jurisprudence, the CJEU has increasingly linked the concept of damage to the origin function of the registered mark with the likelihood of confusion among consumers: in its case law on keyword advertising, for instance, the CJEU has consistently held that the mark's origin function is affected where the advertisement does not enable consumers, or enables them only with difficulty, 'to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party'.⁵⁹ In light of this, it is entirely possible to make out a case that the recreation of celebrity's likeness in the form of a videogame character is a use that is capable of jeopardizing the origin function of the registered mark, in circumstances where there is a real possibility of the consumer perceiving that character as an indication that the videogame has been licensed or endorsed by the celebrity in question, for the reasons that have already been discussed in relation to the misrepresentation element of passing off. The possibility that this perception may arise only after the point of sale – such as where the celebrity's likeness is not featured on the promotional materials for the videogame – would not affect the overall assessment, given the

⁵⁹ Google France Sarl v Louis Vuitton Malletier EU:C:2010:159, [84]; Die Bergspechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v Guni EU:C:2010:163, [35]; Portakabin Ltd v Primakabin BV EU:C:2010:416, [34]. See also DataCard Corp v Eagle Technologies Ltd [2011] EWHC 244 (Pat), [263] (Arnold J describing this as 'a test of likelihood of confusion, with a reversed onus').

CJEU's recognition of the effects of post-sale confusion on the origin function of the registered mark in Arsenal.

In addition to the origin function, the recreation of a celebrity's likeness in the form of a videogame character also has the potential to affect the advertising, investment, and communication functions of the registered mark – although, as the CJEU has yet to give a precise definition to each of these functions, it is difficult to state with any certainty the extent to which this will be the case. In relation to the advertising function, the CJEU has suggested that this will be affected where the unauthorised use 'adversely affects the proprietor's use of its mark as a factor in sales promotion or as an instrument of commercial strategy'.⁶⁰ In *DataCard*, Arnold J described the advertising function of a mark as the function of 'conveying a particular image to the average consumer of the goods or services in question'.⁶¹ It might be argued, then, that the unauthorised recreation of a celebrity's likeness in a videogame could potentially jeopardize the advertising function of the mark, as the celebrity's loss of control over the context in which it is used could lead to a diminution in its effectiveness as a tool for commercial strategy and promotion. The same might also be said in relation to the investment function, which, as the CJEU has explained, is adversely affected where the unauthorised use 'substantially interferes with the proprietor's use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty'.⁶² While the CJEU has yet to elaborate on the nature of the communication function, Advocate-General Mengozzi has linked this function with the role of the trade mark as 'a vehicle for providing consumers with various kinds of information on the goods identified by them', including promotional messages aimed at cultivating a particular image of the

⁶⁰ *Google France Sarl v Louis Vuitton Malletier* EU:C:2010 :159, [92].

⁶¹ [2011] EWHC 244 (Pat), [272] (emphasis in original).

⁶² *Interflora Inc v Marks & Spencer plc* EU:C:2011:604, [66].

product.⁶³ This would appear to raise concerns similar to those arising in relation to the advertising and investment functions.

Conclusion

While the unauthorised recreation of a celebrity's likeness in the form of a videogame character is unlikely to give rise to any claims of infringement under copyright law, the position may well be very different in relation to the law of passing off and the law of trade mark. While such a scenario might appear far removed from the paradigmatic case of passing off or trade mark infringement, over the last few decades, the ambit of each of these intellectual property regimes has expanded to the point where its applicability to activities such as this can no longer be dismissed out of hand. For some, these developments might well be a positive indication of the malleability of intellectual property law and its ability to keep pace with contemporary commercial reality. Through these developments, however, the law has now come closer than ever to the effective recognition of a well-known personality's exclusive right to their own image, even though the courts have consistently asserted the non-existence of such a right under the law of the UK. The seemingly self-contained issue of the recreation of celebrity likenesses in videogames thus highlights the expansion that has taken place within these two intellectual property regimes over a relatively short period. If the law is to continue on its present trajectory, therefore, there needs to be more awareness of its likely destination, as well as a greater willingness to interrogate the implications of these developments, both positive and negative.

⁶³ *L'Oreal SA v Bellure NV* EU:C:2009:378, [AG54].