

Intellectual Property

Image Rights: Training
Seminar Creating
commercial opportunity
providing legal certainty.

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Image rights: Commercial reality, legal uncertainty.

- **Lord Hoffmann** in *Campbell v MGN Ltd (2004)*
“Naomi Campbell is a famous fashion model who lives by publicity. What she has to sell is herself: her personal appearance and her personality. She employs public relation agents to present her personal life to the media in the best possible light just as she employs professionals to advise her on dress and make-up. That is no criticism of her. It is a trade like any other.”



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Image rights: Commercial reality, legal uncertainty.

- **Lindsay J.** (*after Peck v United Kingdom [2003] EMLR 15 and Douglas v Hello! [2005] EWCA Civ 595*)

Should protection for the personality be a decision for the courts or for the legislator ? As Lindsay J states (in relation to privacy) “...if Parliament does not act soon the less satisfactory course, of the courts creating law bit by bit at the expense of the litigants and with inevitable delays and uncertainty, will be thrust upon the judiciary”.

What are personality and image rights?

- The universal and unique personality right.
- Right of privacy and the right of publicity.
- Image rights are the public expression of the attributes of the personality.

How are image rights expressed?

- Image rights are an integral part of artistic expression, celebrity or sporting achievement.
- Image rights include rights in a person's name, voice, signature, photograph, character or likeness.

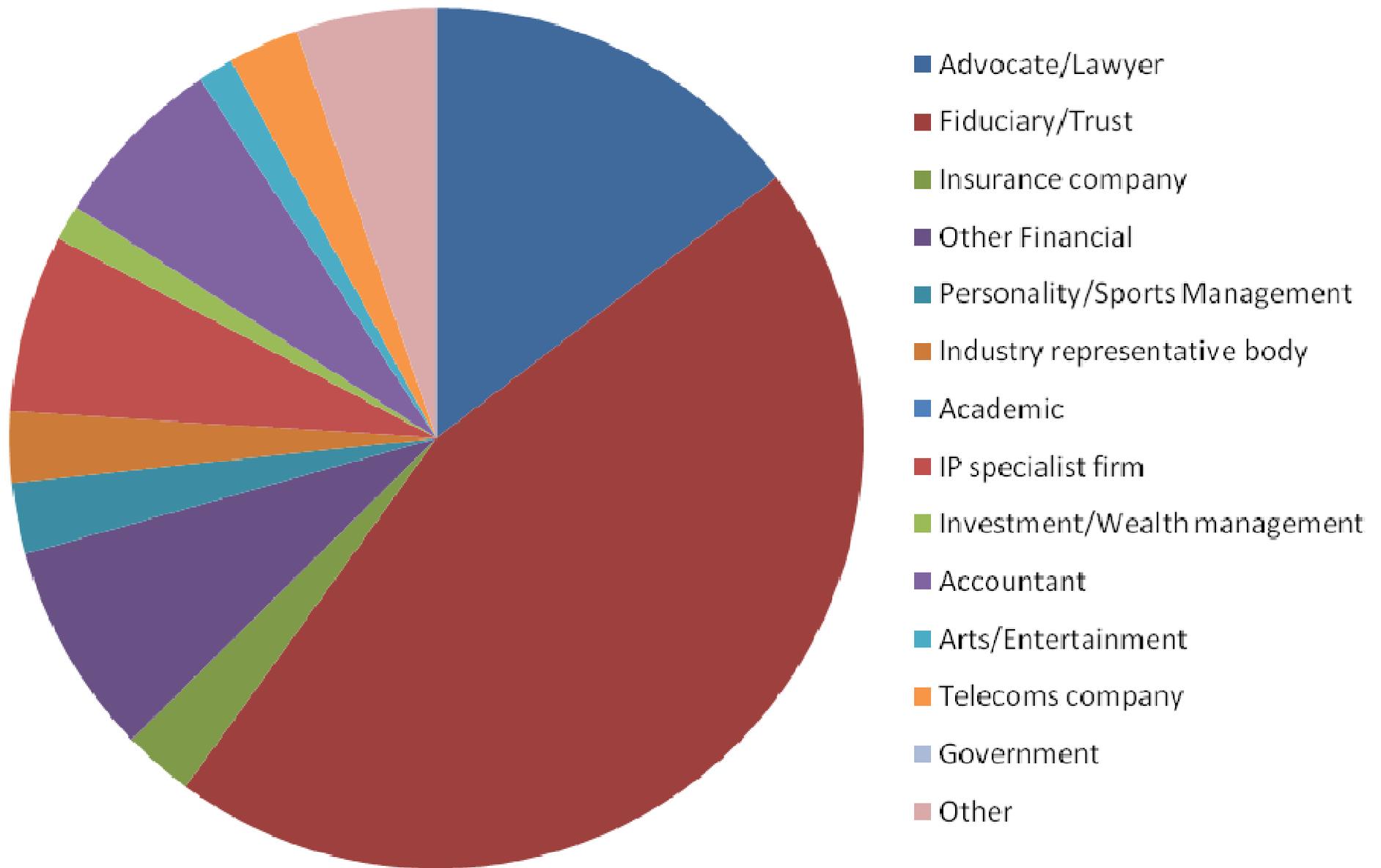
Publicity and Image Rights International Position

- Major parts of contracts involve persons and the public expression of their images.
- UK, Guernsey and Common Law.
- EU and civil law countries.
- USA and sui generis legislation on a state by state basis.

Nature of Image Rights.

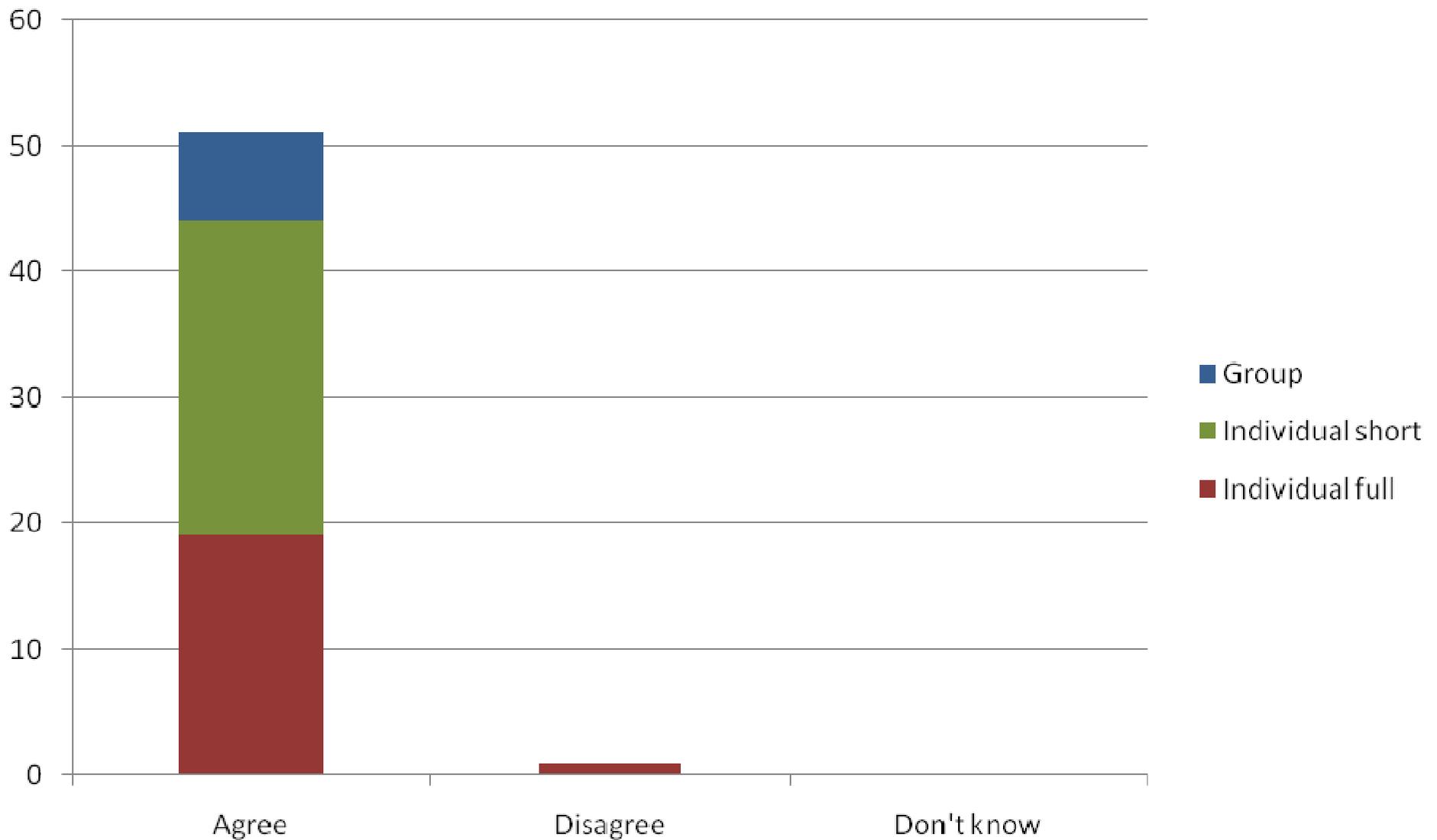
- Considered research.
- International comparisons.
- Maximise the commercial opportunity.
- Consider objections and need for limitations to protect freedom of expression and public interest.

Figure 2: Industry sector of all respondents



Should Guernsey Introduce Image Rights?

Figure 1: Cumulative bar chart showing respondents opinion on whether Guernsey should make special legal provision for image rights?



Market Opportunity

- Image rights are a commercial reality.
- No jurisdiction yet has a law to meet this market need.
- What is needed is a custom made image rights law.
- Guernsey could provide this law.

Research and Consultation

- Culmination of several years research.
- Consultation with commerce and industry.
- Aim to complete and enable image rights into service for 2012.

Personality and Image Rights Earnings.

- Celebrities and sports personalities have two sources of income:
 1. Primary activity arising from their fame, their sporting achievements, their performance in films, modelling etc.
 2. The commercial opportunities which arise from their success in their primary activity.

The Value of Image Rights.

- Product endorsement.
- Character merchandising.
- Corporate merchandising.
- Personal appearances.

Value of Personal Rights and Brand Associations.

Cricket: India's Cricket hero
Sachin Tendulkar signs 1.8
billion rupees (£22m) image
rights deal.

May 2006

Source of Report Sunday Times 5th May.

BuzzyTimes.com

Maximising Brand Value: David Beckham

Beckham Brands Ltd net income £4m on revenue £10m: source 2008 accounts Companies House.

Footwork productions: Endorsements £9.7m including: Adidas AG, Motorola Inc. Sharpie pen company.

Galaxy contract 5 years estimated £160m, playing fees + Marketing revenue: source Bloomberg 2010

Season 2009 Best paid player for 5th time in career at £28m: source France Football 2009.

Corporate Image Rights.

In Arsenal vs Reed: Arsenal used TMs to protect their brand name in association with the club. Image rights would add to the clubs portfolio of protection.



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Personal and Corporate
image rights: Sir Richard is
estimated to be worth £3bn



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States Report : In a nutshell

- Image rights are a commercial reality and very valuable.
- No jurisdiction yet has a law to meet this market need.
- What is needed is a custom made image rights law.
- The law will balance the commercial requirements with the need to protect freedom of expression and news reporting while preserving Island reputation interests.
- The introduction of image rights will benefit high value sectors of commerce and has strong industry support.
- Guernsey should provide this law which is recommended as a drafting priority.

“Pour”

unopposed after very supportive speeches in debate.

Image Rights Environment

- Legislation
- Registration
- Structuring and administration
- Licensing
- Taxation
- Marketing
- International agreements
- Litigation

Registered or Unregistered?

There is a strong case to introduce a registration system for image rights.

- Registration evidences the claims and creates the link in law to Guernsey.
- Opens up the market to rights holders from other jurisdictions.
- An incentive for individuals and businesses to come to Guernsey.

What images should be registrable?

Primary registration should be dependant upon the prior registration of “personality” names rather than the various images associated with personality.

- One registration will cover all associated images.
- It does not matter if a name is distinctive.
- Simple registration process.

Availability of Image Right Registration.

Available to any person, without any public recognition or qualification test.

- Freedom for everyone to register.
- Difficulty of managing short-term celebrity.
- Trade Mark law complication for “well known marks”.
- No difficulty in law in allowing all persons to register.
- Simple registration.

Image rights (Bailiwick of Guernsey) Ordinance 2012

- Personnage, registered personality, image rights.
- Grounds for refusal of registration.
- Application and registration.
- Infringement of image rights
- Limitations and balancing public interests
- Property rights and licensing
- Moral rights
- Image rights agents
- Fees
- Offences
- Inter-operability with other rights
- International

Personnage: Natural Person

The personage of a natural person is:

- a living (or deceased) person, who is the creator or their personality and the person through whom their personality is expressed.
- the first proprietor of their personality and therefore of their registered personality unless this has been assigned prior to another as the prospective owner of the registered personality.

Personnage : fictional.

The personage of a fictional character is:

- a fictional character of a human or non human
- the creator of the fictional character is the first proprietor of the fictional personality.

Personality

The personage becomes recognised under the Ordinance when the personality becomes registered as a “**registered personality**” or is the subject of such an application.



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Personnage

Section 1

- A natural person (living or deceased within 100 years)
- A legal person.
- A joint personality
- A group (team)
- A fictional character



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Registered Personality

Section 2

A registered personality is a property right obtained by the registration of the personality in the Register.

The registration brings into effect in law the:

- Property right
- Protection of the right
- Image rights
- Registered image rights
- Moral rights

Image

Section 3

Name + other names	Voice	Signature	Likeness	Appearance
Silhouette	Feature	Face	Expressions	Gestures
	Mannerisms	Distinctive characteristic	Distinctive attribute	
Photograph	Illustration	Image	Picture	Moving image
Electronic representation (Avatar)	Other representation (Of the personage)			



Image rights

Section 5

- Proprietor of the registered personality has exclusive rights in the images (unregistered and registered)
- Subject to assignment
- Infringed by use ref. S27
- Effect from date of registration of the registered personality
- Effect from date of registration of the registered image rights.



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Grounds for refusal ¹

Sections 6 - 10

Absolute

- Does not satisfy requirements of the Ordinance
- Contrary to public policy / morality
- Specially protected emblem
- Deceptive, bad faith, offence
- Customary in the language, culture, cognizance or trade
- Other requirements ...

Grounds for refusal 2

Sections 6 – 10

Relative

- Existing personalities, existing images and existing rights

Note:

- Applicant / agent responsible for declaration
- Publication process
- Observation and opposition process.
- Provision for same name and identical sibilings.
- Subject to existing rights operates on the principle of first to register.

Application for registration

Section 11 - 13

Made by the personage, personal representative or the prospective proprietor with:

- Request for registration of the personality or image
- Evidence that the application meets the requirements under the Ordinance.
- Declaration regarding existing rights s11 4 (e) and S8
- Personage – natural person: Name, date of birth passport size photo.
- Prospective proprietor: verification of ownership.
- Fee

Registration

S 17 - 26

- Registered after completing examination, publication subject to opposition, observations.
- Subject to appeal to the Court
- Date of filing becomes registration date.
- Published 20 working days.
- Duration:
 - Registered personality 10 years
 - Registered image 3 years
- Renewal of registration therefore potentially an indefinite right as renewed

Infringement

S 27 - 30

Infringed by use for a commercial purpose or a financial or economic benefit.

- Identical or similar – likelihood of confusion
- Unfair advantage
- Detrimental to distinctive character or repute

Protected Image

s27 (2)

- Distinctive.
- Actual or potential value
- Satisfies Ordinance requirement (whether or nor registered)

Distinctiveness

S28

Only “distinctive” images are enforceable.

- Registered images: a presumption of distinctiveness.
- For images which are not registered distinctiveness has to be first proved before infringement proceedings can be considered.
- Recognised as being associated with the registered personality by a wide sector of the public in any part of the world. *Section 28 (2), (3), (5)*.

Distinctiveness: A critical test.

Section 28 (4)

Provisions adapted from WIPO guidelines on well-known marks:

- Level of distinctiveness.
- Publicity associated with the image.
- Use of the image in communication.
- Recognition of the image.
- Actual or potential value.
- Whether the image is registered (public statement of ownership as a claim for a distinctive image).

Note: not distinctive if customary in language or trade: “hoover” effect.

Enforcement (Infringement proceedings)

Sections 41 - 50

- Order to cease production. *Section 42*
- Order for delivery up of infringing goods, publications or articles. *Section 43*
- Order of disposal of infringing goods, publications or articles. *Section 45*
- Damages. *Section 49*

Note:

Right to continue use begun before registration. *Section 50*

Exceptions and Limitations

There are express provisions balancing image rights against other legitimate interests and activities. In particular, safeguarding free speech and other matters of public interest including freedom of news reporting.

Limitations ⁽¹⁾

Sections 31 - 40

- Fair dealing *sections 31 – 32*
 - Parody or satire.
 - News reporting, commentary or other journalistic material.
 - Arts.
 - Research.
 - Other : test in *section 34*

Limitations (2)

Sections 31 - 40

- Comparative advertising
- Incidental inclusion
- Education
- Public administration and law enforcement
- Temporary copies
- Use by proprietor or with consent (contra clause)

Nature of the Right

S51 - 60

Registered personality and registered or unregistered images are property rights which can be:

- Assigned.
- Licensed.
- Capitalised.
- Sold and purchased as for any other item of property.
- Securitised
- Identified with an image rights symbol “IR” : registered rights only.

“IR” Symbol



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Moral Rights

Sections 65 - 77

- Under specified circumstances extend rights beyond “purposes of trade”:
 - Right to be identified as the personality.
 - Right not to be subject to derogatory treatment.
- Natural persons
- Must be asserted
- Not assignable
- Subject to waiver and exceptions

Image rights : applications before Registrar

S96 – S100 + regulations

- Recognition
- Register
- Requirements
 - Registration in person by personage, personal representative or proprietor.
 - Otherwise by agent.

Agents (i)

(S96 – S100 + regulations)

A qualifying person who is : ordinarily resident in the Bailiwick and who is:

- An advocate or member of the Bar of England, Wales, N. Ireland or faculty of Advocates in Scotland.
- A solicitor of the Supreme Court (E,W,NI,S).
- Patent or Trade Mark Attorney.
- A director / manager of a CSP (S 532 Companies Law) who has a level 7 qualification.
- Other such person by reason of qualification or experience.

Agents (ii)

(S96 – S100 + regulations)

A qualifying person who has:

- A business address within the Bailiwick.
- Completed an image rights training course.
- Paid the agent registration fee £500.

Note:

Industry code of practice under consideration.

Offences

S 103 - 107

Note mostly civil remedies but there are some limited areas where criminal remedies apply:

- Falsification of the Register
- Falsely representing a personality or an image as registered
- Criminal liability of directors and partners
- Defence of due diligence.

Fees

S93

Selection of proposed fees:

- Natural person £1,000 for 10 years.
- Legal £5,000 for 10 years.
- Image £100 for 3 years (*proposal for 1st image with registered personality*).
- Series and complex images £200 for 3 years.
- Not for profit 50% reduction.
- Guernsey registered charity free of charge.

The Register (i)

S 78

Available to the public:

- Registered personalities and images.
- Date of registration.
- Renewal date.
- Record whether moral rights are asserted.
- Agent details.
- Licenses.



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The Register (ii)

S 78

Available to the personage, the agent or on application to the Registrar (as for opposition proceedings)

- Proprietor details.
- Assignments.
- Date of birth / inception of personage.

Inter-operability with other rights.

S 112

- Does not take away any other statutory rights.
- Operates “alongside” other rights as for other IP rights.
- With other IP rights can be a supporting right.
- Courts will decide the jurisprudence but it is expected to be as for other IP legislation where parties have different rights.

International ⁽¹⁾ Enforcement.

Bailiwick legislation but may have legal effect beyond the geographical area of the Islands by:

- Enhancing existing protection.
- Contract tying terms back to Bailiwick law.
- Licensing of the Bailiwick image rights.
- Complimentary protection by other IP rights.
- Infringement on the internet, global media possible but use

with care: *section 28 (Distinctiveness and WIPO principles) and section 44 (infringing goods publications or articles).*

International ⁽²⁾ Opportunities

- Importance of transparency and availability of the images on the Registry.
- The structuring, licensing and managing of the image rights is the key opportunity.
- Many opportunities for “selling” Bailiwick professional services.

Risk

- Professional.
- Reputational.
- Societal.
- Legal.
- International.

Risk Mitigation & Management

- Legislation.
- Registration and register.
- Applicant / Agent.
- Training.
- Marketing message.
- Code of conduct.
- Industry practice.
- International presence and communication.

Image Rights Value chain:

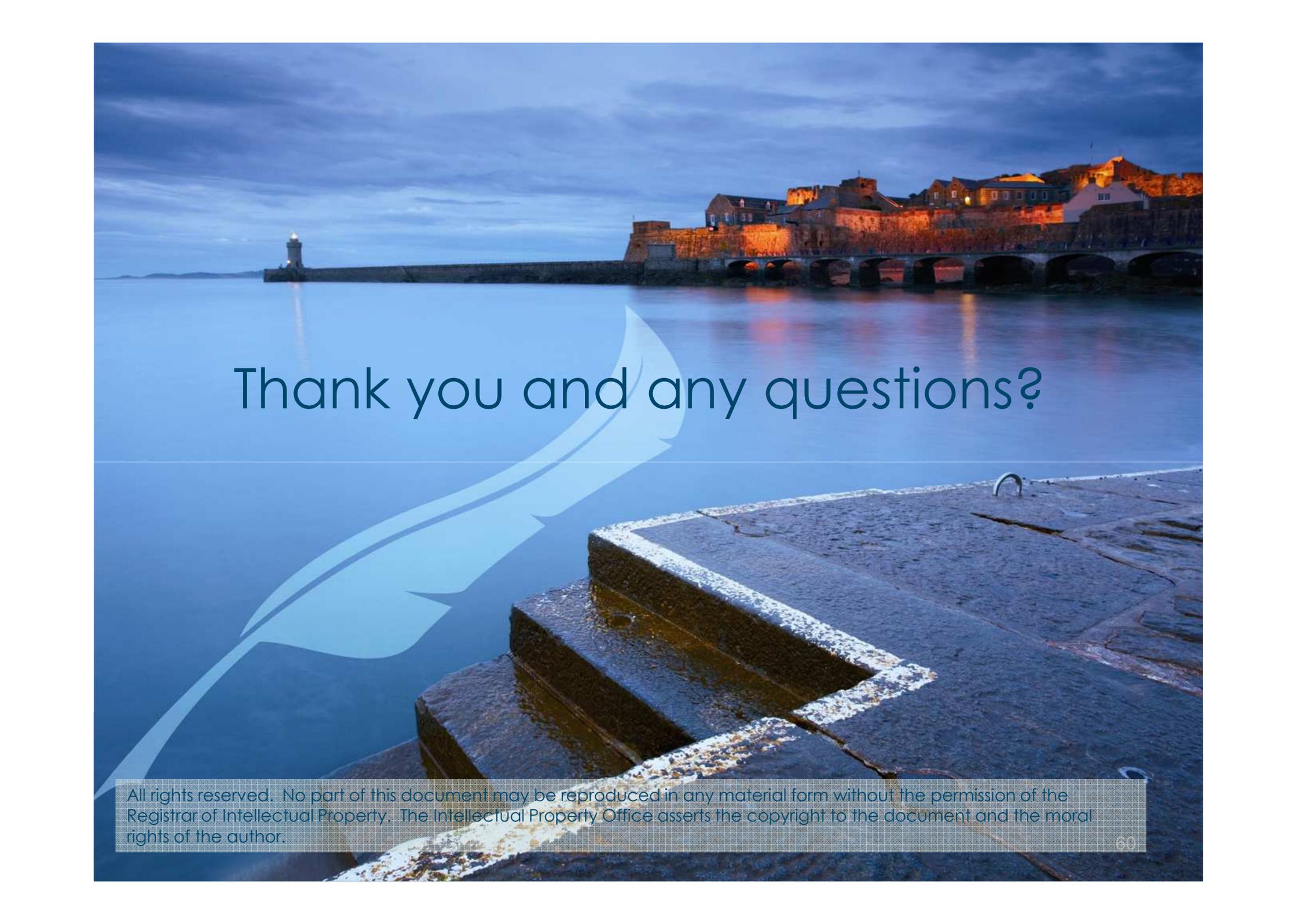
Personality (Sports, Media, Celebrity)
Manages image rights in Guernsey under new Image Rights Legislation



Legal Provision for Image Rights

Enacting an image rights ordinance will:

- Create Market opportunity.
- Provide a new high value product.
- Be a global U.S.P.
- Add wealth management services.
- Be complimentary to the skills and industry base.



Thank you and any questions?

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