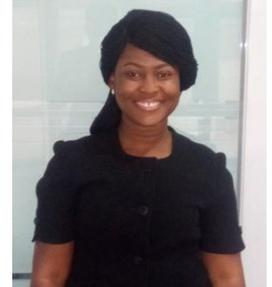




Intellectual Property
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A REVIEW OF SOME LEGAL ISSUES ARISING FROM THE USE OF CELEBRITY IMAGES FOR COMMERCIAL PURPOSES IN NIGERIA¹

1. INTRODUCTION

Celebrities often have two streams of income, one for the work they are known for (like acting, singing, dancing, stand-up comedies etc.) and the other, from endorsement deals and sponsorships. This second and, often, more important stream of income derives from the “image” and personality that these celebrities have built over time. For example, David Beckham’s estimated earnings as at 2009 from endorsements and advertisements alone is stated to have exceeded his earnings from playing football.² These unique characteristics such as the appearance, voice, use of certain catchphrases etc., make up a celebrity’s image, and this image most times compel their fans and followers to patronize products and services to which they are associated. These intangible proprietary rights are very essential to celebrities, as research has proven that it contributes to the bulk of celebrity income.³

2. WHAT IS IMAGE RIGHT

Image rights (also known as the right of publicity in the United States) refer to a person’s right to commercialize aspects of his/her personality such as physical appearance, pictures or caricatures, signature, voice, personal logos and slogans, and the right to prevent other people from commercially making use of them without

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² (2018) “Personality Rights” available at <https://www.lawteacher.net/free-law-essays/criminology/personality-rights.php> accessed on 20th May 2019.

³ Samantha Leal, (2015), “Here’s How Celebrities REALLY Make Their Money” available at <https://www.marieclaire.com/celebrity/news/a13594/5-surprising-ways-celebs-make-their-money/> accessed on 29th April 2019.

authorization.⁴ It is simply the right of a person to control the public commercial exploitation of his or her identity.

Image rights are equivalent to property rights. The very notion that property rights can vest in an individual's personality imply conversely that attributes of that personality cannot be appropriated without prior permission, as with other kinds of property rights.⁵ It is important to note that "it is celebrities who have mostly instituted and won image rights cases".⁶ This is not to suggest that persons who are not celebrities have no image rights; however, one will find that the ability of a claimant to adequately demonstrate the enjoyment of goodwill or considerable influence might be factors to be considered in any image rights action.⁷

To show Infringement of image rights, a plaintiff must prove: (1) Validity - that the plaintiff owns an enforceable right in the identity or persona of a human being; and (2) infringement - (a) that the defendant, without permission, has used some aspect of the plaintiff's identity or persona in such a way that the plaintiff is identifiable from the defendant's use; and (b) that defendant's use is likely to cause damage to the commercial value of that persona.⁸

3. IMAGE RIGHTS IN NIGERIA AND OTHER JURISDICTIONS

Even though there is no statutory provision for image rights in the United Kingdom, there are some decided cases on the subject matter that can be of persuasive effect in Nigeria. The case of **Robyn Rihanna Fenty & Ors. v. Arcadia Group Brands Limited (T/A TOPSHOP) & Anor.**,⁹ gives us a clear view into the present position of English law in respect of image rights. In this passing off action, the Defendant, a well-known fashion retailer, started selling a t-shirt with the Claimant's image in March 2012. The image in dispute was a photograph taken by an independent photographer. The Defendant, Topshop, had a licence from the photographer who took the Claimant's pictures; but it did not have a licence from the Claimant. The Claimant contended that the sale of this t-shirt without her permission infringed her

⁴ See Section 32-36-1-7 of the Indiana Code - Right of Publicity statute. See also Prince Alex-Iwu, (2017) "Photo Privacy & Media/Image Rights in Nigeria" available at <http://barcode.stillwaterslaw.com/1.1/2017/04/01/photo-privacy-and-mediainage-rights-in-nigeria/> accessed on 23rd April 2019.

⁵ *Ibid.*

⁶ Prince Alex-Iwu, (2016) "The Legal Regime for the Enforcement of Image Rights - A Nigerian Question " available at https://www.academia.edu/12605016/THE_LEGAL_REGIME_FOR_ENFORCEMENT_OF_IMAGE_RIGHTS_-A_NIGERIAN_QUESTION accessed on 13th April 2019.

⁷ *Ibid.*

⁸ S. Hines and C. Steiner (2012) "Life After Death- Right of Publicity Law" available at <https://www.artlawgallery.com/2012/04/articles/intellectual-property-copyright-and-moral-rights/life-after-death-right-of-publicity-law/> accessed on 25th April 2019.

⁹ [2013] EWHC 2310 (Ch).

rights.¹⁰ At the conclusion of the trial, the Court found for the Claimant when it held in the following words:

“The mere sale by a trader of a t-shirt bearing an image of a famous person is not, without more, an act of passing off. However, the sale of this image of this person on this garment by this shop in these circumstances is a different matter. I find that Topshop’s sale of this Rihanna t-shirt without her approval was an act of passing off.”¹¹

This judgment was upheld on appeal. It is worthy of note that Judge Briss in his Judgment above, had earlier clarified that this case was one of passing off and not an infringement of Image Right *stricto sensu* because according to him:

“...there is today in England no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image”.

In the United States of America, various states have developed a wide legal framework to prevent the exploitation of the economic benefits attached to the use of a person’s image.¹² In the US, these rights are known as the Right of Publicity. Under the Indiana Statute, for instance, persons entitled to this right of publicity are called “Personalities” (otherwise known as Celebrities).¹³ There are also several robust judicial authorities on the subject matter.

In **John W. Carson v. Here’s Johnny Portable Toilets Inc.**,¹⁴ the court stated that, *“the right of publicity is that a celebrity has a protected pecuniary interest in the commercial exploitation of his identity. If the celebrity’s identity is commercially exploited, there has been an invasion of his rights.”*

There is no specific law on image rights in Nigeria. The closest law would be the “Right of Privacy” provided for in section 37 of the 1999 constitution, as amended.

¹⁰ A. Adetula, (2016) “Image Rights and IP in Nigeria” available at <http://barcode.stillwaterslaw.com/1.1/2015/12/21/image-rights-and-ip-in-nigeria/> accessed on 18th April 2019.

¹¹ *Ibid.* In this case, the court held that the plaintiff had ample goodwill to succeed in a passing off action of this kind, because the plaintiff was a world famous pop star who ran very large merchandising and endorsement operations and was regarded as a style icon by many people. Such people were interested in what they perceived to be the plaintiff’s views about style and fashion. If she was seen to wear or approve of an item of clothing, that was an endorsement of that item in the minds of those people.

¹² *Ibid.*

¹³ The Statute defines a Personality as a living or deceased natural person whose name, voice, signature, photograph, image, gesture etc. has commercial value.

¹⁴ 810 F.2d 104 (1987).

There is also no known judicial authority on image rights in Nigeria. Due to this dearth of judicial and statutory provision on Image Rights in Nigeria, one can arguably say that there may not be compensation under Nigerian law (unless reference is had to English case law) if an action is instituted for the unauthorized violation of a person's image rights. On the contrary, where a person's image is registered as a device/logo at the Nigerian Trade Marks Registry, an unauthorised use of that trademark would amount to an infringement under the Nigerian Trade Marks Act.¹⁵

4. **COPYRIGHT OF A PHOTOGRAPHER v. THE IMAGE RIGHT OF A CELEBRITY**

By virtue of Section 39 of the Nigerian Copyright Act,¹⁶ the copyright in a photograph belongs to the person that took the picture, i.e. the photographer.¹⁷ The photographer is the owner of the pictures and as such, he possesses exclusive control over that picture.

Based on the foregoing provision, where a photographer takes a photograph of anything or person including a celebrity, he has copyright over that photograph and can make use of it as he likes. However, since the image right of a celebrity is also recognized in most jurisdictions, there exists concurrent rights over the picture of the celebrity, which can give rise to a conflict of rights, and in such case, one would have to decide which of these rights take priority: the photographer's copyright or the celebrity's Image Right?

In **Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.**,¹⁸ the estate of Marilyn Monroe brought an action against the Shaw Family Archives ("SFA"), which is owned by the children of the late photographer Sam Shaw, who took (and owned the copyright in) several of the most famous images of Marilyn Monroe. Monroe's estate alleged that SFA violated Monroe's publicity rights under Indiana's Right of Publicity Act because it sold T-shirts at a Target store in Indianapolis bearing Monroe's photograph and operated a website through which customers could purchase licenses for the use of Monroe's image on various commercial products.¹⁹ The United States District Court for the Southern District of New York found that in 1962,

¹⁵ Section 5 (1) (2) of the Trade Marks Act, Cap T 13, Laws of the Federation of Nigeria 2004

¹⁶ Cap C28 Laws of the Federation of Nigeria 2004.

¹⁷ There are certain circumstances where the copyright might not vest in the photographer. See section 9 of the CA.

¹⁸ 486 F. Supp. 2d 309, 2007, 15 Vill. Sports & Ent. L.J. 299 (2008).

¹⁹ S. Edelman (2007) "Death Pays: The Fight over Marilyn Monroe's Publicity Rights" available at <https://ccbjournal.com/articles/death-pays-fight-over-marilyn-monroes-publicity-rights> accessed on 26th April 2019.

the year Monroe died; New York did not recognize a transferable post mortem right of publicity. The court found that since the right of publicity did not exist, Monroe did not possess the right when she died; therefore, her Will conveyed no rights to her heirs. This finding defeated any claim of ownership and thrust Monroe's persona into the public domain, where anyone is free to use it.²⁰

Flowing from the above decision, it would appear that where the image right or post mortem image right of a celebrity is statutorily recognized and protected, such right in the event of a conflict or action for infringement, will take priority over that of the Photographer who took the images. Conversely, lack of any legislative enactment on Image Rights presupposes the absence of a cause of action or right on the part of the celebrity.

This writer holds the view that the image right of a person is still enforceable despite the absence of an existing legislation on image rights.²¹ The Nigerian constitution²² for example, provides for the right of privacy of an individual. It reads as follows:

“The privacy of citizens, their homes, correspondence, telephone conversations and telegraphic communications is hereby guaranteed and protected.”

Flowing from the above provision, any intrusion of personal life by whatever means or form such as photography, written articles or caricatures may be ground for an action for breach of the right to privacy. Therefore, an unauthorised photograph of a person can constitute an invasion of a person's privacy and the celebrity in this case can protect his image from being used without his or her consent.

Likewise, where there is a contract of employment between the photographer and the celebrity, the rights to those images will be owned by the employer (the celebrity) and he or she therefore possesses exclusive control over the image and can bring an action for breach of contract where the photographer uses the pictures without authorization.

In summary, a celebrity can protect and enforce his or her image rights even though there are no express statutory provisions on the subject matter. In the United Kingdom where there is no law on Image rights, different legal approaches have

²⁰ G. Weyer (2008) “Marilyn Monroe and the right of Publicity” available at https://lawprofessors.typepad.com/trusts_estates_prof/2008/07/marilyn-monroe.html accessed on 25th April 2019.

²¹ India, just like Nigeria, does not have any specific legislation on Image rights. However, the Indian courts through its judgment recognize the existence of this right as it is deemed as an inherent part of the right of privacy, which is a constitutional right.

²² Section 37 of the 1999 Constitution of Nigeria as amended.

been adopted by celebrities to address this issue. Some of these alternative approaches include passing off, Trademarks, Privacy and Data Protection, Defamation, Advertising and Contract.

5. IMAGE RIGHTS OF DELEBS (DECEASED CELEBRITIES)

Usually, when an iconic celebrity passes away, their memory lives on with their fans and in many cases, we see a celebrity's fan base increase post mortem.²³ Companies have caught on to this and are capitalizing on it by using images of deceased celebrities in their branding tactics and other initiatives. This speaks to the consumer preference for nostalgia, and perhaps of deceased celebrities who represent a lifestyle or dream.²⁴

Post mortem right of publicity exist beyond the death of a celebrity and are protected by and in many states in the United States. The various states where the law applies deal with the right of publicity differently. For example, while California provides for post mortem rights of publicity for 70 years, Florida, Illinois, Indiana gives 40, 50 and 100 years respectively, while New York does not recognize post mortem Image rights.

From the decision of the court in the famous *Elvis Presley's case*,²⁵ it is clear that the Image right of a person can be bequeathed as part of their legacy, thereby enabling heirs to continue appropriating these rights even after their death.

Forbes now runs an entire website devoted to "top-earning dead celebrities." More than a few notable celebrities are monetarily worth more dead than alive.²⁶ Coming in at No. 1 on the Forbes top-earning dead celebrities list is the "King of Pop," Michael Jackson. The list put the total 2009 earnings of Michael Jackson at \$275 million, Elvis Presley \$60 million, Steve McQueen \$6 million, Marilyn Monroe \$8 million and Albert Einstein's earnings, at \$10 million.²⁷

²³ R. Strand, (2016) "Guide to Deceased Celebrity Licensing" available at <https://www.brandingstrategyinsider.com/2016/07/10748.html#.XOV-H9JKJIU> accessed on 12th April 2019.

²⁴ *Ibid.*

²⁵ *Elvis Presley Enterprises Incorporation. v. Capece*, 950 F.Supp. 783 (S.D.Tex.1996). The Plaintiff, Elvis Presley Enterprises Inc. (EPE), is the assignee and registrant of all trademarks, copyrights, and publicity rights belonging to the Elvis Presley estate. The defendant, Capece, opened a nightclub named "The Velvet Elvis" where Pictures and iconic references to Elvis Presley were widely used. The Elvis Presley estate brought an action for trademark infringement and violation of his right of publicity. The court ruled in favor of EPE on its right of publicity claim in relation to the use of Elvis's name and likeness.

²⁶ R. Strand, (2016) "Guide to Deceased Celebrity Licensing" available at <https://www.brandingstrategyinsider.com/2016/07/10748.html#.XOV-H9JKJIU> accessed on 12th April 2019.

²⁷ A. Kirsta, (2012) "Selling the dead", available at <https://www.telegraph.co.uk/finance/9056455/Selling-the-dead.html> accessed on 25th April 2019.

6. CONCLUSION

The images of celebrities often generate a fortune in licensing fees for advertising, endorsement, and promotion of business entities. These images are valuable as their association to products or services attracts valuable gains to the product owners. Consequently, since a bulk of the income of celebrities is often derived from their image rights, celebrities are very keen on protecting this right from infringement.

Moreover, like in trademark infringement, where the image of a celebrity is associated with a brand without authorisation, it might cause confusion in the mind of the consumers who might erroneously believe that the celebrity is endorsing such brand. This misuse may also interfere with the celebrity's contractual relations where he or she is perceived to have endorsed a competing brand after signing an endorsement deal with a particular brand. The importance of the protection of this right cannot therefore be overemphasized and like other intellectual property rights, image rights should be legally acknowledged and protected in Nigeria.

However, pending the enactment of an image rights law in Nigeria, celebrities can adopt the alternative means discussed in this paper to protect their identities from misappropriation. It is also my expectation that when the opportunity arises, the Nigerian courts will take the initiative from India and not only recognize but also enforce this right notwithstanding lack of a specific law on the subject matter.

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