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FASHION QUEEN – MAYER BROWN EXAMINES RIHANNA’S VICTORY AGAINST TOPSHOP AND ITS IMPLICATIONS

By Sarah Byrt and Richard Assmus

Rihanna’s much-publicised High Court victory against high street retailer Topshop, over the sale of T-shirts bearing her photo, takes the UK law of passing off another step forward in the protection of image rights in practice, if not in strict legal theory. Whilst the judge made clear that UK law has no stand-alone image rights as such (applying *Douglas v Hello*², concerning the “spoiler” photos of Michael Douglas’ and Catherine Zeta-Jones’ wedding), the application of traditional principles of passing off law to this case reached a similar end result. The judgment will surely help other celebrities trying to control their image and maximise their revenues from brand endorsement. The more difficult legal issue is exactly where to draw the line, since there were a number of factors in the case which were specific to Rihanna or to Topshop and which will not be present in every case.

Background

Topshop sold a range of fashion T-shirts with “iconic images”, some licensed and some unlicensed (as with the Rihanna garment). In spring/summer 2012, it sold some 12,000 T-shirts featuring a striking photo of Rihanna’s face, for a retail price of £22. The product sold out.

Rihanna had been photographed without her consent during the video shoot for “We found love”, with the all-important result that the photo used on the T-shirt was similar to those used in promotional materials for her album (notably, her hairstyle and headscarf were the same).

Causes of action

Rihanna had to rely solely on passing off. She did not own copyright in the “papped” image; no breach of privacy issue arose out of the way the photograph was taken (unlike *Creation Records v. News Group*², in which Oasis’ record company was found to have an arguable case for breach of confidence when a photographer gained unauthorised access to the roped-off album shoot for “Be Here Now”); there was no defamation and neither her name nor her logo (both trade marked) had been used (other than the word RIHANNA for a few days on line, after which Topshop used a generic description). This meant that, of the mosaic of possible arguments which a celebrity might use to protect his or her image under UK law, only one was available to her.

The elements of passing off

Rihanna, like many celebrities, had ample goodwill protectable via a passing off claim and her goodwill extended beyond the world of music into fashion. As well as a multi-million dollar merchandising agreement, the star has a tie-up with River Island (her third collection comes out in that high street store in September) and had earlier collaborated with designer labels.

The crucial issue for passing off was whether there was a “misrepresentation”. In his judgment, Mr Justice Birss repeatedly emphasised that not every use of a celebrity’s image on a T-shirt will give rise to passing off. “There is no



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¹ [2007] UKHL 21

² [1997] EMLR

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automatic assumption that a product of this kind has been authorised” and it is not enough that the consumer recognises that the photograph is of Rihanna: “There must be a misrepresentation about trade origin”. That false belief must then play a part in the consumer’s decision to buy. (There was no suggestion that Topshop had deliberately tried to give the impression of an authorised product.)

These are classic principles, but as the world of brand endorsement develops apace, it must surely become increasingly straightforward for celebrities to pull themselves up by their boot straps and say: “Everyone knows that stars do endorsement deals; I license my image on this kind of product and my fans know that; people seeing this product would think I must have endorsed it; therefore there is a misrepresentation”. The law does not, as yet, work on that basis.

Topshop argued unsuccessfully that, had this been an officially endorsed product, this fact would have been made abundantly clear on the T-shirt and its labelling. Evidence also showed that the distinction which existed around 10 years ago between conventional tour T-shirts (with tour dates screen printed on normal T-shirts) and fashion clothing (more designed and higher quality) was now blurred, so that there could be passing off even in the case of a fashion item.

Rihanna’s legal team accepted as a general proposition that the use of her image did not necessarily make a representation that the product had been authorised by her, but there were specific circumstances in this case, as follows:

- The particular photo used, in which Rihanna was looking directly at the camera, was similar to that used in her album promotional materials and the image was “not just recognisably Rihanna, it looks like a publicity shot for what was then a recent musical release”. It could therefore be thought to be part of the marketing for the album – a key factor, if not the deciding point in the case.

- Rihanna’s status as a fashion icon and her activities as a fashion designer and tie-ups with fashion retailers increased the chance of a misrepresentation.
- Topshop is not just a major high street retailer (where one might expect to buy authorised goods, unlike, say, on a market stall) but had carried out a promotion involving Rihanna in 2010, and had had a collaboration with Kate Moss. It had enthusiastically Tweeted to its 350,000 followers when Rihanna went shopping in its flagship Oxford Circus store in 2012, thereby “seeking to take advantage of [her] position as a style icon” and illustrating the “symbiotic” relationship between celebrities and stores.

Together, these particular factors were found to have created a real likelihood of deception in the passing off sense.

Implications

Since *Irvine v Talksport*³ (in which Eddie Irvine successfully objected to the unauthorised use of his image in a mailshot), it has been clear that the principles of passing off are capable of being applied to cases of false endorsement. Use in advertising is quite likely to give rise to a misrepresentation; the whole context is likely to give the impression of an endorsement. T-shirts are not the same and can have a “fan” meaning for the consumer without necessarily having an endorsement meaning.

There is a difficult balancing act to be carried out in future cases. The judgment in this fact-dependant case does not mean that all bets are now off for this kind of T-shirt. Not all garments will echo album marketing materials and not all retailers have a reputation for collaborations with celebrities in the way Topshop does.

Artists will be on stronger ground where, like Rihanna, they can point to extra factors linking themselves to the world of fashion and linking the image used to an authorised one. Even without that extra ammunition, in practice, they now have a useful judgment which they or

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their companies can brandish at alleged infringers, who will find themselves on the back foot. Faced with a potential claimant who is likely to be wealthy and who will have every incentive to protect his or her merchandising and endorsement revenues (perhaps particularly music stars who want to exploit these revenue streams, given falling music sales), retailers may decide to take the easy way out rather than face what is now more of an uphill struggle in defeating a passing off claim. The stakes will be even higher where copyright or trade mark issues can be added to the mix.

Artists will be well advised to obtain trade marks for their names and logos and to try and avoid paparazzi infiltrating photo shoots. Retailers on the other hand should at all costs avoid images which resemble album artwork and video shoots, as well as images and names which are trade marked for the relevant products; they should also steer clear of the “looking at camera” kind of image. Although disclaimer labelling along the lines of “this is not an authorised product” will not avoid trade mark infringement, if used properly, it can neutralise a passing off claim.

Where products are designed by third parties, retailers should insist on an indemnity against all forms of IP infringement. It is not surprising to hear that Topshop apparently has an indemnity from its supplier for whom Topshop is a major customer, so one can imagine that the financial burden will fall fairly and squarely on that company (although prices may rise as a knock-on effect).

As usual, damages are yet to be assessed but are likely to be based on some kind of notional licence fee, starting at the kind of sum for which a star of Rihanna's renown would be prepared to “get out of bed”.

What if this had taken place in the US?

In the United States, Rihanna would have relied on her right of publicity as the primary cause of action. Unlike the position in the UK, where image rights are still subsumed into passing off which then requires a misrepresentation (the issue at the heart of this case), the US courts and statutes have decoupled these two concepts, making it easier for celebrities to protect their image. In the United States, “the right of publicity is [seen] as the inherent right of every human being to control the commercial use of his or her identity”⁴. It is a purely commercial right, infringed when: (1) the plaintiff owns a valid and enforceable right in his or her identity; (2) the defendant uses an image, name, etc. in a manner that identifies the plaintiff; and (3) that use is likely to cause damage to the commercial value of the plaintiff's persona.

The provenance of the image at issue is not necessarily a consideration in a right of publicity case. In the United States, acquiring a photograph through an unauthorized intrusion gives rise to a separate cause of action (right of privacy). Here, even if Rihanna had acquiesced to the photo being taken, as long as she did not permit its use on the T-shirts, her right of publicity claim would likely remain intact.

This claim is distinct from false designation of origin (similar to passing off), false endorsement (recognised in some US courts), and trade mark infringement. The latter all require misrepresentation by the defendant, whereas a right of publicity case merely requires that consumers actually identify the plaintiff based on the defendant's usage. Rihanna, as a well-known celebrity, is clearly identifiable from the Topshop shirts, and these unauthorized sales likely affected her ability to sell similar merchandise or otherwise exploit her proprietary rights in her persona. It follows that a US court would be likely to find that her right of publicity was infringed, entitling her to an injunction and compensation.

⁴ *Miller v. Glenn Miller Productions, Inc.*, 454 F.3d 975, 988–89 (9th Cir. 2006)

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US false designation of origin and false endorsement claims are as fact-driven as their UK counterpart since both require a degree of misrepresentation regarding Rihanna's sponsorship or the underlying origin of the Topshop shirts. Given the nuanced details in this case, Rihanna would have likely succeeded under these claims as well. Celebrities therefore have more weapons in their armoury across the Atlantic, although in this particular case, UK concepts of passing off were enough to protect a famous image.

Case reference: *Robyn Rihanna Fenty and others v Arcadia Group Brands Ltd (t/a Topshop) and another* [2013] EWHC 2310 (Ch), 31 July 2013

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