



Where defamation or privacy don't fit the facts, to what extent are claimants relying on IP or data protection to safeguard reputations?

Romana Canneti, 4KBW

Intellectual Property Rights

What are intellectual property rights?

- Protect your skills, creativity, product or even your investment.

Statutory intellectual property rights largely governed by:

- The Copyrights Designs and Patents Act 1988
- The Trade Marks Act 1994
- The Comparative Advertising Directive as implemented in the UK by the Business Protection from Misleading Marketing Regulations 2008 (SI 2008/1276)
- Non-statutory: tort of passing off (protects unregistered rights).

Copyright



- The Copyright, Designs and Patents Act 1988 includes provisions referencing reputation and privacy.
- S80(2)(b) protection from derogatory treatment: *“the treatment of a work is derogatory if it amounts to distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author or director.”*
- “Treatment” defined by Mr J Fyshe in *Harrison v Harrison* [2010] EWPCC 3 at [60]: *“treatment of a work is a broad, general concept...[that]...implies a spectrum of possible acts carried out on a work, from the addition of, say, a single word to a poem, to the destruction of the entire work.”*
- Whether treatment is derogatory is an objective test which requires evidence although no requirement for serious harm.
 - *Tidy v Trustees of the Natural History Museum* (1995) 39 I.P.R. 501.
 - *Confetti Records Ltd v Warner Music UK Ltd* [2003] EWHC 1274 (Ch) per Mr J Lewison at [150]: *“the mere fact that a work has been distorted or mutilated gives rise to no claim, unless the distortion or mutilation prejudices the author's honour or reputation.”*
 - Cf. *Delves-Broughton v House of Harlot Ltd* [2012] EWPCC 29 which is unlikely to be followed.

Copyright



- S84(1) of the Copyright, Designs and Patents Act 1988 makes false attribution of a work actionable.
- *Clark v Associated Newspapers Ltd* [1998] EWHC Patents 345 but NB the new fair dealing defence in s30A.
- Earlier examples of false attribution claims brought under s43 of the Copyright Act 1956:
 - *Noah v Shuba* [1991] F.S.R. 14
 - *Moore v News of the World* [1972] 1 Q.B. 441
- S85 of the Copyright, Designs and Patents Act 1988, specific privacy provision that protects those who – for private and domestic purposes – commission “*the taking of a photograph or the making of a film*” .
 - *Trimingham v Associated Newspapers* [2012] EWHC 1296 (QB)
 - NB Tugendhat J on commissioning connotating an obligation to pay

Copyright - remedies

- Copyright is a property right
- A Claimant can seek:
 - Damages
 - Injunctions
 - Accounts for usage
 - Delivery up
 - Destruction of infringing copies

Copyright - defences

- Most relevant found in s30 which allows for fair dealing of a work for the purpose of news reporting, criticism or review – provided the work has been made available to the public and is accompanied by a sufficient acknowledgement (s.30(1) and (2)).
- S171(3) allows for a public interest defence: *“Nothing in this part affects any rule of law preventing or restricting the enforcement of copyright on grounds of public interest or otherwise.”*

Copyright - CDPA s171(3)



- *Hyde Park Properties v Yelland; Hyde Park Properties v Yelland R.P.C.* (1999) 116(18) 655–672 and Case No 1999/0459/3 Court of Appeal
 - Precursor to the proportionality balancing exercise and pre-Human Rights Act 1998.
 - Concerned stills taken from a videotape of Princess Diana and Dodi Al-Fayed visiting his father’s villa in Paris, published by The Sun in 1998 under the headline “*Video That Shames Fayed*”.
 - Per Lord Justice Aldous at [67] “...*Perhaps the driveways stills were of interest to the public... but there was no need in the public interest in having them published.*”
 - Court’s inherent jurisdiction limited to where enforcement would offend public policy or the law.

Copyright - CDPA s171(3)



- *Ashdown v Telegraph Group* [2001] EWCA Civ 1142
 - Action for copyright infringement and breach of confidence after the Sunday Telegraph published extensive extracts from his confidential record of a meeting at 10 Downing Street in 1997.
 - At [58] “...Now that the Human Rights Act is in force, there is the clearest public interest in giving effect to the right of freedom of expression in those rare cases where this right trumps the rights conferred by the Copyright Act. In such circumstances, we consider that s.171(3) of the Act permits the defence of public interest to be raised.”

Copyright - CDPA s171(3)



HRH The Prince of Wales v Associated Newspapers (No.3) (CA), HRH The Prince of Wales v Associated Newspapers (No.3) (CA) [2006] EWCA Civ 1776

- Mail on Sunday's attempts to publish the Prince of Wales' private journals.
- S30(2) fair dealing defence failed because article had no bearing on current events; s30(1) defence also failed because of limited private circulation.
- S171(3) "public interest" defence – the newspaper argued that no commercial interest was at stake and Prince Charles should not be permitted to rely on his copyright in order to protect his privacy. Failed at first instance and on appeal.

Copyright - CDPA s171(3)



- *Unilever plc v Nick Griffin* [2010] EWHC 899 (Ch)
 - Action for trade mark infringement, passing off and copyright brought by the manufacturer of Marmite against Nick Griffin.
 - Injunction granted.
 - Arnold J said of the s171(3) “public interest” defence “...as it presently exists in English law it is somewhat limited...[but] there may be room for further development, particularly in a political context such as this.”

s171(3)

- Don't forget public interest defence in copyright if the facts fit.
- Judge receptive to argument in recent case, prompting C to settle.

Image Rights

- In European law individuals have the right to control the use of their image under Article 8 of the European Convention on Human Rights.
- Acknowledged in both *Von Hannover* cases:
 - In the first *Von Hannover v Germany* case (Application no. 59320/00) the judges commented at [72] *“In any event the Court considers that, in these conditions, the Act* has to be interpreted narrowly to ensure that the State complies with its positive obligation under the Convention to protect private life and the right to control the use of one’s image.”*
 - In *Von Hannover v Germany (No.2)* (2012) 55 E.H.R.R. 15 at [96] the judges noted *“The right to the protection of one’s image is thus one of the essential components of personal development. It mainly presupposes the individual’s right to control the use of that image”*.
- *s22 of the German Copyright (Arts Domain) Act 1965. The Copyrights Designs and Patents Act 1988 has no equivalent.

Image Rights in the UK?

- *Campbell v MGN Limited* [2004] UKHL 22; [2004] 2 AC 457; [2004] 2 WLR 1232; [2004] EMLR 247 per Lady Hale at [134]: “...*Inside its [Convention balancing exercise’s] scope is what has been termed the protection of the individual’s informational autonomy’ by prohibiting the publication of confidential information...*”
- *Douglas v Hello* [2005] EWCA Civ 595, QB 125:
 - At [113] the Court of Appeal said “*Recognition of the right of a celebrity to make money out of publicising private information about himself, including his photographs on a private occasion, breaks new ground. It has echoes of the droit à l’image reflected in ...[the] French Code Civil and the German cause of action...describe[d].. as the ‘tort of publicity claim’...*”
 - In the House of Lords, Lord Hoffman quashed the idea of an English image right at paragraph 124 “*Is there any reason of public policy why the law of confidence should not protect information of this form and subject-matter? There is in my opinion no question of creating an “image right” or any other unorthodox form of intellectual property.*”
- Concept of loss of control [mooted also in *Douglas*]: *David Murray (by his litigation friends David Murray and Joanne Murray) v Big Pictures Limited* [2008] EWCA Civ 446.
 - Claim brought by J K Rowling and her partner on behalf of their baby son who had been snapped in his buggy by paparazzi.
 - In deciding in favour of the child’s reasonable expectation of privacy, Sir Anthony Clarke made clear that the court was not creating an image right (at [54]).

“Image Based Abuse”

- New phrase coined in a judgment given on 23 February 2023 by Mrs Justice Thornton in *FGX v Stuart Gaunt* [2023] EWHC 419 (KB).
- Claimant granted £60,000 in general damages for PTSD and psychiatric damage, as well as £37,041.61 in special damages to reflect consequential financial losses.

Passing Off



- *Fenty v Arcadia Group Brands* [2015] EWCA Civ 3.

- Claim for passing off brought by Rihanna against Topshop's owner. Topshop was selling a t-shirt carrying an image of the singer taken from a still from a video shoot, licensed to Topshop by the photographer.
- At [43] Lord Kitchin summarised the three elements of a passing off claim:
 - “[A Claimant] must show
 1. that he has a relevant goodwill,
 2. that the activities of the defendant amount to a misrepresentation that he has endorsed or approved the goods or services of which he complains, and
 3. that these activities have caused or are likely to cause him damage to his goodwill and business.”
- Finding for Rihanna, at [29] Lord Kitchin confirmed “There is in English law no “image right” or “character right” which allows a celebrity to control the use of his or her name or image.”
- Cited leading case of *Reckitt & Colman Products Ltd v Borden Inc & Ors* [1990] R.P.C. 341 (lemon juice claim).
- At [37] Lord Kitchin found that “...here Rihanna contended that she had a reputation and goodwill in connection with her business activities and further, that the use of her image on the t-shirt amounted to a misrepresentation and was likely to deceive members of the public into believing it was approved of and authorised by her and...that she was happy to be associated with it and had endorsed it. Put another way, it was her case that the misrepresentation that she was associated with the t-shirt made it more attractive and so played a material part in the decision of the public to buy it.”
- Rihanna’s significant goodwill spanning her work as a singer and fashion icon and her previous commercial dealings with Topshop contributed to the finding of misrepresentation.
- Enough that “a substantial number of consumers [were confused] but not necessarily all of them.” [50].

Passing Off

- First element in the *Reckitt* ‘holy trinity’ of passing off is goodwill.
 - *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch).
 - Photo of Eddie Irvine, the Formula 1 racing driver, used in corporate brochure produced by the Defendant, a sports-focussed radio station.
 - Image manipulated.
 - Photo had been licensed.
 - Passing off found.
 - On appeal the correct measure of damages was held to be comparable to situations in which an infringer made unlicensed use of an invention: his award of £2,000 was increased to £25,000.

Passing Off



- Evidence of goodwill

- Can be evidenced by data such as revenue, customer figures, and advertising spend within the jurisdiction, even where the advertising took place prior to the business being launched: *Starbucks (HK) Ltd and another v British Sky Broadcasting Group and others (No 2)* [2015] 1 W.L.R. 2628.
- Usually, timing is all (*Irvine*).
- Loss of control is also a factor (*Fenty*).

Passing Off



- Misrepresentation is the second element of the ‘holy trinity’.
 - As in *Reckitt*, does not have to be intentional or fraudulent but likelihood of a person being misled is an essential ingredient of the tort.
 - Question of fact, needs to be more than mere confusion.
 - Factors indicating misrepresentation:
 - Similarity of products or services;
 - Prominence of any logos;
 - Degree of care in the product and services;
 - Whether the Claimant and Defendant operate in common spheres (*Harrods Ltd v Harrodian School* [1996] R.P.C. 697; *Martinez v Prick Me Baby One More Time* [2018] EWHC 776).
 - *Martinez* also set geographical limit to C’s goodwill (per J Melissa Clarke [21][64-66])
 - Must be a substantial number of customers who erroneously believe there was a trade connection between the parties, thereby damaging the Claimant’s goodwill.
 - Customers are ordinary members of the public with no particular knowledge or close connection to the Claimant but they cannot be “*morons in a hurry*” (*Morning Star Cooperative Society Ltd v Express Newspapers Ltd* [1979] F.S.R. 113 (18 October 1978)).

Passing Off



- Damage is the third element of the ‘holy trinity’.
 - A damages award will be contingent upon proof that C’s goodwill has been damaged – or, in an action for an injunction, that damage to C’s goodwill is reasonably foreseeable.
 - As Millet LJ stated in *Harrods*, “*damage to reputation without damage to goodwill is not sufficient to support an action for passing off*” at [718].
 - Damage to reputation can be a factor (as per *Erven Warnink Besloten Vennootschap and Another Appellants v J. Townend & Sons (Hull) Ltd. and Another Respondents* [1979] A.C. 731 but more is needed).
 - Evidence of damage to goodwill can include:
 - diversion of sales;
 - the ‘injurious association’ of the Claimant with the holder of a bad reputation which has, or reasonably foreseeably will, damage Claimant’s goodwill;
 - loss of opportunity to expand; or
 - erosion of goodwill as in *Irvine*: per trial judge at [34]: D ‘squatting’ on C’s exclusive right to use his image damaged his goodwill (EWHC 367 (CH)).

Passing Off



- *Shazam Productions Ltd v Only Fools The Dining Experience Ltd* [2022] EWHC 1379 (IPEC)

- Claimant was the company set up by John Sullivan's family, writer of Only Fools and Horses, to exploit the IP rights held by him in connection with OFAH.
- Defendant developed an interactive dining experience where actors played roles that were not named but acted a number of scenes from OFAH but also improvised scenes.
- Found that the similar clothing worn by the actors in publicity material for the Defendant were likely to cause confusion that it was authorised despite a disclaimer. The judge noted that if this had been displayed more prominently misrepresentation could have been avoided.
- Damage was found as at the authorised OFAH musical was being advertised at the time and there was a real risk that trade would be diverted.

Comparative Advertising

- Business Protection from Misleading Marketing Regulations 2008 (SI 2008/1276)
- Comparative advertisement defined in Article 2(c) of the Comparative Advertising Directive.

Comparative Advertising



- Regulation 4 of the Business Protection from Misleading Marketing Regulations 2008 (SI 2008/1276) provides that comparative advertising will be lawful when:
 - (a) it is not misleading under regulation 3;
 - (b) it is not a misleading action under regulation 5 of the Consumer Protection from Unfair Trading Regulations 2008(1) or a misleading omission under regulation 6 of those Regulations;
 - (c) it compares products meeting the same needs or intended for the same purpose;
 - (d) it objectively compares one or more material, relevant, verifiable and representative features of those products, which may include price;
 - (e) it does not create confusion among traders—
 - (i) between the advertiser and a competitor, or
 - (ii) between the trade marks, trade names, other distinguishing marks or products of the advertiser and those of a competitor;
 - (f) it does not discredit or denigrate the trade marks, trade names, other distinguishing marks, products, activities, or circumstances of a competitor;
 - (g) for products with designation of origin, it relates in each case to products with the same designation;
 - (h) it does not take unfair advantage of the reputation of a trade mark, trade name or other distinguishing marks of a competitor or of the designation of origin of competing products;
 - (i) it does not present products as imitations or replicas of products bearing a protected trade mark or trade name.

What is Trade Mark Infringement?

- Occurs where a registered trade mark is used in the course of trade without the proprietor's consent in any of the following circumstances:
 - The sign used by the infringer is identical with the registered trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered (s10(1) TMA 1994).
 - The sign used by the infringer is:
 - identical with the registered trade mark, and used in relation to goods or services which are similar to those for which the trade mark is registered; or
 - similar to the registered trade mark, and used in relation to goods or services which are identical with or similar to those for which the trade mark is registered;
 - and, in each case, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association (s10(2) TMA 1994).
 - The sign used by the infringer is identical with or similar to the registered trade mark, the trade mark has a reputation in the UK, and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark (s10(3) TMA 1994).

Limited application of *Bonnard v Perryman* to Trademark actions



- *Boehringer Ingelheim Limited and others v Vetplus Ltd.*
[2007] EWCA Civ 583.
 - The Defendant tested the Claimant's dog food, using a method that both used, and found that the Claimant's dog food did not contain the amount of chondroitin advertised. Chondroitin was reputed to have a beneficial effect on a dog's limbs.
 - Jacob LJ refused an injunction but said that the rule in *Bonnard v Perryman* had limited applicability in trade mark infringement actions.
 - Trade mark infringement is more than a claim to protect reputation as it is based on a property right (at [36]).
 - At [41] he said "*Although there is an important issue of free speech involved in comparative advertising other more complex factors are involved too. Most particularly the defendant has a commercial interest in diverting trade which would have gone to the trademark owner to himself. It is not a question of "pure" free speech*".

Trade Mark Infringement – interplay with freedom of expression



- *Miss World Ltd v Channel Four Television Corporation* [2007] EWHC 982 (Ch).

- Application by Miss World Ltd for an injunction to restrain Channel 4 from infringing its domestic and community trade marks.
- The Applicant was the organiser of the MISS WORLD beauty pageant. It had become aware that Channel 4 intended to broadcast a programme entitled "Mr Miss World" about a beauty pageant for transvestites and transsexuals that had taken place in Thailand.
- After considering the interplay of the Applicant's goodwill and freedom of commercial expression under Article 10 ECHR and s12 HRA 1998, the court granted an injunction to restrain the use of Mr Miss World stating "*Absent a sign which is really telling a political story, making a political point or identifying some matter of public importance, I find the idea that use of a trade mark can of itself generally engage Art 10 of the Convention difficult.*"
- See also *Patel v Allos Therapeutics Inc.* [2008] 6 WLUK 321 at [22] where the judge noted that freedom of expression "*is not unqualified and must be balanced against the rights of others, such as the rights of a minority not to suffer abuse, or, as in this case, the rights of a trade mark owner freely to enjoy its own rights and property.*"

Data Protection

- Celebrity's claim limited solely to DPA 2018 breaches; details of fitness regimen and quotes in media interview included in a retailer's free magazine.
- Claimant claimed damages and pleaded breaches of the UK GDPR:
 - Article 5(1)(a) – data shall be processed lawfully, fairly and in a transparent manner
 - Article 5(1)(d) – accuracy
 - Article 14 – requirement to inform a data subject that the Defendant was a data controller
 - Alleged failure of the Defendant to respond to a data subject access request pursuant to Articles 12(3) and 15