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Protecting a Sports Celebrity's Goodwill in Personality in Australia

Abstract
A sports celebrity's fame – her 'personality' - is commercially valuable for marketing products and services. Developments in the law suggest there are good reasons for trademarking a celebrity's image. The law needs to be applied within clearer boundaries and offer more certainty in this area. Today, the practice of trademarking celebrity image complements the tort of passing off in protecting goodwill in a celebrity's personality.

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PROTECTING A SPORTS CELEBRITY'S GOODWILL IN PERSONALITY IN AUSTRALIA[1]

JENNY NG SWEE GAIK [*]

A sports celebrity's fame – her 'personality' - is commercially valuable for marketing products and services. Developments in the law suggest there are good reasons for trademarking a celebrity's image. The law needs to be applied within clearer boundaries and offer more certainty in this area. Today, the practice of trademarking celebrity image complements the tort of passing off in protecting goodwill in a celebrity's personality.

The fame of a celebrity is commercially valuable when attached to a product or an event. Association of aspects of the top sportsperson's 'personality' – his photographic image, for example - increase the attractiveness of goods and services. Tiger Woods' image adorns Nike sports gear. Olympic gold medalists dive into endorsement deals that allow the use of their image to market products and services, sometimes with enormous effect in sales. This 'related to trade' endorsement – where the athlete is associated with products and services related to her field of sport – or the unrelated to trade endorsements (the athlete is associated with an unrelated product; eg, rugby players with telephones) – are usually given over to the product or services provider in return for a licence fee. The celebrity receives the fee in return for the use of his personality, and that use is controlled by their contract. But celebrity endorsement is occasionally usurped or 'stolen' by eager advertisers without the permission of the celebrity, in violation of the celebrity's economic interest in his own personality. What can the celebrity do about it?

Personality rights do not exist in Australia. However, celebrity athletes can control the use of their 'personality' and image by trademarking their image as well as bringing an action in the tort of passing off.[3] There is also the possibility of action for breach of the misleading and deceptive conduct provisions (s 52 and s 53) of the *Trade Practices Act 1974* (Cwth). Whilst the *Trade Practices Act* has been useful, the intention of the *Trade Practices Act* was not to protect goodwill in personality. Rather, it is for protecting one against misleading and deceptive conduct.

This article examines the protection afforded by the *Trade Marks Act* and the action in the tort of passing off. It also analyses how useful they are as well as the limitations in their applications.

I PROTECTING GOODWILL IN PERSONALITY – THE TRADE MARKS ACT AND THE TORT OF PASSING OFF

The tort of passing off has been useful in protecting goodwill in personality. Recently, we have seen the practice of trademarking celebrity names as well. However, most celebrity names are not

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[1] I would like to thank Professor Jim Corkery and Professor Duncan Bentley for reminding me to write this article out of one of my thesis. I would also like to thank Professor Jay Forder for always being helpful in my research.

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[3] Similarly, many other celebrities such as actors, etc have sought to protect goodwill in their personality by trademarking their image and/or the action in the tort of passing off. Whilst this article focuses on celebrity athletes, the discussion applies to other types of celebrities as well.

trade marks and the more popular avenue of redress is by way of an action in the tort of passing off. This section will examine these forms of protection for the goodwill in personality.

A The Trade Marks Act 1995

The Trade Marks Act 1995 states that a trade mark is a 'sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with by any other person'. A sign includes any 'letter, word, name, signature, numeral devices, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent'.[4]

Hence, the name, image, signature or other distinctive qualities of a celebrity personality are potentially capable of being registered as trade marks. The Australian model and actor, Elle MacPherson's name and signature are trade marked. The English Football Club, Tottenham Hotspur, has registered the trade mark *Tottenham*. The celebrated New Zealand horse rider Mark Todd, the Dutch footballer Jaap Stam, and Lennox Lewis, the heavyweight boxing champion, have also protected their names by trade mark registration. After the Kieren Perkins case,[5] Mr. Perkins has managed to register images of his face as trade marks.[6]

Celebrity names and personality marks may be registered under s 41(2). For example, Kenny Rogers' name, picture and signature may be protected when it is placed in an advertisement for the famous Kenny Rogers' Roasted Chicken chain of restaurants. This is because his name, picture and signature act as a badge of origin, which indicates the source of the product.

However, where the registration of a trade mark is concerned, s 41(2) of the *Trade Marks Act 1995* states that,

> an application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered … from the goods or services of other persons.

In *Torpedoes Sportswear Pty Limited v Thorpedo Enterprises Pty Limited*,[7] Thorpedo Enterprises sought to register the word 'Thorpedo' which was used to refer to the brilliant Olympic swimmer Ian Thorpe. This case concerns issues of whether the marks are substantially identical or deceptively similar. This involved the consideration of the similarity with a registered device mark that was called 'Torpedos'. Bennett J stated that the two marks were not substantially identical because the totality of the characteristics of the marks was taken into account and the actual words were different.

Lastly, protection can be afforded by arguing an infringement of a registered trade mark. However, there is currently no binding precedent in Australia to show how successful this will be as a form of protection and there is no specific test for infringement.[8]

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4 Section 6, *Trade Marks Act 1995* (Cth).

5 *Talmax Pty Ltd v Telstra Corp Ltd* (1996) 36 IPR 46.

6 Heerey P, 'Character and Personality: Where to for protection in the Intellectual Property Area?' (1999) *Intellectual Property Forum* 39.

7 (2003) 132 FCR 326; (2003) 59 IPR 318.

8 Lynne Weathered , 'Trademarking Celebrity Image: The Impact of Distinctiveness and Use As a Trade Mark' (2000) 12 *Bond Law Review* 161.

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Limitations

Section 41(2) of the *Trade Marks Act* will not apply to some celebrity names that appear on products that do not, in any way, relate to the celebrity. This is because if the celebrity name is trade marked, it would extend well beyond the traditional function of a trade mark. Lynne Weathered points this out:[9]

> it is observed that the role of trade marks may require re-evaluation in respect of their application to celebrity personality marks. Celebrity personality marks are often in effect the product themselves. Trade marks themselves were intended to distinguish the product, not be the product. Therefore, non traditional celebrity personality marks, when used for purposes other than indicating the origin or source of the product or service, arguably stretch the purpose of trade marks beyond the point where legal protection is justified. If legal protection should be granted to celebrities, perhaps this should be accomplished through other measures, rather than blurring the legal role of trade marks.

Trademarking should not be used to protect character merchandising. Lord Brightman sets out the rationale for restricting the scope from extending to character merchandising in *Re American Greetings Application (Holly Hobbie's Trade Mark)*[10] (which has been cited favourably by the Australian Federal Court in *Pacific Dunlop Ltd v Hogan.*[11])

> To my mind, trafficking in the trade mark context conveys the notion of dealing in a trade mark primarily as a commodity in its own right and not primarily for the purpose of identifying or promoting merchandise in which the proprietor of the trade mark is interested. If there is no real trade connection between the proprietor of the mark and the licensee or his goods, there is room for the conclusion that the grant of the license is a trafficking in the mark.

Samuel K Murumba also comments on character merchandising:[12]

> After the *Holly Hobbie* decision it seems clear that, for all their cumbersome and expensive registration procedure, trade marks will hardly provide protection for proprietary interests in personality, likeness or reputation.

The White Paper, *Reform on Trade Marks Law*, echoes this:[13]

> 4.42 The *Holly Hobbie* case illustrates the part played by trade mark licences in the rapidly-expanding activity of character merchandising. There are arguments however that character merchandising should not be a trade mark matter, since the characters are not trade marks in the first place, nor are they used as trade marks; instead they serve merely to enhance the eye-appeal of the goods. This is a matter more for the protection by copyright or design law than by trade mark registration. One legitimate fear is that, since a trade mark registration may be renewed indefinitely, this could be used to obtain a backdoor extension of the protection conferred under copyright law although, since character merchandising is essentially fashion-dependent, in many cases the character will have ceased to be merchandisable long before the copyright term has expired.
>
> After careful consideration, the Government's view is that it is virtually impossible to construct a legal framework which would distinguish between straightforward character merchandising (using for example a popular cartoon character having no independent

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9 Ibid.

10 [1984] 1 All ER 426; [1984] FSR 199 (HL).

11 (1989) 87 ALR 14.

12 *Commercial Exploitation of Personality* (1986).

13 Cm 1203 (1990), paras 4.42-3.

existence as a trade mark), the practice of decorating goods such as T- shirts or mugs with a trade mark having a reputation in connection with quite different goods, and cases where a trade mark simultaneously decorates the goods and distinguishes their source. It has been suggested that a sui generis character right could be created, having a finite life, but it is not clear how it could be made obligatory to use this as an alternative to trade mark protection. In short, it is felt that any attempt to legislate in this area would be likely to create legal and administrative difficulties disproportionate to any problems that it would obviate.

B The tort of passing off

There have been vast case law developments where the extended tort of passing off has been used to protect goodwill in personality in Australia. The tort of passing off was initially intended as a way of preventing a defendant from passing off his own goods as the plaintiff's goods.[14] It was later extended to cover misrepresentations on the quality of the plaintiff's goods[15] and cases 'where although the plaintiff and defendant were not competing traders in the same line of business, a false suggestion by the defendant that their businesses were connected with one another would damage the reputation, and thus the goodwill of the plaintiff's business'.[16] Furthermore, the tort also covers cases involving the misdescription of goods, or the misuse of a descriptive term.[17]

The Australian courts have been willing to adapt this tort in order to remedy cases of appropriation of personality. However, this approach is not without its problems, as was illustrated by cases such as Hogan v Koala Dundee Pty Ltd.[18]

(a) The elements of passing off

Lord Diplock in Erven Warnink v Townend,[19] set out five necessary elements to establish a cause of action in passing off: (i) a misrepresentation, (ii) made by a trader in the course of trade, (iii) to prospective customers or ultimate consumers of goods or services supplied by the trader, (iv) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence), and (v) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

However, the key elements of the tort are usually analysed in terms of the 'classical trinity' of: '(i) a reputation (or goodwill) acquired by the plaintiff in his goods, name, mark etc. (ii) misrepresentation by the defendant leading to confusion (or deception) causing (iii) damage to the plaintiff'.[20] The appropriation of personality cases will be analysed in accordance with this 'classical trinity'.

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14 See, eg, *Reddaway v Banham* (1896) 13 RPC 429.

15 *Spalding (AG) & Bros v Gamage (AW) Ltd* (1915) 32 RPC 273, 283-4.

16 *Erven Warnink BV v Townend & Sons (Hull) Ltd* [1979] AC 731, 741-2 per Lord Diplock.

17 *Erven Warnink BV v Townend & Sons (Hull) Ltd* [1979] AC 731.

18 (1988) 83 ALR 187.

19 [1979] AC 731.

20 *Consorzio del Prosciutto di Parma v Marks & Spencer Plc* [1991] RPC 351, 368 following the remarks of Lord Oliver in *Reckitt & Colman Ltd v Borden Inc* [1990] 1 WLR 491, 499.

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(i) Goodwill

The common law developed favourably in the landmark case of Henderson v Radio Corporation,[21] as the court did not insist on there being a 'common field of activity'.

In Henderson v Radio Corporation,[22] professional ballroom dancers objected to the use of their image on the packaging of a record. They were not in the business of recording music for commercial sale, and hence, were not able to claim to be in a 'common field'. However, they were able to demonstrate a pattern of previous appearances in advertisements which earned them an income.

The Court held that there was no need for an actual or potential area in which the parties' trading activities conflicted. Evatt CJ stated that, although the remedy in passing off was necessarily only available where the parties were engaged in business, that expression would be used 'in its widest to include professions and callings'. Manning J elaborated, stating that the development in advertising practices had 'opened up a new field of gainful employment for many persons, who, by reason not only of their sporting, but of their social, artistic, and other activities, which have attracted notoriety, have found themselves in a position to earn substantial sums of money by lending their recommendation or sponsorship to an almost infinite variety of commodities'.

(ii) Misrepresentation

Cases of appropriation of personality are generally concerned with misrepresentations regarding the reputation of the plaintiff, which leads to public confusion, thereby resulting in damage or a real possibility of damage to the plaintiff.

The Australian courts have taken an expansive approach as evidenced in *Henderson v Radio Corporation Pty Ltd.*[23] The design of the record cover gave prominence to the picture of the Hendersons dancing. Hence, according to Evatt CJ, when it was viewed from a distance, as would be the case in a shop display, it could easily lead to the deception of possible purchasers. Consequently, the conduct of the defendant amounted to a misrepresentation that the business of the plaintiff was connected with the business of the defendant. The notion of a business, as noted above, was interpreted in its widest sense as including professions and callings.

The *Koala Dundee* case

Pincus J took a more radical approach in *Hogan v Koala Dundee Pty Ltd.*[24] The defendants had made unauthorised use of images deriving from the plaintiffs' film, 'Crocodile Dundee', and, in particular, had used the name 'Dundee' on their merchandise. According to Pincus J, it was 'possible to bring a passing off action in respect of an image, including a name, unconnected with any business at all'. This was a novel and wide proposition.

Pincus J's view is contrary to previous Australian authorities, as it suggested that liability need not be based on misrepresentation, and it would suffice if there was a misappropriation of commercial reputation. This approach has not been followed in subsequent Australian cases. In *Pacific Dunlop Ltd v Hogan*[25] the Full Federal Court maintained the need to show a

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[21] [1969] RPC 218.
[22] [1969] RPC 218.
[23] [1969] RPC 218.
[24] (1988) 83 ALR 187.
[25] (1989) 87 ALR 14.

misrepresentation and damage to goodwill, rather than the broader notion of misappropriation set out in *Hogan v Koala Dundee*.[26] The requirement of misrepresentation was subsequently maintained in *Talmax Pty Ltd v Telstra Corp Ltd*.[27]

Hutchence v South Seas Bubble[28] involved the producing and selling of t-shirts printed with a design owned by the rock group INXS. Passing off was established, as the designs were likely to mislead purchasers who would think that the t-shirts had been approved by INXS. This is despite the fact that the market stall selling the t-shirts stated that the products were 'genuine bootleg'. This is because it was not sufficient to prevent a misrepresentation, which misled many purchasers who thought that they were buying goods, approved by INXS.

(iii) Damage

For passing off, the plaintiff must show damage to his goodwill.[29] This is the fifth of Lord Diplock's criteria in *Erven Warnick,* which states that the defendant's misrepresentation must cause actual damage to his business or goodwill, or the probability of damage. In the classic action for passing off, the defendant would have misrepresented that his goods or his business were the plaintiff's goods or business,[30] resulting in a diversion of trade from the plaintiff to the defendant, which would amount to damage done to the plaintiff.

(b) The effectiveness and limitations of the tort of passing off as an avenue of redress

Despite the emerging trend of trademarking celebrities' names, the tort of passing off is an important avenue of redress, especially in areas such as character merchandising. Generally, the Australian courts have been able to secure the rights of celebrities in the action of passing off fairly well. However, it is a vague area in certain respects. For example, it is unclear from the passages in Evatt's judgment in *Henderson v Radio Corporation Pty Ltd*[31] as to the types of misrepresentation which render a remedy in passing off. Would it be limited to misrepresentations, which might result in damaging the plaintiffs in their business or profession; or would it also extend a remedy in cases of a misrepresentation amounting to an appropriation of personality whereby there was no injury to the plaintiffs in such a capacity? Furthermore, could liability be based on misappropriation of such a property right; or was there still a need to show a misrepresentation, leading to consumer confusion or deception? Evatt CJ and Manning J seems to indicate the need for a misrepresentation, rather than a misappropriation of an independent property right. The vagueness has led some commentators to argue that the courts have developed a legal fiction.[32] In many instances, when establishing an action in the tort of passing off poses a difficulty due to the vagueness in some of its elements, the Trade Practices Act is used instead. Whilst the intention of the *Trade Practices Act* was not to secure goodwill in one's personality, it is useful in an indirect manner as it protects one against misleading and deceptive conduct.

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26 (1988) 83 ALR 187.

27 (1996) ATPR 41-535 (CA Qld).

28 (1986) 6 IPR 473.

29 P Cane, *Tort Law and Economic Interests* (2nd edn 1996) 78.

30 *Spalding (AG) & Bros v Gamage (A.W) Ltd* (1915) 32 RPC 273; *The Clock Ltd v The Clock House Hotel Ltd* (1936) 53 RPC 269.

31 (1960) 60 SR (NSW) 576; [1969] RPC 218.

32 Huw-Beverley Smith, *The Commercial Appropriation of Personality* (2002) 110.

II GOODWILL IN PERSONALITY AND DOMAIN NAMES

Names of celebrities have been registered as domain names all over the world. Many celebrities have tried to protect their personal names in the Uniform Dispute Resolution Policy *('UDRP')*. This applies in Australia as well although Australian domain name registrants would also have a recourse in the auDRP.[33] However, the auDRP only deals with domain name cases concerning country code top level domains (ccTLDs) in Australia. This article focuses on generic top level domain names (gTLDs) and analyses how the law applies in relation to an Australian registrant of a gTLD. This is because the issues on personal names concerns gTLDs more than ccTLDs due to a lack of international norms. As the World Intellectual Property Organisation's Final Report[34] aptly puts it,

> Insofar as ccTLDs are concerned, the lack of international norms is less significant. Clear law at the national level for the protection of personal names against abusive domain name registrations, if it exists, can be applied to registrations in the corresponding ccTLD.

Where personal names are concerned, professional athletes have sought protection in a number of cases, such as: Daniel C Marino, Jr v Video Images Productions WIPO Case No D2000-0598[35] (Athlete, movie actor and sports commentator); *Jules I Kendall v Donald Mayer Re skipkendall.com* WIPO Case No. D2000-0868[36] (Professional golfer); *Jaap Stam v Oliver Cohen* WIPO Case No D2000-1061[37] (famous soccer player); *Pierre van Hooijdonk v SB Tait* WIPO Case No. D2000-1068[38] (famous soccer player).

A Cybersquatting problems

Cybersquatting usually occurs when third parties register domain names which consist of celebrities' names or variants, in the hope of selling the domain names for a profit. This act of cybersquatting has been rampant, especially in generic top level domain names (gTLD) as anyone can register a domain name on a 'first come, first served' basis. The UDRP procedures require that it must be proven that the domain name is: (i) identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the registrant has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith.

Where the first requirement is concerned, the tort of passing off has often been used to prove the first element of an identical or confusingly similar trademark or service mark.[39] This is especially so since celebrity names are usually not registered as trade marks. The UDRP provides that there must be 'a trademark or service mark in which the complainant has *rights*,' without specifying how these rights are acquired.[40] The complainant need not hold rights specifically in a *registered*

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33 The auDRP is modelled in a similar manner to the UDRP.

34 *Report of the Second WIPO Internet Domain Name Process* (September 3, 2001) <http://wipo2.wipo.int> at 23 March 2008.

35 <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0598.html> at 23 March 2008.

36 <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0868.html> at 23 March 2008.

37 <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1061.html> at 23 March 2008.

38 <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1068.html> at 23 March 2008.

39 *Julian Barnes v Old Barn Studios Ltd* WIPO Case No D2001-0121 <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0121.html> at 23 March 2008.

40 See J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Vol. 4, ch. 25, §25:74.2 (2000), indicating that 'the reference to a trademark or service mark 'in which the complainant has rights' means

trademark or service mark. A common law or unregistered trade mark would also satisfy the first requirement.[41]

Hence, many complainants in UDRP decisions regarding personal names have satisfied the first requirement by relying on common law trade marks in the disputed names. The *Jeanette Winterson case*[42] has often been cited in these cases. However, if Australian law applies in the UDRP proceedings, the elements of the tort of passing off must be proven.[43]

B The Jeanette Winterson case

The *Jeanette Winterson case*[44] was the first case on personal names under the UDRP, administered by WIPO. The domain names, <Jeanettewinterson.com>, <Jeanettewinterson.net> and <Jeanettewinterson.org>, were being contested by the complainant. Both the complainant and the respondent were domiciled in the United Kingdom. The complainant was a famous author named Jeanette Winterson. Several hundred thousand copies of her books had been sold worldwide every year. The respondent was a research fellow at Cambridge University. He had registered the domain name <writers.com>. His intention was to develop websites devoted to some of the world's favourite writers. 132 writers were named on the website including Jeanette Winterson. The respondent has registered some domain names with the names of these writers. He also admitted that he intended to sell one or two domain names to provide the necessary venture capital for his scheme.

The panelist in this case referred to the Court of Appeal decision of *British Telecommunications plc v One In A Million Limited*[45] and also cited a number of English cases dealing with passing off involving the names of well-known individuals.[46] However, he concluded that,

> the case for decision here does not concern whether or not passing-off has occurred **but**[47] whether the Complainant (Jeanette Winterson) has rights in her name sufficient to constitute a trade mark for the purposes of para. 4a of the Policy.

It would seem that the Panel had recognised a right in a name based broadly on goodwill which circumvents the need to prove the elements of a passing off action. This would mean that the inability under English law to sue for infringement of an unregistered trade mark (other

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that ownership of a *registered* mark is not required – unregistered or common law trademark or service mark rights will suffice' (Emphasis in original).

41 One of the earliest decisions to rely on unregistered rights in a trademark was handed down in the consolidated cases of *Bennett Coleman & Co v Steven S. Lalwani* WIPO Cases D2000-0014 and D2000-0015 <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0014.html> at 23 March 2008.

42 *Jeanette Winterson v Mark Hogarth,* WIPO Case No D2000-0235 <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html> at 23 March 2008.

43 See eg *Re: Telmak Teleproducts (Australia) Pty Ltd And: Coles Myer Ltd No G1002 of 1998* (Federal Court; unreported).

44 *Jeanette Winterson v Mark Hogarth,* WIPO Case No D2000-0235 <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html> at 23 March 2008.

45 [1999] FSR 1.

46 The cases cited include *Mcculloch v Lewis A. May (Produce Distributors), Ltd ('Uncle Mac Case')* [1947] 2 All ER 845; *Taverner Rutledge v Trexpalm* [1975] FSR 479; *Wombles Ltd v Wombles Skips Ltd ('Wombles case')* [1977] RPC 1999; and *Mirage Studios v Counter-Feat Clothing Company Ltd ('Teenage Mutant Ninja Turtles case')* [1991] FSR 145.

47 Panelist's own emphasis.

than a potential claim under s 56 of the *Trade Marks Act 1994*) will not affect a person's right to bring a successful action under the UDRP.

As observed by Belinda Isaac,[48]

> the panel in the *Jeanette Winterson* case erred in failing to consider whether on the facts the three essential elements of the tort of passing off had been established. Whilst the outcome of the case may be welcomed by celebrities, it causes unpredictability as far as the quality of the UDRP decisions are concerned, especially as subsequent decisions of foreign panelists cite the *Jeanette Winterson* case as authority for the proposition that English law affords protection in respect of infringement of common law trade marks.

In the Australian context, the *Jeanette Winterson case* may mislead a panel with an Australian respondent and/or complainant (which applies Australian law in the UDRP proceedings). This is because, under Australian law, the elements of passing off must be proven to protect goodwill in personality in such an instance.[49]

C Cases decided after WIPO's Final Report and the Jeanette Winterson's case

The Second WIPO Internet Domain Name Process addressed the issues regarding personal names through a process of consultations - online and through in-person regional meetings - resulting in a final Report that was published on 3 September 3 2001. At their meeting from 23 September to 1 October 2002, WIPO Member States took a decision based on the recommendations of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications *('Standing Committee').* This decision has been transmitted to ICANN. Where personal names were concerned, the Standing Committee has decided that no action is recommended. Hence, this would mean that the scope of the UDRP should not be broadened to cover personal names beyond those which are already protected under the current UDRP as trade or service marks.

However, it is observed that the panelists still take different approaches on issues regarding personal names. Some panelists would decide on matters regarding personal names only if the complainants have profited from their reputations in commerce. Such an approach is in accordance with WIPO's Final Report. This is well illustrated in cases such as *R. E. 'Ted' Turner and Ted Turner Film Properties, LLC v Mazen Fahmi,*[50] *Utada Hikaru v utada fan,*[51] *Gene Edwards v David Miller*[52] and *Charles Rapier v Dark Moon Management.*[53] However, other panelists take the position that well- known entertainers and personalities are able to prevent the unauthorised registration of domain names in appropriate cases. This position is taken without making any

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48 'Personal Names and the UDRP: A Warning to Authors and Celebrities' [2001] *Ent LR 43.*

49 See eg *Re: Telmak Teleproducts (Australia) Pty Ltd And: Coles Myer Ltd No. G1002 of 1998* (Federal Court; unreported).

50 WIPO Case No D2002-0251 <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0251.html> at 23 March 2008.

51 WIPO Case No D2003-0686 <http://arbiter.wipo.int/domains/decisions/html/2003/d2003-0686.html> at 23 March 2008.

52 WIPO Case No D2003-0339 <http://arbiter.wipo.int/domains/decisions/html/2003/d2003-0339.html> at 23 March 2008.

53 WIPO case No D2004- 0221 <http://arbiter.wipo.int/domains/decisions/html/2004/d2004-0221.html> at 23 March 2008.

further analysis. This is evident in cases such as *Elmore 'Rip' Torn, Jr., p/k/a/ Rip Torn v Riptorn.com,*[54] *Warren Faidley v Venture Services, Inc*[55] and *Fox News Network, LCC v Warren Reid.*[56]

Hence, in *R E 'Ted' Turner and Ted Turner Film Properties, LLC v Mazen Fahmi,*[57] where the former position was taken, the panelist stated,

> In the view of the majority, this is just another in a line of cases where a domain name registrant has sought to capitalize on the fame and reputation of an internationally well-known person. Unfortunately, the Policy does not give Mr. Turner or TTFP a remedy in this case. They may have some remedy in a national court.

On the other hand, in another case with an Australian respondent in *Fox News Network, LCC v Warren Reid,*[58] the panelist considered and accepted personality rights in the UDRP proceedings without very much further analysis and stated,

> The Respondent's contention that the Domain Name is not identical to the Complainant's mark, 'The O'Reilly Factor', and his domain name <billoreily.com> is allowable because the Complainant has no rights as such in the Bill O'Reily name is not accepted. It is established that well- known entertainers and personalities are able to prevent the unauthorised registration of domain names in appropriate cases. Refer to *Nicole Kidman v John Zuccarini,* WIPO Case No. D2000- 1415 (January 23, 2001). The same broad principle applies here and it seems appropriate to apply it to the present facts.

This case highlights a discrepancy in the UDRP decisions. This is especially so because the respondent was an Australian. Following the Rules for Uniform Domain Name Dispute Resolution Policy[59] which was adopted by ICANN, a mutual jurisdiction means 'a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.' Furthermore, Rule 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy provides that the panel shall decide a complaint on the basis, *inter alia*, of 'any rules and principles of law that it deems applicable.' The applicable law will depend on the facts of the case, including the location of the parties.

As the respondent (and domain name holder) is an Australian, Australian law should apply. However, this is obviously not the case, as personality rights seem to be recognized in the decision. This right does not exist in Australia. Perhaps the panel, in exercising its jurisdiction to use 'any rules and principles of law that it deems applicable', followed American law (because the complainant is an American) or the 'precedents' of previous UDRP decisions without much

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54 WIPO case No D2001- 0859 <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0850.html at 23 March 2008.

55 WIPO case No D2001- 1143 <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1143.html> at 23 March 2008.

56 WIPO Case No D2002-1085 <http://arbiter.wipo.int/domains/decisions/html/2002/d2002-1085.html> at 23 March 2008.

57 WIPO Case No D2002-0251<http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0251.html> at 23 March 2008.

58 WIPO Case No D2002-1085<http://arbiter.wipo.int/domains/decisions/html/2002/d2002-1085.html> at 23 March 2008.

59 <http://www.icann.org/dndr/udrp/uniform-rules.htm> at 23 March 2008.

regard for rules on choice of law. It is clear that there are difficulties in addressing legal rights of different jurisdictions and matters on conflict of laws in such an instance.

Furthermore, the *Jeanette Winterson case*[60] continues to be a precedent that is referred to in this case as well as in other cases such as *Alan Bond v Information360 Limited*.[61]

Trademarking a celebrity's name which appears in a domain name is useful, as it prevents the ambiguities above. This is because personal names that have been trademarked can be protected under the UDRP.

III CONCLUSION

The complexity of the law in this area suggests the need for reform. Trademarking celebrity image is a fairly new approach. It is definitely a useful approach. However, it should be exercised within its proper boundaries and limitations.

Where reforms are concerned, it is interesting to note that the Australian Law Commission has made an attempt more than 25 years ago in the form of clause 23 of a privacy bill known as the Unfair Publications Bill 1979. Clause 23 states,

> A person whose name, identity, reputation or likeness is appropriated has a right of action against the person who appropriated his name, identity or likeness and against each person who, knowing of the appropriation, has used the appropriation for his own benefit or to the detriment of the first named person.

The proposed Bill has been said to offer even greater protection. This is because unlike the *Trade Practices Act 1974* or the action for passing off, it is not dependent on the need to prove the element of deception or confusion. However, legislation should most probably be the last resort. As observed by Samuel K Murumba,[62]

> ideally, proprietary interests (as distinct from privacy interests) are best protected by proprietary principles which have been developed by the courts, for instance those of passing off, rather than by the contentious notion of privacy, the exact limits if which are yet to be worked out. This view presupposes a willingness on the part of the courts to take the initiative to extend those existing principles that one more logical step needed to bring about the necessary protection. Unless, such willingness is forthcoming, legislation is certainly called for, as it was in New York after *Roberson's case*, to bring about the necessary change…

The developments above seem to suggest that there is much reason for trademarking a celebrity's image. It is hoped that the jurisprudence in the area concerning trademarking celebrity's image continues to grow so that it is applied within clearer boundaries and affords more certainty to the

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60 *Jeanette Winterson v Mark Hogarth* WIPO Case No. D2000-0235 <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html> at 23 March 2008.

61 WIPO Case No. D2007-1081< http://www.wipo.int/amc/en/domains/decisions/word/2007/d2007-1081.doc> at 23 March 2008. However, it is noted that the panelist in this case was correct on the legal principles regarding personal names where he stated, 'While the UDRP does not specifically protect personal names, in situations where an unregistered personal name is being used for trade or commerce, the complainant can establish common law trademark rights in the name. Reference can be made to the test required for the common law action of passing off…The name in question should be actually used in trade or commerce to establish unregistered trademark rights. Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to show unregistered trademark rights.'

62 Commercial Exploitation of Personality (1986).

law in this area. Today, the practice of trademarking celebrity image complements the tort of passing off in protecting goodwill in a celebrity's personality.