

• IMAGE RIGHTS IN GUERNSEY

The long-awaited Image Rights legislation in Guernsey has now been made available for consultation. The consultation period runs until 7 March 2012. This briefing note sets out the key points of the Image Rights (Bailiwick of Guernsey) Ordinance, 2012 (the "IR Ordinance").

INTRODUCTION

The IR Ordinance establishes a new form of intellectual property, previously unrecognised in a registrable form anywhere else in the world. It centres on two key concepts - the "registered personality" and the "registered image".

The core right is the registered personality. Personality refers to:

- natural or legal persons;
- a joint personality;
- a group; or
- a fictional character of a human.

Ant & Dec and Laurel & Hardy may be joint personalities. Torville and Dean may be both joint personalities and a group. Interestingly, it is only the fictional character of a human that can qualify as a personality and hence Shrek, Buzz Lightyear and even Tom & Jerry would not qualify as personalities. Conversely, James Bond, Tintin and Popeye would qualify as personalities. As Superman is from Krypton and hence of extraterrestrial origin, he is not human and hence probably does not qualify as a personality.

The creator of the fictional character is, generally, the prospective proprietor of, that fictional character, together with any image rights therein. A legal person can be a registered personality so arguably therefore, Disney could be a registered personality with all associated cartoons registered as the related images, thereby getting protection for cartoon characters such as Mickey Mouse, Donald Duck and Winnie the Pooh.

The IR Ordinance also caters for both dead people and "extinct" legal persons. If the natural or legal person was "in existence" less than 100 years prior to the date of filing of the application for registration of the personality, it will also qualify as a personality. In this respect, think of the continued significance and value of Michael Jackson, Marilyn Monroe, Elvis Presley or even Woolworths.

The starting point is therefore to become a proprietor of a registered personality. That proprietor has the image rights and other rights and remedies provided by the IR Ordinance. The person registered as the proprietor is, by reason of the fact of registration alone, the legal owner of the registered personality and the associated image rights and other rights.

Image refers to:

- the name or any other name by which a registered personality is known (David Beckham or "Becks");
- voice;
- signature;
- likeness;
- various expressions, gestures and mannerisms;
- any other distinctive characteristic or personal attributes of a registered personality; and/or
- photographs, illustrations, moving images, electronic or other representations of, or associated with, a registered personality.

So, a racing car driver will be able to control the use of his image in video games - similarly with the use of football or tennis players in the associated games.

In this respect, think of Wilkinson's pose as he is about to convert the try, the expression "You can't be serious" or the ever changing face of Lady Gaga.

WHO IS THE PROPRIETOR?

In the context of the IR Ordinance, it is critical that the proprietor of the registered personality and hence the registered image(s) can be different from the underlying personality. In this respect, the application process allows for the name and address of the prospective proprietor and the personality to be different of registration. In addition, the consenting process envisages the proprietor consenting to the process as opposed to the individual personality having to be involved each and every time.

So, upon the registration of a personality the proprietor of the registered personality shall be the person registered as the proprietor or if none, the personality themselves. This could have serious consequences if the agent registering the rights gets it wrong. Further, the proprietor of a registered personality has exclusive rights in the images associated with or registered against that registered personality.

WHAT DOES THE IMAGE RIGHT GIVE YOU?

It is currently proposed that a personality or an image will be registered for a period of one year from the date of registration. In our view, this is far too short. While it may be appropriate for the image rights to be quite a short period (3 - 4 years), the personality right should surely be longer (maybe up to 10 years). It will be difficult to effectively licence a right or build it into commercial contracts if it only lasts for one year. Of course, it is renewable and this helps in some respects but our view is that a longer period is appropriate.

The IR Ordinance is slightly unclear on the nature of the personality rights as opposed to the image right and what you can do with each. A registered personality is personal or movable property which is transmittable by assignment provided that certain requirements are met, the main one being

that it is not effective unless it is in writing signed by or on behalf of the proprietor of the registered personality.

There are provisions dealing with registration of transactions affecting registered personalities. These include, most importantly, assignment and granting of a licence. Until the application has been made for registration of that transaction, the transaction is ineffective as against a person acquiring a conflicting interest (provided no reasonable ground of knowledge) and the 'licensee' has no rights or remedies in relation to infringement. Upon registration, the licensee acquires certain rights to prevent infringement. This is a very important step in the protection of image rights. As they currently only relate to the individual and are currently drafted on a purely contractual basis, the licensee has to rely on the individual themselves to enforce the right. Now the club or the brand will be able to enforce directly under certain circumstances (mirroring trademark principles) and a licensee may bring proceedings in its own name as if the licensee were the proprietor. So if Puma uses Usain Bolt's registered personality and associated image rights under licence, it will no longer have to rely on Usain Bolt to enforce those image rights himself if Adidas (for example) uses the same image rights on the internet (available in Guernsey). In the image rights world, this is a big step forward.

GROUNDS FOR REFUSAL

There are various reasons given in the IR Ordinance as to why either a personality or an image should not be registered, or can be refused. These effectively either complement or mirror existing trade mark laws and rules and fall into two categories - absolute grounds for refusal and relative grounds for refusal. It should be noted that the IR Ordinance additionally allows for grounds which may be determined by the Registrar from time to time.

Absolute Grounds

An absolute ground is one where the Registry itself fundamentally objects to the registration of the right. Such an objection may be raised on the following grounds:

- Contrary to public policy or morality (Jesus);
- Deceptive to the public (works for trade marks, less sure about image rights);
- Bad faith application (perhaps an employee registering an employer's IP);
- The images or personality are associated with items which are commonplace. This is quite a difficult concept to tackle when it comes to image rights. For trade marks, these are often simpler and might be something like the inability to register XL for clothing, but it remains to be seen whether this concept can be so easily identifiable for images; and/or
- The images or personality include a representation of a protected emblem, such as a national flag, the Olympic symbol, image of the Queen etc.

Relative Grounds

A relative ground for refusal is where the application is deemed to be either the same or confusingly similar to an existing registered image or personality right.

The notion of what is the same or similar is much more difficult than it seems. Trade mark courts have been struggling for decades over what "confusingly similar" and "likelihood of association" may mean in practice. Would Lewis Hamilton's eyes through a visor be similar to his face on its own? Would any two people wearing a crash helmet look the same if photographed from the same angle? If so, would it be confusingly so?

The Registrar is able to consult any registry anywhere in the world to determine whether such earlier rights exist (whether these rights be a trade mark, a copyright or other registered or unregistered rights).

In practice, this is a considerable task to undertake for each application and we believe that the Registrar will not invoke this

but will make use of s.11(2)(f) and rely on the applicant's declaration that the personality or image right does not infringe any earlier rights. It is therefore a serious responsibility for anyone to file either a personality or an image right and also requires an inherent understanding of existing IP rights such as trade marks and copyright and the interplay between these rights and the new image rights.

CLASSIFICATION

The IR Ordinance refers (s. 13) to a classification system for both personalities and images which may be adopted by the Registrar. As yet, we are unaware of what form this will take and whether it may bear a resemblance to the Vienna classification system as used for trade mark images.

INFRINGING THE IMAGE RIGHT

There is an additional layer of complication to the infringement provisions. Only a 'protected image' can be infringed. To be a protected image, the image has to be 'distinctive' and have 'actual or potential value'. Both terms are defined in the IR Ordinance. Notably, a registered image is presumed to be distinctive (although the presumption can be rebutted) although there are various other tests that can be used to assess distinctiveness. In relation to actual or potential value, that is assessed at the time of the infringement. Again, a registered personality is presumed to have actual or potential value, although this can be rebutted.

A registered personality's image rights are infringed by the use of an image:

- which is identical to a protected image;
- which is similar and there exists likelihood of confusion or association; or
- which is identical or similar and the use takes unfair advantage of, or is detrimental to the distinctive character, repute or value of that registered personality.

There are several similarities to the infringement principles surrounding trademarks and this is very useful from a case law perspective.

PART III OF THE IR ORDINANCE - ADMINISTRATIVE

Recorded Details

The main details that will be recorded are the name and address of the proprietor of the personality and image rights, together with the date when these rights were registered. It should be noted that the date for application will be the date upon which all of the appropriate paperwork for an application has been received by the Registry. This may be important as the ultimate registration date will be the application date - if there is a late filing this may affect when a proprietor can back date any claim for damages for infringement.

There is provision made in the IR Ordinance for the register to be searchable. We favour an in person search of the register and not an internet enabled search system. This would deal with any privacy issues related to having a freely searchable database which may arise.

Also entered on the register will be a list of any registrable transactions against a particular personality or image right. Such transactions would be:

- licence;
- assignment;
- assent by a representative;
- order of court; or
- other transactions as may be prescribed (such as security granted over the image rights).

Process

The proprietor of the personality will make the application, either himself (if Guernsey resident) or through a Guernsey Image Rights agent, for either the personality on its own or for both the personality in conjunction with an image right or rights.

On submission, the Registry will check that the application satisfies all the relevant criteria required for a valid application. If this is the case, the application will be given an application date.

Thereafter, the Registry will check the application on both absolute and relative grounds (see above). If the application is

approved, it will then go through to the opposition stage, where it will be open for a third party to object to the application if they see fit. If no opposition is received then the personality and/or the image(s) will be registered.

It is not stated in the IR Ordinance how long the opposition period will be, but if this mirrors the existing arrangements for trade marks in Guernsey, this will be 20 working days. During this time, any third party who wishes to object will have to give notice of the opposition to the Registrar, by filing the appropriate documentation and paying the opposition fees. We are assuming that the opposition process will be much the same as for trade marks, whereby each party gives evidence and the Registry rules on the facts as presented to it.

Unauthorised Use

The IR Ordinance details what constitutes an unauthorised use of an image right. Infringement is committed by someone using the protected image on any goods or services without the proprietor's or licensee's permission. In addition, the list of infringing acts extends to having such goods in one's possession with a view to committing such infringement.

Provision has also been made for infringement through publication or distribution of a publication containing an infringed image. This is of particular interest to those businesses hosting websites for others as the definition of distribution may be considered to fall within this category.

These are wide ranging definitions for infringement and they do not limit the use to particular goods or services as with a trade mark. As a result, this is a powerful right which is particularly attractive to brand owners.

Fees

There is no mention in the IR Ordinance of the level of fees for an application to register either a personality or an image. This will be set by the Registry nearer the time to the roll out of the Image Rights register.

OUR SERVICES

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