



THE THORNY QUESTION OF ENFORCEMENT

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One question that we have been asked (perhaps more so than any other) is how do I enforce this Guernsey Image Right worldwide? In one respect this is not surprising and in another respect, we find it quite strange.

We find it strange for one reason - that is because when we ask 'how many of your clients have you advised to get trademarks and of those how many have worldwide protection in their trademark portfolio?' the answer is invariably 'lots have trademarks but none have them worldwide and most not even outside their home jurisdiction'. So the world of image rights is operating in a rag bag fashion with no clear right anywhere in the world. No-one has or can have a worldwide right. The cost of having a trademark registered worldwide would be completely prohibitive and in many cases would not be of any use - it may not have been used, it may not be in the right class of goods and services and it may not satisfy the badge of origin test. The Guernsey right offers clarity in this world of image rights and has several significant advantages over the existing rights that exist. For the wider benefits, please see our briefing note 'Why should my client get a Guernsey Image Right?'

Enforcement of judgment

Assuming you have got a Guernsey judgment, what can you do with it? This is a little more straight forward. Guernsey has statutory reciprocal enforcement links with several (decidedly odd) jurisdictions, including all major UK jurisdictions, but also Suriname and the Dutch Antilles!

However, it is important not to place too much importance on statutory reciprocal enforcement, or the lack thereof in your jurisdiction of choice. The 'common law' enforcement process is generally no more complicated than commencing a simple debt proceeding in the foreign jurisdiction based on the Guernsey judgment - this is especially so in the 'common law' world, including the US, Canada, Australia and New Zealand. Absent any disqualifying factors (which in substance reflect those contained in the reciprocal enforcement legislation), we would expect little trouble in enforcing in those jurisdictions. However, it must be remembered that foreign enforcement of a Guernsey judgment is always a matter for the foreign Courts and hence not strictly a question of Guernsey law.

The portfolio and pragmatic approach

Several commentators have suggested to us that they take a very simple and pragmatic view of this right - it is simply better to have one than not to have one. That may sound flippant but is not intended to be so.

We are working on the assumption that there is likely to be a portfolio of rights, including registered rights such as trademarks and unregistered rights such as privacy and about if that business has been the licensing of that trademark and the associated image rights - several trademark lawyers have commented to us that linking the image rights to an existing trademark portfolio would help to extend

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the scope of that portfolio but also would assist if there was a trademark infringement. Such arguments range from the extremely technical use argument to the simple view that it is another registered right to include in the bundle - this range of views strays beyond the scope of Guernsey law and is a question of the home jurisdictions laws.

It is also relevant to consider how this might play out in a privacy, confidentiality or even copyright infringement claim. My reading of the Douglas v Hello case suggests that it was relevant to see the lengths that Michael and Catherine had gone to in order to keep their wedding private. I wonder whether it might not be helpful in a similar case to demonstrate that this type of individual had gone to all lengths that they had to protect their image. While the court may end up saying that it is Guernsey so it means nothing here, they may also say 'well you didn't register your rights in Guernsey, the only place in the world that you can so you can't really take them that seriously or value them that highly.' I wouldn't want to be on the end of that judgment!

Conclusion

We are not saying that this Guernsey right is a silver bullet for worldwide protection without restriction. That would be daft and ignorant. However, we do believe that this right may provide a range of interesting alternatives that have until recently not existed. For a moderate cost, it seems that having this option is much better than not having it. I never did find out what the Queen of Spain would have to be paid or why my wife was looking up the online dating agency though!

Jurisdiction

The question of jurisdiction is a tricky one. Although the authorities seem relatively colourful (covering the field from Mozambique to Storm Troopers), this involves some fairly arid debates of private international law. Essentially, there are two questions:

- First, when will the Guernsey Court exercise jurisdiction?
- Second, can and would a foreign court (say in the jurisdiction where the infringer has valuable assets) recognise and enforce the Guernsey Image Right itself?

Guernsey Court follows general common law principles, paying particular regard to English jurisprudence

As to the first question, the Guernsey Court follows general common law principles in this area, paying particular regard to English jurisprudence. As such, it is likely to follow principles established under trademark infringement on the internet, by way of example. As the Guernsey Image Right is more similar to a trademark than to copyright, some commentators have suggested that those principles are more likely to enable the Guernsey courts to take jurisdiction. In the case of a foreign defendant, the Court will look for a jurisdictional 'hook' to assume jurisdiction over the matter. We think there are a number of bases that the Court might rely upon (including that damage to the right will be "suffered" in Guernsey). The Court will then consider whether Guernsey is clearly the most appropriate jurisdiction to hear the dispute. As a general comment, the Guernsey Court does seem to take a fairly expansive attitude to its own jurisdiction.

As to the second question, the aforementioned Storm Trooper decision (Lucasfilm v Ainsworth) has been suggested by some commentators to provide the basis for an argument that foreign Courts, or at least those that follow English common law principles,

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could recognise and enforce Guernsey Image Rights. This is an interesting (to some of us, anyway) and developing area of law - the commentary is certainly a bold step. Whilst we think that private international law generally is certainly moving in the direction of universal recognition of such rights, whether we have reached this stage yet is something that can only be determined on a case by case basis.

Ashley Madison and the queen of Spain

My wife recently sent me a link to a Daily Mail article for a dating agency. There were two problems with this - one that she was sending me a link to a dating agency and secondly I could not work out whether it was for her benefit or mine - fortunately she had spotted my current favourite example of an image right infringement and how it might work in practice.

The story was that an online dating agency, Ashley Madison, had a picture of the Queen of Spain draped over a topless bloke with a strapline that gave us all some hope - it said 'Life is too short - Have an affair. With Ashley Madison, you'll never need to sleep alone.' Now call me a prude but it seems pretty punchy to link the Queen of Spain to that.

The Queen of Spain does not have a Guernsey Image Right but it got me to thinking about what would happen if she did. I could very clearly see that image on the internet in Guernsey and could, had I wanted to, logged on and got myself a date on my next trip to the US! It seems to me that Ashley Madison would have had to have paid an awful lot to the Queen of Spain to use her image in this way - if indeed they could have ever afforded it. It also seems to me that it is pretty morally prejudicial for her to be linked with this website in this way. I think that there was supposed to be some commentary on the state of her marriage.

Now some of you may say that the royalties for her to licence her rights in Guernsey would only have been limited - she might disagree and the Mastercard advert springs to mind - somethings are just priceless. In any event, it is a flagrant abuse of her image and, in this circumstance, the Guernsey courts would have had the power to award additional damages. It strikes me that she might well have preferred to have a Guernsey Image Right to have had the option. Under the current laws, she had no options.

The Guernsey Image Right grants much wider protection than any other current form of intellectual property in the field of image rights and personal branding. Like any form of IP, it is, of course, a territorial right. So, while trademarks have the potential for worldwide protection, they are very narrow in this field of image rights and personal branding. The Guernsey Image Right is, by comparison, much wider in scope of protection but potentially much more limited in terms of territorial scope. The combination of a decent trademark portfolio and a Guernsey Image Right is, however, a potent combination.

While some commentators have suggested that this right is a silver bullet for worldwide enforcement, we are much more cautious and do, of course, accept that there are some limitations in this right's application. In this note we set out some of the interesting points in the new law and why we consider that this new right should be seen as an additional and important tool in the armoury for potential enforcement.

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Starting point

The starting point is that an image right is infringed by the use of an image for a commercial purpose or financial benefit without consent. The test of infringement is similar to the test for trademarks where the image is identical or similar and there is likelihood of confusion. The test is also similar to trademarks such that there is an infringement where the image is identical or similar and it takes unfair advantage of the image. Additionally, the image is infringed if that use without due cause is detrimental to the value of that registered personality or the images. This reference to value goes wider than the traditional trademark principles. There are tests to ensure that only protected images can be infringed which centre around distinctiveness and value although where the image is registered the presumption is that such tests are satisfied.

Is it just damages?

While there are certain fair dealing limitations and some restrictions on the damages available, an infringement is generally actionable by the proprietor (or in certain cases a licensee) of an image right. All relief by way of damages, injunctions, accounts or otherwise is available to the party bringing the action.

When awarding damages, the award shall be appropriate to the actual prejudice suffered. All relevant factors shall be taken into account including lost profits suffered and unfair profits made. Interestingly, elements other than economic factors, including the moral prejudice suffered caused by the infringement can also be taken into account. This is significantly wider than the principles established under trademark law and takes the scope for damages substantially beyond pure economic loss. More similarly to trademark principles, damages may also be awarded on the basis of the royalties or fees which would have been due had the defendant obtained a licence.

Further, the court has the power to award additional damages depending on the flagrancy of the infringement and any benefit accruing to the defendant by reason of the infringement. This wording takes its origin from section 97 of the UK Copyright legislation and hence will benefit from what limited case law there is on this point.

We are often asked if a client was able to bring a successful claim for infringement whether such a claim would be limited to the damages suffered in Guernsey - we consider that there is the potential for such a claim to be much wider - not least because of this concept of moral prejudice and the ability to award additional damages. The combination seems to us to take us potentially beyond the pure economic loss that may have been suffered in Guernsey - which, of course, may be limited although see below for the Queen of Spain!

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FOR MORE INFORMATION PLEASE CONTACT:



DAVID EVANS

Director // Guernsey

t:+44 (0) 1481 734220 // e:david.evans@collascrillip.com



JASON ROMER

Group Managing Partner* // Jersey

t:+44 (0) 1534 601696 // e:jason.romer@collascrill.com

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