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UK: Protection Of Celebrity Images In The U.K. – Rihanna Decision Affirmed By Court Of Appeal

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Fenty & Ors v Arcadia Group Brands Limited (t/a Topshop) ([2013] EWHC 2310 (Ch), aff'd, [2015] EWCA Civ 3

We refer to our December 2013 Information Letter report on the decision by the UK High Court finding Topshop liable for passing off for engaging in unauthorized sale of T-shirts bearing an image of the well-known pop star Rihanna. In a ruling dated January 22, 2015, the Court of Appeal (Civil Division) has now upheld this decision. The case is significant in that prior cases have tended to rule against celebrity plaintiffs in such merchandising cases. Our prior report on the decision may be summarized as follows:

In a highly-publicized decision in July 2013, the High Court of England and Wales (Justice Birss) ruled that the UK-based retailer Topshop's sale of a T-shirt bearing a photograph of the singer without her authorization was an act of passing off. The T-shirt, which the retailer began selling in March 2012, featured an image of Rihanna taken during a video shoot for her single, "We Found Love," which was later used to promote her "Talk That Talk" album featuring that single. While Topshop's manufacturer had obtained a license from the photographer, Topshop had failed to seek authorization from Rihanna herself. Rihanna (and two of her corporate licensing vehicles) sued Topshop for passing off on the ground that sale of the T-shirt featuring her image would create the false impression that Rihanna had authorized the T-shirt.

In his decision, Justice Birss emphasized that UK law does not recognize image rights or rights of publicity, noting that "there is today in England no such thing as a freestanding general right by a famous person (or anyone else) to control the reproduction of their image." Instead, celebrities must rely on passing off to prevent the unauthorized third-party use of their images.

The plaintiff in a passing off action must establish that: (i) he or she has goodwill and reputation among relevant members of the public; (ii) the use in question constitutes a misrepresentation (i.e., is "likely to deceive those members of the public into buying the product because they think it is authorized by [the plaintiff]"; and (iii) the misrepresentation must cause damage to the individual's goodwill. It has been difficult for celebrities to prove misrepresentation in such cases. Courts have reasoned that consumers merely purchased the product because it featured the celebrity, and not because of the false belief that the celebrity had authorized it. The decision in this case was highly fact-driven and turned largely on whether there was a misrepresentation.

Goodwill. In considering goodwill, the court concluded that Rihanna had "ample goodwill" on the basis of several factors, including that the "world famous pop star" runs an extensive merchandising and endorsement operation and has made an effort to promote an association between herself and the world of fashion. In addition to several endorsement deals and collaborations with leading fashion companies, in 2010 and 2011 Rihanna had authorized goods sold in Topman, Topshop's men's store. The judge found that the scope of Rihanna's goodwill extended not only to her reputation as a musician but also to

the fashion industry where she was considered a "style icon."

Misrepresentation. The judge noted that selling a product featuring a recognizable image of a celebrity is not, on its own, passing off; the purchaser must be deceived into purchasing the product based on the false belief that the plaintiff authorized or endorsed it. If the consumer merely bought the T-shirt because it featured an image of the pop star, no misrepresentation has occurred; rather, in addition, "there must be a misrepresentation about trade origin."

Here, a key factor contributing to misrepresentation was the nature of the image itself. In particular, the image was similar to an image used in the above-mentioned album's promotional materials and resembled "a publicity shot for what was then a recent musical release." The court reasoned that use of this image for a T-shirt was thus likely to cause consumers to believe that the image was part of officially-authorized marketing merchandise. The court also noted that Topshop has a history of very public associations with fashionable celebrities, including Kate Moss and Rihanna herself. In fact, in 2010, Topshop sponsored a shopping competition where entrants were offered the chance to win a personal shopping appointment with Rihanna. Then, in February 2012, just weeks before the T-shirt in question went on sale, a visit by Rihanna to the flagship Topshop store was publicized by Topshop staff. This was clear evidence of Topshop's recognition and attempt to take advantage of Rihanna's status as a fashion icon. While the fact that the hangtag and label did not feature Rihanna's "R slash logo" or the word RIHANNA were in Topshop's favor, these factors were not sufficient to avoid a finding of misrepresentation.

Damage. The judge concluded that the misrepresentation would result in lost sales to Rihanna's merchandising business and a loss of control of her reputation in the fashion industry.

Court of Appeal. In affirming the High Court decision, the Court of Appeal agreed that UK law does not provide for a general right that allows a celebrity to control the use of his/her name or image. In this case, however, the court found that Rihanna had demonstrated an acquired protectable goodwill in her name. And while the decision cannot be relied upon to support a claim of "image rights" in general, it does show that a passing off theory may be used to protect a right to exploit one's image if the facts permit.

As noted in our original report, the case turned largely on the fact that Rihanna had engaged in substantial endorsement activity in the past, had collaborated in this regard with third parties (including Topshop, as well as H&M and others), and had done much to promote an association between herself and the fashion world, creating her image as a "style icon" in the minds of relevant portions of the public, especially young women. The Court of Appeal thus agreed with the finding of the High Court that Rihanna had acquired significant goodwill in relation to fashion, as well as in her role as a pop artist. The public would therefore associate any fashion items bearing her image as having been endorsed by her.

Conclusion. Unlike a number of previously unsuccessful passing off actions brought by celebrities in the UK, this case turned on certain salient facts, including especially the particular image used and the prior and apparently recent dealings between the plaintiff and Topshop. The decision may have gone the other way if, for example, Topshop had used a different image of Rihanna, and/or if such business dealings were not present. This decision demonstrates that passing off can be an effective enforcement tool where the facts demonstrate that a celebrity has clear goodwill in an industry and the nature of the unauthorized use is such that it would lead consumers to believe that the subject use of an image was officially authorized.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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