Singapore Journal of Legal Studies
[2010] 151–176

THE FAME MONSTER RELOADED: THE CONTEMPORARY CELEBRITY, CULTURAL STUDIES AND PASSING OFF*

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The common law jurisdictions of Australia and Singapore often adopt a conservative approach to recognising new property rights, particularly with respect to the human persona, but courts frequently take their cue from developments in the United Kingdom. This article revisits the landmark cases in these jurisdictions which, in declaring that a property right in the goodwill of a celebrity may be protected against unlicensed commercial appropriation, use language evocative of the right of publicity. It examines how the courts have expanded the passing off action to prevent the unauthorised commercial use of the images of well-known personalities. Finally, by adopting a cultural studies analysis that investigates the semiotic nature of the celebrity sign and its influence on contemporary consumption, this article offers a different perspective to the debate on the protection of image rights.

I. INTRODUCTION

The fame monster is a mysterious phenomenon. At barely 24, Lady Gaga has been named by *Time* alongside Bill Clinton, Marc Jacobs and Simon Cowell as one of the '100 Most Influential People in the World'.[1] We often desire to be associated with a famous individual; he or she is deified, idolised, admired and imitated. Yet we also want to see fame falter, where that same individual is subject to ridicule, mockery, scorn and derision. Much of cultural studies research concentrates on how a particular phenomenon relates to matters of ideology, race, social class and gender; it departs from the *text* (which seems to be the law's main concern) to undertake a discursive analysis of the *context* to consider how power in society is distributed and contested through processes of production, circulation and consumption. Elsewhere, I have argued that a pragmatic approach to cultural studies might be useful to law.[2] This article adopts the premise that the celebrity personality—or the commercially valuable public persona of a famous individual—is a collective product of a *celebrity trinity* comprising the celebrity individual, the audience and the cultural producers. Too often, the right of publicity laws in the United States that prevent

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* This article is jointly published with Sydney Law Review (2010, vol. 32, no. 2).

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1 *Time: The 100 Most Influential People in the World* (US Edition), Vol 175, No 18, 10 May 2010.

2 See David Tan, 'Beyond Trademark Law: What the Right of Publicity Can Learn from Cultural Studies' (2008) 25 *Cardozo Arts & Entertainment Law Journal* 913.

the unauthorised commercial exploitation of the celebrity identity[3] focus only on the celebrity individual as the equivalent of the celebrity personality, ignoring the quintessential roles of the audience and cultural producers. While the right of publicity doctrine does take into account the myriad interests of the constituents of the celebrity trinity, it tends to address only the tension between the celebrity individual and the producers when determining whether there was actionable commercial appropriation of the value of identity. In contrast, the common law passing off action considers the interests of all three constituents simultaneously when evaluating the commercial implications of an unauthorised use of identity and subsequent liability based on a misrepresentation to the audience of an association between the producer and the celebrity individual.

The recognition of a proprietary interest in the identity of a well-known individual in right of publicity doctrine is analogous to the recognition of a proprietary interest in goodwill or reputation of the celebrity in a common law passing off claim. Both actions acknowledge that the law should protect the commercial interests of these individuals and prevent unlawful profiting. However, it is established law that a right of publicity claim does not require any evidence that a consumer is likely to be confused as to the plaintiff's association with, or endorsement of, the defendant's use.[4] Therefore it appears more expansive in its protection against an unauthorised use of identity compared to a common law passing off claim. Celebrities in common law jurisdictions like the United Kingdom (UK), Australia and Singapore generally rely on the action of passing off and equivalent statutory claims if their identities have been used without their consent in advertising or trade as the right of publicity is not recognised in these jurisdictions.[5] Unlike in a right of publicity claim, it is

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3 *Restatement (Third) of Unfair Competition* § 46 (1995). The United States right of publicity action is available to all claimants—celebrities and non-celebrities. However, due to the highly lucrative commercial value associated with the celebrity identity, most claims are brought by celebrities like Tiger Woods, Dustin Hoffman, Johnny Carson, Bette Midler and professional sporting league athletes for unauthorised uses of their identity. See, eg, *ETW Corp v Jireh Publishing*, 332 F 3d 915 (6th Cir, 2003) ('*ETW Corp*'); *Hoffman v Capital Cities/ABC Inc*, 255 F 3d 1180 (9th Cir, 2001) ('*Hoffman*'); *Midler v Ford Motor Co*, 849 F 2d 460 (9th Cir, 1988); *Carson v Here's Johnny Portable Toilets Inc*, 698 F 2d 831 (6th Cir, 1983); *Doe v TCI Cablevision*, 110 SW 3d 363 (Mo banc, 2003) cert denied 540 US 1106 (2004); *Wendt v Host International Inc*, 125 F 3d 806 (9th Cir, 1997); *Cardtoons LC v Major League Baseball Players Association*, 95 F 3d 959 (10th Cir, 1996).

4 *Restatement (Third) of Unfair Competition* §§ 46 cmt c, 47 cmt a (1995); J Thomas McCarthy, *The Rights of Publicity and Privacy* (Clark Boardman, 2nd ed, 2000) § 2:8; Melville B Nimmer, 'The Right of Publicity' (1954) 19 *Law & Contemporary Problems* 203, 212; *Parks v LaFace Records*, 329 F 3d 437, 460 (6th Cir, 2003) ('*Parks*'); *Abdul-Jabbar v General Motors Corp*, 75 F 3d 1391, 1398 (9th Cir, 1996) ('*Abdul-Jabbar*'); *Rogers v Grimaldi*, 875 F 2d 994, 1004 (2nd Cir, 1989) ('*Rogers*').

5 The common law passing off action finds an equivalent in the United States, where the broad language of the federal *Lanham Act* § 43(a) creates a civil cause of action against any person who identifies his or her product in such a way as to likely cause confusion among consumers or to cause consumers to make a mistake or to deceive consumers as to the association of the producer of the product with another person or regarding the origin of the product or the sponsorship or approval of the product by another person: 15 USC § 1125(a). Plaintiffs in the United States often invoke § 43(a) to protect intellectual property rights in 'trademarks' or 'marks', but it is increasingly used by celebrities 'to vindicate property rights in their identities against allegedly misleading commercial use by others': *Parks*, 329 F 3d 437, 445 (6th Cir, 2003). See also *Parks*, ibid 447 (noting that 'courts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a)'). There appears to be a growing trend in celebrities filing concurrent right of publicity and *Lanham Act* claims for unauthorised commercial uses of their identity. See, eg, *White v Samsung Electronics America Inc*, 971 F 2d 1395, 1399–400

necessary to show in passing off that consumers have been misled or deceived as to the celebrity's endorsement of, or association with, the defendant's products.[6]

This article argues that the common law passing off action provides adequate protection against unlawful exploitation of the celebrity persona. Part II outlines the elements of the modern extended passing off action as applied by courts over the last few years. Part III presents an overview of how insights from cultural studies may be useful to passing off jurisprudence. Drawing on cultural studies, Part IV contends that the subsistence of goodwill in a celebrity persona may reside in a wide range of evocative indicia of identity as long as they are readily identifiable by the relevant segment of consumers. Part V argues that an impressionistic approach to determining misrepresentation may be supported by cultural studies perspectives on the transfer of affective meanings from the celebrity sign to the celebrity-related product in contemporary consumption. Finally, Part VI concludes that the focus on the impression that is created in the minds of consumers in a passing off action can overcome some of the doctrinal objections to characterising indicia of identity as personal property, and the element of misrepresentation. This approach requires courts to examine whether in fact the affective meanings of a celebrity persona have been transferred as a result of consumers perceiving an endorsement, approval or association of a celebrity plaintiff with the defendant's products. Such an approach is consonant with contemporary consumption of the celebrity commodity.

II. The Extended Passing Off Action

In a number of Anglo-liberal common law jurisdictions like the UK and Australia, there is no actionable proprietary right in one's identity equivalent to the right of publicity in the United States. The classic common law tort of passing off was originally intended to protect against rival traders in the same field of business 'passing off' their products as the products of another competitor ('trading goodwill'), with its rationale being the prevention of commercial dishonesty.[7] Subsequently, passing off has broadened to protect goodwill 'not in its classic form of a trader representing

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(9th Cir, 1992) ('*White I*'); *Waits v Frito Lay Inc*, 978 F 2d 1093, 1110 (9th Cir, 1992) ('*Waits*'); *Abdul-Jabbar*, 85 F 3d 407, 410 (9th Cir, 1996); *Landham v Lewis Galoob Toys Inc*, 227 F 3d 619, 626 (6th Cir, 2000); *Allen v National Video Inc*, 610 F Supp 612, 624–5 (SD NY, 1985) ('*Allen*').

6 See, eg, *Irvine v Talksport Ltd* [2002] 1 WLR 2355 ('*Irvine*'); *Pacific Dunlop Ltd v Hogan* (1989) 25 FCR 553 ('*Crocodile Dundee case*'); *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314 ('*Koala Dundee*'); *Henderson v Radio Corporation Pty Ltd* (1960) SR(NSW) 576 ('*Henderson*'). In Australia, plaintiffs may also bring a statutory action for misleading and deceptive conduct under s 52 of the *Trade Practices Act 1974* (Cth). See *Campomar Sociedad Limitada v Nike International Ltd* (2000) 202 CLR 45, 88 ('*Campomar*') ('Section 52 is designed to protect consumers. However, passing-off, at least so far as concerns equitable relief, protects injury to the goodwill built up by activities of the plaintiff').

7 See, eg, *Reddaway (Frank) & Co Ltd v George Banham & Co Ltd* [1896] AC 199, 204; *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] AC 731, 742 ('*Erven Warnink*'); *Irvine*, ibid 2360. See also David Tan and J Thomas McCarthy, 'Australia—Protecting goodwill and reputation' in J Thomas McCarthy, *The Rights of Publicity and Privacy* (Thomson West, 2000) (updated March 2010) § 6:158; Alison Laurie, 'The Big Sell: The Value and Effectiveness of Character Merchandising Protection in Australia' (2003) 54 *Intellectual Property Forum* 12, 14; Benjamin F Katekar, 'Coping with Character Merchandising—Passing Off Unsurpassed' (1996) 7 *Australian Intellectual Property Journal* 178, 188.

his goods as the goods of somebody else, but in an extended form'[8] as 'the attractive force which brings in custom'.[9] In the UK, Laddie J in *Irvine v Talksport Ltd* declared that the extended action of passing off today does not require the plaintiff to prove a common field of activity;[10] and it appears that the passing off action is capable of protecting the goodwill or valuable reputation of a person or business against any unauthorised claim of association or connection by another ('promotional goodwill').[11] It is also clear that the passing off action is 'a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation'.[12] This position resonates with the cases in Australia and Singapore.[13]

Despite there being no generally accepted definition of passing off, the element of misrepresentation or misleading or deceptive conduct is considered to be central to the tort.[14] The elements of a common law passing off action in the UK, Australia and Singapore follow the position set out by the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc*[15] in that there are three key elements of goodwill or valuable reputation, deceptive conduct and damage.[16]

It is generally accepted that consumers are often influenced in their choice of products because of a perceived association between those products and a celebrity personality. Over the last two decades, the courts have increasingly recognised that it is a prevalent commercial practice 'whereby, to gain a competitive advantage, goods and services are marketed to the public by associating them with a well-known personality, real or fictitious … who has developed an identifiable reputation among potential purchasers … [thus appearing] more desirable to consumers'.[17] As a Federal Court of Australia judge remarked, the use of celebrities in advertising seeks to 'foster

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8 *Erven Warnink*, ibid 739. One commentator has argued that the early cases revealed 'clear signs of the courts' willingness to protect valuable personal reputations … [and] it is apparent that the law of passing off has not changed substantially since these early times'. See Ian Tregoning, 'What's In A Name? Goodwill in Early Passing-Off Cases' (2008) 34 *Monash University Law Review* 75, 101.

9 *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, 224 ('*Muller*'). See also *Federal Commissioner for Taxation v Murry* (1998) 193 CLR 605, 615 ('*Murry*').

10 *Irvine* [2002] 1 WLR 2355, 2368. For criticisms of the rejection of a need for common field of activity, see Gary Scanlan, 'Personality, Endorsement and Everything: The Modern Law of Passing Off and the Myth of the Personality Right' (2003) 25 *European Intellectual Property Review* 563, 568–9.

11 See, eg, Samuel K Murumba, *Commercial Exploitation of Personality* (Law Book Co, 1986) 65. See also *Arsenal FC plc v Reed* [2001] RPC 922, 930–1.

12 *Star Industrial Co Ltd v Yap Kwee Kor* (1975) 1B IPR 582, 592. See also *Burberrys v JC Cording & Co Ltd* (1909) 26 RPC 693, 701. This is in contrast to the right of publicity. See, eg, *Haelan Laboratories Inc v Topps Chewing Gum Inc*, 202 F 2d 866 (2nd Cir, 1953); *White I*, 971 F 2d 1395 (9th Cir, 1992); *Waits*, 978 F 2d 1093 (9th Cir, 1992); *Abdul-Jabbar*, 85 F 3d 407 (9th Cir, 1996).

13 See, eg, *Campomar* (2000) 202 CLR 45, 89 (Australian High Court unanimous decision). See also *Henderson* (1960) SR(NSW) 576; *Crocodile Dundee case* (1989) 25 FCR 553; *Koala Dundee Pty Ltd* (1988) 20 FCR 314; *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ('*CDL Hotels*').

14 See, eg, *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302, 356 ('*ConAgra*') (it 'contains sufficient nooks and crannies to make it difficult to formulate any satisfactory definition'); *Irvine* [2002] 1 WLR 2355, 2360 (it ensures 'a degree of honesty and fairness in the way trade is conducted').

15 [1990] 1 All ER 873 ('*Reckitt & Colman*').

16 See, eg, *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] 1 WLR 193 ('*Cadbury Schweppes*'); *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* (1984) 156 CLR 414 ('*Moorgate Tobacco (No 2)*'); *Irvine* [2002] 1 WLR 2355.

17 Laurie, above n 7, 12.

favourable inclination towards [the product], a good feeling about it, an emotional attachment to it' such that the product is 'better in [the] eyes' of the consumers than a comparable product without such an association.[18] The typical celebrity claims made in passing off actions are that the use of name, likeness, voice or other indicia of identity mislead a significant proportion of consumers by implying:

(i) that the celebrity *approved* of the advertiser/trader or its product;
(ii) that the celebrity *consented* to the use of his/her identity by the advertiser/trader; or
(iii) that there is some *connection or association* between the celebrity and the advertiser/trader (impressionistic association).

Over the last decade, there have been relatively few passing off claims by celebrities in the UK, Australia or Singapore. The most high profile case arguably is Formula One driver Eddie Irvine's claim against Talksport for using a digitally altered photograph of him holding a portable radio bearing the name of the radio station in a promotional brochure.[19] Commentator Hazel Carty, in a comparative analysis of publicity rights and passing off, has intimated that *Irvine* 'signals a marked advance in [celebrities'] quest for image rights'[20] but the 'problem with the discussion in *Irvine* is that a tight definition of "endorse" is not applied'.[21] Irvine was awarded damages at first instance amounting to £2000, but this was increased to £25 000 on appeal, being the 'reasonable endorsement fee' the defendant '*would have had to pay* in order to obtain lawfully that which it in fact obtained unlawfully'.[22] The decision of Laddie J at first instance, with its ringing endorsement of the Australian case of *Henderson v Radio Corporation Pty Ltd* in eliminating the need to show a common field of activity,[23] suggests that English and Australian cases may be converging in the area of passing off claims by well-known individuals. It is also important to note that Laddie J's views appear to have been accepted by the English Court of Appeal.[24] Although Laddie J does not refer to the Australian passing off cases involving claims by celebrities like Paul Hogan and Kieren Perkins,[25] his judgment indicates that the English courts may be prepared to go as far as the Australian courts in finding that impressionistic association may suffice as misrepresentation. In particular, as Laddie J declares:

> the court can take judicial notice that it is common for famous people to exploit their names and images by way of endorsement … those in business have reason to believe that the lustre of a famous personality, if attached to their goods or services, will enhance the attractiveness of those goods or services to their target market.[26]

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18 *Crocodile Dundee case* (1989) 25 FCR 553, 583–4 (Burchett J).
19 *Irvine* [2002] 1 WLR 2355.
20 Hazel Carty, 'Advertising, Publicity Rights and English Law' (2004) 3 *Intellectual Property Quarterly* 209, 253.
21 Ibid 256.
22 *Irvine v Talksport Ltd (Damages)* [2003] 2 All ER 881, 903 ('*Irvine (Damages)*').
23 *Irvine* [2002] 1 WLR 2355, 2365, 2368.
24 *Irvine (Damages)* [2003] 2 All ER 881, 887.
25 See discussion in Part IV below.
26 *Irvine* [2002] 1 WLR 2355, 2368.

The dicta suggests that courts may adopt, as evident in the *Crocodile Dundee* litigation,[27] a less stringent view of misrepresentation when the celebrity persona has been used by the defendant in advertising and merchandising. Although there is a dearth of celebrity passing off cases in Singapore,[28] the consideration by the Singaporean courts of all evidence of the surrounding circumstances, which include the nature of the purchasing public, the intent of the defendant, the extent of confusion and the way in which confusion arises, also allows room for impressionistic association to satisfy the requirement of confusion or deception.[29]

If courts embrace an impressionistic approach toward determining misrepresentation, the passing off action can provide robust protection against the misappropriation of the commercial value of the celebrity persona, and may even extend greater protection to the celebrity plaintiff than the right of publicity. Such an approach is supported by analyses in cultural studies that investigate how the celebrity personality can influence contemporary consumption. Although there has been criticism that adopting an impressionistic approach to misrepresentation is tantamount to recognising a de facto tort of misappropriation of personality,[30] this article argues that attuning judicial inquiry to whether the affective value of the celebrity persona has been perceived to have transferred to the defendant's product can mitigate this concern of equating identification with liability.

III. Passing Off—A Cultural Studies Perspective

In the aftermath of *Irvine*, the need for clarity involves the following salient issues to be addressed: 'was there a real suggestion of endorsement; was this "material" to consumer choice; was goodwill harmed?'[31] The focus of this article will be on two key principles: the presence of goodwill and misleading or deceptive conduct. As cultural studies is a diverse discipline that incorporates perspectives from areas such as anthropology, gender studies, media studies, semiotics and sociology, this article has adopted a combination of resources 'based on revised, updated, and reconstructed readings of British cultural studies, of the Frankfurt School, of some positions of postmodern theory, and of feminism and multicultural theory'.[32] It agrees with cultural scholar Douglas Kellner that, instead of selecting a particular theory of cultural studies, this 'multiperspectival approach' is not only 'pragmatic contextualist' in its orientation, but can also yield 'more insightful and useful analyses than those

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27 *Crocodile Dundee case* (1989) 25 FCR 553; *Koala Dundee* (1988) 20 FCR 314.

28 Curiously, two claims brought by a well-known model and politician respectively in Singapore for an unauthorised use of their images in advertisements, eschewed the passing off action and relied instead on the tort of defamation. Both plaintiffs succeeded. See *Chiam See Tong v Xin Zhang Jiang Restaurant* [1995] 3 SLR 196; *Hanis Saini Hussey v Integrated Information* [1998] SGHC 219.

29 See, eg, *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] SLR 133, 142; *Saga Foodstuffs Manufacturers (Pte) Ltd v Best Food Pte Ltd* [1995] 1 SLR 739, 749; *Pontiac Marina Pte Ltd v CDL Hotels International Ltd* [1997] 3 SLR 726, [106]. See also *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR 712, [97].

30 See, eg, Katekar, above n 7; Carty, above n 20.

31 Carty, ibid 254.

32 Douglas Kellner, *Media Culture: Cultural Studies, Identity and Politics between the Modern and the Postmodern* (Routledge, 1995) 9.

produced by one perspective alone'.[33] Such an approach is evident in the celebrity studies of contemporary cultural scholars like Richard Dyer, David Marshall, Graeme Turner and Stuart Hall, whose writings constitute an invaluable resource for this research.[34]

Indeed the usefulness of cultural studies to passing off doctrine lies in its examination of the roles and meanings of celebrities in contemporary society, how people consume them and incorporate them into their daily lives. Some of these ideas are evident in the writings of legal scholars like Rosemary Coombe and Michael Madow who have drawn from cultural studies to critique the right of publicity and other intellectual property regimes for their restrictive impact on the public domain.[35] However, this article will use cultural studies in a different manner from the postmodern agenda of these legal scholars;[36] it will instead employ cultural studies with a pragmatic orientation to discover what it has to offer to the advancement of passing off doctrine.

The celebrity, as a widely recognised cultural sign, can encourage the public who identify with the attributed ideological values to consume the celebrity itself as a commodity (for example, by watching the movies of a particular actor) or products associated with the celebrity (for example, by purchasing celebrity-endorsed products). In his critique of consumption, Jean Baudrillard contends that the consumer 'no longer relates to a particular object in its specific utility, but to a set of objects in its total signification'.[37] Thus, increasingly, when consumers buy various consumer goods, they 'buy into' the significations of these commodities in the construction of their self-identities.[38] Due to the meticulously constructed public personae of many celebrities—particularly movie stars and sport icons[39]—the semiotic sign of these well-known individuals is usually 'decoded' by the audience to represent a

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33 Ibid 26.

34 See, eg, Richard Dyer, *Stars* (British Film Institute, 1979); Richard Dyer, *Heavenly Bodies: Film Stars and Society* (Routledge, 1986); P David Marshall, *Celebrity and Power: Fame in Contemporary Culture* (University of Minnesota Press, 1997); Graeme Turner, *Understanding Celebrity* (Sage, 2004); Stuart Hall, 'Encoding/Decoding' in Stuart Hall, Dorothy Hobson, Andrew Lowe and Paul Willis (eds), *Culture, Media, Language* (Harper Collins, 1980) 128.

35 See, eg, Rosemary J Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation, and the Law* (Duke University Press, 1998); Rosemary J Coombe, 'Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue' (1991) 69 *Texas Law Review* 1853; Michael Madow, 'Private Ownership of Public Image: Popular Culture and Publicity Rights' (1993) 81 *California Law Review* 125.

36 See, eg, Madow, ibid; Rosemary J Coombe, 'Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders' (1992) 10 *Cardozo Arts & Entertainment Law Journal* 365; Margaret Chon, 'Postmodern "Progress": Reconsidering the Copyright and Patent Power' (1993) 43 *DePaul Law Review* 97; Keith Aoki, 'Adrift in the Intertext: Authorship and Audience "Recoding" Rights' (1993) 68 *Chicago-Kent Law Review* 805; David Lange, 'Recognizing the Public Domain' (1981) 44(4) *Law & Contemporary Problems* 147.

37 Jean Baudrillard, *The Consumer Society: Myths and Structures* (Chris Turner trans, Sage, 1998 ed) [trans of: *La Sociètè de Consummation* (first published 1970)] 27.

38 See also prominent arguments by Zygmunt Bauman, *Postmodernity and Its Discontents* (Polity Press, 1997); Zygmunt Bauman, *Consuming Life* (Polity Press, 2007).

39 See, eg, Dyer, above n 34; Richard DeCordova, *Picture Personalities: The Emergence of the Star System in America* (University of Illinois Press, 1990); Christine Gledhill (ed), *Stardom: Industry of Desire* (Routledge, 1991); Garry Whannel, *Media Sport Stars: Masculinities and Moralities* (Routledge, 2002); Barry Smart, *The Sport Star: Modern Sport and the Cultural Economy of Sporting Celebrity* (Sage, 2005).

defined cluster of meanings.[40] While movie stars are often represented as objects of aspiration, glamour and desire,[41] the celebrity athlete signifies heroism, human transcendence and a love for the pure authentic game.[42] The concept of celebrity—with its attendant notions of well-knownness, adulation and popularity—is signified through, for example, an entertainer or athlete, and the resulting product is a sign replete with meaning in everyday culture. It is generally accepted in cultural studies that celebrities possess particular configurations of meanings; and each celebrity personality can offer these meanings with a special precision that can add value to products. Indeed both Turner and Marshall view celebrities to be created primarily for commercial and promotional purposes.[43] Marshall also sees celebrities as being influential representatives of the public, signifying 'subject positions that audiences can adopt or adapt in the formation of social identities'.[44] Consumers are seen to 'shap[e] a sense of self through the object of fandom' by consuming products associated with celebrities.[45] It has been argued that these products of themselves have no value. Ellis Cashmore contends that 'having the approval of a celebrity may convince some consumers that they are buying something authentic, substantial, or even profound' and points out that '[v]alue doesn't exist in any pure form: products are invested with value'.[46] Thus a particular celebrity individual enjoys goodwill in his or her identity only because consumers have vested meanings in his or her readily recognisable persona.

From a cultural studies perspective, it may be argued that the passing off action correctly focuses on the interrelationships between the celebrity individual, cultural

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40 See, eg, Dyer (1979), above n 34, 33–85; Marshall, above n 34, 56–71, 185–99, 244–7; Turner, above n 34, 14–5, 23–6, 89–108; Chris Rojek, *Celebrity* (2001), 51–63, 74–8, 91–9, 186–99. For a discussion of the encoding of meanings in these commodities, and the subsequent decoding by audiences, see Roland Barthes, *Mythologies* (Annette Lavers trans, Farrar, Straus and Giroux, 1972) 110–11; Hall, above n 34, 131–8.

41 See, eg, Dyer, ibid 99 ('stars are supremely figures of identification … and this identification is achieved principally through the star's relation to social types'); Paul McDonald, 'Supplementary Chapter: Reconceptualizing Stardom' in Richard Dyer, *Stars* (2nd ed, 1998) 191 ('American films offered a greater degree of "glamour", and American film stars acted as the special representatives of that glamour'); Carmel Giarratana, 'The Keanu Effect—Stardom and the Landscape of the Acting Body: Los Angeles/Hollywood as Sight/Site' in Angela Ndalianis and Charlotte Henry (eds), *Stars in Our Eyes: The Star Phenomenon in the Contemporary Era* (Greenwood, 2002) 61 (analysing the stardom of movie celebrities especially the global popularity of Keanu Reeves).

42 See, eg, Whannel, above n 39, 46 ('The cultures of sport still depend in part upon a constant re-enacting of the heroic … Footballers Paul Gascoigne and Ryan Giggs have had to carry the burden of figures expected to provide the heroic.'); CL Cole and David L Andrews, 'America's New Son: Tiger Woods and America's multiculturalism' in David L Andrews and Steven J Jackson (eds), *Sport Stars: The Cultural Politics of Sporting Celebrity* (Routledge, 2001) 70, 81 ('Woods signifies a post-national order, suggests a transnational coalition of sorts, and is imagined as a global-national antidote … Woods is coded as a multicultural sign of color-blindness'); Kyle W Kusz, 'Andre Agassi and Generation X: Reading white masculinity in 1990s' America' in *Sport Stars*, ibid 51, 64 ('the rearticulation of Agassi's white masculinity in the mid-1990s exemplifies the process in which he was constructed and valorized for exemplifying a reformed Generation X slacker').

43 Turner, above n 34, 9, 34; Marshall, above n 34, 65, 244–6. See also Ellis Cashmore, *Celebrity/Culture* (Abingdon, 2006) 72.

44 Marshall, above n 34, 65.

45 Cornel Sandvoss, *Fans: The Mirror of Consumption* (Polity Press, 2005) 157. See also David Lewis and Darren Bridger, *The Soul of the New Consumer* (Nicholas Brealey Publishing, 2001) 28.

46 Cashmore, above n 43, 167.

producers and audiences in determining legal liability, whereas the right of publicity appears more concerned with conferring and protecting a property right of the celebrity individual from being interfered with by free-riding producers. In not regarding identity to be a property right, the passing off action offers a less controversial approach to enforcing one's interest against unauthorised commercial exploitation of identity only under the conditions where the *associative* value of identity has been misappropriated. Rather than relying on a presumption,[47] the passing off action requires courts to examine the impact and reaction of audiences to the unauthorised use of identity in their determination of liability. The next two parts argue that two key elements in passing off doctrine—the subsistence of goodwill and the presence of misrepresentation/likelihood of confusion—find strong support in cultural studies for their potential to take into account the celebrity trinity as well as the research findings on contemporary consumption behaviour.

IV. Goodwill and Well-Knownness of the Celebrity

A. *Existence of Local Goodwill*

Although the courts have conceded that 'goodwill' was 'a thing very easy to describe, very difficult to define',[48] it is accepted that the threshold issue is usually a question of whether the plaintiff has the requisite local goodwill or reputation to support an action in passing off where it is shown that a substantial number of people would consider the name, get-up or other indicia to be distinctive of the goods or services of the plaintiff.[49] In advertising or merchandising involving celebrity personalities, as the proprietary right protected in passing off is property in the goodwill or reputation which *attaches* to the name, likeness or other indicia of identity rather than property in those indicia themselves, the passing off action, unlike the right of publicity, does not protect any commercial exploitation right per se in the indicia of identity. As the Australian High Court has emphasised, 'goodwill is not something which can be conveyed or held in gross; it is something which attaches to a business'.[50]

In a passing off claim, a celebrity has to show that he or she has a protectable commercial goodwill or reputation within a particular area or location in which the relevant misrepresentation is alleged to have taken place.[51] The terms 'goodwill'

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47 It is presently accepted by the courts, in right of publicity cases, that the defendant should be held liable because 'it received a benefit by getting to use a celebrity's name for free in its advertising' or when the celebrity's identity is used 'to attract the consumers' attention'. See, eg, *Eastwood v Superior Court of Los Angeles County*, 149 Cal App 3d 409, 420 (1983) ('*Eastwood*'); *Abdul-Jabbar*, 85 F 3d 407, 416 (9th Cir, 1996); *Henley*, 46 F Supp 2d 587, 597 (ND Tex, 1999).

48 See, eg, *Murry* (1998) 193 CLR 605, 631; *Muller* [1901] AC 217, 223.

49 See, eg, *Reckitt & Colman* [1990] 1 All ER 873, 880; *ConAgra* (1992) 33 FCR 302, 346–50.

50 *Murry* (1998) 193 CLR 605, 615 (citing *Geraghty v Minter* (1979) 142 CLR 177, 181).

51 In Australia, it is not necessary for the plaintiff to have a business presence in Australia; it is sufficient that he or she has a reputation among the persons there. See, eg, *ConAgra* (1992) 33 FCR 302, 340–4. The specific thing in which goodwill is vested must also be identified. See, eg, *Conan Doyle v London Mystery Magazine Ltd* (1949) 66 RPC 312, 313–14 (goodwill only in existing stories and not generally in all aspects of Sherlock Holmes character).

and 'reputation' have been used interchangeably.[52] In other words, it is recognised that the reputation of a plaintiff in the forum is the source of his potential business there; and a 'sufficient reputation' to be actionable 'requires something more than a reputation among a small number of persons'.[53] For most individuals who have become well-known to the public through their endeavours in the fields of sports, entertainment or popular culture, it appears that they will have no problem satisfying the first element of a common law passing off claim.[54] Expert evidence, survey evidence and results from focus groups are often admitted as evidence used to prove the subsistence of goodwill.[55]

In *Henderson v Radio Corp*, in arriving at the conclusion that the professional ballroom dancing couple has the requisite protectable reputation, the Supreme Court of New South Wales examined the 'publicity [the plaintiffs] received through their public performances, personal and on television, through their lectures and demonstrations, and by means of articles, photographs and advertisements which have appeared in the press'.[56] It does not matter to the courts how the goodwill of a celebrity has become fixed in the minds of the relevant section of the public, as long as it has gained a distinctive character recognised by the public through repeated exposure in the entertainment and communications media.[57]

B. *Identification of the Celebrity*

The House of Lords has recognised that the tort of passing off is 'wide enough to encompass other descriptive material, such as slogans or visual images … provided always that such descriptive material has become part of the goodwill of the product'.[58] Similarly, the Australian High Court, in a unanimous decision, has indicated that:

> the adaptation of the traditional doctrine of passing off to meet new circumstances involving the deceptive or confusing use of *names, descriptive terms or other indicia* to persuade purchasers or customers to believe that goods or services have an association [with], quality or endorsement [of] … another …[59]

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[52] See, eg, *Consorzio del Prosciutto di Parma v Marks & Spencer plc* (1989) 16 IPR 117, 123–4; *ConAgra* (1992) 33 FCR 302, 340; Christopher Wadlow, *The Law of Passing Off* (Sweet & Maxwell, 3rd ed, 2004) 6.

[53] *ConAgra* (1992) 33 FCR 302, 346.

[54] See, eg, *Irvine* [2002] 1 WLR 2355 (F1 driver Eddie Irvine); *Crocodile Dundee case* (1989) 25 FCR 553 (actor Paul Hogan); *Hutchence v South Sea Bubble Co Pty Ltd* (1986) 6 IPR 473 ('*Hutchence*') (pop music group INXS); *Talmax* [1997] 2 Qd R 444 (swimmer Kieren Perkins); *Honey v Australian Airlines* (1990) 18 IPR 185 (athlete Gary Honey); *Newton-John v Scholl-Plough (Australia) Ltd* (1986) 11 FCR 233 (singer Olivia Newton-John).

[55] See, eg, *Telstra Corp Ltd v Royal & Sun Alliance Insurance Australia Ltd* (2003) 57 IPR 453. However, courts are more reluctant to place great weight on expert testimony and survey evidence as proof of misrepresentation. Cf *Pacific Publications Pty Ltd v IPC Media Pty Ltd* (2003) 57 IPR 28; *CA Henschke & Co v Rosemount Estates Pty Ltd* (1999) 47 IPR 63; *CDL Hotels* [1998] 2 SLR 550.

[56] *Henderson* (1960) SR(NSW) 576, 579.

[57] See, eg, *Hutchence* (1986) 6 IPR 473; *Twentieth Century Fox Film Corp v South Australian Brewing Co Ltd* (1996) 34 IPR 225, 230–2 ('*Duff Beer case*').

[58] *Cadbury-Schweppes* [1981] 1 WLR 193, 200. See also *Irvine* [2002] 1 WLR 2355, 2361.

[59] *Campomar* (2000) 202 CLR 45, 88–9 (quoting *Moorgate Tobacco (No 2)* (1984) 156 CLR 414, 445) (emphasis added).

Although passing off cases in the UK and Australia have yet to consider evocative aspects of identity to the extent that right of publicity cases like *White v Samsung* have in the US, it appears that evocative aspects of identity[60]—like the 'Here's Johnny' slogan in *Carson v Here's Johnny Portable Toilets*[61] and the distinctive racing car in *Motschenbacher v RJ Reynolds Tobacco Company*[62]—which allow a relevant section of the public to identify a particular celebrity would be 'protected' in passing off as long as the celebrity meets the local standard of goodwill/reputation. In fact, Pincus J of the Federal Court of Australia made explicit reference to *Motschenbacher*: that where a well-known personality may be identified by consumers through indicia associated with him, it is open to the plaintiff then to show wrongful association of goods with him.[63] On the other hand, despite the plaintiff being a well-known personality, there can be no liability if the plaintiff was not sufficiently identified by a significant segment of the target audience from the defendant's use.[64] This first element of passing off finds a parallel in the threshold requirement of identification in a right of publicity claim.[65]

The reasoning in two Australian cases involving a lookalike and a role played by a celebrity plaintiff suggests that courts there are willing to extend the passing off action to cover evocative indicia of identity. However, unlike the vigorous opposition witnessed with regard to recognising actionable evocation in right of publicity doctrine, the requirement of proof of misrepresentation in passing off can present a formidable obstacle to a plaintiff's success. In *Newton-John v Scholl-Plough*, an advertisement featured an Olivia Newton-John lookalike with the slogan 'Olivia? No, Maybelline' in 'large and striking letters'.[66] The court acknowledged that Maybelline had '[made]

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60 The word 'evoke' means 'to call forth', 'to conjure up' or 'to bring to mind or recollection'. Presently, all the other indicia of identity outside of 'name' and 'likeness' which are recognised by the courts fall into three broad categories, united by their ability—either singularly or in various combinations—to 'evoke' the celebrity in the minds of the audience in a manner that readily identifies the plaintiff. These three categories are: (i) a distinctive voice that evokes the celebrity (as represented by the typical soundalike imitation cases); (ii) a role or character that is evocative of the plaintiff (as represented by the typical use of a film or television character popularised by the plaintiff); (c) other indicia that evoke the celebrity (as seen in the more difficult cases where the defendant has used a combination of objects, dress, makeup, performing style, music, set design etc). In summary, some courts are prepared to find that the identity requirement is satisfied as long as a clear reference to a celebrity has been evoked by an advertisement—ie, where the celebrity in question is 'readily identifiable' by the audience—from which there was a commercial advantage to be gained by the defendant. See, eg, *Midler*, 849 F 2d 460 (9th Cir, 1988); *Waits*, 978 F 2d 1093 (9th Cir, 1992); *White I*, 971 F 2d 1395 (9th Cir, 1992).

61 698 F 2d 831 (6th Cir, 1983).

62 498 F 2d 821 (9th Cir, 1974).

63 *Koala Dundee* (1988) 20 FCR 314, 325.

64 *10th Cantanae Pty Ltd v Shoshana Pty Ltd* (1987) 79 ALR 299, 302–3, 308. The majority required that the plaintiff be 'unequivocally' or 'plainly' identified from the defendant's advertisement. Contra *Shoshana Pty Ltd v 10th Cantanae Pty Ltd* (1987) 18 FCR 285, 291 (where the trial judge found that 'many readers … would associate an advertisement concerned with television, and picturing an attractive brunette, with the well-known television image of Sue Smith').

65 To establish a prima face case, a plaintiff must usually prove that his or her identity has been used, that is, a 'more than de minimis number of ordinary viewers of [the] defendant's use identify the plaintiff': McCarthy, above n 4, § 3:17. See also McCarthy, ibid §§ 3:18–3:22, 4:47, 4:56–4:57, 4:60. The Ninth Circuit has also pointed out that '[i]dentifiability … is a central element of a right of publicity claim.' *Waits*, 978 F 2d 1093, 1102 (9th Cir, 1992).

66 *Newton-John v Scholl-Plough (Australia) Ltd* (1986) 11 FCR 233, 234 ('*Newton-John*'). The advertisement also contained the words: 'For the "Olivia Look" use "Blooming Colours" Neapolitan Frosts eyeshadows … Maybelline makes anything possible.'

use of elements which belong to the reputation of [the celebrity]'[67] and there was 'an appropriation of the appearance of the applicant'.[68] Such an observation resonates with the likeness appropriation in right of publicity cases like *Onassis v Christian Dior-New York Inc*[69] and *Allen v National Video Inc*,[70] but mere appropriation in passing off does not result in liability. It was held that:

> the casual reader would get the impression that indeed the advertiser had made use of Olivia Newton-John's reputation to the extent of gaining attention, but not to the extent of making any suggestion of an association.[71]

In *Pacific Dunlop v Hogan*, a parodic television commercial evoked the character Mick Dundee, the screen persona of actor Paul Hogan.[72] Although the court was split on the issue of misrepresentation, all justices were of the view that the well-known knife scene from the *Crocodile Dundee* movie evoked by the advertisement grabbed audiences' attention, and had exploited the substantial commercially valuable goodwill of the character created and played by Hogan.[73] The actor in the television commercial bore no facial resemblance to Hogan but the distinctive elements of the clothes worn were identifiable as those worn by Mick Dundee in the movie. By holding that an unauthorised evocation of the distinctive clothes and mise-en-scène may constitute an appropriation of goodwill, this aspect of the decision finds its parallel in the right of publicity cases like *White* (where the presence of the *Wheel of Fortune* set evoked Vanna White) and *Motschenbacher* (where a distinctive racing car evoked the driver).

C. *Cultural Studies and the Value of Well-Knownness*

Daniel Boorstin's influential reading of the superficiality of the celebrity in 1961[74] paved the way for future works on the nature of the contemporary celebrity personality. His elegant and oft-quoted phrase—'*A celebrity is a person who is known for his well-knownness*'[75]—is an important starting point for a broad definition of a contemporary celebrity based on a ubiquitous media presence and public recognition. Boorstin's reading of fame that explains the rapid proliferation of celebrities[76]

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67 *Newton-John*, ibid 234 (citing *Radio Corporation Pty Ltd v Disney* (1937) 57 CLR 448, 457).

68 Ibid.

69 472 NYS 2d 254 (NY Sup Ct, 1984) ('*Onassis*').

70 610 F Supp 612 (SD NY, 1985).

71 *Newton-John* (1986) 11 FCR 233, 235. Contra *Eastwood*, 149 Cal App 3d 409, 420 (1983) ('Because of a celebrity's audience appeal, people respond almost automatically to a celebrity's name or picture … To the extent their use attracted the readers' attention, the *Enquirer* gained a commercial advantage').

72 *Crocodile Dundee case* (1989) 23 FCR 553. Similarly, a koala image in a 'Dundee Country' setting was held to be evocative of the Mick Dundee character from the same movie. *Koala Dundee* (1988) 20 FCR 314, 323, 327.

73 Ibid 567–9, 575–7, 583–4. By a 2-to-1 majority, the Federal Court found that misrepresentation was made out and Paul Hogan succeeded in his passing off claim.

74 Daniel J Boorstin, *The Image: A Guide to Pseudo-Events in America* (Vintage Books, 1961).

75 Ibid 57.

76 For example, in his study of celebrities and popular culture, Australian media scholar McKenzie Wark remarks apropos that celebrity is after all 'an index of media productivity' and 'the human face of the media vector'. McKenzie Wark, *Celebrities, Culture and Cyberspace: The Light on the Hill in a Postmodern World* (Pluto Press, 1999) 82. In another important study of how the media selects and

has been adopted by influential contemporary cultural studies scholars who investigate the celebrity phenomenon like Dyer,[77] Marshall,[78] Turner,[79] Chris Rojek[80] and Garry Whannel.[81]

Cultural studies writings are notable in their overwhelming acceptance that the contemporary celebrity is 'characterized by an individual distinction, mass appeal, ubiquity and popular authorship'.[82] In the 21st century, the escalating growth in the range of media outlets and the vastly increased speed of circulation of information can combine to create the phenomenon of a vortex effect.[83] In the midst of a vortextual moment, the public persona of a celebrity can be born almost instantaneously, when the newspapers, television, radio, tabloids, columnists, internet chatrooms and blogs are all drawn into the same topic. Individuals from almost any field, be it film, sport, music, television, business or even cookery, can be elevated to the status of celebrity.[84] It is this widespread public identification—both of the visual image and the embodied values/ideals—that defines a celebrity, and consequently imparts to it a commercial value in the context of consumption.[85]

In addition to their widespread recognition, celebrities 'succeed by skillfully distinguishing themselves from others essentially like them',[86] through acquiring and honing a particular appearance, gesture, voice or other attributes. In writing on why celebrities enhance brand familiarity and favourability, it was observed that celebrities 'have very high public awareness and people are able to visualize them very easily as they are so familiar with them'.[87] It is this evocative aspect of celebrity—through the 'marginal differentiation of their personalities'[88] that leads to easy audience recall—which provides the impetus for the legal recognition and protection of the commercial value of the celebrity identity. The ubiquitous circulation of a particular personality in contemporary society can happen through multifarious channels like print, broadcast, film, internet, merchandising and even through daily social conversations. This proliferation of an individual's name, image or other distinctive characteristics can result in that individual gaining an ever-increasing familiarity among members of the public, thus becoming 'well-known'.[89] The judicial evaluation of whether the plaintiff has established the requisite local

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emphasises aspects of news, Todd Gitlin charges that the media creates celebrities 'where there were none'. Todd Gitlin, *The Whole World is Watching: Mass Media in the Making and Unmaking of the New Left* (University of California Press, 1980) 154.

77 Dyer, above n 34.

78 Marshall, above n 34, 11.

79 Graeme Turner, *Film as Social Practice* (Routledge, 4th ed, 2006) 144; Turner, above n 34, 5.

80 Rojek, above n 40, 18, 76–7. In particular, Rojek comments that '[c]elebrity power depends on immediate public recognition': ibid 76.

81 Whannel, above n 39, 42–3.

82 Tan, above n 2, 938.

83 Whannel, above n 39, 206.

84 See, eg, Irving Rein, Philip Kotler and Martin Stoller, *High Visibility: The Making and Marketing of Professionals into Celebrities* (McGraw-Hill Companies, 1997).

85 See, eg, Coombe (1998), above n 35, 96.

86 Boorstin, above n 74, 65.

87 Hamish Pringle, *Celebrity Sells* (John Wiley & Sons 2004) 68–9.

88 Boorstin, above n 74, 65.

89 See, ibid 57–61; Turner, above n 34, 34–41; Graeme Turner, Frances Bonner and P David Marshall, *Fame Games: The Production of Celebrity in Australia* (Cambridge University Press, 2000) 9.

goodwill or reputation takes into account precisely these channels of communication, considering a wide range of media exposure from print publicity to advertising circulation, as well as television audience figures indicated by AC Nielsen ratings.[90]

In its threshold evaluation of whether the plaintiff enjoys the requisite local goodwill based on a geographical delimitation, passing off can quickly dispose of claims where the plaintiff is not a well-known individual who has a commercially valuable reputation to exploit. Thus for right of publicity cases like *DeClemente v Columbia Pictures Industries Inc*[91] and *Pesina v Midway Manufacturing Co*[92] where the defendants were granted summary judgment on the grounds that the plaintiffs were not well-known personalities, a similar result would also likely be reached in passing off on the basis of the absence of goodwill. By focusing on goodwill, the passing off action sidesteps the heated debate around the recognition of a *proprietary* right of publicity in evocative aspects of identity.[93] Nonetheless, courts still have to confront the question whether the plaintiff has been identified by the relevant group of consumers through the defendant's use. However, this inquiry may sometimes be deferred to the misrepresentation stage, where the court would determine if, based on an overall impression, consumers were misled as to the celebrity plaintiff's approval of the product. For example, from the facts in *White*,[94] it is likely that Vanna White would satisfy the requirement of goodwill in a passing off claim, but it is open whether consumers would have the impression that the robot in a blond wig conveys her endorsement of or personal association with Samsung; the court does not have to confront the question of whether White has a property right in a robot, or even the image of a man or monkey, in the particular get-up.[95] Generally, goodwill should not be a significant hurdle for international celebrities whose names, likeness and other distinctive characteristics have been widely circulated in both the traditional and new media. Unlike some of the cases decided in the last century,[96] well-knownness in the 21st century often transcends national geographical boundaries.

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90 See, eg, *Duff Beer case* (1996) 34 IPR 225, 230–2; *Irvine* [2002] 1 WLR 2355, 2370–3.

91 860 F Supp 30, 53 (ED NY, 1994) ('The plaintiff's public personality as the Karate Kid simply has not reached the magnitude of public notoriety necessary to be actionable … and is known as the Karate Kid only to a small group of people').

92 948 F Supp 40, 42–3 (ND Ill, 1996) (the plaintiff 'is not a widely known martial artist and the public does not even recognize him as a model for Johnny Cage [the video game character]').

93 See, eg, *White I*, 971 F 2d 1395 (9th Cir, 1992); *Wendt*, 125 F 3d 806, 814 (9th Cir, 1997). Arguably the controversy also surrounds the property right in a role or character. See, eg, *McFarland v Miller*, 14 F 3d 912 (3rd Cir, 1994); *Lugosi*, 25 Cal 3d 813 (1979); *Nurmi v Peterson,* 1989 WL 407484 (CD Cal, 1989); Peter K Yu, 'Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters' (1998) 20 *Cardozo Law Review* 355.

94 See, eg, *White I*, 971 F 2d 1395 (9th Cir, 1992).

95 *White v Samsung Electronics America Inc*, 989 F 2d 1512, 1515 (Kozsinki J) (9th Cir, 1993) ('*White II*') ('anybody standing beside it—a brunette woman, a man wearing women's clothes, a monkey in a wig and gown—would evoke White's image, precisely the way the robot did').

96 See, eg, *Lyngstad v Anabas Products Ltd* [1977] FSR 62 ('*Lyngstad*') (finding that the pop group ABBA lacked the requisite local goodwill).

V. Misleading Conduct and Meaning Transfer in Consumption

A. *Proving Misrepresentation*

Despite a general recognition that one may have a proprietary interest in goodwill that may be vindicated through a passing off action—language that is evocative of the concept of misappropriation in a right of publicity claim—courts are nevertheless adamant that 'there is still a need to demonstrate a *misrepresentation* because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant's reputation'.[97] Australian courts have also established that the finding of deceptive conduct must be assessed taking into consideration all the circumstances and the overall effect or impression on the consumers or potential consumers; the courts rely on 'a combination of visual impression and judicial estimation of the effect likely to be produced' by the defendant's conduct on consumers.[98]

However, the case law does not indicate clearly what type of misrepresentation must be alleged. Some cases, particularly in the UK, appear to have adopted a distinction between unauthorised uses of the celebrity persona in advertising (more likely to be misleading as to sponsorship, endorsement or association) and merchandising (less likely to be misleading);[99] this presumption is aptly captured in *Irvine*:

> When people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care one way or the other who made, sold or licensed it. When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source.[100]

At least in the UK, celebrity claimants generally have a greater burden to discharge in proving misrepresentation in respect of merchandising compared to advertisements;[101] Australian courts may be less influenced by this distinction.[102] But this

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97 See, eg, *Irvine* [2002] 1 WLR 2355, 2368 (emphasis added).

98 *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641, 659. Evidence of actual deception is not conclusive; ultimately it was 'a question of fact to be decided by considering what [was] said and done against the background of all surrounding circumstances'. *Taco Co of Australia Inc v Taco Bell Pty Ltd* (1982) 42 ALR 177, 202 ('*Taco Bell*'); *10th Cantanae* (1987) 79 ALR 299, 318. See also *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 55 IPR 354; *Anheuser-Busch Inc v Budjovecky Budvar Narodni Podnik* (2002) 56 IPR 182; *Mark Foys Pty Ltd v TVSN (Pacific) Ltd* (2000) 104 FCR 61.

99 See, eg, *Irvine* [2002] 1 WLR 2355, 2359 (merchandising 'involves exploiting images, themes or articles which have become famous … It is not a necessary feature of merchandising that members of the public will think the products are in any sense endorsed'); *Elvis Presley Trade Marks* [1999] RPC 567, 585; *Elvis Presley Trade Marks* [1997] RPC 543, 552.

100 *Elvis Presley Trade Marks* [1997] RPC 543, 554.

101 See, eg, *Arsenal FC plc v Reed* [2001] RPC 922 (no passing off in sale of unofficial Arsenal merchandise); *Lyngstad* [1977] FSR 62 (adopting a more restrictive view of consumer confusion in respect of ABBA merchandise). Contra *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] 1 FSR 145 (*Teenage Mutant Ninja Turtles* merchandise).

102 In a number of Australian cases involving character merchandising, the plaintiffs succeeded in proving misrepresentation. However, most of these involve fictitious characters, rather than human personalities. See, eg, *Duff Beer case* (1996) 34 IPR 225, 230–2 (Duff beer product based on *The Simpsons* cartoon series); *Fido Dido Inc v Venture Stores (Retailers) Pty Ltd* (1988) 16 IPR 365 (Fido Dido

apparent advertisement/merchandising dichotomy has been criticised for being 'at best … just another tool used by the judge to justify an order to a defendant to stop what the judge perceives to be unfair trading'.[103]

It has been observed that the Australian courts are generally sympathetic toward celebrity plaintiffs whose goodwill has been misappropriated in the course of trade. Burchett J of the Federal Court thought that the judicial focus should not be on determining the nature of 'precise representations', but rather on 'suggestions by [the trader] that may inveigle the emotions into false responses';[104] in particular, the 'subliminal effect of an advertisement … may be deceptive even without making any [explicit] untrue statement'.[105] This impressionistic approach, especially with the findings of misrepresentation in the parodic advertisement in the *Crocodile Dundee* case and in the get-up of the koala image in *Koala Dundee*, has led commentators to lament that 'mere *identification* was enough to suggest an association and therefore a misrepresentation'.[106] The unpredictability of this approach is also demonstrated in Olympic swimmer Kieren Perkins' claim against Telecom Australia for using a photograph of him wearing a swimming cap with the defendant's logo in an advertisement which allegedly highlighted Perkins' achievements to promote the sport of swimming. The Full Federal Court there reversed the trial judge's decision, finding that the advertisement misrepresented that Perkins 'was sponsored by it [and] had consented to its use of his name, image and reputation'.[107] More importantly, the court held that the relevant target audience in passing off included:

> the astute and the gullible, the intelligent and the not so intelligent, the well educated as well as the poorly educated, men and women of various ages pursuing a variety of vocations, and [the plaintiff] could rely on any meaning which was reasonably open to a significant number of the newspaper readership.[108]

Thus, even in the absence of an explicit misrepresentation, it appears that courts are increasingly open to accepting that the overall or 'gestalt'[109] impression of the defendant's use can constitute misleading or deceptive conduct. As Burchett

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character merchandising); *Koala Dundee* (1988) 20 FCR 314 (merchandise based on *Crocodile Dundee* character); *Children's Television Workshop Inc v Woolworths (NSW) Ltd* [1981] 1 NSWLR 273 (*Muppets* merchandise). Cf *Hutchence* (1986) 6 IPR 473 (merchandising with respect to pop band INXS).

103 Ng-Loy Wee Loon, 'Trademark Protection for Personalities and Characters' in FW Grosheide and JJ Brinkhof (eds), *Intellectual Property Law: Articles on Crossing Borders Between Traditional and Actual* (Intersentia, 2005) 331, 338.

104 *Crocodile Dundee case* (1989) 23 FCR 553, 584.

105 *Newton-John* (1985) 11 FCR 233, 235.

106 Scott Ralston, 'Australian Celebrity Endorsements: The Need for an Australian Right of Publicity' (2001) 20(4) *Communications Law Bulletin* 9, 10 (emphasis in original). See also Mark Davison and Maree Kennedy, 'Proof of Deception and Character Merchandising Cases' (1990) 16 *Monash University Law Review* 111, 115 (this is a 'spectacular departure from the passing off requirement of factual misrepresentation'). It should also be noted that passing off is not made out 'merely because members of the public would be caused to wonder whether it might not be the case that two products come from the same source': *Puxu* (1982) 149 CLR 191, 209.

107 *Talmax* [1997] 2 Qd R 444, 451.

108 Ibid 446 (citing *Taco Bell* (1982) 42 ALR 177, 202).

109 *Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd* (2002) 55 IPR 354, 366.

J commented in the *Crocodile Dundee* case, '[i]t would be unfortunate if the law merely prevented a trader using the primitive club of direct misrepresentation, while leaving him free to employ the more sophisticated rapier of suggestion, which may deceive more completely'.[110] However, the use of prominent disclaimers can alleviate any likelihood of confusion. Even though the consumers' attention would have been captured by the defendant's use of the celebrity persona—for example, an Olivia Newton-John lookalike in a print advertisement—the passing off claim would fail if consumers were not misled or deceived as to the celebrity's connection with the defendant.[111] Due to the number of possible variations where disclaimers are involved, courts have been reluctant to establish any general formula for determining the effect of disclaimers in favour of approaching each case on its own facts.[112]

B. *Free Speech Defence*

In the UK, Australia and Singapore, there is no independent free speech defence in a passing off action. Although there may be free speech guarantees in these jurisdictions—for example, under art 10 of the *European Convention on Human Rights* for the UK[113] and the implied constitutional freedom of political communication for Australia[114]—there is no equivalent of the First Amendment defence employed by US courts when evaluating the *Lanham Act* § 43(a) claims.[115] Generally, Australian courts appear to be focused on a vertical application of this constitutional freedom as a check on the exercise of state powers to restrict communication that

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110 (1989) 23 FCR 553, 586.

111 *Newton-John*, ibid 234–5 (even the 'very casual reader … will not be deceived'). However, under right of publicity doctrine, the defendant is likely to be liable. According to a hypothetical scenario by the Tenth Circuit, '[i]f Mitchell Fruit posted a billboard featuring a picture of Madonna and the phrase, "Madonna may have ten platinum albums, but she's never had a Mitchell banana," Madonna would not have a claim for false endorsement. She would, however, have a publicity rights claim, because Mitchell Fruit misappropriated her name and likeness for commercial purposes': *Cardtoons LC v Major League Baseball Players Association*, 95 F 3d 959, 968 (10th Cir, 1996).

112 See, eg, *Duff Beer case* (1996) 34 IPR 247, 251.

113 Article 10 tends to be balanced with art 8 which guarantees individual privacy. Courts appear to rank types of speech on a hierarchy based on their contribution to democratic debate when engaging in a balancing exercise. See, eg, *Campbell v MGN Ltd* [2004] 2 AC 457; *Von Hannover v Germany* (2005) 40 EHRR 1. Although art 10 has a horizontal application, it has not been invoked in passing off cases. Laddie J referred to the *ECHR* and the *Human Rights Act* 1998 (UK) 'by way of postscript' but did not mention art 10: *Irvine* [2002] 1 WLR 2355, 2379.

114 See, eg, *Lange v Australian Broadcasting Corporation* (1997) 189 CLR 520 ('*Lange*'); *Levy v Victoria* (1997) 189 CLR 579 ('*Levy*'); *Coleman v Power* (2004) 220 CLR 1 ('*Coleman*').

115 Several United States Circuit courts use the two-pronged test from *Rogers* under which the title of an expressive work will be deemed protected artistic speech unless it has 'no artistic relevance' to the underlying work, or if there was artistic relevance, the title 'explicitly misleads as to the source or content of the work': *Rogers*, 875 F 2d 994, 999 (2nd Cir, 1989). See also *Parks*, 329 F 3d 437, 447 (6th Cir, 2003); *Westchester Media v PRL USA Holdings Inc*, 214 F 3d 658, 665 (5th Cir, 2000); Stephanie Dotson Zimdahl, 'A Celebrity Balancing Act: An Analysis of Trademark Protection under the Lanham Act and the First Amendment Artistic Expression Defense' (2005) 99 *Northwestern University Law Review* 1817, 1843–54.

contributes to democratic debate and discussion of governmental matters,[116] and are not prepared to expand this freedom to the extent of either the First Amendment[117] or art 10 of the ECHR.[118] Although certain expressive conduct like social activism against duck shooting[119] and use of insulting words in a public place alleging police corruption[120] may qualify as protectable speech, the judicial focus in these cases is on the vertical effect of state action. From the jurisprudence, it is unlikely that the implied freedom of political communication would function as an affirmative defence applicable to passing off or s 52 of the *Trade Practices Act 1974* (Cth). In the context of the implied freedom, the unanimous High Court in *Lange* held that 'the common law must conform with the Constitution';[121] the court appears unwilling to create any constitutional defences and prefers to interpret the common law in a manner that is in harmony with the *Commonwealth Constitution*.[122] Notwithstanding the fact that the implied freedom offers a much weaker protection to speech compared to art 10 of the ECHR, it is arguable that, similar to the English position, political recodings of the celebrity sign that contribute to the dissemination of information, opinions and arguments concerning government and political matters that affect the electorate may be taken into account when determining misleading conduct.

Although this article will not be engaging in a detailed discussion of how robust First Amendment free speech principles can influence a court's determination of a *Lanham Act* § 43(a) claim, it suffices to note that the pro-speech culture in the US can lead to diminished protection for celebrity plaintiffs.[123] Even where a defendant has capitalised on a celebrity's fame and popularity for commercial benefit, a finding of artistic relevance in a *Lanham Act* claim would give the defendant a free ride on the celebrity's star value.[124] The artistic relevance threshold is an easy one to meet, and courts require *explicit* misleading conduct on the part of the defendants in order for liability to be imposed. The impressionistic approach adopted by the Australian courts in both the *Koala Dundee* and *Crocodile Dundee* cases would not be accepted by the US courts. Furthermore, the artistic—and parodic—elements in the koala image and the *Crocodile Dundee* advertisement would be relevant to the content of the defendants' works and were not explicitly misleading as to the content under the *Rogers* test.

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116 Tan and McCarthy, above n 7, § 6:159.

117 The High Court has considered the generous protection accorded to speech under the United States Constitution and distinguished First Amendment rights-based jurisprudence as being inapplicable to Australia. See, eg, *Lange* (1997) 189 CLR 520, 563–4, 567; *Levy* (1997) 189 CLR 579, 622, 637–8, 644. Contra William G Buss, 'Alexander Meiklejohn, American Constitutional Law, and Australia's Implied Freedom of Political Communication' (2006) 34 *Federal Law Review* 421, 439–42.

118 The High Court's strong opposition to personal rights might also be understood to be a rejection of the horizontal rights concept of art 10 of the ECHR. See also Buss, ibid 441.

119 *Levy* (1997) 189 CLR 579.

120 *Coleman* (2004) 220 CLR 1.

121 *Lange* (1997) 189 CLR 520, 566. See also discussions of this conformity in Buss, above n 117, 429–39.

122 *Lange*, ibid 564–6. See also an examination of the use of common law methodology in cases dealing with freedom of political communication post-*Lange*, see Buss, ibid 435, 450–7.

123 See, eg, *Rogers*, 875 F 2d 994 (2nd Cir, 1989); *ETW Corp*, 332 F 3d 915 (6th Cir, 2003). The courts also apply a nominative fair use test under trademark analysis, which further erodes protection of the celebrity persona against unauthorised commercial exploitation. See, eg, *New Kids On The Block v News America Publishing Inc*, 971 F 2d 302 (9th Cir, 1992); *Cairns v Franklin Mint Co*, 292 F 3d 1139 (9th Cir, 2002); *Clark v America Online Inc*, 2000 WL 33535712 (CD Cal, 2000).

124 Zimdahl, above n 115, 1854.

In a case where an American artist sold lithographs bearing an almost literal depiction of Tiger Woods in a pose reminiscent of his stance in a Nike poster, the US Sixth Circuit by a majority found that 'the presence of Woods's image in Rush's painting *The Masters of Augusta* does have artistic relevance to the underlying work and that it does not explicitly mislead as to the source of the work'.[125] Again, despite survey evidence that 'some members of the public would draw the incorrect inference that Woods had some connection with Rush's print', the 'risk of misunderstanding … [was] outweighed by the interest in artistic expression'.[126] At least one commentator has argued that Tiger Woods would have fared better under a passing off action in Australia—that 'the evidence of consumer confusion would not have been so quickly eclipsed by First Amendment concerns'.[127] Similarly in *Kirby v Sega of America*, where pop singer Keirin Kirby alleged that Sega had developed a video game character that appropriated her identity,[128] the California Court of Appeal applied the transformative elements test to find that the defendant has 'added creative elements to create a new expression' protectable by the First Amendment.[129] This was sufficient to bar *both* the plaintiff's right of publicity and *Lanham Act* claims.[130] However, in cases where the celebrity has been portrayed in a straightforward manner in an advertisement especially in the co-present mode[131]—whether through the use of a lookalike or through an evocative device[132]—the outcome in the US courts is likely to mirror the Australian passing off experience.

C. *Cultural Studies and the Transfer of Affective Meaning*

Writings in cultural studies have observed that fame is in part defined and conferred upon a celebrity individual by the consuming public, and in part constructed and propagated by the cultural producers. Dyer, in his early influential study of the Hollywood star phenomenon, has highlighted the role of the audience in the creation of stars, and their subsequent consumption as commodities.[133] As Marshall avers, '[t]he celebrity's power is derived from the collective configuration of its meaning … the audience is central in sustaining the power of any celebrity sign'.[134] One may

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125 *ETW Corp*, 332 F 3d 915, 937 (6th Cir, 2003).

126 Ibid.

127 David S Caudill, 'Once More into the Breach: Contrasting US and Australian "Rights of Publicity"' (2004) 9 *Media & Arts Law Review* 263, 276.

128 In addition to some visual similarities, the video game character's name 'Ulala' is a phonetic variant of 'ooh la la', a phrase often used by Kirby and associated with Kirby: 144 Cal App 4th 47, 56 (2006) ('*Kirby*').

129 Ibid 59.

130 Ibid 61.

131 Grant McCracken, 'Who is the Celebrity Endorser? Cultural Foundations of the Endorsement Process' (1989) 16 *Journal of Consumer Research* 310. See section below for a further discussion.

132 See, eg, *Allen*, 610 F Supp 612 (SD NY, 1985); *Allen v Men's World Outlet Inc*, 679 F Supp 360 (SD NY, 1988); *Lombardo v Doyle, Dane & Bernbach Inc*, 396 NYS 2d 661 (1977).

133 Dyer, above n 34, 18–9, 160–2.

134 Marshall, above n 34, 65. See also Francesco Alberoni, 'The Powerless Elite: Theory and Sociological Research on the Phenomenon of the Stars' in Denis McQuail (ed), *Sociology of Mass Communications* (Denis McQuail trans, Penguin, 1972) 75, 93.

therefore argue that the touchstone for liability for the unauthorised commercial exploitation of a celebrity's identity ought to take into account the *effect* of such a use on the audience-consumer. Like Barthesian myths, celebrity images in advertising 'contain subject positions and models for identification that are heavily coded ideologically'.[135] In *Celebrity*, Chris Rojek postulates:

> [The celebrity] embodies desire in an animate object, which allows for deeper levels of attachment and identification than with inanimate commodities. Celebrities can be reinvented to renew desire, and because of this they are extremely efficient resources in the mobilization of global desire. In a word, they *humanize* desire.[136]

Using a celebrity in advertising, product merchandising and other commercial contexts is likely to have a positive effect on consumers' brand perceptions and purchasing decisions; this is commonly referred to as the 'positive halo effect'.[137] In buying a product associated with a celebrity, the consumer can buy into some of the glamour, self-indulgence and decadence of the charmed life of a movie star or into the athleticism and success of a sporting icon. Such symbolic celebrity images attempt to create an association between the products offered and the ideologically desirable traits in order to produce the impression that if one wants to be a certain type of person, then one should buy the particular product.[138]

While cultural scholars like Dyer have acknowledged the commoditised status of the celebrity, it was Grant McCracken who in 1989 connected empirical socio-psychological and economic research with cultural studies writings on the semiotic significance of celebrities to consumption.[139] McCracken's conclusion that a celebrity sign is 'persuasive' to consumers because he or she is 'made up of certain meanings that the consumer finds compelling and useful' provided a good foundation for further investigative work on the impact of celebrities on contemporary consumption.[140]

McCracken lists four types of celebrity endorsements—(i) explicit mode ('I endorse this product'); (ii) implicit mode ('I use this product'); (iii) imperative mode ('You should use this product') and (iv) copresent mode (in which the celebrity appears with the product)—pointing out that a celebrity individual is 'persuasive' to consumers because he or she is 'made up of certain meanings that the consumer finds compelling and useful' with respect to them making a consumption decision.[141] He appears to draw significantly from cultural studies when he posits a 'meaning transfer model' comprising three stages: that the meaning of class, status, gender, age, personality and lifestyle types as embodied by the semiotic sign of the celebrity 'begins as something resident in the culturally constituted world' (Stage 1) and 'then moves

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135 Kellner, above n 32, 248.
136 Rojek, above n 40, 189.
137 See, eg, Pringle, above n 87, 72.
138 Kellner, above n 32, 248.
139 McCracken, above n 131.
140 See, eg, Roobina Ohanian, 'The Impact of Celebrity Spokespersons' Perceived Image on Consumers' Intention to Purchase' (1991) 31(1) *Journal of Advertising Research* 46; B Zafer Erdogan, 'Celebrity Endorsement: A Literature Review' (1999) 15 *Journal of Marketing Management* 291.
141 Ibid 312.

to consumer goods' when used in conjunction with a product (Stage 2).[142] The 'cultural circuit [of the] movement of meaning is complete' when consumers perceive these goods not as commodities of utility but also as bundles of meanings with which to construct their social identity' (Stage 3).[143] In summary,

> the endorsement process depends upon the symbolic properties of the celebrity endorser. Using a 'meaning transfer' perspective, these properties are shown to reside in the celebrity and move from celebrity to consumer good and from good to consumer.[144]

Thus the initial affective relationship between the celebrity and the audience translates to an economic one between the celebrity/product and the audience/consumer;[145] in fact, it is at Stage 2 where the affective meanings of the celebrity's persona are 'transferred' into the product, thereby realising the potential economic value through its associative use.

It is worth noting that each celebrity has his or her own unique set of characteristics and connotational meanings; and different celebrities have different associative values.[146] In his study of advertising and popular culture, Jib Fowles also observed that in exemplifying relevant social norms, celebrities enjoy 'a sort of equity that advertisers can only eye covetously'.[147] Generally, celebrity endorsements result

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142 Ibid 313.

143 Ibid 314. In consumption generally, as Jean Baudrillard asserts, 'economic exchange value (money) is converted into sign exchange value (prestige, etc.)'. Jean Baudrillard, *For a Critique of the Political Economy of the Sign* (Charles Levin trans, Telos Press, 1981) 112. See also Graeme Turner, *British Cultural Studies: An Introduction* (Routledge, 3rd ed, 2003) 219–20; David Morley and Kevin Robins (eds), *British Cultural Studies: Geography, Nationality and Identity* (Oxford University Press, 2001) 10.

144 McCracken, above n 131, 310. McCracken's defining works on the cultural meaning of consumption combines particular aspects of cultural studies with economic analysis, and have been oft-cited in journals on advertising, marketing and consumer research. See also Grant McCracken, *Culture and Consumption II: Markets, Meaning and Brand Management* (Indiana University Press, 2005); Grant McCracken, *Culture and Consumption: New Approaches to the Symbolic Character of Consumer Goods and Activities* (Indiana University Press, 1990).

145 A celebrity can be interpreted as being a part of a reference group of persons that serves as a point of reference for an individual by communicating values, attitudes and providing a specific guide for behaviour. In effect, consumption becomes 'a medium for creating and communicating social identity and expressing consumer values': Marye C Tharp, *Marketing and Consumer Identity in Multicultural America* (Sage, 2001) 33 (citing Grant McCracken, 'Culture and Consumption: A Theoretical Account of the Structure and Movement of the Cultural Meaning of Consumer Goods' (1986) 13 *Journal of Consumer Research* 71). See also Morris B Holbrook and Elizabeth C Hirschman, *The Semiotics of Consumption: Interpreting Symbolic Consumer Behavior in Popular Culture and Works of Art* (Mouton de Gruyter, 1993).

146 Companies may use a number of measurement tools like Q Scores or the Davie-Brown Index to determine the relative effectiveness of a particular celebrity for commercial endorsement purposes. Q Scores have been accepted to be the industry standard for measuring familiarity, likeability and appeal of celebrities. See, eg, Geraldine R Henderson and Jerome D Williams, 'Michael Jordan Who? The Impact of Other-Race Contact in Celebrity Endorser Recognition' in Jerome D Williams, Wei-Na Lee and Curtis P Haugtvedt (eds), *Diversity in Advertising: Broadening the Scope of Research Directions* (Psychology Press, 2004) 279, 280–3; Q Scores <http://www.qscores.com/pages/Template1/site11/28/default.aspx> at 30 May 2008; Duff McDonald, *The Celebrity Trust Index* (2006) New York <http://nymag.com/news/intelligencer/16143/> at 30 May 2008.

147 Jib Fowles, *Advertising and Popular Culture* (Sage, 1996) 119. He also affirms McCracken's thesis of meaning transfer in consumption. Ibid 127–31.

in better product sales only when consumers feel that whatever cultural meanings attached to the celebrity can move along unimpeded paths from the celebrity to the product. Advertisers often 'deploy a [celebrity] signifier, already conventionally related to a mental concept they wish to attach to their product, as a means of providing their product with that meaning.'[148] In the copresent mode popular with many advertisers today,[149] a direct endorsement by the celebrity as spokesperson is not necessary for the meaning transfer to take place, and this is evident in the contemporary advertising practices of successful brands like TAG Heuer, Louis Vuitton, Nike and Gillette that utilise the copresent mode.[150] Often the juxtaposition or mention of a celebrity in connection with a product is sufficient for the audience to 'decode' the semiotic meaning and make the affective link between the celebrity and the product.

According to a study on consumption values by Sheth et al, the use of the celebrity personality in advertising would be seen to increase the *emotional* and *social* consumption values of brands.[151] The associative value of the celebrity identity is realised when the enhanced emotional and social consumption values of brands translate to improved sales and customer loyalty. These observations suggest that the defendant has gained a benefit when the products, to which have been transferred the positive semiotic meanings associated with the celebrity, are seen to be more attractive to consumers.

If one accepts that the celebrity identity has an associative value only because of the semiotic meanings conferred on it by the audience, then public perception becomes the natural reference point for the determination of liability. An analysis of the research on source credibility and source attractiveness models[152] has revealed that 'the movement of meanings from [the celebrity to] consumer goods [and ultimately] to the individual consumer is accomplished through the efforts of the consumer'.[153] Advertisers choose the particular configuration of culturally constituted meanings they wish to convey, which may be examined in passing off under

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148 Turner, above n 143, 15 (discussing semiotics in practice).

149 This is where the advertisement simply depicts the celebrity next to the product with no explicit endorsement text. See McCracken, above n 131, 310; Tan, above n 2, 963. See also Uche Okonkwo, *Luxury Fashion Branding: Trends, Tactics, Techniques* (Palgrave Macmillan, 2007) 156–64; Henderson and Williams, above n 146; Brian D Till and Michael Busler, 'Matching Products with Endorsers: Attractiveness versus Expertise' (1998) 15 *Journal of Consumer Marketing* 576.

150 The celebrities who appear in these advertisements are often well-recognised by consumers all over the world, spanning the Americas, Europe and Asia. They include Brad Pitt (for TAG Heuer), Madonna (Louis Vuitton), Tiger Woods (Nike) and David Beckham (Gillette).

151 Jagdish N Sheth, Bruce I Newman and Barbara L Gross, 'Why We Buy What We Buy: A Theory of Consumption Values' (1991) 22 *Journal of Business Research* 159, 160. Successful transnational brands have thrived on building a cachet of high emotional value with their customers through 'emotional branding' campaigns that engender enduring loyalty. The emotional value is often the overriding consideration in the purchasing decision. See, eg, Marc Gobé, *Emotional Branding: The New Paradigm for Connecting Brands to People* (Allworth Press, 2001); Scott Robinette and Claire Brand, *Emotional Marketing: The Hallmark Way of Winning Customers for Life* (McGraw-Hill, 2001).

152 These models investigate the conditions under which endorsement messages are perceived by consumers and postulate that the effectiveness of a message depends on the trustworthiness and familiarity/likeability of the celebrity. For a discussion of various findings, see McCracken, above n 131, 310–2.

153 McCracken, ibid 313.

the rubric of the intent of the trader.[154] However, regardless of their intent,

> the final act of meaning transfer is performed by the consumer, who must glimpse in a moment of recognition … the cultural meanings contained in the people, objects, and contexts of the advertisement are also contained in the product.[155]

The more recent Australian cases have held that the plaintiff could 'rely on any meaning which was reasonably open to a significant number of the [target audience]'.[156] The tort of passing off seems to accommodate this cultural insight better than the right of publicity:

> the test of whether a celebrity's image may be used in commerce depends on the court's appreciation of the attitude the average consumer may take to it, rather than leaving it up to the celebrity to decide, with limitations posed by the public interest (a consumer-based test instead of an individual rights-based test).[157]

It would appear that the English and Australian courts, in preferring the passing off action over the right of publicity in protecting the commercial value of the celebrity identity, implicitly recognise the audience's role as 'a potentially crucial pivot point for the understanding of a whole range of social and cultural processes that bear on the central questions of public communication'.[158]

In effect, the passing off action bears a similarity to a right of publicity claim in that it proscribes conduct that 'siphon[s] some of the publicity value or good will in the celebrity's persona into the product'[159] but liability is imposed only when the consumer is led to believe that such a transfer has occurred. If there is *no likelihood* that a typical consumer would be led to believe that a celebrity endorses or is connected to the defendant's product, then *no* associative value has flowed to the product, and accordingly there should be no liability. In the copresent mode frequently employed in print advertisements, there may be no explicit indication of endorsement. Hence in this form of 'enhancement advertising', the endorsement can be 'by inference only, not in express words but by the association of a celebrity with a product, merely by them appearing together'.[160] In the context of a *Lanham Act* claim, summary judgment was awarded to Woody Allen on the basis that the defendant's use of a lookalike in an advertisement created a likelihood of confusion over whether Allen 'endorsed or was otherwise involved in [the defendant's] services'.[161] The court remarked that '[w]hen a public figure of Woody Allen's stature appears in an advertisement, his

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154 See, eg, *Irvine* [2002] 1 WLR 2355, 2376–7; *Crocodile Dundee case* (1989) 23 FCR 553, 575–6, 586. For *Lanham Act* § 43(a) cases, it is one of the factors to be considered in determining the likelihood of confusion. See, eg, *Downing*, 265 F 3d 994, 1007–8 (9th Cir, 2001).

155 McCracken, above n 131, 314.

156 See, eg, *Talmax* [1997] 2 Qd R 444, 446.

157 William van Caenegem, 'Different Approaches to the Protection of Celebrities Against Unauthorised Use of their Image in Advertising in Australia, the United States and the Federal Republic of Germany' (1990) 12 *European Intellectual Property Review* 452, 458 (emphasis added). See also *10th Cantanae* (1987) 79 ALR 299, 301.

158 Roger Silverstone, 'Television and Everyday Life: Towards an Anthropology of the Television Audience' in Marjorie Ferguson (ed), *Public Communication—The New Imperatives: Future Directions for Media Research* (Sage, 1990) 132, 173.

159 *Lugosi v Universal Pictures*, 25 Cal 3d 813, 814 (1979).

160 Carty, above n 20, 217.

161 *Allen*, 610 F Supp 612, 627 (SD NY, 1985).

mere presence is inescapably to be interpreted as an endorsement'.[162] The copresent mode is ubiquitously used by transnational brands that rely on the well-knownness of celebrities with global goodwill to lend their star aura to their brands and products by simply being present in the advertisement.[163] No explicit endorsement message is required; the mere presence of the celebrity suggests an approval or association sufficient to impel relevant segments of consumers to buy the product.[164] This understanding of consumption behaviour supports the impressionistic approach to determining misrepresentation when the image of a celebrity is used in the copresent mode; and it appears that this type of 'connection misrepresentation … is now accepted to be part of the tort'.[165]

As observed in the *Crocodile Dundee* case, it is the association with the celebrity that 'proceeds more subtly to foster favourable inclination towards it' such that the products are better in the consumer's eyes.[166] Similarly, in *Irvine*, the defendant was liable not simply because the advertisement was designed 'with the intention of grabbing the attention of the audience', but because the impression of Eddie Irvine's support of Talk Radio 'would make it more attractive to potential listeners with the result that more would listen to its programmes and that would make Talk Radio an attractive medium in which to place advertisements'.[167] Thus liability in passing off is only imposed at the point in the consumption process where the celebrity's persona has been 'transferred' into the product, thereby realising the potential economic value through its associative use.[168] This point is signified by the consumers being misled as to the celebrity's association with or endorsement of the defendant's products. Even if courts adopt the broader impressionistic approach to determining misrepresentation, this approach nevertheless still adheres to discovering whether the transfer of semiotic values from the celebrity persona to the defendant's product has occurred, based on the perception and behaviour of the relevant segment of consumers. If this 'transfer' has not occurred, because the consumers were not misled as to the plaintiff's association with the defendant, then it is arguable that the plaintiff has lost nothing of commercial value. However, courts have to be careful not to equate identification with misrepresentation, otherwise the assumption that the copresent mode in advertising represents approval or association becomes an irrefutable fact.

VI. Conclusions

Unlike in right of publicity doctrine, which may generally impose liability for misappropriation—based on identification of a celebrity plaintiff from the

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162 Ibid 627 fn 8.

163 See above n 150.

164 In his analysis, Cashmore noted that advertising has 'moved away from the utilitarian approach in which product information was at the forefront. Many global brands avoid even mentioning products in an attempt to create synonymy between their brand and the celebrity': Cashmore, above n 43, 172.

165 Carty, above n 20, 239. See also Andrew Terry, 'Image Filching and Passing Off in Australia: Misrepresentation or Misappropriation' (1990) 12 *European Intellectual Property Review* 219.

166 *Crocodile Dundee case* (1989) 23 FCR 553, 583–4.

167 *Irvine* [2002] 1 WLR 2355, 2377–8.

168 Cf *Lugosi*, 25 Cal 3d 813, 834–5 (1979).

defendant's unauthorised commercial use—the passing off action requires the plaintiff to prove an additional element of misrepresentation of the celebrity's association with the defendant. Nonetheless, the passing off action may, in certain circumstances, extend even greater protection to celebrities than in a US right of publicity claim,[169] where the First Amendment defence increasingly is used to curb the expanding proprietary reach of the celebrity identity.[170] Its focus on the impression that is created in the minds of consumers can overcome some of the doctrinal objections to characterising indicia of identity as personal property, and 'has the potential to acknowledge the existence of celebrity images in popular culture as a shared resource or heritage'.[171] Furthermore, as legal commentator Marshall Leaffer argues, there is potential to agree on 'an international norm for the protection of [a] personality right based on false endorsement'.[172] Moreover, passing off allows courts to properly evaluate whether the affective meaning has been transferred as a result of the perception of consumers, rather than be mired in First Amendment rhetoric commonly witnessed in the US cases. In *ETW Corp* and *Kirby*, the US courts were more concerned with whether the defendants' free speech interests were protected rather than whether consumers were misled as to the celebrity's association with the defendants. The courts made virtually no attempt to examine whether there was a likelihood of confusion under the *Lanham Act* claims once it was found that the defendants' expressions were protectable speech. It appears that Tiger Woods and Keirin Kirby are more likely to have a better chance of success in a passing off claim in Australia on the basis of impressionistic association, compared to the pro-speech outcomes as decided by the Sixth Circuit and the California Court of Appeal.

As illustrated in the celebrity endorsement studies conducted by McCracken, it is this impression of association that makes the defendant's products more attractive to a relevant group of consumers to whom a particular celebrity persona connotes positive affective meanings. If consumers perceive this association from the defendant's unauthorised use of the celebrity persona, then the impression engendered is a false one, and accordingly the defendant's conduct is misleading. As Carty so trenchantly stated, '[t]he grab value of the celebrity magnet is not per se protected by the tort [of passing off]'.[173] The focus on misrepresentation, unlike misappropriation in right of publicity cases, directs courts to the moment at which harm or damage to the celebrity occurs, that is, the celebrity should have been paid a fee for the transfer of the semiotic meanings of his or her persona to the defendant's product as a result of the product becoming more valuable in the eyes of the consumers. Rather than

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169 See Caudill, above n 127. Contra John McMullan, 'Personality Rights in Australia' (1997) 8 *Australian Intellectual Property Journal* 86; Ralston, above n 106.

170 See, eg, the use of the transformative elements test or the actual malice standard to defeat right of publicity claims in a number of cases which have been criticised for their unsatisfactory analyses of the balance between property and speech protections. See, eg, *Winter v DC Comics*, 30 Cal 4th 881 (2003); *Kirby*, 144 Cal App 4th 47 (2006); *ETW Corp*, 332 F 3d 915 (6th Cir, 2003); *Hoffman*, 255 F 3d 1180 (9th Cir, 2001); *CBC Distribution and Marketing Inc v Major League Baseball Advanced Media LP*, 505 F 3d 818 (8th Cir, 2007).

171 Kirsten Anker, 'Possessing Star Qualities: Celebrity Identity as Property' (2002) 11 *Griffith Law Review* 147, 166.

172 Marshall Leaffer, 'The Right of Publicity: A Comparative Perspective' (2007) 70 *Albany Law Review* 1357, 1372. Leaffer also contends that the 'British court in the Irvine case got it right and its reasoning should be the current standard'.

173 Carty, above n 20, 257.

assume that meaning has been transferred from celebrity to product, like in a typical right of publicity claim, the element of misrepresentation requires courts to examine whether in fact these meanings have been transferred as a result of consumers perceiving an endorsement, approval or association of a celebrity plaintiff with the defendant's products.

Indeed celebrities 'perform important functions in a mature capitalist economy in which consumer demand is paramount.'[174] The analysis here presents an opportunity for a larger inquiry into the intertextuality of the celebrity sign, through studying how 'affective attachments or connotations that are configured around individual celebrities can be revealed'.[175] As Gilbert Rodman argues, 'stardom is not a purely mercantile phenomenon imposed "from above" by profit-hungry media conglomerates as much as it is a socially based phenomenon generated "from below" at the level of real people who make affective investments in particular media figures'.[176] Since the majority of passing off cases that involve the celebrity persona occur in the context of advertisements, further examination of writings on the semiotics of advertising and audience receptivity[177] may reveal even more insights into audience perception and the legal determination of likelihood of confusion. Thus the findings in this article suggest that the extended passing off claim not only appears to be adequate in protecting against unauthorised exploitation of the associative value of a celebrity's persona, but is also able to consider, in a more holistic manner than in a right of publicity claim, the interests of the constituents of the celebrity trinity.[178] The celebrity individual is accorded control over the associative value of his or her commercially valuable identity, but only in circumstances where his or her star aura is transferred to other commodities. The producers as commercial traders are allowed to compete more freely, but not dishonestly. And finally, almost conspicuous by their absence in right of publicity doctrine, the audiences who invest meanings in the celebrity personality are examined as *consumers* in the determination of whether manipulative consumption has occurred.

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174 Ibid 264.

175 Marshall, above n 34, 59.

176 Gilbert B Rodman, *Elvis After Elvis: The Posthumous Career of a Living Legend* (Routledge, 1996) 12. See also Turner, above n 34, 91; Marshall, above n 34, 199.

177 See, eg, Judith Williamson, *Decoding Advertisements* (Marion Boyers Publishing, 1978); Judith Williamson, *Consuming Passions: The Dynamics of Popular Culture* (Marion Boyers Publishing, 1991); Sut Jhally, *The Codes of Advertising: Fetishism and the Political Economy of Meaning in Consumer Society* (Routledge, 1987); William Leiss, Stephen Kline, Sut Jhally and Jacqueline Botterill, *Social Communication in Advertising: Consumption in the Mediated Marketplace* (Routledge, 3rd ed, 2005); Ien Ang, *Desperately Seeking the Audience* (Routledge, 1991); David Morley and Charlotte Brundson, *The Nationwide Audience Study* (Routledge, 1999).

178 Legal commentator Alison Laurie alluded to this when she said 'the issue of protection of character merchandising rights involves the striking of a balance between three sets of competing interests', but did not explore this further. Laurie, above n 7, 14. See also similar considerations in Katekar, above n 7, 197; Leaffer, above n 172, 1370–2.