NUS Working Paper 2017/010

Image Rights and Data Protection

David TAN

david.tan@nus.edu.sg

[August 2017]

IMAGE RIGHTS AND DATA PROTECTION

David Tan*

I INTRODUCTION

"Image rights" extend beyond the protection of an individual's portrait, photograph or likeness. They are also known as "personality rights" and they generally protect against unauthorised publication of one's private information and commercial exploitation of aspects of one's persona. In the United States, they are seen to comprise the right of publicity and the right of privacy. Different theoretical rationales have been invoked to justify the recognition of personality rights. The right of publicity is the legal right to control commercial uses of one's identity, which protects the *economic* interests of a famous personality, and the right of privacy is the right of the individual to be let alone, which protects *dignitary* interests. Publicity and privacy rights in the US are protected by a combination of common law and statutes at the state level. The right of publicity is usually regarded as a property right that is freely assignable and sometimes descendible. In contrast, the right of privacy is not transferable and exists within a tortious framework comprising separate elements relating to different aspects of privacy.

In Singapore, both the rights of publicity and privacy are neither recognised under the common law nor statute. However, the Personal Data Protection Act 2012 (PDPA) offers protection against unauthorised use and disclosure of "personal data" in certain circumstances,[1] which in turn confers incidental personality rights in the form of a right of private action for breaches of the PDPA.[2] In Europe, it is recognised that the protection of natural persons in relation to the processing of personal data is a fundamental right, and a spectrum of similar but more extensive protections are enshrined in the European Union's General Data Protection Regulation (GDPR).[3] Unlike in Singapore, and many other Commonwealth common law jurisdictions, a number of Member States of the European Union such as Germany and France recognise personality rights or *droit a l'image* as independent causes of action.[4] Generally, such data protection legislation are

---

* Associate Professor, Dean's Chair, Faculty of Law, National University of Singapore.

1 Personal Data Protection Act 2012 (Cap 26) ss 2, 17(2), 17(3), 18. "Personal data" is defined broadly to include all "data, whether true or not, about an individual who can be identified … from that data".

2 Personal Data Protection Act 2012 (Cap 26) s 32.

3 Regulation (EU) 2016/679 of the European Parliament and of the Council on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (27 April 2016). It shall apply from 25 May 2018.

4 Eg *Bürgerliches Gesetzbuch* §12 (*Civil Code 1900 – BGB)*, *Kunsturheberrechtsgesetz* §22 (*Act on Copyright in Works of Visual Arts 1907 – KUG)* (Germany); Code civil art 1382 (France). See also Elisabeth Logeais and Jean-Baptiste Schroeder, "The French Right of Image: An Ambiguous Concept Protecting the Human Persona" (1998) 18 *Loyola of Los Angeles Entertainment Law Journal* 511; Alain J Lapter, "How the Other Half Lives (Revisited): Twenty Years Since Midler v Ford – A Global Perspective on the Right of Publicity" (2007) 15 *Texas Intellectual Property Law Journal* 239; Huw Beverley-Smith, Angsar Ohly and Agnès Lucas-Schloetter, *Privacy, Property and Personality: Civil Law Perspectives on Commercial Appropriation* (2005); Giorgio Resta, "The New Frontiers of

not intended or designed to protect against unauthorised commercial exploitation of personal data: (i) on or in products, merchandise or goods; or (ii) for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services. An individual's whose personal data – i.e. name, image or any "data" that identifies him or her – has been commercially appropriated in advertising or merchandising will often have to seek recourse under right of publicity or passing off laws.

II LIMITED SCOPE OF THE PERSONAL DATA PROTECTION ACT

The purpose of the PDPA is stated as "govern(ing) the collection, use and disclosure of personal data by organisations in a manner that recognises both the right of individuals to protect their personal data and the need of organisations to collect, use or disclose personal data for purposes that a reasonable person would consider appropriate in the circumstances."[5] It is clear that the PDPA confers on individuals, for the first time in Singapore, the right to personal data protection subject to the limits defined in the statute, and this right is independent of any common law or fundamental right to privacy (which has not been recognised in Singapore).[6] Furthermore, its three main objectives are uncontroversial: (i) granting a qualified statutory right of individuals to data protection; (ii) providing private organisations with a qualified right to collect, use and disclose personal data under a "principled-based and technology neutral approach"; and (iii) supporting the development of Singapore into a global data hub.[7] As Simon Chesterman correctly notes,

> In terms of the implications for privacy, it is telling that although the word "privacy" appeared in passing in the various consultation papers, it is entirely absent from the legislation as adopted. Instead, the purpose as articulated in the PDPA is clearly focused on the *management of information*.[8]

The possible meanings of "personal data" have been well examined in other writings. For instance, Warren Chik and Joey Pang have noted two possible approaches to defining the scope of personal data under the PDPA. The first "balance-of-interests" approach construes personal data contextually, i.e. "what constitutes personal data will be determined by considering whether such a reading promotes the right of individuals to data protection while not making compliance overly onerous for private organisations".[9] Such an approach has been adopted by Australia and Hong Kong. The second "broad and

---

Personality Rights and the Problem of Commodification: European and Comparative Perspectives" (2011) 26 *Tulane European and Civil Law Forum* 33; Silvio Martuccelli, "The Right of Publicity under Italian Civil Law" (1998) 18 *Loyola of Los Angeles Entertainment Law Journal* 543.

5 Personal Data Protection Act 2012 (Cap 26) s 3.

6 See Warren B Chik and Pang Keep Ying Joey, "The Meaning and Scope of Personal Data under the Singapore Personal Data Protection Act" (2014) 26 *Singapore Academy of Law Journal* 354, 362-363.

7 Ibid at 366 (internal citations omitted).

8 Simon Chesterman, "From Privacy to Data Protection" in Simon Chesterman (ed), *Data Protection Law in Singapore: Privacy and Sovereignty in an Interconnected World* (2014) 1 at [1.49]. See also Assoc Prof Dr Yaacob Ibrahim, Minister for Communications and Information, 'second Reading Speech on the Personal Data Protection Bill 2012", *Singapore Parliamentary Reports (Hansard)* (15 October 2012).

9 Chik and Pang, above n 6, at 367.

expansive" approach appears to be supported by Canada, the United Kingdom (UK) and the European Union, and it confers a wide meaning to personal data; it is also the approach championed by Chik and Pang.[10] Indeed the definition of personal data under section 2 of the PDPA is very similar to section 1(1) of the Data Protection Act 1998 (UK). While "data" is not specifically defined in the PDPA, it would cover information, written or otherwise recorded, and would include photographs and audio-visual recordings in manual or electronic/digital format.[11] The Personal Data Protection Commission (PDPC) has issued an advisory noting that "[a]n individual can be identified if that individual can be singled out from other individuals by an organisation based on one or more characteristics of the data or other pieces of information."[12] In the March 2017 revised version of the PDPC's *Advisory Guidelines on the Personal Data Protection Act for Selected Topics*, it was stated that "[a]n image of an individual in a photograph or video recording is personal data about that individual."[13] While there is some ambiguity regarding the scope of data "about an individual" under the PDPA,[14] it is the issue of identifiability of the individual that is ultimately relevant to the commercial exploitation of personal data in advertising and selling. Sections 11 and 12 of the PDPA, which set out the general rules, policies and practices of the Act, unequivocally limits the ambit of the Act to the collection, use and disclosure of personal data in respect of privacy and confidentiality concerns only.[15] Section 24 provides:

> An organisation shall protect personal data in its possession or under its control by making reasonable security arrangements to prevent unauthorised access, collection, use, disclosure, copying, modification, disposal or similar risks.

If an organisation were to possess a photograph of a well-known individual, even if it owns the copyright to that photograph, and then subsequently uses the photograph in an advertisement, it would have infringed section 24.[16] While there has been no litigation on this aspect so far, it is unlikely that damages awarded under the right of private action under section 32 – which appears to be related to privacy concerns – will include an account of profits or damages due to harm to the individual's goodwill by tarnishing the reputation behind it or as a result of loss of endorsement revenue.

---

10 Ibid at 368-371.

11 Ibid at 374.

12 Personal Data Protection Commission, *Advisory Guidelines on Key Concepts in the Personal Data Protection Act* (24 September 2013) at para 5.9. On the burden of proof in identification, see Chik and Pang, above n 6, 386-387.

13 Personal Data Protection Commission, *Advisory Guidelines on the Personal Data Protection Act for Selected Topics* (revised 28 March 2017) at para 4.2.

14 Chik and Pang, above n 6, at 380-385.

15 Furthermore, a significant portion of the PDPA focuses on the Do Not Call Registry, which strongly indicates that the PDPA is less concerned with protecting the commercial interests of individuals than with dignitary interests, which encompass privacy and confidentiality dimensions. See Personal Data Protection Act 2012 (Cap 26) Part IX ss 36-48.

16 An illustrative example where consent would be required if the organisation wanted to publish the photograph taken at an event for its "business purpose" has been provided in the Personal Data Protection Commission, *Advisory Guidelines on the Personal Data Protection Act for Selected Topics* (revised 28 March 2017) at para 4.7.

In the United States (US), the above unauthorised use would be covered by the right of publicity in a majority of states. The right of publicity, broadly defined as the "inherent right of every human being to control the commercial use of his or her identity",[17] has been well-established in the US for over sixty years.[18] Outside the US, the common law passing off action is the claim relied upon by celebrities in common law jurisdictions, such as the UK, Australia, Hong Kong and Singapore, which do not recognise a right of publicity, to protect themselves against the commercial appropriation of their fame. Although the right of publicity and passing off claims share a basic similarity in that both protect the valuable commercial goodwill that inheres in a famous individual's persona, the elements of the two causes of action are fundamentally different.

III COMMERCIAL EXPLOITATION OF PERSONAL DATA IN ADVERTISING AND SELLING

A. The Right of Publicity – *Fraley v Facebook* under the PDPA

The right of publicity ensures that the right to control the commercial exploitation of an individual's fame or public notoriety belongs to the individual with whom it is identified. It protects the "associative value" that celebrities bring to products and services.[19] It does not require one to prove a likelihood of confusion, but it requires a proof of fame. It has been called the "right to manage fame".[20] Generally perceived to be a property right akin to an intangible or intellectual property right,[21] the right of publicity has been invoked mainly by well-known individuals to monetise their identity and to prevent unauthorised commercial uses of various aspects of their persona.[22]

---

17 J Thomas McCarthy, *The Rights of Publicity and Privacy* (2nd ed, 2000) (April 2016 update) § 3:1.

18 It was first recognised by the Second Circuit in 1953 that baseball players had a "right of publicity" in their images. *Haelan Laboratories Inc v Topps Chewing Gum Inc*, 202 F 2d 866, 868 (2nd Cir, 1953). In the only right of publicity case ever to reach the US Supreme Court, the court affirmed the recognition of such an actionable right. *Zacchini v Scripps-Howard Broadcasting Company*, 433 US 562 (1977). In 2017, 31 states had provided their citizens with a remedy for infringement of the right of publicity. Twenty-one states recognise publicity rights by way of common law, and of those, eight also have also have statutory provisions broad enough to encompass the right of publicity. Moreover, ten states have statutes which, while some are labeled "privacy" statutes, are worded in such a way that most aspects of the right of publicity are embodied in those statutes.

19 Sheldon W Halpern, "The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality" (1995) 46 *Hastings Law Journal* 853, 856, 859-60.

20 Daniel Gervais and Martin L. Holmes, "Fame, Property, and Identity: The Scope and Purpose of the Right of Publicity" (2014) 25 *Fordham Intellectual Property, Media & Entertainment Law Journal* 181, 195.

21 Eg *Comedy III Productions Inc v Gary Saderup Inc*, 25 Cal 4th 387, 399 (2001).

22 The 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 in the US are brought by celebrities like Tiger Woods, Dustin Hoffman, Johnny Carson, Bette Midler and professional sporting league athletes for unauthorised uses of their identity. 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); *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); *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).

For celebrities who actively seek fame through the attention of the media, it was an unconvincing argument to extend the traditional right of privacy to prevent the unauthorised commercial uses of their identities.[23] In the US, the *Restatement (Third)* makes a distinction between the right of privacy and right of publicity, explaining that while privacy relates to an "injury to solitude or personal feelings", the right of publicity provides a redress for "commercial harm"[24] and is widely seen to be "a purely economic property tort".[25] The complementary tort of appropriation of personality under the rubric of invasion of privacy was primarily designed to compensate for the hurt feelings of private individuals who find their identities usurped for another's commercial gain; and it is articulated in the *Restatement (Second) of Torts* that "[o]ne who appropriates to his own use or benefit the name and likeness of another is subject to liability to the other for the invasion of his privacy."[26] Since it is widely accepted that the right of publicity originated from the privacy tort of misappropriation of identity,[27] some courts, when adjudicating a common law claim for an unauthorised commercial use of identity, may refer to the *Restatement (Second)* instead.[28] The *Restatement (Third)* also indicates that similar substantive rules may govern the determination of liability.[29]

Although the right of publicity may have been accepted as an emerging area of intellectual property law in the US, its conceptual basis is still not entirely clear.[30] As Mark Bartholomew so succinctly puts it, "[i]t would be hard to find a property right more vilified in the legal academy than the right of publicity."[31] Legal scholars Stacey Dogan and Mark Lemley have identified "the usual explanations" as belonging to three

---

23 See, eg, United States cases from the early twentieth century, where the courts protected individuals from unauthorised commercial uses of name and likeness by enforcing a right of privacy: *Pavesich v New England Insurance Co*, 50 SE 68 (Ga, 1905); *Edison v Edison Polyform Manufacturing Co*, 67 A 392 (NJ, 1907); *Kunz v Allen*, 172 P 532 (Kan, 1918).

24 *Restatement (Third) of Unfair Competition* § 46 cmt b (1995); McCarthy, above n 17, § 1:35.

25 Robert T Thompson, "Image as Personal Property: How Privacy Law has influenced the Right of Publicity" (2009) 16 *UCLA Entertainment Law Review* 155, 156. For a more extensive analysis, see Samantha Barbas, *Laws of Image, Privacy and Publicity in America* (2015).

26 *Restatement (Second) of Torts* § 652C (1977).

27 The right of publicity and the right of privacy are not mutually exclusive and they originate from the same wrong. See William L Prosser, "Privacy" (1960) 48 *California Law Review* 383, 389. See also *Restatement (Third) of Unfair Competition* § 46 cmt b (1995). Following the decision in *Haelan Laboratories*, Melville Nimmer explained that the right to privacy provided insufficient protection for the commercial value of one's identity because it focused on prevention of feelings of indignity and embarrassment that are often not present in cases involving celebrities and that this new publicity right should more appropriately be an assignable property right. This seems to be the view adopted in over half of the US states. Melville Nimmer, "The Right of Publicity" (1954) 19 *Law & Contemporary Problems* 203. Despite the differences in the types of damages that may be recovered, the key elements of the publicity tort and the identity misappropriation tort are essentially similar. *Doe*, 110 SW 3d 363, 368-69 (Mo banc, 2003). See also comments by Howard I Berkman, "The Right of Publicity-Protection for Public Figures and Celebrities" (1976) 42 *Brooklyn Law Review* 527, 534-41.

28 Eg *Matthews v Wozencraft*, 15 F 3d 432, 437 (5th Cir, 1994); *Kimbrough v Coca-Cola/USA*, 521 SE 2d 719, 722 (Tex Civ App, 1975). See also McCarthy, above n 17, § 6:4.

29 *Restatement (Third) of Unfair Competition* § 46 cmt b (1995).

30 See David Tan, *The Commercial Appropriation of Fame: A Cultural Analysis of the Right of Publicity and Passing Off* (2017) 45-63.

31 Mark Bartholomew, "A Right is Born: Celebrity, Property, and Postmodern Lawmaking" (2011) 44 *Connecticut Law Review* 301, 303 fn 2.

categories: "the moral or natural rights story; the exhaustion or allocative-efficiency account; and the incentive-based rationale."[32] These theoretical justifications have all been subject to numerous criticisms,[33] but there is no doubt that the right of publicity is firmly entrenched in American jurisprudence and provides the fundamental protection for the commercial value of the celebrity identity. Indeed the *Restatement (Third)* observes that overriding rationale appears to be grounded in unjust enrichment, with the result that, unlike in *Lanham Act* § 43(a) and passing off claims, there is no need to prove likelihood of confusion or misleading conduct. Furthermore, the law is more concerned with an unauthorised commercial advantage gained by the defendant than with any actual damage or loss suffered by the plaintiff.[34]

In practice, infringement of the right of publicity is found when the plaintiff is "identified" from the defendant's unauthorised commercial use.[35] What is really in dispute today in the US, is not whether the right of publicity should exist, but rather what it protects and the extent of that protection. It is the common perception that the right of publicity is a legal privilege granted exclusively to the rich and famous that is probably most damaging to the right's credibility. Criticism of the right of publicity is almost invariably accompanied by indignity over the notion that the right functions as a legal remedy to reimburse individuals who are already financially very well-off,[36] as living lives of leisure,[37] or as having not done any "real" work to achieve their exalted positions. It is for these reasons that most Commonwealth common law jurisdictions with a vibrant entertainment industry like the United Kingdom, Australia, and Hong Kong have eschewed any explicit recognition of this right, and have opted instead to address any commercial appropriation of valuable identity under the existing law of passing off.

However, the Internet age might have altered the terms of the debate as individuals expend significant effort to create new content for social media platforms on the internet in a bid to secure "Likes" and repostings in their bid to become instantly famous. The unjust enrichment rationale for the right of publicity, championed by the US Supreme Court in the only decision it has rendered in this area, appears to be the most compelling justification for recognising the right of publicity. In *Fraley v Facebook*,[38] a California court found that Facebook earns revenue primarily through the sale of targeted advertising that appears on members" Facebook pages. Each time Facebook users clicked

---

32 Stacey L Dogan and Mark A Lemley, "What the Right of Publicity Can Learn from Trademark Law" (2006) 58 *Stanford Law Review* 1161, 1180 (footnotes omitted).

33 For a summary of these criticisms, see David Tan, "Beyond Trademark Law: What the Right of Publicity Can Learn from Cultural Studies" (2008) 25 *Cardozo Arts & Entertainment Law Journal* 913, 927-38.

34 *Restatement (Third) of Unfair Competition* § 46 (1995) cmt c. However, the award of compensatory damages is "measured [either] by the loss to the plaintiff or … by the unjust gain to the defendant". *Restatement (Third) of Unfair Competition* § 49 (1995) cmt a. While damage is often presumed, the court may award nominal damages if the plaintiff fails to establish on the evidence pecuniary gain to the defendant or pecuniary loss to the plaintiff. *Restatement (Third) of Unfair Competition* § 49 (1995) cmt c.

35 Eg *Restatement (Third) of Unfair Competition* § 46 (1995) cmt d; McCarthy, above n 17, § 3:7.

36 Eg *ETW Corp v Jireh Publishing Inc*, 332 F 3d 915 (6th Cir, 2003).

37 Eg *Hilton v Hallmark Cards*, 599 F 3d 894 (9th Cir, 2010).

38 *Fraley v Facebook Inc*, 830 F Supp 2d 785 (ND Cal, 2011).

a "Like" button on certain companies" website for various reasons, such as to access a special offer code for a new product, to access photographs of an event, or to become eligible for a promotional prize, their actions would be interpreted and publicised by Facebook as an endorsement of those advertisers, products, services, or brands as a "Sponsored Story". These "Sponsored Stories" constitute a new form of advertising which drafted millions of Facebook members as unpaid and unknowing spokespersons for various products.

Hypothetically, if the plaintiffs in *Fraley* had presented their case as an infringement of section 24 of the PDPA in Singapore, it would be arguable that Facebook, "an organisation", possessed and controlled "personal data" (i.e. the "Likes" of each Facebook user) and had failed to make "reasonable security arrangements to prevent unauthorised … use" of the data; Facebook had in fact used the personal data themselves for commercial gain. This potential breach does not address the issue that Facebook has commercially exploited the individuals' personal data for a new advertising revenue stream.

The California court agreed with the plaintiffs' contention that "their individual, personalized endorsement of products, services, and brands to their friends and acquaintances has concrete, provable value in the economy at large, which can be measured by the additional profit Facebook earns from selling Sponsored Stories compared to its sale of regular advertisements."[39] According to Sheryl Sandberg, Chief Operating Officer of Facebook, the value of a Sponsored Story advertisement is at least twice and up to three times the value of a standard Facebook.com advertisement without a friend endorsement.[40] It is unsurprising that, in *Fraley*, the California District Court accepted possibly the widest definition of contemporary fame in the digital age in finding that the plaintiffs" allegations of provable commercial value was sufficient to survive a motion by the defendant Facebook to dismiss: "[i]n essence, Plaintiffs are celebrities – to their friends."[41]

B. Passing Off – *Heigl v Duane Reade* under the PDPA

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.[42] Therefore it appears more

---

39 Ibid at 799.

40 Ibid.

41 Ibid at 809. See also ibid at 805 (the court agrees with the "Plaintiffs' assertion of their status as local 'celebrities' within their own Facebook social networks").

42 *Restatement (Third) of Unfair Competition* §§ 46 cmt c, 47 cmt a (1995); J Thomas McCarthy, *The Rights of Publicity and Privacy* (2nd ed, 2000) (updated April 2016) § 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,

expansive in its protection against an unauthorised use of identity compared to a common law passing off claim. Celebrities in common law jurisdictions like Singapore, the UK and Australia 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.[43] Unlike in a right of publicity claim, it is 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.

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.[44] Subsequently, passing off has broadened to protect goodwill "not in its classic form of a trader representing his goods as the goods of somebody else, but in an extended form."[45] In the UK, it appears settled law that the extended action of passing off today does not require the plaintiff to prove a common field of activity;[46] and it appears that the passing off action is capable of protecting the goodwill or valuable reputation of a person/business against any unauthorised claim of association or connection by another ("promotional goodwill").[47] In 2015, the English Court of Appeal unequivocally recognised the passing off action as the appropriate cause of action for celebrities wishing to seek a remedy for a commercial appropriation of their fame: "the proposition that a famous personality has no right to control the use of her image in general does not lead inexorably to the conclusion that the use of a particular image cannot give rise to the mistaken belief by consumers that the goods to which it is applied have been authorised."[48] This position resonates with the Australian cases.[49]

1398 (9th Cir, 1996) ("*Abdul-Jabbar*"); *Rogers v Grimaldi*, 875 F 2d 994, 1004 (2nd Cir, 1989) ("*Rogers*").

43 Eg *Irvine v Talksport Ltd* [2002] 1 WLR 2355 ("*Irvine*"); *Pacific Dunlop Ltd v Hogan* (1989) 25 FCR 553 ("*Crocodile Dundee*"); *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314 ("*Koala Dundee*"); *Henderson v Radio Corporation Pty Ltd* (1960) SR(NSW) 576; [1969] RPC 218 ("*Henderson*").

44 Eg *Reddaway (Frank) & Co Ltd v George Banham & Co Ltd* [1896] AC 199, 204 ("*Reddaway*"); *Erven Warnink BV v J Townsend & Sons (Hull) Ltd* [1979] AC 731, 742 ("*Erven Warnink*"); *Irvine*, ibid 2360. See also 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.

45 *Erven Warnink* [1979] AC 731, 739. However, 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.

46 Eg *Lego Systems A/S v Lego M Lemelstrich* [1983] FSR 155, 183-7 ("*Lego*"); *Irvine* [2002] 1 WLR 2355, 2368.

47 Eg Samuel K Murumba, *Commercial Exploitation of Personality* (1986) 65. See also *Arsenal Football Club plc v Reed* [2001] RPC 922, 930-1.

48 *Fenty & Ors v Arcadia Group Brands Ltd (trading as Topshop)* [2015] EWCA Civ 3 at [48] ("*Fenty*").

49 Eg *Campomar* (2000) 2002 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. 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.

The passing off action does not recognise a proprietary interest per se in a name, likeness or other indicia of identity,[50] but it protects goodwill as "the attractive force which brings in custom"[51] by preventing a trader from gaining an unfair competitive advantage through associating itself or its products with a well-known personality. In order for a celebrity to obtain legal recourse for interference with his or her goodwill, the claimant must prove all the elements of the passing off tort. Despite there being no generally accepted definition of passing off, the element of misrepresentation or misleading/deceptive conduct is considered to be central to the tort.[52] However, the misrepresentation must relate to the plaintiff's goodwill and harm it in some way, and "mere misrepresentation/confusion alone is not sufficient".[53] The elements of a common law passing off action in Singapore, the UK and Australia follow the position set out by the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc*[54] in that there are three key elements of goodwill or valuable reputation, misrepresentation or deceptive conduct and damage (known as the "classic trinity").[55]

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."[56] Similarly, the Australian High Court, in a unanimous decision, has recognised

> 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.[57]

---

50 This is in contrast to the right of publicity where an unauthorised commercial use of identity is perceived to be a tortious interference with a property right. 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).

51 *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*").

52 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").

53 Hazel Carty, "Heads of Damage in Passing Off" (1996) 18 *European Intellectual Property Review* 487, 487. See also *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413 ("*Budweiser case*").

54 [1990] 1 All ER 873 ("*Reckitt & Colman*").

55 Eg *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical)* [2016] 4 SLR 86; *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216; *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712; *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. See also *Consorzio del Prosciutto di Parma v Marks and Spencer Plc (Parma Ham)* [1991] RPC 351; *Harrods Ltd v Harrodian School* [1996] RPC 697; *Diageo NA Inc v Intercontinental Brands (ICB) Ltd (Vodkat)* [2010] EWCA Civ 920 [2011] RPC 2; *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch), [2011] FSR 11; *Specsavers v Asda* [2010] EWHC 2035 (Ch), [2011] FSR 1.

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

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

These judicial acceptance of a wide range of indicia of identity coheres with the broad scope of "personal data" under section 2 of the PDPA. The Singapore Court of Appeal's comment in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* suggest that the local courts are less concerned with narrowing what might constitute goodwill:

> What the tort seeks to protect is not the plaintiff's use of a mark, name or get-up *per se*; rather, the tort seeks to prevent the defendant from causing damage to the plaintiff by committing an actionable misrepresentation.[58]

In a passing off claim, an individual 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.[59] The terms "goodwill" and "reputation" have been used interchangeably.[60] In other words, it is recognised that the reputation of a plaintiff in the forum is the source of his or her potential business there; and a "sufficient reputation" to be actionable "requires something more than a reputation among a small number of persons".[61] So far the celebrities who have brought a passing off claim in UK and Australia – like Rihanna, Eddie Irvine, Paul Hogan and Kieren Perkins – have previously exploited their goodwill through local endorsements. It is necessary for the claimant to demonstrate local custom, i.e. the presence either of transactions/business with customers, or simply of customers in the jurisdiction in which passing off is alleged. In *Starbucks (HK) Ltd v British Sky Broadcasting Group*, the Supreme Court of the United Kingdom (UKSC) adopted the "hard line" approach to goodwill, where Lord Neuberger, writing for a unanimous court, held:

> I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.[62]

---

58 *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical)* [2016] 4 SLR 86 at [28].

59 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. Eg *ConAgra* (1992) 33 FCR 302, 340-4. The specific thing in which goodwill is vested must also be identified. Eg *Conan Doyle v London Mystery Magazine Ltd* (1949) 66 RPC 312, 313-4 (goodwill only in existing stories and not generally in all aspects of Sherlock Holmes character).

60 Eg *Consorzio del Prosciutto di Parma v Marks & Spencer plc* (1989) 16 IPR 117, 123-4; *ConAgra* (1992) 33 FCR 302, 340.

61 *ConAgra*, ibid 346.

62 [2015] UKSC 31, at [47] ('*NOW TV*' case). The appellant claimants, Starbucks (HK) Ltd and PCCW Media Ltd, are members of a substantial group based in Hong Kong headed by PCCW Ltd (PCCM). Since 2003, the claimants have provided a closed circuit internet protocol television (IPTV) service in Hong Kong and had used the name 'NOW TV' since March 2006. By 2012, after PCCM had spent substantial sums on marketing, NOW TV had become the largest pay TV operator in Hong Kong, with around 1.2m subscribers, covering over half the households in Hong Kong. People in the United Kingdom cannot receive this closed circuit service. However, a number of Chinese speakers

Lord Neuberger doubted that a passing off claim could be brought by a claimant who has not yet attracted goodwill in the UK but has only launched a substantial advertising campaign within the UK announcing that it will imminently be marketing its goods and services there.[63]

Unlike the inquiry pertaining to *commercial traders*, the question of "what form of activity on the part of the plaintiff is required before it can be said that he has a 'business' here to which goodwill can attach?"[64] should not be relevant in cases where the *celebrity individual* brings a passing off claim. The celebrity individual often does not manufacture or trades in a particular product. The actionable goodwill of well-known individuals lies in their commercial potential or associative value at the time when passing off is alleged. Even for celebrities who have not previously exploited their fame through endorsements, cultural studies perspectives would support a finding of goodwill based on their well-knownness to audiences and the affective meanings that their personae embody. 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 in Singapore, the UK or Australia.[65] Expert evidence, survey evidence and results from focus groups are often admitted as evidence used to prove the subsistence of goodwill.[66]

Although courts have remarked that "[t]he law relating to which heads of damage are (or should be) judicially recognised under the tort of passing off is notoriously difficult",[67] there is insufficient attention given to the element of damage in passing off.

---

permanently or temporarily resident in the UK in 2012 were aware of the NOW TV service through exposure to it when residing in or visiting Hong Kong. In June 2012, PCCM had launched a NOW player 'app' in the UK, both on its website and via the Apple App Store, in order to warm up the market for the launch of PCCM's NOW TV on the platform of its proposed UK partner. The app and the channels were to be targeted at the Chinese-speaking population in the UK. By October 2012, just over 2,200 people in the UK had downloaded the app. In 2012, the respondents announced that they intended to launch a new IPTV service under the name NOW TV, as an OTT service. They subsequently effected that launch in beta form in mid-July 2012. The UKSC held that PCCM's business is based in Hong Kong, and it has no customers in the UK, and therefore no actionable goodwill.

63 Ibid at [66].

64 Eg *Budweiser case* [1984] FSR 413, 465. See also *Star Industrial Company Limited v Yap Kwee Kor* [1976] FSR 256, 269 ('*Yap*').

65 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 Pty Ltd v Telstra Corp Ltd* [1997] 2 Qd R 444 ('*Talmax*') (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). See also Huw Beverley-Smith, *The Commercial Appropriation of Personality* (2002) 61-70 (comparing the requirement of goodwill in UK and Australia).

66 However, courts are more reluctant to place great weight on expert testimony and survey evidence as proof of misrepresentation. Eg *Britt Allcroft (Thomas) LLC v Miller* (2000) 49 IPR 7, 15-6. See further *Halsbury's Laws of Australia* (2008) [240-4595] fn 8.

67 *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 at [96].

In most cases, there is an intrinsic likelihood of damage to goodwill once the misrepresentation has been made out;[68] it is only in the rare instance that the court will find that there is no damage to the trading plaintiff's goodwill because the plaintiff has no business presence despite enjoying local goodwill.[69] Generally, courts require actual or probable damage to goodwill to be shown. But in practice, as Jennifer Davis points out,

> it is a recognised aspect of passing off that a court may assume there is the relevant damage if goodwill and a misrepresentation can be shown … indeed in the vast majority of passing off cases, claimants are able to assert that they have suffered damage to their goodwill, or are likely to do so, or the courts are able to infer the same in the sure knowledge that it will be highly unlikely that the claimant will need to adduce proof of such damage.[70]

In a classic setting, the common types of damage – sometimes known as "narrow" definition of damage – are diversion of trade or loss of sales,[71] and devaluation or debasement of reputation or injurious association.[72] In more contentious situations involving commercial traders, there has been judicial support for a "broad" definition of damage such as the loss of control over the plaintiff's own reputation,[73] erosion of distinctiveness[74] and dilution of the profit potential of the plaintiff's name.[75] Carty argues that a "real risk of damage may arise from possible harm to the claimant's goodwill by tarnishing the reputation behind it or through lost sales. However, free riding or "unfair

---

68 Eg *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 19, at [106]-[108]; *Kimberley-Clark Ltd v Fort Sterling Ltd* [1997] FSR 877, 890.

69 Eg *Budweiser case* [1984] FSR 413, 468-72. In certain situations, the court has required "clear and cogent proof … of actual damage or the real likelihood of damage to the [claimants"] property in their goodwill … be substantial". *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501, 547 ("*Stringfellow*").

70 Jennifer Davis, "Why the United Kingdom should have a law against misappropriation" [2010] *Cambridge Law Journal* 561, 576-577.

71 Eg *Reddaway* [1896] AC 199.

72 Eg *Erven Warnink* [1979] AC 731; *Unitex Ltd Union Texturing Co* [1973] RPC 119; *Annabel's (Berkeley Square) Ltd v Schock (G) (t/a Annabel's Escort Agency)* [1972] FSR 261; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273.

73 Eg *Home Box Office Inc v Channel 5 Home Box Office Ltd* [1982] FSR 449 ("*HBO*"). See also *Lego* [1983] FSR 155, 195 ("the inability of the plaintiffs to control such use must involve a real risk of injury to their reputation"); *Harrods Ltd v The Harrodian School Ltd* [1993] FSR 641, 724 (Sir Michael Kerr dissenting) ("*Harrods*"). See also Peter Jones, "Manipulating the Law Against Misleading Imagery: Photo-Montage and Appropriation of Well-Known Personality" (1999) 21 *European Intellectual Property Review* 28, 29-30.

74 Eg *Irvine* [2002] 1 WLR 2355; *Taittinger SA v Allbev Ltd* [1993] FSR 641 ("*Taittinger*"); *Bollinger v Costa Brava Wine Co Ltd (No 2)* [1992] 2 NZLR 327; *Amanresorts* [2009] FSR 763. See also criticisms in Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (3rd ed, 2004) [4-44].

75 Eg *Taittinger*, ibid; *Lego* [1983] FSR 155; *Alfred Dunhill Ltd v Sunoptic SA* [1979] FSR 337. However, Carty has argued that "injury to commercial magnetism or commercial potential … do not necessarily involve damage to goodwill" in a passing off action. Carty, above n 53, 487. There was an intimation, but without further elaboration, by English court that not all confusion causes damage. See also criticisms in Hazel Carty, "Dilution and Passing Off: Cause for Concern" (1996) 112 *Law Quarterly Review* 632.

advantage" is not damage."[76] Despite Laddie J citing erosion as the harm in *Irvine*, he also referred to Talksport 'squatting" and taking the "lustre" of the famous claimant in order to enhance "the attractiveness of the product to the target audience".[77] The law in this area is anything but consistent. In a number of decisions concerning *commercial traders*, the English courts seem to have drawn a line at recognising as a legitimate item of damage a restriction on expansion potential,[78] but the Australian courts have been willing to accept an interference with the licensing or merchandising potential of *celebrity individuals* as a head of damage.[79] In *Henderson*, the court held that the "appropriation of [the] professional or business reputation" of the well-known ballroom dancers for the defendant's "commercial ends" and thus depriving them of their right "to withhold or bestow at will" is "an injury in itself".[80] Similar language regarding wrongful appropriation of reputation in commercial trading has been used by the English Court of Appeal in finding that once misrepresentation has been shown, although the defendants" "Elderflower Champagne" would "not reduce the … plaintiffs" sales in any significant or direct way", erosion of the singularity and exclusiveness of the Champagne description nonetheless qualified as 'serious" damage.[81]

In a more recent celebrity passing off case, it appears that the English Court of Appeal, like the Australian courts, is prepared to extend heads of damage to include potential loss of licensing opportunities,[82] although it has not been explicit whether it would allow a claim in a situation where the claimant has yet to license his or her name for the purposes of sponsorship, endorsement and merchandising.[83] So far, the passing off cases involving celebrity claims in an unauthorised endorsement context have been instituted by individuals who have a history of commercial sponsorships – like Rihanna, the Spice Girls and Eddie Irvine in the UK, and Paul Hogan, Olivia Newton-John, Kieren Perkins and Gary Honey in Australia. A contemporary celebrity who is a well-known mediated persona, including those who have attained internet fame, can possess valuable goodwill because of his or her well-knownness. This celebrity goodwill can exist where the individual has not had the opportunity to endorse any product, or even where the celebrity has refused to endorse any product. If a well-known individual is accepted by the court to have the requisite goodwill, then once misrepresentation has been shown, there is no compelling reason to deny remedy on the grounds that there is no damage because there was no prior history of commercial endorsement.

---

76 Hazel Carty, "Passing Off: Frameworks of Liability Debated" [2012] *Intellectual Property Quarterly* 106, 109.

77 *Irvine v Talksport* [2002] EWHC 367 (Ch); [2002] 1 WLR 2355 at [39].

78 Eg *Newsweek Inc v BBC* [1979] RPC 441; *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501. See also *Lyngstad v Anabas Products Ltd* [1977] FSR 62 (regarding Abba merchandise, but the case was arguably disposed on the goodwill issue).

79 Eg *Henderson* (1960) SR(NSW) 576; *Koala Dundee* (1988) 20 FCR 314; *Crocodile Dundee case* (1989) 25 FCR 553. Contra *Halliwell v Panini SpA* (Unreported, 6 June 1997) (an English decision permitting unauthorised use of Spice Girls images on memorabilia stickers).

80 *Henderson* [1969] RPC 218, 236.

81 *Taittinger* [1993] FSR 641, 678.

82 *Irvine (Damages)* [2003] 2 All ER 881, 903.

83 It was not an issue in *Irvine* as Eddie Irvine "has been engaged to sponsor a variety of products including, amongst others, sun glasses, mens' toiletries, fashion clothing, footwear and car racing helmets". *Irvine* [2002] 1 WLR 2355, 2371.

The degree of harm to the celebrity may be appropriately assessed in the award of damages; for example, one who has a track record of commercial endorsements, like Eddie Irvine, may receive more substantial compensation based on previous licensing arrangements than one has not agreed to any public endorsements. The English Court of Appeal has recently intimated that in the award of damages, the computation would be based on what the market would have paid if the celebrity had agreed to be in the advertisement.[84] It has also been argued that when misrepresentation has been proven, even where a plaintiff "cannot prove direct loss or damage to his goodwill, the damages for the defendant's wrongdoing will be calculated as if the defendant had acted properly in seeking a license prior to using the plaintiff's image."[85] In *Fenty v Arcadia Group Brands Ltd (trading as Topshop)*, Birss J thought that damage "amounts to sales lost to [Rihanna's] merchandising business. It also represents a loss of control over her reputation in the fashion sphere."[86]

It is notable that some academic commentators are not so ready to gloss over the element of damage, arguing that "backdoor unprincipled extensions are not acceptable".[87] Yet in a breach of confidence context involving the wedding photographs of Michael Douglas and Catherine Zeta-Jones, a majority in the House of Lords seemed cognisant of the commercial potential of the contemporary celebrity and was prepared to extend greater protection to celebrities in preventing unauthorised commercial uses of their images, with Lord Hoffmann remarking that being a celebrity is a lawful trade and that the law should be flexible enough to protect even the commercial value of information relating to celebrities.[88] There is no reason to doubt that the willingness shown by the House of Lords to adapt the breach of confidence action to protect the commercial value of the celebrity persona is also likely to extend to the passing off claim.[89]

The litigation by actress Katherine Heigl in New York against an unauthorised use of a photograph of her shopping shows how the tort of passing off would be necessary in Singapore to seek redress for the commercial harm that an action under section 24 would not otherwise cover. Indeed social media platforms offer a plethora of opportunities for the commercial appropriation of fame. While the widespread individual posting of memes and GIFs rarely exploit the commercial value of the celebrity's fame,

---

84 See *Irvine (Damages)* [2003] 2 All ER 881, 903.

85 Peter M Bryniczka, 'snatching Victory from the Jaws of Defeat - English Law Now Offers Better Protection of Celebrities" Rights" (2004) 11 *Sports Lawyers Journal* 171, 188.

86 *Fenty & Ors v Arcadia Group Brands Ltd (trading as Topshop)* [2013] EWHC 2310 (Ch) at [74].

87 Carty, above n 53, 493. See also Suman Naresh, "Passing Off, Goodwill and False Advertising: New Wine in Old Bottles" [1986] *Cambridge Law Journal* 97, 97. Contra Douglas Farnsworth, "Does English Law Lack Personality" (2003) 3 *International Sports Law Review* 210, 218 ("English law is clearly out of step with commercial reality").

88 *OBG Ltd v Allan; Douglas v Hello!* [2008] 1 AC 1, 49.

89 It was raised by Laddie J, but without further discussion, that Article 8 of the *ECHR* may be relevant in influencing the development of the law in this area. *Irvine* [2002] 1 WLR 2355, 2379. Perhaps, the passing off claim may be extended to protect against the invasion of one's privacy through the appropriation of one's name and likeness for another's benefit – a *privacy* tort recognised in the United States. See, eg, *Restatement (Second) of Torts* § 652C (1977); William L Prosser, "Privacy" (1960) 48 *California Law Review* 383, 389.

commercial organisations have to be more careful about their postings of celebrity images, even if they owned the copyright to these images. When highly recognised actress Katherine Heigl was photographed by a New York paparazzi as she was leaving a Duane Reade store, the leading retail pharmacy chain Duane Reade tweeted the photo on 18 March 2014 with a caption reading, "Love a quick #DuaneReade run? Even @KatieHeigl can't resist shopping #NYC's favorite drugstore." Heigl sued for US$6 million for the misappropriation of her identity under the *New York Civil Rights Law §§50-51* and had pledged to donate all monies recovered in this lawsuit to a charitable animal welfare foundation, the Jason Debus Heigl Foundation.[90] At the time of the lawsuit, Duane Reade's Twitter account has 2.02 million followers, and states in the identification headline that "Duane Reade is the largest and most recognized drugstore chain in the New York Metropolitan area serving customers since 1960." As of 1 April 2014, it has tweeted advertising messages to its two-million-plus followers over 19,900 times. Its Twitter account also includes a link to its Facebook page.

The photograph of Heigl was taken in a public place. Under section 2 of the PDPA, "publicly available" in relation to personal data about an individual means "personal data that is generally available to the public, and includes personal data which can be observed by reasonably expected means at a location or an event (a) at which the individual appears; and (b) that is open to the public." Under the Second, Third and Fourth Schedules of the PDPA, an organisation may collect, use and disclose, without consent of the individual, any personal data about the individual that was "publicly available".[91] In this scenario, the photograph of Heigl outside the Duane Reade store in a public place is clearly "publicly available" data; an individual in Heigl's position in Singapore would have no recourse under the PDPA even if the individual's fame has been commercially exploited in a similar manner.

Heigl alleged that the purpose of Duane Reade's social media activities is "commercial advertising aimed at attracting customers and revenue, especially social media savvy customers in the coveted young adult demographics."[92] Moreover, Duane Reade's Tweets "predominantly promote commercial advertisements for a wide range of its products and services."[93] Capitalising on their original unauthorised Tweet to maximum advantage on their Facebook page, Duane Reade changed "favorite drugstore" to "most convenient drugstore" to emphasise the commercial message: "Don't you just love a quick #DuaneReade run? Even Katherine Heigl can't resist shopping at #NYC's most convenient drugstore!" Heigl maintains a Twitter account with over 754,000 followers (@KatieHeigl), and her lawyers argued that the unequivocal reference by Duane Reade to her Twitter handle @KatieHeigl is clearly exploiting her associative value by targeting her followers. By August 2014, Duane Reade had reached a "mutually beneficial" settlement with the actress, where Duane Reade will make a donation to the

---

90 *Heigl v Duane Reade Inc*, Case 1:14-cv-02502-ER, 9 April 2014 (SDNY) ("*Heigl*").

91 Personal Data Protection Act 2012 (Cap 26) Second Schedule para 1(c), Third Schedule para 1(c), Fourth Schedule para 1(d).

92 *Heigl*, Case 1:14-cv-02502-ER, 9 April 2014 (SDNY) at [18].

93 Ibid at [19].

Jason Debus Heigl Foundation which was set up in memory of her dead brother.[94]

If an individual were to seek redress in such a scenario under the tort of passing off in Singapore, the likelihood of success would be high. Assuming it was a local celebrity like Kit Chan or Zoe Tay photographed with shopping bags exiting a supermarket in Singapore, proving local goodwill or reputation would not be an obstacle. The use of similar hashtags and Twitter handles arguably suggest: (i) that the celebrity *approved* of the advertiser/trader or its product; or (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.[95] However, the case law "does not indicate [clearly] what type of misrepresentation must be alleged."[96] Carty explains that liability in passing off does not focus on confusion per se: "a lack of confusion does not rule out the presence of a material misrepresentation and not all confusing misrepresentations are material misrepresentations."[97] She notes that the tort of passing off helps "to protect the market information passing between trader and consumer, but it does not as such serve to protect the persuasive effect (subliminal or otherwise) of reputation or aura."[98] 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 by Laddie J:

> 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

---

94 Nate Raymond, "Katherine Heigl, Duane Reade end lawsuit over actress" photo", *Reuters.com* <http://www.reuters.com/article/us-people-katherineheigl-idUSKBN0GR2BD20140827> accessed 25 May 2017.

95 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; *10th Cantanae Pty Ltd v Shoshana Pty Ltd* (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. Although the English and Australian courts have not enumerated a list of factors to be examined, in practice, most of the *Downing* factors – in the context of a *Lanham Act* § 43(a) celebrity false endorsement claim – are considered. See *Downing v Abercrombie & Fitch*, 265 F 3d 994, 1007-8 (9th Cir, 2001) ("*Downing*") (restating the *Sleekcraft* factors to be considered in the context of celebrity claims for an unauthorised use of identity).

96 *Halsbury's Laws of Australia* (2008) [240-510] fn 1. See also *The Commercial Appropriation of Personality* (2002) 72-97 (comparing different types of connection misrepresentation in the UK and Australia). Similar observations have also been made about the *Lanham Act*. See Sheldon W Halpern, "The Right of Publicity: Commercial Exploitation of the Associative Value of Personality" (1986) 39 *Vanderbilt Law Review* 1199, 1242 ("Indeed, confusion exists about the nature and degree of 'confusion' required to make out a Lanham Act claim.").

97 Carty, above n 76, at 108.

98 Ibid 109.

99 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.

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 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] Courts in Singapore have not had the occasion to consider this issue.

What this episode illustrates is the commercial potential that social media platforms bring to brands that are seeking to engage with consumers and audiences in myriad ways. Both individuals and companies alike are leveraging social media, using Facebook and Twitter in particular to reach out to more fans, audiences and consumers. The individuals seek to become famous, and companies seek to become popular with consumers. These legal developments in the US, especially with the *Fraley* and *Heigl* litigation, signal a broader interpretation of what fame means in the 21st century and how the commercial value of fame may be exploited online.

IV CONCLUDING COMMENTS – OVERLAPPING IMAGE RIGHTS AND DATA PROTECTION RIGHTS

Back in 1960, when he formulated the four-torts privacy framework, William Prosser had warned that this overlap is "an area in which one must tread warily and be on the lookout for bogs."[104] For celebrities who actively seek fame through the attention of the media, courts were often unwilling to accept that the unauthorised commercial use of the identity of a celebrity public figure had invaded the right to be let alone.[105] Confronted with the economic value ascribed to the celebrity personality, US courts have created a separate tort of right of publicity, which can sometimes be confused with the

---

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

101 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. 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 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 F W Grosheide and J J Brinkhof (eds), *Intellectual Property Law: Articles on Crossing Borders Between Traditional and Actual* (2005) 331, 338.

104 Prosser, above n 27, at 407-408.

105 Eg *Paramount Pictures Inc v Leader Press, Inc*, 24 F Supp 1004 (1938); *O'Brien v Pabst Sales Co*, 124 F 2d 167 (5th Cir, 1941); *Gautier v Pro-Football, Inc*, 107 NE 2d 485 (1952).

tort of appropriation of personality under the rubric of invasion of privacy. Following the decision in *Haelan Laboratories*,[106] Melville Nimmer explained that the right to privacy provided insufficient protection for the commercial value of one's identity because it focused on prevention of feelings of indignity and embarrassment that are often not present in cases involving celebrities and that this new right should more appropriately be an assignable property right.[107]

A majority of US state jurisdictions today have affirmed the right of publicity. It is accepted in many US states that the right of publicity is an assignable property right in contrast to the non-assignable personal right of privacy. Unfortunately the courts have not resolved the overlap between the publicity right and the appropriation tort under the invasion of privacy, often preferring to declare summarily that whether the right is denominated publicity or privacy, "it stems from [the court's] recognition that an individual has the right to control the use of his own name and image and the publication of information about himself."[108]

Despite the differences in the types of damages that may be recovered, the elements of the publicity tort and the appropriation of personality (privacy) tort are largely similar. [109] In practice, a celebrity will commence a right of publicity action in jurisdictions where the right is recognised, while a non-celebrity is more likely to assert a privacy claim when his or her identity has been appropriated. In a right of publicity action, the measure of damages is focused on the pecuniary loss to the celebrity or the unjust pecuniary gain to the defendant; in an appropriation tort for invasion of privacy, the plaintiff can recover for mental or emotional distress and suffering, in addition to pecuniary loss. [110] Liability in both cases is based on misappropriation rather than misrepresentation, thus proof of deception or consumer confusion is not required.[111] In Commonwealth common law jurisdictions like Singapore and the UK, plaintiffs can seek recourse under the tort of passing off which appears to protect against commercial exploitation of one's identity in the lacuna that personal data protection legislations do not cover.

In Singapore, even the tort of defamation may offer a remedy for commercial appropriation of a valuable identity. In *Chiam See Tong v Xin Zhang Jiang Restaurant*

---

106 202 F 2d 866 (2nd Cir, 1953).

107 Melville Nimmer, "The Right of Publicity" (1954) 19 *Law & Contemporary Problems* 203.

108 *Carson v National Bank of Commerce Trust and Savings*, 501 F 2d 1082, 1084 (8th Cir, 1974).

109 *Doe*, 110 SW 3d 363, 368-69 (Mo, 2003). See also comments by Howard I Berkman, "The Right of Publicity-Protection for Public Figures and Celebrities" (1976) 42 *Brooklyn Law Review* 527, 534-41.

110 *Restatement (Third) of Unfair Competition* § 49 (1995). See, eg, *Bear Foot, Inc v Chandler*, 965 SW 2d 386, 389 (Mo App, 1998); *Haith v Model Cities Health Corp of Kansas City*, 704 SW 2d 684, 688 (Mo App, 1986). Since the appropriation tort falls under the rubric of privacy, it applies regardless whether the plaintiff's name is used for commercial *or* non-commercial advantage.

111 *Rogers v Grimbaldi*, 875 F 2d 994, 1003-4 (2nd Cir, 1989). In this respect, the right of publicity differs from trademarks in that there may be liability despite there being no likelihood of confusion as to source or connection by way of endorsement or sponsorship. See *Motschenbacher*, 498 F 2d 821, 826-7 (9th Cir, 1974); *Waits*, 978 F 2d 1093, 1102 (9th Cir, 1992); *Elvis Presley Enterprises, Inc v Capece*, 950 F Supp 783, 801 (ND Tex, 1999).

Pte Ltd,[112] Chiam, a prominent politician in Singapore, and his Singapore Democratic Party supporters had a birthday dinner celebration for him at the defendant restaurant. At the dinner, Chiam sang at a karaoke singing competition organised by the defendant to raise funds for charity. On 24 June 1992, the defendant's advertisement appeared in *The New Paper*. The court found that: "About 95% of the advertisement referred to the restaurant, what it was offering to customers, the menu and the set meals. It was an advertising puff."[113] However, the advertisement also contained a photograph of Chiam holding a microphone, and next to him was a caption in Chinese and a caption in English. The Chinese version mentioned that "Member of Parliament Chiam See Tong's single song "Rong Shu Xia" raised $1,000." On the other hand, the English version stated: "Charity/Fund collection/Community Chest Activity Dedication Songs are welcome." The judge held that:

> In that way and to the English non-Chinese reader, the plaintiff was delinked from the charity event under reference. … An ordinary reader in English, who did not read Chinese, of that page of the *New Paper* would conclude that the plaintiff was making a commercial announcement for the defendants. … [The defendants] deliberately made use of the photograph of the plaintiff and his popularity as a Member of Parliament in such a way in the advertisement that his purpose was to promote the defendants" business as a restaurant.[114]

If the PDPA were in effect back in 1992, this publication of Chiam's photograph would not have been a breach of the PDPA. If Chiam had sought a remedy for damages under passing off, he would likely have succeeded in proving a misrepresentation of his approval or endorsement of the defendant restaurant. However, despite the commercial advantage gained by the defendant, Chiam's claim was for an injury inflicted upon his *dignitary* – as opposed to commercial – interests; his contention was that his reputation has been besmirched by the advertisement. The court agreed that "all three advertisements were defamatory of the plaintiff and that to the ordinary English reader, who did not read Chinese, the photographic portrait suggested that the plaintiff had consented to the use of his photograph for publicity either for gain or to sponsor a private restaurant and that he had done so by taking advantage of his position as a Member of Parliament and also for the benefit of promoting himself as an advocate and solicitor."[115] The court awarded $50,000 to Chiam "to repair the reputation and status of his high office as Member of Parliament and to compensate [him] for his anguish and hurt feelings."[116]

In summary, even though the right of publicity is not recognised in Singapore, the tort of passing off – and possibly even an action in defamation in exceptional circumstances – can offer robust protection for commercial exploitation of one's identity in advertising and selling. Securing consent to being photographed at an event or photographing an individual in a public place does not give one carte blanche to publish

---

112 [1995] 1 SLR(R) 856, [1995] SGHC 109.
113 [1995] 1 SLR(R) 856 at [3].
114 Ibid.
115 Ibid at [7].
116 Ibid at [11].

such personal data when it is tantamount to commercial exploitation.