



The sale by Topshop of Rihanna t-shirt does amount to passing off - Court of Appeal upholds High Court decision

The Court of Appeal has unanimously upheld the High Court decision that the sale by Topshop (part of the Arcadia Group) of a t-shirt displaying an image of Rihanna amounted to passing off ([2015] EWCA Civ 3).

Background

The image used by Topshop was a photograph taken by an independent photographer during the video shoot for her single “We Found Love” from the 2011 album “Talk That Talk”. Topshop obtained a licence from the photographer (as the owner of the copyright), but had not asked Rihanna for permission to use the image.

The High Court was keen to impress at the outset that the case was not concerned with “image” or “personality” rights. Referring to *Douglas v Hello* ([2007] UKHL 21), Birss J confirmed that there was “no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image”. The case was an action for passing off in which (1) goodwill, (2) a misrepresentation likely to deceive and (3) damage must be proven.

Specifically, Birss J emphasised the need for there to be a misrepresentation about “trade origin”. If customers buying a t-shirt simply wanted to buy an image of Rihanna then no misrepresentation will have taken place. However, if goods are sold in circumstances in which purchasers understand there to be a representation that the goods are authorised, “official” merchandise when they are not then this could amount to a false representation sufficient for passing off. The finding therefore depended on the nature of the relevant market and on the perceptions of purchasers.

The High Court’s reasoning

In finding for Rihanna, Birss J concluded that the mere sale by a trader of a t-shirt bearing an image of a famous person would not, without more, be an act of passing off. However “the sale of this image of this person on this garment by this shop in these circumstances” was a different matter and Topshop’s sale of the t-shirt without Rihanna’s approval amounted to passing off.

Goodwill

Specifically, in the context of goodwill, Birss J found that Rihanna was and is regarded as a “style icon” and the scope of her goodwill was not only as a music artist but also in “the world of fashion”. In this context, the fact that the t-shirt was a fashion led garment (as opposed to a more basic pop star merchandising style t-shirt) would not rule out the idea that she had endorsed the t-shirt.

Misrepresentation

With regard to the more difficult question of misrepresentation, nothing on the labelling suggested that Rihanna had authorised the t-shirt (her name and signature “R” slash logo had not been used); nor was there evidence of any actual confusion. However, crucially, the nature of the protagonists led Birss J to conclude that purchasers were likely to be deceived:

- **The fact that it was Topshop mattered.**

Birss J found that the links between Topshop and famous stars in general (such as Kate Moss), and more importantly their prior public associations with Rihanna, would enhance the likelihood in the purchaser’s mind that the t-shirt was authorised.

- **The fact that Rihanna was a “style icon” and the photograph was taken in the context of an album and video shoot mattered.**

The image was not just an image of Rihanna. It looked like a publicity shoot and, to her fans, may look like part of a wider marketing campaign. Birss J accepted that a good number of purchasers might buy the t-shirt without giving the question of authorisation “any thought at all”, but a substantial portion of those considering the product (namely Rihanna fans) would be induced to think it was authorised (which would be part of what motivated them to buy the t-shirt).

Damage

Having found that there had been a misrepresentation, damage followed - both in terms of sales lost to Rihanna’s merchandising business and her loss of control over her “reputation in the fashion sphere”.

The Appeal

Topshop appealed the High Court's decision on four grounds, all of which were rejected by the Court of Appeal (Kitchen LJ giving the leading judgment):

- Topshop argued that the judge wrongly proceeded on the basis that there was no difference in law between an endorsement case and a merchandising case (i.e.; that merchandising carries with it no misrepresentation – people would buy the t-shirt simply because it had a picture of Rihanna, not because they believed that Rihanna was connected to it). The Court of Appeal disagreed. It found that Birss J had given due regard to the distinction and, on the facts, reached the conclusion that this particular t-shirt with this particular image amounted to a representation that Rihanna had endorsed it.
- Second, Topshop argued that because Rihanna could not control the use of her image in general, the use of a particular image could not give rise to a misrepresentation. The Court of Appeal was unwilling to entertain this argument.
- Nor was it impressed by Topshop's third line of appeal (that the judge "ought to have assessed the claim having regard to the perceptions of those persons for whom the presence of the image of Rihanna on the t-shirt was origin neutral, and not the perceptions of those persons who were liable to regard the presence of the image as an indication of authorisation"). It considered this argument to be "misconceived" in that it would involve the Court shutting its eyes to the reality. It was "plainly relevant" to consider potential customers who were both fans of Rihanna and prepared to shop in Topshop and the judge was "bound to consider and take into account the activities of Topshop in publicising and promoting its connection with Rihanna".

- The fourth argument was a technical one about the way the case was pleaded and criticisms of the evidence filed in support (which included opinion evidence given by a lay witness). Whilst the Court of Appeal had some sympathy with the latter criticism, it did not impact upon the overall conclusion reached.

Of more interest were the comments made by Underhill LJ in support who noted that the case was "close to the borderline" and essentially turned on two things which, taken together, were key – (1) Rihanna's prior association with Topshop and (2) the nature of the image itself.

Conclusion

This case is a reminder that there is no codified law which protects "image rights" in the UK. Whether a passing off action can succeed comes down to whether, in the circumstances, there has been a misrepresentation as to origin. Each case will very much turn on its facts and the nature of the parties, their prior dealings and the nature of the image itself are all crucial factors.

Contacts

The author Emily Roberts is a specialist in IP Disputes working with Jeremy Dickerson.



Jeremy Dickerson
Partner

+44 (0) 117 902 2728

jeremy.dickerson@burges-salmon.com



Emily Roberts
Senior Associate

+44 (0) 117 902 2793

emily.roberts@burges-salmon.com

Burges Salmon LLP, One Glass Wharf, Bristol BS2 0ZX Tel: +44 (0) 117 939 2000 Fax: +44 (0) 117 902 4400
6 New Street Square, London EC4A 3BF Tel: +44 (0) 20 7685 1200 Fax: +44 (0) 20 7980 4966

www.burges-salmon.com

Burges Salmon LLP is a limited liability partnership registered in England and Wales (LLP number OC307212), and is authorised and regulated by the Solicitors Regulation Authority. It is also regulated by the Law Society of Scotland. Its registered office is at One Glass Wharf, Bristol BS2 0ZX. A list of the members may be inspected at its registered office. Further information about Burges Salmon entities, including details of their regulators, is set out in the 'Who we are' section of the Burges Salmon website at www.burges-salmon.com.

© Burges Salmon LLP 2015. All rights reserved. Extracts may be reproduced with our prior consent, provided that the source is acknowledged. Disclaimer: This briefing gives general information only and is not intended to be an exhaustive statement of the law. Although we have taken care over the information, you should not rely on it as legal advice. We do not accept any liability to anyone who does rely on its content.

Data Protection: Your details are processed and kept securely in accordance with the Data Protection Act 1998. We may use your personal information to send information to you about our products and services, newsletters and legal updates; to invite you to our training seminars and other events; and for analysis including generation of marketing reports. To help us keep our database up to date, please let us know if your contact details change or if you do not want to receive any further marketing material by contacting marketing@burges-salmon.com.