From 'ABBA' to Gould: A closer look at the development of Personality Rights in Canada

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The commercial exploitation of the names and images of famous personalities, living and deceased, has become a highly lucrative practice in the 1990s. Key to the marketing potential of personality is the link in a consumer's mind between the celebrity and the product that he or she endorses.[1] The potential earnings from such exploitation of a celebrity's name or identity are almost unlimited with current advances in mass media information and communication technology. The emerging threat of unauthorized usurpation of personality rights has elicited concern regarding the uncertainty of the law protecting celebrity rights in Canada. When compared to the U.S., the intellectual property rights attached to living or deceased personalities in Canada have traditionally been less developed and adjudicated.

Recently, however, the situation has changed significantly. Three leading Ontario judgements and a Supreme Court of Canada decision have further developed the law relating to personality rights in Canada.[2] The disputes in these cases tend to focus on two central themes. The first is the balancing of the celebrity's right to control all uses of his or her persona against society's interest in free expression. The second is characterizing the action as a proprietary rather than a personal right such as privacy or libel. How much protection should be extended to celebrities or legates of the celebrity, where the impugned activity deals with thoughts, ideas, newsworthy events or matters of public interest? What is the current position on the tort of appropriation of personality in Canada, in light of the recent Ontario Court (General Division) and Appeal Court decisions in *Gould Estate* v. *Stoddart Publishing*[3] and that of the Supreme Court of Canada in *Les editions Vice-Versa* v. *Aubry*[4]? This essay will outline the development of the existing law in relation to personality rights in Canada, along with an analysis of the current trend in this field following the two leading cases, *Gould* and *Aubry*.

Development of Personality Rights in Canada

With relatively few exceptions, intellectual property is governed by federal law in Canada.[5] Federal statute law regulates patents, trademarks, copyright, moral rights, industrial designs and topography rights. The only provincially regulated aspects of intellectual property are the common law torts of passing off, appropriation of personality and confidential information, and the statutes in a few of the provinces[6] concerning privacy, including person-

1 Howell, Robert G. "Publicity Rights in the Common Law Provinces of Canada", 18 Loyola of Los Angeles Entertainment Law Journal 487.
2 *Gould Estate* v. *Stoddart Publishing* [1996], 15 Estates and Trusts Reports (2d) 167, hereinafter cited as "*Gould 1996*"; *Gould Estate* v. *Stoddart Publishing* [1998], 321 Dominion Law Reports (4th) 161 (Ontario Court of Appeal), hereinafter cited to Dominion Law Reports as "*Gould 1998*"; *Athans* v. *Canadian Adventure Camps Ltd. et al* [1977], 17 Ontario Reports (2d) 425, 80 Dominion Law Reports (3d) 583 (Ontario High Court), hereinafter cited to Dominion Law Reports as "*Athans*"; *Krouse* v. *Chrysler Canada Ltd. et al*, [1974] 1 Ontario Reports (2d) 225, 1974 40 Dominion Law Reports (3d) 15 (Ontario Court of Appeal); hereinafter cited to Dominion Law Reports as "*Krouse*".
3 *Gould 1996* and *Gould 1998*, See above.
4 *Les editions Vice-Versa* v. *Aubry* [1998], 1 Supreme Court Reports 591, 577 Dominion Law Reports (4th) 157; hereinafter cited to Dominion Law Reports as "*Aubry*"
5 The Copyright Act, Revised Statutes of Canada 1985, chapter C-42.

ality rights.[7] Traditionally, aggrieved celebrities seeking a remedy for an unauthorized appropriation of their persona have looked to the tort of passing off, registered trademarks, or legal protection of privacy under the provincial statutory torts of privacy.[8]

The statutory rights to privacy are primarily based on the protection of solitude and seclusion.[9] A privacy injury, as compared with an injury to publicity, is defined as, "the nature of infliction of mental suffering from a violation of seclusion."[10] An invasion of publicity rights, on the other hand, is an economic injury flowing from an unauthorized use of an asset.[11] It is unclear whether the statutes safeguard both privacy and publicity rights, or favour the protection of one over another. It has been argued that since there is a provision which extinguishes all statutory rights upon the death of the person whose privacy has been violated, this is more consistent with a protection of privacy.[12] The lack of judicial interpretation of the statutes makes the scope of statutory privacy protection uncertain and unpredictable.

Passing off actions and protections under trademark law do not provide complete immunity for celebrities wishing to safeguard their persona. Passing off is primarily a proprietary action, protecting the "business and goodwill" of the plaintiff.[13] The main requirement under the tort of passing off is the need to show an active misrepresentation that forseeably causes the public to be confused as to some association between the plaintiff's product and the defendant.[14] The problem for celebrities seeking to use this tort as a remedy for an appropriation may come with the strict test involved in the operation of the tort. The test, simply put, is that the parties must be in a common field of activity for the misrepresentation to be factual. Many celebrities are rarely, if ever, in the same field of activity as a supplier of the product marketed by use of the celebrity's personality, severely limiting passing off as a remedy for celebrities.[15] Additional difficulties for celebrities wishing to proceed under the tort are perhaps best highlighted by the case of *Lyngstad* v. *Anabas Products Ltd*, where the musical group ABBA was unable to obtain relief under the

6 British Columbia, Manitoba, Saskatchewan, Newfoundland and Civil Code protection in Quebec. Revised Statutes of British Columbia 1979 chapter 336, Revised Statutes of Saskatchewan 1978, chapter P-24; Revised Statutes of Manitoba1987, chapter P-125; and Statutes of Newfoundland 1981, chapter 6.

7 David Vaver, *Intellectual Property Law: Copyrights, Patents and Trade-marks* (Concord: Irwin Law, 1997) at 1-5.

8 See note 1 at 490-491.

9 British Columbia has added to the right to privacy and has created two separate torts: invasion of privacy and appropriation of personality. See note 1 at 7.

10 Robert G. Howell "The Common Law Appropriation of Personality Tort" (1986) Intellectual Property Journal 149 at 153-155.

11 See above.

12 This argument is based on the U.S. examples dealing with privacy rights, where it appears that privacy as a personal right is non-assignable and terminates upon death, *Lugosi* v. *Universal Pictures*, 603 Pacific 2d 4 25 Supreme Court of California (1979). See above at 161.

13 Smyth Lyons, "Legal Issues in the Creation, Management and Exploitation of Computer Databases". Found at http://www.smithlyons.ca/it/cme/pcs.htm on, November 1, 1998.

14 Howell, see note 1 at 490.

15 See the 'common field of activity' test originated in *McCulloch* v. *Lewis A. May Ltd.* [1947] 2 All England Reports 845 (House of Lords), though it was discredited in *Annabel's Ltd* v. *Schock* [1972] Reports of Patent Cases 838 (English Court of Appeal).

tort.[16] Recently, the test for passing off has become increasingly flexible. In *National Hockey League* v. *Pepsi-Cola Canada Ltd.,* Justice Harding of the British Columbia Supreme Court found that it is the product or business of the defendant that must be seen to be "approved, authorized or endorsed by the plaintiff."[17] The requirement of a misrepresentation, however, still presents a difficulty for celebrities wishing to proceed under this tort. At the same time, trademarks are difficult and expensive to establish, and have the additional capability of being challenged and struck out.[18] These inadequacies in alternate remedies led to the recognition and growth in the importance of personality rights at the common law level.

Personality rights in Canada, then, have come to be primarily protected by the tort of "appropriation of personality."[19] At common law, this tort has been seen as covering a person's commercial right to use their celebrated status as a source of income, or their "right to publicity".[20] The tort was first articulated by Justice Estey in *Krouse* v. *Chrysler Canada Ltd. et al.*[21] Estey held that the courts would be justified in finding a defendant liable for damages for appropriating a plaintiff's personality, where the appropriation amounted to "an invasion of his right to exploit his personality by the use of his image, voice or otherwise with damage to the plaintiff."[22] The tort was limited to situations in which the name or image of the celebrity was used in advertising or promotion of a defendant's product or service, so as to imply that the celebrity endorsed the activity of the defendant.

It appears that the test for determining whether or not an appropriation has occurred is whether it would appear to the public that the plaintiff was endorsing the defendant's product. There does not appear to be a need to prove that the public is confused by a misrepresentation, as in the classic test for passing off.[23] The decision in *Athans* v. *Canadian Adventure Camps Ltd. et al*, following *Krouse*, adopted a similar test focusing more explicitly on misappropriations. The Court in *Athans* recognised that the plaintiff had a proprietary right "in the exclusive marketing for gain of his personality, image and name, and that the law entitles him to protect that right, if it is invaded."[24] The judgments in both cases appear to draw a distinction between circumstances in which the personality is used in some fashion and those in which the celebrity is the subject, (i.e. as in unauthorized biographies or plays offering insight into a celebrity).[25] This was a key issue in the *Gould* case, where the court dealt more fully with the public/proprietary versus private dimension of the tort.

Gould Estate v. Stoddart Publishing

It has been said regarding the *Gould* decision that, "no common law case or statute has breathed as much potential life into [personality rights] as the 1996 Ontario Court (General Division) summary judgment of Justice Sidney Lederman in *Gould* – at least until the Ontario Court of Appeal's ruling on the appeal of that decision."[26] The *Gould* decision, aside from being the only Commonwealth case regarding descendability of personality rights, is one of the most important judgments to develop and revive the tort of appropriation of personality in Canada. The facts in both motions were as follows: In 1956 Glenn Gould, a concert pianist not yet famous, was interviewed and photographed for an article in "Weekend Magazine" by a reporter. The meeting was arranged by Gould's publicist in the interest of promoting Gould. The interview took place at various venues over an extended

16 An illustrative case, *Lyngstad* v. *Anabas Products Ltd* [1977] Fleet Street Reports 62,68 (Chancery), highlights the limitation of passing off actions. The Court, in denying relief to the musical group "ABBA," noted that in order for passing off to provide effective relief, the element of association would need to be diminished in content to the level that the public believed that ABBA had given consent to have the group's image on the defendant's products. As quoted in Howell, see note 1 at 499-500. This same type of test was later adopted in Australia in *Pacific Dunlop* v. *Hogan* [1989] 87 Australian Law Reports 14, 45-46 (Federal Court of Australia); hereinafter cited as "Hogan."

17 *National Hockey League* v. *Pepsi-Cola Canada Ltd.* [1992] 42 Canadian Patent Reporter (3d) 390 as quoted in Howell, see note 1 at 501. This test built on the formulation in *Paramount Pictures Corporation* v. *Howley* [1991] 5 Ontario Reports (3d) 573, which adopted the Australian decision in *Hogan*, see above.

18 See note 16 at 26.

19 Michael D. Andrews and Angela Fulanetto, "Canada Strengthens Rights in Personality," Law Journal Extra (March 1997). Found at http://www.ipww.com/mar97//p25canada.html on November 1, 1998. Hereinafter cited as "Law Journal Extra."

20 See note 1 at 488.

21 See note 2.

22 See above at 238.

23 See note 1 at 493.

24 Law Journal Extra, see note 19 at 1.

25 See note 2 at 167.

26 Elise Ornstein, "Gould rulings leave personality misappropriation muddled" The Lawyers Weekly (11 September, 1998) at 9. Hereinafter cited as "The Lawyers Weekly."

period of time. The journalist used informal settings and recorded some of their conversations, while also taking 400 photos of Gould in various poses. Certain photographs and comments were used in the article. About 40 years later, the journalist decided to publish a book using 70 of the photographs from the 1956 interview, as well as drawing heavily on the recorded conversations. The estate claimed unsuccessfully for alleged infringement of copyright.

The reporter Carroll was held to be the owner of copyright in the photographs and the notes he had made. The estate alleged that the use of the photos constituted the tort of appropriation of personality. At trial, the issue, as articulated by Justice Lederman, was whether Gould had "any proprietary rights in his image, likeness or personality which had been appropriated by the publication of the photographs in the book."[27] Neither Gould, nor his estate, were at the time of his death or in the following 14 years publicly making use of Gould's persona. In fact, Gould was well known as a recluse who preferred to stay out of the limelight. This raised the question of whether the tort was capable of protecting what was in essence Gould's right to privacy. The loss was essentially a violation of his seclusion.

The tort had already been applied in a merchandising context in *Athans* and *Krouse*, but could it be extended to non-merchandizing or a privacy context? The Court decided that it was open for it to decide to limit the tort on a contextual basis to the merchandizing sphere, on the basis that all previous cases dealt with an appropriation in the merchandizing context.[28] Professor Howell has noted that this may overlook another case dealing with this issue, *Dowell* v. *Mengen*, where the Ontario High Court recognized the tort in a non-merchandizing context.[29] The potential privacy element of this tort had thus been left open for future cases to decide. The Court in *Gould* preferred to deal with the matter as one of public interest.

The claim by the Gould estate was denied. Echoing the concerns of Justice Estey in *Krouse*, the Court agreed that the right of personality should be limited by balancing the scope of the individual's right of publicity against the societal interests in free expression.[30] This is to be accomplished by examining whether the use of the celebrity's property predominantly serves a societal function valued by the protection of free speech or merely constitutes a commercial exploitation of the celebrity's persona.[31] The Ontario Court of Appeal agreed with the disposition of the case but based its decision on conventional principles relating to copyright[32] and refrained from addressing the case on the basis of the breach of publicity rights, preferring to rule on the basis of public interest in free expression.[33]

Howell, drawing from the principles articulated in *Krouse* and from the decisions to date, has classified the basic elements necessary to the current successful maintenance of an action in the tort of appropriation:

1. The plaintiff must be identified in the depiction.
2. The usage made by the defendant of the plaintiff's persona should be more than incidental or *de minimis*.
3. There is no express requirement of an intent to misappropriate, but all cases to date in Canada have involved intentional conduct.

27 See note 2 at 171.
28 See above at 175.
29 See note 1 at 495.
30 Undeniably the U.S. prefers much stronger protection of celebrity personality rights, and this influence seems to have permeated some of the underlying rationale of the Canadian provincial statutes protecting the right to privacy, and informed some common law decisions on this subject. The growing importance of personality rights, especially in the field of character merchandizing, is evidenced by the increasing amounts of litigation worldwide and certainly there is an interest in maintaining uniformity of law globally for all countries.
31 See note 26 at 9.
32 The defendant owned the copyright in the photographs and the tape-recorded words, so there was no need to proceed further on other issues.
33 See note 26 at 9.

4. There must be damage.[34]
5. There must not be a public interest in publicity that would counter any action for misappropriation.[35]

This, however, is a mere list of factors a court is likely to consider in rendering its judgment, and is not to be taken as a matter of settled law. Had the decision in *Gould* been argued at the Supreme Court of Canada, it would have introduced certainty into this common law area. To complicate matters further, following the decision in *Aubry*, it appears that in a privacy context (under the Quebec Charter), the level of protection afforded is greater than the level of the publicity protection currently available under the common law tort of appropriation of personality. This results in two contrasting levels of protection for publicity/privacy rights within a single country.

Les Editions Vice Versa Inc. v. Aubry

In *Aubry*, the respondent brought an action in civil liability against the appellants, a photographer and publisher of a magazine, for taking and publishing a photograph of the respondent sitting on the steps of a building. The photograph was taken in a public place and was published without the respondent's consent. The trial judge held that the unauthorized publication of the photograph constituted a violation of privacy and ordered the appellants to pay $2,000 jointly and severally. The majority at the Quebec Court of Appeal affirmed the decision.[36] The Supreme Court of Canada upheld the judgement and dismissed the appeal. The majority held that if the purpose of the right to privacy under section 5 of the Quebec Charter is to protect a sphere of individual autonomy, it must include the ability to control the use made of one's image.[37]

The Supreme Court of Canada recognized the conflict with the right to freedom of expression, protected by section 3 of the Quebec Charter, but held that this is a question that depends on the context of the situation. In *Aubry,* the context was establishing a balance between the subject's right to privacy and the alleged public interest in publishing the photograph. Thus, the Court concluded that an artist's right to publish is not absolute and cannot include the right to infringe, without any justification, on the rights of the subject of the work. The injured party need not be a celebrity. They must merely demonstrate that there was no sufficient public interest, in the publishing of a work, to which they did not consent, using the injured party's image, conversations or performances.[38] In order to claim for damages, however, it seems the plaintiff must show some proof of prejudice resulting from the publication.

This decision has ramifications in Quebec, and in the rest of Canada, if followed in the common law provinces. In Quebec, it extends the protection of personality to a non-merchandizing and non-celebrity context. Whether such an extension is sensible is highly debatable. One important concern might be the tremendous potential for a flood of litigation. For example, any person wishing to reproduce a photograph of any individual, celebrity or not, without getting consent from each and every person in every photograph, would be liable for loss of privacy. Regardless of the consequences of this decision, there is no doubt that the Supreme Court of Canada has now created two distinct approaches to personality rights in Canada. Individuals in Quebec, whether celebrities or not, are seem-

34 In *Krouse*, see note 2, damage was held to be whether the prospects of the plaintiff selling his endorsement to other sources had been lost or diminished and if so the quantum of such a loss. In *Athans*, see note 2, the formulation was the amount the plaintiff "ought reasonably to have received in the market for permission to publish the drawings" as quoted in Howell, see note 10 at 179.

35 See note 1 at 494-495.

36 See note 4 at 591.

37 See above.

38 See above at 591-593.

ingly entitled to stronger protection of their right to privacy, and perhaps publicity, than those in the rest of Canada.

Conclusion

Celebrities wishing to restrain publication of photographs and statements collected during interviews and private appearances cannot rely on the current scope of personality rights in Canada. In light of the decision in *Gould,* which emphasized the perspective of copyright rather than personality rights of the subject, and given the onerous requirements of trademark law and the narrow interpretation of rights under the tort of passing off, famous individuals should establish express limitations to the use of these materials. The tort of appropriation of personality is still a relatively recent development and will require more time to evolve. There is still no clear consensus as to the parameters of this tort at common law. Issues left unsettled by the law include whether the tort incorporates privacy protection in addition to the proprietary protections against unauthorized merchandizing and whether the tort extends to the context of non-merchandizing appropriation. Both unresolved issues create a great uncertainty in the law.

The decision of the Supreme Court of Canada in *Aubry* may considerably influence the future growth of this tort. The decision appears to extend the scope of personality rights significantly. The context of the decision, however, was limited to the Quebec Charter and did not specifically evaluate the common law personality rights in the rest of Canada. Therefore, the decision is not readily applicable to the common law provinces in Canada.

The current position in Canada remains uncertain. It is difficult to piece together the complex case law to summarize the extent to which individuals can currently protect their public and private rights under the tort of appropriation of personality. It is even more difficult to have two conflicting systems of protection within the same country. Some of the blame for the awkward development of personality rights in Canada can be placed on the courts who have been left to develop the law without much guidance.

It would greatly clarify the law in this area if the applicants in *Gould* had appealed the decision to the Supreme Court. Furthermore, a greater development of the "public interest test" (the balance to be established between the protection of persona and public right to freedom of expression) would also enhance the clarity and predictability of the publicity rights currently enforced. As it stands, the decision in *Gould* should be well heeded by all Canadians outside of Quebec, or visiting celebrities, who need to be aware of the danger of not explicitly reserving the right of publicity during public conversations and appearances.