

VIEWPOINT RIHANNA VS TOPSHOP

UNDERSTANDING RIHANNA VS TOPSHOP

Annabelle Gauberti, founding partner of law firm for creative industries Crefovi, explains the law surrounding 'passing off' and what Rihanna's recent victory against Topshop means for artists



LEGAL

■ BY ANNABELLE GAUBERTI

In March 2012, Topshop started selling a t-shirt featuring a photo of Rihanna taken by an independent photographer.

Topshop had a licence to use the copyright on the image but no permission from Rihanna.

The superstar contended that the sale of such a t-shirt without her authorisation infringed her rights. Topshop did not agree.

On March 30, 2012, Rihanna filed a lawsuit with the chancery division - a part of the high court of justice that deals with intellectual property claims - against Topshop's parent company Arcadia Group and Topshop/Topman Limited.

After four days of hearing, Mr Justice Birss ruled on July 31, 2013 that the mere sale of a t-shirt bearing an image of a famous person, by a trader, is not, without more, an act of passing off. However, the sale of this image, of this person (Rihanna) on the garment, by this shop, in these circumstances, is a different matter. Mr Justice Birss ruled that Topshop's sale of this Rihanna t-shirt without her approval was an act of passing off.

In a second judgment, on 26 September 2013, Mr Justice Birss ordered Topshop to pay the performer's legal costs of almost £1 million, with an interim payment of £200,000 to be made within 14 days from the date of the judgment. In addition, he granted Rihanna an injunction to prevent any future similar wrong use of her image, imposing a permanent ban on Topshop selling these infringing t-shirts.

How did the judge reach the decision to condemn Topshop for passing off?

Passing off is an intellectual property right under English law.

To understand passing off, we need to define what goodwill is: goodwill is a form of property constituting the market perception of the value and

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ANNABELLE GAUBERTI, CREFOVI

quality of a business and its products. This goodwill can be protected against interference or damage by passing off.

Passing off is therefore a tort that may be used in preventing a trader from making misrepresentations that damage the goodwill of another trader.

There are three conditions for passing off to be established, as the judge set out in his judgment:

There must be some evidence that Rihanna has goodwill and a reputation amongst the relevant members of the public;

Topshop's conduct must be shown to make a misrepresentation - i.e. it must be likely to lead the public to believe that the t-shirts had been authorised by Rihanna therefore deceiving those members of the public into buying the product.

There must be some evidence that the misrepresentation caused some damage to Rihanna's goodwill.

According to Mr Justice Birss, these three conditions were met and therefore he ruled that Topshop had infringed Rihanna's intellectual property rights by passing off.

What implications will the case have for retailers and designers?

This is not the first time that celebrities and brands have clashed about differing views surrounding the use of image rights in a commercial context.

In 2003, Catherine Zeta-Jones took legal action against French skincare company Caudalie for running an ad campaign saying that the actress was seen buying its products, which Ms Zeta-Jones refuted. The lawsuit was filed in Los Angeles in September 2003 and I believe that the parties reached an off-court settlement some

ABOVE
Finishing on top: Rihanna was granted an injunction to prevent Topshop selling t-shirts bearing a particular photo of her taken by an independent photographer

time after.

The key finding for retailers and brands here is that they rarely win in these lawsuits in which they are defendants. And, if a brand owner or retailer were to win an intellectual property infringement case, it could still feel like a loss because of the high costs of litigation associated with the lawsuit and the reputational damage that they will invariably suffer.

Retailers and designers must run by their in-house or external legal teams, any "creative" project involving a "homage" to, or "quasi-endorsement" by another artist, creative person or brand. Legal checks and clearance processes need to be done before any product is launched in the market.

What implications will the case have for music artists, their managers and labels?

Music artists, especially those who have signed endorsement and merchandising deals with brands, need to emulate Rihanna by adopting a systematic approach against non-authorised brands using their image and personality rights.

Represented by an apt and reactive lawyer - who needs to first check all the facts and that the legal requirements for violation of image rights have been met - artists should not hesitate to send a cease-and-desist letter to the infringing brand. In this letter, artists and their legal representatives could refer to passing off - if the infringement is happening in England and Wales - or other types of legal arguments - if the infringement is happening in other jurisdictions - that are customarily used in cases of violation of image and personality rights.

The quicker an artist and their lawyer react to the infringement by sending a cease-and-desist letter, the higher the probability of success in court, should the infringing brand refuse to quickly discontinue the sale of the infringing products and/or provide some damages to the musical artist, whose image and reputation have been tarnished by that brand's actions.