

## Rihanna Topshop & passing off: a love/hate relationship | London law firm for creative industries Crefovi

by Crefovi - Sun, Aug 04, 2013

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**Jeff Randall interviewed Crefovi's founding partner, Annabelle Gauberti, during his live show on Sky News, on 31 July 2013, the**

**day on which the [court judgment Rihanna vs Topshop](#) was made public.**

**As Jeff's interview was really short and snappy, Annabelle did not get a chance to say what she thought was important about this court decision, as far as the protection of celebrities' personality rights is concerned.**

[Rihanna v Topshop lawsuit](#) from [Annabelle Gauberti](#).

Here are the three questions that I was asked to prepare answers to, before the interview:

1. What was Rihanna's problem with Topshop?
2. Is image copyright an issue that many celebrities have to deal with?
3. What implications will the case have for retailers and designers?

[YouTube Video](#)

## 1. What was Rihanna's problem with Topshop?

Topshop, a well-known fashion retailer, started selling, in March 2012, a t-shirt with an image of Rihanna, the worldwide famous pop star, on it.

The image was a photograph taken by an independent photographer. Topshop had a licence to use the copyright on the image from the photographer but no licence from Rihanna.

Rihanna contended that the sale of such a t-shirt, without her permission, infringed her rights. Topshop did not agree.

Rihanna, as well as her companies Roraj Trade LLC and Combermere Entertainment Properties, LLC filed a lawsuit on 30 March 2012 with the [chancery division](#), a part of the high court of justice which deals with intellectual property claims, against Arcadia Group, parent company of Topshop, and Topshop/Topman Limited.

After four days of hearing, on 17, 18, 19 and 23 July 2013, judge Mr Justice Birss ruled on 31 July 2013.

The judge ruled that the mere sale, by a trader, of a t-shirt bearing an image of a famous person 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. [He ruled for the claimants.](#)

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

From the outset, judge Mr Justice Birss stated that the case was not relating to so-called "image rights".

He confirmed the case law, which firmly applies in England, that there is no free standing general right by a famous person to control the reproduction of their image, or "image rights".

In addition, according to the judge, there was no issue, here, about law of privacy or breach of Rihanna's privacy.

Further to these preliminary comments, Mr Justice Birss explained that the case was concerned with 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 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 which damage the goodwill of another trader.

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

- Some evidence that Rihanna has goodwill and a reputation amongst the relevant members of the public ;
- Topshop's conduct complained of must be shown to make a misrepresentation, i.e. is likely to lead the public to believe that the t-shirts had been authorised by Rihanna and therefore deceiving those members of the public into buying the product ;
- Some evidence that the misrepresentation caused some damage to Rihanna's goodwill.

Now, let's apply those conditions to the facts, as Mr Justice Birss did, in his decision of 31 July 2013.

## **2.a. Goodwill**

There is no doubt that Rihanna has a world-famous reputation. Through her companies, she runs a very large merchandising and endorsement operation.

For example, she has, or used to have, endorsement agreements with the likes of Nike, Gillette and Clinique. Her vast merchandising business is managed by Live Nation, which paid a hefty sum for the right to put Rihanna's image on t-shirts.

In addition, Rihanna is very fashion conscious and oriented, having done collaborations with Gucci in 2008, Armani in 2011 and 2012, which produced two capsule collections. In 2012, she entered into an agreement with River Island, to design clothes.

Rihanna has ample goodwill to succeed in a passing off action.

## **2.b. Misrepresentation**

Demonstrating that Topshop had done some misrepresentation was the (slightly more) difficult aspect of this lawsuit.

It is true that the fashion garment on which Rihanna's image appeared did not set out the words "Rihanna" or her logo "R".

However, the judge found that Topshop's actions gave the impression that the t-shirt, and the use of Rihanna's image on it, was authorised.

The photograph on which the image is based was taken during the video shoot of "We found love" for Rihanna's 2011 "Talk that talk" album.

Rihanna's fans will recognise, or think they recognise, this particular image of Rihanna, in a particular context, which is her "Talk that talk" album. For those fans, the idea that the image is authorised will be part of what motivates them to buy the product.

Many will buy the product because they think she approved of it. Other will wish to buy the t-shirt because of the "value of the perceived authorisation itself". In both cases, they will be deceived.

Therefore, Mr Justice Birss ruled that a misrepresentation was being made by Topshop.

## **2.c. Damage**

Such misrepresentation creates a false belief that the t-shirt has been authorised by Rihanna herself.

That will be obviously damaging to the claimants' goodwill because of the sales lost to Rihanna's merchandising business and because of the loss of control over her reputation in the fashion sphere.

Interestingly, the written and oral press have been blabbing about Rihanna suing Topshop for \$5 million, which is untrue.

I understand that neither the court papers nor the court judgment make any reference to a particular figure, at which Rihanna and her advisers would have valued her financial prejudice deriving from Topshop's misrepresentations.

Now that passing off has been confirmed by the judge, the next step for him is to assess the damages that Topshop will have to pay to Rihanna and her companies. The way such financial compensation is usually computed is by assessing the equivalent to what the celebrity in question would likely have received from the endorsement, had it been legitimate.

Furthermore, since I wrote the present article, shortly after being interviewed on 31 July 2013, I understand that the high court of justice in London ordered Topshop to pay the singer's legal costs of almost £1million, with an interim payment of £200,000 to be made within 14 days from the date of the second judgment of 26 September 2013.

In addition, Mr Justice Birss (him again!), in his second judgment, 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.

### **3. Is image copyright an issue that many celebrities have to deal with?**

This was the second question I was asked to prepare an answer to, before being interviewed by Jeff Randall on Sky News.

Image copyright is the intellectual property right that a photographer would have on his pictures.

For example, the independent photographer, who shot that picture during the making of Rihanna's video, owned such image copyright and assigned it by entering into a licensing agreement with Topshop (i.e. he got some royalties, probably a percentage on the total sales of the t-shirts by Topshop, in exchange for such copyright assignment).

Image copyright is not the intellectual property right at stake, vis-à-vis Rihanna and her companies.

What many (if not all) celebrities have to deal with is the protection of their personality rights, also known as rights of publicity or image rights. These are the rights of an individual to control the commercial use of his name, image, likeness, etc.

In common law jurisdictions, such as England, the typical route to protect those image rights is the tort of passing off.

Indeed, there is no codified regime of image or personality rights in England, such as article 9 of the French civil code in France, for example.

In England, there is therefore a need to rely on a variety of statutory and case law.

The groundbreaking case, in relation to passing off and celebrities, is the [Eddie Irvine vs Talksport case from 2002](#). Passing off was extended then, in order to allow famous people, with sufficient goodwill, to protect their names and images, if an unauthorised exploitation of these was done in a way that suggested the celebrity had endorsed a product.

### **4. What implications will the case have for retailers and designers?**

It is not the first time that celebrities and brands clash about differing views revolving around 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 time after.

Another interesting story, involving Topshop again, was its embroilment in a copying row, after up-and-coming graphic designer Kate Moross started a Twitter campaign in October 2012. Ms Moross revealed that Topman sweaters were bearing a tribal print which, she claims, in places, is identical to a design she created and sold via her website in February 2011.

The key finding for retailers and brands, here, is that they rarely win, in these lawsuits in which they are defendants. If, by extraordinary, some brand owners and retailers were to win an intellectual property infringement case, they would still loose because of the high costs of litigation associated with the lawsuit and because of the reputational damage that they will invariably suffer from.

Retailers and designers must run by their in-house or external legal teams, any “creative” project which is borderline, involving a “homage” to, or “quasi-endorsement” by, another artist, creative person or brand. Those legal checks and clearance processes need being done before any product is launched in the market, of course.

I think that the next high-profile legal battle, in the fashion sector, will revolve around the very subtle and ironic use of logos and names, of super luxurious brands such as Hermes, [Cartier](#) and Chanel, by savvy graphic designers who monetize their inventive derision by putting it on (expensive!) hooded sweaters.

To conclude about the repercussions of the Rihanna v Topshop case on the music industry, I think that musical artists, especially those who have signed endorsement and merchandising deals with brands, need to emulate Rihanna, by adopting a systematic approach against non-authorized brands using the artist’s 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, musical artists should not hesitate to send a cease-and-desist letter to the infringing brand. In this letter, musical 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), which are customarily used in cases of violation of image and personality rights.

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

*Author: Annabelle Gauberti, founding partner of the London firm for the creative industries, Crefovi.*

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