

An interesting issue thrown up by the cases is whether the special Olympic legislation was necessary to deal with 'ambush marketing' given the power of the *Trade Practices Act*. Despite the fairly complex structure of the Olympic legislation, there continued to be a requirement of conveying to the public a message of Olympic sponsorship before breach occurred. In substance, this is entirely analogous to the requirement for breach of section 52 of the *Trade Practices Act* that a misrepresentation be conveyed. Legally, therefore, it seems that it may not have been necessary to create Olympic specific causes of action. In practice, of course, the legislation may including the special causes of action have acted as a significant deterrent.

THE SHOE MANUFACTURERS

In late 1997, Reebok became the athletic footwear sponsor for the Sydney Olympic Games. As you would expect, the agreement gave Reebok exclusivity on athletic footwear although Reebok acknowledged that SOCOG might:

'...enter into sponsorship agreements with, and grant advertising, marketing and promotional rights to suppliers of sports apparel, sports footwear or sports equipment not provided by [Reebok] provided that such ... rights will be limited to the right to use a product-specific SOCOG or AOC designation in non-electronic media ...'

Two years later, Reebok purported to terminate its sponsorship agreement on the basis of alleged material breaches by SOCOG including entering into

agreements with Canterbury and Pacific Dunlop (baseball caps).

SOCOG responded that Reebok had wrongfully repudiated the agreement but it accepted that the agreement was at an end and claimed that Reebok owed it \$500,000.

Reebok struck pre-emptively by commencing litigation in late 1999 seeking declarations to the effect that it had validly terminated, damages for breach of contract and other relief. SOCOG cross claimed seeking to recover the amount allegedly owed.

Over the course of the next 12 months, the parties argued an interlocutory issue concerning access to documents and confidentiality up to the court of appeal of NSW and back again.

Reebok wanted to see the Pacific Dunlop agreement. SOCOG did not want to provide it at all and certainly not to anybody other than the external lawyers for Reebok. Reebok's response was that it at least needed to be able to get instructions from Reebok's internal lawyers. But if Reebok saw the Pacific Dunlop agreement, so SOCOG counter-responded, it would assist Reebok in ambush marketing.

Despite SOCOG's attempts at defining ambush marketing, Justice Rofe in the New South Wales Supreme Court concluded that:

'... the term 'ambush marketing', which has a pejorative ring, was intended to identify nothing more than marketing by competitors of sponsors in opposition to the sponsors, which is an everyday occurrence in commercial life'.

The Court ordered that Reebok lawyers should have access to the Pacific Dunlop agreement albeit in a redacted form (irrelevant sensitive material removed). SOCOG appealed to the Court of Appeal and the appeal was dismissed.

Reebok then revived the issue by seeking access to the Canterbury agreement not be limited to internal lawyers but expanded to allow access by nominated employees of Reebok and witnesses. At the same time, SOCOG sought documents from Reebok and its Australian subsidiary about Olympic marketing plans apparently in an endeavour to show that SOCOG's fears that access to the agreements would lead to ambush marketing by Reebok were reasonably based. The dispute about production of documents was resolved by agreed provision of certain documents.

As to Reebok's renewed request for expanded confidentiality, Justice Hunter in the Supreme Court (in what was an astute exercise of practical case management) ordered the expanded access but deferred until after conclusion of the Olympic Games.

After the conclusion of the Olympic Games, Justice Hunter made a costs order in favour of Reebok (costs of the applications be plaintiff's costs in the cause). But it is irresistible to speculate that, if not yet already settled, the proceedings will, sooner or later, settle.

The views expressed in this article are those of the author and not necessarily those of the firm or its clients.

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Corporations Law Goes Into Bat For Bradman

Hilary May Black looks at what lengths celebrities can go to in order to protect their names and images from unauthorised use and whether that protection is enough.

Australian cricketing legend, the late Sir Donald Bradman, and the non-profit organisation responsible for protecting his name and image, the Bradman Foundation, have recently been required to fend off unauthorised users. Their cause has recently been fortified by an amendment to Australia's Corporations Law which confirms Bradman's unique status amongst his die-hard Australian fans and elevates the protection of his name to a statutory level.

UNAUTHORISED USERS – A STICKY WICKET

Amongst the organisations that have recently fallen foul of the Foundation's attempts to protect the Bradman name are a number of shops operating on Adelaide's Burbridge Road, to be renamed Sir Donald Bradman Drive from January 1, 2001. Sir Donald approved the re-naming of the road. However, since that time a number of businesses have tried to take advantage of the re-

naming for their own commercial purposes. In anticipation of the name change a café on Burbridge Road registered the business name "Bradman's Café Restaurant" with plans to feature cricket memorabilia. After negotiations with the Foundation the owners have dropped plans for the cricketing theme and will identify themselves, by location, as "Bradman Drive Café Restaurant" rather than attempt to link the café with Sir Donald Bradman himself. However, the unfortunate re-naming of a sex shop

on the same road as "Erotica on Bradman" remains a problem for the Foundation.

On another front, there is a museum in Cootamundra where Sir Donald was born which has trade mark applications pending for the name "Bradman's Birthplace". The Foundation has requested that the museum withdraw its application and has entered into negotiations with the Cootamundra Council with a view to reaching an agreement whereby the museum can use the name with the Foundation's permission.

Finally, the Foundation commenced an action in the Federal Court of Australia in early October 2000 to prevent the unauthorised use of the Bradman name, associated indicia and images by the "Bradman Corporation" and associated companies such as "Bradman Building Pty Ltd" and "Bradman Cascades Pty Ltd" which operate a string of property developments in the southern highlands of New South Wales, famously associated with Bradman's early cricketing exploits.

TRADE MARKS AND TRADE PRACTICES STEP UP TO THE CREASE

Celebrities attempting to protect their names and images under Australian law are generally obliged to rely on actions under the tort of passing off or the *Trade Practices Act 1974 (Cth)* and state equivalents which attack the alleged misrepresentation of an association between the celebrity and the usurper's product or service. The value of the tort of passing off, in the protection of celebrity personality under Australian law, was established in the *Henderson Case*¹ in 1960. Here a well known ballroom dancing couple took action against the unauthorised use of their photograph on the sleeve of a dance music record arguing that the defendant's use of the photograph misrepresented a favourable connection with themselves that did not exist. The Court ordered an injunction to prevent further unauthorised use of the photograph.

However, damage resulting from the unauthorised use of a celebrity's name or image such as lost sponsorship fees or tarnished reputation are difficult to prove and quantify. Action under the *Trade Practices Act* has proven useful in this regard because, unlike the tort of passing off where actual damage must be proven, loss of an opportunity to exploit one's own personality, because of the unauthorised actions of another, has proven sufficient to ground an action for damages under the Act.² Nevertheless, cases such as

*Sue Smith*³, *Honey*⁴ and *Olivia Newton-John*⁵ indicate that the use of subtle imitations and prominent disclaimers can defeat celebrity claims relatively easily.

As a result Australian trade mark law has now also been called upon to assist in protecting celebrity names, images and signatures with a number of celebrities such as racing car drivers Jacques Villeneuve and Michael Schumacher and Olympic swimmer Kieren Perkins registering photographs of themselves. Perkins has also registered his name, signature and nickname "Superfish". The Bradman Foundation has had Sir Donald's name and signature registered since 1992 although registrations for a number of photographic images are still pending.

A measure of post-mortem protection is available under this avenue with Elvis Presley Enterprises, for example, holding registered trade marks in Australia for Elvis's name and a photograph since 1986. Although some quarters continue to express doubt as to whether Elvis did, in fact, definitively "leave the building" in 1977, pending his return, his estate is firmly in control of the use of his name and image by Australian businesses.

However, protection of celebrity personality under trade mark law is limited in a number of respects. First of all, protection only extends to the classes of goods and services for which the personality has registered the indicia of their personality such as their name or likeness. Use of the trade mark in relation to other classes of goods and services cannot be prevented by that registration unless the mark is accepted as being "well known"⁶ which may apply in the case of leading celebrity personalities.

In addition the trade mark must be used as a trade mark. For example, in the *Rolling Stones Case*⁷ the Federal Court held that the use of the words "Rolling Stones" on the cover of an unauthorised recording of the band did not infringe the registered trade mark "Rolling Stones" because the packaging of the recording carried a bold disclaimer making it plain that the recording was unauthorised. In these circumstances the use of the words "Rolling Stones" on the cover were merely descriptive of its contents.

Trade mark registration is not a realistic option for emerging personalities or those whose fame is likely not to be enduring. The initial costs of trade mark registration, the complexities of the registration process, the time involved in obtaining registration and the organisational and financial infrastructure required to maintain its use means that it is only of practical use to relatively well established celebrities.

Finally, celebrity owners of a registered trade mark cannot use the fact of registration as a platform from which to issue what may ultimately be groundless threats against unauthorised users of the celebrity's name or image. Since a threat to bring legal proceedings for infringement of a trade mark may have severe commercial ramifications for the alleged infringer⁸ the *Trade Marks Act*⁹ specifically prevents trade mark owners from issuing threats of legal action where they are unable to substantiate their claim.

AUSTRALIAN LAW DUCKS A RIGHT OF PUBLICITY

In contrast to Australian law there is a well developed body of law giving specific protection to personality in Europe, Canada and the United States of America, in particular. The American "right of publicity" gives the celebrity personality an action against misappropriation of key aspects of their identity for unauthorised commercial use. Twenty six American states have some form of statutory or common law right of publicity protection.

In the United States the right of publicity has been invoked to prevent imitations of celebrity voices in advertising (the *Bette Midler Case*¹⁰ and the *Tom Waits Case*¹¹), the portrayal of a game show host by a look-alike robot (the *Vanna White Case*¹²), the use of a photograph of the late Fred Astaire for an instructional dance video without the permission of his estate (the *Robyn Astaire Case*¹³) and even the use of a slogan, "Here's Johnny!!", famously associated with the television entertainer Johnny Carson, for a portable toilet advertisement without his permission.¹⁴

Given the lack of a comprehensive means of preventing unauthorised use of celebrity personality under Australian law there has been considerable academic and some judicial support for an American style "right of publicity" in Australia in recent years. However, prospects for this development were rejected by the High Court of Australia when it confirmed in *Moorgate Tobacco*¹⁵ in 1984, and more recently in the *Nike Case*,¹⁶ that there is no general tort of unfair competition in Australian law. Consequently, there is no common law basis for attacking misappropriation of celebrity personality directly, as is possible under right of publicity laws found in Europe and the United States. In addition, despite support by the Australian Law Reform Commission in its 1979 "Report on Unfair Publication" for a statutory right of publicity in Australia no legislative initiatives in this area have eventuated.

CORPORATIONS LAW GOES INTO BAT FOR BRADMAN

To the Interest of Australian cricket fans and members of the legal profession, not a mutually exclusive group, the late Sir Donald Bradman's iconic status was recently confirmed by an amendment to the Australian Corporations law on 11 October 2000. The *Corporations Amendment Regulation 2000 (No. 8)* now adds Sir Donald's name to a select group whose names may not be used to register a company name if a connection, which does not exist, with one of these people or organisations, is suggested. Current members of this very special club include all members of the Royal Family, persons in receipt of Royal Patronage and ex-serviceman's organisations. In adding Sir Donald's name to this hallowed list his status as an icon in the development of a unique Australian identity along with the Queen and the "Aussie Digger" is assured. The States and Territories are considering changes to their Business Names legislation in support of the Commonwealth initiative.¹⁷

COULD OTHER CELEBRITIES FOLLOW ON ?

Although appearing to create a precedent that other Australian celebrities might try to emulate, the Australian Prime Minister John Howard, is of the view that it is unlikely that anyone will be able to claim a similar contribution to the development of the Australian "character" in years to come.¹⁸

Action under the tort of passing off, the *Trade Practices Act* and the *Trade Marks Act* provides a limited form of protection for celebrity personality under Australian law. However these areas of law focus on the misrepresentation of a connection between the celebrity and the unauthorised user when the mischief these actions seek to remedy is misappropriation. The repeated attempts by commercial interests to use aspects of Sir Donald Bradman's personality without permission illustrates the need for more comprehensive protection of celebrity personality under Australian law to prevent the misappropriation of the relation to company registrations recent news about unauthorised attempts to sell a selection of Sir Donald's personal letters illustrate that the protection required may need to be wider.¹⁹

The majority of celebrities make a substantial investment in the development of their personalities and images. In those cases where investment of this type can be proven it is reasonable to provide some form of specific legal protection in return for this creative

endeavour and to prevent the unjust enrichment of undeserving usurpers. Whilst imperfect, protection focusing on misappropriation of clearly defined and limited indicia such as a celebrity's name, signature, photograph, or likeness, rather than an attempt to protect the identity itself, is recommended.²⁰ Recognition of these rights as a form of personal property, similar to the registered trade mark under the *Trade Marks Act*²¹, will allow them to be assignable, necessary to the concept of personality merchandising. Ultimately, whatever form of protection is to be extended to celebrity personality under Australian law, must be balanced by the continuing need for reasonable public access to information, a principle underlying all forms of intellectual property protection in Australia today.

1 *Henderson v Radio Corp Pty Ltd* (1960) 60 SR (NSW) 576.

2 In *Talmax Pty Ltd v Testra Corp Ltd* [1997] 2 Qd R 444 Olympic swimmer, Kieren Perkins took action against telecommunications giant, Telstra Corporation, for its unauthorised use of his name and photo in newspaper promotional material. The Court ordered damages of \$15,000 under the *Trade Practices Act 1974* (Cth) s82(1) for the diminution of the opportunity for Perkins to commercially exploit his name, image and reputation because of the defendant's misleading conduct in contravention of s52.

3 *10th Cantanae Pty Ltd v Shoshana Pty Ltd* (1987) 79 ALR 299: Sue Smith, a well known personality, sued the defendant for its use of her name in a magazine advertisement for video records. The advertisement featured a model operating a remote control with the words "Sue Smith just took control of her video recorder." A majority of the Federal Court held there was no passing off as there was no evidence of the public being misled as to the identity of the model.

4 *Honey v Australian Airlines Ltd* (1990) 18 IPR 185: Olympic athlete, Gary Honey took action in passing off against Australian airlines who distributed a poster featuring his photo along with its company logo. The airline then gave permission for a religious publishing organisation to use the photograph on the cover of a magazine and a book it published. The court dismissed the case accepting the Airlines' argument that the purpose of the poster was the promotion of the sport not the Airline itself and that there was no misrepresentation of a commercial arrangement of sponsorship or endorsement between the parties.

5 *Newton-John v Scholl-Plough (Australia) Ltd* (1985) 11 FCR 233: Internationally known singer and actress Olivia Newton-John took action against an advertisement containing a photograph of a "look alike" model. On top of the ad were the words "Olivia? No, Maybelline!" The court took the view that the words "No, Maybelline" acted as sufficient disclaimer to negate Newton-John's claim of passing and misleading and deceptive conduct under the *Trade Practices Act 1974* (Cth), s52.

6 *Trade Marks Act 1995* (Cth), s120(3). S120(4) states "In deciding ...whether a trade mark is well known in Australia, one must take account of the extent to which the trade mark is known within the relevant sector of the public,

whether as a result of the promotion of the trade mark or for any other reason."

7 *Musidor BV v Tansing* (1994) 29 IPR 203.

8 *Montana Tyres Rims & Tubes Pty Ltd v Transport Tyre Sales Pty Ltd* (1998) 41 IPR 301 per Wilcox J at 321.

9 *Trade Marks Act 1995* (Cth) s129.

10 *Midler v Ford Motor Co*, 849 F2d 460 (9th Cir, 1988).

11 *Waits v Frito-Lay, Inc*, 978 F2d 1093 (9th Cir, 1992).

12 *White v Samsung Electronics America Inc*, 971 F2d 1395 (9th Cir, 1992).

13 *Robyn Astaire v Best Film & Video Corp*, 116 F3d 1297 (9th Cir, 1997).

14 *Carson v Reynolds*, 49 CPR (2d) 57 (1980).

15 *Moorgate Tobacco Co Ltd v Philip Morris Ltd* (No 2) (1984) 156 CLR 414.

16 *Campomar Sociedad Limitada v Nike International Ltd* (2000) 169 ALR 677 at 679-690.

17 The Hon John Howard, MP, Media Release, 12 October 2000.

18 The Hon John Howard, MP, Doorstop Interview, Melbourne, 12 October 2000.

19 A remedy might be available under the *Copyright Act 1968* (Cth) for infringement of Sir Donald's copyright in the letters written by him. However, this does not attack the fundamental problem posed by the publication of the letters which is the attempt to benefit from the unauthorised use of his name and personality.

20 Clearly it is necessary to guard against providing remedies to undeserving claimants. The statutory right of publicity in New York, for example, provides protection for these limited indicia on the basis that the celebrity can establish that these aspects of their personality have publicity value, that they have exploited their personality in such a manner that it is evident that the celebrity recognises their own commercial value and that the defendant has misappropriated the celebrity's image for purposes of trade or advertising, without the celebrity's consent: *New York Civil Rights Law*, 50-51.

21 *Trade Marks Act 1995* (Cth), s21.

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