Bereskin & Parr LLP

Nothing lasts forever – or does it?

While personality rights are recognised in Canada, a number of questions remain

Personality rights are recognised in Canada primarily through the common law tort of misappropriation of personality and/or statutory claims in four provincial privacy acts. How long such rights last after the personality dies is unclear. With tort, as opposed to statutory actions, rights appear descendible to the individual's estate, but the term of posthumous protection remains under contention. Regardless, licensing personality rights of dead celebrities remains big business.

Barry Silverstein, a marketing consultant and co-author of the McGraw-Hill book, *The Breakaway Brand*, gave his take on the trend: "Gloomy as it may seem, marketing the dead is actually a billion dollar industry... I believe using dead celebrities is part of a marketing program as both a short-term and long-term strategy. It's short-term, because marketers can capitalize immediately on a dead celebrity who dies, but it's long-term because, as has been proven with Elvis Presley, a dead celebrity's aura can live 10, 20, or 50 years, thus providing a smart marketer with an ongoing path to potential sales and profits."

Regardless of uncertainty, licensing agencies license personality rights in Canada for dead celebrities for as long as possible. One Canadian company was asked to license use of a portrait of Mark Twain even though this iconic writer has been dead for 102 years! Is that an unreasonable monopoly? Not for the State of Indiana, which provides celebrities' heirs with a 100-year posthumous term of protection. So for how long should licences be considered necessary? One of the longest rights monopolies is copyright, which typically runs for the period of an author's life plus 50 years. This term has been criticised as putting an excessive stranglehold on the public domain and freedom of expression. Should these same concerns not be applied when considering personality rights?

In Canada, there is both common law and statutory protection for personality rights, stemming from an individual's publicity rights (proprietary in nature – that is, the exclusive right to commercialise one's persona) and right to privacy (a personal interest – that is, the right to be left alone).

The common law tort of misappropriation of personality is available to individuals (outside Quebec) who have suffered economic injury from violation of their publicity rights. A statutory tort of wrongful use of personality is created under the privacy acts in British Columbia, Manitoba, Newfoundland and Saskatchewan, as well as under the Quebec Civil Code. In addition, the Quebec Charter of Human Rights and Freedoms creates a statutory action based on the right to privacy.

Misappropriation of personality

For protection to arise under this tort, the defendant must attempt to derive economic benefit through unauthorised use of the plaintiff's personality – that is, his or her name, reputation, likeness "or some other components of the plaintiff's individuality or personality which the viewer associates or identifies with the plaintiff" (*Joseph v Daniels (Doing Business as Brent Daniels Photography)* (1986), 11 CPR (3d) 544 at 549 (BCSC)). This tort is primarily commercial for celebrities whose careers rely on publicity, rather than protecting the opposite – that is, an individual's right to privacy.

Krouse v Chrysler Canada Ltd ((1973), 13 CPR (2d) 28 at 44 (Ont CA)), involving use of a professional football player's photograph in an advertisement, first delineated the tort in Canada. Although the football player's claim failed, Justice Estey held that: "There may well be circumstances in which the Courts would be justified in holding a defendant liable in damages for appropriation of a plaintiff's personality, amounting to an invasion of his right to exploit his personality by the use of his image, voice or otherwise with damage to the plaintiff" (Krouse at 44).

In *Athans v Canadian Adventure Camps Ltd* ((1977), 34 CPR (2d) 126 at 136 (Ont HCJ)), Justice Henry held that the proprietary right existed "in the exclusive marketing for gain of his personality, image and name" (Althans at 136).

The court in *Gould Estate v Stoddart Publishing Co* ((1996), 74 CPR (3d) 206 (Ont Ct Gen Div), aff'd (1998), 39 OR (3d) 545 (CA), leave to appeal to SCC refused (1999), 236 NR 396 (note) (SCC)) balanced the public's interest in learning about a famous individual (pianist Glenn Gould) against that individual's right to make economic use of his identity. When setting this balance, consideration must be given as to whether the celebrity has been used solely for commercial exploitation or whether the "subject of the activity is the celebrity and the work is an attempt to provide [the public with] some insights about that celebrity" (*Gould* at 213). This is the 'sales versus subject' distinction, with the tort applying to using a celebrity to promote an unrelated commercial endeavour, but not applying where the endeavour is about the celebrity (eg, a biography).

The *Gould* case, although not having to decide this issue, first established that the tort action should survive death of the celebrity and be enforceable by the heirs for a reasonable period: "The right of publicity, being a form of intangible property under Ontario law akin to copyright, should descend to the celebrity's heirs. Reputation and fame can be a capital asset that one nurtures and may choose to exploit and it

may have a value much greater than any tangible property." (*Gould* at 215)

However, the court stopped short of determining the duration of the tort after the celebrity's death: "As a final comment on this topic, the U.S. cases on both sides of the right of publicity debate have expressed concern over whether there should be a durational limit on the right of publicity after it is inherited (see Presley, supra, 1355 fn 10, and *Lugosi v. Universal Pictures, Cal.*, 603 P.2d 425 (Sup. Ct. 1979) at p. 430). For the present purposes though, suffice it to say that Gould passed away in 1982, and it seems reasonable to conclude that whatever the durational limit, if any, it is unlikely to be less than 14 years. The protection granted by other intangible property rights such as patents and copyrights is longer." (*Gould* at 215)

Provincial privacy acts and Quebec Civil Code

The provincial privacy acts in Manitoba, British Columbia, Saskatchewan and Newfoundland all provide statutory torts of wrongful use of personality. Each of these is based on violation of a person's privacy.

As an example, the relevant provision in the British Columbia Privacy Act (RSBC 1996, c 373, ss 3(2)) states that: "It is a tort, actionable without proof of damage, for a person to use the name or portrait [defined to include likeness] of another for the purpose of advertising or promoting the sale of, or other trading in, property or services, unless that other, or a person entitled to consent on his or her behalf, consents to the use for that purpose."

The relevant provisions in the Manitoba, Saskatchewan and Newfoundland acts are similar, with a slightly wider ambit of protection to include unauthorised use of a person's name, likeness and voice. In British Columbia, Saskatchewan and Newfoundland, these statutory causes of action are extinguished on the individual's death. The Manitoba statute is silent on this point.

Section 36 of the Quebec Civil Code (SQ 1991, c 64) also recognises that use of a person's "name, image, likeness or voice for a purpose other than the legitimate information of the public" is an invasion of privacy.

Under the Quebec Charter of Human Rights and Freedoms (RSQ c C-12), individuals can base a statutory action on the right to privacy found in Section 5 of the charter, which reads: "Every person has a right to respect for his private life."

This type of action has been recognised by the Supreme Court of Canada in *Aubry v Éditions Vice-Versa Inc* ((1998), 78 CPR (3d) 289 (SCC)), which found liability for the unauthorised publication of a non-celebrity's photograph taken in a public place by the defendant photographer.

Jill Jarvis-Tonus
Partner
jj-tonus@bereskinparr.com

Jill Jarvis-Tonus is a partner, barrister, solicitor and registered trademark agent with Bereskin & Parr LLP. She is the head of the firm's new media/copyright group. Ms Jarvis-Tonus specialises in trademark and copyright registration, trademark oppositions, assignments of rights, due diligence work and licensing – particularly in the entertainment, publishing and software industries. She also handles the review of and advice on copyright policy and legislative change.

Conclusion

Given the commercial value of personality rights, it would serve market certainty for Canadian law to determine the rights' duration, if any, after a personality's death.

Three of the four provincial privacy acts expressly deny any rights after an individual dies. This may reflect that the provincial acts, at their core, were intended to safeguard an individual's privacy as opposed to any commercial exploitation, which relates primarily to celebrities. As such, the privacy acts create a 'personal' right akin to defamation law, which protects an individual's reputation. Logically, personal rights should end with the death of the individual.

On the other hand, the common law tort has greater flexibility and national scope to address a celebrity's exclusive right over economic exploitation of his or her persona. Over time, commercial exploitation rights become a valuable asset, as does an IP right. For example, trademark law protects brands and copyright law protects the commercial exploitation of artistic, literary, musical and dramatic works. Descendible IP rights have set terms. Accordingly, they make appropriate models when considering personality rights.

Under trademark law, protection can be perpetual provided that the mark, registered or unregistered, continues to be used on a product or service. If the mark is registered, the owner must verify that it remains in use every 15 years by renewing the registration. A similar approach could be adopted by the courts holding that a celebrity's personality can be protected posthumously for an indefinite period, provided that the heirs are actively licensing it – an indication that the 'personality' asset remains valuable. However, if no licensing activity occurs for a significant concurrent period of time (eg, 15 years), the personality rights could be considered abandoned.

Should perpetual protection seem an undue monopoly, the Trademarks Act provides another approach. Under Section 9(1)(l), no one shall "adopt in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for the portrait or signature of any individual who is living or has died within the preceding thirty years".

Section 9 would provide a more modest limit for the duration of personality rights (ie, 30 years after a celebrity's death).

A third alternative, and one alluded to in *Gould*, would be copyright. The judge in that case may have seen a correlation between:

- the asset that an author creates in a literary or artistic work; and
- the asset that a celebrity builds from his or her persona.

It would seem logical, then, to correlate the posthumous rights granted to both authors and celebrities at life of the author/celebrity plus 50 years. Another logical connection between these two areas of law is that celebrity licensing often extends to use on products also subject to copyright protection (eg, T-shirts or print publications). Should the courts adopt a life-plus-50 rule for personality rights, it would create uniform dual protection for merchandised goods, permitting certainty as to when all rights in such merchandise fall into the public domain. An appropriate balance, some would say, between private and public interests, property rights and freedom of expression.

For now, this is all just supposition. A case needs to be brought which requires the courts to decide the rights duration issue head-on. Until then, do not be surprised if you hear from Mr Twain's reps. WTR