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Judgment Book

IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

IN COMMON LAW

SUIT NO. C.L. R115/1992

BETWEEN	THE ROBERT MARLEY FOUNDATION	PLAINTIFF
AND	DINO MICHELLE LIMITED	DEFENDANT

Michael Hylton, Peter Goldson and Miss Debbie Fraser instructed by Myers, Fletcher & Gordon for the Plaintiff.

Enos Grant instructed by Maurice Long of Clough, Long & Co. for the Defendant

February 7, 8, 9 and May 12, 1994

CLARKE J.

In this suit the plaintiff claims damages under three heads: (1) passing off, (2) "appropriation of personality" (which counsel for the plaintiff urge me to recognize as an independent tort) and, in the alternative, (3) moneys had and received. The plaintiff seeks, too, an injunction restraining the defendant whether by its servants or agents from manufacturing, printing, distributing or in any way dealing in any T-shirts or other items bearing the name, likeness, signature, image, photograph, and biography of Bob Marley without the prior written consent of the plaintiff.

When the case came up before me for trial the defendant through its counsel admitted that all the factual allegations made in the statement of claim are correct. Some of the admitted facts are amplified by unchallenged documentary evidence adduced on behalf of the plaintiff. And as counsel on both sides indicated, the question of the proper inferences to be drawn from the primary facts apart, the live issue, as foreshadowed by the statment of defence is one of law: do the facts establish cause(s) of action?

Omitting the claim for relief, the statement of claim reads as follows:

"1. The Hon. Robert Nesta Marley, O.M. (hereinafter referred to as "Bob Marley") was a Songwriter and Musician of international stature who died on May 11, 1981, intestate. During his lifetime, Bob Marley wrote and/or recorded numerous songs, millions of copies of which have been sold worldwide, both before and after his death. His name and his face are immediately recognizable throughout the Island of Jamaica, and in many other parts of the world.

2. At all material times, the sole Administrator of Bob Marley's Estate has been Mutual Security Merchant Bank and Trust Company Limited (hereinafter called "The Administrator").

3. Pursuant to an agreement made in April 1988, and approved by this Honourable Court, the Administrator transferred to Island Logic Inc. various rights and property including the right to use and/or to authorize others to use Bob Marley's personality, name, likeness, signature, image, photographs and biography anywhere in the world, including the Island of Jamaica. Island Logic Inc. thereafter transferred the said rights to Stitching Bob Marley, a Dutch Corporation.

4. The Plaintiff is a company incorporated under the laws of Jamaica and limited by Guarantee. Stitching Bob Marley has transferred the aforesaid rights to Bob Marley Music Inc., a corporation formed under the laws of the State of California in the United States of America, which, in turn, transferred same to the Plaintiff in relation to the Island of Jamaica. The Plaintiff therefore has the sole right to use or license others to use the personality, name, likeness, signature, image, photographs and biography of Bob Marley within the Island of Jamaica.

5. The Plaintiff operates the Bob Marley Museum in Kingston, Jamaica and sells there and elsewhere T-shirts and other souvenir items bearing Bob Marley's name, photograph and or likeness.

6. The Plaintiff has licensed and is negotiating to license various persons in Jamaica to use Bob Marley's likeness or name on T-shirts or otherwise and Bob Marley Music Inc., and its Assignees and Licensees have licensed and authorized numerous persons worldwide to do so.

7. The Plaintiff's existence and purposes are a matter of public knowledge.

8. The Defendant is a company incorporated under the laws of Jamaica and carries on the business inter alia of manufacturing and selling T-shirts labeled "Fun Tops".

9. The Defendant has manufactured and/or sold a number of T-shirts bearing Bob Marley's image and bearing the words "Bob *1945-1981" throughout the island of Jamaica. The Defendant neither sought nor obtained the approval or consent of the Plaintiff and has failed and/or refused to cease manufacturing or selling the said T-shirts despite demands from the Plaintiff to do so.

11. The T-shirts sold by the Defendant are made of a material and undergo a printing process which are inferior in quality to that used by the Plaintiff and its Licensees.

11. The Defendant has misled the public into believing that an association, whether it be commerical or otherwise, exists between the Plaintiff and the T-shirts being sold by the Defendant to the detriment of the Plaintff.

PARTICULARS

(a) The Plaintiff has the exclusive right to do, and does deal in and license others to deal in the use of the personality, image, photographs, name and biography of Bob Marley.

(b) The Defendant, prior to dealing in T-shirts with the late Bob Marley's image and name, had knowledge of or should have been put on enquiry to ascertain (a) above.

(c) The Defendant manufactures, deals in, and markets the said T-shirts.

(d) The Defendant thereby caused the public to believe that the T-shirts manufactured and/or sold by the Defendant had the approval and sanction of the Plaintiff, or that a commercial arrangement between the Plaintiff and the Defendant exists, a belief which is untrue.

12. The Defendant, in manufacturing and/or selling the said T-shirts, has appropriated for its own use and benefit the Plaintiff's proprietary right in the exclusive marketing for gain in Jamaica of the licence to use Bob Marley's personality, image, photographs, name and biography.

13. In the premises the Plaintiff has suffered loss and damage."

Counsel for the defendant contends that the facts pleaded therein do not establish a cause of action. The suit, he says, must therefore be dismissed. The plaintiff's counsel on the other hand asks for judgment averring that the statement of claim discloses the disputed causes of action.

Were the plaintiff to succeed because, for instance, I concluded that the statement of claim pleads facts establishing the passing off action, Mr. Grant properly conceded that the appropriate remedies would be damages and an injunction as prayed.

Passing Off

Take first the tort of passing off. Undoubtedly an established tort, it is committed where a trader so conducts his business as to lead the public to believe that his goods or business are the goods or business of, or are associated with, another trader as a result whereof the business or goodwill of the latter is really likely to be damaged. In this area of the law, the term trader is wide, especially where as here the defendant's activities are of a commercial nature. The term includes incorporated non-profit and charitable bodies which, like the plaintiff, sell or distribute goods in connection with the activities they were formed to promote. See **Lagos Chamber of Commerce Inc. v. Registrar of Companies** (1956) 72 R.P.C. 263 and **Dr. Barnardo's Homes: National Incorporated Association v. Barnardo Amalgamated Industries Ltd.** (1950) 66 R.P.C. 103. And although the plaintiff is a company formed for promoting art, science, religion or charity, the law and the company's very constitution sanction its trading activities. So, Mr. Grant's submission that such a company has no business interest to be protected by the doctrine of passing off has only to be stated to be rejected.

Warnink and Another v. Townend & Sons and Another [1979] A.C. 731 or [1979] 2 All. E.R. 937 is a leading case on the passing off action. That case went up to the House of Lords. The plaintiffs had for many years manufactured and distributed in Britain a popular liquor called "advocaat". Made in the Netherlands by a number of manufacturers including the plaintiff it had been sold in Britain for many years where it had acquired a substantial reputation and goodwill as a distinct and recognizable beverage. The defendants made and marketed in England a similar (but differently constituted) drink described as a "Keeling Old English Advocaat". Although it could not be shown that it was mistaken for Dutch advocaat it captured a substantial part of the plaintiffs' English market.

The plaintiffs' passing off action succeeded. The defendants, it was held, were seeking to take advantage of the goodwill attached

to the name, advocaat, as a description of the Dutch product by misrepresenting that their product was related or connected to that product. The leading speeches, Lord Diplock's and Lord Fraser's, make it plain that a product, which had gained a reputation in the market by reason of its recognizable and distinctive qualities of name and composition and had thereby generated the relevant goodwill, should be protected from deceptive use of its name by competitors. The injunction granted at first instance was restored because all the tests for a passing off action were met.

By combining the tests propounded by Lord Diplock and Lord Fraser, a learned editor, has, in my view, correctly analysed the essential ingredients of a passing off action as follows:

> "(1) That the plaintiff's business comprises selling in [Jamaica] a class of goods to which the particular trade name [face, likeness or image] applies;
>
> (2) That the name [face, likeness or image] is distinctive of the plaintiff's goods;
>
> (3) That goodwill is attached to the name [face, likeness, image] and is the plaintiff's;
>
> (4) That the defendant has made a representation;
>
> (5) That he has done so in the course of trade to customers or ultimate recipients of the goods;
>
> (6) That the business or goodwill of the plaintiff is really likely to be damaged" - see Clerk & Lindsell on Torts 16th edition 30-29.

There can therefore be no valid cause of action for passing off if there is no invasion of the goodwill of a trader's business by a false representation made by another trader in the course of trade.

As far as concerns the question of misrepresentation the plaintiff in the instant case obviously has no cause of action for passing off in the clasic form of a trader representing his goods as the goods of another. Mr. Grant submitted before me that if the misrepresentation is not so limited it is unavailing. That was what counsel for the respondent had unsuccessfully submitted before the House of Lords in the Warnink case. That is of course, not the law. The law has developed at least to the point where it is enough

that the misrepresentation is calculated to give one trader the benefit of another's goodwill.

This development has been engendered by Lord Parker's seminal identification of the nature of the proprietary right "the invasion of which is the subject of ... passing off actions" as the "property in the business or goodwill likely to be injured by the misrepresentation": **Spalding and Bros. v. A.W. Gamage Ltd.** (1915) 84 L.J. Ch. 449, 450; and see the speech of Lord Diplock in **Warnink v. Townend (supra).**

In the instant case the misrepresentation is not in dispute. By manufacturing and selling T-shirts bearing Bob Marley's image or likeness and the appellation, "Bob *1948-1981", the defendant has misled the public to beleive that an association, be it commercial or otherwise, exists between the plaintiff and the T-shirts being sold by the defendant: see paragraphs 9, 11 and 11(a) of the statement of claim.

That is, however, not all. The statement of claim must plead not only facts showing the defendant's acts of misrepresentation, but must also plead facts leading to the conclusion that the plaintiff is entitled to the relevant goodwill. This, Mr. Grant submitted, has not been done.

Although goodwill as a concept is wide, "goodwill as the subject of proprietary rights is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached": **Star Industrial Co. Ltd. v. Yap Kwee Kor** [1976] F.S.R. 256, 269, per Lord Diplock. It is, as Lord McNaghten once said, "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom": **Inland Revenue Commissioners v. Muller & Co.** [1901] A.C. 213 at 223 and 224.

Now, the late Bob Marley was a musician and songwriter of international stature. Millions of copies of the songs he wrote and recorded have been sold worldwide both before and after his death

in 1981. From these primary facts I conclude that he was a celebrity who had a music and songwriting 'business' of international proportions. And whilst it has not beeen shown that he was involved in manufacturing and/or selling T-shirts, he had, as I will show later in this judgment the sole or exclusive right (subsequently acquired by the plaintiff) to use or license other persons to use in Jamaica his name and likeness for commercial gain.

The plaintiff's business includes (a) selling T-shirts bearing Marley's name and image or likeness etc. and (b) licensing persons to use Marley's name, image or likeness etc. on T-shirts or otherwise. The Plaintiff "whose existence and purposes are a matter of public knowledge" has in fact licensed, and is negotiating to license, various persons in Jamaica to use Marley's name and likeness as aforesaid. Indeed, two non-exclusive license agreements, made between the plaintiff and third persons for valuable consideration were admitted in evidence. So, the clear and reasonable inference must be that "because of the good name, reputation and connection of [the plaintiff's] business" various persons have for commercial purposes paid, or are prepared to pay the plaintiff for use on T-shirts etc. Bob Marley's name and likeness or other **indicia** of his personality. These are clearly "the attractive force which brings in custom." Add to that the allegations, admitted by the defendant, that its use of Bob Marley's name and likeness on T-shirts it sells, has led to the public's mistaken belief that there is a connection between its goods and the plaintiff, resulting in loss and damage to the plaintiff.

The facts as pleaded therefore lead to the inescapable conclusion that goodwill is attached to Bob Marley's name and likeness in connection with the plaintiff's business. And that goodwill belongs to the plaintiff. It has been invaded by the defendant's aforesaid misrepresentation.

The detriment suffered by the plaintiff by this invasion of its goodwill is underscored by this, that the defendant has em-

ployed goods of inferior quality to the plaintiff's in making the false representation according to which the public has been misled into believing that a commercial arrangement exists between the plaintiff and the defendant. So I disagree with Mr. Grant's submission that in manufacturing and selling the said T-shirts the defendant was merely satisfying a popular demand.

Mr. Grant submitted that, in any event, an action in passing off is not maintainable as, according to him, the facts show that the parties are not engaged in a common field of activity. A number of things must be said about that submission. First, of all, although only the plaintiff licenses person to utilise in Jamaica Bob Marley's name and likeness, both parties sell T-shirts with Bob Marley's name and likeness printed thereon. Second, as the businesses of the parties therefore overlap, this case does not violate the principle of the decision of the English Court of Appeal in **McCullock v. May** [1947] 2 All. E.R. 845 (relied on by Mr. Grant) that in a passing off action the parties must have a common field of activity, on the basis that otherwise they would not be business rivals. Third, with great respect, I am not persuaded that I ought to accept that proposition for, even though it has not been violated by the instant case, as Evatt C.J. and May J. reasoned in rejecting it in the Full Court of the Supreme Court of New South Wales, "[i]f deception and damages are proved, it is not easy to see the justification for introducing another factor as a condition of the Court's power to intervene:" **Radio Corporation v. Henderson** [1960] N.S.W. 279, 282.

In that case the plaintiffs were well-known professional ballroom dancers. Their photographs had been used, without consent, by the defendants on the cover of a gramaphone record of dance music. Even though a common field of activity was found to exist, there is much force in the learned judges' reasoning and I respectfully adopt it.

From the foregoing analysis I consider it plain that the facts presented by the statement of claim disclose a cause of action for

passing off. The requirements of the tort have been met and no exceptional features on public policy grounds justify witholding a remedy.

Appropriation of Personality

Mr. Grant next submitted that, although recognized in Canada and some States of the United States of America, the concept of appropriation of personality as an independent tort is in this country jurisprudentially novel and esoteric. He further submitted that so far as the courts in Jamaica are concerned the categories of heads of tortious liability are closed and may only be opened or increased by Parliament.

Now, at the invitation of Mr. Hylton I take judicial notice of this, that "much modern commericial activity focuses upon the creation of a public perception of an association between a consumer product and a celebrity figure for the purpose of marketing the product." This constitutes, according to one academic writer to whom the quoted words in this paragraph are attributable, "a valuable by product of [the] fame [of most celebrities] allowing them to sell their **persona** for a user fee": Robert Howell in an article in the Intellectual Property Journal 1986 at page 150. This interest, Mr. Hylton submitted, would be protected so far as the plaintiff is concerned by the recognition by the common law of Jamaica, in consonance with some other common law jurisdictions, of an independent tort known in Canada as "appropriation of personality" and in the United States as "breach of the right of publicity". He further submitted that such a tort rests on the juridical basis that:

> "When a person has a **persona** which is commercially marketable another person should not be allowed to take commercial advantage of that **persona** without permission."

And, as I understand his argument, that is precisely the basis of the plaintiff's claim for damages for apropriation of personality as set forth in paragraph 13 of the statement of claim as follows:

> "The defendant in manufacturing and/or selling the said T-shirts, has appropriated for its own use and benefit the plaintiff's proprietary right in the exclusive marketing for gain in Jamaica of the license to use Bob Marley's personality, image, photograph, name and biography".

If no exclusivity of control or ownership of personality exists anyone may, in the absence of some existing tortious or contractual obligation, appropriate or market such personality without permission. In such a case there is no legal right and therefore no duty situation arises. In the absence of a duty cast upon the would-be appropriator, the celebrity or his personal representatives or assignees would have no proprietary right to exclusively market for gain his personality.

A fundamental question that must needs be determined, therefore, is whether our law recognizes the existence of property or any other right in, or attached to, personality which in this context comprises a natural person's name and likeness or other **indicia** of identity. The question arises against the background of the notorious commercial practice of the use without permission of the name and likeness of another. In examining the authorities which include some 19th century English cases I bear in mind the following dictum of Scott L.J. expressed some 53 years ago:

> "The common law has throughout its long history developed as an organic growth, at first slowly under hampering restrictions of legal forms of process, more quickly in Lord Mansfield's time, and in the last one hundred years at an ever - increasing rate of progress as new cases, arising under new conditions of society, of applied science and of public opinion, have presented themselves for solution" - see **Haseldine v. Daw** [1941] 2 K.B. 343, 362.

In **Routh v. Webster** (1849) 10 Beav. 561 the defendant published without authority the plaintiff's name as a trustee/promoter of a joint stock company. The court granted an injunction enjoining the unauthorised use on the basis that the use of itself exposed the plaintiff to financial risk. In that case, despite Lord Langdale's

admonition not to use the name of persons without their authority, in another case the following year, that judge refused to restrain the unauthorised use of the plaintiff's name: **Clark v. Freeman** (1850) 11 Beav. 112. There the defendant took advantage of the name and reputation of the plaintiff, an eminent physician, by advertising pills purporting to relieve consumption as "Sir J. Clark's Consumption Pills". Holding that to grant the injunction would falsely imply that the court had jurisdiction to stay the publication of a libel, Lord Langdale at page 118 concluded that persons of the plaintiff's standing must accept such exposure as the price of eminence:" Other persons try to avail themselves of their names and reputations for the purposes of making profit for themselves; that unfortunately continually happens."

Clark v. Freeman (supra) was followed in a line of professional cases characterised by this, that the name of a prominent expert had been apppropriated for advertising purposes by a manufacturer: see for instance, **Williams v. Hodge** (1887) 4 T.L.R. 175; **Dockrell v. Dougall** (1899) 80 L.T. 556; **B.M.A. v. Marsh** (1931) 48 R.P.C. 565. In **Dockrell v. Dougall** the plaintiff's claim in libel failed, but he further claimed that a person has a property in his own name, a claim which echoed the view of some judges expressed obiter in earlier cases. Cairns L.J. for instance, said in one case. "It always appeared to me that **Clark v. Freeman** might have been decided in favour of the plaintiff on the ground that he had a property in his own name": see **Maxwell v. Hogg** (1867) L.R. 2 Ch. 307, 310. In **Dockrell v. Dougall (supra)** however, Smith L.J. rejected the plaintiff's contention and held that no injunction could be granted unless the plaintiff could show injury in his property, business or profession. While Williams L.J. found no authority to support the notion of property in a name **per se**, he held that the plaintiff could only succeed in his claim for an injunction if he could show that the defendant had done something more than use his name without authority. Williams L.J. agreed that the unauthorised use of another's name would be action-

able if it led to an infraction of his rights of property or any injury to him in his property, business or profession.

In **Corelli v. Wall** (1906) 22 T.L.R. 532 the defendants sold without the consent of the plaintiff, a novelist, postcards depicting bad portraits of her. She claimed an injunction on two grounds: libel and the publication of her portrait without her consent. Swinfin Eady J. refused to issue it on either ground. In so far as the second ground was concerned, the learned judge held that there was no authority for the plaintiff's claim to a right as a "private person" to restrain the unauthorised publication of her portrait.

Those two cases were relied on by Greer L.J. in **Tolley v. Fry & Sons Ltd.** 1 K.B. 467, 478 as authority for the proposition that the unauthorised use of another's photograph, caricature or name is not actionable in the absence of defamation. With great respect, that proposition is too wide and categorical. Neither of the two cases on which the learned Lord Justice relied went that far. And it is obiter, as witness the fact situation of **Tolley v. Fry & Sons Ltd.** itself. There the plaintiff, a renowned amateur golfer, was caricatured by the defendant, without his consent, in an advertisement of their chocolate which depicted him with a packet protruding from his pocket. Represented with him was a caddy who also had a packet of chocolate the excellence of which he likened to the excellence of the plaintiff's drive. The plaintiff sued to recover damages for libel alleging in his innuendo that the defendants thereby meant that the plaintiff had agreed to let his portrait be exhibited for advertisement, that he had done so for gain, and that he had thus prostituted his reputation as an amateur golfer. The sole issue was whether the advertisement was capable of any, or the alleged, defamatory meaning.

Except for the unauthorised issue of portrait, the material facts of that case are essentially dissimilar to those of the case before me. Mr. Tolley as an amateur golfer was concerned to pre-

serve his amateur status and reputation in golf. He could assert no right, or no exclusive right, to market his personality for gain, for his status as an amateur sportsman would have been inconsistent with any such assertion. Accordingly, appropriation of his name and likeness, though capable of being defamatory, could not injure him in his "property, business or profession." Given his status those would be inapplicable. In my view, that is why the unauthorised use of Mr. Tolley's portrait for commercial purposes was not actionable in the absence of defamation.

Interestingly, the contention raised in **Dockrell v. Dougall** that a person has a property in his own name **per se** was also in effect raised in **Sim v. Heinz** [1959] 1 W.L.R. 313. There the plaintiff sued in respect of an advertisement utilising a voice made to sound like his. In an application for an interlocutory injunction to restrain the appropriation of his voice the plaintiff, while not in terms claiming property in his voice, claimed that "in the case of a professional man like an actor, his reputation in the mind of the public, based upon his performances, is a right of property capable of invasion, just as the right of property contained in a particular kind of goods or method of get up of goods ..." However, as the proceedings were interlocutory McNair J. refused to rule as to whether an action in passing off would lie, though in his view it would be "a grave defect in the law if it were possible for a party for the purpose of commercial gain, to make use of the voice of another party without his consent.."

Although no West Indian or English decisions recognize property in personality **per se**, dicta in cases such as **Clark v. Freeman** and **Dockrell v. Dougall** **(supra)** support the concept of a property interest as distinct from a privacy interest attached to personality. Just as the law recognizes property in the goodwill of a business so must the law recognize that

property rights attach to the goodwill generated by a celebrity's personality. On that basis those rights are violated where the **indicia** of a celebrity's personality are appropriated for commercial purposes. And the principles of unjust enrichment demand that a person must not "unjustly" benefit at the expense of another.

The common law is not static. It has the capacity to develop "as new cases, arising under new conditions of society ... [present] themselves for solution." Indeed in Canada and in several States of the United States of America the common law (in the widest sense) **has** developed to take account of the commercial practice of utilizing without consent the name and likeness or image of celebrities. In that connection Mr. Hylton cited Canadian and American cases including **Krouse v. Chrysler Canada Ltd.** (1973) 40 D.L.R. (3d) 15, **Athans v. Canadian Adventure Camps Ltd.** (1977) 80 D.L.R. (3d) 583.

In **Krouse v. Chrysler Canada Ltd. (supra)** an action picture of a professional football game was used in a device for advertising cars. The plaintiff, one of the football players who was identified by the number on his uniform, had not consented to the use of the photograph and sued to recover damages against the car advertisers on the basis of passing off and misapproriation of personality. Although the plaintiff's action failed, the Ontario Court of Appeal recognized that it is possible to establish in certain circumstances the tort of appropriation of personality even if there be no passing off proved.

The court based such a tort on a right in the nature of a property right to the exclusive use of a celebrity's personality. In doing so the court acknowledged that persons in the position of the plaintiff possess a notoriety as a by product of their status, and took judicial notice of community recognition of the practice of persons to make their notoriety itself an object of commerce: see pages 26, 28 and 30 of the Report. The Court held

property rights attach to the goodwill generated by a celebrity's personality. On that basis those rights a

however, that on the facts of the case the car advertisers had not committed the tort because the photograph had not been used to associate the plaintiff with the commercial enterprise. It was the game of professional football that had been deliberately incorporated in the advertising device and not the personality of the plaintiff who was only one of the participants of the game.

As Mr. Hylton submitted, in the instant case it is Bob Marley's name and likeness which the defendant has exploited and associated with its commerical enterprise. His is the only face on the T-shirts.

In **Athans v. Canadian Adventure Camps Ltd. (supra)** the plainitff was a professional water-skier of international repute. A drawing of his photograph was used by the defendants in a brochure advertising a summer camp. The Ontario High Court held, relying on **Krouse v. Chrysler Canada Ltd.** that although no case of passing off was established, the defendants were liable for the tort of appropriating the plaintiff's personality, the unconsented representational image of the plaintiff by the defendant for commercial advantage being an invasion of the plaintiff's exclusive right to market his personality.

So, as has been pointed out, both Canadian cases acknowledge that the true object of proprietary protection in the tort is the celebrity's personality as a commodity with a marketable business value, his name and likeness simply being **indicia** of that property interest: see **Robert Howell op.cit.**pp 175 and 176.

From the foregoing analysis I respectfully conclude that our law recognizes a civil wrong, known in Canada as "appropriation of personality" and in several States of the United States as, "breach of the right of publicity". It is not so much that the cases have "uncovered a piece of the common law and equity that had [hitherto] escaped notice ..." as Cross J. once expressed himself in a passing off action - see **Vine Production Ltd. v. McKenzie & Co. Ltd.** (1969) R.P.C. 1, 23 - but rather, the declaration of the tort results from the application of recognized

principles of law (even if hitherto diffuse) to particular fact situations arising under "new conditions of society". The tort consists of the appropriation of a celebrity's personality (usually in terms of his or her name and likeness etc.) for the financial gain or commercial advantage of the appropriator, to the deteriment of the celebrity or those claiming through him or her.

In the present case the detriment must be seen not only in terms of financial loss but in terms of loss of quality control in relation to the said T-shirts manufactured and sold by the defendant. Such a control (as evidenced by the aforesaid non-exclusive license agreements which I hold, contrary to Mr. Grant's submission, do not contravene the Fair Competition Act, 1993) is maintained by the plaintiff over the licencees of its right to use Bob Marley's name and likeness etc. There is no question, however, that without permission the defendant manufactured and marketed for financial gain T-shirts, of a quality inferior to the plaintiff's, bearing the name and likeness of the late Bob Marley whose fame and reputation the plaintiff seeks to protect as evidenced by the said agreements. The question whether the statement of claim discloses a cause of action against the defendant for appropriation of personality depends, therefore, on whether that tort can be committed even though the celebrity is dead.

Closely reasoned and helpful decisions in two American cases (again cited by Mr. Hylton) make it clear that the "right of publicity" defined as a celebrity's right to the exclusive use of his or her name and likeness, is inheritable and devisable and that the owner of such right need not have commercially exploited it before it can survive his or her death: **Martin Luther King J Centre for Social Change Inc. v. American Heritage Products Inc.** (1983) 694F 2d 674; **The State of Tennessee, Ex. Rel. The Elvis Presley International Memorial Foundation et al v. Gentry Crowell** (1987) 733 S.W. 2d 89.

In the **Martin Luther King** case the plaintiffs claimed **inter alia** that the manufacture and sale by the defendants of busts of Dr. Martin Luther King violated Dr. King's "right of publicity" which they sought to enforce as assignees of the exclusive use of his name and likeness. After declaring that the "right of publicity" is a recognized and distinct right in the particular jurisdiction, the United States Court of Appeals for the Eleventh Circuit held (at page 682) as follows:

> "For the reasons which follow we hold that the right of publicity survives the death of its owner and is inheritable and devisable. Recognition of the right of publicity rewards and thereby encourages effort and creativity. If the right of publicity dies with the celebrity, the economic value of the right of publicity during life would be diminished because the celebrity's untimely death would seriously impair, if not destroy, the value of the right of continued commercial use. Conversely, those who would profit from the fame of a celebrity after his or her death for their own benefit and without authorization have failed to establish their claim that they shoudl be the beneficiaries of the celebrity's death. Finally, the trend since the early common law has been to recognize survivability, notwithstanding the legal problems which may thereby arise."

Mr. Grant argued that since the plaintiff in the instant case has not shown that Bob Marley had himself licensed or authorised anyone to put his name and likeness on T-shirts or other clothing, the plaintiff should not have the exclusive right to licence persons to do so now. So the question that arises is this: must the owner have commercially exploited the right before it can survive his death? That question was answered by the Court of Appeals, Eleventh Circuit in the Martin Luther case and I hold that that court's reasoning and conclusion are applicable here as well. There the majority opinion states at page 683 this:

> "That we should single out for protection after death those entertainers and athletes who exploit their **personae** during life, and deny protection after death to those who enjoy public acclamation but did not exploit themselves during life, puts a

> premium on exploitation. Having found that there are valid reasons for recognizing the right of publicity during life, we find no reason to protect after death only those who took commercial advantage of their fame.
> ... a person who avoids exploitation during life is entitled to have his image protected against exploitation after death just as much if not more than a person who exploited his image during life."

In the **Elvis Presley** case also, the Court of Appeals of Tennessee concluded that recognizing that the right of publicity is descendible would accord with principle in that:

> "(1) The Court recognizes that an individual's right of testamentary distribution is an essential right. If a celebrity's right of publicity is treated as an intangible property right in life, it is no less a property right at death.
>
> (2) One of the basic principles of Anglo American jurisprudence is that "one may not reap where another has sown nor gather where another has strewn."
>
> (3) Recognizing that the right of publicity is descendible is consistent with a celebrity's expectation that he is creating a valuable capital asset that will benefit his heirs and assigns after his death.
>
> (4) Concluding that the right of publicity is descendible recognizes the value of the contract rights of persons who have acquired the right to use a celebrity's name and likeness. The value of this interest stems from its duration and its exclusivity. If a celebrity's name and likeness were to enter the public domain at death, the value of any existing contract made while the celebrity was alive would be greatly diminished.
>
> (5) Recognizing that the right of publicity can be descendible will further the public's interest in being free from deception with regard to the sponsorship, approval or certification of goods and services. Falsely claiming that a living celebrity endorses a product of service violates the law. It should likewise be discouraged after a celebrity has died.

(6) Recognizing that the right of publicity can be descendible is consistent with policy against unfair competition through the use of deceptively similar corporate names.

Again, those factors are equally applicable to the case before me. I hold, therefore, that Bob Marley, a celebrity of renown at home and abroad, had a right to the exclusive use of his name and likeness or image. The right entitled him to exploit it commercially. He could, for instance, for a fee, license persons to use his name and likeness etc. for commercial gain. That right survived his death. The plaintiff is the assignee of that right in Jamaica. And as the statement of claim pleads, the plaintiff is invested with the proprietary right in the exclusive marketing for gain in Jamaica of the license to use his image, photograph, name, all **indicia** of his personality.

In my judgment, the commercial use of Bob Marley's name and likeness or image by the defendant without the plaintiff's consent constitutes an invasion or impairment of the plaintiff's exclusive right as aforesaid resulting in damage to the plaintiff. Such conduct on the defendant's part constitutes the tort of appropriation of personality, separate and distinct from the tort of passing off.

Moneys had and received

In the context of this case the plaintiff succeeds because the statement of claim discloses causes of action for passing off and appropriation of personality respectively. Accordingly it is wholly inappropriate to consider the alternative claim for damages for money had and received on the ground of unjust enrishment.

Remedies

Mr. Grant agreed that if a cause of action for passing off is disclosed an injunction and damages would be appropriate remedies.

Having regard to all the circumstances of this case including the fact that the defendant has shown no clear intention of

discontinuing the wrongful acts, I grant the plaintiff a permanent injunction in the terms sought as set forth in the first paragraph of this judgment.

Although the statement of claim discloses two causes of action damages will not be awarded twice over. A single award of damages will suffice.

In any case, counsel on both sides agreed that in the event that the plaintiff succeeds, the quantum of damages awardable is $86,040.50. That sum is based on what the plaintiff would have received had the defendant made and sold the T-shirts with the plaintiff's approval. The plaintiff, I am told by counsel, has accepted the defendant's figures as to the number of T-shirts it has made and sold and as to the wholsale selling price therefor. The agrred quantum has been arrived at by applying to those figures the royalty rate of 15% which, as the evidence indicates, the plaintiff applies to sales made by its licensees.

Accordingly, in addition to the injunction I award the plaintiff damages against the defendant in the sum of $86,040.50.

The defendant must pay the plaintiff's costs which are to be taxed if not agreed.