

On the other hand, publishers may (and often do), for example, by including an express prohibition against the redistribution of their online newsletter.

What should you do?

The ease with which emails can be created and sent belies the legal ramifications which result from improper email use.

From a copyright perspective, email recipients should respect any restrictions which the sender places on their use of an email, such as a prohibition on redistribution or confidentiality. For an employer, staff can be made aware of this

through training and an Email Policy.

Senders of emails should be mindful of the number of retrievable copies of emails which are made in the course of communicating an email. As a result, they should choose the contents of their email carefully. Employers should ensure that their Email Policy includes restrictions on employee use of email to limit their liability in case an employee uses it to swap copyright infringing material, such as music or picture files.

Exposure to copyright infringement liability from improper email use has not changed since the enactment of the

Digital Agenda Act. However, the Government's comments have brought this issue into relief and organisations which facilitate email access would be wise to consider how they can limit their potential exposure.

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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Personality Rights in Australia

Ann Slater looks at possible avenues for Australians to protect performance rights and rights in personalities.

The need to protect performance rights and rights in personality is likely to increase as technology remasters, recreates or impersonates an actor or celebrity. There is little protection from film studios creating "virtual actors" using computer technology to create convincing humans based on images of celebrities. This technology, seen in films from "Roger Rabbit" to "Jurassic Park", has already been used to complete the films "The Crow" and "Gladiator", when actors died during production.

THE US APPROACH

In the United States, there is a concept of an individuals' right of publicity. However, there is no such basic right or concept in Australia.

The US right of publicity is the right of all individuals, but principally celebrities, against the misappropriation by another of the commercial value of their own identity or performance. The right affords a financial interest in controlling the use of their identity.

AUSTRALIAN REGULATION

The principal legislative regime in Australia to protect personality is a series of intellectual property acts and common law remedies namely, the *Trade Marks Act 1995(Cth)*, the *Copyright Act 1968(Cth)*, the *Trade Practices Act 1974(Cth)* and the common law actions of passing off, defamation and unjust enrichment. Arguably the new Moral Rights legislation may also be used the

protect personality.

Copyright Act

The *Copyright Act 1968 (Cth)* is the principal form of protection.

An author (eg. an actor) has the capacity to exploit their work (eg. a character or artificial personality) or material without others being able to copy that work. Copyright owners are entitled to monetary remuneration upon the use by others of their particular work. It also specifies the remedies available to an author in the event of the unauthorised exploitation of the subject matter of the copyright. These provisions allow the owner of a copyright to bring an action for infringement and to seek relief in the form of an injunction, award of damages or account of profits.

Performance is protected under the *Copyright Act* and arguably a character or personality created in the performance is also capable of protection and monopolisation under the *Copyright Act*. Tribute bands are excluded from infringement under the *Copyright Act*.

Trade Marks

Trade marks may include, amongst other things, devices, labels, names, sound, smell and aspects of packaging.

Aspects of packaging as a trade mark is particularly relevant to personality insofar as the external representation of an actor or personality's character or image may be a registrable trade mark e.g. the colour pink for the late Barbara Cartland, the external clothes and general get up of the characters Bob Downe and Dame Edna Everage.

Trade Practices

Whilst not strictly concerned with the protection of personality, Part V of the *Trade Practices Act 1974 (Cth)* has the effect of enabling commercial competitors to bring actions for misrepresentation of association with, or endorsement of, a particular product. The provisions do not require a trader to show that they actually possess a well-known name, image or reputation, providing that the false representation of an association with the plaintiff's product by the defendant can be established.

The *Trade Practices Act* is designed to protect consumers from buying goods or services that have been falsely associated with another product or personality and serves to protect against the unauthorised exploitation of reputation or personality.

Passing Off

The common law action of passing off requires the plaintiff to establish that a misrepresentation has been made in the course of trade or business to customers or prospective customers and that it is reasonably foreseeable that this misrepresentation will injure the plaintiff's own business or goodwill.

In *Henderson v Radio Corp Pty Ltd*, passing off was applied to the practice of character merchandising. The Court did so by relaxing the "common field of activity" requirement, previously imposed by the English courts in relation to passing off actions.

In the *Henderson* case this allowed the plaintiff ballroom dancers to be characterised as "competitive in a broad

sense" with the defendant record producers who had used the dancers' image on a dance record. The Court held that the plaintiffs had been presented as endorsing the defendant's record in the course of their professional activities. Subsequently, Australian courts accepted the broad proposition that an action for passing off lies where there is a misrepresentation by the defendant that the plaintiff has endorsed or approved a particular product, service or business.¹

In *Hogan v Koala Dundee Pty Ltd*,² Pinous J indicated there was a "degree of artificiality in deciding image-filching cases on the basis that the vice attacked is misleading the public about licensing arrangements". Subsequently, in *Pacific Dunlop Ltd v Hogan*³ the plaintiff complained of the use of a short sequence from the movie *Crocodile Dundee* in a television advertisement for a brand of shoes. In the course of his judgment in the Full Federal Court, Burchett J observed that:

*The consumer is moved by a desire to wear something belonging in some sense to Crocodile Dundee. The arousal of that feeling by Mr Hogan himself could not be regarded as misleading, for then the value he promises the product will have is not in its leather, but in its association with himself. When, however, an advertisement he did not authorise makes the same suggestion, it is misleading, for the product sold by that advertisement really lacks the one feature the advertisement attributed to it.*⁴

Despite his observations, Burchett J framed his decision squarely in the traditional terms of passing off, signalling that the court did not require an unequivocal representation of endorsement in order to make out the action.

This conservative approach was highlighted by the decision of the Federal Court in *Honey v Australian Airlines Ltd*⁵ where the athlete Gary Honey sought unsuccessfully to restrain the use of his photograph on advertising posters. Northrop J concluded that he was not satisfied that a reasonable number of persons, on seeing the poster would have concluded that the plaintiff had given his endorsement to Australian Airlines. Similarly, considerations applied in *Newton-John v Scholl-Plough (Australia) Ltd*,⁶

Defamation

At common law, a person's reputation is



protected largely by the tort of defamation.

The law of defamation within Australia varies between each State and Territory. Some States apply the common law, others apply both the common law and statute, and finally, some States are governed solely by statutory provisions.

A defamatory statement is a statement which holds a person up to hatred, ridicule or contempt or tends to lower the person in the estimation of a right thinking ordinary decent Australian.

To be defamatory an imputation need have no actual effect on a person's reputation. A defamatory statement may be conveyed by words or visual images either singularly or in conjunction. An imputation may be conveyed even though it is not apparent on the face of the words alone.

A person will establish a cause of action in defamation if there are three elements present:

- that the words carry a defamatory imputation – "meaning";
- the matter is capable of identifying the person – "identification";
- the matter has been communicated

to at least one other person – "publication".

It has been held that the use of a person's name without his authority may be restrained by an injunction, regardless of whether there is a defamatory imputation conveyed or not, if the use is calculated to cause his pecuniary loss.⁷

Again, although the law goes some way to protecting an individual's reputation, it does not provide an absolute right amounting to the prevention of the use or misuse of a person's likeness or character.

1 10 IPR

2 (1988) 12 IPR 504.

3 (1989) 14 IPR 398.

4 (1989) 14 IPR 398 at 429-430.

5 (1989) 14 IPR 264.

6 (1986) 11 FCR 233.

7 *Tulley v Fry* [1930] KB 467. See the judgment of Greer LJ at 478.

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