

# Rihanna and passing-off

 By [Gaelyn Scott](#)

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It's been well reported that Rihanna succeeded in her court case against the retail chain Topshop.

The facts were straightforward. Topshop used a photo of Rihanna on a t-shirt that it sold, but it didn't obtain the artist's consent. The UK court had no hesitation in finding that Topshop had infringed Rihanna's rights.

Cases involving the unauthorised usage of celebrity images crop up from time to time. There was a famous case in the UK where Formula 1 driver Eddie Irvine successfully sued a radio station for using a photo of him in a print ad without consent. In South Africa, former Miss SA, Basetsana Khumalo successfully sued Cycle Lab for using her image in an ad without consent, and it was reported a few years back that singer PJ Powers sued an advertising agency that had used a photo of her in an ad that appeared in a urinal. Whereas soccer boss Jomo Sono once complained about a newspaper ad that associated him with a beer brand.

We wrote an earlier article about the Rihanna case (before the decision had come out), and in it we discussed the various types of action that a celebrity might have in cases such as this. We mentioned that celebrities may be able to sue for trademark infringement if they have registered their photo or likeness. We mentioned that South African law recognises a right to identity, which is something that came up in the Khumalo case. We discussed the fact that there may be recourse under the code of the Advertising Standards Authority, and we discussed that if the celebrity actually owns the copyright of the photo that has been used (a fairly unlikely event), he/she may be able to sue for copyright infringement.

What's interesting about the Rihanna case is that it wasn't based on any of these grounds. It was, in fact, a claim for passing-off. One of the reasons for this is that UK law does not recognise a right to identity like we do, or a publicity right as they have in the USA. But passing-off is also part of our law, so it's worth looking at just how this works in the context of product endorsement.

## Passing-off re: product endorsement

Passing-off is a form of unlawful competition. In order to succeed in a passing-off case, you generally need to show that your name or trademark enjoys a reputation or goodwill, and that the other party is - by using the same name or trademark or something similar - misrepresenting that their product is connected with you, and thereby causing you damage.

Passing-off can take many different forms. It may involve a similar product get-up, as it did in a recent South African case where a court held that one company had passed-off its braai salt as that of a competitor, because it had used a similar get-up comprising an orange plastic container with a brown cap, and the brand name in a white oval with a blue trim,

despite the fact that the brand names were quite different. Passing-off may come up in the context of the trade dress (the look and feel) of a shop or restaurant. It may even come up in the context of a company suggesting that its product is of a type that it isn't, for example Swiss chocolate, Scotch whisky, or as it happened in a recent UK case, Greek yoghurt - this is sometimes referred to as 'extended passing-off'.

Then there's the form of passing-off we're concerned with here, namely product endorsement. The court in the Rihanna case said that a significant number of consumers would mistakenly assume that Rihanna had endorsed the t-shirt. That was the misrepresentation. The court also found that Topshop's conduct harmed Rihanna's goodwill and represented a loss of control over her reputation in the fashion sphere. This was the damage. In the Eddie Irvine case the court found the same thing - people would mistakenly assume that he had endorsed the station, depriving him of a money-making opportunity.

## Trademark infringement vs. passing-off

So does the man or woman on the street, seeing a well-known person linked with a product, automatically assume that the celebrity has endorsed the product? And will the celebrity always suffer damage if that assumption is made? Different factors will come into play. For example, the public is perhaps more likely to assume endorsement in the case of a sportsman or film star, or indeed any celebrity who is known or likely to endorse products, than in the case of a religious leader like the Dalai Lama or Desmond Tutu. In the Rihanna case, the fact that Rihanna is huge right now and known to be involved in the world of fashion, clearly played a role. The public is probably also more likely to assume endorsement in the case of a live celebrity than a dead one (where it's the estate that will do the authorisation). The nature of the product may play a role too - people seeing the photo of a celebrity on a poster or book cover will probably assume that the product is about the celebrity rather than that the product that has been endorsed by the celebrity. Yet if they see the same photo on a t-shirt or on a cosmetic product they may assume endorsement.

It's worth remembering that one of the major differences between trademark infringement and passing-off is that with passing-off external factors that may increase or reduce the likelihood of confusion are considered. This quote from the old case of Blue Lion (which dealt with get-up - a style or arrangement of dress - rather than endorsement) is interesting: 'The law of passing-off is not designed to grant monopolies in successful get-ups. A certain measure of copying is permissible. But the moment a party copies he is in danger and he escapes liability only if he makes it "perfectly clear" to the public that the articles that he is selling are not the other manufacturer's, but his own articles, so that there is no probability of any ordinary purchaser being deceived.'

So, is it possible that if Topshop had put a clear disclaimer on the t-shirt: 'This product features a photo of Rihanna but it has not been endorsed by her,' the court would have found that there was no passing-off? Perhaps! But you do need to bear in mind that in South Africa, the right to identity can also be invoked, and that does not require any confusion on the part of the public. So best not to try it!

## ABOUT GAELYN SCOTT

Gaelyn Scott is a director at ENSAfrica and head of the firm's IP department. Gaelyn has 20 years' experience and specialises in strategic brand management and the enforcement of IP rights, both locally and internationally, with extensive experience in Africa.

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