

Just who controls the rights to a sporting star's image? Behind the Leo Barry/AFL/Tabcorp image rights stoush

This article considers the main issues raised by the case of Leo Barry, the Sydney Swans footballer whose image was featured in a photograph from the 2005 AFL Grand Final in federal court proceedings against the AFL and Tabcorp. It examines some of the issues raised by the case in relation to the ownership and use of a sporting personality's image and considers the difference between the jurisdiction of Australian and the USA in relation to how these types of disputes may be dealt with. There is also a brief discussion on the rise of Celebrity Branding.

Who exactly controls the rights to a sporting star's image? With Leo Barry, the Sydney Swans star, recently taking on both Tabcorp and the Australian Football League (AFL) in the Federal Court of Australia¹ for using the photograph of the contested mark of the AFL 2005 Grand Final without his consent (and Tabcorp suing the AFL for telling it that Barry's consent was not needed); many are left scratching their heads asking if Australia should now be moving to a US styled 'right of publicity' approach for celebrities and the use of their image.

In general terms, under the *Copyright Act 1968* (Cth), the original owner of copyright in a photograph is the photographer who has the exclusive right to reproduce, publish or communicate the photograph to the public. The AFL, like many other sporting bodies seeks to restrict these rights by only allowing licensed photographers to take photographs of games. This allows it to exercise commercial control by way of release, use and distribution and under the terms of any agreement with subject of the photographs (ie the players) provides a royalty reward scheme as negotiated from time to time.

The three main causes of action that Barry has pleaded in his statement of claim filed in the Federal Court of Australia on 8 December 2006 against the AFL (1st Respondent) and Tabcorp (2nd Respondent) are under the heads of contravention of the law of trade practices (and fair trading); passing off and breach of contract against the AFL under its AFL/AFLPA² Collective Bargaining Agreement signed on 23 March 2004 (CBA).

Central to the contract dispute in this case appears to be whether under the contractual terms of the CBA any royalties should be owing to Leo Barry on the basis of whether the photo of the mark uses the name, likeness or image of a 'featured player' (in which case a handsome royalty of 80% of the net receipts from the licensing activity would be payable to Barry) or not.

The CBA defines a 'featured player' as one who is "predominant or the central focus in the image and/or is central or significant to the Licensing activity". Moreover, under the CBA where 6 or more players from different teams are used in an image for a licensing activity (a 'multiple player image') the AFL under the CBA is only required to seek approval from 'featured players' and not 'surrounding players'. The question of whether or not Barry is in fact a featured player is at the heart of this dispute. Barry claims that the photograph is a 'multiple player image'; that he is the 'featured player' and in breach of the CBA the AFL did not get his approval to use his image (as required under the CBA) and failed to pay him the royalty. (Under the CBA, the AFL can only use a players name and image for licensing activities provided the AFL has obtained approval in

¹ *Leo Barry v Australian Football League & Anor* VID1013/2006

² AFLPA – Australian Football League Players Association

accordance with the terms of the AFL Licensing Operational Guidelines which form part of the CBA.)

Barry's claim against Tabcorp and the AFL is also based extensively in Australian law which protects a celebrity's image as based on the law of trade practices and an expansion in the law of passing off. Most of these cases seek to protect 'promotional goodwill' or, in short, where a celebrity image is used on a defendant's goods or services so as to mislead or deceive consumers that there maybe a 'business connection' between the celebrity and the defendant. One of the leading cases in this area was in 1989 when Paul Hogan successfully sued Pacific Dunlop for misrepresenting his character of Crocodile Dundee in relation to promotion of shoes.³ Barry claims that Tabcorp has contravened the relevant statutory sections and engaged in passing off and that the AFL 'aided and abetted' and was 'knowingly concerned' with such activities.

Under this area of law Barry will be required to establish that a misrepresentation has occurred which creates a false belief in consumers' minds that the parties (ie Barry and Tabcorp) have a commercial arrangement in respect of Tabcorp's business or wagering activities.

As part of this consideration, Barry will have the burdensome evidential requirement of establishing both proof of his reputation and damage to his celebrity arising from the use of his image in the photograph. As to his reputation Barry has pleaded in his statement of claim valuable goodwill and reputation not only in his 'name, likeness, identity and reputation' but also in that 'Spectacular Mark' of the 2005 Grand Final.

This case will have clear implications for other sports celebrities as it raises the general question of compensation for an unauthorised use of a player/celebrity image. Apart from the contractual issues under the CBA, the current proceedings are rooted squarely in considerations of 'character merchandising' considered by the courts nearly twenty years ago in the leading *Hogan* case.

By contrast, in the USA there appears to be a much more direct and streamlined legal approach which may be relevant to dealing with these sorts of disputes. Apart from our home grown celebrities, two very clear examples of the USA experience in relation to celebrity branding in the sports industry are Tiger Woods and Greg Norman which have been identified by many as some of the more successful celebrity sporting brands in the United States.

In the USA both common law and legislation recognises 'personality rights' incorporating publicity and privacy rights and this greatly assists each of these individuals to protect their respective brands arising from the 'right of publicity' should the need arise. The right of publicity in the USA essentially means the celebrity's right to the commercial value of their fame. It is considered additional to and independent of their right of privacy. It is clear under USA law that a person's name, image or other aspects of personality cannot be used without his/her consent.⁴

³ *Pacific Dunlop Ltd v Hogan* (1989) 23 FCR 553

⁴ For an example of the statutory treatment of the right to publicity in the USA, see eg the CAL CIVIL CODE §§ 3344, 3344.1 (West 1997 & Supp 2002) provides

[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases ... without such person's prior consent ... shall be liable for any damages sustained by the person or persons injured as a result thereof

This position at law is not mirrored in Australia and while no formal 'personality rights' currently exist there are options available when seeking to protect or exploit personality. A defamation suit may be available to a celebrity if it was considered that the use of the image was regarded as derogatory to the individual concerned. In addition, an action for 'passing off' or under the *Trade Practices Act 1974* (Cth) for misleading or deceptive conduct may also be available on a case-by-case basis. The test for such actions ultimately turn on whether or not the individual has a reputation and whether or not consumers would be confused or misled into thinking there was endorsement or connection to a product or service.

With many celebrities and sporting stars treating their brand development and growth in the same way that corporate enterprises do; commensurately celebrities are taking the necessary steps to defend their brand outside the courts. That means registering trade marks to protect their name, image and often signature. There has been a growing trend of late in relation to this phenomenon of 'Celebrity Branding' and it shows no sign of slowing. Had Barry registered his name and image as a trade mark then he may well have been able to plead an additional cause of action against both the AFL and Tabcorp.

While there remains to be seen before Australian courts a test case in relation to an infringement of a registered celebrity trademark, it is clear that there is a growing trend amongst celebrities to register their personality as a trademark as part of an overall strategy to protect the brand value which may be associated with his/her iconic status in the community.

While the jury may be out as to the level of impact of the deterrent power of a celebrity registered trade mark it is clear that it does offer a protection above and beyond those whose image remains unregistered. As a result, everyone in the sports industry should be aware of not only the advertising and marketing issues but also the legal implications of Celebrity Branding campaigns.

At the time of writing, Barry's case has been listed for mediation and will continue to play out before the court but maybe the quarter time siren has gone for Australian lawmakers to look to a change in image for this area of the law.

21 February 2007
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