A columnist's junket: How a Robot can breach Vanna White's personality rights

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One of the great perks of being a columnist for *Lawyers Weekly* is the fabulous boondoggles - *all expenses paid*! For example, the newspaper recently offered to pick up the entire tab for me to attend a CBA dinner and speech on advertising law on October 7, thus saving my law firm thirty three dollars and sixty four cents, plus GST. As it happens, my office is only a block or two or from the Ontario branch of the CBA in downtown Toronto so I walked over, but the point remains - *I could have taken a cab (maybe even a limo) and the paper would have picked up every nickel of my travel expenses!!*

The big event was a Canadian Bar Association Corporate Counsel section meeting - an entire room full of in-house lawyers! I meant to seize the opportunity, and give my card out to everyone there, but I lost my nerve at the last minute.

The speaker was a sole practitioner and trade mark agent, Eric Swetsky, who gave an engaging speech on basic trade mark law ("Trade-marks - what are they?") and advertising law.

Advertising law is partly a subset of intellectual property law, and partly not. The basic points are:

Misleading Advertising: there is a section of the *Competition Act* which prohibits false and misleading advertising. There are people in Ottawa who enforce it. Sometimes they can be amazingly picky. For example, if a crate says it contains 50 gallons, there could be trouble if it is not made clear *imperial* gallons are meant, as opposed to whatever the other kind of gallons is.

Contests: There are special rules about contests. Essentially, everything about a contest has to be on the up and up, otherwise the Competition Bureau will come down like a thunderbolt from Zeus. Also, if you hold a contest in Quebec you have to pay a special

fee or tax to the Quebec government, with the result that contests are often held everywhere except Quebec.

Comparative Advertising: Then there is the question of comparative advertising i.e. saying nastly things about your competitors explicitly or implicitly in ads. There has been a lot of case law on this recently, discussed in a number of my columns *passim.* I listened to this part of Mr. Swetsky's talk with interest because I recently argued a misleading advertising case, and had all the cases packed into my head, the way some people's head are packed with amazing amounts of baseball trivia. Mr. Swetsky gave an excellent summary of the leading cases, I thought. There have been some recent cases where interlocutory injunctions have been granted to stop rival advertising campaigns. More often judges, however, seem to treating these cases with scepticism, figuring that large and well-funded advertisers are able to look after themselves in the marketplace of ideas, without the court's help.

Personality Rights: Finally, Mr. Swetsky came to the most glamourous aspect of intellectual property law: personality rights, also known as "misappropriation of personality". The principle, in a nutshell, is that advertisers cannot use celebrities in ads, even indirectly through impersonators, without paying them. Mr. Swetsky told us about cases involving Bette Midler, Jackie Onnassis, Woody Allen and Vanna White (my personal favourite). In 1988, Bette Midler successfully sued Ford when it used a singer in a TV ad who sounded like her. Jackie Onassis also successfully sued Christian Dior when it used a Jackie look-alike model in an ad.

Woody Allen, however, lost because, although a lookalike was used in a video chain ad campaign, the court didn't think anyone would think Allen himself was connected with the ad. Vanna White, however, won even though the ad did not use a look-alike: Samsung used a robot in a blond wig in an ad. The robot was standing in front of a letter display like the one Vanna White uses on Wheel of Fortune on TV. The court said this misappropiated Vanna White's personality, and awarded damages. As Mr. Swatsky said, these cases are all American, but they probably would be applied in Canada.

Mr. Swetsky wisely did not get into all the cases, or we would have been there all night. But there are others: the Beatles, Cary Grant, Mohammed Ali, Joe Namath and Ann Margaret have all gone to court to enforce personality rights (Ann Margaret lost, but the others won.) There are also two older Canadian cases, *Krouse* (Hamilton Tiger Cats football player, who won) and *Athans* (water skier, who lost) that make clear that there is such a tort in Canada as misappropriation of personality.

In general, Mr. Swatsky's talk was well-received. I enjoyed it. The food wasn't bad either.

Well, that about wraps up my story on the CBA dinner. I sure enjoyed being sent into the field to cover an intellectual property story, all expenses paid. I'm planning to convince

my editor there are sure to be some some fast-breaking IP stories around the French Riviera this winter.

A final note on Prozac

Many readers will know the Federal Court of Appeal overtuned an interlocutory injunction in the Prozac case. The generic win on Prozac made even the front page of the *Globe and Mail Report on Business*, not generally known for its coverage of intellectual property litigation.

The question in many people's minds will be, how will the Federal Court of Appeal's decision on the Prozac injunction (*Eli Lilly v. Novopharm and Apotex*, September 25, 1996) affect potential future injunction applications in other tablet lookalike cases?

The reasons of the Federal Court of Appeal in the Prozac case are brief, and strictly confined to specific evidentiary points in that case. No caselaw was referred to except for a single footnote referring to the "thorough review of the jurisprudence on this issue" by Mr. Justice Wetston in *Procter & Gamble Pharmaceuticals v. Novopharm*, a case released in July of this year. An interlocutory injunction was denied in that case, after an exhaustive review of the caselaw on pharmaceutical passing off cases and irreparable harm (discussed in my last column).

The big issue for many brand name drug companies therefore will be: does the Prozac case, and the judge's wrap-up of the jurisprudence in the Procter & Gamble case, which the Federal Court seems to have adopted by reference, mean that such injunction applications have little or no chance of success in future?

Only time will tell. Most important, everyone in the pharmacetical industry will have their eyes on the upcoming five or six week long Prozac trial, due to start in early November.