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Laws and Rights: Analysing the Legal Regime of Character Merchandising in Nigeria

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Abstract

Character merchandising has grown exponentially with the advancement in technology and social media platforms. This is apparent in the increased rate of the commercial exploitation of the persona of a character. This article gives an in-depth knowledge into the legal framework of character merchandising in Nigeria by analysing the various rights embedded in the practice of character merchandising and the relevant national and international legal instruments governing same. The study employs a doctrinal approach by analysing and examining statute, case laws and exploring literature such as journals, articles, seminar papers. This article examines the existing legal regime governing the practice of character merchandising in Nigeria whilst recommending the need for the establishment of a unified sui generis legislation that will enhance and develop the practice of character merchandising in Nigeria.

Keywords: Character Merchandising, Property Rights, Personality Rights, Publicity Rights, Privacy Rights, Intellectual Property Rights.

Introduction

Advertising, influencing, endorsements are modern marketing strategies employed to enhance the growth of a business. A common factor amongst these forms of marketing strategies, is the involvement of a character. This is evident in the ever-growing act of commercially exploiting the personality of characterswhich is termed character merchandising. Character merchandising involves exploiting the personality such as the name, voice, signature, appearance, picture, catchphrase, statement, dressing, attitude, or any representation by which a character is known by the public to promote a good or service with the aim of persuading consumers to purchase the good or service to ultimately achieve increased sales and profitability.

A character can be human or non-human which may be human fictional characters or real persons. Examples of such include Jenifa played by Funke Akindele, Aki & Paw played by Chinedu Ikedieze and Osita Iheme, Taaooma played by Maryam Apaokagi, Mr Macaroni played by Debo Adedayo, Black Panther played by Chadwick Boseman, Hannah Montanna played by Miley Cyrus and Captain Jack Sparrow played by Johnny Depp. Non-human characters are

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generally fictional. They include cartoon characters like Simba from Lion King, Tom & Jerry, Mickey Mouse, Shrek and Donald Duck.

Every character whether human or non-human possesses rights vested in it by the law. These vested rights are to protect and enhance the commercial exploitation and economic value of a character. These vested rights differ in their name and nomenclature but are similar in the interests it seeks to protect. The right vested in a real person is regarded as personality rights while that vested in a fictional character isreferred to as property rights.

Following the economic benefits associated with character merchandising comes the need for a legal discourse on the level of protection given to the commercial value of a character.

Rights

Property Rights

Property rights is the protection under the law afforded to a fictional character. It vests on the creator of a fictional character economic and exploitation rights which are enshrined in intellectual property rights (IPRs) specifically, copyright, trademarks, designs. The IPRs are governed by different laws. In Nigeria, copyright is governed by the Copyright Act of 1988[1], trademark by Trademark Act 1967[2], Trade Malpractices (Miscellaneous Offences) Act 1992[3].

Personality Rights

Personality rights aim at protecting the individuality of a person which may be physical, psychological or moral in nature as expressed externally. It comprises of two common law rights which are the right to privacy and right to publicity[4]. Privacy rights is considered from the standpoint of ensuring human dignity while publicity rights are considered from the standpoint of economic or commercial value.[5] According to McCarthy, publicity rights should not beunder the confines of trademark, copyright or privacy right although they are similar in nature.[6]

Walsh contends that there seem to be a ray of hope for the effective recognition of personality rights in the United Kingdom following the expansion provided under the tort of passing off, trademark law and the breach of confidence[7]. As of now, this same assertion can however not be made for Nigeria. Unlike the United Kingdom which can be said to be lagging in creating unique legal protection for personality rights, Nigeria seems not to be even aware of the potential benefits of allowing for the exclusive control of personality rights or granting a proprietary right in a celebrity's personality.

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1 Cap C 28, Laws of the Federation of Nigeria 2004.
2 Cap T 13, Laws of the Federation of Nigeria 2004; Volume 14, Laws of the Federation of Nigeria 2010.
3 Cap T 12, Laws of the Federation of Nigeria 2004; Volume 14, Laws of the Federation of Nigeria 2010 Section 1 (a); Note, that there is a Trade Malpractices (Miscellaneous Offences) Act Amendment Bill, 2019.
4 Hazel Carty, 'Advertising, Publicity Rights and English Law' (2004) 3 I.P.Q. 209.
5 Ibid.
6 Thomas McCarthy, *The Rights of Publicity and Privacy* (2d Ed. 2000) 1:3.
7 Catherine Walsh, 'The Justifications Underlying Personality Rights' (2013) 24(1) Entertainment Law Review 17.

Publicity Rights

Publicity rights are commonly referred to as image rights in Nigeria. Jerome Frank an American judge established the term 'right of publicity' as a novel property right for the protection of the economic and commercial value of fame in 1953.[8] Before the advent of publicity rights, preventing the unauthorised commercial exploitation of an individual's persons was founded on the jurisprudential principle of human dignity and self-esteem.[9] This jurisprudential principle however did not take into cognisance individuals who were not averse to the commercial exploitation of their persona as far as they were rewarded monetarily[10]. According to Nimmer celebrities required a right to control and protect the economic value of their persona.[11]

The need for a balance of the protection of human dignity, self-esteem and financial interest gave birth to publicity rights. Publicity rights contend for the exclusive right of an individual to control the utilisation of an individual's persona without authorisation or the provision of a determined consideration.[12] An individual should have the discretion to decide the aspect of personality or individuality to be publicised or privatised.

In the American case of *Midler v. Ford Motor Co & others*,[13] the defendant intended to create a commercial for its cars using one of the songs of Bette Midler however, the advertising company's request to use her version of the song for the commercial was declined. The company, therefore, engaged Ula Hedwig one of Midler's backup singers to sing the song in such a way that it will seem like it was Midler herself singing. Midler sued Ford and they argued that Midler's name, voice, likeness or photograph was not used in the commercial. The Court however held that the act of using a 'sound-alike' is tantamount to the commercial exploitation of Midler's individuality.

Privacy Rights

The right of privacy is the right not to be disturbed, to be let alone, not to publicise a person's personality without authorisation and banning the public eye from the private affairs of a person. It is a form of self-ownership that prohibits the public from accessing the domain of the self-ownership,[14] The Report of the Committee on Privacy and Related Matters 1990 defines privacy as the right to be protected from intrusion into the personal or family affairs of an individual.[15]

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[8] Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866 (2d Cir. 1953), cert. denied, 346 U.S. 816 (1953);
S.W. Halpern, 'The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality' (1995) Hastings L.J. 853.

[9] All Answers ltd, 'What Is Personality Merchandising Philosophy Essay' (UKEssays.com,December 2021)<https://www.ukessays.com/essays/essays/philosophy/what-is-personality-merchandising-philosophy-essay.php?vref=1> accessed 6 December 2021.

[10] Ibid.

[11] Melville B. Nimmer, 'The right of Publicity' (1954) 19 L. & C.P. 203.

[12] Savan Bains, 'Personality Rights: Should the UK grant Celebrities a Proprietary Right in their Personality? Part 2' (2007) 13 Ent. L.R. 18 (6) 205.

[13] 849 F.2d 460; 57 USLW 2053; 1988 Copr.L.Dec. (CCH) ¶ 26,313; 7 U.S.P.Q.2d 1398; 15 Media L. Rep. 1620.

[14] Yinka Olomojobi, Right to Privacy in Nigeria (SSRN, 31 October 2017) <https://ssrn.com/abstract=3062603 or http://dx.doi.org/10.2139/ssrn.3062603> accessed 11 December 2021.

[15] Report of the Committee on Privacy and Related Matters 1990 Cmnd. 1102, London: HMSO 7; E.S Nwauche, 'The Right To Privacy In Nigeria' CALS Review of Nigerian Law and Practice Review of Nigerian Law and

Privacy right was established in America by Warren and Brandeis in their Article titled '*The Right to Privacy*'[16] which was occasioned by the rampancy of the intrusion of the media in the concerns of private citizens who in this circumstance was an affluent Boston socialite and the wife of Warren. The Article brought to fore the menace of the media at that time and that with the advancement in technology came novel inventions such as devices that could record, photograph and share the images and information of a person publicly[17].

Taking a cue from the copyright protection as provided under common law, they established that similar protection could be afforded to the private acts and opinions of citizens.[18]Warren and Brandeis criticised the press by explaining that the 'gossip industry' which they created, has diverted people's interest from important things in a bid to satisfy the publics unhealthy interest.[19] Privacy rights were therefore invoked from common law to protect the interest of the public from the intrusiveness of the media with their novel inventions and technologies.

Savage.[20]

Privacy rights entail elements that require effective legal protection such as 'confidential correspondence, email and internet use, medical history, personal data, eavesdropping, sexual orientation, personal lifestyles',[21] 'personal autonomy, limited access to the self, confidentiality, the management of personal information and the right of individuality and relationship[22].

Article 12 of the United Nation Declaration of Human Rights (UDHR), 1948 provides that 'no one shall be subjected to arbitrary interference with his privacy, family, home or correspondence, nor to attacks upon his honour and reputation'.[23] Everyone has the right to the protection of the law against such interference or attacks'. Similarly, the International Covenant on Civil and Political Rights (ICCPR), 1966 in Article 17 states that 'no one shall be subjected to arbitrary or unlawful interference with his privacy, family, home or correspondence, nor to unlawful attacks on his honour and reputation'.[24] Section 37 of the 1999, Constitution of the Federal Republic of Nigeria (CFRN) also guarantees 'the privacy of citizens, their home, correspondence, telephone conversations and telegraphic communications'.[25]

Comparing this provision of section 37 of the CFRN vis-à-vis the nature of personality

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Practice Vol. 1(1) 2007 (1) 2007 <Microsoft Word - CALS Review 3.doc (9jalegal.com.ng)> accessed 11 December 2021.

[16] Samuel Warren and Louis Brandeis, 'The Right to Privacy, (1890) 4 Harv. L. Rev. 193.

[17] Angela Adrian, 'What a lovely bunch of coconuts! A Comparison between Louisiana and the United Kingdom with regards to the Appropriation of Personality' (2004) 15(7) Entertainment Law Review 212.

[18] Ibid.

[19] Warren & Brandeis (n 17).

[20] She is a famous female singer in Nigeria whose sex tape surfaced the internet on October 18 2021. LagosLife_ng, 'Full Video: Tiwa Savage Sex Tape Hits Internet' (LagosLife_ng, October 19, 2021) <https://lagoslifeng.com/2021/10/19/full-video-tiwa-savage-sex-tape-hits-internet/> accessed 12 December 2021.

[21] Yinka Olomojobi, Right to Privacy in Nigeria (SSRN, 31 October 2017) <https://ssrn.com/abstract=3062603 or http://dx.doi.org/10.2139/ssrn.3062603> accessed 11 December 2021.

[22] Daniel J. Solove, Understanding Privacy (Harvard University Press, 2008) 39.

[23] This is available at <Universal Declaration of Human Rights | United Nations> accessed 11 December 2021

[25]This is available at https://publicofficialsfinancialdisclosure.worldbank.org/sites/fdl/files/assets/law-library-files/Nigeria_Constitution_1999_en.pdf > accessed 12 December 2021.

merchandising reveals that this law is restrictive because it does not adequately provide protection for the owner of a persona. Proving a breach of privacy rights as it relates to personality rights in Nigeria requires conviction in court. The conviction is such that requires persuading the court to be able to construe that the right to privacy as provided in section 37 extends to the use of the private aspect of an individual's personae for economic benefits without authorisation. The fate of a celebrity whose personality rights has been infringed is therefore left to the discretionary understanding and inclination of the court.

With the protection of personality rights, Article 12 of the UDHR and Article 17 of the ICCPR can be regarded as a more viable legal protection in Nigeria because these provisions go further to expressly entrench the privacy rights by stating that it is unlawful to attack a person's honour and reputation. These can be interpreted to mean that the expression of an individual's personality should be effectively protected with the individual having exclusive control of the personality and confidential information.

Megwara in analysing the provision of section 37 interprets it to mean that every Nigeria citizen has the right to: live an isolated life, be discreet about social, sexual, marital relationships, hide nudity from the public and the ownership and use of the body[26]. This interpretation aligns with the practice of character merchandising as it recognises the right to the ownership and use of the body which could be said to include the persona of an individual. This is possible if the court is convinced to align with the interpretation given by Megwara.

Section 14 of the Freedom of Information Act, 2011 also makes provision for privacy rights in Nigeria specifically it states that:

'(1) Subject to subsection (2); a public institution must deny an application forinformation that contains personal information and information exempted under this subsection includes -

(a) files and personal information maintained with respect to clients, patients, residents, students, or other individuals receiving social, medical, educational, vocational, financial, supervisory or custodial care or services directly or indirectly from public institutions;

(b) personnel files and personal information maintained with respect to employees, appointees or elected officials of any public institution or applicants for such positions;

(c) files and personal information maintained with respect to any applicant, registrant or licensee by any government or public institution cooperating with or engaged in professional or occupational registration, licensure or discipline;

(d) information required of any taxpayer in connection with the assessment or collection of any tax unless disclosure is otherwise requested by the statute; and

(e) information revealing the identity of persons who file complaints with or provide information to administrative, investigative, law enforcement or penal agencies on the commission of any crime.

(2) A public institution shall disclose any information that contains personalinformation if -

[26] Lloyd Megwara, The Law and Practice of Human Rights in Nigeria (Olive Printing & Publishing House, 2010) 202.

(a) the individual to whom it relates consents to the disclosure; or

(b) the information is publicly available.

(3) Where disclosure of any information referred to in this section would be in the public interest, and if the public interest in the disclosure of such information clearly outweighs the protection of the privacy of the individual to whom such information relates, the public institution to whom a request for disclosure is made shall disclose such information subject to section 14 (2) of this Act.

This section prohibits the unauthorised release of the personal information of a person by a public or private institution which provides a public service. These institutions are expected to keep the information of individuals in their custody with utmost confidentiality and trust. Section 14 (1) expressly provides that an application to procure private information must be denied. An exemption to this rule is provided in section 14(2 &3) to the extent that consent was given by the individual, the information is in the public domain and the interest of the public outweighs the interest of the individual to be protected.

In the case of *Woodward v Hutchinson*[27]which involved a breach of privacy based on the publication of the private information of the plaintiff by the defendant. Lord Denning MR established that in determining a claim of the breach of privacy rights as regards the release of confidential information there is need to create an equilibrium between the private interest of upholding confidence and the public interest of being aware of the truth.

As opined by Justice Cobb in the case of *Pavesich v. New England Life Insurance Company,*[28] privacy right is fundamental to the wellbeing and existence of every individual and society. Despite this assertion, there is a paucity of privacy litigation in Nigeria as Olomojobi puts it, Nigerians tend to endure, ignore and overlook acts that breach their privacy rights.[29] A recent example is the case of Tiwa Savage.[30]

Laws

Nigeria is one of the many countries which relies on several piecemeal legislation to protect character merchandising due to the lack of a unified *sui generis* legislation.

Copyright

Section 1 (a-f) of the Nigerian Copyright Act, 1988 provides for the works eligible for copyright. They are literary, musical and artistic works, cinematograph films, sound recordings and broadcasts. The protection of fictional characters under copyright in Nigeria,thus, come under literary works, artistic works and cinematograph films. Section 2 of the Copyright Act state that:

‘(2) A literary, musical or artistic work shall not be eligible for copyright unless-

(a) sufficient effort has been expended on making the work to give it an original character;

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[27] [1977] 2 All ER 751.
[28] [1904] 122, Ga. 190, 201.
[29] Olomojobi (n 22).
[30] She is a famous female singer in Nigeria whose sex tape surfaced the internet on October 18 2021. LagosLife_ng, ‘Full Video: Tiwa Savage Sex Tape Hits Internet’ (LagosLife_ng, October 19, 2021) <https://lagoslifeng.com/2021/10/19/full-video-tiwa-savage-sex-tape-hits-internet/> accessed 12 December 2021.

(b) the work has been fixed in any definite medium of expression now known or later to be developed, from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of any machine or device.

This provision set out the criteria to be fulfilled before a work can be protected under copyright and this applies to the protection of a fictional character. It can be deduced from the foregoing that for a fictional character to be protected under copyright it must originate from a creative endeavour, be original and must be in a fixed form. For an artistic work, it must not be a prototype for a work to be created for mass production and must not have originated from an infringement.

Further, the fictional character must possess a distinct nature such that it has its own reputation and goodwill from the public. Distinctiveness and notoriety are the two elements that make the name of a fictional character eligible for protection under copyright.[31] Generally, a character's name is not protected under copyright unless proven that the character is distinguished from the work.

Schedule 1, Clause 1 of the Act provides that a work is guaranteed copyright protection during the lifetime of the author and seventy years after death after which it falls in the public domain and can be used by anyone provided the moral right of the author is respected. The seventy-year timeframe limits the creator's economic right however there is a need to create an equilibrium between an author/creator's economic and commercial right and the public's socio-cultural right to a creative expression/work.

Fictional characters protected as a literary work include characters in a comic strip such as Shegs from Supa Strikas, Tintin[32] and characters from Novels adapted to cartoons in movies or comic strips such as Alice in Wonderland and the Adventures of Pinocchio.

Fictional characters protected as an artistic work such as characters created for the purpose of merchandising are also protected under copyright. An example is the Fido Dido character, which was exploited by Fido Dido Inc. to merchandise Seven-Up; the character Zuzu used in promoting the Vodafone brand, characters from famous paintings such as Mona-Lisa by Da Vinci and the paintings of Raja Ram Mohan Roy. Fictional characters protected as a cinematography film include characters created as cartoon characters for films, movies Simba from Lion King, Frozen[33], Tom & Jerry, Mickey Mouse, Donald Duck, Star Wars[34], robots, sculptures, puppets, dolls used for films, musical or television shows. These include characters created for children television shows like Barney, Coco Melon and characters who originated from a film and subsequently adapted as cartoons like Zorro.

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[31] World Intellectual Property Organization,'Character Merchandising' (Report of International Bureau, 1994) (n 36)16, 17.

[32] Tintin was created in 1929 in a comic strip by a Belgian cartoonist called Georges Remi.

[33] Over $5 billion worth of frozen merchandise was sold in 2014.

[34] Over $243 million worth of merchandise from the film Star War: The Force Awakens was sold in 2015 and only the books sold over $ 2 million; Paul Bond, 'A Breakdown of 'Star Wars' Merchandise Sales This Year' The (Hollywood Reporter, 17 December 2015) <http://www.hollywoodreporter.com/news/a-breakdown-star-wars-merchandise-849861> accessed 6 December 2021.

The copyright protection for a cartoon character is not limited to just the original work but to every carriage, pose and posture of the character created. The protection given to creators/authors of fictional characters under copyright gives them the right to control how the feature of the character is reproduced and distributed whilst profiting from same.

To the extent that the protection afforded under copyright is for a work in a fixed and tangible form, copyright cannot effectively protect a character from an unauthorised merchandising. This is because the character's personality being used for the unauthorised act of merchandising may not necessarily be expressed in a fixed form.

Another limitation is that copyright protection is given only to the author/creator of a work, meaning that only they can bring an action for infringement. In a situation where an infringement is done in respect of a particular character, the character can only sue with the aid of the creator who owns the work and copyright protection.

If for example, the persona of the fictional character Jenifa is used, Funke Akindele in suing for an infringement may have to rely on the producers. This is because producers of film are usually the owners of the copyright of the movies or music videos. Creators/authors may not be the character even though they own the copyright of the character who gets the popularity and the fame. The need to therefore rely on them can be limiting for the characters and exhausting for the producers. Imagine, that 80% of the characters in a cinematographic film need the help of their producer to sue for the unauthorised use of their persona.

Copyright in a photograph or artistic work is vested in the photographer or artist being the creators of the work[35]. If such works are deceptively used to endorse or promote a good or service, the celebrity cannot sue under copyright because there is no protection provided. A practical example is the case of Ayo Makun (AY), a celebrity comedian and a film distributor. AY's image was used to promote a movie titled; The Number One Fan which was being marketed as Inspector AY.[36] He stated that he merely played a supporting role and had no agreement that his brand will be used to promote the movie. Copyright might not be the best legal remedy if he does not own the copyright in the photograph used by the distributor.

The whole idea that copyright can protect the persona of an individual has been opposed by the English courts as exemplified by the Whitford Committee in 1977[37] and the case of *Exxon Corp v Exxon Insurance Consultants International Ltd*,[38] where it was established that a character claiming copyright protection under literary work must prove that it 'conveys an information, instruction or pleasure'. Considering that Nigerian courts tend to apply and incline to the decisions of the English Court, it might be impossible for there to be any protection under copyright.

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[35] Copyright Act 1988, Cap C 28, Laws of the Federation of Nigeria 2004, s 29.
[36] Segun Aluko, 'Nollywood May Be Ready for Its "First Big" Right of Publicity Lawsuit' (LinkedIn, 28 September 2015) <https://www.linkedin.com/pulse/nollywood-may-ready-its-first-big-right-publicity-lawsuit-segun-aluko/> accessed 5 December 2021.
[37] The Report on the Law of Copyright and Designs. HMSO, 1977. Cmnd.6732.
[38] [1982] R.P.C. 69.

Passing Off

Passing off prevents misrepresentation such that may lead to confusion, damage of goodwill or reputation. Lord Diplock in the case of *Erven Warnick* v. *Townend*[39]provided five conditions to be met to establish a case of passing off. There must be a misrepresentation, done in the course of a trade or a particular good or service, to mislead potential consumers of the good or service, which adversely affects the goodwill of another business and has occasioned damage to the goodwill or business.[40]

The condition of the 'common field of activity'was established in the case of *McCulloch v Lewis A May (Produce Distributors) Ltd*[41]as an additional requirement for a successful claim for Passing off. In this case, the plaintiff was a radio presenter with the nickname **Uncle Mac** which the defendant company was using to promote its cereal. The plaintiff sued to stop the promotional act but was unsuccessful because according to Judge Wynn-Parry, there was no component of Passing off considering that they each operated in different fields of business.

The tort of Passing off is not without its limitations, the doctrine of the common field of activity can be said to be a tool use to bypass regarding character merchandising as a mercantile and lucrative endeavour. This is because it is difficult for a celebrity to prove that there is a common field of activity considering that there is no involvement in the particular trade, good or service but merely a necessity to prevent the unauthorised use of their persona for the promotion or advertisement of good or service.[42]

Celebrities have tried to find a way around the common field of activity doctrine by emphasising that the misrepresentation that they endorse a good or service is likely to confuse and mislead consumers. This has been debunked by the courts on the premise that the merchandising of souvenirs or memorabilia is not tantamount to Passing off because the consumers are not concerned if the souvenir is affiliated to the celebrity but bought it because it has the image of the celebrity on it.[43] This position is contentious in that the reason the memorabilia is purchased is because of the celebrity which is a commercial misappropriation of the celerity's persona.

Passing off was established as a 'means of protection for the right of property, which exist not only in a particular name, mark or style but in an established business, commercial or professional reputation or goodwill.'[44] However, the evidential burden of proof makes it so limited rather than protecting the character, it could be said to promote unfair trade competition and deceit. The conditions which establish passing off include trading in the same good or service, the mark must possess goodwill and reputation,[45] there must be misrepresentation by the

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[39] (1980) RPC 31.
[40] These conditions were also applied in *Reckitt & Coleman v Borden* [1990] R.P.C. 340; HL p.499.
[41] [1948] 65 R.P.C. 58.
[42] Savan Bains, 'Personality rights: should the UK grant celebrities a proprietary right in their personality? Part 1' (2007) 18(5) Ent. L.R. 165.
[43] *Lyngstad v Anabas Products* [1977] F.S.R. 62; *Harrison and Starkey v Polydor Ltd* [1977] F.S.R. 1; *Wombles Ltd v Wombles Skips Ltd* [1977] R.P.C. 99.
[44] Salmond & Heuston, *Law of Torts* (20th edn, Sweet & Maxwell 1992) 395.
[45] In *BBC Worldwide Ltd & Another v. Patty Screen Printing Ltd andOthers* [1998] F.S.R. 665, the court emphasised the importance of the plaintiff proving that the character had developed a 'reputation' in connection with merchandising.

unauthorised user whether mistakenly or intentionally, a likelihood of confusion to the consumers of the goods and a resulting damage. Proving this is difficult and expensive.[46] However, the applicable principle is that if there is no proof; no remedy can be given to the owner of the mark.[47]

In *Irvine v Talksport*[48], the court deviated from applying the doctrine of the common filed of activity'. In this case, the permission to use the picture of Eddie Irvine a Formula I driver was obtained by the defendant. However, in its use of pictures on the defendant's brochure covers the picture has been adjusted to make it seem that the phone he was originally holding was a radio with the inscribed words 'Talk Radio'. The plaintiff sued the defendants for passing off and the court held that the plaintiff sufficiently proved that he had goodwill and reputation and the doctrine was not applied by Laddie J. The case of Irvine is a light to the protection offered by Passing off. If a celebrity can prove the element of misrepresentation and goodwill, then there is a likelihood of success under Passing off however this is limited specifically to endorsement as a form of character merchandising.

In 2016, the image of Richard Mofe Damijo (RMD) a Nigerian Actor was used by Jumia an online retail store to promote its fashion page. If the instant case, was taken to court and decided in line with the dictum of Laddie J., RMD may be successful in his claim and entitled to compensation. However, if the AY's case is brought under the tort of Passing off, the case may also be successful if the court is inclined to tow the path of Laddie, J.

Trademark

Section 67 of the Trademark Act 1994 defines Trademark as 'except in relation to a certification trademark, a mark used or proposed to be used in relation to goods to indicate, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as a registered user to use the mark, whether with or without any indication of the identity of that person and means, in relation to a certification trademark, a mark registered or deemed to have been registered under section 43 of this Act'.

Section 9 of the Act further provides:
'Distinctiveness needed for registration in Part A

(1) In order for a trademark (other than a certification trademark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars-

(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being, according to its ordinary signification, a geographical name or a surname;

(e) any other distinctive mark:

[46] Moulton (n 178).
[47] Wombles v Wombles Skips [1975] RPC 99.
[48] [2002] 1 WLR 2355 at 2368.

Provided that a name, signature or word or words other than such as fall within paragraphs *(a)* to *(d)* of this section, shall not be registrable under paragraph *(e)* of this section, except upon evidence of its distinctiveness.

(2) For the purposes of this section, 'distinctive' means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade, from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

An analysis of the foregoing provision of the law connotes that the trademark law was made primarily for businesses, organisation to protect their commercial brand of their organisation, goods and services. However, the name of a character can be registered as a trademark, but the proposed name must meet the criteria of distinctiveness such that it acts as an indicator of origin of the good or service. Distinctiveness means the name must not be descriptive or generic in nature.

Considering the nature of the fame and popularity attached to celebrities, it is almost impossible to meet the criteria of distinctiveness. In cases of character merchandising, the character is associated with the good or service such that it becomes the indication of the quality. This is because the name is more likely to be seen by the public as an indicator of the quality of a good or service which connotes descriptiveness rather than distinctiveness and such name may not be registered as a trademark.

This was exemplified in the Japanese case of *Ate My Heart Inc. v Commissioner of the JPO,*[49] Lady Gaga a renowned singer on the 28 March 2011 applied to register the mark LADY GAGA under Class 9 which provides for phonographic records, downloadable music files, cinematographic and projection films, pre-recorded video discs and videotapes with the Japan Patent Office (JPO) though her company Ate My Heart Inc. The JPO rejected the application stating that the mark, LADY GAGA was not distinctive and it had the likelihood of misleading the public if used for goods not connected with Lady Gaga. This means that the mark will act as an indicator of quality rather than an indicator of origin. Ate My Heart Inc. appealed to the Intellectual Property High Court which affirmed the decision of the JPO stating that the mark was a popular name in Japan as the name of the famous female singer based in the United States of America. The Supreme Court of Japan declined to hear the appeal and upheld the decision of the JPO and High Court rejecting to register the mark.

Where the character is not the origin or source of the good or service, the trademark becomes irrelevant and inapplicable. Further, trademarks are registered in connection to a particular good or service. In Nigeria, there are 45 classes of goods or services which is in accordance with the Nice Agreement of 1957. This means that an infringement can only arise when the trademark was used in line with the class of good or service registered.

[49] [2013] Gyo-Ke 10158; Appeal No. 2011-27961).

Some Nigerian celebrities have been successful in crossing the hurdle of distinctiveness, indicator of origin and have trademarked their names or nicknames. Actress, Omotola Jalade-Ekeinde, trademarked her name 'Omotola', Erica Nlewedim, who was a contestant in the Big Brother reality tv show, trademarked her nickname 'Star Girl', music artiste Ayo Balogun (Wizkid) also trademarked his nickname 'Star Boy'[50].

Conclusion and Recommendations

Despite the exponential growth of character merchandising, the effective protection of the rights encapsulated therein is still problematic. It seems like it is better to have piecemeal protection than none at all, even though the legal protection afforded may not survive nor stand the test of an adjudication process neither can it effectively protect the nature of interests evident in the practice of character merchandising; personal, reputational, mental, economic and monetary.

The reliance on piecemeal legislation to protect character merchandising is a façade which poses several challenges to its practice as the existing laws are characterised by restrictions that limit its effective practice. For instance, copyright vests protection in the author of a work, this means that no protection is afforded to a character that does not own the work. The provision of the existing legal regime also has a narrow interpretation in its application which leads to the loss of economic, reputation and monetary value to the character.

This research, therefore, advocates for the establishment of *sui-generis* unified legislation which is bespoke to the practice of character merchandising in Nigeria and can be utilised to encourage creativity, innovation, economic gain and the socio-economic development of Nigeria.

[50] Steve Austin Nwabueze and Theodora Olumekor 'Beyond the Runway: Understanding the Scope of Image Rights Protection Under Nigerian Law' (International Bar Association, 18 August 2021) <https://www.ibanet.org/image-rights-protection-nigerian-law> accessed 27 September 2021.