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Can I use the image or trademark of a “deleb” for advertising purposes?

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A recent Supreme Court judgement in the Dalí case shows clear respect for trademarks but raises some questions regarding image.

A great many brands have used in their advertising campaigns the images of people who, despite no longer being alive, continue to have considerable selling power. There are even marketing studies which show that advertising campaigns that link the products or services being advertised to deceased celebrities are more effective.

Each year, Forbes magazine publishes its [ranking of the dead celebrities](#) who, through the exploitation of their image, generate most revenues (the so-called “delebs” or dead celebrities). The exploitation of the image of Marilyn Monroe, for example, despite the time which has passed since her death, has come to be valued at over 15 million dollars, and Elvis Presley’s image rights generate an average of 55 million dollars each year.

On the other hand, trademarking an artist’s name is common practice, particularly in the modern art market. “Picasso” or “Dalí”, for example, are registered trademarks, and these trademarks are generally owned by an artist’s heirs.

This practice seeks to extend protection of the figure of the artist beyond their death, designating a series of goods and services, usually to cover merchandising or an exhibition of artworks. Indeed, it is entirely possible to trademark a name and this is recognized in the European Union Trade Mark Regulation under article 4, as a sign of which a European Union trade mark may consist, and article 53.2.a), as a relative ground for invalidity, where it enters into conflict with a right to a name.

One of the questions raised is: Can the images of deceased celebrities be used without authorization?

Unfortunately, the regulation in Spain of post mortem image rights is very vague, leading to much uncertainty in its interpretation. The provisions of Organic Law 1/1982 of May 5, 1982 on the civil law protection of the right to honor, personal and family privacy and one’s own image (Organic Law 1/1982) refers only to the post mortem protection of publicity rights, and simply stipulates

which persons are legally entitled to prevent the use of the image of the deceased for which no authorization was given during his/her lifetime. It makes no mention, however, with respect to the post mortem transfer of the economic aspect of publicity rights.

Accordingly, the rights relating to a subject's personality are extinguished upon his/her death, it being only the memory of the deceased which is afforded protection.

According to article 4 of Organic Law 1/1982, actions seeking the protection of the fundamental own image rights of deceased persons may be brought by whomever the deceased named for this purpose in his/her will, or failing this, by his/her spouse, ascendants, descendants or siblings who are alive at the time of death. Failing all of the above, it is up to the Public Prosecutor to bring such actions, acting either *ex officio* or at the behest of any interested party, although no more than eighty years must have passed since the demise of the subject concerned.

The Constitutional Court sustains that when the holder of such rights dies and his/her personality is extinguished—pursuant to article 32 of the Civil Code—rights of a strictly personal nature such as publicity rights also cease to exist. A person's death implies the extinguishment of his/her personality, meaning that the object worthy of protection under constitutional law no longer exists. However complex a task this may be, it is therefore necessary to draw a distinction between the protection of the memory of the deceased and the economic rights relating to a person's image.

The Supreme Court had been recognizing the protection of image rights, both with respect to the strictly personal aspect protected under article 18.1 of the Spanish Constitution and to the economic aspect: “*a set of rights relating to the commercial exploitation of the image*[1]”, apparently protected under Organic Law 1/1982. Precisely this economic aspect was protected, even where it had been contractually assigned to third parties.

A recent Supreme Court judgement of June 20, 2016[2] in respect of the unauthorized exploitation of the image of Salvador Dalí, also raises some interesting questions with respect to the post mortem protection of publicity rights.

The case related to an exhibition of the so-called “Clot Collection” sculptures by Salvador Dalí at the Real Círculo Artístico de Barcelona. Visitors to the exhibition were given the opportunity to purchase a range of products which included the name and image of the famous Catalan artist. His image was also used in the promotion of the exhibition in a variety of forms. The Dali Foundation brought actions for the unauthorized use of publicity rights, in addition to actions for the infringement of trademarks and intellectual property rights.

The Barcelona Court found that trademark and intellectual property rights had been infringed but it dismissed the claims of violation of image rights on the grounds that the plaintiffs lacked the necessary legal standing.

The Plenary session of the Supreme Court's Civil Law Chamber concluded that since Dalí's will contained no express provision designating the person by whom the actions envisaged in Organic Law 1/1982 should be exercised, the foundation lacked the necessary legal standing, meaning that an action could only be brought by the Public Prosecutor. The Supreme Court also held that the Foundation did not seek to protect Dalí's memory but rather to exploit the strictly economic aspect of his image.

The ground on which the cassation appeal was based was also dismissed because the appellant was

seeking protection not of the deceased's memory, but of interests of a strictly economic nature which fell outside the scope of the protection corresponding to such memory according to the terms of the said law.

In relation to the economic content of publicity rights, the judgement in question echoes the judgement of the Constitutional Court no. 81/2001 of March 26, 2001, which affirmed that: *“The protection of the economic, financial or commercial value of the image affects legal interests other than those attaching to personality rights, and **although such interests are worthy of protection and are indeed protected**, they do not form part of the content of the fundamental right to one's own image referred to in article 181. The injury caused to the memory of the deceased, just like an infringement of the fundamental right to one's own image when he/she was alive, can be sustained through the “use of the name, voice or image of a person for advertising, commercial or similar purposes” (article 7.6 of Organic Law 1/1982).”*

The conclusion to be drawn in the light of this judgement would appear to be that the mere use of a person's image for commercial purposes is not sufficient to constitute an unlawful violation of the right, since there is an additional requirement to be met: injury caused to the deceased's memory. From a business viewpoint, the existence of an injury to the memory of a deceased person is clearly difficult to establish.

With respect to trademarks, in this case the defendant claimed that the use of the “Dalí” sign on shoulder bags, posters and brochures was not use “as a trademark.” The Barcelona Provincial Appellate Court recognized that the owner of the “DALÍ” trademarks cannot prevent any use whatsoever of the term, but it may do so when it is used to designate certain goods and/or services for which the trademark is registered. In this connection, the use of the “Dalí” sign as the title of the exhibition is clearly use as a trademark.

Nonetheless, this raises an interesting scenario, that is, how to determine the limits on the use of an artist's name that has been trademarked.

The judgement once again leaves a number of questions unanswered. The subject of post mortem protection of image rights continues to raise many unresolved issues and generate much legal uncertainty.

Having said this, it should also be borne in mind that protection of publicity rights can be sought through other more generic channels, such as an action for “misappropriation of another party's reputation” under the unfair competition law.

The above comments relate to the Spanish legal system. In comparative law, this is an even more complex field since there is no single generally accepted concept of either image rights or their post mortem protection. What this means, in practice, is that the legal framework applicable in each territory in which the deceased person's image is to be used must be examined, in order to establish whether prior consent needs to be obtained.

[1] Supreme Court judgement of November 28, 2007.

[2] Supreme Court judgement no. 414/2016.

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