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Commercial Law Update

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# Sir Donald Bradman: A "loved and missed family member" or a "brand name like 'Mickey Mouse'"?[1]

*It is well understood that a celebrity is entitled to exploit their own name for commercial gain during their lifetime by offering product endorsements. That right arises because of the skill, effort and investment they have put into establishing their public profile. After the death of the celebrity, unless they have assigned those rights to a third party during their lifetime, or left them to a third party in their will, their estate enjoys that right. A current case involving the name of the late Sir Donald Bradman highlights the tension that can arise between short-term commercial exploitation of the name and protection of the reputation upon which the future value of the name depends.*

## Summary dismissal of claims in tort and contract reversed on appeal

Sir Donald Bradman had, during his lifetime, assigned his rights in his name to the Bradman Museum Trust. The executors of the late Sir Donald's estate (who include his son John Bradman) won the right in March this year, following an appeal to the Full Federal Court of the Supreme Court of SA,[2] to further pursue their suits in tort and contract against Allens Arthur Robinson (AAR), the solicitors who advised Sir Donald in setting up the trust, in spite of the fact that they are well out of time in bringing these claims according to the *Limitations of Actions Act 1936* (SA).

## The first instance decision

At first instance, AAR had obtained an order for summary dismissal in respect of the executors' claims for negligence and breach of retainer. (AAR had accepted that the executors' additional claim against it in respect of breach of fiduciary duty "must proceed to trial").[3]

Some of the executors' claims were so old that they had expired during the lifetime of the deceased. However, the executors maintained that despite considerable correspondence between the estate and AAR in relation to disputes they were having over the Bradman Foundation's use of Sir Donald's name in the years following his death in 2001, they hadn't ascertained the precise role of AAR in relation to AAR's retainer with Sir Donald until John Bradman read the website profile of Jim Dwyer (the relevant AAR partner) on 2 August 2007, where he claimed that "for over 10 years he acted as legal advisor to Sir Donald Bradman."[4]

The judge at first instance, Kourakis J, had dismissed the executors' claims against AAR in tort and contract summarily[5] on the basis that the executors had "no reasonable prospect of establishing an entitlement of extension of time in which to institute those actions, pursuant to s 48 of the *Limitations of Actions Act 1936* (SA)".[6]

### Footnotes

1 AAP has reported at www.legalonline.thomson.com.au that this was the Bradman family description in 2005 when initially protesting the foundation's decision to licence an Australian food company to market "Bradman" chocolate chip cookies in India. A mediation, conducted at the end of 2006, between the family and the foundation was apparently inconclusive, and has culminated in the current proceedings.

2 ***The Estate of the Late Sir Donald Bradman v Allens Arthur Robinson*** (2010) 107 SASR 1; [2010] SASC 71; BC201001700.

3 Above note 2 at [2].

4 Above note 2 at [101].

5 ***Bradman v Allens Arthur Robinson*** (2009) 103 SASR 438; 262 LSJS 52; [2009] SASC 80; BC200901986

6 Above note 2 at [1].

Vanstone J, in dissent in the Court of Appeal, found the website profile to be so general and non-specific that it was "more of a boast than an admission"[7] and therefore not capable of allowing John Bradman (and through him the other executors) to ascertain anything about the nature of the retainer that he did not already know. Her Honour also upheld the summary dismissal of the claims on the basis that it was not open to executors to "ascertain" something after the deceased's death that the deceased knew when he was alive (ie, that AAR were his solicitors), so as to "enliven the s 48 discretion"[8] to extend the time for bringing the claims.

## The Court of Appeal majority view

The majority of the Full Federal Court disagreed with the judge at first instance and felt he did not give due consideration to the complexity of the issues and the ambivalence of the evidence in entering summary judgment.

## The executors' concerns in this case

In seeking to protect the deceased's name from what they regard as inappropriate commercial use, the executors are no doubt motivated by what they see as their duty to protect the deceased's reputation.

To seek to curtail commercial exploitation of the deceased's name in order to protect the deceased's reputation at first glance seems the opposite motivation, but is no less legitimate than the reasons a celebrity has for trying to protect their own name during their lifetime against misuse by third parties.

The celebrity's rights in that regard have often been described as the right to protect their skill, effort and investment, or, in other words, to exclusively exploit (or presumably alternatively ***not*** to exploit) their own name and reputation by offering product endorsements and the like. The executors of the Bradman estate clearly feel that over-exploitation of the Bradman name has the potential to damage the reputation on which it is founded.

## Concerns of executors who have control over the celebrity name

Executors of celebrity estates have also acted to prevent the deception of consumers, such as in the NSW case brought in 2003–04 by the estate of the late Diana, the Princess of Wales,[9] where the law of passing off and misleading and deceptive conduct was invoked to stop a florist from trade marking roses in a manner which may have led consumers to believe they had an association with the late Princess.

## The twist in this case – the executors lack control over the name

The twist in the current Bradman case is that the intellectual property rights in the name of the deceased, including the trade marks he had registered in his name and his signature, were transferred by Sir Donald to the newly formed corporate trustee of the trust, the Bradman Foundation, back in 1994 (seven years before his death in 2001, aged 92) and therefore never became part of his estate.

## How Sir Donald approached the protection of his own name during his lifetime

Sir Donald was active in protecting his own name during his lifetime, even up to the last years of his life.

In 2000, he had AAR commence proceedings[10] against property developers using his name as their company name. The Bradman Foundation, as the registered proprietor of the relevant trade marks, was the second plaintiff in those proceedings. However, the plaintiffs were able to drop that action when the then Prime Minister (and noted cricket tragic) John Howard took the unprecedented step of adding Sir Donald's name to the list of prohibited names in the Corporations Act regulations.[11]

### Footnotes

7 Above note 2 at [179].

8 Above note 2 at [188].

9 ***McCorquodale v Masterson*** (2004) 63 IPR 582; (2004) AIPC 92-033; [2004] FCA 1247; BC200406282.

10 www.aar.com.au.

11 Corporations Act Regulations 2001, Sch 6, r 6203(e). Mary MacKillop's name has this year also been added to this list. Saint Mary and Sir Donald are the only two individual Australians whose names are protected in this way. Like a member of the Royal Family, if, in the context in which it is used, a proposed company name suggests a connection with them, it will be unacceptable for registration.

It seems likely that Sir Donald knew exactly what he was doing when he set up the foundation and signed over the rights to his name to it in 1994. Whether he was properly informed of the consequences of his actions is, of course, the central issue of the current proceedings.

## Was there a conflict of interest?

Apparently while he was alive, the foundation consulted Sir Donald "regularly regarding the commercial use of his name and likeness" and "took into account his views".[12] Clearly, the executors feel this practice should not have ceased on his death. As things stand, they allege, amongst other things, a conflict of interest in AAR having advised Sir Donald and the foundation at a time when they had competing interests.

## The future of the proceedings

The executors will have the chance to present their claims in tort and contract at a future hearing in the Supreme Court of SA, provided that they are able first to convince the court to extend the limitation period.

It looks like that hearing will not take place until well into the year. The matter has been assigned a special classification under the SA Supreme Court Civil Rules, and White J has been assigned to supervise its conduct to the point of trial.

### Footnotes

12 Above note 2 at [5].

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