

THE REPUBLIC OF UGANDA
IN THE HIGH COURT OF UGANDA SITTING AT KAMPALA
(COMMERCIAL DIVISION)
CIVIL SUIT No. 0317 OF 2011

5 **PRO-LINE SOCCER ACADEMY LIMITED PLAINTIFF**

VERSUS

1. **MTN UGANDA LIMITED }
2. M/s CQ SAATHI & SAATHI } DEFENDANTS
10 3. FUFA (UGANDA) LIMITED } THIRD PARTY**

Before: Hon Justice Stephen Mubiru.

JUDGMENT

a) The Plaintiff's claim;

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The plaintiff is a private limited liability company undertaking the business of promotion and development of the game of soccer in Uganda. The 1st defendant is a communications company, while the 2nd defendant is a firm operating as an advertising agency. By an agreement dated 4th July, 2007 between eight members of the national soccer team, the “Uganda Cranes,” and the plaintiff, the latter was authorised to enlist contracts for the commercial use of their images at a negotiated consideration. Subsequently, by an agreement dated 7th September, 2007 between the plaintiff and the 2nd defendant, the plaintiff undertook to procure eleven members of the “Uganda Cranes,” to pose for a series of photoshoots the products of which were to be used exclusively in advertising and promotional activities of the 1st defendant for a period of one year, expiring on 8th September, 2008. It was agreed that for the image rights of the eleven team members of the “Uganda Cranes” so procured, the plaintiff was to be paid a sum of shs. 114,120,000/= part of which was free air time worth a total of shs. 21,120,000/= to be availed the participating team members for the duration of the contract.

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As agreed, the plaintiff availed the 2nd defendant the eleven “Uganda Cranes” team members who then were engaged in the episodes of photoshoots. The photos so generated were over the duration of the contract used in advertising the 1st defendants across multiple media platforms, including the print media, the electronic media, and online. The images were also distributed nationwide and

displayed in various forms in shops, offices, business premises and in other private and public spaces, with the slogans such as, “One Team, One Dream,” and “it is more than just a game, it’s a passion.” Despite the contract between the plaintiff and the 1st defendant having expired on 8th September, 2007 the 1st defendant continued to use the images in its advertising and promotional activities. The plaintiff contends that the 1st defendant’s continued use of the images after expiry of the contract without its consent, constitutes an infringement of the image rights vested in it by the eleven “Uganda Cranes” team members. Through the agency of the 2nd defendant, the 1st defendant was bound by the agreement of 7th September, 2007. The 1st defendant was both the principal and beneficiary of that contract. The plaintiff therefore seeks recovery of shs. 342,360,000/= for that violation for the period commencing from 8th September, 2007 to 8th September, 2011 and general damages for the period thereafter until the stoppage of the infringement, general damages for breach of contract, interest and costs.

b) The 1st defendant’s defence to the claim;

In its written statement of defence, the 1st defendant contends the plaintiff has no cause of action against it. The 1st defendant is not bound by the contract between the plaintiff and the 2nd defendant since it is not a party to the agreement. Since the month of May, 2007 the 1st defendant has had a sponsorship arrangement with the Federation of Uganda Football Associations (FUFA), by which the federation granted the 1st defendant rights to feature images of team members, individually or as a team, of the “Uganda Cranes,” in its advertising and promotional activities. By that agreement the 1st defendant obtained property in the images and their use had not violated any rights of the plaintiff. Whatever promotional material the plaintiff is complaining of, was duly generated and used in accordance with the sponsorship arrangement it has with FUFA. It is only the 2nd defendant against which the plaintiff may lay a claim for breach of contract.

c) The 2nd defendant’s defence to the claim;

In its written statement of defence, the 2nd defendant contends the suit is barred by limitation and is also misconceived. The 1st defendant’s position of agency ceased upon the expiry of the contract of 7th September, 2007. If the 1st defendant continued using the advertising material it generated

during the existence of the contract, then the claim is only maintainable against the 1st defendant. The 2nd defendant served as an agent of the 1st defendant for only one year and had no obligation to cause the 1st defendant to renew the contract once it expired.

5 d) The 3rd party's defence to the claim;

In its written statement of defence, the 3rd party denied liability under the contract of 7th September, 2007 between the plaintiff and the 2nd defendant on which the suit is founded, since it is not privy to that contract. By its position as the national institution responsible for the development, 10 management and regulation of the game of soccer in Uganda, it has the mandate to organise international matches for the "Uganda Cranes," by virtue of which it has rights to the images of the individual players as a national team. It is not true that the plaintiff has image rights in any four or more players donning the attire for the national team. The contact between the 1st defendant and the third party is distinct from that the 1st defendant has with the plaintiff. The 3rd party has no 15 obligation to indemnify the 1st defendant for obligations arising under the latter agreement.

e) The issues to be decided;

In the joint scheduling memorandum filed on 22nd January, 2016 and as modified in Court on 28th 20 January, 2016, the parties agreed on the following issues for the Court's determination, namely;

1. Whether the plaintiff owns the players'/models' image rights in issue.
2. Whether the defendants are in breach of any contract.
3. Whether the plaintiff is entitled to payment for continued use of its models' images for the period of three years in line with the contract dated 7th September, 2007.
- 25 4. Whether the parties are entitled to the remedies sought.

f) The submissions of counsel for the plaintiff;

Counsel for the plaintiff M/s Omongole & Co. Advocates submitted that image rights are 30 personality rights or publicity rights. It is the right to control the commercial use of one's image. That right is vested in the individual soccer players. Neither of them individually nor as a team did

they assign their individual rights to any of the defendants nor the third party. They only did so with the plaintiff, whom they authorised, on their behalf, to enter into the contract of 7th September, 2007. That contract was valid until 8th September, 2008. Upon expiry of the agreed period, the defendants had no right to the continued use of the images without the consent of the plaintiff. The 1st defendant as a result generated a lot of revenue from the violation. The 1st defendant continued to unlawfully use the images until the year 2013. Alternatively, the contract could be deemed to have been renewed by conduct. The defendants do not deny having used the images beyond the contractual period but justify it by reference to sponsorship agreements with the 3rd party. The 3rd party could not have acquired the private image rights simply by being a national regulator of the sport. Continued use of the images is in breach of the implied contract. As the quantum of special damages, the contract sum of sum of shs. 114,120,000/= should be multiplied by the number of years of breach, or alternatively each of the participating team members should be compensated in the sum of shs 80,000,000/= The plaintiff should as well be awarded shs. 100,000,000/= as general damages, or alternatively each of the participating team members should be compensated in the sum of shs 20,000,000/= The awards should attract interest of 25% per annum and the costs of the suit should be awarded to the plaintiff.

g) The submissions of counsel for the 1st defendant;

Counsel for the defendant M/s Kampala Associated Advocates submitted that the plaintiff lacks *locus standi*. Image rights are in their nature personal rights. The rights were assigned to the 1st defendant though the 2nd defendant, by the participating “Uganda Cranes” team members and not the plaintiff. The plaintiff is a mere agent of the players. The agreement dated 4th July, 2007 between the individual members of the “Uganda Cranes,” and the plaintiff, did not authorise the latter to enforce their image rights. The plaintiff is not a holder of powers of attorney of any of the individual players. In the contract between the plaintiff and the 2nd defendant, each of the individual players assigned his image rights to the 2nd defendant. They also assigned to the 2nd defendant, property rights in the material generated under the agreement. The 1st defendant’s right to use the images is derived from the agreement of 7th September, 2007 and the sponsorship agreement of 1st September, 2013 with the 3rd party. The 3rd party is responsible for the management of the “Uganda Cranes” team. The two sponsorship agreements signed with the 3rd

party on 17th May, 2007 and 25th September, 2010 authorised the 1st defendant to seek indemnification from the 3rd party in the event of liability incurred as a result from activities undertaken under the two agreements. It is by virtue of activities undertaken under the two agreements that the 1st defendant is now the subject of the current suit.

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h) The submissions of counsel for the 3rd party;

Counsel for the defendant M/s Ochieng Associated Advocates and Solicitors submitted that the 1st defendant's claim of indemnity against the 3rd party is time barred. The 1st defendant's claim is founded on a clause contained in an agreement signed on 17th May, 2007 which expired on 17th May, 2010. By the time the third party notice was issued, on 3rd November, 2020 it was more than seven years since the expiry of the contract. Liability based on a contractual term of indemnity is therefore time barred. The 1st defendant did not plead any disability justifying the delay, at the time of applying for issuance of the 3rd party notice.

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i) The decision;

In all civil litigation, the onus is on the plaintiff to prove to court on a balance of probabilities, the plaintiff's entitlement to the relief being sought. The plaintiff must prove each element of its claim, or cause of action, in order to recover. In other words, the persuasive burden is cast upon the plaintiff to prove to the court why the defendant is liable for the relief claimed. The plaintiff has to prove in this particular claim that; (i) there was use of a person's protected attribute such as name or likeness; (ii) for commercial or other exploitative purposes; and (iii) without that person's permission for the offending use.

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A claim for infringement of one's image requires three basic elements: (i) ownership of an enforceable right in the identity of a human being; (ii) use by another, without permission, of some aspect of the plaintiff's identity in such a way that it is identifiable from the unauthorised use; and (ii) likelihood that the defendant's use will cause economic injury to the value of that identity. This right is invoked mainly by celebrities to prevent unauthorised commercial uses of various aspects

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of their personae. Liability arises with the use someone's name or photograph in a commercial setting, such as in advertising or other promotional activities.

5 The central question then in this suit is whether FUFA was in a position to negotiate the players' image rights with the defendants. Whether when they are called up by the national team as the federation responsible for the national team, it automatically holds the sportspersons image rights and whether by that fact alone the players authorised FUFA to act as their agent. Whether it is appropriate to make the basic distinction between individual image rights which are owned by the sportsperson and collective rights, which are owned by the club or the 3rd party as the organising
10 entity for the national soccer team.

First issue; whether the plaintiff owns the players'/models' image rights in issue.

15 Image rights may vest in; a natural person, a legal person, a joint personality (two or more natural or legal persons who are (or who are publically perceived to be) intrinsically linked and who together have a joint personality, a group (two or more natural or legal persons who are (or who are publically perceived to be) linked in a common purpose and who together form a collective group or team; a fictional character (of a human or non-human nature).

20 a. Image rights of the individual.

The term "image rights" is used to describe rights that individuals have in their personality, which enables them to control the exploitation of their name or picture. Soccer players' image rights were duly defined by the High Court of England and Wales in *Proactive Sports Management Ltd v. Rooney and others* 2010 EWHC 1807: [2011] EWCA Civ 1444;
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30 Image rights means the right for any commercial or promotional purpose to use the Player's name, nickname, slogan and signatures developed from time to time, image, likeness, voice, logos, get-ups, initials, team or squad number (as may be allocated from time to time), reputation, video or full portrayal, biographical information, graphical representation, electronic, animated or computer-generated representation and/or any other representation and/or right of association and/or any other right or quasi-right anywhere in the World of the Player in relation to his name, reputation,

image, promotional services, and/or his performance together with the right to apply for registration of any such rights

5 Personality rights consist of two types of rights; the right to privacy and the right to publicity. The right to privacy is the right to keep one's image and likeness from exploitation without permission or compensation and applies to members of the general public. The right to publicity is the exclusive right of an individual to market his or her image, likeness, or persona for financial gain (see *Asege Winnie v. Opportunity Bank (U) Ltd and another, H. C. Civil Suit No. 756 of 2013; Jessicar Clarise Wanjiru v. Davinci Aesthetics & Reconstruction Centre and two others, [2017] eKLR; Catherine Njeri Wanjiru v. Machakos University [2022] KEHC 10599 (KLR) and Shimlon Mwangi Kuria v. the University of Kabianga [2023] KEHC 809 (KLR)*).

15 Therefore image rights are broadly defined, using the expression "image" not in its narrow sense of "likeness" but in its wider sense of "persona" or "brand," to use a marketing term. A player's image can include anything about that player such as the player's name, nicknames, likeness, image, photograph, signature, autograph, initials, statements, endorsement, physical details, voice and other personal characteristics unique to the player. In a nutshell, they are the proprietary rights that an individual has in the image of himself or herself, and the other unique characteristics associated with their personality. They are the equivalents of trademark protection for a logo, or copyright for a work of art. As one of the most diverse concepts in sports law, everything related to the image of a sportsperson could be considered a matter of image rights.

25 In some jurisdictions the right of publicity is considered an economic right (the right of ownership in an intangible asset), while in others it is conceived as a personality right and, as such, fundamental. The commercial aspect of this right has traditionally been of secondary importance, however, courts are moving ever closer to the economic right model because of its greater economic functionality. Personality rights are generally thought to consist of the moral rights of authors: the right to privacy, the right to protect one's honour and reputation, and the right to control the use of one's image. Nevertheless, the United Kingdom does not recognise a general privacy right or a right of personal portrayal as such. There it has evolved through case law protection as passing off and the right of confidence.

The concept of image rights springs from the recognition that individuals possess a property right in their own images (see *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc*, 202 F.2d 866 (2d Cir. 1953). “[A] person’s image constitutes one of the chief attributes of his or her personality, as it reveals the person’s unique characteristics and distinguishes the person from his or her peers.

5 The right to the protection of one’s image is thus one of the essential components of personal development. It mainly presupposes the individual’s right to control the use of that image, including the right to refuse publication thereof ...” (see *von Hannover v. Germany (No. 2)*. Reference: (2012) 55 E.H.R.R. 15. Court: European Court of Human Rights (Grand Chamber).

10 Every person, celebrity or non-celebrity, has a right of publicity, which in short, is the right to own, protect and commercially exploit one’s identity. The holder of the image rights is the individual whose image is reproduced. Image rights are thus simply the right a person possesses to control, sell, license and otherwise monetise his or her likeness. The concept purports to protect against uncompensated commercial exploitation of a person (such as a player’s) likeness or identity.

15 Unfortunately, Sports Law does not regulate these rights. The regulation of the image rights of professional sportspersons is defined privately, through employment and commercial contracts executed between clubs, sports corporations and sportspersons.

In soccer, the term “image rights” refers to proprietary rights of a player’s personality, and the

20 right to control, licence, exploit and prevent third parties from making use of attributes related to the player’s image. This includes the following: the player’s name, nickname and / or initials, the player’s squad number, the player’s image and / or photograph, the player’s voice, the player’s autograph, the player’s social media handles, and all other characteristics that are unique to the player. In *Proactive Sports Management Ltd v. Rooney and others* [2010] EWHC 1807 (QB);

25 [2011] EWCA Civ 1444, image rights of football players were defined as follows:

The right for any commercial or promotional purpose to use the Player’s name, nickname, slogan, and signatures developed from time to time, image, likeness, voice, logos, get-ups, initials, team or squad number, reputation, video or film portrayal,

30 biographical information, graphical representation, electronic, animated or computer-generated representation and/or any other representation and/or right of association and/or any other right or quasi-right anywhere in the World of the Player in relation to

his name, reputation, image, promotional services, and/or his performance together with the right to apply for registration of any such rights.

5 These rights do not actually exist as a separate standalone right under the intellectual property law of Uganda. The legal protection of one's own image is based on the right of privacy; reflecting one's soul and uniqueness. The right of privacy concerns the right of a person to be let alone, to be free from unwarranted publicity, and to live without unwarranted interference by the public in matters with which the public is not necessarily concerned. An actionable invasion of the right of privacy is the unwarranted appropriation or exploitation of one's personality, the publicising of
10 one's private affairs with which the public has no legitimate concern, or the wrongful intrusion into one's private activities in such a manner as to outrage or cause mental suffering, shame or humiliation to a person of ordinary sensibilities.

15 There is no specific, statute-based law protection in relation to image rights since there is no codified or consolidated legislation that protects image rights as such. Instead, sports stars need to rely on a patchwork of laws including intellectual property rights, passing off, privacy laws, and defamation to prevent authorised exploitation of their image. The concept of image rights (as intellectual property) includes various separate rights (for example, trademarks, copyright and the ability to claim for "passing off"). As regards copyright, section 4 of *The Copyright and*
20 *Neighbouring Rights Act, 2006* automatically confers a property right on the author of original works which can include literary, dramatic, musical or artistic works. There is, however, no copyright in a player's face or his name because they are not original works. The copyright in a player's photograph will belong to the photographer (save if there is an assignment). Likewise, the copyright in an audio recording of a media interview will belong to the interviewer. As a result,
25 the law of copyright is of limited use to professional players.

Similarly, a trademark is a registrable intellectual property right which comprises any sign capable of being reproduced graphically and capable of distinguishing goods and services of one undertaking from those of another undertaking. Sporting personalities can apply to register
30 trademarks comprising their name, slogans, logo (amongst others) but such signs will only qualify for registration under section 4 of *The Trademarks Act, 7 of 2010* if they are sufficiently distinctive and unique.

In light of the above limitations, the approach therefore used in the enforcement of image rights is to rely on a framework of statutory and common law intellectual property rights to prevent unauthorised exploitation. The common law remedy of passing off is often used as well (see for
5 example *Robyn Rihanna Fenty and others v. Arcadia Group Brands Limited and another* [2015] 1 WLR 329). Image rights provide their holders protection against unauthorised persons claiming ownership or endorsement by the holder without their permission. However, besides consent, a public dimension must exist when using the image of a soccer player under “public interest.” The commercialisation should not be mistaken with the freedom of the media to use the image
10 reflections and information of a sportsperson, as a celebrity with public recognition.

The image itself has two characteristics: as a personal right and as a property right. It is common sense that image rights are protected as personal rights, therefore are non-transferable to a new owner. The ownership is an immutable condition that protects the player’s image as a human right,
15 and it is not possible to waive a fundamental personal right. The holder of the right to one’s own image cannot license it fully, that is, only the economic aspect of these rights may be licensed. The possibility to license image rights rests in the property aspect of this institute. The right to one’s own image is the ability to decide when, how and by whom our physically recognisable features (image, voice and name) can be captured, reproduced or published. Defined as a “publicity” right
20 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc*, 202 F.2d 866 (2d Cir. 1953), it was described as follows;

A man has a right in the publicity value of his photograph, i. e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made
25 “in gross,” i.e., without an accompanying transfer of a business or of anything else. Whether it be labelled a “property” right is immaterial; for here, as often elsewhere, the tag “property” simply symbolises the fact that courts enforce a claim which has pecuniary worth.

This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorising advertisements, popularising their countenances, displayed in newspapers, magazines, busses, trains

and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

5 Many scholars and courts credit this case with ushering in the modern right of publicity in the United States, which is the equivalent of image rights in many other jurisdictions. It recognised an alienable legal right in the value of a celebrity image. In particular, the court held that baseball players could sell to one party the exclusive right to use their images on baseball cards. It's not that celebrities lacked legal rights before this decision. They could object to many uses of their
10 name or likeness to advertise products, and had at least some cognisable privacy rights as well. But before this case, these legal rights focused largely on avoiding harm to the celebrity; no court had recognised celebrity images as legal rights that could be sold to the highest bidder.

Image rights deals enable the parties to exploit that likeness for commercial value, i.e. through
15 sponsorship and endorsement activities. There are three main ways that a soccer player can seek to commercialise his or her rights; (i) sponsorship, (ii) endorsement, and (iii) merchandising. Under a sponsorship arrangement, a corporate brand pays the player (or provides the player with products) in exchange for being granted certain marketing rights by the player, in order to promote the brand's image generally. The marketing rights might take the form of participation in
20 advertising, or wearing branded clothing, for instance.

On the other hand, an endorsement arrangement goes one step further than this. It involves the personal recommendation by the player, of products made by the sponsoring brand, or at least a close association between the player and those products. In this case, the brand in question is not
25 merely seeking to raise its profile but to affect purchasing patterns of the public. For example, many premium and luxury watch manufacturers have endorsement arrangements with players. Lastly, merchandising arrangements operate by monetising the player's own image rights and status, by applying it to the player's "personal" range of products. Generally merchandising requires considerable investment of resource into protecting and growing the player's own image
30 and "brand," including investment in a trademark portfolio. This goes beyond what most players would require. So image rights can be very valuable assets for players (and their clubs) to exploit. Clearly they are an important asset for players, one that can add value to a contract and also enable

them to engage in their own monetisation activities, potentially long after their playing career is over.

5 This complex perception of “image” can be exploited collectively or individually. Collectively as part of the football team, the player could have their image exploited through sports events, championships and matches, by the broadcasters and the club. On the other hand, the player could have their image exploited through specific commercial projects off the field of play, by sponsors, third parties, and also the club. The player needs to define the limits and conditions, distinguishing uses from commercial deals. It is a non-exhaustive list of possibilities that can be negotiated as the
10 parties see fit.

In order to market an image of a player, it must be clear that the individual has an image that has a value to sponsors. In the beginning of a soccer player’s career, the image rights are owned by the player himself, i.e. the player’s image rights cannot be exploited by anyone without the player’s
15 consent. Once the player acquires an image that has a value to sponsors, there will likely be an employment contract and image rights agreement negotiation. If the player’s image has independent commercial value (or the prospect of such), then the player will often seek to transact in it. The negotiation usually will rotate around the extent to which the club may use the representation of the player and/or use of the player’s image rights in connection with or
20 combination with any of the name, colours, crest, strip, logos identifying him as a player for his club. Consent does not need to be in writing, but it must be unequivocal.

b. The associated, group, collective or team image rights.

25 Image rights can be exploited individually or collectively as part of the football team. The image of the sportsperson associated with the distinctive signs of the club or team is said to be collective image when the number of athletes whose image is reproduced exceeds a certain threshold (usually a minimum of three to five players is required), which is often defined by a collective agreement. In such case, this type of image normally belongs to the employer, who then decides whether to
30 use the collective associated image on any medium or by any means, for its own benefit or that of its partners. The collective image can be exploited off the field of play, by sponsors, third parties,

and also the club, or by the national association where the player is an international footballer and has further image rights agreements with his national football association.

5 While the Club recognises that the player owns exclusive rights to his individual personality, including his likeness, the player recognises that the Club or national association owns exclusive rights to its name, emblems and uniform, which the player wears as a player for the Club or national team. The powerful connection between a sports team and its supporters is hinged upon these image rights, which extend to the team's name, colours, mascots, and even the collective image of its players. Use of the player's image rights in a collective context by the club or national
10 association is currently a matter covered by the employment contract. The contract governs any representation of the player and/or the player's image in connection or combination with the name, colours, trademarks, logos or other identifying characteristics of the Club or national association, or in any manner referring to or taking advantage of any of the same.

15 By such contracts, the player ordinarily grants to the Club the right to photograph the player both individually and as a member of a squad. The player grants the Club the right to use his image as part of the team's collective image. The contract specifies that the player must participate in the Club's commercial operations and thereby permits the use of such photographs and the player's image in a Club Context in connection with the promotion of the Club and its playing activities
20 and the promotion of the League and the manufacture, sale, distribution, licensing, advertising, marketing, and promotion of the Club's club branded and football related products or services (including such products or services which are endorsed by or produced under licence from the Club) and in relation to the League's licensed products services and sponsors in such manner as the Club may reasonably think fit so long as: the use of the player's photograph and/or player's
25 image either alone or with not more than two other players at the Club is limited to no greater usage than the average for all players regularly in the Club's first team, and the Player's photograph and/or player's image is not be used to imply any brand or product endorsement by the Player.

By the employment contract with the Club, the players assign the collective aspect of their image
30 rights, reserving those of an individual nature for themselves. The assignment of image rights is almost complete and the Clubs exploit most aspects of the image rights of their players. By doing

so, the Clubs try to offset the high signing bonuses of their players, receiving in exchange any remuneration that they generate, directly or indirectly, through the commercialisation of their individual and collective images.

5 By such contracts, the player usually agrees that the Club will be entitled to use, in a reasonable manner and so as not to bring the player into disrepute, the name, the nickname, signature image, voice, film portrayal and other characteristics of the player in connection with manufacture, selling, distribution, licensing and promotion of items of official Club merchandise relating to the Club and its player. Football Clubs usually include a clause restraining the player at any time
10 during the term of the contract, when on international duty in relation to the players' national football association (FUFA), the continental football association (CAF) or the international football association (FIFA), from doing anything to promote endorse or provide promotional marketing or advertising services or exploit the player's image either (a) in relation to any person in respect of such person's products brand or services which conflict or compete with any of the
15 Club's club branded or football related products or any products brand or services of the Club's main sponsors/commercial partners or of the League's principal sponsor, without the written consent of the Club.

The use of an athlete's image during the course of participation in a sport events of the nature for
20 which he or she is contracted with the team as a member of their team at such an event, exploitation of their image by the club during the course of such an event is considered to be an inherent part of their labour contract. Next to collective image rights, such as team photographs, which are a matter for collective or individual negotiation with the club, there may also be a category of associated image when the number of persons granting the use of their associated image does not
25 reach the threshold fixed by the club. Except to the extent specifically provided in the club employment contract or otherwise specifically agreed with the player, a player is ordinarily not prevented from undertaking promotional activities or from exploiting the player's image so long as those promotional activities or exploitation do not interfere or conflict with the player's obligations under the contract, and the player gives reasonable advance notice to the Club of any
30 intended promotional activities or exploitation.

c. The clash between copyright protection and image rights.

Associated, group, collective or team image rights also intersect with issues of copyright ownership. While copyright protects the copyright holder's property rights in the work or intellectual creation, privacy and publicity rights protect the interests of the person(s) who may be the subject(s) of the work or intellectual creation. Copyright ownership in situations where a photographer takes a photograph of a person who is aware that her/his photograph was being taken, someone who posed for the photograph or commissioned it, is to a large extent, clear.

Copyright is vested in the photographer who is employed or commissioned to take the photograph, except where a prior contract or agreement exists to the contrary. Regardless of the quality of photographs, copyright law classifies photographs as artistic works and confers authorship on the person who took the photograph. Authorship is hinged on the belief that the photographer must have exercised judgment as to what to photograph, the arrangement of a scene, including positioning, lighting and other exercise of judgment, skill, or labour in taking the photograph. It is thus the creativity and arrangements involved which determines the assignment of copyright in the photograph. It was held in *Creation Records Limited v. News Group Newspapers*, [1997] EMLR 444; [1997] EWHC Ch 370 that;

It seems to me that ordinarily the creator of a photograph is the person who takes it. There may be cases where one person sets up the scene to be photographed (the position and angle of the camera and all necessary settings) and directs a second person to press the shutter at a moment chosen by the first, in which case it would be the first, not the second, who creates the photograph. There may also be cases of collaboration between the person behind the camera and one or more others in which the actual photographer has greater input, although no complete control of the creation of the photograph, in which case it would be the first, not the second, who creates the photograph. There may also be cases of collaboration between the person behind the camera and one or more others in which the actual photographer has greater input, although no complete control of the creation of the photograph, in which case it may be a work of joint creation and joint authorship.

The photographer owns copyright in the photograph as a consequence of being recognised as the author of it. If the photograph was created in the course of an employment or if she/he was

commissioned to take the photographs, the employer or the commissioner owns copyright over the photograph, although the photographer may always be acknowledged as the author. Apart from the moral rights, which are expressly reserved for the author, the economic benefits of copyright are reserved for the owner rather than the author *per se*. where an independent contractor/freelance
5 writer is paid to do a write-up on another, or a freelance photographer, painter or artist is commissioned to take a photograph, paint a portrait or make a sculpture, as the case may be, ownership of the resulting works lie in the author/writer, photographer or artists respectively, and not in the person appearing in the work or the one who commissioned it.

10 Generally, an author or owner of copyright exercises either or both of two broad rights, namely, right of exploitation/commercialisation and moral rights. A photographer, deemed to be the owner of a photograph, can exercise all rights incidental to that status, including the right to reproduce, publish or exploit the work as she/he may deem fit. As such, the photographer may distribute, share, exhibit, commercially exploit, duplicate and make use of the photograph in any other
15 professional respect. Consequently the photographer in the exercise of right of ownership in the photographs, might publish, share, exploit, distribute or otherwise deal with the photographs in spite of the interest or rights of those captured.

While the owner of a copyright, i.e., the creator of the work, has the exclusive right to reproduce,
20 distribute, perform, display, and license the work and to prepare derivative works based on the work, including to ability to sue for copyright infringement when that work is used in an unauthorized manner, issues arise as to whether the person depicted in the image can, in some ways, control the use and distribution of his/her own images; the extent to which an individual may control or restrict the use of his or her image, and hence the conflict between the rights of
25 individuals against commercial enterprises, which now forms the crux of this case. The case now before Court is essentially a clash between copyright protection and image rights.

d. Transfer /assignment / licensing of the image rights.

30 The right to one's own image is the ability to decide when, how and by whom our physically recognisable features (image, voice and name) can be captured, reproduced or published.

Therefore image rights may be licensed and assigned. The holder of the right to one's own image cannot license it fully, i.e., only the economic aspect of these rights may be licensed. The implication is that unauthorised production, reproduction and use of images (or pictures), transfer or any other means may amount to an infringement, depending on the reason, manner, type and scope of use.

The assignment of image rights refers to the transfer (or sale) of the right of commercial use, either wholly or partially, and either generally or subject to limitations relating to territory, medium or sector of the market or other limitations relating to the scope of the assignment. The assignment operates a change in property interest from the assignor to the assignee allowing the latter to legally enforce its rights should there be an infringement. The assignee acquires full and complete ownership rights and will be free to use its rights as it deems appropriate, including licensing them to others or transferring them to a third party. The assignment will generally involve a one-time payment from the assignee to the assignor.

On the other hand, a license authorises the licensee to perform certain acts strictly reserved to the image rights owner, over a specified period of time. Since the license is a right granted over time, the licensor will have more control over the licensee as per the terms of the license agreement. The licensor retains some level of control over the image rights by remaining the rights owner. The licensee acquires limited property rights, since the licensor does not transfer ownership of the image rights to the licensee. However, the exclusive licensee acquires legal standing to directly sue third parties who may be infringing on its exclusive license rights. Exclusive licenses are generally structured in such a way that the licensee pays ongoing royalty payments to the licensor.

There are three types of licenses: the "exclusive license," which is only granted to one licensee, and excludes the image rights holder from using the image and from granting licenses to any other person; the "sole license," which is only granted to one licensee and excludes the image rights holder from granting licenses to any other person, but does not exclude the holder from using the image; and the "non-exclusive license," which does not exclude the image rights holder from using the image or from granting licenses to any other person. An exclusive licence exists when the following conditions are met: (a) the image rights owner (the licensor) permits another person (the

licensee) to do something within the image rights; (b) the licensor promises not to give anyone else the same permission for the duration of the licence; and (c) the licensor himself promises not to do those acts that have been licensed to the licensee for the duration of the licence.

5 The individual player is the owner of their image rights. In the beginning of a football player's career, the image rights are owned by the player himself, i.e. the player's image rights cannot be exploited by anyone without the player's consent. When the player signs a contract with a club, the club will normally obtain certain image rights from the player, i.e. the player gives his consent to the club obtaining parts of his image rights, enabling the club to use the player's image rights
10 as a part of the club's marketing strategy. If the player is chosen to play for his national association, the national association will normally also obtain certain image rights. The image rights that originally was solely the player's, will then be split between the player, the club and the national association.

15 Often players will create an image rights company and assign the rights to that company. One of the reasons for doing this is so that image rights can be kept out of a player's main contract with their club. Clubs will then enter into a separate agreement with the company to use the player's image rights both to promote itself and to endorse the products / services of their own sponsors. The proprietor of image rights (or the author of the work) could be the company (the photograph
20 agency or image creator) who exercise intellectual property rights over the image by virtue of the royalty agreement signed with the personality, or the personality himself or herself who has personal rights over the use of the images. A photographer generally has a right over the pictures taken by him unless he is an independent photographer hired for a contract for service.

25 The player, as the absolute owner of his image, can license a company, a third person, or a club to exploit their image consenting through an image rights licensing agreement. Expressly agreeing that the counter-party is allowed to reproduce, publish, capture, and monetise their image in a specific scope of use. This contract needs to be very clear and concise and will contain clauses corresponding to the duration, the fees and the terms of payment, scope of the image exploitation,
30 the obligations of both parties, the IP rights and trademarks protection, the termination conditions, jurisdiction and governing law chosen by the parties, and any other items agreed by the parties.

When the player signs a contract with a club, the club will normally obtain certain image rights from the player, i.e. the player gives his consent to the club obtaining parts of his image rights, enabling the club to use the player's image rights as a part of the club's marketing strategy. A club context agreement refers to the use of the player's image in conjunction with the club's name, colours, crest, logo, trademark and/or other identifying characteristics of the club. If the player is chosen to play for his national association, the national association will normally also obtain certain image rights. The image rights that originally was solely the player's, will then be split between the player, the club and the national association.

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Any sportsperson or celebrity's name, image, reputation, voice, signature, initials or nickname can be seen as intangible assets that have the ability to be commercialised. Images of athletes can be used and exploited by a whole range of natural and legal person, either directly or indirectly: the athlete himself, the sports agents, clubs, teams, sports companies and associations, sports federations, image rights companies, sports event organisers, sports equipment manufacturers, manufacturer of goods and provider of services, film producers, advertising or public relations entities etc. sports players enjoy the benefit of being able to exploit other commercial opportunities such as image licensing agreements, celebrity endorsements and appearance fees. Image licensing agreements involve the commercial exploitation of a player's image, such as the use of the player's name, photograph, reputation, voice, signature, initials or nickname. Image rights are the legal rights associated with using the image of a sportsperson in marketing or promotional activities. Image rights payments refer to the payments that a player receives from an enterprise that uses such player's image for advertising purposes.

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A common starting point is that image rights are governed by the principle of freedom of contract. At the outset of a player's career, his image rights are owned by the player in so far as they cannot be exploited, licensed or assigned without his prior consent. The primary mechanism through which image rights are used commercially is through a licensing agreement. The plaintiff derived the authority to execute the contract dated 7th September, 2007 with the 2nd defendant, on basis of one the plaintiff signed with nine of the eleven players, on 4th July, 2007 which states as follows;

5 We the undersigned players, hereby agree to let Proline Soccer Academy use our images to be used by Interested Companies in the promotion of their products, Proline will pay us a fee as we shall negotiate from time to time. Proline undertakes to facilitate the process of generating the images on top of payments that will be agreed. Proline is free to deal with any company or organisation and by signing this agreement, we have given permission to Proline Soccer Academy to use our Images in regard to the above subject matter (emphasis added).

10 The signatories are named as; Onyango Denis, Masaaba Simeon, Kizito Nestroy, Ibra Sekajja, Noah Kasule, Wagaluka Dan, Masa Geoffrey, Serunuuma Geoffrey and Obua David. Spaces provided for Batabaire Timothy and Asan Bajope were left blank. This contract does not achieve the level of clarity and conciseness required in contracts of this nature. Ideally it should have contained clauses regarding the duration, the fees and the terms of payment, scope of the image exploitation, the obligations of both parties, the IP rights and trademarks protection, the
15 termination conditions, jurisdiction and governing law chosen by the parties, and any other items agreed by the parties. It is not readily clear what the plaintiff undertook to do when it bound itself to undertake the “process of generating the images.” It must be remembered that the personality of the player is not what is protected *per se*, it is the “image” associated with the personality that is protected because it distinctive and if it has actual or potential value. Perhaps what this means
20 is that the plaintiff was to manage the process of generating images within their natural meaning i.e. photos and other physical forms of illustration.

25 Despite its shortcomings, the wording of that agreement constitutes the plaintiff into a licensee of the images of the nine signatories. The nine players granted the plaintiff the right to put their images to commercial use for their benefit. It is common sense that image rights are protected as personal rights, therefore are non-transferable to a new owner, i.e. their ownership is an immutable condition that protects the player’s image as a human right, and it is not possible to waive a personal right. The possibility to license image rights rests in their property aspect. The player, as the absolute owner of his image, can license a company, a third person, or a club to exploit their
30 image, thereby consenting through an image rights licensing agreement such as this.

It is on the basis of the licence agreement of 4th July, 2007 that the interests and rights sought to be enforced by the plaintiff, now have to be traced to the “contract for Performing Artists and

Models' dated 7th September, 2007 to which we now turn. Clauses 1, 5, 7 and 9 of the contract specifically provide as follows;

1. Appointment:

5 The Practitioner hereby engages the Performer and the Performer grants
Practitioner the sole and exclusive right to exhibit the Performer's
photographs, art, location/location hire, props, costume, material or other
images in any advertisement published or displayed as hereinafter mentioned
relating to press, electronic and print media, banners, billboards, airtime
10 cards, vehicles, branding, posters, brochures, leaflets, television, video and
magazines, amongst others, in Uganda or abroad or in any form and manner
as may be chosen by the Advertising agency.

5. Intellectual property rights:

15 The copyright, performing rights and other rights in the advertising material
shall be transferred to the Advertising Agency automatically upon
notification of the Performer by the Advertising Agency of its acceptance of
the advertising material for the publication.

7. Length of performance:

20 The Advertising Agency hereby contracts with the Performer that the
Performer will agree to shots at agreed times. The performer agrees to
payment for the sum of US\$ 2,000,000/= for each consecutive shoot for a
different campaign after the first shoot. Upon performance and subsequent
25 payment the Practitioner shall retain the legal property in the goods of images
made out of the shooting.

9. Copyright and Assignments:

30 The performer agrees to assign all performing rights, copyright and other
rights which may arise in the course of this agreement to the Advertising
Agency and acknowledges that rights in respect of the material produced in
terms of this agreement is the property of the Advertising Agency, and that
the Advertising Agency is the sole legal and beneficial owner of the rights
and has the right to permit the advertising team to air it and identify him as
35 the author of the material without restriction.

In that agreement, the plaintiff is described as "the Performer Agency." The agreement does not define "Performer" but considering that in paragraph 2 the 2nd defendant agreed "to pay the

performers (11)...” The only reasonable inference that can be draw is that it is a reference to the 11 participating team members of the “Uganda Cranes.” Whereas in the licence agreement of 4th July, 2007 the nine signatory team members of the “Uganda Cranes” authorised the plaintiff to find interested Companies interested in using their images in the promotion of their products and services, the agreement does not deal with the transfer of image rights, but rather the copyright to advertising material arising from the permission granted to use the signatory team members in the generation of such material. Therefore, neither the agreement of 4th July, 2007 between the nine signatory team members and the plaintiff, nor that of 7th September, 2007 between the plaintiff and the 2nd defendant, constituted a transfer, or assignment of the players’ image rights, the respectively licensing the use of the image rights and creation of copyrights out of them.

While the copyright over a photograph is vested in the photographer, the freedom to exploit this right is limited by the image rights of the person who happens to be the subject of the photo, particularly in instances where the photographer seeks to exploit the photograph commercially. These rights are synergistic, as the person who happens to be the subject of the photo must also obtain permission from the photographer to make certain use of the photograph. The right to one’s own image and copyright could eventually clash if the photographer makes use of an image of his authorship without having the permission of the portrayed person.

To resolve the conflict, Court ought to consider the incidence of the two rights. Image rights derive recognition from the protection of the right to privacy contained in article 27 of *The Constitution of the Republic of Uganda, 1995*. This is augmented by *The Data Protection and Privacy Act, 9 of 2019* which was enacted to protect the privacy of the individual and of personal data by regulating the collection and processing of personal information. On the other hand, although it is arguable that copyright as a form of intellectual property is protected by article 26 thereof, under the general provision for property rights, it is mostly recognised as a right protected by statute under *The Copyright and Neighbouring Rights Act, 2006*. In the event of a clash, it follows that a right directly protected by *The Constitution* should prevail over that protected by statute. The artistic freedom involved in the creation of copyright-protected works of mind based on another person’s image cannot override the autonomy of the protection of a person’s image. Image rights thus create an external limitation of copyright law where the subject of the copyright is an image of an individual.

In short, the photographer must have the portrayed person's consent in order to capture and use the picture. The existence of such consent is a *conditio sine qua non* for copyrights to be claimed over a picture featuring the image of an individual. If the consent of the photographed person is unequivocal, then copyrights prevail over image rights. So, when there is no doubt that the person's consent has been granted for such use, copyright law prevails over image rights. Consent given subject to temporal limitation, in light of the intended duration of an activity, is often used as a method to address uncertainty about the adverse effects for that consent. Activities may change and expand over time triggering a change of because the practices have changed significantly. The permission will lapse on the date specified in the consent.

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The plaintiff's case is that the by virtue of the agreement dated 7th September, 2007 between the plaintiff and the 2nd defendant, the 11 participating team members of the "Uganda Cranes" permitted the use of their image and the copyrights of the material so generated for use by the 1st defendant, for only a period of one year, which expired on 8th September, 2007 such that the 1st defendant's continued use of the images in its advertising and promotional activities thereafter, constitutes a violation of their image rights. None of the 11 participating team members consented to their reproduction and further dissemination beyond that date, it is contended. In its defence, the 1st defendant instead invokes consent derived, not directly from the 11 participating team members, but rather from the 3rd party by virtue of the two sponsorship agreements signed on 17th May, 2007 and 25th September, 2010 as justification for its use of the 11 participating team members' images in its advertising and promotional material, beyond that date. This then calls for analysis of how the 3rd party acquired the image rights of the 11 participating team members so as to be in position to grant the 1st defendant, their use in its advertising and promotional material.

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It is trite that FUFA does not have individual football players as direct members; instead, players are affiliated with their respective clubs. Article 10 of *The Statutes of the Federation of Uganda Football Associations (FUFA)* at the time of the two sponsorship agreements, listed the ordinary membership of the 3rd party as including; the 16 First Division Clubs, the second Division League, eight Regional Football Associations, the Uganda Football Players Association, the Uganda Women Football Association, the Uganda Football Coaches Association, the Uganda Football Referees Association, the Uganda Beach Soccer Association, the Uganda Schools Football

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Association. Associate members include; the Uganda National Universities Football Association, the Uganda Tertiary Institutions and Colleges Football Association and the FUTSAL Association of Uganda. Without a direct link with the 11 participating team members by way of membership, the only options left to the 3rd party as a means of acquisition of their image rights are thought their employment contracts, either directly with itself or indirectly with their respective clubs.

It is typically the clubs which hold the mandate to negotiate and sell name and likeness rights of its players. For example, in the case of professional football players playing in the English Premier League, they are required to sign the standard FA Premier League contract which contains a mandatory clause under which they grant their club the right to use their image in both a personal and club capacity. The club and the Premier league then have the right to sell these rights to for example the “Electronic Arts” Games for use in their games. So if a club does not have a separate image rights agreement in place with its players it would be difficult to use, their image with the majority of the club’s commercial partners because that is not generally permitted under a player’s standard employment contract. And more importantly, the club’s commercial partners would probably want to use the star players’ image more than perhaps one of the first team squad players who would be less recognisable in other markets. So the reality is if the club wants to use the image across a range of sponsorship opportunities, then it becomes pretty vital for the club to contract separately with the player through an image rights deal to have control of those rights to endorse particular products and services, and if the player owns his image through a company, the club will need to contract with that company

In its Circular 1171/2008, FIFA stated that the Club and the player have to agree how the player’s image rights are exploited, if applicable and as a recommendation, that the individual player may exploit his rights by himself (if not conflicting with clubs sponsors/partners) whilst the Club may exploit the player’s image rights as part of a group and/or the whole squad. Once the image right is transferred to the club, the club will contract with third parties and commercial partners. It may well be that any club deal limits a player’s personal deal options to ensure that its players cannot endorse competitors of its sponsors, even in a personal capacity, or even seek to share in revenues from personal deals in return for seeking to source individual deals for players. In general, elite

international players will license their image rights to three broad categories of licensee (i) their club (ii) their personal sponsors and (iii) national association.

5 Clubs traditionally pay their players solely for playing football. Without a separate image rights agreement in place with their star players it would be difficult for clubs to use their players' image with the club's commercial partners because that is not generally permitted under a player's standard employment contract. Typically, under an image rights agreement, a player will license the rights to their "image" to their club who, in addition to paying the player a wage, will pay royalties for the use of the player's image. In the English Premier League standard player's contract, the club is given the right to use the player's image rights to a wide extent, as long as it is in connection with the promotion of the club. In that league, Clause 4 of the standard player's contract states that:

15 The Player hereby grants to the Club the right to photograph the Player both individually and as a member of a squad and to use such photographs and the Player's Image in a Club Context in connection with the promotion of the Club and its playing activities and the promotion of the League and the manufacture sale distribution licensing advertising marketing and promotion of the Club's club branded and football related products (including the Strip) or services (including such products or services which are
20 endorsed by or produced under licence from the Club) and in relation to the League's licensed products, services and sponsors in such manner as the Club may reasonably think fit

In today's big money soccer industry, part of the return on investment in a player is the ability to use their image and sell merchandise. However, it should be noted that the wording of the contract does not necessarily cover the transfer of the image rights to third parties. These clauses are however, often accompanied by further terms set out in separate image rights contracts, especially in the case of top players whose image is of particular value.

30 The parties to the instant case did not lead cogent evidence explaining the practice in Uganda. It is the team manager for Uganda Crane since 2019, D.W.2 Mr. Massa Geoffrey who, without elaboration or corroboration with documentary evidence, testified that at the club level, it is the sponsor of the club owns the image rights. Presumably this is by contract. It is therefore entirely

on basis of two sponsorship agreements dated 17th May, 2007 and 25th November, 2010 between the 1st defendant and the 3rd party that the 1st defendant relies on as the source of authority over the 11 players' image rights. The relevant part of the preamble and Clauses 4.4 common to both agreements, as well as clause 7 in the former, which is not reproduced in the latter, provide as follows;

Whereas the Sponsored is a Ugandan football association that administers professional football in Uganda and is desirous of obtaining sponsorship to fund its sporting events in the field of football, to help promote the interests and development of football in Uganda:

4.4 The Sponsored shall afford the Sponsor the right to feature the Team as a whole or as individual members in the promotion and advertising campaign.

7 Team

The Sponsorship rights envisaged herein shall specifically apply to the Uganda Cranes in respect of all official local and international football fixtures and friendly international matches played both in Uganda and abroad.

As the image rights of the football player originally belongs to himself, FUFA cannot obtain the image rights from clubs and leagues comprising its membership unless the clubs and leagues have obtained the image rights with regard to names and likeness, from the players. Through their agreements with the players the clubs and leagues would then be in positions to negotiate conditions for FUFA to use the players' image rights. If a contract specifies that the player gives the club the right to make an agreement with FUFA to use the player's name and likeness, it is obvious that FUFA would have obtained such a right. However, if a contract regulates the matter of image rights more generally, it would be debatable whether the club is in a position to pass on parts of the image rights to a third party such as FUFA.

The alternative would be a contract of sorts between the player and FUFA. However in the evidence before Court, there is no contractual relationship between the players and FUFA or the national team. The direct mandate of FUFA with the players appears to be limited to the selection those who might take part in international soccer competitions on a national representative team

level. The relevant provisions of the FUFA’s “Statutes of the Federation of Uganda Football Associations (FUFA),” state as follows;

Article 5 Players

1. The status of Players and the provisions for their transfer shall be regulated by the Executive Committee of FUFA in accordance with the current FIFA Regulations for the Status and Transfer of Players.
2. Players shall be registered in accordance with the Regulations of FUFA

Article 80 Rights

1. FUFA and its members are the original owners of all rights emanating from competitions and other events coming under their respective jurisdiction, without any restriction as to content, time and place. These rights include among others, every kind of financial rights, audio, visual and radio recording, reproduction and broadcasting rights, multimedia rights, marketing and promotional rights and incorporeal rights such as emblems and rights arising under copyright law.
2. The Executive Committee shall decide how and to what extent these rights are utilised and draw up special regulations to this end.

Article 81 Authorisations

FUFA and its Members are exclusively responsible for authorising the distribution of image and sound and other data carriers of football matches and events coming under their respective jurisdiction, and without any restriction

There is no employment relationship between the sporting federation and the player chosen for the national team. When analysing the relationship between a sportsperson and the federation in a similar situation, the Court of Justice of the European Union ruled that it is an independent relationship of an economic nature (see *Christelle Delière v. Ligue francophone de judo et disciplines associées ASBL and others*, Times 19-Apr-2000, C-51/96, C-191/97, [2000] ECR I-2549, [2000] EUECJ C-191/97, [2000] EUECJ C-51/96, decision by the CJEU of April 11, 2000 C-51/96 and c191/97). The pursuit of an activity as an employed person or the provision of services for remuneration must be regarded as an economic activity. The mere fact that a sports association or federation unilaterally classifies its members as amateur athletes does not in itself mean that

those members do not engage in economic activities. Leading sports personalities could receive, in addition to grants and other assistance, higher levels of income because of their celebrity status, with the result that they provided services of an economic nature.

5 Since the only employment relationship in this structure is that between the club and the player, the extent to which a club, a league or FUFA can conclude an agreement with third party as regards the use of a player's name and likeness would depend on the agreement between the player and the club. As the image rights of the soccer player originally belongs to himself, preventing the player's image rights from being exploited by anyone without the player's consent, FUFA cannot
10 obtain the image rights from clubs and leagues unless the clubs or leagues have obtained the image rights with regards to names and likeness from the players, and through their agreements with the players are in positions to negotiate conditions for FUFA to use the players' image rights.

Typically, when a player is called up to represent his or her country in senior international
15 competitions, that player will sign a contract with his or her respective national association. Alongside relevant FIFA regulations (Annexe 1 of the Regulations on the Status and Transfer of Players), these contracts govern the relationship between the players and their national associations in respect of participation in international football. These contracts will often contain an image rights component, which address the rights and obligations of both the player and the national
20 association as relates to the use of the player's image on the international scene. However, not every national association will have a detailed contract with their players which address the issue of image rights.

According to the Chief Executive of FUFA, the 3rd party, D.W.3 Mr. Edgar Watson Suubi, It is a
25 common practice that whoever is summoned to the national team, by virtue of being so summoned, FUFA would gain their image rights. It is the practice in Uganda which he has known since he was an armature footballer. No other witness testified about the existence of such a practice. The proposition therefore is that being called to the national team by practice gives rise to an implied consent to the use of a player's image by FUFA for commercial purposes, as some form of trade
30 practice or usage of trade. A "usage of trade" is any practice or method of dealing having such regularity of observance in a place, vocation, or trade as to justify an expectation that it will be

observed with respect to the transaction in question. The existence and scope of such a usage must be proved as fact. If it is established that such a usage exists as embodied in a trade code or similar record or widespread practice, its interpretation is a question of law.

5 Being a fact dependant on regularity of observance in order to be established as a usage of trade, it would require evidence of repeated occasions of such performance by FUFA, and the fact of the players called to the national team have always had knowledge of the nature of that performance and opportunity for objection to it, but having gone ahead on each of those occasions to accept the performance or acquiesces in it without objection. Neither the third party nor any of the
10 defendants adduced such evidence. I therefore have not found any basis for making the finding that it is implied in the fact of being called to the national team that a player consents to the use of his image by FUFA for purposes of advertising the tournament and also in advertising the commercial interests of the sponsors of the tournament. The consent that can be implied is when pictures are taken during a football match for public information, even though it is debatable that
15 by playing the match on an open stage a player would have implicitly agreed to the use of their image for commercial purposes.

Evidence would be required of intentional and deliberate inclusion of assignment of image rights when a player answers the call to the national team. Although consent to the use of image rights
20 may be considered incidental to playing a match on an open stage, if the work in which the image is included is intended to serve a commercial purpose, it is unlikely to be deemed incidental. For example in *Football Association Premier League Ltd v. Panini UK Ltd* [2004] FSR 1; [2003] EWCA Civ 995 the defendant made football stickers which were not authorised by the Premier League or any of its teams. The stickers sold in conjunction with an album, had a photographic
25 image of those players in their team strips, with the club badges and emblems visible on them. The claimant had licensed the production of an official stickers and album collection to M/s Topps Europe Limited. The claimant alleged this was infringement of copyright in the badges and emblems as artistic works. The defendant relied on the provisions of section 31 of *The Copyright, Designs and Patents Act 1988*, which provided that copyright in a work is not infringed by its
30 incidental inclusion in an artistic work or other work in which copyright subsists. It was held that the objective, when creating the image of the player as it appeared on the sticker or in the album,

was to produce something that would be attractive to a collector. It was therefore impossible to say that the inclusion of the individual badge and the FAPL emblem were incidental. It was found to be a work created primarily to serve a commercial purpose, rather than being an aesthetic, incidental inclusion in an artistic work.

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This suit is an excellent case study for why it is crucial for international soccer players and FUFA to have settled contractual provisions relating to the commercial use of the players' images by FUFA when the player is on an international duty. Considering the personal life, privacy, work, skills, and daily activities of a soccer player, legal protection of the player's image is essential.

10 Their image is part of their power and needs to be protected by limits and obligations through contractual clauses guaranteed and consented to by the owner of this personal right. D.W.2 Mr. Massa Geoffrey testified that the photographs now in issue were taken by FUFA at the Mandela National Stadium, Namboole, on the field. It is a team picture of the first eleven that played against the Nigerian national team, the "Super Eagles." The 1st defendant, MTN used them to advertise
15 and promote its products and services.

However, in absence a contract on image rights with any of the 11 participating players nor evidence of any practice of implied consent to the assignment of such rights, when by Clause 4.4 common to both sponsorship agreements FUFA gave the 1st defendant, "the right to feature the
20 Team as a whole or as individual members in [its] promotion and advertising campaign," it in effect gave a right it had no capacity to assign, since none had been given to it by any of the 11 participating players, whether directly or indirectly. It is a well-established principle of the law that no one can give what they do not have (*nemo dat quod non habet*). The rule represents the common law's traditional favour of the preservation of property rights. With a few exceptions
25 mainly in relation to real property, a transferor of property rights cannot pass a better title than he himself possesses. One who acquires property rights from such a transferor does not acquire any protectable right. The true owner of the rights does not lose his or her rights simply because of the wrongful act of an impostor who transfers those rights to an innocent third party who acted in good faith in paying money to the impostor for those rights.

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e. The plaintiff's locus standi;

Some ancillary issues were raised in the parties' submissions that have to be addressed before final conclusion of the issue. It was contended by counsel for the 1st defendant that the plaintiff lacks
5 *locus standi* to maintain this suit. The term *locus standi* literally means a place of standing. It means a right to appear in court, and, conversely, to say that a person has no *locus standi* means that he has no right to appear or be heard in a specified proceeding (see *Njau and others v. City Council of Nairobi [1976–1985] 1 EA 397 at 407*). The concept is crucial because it ensures that only those having a legitimate stake in a case or disagreement are permitted to participate in
10 judicial processes. It serves as a deterrent to frivolous or irrelevant lawsuits and contributes to the legal system's integrity and efficiency. To say that a person has no *locus standi* means the person cannot be heard, even on whether or not he has a case worth listening to. The foundation of *locus standi* is having a substantial interest in the matter that is the subject of litigation. Normally, save for a few exceptions, only a person who has a direct personal interest in the remedy being sought
15 or a legal right or claim that is recognised and protected by law, has *locus standi* to seek that remedy in court. A person must have a personal, direct or substantial interest in a matter in order to be entertained by the court. It means that a person can only go to court if his or her personal interests are jeopardised or injured.

20 In other words, a right must exist in the plaintiff to have a basis to access the Court for a remedy. One must justify such right by showing that one has a direct and substantial interest in the outcome of the litigation. A person must demonstrate a sufficient connection to the matter at hand. The person or entity asserting *locus standi* must have suffered or be at risk of suffering a direct and concrete injury or harm. This injury must be distinct and individualised, rather than a general
25 grievance shared by the public at large. This could involve showing a direct and personal interest, such as being directly affected by the subject of the suit or having a specific legal right that is being violated. When the plaintiff has a direct financial or legal interest in the outcome of the suit, it is easier to show "direct interest" since it is one of the means of demonstrating a personal connection with the decision concerned. A person holding a non-exclusive license is not entitled to complain
30 about any alleged infringement of the rights so licensed.

An exclusive license provides the licensee specific rights to perform certain acts legally reserved to the image owner. Consequently, the exclusive licensee must obtain the licensor's permission to do anything beyond the scope of the exclusive license. An exclusive licensee though generally has standing to directly sue third parties who may be infringing on its exclusive license rights. A representation agreement can still be "exclusive" for standing purposes especially where the image rights holder does not retain the right to license the use of the image him-or herself. The rationale is that in such an arrangement, the agency remains the exclusive agency. Ownership of the exclusive licensee of the right infringed confers standing. A licensee is considered a "substantial owner" of the right and therefor capable of suing (see *United Lacquer Mfg. Corp. v. Maas & Waldstein Co*, 111 F. Supp. 139 (D.N.J. 1953)). Unless the licensing agreement provides otherwise, the holder of an exclusive licence in respect of image rights is entitled to sue under the same circumstances as the rights holder. Infringement of the licensed image rights is considered to be financially injurious to the licensee of the rights. However, enforcement actions are limited to the specific rights exclusively owned. For example, a plaintiff who owns the exclusive rights to display the images publicly can only sue to enforce that specific right. Such a plaintiff, cannot go after alleged infringers making unauthorised copies or derivative works of the images.

Parties intending to convey enforceable exclusive image rights must shore up their agreements to make the intent clear. The nine signatories did not promise that all others (beyond the plaintiff) were to be excluded from using their images. The implication is that the nine signatories retained the right to license third parties to use their images. In sum, the nine signatories did not grant the plaintiff the rights of an exclusive licensee, but retained for themselves the right to license the use of their images to others.

However, there is no rule that a party cannot be an exclusive licensee of image rights if others may be licensed. To decide whether an exclusive licensee has the right to sue for the infringement of licensed image rights, courts often first interpret the intent of the parties to the exclusive license agreement in order to determine whether or not the license at issue is in fact an exclusive license. Determining whether a licensee is an exclusive licensee or a bare licensee is a question of ascertaining the intent of the parties as manifested by their agreement and examining the grant. The use of the word "exclusive" is not controlling; what matters is the substance of the arrangement

(see *Textile Productions, Inc. v. Mead Corp.*, 134 F.3d 1481, 1484 (Fed. Cir. 1998). A licensee is an exclusive one only if the image rights holder has promised, expressly or impliedly, that others shall be excluded from using the image within the field covered by the license.

5 There may be a plurality of exclusive licenses with divergent limitations placed on the licenses, each without the threat of competition from other licensees or the licensor. Where a licensee has exclusive rights under a license agreement, that licensee is the only party authorised to exercise those rights. If a license agreement transfers “all substantial rights” to the image rights and “the surrounding circumstances indicate an intent to do so,” then the license may be considered
10 exclusive for purposes of standing (see *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 874 (Fed. Cir. 1991) and *Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1340 (Fed. Cir. 2007). In other words, where an image rights holder transfers all substantial rights to the image in a license agreement, this confers standing on the licensee to sue for infringement in its own name alone. The retained right is the most important factor in determining whether a
15 license is exclusive and transferred sufficient rights to render the licensee the owner of the image rights for the specified period.

In the instant case, the agreement does not expressly reserve any rights in the nine signatory licensors, by any alternative means, to market their images individually or as a team. The licensee
20 was granted beneficial ownership of the signatory licensors’ proprietary rights for purpose of marketing them for commercial use in the promotion and advertisement of products and services. A licensee with sufficient proprietary interest has standing regardless of whether the right to sue is expressly granted in the licensing agreement or not.

25 f. The 2nd defendant’s contractual liability to the plaintiff;

It was further contended by counsel for the plaintiff that the 2nd defendant executed the contract of 7th September, 2007 as an agent of the 1st defendant. It however is not indicated anywhere in the contract that the 2nd defendant signed in a representative capacity nor that it was executed for the
30 benefit of the 1st defendant, although it became apparent in its implementation that it was for the benefit of the 1st defendant.

Furthermore, P.W.1 Mr. Mujib Kasule, testified that it is after his company agreeing on terms with MTN, the 1st defendant, that they sent him to Saatchi and Saatchi, the 2nd defendant to sign the contract. Subsequently payment came from the 1st defendant in form of cash and airtime. A contract or agreement between an agent and a third party is considered to be a contract between the principal and the third party. In the event the contract is breached by the principal, the agent cannot be held personally liable for any damages resulting from the breach. It is an established principle that where the principal is disclosed the agent cannot be sued on the contract (see *Ram v. Singh (1933) 5 ULR 76; Friendship Container Manufacture Ltd v. Mitchell Cotts (K) Ltd [2001] 2 EA 338* and *Phenehas Agaba v. Swift Freight International Ltd, H. C. Civil Suit No 143 of 2000*). The principal's existence and identity was made known to the plaintiff through words and performance of acts authorised by the contract.

It is evident from both the plaint and the testimony of P.W.1 Mr. Mujib Kasule that the plaintiff at all material time knew and believed that the 2nd defendant was an agent of the 1st defendant. The plaintiff's suit for breach of contract against the 2nd defendant is therefore unsustainable, since there is no claim against the 2nd defendant regarding the continued beyond 8th September, 2008 use of the material it generated for the use by the 1st defendant in its marketing and promotion activities, the suit against the 2nd defendant is entirely misconceived. For that reason the plaintiff's suit against the 2nd defendant is dismissed with costs to the 2nd defendant.

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g. The 3rd party's indemnity liability to the 1st defendant;

It was further contended by counsel for the 3rd party that it had no liability under the contract of 7th September, 2007 since it is not a party to it and never undertook to indemnify the 1st defendant in respect of any liability arising therefrom. Furthermore, that its indemnity obligations on basis of two sponsorship agreements dated 17th May, 2007 and 25th November, 2010 between the 1st defendant and the 3rd party are time barred. Indeed the 1st defendant lays claim to indemnification on basis of Clauses 14 in the former, which is similar to Clauses 7 in the latter agreement, providing as follows;

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14. Indemnity

The Sponsored hereby indemnifies the Sponsor, its agents, consultants and employees against any loss, damage or liability arising out of any activities

of the Sponsored, its agents, contractors or employees pursuant to this Agreement.

5 According to Order 1 rule 14 (1) of *The Civil Procedure Rules*, where a defendant claims to be entitled to contribution or indemnity over against any person not a party to the suit, he or she may, by leave of the court, issue a notice, called a “third party notice” to that effect (see *Overseas Touring Co. (Road Services) Ltd. v. African Produce Agency (1949) Ltd.* [1962] E.A. 190). In accordance with Order 1 rule 18 of *The Civil Procedure Rules*, questions of the third party’s liability to the defendant may be tried as one of the issues for determination in the main suit. That
10 notice was duly issued on 3rd November, 2020 upon the 1st defendant’s application.

Order 1 rule 17 of the Rules provides that in case the suit is tried and results in favour of the plaintiff, the court may either at or after the trial enter such judgment as the nature of the suit may require for the defendant giving notice against the third party, but that execution of the judgment
15 shall not be issued without leave of the court, until after satisfaction by the defendant of the decree against him or her. The provision envisages that the subject matter between the third party and defendant must be the same as the subject matter between plaintiff and the defendant and the original cause of action must be the same (see *Yafesi Walusimbi v. The Attorney-General of Uganda* [1959] 1 EA 223). The claim by the plaintiff against the defendant in this case relates to
20 the violation of image rights the 3rd party while the clause by which the 3rd party bound itself to indemnify the 1st defendant contained an undertaking by the 3rd party to afford the 1st defendant “the right to feature the Team as a whole or as individual members in [its] promotion and advertising campaign.” The subject matter between the 3rd party and the 1st defendant is therefore the same as the subject matter between plaintiff and the 1st defendant. The original cause of action
25 is the same in so far as it relates to the violation of image rights.

Under section 3 (1) (a) of *The Limitation Act*, a party cannot bring a suit based on a contract more than six years from when the cause action first accrues. When an action “first accrues” is generally from when the circumstances giving rise to the claim first occurred i.e., when the party breached
30 the contract(see *Gould v. Johnson (1702) 2 Salk 422; 91 ER 367* and *Midland Bank Trust Co., Ltd. v. Hett, Stubbs and Kemp (a firm)* [1978] 3 All E. R. 571). The qualification to this is that, where

the loss is solely economic, the cause of action accrues when the loss first becomes apparent or can be discovered through reasonable diligence.

5 The general position of the law is that the time for claiming loss or damage on an indemnity is when a party first suffers the loss or damage, i.e. when the loss has been ascertained or is ascertainable (see *Wardley Australia Ltd v. State of Western Australia (1992) 175 CLR 514*;
Therefore, the cause of action to entitle recovery under an indemnity does not arise until the indemnified person suffers actual loss; once the liability has been fixed or quantified. It does not matter whether the indemnified party pays the money over to the party it is intended to pay. In the
10 circumstances of this case, the 1st defendant cannot suffer actual loss, nor is such a loss ascertainable until a judgment is entered against it. A judgment of this Court is required to determine liability and also to fix the sum to a definite amount, i.e. the debt. By the contract of indemnity, the 1st defendant as the party indemnified may then recover all such charges as necessarily and reasonably arise out of the circumstances under which the 3rd party as the party
15 charged becomes responsible. The amount required to be paid is the amount required to prevent the 1st defendant as the indemnified person, suffering loss.

Finally therefore, counsel for the 3rd party's submission that by the time the third party notice was issued, on 3rd November, 2020 it was more than seven years since the expiry of the contract and
20 that liability based on a contractual term of indemnity was time barred, is therefore rejected. The cause of action against it will arise when the 1st defendant suffers a loss which is the subject of the indemnity Joinder of the 3rd party to the proceedings did not requires the cause of cation to have accrued; it only required the existence of a contractually based right to a claim of entitlement to indemnity.

25 In the final conclusion of this issue, the conflict is thus between the copyright vested in the author of a photograph that was taken of the 11 participating players, and then used without their consent, but rather with the permission of FUFA, for the commercial purposes of the 1st defendant on the one hand, and the image rights belonging to the subjects of the photos, on the other. This being a
30 case where there is no express or implied consent by any of the 11 participating players to the use of that image by the 1st defendant in its commercial and promotional activities, their consent as the

photographed persons is equivocal. In that case then, copyright cannot prevail over image rights. When there is doubt that the person's consent has been granted for such use, image rights prevail over copyright law. An exclusive license when granted allows the person the same rights as that of the owner of the image right. Therefore, the issue is answered in the affirmative. For all practical purposes, as an exclusive licensee, the plaintiff owns the players'/models' image rights in issue and is capable of suing for their enforcement.

Second issue; whether the defendants are in breach of any contract.

It is Counsel for the plaintiff's alternative submissions that the contract could be deemed to have been renewed by conduct, since the defendants do not deny having used the images beyond the contractual period. Whereas the 1st defendant admitted using images of the 11 participating players beyond the expiry date of 8th November, 2008 I denied having done so on basis of material generated under the expired contract but rather on material generated under the two sponsorship agreements with the 3rd party. There is therefore no evidential base to support the assertion that the 1st defendant continued to perform activities under the contract of following its expiry.

In any event, a contract which has come to an end cannot be renewed unilaterally by the conduct of only one of the parties to it. For a contract to be deemed to have been renewed by conduct, there is need for mutuality of performance of its obligations by the parties thereto following its expiry. The actions of parties after a contract expires can demonstrate an intention to extend the contract beyond the expiry date despite any discussion or express agreement. Where a contract expires and the parties act as if the contract is extended, the law will deem that the contract was extended (see *Coffee Time Donuts Incorporated v. 2197938 Ontario Inc.*, 2022 ONCA 435). The law considers the conduct of the parties to determine if they demonstrated an intention to be bound by the expired contract. It appears apparent that, in this way, the law follows the moral principle that actions speak louder than words. The court will look at the parties' actions and communications, to decide what a reasonable person would have understood the parties' intentions to be, rather than what they may subjectively have intended.

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If the parties continue to do business in a way which is consistent with the terms of the expired contract dated 7th September, 2007, this would support an argument that its terms still dictate their relationship. If there is no change to how the parties conducted themselves under the terms of the contract after expiry, it is strongly arguable the parties had the implied intention to continue under the same terms and conditions of the expired contract or enter a new contract on those terms. Before Court, there is no evidence that either the plaintiff or the 1st defendant continued to conduct themselves in the same way toward each other as they did before the contract expired. Therefore, the issue is answered in the negative. The defendants are in breach of any contract with the plaintiff.

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Third issue; whether the plaintiff is entitled to payment for the continued use of its models' images for the period of three years in line with the contract dated 7th September, 2007.

Fourth issue; whether the parties are entitled to the remedies sought;

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These two issues are correlated and will be addressed concurrently. Regardless of consent, the individual's image is considered to be an inalienable, precious right over which control could never (and should never) be lost by the owner. Considering the temporal limitation in the use of their images that was given to the 1st defendant, through its agent the 2nd defendant, under the agreement dated 7th September, 2007 the permission that had previously been granted to the 1st defendant had lapsed on 8th September, 2008 and cannot afford the 1st defendant defence to its continued use of the 11 participating players beyond that date.

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The consent to the publication of one's image constitutes a unilateral transaction, having as its object not the very personal and inalienable right to the image, which as such cannot be negotiated, but only the exercise of this right. Although it may occasionally be included in a contract, the consent nevertheless remains distinct and independent from the agreement that contains it (see for example *Michael Kirk Douglas and another v. Hello! Ltd (No. 3)* [2005] EWCA Civ 595; [2006] QB 125; [2005] 4 All ER 128). As a result, it is always revocable regardless of the remuneration, which does not authorise a transaction, in view of the nature of an inalienable right and, therefore, not susceptible of evaluation in economic terms.

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An individual's identity is infringed where a person's image is used or appropriated without his or her permission for advertising purposes, creating the false impression that such person has consented to such conduct or supports the advertised product, service or business (see *Edmund Irvine Tidswell Ltd. v. Talksport Ltd.* [2002] WLR 2355; [2002] 2 ALL ER 414). Although the right of publicity is commonly associated with celebrities, every person, regardless of how famous, has a right to prevent unauthorised use of their name or image to sell products. This right also prohibits any implication that a person endorses a product (without the person's permission). The right to publicity, on the other hand, protects individuals from the exploitation of their name or likeness for commercial purpose. The plaintiff has proved the violation by the 1st defendant of the image rights licensed to it by the 11 participating players which the entities it to a number of reliefs.

i. General damages and interest.

It is impossible to accurately value the exploitation of a soccer player's image as marketing revenue for a sponsor, club, or third party, but it is common sense that it is a remarkable venture that could be estimated simply by analysing the profitable results generated by a player's exposition. In assessing damages generally, a "lost license fee" is often applied. In other words, what would the offending party have had to pay if that party had been granted a license to commercially use and exploit the sports image rights concerned. In *Edmund Irvine Tidswell Ltd. v. Talksport Ltd.* [2002] WLR 2355; [2002] 2 ALL ER 414 it was held that damages should be "a reasonable endorsement fee" which would be the amount that the defendant would have reasonably paid to feature the celebrity in their advertising, taking into account the total cost of the advertising campaign and the target audience. On appeal it was confirmed the proper measure was the fee that the defendants would have had to pay had they obtained the endorsement lawfully which on the evidence was GBP £ 25,000.

The alternative methodology used is based on the income approach. In other words, the Court will identify and predict future revenue streams from commercialising the sports person's image and discount them into the present applying certain risk factors, including injury and early retirement. These are based on the abilities and expected performances of the sports persons concerned. Such evaluations are made on a case-by-case basis according to the particular facts and circumstances

of each individual, taking into account the player's performance on the pitch will have a value whilst a separate discussion regarding his image rights may factor in an analysis of how much income they can expect to generate for paying the player for those rights, and any fall from grace of the sports person

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It was the testimony of D.W.3 Mr. Edgar Watson Suubi, that the 1st defendant sponsored FUFA between the years 2007-2010 and then from 2010 and ended in 2013. For the duration of that sponsorship, the 3rd party had erroneously granted the 1st defendant the right to use the images licenced to the plaintiff, yet the consent given through the plaintiff had expired on 8th September, 10 2008. The 1st defendant therefore for a period of five years, in violation of the image rights, used the images which had been exclusively licensed to the plaintiff in circumstances where it is reasonable to estimate that it would have had to pay the plaintiff at the rate that had been negotiated under the expired contract, had it been granted an extension of that agreement to commercially use and exploit the sports image rights for that duration. The plaintiff is accordingly awarded a sum of 15 shs. 570,600,000/= as general damages.

Section 26 (2) of *The Civil Procedure Act* empowers the Court, insofar as the decree is for the payment of money, to order interest at such rate as the court deems reasonable to be paid on the principal sum adjudged from the date of the suit to the date of the decree. The plaintiff is 20 accordingly awarded interest on the decretal sum at the rate of 6% per annum, from the date of filing the suit, i.e. 6th September, 2011 until payment in full.

i. Costs.

25 The general rule under section 27 (2) of *The Civil Procedure Act* is that costs follow the event unless the court, for good reason, otherwise directs. This means that the winning party is to obtain an order for costs to be paid by the other party, unless the court for good cause otherwise directs. I have not found any special reasons that justify a departure from the rule. Therefore in conclusion, judgment is entered for the plaintiff against the defendant, as follows;

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- a) The sum of shs. 570,600,000/= as general damages.

- b) Interest thereon at the rate of 6% p.a. from the date of filing the suit, i.e. 6th September, 2011, until payment in full.
- c) The costs of the suit.

5 Delivered electronically this 2nd day of February, 2024

.....Stephen Mubiru.....
Stephen Mubiru
Judge,
2nd February, 2024.

