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Celebrity's Name Taken in Vain

Recently, the Federal Court in *Mohammad Hafiz bin Hamidun (MHH)* validated the right of celebrities to protect their goodwill by an action in passing off.

A popular *nasyid* singer and composer, MHH owns Haje Sdn Bhd (**HSB**), a fashion business. Sometime in February 2017, MHH received messages from his fans asking whether certain products sold by another party (**D**) with the label “*Hafiz Hamidun*” were related to him. They were not, prompting MHH to commence an action for passing off.

Goodwill in celebrities

Goodwill, an intangible and fluid asset, is not strictly attached to any particular individual or group of persons.¹ Rather, it exists in the trade or in the goods or services. It can be affixed to the name, description or any other insignia, mark or distinguishing feature relevant to those goods or services.

Celebrities can own goodwill.² They amass goodwill generated by their personal achievements and fan base.³ The misappropriation or deceptive use of a celebrity's goodwill for commercial gain falls within the purpose for which the tort of passing off was developed to remedy.⁴

To maintain an action in passing off, it must be shown there exists a false representation of a connection between the products and the celebrity. It is insufficient to prove that the celebrity's name or image was used.⁵

In this case, the Federal Court held members of the public, including the fans of MHH, were led to believe the products sold

¹ Paragraph 44 of the grounds of judgment
² Paragraphs 49 and 59
³ Paragraph 68
⁴ Paragraph 54
⁵ Paragraph 62

by D with the label “*Hafiz Hamidun*” belonged or were endorsed by MHH.⁶ There was a clear deception to misappropriate MHH’s goodwill.⁷

Locus standi

The Federal Court also rejected D’s argument of HSB owning the goodwill instead of MHH.⁸ It was held both MHH and HSB had *locus standi* to commence an action in passing off against D.⁹ The use of goodwill between MHH and HSB was a private matter between the parties.¹⁰ D was a mere outsider who had no right to use the goodwill.¹¹ Hence, D was barred from evading liability for the tort of passing off on mere technicalities.¹²

Conclusion

This decision marks a new milestone in Malaysia and contributes positively towards the development of intellectual property law in the local jurisprudence.

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⁶ Paragraph 64
⁷ Paragraph 64
⁸ Paragraph 76
⁹ Paragraph 76
¹⁰ Paragraph 71
¹¹ Paragraph 71
¹² Paragraph 73