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Emerging Trends in Publicity Rights in India: An Analysis Under the Intellectual Property Laws in India

by

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Abstract — Emerging as an interesting legal trend in India, publicity or personality rights of celebrities are contributing to the development of Indian entertainment law, thereby establishing the need for legal scholars and academics to study the implications of these unique rights.

Publicity rights have their origin in other common law jurisdictions and arose in response to the presence and influence of the motion pictures industry. Primarily derived from the right of privacy, publicity rights in India have arisen as a sui generis regime due to the increasing rate of unauthorized usage of the various aspects of the celebrity persona, including those of celebrated actors such as Amitabh Bachchan and Rajnikanth, whose appearance or likeness have been unduly exploited for commercial gains by advertisers and brands alike. Unfortunately, the current Indian intellectual property regime seems insufficiently equipped to deal with this issue and its consequences. Judicial decisions in this area have been sporadic, leading towards the need to develop more lucid statutory language for enforcing this right and possibly, a distinct regime of publicity rights.

This paper seeks to examine the growth of personality rights of celebrities as an emerging specialized right in India. The paper is divided into three parts. Part I of the paper discusses the origin and evolution of publicity rights through international cases and judicial decisions. Part II discusses and analyzes Indian cases and judicial decisions that have enforced publicity rights. Part III discusses other statutory provisions dealing with publicity rights such as copyright,



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trademark and related legislations in India. This paper concludes with possible suggestions as a way forward through a comparative analysis of the experience in different jurisdictions, with the hope of finding a suitable solution to India's unique legal, social and cultural scenario.

PART I INTRODUCTION

The origin of the right to publicity or personality lies in the efforts of the entertainment industry in response to the recognition of the commercial value of a celebrity's image, likeness, voice and appearance. With the growth of digital media, the study of publicity rights assumes immense importance and finds itself at the center of several contracts and negotiations in the entertainment industry.

Publicity rights or privacy rights, simply put, are those rights which protect the interests of celebrities in their images and identities.¹ The development of the jurisprudence of publicity rights has been surrounded by a great deal of skepticism,

often giving rise to the debate that whether such a right is truly representative of the need to protect a person's privacy rights or is if it is merely an exaggeration of an otherwise frivolous interest. Some scholars advocate that the treatment of the human likeness as a source of monetary gain is an unnecessary and excessive commercialization of the human body, resulting in speculations as to whether such a right must exist and encouraged. Others consider publicity rights to be an offshoot of intellectual property rights like copyright and trademark, finding no significant difference between the commercial exploitation of a person's idea and a person's likeness, so long as there is consent of the concerned individual.

The question that arises then is whether a separate species of rights is required to protect these interests or the existing legal infrastructure already provides a framework that simply requires effective implementation. Several jurists have expressed the need to examine the justifications which underlie this particular species of right, and to discard the ambiguities which tend to surround it. With the ever increasing recognition afforded to publicity rights in courts across jurisdictions, it becomes imperative that we begin to focus on addressing the question that whether we actually need a separate rights regime for protecting interests arising out an individual's publicity, or the existing legal infrastructure is sufficient to protect one's interests.



DEFINING A PUBLICITY RIGHT:

A publicity right refers to a right, which protects an individual's interest in an image, a voice or likeness. This right enables a celebrity to object to the use of his image or likeness in any manner, without his consent. It is also a right, which is pecuniary in nature as it allows a celebrity to make profits by the use of his likeness. However, it needs to be understood as slightly distinct from a right of privacy in that if a man has a right in the publicity value of his photograph, then he has a right to grant exclusive privilege of publishing his picture.²


Brook LJ, in a 2005 decision defined the right to publicity as "*An exclusive right of a celebrity to the profits to be made through the exploitation of his fame and popularity for commercial purpose*".³ This definition helps to distinguish the notion of publicity right from related moral and privacy rights by putting emphasis on its commercial value. In the same case, it was observed by Sedley LJ that damage to the reputation of an individual does not amount to financial or economic loss, and thus publicity right is one which concerns intangible harm. This is recognition of an intellectual property right that aims to secure financial benefits rather than merely provide protection to the celebrity.

The most cited definition of a publicity right can be found in section 46 of the 'Restatement (Third) of Unfair Competition Act (2005), Appropriation of the Commercial Value of a Person's Identity: The Right of Publicity which essentially states, "*One who appropriates the commercial value of a person's identity by using, without consent, the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate.*"

THE ORIGINS AND HISTORY OF THE RIGHT:

The origin of the publicity right lies in the understanding of the right to privacy.⁴ The notion that a celebrity was entitled to financial benefits from the use of his image was only a consequence of acknowledging the fact that the celebrity had a right to

privacy. In other words, it was only after courts made it clear that being a celebrity or public figure does not justify the full disclosure of everything that occurred in their personal lives, that it was understood that if a celebrity were to make some part of his or her life public, then he or she would be entitled to monetary compensation for the same. This necessarily led to a controversial two-fold justification for


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the introduction of publicity rights, namely an economic justification and a moral justification. The economic justification for the right afforded protection to the celebrity from overexploitation and is often looked upon as an incentive to foster fame.⁵ The moral justification adopts the view that since celebrity is the one who contributes towards the creation of the identity, he alone stands to gain from the benefits accruing to it.⁶ These justifications have a firm basis in the prevention of unjust enrichment.

One of the most common forms of exploitation of popularity is celebrity advertising, which is often the only way in which one can distinguish between several similarly priced products of the same quality. In addition to an attractive packaging and a respected trademark, the persona of a celebrity adds substantial market value to the product, thereby placing a price tag on market popularity as well.⁷ It is the effort to curb this 'free-riding' and appropriation of celebrity's popularity, which lends purpose to the creation or rather recognition of the publicity right.

The first case to explicitly recognise the right to publicity was *Haelan Laboratories Inc v. Topps Chewing Gum Inc*⁸. This case devised the traditional publicity rights, while recognizing the value of, and property right in, a baseball player's photograph used on trading cards. The Court held that in addition to, and independent of that right of privacy, a man would also have a right in the publicity value of his photograph. The Court finally held that the plaintiff had a valid claim against the defendant so long as the defendant used the player's photograph during the term of the plaintiff's grant and with the knowledge of the terms of the plaintiff's contract.

Subsequent commentaries have modified our understanding of the publicity right as distinct from the right to privacy. For instance, Professor Melville B. Nimmer argues that although publicity and privacy claims sometimes overlapped, plaintiffs approaching the courts for privacy were concerned with unwanted intrusion into their personal lives, while plaintiffs coming to courts for publicity rights complained of the uncompensated exploitation of their identities.⁹ In 1977, the United States Supreme Court recognised a common law right of publicity.¹⁰ The action was said to lie if the claimant could demonstrate the fact that:

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- he owned a publicity right concerning his own or licensed personality features;
- the defendant without permission used these features in a way that the celebrity is identifiable; and this use was likely to cause damage to the commercial value of the personality features.

The right of publicity originated as a prohibition against misappropriating a person's name or likeness, thus creating the idea of a protected persona. The Court noted that the right of publicity served three basic purposes¹¹, namely—

- It prevented others from being unjustly enriched by the goodwill of the plaintiff.
- It kept others from interfering with the plaintiff's right to make a living as an entertainer.
- It provided entertainers and celebrities an economic incentive to continue to invest in creating performances that the public could enjoy.

There have been a lot of cases suggesting various avenues in which exploitation of popularity may occur. For instance, in a celebrated case, the famous American entertainer and filmmaker, Woody Allen, was granted an injunction to prevent the use of a look-alike in a commercial, thereby protecting his likeness.¹² In another case, the repetitive use of the slogan, "Here's Johnny", which was used to introduce a TV show was held to be indicative of a famous person, and therefore, could not be adopted for the sale of portable toilets.¹³ An actor prevented a restaurant from adopting the name of the performed film character Spanky McFarland, and the use of the pictures of other actors.¹⁴ The problem regarding the use of sound-alike voices was addressed in several cases. In *Waits v. Frito-Lay Inc*¹⁵, the Court awarded a compensation of \$375,000 plus \$2 million in punitive damages to Tom Waits whose voice was adopted by a voice alike for commercials. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*¹⁶, the defendant tobacco company used a slightly modified footage of a famous car-race driver's car in a television commercial without permission and consequently the driver's right of publicity was held to have been infringed.

Statutory incorporation of the right has also taken place in different jurisdictions. However, the realm of publicity right is still growing in order



to combat the ever increasing ways in which one may benefit from another's fame.

STUDY OF PUBLICITY RIGHTS FROM OTHER JURISDICTIONS

1. THE RIGHT OF PUBLICITY IN THE UNITED STATES:


The development of the right to publicity is closely related to the right to privacy in American jurisprudence. The New York Legislature created a statutory right to privacy in 1903 following a case where the plaintiff claimed that her likeness had been used to create an image on flour bags. Although the Court rejected her claim, this case gave rise to the need for a right to privacy, violation of which would entail both civil and criminal liability. The Common Law principle of privacy however, was soon phased out as it was held to be inadequate in dealing with the commercial interests of celebrities. The need was felt to recognise a right which was meant to protect the pecuniary interest of the celebrity, and possibly the intellectual property produced by them. Interestingly enough, the New York Legislature's attempt to create a commercial publicity right, couched in human rights theory, was not far from the German version of the right.

The strongest publicity rights in the United States exist in California, the home of a powerful celebrity market. The statutory protection afforded is almost custom made to the needs of professionals and celebrities in California. There are several legislations like the Lanham (Trademark) Act, 1976 which affords protection in cases involving passing off, one of the most sought after routes to ensure celebrity protection. There is a great deal of case law which is responsible for the development of right of publicity in the United States as we know it today.

A. Defenses and Duration:

The right of publicity is not absolute and is subject to certain limitations. Although there has been some disagreement as to what limitations can be imposed on the


protection accorded to the citizen under the right of publicity, there have been some accepted defenses to the right. Firstly, consent, preferably written, is a valid defense, although there have been instances such as Washington's statutory law acceptance of "oral" or "implied" consent as adequate.¹⁷ A material published with the consent of a celebrity cannot be said to infringe the celebrity's right of publicity. Another popular

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defense cited is that of newsworthiness. If the material published is not merely gossip or speculation, and is factual in nature and worthy of being reported as news, it is possible to claim that there has been no infringement on the individual's right of publicity.¹⁸

Another very important defense concerns the protection offered under the freedom of speech and expression. This has already been dealt with in detail previously in connection with the famed *Tiger Woods' case*. In the United States, a great deal of literature has been generated on the discussion of the First Amendment defenses which primarily focus on speech and expression. The role of the courts while determining the applicability of such a defense essentially involves conducting a fact-specific balancing test which aims to compare competing interests of the person's right of publicity with the public's right to be informed.¹⁹ As already mentioned, the transformative elements test is of crucial importance here, as is determining the primary message of the work in question. For instance, if the purpose of the reference is to advertise or sell an unrelated product, chances are that it will be treated as a commercial endeavor and thereby will be entitled to little or no protection under the First Amendment.²⁰ Similarly, if the primary purpose of the reference is art, parody or political speech, then the courts are more likely to provide the protection under the First Amendment. The same has been witnessed in the case of *ETW Corp. v. Jireh Publishing Inc.*²¹

Death is not a practical defense to adopt, as in most jurisdictions, the right of publicity is descendible and transferable. This effectively allows the right of publicity to persist for a period ranging from 10 to 100 years after the death of the individual. The States of Tennessee, Indiana and Oklahoma in the United States recognise the longest potential post-mortem publicity rights,²² with Indiana and Oklahoma recognizing a right persisting for 100 years. The Tennessee statute provides protection to the right holder for as long as he or she continually exploits the commercial value of the identity. This necessarily means that duration of the right is practically unending in some jurisdictions. Washington law provides a 10 year post mortem right for individuals and 75 years for those whose persona rights continue to have commercial value.²³

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Marilyn Monroe is synonymous with the words "blonde" and "bombshell". Inarguably one of the most successful actresses of her time, she was known to have redefined American cinema through her performances and controversies. Her fame earned her a great deal of money, something which has not really changed since her death in 1962. The use of Monroe's name, voice and likeness in the course of selling a vast range of products has been a huge source of income for her estate. Combining

efforts with leading talent agency CMG Worldwide Inc., the Monroe estate has been able to rake in nearly \$30 million after licensing the actresses' name and image.²⁴ This enormous income flow however, faced an insurmountable blockade created by two decisions in May 2007²⁵, which held that Monroe's publicity rights died with her. As a result, the Monroe estate was no longer the rightful owner of Marilyn's voice, likeness or image, thereby preventing them from licensing it through CMG or any other agency.

2. PUBLICITY RIGHTS IN THE UK:

English law has always resisted the creation of a publicity right, and has instead emphasized freedom of speech and expression. The gradual development of the right of publicity is partly due to the country's commitment to international treaties such as the European Convention on Human Rights (ECHR). In a series of cases, courts have held that taking pictures of individuals without their consent is violative of Article 8 of the ECHR²⁶, regardless of the purpose for which the photographs are meant. There have been several famous decisions such as the one involving pictures of the Douglas-Jones wedding, and the recent decision concerning a compensation made to Naomi Campbell under the Data Protection Act, for an unauthorized publication of her photo, in a story about her drug therapy.

3. PUBLICITY RIGHTS IN GERMANY:

In Germany, the situation under trademark, copyright and unfair competition laws differs only slightly from the position in the UK.²⁷ It is necessary to highlight here the fact that both UK and Germany have developed torts that grant protection in specific situations, such as the tort of passing off. The tort of passing off establishes that nobody has any right to represent his goods as the goods of someone else.²⁸ Every passing off action has, at



its core, ingredients of goodwill, misrepresentation and damages. In the *Jif Lemon case*²⁹, the House of Lords stated following conditions for a successful claim under the tort of passing off:

- goodwill or reputation must be attached to the products or services of the plaintiff;
- the misrepresentation must lead to confusion as to the source of the goods or services; and
- this confusion must cause damage to the claimant.

The difference between the law in UK and Germany in the treatment of this right and the tort of passing off is the presence of additional tools in German law. Statutory protection afforded by the German Civil Code, the Copyright in Works of Art and Photography Act, 1907 and the German Constitution attempts to provide a stronger legal support to celebrities' interests in terms of protecting the rights attached to one's name, picture and personality.

PART II DEVELOPMENT OF PUBLICITY RIGHTS IN INDIA

The jurisprudence of publicity or personality rights is at a nascent stage in India. While no legislation recognises *per se* the right of publicity in India exists, the courts, particularly the Delhi High Court and the Bombay High Court have been reasonably active in recognizing and enforcing this right.

The right of publicity stems from the right of privacy, as evidenced from *R. Rajagopal v. State of T.N.*³⁰. The Court held that one of the inherent aspects of the

right to privacy as enshrined under Article 21 of the Constitution is the right to prevent others from using the person's name or likeness without his consent for advertising or non-advertising purposes. This also includes the right to prevent others from publishing the life story of a person, whether written in a laudatory manner or in the form of a critical commentary.

However, if a matter dealing with an individual, his family, or education becomes a matter of public record, the right to privacy no longer subsists and the former becomes a legitimate subject for comment by press and the media.



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In a number of instances, the courts have interpreted the right of publicity of famous persons in the same light as protection afforded to well-known trademarks. For instance, in *DM Entertainment v. Jhaveri*³¹ Daler Mehndi, a famous Indian singer, composer and performer, brought an action against a party that had registered a domain name 'dalmehndi.net'. The Delhi High Court prohibited the defendant from using the mark and domain name, thus recognizing the fact that an entertainer's name may have significance as a trademark. Similarly, in *Arun Jaitley v. Network Solutions (P) Ltd.*³², the plaintiff, Mr. Arun Jaitley, a prominent political leader of the Bharatiya Janata Party (BJP), filed for a permanent injunction to restrain the defendants from misusing a domain name, www.arunjaitley.com. The plaintiff also asked for immediate transfer of the said domain name as the plaintiff wished to register the domain through the website of the defendants. The Delhi High Court upheld the right of Mr. Jaitley and pronounced that any person may be restrained from using popular or well-known celebrities' personal names, when, firstly, it is satisfied that the particular name is a well-known trademark as envisaged under the basic principles of trademark law, and secondly, the person is entitled to use his name for commercial purposes.

The scope and applicability of the right of publicity was defined in *ICC Development (International) Ltd. v. Arvee Enterprises*³³, wherein the Delhi High Court laid down that right of publicity neither applies to non-living entities or objects such as an event or a sport which made the individual famous, nor to the corporation that has brought about the organization of the event, as non-living entities are protected under the copyright, trademark law, dilution and unfair competition law. Therefore, non-living entities need not be brought under the scope and ambit of rights of publicity. Furthermore, extension of the right of publicity to non-living entities goes against the basic tenets of the concept of "persona". Additionally, since the right of publicity has evolved from the right of privacy, it can inhere only in an individual or in any indicia of an individual's personality like his name, personality trait, signature, or voice. An individual may acquire right of publicity as a result of his or her association with any event, sport, or a movie. However, this right cannot be enjoyed by the event, or the sport which made neither the individual famous, nor the corporation that has brought about the organization of the event.

In another interesting case brought before the Delhi High Court, namely *Titan Industries Ltd. v. Ramkumar Jewellers*³⁴, Bollywood superstars, Amitabh Bachchan and Jaya Bachchan, were hired by Titan Industries for



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promoting Titan's Diwali season jewelry collection under Titan's brand name - Tanishq. The defendants, Ramkumar Jewellers, allegedly copied the images of the two superstars for their own hoardings, which were put up all over Muzzarfarpur in the state of Uttar Pradesh, to the extent that it became ostensible to the members of the public that Amitabh Bachchan and Jaya Bachchan were endorsing Ramkumar Jewellers' products. The Court held that the right to control the use of identity of the famous personality should vest with the celebrity himself and should not accrue to others. Therefore, this right to control the commercial use of the identity of a human being, not only a celebrity or a "famous person" is known as "right to publicity".

Furthermore, the Court has laid down the following guidelines for establishing the burden of proof by the plaintiff in cases of infringement of the right of publicity:

- Validity: The plaintiff owns an enforceable right in the identity or persona of a human being.
- Identifiability: The celebrity must be identifiable from defendant's unauthorized use. If the plaintiff is a very well-known and widely recognised celebrity, a simple comparison to the defendant's use and the plaintiff's identifying features, may itself be sufficient to create a strong inference of identifiability. This is termed as unaided identification.
- Direct or circumstantial evidence of the defendant's intent to trade upon the identity of the plaintiff, from which identifiability can be presumed.

In *Sonu Nigam v. Amrik Singh*³⁵, Sonu Nigam, a well-known Bollywood singer, filed a suit against, *inter alia*, Mika Singh and Bright Outdoor Media, before the Bombay High Court because unauthorized hoardings and billboards, featuring the image of Sonu Nigam were put up by the defendants. The hoardings contained advertisements, which featured large picture of Mika Singh, as against smaller images of Mr. Nigam. The Bombay High Court granted an order to restrain Mika Singh and OCP Music from directly or indirectly publishing the advertisement and use of the plaintiff's image in any manner whatsoever, as it violated Sonu Nigam's personality, publicity and image rights.

In *Sourav Ganguly v. Tata Tea Ltd.*, before the Calcutta High Court, Sourav Ganguly, a popular cricketer and former captain of the national team, discovered that a well-known brand of tea was cashing in on his success by offering consumers a chance to meet and congratulate the cricketer. The offer implied that the cricketer was associated with the promotion, which was not the case. Ganguly successfully challenged the same in court before settling the dispute amicably.



In 2009, Mont Blanc, the German luxury pens giant, on 140th Birth Anniversary of Mahatma Gandhi launched limited, special edition pens, "Mahatma Gandhi Limited Edition 241" and "Mahatma Gandhi Limited Edition 3000" with Gandhi's image embossed on the nib of the pens. However, managing trustee of the Centre for Consumer Education in Kerala, filed a writ petition on the grounds that use of Mahatma Gandhi's image on pens is wrong, illegal and prohibited under Section 3 of the Emblems and Names (Prevention of Improper Use) Act, 1950, under which no person can use for the purpose of any trade, business, or calling or profession, any name or emblem specified in the Schedule, without prior permission from the Central Government.

As further stated in Schedule 9A of the Act, the “name and the pictorial representation of Mahatma Gandhi” as an item cannot be used for the purpose of any trade, business, or profession or any commercial transactions.

The luxury pens' company gave an oral undertaking that it would not sell any pens with the image of Mahatma Gandhi, till such time as its application for permission was denied by the Central Government. The Central Government refused permission for the use of the image of Mahatma Gandhi on the company's pens. The Supreme Court decided to dispose of the case after Mont Blanc decided to withdraw the pens and advertisements from the market.

More recently, Lalit Bhasin, a prominent corporate lawyer from India, had filed an opposition in his personal capacity against the trademark application before the Ecuador Trademark Registry regarding the registration of the name and image of the Father of the Nation, Mahatma Gandhi as “Arroz Gandhi” (Gandhi Rice) trademark. The registration was sought as an international Class 30 mark with respect to “aged or old rice, also medium and long grain rice that may or may not come from India”.

Section 3 of the Emblems and Names Act (Prevention of Improper Use) Act, 1950 prohibits the use of certain names for the purpose of any trade, business, calling or profession, as specified in the Schedule to the Act. The Schedule in Point 9-A of the Act prohibits the use of the name or pictorial representation of “Mahatma Gandhi”. The Schedule prevents the use of the name, emblem or an official seal.

The Ecuador Trademark Registry through its order on June 6, 2013 accepted the opposition filed by Lalit Bhasin and rejected the registration of the Arroz Gandhi mark. The Trademark Registry held that Lalit Bhasin had a legitimate interest in opposing the registration as he had the capacity, power and rights that every Indian citizen owns, for defending his national symbols and the characters that form part of the culture and identity of their country. In this case, the name and image of Mahatma Gandhi, the Father

of the Nation, is one of the most highly revered national symbols of India. The Trademark Registry also stated that it was also an icon of spirituality in India. Additionally, the Trademark Registry considered the fact that the Arroz Gandhi mark contained the Gandhi drawing with all its graphic elements. This, when comparing the similarities and not the differences, infringes the copyright of the Gandhi drawing.

Therefore, the restriction from using rights of personality and publicity of a national figure in a foreign country and consequently, the prohibition on deriving financial benefit from such a person's name and likeness was recognised by Ecuador case and therein lays the significance of this judgment.

RELATIONSHIP BETWEEN PUBLICITY RIGHTS AND OTHER IP RIGHTS

4. TRADEMARKS, PASSING OFF, AND PUBLICITY:

The right of publicity and the law of trademarks have a great deal in common, beginning with their common goal of ensuring that the owners of the right continue to control the use and meaning of their identities.³⁶ Trademark law attempts to curb such use of trademarks which might result in confusion or ambiguity as regards to the affiliation or source of the goods. The right to publicity provides a similar protection in that it tries to prevent cases where a celebrity may be falsely or mistakenly associated with a product that they are not necessarily using, much less endorsing. These rights are significant as they not only ensure the protection of celebrity interests but also contribute to creating awareness among the general public. In other words, both these

rights together, eliminate the possibility of misinformed audiences or consumers. This is where passing off and dilution finds meaning. The basic premise underlying passing off is that misinforming or misleading public is to be treated as unacceptable. The notion of understanding publicity rights in the context of trademark law has several advantages. Firstly, the experience provided by the law related to trademarks helps to give shape and context to the matters that may arise with reference to publicity rights. Secondly, an understanding of trademark law will allow us to set limits to how the right to publicity rights may be conceived. The primary quandary surrounding publicity rights concerns prescribing a reasonable limit to the kind of situations that it may be applied to.



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The right of publicity requires a study of several areas of law. The issues involved in the understanding of publicity rights spans across those related to constitutional law, intellectual property and jurisprudence. The controversies generated around this particular right are indicative of the shaky ground on which celebrity rights are based. As is evident from the discussion so far, not all jurisdictions provide for a statutorily recognised publicity or privacy right. The alternate routes to seek protection include resorting to other forms of intellectual property protection such as trademark or copyright laws. The right of publicity also hinges on the working and availability of other rights such as the right to privacy and the freedom of speech and expression.

Much like publicity rights, trademark rights too are rights appurtenant, rather than self-supporting intellectual property rights.³⁷ For a trademark claim to succeed there must be a demonstration of the likelihood of consumer confusion, whereas publicity claim requires a demonstration of appropriation of the economic, associative value. For example, a clear, unequivocal disclaimer of affiliation of any kind can be used as a defense to an infringement claim, whereas such a disclaimer in the publicity claim, which is not dependent upon endorsement, could well serve to exacerbate the appropriation.

In *Bi-Rite Enterprises Inc. v. Button Master*³⁸, the Court held that a trademark right cannot be a vehicle for enforcing claims arising out of the merchandising of the mark itself absent clear evidence of real (rather than spurious), source, origin, or sponsorship of the goods or services. In the same vein, the right of publicity, if properly understood and bounded, is an appurtenant right, rather than absolute exclusionary property right, in the name or image and that its recognition accordingly precludes a publicity claim based solely on the exploitation of the image itself without association with the user of the image.

Focus on the fundamental nature of the underlying legal constructs of the trademark law and of the cognate right of publicity allows application of a conceptual occam's razor, a simplification that sets the proper boundaries and balance.

5. COPYRIGHT LAW AND PUBLICITY RIGHTS:

There have been a few instances where the application of copyright law has created problems in the assertion of publicity rights. In the United States, this has culminated in the possible pre-emption by copyright law, although there have been cases where the publicity right claims arising



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under state law have stood up to the challenge.³⁹ When the United States Congress amended the Copyright Act in 1976, it provided for the explicit pre-emption of certain types of state law claims related to copyright in the enactment of section 301(a) and (b). Section 301(a) provided for a two-pronged test wherein pre-emption is to be allowed—

- The state right is “equivalent” to the exclusive rights of a federal copyright; and
- The state right is “within the subject matter of copyright” as defined by the Copyright Act, 1976.

A claim for violation of a right of publicity in connection with the use of an individual's name or claims arising from the use of a photograph, a likeness, or any other still image cannot be subject to pre-emption. In *Stanford v. Caesars Entertainment Inc*⁴⁰, the Court held that Crisper Stanford's right of publicity claims were pre-empted because it was not the plaintiff's image, voice, likeness and persona that were at issue, but rather his role as the fictional character “Loose Slot Louie”. Since the plaintiff's performance was a dramatic work which could be fixed in a tangible medium of expression, it fell within the ambit of copyright law. It thus, satisfied the subject matter and equivalency requirements necessary for pre-emption.

6. PUBLICITY RIGHTS VERSUS FUNDAMENTAL RIGHTS:

Although this is an argument which cuts across several jurisdictions, it is perhaps best explained in terms of the fundamental rights found in Part III of the Constitution of India. There is a great deal of overlapping interests while addressing the limits or lack thereof, of celebrity and fundamental rights. One of the most common conflicts is that between the freedom of speech and expression and the right to privacy. The freedom of speech and expression is embodied under Article 19(1)(a) and provides the foundation for most of the work that the media and press rely on. However, there are reasonable limits prescribed, but what is often to be determined is what may be classified as reasonable and unreasonable. Alongside this right to freedom of speech and expression, works the right to information which is an integral part of Article 19, and is cited often as the key to a successful democracy. What needs to be determined is how far one can intrude into another's life, in the name of transparency. In response to this, the right to privacy needs to be considered. The right to privacy has been read into Articles 21 and 19(1)(d), and is an essential right carried by most international instruments. In light of this, publicity rights seem justified in



their operation, in that they protect the unauthorised use of images, voice, or likeness, thereby restricting the kinds of association a celebrity may have. Regardless of whether this may be considered good or bad, the truth remains that the private celebrity interest sought to be protected by a publicity right will always remain subservient to a larger public interest.

Related to this conflict is another one based on the premise of human dignity. It is argued that rights such as publicity rights run a tight rope between arguments which suggest that they protect individual interests, and other arguments which largely support the idea that such rights only further the commercialization of the human personality. For instance, in the United States this translates into cases concerning First Amendment protection, something which was disputed in *CBC Distribution and Mktg. Inc v. Major League Baseball Advanced Media*⁴¹, where the Federal Circuit Court of Appeals rejected publicity rights claims of major league baseball players, stating

that their interests were subordinate to the First Amendment free speech protection.

The right of publicity is often found to be in conflict with the right to freedom of speech and expression. In United States law, this tense situation is expressed in the form of a continuing debate between the right of publicity and the First Amendment Right of freedom and expression.⁴² For years, United States Courts have been attempting to strike a balance between the celebrity's publicity right and the First Amendment right of speech and expression. In *Dustin Hoffman v. Capital Cities/ABC Inc*⁴³ the Court held that commercial aspects were "inextricably entwined" with expressive elements, due to which protection could be opted under the First Amendment. In *Comedy III Productions, Inc v. Gary Saderup Inc*⁴⁴, the Court also laid down the transformative elements test to determine whether an artist's work could be protected under the First Amendment. Under this test, if a work contains significant transformative and is less likely to interfere with the economic interests protected by the right of publicity, then the First Amendment protection would automatically outweigh the state's interest in enforcing the right of publicity.⁴⁵ The transformative elements test attempted to resolve the conflict between First Amendment protection and publicity rights by laying down the standard which would balance both rights. The debate between First Amendment protection and publicity rights reached a



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critical point in 2003, in *ETW Corpn. v. Jireh Publishing Inc*⁴⁶, better known as the Tiger Woods case. Essentially, the case was instrumental in the analysis of several precedents, ultimately upholding the validity of Rush's work, a painting titled, "The Masters of Augusta", featuring Tiger Woods in three poses, which was entitled to First Amendment protection as it was more than a mere literal likeness, and involved artistic elements. Using the balancing test adopted in *Cardtoons LC v. Major League Baseball Players Assn.*⁴⁷, it was concluded that the degree of restriction placed on speech in this case, was greater than Wood's intellectual property right. Therefore, the appearance of Woods' image in an artwork is not detrimental to the commercial value of his image and likeness.

PART III

STATUTORY PROTECTION FOR IMAGE RIGHTS OF THE CELEBRITIES IN INDIA

A. Protection Under Advertising Legislation

Advertisements in India are governed by the Code of Self-Regulation in Advertising, which was adopted by the Advertising Standards Council of India (ASCI) in 1985. The ASCI Code is a voluntary, non-governmental, self-regulatory body. The body is registered as "voluntary organization" under Section 25 of the Companies Act. The Code provides that:


"Advertisements should contain no references to any individual, firm or institution which confers an unjustified advantage on the product advertised or tends to bring the person, firm or institution into ridicule or disrepute. If and when required to do so by the ASCI, the advertiser and the advertising agency shall produce explicit permission from the person, firm or institution to which reference is made in the advertisement."

The ASCI Code is recognised under various Indian laws in addition to being adopted by advertising-industry bodies.

B. Copyright Act, 1957

The Copyright Act, 1967 inadequately recognises publicity or image rights of the celebrities. There is a separate category of performers' rights which grants economic

rights to performers. Sections 38 and Section 39

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provides that where any performer appears to engage in any performance, he shall have the special right to be known as the “performer's rights” in relation to such a performance. These rights are:

- To make a sound recording or visual recording of his performance.
- To reproduce the sound recording or visual recording of his performance.
- To broadcast his performance.
- To communicate the performance to the public otherwise than broadcast.

Section 38(3) provides that during the continuance of a performer's right in relation to his performance, any person who without the consent of the performer, does any of the aforementioned acts in respect of the performance, or any substantial part thereof, shall be deemed to have infringed the performer's right.

However, these rights are subject to exceptions as provided under section 39 of the Copyright Act. The provision states that no performer's right shall be deemed to be infringed by:

1. the making of any sound recording or visual recording for the private use of the person making such a recording, or solely for the purposes of *bona fide* teaching or research; and
2. the use consistent with the dealing of excerpts of a performance or of a broadcast in the reporting of current events or for *bona fide* review, teaching or research, such other acts, with any necessary adaptations and modifications, which do not constitute infringement of copyright under section 52.

CONCLUSION

As may be seen from the discussion in the above section, the current regulatory and legislative framework under the current intellectual property laws in India is insufficient to curb the blatant use of various aspects of commercial persona, image or likeness of a famous individual. On the one hand, there is a need to either broaden the existing intellectual property legal regime or an exclusive statutory framework which may be adopted to recognise and enforce publicity rights of celebrities.

However, since celebrities are public figures and their activities evoke everyone's interest, conferring on them special rights may have the effect of putting them on a higher pedestal, and this may, in turn, be a dangerous proposition. These concerns surely need to be addressed before any statutory framework is enabled to protect their rights.

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¹ William W Fischer III, ‘The Growth of Intellectual Property: A History of the Ownership of Ideas in the United States’ in D Vaver (ed), *Intellectual Property Rights: Critical Concepts in Law* (Taylor and Francis 2006) 72.

² *Haelan Laboratories Inc v. Topps Chewing Gum Inc*, 202 F 2d 866, 868 (2d Cir 1953).

³ *Douglas v. Hello! Ltd.*, 2006 QB 125 : (2005) 3 WLR 881 : 2005 EWCA Civ 595.

⁴ Russell J Frackman and Tammy C Bloomfield, ‘The Right of Publicity: Going to the Dogs?’ (1996) The UCLA Online Institute for Cyberspace Law and Policy <www.gseis.ucla.edu/iclp/rftb.html> accessed 1 October 2008.

⁵ Jacy T Jasmer, ‘*ETW Corp v. Jireh Publishing, Inc: A Workable Standard, an Unworkable Decision*’, (2004) (5)

MIPR 296 <mipr.umn.edu/archive/v5n2/Jasmer.pdf> accessed 10 October 2008.

⁶ *ibid* 298.

⁷ Jan Klink, '50 Years of Publicity Rights in the United States and the never-ending Hassle with Intellectual Property and Personality Rights in Europe (2003) <www.ab-patent.com/downloads/publicity_rights.pdf> accessed 1 October 2008.

⁸ Haelan Laboratories Inc (n 2733).

⁹ Franckman (n 2755).

¹⁰ *Zacchini v. Scripps Howard Broadcasting Co.*, 53 L Ed 2d 965 : 433 US 5624 (1977).

¹¹ *Zacchini* (n 281) 576.

¹² *Allen v. National Video Inc*, 610 F Supp 612, 630 (SDNY 1985).

¹³ *Carson v. Here's Johnny Portable Toilets Inc*, 698 F 2d 831 (6th Cir 1983).

¹⁴ *McFarland v. Miller*, 14 F 3d 912 (3rd Cir 1994).

¹⁵ 978 F 2d 1093 (9th Cir 1992).

¹⁶ 498 F 2d 821 (9th Cir 1974).

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¹⁸ *Walter v. NBC Television Network Inc*, 27 AD 3d 1069 (2006).

¹⁹ *ibid* 6.

²⁰ *Parks v. Laface Records*, 329 F 3d 437 (6th Cir 2003).

²¹ 332 F 3d 915 (6th Cir 2003).

²² Heather Briston, 'The Right of Privacy and the Right of Publicity: It's not just about tabloids and fame' (2004) in Choices and Challenges: Hot Topics Facing Curators and Archivists <scholarsbank.uoregon.edu/dspace/bitstream/1794/2444/2/HFM_paper_v2.pdf> accessed 1 October 2008.

²³ O Yale Lewis Jr (n 288) 5.

²⁴ Sara L Edelman, 'Death Pays: The Fight Over Marilyn Monroe's Publicity Rights' (2007) The Metropolitan Corporate Counsel <www.metrocorpocounsel.com/current.php?artType=view&artMonth=August&artYear=2008&EntryNo=6903> accessed 1 October 2008.

²⁵ *Shaw Family Archives Ltd. v. CMG Worldwide Inc* No. 05 Civ 3939 (CM), 2007 US Dist LEXIS 35674 (SDNY 2-5-2007) and *The Milton H Greene Archives Inc v. CMG Worldwide Inc* 05-CV-2200 (MMM).

²⁶ European Convention on Human Rights, art 8.

²⁷ *Zacchini* (n 281); *Klink* (n 27).

²⁸ *Reddaway v. Banham*, 1896 AC 199 : (1896) 13 RPC 218, 224.

²⁹ *Reckitt & Colman (Products) Ltd. v. Borden Inc*, (1990) 1 WLR 491 (1990) 1 All ER 873 : 1990 RPC 340, 499 (HL).

³⁰ (1994) 6 SCC 632 : AIR 1995 SC 264.

³¹ Case No. 1147 of 2001, dated 10-10-2001 (Del).

³² 2011 SCC OnLine Del 2660 : (2011) 181 DLT 716.

³³ 2003 SCC OnLine Del 2 : (2003) 26 PTC 245 Del.

³⁴ 2012 SCC OnLine Del 2382.

³⁵ *Sonu Nigam v. Amrik Singh*, Civil Suit No. 372 of 2013, decided on 26-4-2014 (Bom).

³⁶ Stacey L Doğan and Mark A Lemley, 'What the Right of Publicity Can Learn from Trademark Law' (2006) 58

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³⁷ *Hanover Star Milling Co. v. Metcalf*, 60 L Ed 713 : 240 US 403, 413-14 (1916).

³⁸ 555 F Supp 1188, 1194 (SDNY 1983).

³⁹ O Yale Lewis Jr (n 29).

⁴⁰ 430 F Supp 2d 749 (WD Tenn 2006).

⁴¹ 505 F 3d 818 (8th Cir 2007).

⁴² The Amendment reads as: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances."

⁴³ 255 F 3d 1180 (9th Cir 2001).

⁴⁴ 21 P 3d 797 (Cal 2001).

⁴⁵ *ibid* 808.

⁴⁶ 332 F 3d 915 (6th Cir 2003).

⁴⁷ 95 F 3d 959 (10th Cir 1996).

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