IMAGE RIGHTS OF FAMOUS PERSONS VIS-À-VIS RIGHT TO PRIVACY: AN ANALYSIS UNDER THE INTELLECTUAL PROPERTY LAWS IN INDIA AND OTHER COUNTRIES

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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 origins in other common law jurisdictions and arose in response to the presence and influence of the cinema industry. Primarily derived from the right of privacy, publicity rights in India have arisen mainly out of judicial precedents related to unauthorized usage of the various aspects of the celebrity persona, whose appearance or likeness have been unduly exploited for commercial gain 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.

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With the ever increasing recognition afforded to publicity rights in courts across jurisdictions, the author aims to focus on answering some of the above mentioned questions with the hope that they will culminate in a response to address the question of whether we need a separate rights regime for publicity rights or whether the existing legal infrastructure proves sufficient. The author concludes that Indian approach to publicity rights is constitutional rather than commercial, and, similar to more developed jurisdictions such as U.S., a dual approach needs to be adopted for better enforcement of publicity rights. There is therefore, an urgent need to recognize persona as a commercial rather than right of human dignity.

1. INTRODUCTION

With the growth of digital media, the study of publicity rights assumes an increasing role of importance and finds itself at the centre of several contracts and negotiations in the entertainment industry.[1] Publicity rights very simply, are those which protect the interests of celebrities in their images and identities.[2] Also referred to as privacy rights in some jurisdictions, the development of the jurisprudence of publicity rights has been surrounded by a great deal of scepticism, often giving rise to debates of whether such a right is truly representative of the need to protect a person's privacy rights or merely an exaggeration of an otherwise frivolous interest. Some scholars advocate that the treatment of the human likeness as

[1] S. Barnett, *The Right to One's Own Image, Publicity and Privacy Rights in the United States and Spain*, 47 AM. J. COMP. L. 556 (1999).
[2] W.W. Fischer III, *A History of the Ownership of Ideas in the United States, in* INTELLECTUAL PROP. RIGHTS: CRITICAL CONCEPTS IN LAW.

a source of monetary gain is an unnecessary and excessive commercialization of the human body and thus, resulting in speculation as to whether such a right must exist and be encouraged.[3] 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 on her behalf.

2. DEFINING A PUBLICITY RIGHT

A publicity right refers to the right, which protects an individual's interest in an image, a voice or likeness.[4] This right enables a celebrity to object to the commercial, or use of his or her image or likeness uses without his consent, such that the user may derive commercial benefit or profit by using a celebrity's image. Conversely, it allows a celebrity to gain profits for the consensual use of his or her likeness. Right of publicity may be distinguished from a right of privacy because if man has a right in the publicity value of his photograph, then he has a right to grant exclusive privilege of publishing his picture.[5]

Brook, L.J., 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".[6] This

[3] Dogan & Lemley, *What Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1162 (2006).
[4] M. McKenna, *The Right of Publicity and Autonomous Self - Definition*, 67 U. PITT. L. REV. 346 (2006).
[5] Halean Lab. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).
[6] Douglas & Zeta Zones v. Hello Ltd., [2005] EWCA (Civ) 595.

definition helps to distinguish the notion of the publicity right from related moral and privacy rights, as it emphasizes on the commercial value of any celebrity's image. In the same case, it was observed by Sedley, L.J., that any adversity to the reputation of an individual does not amount to financial or economic loss, and thus the publicity right is one which concerns intangible harm. This hints at the 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."

In sum, publicity rights or personality rights, is the right of any celebrity or an individual to navigate the commercial use of his or her own persona or identity for selling any advertisers' products.[7] Impliedly, it gives an individual the exclusive right to license the use of their identity for commercial promotion.

[7] *Right of Publicity: An Overview*, CORNELL UNIV. LAW SCH., https://www.law.cornell.edu/wex/publicity (last visited Aug. 5, 2015).

3. THE HISTORICAL DEVELOPMENT OF THE RIGHT OF PUBLICITY

The origin of the publicity right lies in the understanding of the right to privacy.[8] The notion that a celebrity was entitled to financial benefit on the use of his or her image was only a consequence of acknowledging the fact that the celebrity had a right to be left alone. In other words, it was only after the courts[9] made it clear that being a celebrity and public figure did not justify the full disclosure of everything that occurred in their personal lives, that it was also 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 the introduction of publicity rights, namely an economic and a moral justification. The economic justification for the right serves to afford protection because a celebrity is able to derive commercial benefit out of use of his or her image. The moral rights justification adopts the view that since the celebrity is the one who contributes towards the creation of the identity; he or she alone stands to gain from the benefits accruing to the identity. The justifications have a firm basis in the prevention of unjust enrichment.

One of the most common forms of the exploitation of popularity is celebrity advertising, which is often the only way in which one can

[8] R.J. Frackman & T.C. Bloomfield, *The Right of Publicity: Going to the Dogs?*, UNIV. OF CAL. AT L.A. ONLINE INST. FOR CYBERSPACE LAW AND POLICY, http://www.gseis.ucla.edu/iclp/rftb.html (last visited Oct. 1, 2014).

[9] White v. Samsung Elec. Am., 971 F.2d 1395 (9th Cir. 1992); *see also* Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983).

distinguish between several similarly priced products of the same quality.[10] In addition advertising and marketing, the position of a celebrity adds substantial market value to the product.[11] It is the effort to curb 'free-riding' and appropriation of another's popularity, which lends purpose to the creation or rather recognition of the publicity right.

One of the initial cases to recognize the right to publicity was *Halean Laboratories, Inc. v. Topps Chewing Gum, Inc.*12This case is known to have devised the traditional right of the publicity doctrine, while recognizing the property right in a baseball player's photograph that was used on trading cards. The Court held that right to publicity exists independently to the right of privacy, which is vested in the publicity value of his photograph.

Subsequent commentaries however modified our understanding of the publicity right so as to allow it to be independent of the right to privacy. For instance, Professor Melville B. Nimmer[13] stated that, while plaintiffs in privacy cases were concerned about the invasion of their privacy, the publicity plaintiffs prayed for compensation for exploitation of their commercial identities. In 1977, the U.S. Supreme Court recognized a

[10] A.D. Hogue, *Image Consulting*, INTELLECTUAL PROP. SUPPLEMENT TO NAT'L L.J. 67 (1998).
[11] J. Klink, *50 Years of Publicity Rights in the United States and the Never-Ending Hassle with Intellectual Property. and Personality Rights in Europe*, RUGER ABEL PATENT & LAWYERS, http://www.ab-patent.com/downloads/publicity_rights.pdf (last visited Oct. 1, 2014).
[12] *Halean Lab.*, 202 F.2d 866, 868 (2d Cir. 1953).
[13] M.B. Nimmer, *The Right of Publicity*, J. L. & CONTEMPORARY PROBLEMS 19 (1954).

common law right of publicity.[14] The action was said to lie if the claimant could demonstrate the fact that he:

- Owns a publicity right concerning his own or licensed personality features
- That the defendant without permission used these features in a way that the celebrity is identifiable and
- That this use is likely to cause damages 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.

In one celebrated case, Woody Allen was granted his request for an injunction to prevent the use of a look-alike in a commercial, thereby protecting his likeness.[15] In another case, the utilization 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.[16] An actor could prevent an eating joint from using the name of the performed film character Spanky McFarland, and prevent the use of the pictures of other actors.[17] The problem regarding the use of sound-alike voices was addressed in several cases. In *Waits v. Frito-Lay,*18to Tom Waits whose voice was adopted by a voice alike for

[14] Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 564 (1977).
[15] Allen v. Nat'l Video, Inc., 610 F. Supp. 612, 630 (S.D.N.Y. 1985).
[16] *Carson*, 698 F.2d 831 (6th Cir. 1983).
[17] McFarland v. Miller, 14 F.3d 912 (3d Cir. 1994).
[18] Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992); *see also* Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988).

advertisements. In *Motschenbacher v. R.J. Reynolds Tobacco Co.*,[19] modified footage of a famous race car driver's car in a television commercial without authorization 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. The publicity right is growing however, in order to combat the ever increasing ways in which one may benefit from another's fame 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. The publicity right is growing however, in order to combat the ever increasing ways in which one may benefit from another's fame.

4. STUDY OF PUBLICITY RIGHTS FROM OTHER JURISDICTIONS

4.1. 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[20] to privacy in 1903 following a case,[21] where the plaintiff claimed that her likeness had been used to create an image on flour bags. The Court rejected her claim; however this gave rise to the need for a right to privacy, violations 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

[19] Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974).
[20] N.Y. CIV. RIGHTS LAW § 50-51.
[21] Roberson v. Rochester Folding Box Co., 64 N.E. 442 (N.Y. 1902).

of celebrities.[22] The need was felt to recognize a right which was meant to protect the pecuniary interest of the celebrity, and possibly the intellectual property produced by them.

The strongest publicity rights in the U.S. exist in California,[23] the home of a powerful celebrity market. The statutory protection afforded is almost custom made to suit the needs of professionals and celebrities in California.[24] On federal level, the Lanham (Trademark) Act,[25] which affords protection in cases involving passing off, is one of the most sought after routes to ensure celebrity protection.

4.1.1. Latest Developments in Publicity Rights in U.S.

In a recent lawsuit filed before the California Superior Court, right of publicity has been taken beyond college athletes and Hollywood celebrities.[26] In this lawsuit, former Central American despot Manuel Noriega has sued Blizzard/Activision over their portrayal of Noriega in its highly successful game "Call of Duty: Black Ops II". One of the characters in the game bore Noriega's likeness, and in view of the above, he had sued Activision under California's right of publicity statute for "portraying him as an antagonist and creating a false impression by using his name and likeness". The case is *sub judice*.

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[22] David T., *Beyond the Trademark Law: What the Right of Publicity Can Learn From Cultural Studies*, 25 CARDOZO ARTS & ENT. L.J., no. 3, 2008, at 913.
[23] CAL. CIV. CODE § 3344.
[24] CAL. CIV. CODE § 3344(a) & (e).
[25] Lanham (Trademark) Act, 15 U.S.C. § 1125.
[26] S. Sholder, *Video Game Cases May Break New Right of Publicity Ground*, LAW360.COM, http://www.law360.com/articles/562163/video-game-cases-may-break-new-right-of-publicity-ground (last visited Aug. 5, 2015).

The latest trends in publicity rights judgments includes right of personality for college athletes.[27] The Court of Appeals applied the transformative use test[28] to determine Hart's right of publicity. The Court considered two parameters: appearance of the celebrity's avatar in the video game and the context of the use of the avatar, and whether the user of the game has the ability to alter the avatar's appearance. Holding that the NCAA Football had sufficiently transformed Hart's identity, the Court accepted his claim for right of publicity.

In a case dealing with post-mortem celebrity rights of Albert Einstein,[29] the Court found that Albert Einstein's post mortem rights had expired under New Jersey common law. The Court also became the first to accept limit on the common law post-mortem right of publicity and concluded that it could no longer be more than 50 years.

In a 2014 judgment,[30] the Seventh Circuit ruled in favour of basketball legend Michael Jordan against supermarket chain Jewel Food Stores, Inc., by making a distinction between commercial and non-commercial speech, the Court held that the advertisement featuring Michael Jordon in a special edition of Sports Illustrated was non-commercial speech, therefore protected by First Amendment, guaranteeing freedom of speech and expression.

4.1.2. Defences and Duration

[27] Hart v. Elec. Arts, Inc., 717 F.3d 141 (3d Cir. 2013).
[28] Comedy III Prod., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 804-08 (Cal. 2001).
[29] Hebrew Univ. of Jerusalem v. Gen. Motors, 903 F.Supp.2d 932 (2012).
[30] Jordan v. Jewel Food Stores, No. 12-1992 (7th Cir. 2014).

The right of publicity, which permits a person to prohibit others from using her name or likeness on goods or products, without the person's prior consent, 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 defences to the right. Firstly, consent, preferably written, is a valid defence, although there have been instances such as Washington's statutory law acceptance of "oral" or "implied" consent as adequate.[31] Material published with the consent of the celebrity, cannot be said to infringe the celebrity's right of publicity. Another popular defence cited is that of news-worthiness. 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.[32]

A very important defence concerns the protection offered under the ambit of the freedom accorded to speech and expression. This has already been dealt with in detail previously in connection with the famed *Tiger Woods'* case. In U.S. especially, a great deal of literature has been generated on the discussion of First amendment defences which primarily focus on speech and expression. The role of the Courts when determining the applicability of such a defence essentially involves conducting a fact-specific balancing test which aims to compare conflicting interests of the person's right of publicity with the public's right to have access to

[31] O.Y. Lewis, *Publicity Rights*, HENDRICKS & LEWIS P.L.L.C., http://www.hllaw.com/images/78222PublicityRights.pdf (last visited Oct. 1, 2014).
[32] Walter v. NBC Television Network, Inc., 27 A.D.3d 1069 (2006).

information. As already mentioned, the transformative elements test is of crucial importance here, as is determining the cardinal message of the work in consideration. 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 endeavour and thereby will be entitled to little or no First amendment protection.[33] Similarly, if the primary purpose of the reference is art, parody or political speech, then the Courts are more likely to support First amendment protection as was witnessed in *E.T.W. Corp. v. Jireh Publishing, Inc.*[34]

Death is not necessarily a practical defence 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. In the U.S., Tennessee, Indiana and Oklahoma are states which recognize the longest potential post-mortem publicity rights[35] 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 the duration of the right is practically unending in some jurisdictions. Washington law provides a post mortem right for ten years for individuals and 75 years for those whose personality rights continue to have some commercial value.

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[33] Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003).
[34] ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003).
[35] H. Briston, *The Right of Privacy and the Right of Publicity: It's Not Just About Tabloids and Fame*, UNIV. OF OR. PUBL'N, https://scholarsbank.uoregon.edu/dspace/bitstream/1794/2444/2/HFM_paper_v2.pdf (last visited Oct. 1, 2014).

Marilyn Monroe is synonymous with the words "blonde" and "bombshell". Easily 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 C.M.G. Worldwide Inc. the Monroe estate has been able to rake in nearly $30 million after licensing the actresses' name and image.[36] This enormous income flow however, faced an insurmountable blockade created by two decisions in May, 2007,[37] which held that Monroe's publicity rights died with her. As a result, the Monroe estate was no longer to be held the rightful owner of Marilyn's voice, likeness or image, thereby preventing them from licensing through CMG or any other agency.

4.2. PUBLICITY RIGHTS IN U.K.

English law has always resisted the creation of a publicity right, and has instead emphasized freedom of speech and expression.[38] The gradual development of the right of publicity is partly due to the country's

[36] S.L. Edelman, *Death Pays: The Fight Over Marilyn Monroe's Publicity Rights*, METRO. CORPORATE COUNSEL, http://www.metrocorpcounsel.com/current.php?artType=view&artMonth=August&artYear=2008&EntryNo=6903 (last visited Oct. 1, 2014).

[37] Shaw Family Archives Ltd. v. CMG Worldwide, Inc., 486 F.Supp.2d 309 (S.D.N.Y. 2007).

[38] *Celebrity Rights*, LEGALSERVICEINDIA.COM, http://www.legalserviceindia.com/article/1139-Celebrity-Rights.html (last visited Oct. 1, 2014).

commitment to international treaties such as the European Convention on Human Rights or the E.C.H.R. In a plethora of cases, Courts have held that taking pictures of individuals without their consent violates Article 8 of the E.C.H.R., regardless of the purpose for which the photographs are meant. There have also 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 printing of her photo in a story about her drug rehabilitation.

4.3. PUBLICITY RIGHTS IN GERMANY

In Germany, there are many similarities in the treatment of publicity rights to U.K.[39] It is here that it is necessary to highlight the fact that both U.K. 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.[40] Every passing off action has at its core, ingredients of goodwill, misrepresentation and damages.

The difference between the U.K. 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'

[39] *Publicity Rights*, RUGER ABEL PATENT & LAWYERS, http://www.ab-patent.com/downloads/publicity_rights.pdf (last visited Oct. 1, 2014).
[40] Reddaway v. Banham, 13 (1896) R.P.C. 218, 224.

interests in terms of protecting the rights to one's name, picture and personality.

5. DEVELOPMENT OF PUBLICITY RIGHTS IN INDIA

The jurisprudence of publicity or personality rights is at nascent stages in India. While no legislation recognizing *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 to publicity stems from right of privacy, as evidenced from *R. Rajagopal v. State of Tamil Nadu*.[41] The Court held that one of the inherent aspects of the right of privacy as enshrined under Article 21 of the Constitution is the right to prevent others from using any individual's name or likeness from being used without his permission for publicity or non-advertising purposes. This also includes the right to prevent others from publishing the life story of a person, whether written in laudatory manner or critical commentary.

However, if a matter dealing with an individual, his family, or education is any information that is public, the right of privacy extends and becomes open for comment by mass media and public inspection.

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*,[42] Daler Mehndi, a famous Indian singer, composer and performer, brought an action

[41] Rajagopal v. State of Tamil Nadu, A.I.R. 1995 S.C. 264.
[42] DM Entm't v. Jhaveri (1147/2001).

against a party that had registered the domain name 'dalermehndi.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 trademark significance. Similarly, in the case of *Arun Jaitley v. Network Solutions Pvt. Ltd.*,[43] the plaintiff, Mr Arun Jaitley, a prominent political leader of the Bharatiya Janata Party, had filed for a permanent injunction to restrain the defendants from misusing and the immediate transfer of the domain name "www. arunjaitley.com". The plaintiff wished to register the domain, www.arunjaitley.com, through the website of the defendants.

The Delhi High Court granted publicity rights to politician Arun Jaitley in the domain name "arunjaitely.com". According to the Court, any person may be restrained to use popular or well-known personal names, when, firstly it is satisfied that the particular personal name is a well-known trademark as envisaged under the basic principles of trademark law, and secondly, the person is entitled to use his personal name for commercial purposes.

The scope and applicability of the right of publicity was defined *in I.C.C. Development v. Arvee Enterprises*,[44] wherein the Delhi High Court laid down that right of publicity does not apply to non-living entities or objects such as an event, or a sport which made the individual popular. Neither the company that organized the event is protected under the copyright, trademark law, dilution and unfair competition since, they are non-living entities.

[43] Jaitley v. Network Solutions Pvt. Ltd., 181 (2011) D.L.T. 716.
[44] I.C.C. Dev. v. Arvee Enter., 2003 (26) P.T.C. 245 (Del.).

In another interesting case brought before the Delhi High Court, *Titan Industries v. Ramkumar Jewellers*,[45] which involved superstars, Amitabh Bachchan and Jaya Bachchan, who had been hired by Titan Industries for promoting Titan's Diwali season jewellery collection, under Titan's brand name of 'Tanishq'. The defendants, Ramkumar Jewellers, allegedly copied the images of the two superstars for their own hoardings, which were put up all over Muzzaffarpur in Uttar Pradesh, to the extent that it became ostensible to the members of the public that Amitabh 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. Therefore, this right to control the commercial use of the identity of any 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:

1. The plaintiff has a valid and enforceable right in the identity or persona of himself.
2. The person may be easily recognized in public. For this purpose, plaintiff's identifying features may itself be sufficient to create a strong inference of identifiability.
3. Direct or circumstantial evidence of the defendant's intent to trade upon the identity of the plaintiff, from which identifiability can be presumed.

[45] Titan Indus. v. Ramkumar Jewelers, 2012 S.C.C. OnLine Del. 2382.

In *Sonu Nigam v. Mika Singh*,[46] 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 Nigam.

The Bombay High Court granted an order to restrain Mika Singh and OCP Music from directly or indirectly publishing the advertisement as it violated Sonu Nigam's personality, publicity and image rights and use of the plaintiff's image in any manner whatsoever.

In another case before the Calcutta High Court, *Sourav Ganguly v. Tata Tea Ltd.*, Sourav Ganguly, a popular cricketer and former captain of the national team, filed a suit against a well-known brand of tea was cashing in on his success by offering consumers a chance to meet and congratulate the cricketer. Ganguly successfully challenged the case in court before settling the dispute amicably, through an out of court settlement.

In sum, the courts in India have recognized the right of publicity, or personality rights as stemming from the right of privacy. Similar to the approach adopted by the American courts, Indian courts, as seen from the above mentioned cases, recognize the right of person to control the use of his name, likeness, for selling, promotion or any commercial use for a profitable purpose, without a person's consent.

[46] Nigam v. Amrik Singh, LAWS (BOM)-2014-4-191.

5.1. SOME UNANSWERED QUESTIONS

A perusal of these cases also reveals that courts also look at the reputation of the person in a claim for right of personality. For instance, both Amitabh Bachchan and Jaya Bachchan in the *Titan* case, are well-known celebrities, with brand value that stretches across the globe. So, it may be concluded that the courts may look at the worldwide reputation of a celebrity. Impliedly, the question left unanswered is, will the court accord the same protection to a lesser-known, i.e. less-widely known celebrity, who may not enjoy the same world-wide fame, like that of say, Mr Bachchan? Is nationwide or localized fame sufficient for a successful claim of right of publicity, or the bench mark is only worldwide fame? In other words, how "famous" or "well-known" does a celebrity or any person, for that matter, need to be so as have "right of publicity"?

6. RELATIONSHIP BETWEEN PUBLICITY RIGHTS AND OTHER I.P. RIGHTS

6.1. TRADEMARKS, PASSING OFF, AND PUBLICITY:

The right to publicity and the law of trademarks has 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.[47] Trademark legislations attempt to curb such use of trademarks which might result in confusion or ambiguity as regards the affiliation or source of the

[47] G. Thomas, *Celebrity-focused Culture Highlights Need for Statutory Right to Publicity*, WORLD TRADEMARK REV., http://www.worldtrademarkreview.com/issues/article.ashx?g=1596958f-55a7-4b2b-a93c-66f887027801 (last visited Jan. 8, 2015).

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 serve a dual purpose of protection; they not only ensure the protection of celebrity interests, but also contribute to creating awareness among the general public. In other words, both rights are responsible for eliminating 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 the public is to be treated as unacceptable. The notion of understanding publicity rights in the context of trademark law has several advantages.[48]

Much like publicity rights, trademark rights are rights appurtenant, rather than self-supporting intellectual property rights.[49] For a trademark claim to succeed, there must be 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 defence 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.

Thus, there are many noteworthy similarities between the right of publicity and trademark law. Like trademark law, the right of publicity stems from unfair competition, as reflected in the Lanham Act. Similar to

[48] R.S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165 (1948).
[49] Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 413-14 (1916).

trademark, the right of publicity can function as an expression of quality to consumer, especially if a celebrity, or his estate, maintains self-imposed quality standards and exercises discretion in the licensing publicity rights.[50]

Given the occasional parallels, overlap is inevitable. In *Motown Record Corp. v. Hormel & Co.,*[51] trademark laws were used to protect the 'persona' of the legendary music group.

6.1.1. Latest Cases on Right of Publicity and Trademark Rights

In the case of *Brown v. Electronic Arts, Inc.,*[52] it was held by the Court that "well-known football player Jim Brown cannot make a false endorsement claim for using his likeness in Madden NFL football video games". The Court further held that "Electronic Arts' use of NFL great Jim Brown's likeness in Madden NFL franchise was not explicitly misleading about Brown's endorsement or affiliation with the game, and thus, Brown's Lanham Act could not surmount the First Amendment's protections of freedom of expression".

6.2. COPYRIGHT LAW AND PUBLICITY RIGHTS

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

[50] *Right of Publicity: Brief History*, RIGHTOFPUBLICITY.COM, http://rightofpublicity.com/brief-history-of-rop (last visited Aug. 5, 2015).
[51] Motown Record Corp. v. Hormel & Co., 657 F.Supp. 1236 (C.D. Cal. 1987).
[52] Brown v. Elec. Arts, Inc., No. 09-56675, 2013 U.S. App. LEXIS 15647 (9th Cir. Jul. 31, 2013).

under state law have stood up to the challenge. When the U.S. 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) provides for a two-pronged test wherein pre-emption is to be allowed if:

- 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.

In *Stanford v. Caesars Entertainment, Inc.*,[53] 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. 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.

Nevertheless, the right of publicity does not have much of a relationship with copyright law. Copyright law applies to original works of authorship fixed in a tangible medium of expression.[54] The exclusive rights are held in the copyright owner and apply to the work itself. This can complicate things because right of publicity and copyright considerations can be implicated in a single usage. An advertisement featuring a celebrity's

[53] Stanford v. Caesars Entm't, Inc., 430 F.Supp.2d 749 (W.D. Tenn. 2006).
[54] Copyright Act, 17 U.S.C. § 102(a); *see also* Copyright Act, 1957, No. 14, Acts of Parliament, 1957 (India).

picture may require authorization from the photographer for the copyright use, and from the celebrity for the Right of Publicity use.

In *Sim v. Heinz & Co. Ltd.*,[55] the Court said that "copyright is neither granted to voice, likeness or other identifiers of persona". "To pursue an action for copyright infringement, an individual must be able to show ownership of a copyright in the image and copying of the image". In the context of celebrity photographs, "lack of ownership is one of the biggest issues which a celebrity encounters, if a photograph gets exploited"[56]. "Copyright gives exclusive, but limited rights of protection and allows celebrities to authorize reproduction, creation of a derivative image, sale or sale of commissioned photograph."[57]

7. PUBLICITY RIGHTS VERSUS FUNDAMENTAL RIGHTS

Publicity rights run a tight rope between protection of individual interests of the celebrities and public interest. For instance, in the US, this translates into cases concerning First amendment protection of freedom of speech and expression as was disputed in *C.B.C Distribution and Marketing, Inc. v. Major League Baseball Advanced Media L.P*,[58]where the federal circuit court of appeals rejected publicity rights claims of major

[55] Sim v. H.J. Heinz & Co. Ltd. [1959] 1 W.L.R. 313 (Eng.).
[56] T. Ahmed & S.R. Swain, *Celebrity Rights Protection under IP Laws,* 16 J. INTELLECTUAL PROP. RIGHTS 10 (2010).
[57] Prather M., *Celebrity Copyright Law,* EHOW.COM, http://www.ehow.com/about_6461739_celebrity-copyright-law.html (last visited Aug. 5, 2015).
[58] CBC Distrib. & Mktg. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007).

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 at conflict with the right to freedom of speech and expression. In U.S. 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. For years, U.S. courts have been attempting to strike a balance between the celebrity's publicity right and the First Amendment rights of speech and expression. In the case of *Hoffman v. Capital Cities/ABC, Inc.*,[59]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*.,[60] the First Amendment protection would automatically outweigh the state's interest in enforcing the right of publicity. 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 under 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 critical point in 2003, in the case of *ETW Corporation v. Jireh Publishing, Inc*.,[61] *Tiger Woods* case. Essentially, the case was instrumental in the analysis of several precedents. The Court determined that Rush's work, a painting titled, "The Masters of Augusta", featuring

[59] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001).
[60] *Comedy III Prod.*, 21 P.3d 797 (Cal. 2001).
[61] *ETW Corp.*, 332 F.3d 915 (6th Cir. 2003).

Tiger Woods in three poses, was entitled to First Amendment protection as it was more than a mere literal likeness, and involved artistic elements. The balancing test adopted in *Cardtoons L.C. v. Major League Baseball Players Association*,[62] his case, was greater than Woods' intellectual property right. Therefore, the appearance of Woods' image in an artwork is not detrimental to the commercial value of his image and likeness. Therefore, the appearance of Woods' image in an artwork is not detrimental to the commercial value of his image and likeness.

7.1. LATEST CASES OF INTERFACE OF RIGHT OF PUBLICITY AND FREEDOM OF EXPRESSION

In the case of *Ryan Hart v. Electronic Arts*,[63] Ryan Hart filed a lawsuit against Electronic Arts (E.A.) for the violation of his right of publicity. He alleged that "E.A. misappropriated his likeness in an NCAA Football video game in order to enhance the commercial value of the game". The district court granted summary judgment in favour of EA the U.S. Court of Appeals for the Third Circuit mentioned that "this case would be determined based upon 'balance of interest test' between right to freedom of speech and expression against the interests in protecting the right of publicity".[64] The Court ruled in favour of EA and held that "freedom of speech and expression under First Amendment of the Constitution weighed in favour of EA".

[62] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996).
[63] *Hart*, 717 F.3d 141 (3d Cir. 2013).
[64] *See Zacchini*, 433 U.S. 562, 574-75 (1977).

In the case of *Edgar Winter v. DC Comics*,[65] the Supreme Court ruled that comic book characters Johnny and Edgar Autumn, modelled on real-life brothers Johnny and Edgar Winter are protected by the First Amendment.

8. STATUTORY PROTECTION OF THE IMAGE RIGHTS OF CELEBRITIES IN INDIA

8.1. COPYRIGHT ACT, 1957

The Copyright Act protects the interests of famous persons by extending moral rights. The important cases dealing with this issue are *Manu Bhandari v. Kala Vikas Pictures Pvt. Ltd.*[66] and *Amar Nath Sehgal v. Union of India*[67].

Sometimes, the lives of famous celebrities have also formed the scripts of many films. In the case of *Phoolan Devi*,[68] former lady dacoit Phoolan Devi had protested against her portrayal in the film "Bandit Queen". The court held that a celebrity could protect his/her life and image as a "constitutional right". Similarly, in the case of *Bala Krishnan*,[69] the dispute was over the life history of Mr Kamaraj, a national leader. Historical facts are not actionable *per se*, and thus, the producers claimed that no one could hold copyright over the life history of a national leader and the information was already available in public. The court did not restrain the

[65] Winter v. DC Comics, 69 P.3d 473, 479 (Cal. 2003).
[66] Bhandari v. Kala Vikas Pictures Pvt. Ltd., A.I.R. 1987 Del. 13.
[67] Sehgal v. Union of India, 2005 (30) P.T.C. 253 (Del.).
[68] Phoolan Devi v. Kapoor, 57 (1995) D.L.T. 154.
[69] Bala Krishnan v. Kamaraj, (2000) (3) Ar. L.R. 622.

release of the film as it held that the reputation of the national leader was not at stake.

Thus, in India, publicity rights arise from privacy rights and flow from human dignity as enshrined under Article 19 and 21 of the Constitution, as contrasted with treatment of publicity rights as commercial property.

8.2. PERFORMERS' RIGHTS

Performers' rights grant economic rights to the performers. Section 38 of the Copyright Act provides that "where any performer appears to engage in any performance, he shall have a special right to be known as the "performer's right" in relation to such a performance."

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. Section 39 provides 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;*
>
> *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 adaptions and modifications, which do not constitute infringement of copyright under Section 52.

8.3. TRADEMARK RIGHTS

Section 14 of the Trademarks Act, 1999 prohibits the use of personal names where an application is made for the registration of a trademark, which falsely suggests connection with a living person, or a person whose death took place within 20 years prior to the date of application. Besides, certain names like Sri Sai Baba, Lord Buddha, Sri Ramakrishna, Sri Sharada Devi, the Sikh Gurus, and Lord Venkateshwara cannot be registered under Section 159(2) of the Trademarks Act, 1999. Thus, the Act provides for a basic framework for celebrities to protect their name and Image in India and this right can be claimed by their legal heirs, when the reputation and image of the deceased is at stake.[70]

9. CONCLUSION

In sum, the ability control commercialization and providing revenue streams for the rightful recipient is the policy objective of the Right of Publicity. The right does not simply ensure that a celebrity or celebrity estate gets paid, but the right to control how celebrity is commercialized, or if she or he will be used at all.[71] As may be seen from the discussion above, jurisprudence of publicity rights is more developed in U.S.A. than India.

[70] Kumari T.V., *Celebrity Rights as a Form of Merchandise Protection Under the Intellectual Property Regime*, 9 JOURNAL OF INTELLECTUAL PROP. RIGHTS, no. 2, 2004, at 134.

[71] Jonathan Faber, *Indiana: A Celebrity-Friendly Jurisdiction*, 43 RES GESTAE, no. 9, 2000.

However, even U.S. till date lacks a federal Right of Publicity Statute, and most statutes dealing with this right are state-based.

The current regulatory and legislative framework under the current intellectual property laws in India is insufficient to deal to curbing blatant use of various aspects of commercial persona, image or likeness of a famous individual. After the Delhi High Court upheld the publicity rights as an individual right, it is now up to the legislature to the commercial and ownership aspects of the publicity rights. On the one hand, there is a need to either broaden the existing intellectual property legal regime, or an exclusive statutory framework may be adopted to recognize 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. The legislature should adequately balance the public interest and the individual interest of the celebrity. This may be done by creating an exception for freedom of speech and expression and other bona fide uses, similar to U.S.