

PUBLICITY RIGHTS OF CELEBRITIES: AN ANALYSIS UNDER THE INTELLECTUAL PROPERTY REGIME

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ABSTRACT

Publicity rights of a celebrity can be understood as rights to control the commercial value of their persona. A more sophisticated form of rights, the most contentious argument against their recognition is the restriction of their applicability to celebrities. Originally developed as an off shoot of right to privacy, publicity rights have emerged as a sui generis regime owing to the increasing number of instances of their trespass. India is far behind the US and the UK in recognising this right. With a few and far provisions under the Trade marks Act 1990, the legislation pertaining to the area is hugely insufficient. With the increasing number of instances of misuse of various aspects of celebrity personas, the demand for enforcement of this right is even more pertinent. This article attempts to explore the meaning and justification behind celebrity rights. It also examines the incapacity of the current framework of intellectual property regime to protect publicity rights, thereby explaining the recent cases of violation. The article further suggests an appropriate framework for protection of publicity rights after an in depth study of the regime in the US and some European countries where they are well established and enforceable.

INTRODUCTION

A celebrity is a person who is known for his well-knownness...

He is neither good nor bad, great or petty. He is the human pseudo event.

~ Daniel Boorstin¹

What makes an individual a celebrity is difficult to define in the contemporary era when this status has become increasingly available to many in our populace. Boorstin has wisely chosen to identify a celebrity through its axiomatic trait of being *well known*. With all the concomitant perks and publicity, celebrity status is widely popularised by the media. Famous faces greet us at every turn – on billboards, on television, on public transport, in the magazines and newspapers, and even on cereal boxes. Celebrities capture the imagination of the youth and the purses of advertisers.² They also generate economic value, be it news stories and gossip items

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1. DANIEL J. BOORSTIN, THE IMAGE: A GUIDE TO PSEUDO-EVENTS IN AMERICA 57 (1961).

2. See David Tan, *Beyond the Trademark Law: What the Right of Publicity Can Learn From Cultural Studies*, 25(3) CARDOZO ARTS & ENT. L. J. 913, 914 (2008) [hereinafter Tan, *Beyond the Trademark Law*].

about their personal and professional lives or lucrative market for celebrity merchandise and endorsements. There is no doubt that celebrity personality is an intangible and valuable asset. Their association with various causes, products and events enable advertisers to exploit their ephemeral status in the society. It is this exploitation which further paves the way for misappropriation of their personas and commercially valuable reputations. In this light, a separate right of publicity has found a vocal demand of late.

Although protection is accorded to celebrities through intellectual property laws, it has proved to be insufficient. There has arisen a strong need of separate regime of publicity rights and this article attempts to fortify the consequence and need of this protection. The first part of the article begins with an attempt to define a ‘celebrity’ and explain the various kinds of celebrity rights, publicity right being one of them. Part II examines the origin and evolution of publicity rights. This is followed by a discussion of development of publicity rights as image rights. The discussion contemplates the scope of trademark law to accord protection to celebrities. Part IV of the article deals with the Indian statutory regime on publicity and image rights, enumerating and analysing the various existing provisions and case laws. This part also draws an analogy from the Trademark Act, 1999 to express the lacuna in the existing law. The article discusses the statutory provision on publicity rights in various jurisdictions like the U.K. and the U.S. and expresses how they are more evolved, in Part V. The last part is an attempt to develop an effective regime for India to protect publicity and image rights of celebrities, keeping in view the instances of gross misuse of their persona in more than one instance.

I. DEFINITION AND KINDS OF CELEBRITY RIGHTS

A. Who is a Celebrity? What are their rights?

Traditionally celebrity status could be acquired by birth or by skill. Sportspersons, political leaders, actors and members of royal families were amongst few who assumed celebrity status. Media and global communication has defined and redefined the ambit of celebrity status time and again. As the dimensions change, be it a reality show participant performing histrionics in front of the cameras or an unsuccessful actor trying to be in limelight through controversial statements, celebrity status can be acquired by almost anyone. At the same time with media’s accentuated support, celebrity influence has pervaded popular culture.³

There are celebrities who have toiled to gain fame in varied fields like art, music, drama and sports. The good-will and reputation earned by them needs legal

3. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. LAW. REV. 125, 128 (1993) [hereinafter Madow, *Private Ownership*].

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protection.⁴ It is important to examine the rights this particular status confers on personalities which fall within its scope. These rights are diverse and exclusive. The exclusivity is significant as they are always encroached upon by the media. The privacy of the celebrities is often invaded by the media thereby infringing some of their rights.

The rights which are granted to celebrities can be divided into three broad categories: moral rights/personality rights, publicity rights and privacy rights.

a. Moral Rights/Personality Rights

Society perceives an individual in a particular way. Where celebrities are involved, their artistic endeavours are considered an extension of their personalities. Intellectual property theorists derived this personhood approach from theories of Kant and Hegel, who viewed private property as embodiment of the personality. They support the contention of private property rights in one's personality as they promote self-expression and human development and thus contribute to the society.⁵ Therefore an individual's personality embodies emotional, dignitary, human and moral values attached to it. Professor Kwall argues that the doctrine of moral rights could be extended to constructed personas to protect personality and reputational aspects of celebrities.⁶ The persona projected by the celebrity is his creative child and his livelihood depends on its preservation and integrity.

The effort in constructing a celebrity persona represents an intellectual, emotional and physical effort, comparable to that of an author. This effort ought to be protected from all kinds of encroachment, economic or otherwise. But mass media often violates personality rights by associating celebrities with products and activities which are contrary to their image.⁷ This issue can be analogically thought of as that of passing off. In *Erven Warnick v. Town end and Sons (Hull Ltd)*,⁸ Lord Diplock laid down five elements necessary to establish the tort of passing off i.e. (a) misrepresentation; (b) made by a trader in the course of trade; (c) to prospective customers; (c) which is calculated to injure the business of another trader; and (d)

4. See T Vidya Kumari, *Celebrity Rights as a Form of Merchandise – Protection Under the Intellectual Property Regime*, 9 J. INTELLEC PROP RIGHTS 120 (2004) [hereinafter Kumari, *Celebrity Rights*].

5. See for detailed discussion, Robert C. Bird & Lucille M. Ponte, *Protecting Moral Rights in United States and United Kingdom: Challenges and Opportunities Under U.K.'s New Performance Regulations*, 24 B.U. INT'L. L. J. 213, 215-216 (2006).

6. See for detailed discussion on constructed personas, Roberta Rosenthal Kwall, *Preserving Personality and Reputational Interests Through Constructed Personas Through Moral Rights: A Blue Print for Twenty First Century*, U. ILL. L. REV. 151, 151-152 (2001).

7. Anurag Pareek & Arka Majumdar, *Protection of Celebrity Rights- Problems and Solutions*, 11 J. INTELLEC. PROP. RIGHTS 415, 415 (2006) [hereinafter Pareek & Majumdar, *Protection of Celebrity Rights*].

8. (1979) AC 731.

which causes actual damage. Subsequent cases have applied the action of passing off to cases wherein the person misrepresents the name and likeness of an individual, more so in case of celebrities.⁹ In *Tom Waits v. Frito-lay Inc.*,¹⁰ voice was considered as integral to the personality of the celebrity and thus was protected by the courts against misappropriation.

b. Privacy Rights

Privacy rights are the most difficult to define. They have a broad and indefinite character. Right to privacy has been described as the most comprehensive and valued of the rights in a modern society.¹¹ There are different conceptions of ‘privacy’ which have been developed by scholars, some too broad and some too narrow.¹² Louis Brandeis (who later went on to become JUDGE BRANDEIS) and his law partner Samuel Warner wrote a pioneering article on privacy in 1890 which argued that the common law should recognise a ‘right to privacy’ which they viewed as a right of preventing truthful but intrusive and embarrassing disclosures by the press.¹³ This article initiated a new chapter in the American law by providing intellectual force and rationale for recognition of a common law right of privacy.¹⁴

Privacy may be covered under expanded notion of defamation but both raise issues which are quite distinct. The essence of the law of defamation is an individual’s reputation and right to privacy safeguards individuals’ sensitivities about what people know and believe about them.¹⁵ Therefore artificially stretching the law of defamation to include privacy is not the solution due to their fundamentally different character.

9. Kumari, *Celebrity Rights*, *supra* note 4, at 126.

10. 978 2FD 1093, 9th circuit 1992 (In this case, singer Tom Wair’s voice was imitated in a commercial of tortilla chips without his consent. Thus he succeeded in an action of misappropriation of his personality.).

11. *Olmstead v. United States*, 277 U.S. 438, 478 (1928) (BRANDEIS, J., dissenting).

12. See for detailed discussion on conceptions of Privacy, Daniel J. Solove, *Conceptualizing Privacy*, 90 CAL. L. REV. 1087, 1092 (2002).

13. See Samuel D Warren & Louis D Brandeis, *Right to Privacy*, 4 HARV. L. REV. 193 (1890) [hereinafter Warren & Brandeis, *Right to Privacy*].

14. J. THOMAS MC CARTHY, MC CARTHY ON TRADEMARKS AND UNFAIR COMPETITION 28-4 (1996). (Cases which came up before the courts in the early twentieth century concerned unpermitted use of person’s name or picture in advertising. New York rejected a common law right of privacy in such cases while Georgia vigorously embraced it. In the following decades, other sides lined up on either side of the split of authority, and some solved the problem by enacting the statute providing for right to sue for some types of invasion of privacy.).

15. See for detailed discussion, Warren & Brandeis, *Right to Privacy*, *supra* note 13, at 194. (They explain that the injury inflicted by invasion of privacy bears a superficial resemblance to the wrongs dealt with by laws of slander and libel. The law of defamation deals only with damage to reputation, i.e., injury done to the individual in his external relations by lowering him in the estimation of his fellows. On the contrary, invasion of privacy deals with injury to the feeling which is spiritual rather than material.).

c. Publicity Rights

The right of publicity is the right of an individual to prevent others from using his name, likeness, photograph or image for commercial purposes without obtaining consent. In other words, it prohibits the unauthorised use of elements or indicia that uniquely identify a person.¹⁶ Thus it is only the celebrity who can authorise the manner in which his name can be used. Melville B. Nimmer has advocated for “right to publicity” by undercutting the force in the doctrine of privacy as evolved by Brandies and Warren.¹⁷ In his critique Nimmer opined that what celebrities needed was not protection against unreasonable intrusion into privacy, but some right to control commercial value of identity.¹⁸ A well known personality thus does not wish to have his name, photograph and likeness reproduced and publicised without his consent or without remuneration to him.

In *Edison v. Edison Polyform Mfg. Co.*,¹⁹ the New Jersey Court of Chancery while granting an injunction to Thomas Alva Edison, stated:

...if man's name be his own property...it is difficult to understand why peculiar cast of one's features is not only one's property, and why its pecuniary value, if it has one, does not belong to his owner, rather than to the person seeking to make unauthorised use of it.

The publicity right is a property based doctrine and its justification as a form of intellectual property lies in the Lockean labour theory. According to this theory, whosoever sows shall only be entitled to reap the fruits.²⁰ A celebrity laboriously constructs his image through skill and hard work and the resultant fame and popularity is his property. Thus it is only him who possesses the right to exploit it commercially. Hence anybody who impinges upon this right of the celebrity to promote his goods or services would be seen as indulging in unfair trade practice, commercial tort, misappropriation of intellectual property of the celebrity, an act of passing off etc.

16. See for detailed discussion, Stacy Allen, Emilio B. Nicolas & Megan Honey, *Non Human Persons and the Right of Publicity*, available at <http://images.jw.com/com/publications/1185.pdf> (last visited on 3 Nov. 2010).

17. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW AND CONTEMP. PROBS. 203 (1954) [hereinafter Nimmer, *The Right of Publicity*].

18. See for detailed discussion, *id.* at 203 (Nimmer argues that well known personalities do not seek solitude and privacy which Brandeis and Warren sought to protect).

19. 67 A. 392 (NJ Ch. 1907) (Thomas Edison developed a pain relief formula and assigned rights to market the formula. Several years later, a New Jersey firm successfully marketed the formula. On the bottle's label, was picture of Thomas Edison and the caption, which Edison testified he never used).

20. See Tan, *Beyond the Trademark Law*, *supra* note 2, at 928; Nimmer, *The Right of Publicity*, *supra* note 17, at 216 (Nimmer also emphasized on the most fundamental axiom of the Anglo American jurisprudence, that every person is entitled to fruits of his labour unless there are important countervailing public policy considerations.).

The law in India is not well developed to protect the publicity/merchandising rights of celebrities. Courts in the U.K. and the U.S. have adopted different remedial approaches but lack a unifying justification in invoking these rights. The article will thus analyse the evolution of law in this regard and contemporary issues relating to endorsements by celebrities.

II. ORIGIN, EVOLUTION AND DEVELOPMENT OF PUBLICITY RIGHTS

A. Missing Link: Right to Publicity and Right to Privacy

The ‘right to privacy’ was conceptualised for the first time by Warren and Brandeis. Their essay is hailed by legal scholars as the foundation of privacy law especially in the U.S. Warren and Brandeis defined privacy as ‘right to be let alone’, a phrase adopted from JUDGE COOLEY’s famous treatise on torts in 1880.²¹

Warren and Brandeis traced the right to privacy to an analogous term: individual’s inviolate personality.²² The origin of this term can be traced by forging a link between the personhood approach and privacy. Personhood as a concept can be defined as those aspects which are an inextricable part of being human and should not be subject to any sort of interference or tampering by the state. Protection against invasion of privacy is one such inviolable right enjoyed by virtue of being human beings.²³

The formulation of ‘right to be let alone’ as ‘non-interference by the state’ has remained ambiguous as many legal scholars criticised the explanation. Ruth Gavison argues that this formulation often neglects to understand that the typical privacy claim is not a claim for non-interference by the state; it is instead a claim for state interference in the form of legal protection against other individuals.²⁴ Although the concepts of ‘inviolable personality’ and ‘right to be let alone’ were too broad and vague,²⁵ these concepts explored the roots of right to privacy and explained how a right could be developed from within such broad conceptions.

A significant question which must be asked is whether the right to publicity is subsumed within right to privacy. In 1954 Melville B. Nimmer studied and defined

21. Around the same time that Warren and Brandeis published their article, the Supreme Court referred to the right to be let alone in holding that a court could not require a plaintiff in a civil case to submit to a surgical examination: “As well said by JUDGE COOLEY: ‘The right to ones person may be said to be a right to complete immunity; to be let alone.’” See *Union Pac. Ry. Co. v. Botsford*, 141 U.S. 250, 252 (1891).

22. See Warren & Brandeis, *Right to Privacy*, *supra* note 13, at 196.

23. See for detailed discussion on ‘personhood’ approach, Jed Rubenfeld, *Right of Privacy*, 102 (4) HARV. L. REV. 737, 752–753 (1988-89).

24. Ruth Gavison, *Privacy and Limits of Law*, 89 YALE L. J. 421, 438 (1980).

25. Any form of offensive and harmful conduct directed towards another person could be characterised as invasion of individual’s privacy if the doctrine of ‘right to be let alone’ is followed.

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parameters of right to publicity.²⁶ He opined that with tremendous strides taken by the media and entertainment industry, there is a pecuniary value attached to the use of a celebrity's name, photograph, signature and likeness. This has led to commercialisation of various facets of his image and it is indeed this aspect of his personality that he should be allowed to control.²⁷

Actually Nimmer's essay was a consequence of JUDGE FRANK's ground breaking opinion in *Haelan Laboratories v. Topps Chewing Gum, Inc.*²⁸ This case held that people, especially prominent ones, in addition to and independent of their right of privacy, have a 'right in publicity value of their photographs'.²⁹ This right could be assigned or licensed, and the licensee or assignee could enforce it against third parties. This right according to JUDGE FRANK, might be called a 'right to publicity'.³⁰ Even as JUDGE FRANK was the first to coin this term, no judicial rationale was offered for the new right except that without it, prominent persons would be denied image revenues and would thus feel 'sorely deprived'.³¹ It seemed obvious to the court that celebrity personas could be bought and sold in the market and be treated as commodities.³² Thus, this case paved the way for commodification of personality.

Subsequently, William D. Prosser³³ scripted a significant article on privacy and culled out four distinct kinds of rights and further reinforced the genesis of right of publicity from right to privacy. He classified amorphous collection of civil wrongs falling within the category called the 'invasion of privacy' into four distinct types³⁴: invasion of privacy by intrusion into private affairs; invasion of privacy by public disclosure of private facts; invasion of privacy by false light and; invasion of privacy by appropriating some aspect of an individual's identity for commercial gain.

26. See Nimmer, *The Right of Publicity*, *supra* note 17.

27. *Id.* at 204.

28. 202 F 2d 866 (2nd Cir.) (1953) (The relevant facts of the case were as follows: Plaintiff, a chewing gum manufacturer, had contracted with certain well known baseball players for the exclusive right to use their photographs in connection with sale of its products. Subsequently, Russell Publishing Company, acting independently, obtained like grants from same players. Russell then assigned rights to the defendant, also a chewing gum manufacturer, which used the players' photographs in promoting its products. Plaintiff sought an injunction on the ground that the defendant's action conduct violated its right of exclusive use. The defendant countered that the players possessed no legal interest in their photographs other than right to privacy, which is personal and not assignable).

29. *Id.* at 868.

30. JUDGE JEROME FRANK in the case stated that: "We think, in addition to and independent of right privacy, a person has a right in the publicity value of his photograph, i.e., the right to grant exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i.e., without an accompanying transfer of business or of anything else. ...This right may be called a "right of publicity". *Id.* at 868.

31. *Id.*

32. Madow, *Private Ownership*, *supra* note 3, at 173-174.

33. William Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

34. These were four independent privacy torts that were soon adopted in the Second Restatement of Torts and have been accepted by nearly all courts in the United States.

The first three rights protect the privacy right of ‘right to be let alone’ and ‘false light’ invasion by the media. It is the fourth independent tort which gave rise to right of publicity, an independent right that seeks to recognise the commercial value of individual’s identity as opposed to injury of feelings caused by media invasion.

III. DEVELOPMENT OF PUBLICITY RIGHTS AS IMAGE RIGHTS

The scope of publicity rights has expanded since its early formulations. Keeping protection at its core, it seeks to regulate the exploitation for financial gain that is inherently part of a celebrity’s chosen profession.³⁵ For example, in *Zacchini v. Scripps-Howard Broadcasting Co.*,³⁶ the US Supreme Court addressed the issue of unjust enrichment and economic value of right of publicity. It was held by the Court that media cannot be granted a licence to broadcast a unique performance without adequate remuneration to the performer. This case led to development of the right to publicity as a property based doctrine and exclusive right of a celebrity to commercial use of fame acquired by him.

Although *Zacchini* accorded performers a right to control dissemination of their performances, it concerned only a local celebrity who sought his livelihood through solely producing stunts. With publicity rights having acquired this dimension, a celebrity has become a commercially marketable commodity. The merchandising and endorsements of celebrities have become a central component of media industry. Celebrities are therefore images which constitute a distinct and recognisable persona. These images, i.e. physical appearance, signature, style, photograph, likeness, recognizable attire, look, voice, gestures are often misappropriated by the ever transgressing media. Thus it is important for us to analyse the philosophy behind image rights - why should such rights be accorded to the celebrities and why are they so important to them in the contemporary era.

A. The Philosophy of Image Rights – The Labour Argument

A commercially marketable public image or persona must be viewed as celebrity’s own product, something that he himself makes or creates by his individual labour. Thus intellectual property in a celebrity’s persona can be justified under the Lockean theory of natural rights.³⁷

35. Ty Ford, *The Price of Fame: The Celebrity Image as a Commodity and the Right of Publicity*, 3 VAND. J. ENT. L. & PRAC. 26, 28 (2001).

36. 433 U.S 562 Ohio 1977 [hereinafter *Zacchini*] (In this case Hugo Zacchini, who made his living performing a “human cannonball” stunt at state fairs and other events, sued a television news channel for broadcasting footage of the live stunt. The performer argued that providing the public with free viewing of his stunt diminished the economic value of his personal appearances. The Court in this case recognized the strongest case of ‘right of publicity’ involving not the appropriation of an entertainer’s reputation, but appropriation of the activity by which entertainer acquired his reputation).

37. RICHARD HEYNES, MEDIA RIGHTS AND INTELLECTUAL PROPERTY 101 (2005) [hereinafter HEYNES, MEDIA RIGHTS].

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A star celebrity attains a commercially valuable public image through a combination of talent, effort, intelligence, pluck and grit. The identity, embodied in his name, likeness, statistics and other personal characteristics is the fruit of his labour and is a type of property.³⁸ This argument is akin to the Lockean philosophy of private property which views private property as reification of one's past efforts, and therefore, one deserves to keep what one has laboured to produce.³⁹ The law should interfere if someone misappropriates another's product of labour. Professor Mc Carthy, a leading advocate of this theory opines that "while one person may build a home, another knit a sweater so also may a third create a valuable personality, all three must be recognised by the law as 'property' protected against trespass and theft."⁴⁰

Further, the proprietary basis of the publicity doctrine emerged as one of the first principles of the Anglo-American jurisprudence. According to this principle, a celebrity should not be deprived of his pecuniary worth which he attains after expending considerable amount of time, effort, skill and even money.⁴¹ Therefore natural proprietary rights over their image are owned by the celebrities and the worth of this property comes from recognition of their labour.

Courts have recognised the labour argument as legally tenable in granting image and publicity rights to celebrities. In *Ublaender v. Henricksen*⁴², JUDGE NEVILLE observed that a name is commercially valuable as an endorsement of a product or for financial gain only because public recognises it and attributes goodwill and feats of skill or accomplishments of one sort or another to that personality.⁴³ A celebrity must be considered to have invested his years of practice and competition in a public personality which eventually may reach marketable status. The courts often describe celebrity plaintiffs as carefully cultivating their talents, slowly building their images, judiciously and patiently nurturing their publicity values.⁴⁴

As a counter side to the labour theory justification of image rights, it is argued that in most cases, the fame and opportunities for its exploitation does not derive from the actual process of labour or skill. With the contemporary age of reality

38. See for detailed discussion, Madow, *Private Ownership*, *supra* note 3, at 182-183.

39. Tan, *Beyond the Trademark Law*, *supra* note 2, at 928.

40. J. THOMAS MC CARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY cited in Madow, *Private Ownership*, *supra* note 3, at 183.

41. Melville Nimmer was the first proponent of recognition of proprietary rights of the celebrities in their personas. Later scholars like, Professor Mc Carthy and Sheldon Halpern advocated this theory. According to Halpern, 'right to publicity is coherently defined and protects economic associative value of the identity.

42. 31 F. Supp. 1277 (D. Minn. 1970).

43. *Id.*

44. Tan, *Beyond the Trademark Law*, *supra* note 2, at 931.

shows, celebrity images which pervade our media are a part of wider social and cultural processes which are irrespective of the labour or skill or having a distinct persona as discussed in the Lockean theory.⁴⁵ Indeed, the persona of a celebrity may not be his sole creation. They rely on an entourage of agents, publicists, sponsors, advertisers, merchandise licensees and assorted media outlets. The public image of the star is thus dependent on these intermediaries and the contractual negotiations premised on the perceived value of an individual.⁴⁶

In addition, it has been questioned if it is proper to confer an additional source of income on celebrity athletes, entertainers etc. who are already very handsomely paid. Michael Madow argues that a famous person's name and face should be treated as a common asset to be shared which is indeed an economic opportunity present in the free market system.⁴⁷

It is argued that reservations for granting image rights to celebrities lose ground in the present scenario of intensified commodification of star images. Celebrities indulge in product endorsements and advertisers use their persona on the theory that their credibility, goodwill and glamour will rub off on the product and thus motivate purchase decisions of the consumers. Utilitarian approach in this perspective also justifies granting of image rights. This approach emphasises on the ability of proprietary rights to operate as an incentive to innovation and creative production.⁴⁸ Also this approach further justifies image rights from the perspective of economic efficiency and monopoly right. Restricted right to celebrity images would ensure economic efficiency in the market. A monopoly right to the commercial use of a celebrity name or image would maximise its economic worth by restricted access and augment its value to a fair price.

B. Individual as Trademark: The Scope of Protection of Image Rights as Trademarks

The principal function of a trademark is one critical to the identification of its origin. A trademark tells a consumer that the quality and attributes of a product bearing the mark are under the control of the same person. For this reason the

45. HEYNES, MEDIA RIGHTS, *supra* note 37, at 102 (One of the scholars Rosemary Coombe furthers the argument of celebrity images and fame representing diverse cultural practices and desires. According to her, celebrity images are not simply marks of identity or simple commodities; they are cultural texts – floating signifiers and are continually invested with libidinal energies, social longings and political aspirations.).

46. *Id.* at 102 (Michael Madow also extends this argument further by emphasizing on the role of media in the image making process. A film star's image is not just in his or films, but the promotion of those films and of the star through public appearances, biographies, interviews, "private life" of the star. Madow, *Private Ownership*, *supra* note 3.).

47. *Id.* at 102.

48. *Id.* at 103.

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consumer can infer that a product bearing the trademark will have the quality and attributes he has come to be associated with the product. Thus a trademark communicates information to the consumer and allows a producer to build up and exploit the reputation of his products.⁴⁹ The law of trademark infringement prohibits deceptive use of the claimant's registered trademark.⁵⁰

As far as images are concerned, trademarks have important functions which go beyond the communication of information to consumers. A trademark can acquire an 'image' through advertising. The image embodies attitudes or feelings or values that the producer has managed to get associated with the trademark. If a trademark has such an image, consumers may be influenced to purchase the product by their attraction to the image or their desires to associate themselves with it. This image based function can be described as the advertising or merchandising function.⁵¹ On the other hand, the protection of trademark for the purpose of identification of origin has a different justification from protecting the trademark for this merchandising function. The unauthorised use of the image cannot in itself be deceptive because its purpose is not to convey information.⁵² In practice modern trademark law protects the merchandising function along with the origin function, i.e., it supports trademark owners in developing and exploiting the image of their trademarks.⁵³

The function of image of the trademark does not take into account deceptiveness which is the essence of trademark law and that is the reason for not conferring protection to it in various jurisdictions. But recent developments have shown that the law of registered trademarks gives increasing support to the protection

49. Peter Jaffery, *Privacy, Confidentiality and Property*, in PAUL L.C. TORREMAN (ED.), *INTELLECTUAL PROPERTY RIGHTS AND HUMAN RIGHTS – ENHANCED EDITION OF COPYRIGHT AND HUMAN RIGHTS 447* (2008) [hereinafter Jaffery, *Privacy*].

50. *Id.* at 447. § 29, Trade Marks Act, 1999 ("A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.") § 9(1)(a), Trade Marks Act 1999 ("Trademarks which are devoid of any distinctive character, that is to say not, capable of distinguishing the goods or services of one person from those of another shall not be registered.")

51. Images generally do not communicate concrete information to the consumers about the product.

52. *See* Jaffery, *Privacy*, *supra* note 49 at 467.

53. Trade mark dilution is a modern concept which recognizes that non-deceptive dilution can also constitute infringement. This includes tarnishing of a trade mark or blurring of its distinctiveness. This can be understood to be intended to protect the image of a trade mark and so to support the advertising or merchandising function of the trade mark, but it is also explicable in terms of origin function, i.e., in terms of effect in hindering communication with consumers. The Trade Marks Act 1999 under § 29 (8) protects the advertising function of the trademark against infringement ("A registered trademark is infringed by any advertising of that trademark if such advertising – (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or (b) is detrimental to its distinctive character; or (c) is against the reputation of the trademark.")

of merchandising marks through trademark registration.⁵⁴

The attempt to recognise image rights has been successful in many jurisdictions which are discussed in the following parts. Thus right to publicity is nothing but *merchandising right of celebrities in their image*. The argument for right of publicity based on law of trademarks and goodwill is firmly gaining ground with the growth of merchandising and endorsements by celebrities.⁵⁵ After having analysed the concept of image rights and examining its connection with intellectual property laws, it is now important for us to foreground the purpose, status and scope of image rights in India and also other jurisdictions.

IV. IMAGE RIGHTS IN INDIA

The jurisprudence of publicity and image rights is in its nascent stages in India. As compared to the global scenario, India has been lagging behind in recognising the right of publicity and image. There is neither a considerable body of case law, nor any comprehensive statute governing image or publicity rights of celebrities. It is only the Emblems and Names (Prevention of Improper Use) Act, 1950, which to a limited extent, protects unauthorised use of few dignitaries' names by prohibiting the use of the names given in its schedule.⁵⁶ Thus the Indian legal system is underequipped in dealing with the modern phenomenon of celebrity endorsements and merchandising. With exorbitant sums riding on celebrities, the advertisers and market forces often find ways and means to abuse celebrity images.

The only authoritative case on publicity rights comes from the Delhi High Court, in *ICC Development (International) Ltd. v. Arvee Enterprises*.⁵⁷ The court held that the right to publicity has evolved from the right to privacy and can inhere

54. It has been reiterated time and again that commercial worth of the celebrity magnet (particularly in advertising) belongs to them. The counsel on behalf of the Elvis Presley Foundation in *Elvis Presley Trade Mark, Re*, [1977] R.P.C. 543 argued that the court should accept a free standing general right to character exploitation enjoyable exclusively by the celebrity.

55. However there are scholars like Thomas Mc Carthy who state that the differences in the law of trademarks and the law of right of publicity outweigh the similarities. The differences largely stem from the historical fact that the right of publicity had its origins in the law of "privacy", whereas the law of trade marks had its origin in the tort of fraud. While the key to the right of publicity is the commercial value of human identity, the key to the law of trade marks is the use of a word or symbol in such a way that it identifies and distinguishes a commercial source.

56. § 3, Emblems and Names (Prevention of Improper Use) Act, 1950 ("Notwithstanding anything contained in any law for the time being in force, no person shall, except in such cases and under such conditions as may be prescribed by the Central Government, use, or continue to use, for the purpose of any trade, business, calling or profession, or in the title of any patent, or in any trade mark or design, any name or emblem specified in the Schedule or any colourable imitation thereof without the previous permission of the Central Government or of such officer of Government as may be authorised in this behalf by the Central Government.").

57. 2005 (30) PTC 253 (Del) [hereinafter *ICC Development*].

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only in an individual or in any indicia of the individual's personality like his name, personality trait, signature, voice etc.⁵⁸ An individual may acquire a right to publicity by virtue of his association with an event, sport, movie etc. However, the right does not inhere in the event in question, that made the individual famous, nor in any corporation that has brought about the organisation of the event. Any effort to take away right of publicity from the individual, to the organiser/ non-human entity would violate Article 19 and 21 of the Constitution of India.⁵⁹

This case shows that development of publicity rights in India flows from rights of human dignity and liberty as enshrined in Articles 19 and 21 of the Constitution. It is rather a tussle between an individual's right to privacy and the interest of the larger public to know. The development of this right as a commercial property is quite restricted if analysed in the intellectual property regime.

A. Protection of Image Rights as Trademarks in India

Individual may apply for protection of their name, likeness and nicknames, among other things, with the Indian Trademarks Registry in order to obtain statutory protection against misuse.⁶⁰ This is of strategic importance to celebrities who intend to use their image and likeness to identify their own or an authorized line of merchandise.⁶¹ Increasingly celebrities are becoming aware of their image rights. A recent example is of actress Mallika Sehrawat who registered her name as a trademark.⁶² Other celebrities including yoga guru Baba Ramdev, cardiologist Naresh Trehan, chef Sanjeev Kapoor and actress Kajol, are among the few who have sought protection under trademark law by applying for registration of their names and images as trademarks.⁶³

In a recent unreported case, *Sourav Ganguly v. Tata Tea Ltd.*, the courts granted senior batsman Sourav Ganguly relief stating that his fame and popularity is his intellectual property. Sourav Ganguly on his return from Lords after scoring

58. *Id.* at ¶ 14.

59. *Id.* at ¶ 14 (A non-human entity or a non-persona does not have a 'right of publicity').

60. § 14, Trademark Act, 1999 prohibits the use of personal names, where an application is made for the registration of the trademark, which falsely suggests the connection with a living person, or a person whose death took place within 20 years prior to the date of application for registration of the trademark. The registrar may, before proceeding with application requires the applicant to furnish the consent of such living person or as the case may be, the legal heirs of the deceased person to the connection appearing on the mark.

61. Surabhi Mehta & Teesta Hans, *Publicity and Image Rights in India*, available at http://asklegalmart.com/yahoo_site_admin/assets/docs/article.356121953.pdf (last visited on 15 Nov. 2010).

62. *Id.*

63. Thomas George, *Celebrity-focused Culture Highlights Need for Statutory Right to Publicity*, available at <http://www.worldtrademarkreview.com/issues/article.ashx?g=1596958f-55a7-4b2b-a93c-66f887027801> (last visited on 8 Jan. 2011).

magnificent centuries found that Tata Tea Ltd. was promoting its tea by offering consumers an opportunity to congratulate him through a postcard which was included in each one kilo packet of tea. Though Sourav Ganguly was the employee of the Company, he had at no time authorised the company to market its tea in association with him in any way.

There have been other instances as well which make it evident that celebrities have increasingly become aware of their image rights. Prior to the release of his movie “Baba” in 2003, cine star Rajnikanth issued a legal notice prohibiting anyone from imitating his screen persona or using the ‘character’ he portrayed in the movie for commercial gain. The legal notice was published in a number of leading English and Tamil dailies.⁶⁴ Owing to misuse of their voice by various brands, actors Amitabh Bachchan and Sunny Deol are also seeking protection under the trademark law.⁶⁵

B. Statutory Inroads of Image Rights

There is no specific provision under the trademark law to protect image rights of celebrities as trademarks. A celebrity may resort to an action of passing off in order to protect his or her publicity and image rights.⁶⁶ However an action of passing off requires proof of: reputation of the individual, some form of misrepresentation and irreparable damage to the individual.

The above standards of proof demonstrate the evasive intent of the legislature in treating an individual as a commodity or a commercial property. The basis of existing provisions is instead in values of human dignity and liberty. There is no mention of the right of individual to control his commercial value, restrict its dissemination etc.

It is important for the purposes of this article to examine other provisions which might lead to protection of publicity rights, although this term is not mentioned explicitly in the Trademark or Copyright Act.

a. Protection under Advertising legislation

All advertisements are governed by the Code for Self-regulation in Advertising

64. The legal notice also declared that no attempt should be made by the advertisers to use Rajnikant’s photos or sketches or attire in the film for the purpose of endorsing products.

65. There were recent instance of a Gutka company imitating Amitabh Bachhan’s voice in its advertisement for endorsement of its product without his permission. Also Sunny Deol issued legal notice to Big 92.7 FM because the latter aired audio fillers ‘Son Sunny’ mimicking him and his family. *Available at* <http://www.financialexpress.com/news/when-celebrities-see-copyrights/729569/0> (last visited on 2 Jan. 2011).

66. § 14, Trade Marks Act 1999 deals with falsely using names and representations of living person or persons who have recently died.

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("Code"), which was adopted by the Advertising Standards Council of India.⁶⁷ 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.*⁶⁸

The Standards of Practice for Radio advertising and the Code for Commercial Advertising on Television contain similar provisions.⁶⁹

b. Protection under Right to Privacy

The right to privacy protects individuals against unlawful government invasion. The Indian Constitution does not grant in express or specific terms, any right to privacy as such. It is not enumerated as a fundamental right in the Constitution. However such a right has been carved out by the Supreme Court in the corpus of Article 21.

In *R. Rajagopal v. State of Tamil Nadu*,⁷⁰ Supreme Court asserted the significance of right to privacy as a constitutional right implicit in the right to life and liberty guaranteed to the citizens by Article 21.⁷¹ A citizen has a right to safeguard the privacy of his own, his family, marriage, procreation, motherhood, child bearing and education among other matters. None can publish anything concerning the above matters without his consent – whether truthful or otherwise and whether laudatory or critical. If he does so, he would be violating right to privacy of the person concerned and would be liable in an action for damages.⁷²

67. Advertising Standards Council of India is a voluntary Self-Regulation council. The sponsors of ASCI who are its principal members, are firms of considerable repute within industry in India, and comprise advertisers, media, ad agencies and other professional and ancillary services connected with advertising practice. It is not a government body.

68. Chapter 1, clause 3, Code.

69. Chapter II, clause 17, Code of Commercial Advertising over All India Radio (The simulation of voices of a personality in connection with the advertisements for commercial products is prohibited unless bonafide evidence is available that such personality has given permission for simulation and it is clearly understood that station broadcasting such announcements are indemnified by the advertiser or advertising agency against any possible legal action.) The Code of Commercial Advertising has the similar provision under chapter II, clause 21 with an addition of the word appearance to the voices as described above.

70. 1994 SCC 632.

71. *Id.* at 634. The apex court defined right to privacy as right to be let alone.

72. *Id.* at 634 (Any publication concerning the aforesaid aspects becomes unobjectionable if such publication is based upon public records including court records. This is for the reason that once a matter becomes a matter of public record, right to privacy no longer subsists and it becomes a legitimate subject for comment by the press and media.)

Although right to publicity comes under the extended view of Article 21 but this right is not absolute; reasonable restrictions can be placed thereon in public interest under Article 19(5). Freedom of press is embedded under Article 19 of the Constitution. Also the expression of ‘freedom of speech and expression’ used in Article 19(1)(a) has been held to include the right to acquire information and disseminate the same.⁷³ The Supreme Court has given a broad dimension to Article 19(1)(a) by laying down the proposition that the freedom to receive and to communicate information and ideas without interference is an important aspect of freedom of speech and expression.⁷⁴

This has been consistently challenged by the celebrities on the ground that media has misused their freedom under the guise of giving news in ‘public interest’.⁷⁵ There have been alternative arguments that celebrities have dedicated their lives to the public and no longer command the protection of law of privacy. But this waiver is not absolute and the celebrity has a right to maintain the privacy of his non-professional and other parts of professional life.

It is clear that a right to privacy is a treasured possession of every individual; it should be respected and should not be exploited by the media on the pretext of public interest. The statutory provisions in India pertaining to protection of image rights are prevalent in the intellectual property regime but they are inadequate. The next part evidences the treatment of image and publicity rights in other jurisdictions, drawing inspiration from the forward thinking contained in foreign laws.

V. IMAGE RIGHTS IN OTHER JURISDICTIONS

They have decided that I am still a product after 15, 16 years that sells well. They shout at me, Oh Di, look up, if you give us a picture, I can get my children to a better school.

~ Princess Diana⁷⁶

Celebrity endorsements and merchandising in India is a comparatively contemporary phenomenon. But in countries like the U.K. and the U.S. celebrity rights regime is well laid out. Celebrities fiercely guard their personas through their

73. M.P. JAIN, INDIAN CONSTITUTIONAL LAW 988 (5th ed. 2008).

74. In *State of Uttar Pradesh v. Raj Narain*, AIR 1975 SC 865, 884, the apex court held that Art 19(1)(a) not only guarantees freedom of speech and expression, it also ensures and comprehends the right of citizens to know, the right to receive information regarding matters of public concern. Similar ratio was drawn in cases like *Secretary, Minister of Information and Broadcasting, Govt. of India v. Cricket Association of Bengal*, AIR 1995 SC 1236 and *Association of Democratic Reforms v. Union of India*, AIR 2001 Del 126.

75. Pareek & Majumdar, *Protection of Celebrity Rights*, *supra* note 7, at 418.

76. Statement made by Princess Diana during a course of interview with BBC in 1995 cited in, Kumari, *Celebrity Rights*, *supra* note 4, at 134.

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publicists and any kind of misappropriation by the advertisers does not go unnoticed. After analysing the Indian position, it is important to examine the provisions pertaining to image rights in other major jurisdictions as well.

A. The U.K. Law: A Notch Above

The U.K. does not have any freestanding right of publicity. The situation seems paradoxical if we consider the fact that the U.K. has the strongest libel laws in the world. Furthermore, it recognised an individual's privacy as being a basic and fundamental human entitlement in October 2000.⁷⁷ There are no sui generis laws in the U.K. to protect image or persona of a celebrity.

Even as the U.K. law is less developed as compared to the U.S., it suffers from the same lacuna as Indian law.⁷⁸ The courts while deciding cases are confused whether to refer to “celebrity”, “character”, “personality” or “image” rights. In order to succeed in a libel claim, a celebrity must show that his reputation has been lowered. The use of trademark law for protection of personality rights is restricted. A name may be trademarked under the provisions of the Trade Mark Act 1994, however the distinctiveness of the name is ought to be proved to get it registered.⁷⁹ Copyright also protects only a photograph, drawing and portrait of an individual as an artistic work but again this does not provide protection to image rights.⁸⁰ Generally, under the English law image and publicity rights are protected under the action of passing off.

The basic principle behind the common law tort of passing off is that of misrepresentation of one's good as someone else's. An actionable passing off under the English law is governed by the classical trinity of goodwill, misrepresentation and damages.⁸¹ These three essentials as stated by the House of Lords are⁸²: *first*, the

77. SIMON SMITH, *IMAGE, PERSONA AND THE LAW* 1 (2001).

78. The British law has protected some aspects of identity and its commercial value in a piecemeal fashion through traditional trademark law and passing off.

79. *See* Elvis Presley Trade Marks, Inc., [1997] R.P.D. 543, 556 (Ch.) (Eng).

80. *Id.* at 547. It was held in this case that Elvis Presley enterprises does not own the likeness of Elvis Presley. No doubt it can prevent the reproduction of the drawings and photographs of him in which it owns copyright, but it has no right to prevent the reproduction or exploitation of any myriad of photographs in which it does not own copyright.

81. *See* Jan Klank, *50 Years of Publicity Rights in the United States and the Never Ending Hassle with Intellectual and Personality Rights in Europe*, 4 I.P.Q. 363, 368 (2003) [hereinafter Klank, *50 Years*].

82. In *Reckitt v. Borden*, [1990] R.P.C. 340, at 499 (A successful plaintiff must demonstrate the following: first, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public. Secondly, he must demonstrate a misrepresentation by the defendant to the public leading or likely to lead the public to believe that goods or services offered by him are the goods and services of the plaintiff. Thirdly, he must demonstrate that he suffers, or in a quia timet action, that is likely to suffer damage by reason of erroneous belief engendered by the defendant's misrepresentation.).

goodwill or reputation must be attached to the product or services of the plaintiff; *secondly*, the defendant has made misrepresentation likely to confuse the public and; *thirdly*, there is loss or the material prospect of loss to the claimant. Bringing appropriation of personality and commercialisation of popularity within the scope of the tort of passing off involves considerable stretching of these three elements.

The case that is often cited as heralding the arrival of image rights is *Irvine and anr v. Talksport*.⁸³ The High Court decision effectively recognised the value of sports image rights and conferred protection on them. The case centred on whether or not a famous sports celebrity had acquired a valuable reputation and if the goodwill in the star's name or likeness had been misrepresented to the market as being licensed by the celebrity concerned.⁸⁴ JUDGE LADDIE's ruling confirmed that the name and image of a sports star is constitutive of a brand, with all various economic rights associated with that status.⁸⁵ It further confirmed that 'passing off' cases are maintainable even if the endorsements do not pertain to their field of expertise.⁸⁶ This was a giant leap towards protecting image rights of celebrities.

Another related case involving a celebrity in a false endorsement campaign involved the former long-distance runner David Bedford. He brought a complaint to the U.K. communications media regulator, Ofcom, which found that two runners featured in the campaign of the operator, each wearing the numbers "118", had caricatured Bedford without his permission.⁸⁷ The Ofcom decision relates solely to a breach of the Television Advertising Standard Code and was specifically stated to be without prejudice to any private claim that Mr Bedford may have for passing off. Notably Ofcom refused to order removal of the adverts, primarily on the basis that Mr Bedford had failed to take action for some six months since first becoming

83. [2002] WLR 2355 (The facts of the case were as follows: Talksport had used doctored photograph of the racing driver in the promotional leaflet that the commercial radio station had circulated to the media buyers and potential advertisers. Fewer than one thousand leaflets were distributed; but the business affairs director for the formula one team noticed the driver's inclusion in the promotion and therefore alerted him regarding the fact. Talksport had digitally manipulated Irvine's image in a photograph of him as if he is endorsing it.).

84. *Id.* at 2355.

85. *Id.* at 2379. It was held that Mr Irvine has a property right in his goodwill which he can protect from unlicensed appropriation consisting of false claim or suggestion of endorsement of a third party's goods or business.

86. *Id.* at 2368. JUDGE LADDIE rejected the common law field of activity requirement on the basis that it severely limited the application of the tort of passing off. Instead, to claim the action of passing off all the requirements were boiled down to existence of goodwill and misrepresentation.

87. In this case, the operator, The Number, owned by the US call centre ran a distinctive 118 118 enquiry service. The service made a major impact in the market in a 70 million pound cross media advertising campaign that used a comic theme starring two long distance runners wearing 1970s running vests with hoops, red socks and pale blue shorts. The characters had distinctive drooping moustaches and long straggly hair. The campaign gained a cult following and was highly successful and mopped up 50 percent of the directory service market.

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aware of the advertising campaign.⁸⁸ Mr Bedford decided not to enter into further litigation, therefore the case which would have possibly been a catalyst in the development of publicity and image rights came to an abrupt end.

Although the cases discussed above prove the increasing awareness of celebrities towards their image rights, as there are no provisions to protect celebrity image and persona, they often rely on the framework of intellectual property rights and torts. But this common law remedy of resorting to equity courts has proved to be rather effective.

B. The U.S. Law: A Celebrated Regime for Celebrity Rights

No country in the world is so driven by personality as is the United States. It stands in the forefront amongst nations regarding development and recognition of the legal doctrine that protects celebrities against unwanted commercial exploitation. Professor Roberta Kwall explains that the primary reason for this is pervasiveness of the fame phenomenon in the U.S. as compared to other nations.⁸⁹ She further mentions the influences of democracy, the American dream, capitalism and consumerism that help to explain the gravitation towards a legal doctrine that safeguards proprietary interests of celebrities.⁹⁰

New York was the first state that adopted a privacy right by statute which could be interpreted broadly enough to include publicity rights in New York in 1903.⁹¹ However, it was not until the 1953 that the courts first accepted the existence of a self standing publicity right, in a case concerning the sale and marketing of picture cards of baseball players that had taken place without their consent.⁹²

Today over thirty states acknowledge some form of image or publicity right, either under the common law or based in statute.⁹³ The duration of right varies widely amongst states. In half of the states, this right is recognised as extending beyond the death of the celebrity and thus enforceable by the heirs and assignees of the celebrities. The right extends to seventy years in California, one hundred years

88. Robert Buchan & Gill Grassie, *Personality Rights: A Brand New Species*, available at <http://www.journalonline.co.uk/Magazine/49-5/1000319.aspx> (last visited on 10 Jan. 2011).

89. Roberta Rosenthal Kwall, *Fame*, 73 IND. L. J. 1, 5 (1997). She further explains that Europeans are more attracted to the American celebrities than the local ones. Other countries like Italy, Germany, Canada and Japan are following the American lead and developing the right of publicity.

90. *Id.* at 8.

91. See Klank, *50 Years*, *supra* note 81, at 376.

92. *Haelan Lab. Inc v. Topps Chewing Gum Inc.*, 202 F 2d 866 (2nd Cir.) (1953).

93. Richard Penfold, Alex Battenson & Jeremy Dickerson, *Image Rights overview: How to Defend Image Rights*, available at http://www.dlapiper.com/files/Publication/8876637c-654c-4030-9e4a-1892561eec8e/Presentation/PublicationAttachment/fa6fc215-0720-4f50-bfdc-1a91e82c403c/Image_Rights_Overview.pdf (last visited on 1 Dec. 2010).

in Indiana, and apparently a perpetual term in Tennessee, home of Elvis.⁹⁴

Initially, the right of publicity had a restricted scope of protection limited to celebrity's name or likeness. But this scope was gradually extended by the courts and commentators to include anything that identifies a celebrity. The best known case was *Vanna White v. Samsung Electronics America Inc.*⁹⁵ In this case White sued Samsung Electronics over a magazine advertisement which showed a female-shaped robot dressed and turning the letters like her.⁹⁶ The Ninth Circuit Federal Court of Appeals gave a broad interpretation to right of publicity reversing the decision of the district court. According to the panel majority, the California right of publicity can't possibly be limited to name and likeness but extends to any appropriation of White's identity, anything that evokes her personality.⁹⁷ The decision therefore widened the scope of publicity rights and tilted the balance in favour of the celebrities, i.e., in addition to the exclusive right in her name, likeness, signature or voice, a celebrity now also has a right to anything that reminds the viewer of her.⁹⁸

The above case law proves the ever expanding ambit of the right of publicity conferred on celebrities, but the right was restricted to a considerable level through the First Amendment.⁹⁹ Reconciling the first amendment values of an uninhibited marketplace of ideas in furtherance of the ideals of free speech with the right of publicity was no doubt a murky process for the courts. An attempt by the court to balance the two doctrines is in the Dustin Hoffman Case.¹⁰⁰ The LA magazine in California was sued by Dustin Hoffman for a front cover which included an image of him manipulated to show him wearing women's clothes.¹⁰¹ At first instance, he

94. Stephan R. Barnett, *The Right to one own Image: Publicity and Privacy Rights in United States and Spain*, 47 AM. J. COMP. L. 555, 560 (1999).

95. 971 F.2d 1395 (9th Cir. 1992).

96. The advertisement which prompted the dispute was for Samsung video cassette recorders. The ad depicted a robot dressed in a wig, gown, and jewellery which David Deutsch Associates, Inc. consciously selected to resemble Vanna White's hair and dress. The robot was placed next to a game board which is instantly recognisable as the Wheel of Fortune game show set, for which White is famous. The caption of the ad read: 'Longest running game show. 2012 A.D.'

97. *Id.* 1398-99. The majority panel further reasoned that a clever advertising strategist could avoid using White's name or likeness but nevertheless remind people of her with impunity, "effectively eviscerating" her rights.

98. This decision was criticized by many commentators as overprotecting intellectual property and harming the future creators and the public at large.

99. First Amendment in the US Constitution protects free speech or promotional speech if it is solely for non commercial purposes.

100. Dustin Hoffman v. Capital Cities/ABC Inc., 255 F.3d 1180 (9th Cir. 2001).

101. *See, id.* at 1182. In March 1997 LA Magazine published a featured article, titled 'Grand Illusions' that used computer altered still photos from famous movies to make it appear that the actors in the stills were

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successfully sued for breach of his image right and was awarded damages by the trial court of \$2.6 million.¹⁰² However, the decision was overturned by the Ninth Circuit Federal Courts of Appeal on the basis that use of the image amounted to no more than free speech, as protected by the First Amendment.¹⁰³

Similar to the above case in 1998, ETW, the licensing agent of well-known golfer Tiger Woods, brought a claim in Ohio against a publisher of limited edition prints of an artwork including Tiger Woods' image.¹⁰⁴ ETW brought an action for trade mark infringement, dilution, unfair competition and false advertising.¹⁰⁵ On appeal in 2003, the court held that as a general rule a person's image or likeness cannot function as a trademark. It also dismissed the image right claim on the basis that the painting amounted to protected free speech under the First Amendment.¹⁰⁶

These cases demonstrate that despite the far-reaching protection of image and publicity rights in the U.S., the courts are prepared to uphold free speech even for commercial use of names and images. Therefore in spite of a strong protection regime accorded to celebrities, courts are always trying to balance free non commercial speech with right to publicity.

C. Other Trends in Publicity Rights

The U.K. is the only country in Europe with no specific legislation for image rights. Most E.U. countries protect commercial use of a celebrity's name and individual. France and Germany particularly have strong image and personality rights.¹⁰⁷ In 2006 German tennis star Boris Becker succeeded in his action for

wearing the latest designer fashions. The final shot was a still from the movie 'Tootsie' which showed Dustin Hoffman wearing not the red sequined evening dress he wore in the film but a chic new outfit by designers Richard Tyler and Ralph Lauren.

102. *Id.* at 1182.

103. *Id.* at 1184. The Court clearly delineated commercial speech from that of non commercial speech. It said: the core notion of commercial speech is that it does no more than propose a commercial transaction.

104. *ETW Corp. v. Jireh Publishing Inc.*, 99 F. Supp. 2d 829 [hereinafter *ETW Corp.*]. In this case ETW Corp., an exclusive licensing agent of Tiger Woods brought an action against Jireh, an Alabama based publishing company and an exclusive publisher of the artwork of Rick Rush, a "sports artist." Rush created a painting titled 'The Masters of Augusta' showing Woods in three positions flanked by two caddies and shadowed by the ghosts of former Masters Tournament champions.

105. Actions were brought under six counts, i.e., trademark infringement under Lanham Act 15 U.S.C. §1114, dilution under U.S.C. §1125, unfair competition and false advertising under U.S.C. §1125(a), unfair competition and deceptive trade practices in violation of the Ohio Revised Code, unfair competition and trademark infringement under Ohio common law and right of publicity in violation of Ohio common law.

106. *ETW Corp.*, *supra* 104, at 835. The painting of Tiger Woods was created by Rick Rush, who characterised himself as 'America's Sporting Artist – Painting America through Sports'. Also the item at issue was a 'limited edition' i.e., only 5000 prints were made available worldwide.

107. In France, personality rights are protected under art. 9 of the French Civil Code. Germany also offers a much greater and sophisticated level of protection. Provisions have been created under Artistic Authors

unauthorised use of his image against the newspaper Frankfurter Allegemeine.¹⁰⁸ Under German law, it is possible to use certain celebrities' images without their permission for information or editorial purposes but not for promotional purposes as was done in Becker's case.¹⁰⁹ He was awarded damages worth Euro1.2m for appropriation of his image by the newspaper without his permission.¹¹⁰ This case shows that German laws protecting image rights of celebrities are stronger than laws in the U.K. Similarly in France also, appropriation of image for editorial and biographical use is considered legitimate free speech. The courts are always trying to balance unlawful commercial exploitation and legitimate free speech.¹¹¹

In Australia, like the U.K. there is no image or publicity right in a person's name or likeness. Australian Courts have developed a law of passing off akin to a right of image or personality. The leading case was brought by Paul Hogan, famous for playing the movie character Crocodile Dundee.¹¹² A shoe manufacturer, Pacific Dunlop, used the character dressed up in a costume similar to that worn by Hogan in the films for the advertisements. The court upheld Hogan's claim of passing off on the basis that the public would assume that Hogan has licensed or endorsed Pacific Dunlop to use the image of Crocodile Dundee.¹¹³

The above examples show that many countries do not have specific provisions for publicity rights but they are protected through the intellectual property laws. This is a serious lacuna as intellectual property and tort laws such as passing off, misrepresentation, libel do not squarely subsume publicity rights.

In the light of discussion of the Indian position vis-a-vis foreign jurisdictions, it is timely to consider the recommended legal regime for publicity rights in India.

Rights Act and the German Constitution. §§ 22 and 23 of the Authors Rights Act, provides that a person has a right to control the publication of his picture. The word "picture" has been given a broad interpretation to anything that resembles a likeness to the person. These provisions are complemented by arts. 1 and 2 of the German Constitution which are quintessentially human rights which in turn prevents them from being waived or transferred.

108. Boris Becker v. FAZ, 21 U 2518/03 [hereinafter *Becker*].

109. Information available at official website of Couchman Harrington Associates, http://www.couchmansllp.com/documents/news_press/Boris%20Becker.pdf (last visited on 8 Dec. 2010) [hereinafter Couchman Harrington].

110. See *Becker*, *supra* note 108. The rule of monetary compensation acting as a real deterrent was explicitly stated in Bundesgerichtshof (BCH- Federal Court of Justice), Case No. 6 ZR 56/94, 15 Nov. 1994. Since then courts have more frequently awarded higher amounts.

111. See Couchman Harrington, *supra* note 109.

112. Hogan v. Koala Dundee Pty (1988) 20 F.C.R. 314.

113. See *supra* note 93; Mary LaFrance & Gail H. Cline, *Identical Cousins?; On the Road With Dilution and the Right of Publicity*, 24 SANTA CLARA COMP. HIGH TECH L. J. 641, 677- 678 (2008).

VI. AN APPPOSITE LEGAL REGIME FOR INDIA

Publicity Right have travelled a long way from the era of being an offshoot of privacy right to an independent standalone right. The significance and the impact of the commercial aspect of the celebrity's personality can be gauged by the ever increasing instances of their personality traits. As the value of the celebrity increases, so do instances of misuse of her persona. Therefore they have time and again expressed their desire for protecting various aspects of their personality. This no doubt, leads to commodification of celebrities and challenging the very ethos of our Constitution which enshrines the principle of human dignity in Articles 19 and 21. But the contemporary trend of generating economic value through celebrities definitely deserves special attention and can in no way be diluted by these provisions.

The evasive attitude to confer property rights on one's personae was observed by the Delhi High Court in *ICC Development*,¹¹⁴ the only pertinent case law which discusses publicity rights. The need of the hour is to recognise the property rights of celebrities in their persona in addition to human dignity rights which are in any case available to all individuals and are the bulwark of our Constitution. The limited protection to a celebrity's image is provided under the provisions of trademark and copyright law. Section 14 of the Trade Marks Act 1999 prohibits use of personal names where an application is made for the registration of the trademark, which falsely suggests a connection with a living person, or a person whose death took place within 20 years prior to the date of application of the registration of the trademark. Therefore the legal heirs of the celebrities can also prevent the misuse of their names. The intent of recognising the transferability and licensing of the particular right can be interpreted from the statute. Thus the property right in one's name is granted to celebrities in the trademark law. But the lacuna of not outlining the rules on assigning and licensing such a right needs to be addressed.

The Copyright Act poses a challenge in case of recognition of publicity rights. The voice of celebrities which is often misused by advertisers cannot be copyrighted as it does not come within the ambit of literary, dramatic or musical work. There is a separate category of performers' rights which grants economic rights to performers.¹¹⁵ But these rights also subsist in a particular performance and not in a general image of the artiste or a celebrity. Therefore the copyright act also is inadequate to confer image rights on celebrities.

The inadequacies in the current framework of intellectual property laws are quite alarming, seeing the blatant misuse of various aspects of the celebrity persona.

114. See *ICC Development*, *supra* note 57.

115. Performers' Rights are given under § 38 of the Copyright Act, 1957. It should be noted that performers are only conferred with economic rights and there is no provision to accord moral rights.

The incorporation of assigning property rights can solve a part of the problem. However the dynamics of public vis-à-vis private interest needs to be worked out. The celebrities offer themselves to public domain and their activities evoke everyone's interest. Therefore conferring on them special rights so as to put them at a higher pedestal might be a dangerous proposition. It also might cause hindrance to creativity by curbing the art of imitating artistes who are performers in their own right. These concerns surely need to be addressed before any statutory framework is enabled to protect their rights. The freedom of speech and expression and freedom of the press granted through our Constitutional principles to every individual should in no way be undermined while conferring any special status to celebrities.

Most of the countries like U.S. as studied in the previous sections have given utmost importance to free speech and always held the exception in high regard despite of having a self standing publicity right. Also in case of Germany, the healthy and sophisticated mix of human rights and publicity rights can be an example for the Indian regime to follow. These legislations have always tried to balance the principles of free speech with the image rights and the same should also be attempted by the Indian regime.

CONCLUSION

Publicity right is a unique one. The dual dimension of recognising human dignity and property approach can solve the dilemma of where to place the publicity right. As the human dignity approach is already recognised by the judiciary, the pure commercial aspect, like transferability, licensing and succession can be competently addressed within the property approach. The balance between public interest in general, i.e., the ideals of free speech and freedom of press *and* the private interest of the celebrity is important. None of these rights can be undermined. Any statutory provision to protect celebrities should strive to attain this balance.