

# India

## Extending celebrity status to IP rights

Legendary Bollywood actor Amitabh Bachchan recently lent his voice to an unusual IP rights case in the media and entertainment industry. He spoke out against the unauthorised use of a soundlike of his distinctive deep baritone in an advertisement promoting a brand of *gutka* (chewing tobacco), an association which was detrimental to his image. Previously, Rajnikant, another legendary actor from the South Indian film industry, issued a legal notice warning against the imitation of his persona and character traits for commercial gain, including unauthorised advertisements, before the release of his film *Baba*. The legal notice published in various leading regional and national newspapers was an assertion by Rajnikant of his personality rights. While Indian celebrities have intermittently attempted to protect their personality rights, the law on this aspect has taken a long time to develop.

There have been many occasions – some publicised, others not – where a celebrity in India has been aggrieved by the unauthorised use of his or her name, likeness, voice, persona or other distinct personality trait. India has rapidly evolved into a consumer-driven market, with products advertised and promoted through every modern technology. Although advertisements and promotional gimmicks make concerted efforts towards establishing strong emotional bonds with consumers, the surest way to reach out to the masses is through celebrity endorsement of a product. With so many brands being endorsed by personalities, market forces are making it impossible for India to continue its laidback approach towards regulating the exploitation of personality rights and enforcing such rights effectively.

The ‘right to publicity’ is defined as the exclusive right of a celebrity to the profits made through the exploitation of his or her fame and popularity for commercial purposes. The right to exploit the economic value of a name, as measured by the fame and recognition earned by the individual, is a publicity/merchandising right. Personality rights are often lost within the area of privacy law, which makes

the effort to regulate them objectively an overwhelming task.

Following the global trend, the right to publicity in India has developed primarily through case law. Recent judgments in this relatively unexplored field signal a growing acceptance of the recognition and protection of the commercial value of an individual’s name and personality traits. The development of personality rights is based on an increased interface with IP law.

### Relevant law

Some jurisdictions have codified laws for personality rights, an example being the Californian Celebrities Rights Act 1985. In France, personality rights are recognised under Article 9 of the Civil Code. Most common law countries, including England and Wales, Australia, Canada and India, have no special legislation recognising personality rights. As a result, the Indian legislature has applied a variety of legal concepts to protect personality rights of individuals and corporations. These include the following.

### Article 21 of the Constitution

This article recognises the international covenant of the right to life and personal liberty. This can be interpreted liberally to include a person’s right to protect his or her name, persona or anything emanating from these.

### Trademarks Act 1999

While a trademark in a name or a corporate name is the most commonly recognised form of intellectual property, other forms emanating from a personality and duly recognised under the Indian trademark legislation have not been exploited at all. A prime example is the recognition of sound marks under Section 2(1)(zb) of the act. The voices of a host of celebrities, including actors, sportspersons, politicians and singers, are mimicked in order to promote products, services and events through various media. However, this provision is little known and so little used.

### Copyright Act 1957

Rights such as moral rights and performers' rights, which have some elements of personality in them, are protected by statute. However, as applied at present, such rights are devoid of any aspect of branding that might be attached to a personality. How far protection under the copyright regime could be extended in order to regulate and enforce personality rights is still unexplored.

### Common law rights against passing off

In the absence of any specific law on personality rights, one remedy is to claim passing off against any party which attempts to impersonate a right. India is increasingly recognising and extending this concept to encompass personality rights.

### Recent case law

While courts in more developed jurisdictions have often considered the concept of personality rights, in India this issue is still in the early stages. The Indian courts have had limited opportunity to deliberate on the issue of personality rights and its importance in branding. However, initial tests based on the fundamental legal concepts discussed above are paving the way for increased recognition of the rights emanating from a personality.

Three recent decisions of the Delhi High Court address different aspects of personality rights.

### Rights in an individual's personality

In *Jaitley v Network Solutions Private Limited* ([181(2011)DLT716]) political leader Arun Jaitley sought a permanent injunction to restrain the defendants from misusing the domain name 'arunjaitely.com', and to order the immediate transfer of such domain name. Jaitley wished to register the domain name 'arunjaitley.com', which the defendants had already registered. On learning of this, Jaitley wrote to the defendants requesting the transfer of the domain name, as it had not been renewed and was pending deletion. In response, the defendants asked the plaintiff either to wait for the domain name to be deleted for non-payment or to make a certified offer to purchase the domain. It was alleged that after expiration of the domain name, the defendants did not delete it or transfer it to the plaintiff, but rather transferred it to an auction site for domain names (the third defendant).

An interim injunction order granted by the court restrained the transfer, alienation or offer for sale of the domain name 'arunjaitley.com' to any third party and the creation of any third-party interest therein. It was

contended that as far as individual persons or eminent personalities are concerned, their identity is established in the virtual world of the Internet. Therefore, it is incumbent to protect domain names so that the identified names of companies and individuals which are distinct in the marketplace may not fall into the hands of individuals who have no genuine link to those names.

Furthermore, in order to prevent cybersquatting or trafficking or trading in domain names or marks, trademark law has been stretched to cover the Internet and domain names may be protected just like trademarks. The name 'Arun Jaitley' fell within the category of personal names that have acquired a distinctive connotation or identity of their own. Therefore, due to its distinctive nature and popularity in several fields, the name had become a well-known personal name or mark under trademark law, thus enabling Jaitley to restrain others from using his name unjustifiably, in addition to his personal right to sue them for the misuse of his name.

### Rights in a corporate personality

In *Tata Sons Ltd v Chak* ([CS(OS) No 392 of 2004]) the defendant sent out mass emails posing as an institution fighting against cancer with the endorsement of Tata Sons Ltd, its chairman Ratan Tata and its domain name 'tata.com'. The defendant had been sending out emails requesting donations for three years before Tata found out about his activities.

Tata is a well-renowned and well-respected company, both in India and internationally. Chairman Ratan Tata enjoys a similar reputation, both in association with the company and separately.

Tata contended that it was in no way associated with the defendant; nor did it endorse the contents of the defendant's emails. It further contended that the defendant had made multiple misrepresentations by putting the email into wide circulation, thereby sending out a false message which would be understood by a significant number of recipients as an endorsement, recommendation or approval by the plaintiff of the defendant's activities. In fact, Tata received various queries about the email, thus proving the confusion caused among the public.

Tata claimed that a person reading the email would be deceived into thinking that Tata had examined the defendant's activities and supported them. That person would further be induced to believe that the company had lent support to the defendant by allowing it to use the Tata name in the emails. Another contention was that the public, which would not otherwise take such a representation seriously, might do so due to the

mention of the names of Ratan Tata and the Tata group, and thus might be induced to forward the email or make a donation.

The court agreed with Tata's contentions and enjoined the defendant from circulating any misleading material bearing the endorsement of Tata, the name of its chairman or its domain name.

### **Rights in an individual's personality when represented through a company**

In *DM Entertainment Pvt Ltd v Baby Gift House* ([CS(OS) 893 of 2002]) the plaintiff company was incorporated in 1996 to manage the career of popular singer Daler Mehndi. The plaintiff had also been assigned all rights, title and interests in Mehndi's personality inherent in his right of publicity, along with his trademark DALER MEHNDI.

The defendant had a successful business selling dolls bearing Mehndi's likeness and singing voice, and consequently cashed in on his popularity. Aggrieved by the defendant's unlawful acts, the plaintiff filed for a permanent injunction restraining the defendant from infringing the artist's right of publicity and the false endorsement leading to passing off.

It was contended that the unlicensed use of Mehndi's persona by any party would leave a false impression on the public that the product or services originated from Mehndi, his sponsors or licensors, and that as such, the defendant's activity constituted an act of false endorsement and passing off. The use of Mehndi's persona to capitalise on his name by using it in conjunction with a commercial product was not proper or legitimate; rather, it amounted to a clear dilution of the uniqueness of such personality and gave rise to a false belief either that the plaintiff has licensed such use or that the defendant had a connection with Mehndi which allowed it to use its exclusive right to market images of the artist. In view of these arguments, the court granted the plaintiff a permanent injunction against the defendant, as well as ordering damages.

### **Rights in an individual's personality assigned to a corporate for the endorsement of their products**

In *Titan Industries Limited v Ramkumar Jewellers* ([CS(OS) 2662 of 2011]), the plaintiff had asked celebrity couple Amitabh Bachchan and Jaya Bachchan to endorse and advertise its range of diamond jewellery sold under the brand name Tanishq. The couple had assigned all the rights in their personality to the plaintiff to be used in advertisements in all media, including print and video. The plaintiff had invested huge sums of money in the promotional campaign.

The defendant, a jeweller dealing in identical goods to those of the plaintiff, was found to have put up a hoarding identical to the plaintiff's, including the same photograph of the celebrity couple displayed on the plaintiff's hoarding.

Since the defendant had neither sought permission from the couple to use their photograph, nor been authorised to do so by the plaintiff, the court held it liable not only for infringement of the plaintiff's copyright in the advertisement, but also for misappropriation of the couple's personality rights. The court thereby granted an interim injunction in favour of the plaintiff while specifically recognising the couple's rights in their personalities.

### **The future**

India has finally begun to address the multi-dimensional concept of personality rights. The increase in the number of exorbitant endorsement deals being signed by famous personalities signifies that tremendous value is attached to such endorsements. If such commercial value in a personality is appropriated by persons who are not authorised to do so, should the personality not be granted the right to sue for such embezzlement? As a result, it is becoming legitimate to determine a personality right in India. With several jurisdictions, such as the United States and the United Kingdom, exonerating the personality rights of celebrities, it may be time for India to push further for judicial and legislative recognition of this concept and to develop a holistic approach to address it.



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