

Celebrity Rights: Protection under IP Laws

Tabrez Ahmad† and Satya Ranjan Swain

KIIT Law School, KIIT University, Bhubaneswar, Odisha 751024

Received 12 October 2010, revised 13 December 2010

Protecting celebrity rights under intellectual property (IP) laws is a significant development in the field of intellectual properties rights. Celebrities can flaunt their popularity and are permitted to make riches out of their identity. Though celebrities have often lend their voices, faces and names to various commercial and non-commercial endeavours for free, there have been instances where photographs of celebrities have been used in advertising and for other purposes without their permission, leading to a scenario where celebrities are unable to make choices regarding the exposure which is acceptable to them as well as monetary benefits that they wish to acquire. In this paper, a modest endeavour is made to highlight and explain various issues concerning celebrity rights and their protection under IP laws. There are various international conventions, which have recognized these rights, either directly or indirectly. The Universal Declaration of Human Rights and the European Convention on Human Rights are noteworthy evidence in this regard. Moreover, the rights of a celebrity can be protected through copyright, trademark, etc. In this paper, various rights like right to privacy, publicity/merchandising right, moral right, personality right, right of passing off, etc. are discussed. These rights are explained in the light of laws in India and practices prevalent in US, UK, and civil law countries like France and Germany.

Keywords: Celebrity rights, intellectual property rights, right to privacy, publicity right, merchandising right, moral right, personality right, right of passing off

The right of celebrities to privacy is persistently being abused in several ways through misappropriation by others. The right of publicity and the right to commercial use of their identity are constantly infringed. Private details of celebrities are routinely leaked to the public and their privacy encroached upon. Misrepresentation or defamation is also common by depiction in a false light, use of photographs in advertisements without permission and reports in tabloid linking them to inappropriate behaviour. The right to privacy is also hampered as more and more employers operate surveillance systems in areas in which their employees have a reasonable expectation of privacy. In the name of preventing theft, harassment, etc., employers are intruding on and invading the privacy of their employees by using hidden cameras, monitoring computer programs, e-mail, website, and other software. There is hence an urgent need to recognize celebrity rights within the realm of intellectual property rights (IPR) and to secure them against any harm.

Who is a Celebrity?

While discussing celebrity rights, it is first necessary to understand what the term celebrity means. Besides, it is also important to remember that

celebrities have the sole right to exploit the value of being a celebrity.¹

Today, actors, authors, artists, politicians, models, athletes, musicians, singers, television personalities, well-known business executives, and anyone who seeks to capture the public attention including reality TV stars are all celebrities. Public perception is the main criteria for determining whether an individual is a celebrity or not. The word celebrity comes from a Latin word 'celebritatem' which means 'the condition of being famous'.² In the case of *Martin Luther King Jr Center for Social Change v American Heritage Products Inc.*,³ it was enunciated that the term 'celebrity' should be interpreted in a broader sense to encompass more than the traditional categories of movie actors, rock stars and ball players. Under the 'direct commercial exploitation of identity' test, when an unauthorized use of a person's identity is made that is both direct in nature and commercial in motivation, the person whose identity has been misappropriated has by definition become a celebrity for right of publicity purposes.⁴

The Indian Copyright Act does not define the word 'celebrity'. But reference can be made to the definition of a performer as given under Section 2(qq). A performer is not a celebrity always and a celebrity may not be a performer at all. The word performer includes 'an actor, singer, musician,

†Email: Corresponding author: tabrezahmad7@gmail.com

dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance'. Section 38 of the Act gives a special right i.e. performers' right to any performer who appears or engages in any performance in relation to such performance and that right shall subsist until fifty years from the beginning of the calendar year next following the year in which the performance is made. Clause 3 of the same section says that during the continuance of a performer's right in relation to any performance, any person who, without the consent of the performer, makes a sound recording or visual recording of the performance; or reproduces a sound recording or visual recording of the performance etc., shall subject to the provisions of Section 39, be deemed to have infringed the performer's right. With reference to performers' rights, creative artistry and interpretative artistry are two terms that find frequent mention. The former produces the result where the object is separate from the artist while in the latter, the artist produces a performance that is inseparable from him.

The word 'celebrity' is perceived by a large chunk of population as an honour and a reward for success. Sportspersons and artists earn it by skill, businessman and TV personalities earn it by wit, politicians earn it by votes and for some it is spontaneous like in the case of princes and princesses, who acquire it by birth or by marriage. Certain others may acquire it by their chance involvement in newsworthy events.⁵

Celebrity Rights

The rights enjoyed by celebrities are a bundle of rights including publicity rights, reproduction rights, distribution rights, rental and lending rights, making available rights, personality rights, privacy rights and so on. But broadly, these rights can be classified under three major categories, namely, personality rights, publicity rights, and privacy rights.

Personality Rights

Personality is a means by which one individual is recognized by another. Through the creation of one's personality, an individual creates an image of himself and his expected behaviour in society. Each personality, *per se* contributes differently to society according to their individual talents. Such personality rights are also justified by the Hegelian meta-physical concept of property which says that – 'An individual's property is the extension of his personality'. Similarly, an individual's contributions to the society are also an extension of his personality.⁶

In *Tolley v Fry*,⁷ there was controversy relating to the use of a picture of a popular amateur golf player to advertise Cadbury chocolates. Tolley's complaint was that the defendants made it appear as if he had consented to appear in the advertisement for gain or reward, and thereby misused his reputation as an amateur golf player for advertising purposes. The court held that the conduct of the defendant was capable of amounting to libel and awarded damages. However, this situation has changed drastically and today, celebrities claim paradoxical rights—the right of privacy along with the right of publicity.

Privacy Rights

The doctrine of privacy put forth by Warren and Brandeis has played a pivotal role in shaping celebrity rights. They opined that the basic concept of personal freedom extended to every person's right 'to be let alone'.⁸ People generally tend to personalize celebrities and become curious about every personal aspect of their lives. Celebrities in turn try to control their personal information since the disclosure of the same might put them in a situation of embarrassment or humiliation resulting in a feeling of insecurity.

In *Cohen v Herbal Concepts Inc*,⁹ a picture of the plaintiff and her daughter was used on the label of a cosmetic product without their consent. The defendants argued that the faces of the two individuals were not identifiable in the photograph. The court however, accepted the statement of the plaintiff's husband and awarded damages to the plaintiff in recognition of her privacy rights.

In the case of *Barber v Times Inc*, a photographer took pictures of Dorothy Barber during her delivery. Ms Barber filed a suit of 'invasion of privacy against Time Inc for unauthorized and forceful entry into her hospital room and for photographing her despite her protests. Ms Barber was successful in her suit and the court while awarding damages of US\$ 3000 opined:

'In publishing details of private matters, the media may report accurately and yet - at least on some occasions - may be found liable for damages. Lawsuits for defamation will not stand where the media have accurately reported the truth, but the media nevertheless could lose an action for invasion of privacy based on similar facts situations. In such instances the truth sometimes hurts.'

Therefore, in such cases, remedy is available to celebrities either in the form of an action for 'invasion of privacy' or in the form of assertion of their 'right to privacy'.

Publicity Rights

Prof J Thomas McCarthy stated, 'The right of publicity is not a kind of trademark. It is not just a species of copyright. And it is not just another kind of privacy right. It is none of these things, although it bears some family resemblance to all three.'¹⁰ Publicity right is 'the inherent right of every human being to control the commercial use of his or her identity.'¹¹ This right also often referred to as merchandising right, is a right to exploit the economic value of the name and fame of an individual. To claim this right, it is necessary to establish that fame is a form of merchandise. Hence, if someone uses the fame of a celebrity to promote his goods it would be termed as an unfair trade practice, misappropriation of intellectual property, or an act of passing off.

In *Midler v Ford Motor Co & others*,¹² the advertising company wanted to use a song by Bette Midler in a commercial for Ford cars. The licence for the song itself was available but Ms Midler turned down the request for permission to use her version. The Agency then contacted Ula Hedwig, a singer who had been a back-up vocalist for Ms Midler and asked her to sing the song for a new recording with the instructions 'to sound as much as possible like the Bette Midler record'. Ms Midler sued when the commercial was aired on television. The defendants argued that they were doing it in compliance with the Civil Code (Section 3344) because they had not used the 'name, voice, signature, photograph or likeness' of Ms Midler rather they had used the voice of Ms Hedwig. The court while stating that Section 3344 did not repeal the common law on privacy and publicity, and arguing that the publicity right of living people was also one of the property, held that the common law right of publicity protected against 'an appropriation of the attributes of one's identity'. The court also held that the defendants by using a sound-alike in these circumstances had clearly sought commercial association with 'an attribute of Midler's identity'. The right of publicity therefore, grants entertainers or other public figures exclusive control over the commercial exploitation of their names, likenesses, or other aspects of their personae.

However, laws pertaining to publicity or merchandising rights of celebrities are still in a fairly nascent stage, especially in India. Further, even as courts in various foreign countries have adopted different approaches to justify this right, no uniform justification has crystallized yet.

Such a right is nonetheless, distinct from the right against 'invasion of privacy' or right against 'adverse

portrayal of one's personality'. Prior to sound and visual recording process, a performer possessed personality right only in his or her performance, which included right of publicity, right to voice, right to likeness and right to privacy. But the inventions of recording technology enabled fixation of performances, leading to the problem of bootlegging (unauthorized recording of live performances). Further due to progress in animation, it is now possible to create convincing humans, computer generated look-alikes of performers or actors including deceased film stars. A real danger lies in unauthorized imaging of celebrities and subsequent digital manipulation to create new images and film footage of the actor. The use of manipulated images of celebrities in inappropriate sites has been a constant source of confusion and cause for defamation.

Need to Protect Celebrity Rights

Primarily, celebrity rights are assignable and licensable for commercial benefits. In the current context, publicity involves immense amount of money and the public image of a celebrity is of tremendous value. Recognizing this valuable asset as a property means that the same would be subject to taxation as a capital asset just like any other intellectual property. This creates an economic incentive for the public and celebrities themselves are adequately rewarded due to their moral claim over money arising out of their fame.

Secondly, the right to publicity is inheritable. Therefore descendants of a celebrity can gain from the popularity created by the celebrity during his/her lifetime.

Thirdly, to protect performers by: (i) alleviating a sense of insecurity in performers due to the fear of 'technological unemployment' including, replacement of musicians by recorded music; (ii) preventing bootlegging; and (iii) controlling exploitation of performers who cannot manage the situation on their own.

Though there is a definite need to protect celebrities, the question is how far? Whether celebrities deserve exclusive rights in a scenario where they are themselves responsible for submitting to the public, seeking patronage and thriving on public applause is question that many want an answer to.

Protection of Celebrity Rights

Liabilities and Remedies

Celebrity rights may be protected using trademark law, copyright law and passing off action. Any

infringement of a performers' non-property or recording rights will therefore amount to breach of statutory duty.

Trademark

Trademark registration has a two-fold significance as far as rights of celebrities are concerned. Firstly, trademark registration of any aspect of a celebrity's personality is indicative of the fact that the celebrity is open to the authorized assignment or licensing of his or her personality for merchandising purposes in the class of goods and services for which registration has been sought. Secondly, the celebrity obtains a means of defending those aspects of their personality against unauthorized use. Unlike action under the tort of passing off or the Trade Practices Act 1974, trademark registration is unique in providing a prospective form of protection for celebrity personality.¹³

In India, celebrities and commercial partners can obtain some protection from trademark law but such protection may be limited in scope. Section 2(1) of the Indian Trade Marks Act, 2000, allows registration of any 'sign capable of distinguishing goods and services of one person from another, any word (including personal names), design, numeral and shape of goods or their packaging' as trademark. Courts in India have accorded protection to film titles, characters and names under trademark laws.¹⁴ The first case that dealt with character merchandizing in India was *Star India Private Limited v Leo Burnett India (Pvt) Ltd*¹⁵, but jurisprudence is still emerging and character merchandising is an area yet to develop in India.

Copyright

There is not much clarity as to what aspects of celebrity rights may be protected under Copyright Act. In *Sim v Heinz & Co Ltd*,¹⁶ the court said that copyright is neither granted to voice, likeness nor other identifiers of a persona. Copyright gives exclusive, although, limited rights of protection and allows celebrities to authorize reproduction, creation of a derivative image, sale or display of, say, a commissioned photograph of themselves by others.¹⁷ To pursue an action for copyright infringement, an individual must be able to show ownership of a copyright in the image and copying of that image. In the context of celebrity photographs, the biggest problem celebrities encounter is their lack of ownership in the photograph being exploited. In case

of books involving celebrity authors, any adaptation, if original, nevertheless can get protection under copyright law.

The Indian Copyright Act, 1957 provides protection to sketches, drawings, etc., which fall within the category of artistic work. Section 14 of the Act grants exclusive right to authorize others to reproduce the work in any form, including conversion of a two dimensional work to three dimensional works and vice versa. The Courts have extended this protection to fictitious characters which fall under the category of artistic work. In the case of *Raja Pocket Books v Radha Pocket Books*¹⁸, a popular character of children's comic book, Nagraj-the Snake King, was deemed to be protected under copyright law. However, no copyright is granted to the name or image of the celebrity in India.

Passing off Action

The action of passing off is relevant in cases of personality merchandising where a person's name, likeness or performance characteristics are misused.

In general, a passing off action is a remedy against the injury to the goodwill or reputation of a person caused by misrepresentation by another person trying to pass off his goods or business as the goods of another. An action in passing off may lie for any unauthorized exploitation of a celebrity's 'goodwill' or 'fame' by falsely indicating endorsement of products by the celebrity. Similarly, the 'wrongful appropriation of personality' could amount to passing off as the celebrity could be said to have a proprietary right in the exclusive marketing for gain in his personality.¹⁹ Indian law recognizes personality rights only when the character or the person has independently acquired public recognition.

In the *Mirage Studios v Counter Feat* case (Ninja Turtle Case)²⁰, Browne-Wilkinson VC, after referring to the Australian cases of *Children's Television Workshop v Woolworths (NSW) Ltd*²¹ and *Fido Dido Inc v Venture Stores (Retailers)*²², was of the opinion that the law as developed in Australia was sound. He said that passing off would apply in a case, where public is misled with regard to a feature or quality of goods sold. In the Ninja Turtle case, the first plaintiff was the owner of the copyright in drawings of fictitious humanoid characters known as 'Teenage Mutant Ninja Turtles' and part of their business was to license reproduction of these characters on goods sold by others. The first defendant made drawings of humanoid turtle characters similar in appearance to

the first plaintiff's characters, utilizing the concept of turtles rather than the actual drawings of turtles. In this case, the court granted an interim injunction against the defendant.

In *Hogan v Koala Dundee*²³, the claimant, who was the writer and star of the film 'Crocodile Dundee', brought an action against two tourist shops which sold clothing and other accessories that were 'of particularly Australian nature'. The claimant's complaint was that the defendants had used the name 'Dundee' and had also used an image of a Koala bear which, like the hero in the claimant's film was dressed in a sleeveless shirt, wore a bush hat with teeth in the band, and carried a knife. In this case, the court granted relief on the basis of 'wrongful appropriation of a reputation or more widely wrongful association of goods with an image properly belonging to an applicant'. Similarly, in *Hogan v Pacific Dunlop*²⁴, the claimant advertised shoes by referring to a particular scene in the film Crocodile Dundee. Here, the court said that misrepresentation must involve use of the image in question to convey the existence of a commercial connection between the plaintiff and the goods and services of the defendant, which was not the case.

In *Henderson v Radio Corporation Pvt Ltd*²⁵, the claimants were professional ballroom dancers. The defendants produced a record 'Strictly for dance' in which they used a picture of the claimants in the cover illustration. The claimants argued that this amounted to passing off. The court held it as wrongful appropriation of personality and professional reputation of the plaintiffs.

Apart from these remedies today, invasion of privacy lawsuits are covered in insurance policies under the category of 'advertising injury'. The term 'advertising injury' covers defamation including libel, slander and product disparagement, infringements of copyrights, trademarks, slogans and advertising ideas or a style of doing business, and may include other violations such as the unauthorized use of a celebrity's name, likeness, voice or image. A violation of a right to privacy is also covered under such policies of insurance as either an advertising or personal injury.²⁶

In UK, apart from the civil liabilities, it is a criminal offence for a person, to do any of the following without sufficient consent, in respect of a recording which he knows or has reason to believe is an illicit recording:

- (a) Sell or hire;
- (b) Import into the United Kingdom (except for private or domestic use);
- (c) Possess such recordings with intention to commit an infringing act or deal in such recordings in the course of business.

Furthermore, it is a criminal offence to infringe a performer's 'making available right' or playing the recording in a public place, if he knows or has a reason to believe that he is infringing the right in recording.²⁷

Provisions in International Conventions

Globally the concept of publicity rights has been evolving gradually in different jurisdictions. There are a number of international conventions or treaties relevant to the protection of performers' rights. The International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, 1961 (Rome Convention), TRIPS and the WIPO Performances and Phonograms Treaty, 1996 (WPPT), are some of the landmark conventions in this regard.

Rome Convention

It is the first international instrument to deal with rights of performers, producers of phonograms and broadcasting organizations. Performers have not been given rights in respect of secondary use as in case of films under Article 19. The right to secondary use is limited to equitable remuneration. This convention does not protect moral rights.

TRIPS

Article 14(1) of TRIPS requires performers to be granted 'the possibility of preventing' the following acts, namely, fixation of their performance on a phonogram, reproduction of such fixation and broadcasting of their live performances. Under Article 14(5), the term can be extended from 20 years to 50 years. Unlike other agreements on intellectual property, TRIPS has a powerful enforcement mechanism and Member States can be disciplined through the WTO's dispute settlement mechanism.

WIPO Performance and Phonograms Treaty (WPPT)

This Treaty was contracted with a desire to develop and maintain the protection of the rights of performers and producers of phonograms in a manner as effective and uniform as possible. It recognizes the need to introduce new international rules in order to provide adequate solutions to the questions raised by modern development, the profound impact of the development

and convergence of information and communication technologies on the production and use of performances and phonograms, and the need to maintain a balance between the rights of performers and producers of phonograms and the larger public interest, particularly education, research and access to information.²⁸ Article 5 of the Treaty provides that independent of economic rights, the performer shall have the right to claim to be identified as the performer of his performance (moral rights) except under certain conditions.

Apart from moral rights, performers shall enjoy the economic rights of performers in their unfixed performances (Article 6), right of reproduction (Article 7), right of distribution (Article 8), right of rental (Article 9), and right of making available of fixed performances (Article 10). The performer has as a result the 'exclusive right to authorize' than a mere 'possibility of preventing'.

Positions in Different Jurisdictions

United States

In the United States, the right of publicity is linked to the concept of privacy. In the case of *Robertson v Rochester Folding Box*²⁹, Mrs Roberson was the first to invoke this right before a New York court, complaining that the defendant company had used her likeness as a decoration for flour bags and used them for commercial advertising. The court rejected the claim. However, the New York legislature, later, created a statutory right of privacy that established both criminal and civil liability for violations. In *Pavesich v New England Life Ins Co*³⁰, the Georgia Supreme Court held that the unauthorized use of an artist's photograph in an advertisement violated a new common law right to privacy. Unlike the relatively unknown plaintiffs in Roberson and Pavesich, who simply wanted to be left alone, celebrities consciously put themselves in the public's eye and have already acquired a certain degree of recognition. Courts interpreted the right of privacy narrowly and effectively precluded celebrities from claiming that a misappropriation of their identity invaded their 'right to be left alone'. Finally, a few years later, a court in Georgia characterized publicity as a property right based on commercial considerations, thus separating it from privacy. Today in the US, several states currently recognize the right; some by statute, some by common law, and others by a combination of both.

In *Haelan Laboratories Inc v Topps Chewing Gum Inc*³¹, Haelan Laboratories and Topps Chewing Gum

were rival manufacturers of chewing gum. To promote the sale of chewing gum, the manufacturers packaged chewing gum with cards showing the names and faces of sports heroes, particularly baseball players. Haelan Laboratories assembled through a third party, a package of player releases, backed by exclusivity agreements. Topps Chewing Gum Inc also continued to bring out its competing cards showing the players who had already signed up for the Haelan cards. In this case it was held that '...in addition to and independent of that right of privacy, a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross', i.e., without accompanying transfer of a business or anything else. Whether it be labelled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth. This right might be called a right of publicity...'

Canada

Canadian common law recognizes the right to personality on a limited basis. This was first acknowledged in *Krouse v Chrysler Canada Ltd.*³² The court held that where a person has marketable value in their likeness and such a likeness has been used in a manner that suggests an endorsement of a product then there are grounds for an action in appropriation of personality. This right was later expanded upon in *Athans v Canadian Adventure Camps*,³³ where the court held that the personality right included both image and name.

United Kingdom

The English law has strongly resisted the concept of publicity rights. As the freedom of speech and expression is given utmost importance in common law countries, these rights are considered antithesis to that. Publicity rights and other rights concerning celebrities lead to benefits only for a segment of citizens with little tangible benefits for the public in general.

However, the European Convention on Human Rights (ECHR) has compelled English law to develop. In a series of cases, the Court at Strasbourg recognized that taking of photos without consent interfered with Article 8 rights under the ECHR. This was held to be so, even if the photographs were taken for police purposes, or for journalistic purposes.

In the case of *Sports Club plc v Inspector of Taxes*³⁴, the UK tax court decided that the money paid under contracts for the promotion of image rights of

international footballers should be recognized as reflecting their image rights and not as salaries. The possibility for a claim for substantial compensation was recognized when photographs taken of the wedding of Michael Douglas and Catherine Zeta-Jones, were published by 'Hello! Magazine' without their consent. Besides, in a recent decision, award of compensation of £ 3,500 was made under the Data Protection Act to Naomi Campbell for a publication of her photograph in a story about her drug therapy. Finally, the concept of publicity rights was settled in the case of *Irvine v Talksport*.³⁵ In this case a successful Formula I driver, Edmund Irvine's image was used without his consent in an advertisement for a radio station. The court held that he had a property right in the goodwill attached to his image, and he was entitled to compensation on the basis of a reasonable endorsement fee.

Civil Law Jurisdictions

In contrast to common law jurisdictions most civil law jurisdictions have specific statutory provisions to protect an individual's image, personal data and other private information.

In France, personality rights are protected under Article 9 of the French Civil Code. The use of someone's image or personal history has been held actionable under French law. However, publicly known facts and images of public figures are not protected. In Germany, personality rights are protected under the German civil code. The right of privacy of the celebrity is protected under German law.

India

In India, there are neither adequate case laws, nor statute governing celebrity rights *per se*. Thus, the legal system in India, at present, is quite deficient in dealing with the modern phenomena of endorsement advertising. But the market has its own forces and does not wait for the law to accomplish.

The Hon'ble Delhi High Court, in *ICC Development (International) Ltd v Arvee Enterprises*³⁶, gave a statement on publicity rights, which is the only authoritative discussion of publicity rights in Indian legal jurisprudence.

'The right of publicity has evolved from the right of privacy and can inhere only in an individual or in any indicia of an individual's personality like his name, personality trait, signature, voice etc. An individual may acquire the right of publicity by virtue of his association

with an event, sport, movie, etc. Any effort to take away the right of publicity from the individuals, to the organizer /non-human entity of the event would be violative of Articles 19 and 21 of the Constitution of India - No persona can be monopolized. The right of publicity vests in an individual and he alone is entitled to profit from it.'

The image rights in India, as considered by the Delhi High Court, arise from the right of privacy which has emerged through case law development and flows from human dignity enshrined in Articles 19 and 21 of the Constitution. This approach has to be contrasted to the approach of treating publicity rights as commercial property.³⁷

There is a need for a dual approach in India as opposed to the purely constitutional approach of the Delhi High Court. There is an urgent need in India for recognizing property rights in one's personae. The right to property is a creation of law and anything is property so long as law gives the status of property to it. Thus, after the Hon'ble Delhi High Court has recognized publicity rights as an individual right, it rests with the legislature to statutorily recognize the commercial and ownership aspects of publicity rights. The legislature should also adequately balance the public interest and the individual interest of the celebrity. In other words, the legislature while granting the celebrity, the right to publicity should also make adequate exception for freedom of speech expression and other bona fide uses as done by the Copyright Act.

The extent, to which these rights are protected in India, can be understood, in the controversy related to the name of Mahatma Gandhi. Mr Tushar Gandhi, the great grandson of Mahatma Gandhi, intended to grant CMG, a multinational company, exclusive marketing rights to use Mahatma Gandhi's name for advertising their products. But this was considered as blasphemy and an offence as it hurt the sentiments of the people who have great regard for Mahatma Gandhi. In defence, Mr Gandhi justified his action by stating that his intention was 'to secure the name of Mahatma Gandhi and not allow it to be used in an irreverent manner'. His argument was that 'the Indian legal system does not provide effective measures to protect the name and image' of Mahatma Gandhi. He cited a previous situation wherein he was unable to serve summons to Nikki Bedi or to Rupert Murdoch when the gay activist, Ashok Row Kavi had made defamatory statements against Mahatma Gandhi. He

stated that he had entered into the contract with the purpose of protecting the name of Mahatma abroad. The facts, however, were that he had neither copyright on the name nor on the works of the Mahatma. Moreover, the use of the name Mahatma Gandhi is specifically prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950. Mr Gandhi ultimately yielded to public pressure and withdrew the permission given to CMG.

Copyright Act protects the interests of famous personalities by extending moral rights. The important cases that dealt with this issue are *Smt Manu Bhandari v Kala Vikas Pictures Pvt Ltd and another*³⁸ and *Amar Nath Sehgal v Union of India and others*.³⁹ There have been cases wherein the personal lives of prominent personalities formed the scripts of many films. The debatable issue here was, whether celebrities can claim copyright over their own life? Historical facts are not copyrightable *per se*. Two prominent cases on this issue are *Bala Krishnan v R Kanagavel Kamaraj and others*⁴⁰ and *Phoolan Devi v Shekar Kapoor and others*.⁴¹ In the case of *Bala Krishnan*, the dispute was related to copyright over the life history of Mr Kamaraj, who was a well known national leader. The grandson and the legal heir of Kamaraj, protested when a TV serial was proposed to be produced based on the life history of Kamaraj. The producers claimed that no one can hold a copyright over the life history of a national leader. Moreover, they added that the information was already in public domain and it was not necessary to take the consent of legal heirs. The court did not permit any restraint or injunction to stop the release of the film or serial as the reputation of the leader was not at stake. Similarly, in the *Phoolan Devi case*, Phoolan Devi herself protested that the film has distorted facts. She sought an injunction as she had given up her past criminal activities and had started her life afresh as a married woman and as a political figure to serve the public. The court held that the issue needed to be thoroughly examined and the implications of such exhibition on the private life of an individual be scrutinized before permitting the release of such films. Thus, a celebrity can protect his/her name and image as a constitutional right.

Besides, the Trademark Act, 1999, clearly prohibits the use of personal names under Section 14 where an application is made for the registration of a 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 for

registration of the trademark. The registrar may, before proceeding with the application, require the applicant to furnish the consent of such living person or as the case may be, the legal heirs of the deceased person whose name appears in the mark. Besides, certain names like, Sri Sai Baba, Lord Buddha, Sri Ramakrishna, Swami Vivekananda, Sri Sarada Devi, The Sikh Gurus and Lord Venkateshwara cannot be registered under Sections 16(1) of 1940, 23(1) of the Trade and Merchandise Act 1958 and 159(2) of the Trademark Act, 1999. Thus, within a basic framework, celebrities can 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.⁴²

In the case of *Indian Performing Right Society Ltd v Eastern Indian Motion Pictures Association and others*,⁴³ Krishna Iyer J was of the opinion that an artist enjoys copyright in the musical work whereas, the film producer is the master of the combination of artistic pieces. The composer as opposed to the singer gets protection in musical work. He opined that both deserve recognition.

What May be Protected?

Performances

It is highly controversial whether performances of film actors are protected under IP laws in India since performances are not protected under copyright laws. Section 13(4) provides that separate creative components within a film are copyrightable. Whether an actor's on-screen image may be protected and whether there is a need to protect against distortion or dishonour was decided in the case of *Manisha Koirala v Shashilal Nair*.⁴⁴ In *Fortune films v Dev Anand*,⁴⁵ it was said that acting in films does not fall under any category of work. A performer's right is expressly excluded under Section 38(4) by stating that 'once a performer has consented to the incorporation of his performance in a cinematograph film, the provisions of sub-sections (1), (2) and (3) shall have no further application to such performance.' Moral rights are conferred only on authors and the definition of author does not cover a film actor.

Digital Images

The other controversial area in IP protection is whether the author has copyright protection over digitally made graphic or cartoons. If the digital image is of a well known personality, is there a

conflict between author's right in his creation and actor's right in his image? This question remains to be answered.

Digital Merchandising

In this case, a computer generated image, if it qualifies as a mark, can get protection under trademark law merely as a mark.

Conclusion

In India, the exclusive right to authorize public performances and broadcast them does not exist. There is provision, merely, for secondary rights to prevent public performance or broadcasting or recordings made without the performers' consent and to receive equitable remuneration. Thus, though economic rights are available, moral rights do not exist. No protection is given against 'substantial similarity' which is a necessary element in protection of celebrity rights.

It is only through litigation, this growing problem can be disciplined. Award of huge damages and multi-million dollar settlements, may stop infringement or violation by those who have in the past failed to respect the privacy of celebrities and employers. Whereas, the judiciary has repeatedly recognized existence of various aspects of the celebrity rights, it rests with the legislature to statutorily recognize commercial aspects of celebrity rights to fill up the lacunae in law and keep pace with rapid commercialization of celebrity status.

References

- 1 *White v Samsung Elec Am Inc*, 971 F.2d 1395, 1397 (9th Cir 1992), cert denied, 113 S. Ct. 2443 (1993).
- 2 Morgan Piers, The power of celebrity, <http://www.arabianbusiness.com/the-power-of-celebrity-122473.html> (23 January 2010).
- 3 *Martin Luther King Jr Center for Social Change v American Heritage Products Inc*, 694 F.2d 674 (11th Cir 1983).
- 4 Hetherington Lee, Direct commercial exploitation of identity: A new age for the right to publicity, *Columbia-VLA Journal of Law and the Arts*, 17 (1992) 1.
- 5 Banerjee B, Celebrity rights: A legal overview, <http://www.legalserviceindia.com/article/l139-Celebrity-Rights.html> (2 January 2010).
- 6 Datta A, Celebrity rights: A legal overview, <http://www.goforthelaw.com/articles/fromlawstu/article31.htm> (21 January 2010).
- 7 *Tolley v Fry* [1931] AC 333; (1931) 1 All ER Rep 131.
- 8 Louis Brandeis D & Warren Samuel D, The right to privacy, *Harvard Law Review*, 4(5)(1890), http://groups.csail.mit.edu/mac/classes/6.805/articles/privacy/Privacy_brand_warr2.html (11 January 2010).
- 9 *Cohen v Herbal Concepts Inc* (1984) 63 NY.2d 379.
- 10 McCarthy J Thomas, The Spring 1995 Horace S Manges Lecture: The Human Persona as Commercial Property: The Right of Publicity, *Columbia-VLA Journal of Law and the Arts*, 19 (1995) 131.
- 11 Keller Bruce P, Condemned to repeat the past: The reemergence of misappropriation and other common law theories of protection for intellectual property, *Harvard Journal of Law & Technology*, 11 (2) (1998) 401.
- 12 *Midler v Ford Motor Co & others* (1988) 849 F.2d 460 (9th Cir).
- 13 Black Hilary May, The role of trademark law in the protection of celebrity personality, *Media & Arts Law Review*, 7 (2) (2002) 105, 106.
- 14 Titus & C Advocates 2008, India guide: Character merchandising in India, <http://www.asialaw.com/Article/1970665/Channel/16681/India-Guide-Character-merchandiing-in-India.html> (18 January 2010).
- 15 *Star India Private Limited v Leo Burnett India (Pvt) Ltd* (2003) 2 B C R 655.
- 16 *Sim v Heinz & Co Ltd* [1959] 1 WLR 313 1959.
- 17 Prather M, Celebrity copyright law, http://www.ewhow.com/about_6461739_celebrity-copyright-law.html (7 August 2010).
- 18 *Raja Pocket Books v Radha Pocket Books* (1997) (40) DRJ 791.
- 19 Haque Azmul, 2003, India: Face value: Personality rights and celebrity endorsements, <http://www.mondaq.com/article.asp?articleid=22487> (12 October 2010).
- 20 *Mirage Studios v Counter Feat Clothing Co Ltd* (Ninja Turtle Case) [1991] FSR 145.
- 21 *Children's Television Workshop v Woolworths (NSW) Ltd* [1981] RPC 187.
- 22 *Fido Dido Inc v Venture Stores (Retailers) Pty Ltd* (1988) 16 IPR 365.
- 23 *Hogan v Koala Dundee* (1988) 12 IPR 508.
- 24 *Hogan v Pacific Dunlop* (1989) 12 IPR 225.
- 25 *Henderson v Radio Corporation Pvt Ltd* [1969 RPC 218].
- 26 Gibson R S, California and international celebrity and employee invasion of privacy, <http://www.hg.org/article.asp?id=7567> (12 October 2010).
- 27 Hart T, Linda Fazzani & Clark S, *Palgrave Law Masters: Intellectual Property Law*, 4th edn, (Palgrave MacMillan, Hampshire England), 2006, pp. 233-234.
- 28 The Preamble, The WIPO Performances and Phonograms Treaty (WPPT), http://www.wipo.int/export/sites/www/treaties/en/ip/wppt/pdf/trtdocs_wo034.pdf (2 December 2010).
- 29 *Robertson v Rochestor Folding Box* (1902) 171 N.Y. 538; 64 N.E. 442; N.Y. LEXIS 881.
- 30 *Pavesich v New England Life Ins Co* (1905) 50 S.E. 68 (Ga)
- 31 *Haelan Laboratories Inc v Topps Chewing Gum Inc*, (1953) 202 F.2d.866 (2d cir).
- 32 *Krouse v Chrysler Canada Ltd* (1971), 5 C P R (2d) 30.
- 33 *Athans v Canadian Adventure Camps*, (1977), 17 O.R. (2d) 425.
- 34 *Sports Club plc v Inspector of Taxes* [2000] STC (SCD) 443.
- 35 *Irvine v Talksport* [2003] EWCA Civ 423.
- 36 *ICC Development (International) Ltd v Arvee Enterprises* (1077) 433 US 562.
- 37 Pareek A et al., Protection of celebrity rights-The problems and the solutions, *Journal of Intellectual Property Rights*, 11 (6) (2006) 420.

- 38 *Smt Manu Bhandari v Kala Vikas Pictures Pvt Ltd and another* 1986(2) Arb L R 151 (Delhi).
- 39 *Nath Sehgal v Union of India and others* 2002 (2) Raj (Delhi) 248.
- 40 *Bala Krishnan v R Kanagavel Kamaraj and others* (2000) (3) Ar L R 622.
- 41 *Phoolan Devi v Shekar Kapoor and others* (1995) P T C 46.
- 42 Kumari T V, Celebrity rights as a form of merchandise-Protection under the intellectual property regime, *Journal of Intellectual Property Rights*, 9 (2) (2004) 134.
- 43 *Indian Performing Right Society Ltd v Eastern Indian Motion Pictures Association and others*, (1977) AIR, SC 1443.
- 44 *Manisha Koirala v Shashilal Nair* (2003) (1) AIIMR 426.
- 45 *Fortune films v Dev Anand* (1079) AIR, Bom 17.