
"Celebrity Endorsements:- Rights vis-à-vis Legal Implications"

-Sneha Sharma

CHAPTER I. INTRODUCTION

"The celebrity is a person who is known for his well-knownness" – Daniel Boorstein

Marketing today relies heavily on creating and maintaining an 'image'. This is reflected, for example, in the popularity of branded and designer goods, in product endorsement by celebrities, as well as merchandising by football clubs and other sporting concerns. In addition, characters have come to have a value of their own. Associating products with Mickey Mouse, Winnie the Pooh, Shahrukh Khan, Amitabh Bacchan, Aishwarya Rai David Beckham or Tiger Woods ensures sales, as does the use of the WWF's¹ panda². Celebrities like Katrina Kaif, Kareena Kapoor, Sachin Tendulkar, and M.S. Dhoni had made their unique image in the public which plays a major and important role in the marketing business. Consequently, it would seem that the use of an image in association with products now extends beyond indications of responsibility for the manufacture and source of those products to the association that their image may bring. The image itself constitutes a valuable commodity worth preserving from competition.³

Furthermore there is the increasing trend for individuals well known in one sphere to gain financially by 'merchandising' themselves.⁴

Celebrity is sought by many as honour. In a democracy it is normally a reward for success. Sportsmen and artists earn it by skill. Businessmen and TV personalities earn it by wit. Politicians earn it by votes. Anyone can inspire us. It is the public who confer celebrity. The public are stimulated by the media. But in the end celebrity is conveyed by the public's choices as consumers and electors. There is also a type of celebrity which is more or less involuntary. Prince and Princess acquire it by their chance involvement in newsworthy events.⁵

¹ World Wide Fund for Nature.

² Colston Catherine & Galloway Jonathan, Modern Intellectual Property Law, Routledge Publications³rd Edn(2010) pg 734

³ ibid

⁴ Ibid

⁵ Barendt Eric & Firth Alison, The Year Book of Copyright and Media Law, Oxford University Press(2002) pg 3

CHAPTER II. JUSTIFICATION FOR LEGAL PROTECTION

Character merchandising is a known and popular way of doing marketing of goods and services by attaching the products or services with real or fictional characters to attract the customers because of the popularity of such characters among the masses. It is generally constituted of licensing or franchising the names or most importantly the persona of the characters which are used for marketing purposes. It comprises the names, visual and aural likeness, or other indica of real or fictional characters for use on products which the individual has no direct connection.⁶

Some characters are of enduring marketability, MICKEY MOUSE, for example. Others are short lived, tied perhaps, to the character unless it is protected in some way, such as by intellectual property rights or contractual terms.⁷

There should be three main justifications for the right to merchandising or protection of image which are as follows:

- i) Misappropriation of value
- ii) Privacy for personality
- iii) Economic justifications
- i) Misappropriation of value ~ Locke's Theory of Property**

The theoretical literature springs from the proposition that a person who labours upon resources that are either not owned or held in common has a natural property right to the fruits of his or her efforts, and that the State has a duty to respect and enforce that natural right. These ideas, originating in the writings of John Locke, are widely thought to be especially applicable to the field of intellectual property.⁸

The core of Locke's theory of property is presented in Chapter V, "Of Property", in the Second Treatise of Two Treatises of Government:⁹

⁶ Supra note 2 pg 735

⁷ ibid

⁸ Elizabeth Verkey, Law of Patents, (Eastern Book Company Lucknow 1st Edition (2005)

⁹ ibid

“Though the Earth and all inferior Creatures be common to all Men, yet every Man has a Property in his own Person. This no Body has any Right to but himself. The Labour of his Body, and the Work of his hands, we may say, are properly his. Whatsoever then he removes out of the State that Nature hath provided, and left it in, he hath mixed his Labour with, and joined to it something that is his own, and thereby makes it his Property. It being by him removed from the common state Nature placed it in, hath by this labour something annexed to it, that excludes the common right of other Men. For this Labour being the unquestionable Property of the Labourer, no Man but he can have a right to what that is once joined to, at least where there is enough, and as good left in common for others.”¹⁰

The raw material is deemed to be held in common and the labour contributes to the value of finished products. The labour theory of property holds that a person’s productive work is the basis for a property claim. People are entitled to claim what they make or create as their own. The mere act of discovery does not establish a property claim, but the appropriation of the discovered good to some further purpose does imply some element of labour. There are many difficulties in applying the general theories to intellectual property. This is true in the efforts to apply labour theory to intellectual property. An answer to the problem is found in the Second Treatise.¹¹ Locke states that intuitions regarding self-ownership point in the direction of appropriating the fruits of one’s labour. Each person plainly has a property in his own person, including the labour of his body, and the work of his hands. It seems only natural that whatever he mixes that labour with should belong to him as well. Most of the value of the things useful to men derives not from the value of the raw materials from which they are made, but from the labour expended on them. As the crux of the matter, the Second Treatise would seem to provide strong support for most forms of intellectual property. According to this view, intellectual property permits to reward the creator for his work in order to encourage him in his innovative work, he will be more inspired to produce and more willing to make his work available to the

¹⁰ Elizabeth Verkey, Law of Patents, (Eastern Book Company Lucknow 1st Edition (2005)

¹¹ *ibid*

public. This establishes a labour criterion of property, whereby individuals may claim property in all goods they appropriate from the state of nature through the work of their hands.¹²

The labour theory has a seam with regard to intellectual property. While the intellectual labourer is as entitled to own the immediate fruits of his or her labour as any other, this entitlement does not establish the terms on which publication will take place. In a totally laissez-faire system, such terms would presumably be negotiated between the intellectual labourer and others desiring the intellectual good. Locke tells us that in the state of nature there is no positive law parceling out ownership or giving any particular person that right to command anyone else. There are, however, moral duties that constrain persons' behavior towards each other. All persons have a duty not to harm others, except in some cases of extreme need. All individuals have many rights. Some we possess by virtue of what we do, and some we possess by virtue of our humanity.

The essential logic of Locke's property theory is: Labour is mine and when I appropriate objects from the common I join my labour to them. If you take the objects I have gathered you have also taken my labour, since I have attached my labor to the objects in question. This harms me, and you should not harm me. You therefore have a duty to leave these objects alone. Therefore I have property in the objects.

The concept of celebrity images or characters value easily fits into the Lockean moral and political schema that maintains that an individual's right to his property is grounded in the labour that begets property itself.¹³ However, this is to ignore both the extent to which celebrity image enters the cultural public domain, and the commercial benefit already secured by celebrities from their activities.¹⁴

ii) Privacy for personality ~ Hegelian Philosophy

¹²supra note 8

¹³Elizabeth Verkey, Law of Patents, (Eastern Book Company Lucknow 1st Edition (2005)

¹⁴Supra note 2 at pg 736

The premise of the Hegelian approach, derived from the writings of Kant and Hegel, is that private property rights are crucial to the satisfaction of some fundamental human needs.¹⁵

Intellectual property rights may be, justified on the ground that they create social and economic conditions, conducive to creative intellectual activity, which in turn is important to human flourishing.¹⁶ Human rights law recognizes a right to privacy for individual Weber also rests justification for publicity rights (as well as a right to privacy) on a natural right to human dignity.¹⁷

iii) Economic justifications ~ Incentive theory

The economic justifications lie in the incentive to creativity that a publicity right would provide more efficient allocation of the resource that celebrity provides, and the prevention of consumer misinformation. However, it is unlikely that the creation of a publicity right would stimulate the generation of celebrity, which is a by-product of other activity. Alone, it would only extend to protection against false endorsements.¹⁸

There can be no denying that merchandising of image yields substantial financial benefits but this does not automatically imply that protection granting property is desirable. To impose an If a celebrity cannot fully exploit his/her name, image, and likeness, the celebrity will lack the incentive to create a valuable persona. In *Zacchini v. Scripps-Howard Broadcasting Co.*,¹⁹ the Supreme Court held it was proper to give Zacchini protection "to protect the entertainer's incentive in order to encourage the production of this type of work. Courts have equated this incentive to the one referred clause of the US Constitution which says that copyrights will be granted to "promote the progress of science and useful arts."²⁰

¹⁵ Fisher William, *Theories of Intellectual Property*, from: Stephen Munzer, ed., *New Essays in the Legal and Political Theory of Property*(Cambridge University Press, 2001), 168-199

¹⁶Supra nbote 6

¹⁷ Catherin Colston e & Jonathan Galloway, *Modern Intellectual Property Law*, Routledge Publications, 3rd Edition (2010)

¹⁸.
ibid

¹⁹ 433U.S. at 576

²⁰ US Const. Art I S.8 cl.8

CHAPTER III. CELEBRITY ENDORSEMENTS: Merchandising Practice

It is another type of merchandising which has received judicial scrutiny in the context of passing off is where the name of an organization or famous person is used to endorse a product. If the organization or person has not agreed to the use of their name, this may amount to passing off. Untill recently, the cases revealed the possibility of two different outcomes, depending on whether the name in question was that of a professional body or a commercial organization on the one hand or an individual on the other.

A right of publicity is a form of 'merchandising right'. A merchandising right is an exclusive right over the use of the image of a famous person or fictional character, or famous club or event or institution, or some other 'object', to promote the sale of a product by associating it with the object. A typical example is the use of the name or picture of the famous person on T-shirts or mugs or toiletries. It is open to argument whether the use of the name or picture in a newspaper amounts to merchandising, even where the news content is minimal; but if the right does apply in the type of case it presumably applies a fortiori to ordinary merchandising.²¹

This type of merchandising is divided into categories which are as follows: - i) Celebrity merchandising ii) Image Merchandising

3.1 CELEBRITY MERCHANDISING: - In this category the real persons are involved. Their images, appearances, voice, signature style of doing some act are used in the commercial place for revenue generation. Famous personalities from different sections of the societies which mainly comprises of film stars, singers, sports person, businessmen, politicians, comedians, actors and actresses of television daily soaps etc. Each one of them has their USP (Unique selling point) because of which they are famous among the masses, and because of which consumers/public get attracted to the products and services for which they endorsed and advertised. They enjoy great popularity and have gained reputation in their respective fields. The special features of such personalities have an image among people and due to this image there is

²¹ Supra note 2 pg 24

commercial success in the market place for the products and services which they get associated with. And thus this type of merchandising can be termed as "Celebrity" or "Reputation" merchandising.

Now the question is why endorsement done by "Reputed" people / Celebrities holds such a strong impact on the minds of the consumers. The reason is that first their popularity among the masses and secondly when they endorse any brands or products , or being a brand ambassador of any range of goods and services, the common people get fascinated by the lifestyle of such celebrities and think that his/ her favorite celebrity is endorsing any product they might be using it too .And thus the celebrity's status and their involvement with any goods or services leave a impression on the minds of the public that they are using it in their personal lives also. For example there is a brand called "SACH" by Sachin Tendulkar, starting from apparels to liquid hand wash, this brand has gained so much popularism among consumers that people tend to buy these SACH products as it is associated with everyone's favorite cricketer Sachin Tendulkar.

3.2 IMAGE MERCHANDISING: - Here there is a dual role played by celebrities. As for example the different roles/characters played and portrayed by the celebrities in any movies, theatres or television daily soaps. Where the public are attracted and influenced by the character of such drama or films. Our very famous Shahrukh Khan is famous for playing the character of lover boy 'Raj' which is liked by the public. In the same was the legendary actor Amitabh Bacchan has given plentiful of good movies and his famous film DON, the character played by him is famous among masses. In the case of daily soaps characters like Tulsi played by Smriti Irani, Ram Kapoor played by Ram Kapoor in Bade acche lagte hai, Anandi of Balika Vadhu and many more. So here the actors and actresses enjoy dual popularity and respect, one because of the characters they are playing in the reel world and second because of their own personality in real world. In the International arena the characters like Harry Potter played by Daniel Radcliffe, Hannah Montana played by Miley Cyrus has received huge fan following. This has automatically leads to the commercial gain of the products and services which get associated with them.

A right against intrusive public exposure of private matter is concerned with protecting the claimant against a form of personal harm (as is a right against adverse portrayal). The

merchandising right is not designed to protect against harm, but to secure to the claimants all the profits to be made by the commercial exploitation of fame. Thus whereas the right against intrusion is justified in terms of protection from harm, the merchandising right must be justified analogously to intellectual property rights, in terms of some right of the celebrity to the financial benefit of his/her fame. One might argue that it is desirable for there to be famous people and that merchandising rights provide an incentive to become famous, or that fame is a valuable commodity that should in the public interest be exploited efficiently, and that this will be best achieved if the famous person has full control over the use of his image. One might simply argue that the celebrity has created his fame and this is sufficient to justify giving him all the financial benefits of it.²²

The Right of Publicity: Protecting the Associative Value of Persona

It is generally understood that the right of publicity began in 1953 with a brief opinion by Judge Jerome Frank of the US Courts of Appeal in *Haelan Laboratories, Inc v. Topps Chewing Gum Inc*²³, holding that a celebrity has a right to damages and other relief for the unauthorized commercial appropriation of his or her persona, and that such right is independent of any common law or a statutory right of privacy.²⁴

In *Haelan Laboratories* case, a professional baseball player had granted to the plaintiff, a seller of bubble gum, the exclusive right to use and distribute his image on cards accompanying the bubble gum. Baseball cards, with pictures and statistics about baseball players, were very popular and bubble gum purveyors competed for the rights. In this case, however, after granting the exclusive right to the plaintiff, the player granted to the defendant, a competitor of the plaintiff, a right to use his image.²⁵ Apart from breach of contract claims that the plaintiff may have had against the player, he plaintiff sought to enforce its exclusive rights, as the player's assignee, against the defendant. New York, whose law was applicable to the case, had a statute

²² Supra note 2 pg 26

²³ 346 US 816(1953)

²⁴ Sheldon Halpren W., *Publicity Rights, Trademark Rights, and Property Rights, Overlapping Intellectual Property Rights*, Oxford (Indian Edn 2013)²⁵ *ibid*

specifically recognizing a right to privacy, creating a claim by an individual against one who uses the individual's 'name, portrait of picture', without consent, for advertising purposes for the purpose of trade.²⁶

CHAPTER IV. LEGISLATIVE FRAMEWORK: INDIAN SCENARIO

4.1 INDIAN TRADEMARK ACT

Indian Trademark Act is also one of the most acclaimed statute for adjudicating Character Merchandising related conflicts although not addressing the issue directly. The provisions are broad and extensive in their application and easier to interpret and apply to such kind of disputes. While Section 2(zb) defines the types of mark which can be treated as trade names²⁷, provided such marks should be distinctive in nature and not describing the quality or type of goods or services. As per section 102 and 103 of the Act, falsifying a registered trademark or falsely applying a registered trademark on goods and services without the approval of the owner or registered proprietor is a punishable offence. In case a person willing to apply a registered trademark in relation to his goods or service it has to take prior permission from the registered proprietor of the trademark or become a registered user of the mark under the act. Not only that the trademark act, 1999 also provides protection for the unregistered trademarks. In case of an unregistered mark being used by a third party without prior authorization from the proprietor or the owner they also have a right of bringing an action for passing off under the Common law against the unauthorized user. But in order to get an action of passing off it is necessary to prove that the mark had a goodwill in the market or is a well known mark and due to the misappropriation of the plaintiffs mark by the defendant it resulted in loss of trade or damage to the good will of the plaintiff as well as its goods or service.

²⁶ New York Civil Rights Law, 50, 51

²⁷ Section 2(zb) of Indian Trademark Act, 1999; Marks such as names, signature, word, device, letter, shape of goods, packaging or combination of colours are capable of being registered as trademarks.

Even though Indian Trademark act has got wider provisions but it does not has a definite law to protect commercial exploitation of fictional characters and likeness of celebrities and producers. For which the only way out is to resort to passing off action for protection of the names and likeness of their famous characters. But the good part being the Indian Courts have recognized the rights of the owner of character in the reputation and goodwill enjoyed by the character, provided that the popularity of a given character has grown beyond the programme or series to which the character is associated²⁸. Therefore even where a character or a celebrity's name or likeness are not registered as trademarks, the courts have recognised their proprietary value on the basis of likeness and granted remedies for passing off.

In spite of the legal provisions neither the trademark law nor copyright regime provides an overall protection of the personality and image right of the character. Though the registered names of the characters may be sought to be protected, as noted above, under the provisions prescribed to protect "well known marks," the whole process shall involve many legal hurdles needed to be crossed. The provision is not providing for a per se protection to such names as the protection shall be available only when such proprietor or user will be able to establish that the name is a well known mark. Further, the provision does not provide for any remedy against unauthorized use of the image or other personality attributes of any character or celebrity for the endorsement purposes. This situation furthers the need to recognize the right of publicity in India.²⁹

Under the Indian trade mark law, the unauthorized use of any registered name by another person for promoting his goods or services, which may not have any relation to goods or services in respect of which the trademark is registered shall amount to an infringement. While the names of a character or any famous personality can be registered as a word mark, the images attached to the character can be protected by registering them as device marks and the commercial value of the same can be protected exclusively. In order to establish an infringement the registered proprietor initially has to show that its trademark or registered name has got a reputation in India

²⁸ Star India Private Limited v. Leo Burnett (India) Private Limited; 2003(27)PTC 81 Bom, para 13

²⁹ Kewalramani Nishant, Character Merchandising, JIPR Vol 17 (Sep 2012) available at <http://nopr.niscair.res.in/bitstream/123456789/14770/3/JIPR%2017%285%29%20454-462.pdf> last visited on 4/27/2015 at 1.24 AM

and the mark or the character involved is being used without prior permission in order to take undue advantage of the good will the character has got in the market for sale or promotion of their products or services or is detrimental to the distinctive character or reputation of the registered mark. Section 29 of the Trademark Act-1999 lays down the aspects of infringement of trademark. it elucidates that a when a person is using , in course of trade any mark, which is identical or deceptively similar to a registered mark and which he is not entitled or licensed to use shall be deemed to infringe onto the rights of the person who has the lawful right over the mark.

Individuals may apply for the protection of their name, likeness and nicknames, among other things with the Indian Trademarks Registry in order to obtain statutory protection against its misuse. Certain celebrities like Shahrukh Khan, Kajol, Mallika Sherawat, AR Rehman, etc have obtained registration of their names in several classes with the Trademarks Registry. [Section 14] TMA 1999

In the absence of statutory protection, an individual may also resort to an action for passing off in order to protect his/her publicity and image rights. However, an action for passing off requires proof of:

The reputation of the individual;

Some form of misrepresentation; and

Irreparable damage to the individual.³⁰

4.2 INDIAN COPYRIGHT ACT

Copyright Protection is very limited in this area. There is no copyright in the name or image of celebrity. Similarly there is no copyright in voice, likeness or other identifiers . However, the Indian Copyright Act,1957 provides a fair degree of protection in respect of sketches, drawings, and so on, falling into the category of artistic work. Section 14 of the Act provides the exclusive right to authorize others to reproduce the work in any form, including conversion of a two-

³⁰ Reckitt & Coleman Products Ltd v Borden Inc , [1990] 1 All E.R. 873

dimensional work to three-dimensional work and vice-versa.³¹ This may be possible in cases where merchandise like toys & T-shirts are made based on artistic work. Section 2(d)(v) of the Copyright Act clearly identifies the producer as the author of the cinematographic film while section 14(d) of the Act provides that the owner of a cinematographic film has the exclusive right to make a copy of the film including a photograph of any image forming a part of such cinematographic film. Further, sealing the fate of performers, section 38(4) of the Act provides that once a performer has consented to the incorporation of his performance in a cinematographic film, the performer's right doesn't subsist in that performance any more. A cumulative reading of these provisions indicates that once a performance becomes a part of a cinematographic film, the performer's rights cease to exist and only the producer has the right over the cinematographic film and any images incorporated therein including the right to exploit these images in the form of merchandising.³²

Indian copyright act, amended 2012 has been the lone warrior supporting the cause of the producers and performers³³ to an extent. Section 2(d)(v) of the Copyright Act clearly states the producers as the author of the cinematographic film³⁴, whereas Section 14(d) of the Act gives exclusive right to the producer of the film to make a copy of the film including photography³⁵.

4.3 PROTECTION UNDER ADVERTISING LEGISLATION

All advertisements are governed by the Code for Self-regulation in Advertising ("Code"), which was adopted by the **Advertising Standards Council of India**. 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

³¹ Ibid

³² Kewalramani Nishant, Character Merchandising, JIPR Vol 17 (Sep 2012) available at <http://nopr.niscair.res.in/bitstream/123456789/14770/3/JIPR%2017%285%29%20454-462.pdf> last visited on 4/27/2015 at 1.24 AM

³³ Section 2(qq) of the Copyright amended act, 2012

³⁴ Section 2(d)(v) of the Copyright amended act, 2012

³⁵ Section 14(d) of the Copyright amended act, 2012

advertising agency shall produce explicit permission from the person, firm or institution to which reference is made in the advertisement.

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

4.4 THE CONSTITUTION OF INDIA

Article 21 of the Constitution of India talks about the fundamental right to life and personal liberty, the jurisprudence on publicity and image rights is in its nascent stages in India. The judiciary is yet to recognize the right of publicity and the right of image as distinct legal rights. In *ICC Development (International) Ltd v Arvee Enterprises* ((CS) OS 1710/2002), the Delhi High Court held that the right of publicity does not extend to events and is confined to persons. The court thus recognized the existence of their right in principle.

RIGHT TO PRIVACY

In **R. Rajagopal v. State of Tamil Nadu**, S C 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. 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 damages³⁶

In 2003 the Delhi high court in its pronouncement had clearly stated that the right to publicity of a celebrity has evolved from the right to privacy which is enshrined under Article 21 of the Indian Constitution. The court's intention in such pronouncement was the right of publicity has evolved from the right of privacy and can inhere only in an individual or in any of his/her personality traits like name, signature, voice and style it possess. Such individual may acquire the right of publicity by virtue of his association with an event, sport, movie etc, but that right

³⁶ Ahmad Tabrez, *Celebrity Rights, Protection under IP Laws*, JIPR, Vol 16(Jan 2011) available at [nopr.niscair.res.in/bitstream/123456789/.../JIPR%2016\(1\)%207-16.pdf](http://nopr.niscair.res.in/bitstream/123456789/.../JIPR%2016(1)%207-16.pdf) last visited on 5/3/2014 at 6.13 pm

³⁷ when taken away by the organizer (non-human entity) of the event would result in violation of Article 19 and 21 of the Constitution of India. No persona can be monopolized. The right to publicity should always vest in an individual and he alone is entitled to profit from it. For example if any entity was to use Sharukh Khan or Salman Khan's name/persona in connection with promoting any brand or product without their authorization they would have a valid and enforceable cause of action. The Indian constitution absolutely knowingly or unknowingly protects the interest of the producers and copyright owners of the entertainment world and its work.

CHAPTER V . JUDICIAL TRENDS

In the area of Celebrity rights, Indian Judiciary is playing a pivotal role which deserves a special mention. The following cases are noteworthy from the Indian context.

SOURAV GANGULY VS. TATA TEA LTD.³⁸,

Sourav Ganguly had returned from an extremely successful tour of England and found that Tata Tea Ltd. was promoting its tea packet by offering the consumers a chance to congratulate Sourav through a postcard which was inside each packet. The company intended to profit from his popularity and his latest success. Sourav could successfully challenge it in the Court before settling the dispute amicably.

DM ENTERTAINMENT PVT LTD V. BABY GIFT HOUSE³⁹

“..The defendant was into the business of selling dolls bearing singer Daler Mehndi's voice and likeness, therefore cashing in on his popularity. Aggrieved by the Defendant's unlawful act, the Plaintiff filed for a permanent injunction in order to restrain the Defendant from infringing Daler

³⁷ Ahmad Tabrez, Celebrity Rights, Protection under IP Laws, JIPR, Vol 16(Jan 2011) available at [nopr.niscair.res.in/bitstream/123456789/.../JIPR%2016\(1\)%207-16.pdf](http://nopr.niscair.res.in/bitstream/123456789/.../JIPR%2016(1)%207-16.pdf) last viited on 5/3/2015 at 6.12 pm

³⁸ Calcutta High Court C.S. No. 361 of 1997

³⁹ CS(OS) No. 893 of 2002

Mehndi's right of publicity and the false endorsement or misrepresentation leading to passing off action. The use of Mehndi's persona to capitalise in defendant's 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 the false belief either that the Plaintiff had granted license for such usage or that the Defendant was associated with Mehndi who allowed the Defendant to use his exclusive right to market the images of the artiste. The court granted the Plaintiff a permanent injunction against the Defendant and also directed damages in favor of the Plaintiff."

TITAN INDUSTRIES LIMITED VS. RAMKUMAR JEWELLERS⁴⁰

"the plaintiff had asked celebrity couple Amitabh Bachchan and Jaya Bachchan to endorse and advertise its range of diamond jewelry 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 jeweler 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 authorized to do so by the plaintiff, the court held that the defendants are liable not only for infringement of the plaintiff's copyright in the advertisement, but also for misappropriation of the couple's personality rights. The Delhi High court thereby granted an interim injunction in favour of the plaintiff while specifically distinguishing the couple's rights in their personalities".

Star India Private Limited v. Leo Burnett (India) Private Limited⁴¹

Star India Pvt. Ltd. (plaintiff) is doing business of acquiring copyrights in cinematograph films, television serials, programs, and also producing and commissioning the production of television

⁴⁰ CS(OS) 2662 of 2011

⁴¹ 2003 (27) PTC 81 Bom

programmers for various television channels. These programs enjoy tremendous popularity amongst viewers in India and abroad. Star India Pvt. Ltd. also had acquired copyright of famous T.V. serial produced by Balaji Telefilms Pvt. Ltd., named, "KUNKI SAAS BHI KABHI BAHU THI" to create, compose and produce 262 episodes of it and became exclusive owners of the copyright in that serial. The serial had acquired immense goodwill and reputation among viewers

in India that they associated the said serial exclusively with Star India Pvt. Ltd. It was contended by the plaintiff that when they saw a Television commercial for merchandizing of Consumer product called, "Tide Detergent" they were surprised to see that the T.V. Commercial was very much similar to their serial. On enquiring it was found that one P&G group of companies (defendant no.2) involved in production of Tide together with an advertising agency(defendant no. 1) has infringed the plaintiffs' copyright in the above said T.V. serial and artistic work and are guilty of the same as the defendant's commercial for promotion and merchandising of tide, is a copy of the plaintiff's T.V. serial, therefore they are liable for continuous act of infringement and violation of their copyright in their famous serial KUNKI SAAS BHI KABHI BAHU THI.

In deciding the issue of character merchandizing, the Honourable court has held that character merchandizing involves the exploitation of fictional characters or the frames of celebrities by licensing such famous fictional characters to others means when the character has developed commodity value of itself, and there is no alike situation present here. Neither of the characters in the serial has become a commodity in its own right, independently of the film/serial. They represent the common people in the serial. There is also nothing to show that the characters Tulsi, Savita or J.D. are capable of marketable independently or jointly. Therefore this issue is also not maintainable⁴².

Sholay Media & Entertainment Pvt Ltd v Parag M Sanghavi⁴³

⁴² 2003 (27) PTC 81, Bom, para 13

⁴³ (unreported, CS (OS) 1892/2006),

Revolved around the proposed remake of well-known Bollywood film Sholay by a reputed Indian director, set a precedent in Indian entertainment law. The suit involved the issues of whether: trademark protection could be granted to the title of a film and the names of its characters; and copyright protection could be afforded to the construction of characters.

The Delhi High Court issued an ex parte injunction to restrain the defendants from infringing the plaintiff's rights and recognised rights in the title of the film and the names and construction of its characters. The terms of the order were confirmed after a series of hearings and the defendant gave an undertaking that it would not infringe the plaintiff's rights.

SAHARA ONE MEDIA AND ENTERTAINMENT & ORS VS SAMPAT PAL & ORS⁴⁴

Plaintiff Sampat Pal had filed a suit for permanent injunction and damages at Delhi HC wherein she claimed that she is a social activist and runs an organization in the name and style of "**Gulabi Gang**". The suit was filed to restrain Sahara One Media & Entertainment & Ors for releasing the film "Gulaab Gang" which she claimed was an adaption of her life story into a movie. She claimed that the portrayal of the characters in the film defamed her and degraded her along with the others members of the organization. She further alleged that the film defames her and portrays her work in bad light and in a horrific manner with swords and sickles. The Single bench of the Delhi High Court passed an order restraining the film's release until the next date of hearing from broadcasting, distributing and promoting the film "Gulaab Gang" in its censored or uncensored prints.

Thereafter the Producers i.e. Sahara One Media & Entertainment & Ors appealed before the Division Bench of the Delhi High Court. The Division Bench of the Delhi High Court allowed the release of the film with a condition in the Disclaimer that Sahara Media and Entertainment can show the film by stating that he has nothing whatsoever to do with the life and works of Sampat Lal and her organization

SONU NIGAM VS AMRIK SINGH (ALIAS MIKA SINGH)⁴⁵

⁴⁴ Suit no.372 of 2013

⁴⁵ Suit no.372 of 2013

The parties to the case were to appear at the Mirchi Awards 2013, and were shown through photographs on the official posters of the event, with their due consent. Mika Singh, in order to promote himself displayed hoardings and posters, which were different from official hoardings and posters of the event, carrying huge pictures of himself along with smaller pictures of the other artists, including Sonu Nigam, without their consent and permission. It was stated that the said hoardings and posters gave an unjustified and incorrect impression to the public about the prominence given to Mika Singh as compared to the other artists. The Bombay High Court restrained the defendant from displaying the pictures of the Plaintiff without his consent and ordered the defendant to pay Rs. 10 Lakhs as damages towards specified charities, as consented by the parties.

SHIVAJI RAO GAIKWAD VS. VARSHA PRODUCTIONS⁴⁶ (MAIN HOON RAJNIKATH)

Superstar Rajnikanth filed a suit seeking injunction restraining the respondent from using the applicant's name/caricature/ style of dialogue delivering etc. in its forthcoming film "Main Hoon Rajnikanth" in any manner whatsoever alleging infiltration of his personality rights by such unauthorized use. Rajnikanth also expressed distress that the film had scenes of immoral nature and the respondent was trying to cash in on his popularity. The court observed that it cannot be disputed that intellectual property right is a recognized valuable right under the modern laws being followed by all civilized countries. Copyright Act, Trade Marks Act, etc are properly safeguarding the rights, by way of relevant statutes. As per Article 21 of the Constitution, everyone is entitled, not only for his life and personal liberty from taking away the said rights, except by procedure established by law, but also guaranteed to lead a dignified life in the human society and hence, no one can cause damage to the fame or reputation of any person against law. From the available materials of the film, the Court held that the film's title and caricature of Rajnikanth in the film would degrade his reputation. The Court was of the view that there was a prima facie case made out and the balance of convenience was also in favour of Rajnikanth. Accordingly, interim injunction was granted

⁴⁶ [Suit no.372 of 2013]

CHAPTER VI: CONCLUSION & SUGGESTIONS

Character merchandising in spite of being a commercial phenomenon given the sort of business advantage it entails, at the same time the legal aspect has been lacking on fast paced business practice. Numerous instances have been taking place in regard to the same where a celebrity in India has been aggrieved by the unauthorized use of his or her name, fame, voice, persona, brand or any other distinct personal trait. Even though advertisement primarily focuses on modern technology but still India being a consumer driven market the best way to create a strong emotional bond with the consumer has been through celebrity endorsement through advertisement, no matter how strong the promotional gimmicks are. With 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.

With the increase in number of exorbitant endorsement deals being signed up by famous personalities and the tremendous value attached to such brand endorsement it has been the need of the hour to address such multi-dimensional concept of personality rights in India. Looking at the significance it holds in making the product well known in the market due to the commercial value of a personality involved, then an unauthorized access of such personality right should be sued for such embezzlement. As a result, it is becoming legitimate to determine the personality right in India. The provisions of the Trade Mark Act may be amended to accommodate the right of publicity within its ambit. "The scope of the definition of "Trade mark," as defined under s.2 (zb) may be widened in such a manner as to include, such marks capable of distinguishing the assignable rights vested in a person or a character owing to the reputation attached to it."

In November 2012, the Guernsey (Bailiwick of Guernsey), a British Crown Dependency created history by becoming the first jurisdiction to enact 'Image Rights' (IR) legislation with a very wide scope that recognized the rights of the celebrity to his personality and publicity. While the position under Indian law pertaining to image rights is still in an evolutionary phase, in the wake of the changing global environment, it is only a matter of time before a similar legislation will be enacted in India as well.

With the increase in number of exorbitant endorsement deals being signed up by famous personalities and the tremendous value attached to such brand endorsement it has been the

need of the hour to address such multi-dimensional concept of personality rights in India. Looking at the significance it holds in making the product well known in the market due to the commercial value of a personality involved, then an unauthorized access of such personality right should be sued for such embezzlement. As a result, it is becoming legitimate to determine the personality right in India. Character merchandising even though a unique concept but not a new one as several jurisdictions, such as the United States and the United Kingdom have already started exonerating the personality rights of its celebrities. India considering it as a alarm /wakeup call should also push further its judicial and legislative recognition of this concept in order to develop a holistic approach to address such concern. India has left no stones unturned to come up with a strong & effective legal provision with judicial precedents for strengthening "Character Merchandising"