

Ranjan Narula Associates

# When your face is your fortune

With a thriving film industry in India, the expectation would be that publicity and image rights laws are firmly established. But is this the reality?

The Indian film industry – popularly known as ‘Bollywood’ – is the largest in the world in terms of ticket sales and annual output. Given their high turnover and the growing fan base of Bollywood stars, it is perhaps surprising that there is no codified law that expressly recognises a celebrity’s right to exercise control over the commercial use of his or her name, image, likeness or other distinctive features, such as voice, signature, nickname and sobriquet.

The process of publicising movies also gives rise to image rights, in the form of a celebrity’s proprietary rights in and to his or her personality. These are commonly understood to be personal attributes, such as physical or stylistic characteristics, name, photographs and other personal representations.

Recognising an individual’s publicity rights is important in order to secure a personal form of IP right, which can provide a source of revenue. This is generally understood to be justified as a reward or incentive for the celebrity’s work in creating the intellectual property. This right is assignable and licensable for commercial gain.

Generally, publicity and image rights are analogous to celebrity. They generate economic value – be it news stories and gossip items about celebrities’ personal and professional lives, or the lucrative market for celebrity merchandise and endorsements. The popularity of a sporting or film personality is inevitably fleeting. Therefore, any misappropriation of intellectual property should result in strong and immediate action. However, such actions remain uncommon in India. A number of factors are responsible for this:

- a lack of codified law or guidelines;
- a huge backlog of cases before the courts; and

- a lack of financial deterrents in terms of costs and damages awarded for misuse of such rights.

Thus, the Indian legal system is as yet not well developed enough to deal with the modern phenomenon of publicity and image rights. Further, the increasing use of the Internet for communication and advertising means that any misuse can proliferate quickly. Consequently, there is a need for stronger and speedier mechanisms to address these issues.

## Legal scenario

Image rights in India arise from the right to privacy and stem from the notion of human dignity as enshrined in Articles 19 and 21 of the Constitution. This approach may be contrasted to that of treating publicity rights as commercial property.

Publicity rights in the form of the right to privacy were first recognised explicitly by the Supreme Court in *RR Raja Gopal v State of Tamil Nadu* (JT 1994 (6) SC 514). In that case, the court opined that: “The first aspect of this right must be said to have been violated where, for example, a person’s name or likeness is used, without his consent, for advertising – or non-advertising – purposes or for any other matter.”

Publicity rights are reserved for persons, not events; this was clarified for the first time by the Delhi High Court in *ICC Development (International) Ltd v Arvee Enterprises* (2003 (26) PTC 245 Del) within the context of the misuse of the Cricket World Cup event name by advertisers that were not registered as official sponsors.

## Trademarks Act provisions

No specific provision in Indian trademark law protects publicity and image rights,

although the definition of ‘mark’ in Section 2(m) of the Trademarks Act 1999 does include names. In the absence of any statute to protect publicity and image rights, a well-known individual whose rights could potentially be misused may resort to a passing-off action in order to protect his or her publicity and image rights. However, a passing-off action requires proof of the individual’s reputation, some form of misrepresentation and irreparable damage to the individual.

A passing-off action may be brought for any unauthorised exploitation of a person’s publicity and image rights, including goodwill or fame, by falsely indicating an individual’s endorsement of products or services. This issue is generally at the crux of most actions that have come up before the courts, as discussed below.

Celebrities can also invoke Section 14 of the Trademarks Act in order to protect unauthorised use of their personal name. Section 14 prohibits registration of a mark that falsely suggests a connection with a living person or a person whose death took place within 20 years of the application date for registration of the trademark. No specific case has been brought on this issue; however, in the *Montblanc* case discussed below, one of the defences put forward was that the company had sought permission from Mahatma Gandhi’s great-grandson to use his name.

## Case law

In *DM Entertainment v Jhaveri* (1147/2001) Daler Mehndi, a famous Indian singer, composer and performer, brought an action against a party that had registered the domain name ‘dalmehndi.net’. The Delhi High Court prohibited the defendant from using the mark and domain name, thus recognising the fact that an entertainer’s name may have trademark significance.

Another case involving famous Indian industrialist Ratan Tata, chairman of the Tata Group, concerned registration of 'Tata' as a domain name (*Tata Sons Ltd v Ramadasoft* (D2000-1713, February 8 2001)). The domains were transferred as an arbitral panel ruled in the plaintiff's favour.

In another case before the Calcutta High Court (*Sourav Ganguly v Tata Tea Ltd*), Sourav Ganguly, a popular cricketer and former captain of the national team, discovered that a well-known brand of tea was cashing in on his success by offering consumers a chance to meet and congratulate the cricketer. The offer implied that the cricketer was associated with the promotion, which was not the case. Ganguly successfully challenged the case in court before settling the dispute amicably.

In 2009 Montblanc released luxury, special-edition pens in India entitled 'Mahatma Gandhi Limited Edition 241' and 'Mahatma Gandhi Limited Edition 3000', which were engraved with Gandhi's portrait on the nib. Tushar Gandhi (Gandhi's great grandson) had given his permission and approval to their release. However, the launch of the pens met opposition under the Emblems and Names (Prevention of Improper Use) Act 1950, which prohibits the use of names and images of nationally important personalities for any trade, business or professional purpose, unless permitted by the government. Consequently, Montblanc was forced to withdraw its advertising campaign and the pens in question from the market.

In *Jaitley v Network Solutions Private Limited* ([181(2011)DLT716]) the Delhi High Court upheld the rights of politician Arun Jaitley in the domain name 'arunjaitely.com'. Jaitley argued that he wanted to register the domain name himself. It was alleged that after the domain name had expired, the defendants had not deleted it or transferred it to the plaintiff, but rather transferred it to a domain name auction site. An interim injunction order granted by the court restrained the transfer, alienation or offer for sale of the domain name 'arunjaitely.com' to any third party and the creation of any third-party interest therein.

In *Titan Industries Limited v Ramkumar Jewellers* ([CS(OS) 2662 of 2011]) the plaintiff engaged noted Indian film actors Amitabh Bachchan and Jaya Bachchan to endorse its range of diamond jewellery sold and marketed under the brand name Tanishq. The couple had assigned all of their personality rights to the plaintiff to be used in advertisements in all media, including print and video. The



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plaintiff had invested huge sums of money in the promotional campaign. The defendant was found to have erected a hoarding identical to that of the plaintiff, featuring the same photograph of the celebrity couple as displayed on the plaintiff's billboard. As 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 the defendant 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 granted an interim injunction in the plaintiff's favour.

### Copyright Act provisions

The Copyright Act 1957 does not define the concept, ambit or scope of publicity and image rights pertaining to an individual. However, the definition of 'performer' in Section 2(qq) – which includes an actor, singer, musician, dancer, acrobat, juggler, snake charmer, lecturer or any person who gives a performance – is important in this context. There is little clarity as to what aspects of an individual's publicity and image rights may be protected under copyright law. Although the Copyright Act protects specific images (eg, photographs, paintings or other derivative works), in order to pursue an infringement action, an individual must prove ownership of copyright in the image and control over the copying of that image. Thus, protection is provided for specific works only. A celebrity cannot exercise a general right to images or recordings that form part of a cinematographic film. Under the Copyright Act, an actor is deemed to have assigned all of his or her rights to a performance if that performance is recorded in the form of a cinematographic film. The producer of the cinematographic film owns the publicity rights to all images of a celebrity within the context of that film. This raises problematic issues if the physical or stylistic characteristics of an actor subsist independently and the general public can distinguish between the actor and the character played by him or her in a movie.

Publicity and image rights have come a long way. However, they are yet to be recognised by way of a statute. Although there have been a few judicial decisions which have accorded protection to celebrities' publicity and image rights through IP laws, they have proved to be insufficient, and there remains a need for a separate regime and statutory protection for publicity rights. **WTR**