

PROTECTING CELEBRITY RIGHTS THROUGH INTELLECTUAL PROPERTY CONCEPTIONS

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The rights of celebrities to make choices regarding the levels of exposure they wish to accept and to profit from exposure if they choose to, is a well recognized concept in the West. In India, however, the right to privacy which emerged through judicial pronouncements is not equipped to protect celebrity rights. This paper analyses the justifications for protection of celebrity-rights and studies the mechanisms through which other legal systems protect these rights. The paper suggests an intellectual property based approach to the protection of celebrity rights, which can be implemented in India either through legislative enactments or through the incorporation of developments in this regard that have occurred in other common law jurisdictions through judicial pronouncements.

I. INTRODUCTION

According to experts and scholars, intellectual property rights, without enforcement, are worthless. The intangible nature of intellectual property, which allows it to flow relatively freely across borders, presents a need for international enforcement of intellectual property rights (*hereinafter* IPR).¹ There is, however, no international intellectual property law *per se*; instead IPRs are subject to the principle of territoriality.² These rights vary according to what each state recognizes

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¹ PAUL MARETT, MARETT: INTELLECTUAL PROPERTY LAW 1 (1996) (defining intellectual property as intangible products or creations of human intellect). According to Paul Marett, intellectual property is intangible property, and is similar to shares in a company, which may be transferred. The three dominant forms of intellectual property are copyright, patents, and trademarks.

² See Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505 (1997) (commenting on territorial reach of intellectual property law and presumption against extraterritoriality).

and enforces. In contemporary times the domain of IPRs has been expanded to afford protection to modern rights such as the ‘right to publicity’ a corollary of the right to privacy, and the bundle of rights that emanate from ‘celebrity rights’. However this incorporation has not been a smooth one, and there has been much friction and conflict on the manner and content of such rights.

The seeds of celebrity rights lay in the novel doctrine of privacy which was created by Samuel Warren and Louis Brandeis in their seminal article — ‘The Right to Privacy’, in which they argued that the basic concept of personal freedom extended to all persons the right ‘to be let alone’.³ The idea of an individual’s legally protectable right of privacy, so universally accepted today, was a daring assertion in the late nineteenth century. Fifteen years after the Warren and Brandeis article, the Supreme Court of the State of Georgia became the first court to embrace a judicial cause of action for invasion of privacy in *Pavesich v. New England Life Insurance Company*.⁴ The case involved a claim against an insurance company which had published, without permission, the plaintiff’s picture as part of an advertisement. The Pavesich court allowed the plaintiff to recover without proof of special damage, recognizing that one’s personal liberty includes the freedom not only from physical restraint, but also to order one’s life without the intrusion of unwanted publicity. Despite these early beginnings, the concept of ‘celebrity rights’ has struggled, even in the United States of America (*hereinafter* US), the chief innovator and exporter of celebrity status, to develop a comprehensive, predictable approach to celebrity rights that would allow creators and proprietors of intellectual property to compete more effectively in global markets.⁵ A sharply defined right of publicity would provide needed certainty in legitimate commercial transactions involving celebrities, advertisers and entertainment concerns while helping guard against overreaching to avoid unduly restricting public access to popular culture.

As much can be stated with a fair amount of certainty: the right of publicity is “the inherent right of every human being to control the commercial use of his or her identity.”⁶ Most states in the US recognize the right, and consider it to be in the nature of property. This is where things become vague; though the right is recognized throughout the US, few courts have actually analyzed what the right encompasses, what the fact that it is ‘in the nature of property’ means, how it interacts with the possessor’s dignitary rights, most notably, the right of privacy and more importantly, how this right can be protected by notions of intellectual property law. Such unclear rules breed uncertainty, and that uncertainty limits

³ Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV.L.REV. 193 (1890).

⁴ 50 S.E. 68 (Ga. 1905).

⁵ Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right to Publicity*, 17 COLUMBIA-VLA JOURNAL OF LAW AND THE ARTS Fall 1 (1992).

⁶ Bruce P. Keller, *Condemned to Repeat the Past: The Reemergence of Misappropriation and Other Common Law Theories of Protection for Intellectual Property*, 11 HARV. J.L. & TECH. 401 (1998).

expression. Musicians, filmmakers, and artists risk expensive and prolonged litigation every time they use a celebrity's name or image in a work, regardless of the relevance, they contend, it might have to their message.⁷

II. CELEBRITY RIGHTS IN US

A. THE RIGHT OF PRIVACY

The right of publicity is rooted in the privacy doctrine that began to develop towards the end of the nineteenth century.⁸ This right of privacy can be succinctly stated as the right 'to be let alone'.⁹ Courts soon extended this right to protect private persons from unwanted publicity.

An inchoate right of publicity is apparent in early courts' attempts to apply the right of privacy to celebrities¹⁰ Some courts were reluctant to apply privacy rights to celebrities, stating that celebrities waived any right 'to be let alone' through their active pursuit of and profit from fame.¹¹ Under this view, commerce in celebrities' identities was limited to payment to the celebrity for a waiver by the celebrity of the right to sue any licensee of the celebrity's identity for violation of privacy rights. If celebrities possessed no privacy rights, waiver of any privacy-based cause of action possessed dubious value at best.¹²

⁷ Joshua Beser, *False Endorsement or First Amendment: An Analysis of Celebrity Trademark Rights and Artistic Expression*, 41 SAN DIEGO L. REV. 1787 (2004).

⁸ A legal right to privacy was first proposed by Samuel D. Warren and Louise D. Brandeis in an article that is widely recognized as one of the most influential ever written. Warren & Brandeis, *supra* note 3.

⁹ *Id.*

¹⁰ *See, e.g.*, O'Brien v. Pabst Sales Co., 124 F.2d 167, 169 (5th Cir. 1941) (finding the publication of a football player's photograph was authorized by his college's publicity department), cert. denied, 315 U.S. 823 (1942); Paramount Pictures, Inc. v. Leader Press, Inc., 24 F. Supp. 1004, 1009 (W.D. Okla. 1938) (holding that although Ohio law may recognize a right of privacy, it does not extend to prominent, notorious, or well known persons), reversed on other grounds, 106 F.2d 229 (10th Cir. 1939); Martin v. F.I.Y. Theatre Co., 26 Ohio Law Abs. 67, 69 (C.P. 1938); cf. Chaplin v. Amador, 93 Cal. App. 358, 360 (1928) (holding Charlie Chaplin allowed to enjoin look-alike actor from performing under the name 'Charlie Aplin' on unfair competition grounds).

¹¹ In O'Brien, *id.*, 170, a college football player was denied recovery under the right of privacy for a beer company's unauthorized inclusion of his picture on a promotional calendar, due to his active pursuit of fame. Dictum from this case, however, illustrates the nascent right of publicity.

¹² Even where celebrities were allowed to sue under a privacy cause of action, damage awards were often minimal. E.g., Miller v. Madison Square Garden Corp., 28 N.Y.S.2d 811, 813 (1941) (allowing the plaintiff to recover six cents for unauthorized use of picture on bicycle race program).

The first case to explicitly recognize that a celebrity's name or likeness has value beyond a right of privacy was *Haelan Laboratories Inc. v. Topps Chewing Gum, Inc.*¹³, a case involving baseball players who licensed their statistics and images for use on baseball cards. In coining the term 'right of publicity', the court stated:

"We think that, in addition to and independent of that right of privacy (which in New York derives from statute), 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 an accompanying transfer of a business or of anything else."¹⁴

Although the court cited little authority or policy for its decision, the jurisprudence laid down in *Haelan Laboratories* appears to underlie the right of publicity.¹⁵ Two influential commentaries further developed the right of publicity. One commentator picked up the phrase 'right of publicity' shortly after *Haelan* in a seminal article that solidified the right of publicity's existence as separate from the right of privacy.¹⁶ The late Professor Prosser, in a commentary universally cited in publicity cases, further delineated the difference between privacy and publicity rights.¹⁷ In so doing, Prosser categorized violation of publicity rights as one of four different torts constituting the invasion of privacy.

1. Intrusion upon the plaintiff's seclusion or solitude or into his private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness.¹⁸

¹³ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

¹⁴ *Id.* 868 (applying New York common law. The court further stated, "Whether it be labeled 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 raises issues including whether it is descendible, possible tax issues, marital property issues, and so on.)

¹⁵ The court stated: "It is common knowledge that many prominent persons [...] would feel sorely deprived if they no longer received money for authorizing advertisements [...] This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures."

¹⁶ Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954) (arguing that, although publicity and privacy claims sometimes overlapped, privacy plaintiffs were concerned with unwanted intrusions into their personal lives, while publicity plaintiffs complained of uncompensated exploitation of their identities, making privacy remedies inadequate).

¹⁷ L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 398-407 (1960).

¹⁸ *Id.*, 389. Prosser also avoided the debate over whether the right of publicity is 'property' arguing it was 'pointless'. *Id.*, 406.

It is the fourth of Prosser's torts, the appropriation of the plaintiff's name or likeness, that courts cite as the right of publicity.¹⁹ This right in one's name or likeness is assignable²⁰, bestowing upon it substantial commercial value and rendering it enforceable by third parties.²¹ Many courts, however, have ruled that this right is not inheritable, making it an amalgam of property and privacy rights. The exact property characteristics of the right of publicity remain unsettled in many jurisdictions today.²²

B. PUBLICITY

The development of the right to publicity in the US has primarily been through case-law. We will elucidate with the aid of landmark cases the development of this right. Haelen court's emancipation of the right of publicity from its privacy parent signaled the beginning of a steady trend towards recognition and protection of the commercial value of an individual's name and likeness. The growing influence of the doctrine was made apparent by the US Supreme Court's pronouncement in *Zacchini v. Scripps-Howard Broadcasting Co.*²³ that the right of publicity not only exists on an independent footing but in appropriate instances can be of sufficient force and effect to subordinate the strong countervailing right of the media, guaranteed by both the First Amendment and the Fourteenth Amendment, to report on newsworthy matters in the public interest.²⁴

Over time the traditional scope of name and likeness protection has been extended to a broad range of related contexts. Courts have decided that one's signature,²⁵ likeness, voice, photograph or sculpture are merely additional methods of evoking one's name and likeness and should be protected to the same extent. In the case of *Carson v. Here's Johnny Portable Toilets Inc.*²⁶ after failing to find the requisite elements to allow the plaintiff to prevail on unfair competition, trademark and privacy theories, the court focused on the right of publicity argument. Rejecting

¹⁹ See, e.g. *White v. Samsung Elec. Am. Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992), cert. denied, 113 S. Ct. 2443 (1993); *Eastwood v. Superior Ct.*, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 133 (Wis. 1979).

²⁰ "Once protected by the law, [the right of publicity] is a right of value upon which the plaintiff can capitalize by selling licenses." W. PAGE KEATON ET AL., PROSSER AND KEATON ON THE LAW OF TORTS 117, 854 (1984).

²¹ See, e.g., Haelan Labs, *supra* note 13.

²² See, e.g., *Memphis Dev. Found. v. Factors Etc. Inc.*, 616 F.2d 956, 958 (6th Cir.) "The common law has not heretofore widely recognized this right to control commercial publicity as a property right which may be inherited.", cert. denied, 449 U.S. 953 (1980); *Lugosi v. Universal Pictures*, 603 P.2d 425, 430 (Cal. 1979) "May the remote descendants of historic public figures obtain damages for the unauthorized commercial use of the names and likenesses of their distinguished ancestors? If not, where is the line to be drawn, and who should draw it?"

²³ 433 U.S. 562 (1977).

²⁴ *Id.*

²⁵ *Cepeda v. Swift & Co.*, 291 F.Supp. 242 (E.D.Mo. 1968).

²⁶ 698 F.2d 831 (6th Cir.1983).

the district court's position requiring specific identification of the entertainer by name as too narrow, the Sixth Circuit stated that "if the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his 'name or likeness' is used."²⁷

The Wisconsin Supreme Court in *Hirsch v. S.C. Johnson & Son, Inc.*,²⁸ which involved football star Elroy Hirsch, ruled that the nickname 'Crazylegs', by which he was known to a large segment of the public, was sufficient to identify him and thus was protectable under the right of publicity. The court articulated the underlying principle by which the need for protection should be defined: "All that is required is that the name clearly identify the wronged person." The court found that the moniker 'Crazylegs' was sufficient to identify Hirsch despite the fact that it was the press and public that had so dubbed him.²⁹ Thus, unauthorized uses of characteristics such as a nickname or an introductory phrase can evoke identity. Of all the identity cases, the most radical extension of protection is found in *Motschenbacher v. R.J. Reynolds Tobacco Co.*³⁰ A famous race car driver succeeded in having a summary judgment overturned where defendant's television cigarette commercial, though not using plaintiff's name, picture or likeness, had associated its product with plaintiff's uniquely marked race car. The Ninth Circuit held that this was sufficient to evoke the plaintiff's identity for an unauthorized commercial purpose.

A year later, the Ninth Circuit, applying California law, considered the problem of unauthorized appropriation of identity in a case which involved singer Nancy Sinatra who had scored the hit record — *These Boots are Made for Walking*.³¹ Seeking to capitalize on the popularity of the record, a tire company produced a series of radio and television commercials using the song under a license agreement from the copyright proprietor. The production imitated the voice, dress and mannerisms of the plaintiff without ever specifically identifying her by name or picture. Sinatra's theory of unfair competition was based on secondary meaning generated by the popularity of her recording. The court rejected this theory on the grounds that Sinatra was not in competition with the tire seller. Following the reasoning utilized in the *Fifth Dimension* case the court further held that since Sinatra did not own the copyright to the song she had popularized, her claim was pre-empted by the Copyright Act.

The *Midler v. Ford Motor Co.*³² case marked the final shift toward the evolving pattern of protecting all incidents of a person's identity against wrongful commercial appropriation. While generally denominated as the right of publicity, some states persist in referring to this action as invasion of the personal right of

²⁷ *Id.*

²⁸ 280 N.W.2d 129 (Wis. 1979).

²⁹ *Id.*

³⁰ 498 F.2d 821 (9th Cir.1974).

³¹ *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir.1970).

³² 849 F.2d 460 (9th Cir.1988).

privacy, while still others have labeled it as a form of unfair or deceptive trade practice, and still others brand it as a form of actionable misappropriation. The distinction is of little practical import for living celebrity plaintiffs. The issue becomes increasingly problematic, however, when the action is brought by an heir, assignee or successor in interest of a deceased celebrity.

C. WHO IS A CELEBRITY?

“Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value [i.e., the value of being a celebrity] whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.”³³

There is universal agreement that the right of publicity protects a celebrity’s prerogative to control the exploitation of his or her identity. This raises the obvious question: Who is a celebrity in the eyes of the law? The case of *Martin Luther King, Jr., Center for Social Change v. American Heritage Products, Inc.*³⁴, addresses this issue correctly, concluding that the term ‘celebrity’ should be interpreted broadly to encompass more than the traditional categories of movie idols, rock stars and ball players. However over time the idea of a ‘celebrity’ has undergone much expansion, and thus now, anyone whose identity commands value in the commercial marketplace qualifies for protection under the ‘direct commercial exploitation of identity’ test.

To start drawing lines and creating judicial tests for celebrity status is an unnecessary exercise. Under the ‘direct commercial exploitation of identity’ test, if a defendant makes an unauthorized use of one’s identity 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.³⁵ All that remains is proof of damages and/or a showing of irreparable harm necessary for equitable relief. Damages would be calculated by the traditional measure of market value of services plus any consequential injury to reputation and earning capacity. Where such damages would be minimal or difficult to establish in the case of an unknown, an alternative scheme of damage computation would be that of unjust enrichment. Any such monetary award would be in addition to injunctive relief.³⁶

³³ White, *supra* note 19.

³⁴ 694 F.2d 674 (11th Cir.1983).

³⁵ See Hetherington, *supra* note 5.

³⁶ *Id.* In those cases where an ordinary citizen’s identity is invaded without the benefit of a release or other permission, any recourse would be based on a right of privacy rather than a right of publicity. See Prosser, *supra* note 17.

III. JUSTIFICATION OF PROTECTING CELEBRITY RIGHTS

The right of publicity has generally been considered to be a separate body of law that has its roots in other bodies.³⁷ Professor 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.”³⁸ Hence, it is important to note that when the right of publicity and its development are discussed in terms of privacy rights, trademark law, copyright law, and property rights, the right of publicity grew from these bodies of law, but no longer is based completely upon them.

A. MORAL JUSTIFICATIONS

While the right of publicity in the United States has been primarily justified in economic terms, the right has also been grounded in moral justifications. One moral justification falls under John Locke’s Labor Theory.³⁹ Under the Labor Theory, a celebrity deserves all the rewards he can gain because he has worked hard and created a persona that has value.⁴⁰ The Theory contemplates the notion that if the publicity right is not given, people will not work as hard to create valuable personalities and society will suffer as a result. In 1954, Professor Melville B. Nimmer expressed the idea that a person who labors to create an image is entitled to enjoy the ‘fruit of [the] publicity values.’⁴¹ This justification has been enforced by the use of state property law. In *McFarland v. E & K Corp.*,⁴² the court held that “[a] celebrity’s identity, embodied in his name, likeness, and other personal characteristics, is the ‘fruit of his labor’ and becomes a type of property entitled to legal protection.”⁴³

Tied to this justification is the notion of unjust enrichment. This idea contends that a company should not be able to profit by using the image or likeness of a celebrity without compensating the celebrity for the use. Again, the US courts have turned to state based property laws to embrace this justification. The Court in *Zacchini v. Scripps-Howard Broadcasting Co.*,⁴⁴ found that “[t]he rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will” and that the defendant had appropriated “the

³⁷ See J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture: The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 131 (1995).

³⁸ *Id.*, 131.

³⁹ See generally JOHN LOCKE, TWO TREATISES OF GOVERNMENT (Neill H. Alford, Jr. et al, ed., 1994) (1698).

⁴⁰ *Id.*

⁴¹ Nimmer, *supra* note 16.

⁴² 18 U.S.P.Q.2d (BNA) 1246 (D. Minn. 1991).

⁴³ *Id.*, 1247.

⁴⁴ 433 U.S. 562 (1977).

very activity by which the entertainer acquired his reputation in the first place".⁴⁵ A final moral justification for the Labor Theory that is sometimes offered concerns state privacy laws. Under these laws, the argument is that the celebrity should be free to associate with whom he wishes. The argument follows that if the celebrity is associated with certain items or services, his reputation will be injured and he will lose respect and economic value.⁴⁶ For example, if Marlboro were able to use Ken Griffey Jr.'s⁴⁷ image in a cigarette advertisement, Griffey's reputation as a clean-cut role model would be tarnished. Therefore, proponents of the Labor Theory would argue that Griffey should have control over his image and likeness so that associations he deems deleterious to his image can be prevented.

All of these justifications have been criticized by individuals such as Professor Michael Madow. Professor Madow questions whether it is truly the celebrity who creates his image or whether it is the public that creates meaning, and then value, in a celebrity's image. He argues that "[t]he notion that a star's public image is nothing else than congealed star labor is just the folklore of celebrity, the bedtime story the celebrity industry prefers to tell us and, perhaps, itself".⁴⁸

B. ECONOMIC JUSTIFICATIONS

There are two primary economic justifications that are advanced to support the right of publicity. The first justification follows a line of reasoning that is tied to the Copyright Act. The second justification utilizes the Lanham Act.

The first economic justification that is often proposed is the incentives argument. The incentives argument is that if a celebrity cannot fully exploit his name, image, and likeness, the celebrity will lack the incentive to create a valuable persona.⁴⁹ For example, if Magic Johnson⁵⁰ could not sell his image to Nike for a large profit, he might have lacked the incentive to play basketball at the intense level that he did. In *Zacchini v. Scripps-Howard Broadcasting Co.*,⁵¹ the Supreme Court held that it was proper to give Zacchini protection "to protect the entertainer's incentive in order to encourage the production of this type of work."⁵² Courts have equated this incentive to the one referred to in the copyright clause of the US Constitution which says that copyrights will be granted to "promote the progress of science and useful arts."⁵³

⁴⁵ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. at 576.

⁴⁶ Michael Madow, *Private Ownership of Public Image; Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993).

⁴⁷ Ken Griffey Jr. currently plays Major League Baseball for the Cincinnati Reds.

⁴⁸ See Madow, *supra* note 46.

⁴⁹ *Id.*

⁵⁰ Magic Johnson, a member of the Basketball Hall of Fame, played for the Los Angeles Lakers until he was diagnosed with H.I.V. and decided to retire.

⁵¹ *Supra* note 45.

⁵² 433 U.S. 562, 577 (1977).

⁵³ U.S. Const. art. I, § 8, cl. 8.

The second justification of the right to publicity concerns the public and its role as consumers. This argument contends that if celebrities are not able to control their images, companies will be able to use them and trick the public into believing that the celebrity is actually endorsing the product with which he is pictured. This argument, which looks to prevent consumer confusion, is based upon section 43(a) of the Lanham Act⁵⁴, which concerns trademark law.⁵⁵

IV. THE EXTENT AND BASES OF PROTECTION TO CELEBRITY RIGHTS IN THE US OF AMERICA

As a whole, courts in the US have found that if the image or likeness of a celebrity shown will evoke the idea of the celebrity in question, the celebrity will have a cause of action. This area has become one of the strong points for celebrities.⁵⁶ What is of importance in these types of cases is whether the advertiser is identifying a celebrity in any way to exploit that celebrity's image. If a name or a nickname is a sufficient identification device, the celebrity will have a valid claim under the publicity rights doctrine.⁵⁷ In 1988, the Ninth Circuit expanded the right of publicity to include voices.⁵⁸ Bette Midler⁵⁹ sued Ford Motor Co. when Ford, after trying to obtain Midler's services, used another person, who sounded like Midler, to sing a song over one of their commercials. The court held that "when a distinctive voice of a professional singer is widely known and is deliberately imitated ... to sell a product, the sellers have appropriated what is not theirs and have committed a tort."⁶⁰

The use of a slogan which first appeared on the Tonight Show led Johnny Carson, the popular former host of the Tonight Show, to bring suit against Here's Johnny Portable Toilets Inc. in the Sixth Circuit.⁶¹ 'Here's Johnny!' is what Ed McMahon, Carson's sidekick, always said before Carson came out to do a show. The word 'John' is also the name for a toilet. The toilet company, wanting to capitalize on this fortunate coincidence, named their company 'Here's Johnny Portable Toilets'. *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage*

⁵⁴ Section 43(a) prohibits the use of any word or image, in conjunction with a product, that will confuse the consumer regarding that product's origin.

⁵⁵ See Lanham Act § 43(a), 15 U.S.C. § 1125(a)(1)(A) (1994).

⁵⁶ See Kevin Fisher, *Which Path To Follow: A Comparative Perspective On the Right Of Publicity*, 16 CONN. J. INT'L L. 95 (2000).

⁵⁷ *Carson v. Here's Johnny Portable Toilets, Inc.* 698 F.2d 831 (6th Cir. 1983) holding that 'Here's Johnny' was an integral part of Carson's image and could not be appropriated without a licensing agreement); *Uhlaender v. Henricksen*, 316 F.Supp. 1277 (D. Minn. 1970) (holding that Major League Baseball players association able to bar the use of player's names in an unauthorized baseball table game).

⁵⁸ *Midler v. Ford*, 849 F.2d 460 (9th Cir. 1988).

⁵⁹ Of 'Bette Davis Eyes' song fame.

⁶⁰ *Id.*

⁶¹ *Carson*, *supra* note 57 .

*Products, Inc.*⁶² raised the questions of whether the right of publicity survives death and whether the owner of the right must exploit the right in order to make claims under the right of publicity. The Sixth Circuit said that a celebrity's image is invaded whenever his or her identity is appropriated in any way. The court held that "[i]f the right of publicity dies with the celebrity, the economic value of the right of publicity during life would be diminished because the celebrity's untimely death would seriously impair, if not destroy, the value of the right of continued commercial use."⁶³ Thus the celebrity rights protection extends to image, voice, likeness and notable slogans. In nature, it is transferable and also inheritable.

A copyright protects a tangible creation for its expression of ideas. Trademark protects something existing in the world for its user, whose use associates that thing with him.⁶⁴ Although names cannot be copyrighted, tangible representations of celebrities' images are often copyrighted under the US Copyright Act. For example, a photograph of a celebrity could be copyrighted. A photographer would typically own the rights to his photograph regardless of what is in it. Selling the photograph to a publication would transfer those rights in the photograph. Typical copyright issues related to celebrities include suits over use of film clips,⁶⁵ graphic artwork,⁶⁶ and musical compositions.⁶⁷ Courts are reluctant to extend trademark protection to copyrightable materials in an effort to prevent circumvention of the limited nature of copyrights through the use of the Lanham Act which deals with trademarks. Apart from copyright protection, and common law protection, celebrity rights are also protected under Federal Acts like the Federal Trademark Dilution Act (*hereinafter* FTDA) which established a federal cause of action when a junior use "whittl[es] away the value of a trademark" when it's used "to identify different products".⁶⁸ The dilution amendment was adopted to "protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion."⁶⁹

⁶² 694 F.2d 674 (11th Cir. 1983).

⁶³ *Id.*

⁶⁴ Keren Levy, *Trademark Parody: A Conflict between Constitutional and Intellectual Property Interests*, 69 GEO. WASH. L. REV. 425, 428-29 (2001).

⁶⁵ See *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593 (9th Cir. 2000), amended by 2000 U.S. App. LEXIS 1421 (9th Cir. 2000). The owner of intellectual property rights in the Three Stooges filed this action against New Line Cinema for use of a Three Stooges clip in the film, *The Long Kiss Goodnight*. Comedy III Productions argued that the clip was 'particularly distinctive' of the Three Stooges' style of comedy, and thus the clip constituted a trademark. The court rejected this attempt to classify the cause of action as trademark infringement, seeing it as an attempt to circumvent copyright law by use of the Lanham Act. The court found that a copyright claim would have failed if it had been brought since the film's copyright had expired and it had entered the public domain.

⁶⁶ See 17 U.S.C. § 102(a)(5) (2000).

⁶⁷ See 17 U.S.C. § 102(a)(2). The history of musical compositions as copyright is as old as copyright law itself.

⁶⁸ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002).

⁶⁹ Dilution claims apply only to famous marks.(15 U.S.C. § 1125(c) (2000) Famous marks are a subset of trademarks that are also protected by traditional infringement claims. While every trademark is, by definition, distinctive, either inherently or through acquiring secondary

Apart from this, celebrity rights are also protected under Sections 43(a)⁷⁰ and 43(c)⁷¹ of the Lanham Act, allowing trademark to also grant protection to celebrity rights. The Lanham Act has been widely used for providing statutory bases for protecting celebrity rights. In *Allen v. National Video Inc*⁷², Woody Allen's Lanham Act claim succeeded because of the use of a look-alike in a print advertisement to promote a home video service. The defendant sought unsuccessfully to distinguish Allen on the fact that a connection existed between Woody Allen, a member of the motion picture industry, and the defendant, a motion picture distributor. The Ninth Circuit pronounced that a celebrity, whose endorsement of a product is implied through the imitation of a 'distinctive attribute' of the celebrity's identity, has standing to sue for false endorsement under section 43(a) of the Lanham Act.

The second Lanham Act amendment broadening celebrity protection is the Anticybersquatting Consumer Protection Act (*hereinafter* ACPA). The ACPA prohibits the registration of an internet domain name that is identical, confusingly similar, or dilutive of a trademark with bad faith intent.⁷³ Congress approved this amendment in order to prevent cybersquatting—the practice of registering domain names containing trademarks, then profiting from selling these domain names to the trademark holders. Celebrities such as Julia Roberts, Madonna, and others regained domain names containing their names in suits against alleged cybersquatters. Like dilution claims, these rights derive from an individual's property interest in a name.

meaning, very few are famous. Section 43(c) includes a non-inclusive eight factor test to determine whether a mark is famous. These factors include, for example, duration and geographical extent of use and the public's degree of recognition. By providing protection only for famous marks, courts can reasonably infer that the infringer had heard of the mark. Thus, initially, dilution protected only the most famous of celebrities, like Madonna or Michael Jordan. However, as in section 43(a) cases, celebrity rights are creeping into the realm of once protected areas, and litigation under the FTDA is expanding to less famous people.

⁷⁰ Section 43(a) protects unregistered trademarks. Since the mid-1980s, courts have increasingly recognized celebrities' claims under the Lanham Act as unregistered trademarks protected by section 43(a).

⁷¹ Under Lanham Act section 43(c)(1), a court can consider the following factors to determine a mark's famousness: "(A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register."

⁷² 610 F. Supp. 612, 618 (S.D.N.Y. 1985).

⁷³ 15 U.S.C. § 1125(d) (2000).

V. CELEBRITY RIGHTS IN THE UNITED KINGDOM

The United Kingdom (*hereinafter* UK) has rejected the idea of publicity rights as a separate body of law, it would make no sense to speak of the justifications for protection. Here we attempt to explore what bodies of law celebrities have attempted to use to protect their images and why many of these attempts have failed in the UK.

A. THE COPYRIGHT, DESIGNS AND PATENTS ACT OF 1988

The Copyright, Designs and Patents Act (*hereinafter* CDPA) allows the owners of copyrighted material to prevent third parties from reproducing the work. A celebrity, for example, could stop a third party from creating a poster of a picture he found in a magazine if the celebrity owns the rights in the picture. A court will find that a copy has been made when “a substantial portion of the plaintiff’s work” has been appropriated.⁷⁴ A ‘substantial portion’ has been held to refer to the quality of the portion taken, the heart of the work, rather than how much of the work was taken.⁷⁵ However, in some cases where an artist used a copyrighted work as a reference, courts have held that a reproduction of that work is not an infringement because the reproduction was made consistent with the artist’s creative vision and impressions.⁷⁶

An example illustrating how this system works and why it provides little protection for celebrities who wish to guard their image follows. Imagine that a gift card publisher, Hallmark for example, begins to produce and sell birthday cards with a picture of Elton John⁷⁷ on the outside. Further, imagine that John hates the picture and wants to stop this use. He will only find recourse under the CDPA if he owns the copyright in the picture that Hallmark is using. If Hallmark took the picture or if John previously sold the rights in that picture to someone else and that individual granted permission to Hallmark, then John cannot stop the sale of the cards.⁷⁸

B. THE TRADE MARKS ACT 1994

As under the CDPA, celebrities have failed to gain protection under the Trade Marks Act. Under this law, a word can become a trademark if it is found to be distinctive in nature.⁷⁹ Distinctiveness may be found when the name is an invented word, a word having no direct connection to the product’s characteristics, the signature of the applicant, or unique.

⁷⁴ See *Bauman v. Fussell*, 14 R.P.C. 485, 487 (Eng. C.A. 1978).

⁷⁵ See *Ladbroke Ltd. v. Hill Ltd.*, 1 W.L.R. 273, 276-78 (Eng. H.L. 1964).

⁷⁶ *Id.*

⁷⁷ A widely acclaimed singer.

⁷⁸ FISHER, *supra* note 56.

⁷⁹ Trade Marks Act, 1994, c. 26, § 1(d) (Eng.).

In *Re: Elvis Presley Trade Marks*,⁸⁰ Elvis Presley Enterprises, Inc. wanted to register 'Elvis Presley' in the United Kingdom, and another British company that used the name Elvis in its mark contested the registration. The court held that the name Elvis could not be registered because it was well known by the public and therefore, was not distinctive. When Elvis Presley Enterprises claimed that the public would be confused, the court stated that "[w]hen a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source."⁸¹ Furthermore, the court stated, "[w]hen people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care who made, sold or licensed it".

From these cases, one can infer that the more famous a personality becomes, and as his or her name or nickname passes into common usage, the less likely it is that he or she will be entitled to claim an exclusive 'right to the name'.⁸² In essence, celebrities who want to stop advertisers, who are using either their names or their likenesses because it is well known and will affect the public, will not be successful because their names and likenesses are so well known.

C. COMMON LAW PASSING OFF RESTRICTIONS

Passing off, in the publicity rights context, occurs when an advertisement uses a celebrity's image in a way that will lead the public to believe that the celebrity is either associated with the subject of the advertisement, or is endorsing the subject of the advertisement. Furthermore, the alleged association or endorsement must cause a loss of income to the celebrity.⁸³ To establish a claim under UK law, the plaintiff must show that the alleged "misrepresentation is likely to cause confusion amongst consumers and a loss of income to the plaintiff"⁸⁴ from this, one could infer that in order for celebrities to protect the use of their images, they must be using their images themselves and expecting to profit from their use. In other words, there is an exploitation requirement. In the case of *Halliwell v. Panini*,⁸⁵ Panini was producing a sticker collection of the Spice Girls that it called the 'Fab Five'. The Spice Girls, who were negotiating a deal with Topps Inc. to produce a sticker set, claimed that the absence of a 'non-official' declaration on the set would lead their fans to believe that it was the Spice Girls and not Panini that were producing the set. The court disagreed, rejected the Spice Girls' request for a preliminary injunction and Justice Lightman stated: "I shall only say that I am far from satisfied that the absence of any disavowal of authorisation by the plaintiffs can reasonably lead members of the public to buy the defendants' product on the basis or in the belief that it was authorised by the plaintiffs."⁸⁶

⁸⁰ 13 R.P.C. 543 (Eng. Ch. 1997), aff'd, 16 R.P.C. 567 (Eng. C.A. 1999).

⁸¹ *Id.*, 545.

⁸² FISHER, *supra* note 56.

⁸³ See Hayley Stallard, *The Right of Publicity in the United Kingdom*, 18 LOY. L.A. ENT. L.J. 565, 567 (1998).

⁸⁴ *Id.*

⁸⁵ 1997 LEXIS (Eng. Ch. June 6, 1997).

⁸⁶ *Id.*

D. COMMON LAW MALICIOUS FALSEHOODS

Under the UK common law, a celebrity can prevent the use of his image if the use entails a malicious falsehood and if his trade is harmed by the falsehood.⁸⁷ The major case illustrating this doctrine is *Tolley v. J.S. Fry & Sons, Ltd.*⁸⁸ Tolley was an amateur golf player who was well known in the UK, and Fry & Sons used a caricature of him in an advertisement for the chocolates they sell. The court found that this use violated the law because people could interpret the caricature as an endorsement by Tolley, and one which would harm his status as an amateur golfer. However, the court also held that while the act amounted to a violation due to the potential financial harm, some people should expect to be thrust into the public spotlight when they enter certain professions.⁸⁹

E. THE ADVERTISING CODES

Perhaps the best protection provided to celebrities is through the non-binding advertising codes. The codes, which deal with non-broadcast uses, self-regulate the advertising industry and attempt to force companies to obtain the celebrity's permission before his image is used.⁹⁰ The codes are The British Code of Advertising Practice⁹¹ and the IBA Code of Advertising Standards and Practice.⁹² While both of the codes provide some protection, the protection is limited. For example, an advertisement that associates a celebrity with a product that does not run contrary to that celebrity's character will not violate the codes.

VI. RELATION BETWEEN RIGHT OF PUBLICITY AND TRADEMARK LAW

In the United States, celebrities use both state and federal causes of action to prevent unauthorized use and protect their economic investment in their identities. Primary federal claims are under section 43(a) of the Lanham Act for false advertising or endorsement, and for dilution under section 43(c). Right of publicity is the broadest and most frequently litigated state law claim. States have varying statutory and common law schemes.⁹³ Unlike the right of privacy, based in the right of an individual to be left alone, the right of publicity protects an individual's name

⁸⁷ Philippa Gannon, *Sporting Glory?*, 146 NEW L.J. 1160 (1996).

⁸⁸ 1 K.B. 467 (Eng. C.A. 1929).

⁸⁹ *Id.*, 477.

⁹⁰ Catherine Lousie Buchanan, *A Comparative Analysis of Name and Likeness Rights in the United States and England*, 18 GOLDEN GATE U. L. REV. 301, 308 (1988).

⁹¹ The British Code of Advertising Practice, c. 31, § 17.2.

⁹² The Independent Broadcasting Authority Code of Advertising Standards and Practice, (IBA July 1986).

⁹³ ALEXANDER LINDEY & MICHAEL LANDAU, *LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS*, § 1:118, 1-431 (2004).

or likeness from being commercially appropriated by someone else.⁹⁴ Whereas a right of privacy claimant does not want exposure at all, a right of publicity claimant asserts that he or she “simply wants to be the one to decide when and where, and to be paid for [the exposure].”⁹⁵

When the right of publicity conflicts with the First Amendment, courts resolve the tension under principles specific to each state right. Some states, such as California, recognize both common law and statutory rights of publicity, which may differ in application.⁹⁶ Trademark and right of publicity claims are similar in that each grants the celebrity the right to protect an economic interest in his or her name. The crucial difference between the two claims is that right of publicity focuses on the individual’s rights instead of consumers’ rights. ‘Right of publicity’ violations do not require likelihood of consumer confusion.⁹⁷ Additionally, celebrities can (and often do) assign their right of publicity, in gross, to studios. Trademark rights cannot be similarly assigned because trademark rights derive from use in commerce and are not property rights in the traditional sense.⁹⁸ Thus a celebrity who has put his image into the world has, essentially, opened the door for the public to shape and mold the image as it sees fit. In addition, others have commented that the right of publicity threatens society’s access to information and the ability to create new ideas based upon the former creations.

VII: THE BEGINNINGS OF A RIGHT TO PUBLICITY IN INDIA

“Civilization is the progress towards a society of privacy. The savage’s whole existence is public, ruled by the laws of his tribe. Civilization is the process of setting man free from men.”

*Ayn Rand*⁹⁹

The exponential growth of the media, particularly the electronic media in India, in the recent years has brought into focus issues of privacy. The media has

⁹⁴ Lerman v. Flynt Distrib. Co., 745 F.2d 123, 127-30, 134 (2d Cir. 1984) (concerning public figures’ limited right of privacy and publicity claims against pornographic magazine for falsely identifying her as nude woman in photograph); *see also* LINDEY & LANDAU, *Id.*, § 1.118, 1.429 to 1.430. As described earlier, the right of privacy is credited to a seminal article in the Harvard Law Review. *See* Warren & Brandeis, *supra* note 3; *see also* Nimmer, *supra* note 16 (expanding on Warren and Brandeis’s right of privacy to explain a new right of publicity for celebrities).

⁹⁵ *See* LINDEY, *supra* note 11.

⁹⁶ California Civil Code section 3344 states: “Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising [...] without such person’s prior consent [...] shall be liable for any damages sustained by the person or persons injured as a result thereof.” Cal. Civ. Code § 3344.

⁹⁷ Beser, *supra* note 7.

⁹⁸ AYN RAND, *THE FOUNTAINHEAD* 715 (1968).

⁹⁹ 1954 SCR 1077.

made it possible to bring the private life of an individual into the public domain, exposing him to the risk of an invasion of his privacy and space.

A. DEVELOPMENT OF THE RIGHT TO PRIVACY BY THE SUPREME COURT

The first few cases that presented the Indian Supreme Court with the opportunity to develop the law on privacy in India were cases of police surveillance. The earliest case in India to deal with 'privacy' was *M.P. Sharma v. Satish Chandra*¹⁰⁰ in the context of Article 19(1)(f) and Article 20(3) of the Constitution of India. The contention that search and seizure violated Article 19(1)(f) was rejected, the Court holding that a mere search by itself did not affect any right to property, and though seizure affected it, such effect was only temporary and was a reasonable restriction on the right. In fact, the law as to privacy was developed in subsequent cases by spelling it out from the right to freedom of speech and expression in Article 19(1)(a) and the right to 'life' in Article 21.

In the case of *Kharak Singh v. State of UP*¹⁰¹, the U.P. Regulations regarding domiciliary visits were in question and the majority bench referring to *Munn v. Illinois*¹⁰² held that though our Constitution did not refer to the right to privacy expressly, yet it can be traced from the right to 'life' in Article 21. According to the majority, Clause 236 of the relevant Regulations in UP, was bad in law; it offended Article 21 in as much as there was no law permitting interference by such visits. The majority, however, did not go into the question whether these visits violated the Act. But, Justice Subba Rao while concurring that the fundamental 'right to privacy' was part of the right to liberty in Article 21, part of the right to freedom of speech and expression in Article 19(1)(a), and also of the right to movement in Art. 19(1)(d), held that the Regulations permitting surveillance violated the fundamental right of privacy. In the discussion the learned Judge referred to *Wolf v. Colorado*.¹⁰³ In effect, all the seven learned Judges held that the 'right to privacy' was part of the right to 'life' in Art. 21.

In the case of *Govind v. State of MP*¹⁰⁴, Mathew J. developed the law relating to the right to privacy from where it was left in *Kharak Singh*¹⁰⁵. The learned Judge referred to *Griswold v. Connecticut*¹⁰⁶ where Douglas, J. referred to the theory of penumbras and peripheral rights and had stated that "[...] the right to privacy was implied in the right to free speech and could be gathered from the entirety of fundamental rights in the constitutional scheme, for, without it, these rights could not be enjoyed

¹⁰⁰ AIR 1963 SC 1295.

¹⁰¹ (1876) 94 US 113.

¹⁰² (1948) 338 US 25.

¹⁰³ (1975) 2 SCC 148.

¹⁰⁴ *Supra* note 101.

¹⁰⁵ (1965) 381 US 479.

¹⁰⁶ (1973) 410 US 113.

meaningfully'. Mathew, J. also referred to *Jane Roe v. Henry Wade*¹⁰⁷ where it was pointed out that though the right to privacy was not specifically referred to in the US Constitution, the right did exist and "roots of that right may be found in the First, Fourth and Fifth Amendments, in the penumbras of the Bill of rights, in the Ninth Amendment, and in the concept of liberty guaranteed by the first section of the Fourteenth Amendment." Justice Mathew, however, stated that the "right to privacy was not absolute" and that the makers of our Constitution wanted to ensure conditions favourable to the pursuit of happiness as explained in the case *Olmstead v. United States*¹⁰⁸ wherein it was held that the privacy right can be denied only when an "important countervailing interest is shown to be superior", or where a compelling State interest was shown. (Justice Mathew left open the issue whether moral interests could be relied upon by the State as compelling interests). "Any right to privacy", the learned Judge said "[...] must encompass and protect the personal intimacies of the home, the family, marriage, motherhood, procreation and child bearing. This list was however not exhaustive."¹⁰⁹ He explained that, if there was State intrusion there must be 'a reasonable basis for intrusion'.¹¹⁰

While examining the UP Regulations 855 and 856, in question in the *Govind* case, Justice Mathew observed that they gave wide powers to the police and needed, therefore, to be read down, if their Constitutionality was to be upheld. He further observed in this context: "Our founding fathers were thoroughly opposed to a Police Raj!" Therefore, the Court must draw boundaries upon these police powers so as to avoid breach of constitutional freedoms. The right to privacy could be restricted on the basis of compelling public interest. Thus from this case onwards it was accepted that the right to privacy has been implied in Art. 19(1)(a) and (d) and Art. 21; that, the right is not absolute and that any State intrusion can be a reasonable restriction only if it has reasonable basis or reasonable materials to support it.

A two-judge Bench in *R. Rajagopal v. State of Tamil Nadu*,¹¹¹ held the "[...] right of privacy to be implicit in the right to life and liberty guaranteed to the citizens of India by Article 21" and defined it as "[...] the right to be let alone". Every citizen has a right to safeguard his own privacy. However, in the case of a matter being part of public records, including court records, the right of privacy cannot be claimed. After this, in a large number of cases including *PUCL v. Union of India*¹¹², *Mr. X v. Hospital 'Z'*¹¹³, *People's Union for Civil Liberties v. Union of India*¹¹⁴, *Sharda v. Dharmpal*¹¹⁵ among others, the right to privacy has been widely accepted as being implied in the Indian Constitution.

¹⁰⁷ (1972) 277 US 438 (471).

¹⁰⁸ *Supra* note 101, ¶ 25.

¹⁰⁹ *Id.*

¹¹⁰ (1994) 6 SCC 632.

¹¹¹ (1997) 1 SCC 301.

¹¹² (1998) 8 SCC 296.

¹¹³ (2003) 4 SCC 399.

¹¹⁴ (2003) 4 SCC 4931.

¹¹⁵ 2003 (26) PTC 245 (Del).

B. THE RIGHT TO PUBLICITY AND 'CELEBRITY RIGHTS' IN INDIA

Unlike the US of America, the development of the right to publicity in India has been very restricted in nature, and there are no statutes that directly deal with it. However in the recent case of *Development (International) Ltd. v. Arvee Enterprises and Anr.*¹¹⁶, the Delhi High Court has shown ample maturity in having the flexibility to discuss the right to publicity in India and also impliedly hold, after surveying a number of Australian and English cases, that the right to publicity in India can only be claimed by individuals and not inanimate objects like companies or corporations.

As per the facts of the case, the plaintiff was the organizer of ICC World Cup held in South Africa, Zimbabwe and Kenya from February 8, 2003 till March 23, 2003 (*hereinafter*, the Event). The plaintiff had created a distinct 'logo' and a 'mascot' for the event. Owing to wide publicity of the said logo and mascot, members of the public associated the same exclusively with the plaintiff. The plaintiff had filed applications for registration of its trade-mark in several countries. It was alleged that the first defendant was the authorised dealer for sale and service of electronic goods manufactured by the second defendant-Philips India Ltd. The defendants were allegedly misrepresenting their association with the plaintiff and the World Cup, by advertisements in media, including newspapers, television, internet and magazines and by using said offending slogans with the intention to unlawfully derive commercial benefit of association with the plaintiff and the World Cup. The learned counsel of the plaintiffs contended that the right of publicity not only protects publicity values of human beings, but also the publicity values in non-living objects that are made popular through effort and that defendants have violated the right of publicity of the plaintiff in the Event, and are deriving unjust enrichment, by basing its entire advertising campaign on the Event and its popularity. Reliance was placed on *Bi-Rite Enterprises v. Button Master*¹¹⁷ *White v. Samsung*¹¹⁸ and *Zacchini v. Scripps Howard Broadcasting Co.*¹¹⁹ However Justice Agrawal opined that "[...] non-living entities are not entitled to the protection of publicity rights in an event, for more than one reasons. Firstly, the copyright law, trade-mark law, dilution law and unfair competition law provide full protection against all forms of appropriation of property to such legal entities [...]. Secondly, it would be against the basic concept of 'persona'. The 'persona' is defined in Black's Law Dictionary, seventh edition to mean 'a person; an individual human being'." He further held:

¹¹⁶ 555 F. Supp. 1188 (S.D.N.Y., 1983).

¹¹⁷ 23 USPQ 2d 1583.,

¹¹⁸ 205 USPQ 741.

¹¹⁹ Some commentators like Beser, *supra* note 7 have suggested the implementation of a Federal Publicity Rights to bring about uniformity in the publicity laws of the different states of the US. "[...] the road to which we should look towards following should be a middle of the road option under which a more adequate balancing system, such as that under the Copyright Act, is introduced. One way to introduce a system in which a uniform balancing system is achieved would be through the implementation of a Federal publicity Rights Act."

“[...] 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. However, that right does not inhere in the event in question, that made the individual famous, nor in the corporation that has brought about the organization of the event. Any effort to take away the right of publicity from the individuals, to the organiser {non-human entity} of the event would be violative of Articles 19 and 21 of the Constitution of India. No persona can be monopolised. The right of Publicity vests in an individual and he alone is entitled to profit from it.”

Thus the right to publicity and ‘celebrity rights’ have had very limited development in India unlike in the US.

VIII. CONCLUSION

Neither the system in the US nor that in the UK provides this type of balancing between the public and the celebrity. In the US, the celebrity is gaining more and more control over his image and the public is receiving nothing in return. In the UK, celebrities are not being rewarded for their creations and commercial advertisers are reaping the benefits.¹²⁰

In India there is no statute which deals with the right to publicity. Judicial decisions on the issue are also quite scarce. It would seem that development of the law on publicity has been stilted after the growth of the law on privacy. However, as progressively, the electronic media in India permeates all forms of society, India will have to develop its publicity laws so as to protect its growing body of celebrities. This can be done either through legislative enactments or through the incorporation of common law development on this issue through judicial pronouncements. But whatever may be the case, a balance has to be struck between the interests of the celebrity and those of society. For example, property law does not balance the rights of the individual to own property against the rights of society to share the property. Thus when someone owns something they can freely prevent anyone else from using it. Applying this type of theory to publicity rights allows the celebrity to gain a monopoly in their image that is not in the public’s interest. Further, it would create an environment where commercial entities would be more likely to know whether their activities were violations or not. Thus in due course of time, India would require a celebrity rights statute.

Judging from the experience of the US and the UK, it would seem that celebrity rights following the doctrine of ‘direct commercial exploitation of identity’ to determine a breach of celebrity rights, balances the needs of the individual concerned as well as societal ones. The proposed test of “direct commercial exploitation of identity” is a pragmatic solution to the problem. The test borrows

from the copyright doctrine of fair use and attempts to create two distinct, but predictable spheres. The protected sphere guarantees protection for private celebrity interests seeking to realize the full financial rewards of their celebrity status. The only proviso is that the exploitation of identity that they seek to license must be restricted to those uses which are both direct in nature and commercial in motivation and for which the user would be expected to pay on the open market. All other uses would be denominated as indirect and incidental and thus be placed in the public domain. Protection accorded to all direct commercial exploitation would extend to all incidents of a celebrity's identity. It would further extend to all persons whose identities are directly used for commercial purposes.

Moreover, borrowing from concepts of copyright, specifically the right of fair use, a similar exception should be allowed in the test of direct commercial exploitation of identity. The general populace should be able to comment upon and criticize the celebrity so long as their comments or criticisms are not falsehoods that injure the celebrity. Parodies would be acceptable. In all other cases celebrities should have the right to exploit the image they labored to create. Under this act the celebrity would own exclusive rights to his name, image, likeness, and voice for his lifetime. This idea finds precedence in the Copyright Act (both Indian and English) that provides protection for works throughout the author's lifetime. Then, after the celebrity's death, the right would pass to his heirs. Again, the copyright law provides a similar notion by allowing the right to exist for a certain number of years after the death of the author. This stance, which allows inheritability, is preferable. A celebrity relies upon the economic power of his image to sell the image for endorsement purposes. If his publicity right died immediately upon his death, the economic value in his image would be severely diminished and this diminished incentive may lead the celebrity to work less at cultivating an image. Also, celebrities who have died would have no protection from undesirable associations. Allowing the right to survive death would grant the celebrity greater economic incentive to create socially desirable images and society would benefit from these creations. Finally, allowing the right to continue for only a set amount of years would balance the power granted to the celebrity against the public's ability to access and utilize the celebrity's image.

Celebrities would, as authors do under the Copyright Act, have the exclusive rights to sell, produce, and distribute their images. This position is more desirable than the UK's stance that does not protect the celebrity's image from third party exploitation. The most powerful argument in favor of this position is that if we do not give economic incentives to potential celebrities, they may not work as hard to create an image from which society will benefit. Certain commentators would reply to this by stating that the public, not the celebrity, actually creates the image and the British system is, therefore, preferable.

