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II Prize

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For the essay

"Infringement of Publicity rights: An Intellectual Property Approach"

INFRINGEMENT OF PUBLICITY RIGHTS: AN INTELLECTUAL PROPERTY APPROACH

Devangini Rai

I. Introduction

A celebrity is often perceived to be larger than life, perfect and appealing. Today, celebrity identities have pervaded mass media catapulting into a marketable resource. The semiotic power[1] of a celebrity is exploited for multifarious purposes ranging from advertising, brand endorsements, merchandising etc. It is here that publicity rights come into existence. Publicity rights refer to the right of controlling the commercial uses of a celebrity persona.[2]

Today these rights find wide acceptance in courts all over the world. The United States of America has a rich and dramatic history of documenting the right with some widely known case-laws in the history of publicity rights such as *Haelan Laboratories, Inc.* v. *Topps Chewing Gum, Inc.*[3], *Zacchini* v. *Scripps-Broadcasting Company*[4] and *White*

[1] Michael Madow, "Private Ownership of Public Image: Popular Culture and Publicity Rights", 81 *Cal. L. Rev.* 185 (1993).
[2] J. Thomas McCarthy, "The Human Persona as Commercial Property: The Right of Publicity" 19 *Colum. -VLA J.L. & Arts* 130 (1994).
[3] 202 F. 2d 866 (2nd Cir. 1953).
[4] 433 U.S. 562 (1977).

v. *Samsung Electronics America, Inc*[5]. Compared to US, India has routinely been described to be at a nascent stage in enforcing publicity rights. Nevertheless, the courts have firmly recognised the right and its infringement in landmark cases like *Titan* v. *Ram Kumar Jewellers*[6], *Shivaji Rao Gaikwad* v. *Varsha Productions* [7]and *DM Entertainment* v. *Baby Gift House*.[8]

The aim of this article is to analyse India's approach in navigating through publicity rights. The article endorses an intellectual property approach to understand the right and its infringement. This is achieved by understanding the parallels between publicity right and trademark law. Further, the application of a publicity right requires checks and balances which is explained through exceptions derived from copyright law. Throughout the article, the author derives insights from US case laws which have had a considerable influence on Indian courts. Towards the end, the article contemplates whether India really needs a sui generis legislation on publicity rights or not.

II. History and Genesis

Rudimentary origins of rights protecting the persona of a person can be attributed to have originated from a right to privacy.[9] In a 1960 article by William Prosser, while identifying the four categories of torts involved in right to privacy, Prosser included the commercial appropriation of one's identity under right to privacy[10]. The modern-day publicity rights can be termed to have developed from the four appropriation torts identified by Prosser.[11] Prosser's formulation of the torts on privacy[12] states four

[5] 971 F.2d 1395, 1399 (9th Cir. 1992).
[6] (2012) 50 PTC 486.
[7] (2015) 662 PTC 351.
[8] CS (OS) 893/2002.
[9] 1 J. Thomas McCarthy, The *Rights Of Publicity And Privacy* § 1:25 (2d Ed. 2014); Mark P. McKenna, "The Right of Publicity and Autonomous Self-Definition" 67 *Univ. Pitt. L. Rev.* 227 (2005-2006); Jennifer E. Rothman, "The Right of Publicity's Intellectual Property Turn", 42 Colum. J. L. & Arts 288 (2019).
[10] William Prosser, "Privacy" 48 *Cal. L. Rev.* 389 (1960). (Professor Prosser in this article identifies four appropriation torts within the realm of privacy, namely 'Intrusion upon plaintiff's seclusion', 'Public disclosure of embarrassing private facts', 'Publicity placing the plaintiff in a false light' and 'Appropriation, for the defendant's advantage, of the plaintiff's name or likeness'.)
[11] 1 J. Thomas McCarthy, *The Rights Of Publicity And Privacy* § 1:25 (2d Ed. 2014); *Carson* v. *Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). (.
[12] William Prosser, *Law of Torts* 804-807 (4th ed., 1971).

requirements for appropriation of name or likeness: use of identity by the defendant, appropriation of identity of the plaintiff, lack of consent and resultant injury.[13]

During the inception of right of privacy, 'celebrity' was not seen as something of a commodity capable of widespread exploitation.[14] The need for a separate right of publicity has been traced to have arisen out of a lack of commercial viability in privacy rights. In one of the earliest cases discussing publicity rights in 1953, the court in *Haelan Laboratories, Inc.* v. *Topps Chewing Gum, Inc.*[15] *('Haelan')* recognised the "right in the publicity value"[16] of a photograph. Differentiating this right from that of privacy, the Court observed that a publicity right is an "exclusive privilege"[17] in the image of the player. The landmark US Supreme Court case of *Zacchini* v. *Scripps-Broadcasting Company* has been further instrumental in firmly establishing the intellectual property moorings of publicity rights.[18]

III. Indica of Identity in Celebrity Persona

The Delhi high court in *Titan Industries* v. *Ram Kumar Jewellers (*hereinafter *Titan Industries*) recognised two components in publicity rights claim: validity and identifiability.[19] The validity component refers to identifying what components of a celebrity identity are legally protected[20] whereas the identifiability component shifts the focus on the manner of appropriation of the identity by defendant's use. The validity prong discusses the identifiable traits that require legal protection under publicity rights. The identifiability prong further analyses the right sought by the plaintiff by judging the use of those traits in the defendant's use.

[13] *Eastwood* v. *Superior Court* 149 Cal.App.3d 409,417 (Cal. Ct. App. 1983).
[14] Sheldon W. Halpern, "The Right of Publicity: Commercial Exploitation of the Associative Value of Personality" 39(5) Vanderbilt L. Rev. 1205 (1986), David Westfall and David Landau, "Publicity Rights as Property Rights", 23 Cardozo Arts & Ent. L. J. 72 (2005) ("Publicity rights initially emerged in response to functionalist considerations: transferable rights were needed to keep pace with commercial custom".).
[15] 202 F. 2d 866 (2nd Cir. 1953).
[16] *Id.* at 868.
[17] *Id.* at 868.
[18] *Supra* note 4 at 576.
[19] *Titan* v. *Ram Kumar Jewellers*, (2021) 50 PTC 486.
[20] In the author's opinion, the framing of the validity prong of the test is misplaced and problematic. This has been explored in Section 5.

The validity prong of the test assumes importance in identifying what traits of a celebrity identity are worth protecting under an intellectual property framework. These traits are referred to as the indicia of identity representing the evocative nature of a celebrity identity. Two basic indica of identity which have been accorded protection by US and Indian courts are name and likeness. These have been explored below.

3.1 Name

Name of a celebrity is the first impression of identity while evoking the celebrity persona. As per the test elucidated in the US case of *Rogers v. Grimaldi*[21], if the evocative nature of the name is used to merely swindle its commercial prowess for the defendant's own use, such appropriation cannot be sustained.

In India, *Shivaji Rao Gaikwad (Rajinikanth) v. M/s. Varsha Productions*[22] dealt with the publicity right of super-star Rajnikanth, a doyen of South India Cinema. It involved a film made by the defendant titled as 'Main Hoon Rajnikanth'. The plaintiff sued the defendant for restraining them to use his name, image, caricature and style of delivering dialogues in any reference in the film. A host of comments made by the actor's fans on the internet alluded the impugned film to the actor which implied the confusion created amongst the audience regarding a cultural image of the plaintiff. The mass fan-following of the plaintiff would create an unmistakable connection between the plaintiff and the impugned film merely going by the title of the film incorporating the plaintiff's name. In light of the accentuating factors against the defendant, an interim injunction was passed in favour of the plaintiff.

Further cases like *Rajat Sharma* v. *Ashok Venkatramani*[23], *Arun Jaitley* v. *Network Solutions Private Limited*[24] and *Tata Sons Limited* v. *Aniket Singh*[25] delivered by the Delhi high court have consistently held publicity rights in the name of the celebrity involved. In *Arun Jaitley* the court noted that rights in a personal name are far superior than the name be used commercially by entities other than the person

[21] *Rogers v. Grimaldi*, 875 F.2d 994,1004 (2d Cir. 1989).
[22] 2015 (62) PTC 351.
[23] CS (COMM) 15/2019.
[24] (2011) 181 DLT 716.
[25] (2015) 65 PTC 337

himself.[26] Thus, a name which is so distinctive owing to the popularity of the person would qualify to be a trade mark.

3.2 Likeness

The word 'likeness' refers to attributes like voice, appearance or any identifiable conduct distinguishable enough to be traced to the celebrity. Ranging from usage of a famous slogan by a TV show host[27], to a voice-lookalike of a celebrity singer[28], to the depiction of a robot impersonating a celebrity host in a TV commercial[29], US courts have been particularly lenient in granting protection to a celebrity likeness being appropriated. The case of *Midler* v. *Ford* involved a voice look-alike of singer Betty Midler being used by a Ford Commercial as the defendant was not able to get Midler on board. The singer sued the defendant for a usage of her voice evocating a similar likeness in the commercial[30]. While the court did not explicitly hold infringement of publicity rights in the voice of the singer, it held that the voice was valuable and distinctive which made the defendants resort to using a look-alike in the first case.

The Delhi High Court case of *DM Entertainment* v. *Baby Gift House*[31] (*DM Entertainment*) involved Daler Mehendi- a famous Punjabi singer suing for commercial appropriation of his persona through sale of doll figures imitating the singer by the defendant. The persona of the singer was characterised as quasi-property with economic value assigned with its identity.[32] Noting the instinctive association which the singer commands in the public, the court held that such identity had been subjected to to commercial use by the defendants to increase the sale of their product.[33] Thus, the defendants were siphoning off the publicity value in the singer's persona.[34]

The case of *Titan Industries* involved the publicity rights claim brought by Titan involving a right of publicity in the images of actors Amitabh and Jaya Bachchan. The

[26] *Mr. Arun Jaitley* v. *Network Solutions Private Limited*, (2011) 181 DLT 716.
[27] *Carson* v. *Here's Johnny Portable Toilets, Inc*., 698 F.2d 831 (6th Cir. 1983)
[28] *Midler* v. *Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988).
[29] *White* v. *Samsung Electronics America, Inc*., 971 F.2d 1395, 1399 (9th Cir. 1992)
[30] *Midler* v. *Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988).
[31] (2012) 50 PTC 486.
[32] *Id.* at 5.
[33] *Id.* at 13.
[34] *Ibid*.

actors appeared in an advertisement promoting the plaintiff's products. The defendant had copied the plaintiff's advertisement which was the exact replica of the advertisement endorsed by the plaintiff. The court observed that owing to the clear identifiability of the actors in the defendant's advertisement it was liable for infringing the publicity rights of the actors.[35]

Therefore, the indica of identity used by the defendant becomes a crucial test to ascertain infringement. Usage of identity should be such that it is a direct reference to the commercial appropriation of a celebrity persona and not merely incidental. This becomes essential as often a publicity right is seen to stifle creativity and freedom of speech. An infamous example of this is the US case of *White v. Samsung Electronics*. The case involved a TV commercial where Samsung intended to show the universality of their products in the future. For this idea, they employed a robotic reference of celebrity host Vanna White next to her 'Wheel of fortune'-a gameboard used in her show. It was argued that the robot-lookalike and the usage of the game board was a misappropriation of White's likeness which was not consented to by her. This case has been subject to intense criticism owing to the Court awarding a right of publicity claim in White's favour. It has been argued that such likeness might be distinctive to White. However, it does not have an element of deception or confusion essential in a publicity rights claim.[36] The usage of White by Samsung has been described as a metaphor or reference in the advertisement which cannot qualify for a commercial misappropriation even if it has been used in a commercial sense.[37] The dangers of overprotection by a right of publicity have been described to hamper the recreation of a role created by a performer in a different setting.[38] In conclusion, decisions like that of Vanna White have been instrumental in overemphasis on publicity rights to protect indicia which do not really deserve protection.

To prevent such overboard usage of publicity rights over a celebrity persona, the second half of the article seeks to endorse a controlled territory of the application of the right guided by the principles in intellectual property rights.

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[35] *Supra* note 19.
[36] Stacey Dogan and Mark Lemley, "What the Right of Publicity Can Learn From Trademark Law" 58 *Stan. L. Rev.* 1195 (2006).
[37] David S. Welkowitz, "Catching Smoke, Nailing JELL-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights" 3(1) *J. Intell. Prop. L.* 80 (1995).
[38] Leslie A Kurtz, "Fictional Characters and Real People" 51 *University of Louisville Law Review* 435 (2013).

IV. Infringement of Publicity Rights: Trademark Approach

This section seeks to cull out parallels between trademark law and publicity rights cases. It begins with understanding the identifiability prong of the test of infringement as given by *Titan Industries*. It then proceeds towards establishing a synergy between trademark law and publicity rights. It finally seeks to apply the laws of passing off and trademark dilution to such cases.

4.1 Identifiability of Celebrity Persona

Titan Industries defined identifiability as celebrity being identifiable from defendant's unauthorised use.[39] It further observed that infringement should only be traceable to the celebrity as a reference.[40] Further *DM Entertainment* observed that the evidence should establish the commercial appropriation of the plaintiff persona which should be sufficient, adequate and substantial. Sparse jurisprudence on publicity rights in India makes the author delve into legislation and case law from US to highlight identifiability further.

In US, the Restatement on Unfair Competition under Section 46 states that an appropriation of the commercial value of the person's identity for purposes of trade would be subject to relief under a Right of Publicity.[41] Further, Section 47 identifies the definition of "Use for Purposes of Trade" or commercial speech in cases of advertising, merchandising and used in connection with services rendered.[42]

In the case of *Newcombe* v. *Adolf Coors Company*, the plaintiff- former baseball player sued the defendant company which appropriated his identity for usage in a beer advertisement.[43] The plaintiff had a history of combating personal alcohol abuse and using his fame to speak out for issues concerning the same. The advertisement against which the plaintiff sued portrayed an illustration of a baseball game depicting a pitcher in a certain position with the beer product depicted next to it. The advertised

[39] *Supra* note 19 at 15.
[40] *Ibid.*
[41] Restatement (Third) of Unfair Competition, 1995, s.46.
[42] *Id* at s. 47.
[43] *Newcombe* v. *Adolf Coors Company*, 157 F.3d 686 (9th Cir. 1998).

illustration had a striking resemblance with the said photograph with the defendant later admitting that the illustration had been derived based on a prior published photograph of Newcombe. Holding that Newcombe's identity was a central figure in the usage by the defendant, the court observed that it was done to gain the consumer's attention to the defendant's commercial advantage.[44]

The above case depicts that the identifiability prong should be proved by showing a harm to the values and the image of the celebrity. It cannot be merely proved by an incidental usage of the persona. This is further elucidated by the next two sections.

4.2 Synergy Between Goals of Trademark Law and Publicity Rights

In a catena of decisions from both jurisdictions, the plaintiffs club their claim of a right to publicity / personality (as known in India) with a trademark infringement and passing off claim. A compelling explanation for protecting publicity rights is through drawing analogies from trademark law.[45] In an analysis on semiotic significance of trademark law, Professor Barton Beebe traces the history of source distinctiveness versus differential distinctiveness in the understanding of trademark as we know. The earlier motives of trademark were to protect property, promote competition and prevent fraud.[46] This function fixates on the source identifying attributes of trademark law. However, it has been described to successively decline accompanied with the rise of what is termed as differential domination. This refers to the effect that consumerism, mass production and advertising had on the public in the 20th century to the extent that the public was no longer concerned about the actual source of the mark. Citing Frank Schechter,

"...today the trademark is not merely the symbol of good will but often the most effective agent for the creation of good will, imprinting upon the public mind an anonymous and impersonal guarantee of satisfaction, creating a desire for further satisfactions. The mark actually sells the goods."[47]

[44] *Id.* at 692.
[45] *Supra* note 36 at 1190.
[46] Barton Beebe, "The Semiotic Analysis of Trademark Law" 52 *UCLA L. Rev.* 677 (2003-04).
[47] Frank I. Schechter, The Rational Basis of Trademark Protection 40 *Harv. L. Rev., 819* (1927).

This article by Professor Beebe does not particularly make any allusions to publicity rights. However, parallels in analysing semiotic significance of celebrity persona can be drawn from this discussion. A celebrity persona is known to sell goods based on the 'publicity value' and consumer perception attached to it.[48] It has been held by Indian courts that while trade mark is a property, it is not property in its pervasive sense.[49] It is the goodwill or reputation which becomes property that is sought to be protected by a trading name.[50]

In essence, by characterising celebrity persona as a type of trade mark, publicity law endows control over name or likeness in a celebrity identity and seeks to prevent unconsented affiliation being reflected from the defendant's usage. This is the strongest analogy which can be drawn between publicity rights and trademark law.[51] In all previously discussed case from both jurisdictions, the reason why courts analysed the identifiability requirement of a celebrity persona is to adjudge whether a proprietary control akin to a trademark is validly sought by the celebrity or not.

4.3 Applying Trademark Principles to Publicity Rights: Jurisprudential Trends

A celebrity identity needs to be understood as a distinctive trademark. Under Section 43(a) of the Lanham Act, usage of any name, symbol, word etc. or any false description or designation of any fact can lead to liability on two grounds [52] namely:

1. Likely to cause confusion (also termed as passing off in common law jurisdictions)
2. Misrepresentation of nature, characteristics, qualities etc. of the plaintiff' s or defendant's good via advertising or promotion.

In *Allen* v. *Men's World Outlet, Inc.*[53] the court recognised a false endorsement claim of a celebrity identity tantamount to that of the trademark holder's interest in a distinctive mark.[54] This is because celebrity endorsements in granting access to the goodwill garnered through their fame function in a similar fashion like trademarks do

[48] *Grant* v. *Esquire, Inc*., 367 F. Supp. 876, 879 ("This common law publicity right is analogous to a commercial entity's right to profit from the "goodwill" it has built up in its name.")
[49] *Induss Food Products* v. *Rani Sati Ice Cream Pvt. Ltd.,* (1998) 18 PTC 15.
[50] *Laxmikant V. Patel* v. *Chetanbhai Shah*, AIR 2002 SC 275.
[51] *Supra* note 36 at 1193.
[52] Lanham Act, Section 43(a).
[53] 610 F. Supp 612 (S.D.N.Y. 1985).
[54] *Id.* at 625-626.

in enhancing fame and marketability of products.[55] The Court of Appeals for the Ninth Circuit in *Newton* v. *Thomson* came strongly upon the misappropriation of publicity and unfair competition claims of the plaintiff. It gave a decision against the plaintiff by applying a strict eight-factor rule. These factors included impact of plaintiff's mark, comparison of goods, adjudging similarity and actual confusion, etc. Undeniably, the test adopted in *Newton* heavily borrows from the principles enshrined in trademark law.

The Delhi high court case *ICC Development (International) Ltd.* v. *Ever Green Service Station*[56] referred the infringement of publicity rights as passing off where the defendant affects the association created in the minds of the consumers with regards to the persona of the celebrity.[57] Thus, the focus is reduced on the intention of the defendant's actions.[58] Another Delhi high court case of *Arun Jaitley v. Network Solutions Private Limited*[59] established the distinctive nature of a personal indica such as the name of the plaintiff to be categorised as a trademark. Recognising the special status of publicity rights arising from an intimate connection to persona, the court held that such entitlement to a personal name is on a higher pedestal.[60]

Considering fame associated with a celebrity persona as a trademark, it gets diluted by the defendant's actions of false endorsement harvesting on a favourable association and emotional responses created by the celebrity's identity.[61] This rationale is highly applicable for publicity rights which has been portrayed to serve a dual purpose of commercial and personal interest. The unique associative effect of a celebrity identity can be affected if the defendant use seeks to threaten the values for which a celebrity is known.[62] This is most common in advertising cases where the celebrity does not consent to be affiliated to a product (such as alcohol[63]) which would render his fame as diluted. In *DM Entertainment* v. *Baby Gift House,* the court held that a false endorsement of the persona of Daler Mehendi through manufacturing of dolls not

[55] *Fraley* v. *Facebook Inc.*, 830 F Supp 2d 785, 800.
[56] 2003 (26) PTC 228 (Del).
[57] *Ibid.*
[58] *Ibid.*
[59] (2011) 47 PTC 1.
[60] *Id.* at 29.
[61] Mary LaFrance and Gail H Cline, "Dilution and the Right of Publicity: Cousins?" 24 *Santa Clara Computer and High Tech LJ* 643 (2008).
[62] Robert C. Deniola, "Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols" 62(4) *N.C. L. Rev.* 638 (1984).
[63] *Supra* note 43.

consented by him, amounted to 'clear dilution' of the uniqueness in his personality.[64] Similarly, in a cybersquatting case involving Cyrus Mistry, the Delhi high court held that the defendant's action of commercially exploiting Mistry's name amounted to dilution of his persona as an eminent businessman.[65] It was further held that such unsolicited activities also diluted the overall distinctiveness of his prestige and repute.[66]

Thus, this section depicts the possible analogies that publicity rights can legitimately draw from trademark law. Passing off on celebrity's goodwill can lead to a likelihood of confusion affecting the evocative nature of the persona. The dilution doctrine further extends the motives of trademark law beyond mere economic considerations. In the author's opinion, trademark dilution offers a stronger analogy than passing off as it deals with disparagement and loss of goodwill than merely creating confusion.[67] For a celebrity, misappropriation of his/her persona for unsolicited uses shall have a profound dignitary effect when such use attacks the values that the celebrity is known for.

V. Exceptions to Publicity Rights under Copyright Law

Copyright law traditionally has been in place to protect and incentivise literary, artistic and dramatic expression. A person creating a work which is an original expression of an idea will be validly granted a copyright in it. As a corollary, the copyright holder has the right to use, modify, and distribute the work as per his will. A person is further allowed to create derivative uses of any copyrighted work including his own work. These negative spaces of copyright law are covered under Section 52 of the Indian Copyright Act and Section 107 of the US Copyright Act under fair use/fair dealing provisions. The collision between copyright law and right of publicity occurs where a copyright pre-emption defence is invoked against a consented use of a celebrity identity.

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[64] *Supra* note 23, para 15.
[65] (2016) 65 PTC 337, para 41.
[66] *Ibid.*
[67] *Supra* note 36 at 1195. ("Consumer confusion justifies the establishment of a right of publicity only to the extent that there actually is consumer confusion.")

The relative ease in justifying trademark principles in a right of publicity is not the case when it comes to copyright law. The ground rule in copyright law is precluding ideas from being monopolised. It has been argued that persona is an idea or style; a manifestation of fame which is intangible. Both the requirements of expression and fixation for a valid copyright are difficult to justify for persona of a celebrity. Thus, instead of establishing a case for a copyright of publicity, this section seeks to explore exceptions for publicity rights based on copyright law.

Broadly speaking, an exception of the nature of copyright pre-emption copyright should only prevent a right to publicity claim from prevailing when the identity appropriated is protected separately under a copyright based upon the creation of the producers. The scope of 'persona' of a celebrity should essentially be based on the real life/real name and likeness of the celebrity and not derived from a copyrighted work owned by a third party. In US, the courts apply the Supremacy Clause enshrined under the US constitution and Section 301 of the Copyright Act to adjudicate copyright pre-emption for publicity rights. For the application of this clause:

1. Subject matter should be an original copyrighted work in a tangible medium

2. The rights sought under the state law should be equivalent to Section 106 of the Copyright Act establishing exclusive rights in a copyrighted work.

For instance, the court invoked the Supremacy clause in Fleet v. CBS where the appellants had not been compensated for their role in a film leading to the appellants bringing an action seeking prohibition against the producers to release the film and capitalising on their identities. Applying the Supremacy clause, the court noted that while the name and likeness of a celebrity is protected, the conversion of such persona into a dramatic work by the owner of the work will not be protected under a publicity claim.

This clause finds interesting application in Kajal Aggarwal v. The Managing Director, V.V.D & Sons P. Ltd which the author believes to have been wrongly decided. The case involved the plaintiff-actress entering into a contractual arrangement with the respondent-company for promoting their hair oil through various mass media including films, television, magazines, hoardings etc for a one-year term. It was alleged by the actress that despite the termination of the contract, the respondents

continued to exploit her pictures and name through the copyrighted promotional material created during the term of the contract. This was contended to severely affect her control over her identity and her economic ability to be associated to other brand endorsements by the virtue of her fame and identity. The respondents contended that since they owned a copyright in the promotional material featuring the actress, they had a right to further exploit the copyright of the film vesting in them. The question for consideration was whether the ad-film and promotional material forming part of their copyrighted work can be commercially exploited beyond the term of the contract.

The court began with the first owner provisions under Section 17 of the Indian Copyright Act,1957 to establish that the person who employs/commissions/contracts for a work to be created is vested with the copyright in the work even though the work is produced by someone else. However, it favoured the actress for a right of publicity claim in what can be termed as an excessive control over her identity. In the author's opinion, while there does not exist any Indian law similar to the Supremacy clause, Section 17 under the Copyright Act still provides protection to the defendants in this case. The economic consideration in exploitation of the actress's identity is fulfilled through the fee that would have been paid to her under the contract. There is no further interest prevailing in the actress's favour to be granted a right in the commercial exploitation in her identity to the extent that it tramples the valid copyright held in the copyrighted work by the respondent company.

VI. Conclusion and Remarks

A reservation that the author has is with the case of *Titan Industries* in how the validity prong has been defined. The definition has a considerable influence derived from *Haelan Laboratories*. In an insightful observation, publicity rights scholar Jennifer Rothman observes that the impetus for adoption of publicity rights through *Haelan* was not the driving force in the law. She argues that the facts of the case portray that private companies needed stronger tools to control celebrity identities from being

licensed further by the celebrity.[68] This impetus is visibly present in the test of identifiability evolved in *Titan Industries Ltd.* v. *M/s Ramkumar Jewellers.*[69] In the author's opinion, instead of defining validity as something the plaintiff owns as an "enforceable right in the identity or persona of a human being", it should be defined on the basis of indicia of identity over which the celebrity has the sole commercial control. Reading this right as being owned by the plaintiff-company mars the entire concept of autonomy and commercial exploitation of a persona being vested in the identity holder.

Based on the research of studying publicity rights under the lens of intellectual property rights, the author does not endorse the idea of a separate sui generis legislation for its protection as has been popularly proposed by many authors.[70] Instead, some amendments to the Trade Marks Act, 1999 can serve the motive.

Some suggestions for the same have been explored below.

1. ***Amending the definition of trademark***: Section 2(m) of the Act enumerates types of signs which can qualify for a trademark. This includes name and signature. Thus, to bring publicity rights under the domain of trademark law, 'persona' of a celebrity can be added to this clause for establishing trademark rights in the identity.

2. ***Adding an additional chapter to deal with publicity rights***: The test for infringement of a persona has a different requirement as compared to the provisions under Section 29(4) dealing with registered marks. The act can cater to the needs of misappropriation of a persona by incorporating the test of infringement under a separate chapter in the Act. This chapter shall explain the following provisions.

    a. ***Validity of a publicity infringement claim***: This provision would cover the first prong of the infringement claim stating that a

[68] Jennifer Rothman, *The Right of Publicity: Privacy Reimagined for a Public World* 46 (Harvard University Press, 2018).
[69] (2012) 50 PTC 486
[70] Anurag Pareek and Arka Majumdar, "Protection of Celebrity Rights-The Problems and the Solutions" 11 *J. Intellec Prop Rights* 423 (2006); Dr. Kalyan C. Kankanala and Sandeep Hegde, "Publicity Rights in India" 39 *N. Ky L Rev.* 264 (2012); Souvanik Mullick and Swati Narnaulia, "Protecting Celebrity Rights Through Intellectual Property Conceptions" 1 *NUJS L. Rev.* 634 (2008).

distinguishable persona must be established by the identity holder. This shall include name and likeness of the celebrity.

b. ***Identifiability through defendant's use***- This provision would state that an indicium of identity belonging to the identity holder should be identifiable from defendant's use.

c. ***Provisos***- Any commercial speech cannot automatically come under the axe of publicity. The defendant's use in incorporating a persona should depend whether such usage is directly capitalising the celebrity's identity or merely incidental in usage.

The proviso shall further provide exceptions to a right of publicity on the basis of fair dealing under the Copyright Act, 1957. This would cover situations of use in a copyrighted work under Section 17 of the Copyright Act, parody, satire, news-worthiness and criticism.

When celebrated American pop artist Andy Warhol said, "In the future everyone would be world famous for fifteen minutes" he could not have been more apt. As the world plunges into the virtual world of Instagram, Twitter, Facebook and You tube, new forms of advertising and promotion are constantly being evolved. The barriers to achieve fame are at a decline owing to freely accessible and democratic platforms for endorsements. In such times the law on publicity rights is bound to expand as the years progress. Enforcement of right to publicity has never been more essential than now. It is hoped that the Indian courts continue to be proactive in protecting publicity rights. Along with this, the involvement of the legislature to grant a statutory recognition to publicity rights by way of amendments cannot be overstated.