

Country correspondents

The Country correspondents section of *World Trademark Review* is a feature in which leading firms from countries across the globe take a detailed look at a specific topic affecting trademark owners

Publicity and image rights

In this issue the correspondents consider publicity and image rights in their respective jurisdictions

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Publicity and image rights in India

India is yet to recognize the rights of publicity and image as distinct legal rights. However, individuals may rely on an accepted framework of IP and other rights to prevent the unauthorized exploitation of their names and images

The right of publicity and the right of image flow from the right to privacy of individuals. In a nutshell, such rights refer to the right of an individual to control the commercial use and exploitation of his or her identity. Originally, the right of publicity protected only the unauthorized use of an individual's name, likeness and image. However, it has now been expanded to protect all the attributes that identify a particular person – namely, his or her identity. Image rights are still considered as a sub-category of publicity rights.

The identity of an individual refers to all distinct, recognizable elements which make up a particular persona, including the individual's physical appearance, image or likeness, name, voice, signature, style, photograph, gestures, recognizable attire, look and facial features.

The right of publicity is a right *in personam*, which is exercised by the individual or by a third party exercising such right on behalf of the individual following assignment or inheritance. The right of publicity encompasses the right to initiate an action to:

- prevent the wrongful appropriation of an individual's identity for commercial purposes without his or her consent; or
- seek compensation.

The Indian position

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

Protection of publicity and image rights as intangible IP assets

Trademarks

Individuals may apply for the protection of their name, likeness and nicknames, among other things, with the Indian Trademarks Registry in order to obtain statutory protection against misuse. This is of strategic importance for celebrities who intend to use their image and likeness to identify their own or an authorized line of merchandise. Recently, well-known Indian actress Mallika Sherawat registered her name as a trademark.

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

- the reputation of the individual;
- some form of misrepresentation; and
- irreparable damage to the individual.

Use of a celebrity's name as part of a domain name may also be prevented under trademark law by:

- bringing an action before a court of law; or
- filing a complaint under the Uniform Dispute Resolution Policy procedure of the Internet Corporation for Assigned Names and Numbers.

In *DM Entertainment v Jhaveri* (Case 1147/2001), Daler Mehndi, a famous Indian composer and performer, brought an action against the defendant following the registration of the domain name 'dalmehndi.net'. The Delhi High Court restrained the defendant from using the trademark DALER MEHNDI, thus recognizing the fact that an entertainer's name may have trademark significance. Another case involving an Indian citizen was that of Ratan Tata, the chairman of Tata

Group, who filed a complaint before a World Intellectual Property Organization (WIPO) arbitration panel seeking the transfer of domain names comprising the name Tata (see *Tata Sons Ltd v Ramadasoft* (Case D2000-1713, February 8 2001)).

However, the adoption, use and protection of an individual's name as a trademark may raise the following contentious issues:

- Use of the trademark in relation to the goods and/or services covered – it is important to distinguish between the types of product that a celebrity could reasonably trade under his or her name and goods which are mere 'image carriers' (eg, posters, photographs and figurines).
- Genuine use of a name that is similar to that of a celebrity – a celebrity's rights in his or her name may trump the rights of a person sharing the same name. However, the Trademarks Act 1999 recognizes that an individual may use his or her own name in good faith. Such an issue arose before a WIPO arbitration panel in 2001 (Case D2001-0537). In this case, an individual, A R Mani, scored a victory against fashion house Armani in relation to the domain name 'armani.com'.
- Cancellation on grounds of non-use – in the absence of actual use of the name as a trademark, the mark may be subject to an action for cancellation on the grounds of non-use, especially in light of the fact that a well-known name is likely to be protected for all classes of goods and services.
- Endorsement by multiple individuals – where a group of celebrities is associated with a product, it may be difficult to define how the cumulative reputation and goodwill in the product might be ascribed to any particular individual.

Copyright

Copyright law may protect a specific image in the form of a photograph, painting or other derivative works. However, complications arising out of the issue of ownership of a specific image make it difficult for individuals to protect their likeness, name or image under copyright law.

Protection under the right to privacy

Protection as a constitutional right

The right to privacy protects individuals against unlawful government invasion. This was illustrated in *Rajagopal v State of Tamil Nadu* (AIR 1995 SC 264), in which restrictions on the use of a person's biography were envisaged. The right to privacy protects all individuals, whether Indian or foreign, against omissions and/or acts of the state. This right applies in case of invasion of the private sphere, rather than use of an individual's likeness.

Protection through a tort action

A person whose privacy has been infringed by a private individual may seek compensation through a tort action, which may be coupled with an action for defamation, breach of confidence and/or misappropriation.

Protection under the unfair competition legislation

The unfair competition legislation, the Competition Act 2002, prohibits anti-competitive practices which harm the interests of consumers. Such practices include, among other things, any act that suggests a sponsorship or endorsement which is untrue and/or misleading. Hence, use of the name or image of a celebrity which creates the impression that the celebrity endorses a product may fall under the provisions of the act.

So far, only a few provisions of the act have come into force; the remaining provisions will come into force in a phased manner. In the meantime, individuals may rely on the provisions of the Monopolistic and Restrictive Trade Practice Act 1969.

Protection under the advertising legislation

All advertisements are governed by the Code for Self-regulation in Advertising, which was adopted by the Advertising Standards Council of India. The code provides that:

- advertisements should contain no references to any individual, firm or institution; and
- the image of an easily identifiable



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individual may not be used without permission.

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

Protection under the Emblems and Names (Prevention of Improper Use) Act 1950

This statute prohibits the use for commercial purposes of the names of certain personalities (including Mahatma Gandhi, Pandit Jawaharlal Nehru, Chhatrapati Shivaji Maharaj and the Indian Prime Minister) and the name, logo or symbol of institutions listed in its schedule, except with permission of the government. Individuals who are not listed in the schedule may also invoke the provisions of the act.

Exceptions and limitations

Conflict with freedom of speech and expression

The right of image of an individual often clashes with the freedom of speech and expression of others (in particular, the media) under Article 19 of the Constitution. In several instances, Indian celebrities have challenged the use of this freedom. However, the use of photographic images and material is protected where it serves the public interest. Similarly, commentary and parody are valid defences.

Post partem assertion of publicity rights

Issues may arise out of the devolution of the publicity rights of celebrities to their legal heirs (see the case of Princess Diana or Elvis Presley).

Roadmap for celebrities

In light of those uncertainties, a celebrity should:

- ensure that a written consent is signed in every sponsorship, marketing or endorsement situation where a third party obtains commercial benefits;
- ensure that the consent agreement is specific (permitted uses, media and timeframe); and
- specify in writing which images should not be made public or used in certain ways.

In light of the increase in celebrity endorsements, India must recognize the right of publicity and image of famous individuals in order to manage the situation for the benefit of all parties. [WTR](#)