CELEBRITY MARKS: AN EMERGING CONCERN
A celebrity is entitled to use publicity or image rights to commercially exploit the goodwill associated with their fame. Amit Mahajan explains.

Simply put, rights of publicity or image rights allow a celebrity to charge for the use of their name, likeness, photograph, voice or personality. The law enables protection against the unauthorised exploitation by others of the goodwill associated with the celebrity. Legally, celebrities are no different to other providers of goods or services to the public and qualify for the same level of protection. As commercialisation is evolving, we have witnessed celebrities acquiring brand status and registering their names as trademarks—Michael Jackson, Elvis Presley and the Spice Girls are examples.

The concept of publicity rights is based on the idea that every individual should have control over commercialising their persona. Stars invest a great deal of hard work and talent in acquiring their status and are entitled to reap the benefit of their efforts. There are two facets to this concept. One is the right to publicity—to prevent one’s name, likeness, or any facet of one’s ‘image’ from being commercially exploited without authorisation or compensation, somewhat like a trademark. It is a transferable, licensable, even descendible right that outlives the celebrity and can be exploited by their heirs. The second facet of the right, odd as it might sound, is the right to privacy—the right to be left alone and to prevent the representation of one’s personality without permission.

Celebrities usually charge a licence fee for the use of their name, image or other attributes in advertising or merchandising. The unauthorised use of a celebrity’s personality can be a species of passing-off, of unfair competition or of misrepresentation, and can even cause reputational damage. It can also amount to a breach of confidence or a violation of privacy.

During the early 1990s, courts were reluctant to consider celebrity marks as subject matter under a trademark regime. But gradually the scenario is changing:

UK and Europe

The UK Patent Office has revised advice given to its own examiners in connection with the trademarking of the names of famous people and groups. It referred to past court decisions on trademarks for Elvis Presley and Arsenal.

In a decision of 1997, a UK court ruled that ‘Elvis Presley’ could not be registered as a trademark. Memorabilia. Elvis fan and businessman Sid Shaw challenged the trademarks registered by a company selling toilet preparations and other products branded as Elvis Presley. The court ruled that neither the deceased singer nor anyone else exclusively owned the name and that it was so well known that it was no longer distinctive and therefore not eligible for trademark protection.

Then, in 2001, the UK court ruled that the trade mark ‘Arsenal’ was validly registered, even though it could be and had been used by others in a non-trademark sense. The judge concluded that this did not automatically make the trademark non-distinctive for scarves and other merchandise associated with the football club.

Although Arsenal is the name of a famous football club rather than the name of an individual or group, the Patent Office says that a similar point arises with the name of a person or organisation that others wish to use in order to demonstrate their support/allegiance. These should be registrable as trademarks for relevant goods, according to the office. The decision in the Arsenal case indicates that such protection should not be automatically refused or invalidated in these circumstances.

Practice Amendment Notice

The Trademarks Registry at the UK Patent Office has recently issued a Practice Amendment Notice governing the ‘Names of Famous People (living and deceased) and Groups’. This amendment allows celebrities to control the use of their names beyond their primary field of operation and would effectively give them far greater control, backed up by law, than is allowed to others who register their business name as a trademark for typical commercial activity.
Trademark use in Europe: revisiting Arsenal in the light of Opel and Picasso

Two relatively new European Court of Justice cases may help clarify the issue. In OPEL, the ECJ suggested that infringing use of a trademark must be use that is seen by the relevant public as a designation of origin. The Picasso decision limits the effect of the Arsenal decision on the relevance of confusion in non-sale situations to the facts of that specific case. In particular, it stresses the point that when assessing the likelihood of confusion in the context of an opposition to an application for registration, the court should focus on the perception of the relevant public at the point of sale.

The US situation

In the US, the law dealing with celebrities' trademark protection and First Amendment defences is splintered within and among the federal circuits. When a celebrity takes issue with the use of their name or image in artistic works used in commerce, such as popular music or film, First Amendment concerns arise. Creation of a message, by its nature, conflicts with attempts to control that message. Creative works, or their tides (when they include a celebrity's name), could imply endorsement or involvement. Three tests—likelihood of confusion, alternative avenues and the Rodgers balancing test—are used to determine whether this type of use is permitted under the false endorsement section of the Lanham Act, Section 43 (a), in light of First Amendment freedom of speech.

A plaintiff claiming to be a celebrity for the purpose of trademark infringement must have been a celebrity at the time of infringement in order to have standing. The Lanham Act protects against economic injury, so plaintiffs must have an economic interest in their names at the time of infringement for it to be actionable. The potential for commercial interest at a later time is insufficient.

Misappropriation of personality

Courts have defined 'personality' to include a person's image, name, voice and any other elements that might uniquely identify a celebrity. In order for a celebrity to plead misappropriation of personality, they must show that the advertiser has used their personality for commercial gain. Although it does not matter whether the celebrity is living or dead, misappropriation of personality does not apply to fictional characters.

The Indian situation

Section 2 (1) (eb) of the Trade Marks Act, 1999, defines a trademark as follows:

"A mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours."

Emerging paradigm of celebrity marks

When compared to the global regime, India has been lagging behind in regard to publicity rights, without a body of case law, nor any comprehensive statute governing image or publicity rights. The legal system in India is quite inadequate to deal with the modern trend of endorsement advertising. However, the law has started to evolve in recent years and the High Court of Delhi has ruled on the matter. Image rights in India as conceived by the Delhi High Court arise from the right of privacy, which has emerged through a case-by-case development in India and flows from human dignity as enshrined in Articles 19 and 21 of the Constitution. When publicity rights are treated as commercial property, they get a limited amount of protection under the following intellectual property laws.

Section 14 of the Trade Marks Act, 1999, provides that where an application is made for the registration of a trademark that falsely suggests a connection with any living person, or a person whose death took place within 20 years prior to the date of application, the Registrar may require the applicant to furnish him with written consent from the living person or, as the case may be, the legal representative of the deceased person. So no unauthorised use is possible.

Section 38 of the Copyright Act, 1957 recognises performers' rights. Section 57, which recognises the moral right of the author, can also be used to protect the reputation of the author. In Amar Nath Sehgal v Union of India, the Delhi High Court observed that many rights flow from a creation, including paternity rights in the work.

In India, an action for protection of image rights/personality rights can also take the following forms:

1. An action for violation of the tort of privacy with requests for an injunction and damages
2. An action for passing-off and infringement
3. An action for breach of confidence with requests for an injunction and damages
4. An action for defamation, civil or criminal. A civil suit may seek an injunction and damages

5. An action for the economic tort of unlawful interference with business or the procurement of breach of contract where the plaintiff celebrity has a subsisting contract with a third party to commercially exploit his images/likeness in any manner.

In India, competition in the market is becoming fiercer by the day. The advertising industry is one of the major service sectors. Indian celebrities are also growing in stature. Celebrities such as Amitabh Bachan, Sachin Tendulkar and many more have acquired brand status, which has every possibility of being misused.

Conclusion

A publicity right is a distinct right, which requires special attention due to its unique nature. Thus, it rests with the legislature to recognise the commercial and property rights aspects of publicity rights to fill up the lacunae in law and keep up with the rapid commercialisation of personality and the development of the Internet. While doing so, the legislature should also adequately balance the public interest and the individual interest of the celebrity. The statute should also reflect the need for preserving human dignity and the need for efficient commercial use of property beyond a person’s lifetime.

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Amit Mahajan has been handling all aspects of trademark opposition and prosecution over the years. He has also been involved in filing rectification/cancellation actions, filing appeals and miscellaneous petitions at the IPAB, attending hearings and arguing matters at the Trade Marks Registry and the IPAB, and rendering legal advice and opinion to clients. Mahajan has also represented the firm at various conferences, including the INTA Annual Conference 2009 and the BRIC IP Forum.