

PROTECTION OF PERSONALITY RIGHTS IN INDIA: ISSUES AND CHALLENGES

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Abstract

The protection of personality rights is an emerging issue in India because the commercial exploitation of personality has increased much more compared to the earlier period. The major problem in India is the lack of proper protection for personality rights, even though the judiciary had tried to cover the issues under the existing IP laws such as trademark, passing off, and copyright. It is high time to look further at whether the existing laws are adequate to cover the personality rights related issues in the present context. This is more so because, as the technologies developed, there has been changes in the market aspect, and this has led to an increase in the commercial exploitation of personality right without appropriate consent. Further, as far as personality rights are concerned, the right aims to protect unauthorized use of personality rights. Therefore, this paper aim is to test whether the existing intellectual property laws are apt for personality rights protection. If not, the paper addresses the question as to what will be the means to address such issues.

Keywords: *Personality Rights, Trademark, Passing Off, Copyright, Commercial Exploitation*

Introduction

The concept of personality right encompasses the right of a person to control the unauthorized use of their personality attributes such as name, image, voice, likeness, etc. Though the right includes both commercial and non-commercial aspects, each jurisdiction views the notion of right in a different way, either as a single right that covers both commercial and non-commercial aspects or else as considering both aspects as two separate rights. Therefore, the terminology used by each jurisdiction varies; whereas in India, “personality rights” and “publicity rights” - are terms used interchangeably. In the current context, more issues have cropped up revolving the commercial aspect of personality right. Hence the concept of personality rights is an emerging topic in the current context, especially in India. When the commercial aspect of personality got its prominence in the market, this in fact vested significance to the value aspect of persona, which further expedited to acquiring consequential attention in the realm of intellectual property right. Also, currently, when marketing has become the primary way of doing business, which led to a rise in competition; this, in fact had

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impacted personality right by the increase in the possibility for commercial misappropriation of personality right¹. To control such unauthorized use of personality rights, countries like US, Germany, and Guernsey introduced their own statutory laws² for protection of personality rights.

In India the concept of personality right was first recognized by judiciary in the twenty-first century³, however much prior to that in the mid-twentieth-century the right was recognized in the aforesaid said countries. Even though in India the courts had initiated to recognize such right, there has been a lack of clarity on the concept of personality rights and also legal gaps for the protection of personality right due to lack of adequate laws in this regard. Nevertheless, Indian courts used the existing IP laws for the protection of some attributes of personality rights such. For example, under trademark, name, signature were protected; under copyright, the performance of personality was protected. Thus, it is clear that in India limited aspects of personality are covered under existing IP laws; yet, protection of other attributes of personality are not dealt under any existing laws.

Protection of Certain Aspect of Personality Right Under IP Laws

Existing legal protection

The closest law to protecting personality rights in India is Article 21 of the Indian Constitution.⁴ But as it leaves out the commercial aspect of personality rights to some extent, the Indian courts applied the provisions under copyright, as well as trademark, for granting protection of certain aspects of personality rights. Even in some cases passing off has been used to protect personality right. While taking some of the India cases into consideration regarding the protection of personality right under existing IP laws, it may appear as though the existing laws are adequate enough to grant protection for personality rights. However, a deeper analysis surpassing the peripheral view, points to a necessity that there are several aspects and intricacies left unaddressed which makes the existing IP laws inadequate. But the courts have ignored these facts and granted remedy. While doing so it has left out the entire subject matter

¹Protection Of Publicity Rights in India- Chambers of Namrata Pahwa-2020 available at <https://www.chambersofnamratapahwa.com/post/protection-of-publicity-rights-in-india> (last visited on June 23, 2023)

² German Civil Code, section 12, Federal Law Gazette Germany, *Act on Copyright in Works of Visual Arts and of Photography* (KUG), section 22 and 23, Federal Law Gazette Germany, 1907 *Germany's Basic Law*- article 1 and 2 - Federal Law Gazette Part III Germany, 1949. *French Civil Code* (1804)- article 9 and 1382, US state law of publicity right and *Restatement (Third) of Unfair Competition*, 1995(USA), Section 46, Lanham Act 1946 (A)(USA), section 43(1).

³*ICC Development (International) v/s Arvee Enterprises and Anr* (2003) Delhi 405, (India) *D.M Entertainment Pvt. Ltd. v Baby Gift House And Ors.* (2010) MANU Delhi 2043.

⁴ *R. Rajagopal v. State of Tamil Nadu* (1995) AIR SC 264.

of personality, such that, as stated in the introduction, only limited personality attributes are seen to be protected under the existing IP laws⁵. Also, in some cases, courts have interpreted the protection of personality rights in a similar way to well-known trademarks protection.⁶ Also for some extent, trademark laws help to regulate the unauthorized use of personality attributes; for example, in *D.M. Entertainment v. Baby Gift House*⁷, the primary case in India that dealt with the commercial aspect of personality right for the first time. In 1996, the plaintiff (Indian artist Daler Mahendi) established a business called D.M. Entertainment Pvt. Ltd., where they had a registered trademark for the letters DM, which stood for their name and all the rights, including right of publicity, commercial endorsement, and other associated rights, were given to the company. And the defendants who own and operate toy and gift stores around Delhi. The dispute is around the selling of Daler Mehndi-inspired dolls, one of which sung a few lyrics from his songs by defendant. The plaintiffs claimed false endorsement, passing off and infringement of the right to publicity. Due to the absence of a specific legislation protecting personality rights, the court provided remedy invoking provisions within the trademark law, such as passing off and false endorsement.⁸

Grounds for Protection Under Existing Laws

Though the court granted remedy under trademark as well as passing off, certain factors can be identified as the reason for giving remedy under this law; first, the plaintiff had a registered mark in his name, and a trade-in relation to the name; and the caricature of the plaintiff was covered under the preview of description of the article sold. Therefore, such use, in fact, amounted to infringement of the registered mark. Second, the person is a well-known personality, thus the passing-off remedy is also simple since, as in the case of a well-known personality, even while use does not lead to consumer confusion, it does benefit on the well-known personality's goodwill which constitutes an act of unfair competition sufficient to claim under passing off. Also, such unauthorized use of his unique identity feature amounts to dilution of their mark; this is also a ground for seeking remedy under passing off. Third, dilution of the uniqueness of personality also gives rise to false belief that the plaintiff has either licensed or the plaintiff have some connection with defendant's product or service which

⁵ Trade Marks Act, section 2(m) - Acts of Parliament- 1999(India) -name and signature, Copyright Act, section 2 (qq) Acts of Parliament- 1957 (India).

⁶ CS (O.S.) 893 of 2002 (Del.) (India), *Arun Jaitley v. Network Solutions Pvt. Ltd.*, (2011) 181 DLT 716.

⁷*Ibid.*

⁸ *Id.* at 7.

amount to false endorsement⁹. All these factors point to why the court granted remedy under trademark. This actually indicates that to claim personality right protection under trademark, these factors are to be present.

Although trademark law may be a better analogy for understanding the ambit of the personality right, in some cases, copyright can also be applied by the court to provide protection of personality right even though the Act does not *prima facie* mention the personality right occupancy but certain sections under the Copyright Act can help furnish a viable remedy for infringement of personality rights. The main provision used under copyright are, Section 2(qq)¹⁰, which defines performer if personality comes under the purview of performer definition; section 38¹¹, where-under performer right can also be claimed, which, in fact, prevents unauthorized marketing of one's performance. In some cases, Section 57¹² also can be applied, which provides protection under the ground of moral right. Further in some other cases¹³, the court can be seen to have applied Section 17(b)¹⁴, for example, in *Titan Indus. Ltd. v. Ramkumar Jewellers*.¹⁵ The issue in this case was that the defendant had set up billboards showing Amitabh and Jaya Bachchan, (two well-known Indian stars) endorsing the defendant's jewellery shop. The plaintiff raised the plea of personality rights infringement based upon the contract (where the personalities assigned their personality right to plaintiff); further, the plaintiff filed a suit seeking injunction restraining the infringement of copyright, misappropriation of personality rights, and passing off damages. Court held that according to Section 17(b) of the Copyright Act, 1957, the plaintiff is the owner of the copyright in the said advertisement which in fact can be substantiated by the endorsement agreements, which clearly state copyright ownership is with the plaintiff¹⁶. Therefore, the defendant's dishonest use of a similar advertisement for their products on the hoardings and the reproduction of the celebrities

⁹ Id. At 7.

¹⁰ Copyright Act, (Acts of Parliament 1957), s. 2(qq)- "*performer*" includes an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance.

¹¹ Id., s. 38.

¹² Id., s. 57.

¹³ *Titan Industries Ltd. V Ramkumar Jewellers*- 2012 (50) PTC 486 (DEL); *Kajal Aggarwal vs The Managing Director* (2011) c.s.no. 635.

¹⁴ Id at 12. S.17 (b) subject to the provisions of clause (a), in the case of a photograph taken, or a painting or portrait drawn, or an engraving or a cinematograph film made, for valuable consideration at the instance of any person, such person shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

¹⁵ *Titan Indus. Ltd. v. Ramkumar Jewellers*, (2012) 50 PTC Del 486.

¹⁶ Id., at 12, s. 17(b) the plaintiff is the first owner of the copyright in the said advertisement and this fact is substantiated by the endorsement agreements which clearly state that ownership of copyright is with the plaintiff.

in the same context as the plaintiffs amounts to the infringement of copyright rights¹⁷. Here the court tried to address the right of the plaintiff under the purview of the first author of the work, and consider the aspect of personality as a performer¹⁸. Along with copyright, the court also laid down elements comprising the liability for infringement of the publicity right, with the first element being validity, which the plaintiff must hold an enforceable right in their persona or identity¹⁹ and the second factor, identifiability which the celebrity must be recognisable from the defendant's illegal usage.²⁰ If personality is identifiable, then infringement of the publicity right does not require proof of confusion or falsity. From these elements, it clarifies that falsity or deception is not an element for an infringement claim; rather, the plaintiff's identity must be "identifiable" from the defendant's illegal commercial use in order to constitute infringement of the personality right. So, it may be concluded that according to the cases, only celebrities have the right; but left addressed here is the question as to what will be the remedy for a lesser-known person when they are to be granted protection under personality based upon the above-said elements. This question is not yet clarified by any court in India. In this case even protection under copyright is granted only because plaintiff has ownership over the copyright in the advertisement. What if the personality attributes are not subject to copyright? How is the remedy to be provided in this situation? All of these factors in reality show how inadequate the judiciary has been in applying various intellectual property rules to safeguard personality rights.

Inadequacy of Protection of Personality Rights Under Existing IP Regimes

In the existing IP regime, the most common IP law used to regulate personality rights is trademark because both personality rights and trademarks provide a legal framework for commercializing the personality features.²¹ Even though personality features are protected through trademarks, the protection under trademark is inadequate due to certain factors. The first factor, which is also the most significant one, is the differences in the scope of protection, as in the case of personality right, it encompasses the exclusive right to control the commercialization of the personality attributes. In contrast, trademark confers an exclusive

¹⁷*Ibid* at 15

¹⁸ *Supra* note 10 at 4.

¹⁹ Harshada Wadkar and Drishti Trivedi Publicity Rights and Its Scope in Intellectual Property Laws *available at* <http://www.iplink-asia.com/articles/114> (last visited on June 23, 2023) .

²⁰ *Id.* 15 at 4.

²¹ Anne Lauber-Ronsberg, The Commercial Exploitation of Personality Features in Germany from the Personality Rights and Trademark Perspectives, 107 TRADEMARK REP. 803 (2017).

right to the owner of the mark with the right to use the sign in connection with the specific goods or services to signify their commercial source.²² In short, trademark is granted to indicate the quality and origin of the product; whereas the aim of personality rights is different as it is used to control the use of persona. Therefore, it can be said that the subject matter of protection of trademark is inadequate. So far as the second factor is to go by, even if under trademark the personality can be protected; such protection is possible only if the person has a registered trademark. And registration under trademark is only possible if the sign is distinctive and can identify and distinguish particular goods emanating from one producer or origin, not from another. The element of distinctiveness can be easily recognized in personality right as every individual have some sort of uniqueness in their personality, but the issue arises with regard to the second element, that is, the requirement to use the sign with regard to the specified products or services in order to indicate their commercial origin. In every personality case, it is impossible to have a trade relation for the personality. Also, even if the personality can register, Trade Mark registry may not allow registration for a range of classes which the personality had no intention to use. This proves the inadequacy of trademarks, because only if the person has any form of trade relation, they are allowed to raise a claim, and even if having been in trade, they are not allowed to register across wide categories. The third factor, for trademark registration, which is that graphical representation of the sign is needed in such cases; this results in difficulty because registration of voice of personality is not possible. This, in fact, shows the other inadequacy of trademark laws as a result of which only limited aspects of personality can be protected under trademark. The third factor led to the fourth factor, which is that section 2(m)²³ defines mark wherein it only includes name, signature etc. and other attributes of personality such as voice, image, likeness, has not been mentioned over here. This proves that only limited attributes of personality can be registered under the Trademark Act. The fifth-factor, which is that trademark can be considered a public interest since they are only protected for owners' marks if rivals' use of the same or a similar mark is likely to cause consumer confusion. Additionally, trademarks are intended to lower the cost to customers of identifying goods that meet their standards for quality.²⁴ Therefore, it becomes clear that Act

²²Kusum Joshi and Vaidehi Pareek-Character Merchandising: Right of Publicity and its Relation with Trademark Laws-Specialusis Ugdymas / Special Education 2022 1 (43)- Trademark law is designed to protect the integrity of a mark's meaning by preventing uses of the mark that confuse consumers.

²³Trade Marks Act, 1999- Section 2 (m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. Acts of Parliament- 1957 (India).

²⁴ Stacey Dogan, "What the Right of Publicity Can Learn from Trademark Law", 58 *Stanford Law Review* 1161 2006 available at: https://scholarship.law.bu.edu/faculty_scholarship/420 (last visited on June 23, 2023).

shows major concern towards consumer protection. That is why under trademark the liability depends upon the likelihood of confusion as to the source or connection by endorsement or sponsorship. But this really limits the instances in which the right to protect one's personality to those situations where there is likelihood of confusion to source of goods.

Some of the above-said factors can be clearly understood through the D.M. Entertainment case where the court granted remedy under trademark on the ground that the plaintiff is a well-known personality and had a registered mark. This, in fact, proves that the trademark law only applies if the personality is well-known or else if the personality has a registered mark. Also, in this case, the plaintiff had a trade relation, which in fact, made it easy to prove the consumer confusion aspect²⁵. This proves that trademark law is not adequate in every case of commercial misappropriation of personality right because in some cases the person might not be having any trade relation, and every use may not amount to consumer confusion²⁶. Also, as far as trademark is concerned, the principal function of a trademark is the identification of its origin, which, in fact, indicate the consumer about the quality and attributes of a product bearing the mark. But personality rights are concerned with the right to control the unauthorize utilization of attributes of personality or to control the commercial exploitation of the value of persona. Whether such use caused any consumer confusion is not a matter of concern, and the only aim is to control the use of their persona in situations where it is used without consent.²⁷ Personality rights will involve associational uses rather than source-indicating²⁸; that is the reason why consumer confusion doesn't form a main parameter for personality right infringement. These factors prove that the protection of personality right under trademark laws is inadequate.

Like trademarks, there are differences while protecting personality right under copyright also. In copyright, under the preview of performer right, personality right has been attempted to be covered by the Indian courts. But while interpreting the definition of the performer in the Copyrights Act, it can be seen that it will not provide complete protection to the person as required under personality right. This is because not all performers can fulfil the prerequisites of being a recognized person, which, in fact, is the proof that the protection under the aspect of “performers” is not adequate. As far as personality right is concerned, it is considered an innate right (inherent right) of every individual; there is no differentiation between celebrity and non-

²⁵Sarah M. Konsky, “Publicity Dilution: A Proposal for Protecting Publicity Rights”, 21 *Santa Clara High Tech. L.J.* 347 2004 available at: <http://digitalcommons.law.scu.edu/chtlj/vol21/iss2/3> (last visited on June 23, 2023).

²⁶*Supra* note 7 at 3.

²⁷*Id* at 21.

²⁸ *Id* at 24.

celebrity to claim personality right. But from the notion of the Indian court, it gets a view that in India, personality right is considered as an exclusive right of celebrity²⁹ which, in fact, seems to be contradictory to the concept of personality right³⁰. Also copyright essentially protects original literary, theatrical, musical, and artistic works as well as cinematograph films, sound recordings, and other works; in short, it provides exclusive rights to creative works. In contrast, personality provides individuals exclusive rights in their persona. Thus, as mentioned earlier, the subject matter of copyright and personality rights are different. Copyright encourages creativity by assuring creators the opportunity to obtain financial rewards for their works³¹. At the same time, personality right affords individuals control of their names, likenesses, and other personal attributes. This means personality right provides a monopoly on a persona rather than their individual expressions. Also, regarding the protection of different attributes of personality are not possible to be covered under copyright³²; for example, protection of name is not possible as it lacks sufficient minimum requirement, and similarly other attributes such as voice, likeness or other identifiers of persona is not fit for copyright law to deal with. To get copyright, the individual must be able to show they are having copyright ownership over those attributes. Another factor that seen in literature as being used to justify both personality right and copyright is incentive theory, but in fact, as far as copyright is concerned, this theory suggests that providing incentives generates great benefits for society whereas for personality rights it does not always require that an individual should produce creative works before it makes rewards³³. Therefore, an incentive for personality may not always benefit for society. This in fact proves that the objectives behind both rights are different and thus, the protection of personality right under copyright is not adequate. In some cases, more than inadequacy, the conflict between copyright and personality can turn out to be a problem. For example, in case of the right over a person's image which has artistic relevance, the question is who would have the right over that image, whether the author of the work or the person whose image is in the work. In most cases, copyright prevails over personality right, even if there is commercial

²⁹ *Supra* note 7 at 3.

³⁰ Thomas J. MC Carthy, *MC Carthy On Trademarks and Unfair Competition* (4th ed. 2004) -Personality is "inherent right of every human being to control the commercial use of his or her identity". This legal right is infringed by unpermitted use which will likely damage the commercial value of this inherent right of human identity."

³¹ Marc J. Apfelbaum, 'Copyright and the Right of Publicity One Pea in Two Pods' 71 *Geo LJ* 1567 (1983).

³² *Sim v. Heinz & Co. Ltd.*, [1959] 1 W.L.R. 313 (Eng.).US case- the Court said that "copyright is neither granted to voice, likeness or other identifiers of persona". See in, Akanksha Jumde & Nishant Kumar, *Image Rights of Famous Persons Vis-a-Vis Right to Privacy: An Analysis under the Intellectual Property Laws in India and Other Countries.*

³³ *Id* at 27.

exploitation of personality right taking place. This, in fact, shows the exploitation of personality right. Another factor is as seen in the case of section 17(b)³⁴ of the Copyright Act, 1957, which is used to regulate the unauthorized use of personality, which comes under the purview of copyrighted work. Here the section provided the first author's or owner's right. In some cases, there might be a conflict between the person who performed the work and the person who has the right over the performance. For example, in the Titan Industries Ltd. case, Amitabh Bachchan and Jaya Bachchan who are the advertisement's performers, acknowledge, represent, and promise to Titan that Titan will hold sole and complete ownership of all intellectual property rights relating to the services. This means all the right with regard to the ad was in the hand of Titan company. If Titan used those images beyond the said agreement, what would be the remedy for those personalities? According to the Act, the first owner of the work is Titan company; therefore, they have an absolute right to exploit all the rights. This, in fact, shows the degree of protection that performer's rights may be able to provide, particularly in cases where the performer does not possess the copyright to the work being performed.³⁵ All these factors, in fact, prove that copyright will only offer a limited scope for an action to prevent the unlawful use of a personality right.

The passing off remedy is another remedy used by the court to grant protection for personality rights, but this too is not sufficient enough to cover the personality right because under passing off, the three-parameters needed to be fulfilled to claim such rights are reputation, misrepresentation, and damage to goodwill or reputation. As in the context of unauthorized use of personality right, more than misrepresentation, misappropriation is happening; in some cases, reputation may not be infringed, but unauthorized use might be happening. As far as reputation is not violated, then the remedy under passing off is not possible; therefore, these elements of passing off became a hurdle to claim remedy under passing off right for personality right infringement.

It is evident from the aforementioned factors that the current trademark and other IP regulations fall short of adequately protecting a person's image from commercial use. Therefore, it is necessary to develop legal frameworks that provide people to protect their personality and have chance to profit monetarily from their image and other personality attributes by registration of

³⁴ Copyright Act, 1957 Section 17(b) *subject to the provisions of clause (a)*.

³⁵ Beverley-Smith, H. *The Commercial Appropriation of Personality* (Cambridge Intellectual Property and Information Law). 33-36 -Cambridge: Cambridge University Press 10.1017/CBO9780511495229 (2002).

their personality, as evidenced in Guernsey's legislation.³⁶ As far as the present-day scenario, a person's image is very valuable because it has brought in more money for them than anything else for which they were famous, which might make image rights management the market leader in the future.³⁷ Therefore, a proper protection can be given by granting a sui generis law for personality rights like Guernsey did which can help to resolve these issues. As now the need for such a right can be seen to be increased thus it may be the time for India to push further for a legislative recognition for this concept and to develop a holistic approach to address it.

³⁶ Image Rights (Bailiwick of Guernsey) Ordinance, 2012- available at - <https://ipo.guernseyregistry.com/article/158676/Image-Rights-Legislation--Regulations>.

³⁷Angela Adrian - Image is Everything The New Image Right of Guernsey-2014- URL- <http://www.icondia.com/wp-content/uploads/2014/04/Image-is-Everything.pdf> See in Image rights register for celebrities proposed in Guernsey- URL- <https://www.theguardian.com/uk/2012/jun/26/image-rights-register-celebrities-guernsey> .

