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PUBLICITY RIGHT IN INDIA: A MISCONCEPTION!

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ABSTRACT

Publicity right was first introduced in India in the year 2002 in the landmark judgment of the Delhi High Court in ICC Development (International) v. Arvee Enterprises and Anr. For a considerable amount of time, there were no further judicial pronouncements on the same. However, post-2010, there have been a considerable number of suits for the enforcement of this right. An analysis of the Indian cases on publicity right leads to confusion as to what the nature and scope of this right are. It is observed that courts are interpreting this common law right (as recognised in the USA) as a facet of existing rights. Primarily this right is being interpreted in light of the personal right of privacy and not independent of it, blurring the difference between the two. Contrary to the practice adopted by the USA, India is yet to limit the scope of publicity as well. The article emphasises on the need to treat publicity right as a right independent of privacy by proposing the right to be treated as a property right, a practice which can be seen in the USA, the country from which the Indian courts adopted the right. It also highlights the lacuna of limitation on the said right in India.

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I. INTRODUCTION

With tremendous strides in communications, advertising, and entertainment techniques, the public personality has found that the use of his name, photograph, and likeness has taken on a pecuniary value undreamed of at the turn of the century.[1] Judge Holmes noted that, *"if one is popular and permits publicity to be given to one's talent and accomplishment in any art or sport, commercial advertisers may seize upon such popularity to increase their sales."*[2]

The whole debate around the protection of one's persona, right to be left alone and right to privacy started with a landmark article by Brandeis and Warren.[3] Since then, public figures have asserted privacy claims against the unauthorised commercial appropriation of their persona, seeking remuneration rather than damages for mental anguish arising from unwanted publicity.[4] However, commercial opportunities provided by the subsequent advent of modernity have pushed the celebrities to a scenario where privacy is the one thing they, *"do not want, or need."*[5] This has led to privacy becoming inadequate to justify pecuniary benefits from the use of a persona, as it is waived by celebrities.[6]

To protect the interest of celebrities from unauthorised use of their persona, the courts have come to recognise the right of publicity.[7] Judge Jerome Frank defined publicity right as, *"the right to grant the exclusive privilege of publishing his picture."*[8] However, the subsequent judicial interpretation of publicity right has widened the ambit of protection under this right.[9] The right implicates a person's interest in autonomous self-definition, preventing others from interfering with the meanings and values that are associated with them by the public.[10]

In the US, the development of this right underlies in the realisation that the right of privacy, which protects inherent aspects of one's being, is not sufficient to protect against the commercial misappropriation of a persona.[11] With this in mind, the article aims to analyse the application of publicity right in India and highlight a more appropriate recourse in the future.

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[1] Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203-223 (1954).

[2] O' Brien v. Pabst Sales Co., 124 F.2d 167 (5TH Cir. 1941).

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

[4] James Q. Whitman, *The Two Western Cultures of Privacy: Dignity Versus Liberty*, 113 YALE L.J. 1151, 1210 (2004).

[5] Gautier v. Pro-Football, 304 NY 354, 361, 107 N. E. 2d 485, 489 (1952).

[6] Nimmer, *supra* note 1.

[7] Haelan Labs. v. Topps Chewing Gum, 202 F.2d 866 (court for the first time recognised the right of publicity).

[8] *Id.*

[9] White v. Samsung, 971 F.2d 1395 (9th Cir. 1992).

[10] Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 282 (2005).

[11] Fredrick R. Kessler, *A Common Law for the Statutory Era: The Right of Publicity and New York's Right of Privacy Statute*, 15 FORDHAM URB. L.J. 951, 952 (1987).

II. INDIAN LEGAL REGIME ON PUBLICITY RIGHT

The analysis of the Indian legal regime on publicity right has been divided into two parts. *Firstly*, the analysis of the Indian cases dealing with publicity right; and *secondly*, the resultant confusion from the inconsistent application of publicity right.

A. Analysis of Indian cases dealing with publicity right

The approach of the courts in India has led to a muddled understanding of the exact nature of publicity right, as they have at various points considered the right to be a personal right, a property right and as a right analogous to trademark right as well on separate instances.

1. Cases treating publicity right as personal right within the right to privacy

ICC Development v. Arvee Enterprises[12] is the first case in the Indian legal regime dealing with the question of publicity right. In this case, the plaintiff company had claimed, *"unfair trade practice of misappropriating the publicity right"* by the defendant. While deciding the matter, the court came to the conclusion that, *"publicity right has evolved from the right to 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…. Any effort to take away the publicity right from the individuals to the organiser of the event would be violative of article 19 and 21 of the Constitution of India. The publicity right vests in an individual and he alone is entitled to profit from it."*[13] The case, contrary to the practice in the USA, blurred the distinction between the right to privacy and publicity right.[14] The repercussion of such an understanding has been dealt with in detail in the latter part of this article.

Subsequently, in the landmark case of *Shivaji Rao Gaikwad v. Varsha Productions*,[15] the plaintiff had claimed a permanent injunction restraining the defendant in any manner whatsoever amounting to the infiltration of the plaintiff's 'personality right' by unauthorised use. Interestingly, the Court referred to cases on publicity rights, and thus, equated personality rights with publicity rights. The distinction between the two becomes fairly apparent by referring to German civil law, as, it distinguishes between economic rights which are assignable, as should be the case with publicity rights, and personality rights which are seen as inseparably connected to the individual,[16] though the meaning and the scope of personality rights is not of primary concern for this inquiry.

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[12] ICC Dev. (Int'l) Ltd. v. Arvee Enters. & Ors., (2003) VII AD 405 (India).

[13] *Id.*

[14] *Haelan Labs.* 202 F.2d at 866; Martin Luther King v. American Heritage Products, 694 F.2d 674 (11th Cir. 1983); Ali v. Playgirl Inc., 447 F. Supp. 723 (SDNY 1978) (The courts in these have recognised publicity right as a right independent of privacy).

[15] Shivaji Rao Gaikwad v. Varsha Prods., (2015) 62 PTC 351 (Madras) (India).

[16] DAVID TAN, THE COMMERCIAL APPROPRIATION OF FAME 48 (Cambridge Univ. Press ed., 2017).

2. Cases treating publicity right as a property right

In this part, the article analyses cases that consider publicity rights as a property right because of the recognition of the right's assignability, as otherwise, privacy being a personal right is inalienable.[17]

The aspect of assignability of publicity rights was first brought up in *D.M. Entertainment v. Baby Gift House*.[18] A company which was assigned the right to commercialise the persona of an individual was successful in enforcing that right against the defendant. This case marked a significant growth of publicity rights in India, as for the first time, an Indian court had laid down certain essentials for enforcing publicity rights. The primary essential being 'identifiability', and as a secondary consideration, it necessitated that the defendant shall have appropriated the persona or some of its essential attributes. The court concluded by making the remark that a publicity right can, in a jurisprudential sense, be located with the individual's right and autonomy to permit or not to permit the commercial exploitation of his likeness or some attributes of his personality.

A landmark judgment that has since been considered as an authoritative text on publicity rights in India is *Titan Industries v. Ramkumar Jewellers.*[19] The case has been referred to time and again in a majority of Indian cases. The defendant had put up hoardings depicting Mr. Amitabh Bachchan and Mrs. Jaya Bachchan (famous Indian actors) as the endorsers of the defendant's jewellery. The plaintiff raised the plea of publicity right, which was assigned to them through a contract. The court divided the discussion into five points. First, being the plaintiff's right to sue. Here the court came to the conclusion that the plaintiff should be eligible to sue based on the contractual obligation of exclusivity. Secondly, the court noted the publicity right as the right of a celebrity. Thirdly, the court discussed the elements of publicity rights as – 'validity' and 'identifiability'. The element of identifiability was the same as discussed in the D.M. Entertainment case, i.e. the personality must be identifiable, whereas, the element of 'validity' was explained as the plaintiff owning an enforceable right in the identity or persona of a human being. Therefore, justifying the assigning and *locus standi* of the plaintiff in this case. In the fourth and fifth points, the court explained the method of proving the element of identifiability.

It should be noted that a decision is *per incuriam* when the court has acted in ignorance of a previous decision of its own or of a court of coordinate jurisdiction which covered the case

[17] Justice K.S. Puttaswamy v. Union of India, (2019) 1 SCC 1 (India).

[18] D.M. Entm't Pvt. v. Baby Gift House & Ors., CS (O.S.) 893 of 2002 (Del.) (India).

[19] Titan Indus. Ltd. v. Ramkumar Jewellers, (2012) 50 PTC 486 (Del.) (India).

before it.[20] Interestingly, the courts in D.M. Entertainment[21] and Titan Industries[22] cases neither referred to the ICC Development[23] case while defining publicity rights nor did they follow the ruling of ICC Development[24], which restricted publicity rights only to an individual. Therefore, even though the two cases treated publicity rights as a property right, which based on the reasoning substantiated in the subsequent parts of this article is the correct approach, one may question the validity of the two cases itself.

3. Cases treating publicity right analogous to trademark law

The cases in this part are an extension of treating publicity right as a property right by enforcing the same under an existing field of Intellectual property rights, i.e. trademark law.

In *Arun Jaitley v. Network Solutions Private Limited and Ors.*,[25] the court noted that the name of Mr. Arun Jaitley falls in the category, wherein it besides being a personal name has attained distinctive indicia of its own. Therefore, the said name due to its peculiar nature or distinctive character coupled with the gained popularity in several fields has become a well-known personal name or mark under the trademark law. Thereby protecting an aspect of publicity right through trademark law.

In *Christian Louboutin Sas v. Nakul Bajaj*,[26] the plaintiff had filed a suit for trademark infringement, passing-off and dilution against the defendant on several grounds, one of which was that the website of the defendant prominently featured photographs of Mr. Christian Louboutin and thereby caused an infringement of publicity right. The plaintiff relied on the US case of *Haelan Laboratories v. Topps Chewing Gum*[27] and the Titan Industries[28] case in support of his contention, and the Delhi High Court ruled in the plaintiff's favour.

In *Gautam Gambhir v. D.A.P & Co.*,[29] a suit was filed by a well-known Cricket Personality 'Gautam Gambhir' seeking injunction, restraining the defendant from using his name in the name of restaurants owned by the defendant. The celebrity status of the plaintiff was not disputed in this case. However, the court noted that the plaintiff is not associated with the

[20] Siddharam Satlingappa Mhetre v. State of Maharashtra & Ors., (2011) 1 SCC 694 (India).
[21] *D.M. Entm't Pvt.*, 893 CS (O.S.).
[22] *Titan Indus. Ltd.* 50 PTC at 486.
[23] *ICC Dev. (Int'l) Ltd.* VII AD at 405.
[24] *Id.*
[25] Arun Jaitley v. Network Sols. Pvt. & Ors., (2011) 181 DLT 716 (India).
[26] Christian Louboutin Sas v. Nakul Bajaj, (2015) 216 DLT (CN) 9 (India).
[27] *Haelan Labs.* 202 F.2d at 866.
[28] *Titan Indus. Ltd.* 50 PTC at 486 (India).
[29] Gautam Gambhir v D.A.P & Co. & Ors., (2017) SCC Online Del 12167 (India).

restaurant business and therefore, the plaintiff's name was not commercialised. The relevance of this case is that it emphasised the need for a clear message of endorsement and therefore, brought in the confusion test, which is generally applied in trademark law, to determine the validity of the plaintiff's claims.

B. The confusion resulting from the inconsistent application of publicity right

The main problem with the decision of the courts in the aforementioned section is primarily regarding the nature of the right. The courts have equated publicity right, which is an economic right, with the right to privacy, which is a personal right. This assertion is through the following two decisions of the courts: -

1. The Delhi High Court in *Tata Sons Limited and Ors. v. Aniket Singh*[30] noted that - "Such acts of the Defendant amount to an invasion of the right to publicity/ privacy rights of Mr. Mistry, as well as passing off in right to protect his name, persona or anything emanating out of these as enshrine in article 21 of the Indian Constitution."[31]
2. The Indian Supreme Court, in the recent landmark privacy judgment of *Justice K.S. Puttaswamy v. Union of India*,[32] while defining the right of privacy in India, discussed the right of publicity.

Additionally, such confusion with regard to the nature of the right raises the question of whether a common man (a non-celebrity) has a right of publicity. The Indian Supreme Court in *R. Rajagopal v. State of Tamil Nadu*, [33] vests the right to privacy with each and every individual and does not make a distinction between a celebrity and a common man whereas other cases involving the right of publicity in India, have considered 'celebrity status' as a *sine quo non* for claiming the same.[34]

Contrary to the Indian practice, commentators have distinguished privacy rights—which protect the right to be free from unwanted publicity—from publicity rights—which grant an exclusive right to control and exploit one's name and likeness.[35] Courts in the USA, too, accept publicity rights as doctrinally distinct from privacy rights,[36] a relevant fact which should be considered in light of India's adoption of publicity right from the US.

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[30] Tata Sons Ltd. & Ors. v. Aniket Singh, (2016) 65 PTC 337 (Del.) (India).

[31] *Id*.

[32] *Justice K.S. Puttaswamy* (2017) 10 SCC 1 (India).

[33] R. Rajagopal & Ors. v. State of Tamil Nadu & Ors., (1994) 6 SCC 632 (India).

[34] *Shivaji Gaikwad* 62 PTC at 351 (India); *Titan Indus. Ltd* 50 PTC at 486 (India).

[35] *See*, Nimmer, *supra* note 1 (arguing that publicity rights should be distinct from privacy rights).

[36] *Haelan Labs.* 202 F.2d at 866; *Martin Luther King* 694 F.2d at 674; *Ali* 447 F. Supp. at 723.

III. NEED FOR TREATING IT AS A PROPERTY RIGHT

In the US, the academia began to draw a distinction between privacy rights per se and publicity rights as a distinct right that initially sprung out of privacy rights, but came to be situated more within the realm of property rights.[37] Most privacy cases involved non-celebrities, and the privacy phase is thus, often treated as a precursor to the right of publicity rather than a first step in its evolution.[38] The proprietarian view has generally prevailed,[39] with courts, including the U.S. Supreme Court, likening publicity rights to intellectual property and recognising that protection for publicity rights creates economic incentives for individuals to engage in socially useful activities that enhance the market value of their identity.[40] The criticism of this incentive theory is that even if celebrities would make such an additional investment, it is not at all clear that society would want to encourage fame for fame's sake.[41] However, the rebuttal to this criticism is that the protection to the fame of persons already established to be famous is an incentive for people who are not as famous, to work harder to gain access to this protection and value, which in turn is likely to fulfil their economic interests.

The court in *First Victoria National Bank v. United States*[42] highlighted the benefits of treating publicity right as a property right by holding that *"An interest labelled 'property' normally may possess certain characteristics: it can be transferred to others; it can be devised and inherited; it can descent to heirs at law... it will be protected against invasion by the courts; it cannot be taken away without the due process of law."*[43] Hereinbelow, the article analyses the publicity right in light of these requirements to ascertain whether it should be labelled as a property right or otherwise.

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[37] Harold R. Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 554 (1960) (arguing that the doctrine "became confused" when public figures began resorting to privacy rights to redress appropriation of one's persona for commercial purposes); William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 406 (1960) (characterizing "appropriation" as "not so much a mental as a proprietary [interest], in the exclusive use of the plaintiff's name and likeness as an aspect of his identity").

[38] Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 167 (1993).

[39] Whitman, *supra* note 4 (noting that "an American interest in one's 'publicity' is an interest in one's property, not an interest in one's honor").

[40] Zacchini v. Scripps Howard Broad. Co., 433 US 562 (1977) ("Ohio's decision to protect petitioner's right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court.").

[41] Steven J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 120 (1980) (arguing that celebrity endorsements may have a "net social disutility").

[42] First Victoria Nat'l Bank v. United States, 620 F.2d 1096 (5th Cir. 1980).

[43] *Id* at ¶25.

A. Licensing

The pecuniary worth of publicity values will be greatly diminished if not totally destroyed if these values cannot be effectively sold.[44] Judge Jerome Frank, while recognising the right of publicity remarked that *"This right of publicity would yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures."*[45] Therefore, the relevance of publicity rights may be questioned in the absence of its assignability.

In most jurisdictions, as well as in India,[46] it is well established that a right of privacy is a personal right rather than a property right[47] and consequently is not assignable.[48] Since the right of privacy is non-assignable, any agreement purporting to grant the right to use the grantor's name and portrait (in connection with a commercial endorsement or tie-up) is construed as constituting merely a release as to the purchaser and as not granting the purchaser any right which he can enforce as against a third party.[49] Nimmer illustrates this as, *"...if a prominent motion picture actress should grant to a bathing suit manufacturer the right to use her name and portrait in connection with its product and if subsequently, a competitive manufacturer should use the same actress's name and portrait in connection with its product, the first manufacturer cannot claim any right of action on a privacy theory against its competitor since the first manufacturer cannot claim to "own" the actress's right of privacy. Assuming the second manufacturer acted with the consent of the actress, at best, the first manufacturer would have a cause of action for breach of contract against the actress."*[50] Judge Frank, while dealing with a problem of a similar nature in the case of Haelan Laboratories, as illustrated by Nimmer, recognised the publicity right *'in addition to and independent of the right of privacy'*.[51]

B. Waiver

The person who primarily enforces the publicity right is generally a celebrity, as discussed initially, who does not want to be left alone but wants to control the use of his persona. Under privacy law, if such a person seeks protection from unauthorised use, he finds that by the very fact of him being a celebrity, *"he has dedicated his life to the public and thereby waived his right to privacy."*[52] As long as the right to privacy in right to life is maintained and once this has become

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[44] Nimmer, *supra* note 1.

[45] *Haelan Labs.* 202 F.2d at 866.

[46] *Justice K.S. Puttaswamy* (2017) 10 SCC 1 (India) (court recognised privacy as a personal right which is inalienable).

[47] Mau v. Rio Grande Oil Inc., 28 F. Supp. 845 (ND Cal. 1939); Metter v. Los Angeles Examiner, 35 Cal. App. 2d 304 (Cal. Ct. App. 1939).

[48] Hanna Mfg. Co. v. Hillerich & Bradsby Co., 78 F.2d 763 (5th Cir. 1935); *Haelan Labs.* 202 F.2d at 866.

[49] *Haelan Labs.* 202 F.2d at 866.

[50] Nimmer, *supra* note 1 at ¶12.

[51] *Haelan Labs.* 202 F.2d at 866.

[52] Nimmer, *supra* note 1.

public, the question of the continuation of that right does not arise.[53] The mere publication of their photographs or images was typically not viewed by courts as an invasion of any privacy interest, because the celebrities had actively sought out their fame and could not be offended by its furtherance.[54] It has been repeatedly suggested that public figures' privacy rights would be more limited than those of purely private individuals.[55] This waiver of privacy, has been recognised by the Indian Supreme Court as well.[56] Justice Nariman remarked – *"if a person has to post on Facebook some vital information, the same being in public domain, he would not be entitled to claim the right to privacy."*[57] The court, in this case, had noted that the fact that information about an individual is in public domain, may become a relevant factor in the exercise of balancing social interest and the aspect of privacy. Therefore, a privacy-based approach of publicity right will substantially curtail the said right, especially in light of the fact that a substantial amount of information about the primary recipient of protection under publicity right, would be in public domain.

C. Descendibility

To maintain that, *"leaving a good name to one's children is sufficient reward in itself for the individual"*[58] is rather harsh on those who have invested their efforts in their name, rather than in the stock market, and constitutes a rather heavy burden to impose on creativity.[59]

Acknowledging the right's proprietary nature, an increasing number of jurisdictions now have a descendible right of publicity, i.e., they permit the celebrity's heirs to bring suits after his death.[60] The modern trend holds the right as descendible.[61] This progression of publicity rights towards descendability mandates the right to be treated as a property right.[62]

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[53] K. Ganeshan & Ors. v. Film Certification Appellate Tribunal, Ministry of Info. and Broad. and Ors., (2016) 6 CTC 1 (India).

[54] Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity can learn from Trademark Law*, 56 STANF. LAW. REV. 1161 (2006).

[55] Corliss v. E.W. Walker Co., 57 F. Rep. 434 (CCD Mass. 1893).

[56] Justice K.S. Puttaswamy 10 SCC 1 (India).

[57] *Id.*

[58] Memphis Dev. Found. v. Factors Etc., 616 F.2d at 956.

[59] Peter L. Felcher & Edward L. Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125 (1980).

[60] Kessler, *supra* note 11.

[61] Dogan & Lemley, *supra* note 54.

[62] *Martin Luther King*, 694 F.2d at 674 (the court held the right to be a property right to deem it as inheritable).

D. Remedies Available

The doctrine of privacy evolved with a view to prevent offensive publicity where newspapers would violate the privacy of wealthy and famous people to publish sensationalised articles.[63] In privacy cases, most US courts recognise that *"liability exists only if the defendant's conduct was such that he should have realized that it would be offensive to persons of ordinary sensibilities. It is only where the intrusion has gone beyond the limits of decency that liability accrues."*[64] Publicity rights are not adequately protected if relief can only be granted when the use of it is made in an offensive manner, since generally the appropriation of a publicity right does not involve a disparagement of the right thus appropriated, or of the persons identified with such rights.[65] Therefore, in a hypothetical scenario where Lionel Messi's photo is used in furtherance of a noble cause, it is likely that he would be left with no remedy for curbing such use of his of persona.

Even in cases where celebrities prevailed in the assertion of their right, their damages were limited to the personal injury that they suffered, rather than the economic value that the use brought to the advertiser.[66] So, even if the essential of offensiveness is ignored from the law, privacy infringement is still compensated only to the extent of injury caused to that person. In *Miller v. Madison Square Garden*,[67] the plaintiff did not face any humiliation/damages by the conduct of the defendant but proved a case for infringement of privacy and the court awarded a nominal sum of 6 cents. Herein, the court did not take into account the fact that the use of the name and picture of the plaintiff on defendant's program was worth a great deal more to defendant than six cents.[68] Therefore, the measure of damages should be computed in terms of the value of the publicity appropriated by the defendant rather than, as in privacy, in terms of the injury sustained by the plaintiff.[69] In case of the contrary, there might be a promotion of such inconsequential infringement of a celebrities' right by and for the benefit of certain corporate houses.

IV. LIMITS ON THE RIGHT OF PUBLICITY

Nimmer has remarked that *"Although the defense of waiver by celebrities should not be recognized in a publicity action, the defense of public interest should be no less effective in a publicity action than in a privacy*

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[63] Quoted in A.T. Mason, Brandeis, *A Free Man's Life 70*, (1946).

[64] Nimmer, *supra* note 1.

[65] Nimmer, *supra* note 1.

[66] *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 73 (1905) (noting that tort damages, such as "recovery of damages for wounded feelings," are available in right of privacy cases).

[67] Miller v. Madison Square Garden, 176 Misc. 714 (NY Sup. Ct. 1941).

[68] Nimmer, *supra* note 1.

[69] *Id*.

action."[70] Limitation on publicity rights becomes particularly important, when courts start applying such rights beyond its intended purpose.[71] Such a broad reading of Publicity Rights has the propensity to impoverish the public domain, and further hinders future creators and the public at large.[72] Recent Indian judgments appear to be afflicted with a similar problem as can be seen in the case of *Rajat Sharma & Anr v. Ashok Venkatramani & Anr.*,[73] wherein, publicity rights were enforced against the defendant for issuing an ad in the newspaper which merely referred to the plaintiff. The same may be questioned to be protected under the freedom of speech. Inherently, there is a tension between the right of publicity and the right of freedom of speech and expression under the First Amendment (the counter part of this being article 19 of the Indian Constitution, i.e., fundament right of freedom of speech).[74] Where a person's name, photograph, or likeness is made in the dissemination of news or in a manner required by public interest, that person should not be able to complain of the infringement of his publicity right.[75] However, not all forms of expression are protected under free speech in the context of publicity right.[76] The US courts have developed various balancing tests to demarcate the boundary between publicity rights and free speech interests, chief among them the influential "transformative use" test adopted from the copyright fair use doctrine.[77] Under this test, an individual, whether or not a celebrity, cannot recover damages for a violation of publicity right when the depicted identity has been transformed into a new creative work of expression.[78] Notably, this constitutional limitation on publicity claim applies even when the transformative depiction is, itself, sold for profit by the secondary user.[79]

Contrary to the above noted and much needed limitation on publicity right, there appears to be a lacuna of the same in India.[80] While the majority of cases in India did not take upon themselves

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[70] *Id.*

[71] Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 S.C. L. REV 783, 806 (1995) (criticizing the Vanna White judgment for extending publicity right beyond the accepted limits).

[72] ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 931 (6th Cir. 2003).

[73] Rajat Sharma & Anr v. Ashok Venkatramani & Anr., CS (Comm.) 15/2019.

[74] ETW Corp. 332 F.3d at 931.

[75] Nimmer, *supra* note 1.

[76] Reid Kress Weisbord, *A Copyright Right of Publicity*, 84 FORDHAM L. REV. 2803 (2016).

[77] *Id.*

[78] Comedy III Prods. Inc. v. Gary Saderup Inc., 21 P.3d 797, 808 (Cal. 2001).

[79] ETW Corp. 332 F.3d at 931.

[80] See, *ICC Dev. (Int'l) Ltd.* VII AD at 405 (India); Arun Jaitley 181 DLT at 716 (India); *Titan Indus. Ltd.* 50 PTC at 486 (India); Christian Louboutin Sas 216 DLT (CN) at 9 (India); *Shivaji Gaikwad* 62 PTC at 351 (India); Tata Sons Ltd. 65 PTC at 337 (India); K. Ganeshan 6 CTC 1 (India); Kajal Aggarwal 1 LW at 330 (The courts in these cases have not taken the burden of ascertaining the limits of publicity right).

the burden of defining the limits of this right, D.M. Entertainment appears to have recognised the free speech restriction on publicity right. The court remarked – *"In a free and democratic society, where every individual's right to free speech is assured, the over emphasis of a famous person's publicity rights can tend to chill the exercise such invaluable democratic right. Thus, for instance, caricature, lampooning, parodies and the like, which may tend to highlight some aspects of the individual's personality traits, may not constitute an infringement of such individual's right to publicity. If it were held otherwise, an entire genre of expression would be unavailable to the general public."*[81] Even though, the court recognised the free speech restriction on publicity right, it did not use this opportunity to lay down the much needed balancing tests, as are recognised in the USA, to demarcate the boundary between publicity right and free speech interest.

A repercussion of not having a well-defined limitation on publicity right can be seen in the Gautam Gambhir case,[82] where the court appears to have utilised the test of likelihood of confusion. The court, while acknowledging the celebrity status of the plaintiff, did not enforce his publicity right on the grounds of lack of confusion among consumers regarding plaintiff's association.[83] Dogan and Lemley propose that confusion about affiliation or sponsorship is most directly analogous to right of publicity cases and hence a test of likelihood of confusion should be adopted by courts, as is done in trademark case.[84] However, courts in publicity claims do not ask whether customers are in fact confused, as they rarely conduct surveys as to whether the use of persona amounted to any confusion.[85] Furthermore, the court in Titan Industries held that the defendant's use of the personality rights of Mr. and Mrs. Bachchan in its advertisement itself contains a clear message of endorsement and the message is false, misleading and is not tied down to any proof of falsity.[86]

Lastly, the case of *Kajal Aggarwal v. The Managing Director*,[87] even though not expressly dealing with publicity right, sheds light on another necessity to demarcate the limits of publicity right. In this case, the plaintiff had sought to restrain the defendant from using the ad-film, in which she had acted, beyond the period of the contract. *Per contra,* the defendant claimed that since he had the copyright over the ad-film, he could use it for a period stipulated in the Indian Copyright Act, which is 60 years. Interestingly, the court upheld the contention of the defendant and ruled that

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[81] D.M. Entm't Pvt. CS (O.S.) 893 of 2002 (Del.) (India) at ¶14.

[82] Gautam Gambhir (2017) SCC Online Del at 12167 (India).

[83] *Id*.

[84] Dogan & Lemley, *supra* note 54.

[85] Dogan & Lemley, *supra* note 54.

[86] *Titan Indus. Ltd*. 50 PTC at 486 (India).

[87] Kajal Aggarwal v. The Managing Dir., V.V.D. & Sons P. Ltd., (2012) 1 LW 330.

statutory provision would prevail over the contractual provision. This begs the question as to what would have been the stance of the court had the plaintiff claimed infringement of publicity right after the expiry of the contract. Therefore, there may be a scenario where there may be a clash between copyright and publicity right, a question yet to be posed before the Indian judiciary, which can only be resolved by identifying the limits to publicity right.

V. CONCLUSION

Unlike India, the courts in the USA have expressly recognised publicity right as a property right, independent of privacy. Such a difference in practice can be attributed to the difference in the scope of the right to privacy in the two countries. In the USA, the right to privacy, being a statutory right, has a well-defined and limited scope in comparison to India,[88] where the scope of this right is yet to be ascertained.[89] Due to this limited scope, the US courts, have relied on publicity right to fill in the lacunas in the right to privacy.[90] On the other hand, Indian courts have muddled publicity right with privacy, by interchangeably using the two.[91] Such practice can be justified due to the lack of limitation on the right to privacy itself, resulting in an overlap between the two rights. However, as noted above, the justification does not eliminate the necessity to treat publicity right as a proprietarian right for the assignability of persona.

Additionally, the court in Haelan Laboratories itself, while recognising the right to publicity, left open critical questions about the content of the new right.[92] The mere recognition of this right without defining the limits of this right, created a theoretical vacuum with very little insight into the values that should guide the courts in the application of this law to new facts.[93] Unfortunately, rather than fill Haelan's vacuum with considered analysis, judges and lawmakers sidestepped the tough issues and increasingly adopted an attitude of *"if value, then right."*[94] India too, by the mere adoption of publicity right from the US, without dealing with the scope and nature of the right, is afflicted with inconsistency in the application of the right. Nevertheless, the Indian legal regime on publicity right, being at such a nascent stage, still has scope to catch

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[88] See, CAL. CIV. CODE § 3344 (1995) & N.Y. CIVIL RIGHTS LAW §§ 50,51 (1903).

[89] *Justice K.S. Puttaswamy* (2017) 10 SCC 1 (India).

[90] See, White 971 F.2d at 1395 (court stated "The right of publicity does not require that appropriations of identity be accomplished through particulars means to be actionable." By doing so the Court extended the remedy for appropriations of plaintiff's identity without the use of his name or likeness, which were prerequisites for a remedy under the right to privacy).

[91] Tata Sons Ltd. 65 PTC at 337 (the court has interchangeably used the term publicity with privacy) (India).

[92] Dogan & Lemley, *supra* note 54.

[93] *Id.*

[94] Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990).

up with the development in law that has taken place in the west. In order to do so, the courts have to, first and foremost, truly understand the nature of the right.