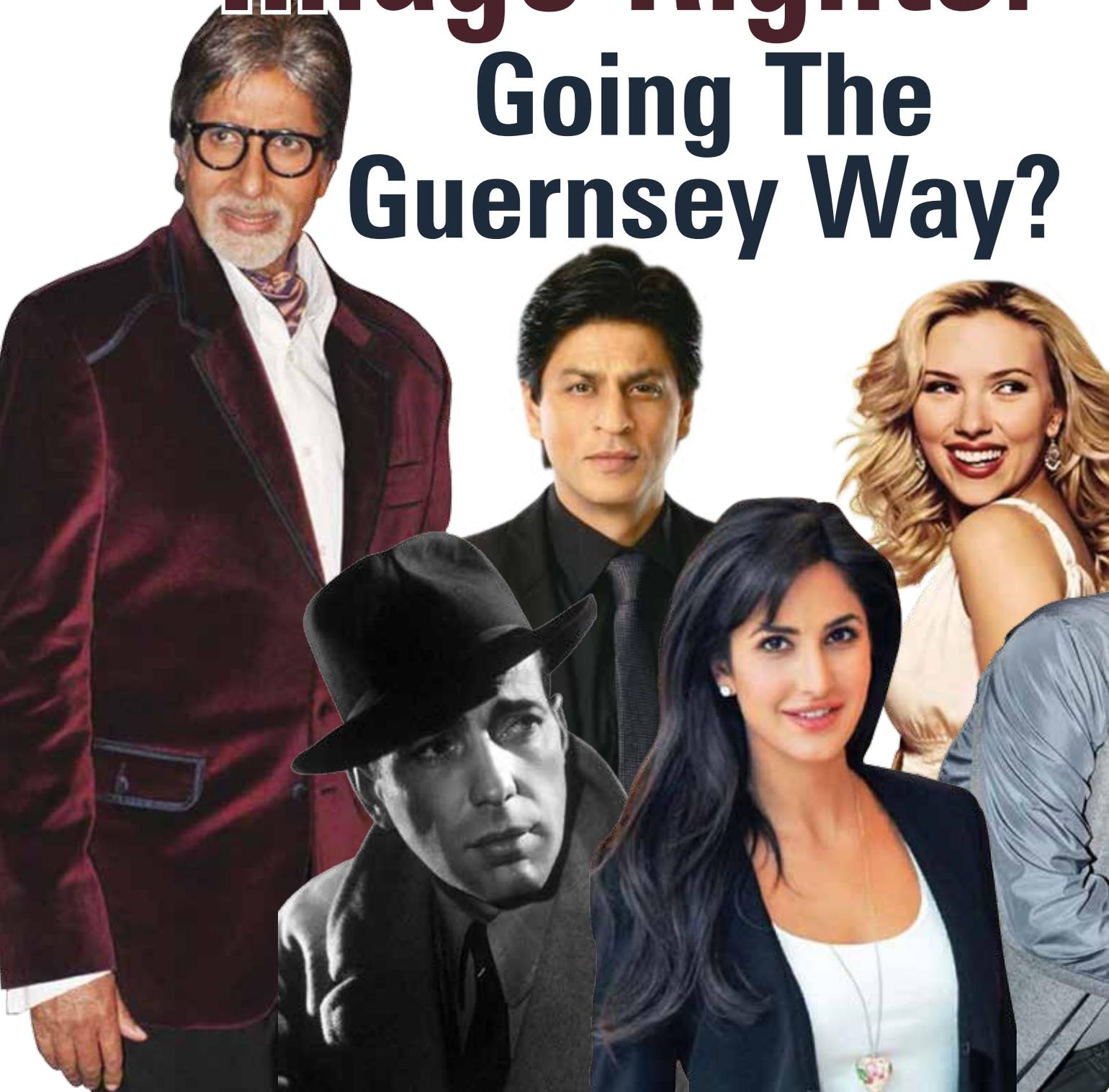


**Zoom In**

# Are Image Rights: Going The Guernsey Way?



*In November 2012, the Guernsey (Bailiwick of Guernsey), a British Crown Dependency created history by becoming the first jurisdiction to enact 'Image Rights' (IR) legislation with a very wide scope that recognized the rights of the celebrity to his personality and publicity. While the position under Indian law pertaining to image rights is still in an evolutionary phase, in the wake of the changing global environment, it is only a matter of time before a similar legislation will be enacted in India as well*



**Anuradha Maheshwari**  
Partner  
Lex Mantis



**Priyam Ravindran**  
Associate  
Lex Mantis

**N**othing sells like success—be that a product, a story, an image or an individual! As humans, we are naturally disposed to lean towards a 11 images of success and worship therefore, our gods, heroes and celebrities. And like all things that become successful, we also do not hesitate to rip them to our advantage. Barbers' shops beckoning customers through prominent and blatant displays of an Amitabh Bachchan or a Shah Rukh Khan photograph with stylized hair, is a common sight all over India. For the gullible and naïve, it creates a plausible

story of an immediate association of the celebrity with the product or at least a promise of a matching delivery.

Modern society is “celebrity-driven,” which means that famous personalities can greatly influence public lives, lifestyles and consumer preferences. It has been long since recognized that a well-known personality has a ‘persona’ that is marketable in its own right, regardless of the original reason for the person's fame. Commercial exploitation of the names and images of both, famous personalities and fictional characters has hence become a highly lucrative practice, more so since the media revolution in the 1990s. But do celebrities have a right to object to the unauthorized use of their names, signs or logos or even consent to an authorized use?

### **Celebrity maketh the Brand**

The concept of celebrity rights within the realm of intellectual property has recently emerged as a much debated issue. Commonly referred to as ‘personality rights’,

*Famous American historian, professor, attorney, and Pulitzer Prize winning author, Daniel J. Boorstin believes that “An image is not simply a trademark, a design, a slogan or an easily remembered picture. It is a studiously crafted personality profile of an individual, institution, corporation, product or service”*

they are in essence the 'Right of Publicity'(publicity rights) and are defined simply as the right of an individual to command and control the use of his or her name, image, likeness or other unequivocal aspects of his or her distinctiveness. It is generally acknowledged as a property right and not as a personal right.

Famous *American* historian, professor, attorney, and Pulitzer Prize winning author, Daniel J. Boorstin believes that *"An image is not simply a trademark, a design, a slogan or an easily remembered picture. It is a studiously crafted personality profile of an individual, institution, corporation, product or service."* The basic premise of

**With multimillion dollar international collaborations and humungous advertising budgets and outlays in every sphere of economic activity, it becomes important for India to convey an image of fair and ethical operating standards to both domestic and international markets**

protection of intellectual property in image rights is to acknowledge and safeguard the labor, effort and resources expended by a person to create the ultimate tangible result of a well-known brand or face and to allow such person alone to reap the rewards of such intellectual investments through contractual compensation. However, the other contentious issues of this subject are the appropriation of personality brands by the unscrupulous and

unfair exploitation and protection of consumer interests.

In a strict etymological sense, the word 'celebrity' derives itself from the Latin expression 'celebritatem' which refers to being well known or famous. Needless to say, with the ever increasing efficacy of marketing strategies, the creation of a celebrity image has emerged at par with the creation of brands and with celebrity endorsements, at the end of the day, the fate of the brand to a great extent depends directly upon the image and mass appeal of the celebrity endorsing it or associated with it.



In a country like India, where intellectual property legislation, privacy laws etc. are yet to mature, finding 'fake' or 'phoney' baritones, mannerisms and a 'look' emulating a celebrity is as common as finding 'fake' goods in the gray market. Where marketers are certain that the celebrity's long hands cannot reach them, they do not hesitate to blatantly use and milk to the fullest the charisma of the celebrity (or sometimes that of a poor lookalike), to endorse a lesser known brand. The images of

Bollywood actors on everything from firecracker boxes to sweetmeats, especially in tier II cities and villages, are legendary. The country's appetite and obsession for celebrities remains insatiable and the susceptibility of the Indian consumer to celebrity endorsements is equally so.

In the classic case of *Tolley v. Fry* (1931), the Court of Appeal in England had awarded damages to an amateur Golfer when his image was used without his prior consent to advertise Cadbury Chocolates. Over the years, the Courts in the US have observed that the scope for interpreting the expression 'celebrity' should not be too narrow. In 1982, the United States Court of Appeals (11th Circuit) was faced with the question of protecting celebrity rights when in *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.* the defendant company sold busts of King without the consent of his family. The Court noted that the right of publicity is a celebrity's right to the exclusive use of his or her name or likeness and that the term 'celebrity' should be interpreted in a broader sense. Dr. King was held to be a public figure and it was further held that the right of publicity survives the death of its owner and is inheritable and devisable.

In more recent times, the controversy involving actor *Humphrey Bogart's* heirs suing the clothing brand and leading apparel company *Burberry LLC* for misusing his image from the movie *Casablanca* to advertise their product, thereby giving an impression that he endorsed the Burberry clothing range. An out of court settlement was reached between the parties. In 2012, The9 Limited, an online game operator and developer in China, launched a new online game named called "*Winning Goal*", using the image of legendary footballer *Diego Maradona* in the game. The footballer contemplated legal action against the NASDAQ-listed gaming giant for using his image

without his prior consent, thereby infringing his personality rights. This case is of particular relevance considering the deluge of digital games and entertainment (many of them emanating out of India), using celebrity images and other expressions, which may or may not be authorized.

In a recent controversy involving Hollywood star **Scarlett Johansson**, a French novelist was at the receiving end of legal action initiated by the star, who was miffed with his novel **La Première Chose Qu'on Regarde (The First Thing We Look At)** that featured a fictional character clearly resembling her. Though the author, Grégoire Delacourt maintained that the fictional character was only a compliment and tribute to the actress's beauty, Johansson has initiated legal action against the author and the publisher for breach and fraudulent use of her personal rights.



Closer home, Bollywood diva **Katrina Kaif**, recently sued a hygiene products company for violation of her image rights. As a newcomer, she had endorsed one of the company's products for a small amount, however, recently, after her newly acquired star status, she endorsed another personal beauty product (similar to the product she endorsed for the earlier company) apparently for a large sum. Controversy began when the earlier company reintroduced the old advertisement on television running simultaneously with the new ad. She has sought an order from the Bombay High Court against the earlier company, restraining it from using the old ads featuring her.

### **Character Merchandising in India**

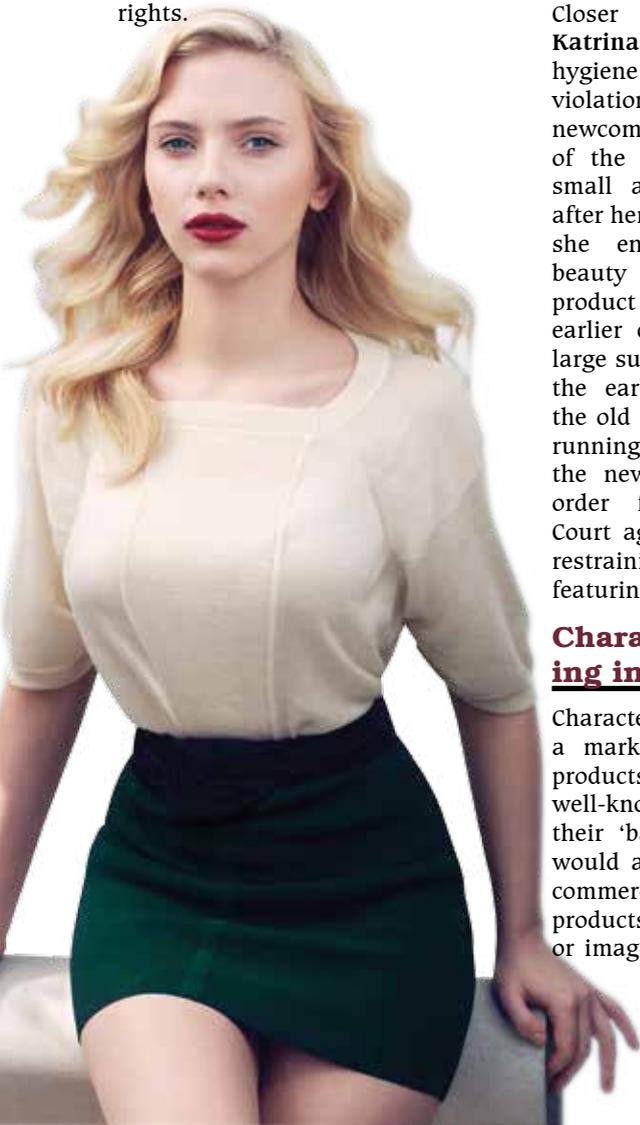
Character merchandising refers to a marketing technique by which products are associated with well-known characters relying on their 'bankable saleability', which would also effectively enhance the commercial value of the associated products. The marketing of name or image for monetary gain in this

manner is known as 'character merchandising'.

Two distinct forms of activities are usually encompassed by the term "character merchandising". Firstly, there is 'merchandising', where the name or more usually, the image of a person or character is applied to goods to make those goods more attractive and worthy to consumers. Secondly, there is 'endorsement', where the name or likeness of a well-known personality or character is associated with a product or business, usually in the form of advertising. The endorsement value of superstars appears to be on the increase, especially with their fan following, which assumes that if they endorse a product, consumers will generally buy it. A rationale could be that a celebrity face attracts immediate attention, more so if it is a well-liked one. And if a product is associated with such a face, then the prevailing positive emotions for the celebrity will extend to the product linked to the face. Riding on the celebrity's public image, the product is also immediately brought into public limelight.

While the Indian economy continues to attract foreign investment; many global brands continue to be wary of the intellectual property regime. As an expanding economy, India needs to create a favorable and encouraging environment of intellectual property rights regime, of which image rights as an evolving domain forms a formidable facet. It is no longer uncommon to see ad films featuring international footballers and cricketers and even Hollywood actors, which has made them household names in India. With multimillion dollar international collaborations and humungous advertising budgets and outlays in every sphere of economic activity, it becomes important for India to convey an image of fair and ethical operating standards to both domestic and international markets.

The Courts in India have on several occasions accorded recognition to personality rights. In DM



Entertainment Pvt. Ltd. v Baby Gift House (2002), the Delhi High Court granted a permanent injunction in favor of the Plaintiff Company, which managed the career of popular Punjabi Pop singer Daler Mehendi. The Defendant was engaged in the business of selling Dolls that resembled the Pop singer and his voice, thereby cashing in on his popularity. It was contended that the use of the star's personality to promote a commercial product was not only illegitimate and amounted to a dilution of the uniqueness of the personality. The judgement marked a key development in the case law pertaining to 'character merchandising' in India.

Recently, in **Titan Industries Limited v Ramkumar Jewellers** (2012), the Delhi High Court held the defendant liable for infringing copyright of the Plaintiff company and also infringing the personality rights of well-known Bollywood star couple Amitabh Bachchan and Jaya Bachchan who had assigned their personality rights to the plaintiff company to use their image in the advertising campaign of their diamond jewellery brand '**Tanishq**'.

## **Guernsey: The Trendsetter**

The Celebrity Rights Act was passed in the State of California in 1985, which enabled a celebrity's personality rights to survive his or her death, which acknowledged for the first time the need to protect celebrity image rights. The Act contains distinct provisions that govern the rights of a celebrity during their lifetime and after their death. However, the Act extends protection only to natural persons whose name, voice; signature, photograph or likeness has commercial value.

In November 2012, the Guernsey (Bailiwick of Guernsey), a British Crown Dependency created history by becoming the first jurisdiction to enact 'Image Rights' (IR) legislation with a very wide scope that recognized the rights of the celebrity to his personality and



publicity. The Law has created the world's first registrable image rights system. The IR legislation is based on two fundamental premises- firstly that, one should have control over one's image and how it is used and, secondly, one should have the capacity to earn a livelihood from that image. The legislation extends to five categories of personalities viz. Natural, Joint, Group, Fictional and Legal and acknowledges both 'personality rights' as well as 'image rights'. The Personality right includes the individual name or even pseudonym and nicknames. Image rights as defined under the legislation cover the name or alias of a personage; the voice, signature, likeness, appearance, silhouette, feature, face, expressions (verbal or facial), gestures, mannerisms and any other distinctive characteristic or personal attributes of the personage; or any photograph, illustration, image, picture, moving image or electronic or other representation of a personage, voice, mannerisms. The legislation also provides that the image right, like any other intellectual property right, is capable of being assigned and/ or licensed. The legislation allows registration by natural or legal persons who are alive and those who died or were dissolved in the past 100 years. Once registered the personality's registration lasts

for ten years although this can be renewed indefinitely similar to trademarks. For images, the duration is three years but these are capable of being renewed indefinitely.

## **Conclusion:**

The position under the Indian law pertaining to 'image rights' is still in an evolutionary phase, however, in wake of the changing global environment, it is only a matter of time a similar legislation be enacted in India as well. To conclude the debate, it is apt to mention the **Don Bradman cookie controversy** that had sparked off a debate across Australia and India in 2005 when the Bradman Foundation licensed a company to manufacture "Bradman" Chocolate Chip Cookies in India. The Bradman family had issued a statement saying, the legendary player was "a loved and missed family member, not a brand name like Mickey Mouse". A heartwarming comment indeed, however it is unlikely that celebrities or their kin would echo similar sentiments in the brand obsessed society that we live in, which is precisely why Guernsey is surely going to emerge a trendsetter in the times to come for other jurisdictions!



*Disclaimer – The views expressed in this article are the personal views of the author and are purely informative in nature.*