

## VII. The Right of Publicity of the celebrity personality

The right of publicity is often considered an extension of the right to privacy<sup>1</sup>, or its “descendant”<sup>2</sup>, even its “cousin”<sup>3</sup>. The concept of privacy as a legal right was notably articulated by Samuel Warren and Louis Brandeis in their seminal 1890 article, “The Right to Privacy”- Warren and Brandeis penned their influential article in response to what they saw as the press's increasing propensity to disclose private facts and publish private photographs without consent. Troubled by this trend, they argued for the recognition of a new legal claim based on an individual's right to be “let alone”, a concept they posited was already implicit in existing case law.<sup>4</sup> Adopting a view of privacy centered on “hurt feelings”, courts logically extended this concept to include identity appropriation claims by non-celebrities who wished to avoid unwanted attention.<sup>5</sup> Celebrities, however, thrive on attention, in fact *actively seek it*, for both personal and professional gain.<sup>6</sup> Consequently, courts and scholars assumed that celebrities did not suffer emotional distress from publicity, regardless of its nature.<sup>7</sup> As a result, privacy claims were deemed unsuitable for celebrities<sup>8</sup>, necessitating an alternative legal framework to address the unauthorized commercial use of their identities.<sup>9</sup> This gap led to the development of the right of publicity. Proponents of this right, having dismissed privacy claims for celebrities, emphasized the economic value of celebrity identities rather than any emotional interests.<sup>10</sup> Thus, the right of publicity was distinguished from privacy claims based on its focus on the unauthorized economic exploitation of a celebrity's identity: i.e. rooted in the *proprietary interest* in persona, and not its *dignitary interests* – which were covered under other torts of *privacy* and *defamation*.<sup>11</sup>

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<sup>1</sup> Lindsay Korotkin, *Finding Reality in The Right of Publicity*, CARDOZO L. REV. DE-NOVO 268, 274 (2013).

<sup>2</sup> Section 1:7 of McCarthy's treatise is titled, “‘Publicity’ law develops from ‘privacy law.’” J. THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY (2ND ED), Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 167 (1993) (“*The right of publicity was created not so much from the right of privacy as from frustration with it.*”); see also Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1203-15 (1986) (detailing history); Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 1, 3 (2005).

<sup>3</sup> Michael Mullins, *New Fame in a New Ballgame: Right of Publicity in the Era of Instant Celebrity*, 45 INDIANA LAW REVIEW 869 (2012). (“*A philosophical cousin of the right to privacy, right of publicity doctrine*”)

<sup>4</sup> Refer discussions under Chapter II and VI of this dissertation, Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy* 4 Harv. L. Rev. 193 (1890). It is believed that Roscoe Pound said that the Warren & Brandeis article did “*nothing less than add a chapter to our law.*” Cited as Statement of Roscoe Pound to William Chilton in 1916, quoted in A. Mason, *Brandeis: A Free Man's Life*, 70 (1946) in McCarthy, *Supra* note 2 at § 1:11, at f.n.no. 3;

<sup>5</sup> Korotkin, *Supra* note 1 at 275

<sup>6</sup> Melville Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954)

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> Korotkin, *Supra* note 1 at 275

<sup>10</sup> McKenna, *Supra* note 2 at 3

<sup>11</sup> Refer *Doe v TCI*, 110 S.W.3d 363 (Mo. 2003) (en banc).[Supreme Court of Missouri] at 368-369 “*The tort of misappropriation of name is one of four recognized torts falling under the general heading of invasion of privacy. The interest protected by the misappropriation of name tort “is the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or others.” Recently, development of the misappropriation of name tort has given rise to a separate yet similar tort termed the “right of publicity,” which is said to “protect a person from losing the benefit of their [sic] working creating a publicly recognizable persona.” Though facially similar, the protections afforded by each tort*

The modern enunciation of the *right of publicity* in the USA is attributed in almost every major text on the subject,<sup>12</sup> to the brief opinion of Judge Jerome Frank of the United States Court of Appeals for the Second Circuit in *Haelan Laboratories*.<sup>13</sup> The court held thus: “*In addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i. e., without an accompanying transfer of a business or of anything else. Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolizes the fact that courts enforce a claim which has pecuniary worth. This right might be called a 'right of publicity', for it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures*”<sup>14</sup>

However, as Prof Rothman points out, “*There is a widespread, almost universal belief held by virtually all courts and scholars that Haelan coined the term the “right of publicity” and that it created a “new” right— one that protected the economic interests of public figures who sought out publicity, and who were allegedly left out in the cold under privacy laws. Commentators even describe Haelan as protecting the rights of individuals to the economic value of their names and likenesses. But the decision did none of these things.*”;<sup>15</sup>

This chapter, and this dissertation, does not aim to question and scrutinize the doctrinal underpinnings of the right of publicity. Instead, it focuses on examining key elements of the claim in the USA, specifically in states of New York and California – which are the main hubs of *entertainment*; and to see which indicia of personality are protectable and when they are not – in favour of artistic expression. The same is then used to inform the study of the evolution of the right in India and draw lessons for the regime in India therefrom. Any loftier attempts are

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*are slightly different: “the [misappropriation of name tort] protects against intrusion upon an individual’s private self-esteem and dignity, while the right of publicity protects against commercial loss caused by appropriation of an individual’s [identity] for commercial exploitation....Despite the differences in the types of damages that may be recovered, the elements of the two torts are essentially the same. To establish the misappropriation tort, the plaintiff must prove that the defendant used the plaintiff’s name without consent to obtain some advantage. In a right of publicity action, the plaintiff must prove the same elements as in a misappropriation suit, with the minor exception that the plaintiff must prove that the defendant used the name to obtain a commercial advantage.”*

<sup>12</sup>Sheldon W Halpern, *Publicity Rights, Trademark Rights and Property Rights*, in OVERLAPPING INTELLECTUAL PROPERTY RIGHTS 321-339, 325 (Neil Wilkof and Shamnad Basheer, eds., 2012); Mc Carthy, *Supra* note 2 at § 1:3 (2nd ed); ROBERT P. MERGES, PETER S. MENELL AND MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1020 (2010), Michael Maddow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993); Stacey L. Dogan, *Haelan Laboratories v. Topps Chewing Gum: Publicity as a Legal Right*, in INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP (Rochelle Cooper Dreyfuss and Jane C. Ginsburg, eds., Cambridge University Press 2014) “*Most scholars and courts credit Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc. with ushering in the modern right of publicity in the United States*”.

<sup>13</sup> *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953)

<sup>14</sup> *Id.* at para 3.

<sup>15</sup> JENNIFER ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* 45 (Harvard University Press, 2018)

not for this researcher to make at this stage, and there are entire treatises on the US law devoted to the area of personality property rights.<sup>16</sup> J Thomas McCarthy – who wrote the seminal treatise on the work, notes that the initial debate over what the right of publicity is, and whether it should exist, is now largely historical<sup>17</sup>. There may be some validity to Steven Semeraro’s argument that publicity rights are unnecessary to incentivize fame, manage the value of publicity, or are undeserved in any recognized moral sense<sup>18</sup>. However, as Kevin Greene reluctantly acknowledges, despite academic criticisms, publicity rights have become a significant commercial enterprise, driven by the public’s insatiable fascination with celebrities.<sup>19</sup> Even if it were true that theoretical justifications for the right of publicity<sup>20</sup> – and to dissociate a proprietary interest in personality from its dignitary roots, - are shaky, it does well to remind ourselves that when considering the issue of justification, a term or concept, that defies a precise definition in analytic jurisprudence can still hold significant value in social and political theory.<sup>21</sup> The lack of a clear-cut theory, which may frustrate legal experts, does not necessarily undermine the concept’s utility or importance in the cultural, social and political contexts where it is applied.<sup>22</sup>

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<sup>16</sup> McCarthy, *Supra* note 2; DAVID TAN, *THE COMMERCIAL APPROPRIATION OF FRAME: A CULTURAL ANALYSIS OF THE RIGHT OF PUBLICITY AND PASSING OFF* (2017); HUW BEVERLEY-SMITH, ANSGAR OHLY & AGNÈS LUCAS-SCHLOETTER, *PRIVACY, PROPERTY AND PERSONALITY* (2005); HUW BEVERLEY-SMITH, ANSGAR OHLY & AGNES LUCAS-SCHLOETTER, *PRIVACY, PROPERTY AND PERSONALITY - CIVIL LAW PERSPECTIVES ON COMMERCIAL APPROPRIATION* (2005); HUW BEVERLY-SMITH, *THE COMMERCIAL APPROPRIATION OF PERSONALITY* (2004); JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY – PRIVACY REIMAGINED FOR A PUBLIC WORLD* (2018).

<sup>17</sup> McCarthy, *Supra* note 2 at § 1:34; *See also* Sheldon W Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality* 46 *Hastings Law Journal* 853 (1995) at 869 (“very few voices have been raised questioning the legitimacy of the right”).

<sup>18</sup> Steven Semeraro, *Property’s End: Why Competition Policy Should Limit the Right of Publicity*, 43 *Connecticut Law Review* 753 (2011) at 755. *See also* Eugene Volokh, *Freedom of Speech and the Right of Publicity*. 40 *Houston Law Review* 903 (2003) at 929 (“As a critic of the right of publicity, I wouldn’t mind seeing the right of publicity eviscerated ... even as to commercial advertising.”) cited in David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p.121 (of 658)

<sup>19</sup> K J Greene, *Right of Publicity, Identity and Performance*, 28 *Santa Clara Computer & High Technology Law Journal* 865 (2011) at 869.

<sup>20</sup> *See generally*, Section 3.2 - *Overview of the Theoretical Justifications for the Right of Publicity*, in, David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at pp.128 to 149 (of 658); Alice Hammerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 (2) *DUKE L. J.* 383 (1999); Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 *CARDOZO ARTS & ENT. L.J.* 81 (1998); Justin Hughes, *The Philosophy of Intellectual Property*, 77 *GEO. L. J.* (1988). Also refer to this dissertation, Chapter II, Section C, pp.2.44 to 2.50.; *See also* contrary views of Gervais and Holmes in Daniel Gervais and Martin L. Holmes, *Fame, Property & Identity: The Purpose and Scope of the Right of Publicity*, 25 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 181 (2014). (“Conceiving the right of publicity as a derivative of or related to trademark law has led to serious errors by courts and commentators. It may even be a misnomer to label the right of publicity as a species of intellectual property. Any argument that the right of publicity somehow incentivizes individuals to pursue laudable careers is as disingenuous as the argument that the public benefits from a celebrity’s ability to sue for monetary damages when a person or entity makes a non-private, non-deceptive use of an individual’s likeness. The right of publicity should be delineated to effectuate its limited but legitimate purpose: to protect an individual’s natural rights in her identity.”)

<sup>21</sup> Beverly-Smith, *Commercial Appropriation of Personality*, 2004 at p.275

<sup>22</sup> J. WALDRON, *THE RIGHT TO PRIVATE PROPERTY* (Oxford, 1988), 31.

## A. Right of Publicity in USA

### i. The “source” of law and the “elements” of the claim

While denounced by Prof Rothman<sup>23</sup>, it is still commonly acknowledged that the concept of the right of publicity originated in 1953 through a concise opinion by Judge Jerome Frank of the United States Court of Appeals for the Second Circuit in the case of *Haelan Laboratories, Inc v Topps Chewing Gum, Inc.*<sup>24</sup>, which established that a celebrity is entitled to damages and other relief for the unauthorized commercial use of their persona.<sup>25</sup> This right is distinct from any traditional common law or statutory right of privacy. Judge Frank’s opinion, noted for its succinctness and market-focused rationale, is considered a foundational piece of the US legal realist movement.<sup>26</sup> In *Haelan*, Plaintiff is a gum manufacturer.<sup>27</sup> Plaintiff entered into a contract with a baseball player to allow the use of the baseball player’s photograph for various gum related sales.<sup>28</sup> In the contract signed by the plaintiff and the baseball player, the baseball player agreed to only grant this right to the plaintiff, and agreed that the baseball player would not sign any similar contracts with other gum manufacturers.<sup>29</sup> Plaintiff also had an option to extend the contract.<sup>30</sup> Defendant is another gum manufacturer.<sup>31</sup> Defendant entered into a contract with the same baseball player, allowing the defendant to use baseball player’s photograph on defendant’s gum merchandise.<sup>32</sup> This contract was entered into during the period that plaintiff’s contract was still in effect, leading to a conflict over the use of the images.



(Source: Wes Westrum trading cards from Bowman and Topps (1951) in *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (recognizing a tort cause of action for violation of the “right of publicity”), Museum of Intellectual Property, [https://www.museumofintellectualproperty.org/exhibits/other\\_forms.html](https://www.museumofintellectualproperty.org/exhibits/other_forms.html) (last visited: May 12, 202

<sup>23</sup> *Supra* note 15

<sup>24</sup> *Supra* note 14

<sup>25</sup> Halpern in Wilkoff and Basheer, 2012 *Supra* note 12 at p.322, para 15.05.

<sup>26</sup> *Id.*

<sup>27</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 867 (2d Cir. 1953).

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*



(Source: Oct-Nov 2021 issue of Beckett Vintage Collector available at: <http://unpopularopinions-mclaughlin.blogspot.com/2021/09/when-one-cent-baseball-cards-set-legal.html> (last visited: May 12, 2024))

Apart from the contractual claims, the plaintiff’s primary argument was rooted in New York law, which had a statute protecting an individual’s “name, portrait or picture” from unauthorized use for advertising or trade purposes.<sup>33</sup> This statute created a personal, non-assignable right focused on protecting subjective interests, preventing the plaintiff from transferring this right to another party.<sup>34</sup> The core of the plaintiff’s argument was that the use of the player’s image without consent constituted an invasion of privacy under New York Civil Rights Law. However, the statutory right, being personal and non-assignable, did not allow the plaintiff, as an assignee, to claim damages for its violation.<sup>35</sup> After a trial without a jury, the trial judge dismissed the complaint.<sup>36</sup> Plaintiff appealed the decision to the Second Circuit Court of Appeals. Defendant argued that the contract with the plaintiff was no more than a release of liability, in order to prevent a right of privacy claim against the plaintiff.<sup>37</sup> Because the right of privacy is personal and not assignable under New York Law the plaintiff’s contract did not vest any property right or other legal interest in which the defendant could invade.<sup>38</sup> However, the Second Circuit noted that if the defendant knew about the contract between the plaintiff and the baseball player and the defendant also knew that the contract contained an

<sup>33</sup> New York Civil Rights Law §§ 50–51 (“NYCRL”)  
<sup>34</sup> As was later observed in *Flores v Mosler Safe Co.*, 7 N.Y.2d 276 (N.Y. 1959) “*The primary purpose of this legislation was to protect the sentiments, thoughts and feelings of an individual*” at 280, citing (Hofstadter, *The Development of the Right of Privacy in New York* [1954], p. 12)  
<sup>35</sup> Halpern in *Wilkoff and Basheer*, 2012 *Supra* note 12 at p.323, para 15.09.  
<sup>36</sup> 202 F.2d 866, 867  
<sup>37</sup> *Id.*  
<sup>38</sup> *Id.*

agreement for exclusive rights, then the interference with the contract would be tortious.<sup>39</sup> The defendant's contracts were obtained through two different sources.<sup>40</sup> One of the sources, *Players Enterprise*, was an agent of defendant's company.<sup>41</sup> The other source, *Russell Publishing*, was not an agent of the company. The Second Circuit determined that because *Players Enterprise* was an agent for defendant, defendant would be liable for any tortious conduct committed by *Players Enterprise*. However, because *Russell Publishing* was acting as an independent source, the defendant would not be liable for the *Russell Publishing's* actions in inducing the breach.<sup>42</sup> However, plaintiff has a valid claim, regarding the publicity claim, against defendant if at any time they used the sources from *Russell Publishing*. It is no defense that the defendant was an assignee of the subsequent contract.<sup>43</sup> After determining which sources the defendant could be found liable for, the Second Circuit then analyzed the defendant's contention that the contract only created a release of liability, because a man has no legal interest in the publication of his picture other than his right of privacy.<sup>44</sup> The majority of the Second Circuit rejected this argument.<sup>45</sup> The Second Circuit stated that apart from the right to privacy, a person also has a right in the publicity value of their image.<sup>46</sup> Therefore, a person is able to grant the exclusive right of publishing their picture. The Second Circuit, also interestingly, further explained that it was unnecessary to label this right as a property right, because tagging something as property “*simply symbolizes that fact that courts enforce a claim which has pecuniary worth.*”<sup>47</sup>

This observation, is particularly intriguing, especially because Prof. Rothman, in her continuing critique [and course correction attempts] of attributing the origin story to *Haelan*, points out - From the beginning, the concept of the right to privacy was closely tied to property-based ideas, specifically the notion of self-ownership.<sup>48</sup> Many early cases advocating for the right to privacy drew upon property claims, such as comparisons to common law copyright.<sup>49</sup> Before the formal establishment of a right to privacy, public figures who commercialized their identities were already recognized as having property rights over their names and likenesses – something that this researcher also calls “the reverse extrapolative” logic<sup>50</sup>. When the right to privacy became more widely recognized, courts frequently referred to it as a “property” right, even when dealing with private figures as plaintiffs.<sup>51</sup> A detailed examination of the *Haelan* case files by Prof Rothman for her book, indicated that the right of publicity was not essential to the court's decision and was not a primary concern for the litigants.<sup>52</sup> Interestingly, New

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<sup>39</sup> *Id.* at 867-68.

<sup>40</sup> *Id.* at 868.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 869.

<sup>44</sup> *Id.*

<sup>45</sup> *Id.* at 868.

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> ‘The Big Bang’ in Rothman, *Privacy Reimagined*, 2018 *Supra* note 16 at p 48

<sup>49</sup> *Id.*

<sup>50</sup> Refer Chapter II, p.2.50 of this Dissertation

<sup>51</sup> ‘The Big Bang’ in Rothman, *Privacy Reimagined*, 2018 *Supra* note 16 at p 48

<sup>52</sup> Rothman, *Privacy Reimagined*, *Supra* note 16 at p 63-64

York state courts later dismissed *Haelan's* interpretation of New York law<sup>53</sup>. Contrary to what the Second Circuit in *Haelan* might have implied, New York does not acknowledge a common law right of publicity. Instead, it confines the cause of action for the appropriation of name and likeness to the statutory right of privacy under state law. As of 2017 (and even after the 2021-2022 amendments, for post mortem right of publicity, and post mortem rights against digitally altered pornography), the right of publicity in New York is a statutory action, under the named right of privacy.<sup>54</sup> Consequently, any perceived independent right of publicity suggested by *Haelan* has been explicitly overturned.<sup>55</sup>

Today, the larger recognition of the right of publicity, distinct nonetheless from its privacy moorings, but instead as a sub-set of an *unfair competition* style tort, is found in the **Restatement (Third) of Unfair Competition** as follows: “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.”<sup>56</sup> It explains the meaning of “purposes of trade” as being “used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user”<sup>57</sup>; however, exempted uses include “news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses”<sup>58</sup>. Injunctive and monetary relief may be granted for an appropriation of the “commercial value”<sup>59</sup> of a person’s identity.<sup>60</sup> The Restatement (Third) differentiates between the right to privacy and the right of publicity by stating that privacy concerns “injury to solitude or personal feelings,” whereas the right of publicity addresses “commercial harm”<sup>61</sup> and is widely recognized as “a purely economic property tort.” The related tort of appropriation of personality, under the umbrella of invasion of privacy<sup>62</sup>, was initially meant to compensate private individuals for the emotional distress caused when their identities were used for someone else’s commercial benefit. According to the **Restatement (Second) of Torts**, “One who appropriates to his own use or benefit the name and likeness of another is subject to liability to the other for the invasion of his privacy.”<sup>63</sup> Since the right of publicity emerged from the privacy tort of misappropriation of identity<sup>64</sup>, some courts may refer to the Restatement (Second) when adjudicating common law claims related to unauthorized commercial use of identity.<sup>65</sup>

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<sup>53</sup> *Stephano v. News Group Pub*, 64 N.Y.2d 174 (N.Y. 1984) at 183

<sup>54</sup> NYCRL, *Supra* note 33

<sup>55</sup> 64 N.Y.2d 174 (N.Y. 1984) at 183, Rothman, *Privacy Reimagined*, *Supra* note 16 at p 64

<sup>56</sup> Restatement (Third) of Unfair Competition § 46 (1995).

<sup>57</sup> Restatement (Third) of Unfair Competition § 47 (1995)

<sup>58</sup> Restatement (Third) of Unfair Competition § 47 (1995)

<sup>59</sup> *Ibid* §§ 48–9

<sup>60</sup> David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p.122 (of 658)

<sup>61</sup> Restatement (Third) of Unfair Competition § 46 (1995); McCarthy, *Supra* note 2 § 1:35.

<sup>62</sup> Refer Prosser’s four torts, discussed in Chapter VI of this Dissertation, pp. 6.2 to 6.3

<sup>63</sup> Restatement (Second) of Torts § 652C (1977).

<sup>64</sup> *Doe v TCI*, *Supra* note 11.

<sup>65</sup> McCarthy, *Supra* note 2 § 6:4

California, the state known for Hollywood<sup>66</sup>, has a statutory right of publicity for both living and deceased individuals.<sup>67</sup> The state allows civil claims for unauthorized use of another person’s “name, voice, signature, photograph, or likeness”<sup>68</sup> on products or merchandise, or for advertising or promotional purposes.<sup>69</sup> Additionally, it is a criminal offense and civil violation to use someone’s unauthorized signature in a political campaign.<sup>70</sup> California’s common law right of publicity predates its statutory counterpart and remains valid, enhancing the statutory right<sup>71</sup>. The state also acknowledges the appropriation branch of the right to privacy, distinguishing between economic and dignitary injuries.<sup>72</sup> Under California Civil Code § 3344.1, post-mortem rights are protected for seventy years after death. This statute provides a cause of action for the unauthorized use of a “deceased personality’s”, “name, voice, signature, photograph, or likeness” on products or merchandise, or for advertising or promotional purposes.

In New York<sup>73</sup> – home to Broadway, recognition of the right to prevent the unauthorized use of one’s name or likeness is established solely through statute.<sup>74</sup> Historically, New York’s highest court was the first to address the concept of a right to privacy.<sup>75</sup> When the court initially rejected this right<sup>76</sup>, public outrage led to the enactment of the nation’s first privacy law in 1903.<sup>77</sup> Furthermore, on November 30, 2020, the Governor of New York signed into law a new provision that includes a postmortem right lasting 40 years after death.<sup>78</sup> This law also introduces regulations against the “*unlawful dissemination or publication of sexually explicit depictions.*”<sup>79</sup> New York allows both civil and criminal actions to prevent the unauthorized use of an individual’s “*name, portrait, or picture*” within the state for “*advertising or trade purposes*”<sup>80</sup>. The civil action additionally extends protection to the unauthorized use of an individual’s “voice” for these purposes.<sup>81</sup> Importantly, NYCRL **does not** protect against

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<sup>66</sup>Refer Rothman’s Roadmap to the Right of Publicity, California [https://rightofpublicityroadmap.com/state\\_page/california/](https://rightofpublicityroadmap.com/state_page/california/)

<sup>67</sup> California Civil Code § 3344 (‘CCC’)

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> California Penal Code § 115.1, CCC § 3344.5

<sup>71</sup> Eastwood v. Superior Court, 149 Cal. App. 3d 409 (1983)

<sup>72</sup> Dora v. Frontline Video, Inc., 15 Cal. App.4th 536 (1993); Melvin v. Reid, 112 Cal. App. 285 (1931)

<sup>73</sup>Refer, Rothman’s Roadmap to Right of Publicity, New York, [https://rightofpublicityroadmap.com/state\\_page/new-york/](https://rightofpublicityroadmap.com/state_page/new-york/)

<sup>74</sup>. NYCRL, §§ 50-51

<sup>75</sup> Edward H. Rosenthal and Barry Werbin, *A Historical Retrospective on New York’s Right of Privacy Law: 115 Years of New York Court of Appeals Jurisprudence*, NYSBA Entertainment, Arts and Sports Law Journal, Fall/Winter 2018 available at : <https://www.herrick.com/publications/a-historical-retrospective-on-new-yorks-right-of-privacy-law-115-years-of-new-york-court-of-appeals-jurisprudence/#:~:text=The%20right%20in%20question%2C%20often,Supreme%20Court%20Justice%20Louis%20Brandeis>

<sup>76</sup> Roberson v. Rochester Folding Box Co., 171 N.Y. 538, 542 (1902).

<sup>77</sup> N.Y. Laws Ch. 132, §§ 1-2 (1903), which subsequently became NYCRL §§ 50, 51. The original 1903 Session law can be viewed at <https://babel.hathitrust.org/cgi/pt?id=nyp.33433090742549;view=1up;seq=320>.

<sup>78</sup> NYCRL, §50-f (wef May 2021) available at [https://dos.ny.gov/system/files/documents/2024/05/right\\_of\\_privacy\\_law.pdf](https://dos.ny.gov/system/files/documents/2024/05/right_of_privacy_law.pdf)

<sup>79</sup> NYCRL § 52-c (S.5959-D/A.5605). [Senate Bill Senate Bill S5959D available at : <https://www.nysenate.gov/legislation/bills/2019/S5959>]

<sup>80</sup> NYCRL, §50 Right of privacy

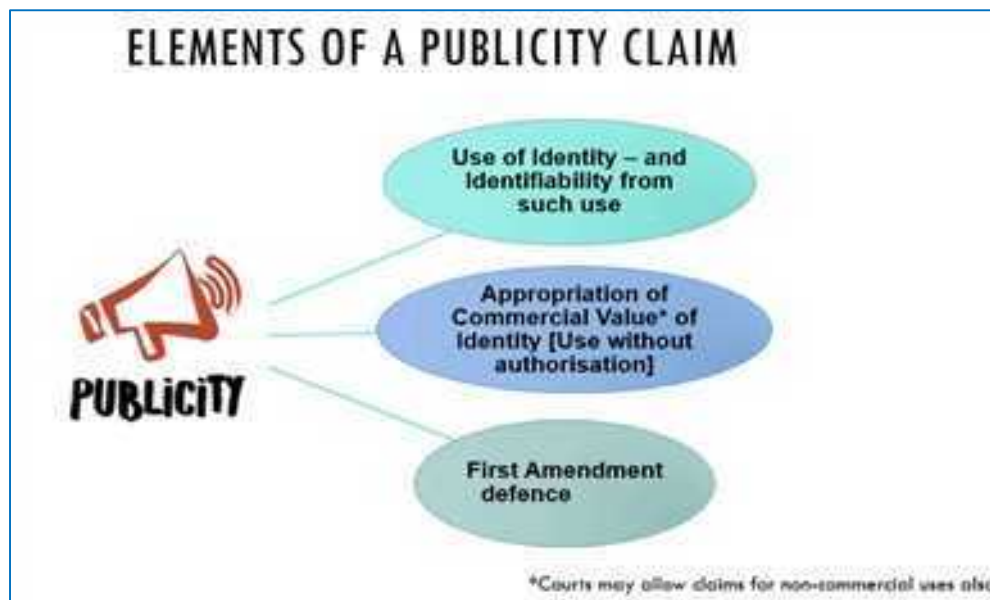
<sup>81</sup> NYCRL §51 Action for injunction and for damages.

*persona* taking, i.e. evocative uses. Only *direct* taking of name and likeness are protected against, including, the civil right against misappropriation of voice, and not a voice sound-alike<sup>82</sup>

From a reading of the above sources, especially from definition of the right of publicity adopted by the Restatement (Third), Prof Tan culls out the following elements of a right of publicity claim, thus<sup>83</sup> :

- i. *“the plaintiff’s identity was used ‘without consent’;*
- ii. *the plaintiff’s identity – ‘name, likeness or other indicia’ – has been used in a manner that identifies the plaintiff;*
- iii. *there must be an appropriation of the ‘commercial value of a person’s identity’<sup>84</sup>, and mere use of the identity without consent for the purposes of trade is insufficient; and*
- iv. *the use of identity does not fall within an exempted category like ‘news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses’; the defendant may also argue that a particular unauthorised use is nevertheless justified and protected as a form of speech under the First Amendment – more frequently known as the First Amendment defence”*

To put this more succinctly,



<sup>82</sup>Refer, Rothman’s Roadmap to Right of Publicity, New York, [https://rightofpublicityroadmap.com/state\\_page/new-york/](https://rightofpublicityroadmap.com/state_page/new-york/)

<sup>83</sup> David Tan, Commercial Appropriation of Fame, *Supra note* 16 at p.124-125 (of 658)

<sup>84</sup> This may not always be true, as is noticed in the NYCRL cases, where the courts have allowed claims for non-commercial uses also – Refer *Stephano v. News Group Publications*, 474 N.E.2d 580 (N.Y. 1984); *Foster v. Svenson*, 128 A.D.3d 150 (N.Y. App. 2015); *Delan by Delan v CBS, Inc.*, 91 A.D.2d 255 (N.Y. 1983); *Ward v. Klein*, 809 N.Y.S.2d 828 (N.Y. Sup. Ct. 2005); *Shamsky v. Garan, Inc.*, 632 N.Y.S. 2d 930 (N.Y. Sup. Ct. 1995) [list from Rothman’s Roadmap to Right of Publicity, New York, [https://rightofpublicityroadmap.com/state\\_page/new-york/](https://rightofpublicityroadmap.com/state_page/new-york/)]

Each US state that acknowledges the right of publicity defines identity differently:<sup>85</sup>

State	Statutory Definition
Alabama	"name, signature, photograph, image, likeness, voice, or substantially similar imitation of one or more of these attributes"
Arkansas	"names, voices, signatures, photographs, and likenesses"
California	"name, voice, signature, photograph, or likeness"
Florida	"name, portrait, photograph, or other likeness"
Hawaii	"name, voice, signature, and likeness" (likeness is defined to include distinctive appearance, gestures, or mannerisms)
Illinois	"name, signature, photograph, image, likeness, or voice"
Indiana	"name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms"
Kentucky	"name or likeness"
Massachusetts	"name, portrait, or picture"
Nebraska	"name, picture, . . . portrait, photograph, or other likeness"
Nevada	"name, voice, signature, photograph, or likeness"
New York	"name, portrait, picture, or voice"
Ohio	"name, voice, signature, photograph, image, likeness, or distinctive appearance"
Oklahoma	"name, voice, signature, photograph, or likeness"
Pennsylvania	"name, signature, photograph, image, likeness, voice, or a substantially similar imitation of one or more thereof"
Rhode Island	"name, likeness, or image"
South Dakota	"name, voice, signature, photograph, image, likeness, distinctive appearance, gesture, or mannerism"
Tennessee	"name, photograph, or likeness" (defined as image)
Texas	"name, voice, signature, photograph, or likeness"
Utah	"name, title, picture, or portrait"
Virginia	"name, portrait, or picture"
Washington	"name, voice, signature, photograph, or likeness"
Wisconsin	"name, portrait, or picture"

Source: Table 1 in Joshua L Simmons and Miranda Means, *Split Personality: Constructing a Coherent Right of Publicity Statute* 10 (5) *Landslide* (May-June 2018) , available at SSRN: <https://ssrn.com/abstract=3187810>

This can lead celebrity plaintiffs to potentially engage in “forum shopping” to find the jurisdiction with the most favourable right of publicity protections.<sup>86</sup> To establish a prima facie case, a plaintiff typically needs to demonstrate that their identity has been used in a way that more than a minimal number of ordinary viewers can identify the plaintiff from the defendant’s unauthorised use.<sup>87</sup> This identification is a factual question for the jury. The Ninth Circuit has emphasized that identifiability is a crucial element of a right of publicity claim<sup>88</sup>. Various methods to prove identifiability include:

<sup>85</sup>Joshua L Simmons and Miranda Means, *Split Personality: Constructing a Coherent Right of Publicity Statute* 10 (5) *Landslide* (May-June 2018) , available at SSRN: <https://ssrn.com/abstract=3187810> [“As table 1 illustrates, the definition of personality varies widely across the many states that have enacted right of publicity statutes. For ease of comparison, like elements appear in like colors. Notably, all of the states surveyed include “name” in their definition of “personality,” and most also include “likeness.” Other common, but not ubiquitous, elements include “signature,” “voice,” “portrait,”<sup>32</sup> “picture,” and “photograph.” Less common elements include “title,” “distinctive appearance,” “substantially similar imitation,” and “gestures or mannerisms.”]

<sup>86</sup> David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p. 171 (of 658); Angela D Cook, *Should Right of Publicity Protection Be Extended to Actors in the Characters in which They Portray* 9 *De-Paul LCA Journal of Art & Entertainment Law* 309, 342. (1999)

<sup>87</sup> McCarthy, *Supra* note 2, § 3:17

<sup>88</sup> *Waits v Frito-Lay Inc*, 978 F 2d 1093, 1102 (9th Cir, 1992)

- i. A straightforward courtroom comparison.<sup>89</sup>
- ii. Evidence of multiple elements within the defendant's use that collectively point to the plaintiff.<sup>90</sup>
- iii. Testimonies from reasonable individuals who recognized and commented on the similarity to the plaintiff.<sup>91</sup>
- iv. Survey evidence from the relevant group of purchasers showing their ability to identify the plaintiff from the defendant's use.<sup>92</sup>
- v. Direct or circumstantial evidence of the defendant's intent to trade on the plaintiff's identity, allowing for a presumption of identifiability.<sup>93</sup>

The following section shall look at some select examples of case law from New York and/or California, under some specific elements of identity, to study how courts have addressed the question of “use of identity” and “appropriation of commercial value” of such identity in specific fact scenarios

ii. Aspects of Identity: Direct Appropriation versus Evocative Appropriation

Judicial acknowledgment of a broad spectrum of actionable indicia of identity in right of publicity cases is reinforced by insights from cultural studies.<sup>94</sup> The modern celebrity, characterized by its “well-knownness,”<sup>95</sup> possesses specific attributes that enable extensive public identification. Distinctive features of identity that evoke a famous persona hold commercial value. For instance, a well-known phrase like “Here’s Johnny” can trigger a more vivid identification of the celebrity than a mere visual likeness.<sup>96</sup> The aim of the right of publicity, which is to prevent the unauthorized commercial exploitation of a valuable persona, is better fulfilled by adopting an inclusive standard for evocative identification.<sup>97</sup> Nonetheless, while evocation is necessary for a right of publicity claim, it is not sufficient on its own, and often, evocation will not give rise to a claim, a direct appropriation must happen.<sup>98</sup>

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<sup>89</sup> McCarthy, *Supra* note 2, § 3:22

<sup>90</sup> White v Samsung 971 F 2d 1395 (9th Cir, 1992); Ali v Playgirl 447 F Supp 723 (SD NY, 1978);

<sup>91</sup> Midler v Ford Motor Company, 849 F 2d 460 (9th Cir, 1988); Waits v Frito-Lay Inc, 978 F 2d 1093, 1102 (9th Cir, 1992)

<sup>92</sup> Doe v TCI Cablevision, 110 SW 3d 363 (Mo banc, 2003)

<sup>93</sup> As pointed out by Prof David Tan (David Tan, Commercial Appropriation of Fame, *Supra* note 16 at p. 172(of 658)) “This is particularly relevant in soundalike and lookalike cases especially when the advertising agency proceeds with an imitation after the celebrity has declined to be featured. E.g. Onassis v Christian Dior-New York Inc, 472 NYS 2d 254, 261 (1984) affd 488 NYS 2d 943 (1985) (“Onassis”); Waits, 978 F 2d 1093 (9th Cir, 1992); Midler, 849 F 2d 460 (9th Cir, 1988).”

<sup>94</sup> David Tan, *Much Ado About Evocation: A Cultural Analysis of “Well Knownness” and the Right of Publicity*, 28 CARDOZO ARTS & ENT. L.J. 317, 333 (2010)

<sup>95</sup> DANIEL J BOORSTIN, THE IMAGE: A GUIDE TO PSEUDO-EVENTS IN AMERICA (Narrated by Timothy Danko, Blackstone Audio Inc., 50th Anniversary Edition, 1962, audiobook released in Sept 2018) (Audible App edition)(audiobook). See also discussions under Chapter II of this dissertation, pp.2.20-2.26

<sup>96</sup> Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 832 (6th Cir. 1983). Johnny Carson had licensed his catch phrase “Here’s Johnny” to a chain of restaurants and was president of and part owner of an apparel company that sold clothing featuring the plaintiff’s name and likeness under the label “Here’s Johnny.

<sup>97</sup> David Tan, Much Ado about Evocation, *Supra* note 94 at 333 ;

<sup>98</sup> Fred Weiler, *The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity*, 13 CARDOZO ARTS & ENT. L.J. 223 (1994)

a) Name and Photograph as Indicia of Personality: Eastwood v Sup Ct for LA County<sup>99</sup>

Clint Eastwood, a renowned actor, filed a complaint against the Enquirer, presenting two causes of action: one for false light invasion of privacy and another for invasion of privacy through the commercial appropriation of his name, photograph, and likeness, under both common law and CCC section 3344. The first cause of action concerned the *Enquirer*, which published a widely read weekly newspaper called the “National Enquirer.” In its April 13, 1982 edition, the Enquirer published a 600-word article detailing Eastwood’s alleged romantic involvement with singer Tanya Tucker and actress Sondra Locke. The cover of this edition featured pictures of Eastwood and Tucker with the caption “Clint Eastwood in Love Triangle with Tanya Tucker.”



Source: Eastwood v. Superior Court | Cases | Westlaw  
[https://content.next.westlaw.com/Link/Document/Blob/14F069541326547F6A2DF26CAEA528B54.png?originalContext=document&transitionType=DocumentImage&uniqueId=89ada3c5-37dd-42a3-9b9b-bac86abea626&ppcid=7e71ddeaefba4df0af9a82d277eb49ac&contextData=\(sc.Default\)](https://content.next.westlaw.com/Link/Document/Blob/14F069541326547F6A2DF26CAEA528B54.png?originalContext=document&transitionType=DocumentImage&uniqueId=89ada3c5-37dd-42a3-9b9b-bac86abea626&ppcid=7e71ddeaefba4df0af9a82d277eb49ac&contextData=(sc.Default))

The article, headlined “Clint Eastwood in Love Triangle” appeared on page 48<sup>100</sup>. Eastwood claims that the article contained false information, alleging the following inaccuracies<sup>101</sup>:

- The article falsely claimed that Eastwood “loves” Tucker and that she means a lot to him.<sup>102</sup>
- It inaccurately stated that Eastwood was swept off his feet and immediately smitten by Tucker in late February 1982; that Tucker made his head spin; that she used her charms

<sup>99</sup> Eastwood v Sup Ct for LA County, 149 Cal.App.3d 409 (Cal. Ct. App. 1983)

<sup>100</sup> *Id.* at 414

<sup>101</sup> *Id.* at 414-415

<sup>102</sup> *Id.*

to get what she wanted from him; and that he now daydreams about their enchanted evenings together.<sup>103</sup>

- It falsely reported that Eastwood and Tucker shared 10 fun-filled romantic evenings together in late February 1982, during which they were constantly in each other's arms,<sup>104</sup> publicly cuddled, and gazed romantically at one another, kissing and hugging in public.
- The article falsely asserted that Eastwood was entangled in a romantic triangle with Tucker and Locke, unable to decide between them, and involved in a romantic tug-of-war with both women dueling over him. It claimed that when he was with Locke, Tucker was constantly on his mind.<sup>105</sup>
- It falsely stated that there were serious problems in Eastwood's relationship with Locke in late February 1982, including a huge argument over marriage, a nasty fight, and Locke storming out of his presence.<sup>106</sup>
- The article falsely claimed that after his supposed romantic interlude with Tucker, Locke camped at Eastwood's doorstep, begged him on hands and knees to "keep her," vowing not to pressure him into marriage, while he acted oblivious to her pleas.<sup>107</sup>

Eastwood also alleged that the Enquirer produced a televised advertisement featuring his name and photograph, prominently mentioning the subject article. Additionally, he claimed that these advertisements, along with the cover of the April 13 publication, were intended to boost sales of the Enquirer. Eastwood asserted thus that the unauthorized use of his name and photograph had harmed his *right to control the commercial use of his identity* and caused damage to his feelings and privacy.

The Enquirer did not contest the legal sufficiency of the first cause of action, which involved invasion of privacy by portraying Eastwood in a false light. However, the Enquirer did challenge the second cause of action, arguing that it did not state a valid claim because

- (1) Eastwood's name and photograph were not used to imply his endorsement of the Enquirer, and
- (2) his name and photograph were used in connection with a news story.

The lower court sustained the newspaper's general demurrer, concluding that the petitioner had not stated a cause of action. However, on appeal, the court determined that the petitioner had sufficiently alleged that the newspaper commercially exploited his name, photograph, and likeness under both common law and CCC § 3344(a). The court further found that the newspaper's conduct might constitute an infringement of the petitioner's right of publicity because Cal. Civ. Code § 3344(d), concerning news, did not exempt a knowing or reckless falsehood.

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<sup>103</sup> *Id*

<sup>104</sup> *Id*

<sup>105</sup> *Id*

<sup>106</sup> *Id*

<sup>107</sup> *Id*

The petitioner’s second cause of action, central to this case, relies on two theories: the common law action of commercial appropriation and the statutory remedy provided in Civil Code section 3344(a) for the knowing, unauthorized use of another’s name, photograph, or likeness for advertising or solicitation purposes.<sup>108</sup> A common law cause of action for appropriation of name or likeness requires allegations of: (1) the defendant’s use of the plaintiff’s identity, (2) the appropriation of the plaintiff’s name or likeness to the defendant’s advantage, commercially or otherwise, (3) lack of consent, and (4) resulting injury.<sup>109</sup> For the statutory remedy under Civil Code section 3344, there must also be an allegation of knowing use of the plaintiff’s name, photograph, or likeness for advertising or solicitation of purchases.<sup>110</sup> The court held that, based in (then) recent judicial interpretation of section 3344 has added a requirement of a “direct” connection between the use and the commercial purpose – however the use can be “in any manner”.<sup>111</sup>

Eastwood alleged that the Enquirer used his name, photograph, and likeness on the front page of the publication and in related telecast advertisements, without his consent, to promote the sales of the Enquirer. Thus, the court found that Eastwood had been successfully able to state an actionable claim in his second cause of action under either the common law or section 3344, or both, because two conditions are met: (1) the Enquirer’s use of Eastwood’s name, photograph, and likeness constituted an appropriation for commercial purposes<sup>112</sup>, and (2) the Enquirer’s conduct amounts to an impermissible infringement of Eastwood’s right of publicity.<sup>113</sup> The initial step in marketing a product or service involves capturing consumer attention. Celebrities, with their widespread appeal, naturally draw people’s focus to their names or images. In this case, the Enquirer capitalized on Eastwood’s fame and persona by featuring him on the cover of their publication and in related televised advertisements.<sup>114</sup> This usage helped the Enquirer garner a commercial edge by attracting reader interest. Eastwood claimed that the news story is completely fabricated and serves as a “cover-up or subterfuge for commercial appropriation” of his name and likeness.<sup>115</sup> Given this assertion, it is necessary to evaluate the First Amendment limitations.<sup>116</sup> When the deliberate fictionalization of Eastwood’s personality is presented to the public as truth, with actual malice, it constitutes commercial exploitation and becomes legally actionable, not Protected by public interest considerations in romantic lives of celebrities and First Amendment protections.<sup>117</sup>

b) Misappropriation of Dead Name - Abdul-Jabbar v General Motors<sup>118</sup>

Kareem Abdul-Jabbar was born Ferdinand Lewis (“Lew”) Alcindor and played basketball under that name during his college career and early years in the NBA. During college, he

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<sup>108</sup> *Id* at 417

<sup>109</sup> *Id* at 418

<sup>110</sup> *Id* at 418

<sup>111</sup> *Id* at 418, 420

<sup>112</sup> *Id* at 419-420

<sup>113</sup> *Id* at 422-424

<sup>114</sup> *Id* at 423

<sup>115</sup> *Id* at 423

<sup>116</sup> *Id* at 424

<sup>117</sup> *Id* at 426

<sup>118</sup> *Abdul-Jabbar v General Motors*, 85 F.3d 407 (9th Cir. 1996)

converted to Islam and began using the name “Kareem Abdul-Jabbar” among friends.<sup>119</sup> In 1971, he legally recorded the name “Kareem Abdul-Jabbar” under an Illinois name recordation statute and subsequently used this name professionally and for endorsements. He has not used the name “Lew Alcindor” for commercial purposes for over ten years.<sup>120</sup> In 1993, during the NCAA men’s basketball tournament, GMC aired a television commercial featuring trivia about Abdul-Jabbar.<sup>121</sup> The ad began with a voice asking, “How ‘bout some trivia?” followed by the text “You’re Talking to the Champ.”<sup>122</sup> The voice then asked, “Who holds the record for being voted the most outstanding player of this tournament?” The screen displayed, “Lew Alcindor, UCLA, ‘67, ‘68, ‘69.” The voice then asked, “Has any car made the ‘Consumer Digest’s Best Buy’ list more than once?” and answered, “The Oldsmobile Eighty-Eight has.”<sup>123</sup> A seven-second clip of the car, along with its price, followed, with the voice noting it made the list three years in a row and announcing a special edition price of \$18,995. The commercial concluded with the messages, “A Definite First Round Pick” and “Demand Better, 88 by Oldsmobile.”<sup>124</sup>

GMC did not obtain Abdul-Jabbar’s consent, nor did it compensate him, to use his former name in the commercial mentioned.<sup>125</sup> When Abdul-Jabbar raised concerns to GMC about the commercial, the company promptly withdrew it. The ad had aired about five or six times in March 1993 before its withdrawal.<sup>126</sup> The parties contested whether Abdul-Jabbar had abandoned the name Lew Alcindor and whether the ad could be perceived as an endorsement by Abdul-Jabbar of the 88 Oldsmobile.<sup>127</sup> In May 1993, Abdul-Jabbar filed a lawsuit in federal district court, asserting claims under the Lanham Act and California’s statutory and common law rights of publicity. During a hearing on March 14, 1994, which was incorporated into the summary judgment order, the district court made a tentative finding that Abdul-Jabbar had abandoned the name Lew Alcindor and any rights associated with it. This finding was the basis for the district court’s decision to grant summary judgment in favor of GMC on both the Lanham Act and state law causes of action.<sup>128</sup> Abdul-Jabbar promptly appealed, alleging violations of the Lanham Act, 15 U.S.C. § 1125(a), and California’s statutory and common law right of publicity.<sup>129</sup>

The court noted that neither the cases cited by the district court nor other relevant cases required that the reference must be “in common, present use”<sup>130</sup> under the statute or California common law.<sup>131</sup> Instead, they supported the notion that “identity” is a more flexible and permissive concept than the statutory list of particular means of appropriation.<sup>132</sup> The court concluded that

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<sup>119</sup> *Id.* at 409

<sup>120</sup> *Id.* at 409

<sup>121</sup> *Id.* at 409

<sup>122</sup> *Id.* at 409

<sup>123</sup> *Id.* at 409

<sup>124</sup> *Id.* at 409

<sup>125</sup> *Id.* at 410

<sup>126</sup> *Id.* at 410

<sup>127</sup> *Id.* at 410

<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at 415

<sup>131</sup> *Id.* at 414

<sup>132</sup> *Id.*

Abdul-Jabbar had presented sufficient facts to state a claim under both California common law and section 3344.<sup>133</sup> On the question of misappropriation for endorsement/commercial use, the court found that to the extent GMC's use of the plaintiff's birth name attracted television viewers' attention, GMC gained a commercial advantage.<sup>134</sup> However, the court also cautioned, that whether or not Lew Alcindor "equals" Kareem Abdul-Jabbar in the sense that "'Here's Johnny' equal[led] Johnny Carson," or "'the greatest equal[led] Muhammed Ali," or the glamorously dressed robot equalled Vanna White, is a question for the jury to decide.<sup>135</sup>

c) Look-alikes and evocative misappropriation – is associative evocation enough? Onassis v. Christian Dior - New York, Inc.<sup>136</sup>

The plaintiff, a former First Lady of the United States and a prominent figure in her own right<sup>137</sup>, sought a preliminary injunction to prevent the defendants from using or distributing an advertisement featuring her likeness through the photograph of a lookalike<sup>138</sup>. The defendants were conducting an advertising campaign to promote specific designer products and an image, fully aware that it was highly unlikely Onassis would consent to being depicted in such a campaign. Consequently, they hired an agency to supply a lookalike<sup>139</sup>.



NYLR §50 -51 both provide for remedies against the use *inter alia* of "picture or portrait" Once a violation is proven, the plaintiff has an unequivocal right to an injunction, irrespective of the comparative damage to the parties involved. The court held that the question of whether there is a violation hinges on the interpretation of the statute.<sup>140</sup> Defendants argue for a strict and literal adherence to the statute, suggesting there is no violation, while the plaintiff contends for a broader interpretation, insisting that there is indeed a violation.<sup>141</sup> The plaintiff's name does not appear in the advertisement, but the image of a well-known personality used in an ad, being instantly recognizable, serves as a tacit endorsement of the commercial product. This image is

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<sup>133</sup> *Id.* at 416

<sup>134</sup> *Id.* at 416

<sup>135</sup> *Id.* at 416

<sup>136</sup> *Onassis v. Christian Dior - New York, Inc.* 122 Misc. 2d 603 (N.Y. Sup. Ct. 1984)

<sup>137</sup> *Id.* at 604

<sup>138</sup> *Id.* at 605

<sup>139</sup> *Id.* at 606

<sup>140</sup> *Id.* at 607

<sup>141</sup> *Id.* at 607

intended to attract attention and focus it on the advertisement.<sup>142</sup> The court thus observed that the principle derived from studying the statute and related case law is that individuals, regardless of their public status, are to be protected against unauthorized commercial exploitation.<sup>143</sup> While the statute may not explicitly cover voice or movement, it aims to safeguard the essence of a person, their identity or persona, from being misappropriated without consent for someone else's profit.<sup>144</sup> The statute is written in the disjunctive, meaning there is no need for both the name and picture to be used together, as defendants suggest.<sup>145</sup> The core of what is prohibited by the statute is the exploitation of an individual's identity, whether conveyed verbally or graphically. Although a photograph might only depict the person in front of the camera, a "portrait or picture" can broadly encompass a representation that conveys an individual's essence and likeness, extending beyond mere actuality to include a purposeful resemblance to reality.<sup>146</sup> This case involves both actuality and appearance, where illusion can enhance reality, and things are not always as they seem.<sup>147</sup> Allowing an illusionist to benefit from this creation while disclaiming the impression they sought to create would create a loophole in the statute.<sup>148</sup> If a person refuses to endorse a product, hiring a lookalike achieves the same effect, which the statute aims to prevent.<sup>149</sup> Therefore, the statute must be interpreted sensibly to prevent easy evasion.<sup>150</sup> If we value the right to privacy in a world where distinctiveness is continually exploited for publicity, we must give the statute more than mere lip service.<sup>151</sup> The principle is clear: commercial entities cannot ride freely on someone else's fame without consent. The commercial hitchhiker must either pay the fare or stand on their own merits.<sup>152</sup> Thus, in essence, the court found, based on the undisputed facts, that the plaintiff's identity had been unlawfully appropriated for commercial and advertising purposes. It did not matter whether the picture used was genuine or counterfeit.<sup>153</sup> Given the clear violation, the plaintiff was entitled to preliminary injunctive relief, but not as broadly as requested. Since the advertisement had already been published, it could not be recalled. The plaintiff was assured against any future publication, but she was not entitled to possess all the prints, plates, and negatives used in creating the ad.<sup>154</sup> Miss Barbara Reynolds, the look-alike model hired, was enjoined only from appearing in commercial advertisements impersonating the plaintiff.<sup>155</sup>

The court in this case, had placed reliance on *Ali v Playgirl*.<sup>156</sup> Muhammad Ali had brought a diversity action seeking injunctive relief and damages against Playgirl, Inc., Independent News

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<sup>142</sup> *Id.* at 610

<sup>143</sup> *Id.* at 610

<sup>144</sup> *Id.* at 610

<sup>145</sup> *Id.* at 611

<sup>146</sup> *Id.* at 611

<sup>147</sup> *Id.* at 612

<sup>148</sup> *Id.*

<sup>149</sup> *Id.*

<sup>150</sup> *Id.*

<sup>151</sup> *Id.*

<sup>152</sup> *Id.*

<sup>153</sup> *Id.* at 616

<sup>154</sup> *Id.* at 616

<sup>155</sup> *Id.*

<sup>156</sup> *Ali v. Playgirl, Inc.* 447 F. Supp. 723 (S.D.N.Y. 1978)

Company (“Independent”), and Tony Yamada<sup>157</sup>. This action stemmed from the unauthorized printing, publication, and distribution of an objectionable portrait of Ali in the February 1978 issue of Playgirl Magazine. The magazine, published by Playgirl, Inc., and distributed in New York by Independent, featured a portrait depicting a nude black man seated in a boxing ring, unmistakably recognizable as Ali.<sup>158</sup>



He’s “The Greatest”, he can’t be beat,  
that we’d bet you any amount,

Some women would like a chance in the  
ring, to go down with him for the count

Source: Copy available with this researcher from being enrolled in the course *Entertainment Law: Popular Iconography and the Celebrity* at NUS Law (2012-2013) during LL.M. Reproduced here with the permission of Prof David Tan, who instructed this course and provided this image

Ali alleged that the publication of this portrait violated his rights under Section 51, NYCRL and his common law right of publicity.<sup>159</sup> He sought a preliminary injunction under Rule 65, Fed.R. Civ.P., to stop the distribution of the February 1978 issue, to withdraw it from circulation, to recover all copies currently offered for sale, and to surrender any printing plates or devices used to reproduce the portrait.<sup>160</sup> The court found Playgirl liable for appropriating Ali’s likeness without his consent. The ruling emphasized that Ali had a commercially valuable proprietary interest in his likeness and reputation, comparable to the name of a successful business entity.<sup>161</sup> The court held that Ali’s likeness and name could be used in legitimate news and feature articles due to his public figure status. However, the portrayal of Ali’s nudity had no legitimate news value.<sup>162</sup> The court denied First Amendment protection to Playgirl, noting that the commercial aspect of the drawing increased the publication’s circulation but did not contribute to any legitimate news or feature content.<sup>163</sup> This decision underscores the distinction between legitimate journalistic use of a public figure’s likeness and unauthorized commercial exploitation without consent.

<sup>157</sup> *Id* at 725

<sup>158</sup> *Id* at 725

<sup>159</sup> *Id* at 725

<sup>160</sup> *Id* at 725

<sup>161</sup> *Id* at 727

<sup>162</sup> *Id* at 727, 728

<sup>163</sup> *Id* at 727, 728

d) Voice and Sound-alikes – Evocative – Associative – Misappropriation - Midler v Ford<sup>164</sup>

Ford initially approached Midler to perform one of her songs for an upcoming commercial, but she declined, maintaining her career-long policy against endorsing products.<sup>165</sup> Instead of obtaining a compulsory license and hiring another singer to record the song for the ad<sup>166</sup>, Midler claimed that Ford deliberately engaged one of her former back-up singers – Ula Hedwig, as the instance of the ad agency Young and Rubicam, to imitate her distinctive voice.<sup>167</sup> This imitation allegedly led viewers to believe that Midler herself was performing in the commercial<sup>168</sup>, especially since the song in question – *Do you Wanna Dance*, from the album *The Divine Miss M*, was originally recorded by her and had gained significant popularity.<sup>169</sup> Midler sued Ford for violating her right of publicity under both the California statutory code and common law. She argued that Ford had misappropriated her likeness and persona by using a voice imitation that closely resembled her own.<sup>170</sup>

The court dismissed her statutory claim due to a strict interpretation of the code, it upheld her common law claim, because neither her ‘name’ or ‘picture’ or a direct taking of anything remotely her, was done – as required by CCC §3344(a).<sup>171</sup> However, the court went on further to nonetheless question as to why would a large enterprise, engage an advertisement agency, to replicate exactly to voice and alto of such a well-known, grammy winning singer?<sup>172</sup> Surely First Amendment protects advertisers against even commercial uses of celebrities in consumption culture<sup>173</sup>, however, voices are even more distinctive than human faces<sup>174</sup> and the court found that with such a distinctive and recognisable *singing voice*, having someone impersonate her, is equivalent to pirating her identity.<sup>175</sup> Thus, the court ruled that the broader common law protection covered the misappropriation of a celebrity’s “indicia of identity” – in this case, a singing voice, extending beyond the specific stipulations of the state statute.<sup>176</sup>

This decision continues to raise important questions about the duration and scope of protection that celebrities can claim over their voices in commercial contexts.<sup>177</sup> Specifically, how long

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<sup>164</sup> Midler v Ford Motor Co. 849 F.2d 460 (9th Cir. 1988); *See also* Waits v. Frito-Lay, Inc 978 F.2d 1093 (9th Cir. 1992) - Four years after *Midler*, the Ninth Circuit applied *Midler* to similar facts concerning Tom Waits’ claim against Frito-Lay for the use of a soundalike in an advertisement, singing in his inimitable raspy and gruff style, a counterintuitive song that was his original commentary on consumerism, after he had refused to sing in it. Waits received almost two-and-a-half million dollars in damages.

<sup>165</sup> *Midler, Id* at 461

<sup>166</sup> *Id.* at 461

<sup>167</sup> *Id.* at 461

<sup>168</sup> *Id.* at 461

<sup>169</sup> *Id.* at 462

<sup>170</sup> *Id.* at 462

<sup>171</sup> *Id.* at 463

<sup>172</sup> *Id.* at 463

<sup>173</sup> *Id.* at 462

<sup>174</sup> *Id.* at 463

<sup>175</sup> *Id.* at 464

<sup>176</sup> *Id.*

<sup>177</sup> Sharon Chester-Taxin, *Will the Real Bette Midler Please Stand Up? The Future of Celebrity Sound-Alike Recordings*, 9 U. Miami Ent. & Sports L. Rev. 165, 170 (1992)

can a celebrity prevent the imitation of their voice for product promotion? Determining what constitutes a distinctive voice also presents challenges.<sup>178</sup> Should it be based on an instinctive recognition, or should it involve scientific measures such as vibration, tone, intonation, and voice quality?<sup>179</sup> Moreover, should the protection for a celebrity's voice last as long as they maintain their celebrity status, or should it be indefinite?<sup>180</sup> Unlimited protection could potentially lead to monopolies over certain sounds, allowing celebrity status and the associated protections to continue throughout a performer's life and even posthumously.<sup>181</sup> This would create a lasting commercial advantage for celebrities, extending their influence and control over their likeness and voice far beyond their active careers.<sup>182</sup>

**\*Addendum – Areas of on-going and future research, May 2024.**

This researcher has been using her LinkedIn profile to put out small note style pieces on these developments, which can be accessed here - <https://www.linkedin.com/in/aakanksha-kumar-she-her-76507765/>. Citations to relevant readings are mentioned in the Bibliography

> Generative AI has been throwing up concerns, and has resulted in a major tussle between three groups –

- a) those who use Generative AI and make un-authorized use of sound-alikes,
- b) The celebrities whose voices are used without authorisation, and
- c) The users, who are using GenAI tools, to put out artistically expressive content, without commercialisation – for example, social media content creators, who are putting out versions of newer songs, sung by legendary yet deceased singers, in a “What If” template – exposing an entirely new generation, to a distinctive voice type, within songs they are more familiar with. The excessive proliferation of GenAI tools, have somewhat sent the performing artist community into an over-reaction drive, in that excessively restrictive legislations, that potentially will affect not just creatorship, but also employment, when such protections are going to become available post mortem [specially pointed out in Prof Rothman's testimony before the Senate Committee]

> Tennessee has proposed a new legislation to tackle Generative AI voice sound alike, which is imaginatively called the ELVIS Act [“Ensuring Likeness Voice and Image Security (ELVIS) Act,”]– because the state is home to the legendary crooner and Elvis impersonators abound.

> The US House of Representatives took steps towards protecting recording artists and the music industry from the use of AI technologies to create recordings that replicate or imitate an artist's voice without the artist's consent, by introducing in early January 2024, a federal bill

<sup>178</sup> David Tan, Much Ado about Evocation, *Supra* note 94 at 326; Leonard Marks, *Granting Publicity Rights to Heirs Protects Performers' Privacy Rights*, MANHATTAN LAW., Apr. 12, 1988.

<sup>179</sup> Alan J. Hartwick, *Is Soundalike Protection Unnecessarily Unlimited?*, N.Y.L.J., June 15, 1990, at 5.

<sup>180</sup> Leonard Marks, *Supra* note 178 at 13

<sup>181</sup> Alain J. Lapter, Esq., *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford A Global Perspective on the Right of Publicity*, available at <https://law.bepress.com/cgi/viewcontent.cgi?article=6630&context=expresso>

<sup>182</sup> Leonard A. Wohl, *The Right of Publicity and Vocal Larceny: Sounding Off on Sound-Alikes*, 57 Fordham L. Rev. 445 (1988); Scott Martin, *How to Steer Clear of Sound Alikes*, ELEC. MEDIA, June 18, 1990.

entitled the “No Artificial Intelligence Fake Replicas and Unauthorized Duplications Act of 2024” or “No AI FRAUD Act.” Congressional hearings were held in the end of May and early February 2024, on both the NO AI FRAUD Act, and the other proposed legislation, NO FAKES Act - Nurture Originals, Foster Art, and Keep Entertainment Safe Act 8 of 2023” or the “NO FAKES Act of 2023” [which proposes to heavily regulate digital replicas and deepfakes]

>Voice over artist Paul Skye, his partner Linnea Sage (on behalf of similarly situated others), have brought a proposed class action suit in May 2024 against Berkeley-based AI startup #LOVO, filed in New York federal court - accusing the company of misappropriating their voices, as well as those of other entertainers such as Scarlett Johansson, Ariana Grande and Conan O’Brien. This is the first of its kind lawsuit against an AI firm itself, over the use of likenesses to train an AI system. The claim centers on an alleged violation of New York’s right of publicity law, says LOVO sells its services using “stolen property” and falsely “represents that it has the legal right to market these voices” when it doesn’t.

>The estate of George Carlin sued a pair of podcasters in early 2024 for using artificial intelligence to create a script and voice imitating the late comedian. The estate said in the lawsuit, that actor Will Sasso, writer Chad Kultgen and their "comedy AI" podcast Dudesy violated Carlin's copyrights and [inherited] right of publicity, with their YouTube video “George Carlin: I'm Glad I'm Dead.” Carlin died in 2008

> The concern on voice as indicia of identity protectable under the right of publicity, has been most recently presented itself, in relation to OpenAI’s Scarlett Johansson alleged sound-alike, “Sky,” one of five possible voice personas available to ChatGPT users to engage with. In Mid May, Entertainer Scarlett Johansson, said in a statement she was approached by OpenAI nine months ago to voice its AI system but declined for “personal reasons”. Johansson was “shocked” and “angered” when she heard the voice option, which “sounded so eerily similar to mine that my closest friends and news outlets could not tell the difference”. Moreover, OpenAI’s CEO Sam Altman, seemed to evoke and allude to Johansson’s character in the film "Her" posting a one-word tweet after the presentation of “Sky”, that simply said “her”. Eventually, OpenAI felt compelled to explicitly clarify that Sky was not based on Johansson. The company published a blogpost about Sky’s creation and claimed that the company values the voice acting industry. Interestingly, Johansson previously brought an action, when a likeness of hers appeared in a 22-second ad posted on X/Twitter by the artificial intelligence image-generating app called Lisa AI: 90s Yearbook & Avatar

> China is not lagging behind, and though it has only a very nascent right of publicity legislation, it already has a voice rights – sound alike case. In April 2024, Beijing Internet Court of China ruled against a defendant that used dubber -Yin’s voice to train a generative AI model. This is also a fascinating case on the question of whether a sound recording made under contract, leads to an implied license over personality rights of the voice artist, held by the media company as the owner of copyright in the sound recording. Under Chinese Civil Code Art 1023, protection of a natural person's voice is to be treated the same as the protection of "image rights", and thus voice is treated as a personal right.

e) Other Evocative Indicia: Misappropriation of Catchphrases – Carson v Here’s Johnny Portable Toilets<sup>183</sup>

John W. Carson (Carson), was the then the host and star of “The Tonight Show”, a popular television program broadcast five nights a week by the National Broadcasting Company. Carson also performed as an entertainer in nightclubs and theaters across the country. On the show, he would be introduced to and walk out on a musical sing-song voice-over, “Here’s Johnny!”<sup>184</sup> Alongside Carson, the additional appellants are Johnny Carson Apparel, Inc. (Apparel), established in 1970, manufactured and marketed men’s clothing to retail stores. Carson, the president of Apparel and holder of 20% of its stock, had licensed Apparel to use his name and picture, which were featured on nearly all of Apparel’s products and promotional materials. With Carson’s consent, Apparel also used the phrase “Here’s Johnny” on clothing labels and in advertising campaigns.<sup>185</sup> In 1977, Apparel granted a license to Marcy Laboratories to use “Here’s Johnny” as the name for a line of men’s toiletries. However, the phrase “Here’s Johnny” has never been registered by appellants as a trademark or service mark.<sup>186</sup> They brought an action against the defendants – Here’s Johnny Portable Toilets, Inc., which was a Michigan corporation that rented and sold “Here’s Johnny” portable toilets.<sup>187</sup> The founder of the company was aware when he formed the corporation that “Here’s Johnny” was the introductory slogan for Carson on “The Tonight Show.”<sup>188</sup> He indicated that he combined the phrase with another slogan, “The World’s Foremost Comedian,” “to create a good play on a phrase.”<sup>189</sup>



Carson brought an action under unfair competition, trademark infringement under federal and state law, and invasion of privacy and publicity rights, under Michigan law<sup>190</sup>, which recognises a common law misappropriation of publicity tort.<sup>191</sup> The fact that consumers would not think Johnny Carson owned or endorsed the portable toilet company was relevant to an unfair competition action but irrelevant to a right of publicity action.<sup>192</sup> The majority decision in the

<sup>183</sup> Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983)

<sup>184</sup> *Id.* at 833

<sup>185</sup> *Id.* at 833

<sup>186</sup> *Id.* at 833

<sup>187</sup> *Id.* at 833

<sup>188</sup> *Id.* at 833

<sup>189</sup> *Id.* at 833. Also, informally in the USA, “john” refers to the bathroom/toilet. *Refer*, Meaning of the word “john”, Cambridge Dictionary, <https://dictionary.cambridge.org/us/dictionary/english/john> (last visited May 14, 2024)

<sup>190</sup> *Id.* at 833

<sup>191</sup> Rothman’s Right of Publicity Roadmap, Michigan, [https://rightofpublicityroadmap.com/state\\_page/michigan/](https://rightofpublicityroadmap.com/state_page/michigan/)

<sup>192</sup> *Id.* at 835

case essentially adopted a functional, ‘celebrity right of publicity theory’ test<sup>193</sup>: if anything used in the advertisement triggers an association with a celebrity, it is a violation of the right of publicity.<sup>194</sup> The Sixth Circuit concluded that the district court's conception of the right of publicity was too narrow and held that the scope of the right is not limited to the misappropriation of a “name” or “likeness”, but rather extends to any situation in which a celebrity’s identity is commercially exploited.<sup>195</sup> Interestingly, the district court and the appeals court in *Carson* found no evidence that the appellant had been damaged by the appellee’s usage of the phrase<sup>196</sup>. The Carson courts also found that although the appellee had intentionally capitalized on the phrase “Here’s Johnny,”, he did not intend to deceive the public into believing Carson was connected with the product. Moreover, the courts found little evidence of actual confusion.<sup>197</sup>

Thus, it has been argued in the aftermath of the *Carson* decision, that if extended too far, the right of publicity would result in the impairment of precious First Amendment freedoms. As one commentator aptly stated, “One man's right is another man’s restraint.”<sup>198</sup> The additional rights granted to one individual under an expansive right of publicity simultaneously represent additional limitations on the free speech rights of all other individuals in society.<sup>199</sup> Such limitations on guaranteed First Amendment freedoms must not be accepted casually.<sup>200</sup>

f) Other Evocative Indicia: Likeness – Associative Evocative Misappropriation via Robot Caricature in *White v Samsung*<sup>201</sup>

Defendants, Samsung Electronics America, Inc. (Samsung) and David Deutsch Associates, Inc. (Deutsch) attempted to capitalize on Vanna White's fame in a particular advertisement without Vanna White’s permission.<sup>202</sup> White brought the suit in the United States District Court of California, alleging infringement of various intellectual property rights.<sup>203</sup> Vanna White is the hostess of one of the most popular game shows on television, *Wheel of Fortune*. An estimated forty million people watch the program daily.<sup>204</sup> White markets her identity to various advertisements, but did not market her identity to defendants. Deutsch produced a series of advertisements for Samsung.<sup>205</sup> The series of advertisements ran in over six widespread publications. On some occasions the publications were run nationally. Each publication had the

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<sup>193</sup> *Id.* at 835

<sup>194</sup> *Id.* at 835

<sup>195</sup> *Id.* at 835

<sup>196</sup> *Id.* at 834

<sup>197</sup> *Id.* at 834

<sup>198</sup> Carrie Goldstein, *Carson v. Here's Johnny Portable Toilets, Inc.: Plumbing the Depths of the Right of Publicity*, 7 *Hastings Comm. & Ent. L.J.* 319 (1984);; Hoffman, *Limitations on Right of Publicity*, 28 *BULL. COPYRIGHT SOC'Y* 111 (1980).

<sup>199</sup> Hoffman, *Id.* [“When enforced, ... the right of publicity may conflict with both the defendant’s and the public’s right of free expression in a number of ways. First the right of publicity can inhibit free expression .... Second, reports and commentaries on the thoughts and conduct of public and prominent persons [could] be subject to censorship under the guise of preventing the dissipation of the publicity value of a person’s identity”]

<sup>200</sup> Goldstein, *Supra* note 198 at 327

<sup>201</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992).

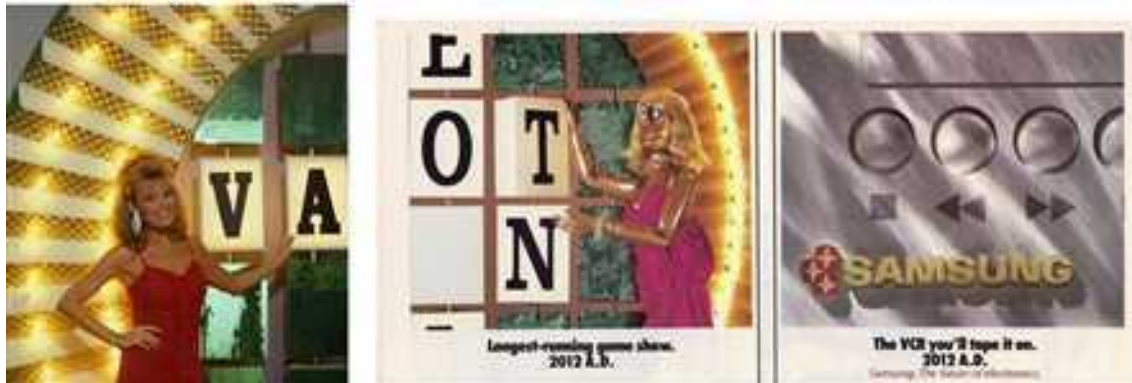
<sup>202</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992).

<sup>203</sup> *White v. Samsung Elecs. Am., Inc.*, No. CV-88-06499-RSWL (C.D. CA. 19).

<sup>204</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F. 2d at 1396.

<sup>205</sup> *Id.*

same theme. They would each depict a current item from popular culture and a Samsung electronics product. Each of the publications was based in the time period of the twenty-first century, and they conveyed the message that these Samsung products would still be in use.<sup>206</sup> The advertisement that was in dispute for this case depicted a robot standing next to the clearly recognizable Wheel of Fortune board. Additionally, the commercial showed a robot with distinctive hair, jewelry, and clothing that the audience could reasonably assume was supposed to be Vanna White.<sup>207</sup> The defendants called this ad the “Vanna White” ad. The caption on the advertisement stated “Longest-running game show. 2012 A.D.”<sup>208</sup> Unlike other celebrities depicted in these advertisements, Vanna White was not paid, and did not consent to the ad.<sup>209</sup>



White sued Samsung and Deutsch under California Civil Code § 3344, California common law right of publicity, and §43(a) of the Lanham Act.<sup>210</sup> The District Court of California granted defendant’s summary judgment motion on all claims<sup>211</sup>. White appealed the District Court’s decision to the Ninth Circuit Court of Appeals.<sup>212</sup> The Ninth Circuit analysed each claim individually. Regarding the California Civil Code § 3344, the Ninth Circuit affirmed the district court’s ruling, stating that the robot at issue was not White’s “likeness” within the meaning of section 3344.<sup>213</sup> Regarding the common law right of publicity claim, the Ninth Circuit stated that, although the defendants avoided the most obvious means of appropriating the plaintiffs’ identity, “each of their actions directly implicated the commercial interests which the right of publicity is designed to protect.”<sup>214</sup> The Ninth Circuit determined that the right of publicity claim should have gone to a jury for decision because there was enough information to defeat summary judgment in favour of the defendant.<sup>215</sup> The Ninth Circuit also remanded White’s Lanham act claim stating that it should also be a matter for jury decision.<sup>216</sup> The Ninth Circuit

<sup>206</sup> *Id.*

<sup>207</sup> *Id.*

<sup>208</sup> *Id.*

<sup>209</sup> *Id.*

<sup>210</sup> *White v. Samsung Elecs. Am., Inc.*, No. CV-88-06499-RSWL

<sup>211</sup> *Id.*

<sup>212</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F. 2d at 1397.

<sup>213</sup> *Id.*

<sup>214</sup> *Id.* at 1400-01.

<sup>215</sup> *Id.* at 1401.

<sup>216</sup> *Id.*

used the *Sleekcraft* factors and determined that the district court erred in rejecting White's Lanham Act claim.<sup>217</sup>

The Ninth Circuit also rejected defendant's Parody defense stating that because this was an advertisement for profit it could not use that particular defense.<sup>218</sup> The case involved a true advertisement run for the purpose of selling Samsung VCRs. Because the advertisement's main goal was to sell VCRs, the defendants cannot claim that the advertisement was used for the sole purpose of humour.<sup>219</sup>

This decision has been criticised on two opposing counts, and both are valid : first, that the decision is riddled with condescension and disdain for Vanna White, by belittling her claim, and also painting her as a live robot with little to do on the show.<sup>220</sup> Second, when Samsung claimed the First Amendment defense, the Ninth Circuit brusquely rejected it and noted that Samsung had paid other celebrities besides Vanna White in return for authorization to use their likenesses in its advertising campaign, thus not really championing free speech as they seemingly set out to do at the beginning of the order.<sup>221</sup> As Prof Tushnet opines, that such an expansive Right of Publicity then, that goes to any form of likeness being given protections for, can then be metaphorically shorthanded as a right to control one's "image,"<sup>222</sup> reflecting how publicity rights are intertwined with the visually driven culture of the past century that has shaped modern celebrity.<sup>223</sup> This metaphor aligns with a key characteristic of visual images: they convey more than just visual information. A person's "image" encompasses not only their appearance but also facts or public perceptions about them.<sup>224</sup> While we may caution against judging books by their covers, it is a common practice. Because an "image" is so laden with

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<sup>217</sup> *Id.*

<sup>218</sup> *Id.*

<sup>219</sup> *Id.*

<sup>220</sup>White v. Samsung – Feminist Rewrite, Uploaded by Emily Donohue, YouTube (Apr 23, 2020), [https://www.youtube.com/watch?v=06\\_KIw1u4f8](https://www.youtube.com/watch?v=06_KIw1u4f8); Brian L Frye, *Commentary on White v. Samsung in FEMINIST JUDGMENTS: REWRITTEN PROPERTY OPINIONS*. 149–176 (Ed. Eloisa C. Rodriguez-Dod and Elena Maria Marty-Nelson, Cambridge University Press, 2021) . In fact, Frye undoes most of this damage from the get go, opening the re-written judgment thus – “*Vanna White is the hostess of Wheel of Fortune. She joined the show in 1982, after winning a nationwide search against more than 200 contestants. While her nominal job is to reveal the letters chosen by the contestants, she soon became the true star of the show. Fans were obsessed by her poise and style, in part because she wore a different outfit for every episode. She became a fashion icon, and Wheel of Fortune owes its remarkable success primarily to “Vannamania” and its aftermath.*”<sup>5</sup> For a few years, White was among the most popular American celebrities, and thirty years later, she remains instantly recognizable, at least among certain demographics”

<sup>221</sup> Mark Bartholomew and Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*. 81 (1) THE GEORGE WASHINGTON LAW REVIEW 1 (January 2013) ; See Rebecca Tushnet, *A Mask that Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 1 (2015) [hereinafter Tushnet, *A Mask that Eats*]; Rebecca Tushnet, *Raising Walls Against Overlapping Rights: Preemption and the Right of Publicity*, 92 NOTRE DAME L. REV. 1539, 1541 (2017); and the counter views of Dustin Marlan, *Unmasking the Right of Publicity*, 71 HASTINGS L.J. 419 (2020); John F. Hyland and Ted C. Lindquist III, *Torts - White v. Samsung Electronics America, Inc.: The Wheels of Justice Take an Unfortunate Turn*, 23 GOLDEN GATE U. L. REV. (1993).

<sup>222</sup> Tushnet, *A Mask that Eats*, *Supra* note 221 at 2

<sup>223</sup> David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p 212(of 658)

<sup>224</sup> Tushnet, *A Mask that Eats*, *Supra* note 221 at 2

meaning, referring to it can appear to take—or misappropriate—something substantial, thereby justifying a celebrity’s claim to control it.<sup>225</sup>

iii. First Amendment and Right of Publicity: What types of “expressive” taking are protected?

The First Amendment to the U.S. Constitution provides that Congress shall make no law abridging the freedom of speech or of the press. In a right of publicity case, if a plaintiff successfully demonstrates that they have been identified by the defendant’s use and that the defendant has appropriated the associative value of their identity, the plaintiff may still encounter a significant defense argument asserting that the unauthorized commercial use is protected by the First Amendment.<sup>226</sup> Without definitive U.S. Supreme Court guidance<sup>227</sup>, circuit and state courts have been attempting to establish a comprehensive standard to address the conflict between the right of publicity—recognized as a private property right—and the free speech values upheld by the First Amendment<sup>228</sup>. This situation has led to the proposal of various tests<sup>229</sup> to balance these competing claims, with much criticism that the current state of the First Amendment defense is “a confusing morass of inconsistent, incomplete, or mutually exclusive approaches, tests, and standards.”<sup>230</sup>

This section shall not aim to study the goals of the First Amendment<sup>231</sup>, or theorise on its affect and role for the right of publicity,<sup>232</sup> as the same are beyond the scope of this dissertation. An attempt shall be made to only identify some *methods* and *tests* as evolved by courts, to define

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<sup>225</sup> Tushnet, *A Mask that Eats*, *Supra* note 221 at 2

<sup>226</sup> David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment* 2 HARVARD JOURNAL OF SPORTS & ENTERTAINMENT LAW I (2011) at 2

<sup>227</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977). – this is the only right of publicity case ever to reach the U.S. Supreme Court, and the court affirmed the recognition of such an actionable right under Ohio state law.

<sup>228</sup> David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p 338(of 658) (“*In the US state jurisdictions that recognise the right of publicity, there appears to be an established practice that courts will first apply the ‘newsworthiness’ test where an individual’s identity is used in relation to a matter of public interest. If the use is not newsworthy, then courts will proceed to apply what is commonly called the ‘First Amendment defence’ to balance the right of publicity with free speech interests. This First Amendment defence can take the form of different judicial tests such as the ‘transformative use’ test or the ‘predominant purpose’ test.*”)

<sup>229</sup> For example, David M Schlachter, ‘*Adjudicating the Right of Publicity in Three Easy Steps*’ (2006) 14 JOURNAL OF LAW & POLICY 471; Jason K Levine, ‘*Can the Right of Publicity Afford Free Speech? A New Right of Publicity Test for First Amendment Cases*’ (2004) 27 HASTINGS COMMUNICATIONS & ENTERTAINMENT LAW JOURNAL 171; W Mack Webner and Leigh Ann Lindquist, ‘*Transformation: The Bright Line between Commercial Publicity Rights and the First Amendment*’ (2004) 37 AKRON LAW REVIEW 171; Eugene Volokh, ‘*Freedom of Speech and the Right of Publicity*’ (2003) 40 HOUSTON LAW REVIEW 903; Mark S Lee, ‘*Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*’ (2003) 23 LOYOLA LA ENTERTAINMENT LAW REVIEW 471; Roberta Rosenthal Kwall, ‘*The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*’ (1994) 70 INDIANA LAW JOURNAL 47; Michael Schoeneberger, ‘*Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Befitting the Right of Publicity*’ (2013) 45 CONNECTICUT LAW REVIEW 1875; Joshua Bloomgarden, ‘*Share His Dream: A Fair Use Standard for Historico-Political Figures’ Rights of Publicity*’ (2012) 31 CARDOZO ARTS & ENTERTAINMENT LAW JOURNAL 149 *cited in* David Tan, *Commercial Appropriation of Fame*, *Supra* note 16 at p 324 (of 658)

<sup>230</sup> Gloria Franke, *The Right of Publicity vs the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CALIF. L. REV. 945 (2006) at 946; Gil Peles, *The Right of Publicity Gone Wild*, 11 UCLA ENT. L. REV. 301, 302 (2004) *cited in* David Tan, *Political Recoding of the Contemporary Celebrity*, *Supra* note 226 at 3.

<sup>231</sup> *Refer* 6. *Right of Publicity and the Freedom of Speech under the First Amendment in* David Tan, *Commercial Appropriation of Fame*, *Supra* note 16

<sup>232</sup> *Id.*

the contours of the First Amendment defense to a prima facie claim of right of publicity violation. Building therefrom, and from the works of David Tan<sup>233</sup>, Rosemary Coombe<sup>234</sup>, Rebecca Tushnet<sup>235</sup> and others, an attempt will be made to understand how certain uses of celebrity identity can be classified as protected free speech and expression, due to their cultural and economic importance in consumption. An attempt is also being made, to study and learn for India, ways in which current judicial tests can consider recordings of the celebrity sign as expressive resources themselves, to enhance the protection of speech that contributes to democracy. The argument being furthered throughout in this study, is that when the law grants a celebrity a right of publicity, it provides them with more than just additional income through licensing fees.<sup>236</sup> It actually bestows upon the celebrity a significant degree of control over the production and dissemination of meaning within society.<sup>237</sup> This control allows the celebrity to suppress interpretations or appropriations of their persona that deviate from their preferred narrative or image.<sup>238</sup>

As discussed in Chapter II<sup>239</sup> and IV, A celebrity's image is often seen as a "cultural narrative" or "signifier" synonymous with dominant culture. The public personas of many celebrities, particularly movie stars and sports icons, are meticulously constructed. The audience usually decodes these well-known individuals as representing a specific cluster of meanings. A celebrity persona is comparable to a well-known brand; each advertisement featuring a celebrity acts as a contributory iteration of the brand. Its function is to connect the brand idea to the advertised product or service in an appropriate style. Movie stars are typically represented as objects of aspiration, glamour, and desire, while celebrity athletes signify heroism, human transcendence, and a love for the pure, authentic game.

For example, if we were to take Oscar Winner Brad Pitt, as the signifier, of the celebrity image, he is signifying desirable attributes of Sexual Desirability, Acting Credibility, Oscar Winner –

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<sup>233</sup>David Tan, Commercial Appropriation of Fame, *Supra* note 16; David Tan, "Affective Transfer and the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity" (2010) 9 VA. SPORTS & ENT. L.J. 272 at 278; David Tan, *The Unbearable Whiteness of Beckham: Political Recoding of Celebrity Signs in First Amendment Jurisprudence* in, POWER & CONTROL: PERSPECTIVES ON LEGAL COMMUNICATION TRANSPARENCY 217 (VIJAY K BHATIA, CHRISTOPH HAFNER, LINDSAY MILLER AND ANNE WAGNER (EDS), 2012); David Tan, *The Lost Language of the First Amendment in Copyright Fair Use: A Semiotic Perspective of the 'Transformative Use' Doctrine Twenty-Five Years On*, 26 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 311 (2016); David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1 (2011); David Tan, *The Contribution of Cultural Studies to Right of Publicity Laws: Evocative Identification, Associative Appropriation and Political Recoding*, Unpublished PhD Dissertation, The University of Melbourne and Melbourne Law School, (April 2010) <https://rest.neptune-prod.its.unimelb.edu.au/server/api/core/bitstreams/83a2cfb2-1f70-5a3a-8556-ac5780b066e7/content>

<sup>234</sup>ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION AND THE LAW, 17 (Durham, NC: Duke University Press, 1998); Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENT. L.J. 365 (1992).

<sup>235</sup> Rebecca Tushnet, *Make Me Walk, Make Me Talk, Do Whatever You Please: Barbie and Exceptions*, in INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 401-408 (ROCHELLE COOPER DREYFUSS AND JANE C. GINSBURG EDS., 2014); Tushnet, *A Mask that Eats*, *Supra* note 221

<sup>236</sup> David Tan, *Evocative Identification, Associative Appropriation and Political Recoding*, *Supra* note 233 at 21

<sup>237</sup> Michael Madow, *Private Ownership of Public Image*, *Supra* note 1 at 145 ("the power to license is the power to suppress")

<sup>238</sup> David Tan, *Evocative Identification, Associative Appropriation and Political Recoding*, *Supra* note 233 at 22

<sup>239</sup> Refer Chapter II, pp.2.12 to 2.18; Chapter IV at pp. 4.1-4.2; 4.38

hard work, Achievement, and is also awkwardly goofy in public appearances. His negative significations also include his estrangement from his children with former partner Angelina Jolie colouring public perception, and his alleged misbehaviour with his family in the past. Nonetheless, if the positive signification were encoded...



**DE/RECODING THE BRAD PITT CELEBRITY SIGN**



...Then, a great example of how the celebrity signifier can be *re coded*, alongside the luxury brand's messaging also being recoded, is SNL's hilarious sketch version <sup>240</sup> of Brad Pitt's video advertisement for *Chanel No.5*.<sup>241</sup> "Is there really no script, because I've been talking to myself for two hours straight. I'm starting to sound insane," the Pitt look-alike actor - Taran Killam

<sup>240</sup> Brad Pitt Ad I - Saturday Night Live, Uploaded by SNL- Saturday Night Live. You Tube (Sep 24, 2013) [https://www.youtube.com/watch?v=pd\\_BOTXkr18](https://www.youtube.com/watch?v=pd_BOTXkr18); Brad Pitt Ad II - Saturday Night Live, Uploaded by SNL- Saturday Night Live. You Tube (Sep 24, 2013) <https://www.youtube.com/watch?v=sVAXN6d1T6U> ; Brad Pitt Ad III - Saturday Night Live, Uploaded by SNL- Saturday Night Live. You Tube (Sep 24, 2013) <https://www.youtube.com/watch?v=SAJ1FxGh1nY>; Brad Pitt Ad IV - Saturday Night Live, Uploaded by SNL- Saturday Night Live. You Tube (Sep 24, 2013) <https://www.youtube.com/watch?v=wDIixfoN1vw> (other versions, pretending to sell Taco Bell, Promoting Tattoo Removals and Dog Condoms)

<sup>241</sup> N°5, the Film with Brad Pitt: There You Are – CHANEL Fragrance, Uploaded by Chanel, You Tube (Oct 15, 2012) <https://www.youtube.com/watch?v=mGs4CjeJiJQ>

says in one ad, after speaking nonsense for a while.<sup>242</sup> In four distinct parodies of Chanel's commercial, Killam gives a spot-on impression of Brad Pitt, complete with a thick beard and shaggy wig reminiscent of Pitt's look. He continues, "I'm sorry, is it just me or do I look super homeless? That's what you want? Okay, then. Rock and roll."<sup>243</sup> This initial skit was just the beginning. In three additional parodies, Killam remains in the same setting, humorously promoting a variety of products including Taco Bell, tattoo removal services, and even dog condoms. In the third skit, he delivers an amusing pitch for dog condoms, saying, "There's a yearning inside of all of us...that yearning never dies. Even if you're a dog. Franklin's Dog Condoms. He's your best friend. Why not be his? And let him keep his balls." <sup>244</sup> The original ad itself which features Pitt as the first male spokesperson for the iconic perfume, was deemed abstruse and esoteric by many. This is what seemingly led to comedic parodies on mocking both the pretentious nature of the ad and Pitt himself.<sup>245</sup> Others speculated, on why this particular ad would work - because he's considered sexy and authentic? Or perhaps it's because his moody, philosophical, and highly pretentious advertisement for Chanel N° 5 is so ripe for parody that the fashion house is capitalizing on the viral wave it generated?<sup>246</sup> Parody videos not only attract substantial traffic themselves but also boost views for the original videos being parodied.<sup>247</sup> Consequently, Pitt is enjoying a good laugh—and a payday—while the commercial benefits from extensive free airtime, having garnered over 7 million views in 24 hours<sup>248</sup> This is a commercial expressive use, surely, however, it is also a valuable recoded use, by encouraging an alternative discourse in the larger semiotics for the consuming audience. The argument is that if this were to go to a trial for Brad Pitt's personality rights, it may so happen that due to the publicity rights being characterised as an interest like private property, significant judicial deference to this right would kick in.<sup>249</sup> This deference often results in the underestimation of the importance of competing First Amendment free speech values.<sup>250</sup> This trend is especially pronounced when the claimed expressive use occurs within a commercial context, which courts typically view as part of the "private" market sphere. <sup>251</sup> By focusing on celebrities and their created, curated personae as "speech events" rather than strictly as property, judicial approaches could create space for considering "recoded" cultural productions.<sup>252</sup> This shift would enhance respect for free speech values by diluting the strict

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<sup>242</sup> Kimberly Nordyke, Aaron Couch, 'SNL' Mocks Brad Pitt's Chanel No. 5 Ad (Video), The Hollywood Reporter (Oct 21, 2012) <https://www.hollywoodreporter.com/news/general-news/snl-mocks-brad-pitts-chanel-no-5-ad-video-381492/>

<sup>243</sup> *Id.*

<sup>244</sup> Brandi Fowler "Saturday Night Live" Spoofs Brad Pitt's Chanel Commercial Taran Killam gives a spot on impression of Pitt in four parodies, NBC DFW, (Oct 21, 2012) [https://www.nbcdfw.com/news/national-international/saturday\\_night\\_live\\_spoofs\\_brad\\_pitt\\_s\\_chanel\\_commercial/1936137/](https://www.nbcdfw.com/news/national-international/saturday_night_live_spoofs_brad_pitt_s_chanel_commercial/1936137/)

<sup>245</sup> Robert Passikoff, Chanel Thinks You'll Buy Perfume From Brad Pitt, Forbes (Oct 12, 2012) <https://www.forbes.com/sites/marketsshare/2012/10/23/chanel-thinks-youll-buy-perfume-from-this-man/>

<sup>246</sup> Anthony Wing Kosner, Why Is Brad Pitt's Chanel N° 5 Ad So Easy To Parody?, Forbes (Oct 26, 2012) <https://www.forbes.com/sites/anthonykosner/2012/10/26/why-is-brad-pitts-chanel-n-5-ad-so-easy-to-parody/>

<sup>247</sup> Pasikoff, *Supra* note 245

<sup>248</sup> Kosner, *Supra* note 246

<sup>249</sup> Keith Aoki, *Adrift in the Intertext: Authorship and Audience Recoding Rights - Comment on Robert H. Rotstein, Beyond Metaphor: Copyright Infringement and the Fiction of the Work*, 68 CHI.-KENT L. REV. 805 (1992) at 826

<sup>250</sup> *Id.*

<sup>251</sup> *Id.*

<sup>252</sup> *Id.*

property-based perspective that currently governs interests protected right of publicity.<sup>253</sup> This approach would allow for a more nuanced judicial analysis that recognizes the interplay between property rights and free speech, especially in contexts where cultural and artistic expressions are at stake.<sup>254</sup> Coombe explains this further by arguing that the law governing publicity rights prohibits the unauthorized reproduction of a celebrity's image for someone else's benefit, thereby fostering the mass circulation of celebrity images by ensuring they retain market value.<sup>255</sup> If these images were freely available for widespread reproduction, there would likely be less incentive to invest in their dissemination through various media channels.<sup>256</sup> Ironically, while this legal framework helps to create fixed, stable identities controlled by the celebrity, it also opens up spaces where these identities can be contested and challenged. Thus, both authorized and unauthorized representations of celebrity identities are shaped by this legal regime.<sup>257</sup>

a) Performers' Rights and Implicit Right of Publicity violation: News Broadcast is not free speech? *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>258</sup>, USSC

*Zacchini* was the first, and so far only Supreme Court ruling on right of publicity. *Zacchini* sets the stage for analysis of systematized frameworks that have emerged as courts struggle with finding a standardized way for performing this balancing (between Right of Publicity and First Amendment) inquiry. Hugo Zacchini, petitioner, was an entertainer famous for his "human cannonball" act. In this act Zacchini would shoot from a cannon into a net about 200 feet away.<sup>259</sup> Each performance that Zacchini would perform lasted about fifteen seconds.<sup>260</sup> In August and September of 1972 Zacchini performed in a fenced area surrounded by grandstands at the Geauga County Fair in Burton, Ohio.<sup>261</sup> Petitioner performed this act on a regular basis for the two months. Members of the fair were not charged a separate admission in order to see this performance.<sup>262</sup> On August 30, 1972 a free-lance reporter for the respondent, Scripps-Howard Broadcasting Co, attended the fair.<sup>263</sup> He carried a small movie camera into the performance and was asked by the petitioner not to use the camera during the performance.<sup>264</sup> The reporter did not film on that particular day, but at the request of the producer, the reporter returned the following day and recorded the performance.<sup>265</sup> The film clip was then shown on the 11 o'clock news program.<sup>266</sup> Petitioner then brought this action in Common Pleas Court claiming the respondent "*showed and commercialized the film of his act without his consent*" and that such conduct constituted an unlawful appropriation of petitioner's personal

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<sup>253</sup> *Id.* at 827

<sup>254</sup> *Id.* at 827

<sup>255</sup> Rosemary J. Coombe, *Author/izing the Celebrity*, *Supra* note 234 at 387

<sup>256</sup> *Id.*

<sup>257</sup> *Id.*

<sup>258</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977),

<sup>259</sup> *Id.*

<sup>260</sup> *Id.*

<sup>261</sup> *Id.*

<sup>262</sup> *Id.*

<sup>263</sup> *Id.*

<sup>264</sup> *Id.* at 563-564.

<sup>265</sup> *Id.* at 564.

<sup>266</sup> *Id.*

property.<sup>267</sup> The Common Pleas Court granted summary judgment in favor of the respondent.<sup>268</sup> The Court of Appeals of Ohio reversed the trial court's ruling.<sup>269</sup> During the Court of Appeals ruling the majority held that the petitioner's complaint stated a viable cause of action for conversion, and for infringement of a common-law copyright.<sup>270</sup> Additionally, one judge joined in a concurring opinion, but on the ground of a right of publicity claim.<sup>271</sup> All three judges ruled that the "*First Amendment did not privilege the press to show the performance on a news program without compensating petitioner for any financial injury he could prove at trial.*"<sup>272</sup> The Supreme Court of Ohio rested petitioner's cause of action under state law on his "right of publicity" claim.<sup>273</sup> The Supreme Court of Ohio ruled in favor of the respondent stating that the "*TV station has a privilege to report in its newscast matters of legitimate public interest which would otherwise be protected by an individual's right of publicity, unless the actual intent of the TV station was to appropriate the benefit of the publicity from some non-privileged private use, or unless the actual intent was to injure the individual.*"<sup>274</sup> The Supreme Court granted certiorari to determine if the First and Fourteenth Amendment immunized respondent from damages occurring from its alleged infringement of petitioner's act.<sup>275</sup> First, the Supreme Court had to answer the Constitutional question of whether the Court had standing to review this case. In order to determine if the Court had standing the Court analyzed if the decision of the Ohio Supreme Court was based on independent and adequate state grounds.<sup>276</sup> The Supreme Court determined that the decision made in the lower court was not based on independent and adequate state grounds; therefore, the decision was reviewable by the Supreme Court.<sup>277</sup> The Supreme Court found that the broadcast of petitioner's entire act posed a substantial threat to the economic value of the performance.<sup>278</sup> The Supreme Court determined that although the State of Ohio may as a matter of state law allow the press the privilege shown in this case, the First and Fourteenth Amendments do not require the Supreme Court to do so. The judgment was reversed.<sup>279</sup>

b) The 'Newsworthiness' and 'public affairs' defense : *Dora and Downing*

In *Dora v Frontline Video Inc.*,<sup>280</sup> the appellant was a legendary and popular surfer at Malibu Beach in the 1950s. According to the respondent's evidence presented in support of their motion for summary judgment, the appellant was regarded as a "legendary figure in surfing," and his "exploits at Malibu . . . are part of the sport's folklore."<sup>281</sup> In 1987, the respondent produced a video documentary titled "The Legends of Malibu" (the program). This documentary primarily

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<sup>267</sup> *Zacchini v. Scripps-Howard Broad. Co.*, No. 918,826 (C.P. Cuyahoga County).

<sup>268</sup> *Id.*

<sup>269</sup> *Zacchini v. Scripps-Howard Broad. Co.*, No. 33713, 1975 Ohio App. LEXIS 6700 (Ct. App 1975).

<sup>270</sup> *Id.*

<sup>271</sup> *Id.*

<sup>272</sup> *Id.*

<sup>273</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 47 Ohio St. 2d 224, 232 (1976).

<sup>274</sup> *Id.*

<sup>275</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. at 565.

<sup>276</sup> *Id.* at 567.

<sup>277</sup> *Id.*

<sup>278</sup> *Id.* at 575.

<sup>279</sup> *Id.* at 578.

<sup>280</sup> *Dora v Frontline Video Inc.*, 15 Cal.App.4th 536 (Cal. Ct. App. 1993)

<sup>281</sup> *Id.* at 540

chronicled the events and public personalities at Malibu during the early days of surfing. The program included footage of famous surfers, including the appellant, taken during that era. Many of these individuals were interviewed on camera for their recollections. The program also featured the audio of an interview with the appellant, heard in the background while photographs of him were shown.<sup>282</sup> The appellant stated in a declaration that he was neither interviewed nor photographed by the respondent and did not consent to the use of his name, photograph, likeness, or voice.<sup>283</sup> The respondent had filed a motion for summary judgment, asserting that the appellant's consent was unnecessary for several reasons: (1) the program qualified as a sports broadcast, (2) it was a news account and a publication of matters in the public interest, and (3) it was truthful and thus protected by the Constitution. The trial court accepted these arguments and granted the motion. On appeal, the appellant disputed each of these contentions made by the respondent.<sup>284</sup> The court found that, since the documentary covered matters of public interest protected by the First Amendment, the common law claim was invalid.<sup>285</sup> In addressing the claim under section 3344(a), the court broadly interpreted the term “public affairs” to include topics beyond traditional news.<sup>286</sup> The court reasoned that restricting “public affairs” to only those topics typically covered on public television or radio would undermine society’s right to know.<sup>287</sup> This could expose publishers and broadcasters to lawsuits for using names and likenesses in documentaries on subjects that are not necessarily related to politics or public policy but are still of public interest.<sup>288</sup> The court protected the documentary against the statutory claim due to the public’s interest in surfing and its influence on popular culture and lifestyle.<sup>289</sup> This influence affects many aspects of contemporary life, qualifying the documentary as a matter of public interest under common law and a public affair under statutory law.<sup>290</sup>

In *Downing*<sup>291</sup> where the photograph of legendary surfers was used on a catalogue for a surfing themed clothes line, without their authorisation, alongside finding for the plaintiffs on the Lanham Act claim, the court also looked at the CCC Section 3344 claim for unauthorised use of photograph. The defendants tried to hide behind the “public affairs” protection under S.3344(a) by citing *Dora v Frontline*, however, the 9<sup>th</sup> Cir court on appeal, distinguished *Dora* and instead applied *Eastwood*, and held:

- The primary purpose of “*The Quarterly*,” which spans 250 pages, was to build brand awareness and increase sales.<sup>292</sup>

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<sup>282</sup> *Id.*

<sup>283</sup> *Id.*

<sup>284</sup> *Id.*

<sup>285</sup> *Id.* at 543-545

<sup>286</sup> *Id.* at 545

<sup>287</sup> *Id.*

<sup>288</sup> *Id.*

<sup>289</sup> *Id.* at 546

<sup>290</sup> *Id.* at 546-547.

<sup>291</sup> *Downing v. Abercrombie Fitch*, 265 F.3d 994 (9th Cir. 2001), *See also* Chapter IV of this dissertation, pp. 4.14 to 4.16

<sup>292</sup> *Id.* at 1002

- In *Dora*, Mickey Dora’s identity “*directly contributed*” to the story about surfing,<sup>293</sup> which was a matter of public interest; however, in this instance, there was only a “tenuous relationship.”<sup>294</sup>
- A&F used the photo “*as window-dressing to advance the catalogue’s surf theme,*”<sup>295</sup> rather than for any genuine public interest. This was similar to the *Eastwood* case where the usage was considered a “*cover-up or subterfuge for commercial appropriation.*”<sup>296</sup>

c) Artistic Expression for Right of Publicity<sup>297</sup> – *Rosa Parks*<sup>298</sup> and *Rogers*<sup>299</sup>

In *Rosa Parks*, Appellant celebrity, Ginger Rogers, sought review of summary judgment by the District Court for Southern District of New York dismissing her claims that appellees, violated the Lanham Act, 15 U.S.C.S. § 1125(a), and infringed her common law rights of publicity and privacy.<sup>300</sup> Ginger Rogers and late Fred Astaire are one of the most famous duos in history.<sup>301</sup> Appellant has won an Academy Award for her performance in *Kitty Foyle*, but her principal fame was established during a series of motion pictures in which she co-starred with Fred Astaire. Rogers has used her name for commercial purposes including allowing J.C. Penney, Inc. to produce a line of GINGER ROGERS lingerie.<sup>302</sup> Appellees are producers and distributors of the motion picture “Ginger and Fred.” In March of 1986 appellees produced and distributed in the United States and Europe a film titled “Ginger and Fred.”<sup>303</sup> The film tells a story of two Italian cabaret performers that imitate Rogers and Astaire. Shortly after the film aired, appellant brought suit in the District Court for Southern District of New York seeking injunctive relief and money damages.<sup>304</sup> The District Court found that the producer’s use of Rogers’s first name in the title and screenplay of the film was an exercise of artistic expression rather than commercial speech.<sup>305</sup> The District Court further stated that because the speech at issue is not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the film is entitled to the full scope of protection under the First Amendment.<sup>306</sup> The Second Circuit affirmed the District Court’s ruling stating that the title “Ginger and Fred” was not arbitrarily chosen to exploit the publicity value. It also does not establish an explicit indication that Rogers endorsed the film or had a role in producing it. Even though some survey evidence established that viewers might be confused by the name, it is not enough to override the interests in artistic expression.<sup>307</sup> The court found that “*minimally*

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<sup>293</sup> *Id.*

<sup>294</sup> *Id.*

<sup>295</sup> *Id.*

<sup>296</sup> *Id.*

<sup>297</sup> Refer Chapter IV of this dissertation, pp. 4.7 to 4.11

<sup>298</sup> *Parks v LaFace Records*, 329 F 3d 437 (6th Cir, 2003)

<sup>299</sup> *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)

<sup>300</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

<sup>301</sup> *Id.*

<sup>302</sup> *Id.* at 996.

<sup>303</sup> *Id.*

<sup>304</sup> *Rogers v. Grimaldi*, 695 F. Supp. 112, 115 (S.D.N.Y. 1988).

<sup>305</sup> *Id.* at 120.

<sup>306</sup> *Id.* at 121.

<sup>307</sup> *Rogers v. Grimaldi*, 875 F.2d at 1001.

*relevant use of a celebrity name in the title of an artistic work was not barred by statute where it did not mislead as to content or denote authorship, sponsorship, or endorsement, and that it did not violate common law rights of publicity and privacy.*<sup>308</sup> Therefore, the Second Circuit affirmed the District Court’s summary judgment ruling in favor of appellees.<sup>309</sup> The Second Circuit also determined there was no infringement of common law rights of privacy where appellant was not portrayed in the film.<sup>310</sup> Additionally, the Second Circuit found there was no right of publicity where appellant's name was sufficiently related to the film and was not being used for commercial advertisement.<sup>311</sup>

This decision was cited with approval in *Rosa Parks*.<sup>312</sup> OutKast used Rosa Parks’ name as the title of their single, with no further reference to Parks in the song except for the line, “Ah ha, hush that fuss; Everybody move to the back of the bus.”<sup>313</sup> The court remanded the case for trial, requiring a balance between Parks’ property right in her name and OutKast's freedom of artistic expression<sup>314</sup>. The court applied the *Rogers v. Grimaldi* test from the Second Circuit, which includes two criteria:

- i) The title must have no artistic relevance to the underlying work whatsoever; or
- ii) If it has some artistic relevance, it must not explicitly mislead as to the source or content of the work.<sup>315</sup>

The court noted that a reasonable finder of fact could determine that the title was a “disguised commercial ad” or adopted “solely to attract attention” to the work.<sup>316</sup> OutKast argued that their use of Rosa Parks’ name was not purely for commercial reasons but was artistic, invoking the First Amendment as a defense.<sup>317</sup> However, the court concluded that the liability question should be determined by the trier of fact after a full evidentiary hearing, rather than as a matter of law on a motion for summary judgment. This decision underscored that merely claiming artistic expression does not automatically exempt defendants from potential liability; the relationship between the title and the content of the work must be scrutinized thoroughly.<sup>318</sup>

d) Parody/Satire/Caricature/Lamprooning – ‘Predominant Purpose’ Test versus ‘Direct Balancing’ Test

In *White v Samsung*<sup>319</sup> the court rejected the *common law* publicity related First Amendment protection for *parodying* by opining that the parodies in other cases poked fun at the personalities, but the spoof here is “*subservient and only tangentially related to the primary*

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<sup>308</sup> *Id.*

<sup>309</sup> *Id.*

<sup>310</sup> *Id.* at 1003.

<sup>311</sup> *Id.* at 1004.

<sup>312</sup> *Parks v LaFace Records*, 329 F 3d 437(6th Cir, 2003)

<sup>313</sup> *Id.* at 442, 443

<sup>314</sup> *Id.* at 451

<sup>315</sup> *Id.* at 461

<sup>316</sup> *Id.* at 461

<sup>317</sup> *Id.* at 463

<sup>318</sup> *Id.* at 463

<sup>319</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992); *Supra* note 201

*selling message*<sup>320</sup> The court held that the commercial nature of Samsung's advertisement, which was designed to sell video cassette recorders, meant it was "garden variety" commercial speech and not protected by the First Amendment from a publicity claim<sup>321</sup>

Commentaries written on this decision, focus predominantly on *copyright pre-emption* and the rights of a performer, vested in copyrightable works, being then exploited by a defendant in a Right of publicity claim.<sup>322</sup> It has been argued that by focusing solely on the commercial nature of the Samsung advertisement, the court dismissed the parody defense without evaluating its applicability as a fair use under copyright law.<sup>323</sup> An analysis of Samsung's parody defense under copyright law might have show that it is arguable whether the advertisement was a fair use of Vanna White's performance. The court did not explore the tussle between performance rights and personality rights in this context.<sup>324</sup> If the 4 statutory fair use factors<sup>325</sup> are analysed in the context of the facts in the case, Heberer argues<sup>326</sup>:

- First Factor: Purpose and Character of Use - The commercial nature of the Samsung advertisement would not necessarily be decisive because the advertisement's message (the long-lasting reliability of Samsung products) differed from the original's message (the popularity of Vanna White and Wheel of Fortune).
- Second Factor: Nature of the Copyrighted Work - This factor considers that some works receive greater copyright protection. For instance, unpublished and fictional works generally receive more protection than published and factual ones. However, in parody cases, this factor is less critical since parodies often target well-known, expressive works.
- Third Factor: Amount and Substantiality of the Portion Used - A parodist is likely to prevail if the amount of the original work used is only enough to "conjure up" the original. In the Samsung case, the use of a robot standing in Vanna White's position with her typical wig, jewellery, and evening gown was sufficient to remind audiences

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<sup>320</sup> *Id* at 1401

<sup>321</sup> *Id* at 1401

<sup>322</sup> William M Heberer III, *The Overprotection Of Celebrity: A Comment On White v. Samsung Electronics America, Inc.*, 22 HOFSTRA LAW REVIEW 729 (1994); J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture-The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129 (1995) [hereinafter McCarthy Lecture] responded to in Stephen R. Barnett, *The Right of Publicity Versus Free Speech in Advertising: Some Counter-Points to Professor McCarthy*, 18 HASTINGS COMM. & ENT. L.J. 593 (1996)

<sup>323</sup> Heberer, *Supra* note 322 at 759

<sup>324</sup> *Id.*

<sup>325</sup> 17 USC § 107 – "107. Limitations on exclusive rights: Fair use

*Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—*

*(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;*

*(2) the nature of the copyrighted work;*

*(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and*

*(4) the effect of the use upon the potential market for or value of the copyrighted work.*

*The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors."* [Refer Chapter II discussion on Tattoo Copyrights and Fair Use]

<sup>326</sup> Heberer, *Supra* note 322 at 760-763

of her performance on *Wheel of Fortune*. The extent of copying should be measured by whether the parody's primary purpose is to critique or spoof the original, rather than serving as a market substitute.

- Fourth Factor: Effect on the Market - This factor examines the impact of the parody on the potential market value of the original work and its derivatives. A parody typically does not harm the market for the original work since they serve different market functions. In this case, the robot did not replace Vanna White in her role as hostess, nor did the advertisement replace the demand for *Wheel of Fortune*. Therefore, the parody was unlikely to impact Vanna White's market value or future endorsements negatively.

Based on this analysis, if a lawsuit had been filed for infringing the copyright in Vanna White's performance on *Wheel of Fortune*, Samsung would likely have prevailed under the four-factor test for fair use provided in § 107 of the Copyright Act. Consequently, Samsung's use of a robot would have been considered a permissible fair use of the elements of Vanna White's performance.

This argument is squarely countered by Haemmerli, saying “*To fall within the subject matter of copyright requires that a work be fixed in tangible form. Heberer (and others), relying on Judge Kozinski, maintain that White’s claim was preempted because the television show in which she acted was fixed. This ignores the fact that what was at issue in White was not a use of the television show (or of a fixed performance by White therein); thus, the fact that the show was fixed, and was owned by Merv Griffin Enterprises rather than by Vanna White, is irrelevant. The preemption argument illustrates nicely why it is important to focus on persona, rather than act or created work. With a focus on persona, no copyright preemption problem can be raised, as the Copyright Act applies only to created works.”<sup>327</sup>*

In *Cardtoons*<sup>328</sup>, the court looked at a parody-First Amendment defense by adopting a methodology of *direct balancing of free speech rights against property rights* by weighing the magnitude of speech interest against asserted governmental interest in protecting an IP style right.

*Cardtoons*, initiated this legal action seeking a declaratory judgment that its parody trading cards featuring active major league baseball players do not violate the publicity rights of members of the Major League Baseball Players Association (“MLBPA”).<sup>329</sup> The district court ruled that the trading cards are a form of expression protected by the First Amendment and thus recognized a parody exception within Oklahoma’s statutory right of publicity. MLBPA appealed, contending that (1) the district court lacked jurisdiction to issue a declaratory judgment and (2) *Cardtoons* does not possess a First Amendment right to market its trading cards.<sup>330</sup> On facts, it was seen that Each card, except for the Spectra cards, displays the *Cardtoons* logo on the back along with a disclaimer: “*Cardtoons baseball is a parody and is NOT licensed by Major League Baseball Properties or Major League Baseball Players*

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<sup>327</sup> Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, *Supra* note 20 at 462

<sup>328</sup> *Cardtoons, L.C., v. Major League Baseball Players Association* 95 F.3d 959 (1996, 10th Cir)

<sup>329</sup> *Id* at 964

<sup>330</sup> *Id* at 964

*Association.*”<sup>331</sup> The court observed that a person reasonably familiar with baseball can easily identify the players satirized on the parody trading cards. The cards used names, caricatures, distinctive team colors, and commentary to mimic individual players. For instance, the card parodying San Francisco Giants’ outfielder Barry Bonds refers to him as “Treasury Bonds” and depicts a recognizable caricature of Bonds, complete with an earring, tipping a bat boy with a 24-carat gold “Fort Knoxville Slugger.”<sup>332</sup>



Source: Museum of Intellectual Property, Cardtoons card for "Treasury Bonds"; Cardtoons, L.C. v. Major League Baseball Players Ass'n (MLBPA), 95 F.3d 959 (10th Cir. 1996); [https://www.museumofintellectualproperty.org/exhibits/other\\_forms.html](https://www.museumofintellectualproperty.org/exhibits/other_forms.html)

The Circuit court held that Cardtoons’ parody trading cards are fully protected under the First Amendment. By necessitating that ““*This case instead requires us to directly balance the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property right*”<sup>333</sup> the court ruled that the “cards provide social commentary on public figures, major league baseball players, who are part of a significant commercial enterprise, major league baseball”<sup>334</sup> While the cards do not constitute core political speech this form of commentary on a notable social institution is considered protected expression.<sup>335</sup> The humorous nature of the commentary does not diminish its protection under the First Amendment.<sup>336</sup> Speech that entertains, like speech that informs, is safeguarded because “*the line between the informing and the entertaining is too elusive for the protection of that basic right.*”<sup>337</sup> Cardtoons’ expression necessitates the use of player identities because the cards not only parody the institution of baseball but also lampoon individual players.<sup>338</sup> Additionally, the use of the trading card format is crucial to the parody because baseball cards have traditionally been used to celebrate baseball players and their achievements.<sup>339</sup> Cardtoons conveys ideas

<sup>331</sup> *Id* at 962

<sup>332</sup> *Id* at 962-963

<sup>333</sup> *Id* at 972

<sup>334</sup> *Id* at 969

<sup>335</sup> *Id*

<sup>336</sup> *Id*

<sup>337</sup> *Id*

<sup>338</sup> *Id* at 972

<sup>339</sup> *Id*

through the use of major league baseball player identities, and MLBPA's efforts to enjoin the parody thus target the content of the speech, not merely its time, place, or manner.<sup>340</sup>

e) Artistic Expression – Transformative Elements test – Are sketches protected as ‘evocative speech’?

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*<sup>341</sup> Defendant was an artist that created a lithograph of "The Three Stooges" and used it to make silk-screened T-shirts. Plaintiff was a company who owned the rights to the former comedy act.<sup>342</sup> The plaintiff objected to the use of the Three Stooges images. Plaintiff also objected to the sale of the T-shirts.<sup>343</sup>



In California Civil Code section 3344 authorizes the recovery of damages by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent.<sup>344</sup> The “Three Stooges” are deceased, but Comedy III production retains the rights to publicity for deceased individuals, under S.3344.1.<sup>345</sup> The Supreme Court of California had to decide whether the artist’s speech interests overrode the holders of the actors’ interest in preventing the unauthorized sale of these products bearing their likeness.<sup>346</sup> The Supreme Court of California held that the Appeals Court was incorrect in stating that lithographs and T-shirts received no protection under the First Amendment since they were reproductions rather than original works of art.<sup>347</sup> The Supreme Court of California stated that the reproductions were equally entitled to First Amendment protection.<sup>348</sup> The Court formulated a balancing test between the First Amendment and the right of publicity based on whether the work added significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.<sup>349</sup> Applying that test here, the California Supreme Court held that there were no such creative elements here and that the right of publicity prevailed.<sup>350</sup> The court held that the charcoal drawings are not sufficiently transformative and instead were “literal

<sup>340</sup> *Id.*

<sup>341</sup> *Comedy III Productions, Inc. v. Gary Saderup, Inc.* 25 Cal.4th 387 (Cal. 2001)

<sup>342</sup> *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 391 (2001).

<sup>343</sup> *Id.*

<sup>344</sup> *Id.*

<sup>345</sup> *Id.*

<sup>346</sup> *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th at 391.

<sup>347</sup> *Id.* at 394.

<sup>348</sup> *Id.*

<sup>349</sup> *Id.*

<sup>350</sup> *Id.*

conventional depictions of *The Three Stooges* so as to exploit their fame”<sup>351</sup> The judgment of the court of appeals affirming an award of damages to the plaintiff was affirmed.<sup>352</sup>

f) Artistic Expression protected under three standard identified tests – *ETW v Jireh Publishing*<sup>353</sup>

ETW is the Licensing agent of Eldrick “Tiger” Woods.<sup>354</sup> Tiger Woods is one of the most famous professional golfers. Woods had assigned ETW the exclusive right to use his name, image, likeness, signature, and all other publicity rights. ETW also owns a United States trademark for the mark “TIGER WOODS.”<sup>355</sup> This registration is used for connection with “art prints, calendars, mounted photographs, notebooks, pencils, posters, trading cards, and unmounted photographs.”<sup>356</sup> Defendant, Jireh, is a publisher of artwork created by Rick Rush. Rick Rush has created paintings of famous figures in sports and famous sports events. Rush created a painting titled *The Masters of Augusta*.<sup>357</sup> This painting commemorated Tiger Wood’s victory at the Masters Tournament in Augusta, Georgia in 1997. During this event, Woods became the youngest player to win the Masters, setting a 72-hole record for the tournament and achieving a record 12-stroke margin of victory. Rush’s painting prominently features three views of Woods in various poses. In the center, Woods is depicted completing a golf swing, while on either side, he is shown crouching and observing a putt. To Woods’s left is his caddy, Mike “Fluff” Cowan, and to his right is his final round partner’s caddy. The background of the painting includes the Augusta National Clubhouse, with a blue sky above featuring likenesses of legendary golfers such as Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus, who are shown looking down on Woods. The Masters leader board is also depicted behind these figures.<sup>358</sup>



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<sup>351</sup> *Id.* at 409.

<sup>352</sup> *Id.*

<sup>353</sup> *ETW Corp. v. Jireh Publishing, Inc.* 332 F.3d 915 (6th Cir. 2003)

<sup>354</sup> *Id.* at 918

<sup>355</sup> *Id.*

<sup>356</sup> *Id.*

<sup>357</sup> *Id.*

<sup>358</sup> *Id.*

ETW filed suit against Jireh on June 26, 1998 in the United States District Court for the Northern District of Ohio, Eastern Division.<sup>359</sup> ETW alleged “trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114; dilution of the mark under the Lanham Act, 15 U.S.C. § 1125(c); unfair competition and false advertising under the Lanham Act, 15 U.S.C. § 1125(a); unfair competition and deceptive trade practices under Ohio Revised Code § 4165.01; unfair competition and trademark infringement under Ohio common law; and violation of Woods's right of publicity under Ohio common law.”<sup>360</sup> Jireh counterclaimed stating that that Rush’s art prints are protected by First Amendment, and therefore did not violate the Lanham Act. Both parties moved for summary judgment.<sup>361</sup> The District Court granted Jireh’s motion and dismissed the claim.<sup>362</sup> ETW appealed to the United States Court of Appeals for the Sixth Circuit who reviewed the summary judgment de novo.<sup>363</sup>

On the question of the right of publicity claim and the First Amendment Protections, the Sixth Cir. Court held:

- Rush’s work is “more than a literal likeness” ... “conveys the message that Woods himself will join that revered group [of golfers]”<sup>364</sup>
- Applied *Rogers* test (2<sup>nd</sup> Cir) – use of Woods’ image has artistic relevance to the underlying work<sup>365</sup>
- Applied *Cardtoons* direct balancing (10<sup>th</sup> Cir) – balanced “societal and personal interests embodied in the First Amendment against Woods’s property rights” ... “outweighed by society’s interest in freedom of artistic expression”<sup>366</sup>
- Applied *Comedy III* transformative elements test (CA) – described in artistic form, a historic event in sports history and significance of Woods’ achievements in that event<sup>367</sup>
- Even in the absence of his (Tiger Woods) right of publicity, he would still be able to “reap substantial financial rewards from authorized appearances and endorsements ”<sup>368</sup>
- **“It is not at all clear that the appearance of Woods’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.”**<sup>369</sup>

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<sup>359</sup> *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

<sup>360</sup> *Id.* at 830-831.

<sup>361</sup> *Id.* at 831.

<sup>362</sup> *Id.* at 836.

<sup>363</sup> *ETW v. Jireh Publ'g, Inc.*, 332 F.3d at 937.

<sup>364</sup> *Id.* at 936

<sup>365</sup> *Id.* at 937

<sup>366</sup> *Id.* at 937

<sup>367</sup> *Id.* at 937

<sup>368</sup> *Id.* at 938

<sup>369</sup> *Id.* at 938. See also - 6. *Art versus Image: The First Amendment versus the Right of Publicity ETW v. Jireh Publishing (2000)* in SARAH K. FIELDS, *GAME FACES: SPORT CELEBRITY AND THE LAWS OF REPUTATION* (2016) at pp. 101-118.

Judge Clay, J expressed in his dissent:

- “Once the celebrity thrusts himself into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope ...”<sup>370</sup>
- BUT it is “difficult to discern any appreciable transformative or creative contribution in D’s prints so as to entitle them to First Amendment protection”<sup>371</sup>“the rendition done by Rush is nearly identical to that in the poster distributed by Nike”<sup>372</sup>
- “The prints gain their commercial value by exploiting the fame and celebrity status that Woods has worked to achieve”<sup>373</sup>

#### iv. Recent cases on Right of Publicity in likeness, phrases and tattoos

In, *OLIVIA De Havilland v. FX Networks*<sup>374</sup> Olivia de Havilland, a renowned actress, objected to her portrayal in FX Networks’ docudrama “Feud: Bette and Joan,” which depicted the rivalry between Hollywood stars Bette Davis and Joan Crawford.<sup>375</sup> She alleged that the producers violated her right of publicity, committed the common law tort of misappropriation of her name, image and likeness, and presented her in a false light.<sup>376</sup> The portrayal included a fictitious interview where her character referred to her sister as a “bitch,” whereas in reality, de Havilland had used the term “dragon lady.”<sup>377</sup> She had never signed a release or given permission for her portrayal in the series.

The trial court denied FX’s motion to strike the complaint.<sup>378</sup> The court concluded that because “Feud” aimed to portray de Havilland as realistically as possible, the show was not “transformative” and thus not entitled to First Amendment protection. This reasoning suggested that many accurate portrayals of real people in books, films, plays, and television programs could be held liable<sup>379</sup>.

The California Court of Appeal reversed the trial court’s decision. The appellate court explained that filmmakers can often portray third parties without their permission, even if some of the details may be incorrect, celebrities don’t own history<sup>380</sup> Producers may enter into agreements with individuals portrayed in their works for various reasons, such as access to the person’s recollections or to avoid litigation, but the First Amendment does not require such agreements.<sup>381</sup> The appellate court found that the depiction was transformative and that de Havilland could not prevail on her false light claim, and neither on her right of publicity claim

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<sup>370</sup> *Id* at 958 (relying on *Zacchini* and *Cartoons* differently)

<sup>371</sup> *Id* at 959

<sup>372</sup> *Id* at 959

<sup>373</sup> *Id* at 960

<sup>374</sup> *OLIVIA De Havilland v. FX Networks, LLC* - 21 Cal. App. 5th 845, 230 Cal. Rptr. 3d 625 (2018) [Refer Introduction to this dissertation, written at a time when the matter was first filed, the matter was decided thereafter and we lost Ms De Havilland on July 26, 2020, as then then oldest surviving Academy Award Winner at 104)

<sup>375</sup> *Id* at 853

<sup>376</sup> *Id* at 853

<sup>377</sup> *Id* at 854

<sup>378</sup> *Id* at 854

<sup>379</sup> *Id* at 854

<sup>380</sup> *Id* at 850

<sup>381</sup> *Id* at 862-863

as the same was a work protected by the First Amendment.<sup>382</sup> The challenged scenes, such as the fictitious interview on the misuse of women in Hollywood and the light-hearted reference to another celebrity’s drinking, were not defamatory.<sup>383</sup> Additionally, the replacement of the term “dragon lady” with “bitch” was not highly offensive to a reasonable person.<sup>384</sup> The court emphasized that the right of publicity cannot be used to censor disagreeable portrayals and that de Havilland’s claim would have a chilling effect on free speech if it were allowed to proceed.<sup>385</sup> The order denying the motion to strike was reversed, highlighting the importance of a speedy resolution in cases involving First Amendment rights to avoid unnecessarily protracted litigation.<sup>386</sup> This ruling reinforces the protection of creative and expressive works under the First Amendment, even when these works include portrayals of real people. It underscores that individuals, regardless of their celebrity status, do not have the right to control or censor historical or biographical depictions of themselves in artistic productions. The decision ensures that creators can depict real events and people without the fear of legal repercussions, provided their portrayals do not constitute defamation or false light invasion of privacy.

The long protracted saga between *Kevin Brophy v Cardi B*<sup>387</sup> came to an end when a lawsuit filed by Kevin Michael Brophy against her, was decided in favour of Cardi B on October 21, 2022. The controversy arose from the use of Brophy’s tattoo in the cover art of Cardi B’s 2016 mixtape “Gangsta Bitch Music Vol. 1”. Brophy’s distinctive tattoo—a tiger battling a snake—was photoshopped onto the back of another man depicted in a sexually suggestive manner.



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<sup>382</sup> *Id* at 862

<sup>383</sup> *Id* at 867

<sup>384</sup> *Id* at 867

<sup>385</sup> *Id* at 871

<sup>386</sup> *Id* at 871

<sup>387</sup> *Kevin Brophy v. Belcalis Almanzar*; Cal Distt. Court Verdict, 359 F. Supp. 3d 917 (C.D. Cal. 2018, May 3, 2018); *Kevin Michael Brophy Jr. v. Belcalis Almanzar*, C.D. Cal., No. 17-1885, Jury Verdict October 21, 2022; Verdict after Jury Trial in *Brophy v. Belcalis Almanzar*, 8:17-cv-01885-CJC(JPRx) (C.D. Cal. Dec. 28, 2022)

Brophy argued that his tattoo made him identifiable, leading to commercial exploitation without his consent, along with ridicule, humiliation, and shame. He filed claims under California's statutory and common law right of publicity and a false light claim against Cardi B and other defendants. Earlier rulings by the district court rejected the defendants' motions to dismiss the claims, ruling out First Amendment defenses and copyright preemption arguments. The issue of whether the use was transformative was left to the jury to decide, with the court not deeming it transformative as a matter of law. The jury ultimately rejected Brophy's claims, concluding there was no misappropriation of his likeness, no violation of Cal. Civ. Code § 3344, and no portrayal in a false light. The broad nature of the jury verdict form suggests the jury found no misappropriation of Brophy's identity.<sup>388</sup> Interestingly, jury instructions on the First Amendment defense asked if the mixtape cover added something new to Brophy's likeness, giving it a new expression, meaning, or message. This framing likely would have led the jury to find the cover art transformative, however the jury didn't reach this question.<sup>389</sup> At the trial's conclusion Brophy was extremely respectful to Cardi B and<sup>390</sup> in Dec 2022, it came to be reported that, the jury verdict had been upheld and almost a year after the initial ruling, in June 2023, lawyers for Brophy told the civil judge that "he would not only reimburse the money that the rapper had dropped on her attorneys but also voluntarily end his efforts to revive the case and waive any chance at a future appeal."<sup>391</sup>

**\*Addendum: Important publication on Implications of *Andy Warhol v Goldsmith* copyright decision from USSC ('AWF') on Right of Publicity**

Jennifer E. Rothman; *The Absent Prince: Reflections on Personality Rights and Andy Warhol Foundation v. Goldsmith*. 94 GREY ROOM 51–55 (2024) .  
doi: [https://doi.org/10.1162/grey\\_a\\_00388](https://doi.org/10.1162/grey_a_00388)

Prof Rothman, wrote this piece, reflecting on how the decision is landmark for recognising the rights of two important artists – photographer Lynn Goldsmith and legendary appropriation artist Andy Warhol; but in the Supreme Court's gusto to resolve questions on transformative fair use and artistic expression, Rothman alleges that the court forgot the most important 'artist' of all – the legendary singer Prince, whose photograph was the subject matter of the dispute.

The Second Circuit Court of Appeals framed the case as a conflict between artists profiting from their creative efforts, recognizing Warhol and Goldsmith but neglecting Prince, who also

<sup>388</sup> See, Jennifer Rothman, *Cardi B Wins Jury Verdict against Tattooed Plaintiff*, Rothman's Roadmap to Right of Publicity, (Nov 1, 2022) [https://rightofpublicityroadmap.com/news\\_commentary/cardi-b-wins-jury-verdict-against-tattooed-plaintiff/](https://rightofpublicityroadmap.com/news_commentary/cardi-b-wins-jury-verdict-against-tattooed-plaintiff/)

<sup>389</sup> *Id.*

<sup>390</sup> Brian Murphy, *Cardi B Prevails in Lawsuit Against the Man with the Tiger (and Snake) Tattoo*, FKKS PC Advertising Law Updates (Nov 4, 2022) <https://advertisinglaw.fkks.com/post/102i0r4/cardi-b-prevails-in-lawsuit-against-the-man-with-the-tiger-and-snake-tattoo#:~:text=The%20press%20reports%20that%20Brophy,assured%20him%2C%20%E2%80%9CIt's%20OK.> ("The press reports that Brophy and Cardi shook hands as they left the courtroom, and he said to her "At the end of the day, I do respect you as an artist." Cardi replied "Maybe you get to know me?" but also assured him, "It's OK")

<sup>391</sup> Bill Donahue, *Cardi B Accuser Agrees to Repay \$350K She Spent on Lawyers In His Failed Lawsuit Over Tattoo Image*, Billboard Legal News(June 12, 2023) <https://www.billboard.com/business/legal/cardi-b-accuser-agrees-pay-350k-legal-bill-tattoo-lawsuit-fails-1235352281/>

sought to control and monetize his identity. The district court initially viewed Warhol's depiction as transformative, changing Prince from a vulnerable figure to an iconic one. However, the Second Circuit and the Supreme Court found that the images served the same purpose—portraits of Prince to illustrate stories about him—thereby not constituting a significant transformation. Prof Rothman laments at how the courts also deconstructed Prince into physical components, treating him as a dress-up doll, further dehumanizing his role in the images. The fair use analysis focused on Goldsmith's control over the licensing market for her photographs, which is a significant source of her income. The court expressed concern that undermining this revenue would reduce her incentive to create professional works – and again, focussed on the disputing artists, not on the rights of the subject of the works. While Prince's interest in controlling his identity extends beyond financial considerations to personal autonomy and dignity, he often sought to define himself and shape public perception. He was known for his privacy and efforts to reclaim his identity, as seen in his change of name to an unpronounceable symbol and writing "SLAVE" on his cheek in protest against his recording contract with Warner Brothers. The outcome of AWF highlights the importance of considering publicity rights when creating works involving real people. Artists should ethically seek consent for using a person's image, even if not legally required, acknowledging the ongoing interests of the subjects of their works. This case underscores the need to balance artistic expression with respect for individuals' personality rights.

## B. India and Celebrity 'Personality' Rights\*

### i) Early case law: A right of publicity is added to the torts for persona salad platter

As explained before, the *right of publicity*, most simply put, protects any individual's *marketable image or persona*. This formulation has been most succinctly put forth by McCarthy in his seminal work as – “*The right of publicity is not merely a legal right of the "celebrity," but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.*”<sup>392</sup> Since celebrities are, simply put, “*brokers of their personae and traders in their own identities*”,<sup>393</sup> these identities are exploitable assets with pecuniary worth, liable to legal protection. Prof. David Tan calls this the “*economic associative value*” that a celebrity brings to a brand when he/she chooses to exploit this image asset, through the transfer of the perceived attributes of the celebrity – for example, success, glamour, beauty and talent – directly to the brand he or she is associated with.<sup>394</sup> Also, the more well-known and more well-liked an individual, the greater will be the potential commercial value of that identity.<sup>395</sup> This right is more well- developed in the United States through the recognition of the common law *right of*

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\*This section shall have portions from an article that has already been published as Aakanksha Kumar, *Re-thinking celebrity domain name arbitration in India: Enforcing the right of publicity through private dispute resolution*, 11 (2). NTUT J.I.P.L.M. 29 (2023)

<sup>392</sup> McCarthy, *Supra* note 2.

<sup>393</sup> PATRICIA LOUGHLAN, BARBARA McDONALD AND ROBERT VAN KRIEKEN, *CELEBRITY AND THE LAW*, 27 (2010).

<sup>394</sup> David Tan, ‘Beyond Trademark Law: What the Right of Publicity Can Learn From Cultural Studies’ (2008) 25 *CARDOZO ARTS & ENTERTAINMENT LAW JOURNAL* 913 at 959

<sup>395</sup> *Vanna White v. Samsung Electronics America Ltd.*, 971 F.2d 1395, 1399 (9<sup>th</sup> Cir, 1992) (‘Vanna White, 1992’); David Tan, “Affective Transfer and the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity” (2010) 9 *Va. Sports & Ent. L.J.* 272 at 278.

publicity, as a “misappropriation tort” (as opposed to the misrepresentation tort, understood as the passing-off claim in trademark law)<sup>396</sup>; however, in many states statutory publicity rights are also granted.<sup>397</sup>

In India, the earliest judicial enunciation of a similar right’s existence, like the USA’s privacy roots, also can be traced back to the Supreme Court’s formulation of the *right to privacy* in what is popularly known as the *Auto Shankar*’s case.<sup>398</sup> The court opined that – “*The right to privacy as an independent and distinctive concept originated in the field of Tort law, under which a new cause of action for damages resulting from unlawful invasion of privacy was recognised. This right has two aspects which are but two faces of the same coin (1) the general law of privacy which affords a tort action for damages resulting from an unlawful invasion of privacy and (2) the constitutional recognition given to the right to privacy which protects personal privacy against unlawful governmental invasion. The first aspect of this right must be said to have been violated where, for example, a person’s name or likeness is used, without his consent, for advertising or non-advertising purposes or for that matter, his life story is written whether laudatory or otherwise and published without his consent... In recent times... this right has acquired a constitutional status.... Right to privacy is not enumerated as a fundamental right in our Constitution but has been inferred from Article 21.*”<sup>399</sup>

Highly unfortunately, in the opinion of this researcher, the course taken for recognition of a *right of publicity*, post the *Auto Shankar* case in India, has not been as advanced as that in the USA, despite India being home to one of largest and oldest entertainment industries in the world. As mentioned, the case law development to give way to a right formulated in economic asset/property value preservation terms, has been sporadic and limited. Most Indian writing on the subject<sup>400</sup>, tries to attribute the “creation” and/or “recognition” of a right of publicity in India, to the decision of the Delhi HC in *ICC v Arvee Enterprises*<sup>401</sup>, however like the error with *Haelan* in the US, this case was **not about right of publicity** of a celebrity person as the plaintiff, and in an erroneous *semantics* style claim, where alongside the broadcasting right of the organiser, there was also a claim for an exclusive “right of publicity of the organiser” of the ICC Cricket World Cup, the court in its *obiter observations* noted – “*The right of publicity has evolved from the right of 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. An individual*

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<sup>396</sup> Loughlan et al, *Supra* note at 34-50. The misrepresentation tort is more used in Australia and UK, however, due to the vast expanse of case-law availability from circuit courts in the US, the judges in both these jurisdictions are becoming increasingly partial to the misappropriation tort formulation of the celebrity personality right.

<sup>397</sup> For example, California Civil Code CIV Section 3344.; Article 5 of the New York Civil Rights Law *etc. Refer preceeding discussions under Section A of this chapter.*

<sup>398</sup> R. Rajagopal v State of Tamil Nadu, (1994) 6 SCC 632. *Refer* discussion under Chapter VII of this Dissertation at pp. 6.38-6.40

<sup>399</sup> *Id.* at 639, para 9.

<sup>400</sup> Tabrez Ahmed and Satya Ranjan Swain, *Celebrity Rights: Protection under IP Laws*, 16 J. INTELLECT. PROP. RIGHTS 7 (2011); Kiran George, *Right of Publicity in India – An Unfinished Story*, SPICY IP, (January 8, 2016) <https://spicyip.com/2016/01/right-of-publicity-in-india-an-unfinished-story.html>; Anurag Pareek and Arka Majumdar, *Protection of Celebrity Rights – The Problems and the Solutions*, 11 J. INTELLECT. PROP. RIGHTS 415 (2006); Garima Budhiraja, *Publicity Rights of Celebrities: An Analysis Under the Intellectual Property Regime*, 12 NALSAR STUD. L. REV. 85 (2011).

<sup>401</sup> *ICC Development (International) v Arvee Enterprises and Anr* 2003 (26) PTC 245 (Del)

*may acquire the right of publicity by virtue of his association with an event, sport, movie, etc. However, that right does not inhere in the event in question, that made the individual famous, nor in the corporation that has brought about the organization of the event... The right of Publicity vests in an individual and he alone is entitled to profit from it.*<sup>402</sup> The court also went on to make another interesting observation in relation to the alienability of such a right, thus – “*Any effort to take away the right of publicity from the individuals, to the organiser {non-human entity} of the event would be violative of Articles 19 and 21 of the Constitution of India.*”<sup>403</sup> Citing McCarthy, the court gave an example of sportspersons thus – “*For example if any entity, was to use Kapil Dev or Sachin Tendulkar's name/persona/indicia in connection with the 'World Cup' without their authorisation, they would have a valid and enforceable cause of action.*”<sup>404</sup>

There is no Supreme Court decision recognising the common law right in India, and therefore, guidance is being sought from jurisprudence available from High Court decisions, most of which is now being contributed to by the pro-active Delhi Judiciary. One of the earliest, yet most comprehensive decisions to come out of the Delhi HC, is Justice Ravindra Bhat’s opinion in *D. M. Entertainment v Baby Gift House*.<sup>405</sup> In relation to unauthorised dancing look alike dolls of the plaintiff, Punjabi singer Daler Mehendi (representative images at p.5.20 of this dissertation), the plaintiffs as *publicity holders under contract* for popular Punjabi pop singer Daler Mehendi, brought an action for *inter alia* false endorsement and misappropriation of a celebrity’s right of publicity, which was described in the claim as “*if a famous person's persona or any individual aspect of his personality is used by another for commercial exploitation or gain, without such person's authorization or license, the act of using the said persona, or attributes of such personality constitute infringement of the famous person's right of publicity*”<sup>406</sup> Accepting the argument, Justice Bhat explained (Citing *Onassis v Dior*), “*The right of publicity can, in a jurisprudential sense, be located with the individual's right and autonomy to permit or not permit the commercial exploitation of his likeness or some attributes of his personality.*”<sup>407</sup> Justice Ravindra Bhat, also explained that “*..to avail the right against the infringement of right to publicity, the plaintiff must be "identifiable" from defendant's unauthorised use...As a secondary consideration, it is necessary to show that the use must be sufficient, adequate or substantial to identify that the defendant is alleged to have appropriated the persona or some of its essential attributes.*”<sup>408</sup> Thereby, a two-step test for infringement of the right was laid out-

- that of ‘identifiability’ of the celebrity from the unauthorised use; and
- the “substantiveness” of the use so as to sufficiently qualify as misappropriation of the image or attributes of the celebrity plaintiff.

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<sup>402</sup> *Id.* at para 14

<sup>403</sup> *Id.* at para 14

<sup>404</sup> *Id.* at para 13-14

<sup>405</sup> *D.M. Entertainment Pvt. Ltd. v Baby Gift House and Ors*, CS(OS) 893/2002, Delhi HC Decision of April 29, 2010 (“Daler Mehendi case”) Refer Chapter VI, pp.5.20=5.21

<sup>406</sup> *Id.* at para 8

<sup>407</sup> *Id.* at para 14.

<sup>408</sup> *Id.* at para 13.

He further went on to nonetheless, express caution – “*In a free and democratic society, where every individual’s right to free speech is assured, the over emphasis on a famous person’s publicity rights can tend to chill the exercise of 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 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. Such caricature, lampooning or parody may be expressed in a variety of ways, i.e. cartoons in newspapers, mime, theatre, even films, songs, etc. Such forms of expression cannot be held to amount to commercial exploitation, per se; if the individual is of the view that the form of expression defames or disparages him, the remedy of damages for libel, or slander, as the case may be, would then, is available to him.*”<sup>409</sup>

April 2012 saw another important development in Delhi through the single-judge decision from Justice Manmohan Singh in *Titan Industries Ltd.v M/s Ramkumar Jewellers*.<sup>410</sup> In a fact scenario similar to the US decision in *Haelan*, the action was brought by the *publicity holder* of the *identity* of Amitabh Bachchan and Jaya Bachchan<sup>411</sup>, as they were the official endorsers of the jewellery brand, Tanishq – A Titan brand; against Ramkumar Jewellers, who had misappropriated the stills of the celebrity couple, as had been shot for an official tanishq ad campaign, and put them on their posters and hoardings across Delhi thus (image taken from the court’s copy of the judgment):



A question arose as to Titan’s standing to bring an action on behalf of the Bachchans and they pointed to the license and endorsement agreement for the same.<sup>412</sup> Proceeding then to first define the celebrity and then the rights of a celebrity, Justice Manmohan Singh, held thus “*A celebrity is defined as a famous or a well-known person. A “celebrity” is merely a person who many people talk about or know about. When the identity of a famous personality is used in advertising without their permission, the complaint is not that no one should not commercialise*

<sup>409</sup> *Id.* at para 14

<sup>410</sup> *Titan Industries Ltd.v M/s Ramkumar Jewellers*, CS(OS) No.2662/2011, Delhi HC Decision of April 26, 2012 (‘Titan case’).

<sup>411</sup> For a clear distinction and understanding of the concept of *identit holder* being the real celebrity individual, and *publicity holder* being the authorised entity in contract; or unauthorised entity in *free speech permissions*; that makes use of the commercial value of such identity, due to the *quasi property* nature of the right of publicity, Refer Rothman, *Privacy Reimagined*, *Supra* note 16

<sup>412</sup> *Id* at para 15.I

*their identity but that the right to control when, where and how their identity is used should vest with the famous personality. The right to control commercial use of human identity is the right to publicity*".<sup>413</sup> Interestingly, there is a seeming inconsistency between the decision in the *Daler Mehndi* case and the *Titan case*. While the *right of publicity* has been explicitly recognized in both, the standard to conclusively establish the existence of the right varies. In *Daler Mehndi case*, the right is perceived through the lens of appropriation of personality indicia of the well-known individual. By extension, mere evocation is not sufficient to constitute a violation of personality rights. As Justice Bhatt points out in the *Daler Mehndi case*, "*the right of publicity protects against the unauthorised appropriation of an individual's very persona which would result in **unearned commercial gain** to another. In the present instance, the **commercial use** of an individual's identity is intended to increase the sales of product by fusing the celebrity's identity with the product and thereby the defendants were selling those dolls, on the basis of publicity value or goodwill in the artist's persona into the product*".<sup>414</sup> Thus, commercial exploitation *qua* misappropriation forms the nucleus of the publicity infringement claim. In contrast, in the *Titan case*, Justice Manmohan, in culling out the methods to evidence identification of the celebrity-plaintiff observes that, "*If the plaintiff is very well known and widely recognised celebrity a simple comparison of the defendant's use and the plaintiff's identifying features may itself be sufficient to create a strong inference of identifiability. This is termed as unaided identification.*"<sup>415</sup> Therefore, per the two-step test, the "identifiability" threshold of the plaintiff is satisfied even if there is a mere comparison of the defendant's use and the plaintiff's identifying feature, subject to the plaintiff being well-known, thus implying that *evocation* by itself is enough to amount to a transgression of the plaintiff's *right of publicity*. This researcher acknowledges that both these decisions, though certainly valuable in their explanations of the applicable standards, are only single-judge decisions from a High Court – thereby have only persuasive value outside the jurisdiction. The jurisprudence of the *right of publicity* in India, is still to evolve and reconcile the standards of identifiability.

Because of these two decisions nonetheless, an emergent new form of a *misappropriation tort*, as opposed to, and in fact, IN ADDITION TO the *misrepresentation tort* i.e. false endorsement and passing off; as well as the *privacy tort* against *non advertising uses* from Auto Shankar, was recognised as available on the salad platter for a celebrity claimant / publicity holder of the celebrity claimant.<sup>416</sup>

Nonetheless, this absence of an explicit statutory recognition of the *right of publicity* in India, allows the right to be claimed and made actionable through different avenues. In *Shivaji Rao Gaekwad v. Varsha Productions*<sup>417</sup>, the plaintiff, more commonly known as 'Superstar Rajinikanth', claimed violation of his *right of publicity*, while also bringing in claims under the common law action of passing-off as well as civil defamation – thus as mentioned earlier – this case is an excellent example of how multiple rights on the salad bowl/salad platter can be utilised, for possible claims arising out of the same cause of action. Superstar Rajinikanth,

<sup>413</sup> *Id.* at para 15.II *citing*, Haelan Laboratories, *Ali v Playgirl* and *Daler Mehndi case*.

<sup>414</sup> *Id.*

<sup>415</sup> *Id.* at para 15.

<sup>416</sup> Refer pp. 6.44-6.45 of this dissertation for this researchers' modified Salad Bowl/Salad platter proposal.

<sup>417</sup> *Shivaji Rao Gaekwad v. Varsha Productions* 2015 SCC OnLine Mad 158. *See also* p.3.28 of this Dissertation.

brought an action against the producers of the film *Main Hoon Rajinikanth* (later changed to *Main Hoon Part-time Killer*).<sup>418</sup> Before the Madras HC, the claim *inter alia* sought that “Any use/misuse of the Plaintiff’s name/image/caricature/style of delivering dialogues amounts to infringement of his personality right and copyright arising thereof...”<sup>419</sup> Without going into the potential copyrightability of a *dialogue delivery style*, the Madras High Court nonetheless ruled in favour of the plaintiff, under the larger idea of *personality rights violation*.<sup>420</sup> While unfortunately this case conflates the subject matters of copyright, trade mark, passing off, privacy, defamation, and right of publicity, and somewhat even obliterates the distinct spaces occupied by each available protection, it does showcase how different claims may be possible and can legitimately be made arising from the same cause of action, but leading to a violation of a different private right. Transplanting the thresholds of identifiability from *Titan Industries*, Justice Subbiah of the Madras HC explained that “*infringement of right of publicity requires no proof of falsity, confusion, or deception, especially when the celebrity is identifiable.*”<sup>421</sup>—thereby clearly distinguishing between the “*likelihood of confusion + goodwill*” requirements of claiming passing off, versus the easier threshold of the burden of proof on the plaintiff in a *right of publicity* claim. Further, he borrowed from the WIPO Arbitral Tribunal decision in *Ms. Barkha Dutt v. Easyticket*<sup>422</sup>, to establish “*that an unauthorised use of a famous person’s name is not a bonafide use and if such name is used to lure users, it does not confer rights or legitimate interests on the infringer*”.<sup>423</sup>



Similarly more recently, in *Rajat Sharma v. Zee Telefilms*<sup>424</sup>, the Delhi HC cited the *Titan Industries case* and *Shivaji Rao Gaekwad* to injunct Zee Telefilms from publishing advertisements that contained the name of the plaintiff through the phrase “*Now, in India Rajat’s ‘ADALAT’ is over*” (translated from Hindi to English).

<sup>418</sup> *Shivaji Rao Gaikwad v M/S. Varsha Productions* (2015) (62) PTC 351 (Mad)

<sup>419</sup> *Id.* at paras. 4-3, 4-5, 4-6 and 8

<sup>420</sup> *Id.* at para 23 (“if any person uses the name of a celebrity without his/her permission, the celebrity is entitled for injunction”)

<sup>421</sup> *Id.* at para 21.

<sup>422</sup> *Ms. Barkha Dutt v. Easyticket*, WIPO Arbitration and Mediation Center, Case No D2009-1247. *Refer* p. 4.35 of this Dissertation.

<sup>423</sup> Para 22, *Supra* note 422

<sup>424</sup> *Rajat Sharma v. Zee Telefilms.*, CS(COMM) 15 OF 2009, Delhi HC Decision of January 11, 2019.



However, while the *Titan case* was cited, there was no mention of the two-step test of infringement. This is particularly relevant because, only the first name of the plaintiff was used, without any other image or portrait or photo or likeness. The “evocative association” it seems however, was so high, because, Rajat Sharma, is known as the host of the long running celebrity “court interrogation and cross examination” style interview show – Aap KiAdalat. Thus using the words “Ki Adalat” in conjunction with “Rajat” brings to mind, only this TV News anchor and journalist, Rajat Sharma, making the plaintiff identifiable. Nonetheless, it appears implicitly that the locus of success for the injunction lies in the plaintiff meeting the threshold of identifiability from the alleged taking in dispute. What is unfortunate however, is that this fact scenario would fall squarely within the *newsworthiness* and *public affairs* defenses to right of publicity taking, as evolved under the First Amendment in the USA. Even in *Daler Mehendi*, Justice Bhat did recognise *lampooning and parodying* as protected in the Article 19 Freedom of Speech and Expression when looking to balance a celebrity’s private right against the right of the users and audience and the press, to re-code. As a parody requires a direct taking to target and ridicule, the taking of the name “Rajat” with the suffix “Ki Adalat” definitively satisfies the parodying threshold, by adding “Ab hogi band” thereafter. It in no way creates an endorsement confusion either, which in any case, is not the requirement to check for in a misappropriation of persona action [confusion is an element for misrepresentation torts like false endorsement and passing off]. Furthermore, the for seeking protection for reputation, the tort of defamation is always available, and one needn’t seek and rely on a blanket injunction through the right of publicity tort.

*Per contra*, every unauthorised use of a name does not constitute personality right infringement. In *Gautam Gambhir v. D.A.P & Co & Anr*<sup>425</sup>, the cricketer-politician Gautam Gambhir sought an injunction against the owner of a restaurant by the name, “Blue Waves by Gautam Gambhir”. An argument led by the plaintiff, *inter alia*, was that his image and thus

<sup>425</sup> *Gautam Gambhir v. D.A.P & Co & Anr.*, CS(COMM) 395 of 2017, Delhi HC Decision of December 13, 2017.

personality right was being tarnished because of association with the restaurant. While the personality right of Gautam Gambhir was recognised, in the absence of direct taking of the economic associative value of the plaintiff, the plaintiff was unable to succeed in his claim. The unauthorised taking must be for commercial gain substantiated by a direct identifiability of the plaintiff, similar to *Titan Industries*, which was missing in this case – more so because the defendant restaurateur’s name himself is “Gautam Gambhir”.

Again, while the aforementioned decisions also do throw light on the contours of the right, a lot of questions remain nonetheless, and the later observations post *Titan and Daler Mehndi* are all in Single Judge decisions from several High Courts. Further, it is interesting to note that in another matter<sup>426</sup> where the *right of publicity* as formulated in the *Daler Mehndi* matter could have been easily put to use, **was not**, and expert advocates chose to instead rely on the passing off tort jurisprudence, and built their argument for Mr. Arun Jaitley on what the court articulated as a goodwill in his name thus “*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 its peculiar nature/ distinctive character coupled with the gained popularity in several fields whether being in politics, or in advocacy, or in part of emergency protest, or as leader or as debator has become well known personal name/ mark under the trade mark law which ensures him the benefit to refrain others from using this name unjustifiably in addition to his personal right to sue them for the misuse of his name.*”<sup>427</sup>

#### ii) India and Post Mortem Right of Publicity: Only Questions, no real answers

In the case of *Mrs. Chitra Jagjit Singh v. Panache Media*<sup>428</sup> Justice Gupte of the High Court of Bombay dismissed the plaintiff’s application for *ad interim* injunction to restrain Panache Media from allegedly violating the publicity rights of the late singer Jagjit Singh. The controversy arose when Panache Media planned an event named “Ek Ehsaas – Jagjit Singh – live in concert”, utilizing certain musical works, as well as the name and photographs of the deceased singer. The plaintiff contended that such an event would malign and disrespect the late singer’s name and goodwill. Although no specific claim regarding the violation of publicity rights was initially made, it was argued during the hearing. Panache Media countered by asserting that the plaintiff had not presented any evidence proving she had inherited the singer’s right of publicity. The court denied *ad interim* relief, stating that the plaintiff had not established a *prima facie* case and had not even alleged a violation of publicity rights or provided evidence of inheriting such rights. The court further stated that if Panache Media had legally acquired the rights to use the musical works of the late singer, it was inconceivable that they could not announce the event or use the singer’s name and image.

In its obiter observations nonetheless, the court outlined criteria for establishing the enforceability of inherited publicity rights:

- “Whether the individual’s body of work or celebrity status resulted in a right to use their name, personality, voice, or image.

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<sup>426</sup> Mr. Arun Jaitley v Network Solutions Pvt. Ltd., CS(OS) 1745 OF 2009, Delhi HC Decision of July 4, 2011.

<sup>427</sup> *Id.* at para 31.

<sup>428</sup> *Mrs. Chitra Jagjit Singh v. Panache Media* (Notice of Motion (L) 499 of 2016 in Suit (L) 111 of 2016)

- Whether this right survived the individual’s death and vested in the plaintiff at the time of the cause of action.
- Whether the defendant made or threatened to make unauthorized use of the individual’s name, personality, voice, or image to the plaintiff’s detriment.”

Although courts have recognized the existence and violation of publicity rights in other cases, this decision appears to be the first to establish criteria for enforcing such 'inherited' publicity rights. Until the time of this dissertation’s completion, this researcher has not come across any other case that has seen a plaintiff in a claim for post-mortem rights, actively use these criteria, and neither has a court since then, addressed these criteria.

Thereafter and even earlier however, there have been a plethora of cases, as discussed in Chapter VII, where legal heirs have tried to seek protection of the proprietary as well as dignitary interests in the persona of deceased celebrities by claiming the impossible – i.e. a descendible tort of privacy or a descendible tort of defamation.<sup>429</sup> Some defendants have also in such claims, tried to counter using the observation from *ICC v Arvee*, that, “personality rights” are not alienable because to do so, would be violative of Article 19 and 21, and therefore, the plaintiffs have no claim.<sup>430</sup> This counter argument too, is flawed. While the court in *ICC v Arvee* was correct in making its observations that the right of publicity inheres in an individual, it is a *quasi property right*<sup>431</sup> that *in fact* is transferrable for a limited time and purpose, under contract – which is how the *Titan* and *Daler Mehendi* cases saw the plaintiff as a *legal entity – a company* that was holding the right of publicity in relation to the impugned unauthorised taking, of the real individual who was the *holder of identity* and in whom the *right of publicity* vests<sup>432</sup>

Something interesting however, happened in *Puttaswamy I*<sup>433</sup>. The problem of the true nature of the *right of publicity* in India got magnified on August 24, 2017, when the Supreme Court issued THIS seminal decision<sup>434</sup>, clarifying finally, the position of *the right to privacy* under Indian law as a fundamental right of all citizens guaranteed under Part III of the Constitution. The majority decision, in part, provides for the horizontal applicability of the privacy right, finding the ground in the enunciation of the right as having both *common law* and *fundamental right* aspects, thereby enabling the simultaneous enforcement of the same right as against those entities that qualify the test of *state* under Article 12 as well as against private entities.<sup>435</sup> Interestingly, Justice Kaul went a step further. In his separate opinion, he elevated the *right of publicity*, otherwise having been previously enunciated only as a common law right,<sup>436</sup> to a being a facet of the fundamental guarantee of privacy. He opined thus – “*Aside from the economic justifications for such a right, it is also justified as protecting individual autonomy*

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<sup>429</sup> Refer Chapter VII, pp. 6.45 to 6.52

<sup>430</sup> Refer Deepa Jayakumar vs A.L. Vijay, Madras HC DB Decision of April 16, 2021; Shri Babuji Rawji Shah v. S. Hussain Zaidi & Ors, Special Leave Petition (Civil) No. 15711 OF 2021; SC Decision of February 24, 2022

<sup>431</sup> Tushnet, A Mask that Eats, *Supra* note 221 at 2

<sup>432</sup> Rothman, Privacy Reimagined, *Supra* note 16

<sup>433</sup> K.S. Puttaswamy and Anr v. Union of India (2017) 10 SCC 1 (“Puttaswamy Case”).

<sup>434</sup> *Supra* note 433.

<sup>435</sup> *Id.* at paras 397, 398 and 428.3.

<sup>436</sup> Refer Titan case and Daler Mehendi case, *Supra*

and personal dignity. The right protects an individual's free, personal conception of the 'self.' The right of publicity implicates a person's interest in autonomous self-definition, which prevents others from interfering with the meanings and values that the public associates with her.<sup>437</sup> This is extremely alarming, as the footnotes in the decision, are to the American *Haelan Laboratories* decision, which as this researcher has pointed out, was **not** really a right of publicity decision, and another alludes to the title of the work by McKenna [Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225 (2005)], without really exploring and unwrapping the nuances of the arguments therein.

In light of the foregoing discussion on the nature of the civil-law (tort law) claim of *right of privacy* and the contrary yet related *economic, commercial* right enforceable also in a civil-law (tort law) claim, read against this one observation by Justice Kaul in *Puttaswamy*, the researcher argues that Justice Kaul's *obiter* leads to a plethora of potential interpretational and implementational issues:

- for one, fundamental rights, by their very nature, are non-assignable, and non-waivable.<sup>438</sup> It is noteworthy that in his majority opinion, Justice Chandrachud in the *Puttaswamy* case has recognised that the *right to privacy* includes 'decisional autonomy'. Further, as explained by celebrated expert Sr. Advocate Mr. Arvind Datar, "*This would include the right of a person to make an informed decision not to enforce his fundamental right. In other words, he can "waive" it.*"<sup>439</sup> Nonetheless, as suggested by McCarthy, the non-assignability of traditional privacy rights was one important reason for the creation of the separate concept of the *right of publicity*<sup>440</sup>. The US courts have uniformly held that the *right of publicity* is a 'property' right, since the *Haelan Laboratories* decision. Courts also view the *right of publicity* as a form of 'intellectual property', having both similarities to and differences from other forms of intellectual property such as copyrights and trademarks.<sup>441</sup> The nature of this right of publicity as a quasi property style right is such that it is, to an extent, separable from the persona embodying it, unlike the fundamental *right of privacy* which is inherent to the individual human person. This is further explained by Post, thus "[P]ersonality is commodified and becomes 'something in the outside world, separate from oneself.' For this reason, commodified personality can endure long beyond the living self of the individual who creates it and can also be owned and used by persons other than its creator."<sup>442</sup>
- Further, fundamental rights in their essence were meant to be enforced by the citizen against the state (vertical application) and not against other citizens (horizontal application). One of the problems with *Auto Shankar* and the reasons why many are

<sup>437</sup> *Supra* note 433 at para 626. See also Prashant Reddy, The Supreme Court's Privacy Judgment Elevates Personality Rights to the Constitutional Plane, SpicyIP (August 26, 2017) <https://spicyip.com/2017/08/the-supreme-courts-privacy-judgment-elevates-personality-rights-to-the-constitutional-plane.html>.

<sup>438</sup> *Basheshar Nath v Commissioner of Income Tax*, [1955] 1 S.C.R.773 ("Basheshar Nath").

<sup>439</sup> Arvind Datar, Can a Fundamental Right be waived?: Legal Notes by Arvind Datar, BAR&BENCH (September 11, 2017) <https://barandbench.com/can-fundamental-right-waived-arvind-datar/>

<sup>440</sup> McCarthy, *Supra* note 2 at §§ 10:6 to 10:13.

<sup>441</sup> *Id.*

<sup>442</sup> Robert C. Post, *Rereading Warren and Brandeis: Privacy, Property, and Appropriation*, 41 Case W. Res. L. Rev. 647, 668 (1991).

critical of it, is that it conceives of a very broad horizontal right to privacy, which has also been endorsed in *Puttaswamy*. As pointed out by Prashant Reddy, it is one thing to claim a strong fundamental right to privacy against the state, but what is the logic of a fundamental right to privacy against fellow citizens?<sup>443</sup> Further, since the *Basheshar Nath*<sup>444</sup> decision has not yet been overruled, fundamental rights are inalienable – **a very literal interpretation and application of Justice Kaul’s opinion would then seem to suggest that right of publicity is not alienable at all.** Such an absurd consequence definitely would not have been the intention!

This further leads to the problem of the inheritability and descendability of these right of publicity claims. Fundamental rights are rights held against the world at large – they do not create actions of infringement *in personam* but are enforceable only in the constitutional courts via their writ jurisdiction, as rights *in rem*. In further creating this artificial “equivocation” between *right of publicity* as a right in the nature of protection against commercial misappropriation and the *fundamental* guarantee of the *right of privacy* as a protection against unlawful invasion, the decision allows for now only *writ courts* to have *exclusive jurisdiction* over such claims – which is in actual practise, not really true. It would potentially start flooding our already overburdened court system<sup>445</sup> with even more matters that will have to undergo the preliminary ‘nature of right claimed’-style scrutiny. This would potentially furthermore lead to the absurdity of the appellate court system operating as first instance ‘summary’ disposal courts, thereby diluting the sanctity of the constitutionally vested writ process.

This issue came to the fore again, in the *Krishna Kishore Singh v Sarla Saraogi* case<sup>446</sup> Justice Narula in his interim order, didn’t find that right to privacy is inherited, however preliminarily observed that the plaintiffs could bring up concerns and prima facie establish them in regard to their own privacy. Nonetheless, relying on the observations of Justice Kaul in *Puttaswamy* read with the scope of the *right of privacy*, Justice Narula in his order continued to obliterate the distinct fields occupied by the subject matters of *right of publicity* and *right to privacy*. He opined that in the absence of *statutory* protections for distinct intellectual property rights applicable within the ‘celebrity rights’ bundle, both *privacy* and *publicity* seem to trace their roots to the Article 21 guarantee of the right to life and personal liberty.<sup>447</sup> Justice Narula explicitly *rejects* thus, the descendability of the *right of publicity*, while nonetheless affirming the descendability of certain intellectual property rights vested with the celebrity.<sup>448</sup> This matter has been disposed of finally by the order of Justice Harisankar<sup>449</sup>. He dismissed the application seeking interlocutory injunction moved by the late actor’s father in his suit against the producers and director of the film, and held – “...*the impugned movie, being based on information in the public domain, which, at the time of its original dissemination, was never*

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<sup>443</sup> Reddy, *Supra* note 437

<sup>444</sup> *Supra* note 438

<sup>445</sup> According to the National Judicial Data Grid, there are 1,09,72,715 civil cases pending before the District and Taluka Courts and 44,02,949 civil cases pending before High Courts in India as of June 2024.

<sup>446</sup> *Krishna Kishore Singh v. Sarla S. Sarogi & Ors.*, CS(COMM) 187 OF 2021, Interim order of Justice Narula of Delhi HC on June 10, 2021, Refer pp.6.48 – 6.49 of this dissertation.

<sup>447</sup> *Id* at para 20

<sup>448</sup> *Id* at para 21

<sup>449</sup> *Krishna Kishore Singh v. Sarla S. Sarogi & Ors.*, [Order of Justice Hari Shankar, Delhi HC, July 11, 2023]

*challenged or questioned, cannot be sought to be injuncted at this distance of time, especially when it has already been released on the Lapalap platform a while ago and must have been seen, by now, by thousands. The movie cannot be said to be infracting Article 19(2) of the Constitution of India. Injuncting further dissemination of the movie would, therefore, infract the defendants' rights under Article 19(1)(a).*<sup>450</sup>

Other parts of the ruling that are noteworthy:

- *“The reliefs sought in the plaint are entirely with respect to SSR. The rights that the prayers in the suit seek to protect and the rights of privacy, publicity and personality which vested in SSR. No relief, qua any right which vests in the plaintiff, finds place in the plaint. The rights ventilated in the plaint – i.e., the right to privacy, the right to publicity and the personality rights which vested in SSR, are not heritable. They died with the death of SSR. The said rights, therefore, did not survive for espousal by the plaintiff;”*<sup>451</sup> - Thus, the court categorically holds that right to privacy, does not survive death, and cannot be claimed for a deceased individual, as has been held in plethora of rulings earlier.
- Nonetheless, even when allowing the film to remain, Justice Harisankar seems extremely **dismissive\*** of claims that are branded “celebrity rights” – this researcher agrees. The personality rights umbrella, inclusive of the quasi property – misappropriation claim style right if publicity, extends to all individuals, not just those who have *fame* attached. In fact, McCarthy points out in his seminal work that *“The right of publicity is not merely a legal right of the “celebrity”, but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.*”<sup>452</sup> Thus, although theoretically available to any individual, since the right requires some commercial value in the image as a precondition, the claim rarely arises outside the celebrity realm.<sup>453</sup> Justice Harisankar observed thus - *“The law cannot allow itself to be a “vehicle to promote celebrity culture” and that the rights which emanate from one’s personality would be available to one and all, and not only to celebrities.*”<sup>454</sup> The court doesn’t address the question of inheritability of these celebrity rights/ personality rights, and in spite of being, unfortunately erroneously labelled “celebrity rights” but being directed to other HC decisions on *right of publicity*, Justice Harisankar says he cannot agree with these decisions, - *“that said, — “celebrity rights”, even as canvassed by Mr Varun Singh, are merely a sub-species of personality rights. As I have already held that the*

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<sup>450</sup> *Id* at para 21.5

<sup>451</sup> *Id* at paras 21, 21.2

**\*Refer Tushnet, A Mask that Eats, *Supra* note 221 at 2 “Courts have regularly seemed disgusted with celebrity culture even while allocating economic rights to exploit such irrational preferences. Today, the right of publicity expansively grants celebrities the right to control commercial exploitations of their names, likenesses, voices and often enough their “identities” in any form that those identities are evoked.”**

<sup>452</sup> J. Thomas McCarthy, *Rights of Publicity and Privacy* § 1:3 (2nd ed).

<sup>453</sup> Robert P. Merges, Peter S. Menell and Mark A. Lemley, *Intellectual Property in the New Technological Age* 1020 (2010)

<sup>454</sup> *Supra* note 449 at paras 22, 22.1.2, 22.1.3, 22.1.4

*plaintiff cannot seek to injunct the telecast of the impugned film on the ground of violation of SSR's personality rights, nothing further needs to be said on this score*".<sup>455</sup>

This researcher's area of study in this dissertation, is to look at the Personality Rights Umbrella, for celebrities, not to advocate for a distinct branch/club of rights that are called "celebrity rights".

- Having seen the movie in question, the court observed that it was clear that the characters "*Mahendra Singh, Urvashi and Keshav Singh*" of the film are merely aliases for "*Sushant Singh Rajput, Rhea Chakraborty and Rajput's father*".<sup>456</sup>
- Justice Harisankar further observed that "*It has to be stated, here, with some regret, that the stand, adopted by the defendants, of the impugned movie being a generalised version of struggling actors in the Bollywood industry, and having merely taken inspiration from news items, is ex facie misleading. The story of the film is practically a day by day story of the life of SSR, as was made known through articles in the press and in magazines. Hardly any independent inventive input has gone into the movie,*" and also observed that the disclaimer inserted in the movie cannot detract from the reality that the movie is a "*celluloid retelling*" of the life and death of the late actor.<sup>457</sup>

### iii) Right of Publicity gone rogue: Overreaching claims, Nomenclature confusions, Omnibus Orders and a ruined Salad Platter

In the last couple of years, the Delhi High Court has seen a sudden wave of *personality rights* actions being filed. Unfortunately however, in the humble opinion of this researcher, most of these actions, could've been easily avoided, given the stature of the celebrities who bring claims, and the small – time fan made merchandise traders, as defendants, who are sought to be injuncted alongside those who are causing harm or leading to actual misappropriation without the free speech protections.

For example, in the case of *Amitabh Bachchan v Rajat Nagi and Ors.*<sup>458</sup> the Delhi High Court granted an *ad interim ex parte omnibus injunction* in favour of veteran actor Amitabh Bachchan in a suit filed for the protection of his "publicity rights". This action was taken against the fake "Kaun Banega Crorepati" (KBC) lottery scam and other alleged online frauds where his photo and voice were being misused to deceive the public. Justice Navin Chawla observed that a *prima facie* case was made out in favour of the actor against the defendants, who are various individuals and entities allegedly violating Bachchan's personality rights. The court noted, "*I am of the opinion that the plaintiff has been able to make out a prima facie case in his favour. The balance of convenience also lies in favour of the plaintiff and against the defendants.*"<sup>459</sup>

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<sup>455</sup> *Id.* at para 22.1.4. This also stands in complete contradistinction to the order of Justice Rajbir Sehrawat of P&H HC in *T Series v Dreamline Realty, Mohali* 2024 SCC OnLine P&H 661, where he categorically observed that the claim of personality rights/ celebrity rights can only be brought by a person who has commercial goodwill and can show celebrity value, it is not a right enforceable by and available to all persons, and that the observations of Justice Kaul in *Puttaswamy I* are not of consequence as they are the opinion of only one judge. A non-celebrity cannot claim privacy in their own life story such that they become the only persons who can consent to its commercial exploitation. *Id.* at para 21

<sup>456</sup> *Id.* at para 18.4

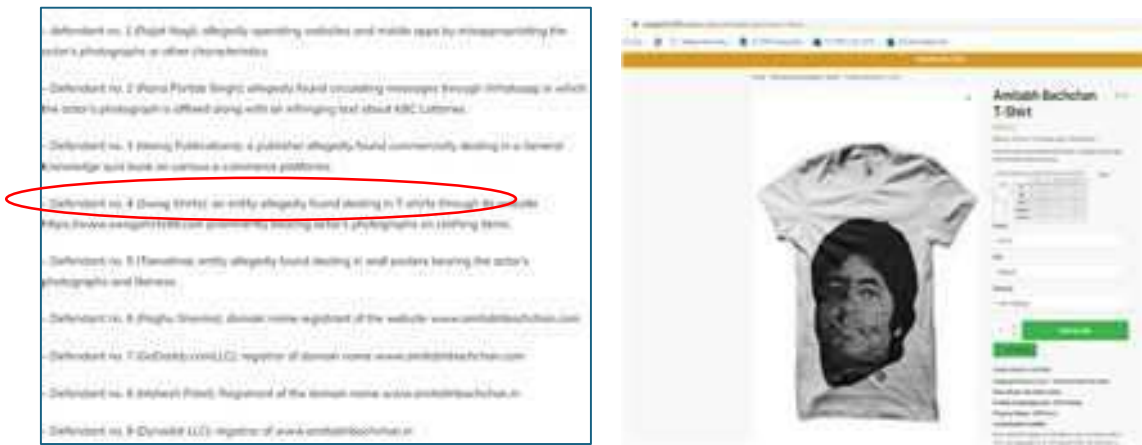
<sup>457</sup> *Id.* at 18.11

<sup>458</sup> *Amitabh Bachchan v. Rajat Nagi and Ors.* MANU/DEOR/195516/2022

<sup>459</sup> *Id.* at para 21

The court found that the defendants appeared to be using the celebrity status of the actor without his authorization or permission, and the activities being complained of were “bringing disrepute to the actor.” The court directed the Department of Telecommunications (DoT) and the Ministry of Electronics and Information Technology (MeitY) to require the respective Internet Service Providers to take down all links or websites listed in the complaint. Additionally, Telecom Service Providers were ordered to block access to all phone numbers used by the defendants to circulate messages on messaging apps, like WhatsApp, which amounted to an infringement of Bachchan’s rights.

This case is notable for being the first instance of a John Doe Injunction in a personality rights case, where domain names were also included under the personality indicia. However, in the list of 09 named defendants, alongside cybersquatters and fake lottery proprietors, are also websites that sell fan – made T shirts, with the face/ caricatures of Amitabh Bachchan. One such website, Swag Shirts, is clearly not a website which is causing any commercial disadvantage to the celebrity stature of the plaintiff, and in fact, as was mentioned in the *Fenty v TopShop* decision, the T shirts there were enjoined *because of the overt methodology of causing an impression in the minds of the public that Rihanna would’ve endorsed the said T shirt, by launching it close to her album launch, as well as having previously been associated with her in the store.* The court there had found that fans aren’t this gullible otherwise to buy T shirts with celebrity faces always under the impression that they’re authorised and endorsed by the celebrity, instead they buy such T shirts simply because, they are fans.



Furthermore, the court doesn’t check itself and conflates all possible claims – and interchangeably uses personality rights/publicity rights (as a plural)/publicity rights as a celebrity (also plural) without really identifying what this “rights” bundle entails. The court does cite *Titan* case, however culls out ‘publicity rights as a celebrity’ erroneously therefrom – the court in *Titan* recognised, a singular right of publicity, as a facet of personality rights. Even though through *Titan* and *Daler Mehendi* cases, the nature of the right of publicity in India, is that of a *misappropriation tort* as under California common law, and *not* the passing off style misrepresentation claim, where endorsement use / consumer confusion is a requirement, bringing a blanket action against a fan – caricature T Shirts maker-seller, is stretching the availability of the right of publicity protection, too far.

Thereafter, in early 2023, it came to be reported, that Superstar Rajinikanth had released a public notice through his lawyers, warning of “civil and criminal action against those who commercially exploit the actor’s name, image, voice or any other distinctive characteristic without his express consent”<sup>460</sup> A copy of the notice is appended below:



This notice makes no effort to understand and identify the rights, and instead brands the rights as “Personality/Publicity/Celebrity” Rights. Furthermore, an extremely wide range of indicia are claimed as covered, and thereby a notice of “prohibition” is issued on “use” beyond just confusing and deceptive advertising and endorsement use, including “imitations” – this in this researcher’s submission, goes too far. Within the protections under Article 19, for parodying, caricaturing and lampooning, imitations for stand up comedy, that is for a paying audience, must definitely be protected – the predominant purpose test, if applied in this context to the Indian scenario, would be to *parody for comedic effect by sounding like Rajinikanth/ acting like Rajinikanth*, and not to *impute to the audience that the performer is Rajinikanth/ is authorised by Rajinikanth*. If a claim is ever brought pursuant to this notice against a mimicry artist/ voice artist/ comic or actor, and an injunction like in the *Amitabh Bachchan* case is granted, it defeats what Tushnet beautifully argues – “*But if, as everyone seems to agree, the Constitution precludes requiring a celebrity’s consent before a writer can pen a biography of her, the result should be the same when a comic artist picks up a pencil or a programmer opens a file.*”<sup>461</sup>

<sup>460</sup> Mohamed Imranullah S, Rajinikanth issues public notice over infringement of rights, *The Hindu*, (Jan 29, 2023) <https://www.thehindu.com/news/national/tamil-nadu/actor-rajinikanths-advocate-issues-public-notice-against-infringement-of-his-personality-rights/article66444370.ece>

<sup>461</sup> Tushnet, *A Mask that Eats*, *Supra* note 221 at 3

A manifestation of Tushnet’s fears that – “As the general public, as well as famous people, became more comfortable with commercializing such images, courts started to identify the harm of such uses less as insults to dignity and privacy and more as violations of a right to control and profit from any commercial uses... An image, described by the Supreme Court as a “short cut from mind to mind,”... here became private property, not a public pathway,”<sup>462</sup> has been observed in two very recent actions, only a few months apart.

In Anil Kapoor v. Simply Life Media And Ors.<sup>463</sup>, Anil Kapoor, celebrated star and veteran actor in his own right, brought an action against 16 identified and several un-identified defendants. The claim asserted that his name and persona, in addition to having substantial commercial value, deserve protection from misuse and tarnishment on the internet. Thus, the aim of the suit was for the Plaintiff to seek to safeguard his “personality rights, publicity rights, and elements associated with his persona”, which include: name; voice, photograph/image/likeness; manner of speaking and dialogue delivery; gestures; signatures, etc." The rights the Plaintiff sought to assert in this case were also three-fold: A) Personality rights, including the right to publicity; B) Copyright in dialogue, image, and other associated works; C) Common law rights, including protection against passing off, dilution, and unfair competition. The 16 identified defendants are thus:

S.No.	Defendants	Unauthorized acts
1	Defendant No.1- Simply Life India	<ul style="list-style-type: none"> <li>• False endorsement of Anil Kapoor as a motivational speaker.</li> <li>• Fees (Task Payment) charged by the Defendant for its service.</li> <li>• Name &amp; image of the Plaintiff being used- "Passing off"</li> </ul>
2.	Defendant No. 12.	• Plaintiff's voice!

3.	Defendant No. 14- Karati Barna Krishna	<ul style="list-style-type: none"> <li>• dialogues and name being used</li> <li>• Plaintiff's face being morphed.</li> <li>• Payment sought from consumers.</li> </ul>
4.	Defendant No.2- Vision Computers	• Wallpapers on mobile phones using Plaintiff's images.
5.	Defendant No.3- TP Apparel LLC	• Merchandise- magnets, t-shirts, caps, stickers including "Anil Kapoor"
6.	Defendant No.4-MAAD Ventures (Book My Face)	• Face masks with Plaintiff's pictures on it.
7.	Defendant No. 7- Khajuram	• Stickers of Plaintiff.
8.	Defendant No. 8- VIP Contents	• Cutouts and face masks of Plaintiff.
9.	Defendant No. 9- Merchandize Products Pvt. Ltd	• Posters of Plaintiff.

10.	Defendant Thunder Enterprise Limited	No.10- Buddy Private	• Key claims with Plaintiff's image.
11.	Defendant Paridhan Showroom	No.11-	• Suits being sold using Plaintiff's name
12.	Defendant Firma Stella	No.13-	• Autographed photos of Plaintiff
13.	Defendant No. 5- Refaceshorts (Jitendra Mishra)	2023	• Deep fakes using Artificial Intelligence representing Plaintiff as Katrina Kaif.
14.	Defendant No.15- Shahid SK		• Plaintiff's generative Artificial Intelligence as a Disney characters.
15.	Defendant No.6- Giphy		• GIF- image keeps

16.	Defendant Nos. 16 and 17- Sun Systems & Solutions and PDR Limited		• Anil Kapoor.net
17.	Defendant Nos.18 and 19- Domains by Proxy LLC and GoDaddy LLC		• Anil Kapoor.com
18.	Defendant No.20- Dynadot LLC		• Anil Kapoor.in
19.	Defendant No.21-John Doe(s)		• 44 links annexed as Annexure-A along with application under Order 39 Rules 1 & 2 of CPC.

Justice Pratibha Singh, writing for the court observed that Fame can bring its own set of disadvantages, as demonstrated by this case, where reputation and fame can sometimes lead to harm.<sup>464</sup> However, she also cautioned and asserted that free speech, including satire, writings,

<sup>462</sup> *Id.* at 4.

<sup>463</sup> Anil Kapoor v. Simply Life Media And Ors., CS(COMM) 652/2023 Delhi High Court Decision of 20 September, 2023.

<sup>464</sup> *Id.* at para 38

and genuine criticism about a person, is undoubtedly protected<sup>465</sup>, however, when such expressions cross the line and result in tarnishing or jeopardizing an individual's personality and associated elements, it becomes illegal.<sup>466</sup> Thus, holding that using a person's name, voice, dialogue, or image in an unauthorized manner for commercial purposes is impermissible, she explained the rationale of such a right by highlighting how celebrities often rely significantly on their endorsement rights for their livelihood, which cannot be undermined by unauthorized merchandising.<sup>467</sup> Furthermore, she cautioned about new technologies, and how with the advent of technological tools, it has become easier for unauthorized users to exploit a celebrity's persona, including through AI.<sup>468</sup> Beyond this right, the court recognised that celebrities also have a right to privacy and do not want their image or voice portrayed negatively<sup>469</sup>. The actor's image being morphed with other actresses is offensive not just to him but also to the other actresses involved.<sup>470</sup> The court cannot ignore such misuse, as tarnishment constitutes an actionable tort<sup>471</sup> that Kapoor needs protection against. The court thus unequivocally held that the plaintiff's name, voice, and persona deserve protection. This protection is not only for the celebrity's own sake but also for the sake of friends and family who do not wish to see his name misused or tarnished on inappropriate websites.<sup>472</sup> Thus with specific references to each named defendant, instructions were issued to pull down the infringing content and domain names, cease the sale of mentioned merchandise, and with a laudable and noteworthy reference to the then *Dark Pattern Guidelines*, Justice Pratibha Singh also explained how misuse Kapoor's persona for advertising purposes on online trading platforms must cease. While in its entirety the order is one of the more well reasoned interim orders, nonetheless, this struggles with the same concerns as were raised for the *Amitabh Bachchan* case. In the named defendants, alongside serious concerns of morphed images that are pornographic, there are inclusions of meme makers who've turned his dialogue from the film *Yudh* "Jhakaas!" into moving "gifs" – this surely should fall within the realm of free speech and memes anyway are completely transformative in purpose and character, from the original scene in the film, and are used as trends and reactions, out of the context of the original in which they appeared. Furthermore, websites selling fan merchandise like keychains and T shirts are again, unduly restrained, alongside deepfakes\* and cyber squatters. This equating of alleged wrongful unauthorised users, is too far reaching a consequence of getting such omnibus orders for "celebrity personality rights" – the salad platter of rights thus, though still a salad, seems to be covered by a thick, unhealthy dressing, such that the individual components and flavours of each vegetable, fruit, beans – whatever have you – is lost to this thick dressing.

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<sup>465</sup> *Id* at para 38

<sup>466</sup> *Id* at para 40, 46

<sup>467</sup> *Id* at para 40

<sup>468</sup> *Id* at para 42

<sup>469</sup> *Id* at para 41, 42 *citing* Auto Shankar's case.

<sup>470</sup> *Id* at para 42

<sup>471</sup> *Id* at para 43

<sup>472</sup> *Id* at para 45

\* Deepfake regulation is an emerging concern in India also, and an area identified for further research, MeitY's advisory in December 2023 is a critical first step to address the harmful impact of deepfakes, and the government, as of March 2024, was proposing amendments to The Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, to regulate deepfakes

Most recently, in the *Jackie Shroff* case,<sup>473</sup> on May 15, 2024; in a civil suit filed by renowned actor Jackie Shroff ('plaintiff'), seeking protection of his publicity/personality rights against unauthorized misuse, the Single Judge Bench of Sanjeev Narula, J., held that the balance of convenience was in favour of the plaintiff and had established a prima facie case for the grant of an *ex-parte* injunction. Consequently, the Court restrained several defendants from infringing the plaintiff's personality/publicity rights and mandated compliance with Order XXXIX Rule 3 of the Code of Civil Procedure, 1908 within one week from 15-05-2024. The Court directed the Department of Telecommunications (DoT) and the Ministry of Electronics and Information Technology (MeitY) to issue necessary directives to telecom service providers and internet service providers to block the infringing URLs/links.<sup>474</sup> The claim arose from multiple causes of action against 15 named and identified defendants who were allegedly making unauthorised use of the plaintiffs registered trademark "BHIDU" and other name identifiers like "JAGGU DADA", "JACKIE" and "JACKIE SHROFF". It was alleged that plaintiff Jackie Shroff, a well-known Indian actor, had registered 'BHIDU' in Class 25 and Class 41 and 'Bhidu ka khopcha' in Class 41 as trademarks. Additionally, 'JACKIE SHROFF', being the plaintiff's personal name, is uniquely associated with him. These infringements and violations took various forms, through the sale of printed merchandise on e-stores, creation of derogatory YouTube videos, opening of a restaurant named 'Bhidu Shawarma & Restaurant', and posting links selling merchandise and certain pornographic content using the name "Jackie Shroff" without prior consent.<sup>475</sup>

The Court referred to the *Daler Mehendi* case, which held that the right of publicity protects individuals against the unauthorized use of their personality indicia, including their name, image, voice, and other distinctive attributes. The Court recognized that such unauthorized use could lead to unearned commercial gain for another party, infringing on the individual's personality rights.<sup>476</sup> Applying this principle, the Court noted that the alleged activities of some defendants, on a prima facie basis, resulted in commercial benefits through the unauthorized exploitation of the plaintiff's personality. They utilized the plaintiff's name, image, voice, and other unique characteristics without permission, infringing on his personality and publicity rights.<sup>477</sup>

Regarding the challenge against a YouTube video titled "Jackie Shroff Is Savage (\*) Jackie Shroff Thug Life!", the Court explained that the term "Thug Life" often appears in memes portraying individuals demonstrating boldness or audacity, with humor or defiance. The Court stated that the portrayal did not introduce any falsehoods but rather embellished the existing public perception of the plaintiff as a formidable and commendable figure. Considering the growing community of memes, spoof, and parody, and the economic benefits that the youth

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<sup>473</sup> Jaikishan Kakubhai Saraf Alias Jackie Shroff v The Peppy Store & Ors (CS(COMM) 389/2024), Delhi HC Order of May 15, 2024; 2024 SCC OnLine Del 3664 (Next listed for October 15, 2024)

<sup>474</sup> *Id* at para 28.e

<sup>475</sup> *Id* at paras 5, 6, 8, 9

<sup>476</sup> *Id* at para 12

<sup>477</sup> *Id* at para 12

derive from viewership, the Court highlighted that these videos represent a form of artistic expression requiring thoughtful engagement with content.<sup>478</sup>

The Court also emphasized that restricting such creative expressions might have far-reaching consequences for this vibrant community and could set a precedent that stifles freedom of expression, deterring the public from exercising their right to free speech due to fear of legal repercussions. Therefore, the Court sought a response from the creator of the video against whom the plaintiff had sought an ex-parte ad-interim injunction and refused to allow the same at the present stage.<sup>479</sup>

The Court concluded that the balance of convenience favoured the plaintiff and established a prima facie case for granting an *ex-parte injunction* against an AI chatbot platform<sup>480</sup>; a defendant selling wallpapers of the plaintiff; creators of videos distorting the plaintiff's face<sup>481</sup>; an e-commerce website selling t-shirts and posters using the plaintiff's photographs and name; and 'Inverted Mushrooms' selling autographed pictures of the plaintiff.<sup>482</sup> The Court stated that not granting an injunction would lead to irreparable loss/harm to the plaintiff, not only financially but also concerning his right to live with dignity.

This case, admittedly, is a better illustration of how the salad platter can be used : Personality Rights Salad Platter with the options of – registered TM rights against restaurant service provider, over the unauthorised use of TM BHIDU; right of publicity against unauthorised endorsement messaging, AI Chatbots, T Shirts etc, and right to privacy against pornographic and morphed images on websites (could've relied on malicious falsehood which is the equivalent false light – privacy tort in India, however the same wasn't claimed). The court also made the laudable effort to break down the 'Thug Life' video, find the artistic expression in it, and seek to conduct the balancing exercise between the private right claimed versus the Constitutional right guaranteed. However also, unfortunately in this case too, small time fan-merchandise websites selling T Shirts have been restrained. In fact, Frankly Wearing, Defendant no. 2 in the case, was named as a defendant for selling a T shirt with the phrase "Anda Kadipatta Kha Bhidu" . The claim alleged that the defendant's website was carrying "animated images of the famous recipe of the Plaintiff of 'Anda Kadipata' that went viral on Instagram along with the word "Bhidu" associated solely with the Plaintiff"<sup>483</sup> This is particularly over-reaching, as Jackie Shroff cannot possibly be claiming "recipe credits" over

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<sup>478</sup> *Id* at paras 19, 20, 21

<sup>479</sup> *Id* at paras 21, 22 ["Therefore, in considering the relief sought by the Plaintiff against Defendant No. 5, this Court considers it is essential to balance the legitimate interests of Defendant No. 5 in artistic and economic expression against the Plaintiff's rights to personality, publicity, and moral integrity. Thus, the court would like to have the response from the Defendant No. 5 before expressing its view on this issue. Therefore, at this stage, the Court is not inclined to order an ex-parte ad-interim injunction in favour of the Plaintiff and against Defendant No.5."]

<sup>480</sup> *Id* at para 24, 28c

<sup>481</sup> *Id* at para 26 ["Defendant No. 18 are unidentified persons and are impleaded as John Does seeking taking down of links which are pornographic in nature and use the Plaintiff's name in the said links. That apart, Plaintiff also seeks taking down of listings of infringing merchandise as available for sale on the impugned links. The said material is prima-facie prejudicial to the Plaintiff's reputation and violates his personality rights. Therefore, the Plaintiff is entitled to an ex-parte ad-interim injunction against such defendants."]

<sup>482</sup> *Id* at para 16

<sup>483</sup> *Id* at para 8, Defendant No. 2, Table Row 2

the dish *Anda Kadipatta*. Yes, the particular nomenclature and the cooking method has been popularised by the viral video<sup>484</sup> and public memory is of his video instructions to make the dish, in his inimitable tapori style,<sup>485</sup> however, the question then arises – should protectable indicia of personality, be interpreted so expansively, to include even basic recipes and dishes, as evocative of a single individual, or should such *culturally expressive speech events*. Tushnet’s worry for the USA, has become a premonition then for India that – “*Today, the right of publicity expansively grants celebrities the right to control commercial exploitations of their names, likenesses, voices and often enough their “identities” in any form that those identities are evoked. This right can be metaphorically shorthanded as a right to control “image,” indicating the way in which publicity rights are bound up with the heavily visual culture of the past century that gave us the modern celebrity.*”<sup>486</sup>



The T shirt in question, and a Google Search for the T shirt, brings up Thumbnails from Frankly wearing, still on the archived search.

However, upon clicking on the link, we are re-directed to (as on May 21, 2024):



<sup>484</sup> Jackie Shroff's "Anda Curry Patta" Recipe #shorts #trending #jackieshroff, Uploaded by Behindcook, YouTube Shorts (Aug 28, 2023) <https://www.youtube.com/watch?v=ZipiujipLHk>

<sup>485</sup> In fact, a while before this matter came up in May 2024, Jackie Shroff licensed his “style” and “mannerisms” to Amazon Prime video, for an April Fools’ Day Spoof Ad, that advertised that subscribers could now choose a “Jaggu Dada Mode” on Sub-Titles and Language. It is a hilariously self-depricating video, but also a masterstroke, in monetising one’s style – a clear evidence that right of publicity in India, works like a quasi property right, covers mannerisms as protected indicia, and is trasferrable thus in a limited extent. Watch - New Feature - Jaggu Dada Mode | Prime Video India, Uploaded by Prime Video India, YouTube (April 1, 2024) <https://www.youtube.com/watch?v=-ANFdra0WU>

<sup>486</sup> Tushnet, A Mask that Eats, *Supra* note 16 at 2

This T Shirt, does use the trademark “Bhidu” and the image of Jackie Shroff, however, using the *fandom isn't gullible* argument, alongside the repeated assertion that fan merchandise are expressive cultural resources, in response to conferring the economic value on celebrity entertainers, this T shirt could be arguably, not infringing Jackie Shroff’s right of publicity. Since the store gave an undertaking to pull down the T shirts anyway, we do not have a prima facie ruling on the question of balancing, which is an opportunity provided to the YouTube video creator for the ‘Thug! Life’ videos. If this T shirt is infringing Jackie Shroff’s Right of publicity, then what would be the fate of this hand-painted wall platter, being sold on RuandChai.com, with the name “Anda Kadipatta Painting”, and the clear description “This one is inspired by Jackie Shroff’s famous Anda KadiPatta recipe”<sup>487</sup>



If we were to study Ru and Chai’s painting in contradistinction to the FranklyWearing T shirt, some things stand out – 1) Jackie Shroff’s Face isn’t used 2) No tag line is used, definitively evoking Jackie Shroff .Therefore, this painting, is even more an “expressive speech event” protected by Article 19 guarantees, than the Frankly Wearing T shirt!

The bottomline is, *transformations* and *artistic expressions* can take many forms, not necessarily visual, just as indicia of identity that are purportedly protected, are not necessarily visual alone, and encompass all and any facets of identity. Thus, to respond to this expanding scope of the right of publicity, this researcher can only, in exercise of her own academic freedoms (with restraint), use a Jackie Shroff interview screen grab<sup>488</sup> as a meme:



<sup>487</sup> Anda Kadipatta Painting, <https://www.ruandchai.com/products/anda-kadipatta-painting> [being sold for a whopping INR6500/- only!] (last visited May 21, 2024)

<sup>488</sup> “I feel one should be able to express bindaas: Jackie Shroff”, Times Now on Twitter (now X) (Nov 15, 2015) <https://twitter.com/TimesNow/status/669406836177567744>

## Addendum

A controversial ruling was also handed down, in a new-technology – clash with right of publicity style case in early April 2023. In *Digital Collectibles Pte Ltd. v. Galactus Funware Technology Pvt. Ltd.*,<sup>489</sup> Justice Amit Bansal of the Delhi High Court delivered a judgment with significant implications, rejecting the Plaintiffs’ application for an interim injunction in the case. The case involved allegations of passing off, unjust enrichment, and breach of personality rights/right of publicity of Plaintiff Nos. 2 to 6, who are prominent Indian cricketers. The dispute centred around the use of players’ images, names/initials, and other attributes in Digital Player Cards (“DPCs”) that could be bought, sold, and traded on the ‘Striker’ platform. Below is a summary of the case's brief facts, the Court's findings, and a brief analysis.

### Facts

- Dream 11’s subsidiary, along with a Singapore-based entity, Digital Collectibles PTE Limited, which operates the website “Rario,” sought interim relief against “Mobile Premier League” and the application “Striker.” Both parties operate similar business models. The suit alleged that the defendants were “minting and distributing” non-fungible tokens (NFTs) that featured images of players with whom the plaintiff had exclusive license agreements.
- The plaintiff claimed that these agreements gave them exclusive rights to mint these tokens. The defendants were accused of infringing these rights and breaching the right of publicity by creating a similar business that used players' caricatures.

### The Intervenors

- WinZO Games Private Limited, a digital gaming and technology company operating the online gaming platform “WinZO”/“WinZO Games.”
- All India Gaming Federation, a not-for-profit society registered under the Societies Registration Act, 1860, representing over 100 members and being the largest and oldest association of online gaming companies in India. They sought to represent the interests of various companies offering online skill-based games/platforms.
- The intervenors aimed to address legal submissions that had broader implications for the gaming industry, particularly for online fantasy sports.

### Relevant Arguments of Plaintiffs

- The plaintiffs relied on cases such as *Titan*, *DM Entertainment*, and *Puttaswamy I*, used *ICC v Arvee* correctly.
- They argued that the sale and trade of NFTs on Striker’s website and mobile application using players’ names, images, and other attributes did not require users to participate in

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<sup>489</sup> *Digital Collectibles Pte Ltd. v. Galactus Funware Technology Pvt. Ltd.*, 2023 SCC OnLine Del 2306, decided on April 26, 2023, Justice Amit Bansal, Delhi HC Single Judge

any fantasy game on Striker. Users could simply trade or sell the NFT Player Cards, and thus the game wasn't of consequence to the "sitting" on unauthorised player images.

#### Relevant Arguments of Defendants

1. The defendants argued that the images and information used in the Online Fantasy Sports (OFS) game were in the public domain and could not be the subject of an exclusive license.
2. They claimed that OFS, by its nature, uses all player information and thus cannot be seen as an endorsement by any particular player.
3. They interpreted the same cases differently and rejected reliance on US cases as they are based on statutes, not common law. (researcher's comment – this is incorrect, as is widely shown throughout this chapter that USA has both statutory and common law misappropriation regimes across different states)
4. They cited the *Fenty* case from the UK to explain the nature of personality rights in India and rejected reliance on *Puttaswamy I*, stating it was irrelevant to personality rights.

#### Arguments of Intervenor

- They argued that the "right of publicity" has no statutory recognition in India and cannot be created by courts based on common law principles. Section 27(2) of the Trade Marks Act, 1999, only recognizes the tort of passing off.
- US case law is based on statutes and recognizes exceptions.
- They claimed the use of names and images was "nominative and descriptive."
- They asserted there was no difference between NFT and non-NFT platforms and that infringement would only arise if officially licensed images were used without consent.
- They argued that *Puttaswamy I* pertains to the right of privacy, not the right of publicity.

#### Court's Observations and Findings

- The court considered all judgments cited by the plaintiffs, including *Haelan*, though there seemed to be a misunderstanding of *Haelan*.
- The court held that the right of publicity is not unrestricted and cannot overshadow the right to freedom of speech and expression, with exceptions for caricature, lampooning, and parodies.
- The court noted that using a celebrity's name and/or image along with data regarding their on-field performances is protected under the right to freedom of speech and expression.

- It was stated that information used by Striker, such as player names and match performance data, is publicly available and cannot be owned by anyone, including the players.
- The court remarked that Striker uses artworks of cricketers and not actual images, which constitutes permissible use.
- Plaintiffs cannot claim exclusive rights over NFT technology. The defendants used NFT technology to ensure security and authenticity of ownership and transactions.
- The court concluded that the digital player cards used by Striker do not suggest any endorsement or association with the player concerned.

### **Researcher’s Comments about the arguments and the ruling:**

#### The Good

- Commercial speech is protected under Article 19(1)(a).
- There was detailed discussion on the right of publicity.
- The right of publicity is not unrestricted – news, lampooning, and satire are protected.
- The court engaged with the “fandom” argument.

#### The Bad

- The court conflated the concepts of passing off and the right of publicity.
- There may have been a flaw in how the plaintiffs structured their claim.
- The defendants conflated OFS with monetized NFTs.
- There was inadequate distinction between *Haelan* and *Titan*.
- The court conflated US statute-based right of publicity with Indian decisions based on common law.

#### The Ugly

- The decision has far-reaching consequences for future discussions on the nature of the right of publicity, especially requiring proof of false endorsement intent.
- The order suggests that any “image” or “information” in the public domain can be commercialized as an NFT.
- The lack of distinction between NFTs to be minted and OFS games undermines the essentials needed to prove a right of publicity action, as established through *Titan*.

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