

Character Merchandising: Right of Publicity and its Relation with Trademark Laws

Kusum Joshi

Assistant Professor, Indore Institute of Law, Indore

Vaidehi Pareek

Assistant Professor, Indore Institute of Law, Indore

Chapter1- Introduction

“I personally think intellectual property is an oxymoron. Physical objects have a completely different natural economy than intellectual goods. It's a tricky thing to try to own something that remains in your possession even after you give it to many others.”

John Perry Barlow

The Intellectual Property is brainchild of human intellect which means that it is the outcome or the result of laborious work done with creativity by the authors, writers, creative people artists and inventors etc. The law is obligated to protect the same that there is no unauthorized use of this creative creation and due recognition is given to the ones who have given in their heart and soul to the work. The law which is used for regulating the creation, its use and authorized exploitation is known as the Intellectual Property Law.

One of the primary branches of this Intellectual Property Law is the Trademark law. A trademark requires a brand, term, or symbol that separates products from other companies' products and services. Branding of products or services through the process gets even smoother with a recognizable mark which can be associated to that particular product, so it is guaranteed and simpler to recognize the product through the trademark. The owner of the trademark can prohibit another rival from using his symbol or a sign. Trademark is a marketing technique that boosts organization funding. A trademark is not necessarily a brand, but a brand is always a trademark. There's a misunderstanding between trademark and brand sometimes. The brand name may be merely a badge or emblem, but in a corporate corporation the trademark is a conspicuous sign or indicator because it has a broader meaning.¹

In recent times, there has been a development of a new concept in the trademark law that is known as 'Merchandising'. Merchandising is the licensing of publicly recognizable properties for use on or in association with products or services to promote sales of those products or services. It is traditionally used to promote and market the core products or the services of the licensor. It has become well known in the fields of motion pictures, sports and events.²

¹Vartika Prasad, *Character Merchandising, Through Trademark Licensing*, IIPRD, (5th February 2021, 9:08 AM) <https://www.iiprd.com/character-merchandising-through-trademark-licensing/>

²RODNEY D. RYDER, *INTELLECTUAL PROPERTY- LAW AND MANAGEMENT*, 125 (Bloomsbury 2018)

One of the most famous way of merchandising is the 'Character Merchandising'. The economic manipulation of a popular character or identity is character merchandising. It really was Walt Disney who designed and created the notion of character apparel and, with Mickey Mouse, Minnie Mouse and Donald Duck in the early half of the twentieth century, started marketing t-shirts, mugs, badges and other items. Ever since, the character's success and goodwill have been tuned into and made the most of by creators of other imaginary creatures and even personalities.³

In this research paper, the researcher has covered the kind of usage of character merchandising, the applicability of trademark laws and regulations upon it. The courts opinion on the cases where character merchandising is in question, this research paper will also discuss the legal basis of claiming merchandising rights in trademark piracy cases, and then introduce past changes and recent trends in administrative/judicial practices and legislative activities associated with protection of merchandising rights in trademark piracy cases.

Literature Review

- **The Limits of the Protection of Alteration and Modernisation of Fictitious Characters by Carl Dominik J. Niedersüß⁴** – The chapter general considerations of the book highlighted the concept of character advertising and reasons for character marketing, the secondary exploitation of a character and the need to adapt are explained in this book by the author at great length. The legal and economic considerations on character Advertisement is also mentioned and the doctrine of dilution and its extension to trademark and character advertising are all explained at great length.
- **What the Right of Publicity Can Learn from Trademark Law by Stacey L. Dogan and Mark A. Lemley⁵**- In this article the author has explained the right to publicity, its moral rights the allocative efficiency and the analogy of the same with trademark laws. This article also throws light on the wrongs like cybersquatting and merchandising and implications of the trademark approach. This paper draws an analogy of right of publicity to the trademark law.
- **The Right of Publicity by Melville B. Nimmer⁶**- In this article the point of research is that how the right of publicity from a secondary right of explanation has become a great method of the revenue generation. In this paper the legal issues relating to the Right of

³ Debleena Ganguly, *India: Character Merchandising*, MONDAQ, (5th February 2021, 9:15 AM) <https://www.mondaq.com/india/trademark/768282/character-merchandising#:~:text=Character%20merchandising%20is%20a%20clever,%2Drecognized%20national%2Finternational%20appeal.>

⁴CARL DOMINIK J. NIEDERSÜß, I DON'T EVEN RECOGNIZE YOU ANYMORE: THE LIMITS OF THE PROTECTION OF ALTERATION AND MODERNISATION OF FICTITIOUS CHARACTERS, 23 (Nomos Verlagsgesellschaft mbH 2015)<https://www.jstor.org/stable/j.ctv941vhq>

⁵Stacey L. Dogan and Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STANFORD LAW REVIEW 1161, 1164-1165 (2006)https://papers.ssrn.com/sol3/papers.cfm?abstract_id=862965

⁶ Melville B. Nimmer, *The Right of Publicity*, 19 LAW AND CONTEMPORARY PROBLEMS 203, 218-219 (1954)https://heinonline.org/HOL/Page?handle=hein.journals/uclalr34&div=52&g_sent=1&casa_token=&collection=journals

Publicity are highlighted. The analysis of core issue along with the core decisions is done in the article.

- **Licensing One's Persona: Analysing The Practice of Personality Merchandising by Raman Mittal**⁷–In this article the difference between sponsorship and licensing and endorsement are explained along with highlighting of issues such as the defamation and dilution are explained. The commercial aspects of the personality licencing is also highlighted in the article.
- **The Merchandising Right:Fragile Theory or Fait Accompli? by Stacey L. Dogan**⁸- In this article the origin of the merchandising rights are explained. The depiction of the merchandising rights and the products are also done. Harm related to broad merchandising rights and the scope of the counterfeiting law is also explained. The functionality and cost of the trademark rights are also explained.
- **Publicity Rights and The Right to Privacy in India bySamarth Krishan Luthra and Vasundhara Bakhru**⁹- This is a comparative study of the right of publicity and its status in India, U.S.A an U.K. This paper also gives suggestions to be incorporated in India for a greater level of protection to be provided in India.
- **The Descendibility of the Right of Publicity: Is There Commercial Life after Death? by Peter L. Felcher and Edward L. Rubin**¹⁰- This paper explains the rights which can be retained by the legal representatives of the personality with the detailed analysis of Elvis Presley case. The use of privacy, defamation and property analogies are also drawn.

Statement of Problem

There has been a practice in the world to follow the lifestyle of the famous personalities and celebrities who are admired by the general public, benefitting from this idea, the character merchandising has gained momentum which means the celebrity licenses his popularity and allows the usage of his fame to market anything. In this field of IPR there are a number of case laws which have come up where there has been a false depiction of association of a personality with the goods, he/she does not intend to endorse.

The rights incorporated with such merchandising can be best associated with image and may be connected with trademark law in IPR. The problem lies whether such rights can

⁷ Raman Mittal, *Licensing One's Persona: Analysing the Practice of Personality Merchandising*, 52 JOURNAL OF THE INDIAN LAW INSTITUTE 16, 18

(2010)[jstor.org/stable/pdf/43953480.pdf?casa_token=XuNUuTmSNvkAAAAA:6Q7HBjQV8tcFpNFYQb1jJf_wvBNkzMLZSDlrdwjS_jZ-](https://www.jstor.org/stable/pdf/43953480.pdf?casa_token=XuNUuTmSNvkAAAAA:6Q7HBjQV8tcFpNFYQb1jJf_wvBNkzMLZSDlrdwjS_jZ-IvQyJz97iIUMp7wqdUI6uKEeYLgixRfJGowps03Ch4I1oa1eCu3E9FpCCsDk0AofTveW0Vg)

[IvQyJz97iIUMp7wqdUI6uKEeYLgixRfJGowps03Ch4I1oa1eCu3E9FpCCsDk0AofTveW0Vg](https://www.jstor.org/stable/pdf/43953480.pdf?casa_token=XuNUuTmSNvkAAAAA:6Q7HBjQV8tcFpNFYQb1jJf_wvBNkzMLZSDlrdwjS_jZ-IvQyJz97iIUMp7wqdUI6uKEeYLgixRfJGowps03Ch4I1oa1eCu3E9FpCCsDk0AofTveW0Vg)

⁸Stacey L. Dogan, *The Merchandising Right: Fragile Theory or Fait Accompli*, STANFORD LAW SCHOOL 1, 22 (2004)https://scholarship.law.bu.edu/cgi/viewcontent.cgi?article=1871&context=faculty_scholarship

⁹ Samarth Krishan Luthra & Vasundhara Bakhru, *Publicity Rights and The Right to Privacy in India*, 31 National Law School of India Review 125,

131(2019)https://www.jstor.org/stable/pdf/26918425.pdf?casa_token=QxXN5zPxxvjgAAAAA:jF2XDmKTFv9_koZvVcPP2RgksyDEOAHX1Dr6JywEbG2rRUNuoFmt0nDfPxw1EGBakvaN7q2dxJZGzZTU-WxYnvymET76DQr_vkA0IU941JvC6dLBj8E

¹⁰ Peter L. Felcher and Edward L. Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life after Death?*, 89 The Yale Law Journal 1120, 1130 (1980)<https://core.ac.uk/download/pdf/160248902.pdf>

be fully covered and guaranteed without a proper dedicated legislation for the same. The area offers a great opportunity in litigation and research but still is not researched.

Objectives of Study

The objectives of this research are:

- to understand the concept of character merchandising and the rights associated therewith.
- to understand the nature of rights involved in character merchandising and the association with trademarks.
- to understand the position of character merchandising in India.

Hypothesis

Character merchandising is a rapidly growing and developing field of Intellectual Property Law which needs to be focused at for the development. Concepts like Right to publicity are important to be developed in a legal system like that of India, where character Merchandising is highly practiced and very popular and protection under trademark law along with a separate legislation development is also required.

Research Questions

- What is the concept of Character Merchandising?
- Whether the rights associated with character merchandising can be associated with Intellectual Property Law and the analogy can be drawn with Trademark Law?
- Whether the rights relating to character merchandising are developed and protected in India?

Chapter-2 Character Merchandising- Licensing the Fame

Character Merchandising & Personality Merchandising are basically the examples of making the most of the popularity which a character or a celebrated personality have amongst the general public and masses. The usage of this fame can be done to sell and market anything, after obtaining the permission of the celebrity or the creator of the character for placing their pictures or anything that can be specifically associated with that character or personality on the merchantable product in an attractive arrangement. The process of recognizing different products and services with a prominent public persona, in order to maximize their marketability is generally known as personality merchandizing. If any imaginary character is being used for the same purpose that exercise is mostly known as character merchandising. The personality permits or 'licenses' his identity that can be used in personality merchandising in conjunction with such products or services in order to boost their reputation in the consumer populace's opinion. The term personality refers to those components or features that make up the external being of an entity and by which an individual is recognized by external parties and can include the title, shortened name, surname, pseudonym, sign, appearance, speech, depiction, look-alike, cartoon, physical characteristics, style of performance, demeanor, gestures. etc.

Character merchandising is a smart marketing strategy in which products and services for enticing consumers are produced close to well-known fictional or even actual characters. In other words, exploiting their well-recognized global presence is a beneficial leveraging of a famous personality. Over time, the prospects of character merchandising have been amplified in so complex ways that what the film community perceives as an ancillary source of commercial violence has become a symbol in terms of sales.¹¹

In one of the famous cases related to character merchandizing *Chorion Rights Limited V. Ishan Apparel and Ors*¹², the appellant, asserted to have been the owner of the fictional character named NODDY's universal copyright and merchandising rights, who was a comic character and had a display that was televised several times each day on the Pogo network under the time frame of Tiny T V who tried to prohibit the defendants from selling merchandise the same under the trade name NODDY. Though the Court agreed the safety from the negative impacts of character merchandising was significant, it held that registered trade mark had been successfully developed by the defendant sometime in 1995, while the complainant's application for registration of the mark dated from 1997. Therefore, while the appellant was the legitimate owner in most jurisdictions of all the marketing rights in NODDY, the defendants were the first party in the country to receive the registration of the trademark. It is an example of merchandising with fictional or animated characters.¹³

Types of Character Merchandising

Character Merchandising is broadly classified into three types, depending upon the character or the person whose popularity is being used to merchandize the product, these categories are as follows:

- (i) **Fictional Character Merchandizing**- Disney Studio (by Walt Disney) pioneered the idea of character merchandising by creating a dedicated department for licensing the privilege to use the animated characters Mickey, Minnie and Donald on multiple brands. Popularity among the individuals of the cartoon characters makes them the most reasonably fit characters ever made. Basically, merchandising with a fictitious character is achieved by putting the items with the name, picture, sound/dialogues. One of the Indian representations is the use of Cadbury chocolates featuring Mickey and Minnie cartoon characters. Another example of character merchandising of fictitious characters like anime is the inclusion of distinct superhero characters on school bags and lunch boxes. A further instance of character merchandising of fictitious characters like anime is the inclusion of distinct superhero characters on back packs and water bottles.¹⁴

¹¹Debleena Ganguly, *India: Character Merchandising*, MONDAQ, (5th February 2021, 9:15 AM) <https://www.mondaq.com/india/trademark/768282/character-merchandising#:~:text=Character%20merchandising%20is%20a%20clever,%2Drecognized%20national%2Finternational%20appeal.>

¹²*Chorion Rights Limited V. Ishan Apparel and Ors*, (2010)ILR 5Delhi481

¹³ *Chorion Rights Limited V. Ishan Apparel and Ors*. (2010) ILR 5Delhi481

¹⁴*Supra note 1*

- (ii) **Personality Merchandising-** Personality merchandising is known as the use of a famous person's identity for marketing goods and services. A well-known individual can be from any field, such as sports, movies, music, etc. The domain from which they belong gives them a characteristic persona that can be seen in conjunction with products and services. This is often known by the name 'merchandising of reputation'. For two factors, celebrity merchandising boosts business: first, individuals will easily identify and react to the product promoted by their favorite star or personality, and secondly, buyers choose to purchase goods that have an image or other association with celebrities.¹⁵
- (iii) **Image Merchandising-** Image merchandising, in the basic sense, uses a fictitious character played by a human in real life. Fictional characters are normally formed in a literary work, and the characters are portrayed by the actors at the time of making cinematographic films from the literary work. In such situations, the person who has played the position is known by such a character. When they see their favorite character from a show, people can connect instantly. Some of the examples are Robert Downy Junior played by Sherlock Holmes and Iron Man, Johnny Depp played by Captain Jack Sparrow, etc.¹⁶

The Legal Issues relating to trademark law involved with Character Merchandising- Rights under trademarks could be subject to the basic characteristics of the character, considering that they meet the conditions of registration. However, since such a character causes the products to be separated from those of others, it becomes, without even registration, a common law trademark. The following features must be specifically specified in the license—

1. Characteristics of a particular character which are being licensed
2. Scope of Exploitation of such character
3. Products and services for which license has been acquired

The main legal issue which may arise in trade mark relating to character merchandising is basically the 'Passing Off'. Intellectual property gives the capacity to license the market value of one's personality. It is analogous to the right to advertising asserted by celebrities to impose false affiliation, that the rule of trademarks may be used by a celebrity to prevent the use of his persona in connection with any object. Under Section 14 of the Trademark Act, some protection is given¹⁷. But still it is not a sufficient safeguard to protect the Rights of the celebrity or the creator of the character and do not give a strong remedy against such wrongs done which relate to a personality of a celebrity or a character.

This will be discussed further in the research paper.

Chapter-3 Rights involved in Personality Merchandising

When the issue is of licensing one's personality arises, it becomes very important to realize that it is not merely a materialistic commodity or a random authorized use of

¹⁵Supra note 1

¹⁶Supra note 1

¹⁷ Trademark Act, 1999, §14, No. 47, Acts of Parliament, 1999 (India)

any article but it is somebody's interest in the name and likeness of a celebrity which should be used very carefully associated with the products and services as any wrong use may tarnish the image of the concerned celebrity very badly.

The right which mainly is concerned with Personality Merchandising is the – 'Right to publicity'.

The "Right to Publicity" which actually is the privilege to advertise grants consumers the authority to regulate, for the advertising purposes, the use of titles and likenesses of the celebrity. Courts have been in existence for years, two facets of this right have failed to make sense - what it means to "commercially," use a title or image, and what elements of the "likeness" of an individual are covered from appropriation. The interpretations of these words have gradually swelled in the absence of any specific legal justification for the right to publicity, to the point at which nearly any reference to a person who gives financial gain to someone else counts as a breach of the right of publicity. The interpretations of these words have gradually soared in the absence of explicit legal justification for the right to publicity, to the stage at which nearly any reference to a person who gives financial gain to someone else counts as a breach of the right of publicity. Around the same time, no meaningful counterpoint to this ever-growing right has been established by the courts. Instead, in situations where the overarching logic of the right of publicity appears to lead to consequences, they deem unjust, they have produced a few exceptions.¹⁸

Relevant concerns for the judiciary have been posed by two kinds of advertising statements. The first includes 'merchandising' claims, in which people argue that their freedom to advertise is infringed not by the use of a brand in advertisement, but by the selling of goods bearing their titles or photos. In particular, judgments have settled these claims by discriminating between, on the one hand, "news" or "speech," and, on the other, "merchandise." But with the the commodification of art and knowledge, this distinction - if it ever made sense - has become increasingly difficult to uphold. There is this another type of questionable argument includes occasions in which an application distracts interest from the celebrity or potentially sullies the image of the celebrity in a manner that damages the overall meaning of her personality. Properly limited, there may be some theoretical appeal to such a cause of action, but courts have interpreted it in ways that transcend any reasonable theoretical framework, especially when concerns of the First Amendment enter the battle.

The passing ability of a case is one root of the problems with these instances. Theoretical argument for media rights. If the government is willing to Courts have a ground on which to specifically define a justification to suppress speech and test if the restraint of expression lives up to its purpose. But because the freedom to advertisement depends on a variety of often sloppy rationalizations, courts have no means to decide whether a clear prohibition of speech is required or even acceptable in order to satisfy the moral purposes of the statute. Instead, they tend to believe that the

¹⁸ Samarth Krishan Luthra & Vasundhara Bakhrui, *Publicity Rights and The Right to Privacy in India*, 31 National Law School of India Review 125, 131(2019)

amount of a series of insufficient justifications is much greater than its components and causes commercial statements to sustain the basic interests of public.

If another dilemma was generated by the lack of a justification, then the solution is to decide whether and when a publicity right could serve a valid purpose Interest from the state. Yet a study of the cases and literature indicates that no one appears to be able to clarify precisely why this right should be granted to persons. A right to privacy does not justify it, since in a wide variety of circumstances that do not suggest privacy at all, the right of publicity has been implemented. A natural or moral right to ownership over one's name or likeness has been suggested by some commentators, but there seems to be little political rationale for granting such control, and the lack of such a right in much of the world and indeed deeds can make one wary of arguments founded on any moral assumption of majority in much of United states history. The legal argument of possessing the use of one's name often tends to be inconsistent with the lack of validity for other kinds of intellectual property (IP) in the United States for natural or moral rights. Of late, and notably in merchandising cases, in an effort to explain and define the right to publicity, courts and critics have looked at trademark law. In the affirmative line, they argue that the opportunity-based logic of trademark law recognizes the right of publicity.¹⁹

The property of an individual is the extension of his personality. This was stated out by Hegel and is generally referred to as the Hegelian intellectual property rights rationale. An individual is entitled to advertise, also referred to as personality rights, is the right to regulate the commercial use of his or her name, portrait, likeness, or other unambiguous facets of his or her identification. Usually, the components composing the right to advertise are referred to as 'identity, appearance and likeness.' This triumvirate ranges from country to country.

Globally, the right of an individual to authorize or pass a company's worth of one's personality is embedded in the case law that treats the right of publicity as a right to property. The right to publicity arises as an extraordinarily important right in diverse countries, divorced from any of the restrictions of conventional trademarks and anti-competitive acts, such as the possibility of misunderstanding by buyers or the demand that the parties to the case work in the same fields of operation.

In the case of *Bi-Rite Enterprise v. Button Master*²⁰, the right to publicity was held to grant an individual an exclusive right to control, without permission, the commercial value of his name and likeness and to prevent others from exploiting that value. The right to publicity is available to human beings only and not to non-living entities.²¹

The privilege of using the identity of the celebrities is becoming a valued trade culture in the marketplace. An individual's right to monitor this precious value commodity, i.e. occasionally his right over his personality is related to as the "Right of publicity." The renowned writer and academician Melville Nimmer, who is also an IP scholar, when he

¹⁹ Stacey L. Dogan, *The Merchandising Right: Fragile Theory or Fait Accompli*, STANFORD LAW SCHOOL 1, 22 (2004)

²⁰ *Bi-Rite Enterprise v. Button Master*, 555 F. Supp. 1188

²¹ *Id* at 20.

wrote a paper on "The right of Publicity" firmly defended the right to advertise. Following are his view quoted in the research paper written by him-

*"The right of publicity must be recognised as a property (not a personal) right, and and subsequent enforcement by the assignee. Furthermore, appropriation of publicity values should be actionable regardless of whether the defendant has used the publicity in a manner offensive to the sensibilities of the plaintiff. Usually, the use will be non-offensive since such a use is more valuable to the defendant as well as to the plaintiff. Likewise, the measure of damages should be computed in terms of the value of the publicity appropriated by the defendant rather than, as in privacy, in terms of the injury sustained by the plaintiff. There must be no waiver of the right by reason of the plaintiff being a well-known personality. Indeed, the right usually becomes important only when the plaintiff (or potential plaintiff) has achieved in some degree a celebrated status. Moreover, since animals, inanimate objects, and business and other institutions all may be endowed with publicity values, the human owners of these non-human entities should have the right of publicity (although not a right of privacy) in such property, and this right should exist (unlike fair competition) regardless of whether the defendant is in competition with plaintiff and regardless of whether he is passing off his own products as those of the plaintiff"*²²

In our country, as an independent civil right, the right to publicity is yet to grow. The right is also a part of the different legal doctrines mentioned below, such as anonymity, slander, trademarks, copyright and unfair competition. Depending on the circumstances of the situation, recourse to any of these rules may be made in the event of improper use of a celebrity's identity.²³

In our Country, unlike the United Kingdom, there is not a separate statutory legislation ensuring the right of publicity for a person. Under the legal system, It was the tort of passing off, this right was primarily applied in India to determine that (a) the contested mark had goodwill and prestige, (b) there was misinterpretation of the mark causing a possibility of misunderstanding and (c) there was real injury or possibility of loss. In most cases, the enforcement of this privilege will unintentionally rely on economic use of the plaintiff's mark to demonstrate 'reputation,' essentially mitigating that the identity of a commoner will not be defensible underneath the law of passing off. While the first cases acknowledging a right to publicity focused on prohibiting the unlawful use of the "name or likeness" of a person, the scope of defense has greatly increased. The boundaries of "likeness" are wide today. Courts now understand that a celebrity has a valid exclusive interest in his identity and that, even though he does not use the name, portrait or photo of the celebrity, a defendant may breach this privilege. The growing right to publicity offers the ability for famous personalities to exploit their identities for huge profits.

This is especially true in ads, where even the sponsorship of a good or service by a personality will draw customer interest, bring prestige or reputation to the brand and,

²² Melville B. Nimmer, *The Right of Publicity*, 19 LAW AND CONTEMPORARY PROBLEMS 203, 218-219 (1954)

²³ *Id.* At 22.

very significantly, improve the revenues of the promoted good or service. Statements from well-known celebrities have "stronger appeal to the purchasing public than other types of advertising" They also increased desired sales of the supported goods and services. Since the law considers the name of a celebrity as land that he may use, lend or rent for profit to others, the person should not be able to use his property with immunity or in a way detrimental to others, including all property owners.

A corresponding obligation to withdraw from exercising the right to the disadvantage of others can be added, together with acceptance of the exclusive privilege to one's name. this right "has commercial value only because the law has granted him the exclusive right to deal in the marketplace with his name, picture or opinion".

Chapter-4 Drawing an Analogy of Right to Publicity with Trademark Law

The right to publicity even after being the most appropriate and necessary right to be conferred upon the celebrities for enabling them to license their name to be associated with merchantable products, still lack a proper definition with full explanation and understanding in several legal systems. Many attempts have been there to explain the Right of Publicity in relation to the moral rights, industrial design, incentives and efficiencies, still there has been no apt definition of the same. Right to publicity can be connected in the best way with the trademark law, the case laws concerning the right to publicity can be coherently understood and an analogy may be drawn which is better than any other branch of Intellectual property law because this particular right is not interested in creation of a new property which in one way or the other is subject to protection under the intellectual property laws. In fact, it is more concerned with the bundle of rights arising out of usage of one's name and likeness with a particular product or services. Both the theories are concerned with the commercial usage and at the same time the protection of such usage. The connection of the product and service with the name it is being associated to. So, it can be put in such a manner, "The structure and content of trademark law provide a theoretical justification for a bounded right of publicity."²⁴

Trademark legislation is meant to preserve the dignity of the definition of a label by means to restrict the use of a symbol that confuses customers or, in the case of popular labels, uses that mess with the mental connection of customers between the mark and the name. The aim also tends to be a legal reason for the right to advertise. When viewers are fooled by the use of a name or likeness of a person, they are hurt as well as the celebrity. Provided that the only individuals who profit do so through deception, such usage almost inevitably causes a net social loss.

In addition to a justification to defend ads, the trademark comparison offers freedom, but still a means to grasp the constraints of such rights. Getting a logical, concise description of the right to publicity and the elaboration of that explanation by an existing body of case law helps one to evaluate the components, limits and reach of the right to publicity against such an existing benchmark. If the justification for the right to

²⁴5. Cf ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 924

publicity is based on a related trademark claim, it is possible that the factual scope of that claim should also be tracked by the trademark claim.

In a variety of marketing rights lawsuits, in an ad, a claimant used the name, picture, or appearance of a personality in a manner that indicated to audiences that perhaps the celebrity promoted the brand in some manner, or at least charged to offer the item its name. Therefore, in *Midler v. Ford Motor Co.*²⁵, Ford hired an impersonator for his commercial to imitate the singing style of singer Bette Midler. Midler, who declined to promote goods or lend her songs to ads as a point of principle, filed for violation of her right to publicity.

The court decided the case in her favour, primarily because the defendant obtained a competitive advantage by enticing buyers into thinking that she had approved their goods. Several other advertisement rights also take this shape - *Waits v. Frito-Lay*²⁶ and *Motschenbacher v. R. J.*²⁷ Reynolds, for one. A few courts have progressed above and beyond to indicate that this is the fundamental principle behind the right of advertising : "The basis of a right of publicity claim concerns the message - whether the plaintiff endorses, or appears to endorse the product in question."

Market misunderstanding justifies the existence of the right to publicity only for the benefit of the point that market uncertainty currently remains. When an accused uses a name or likeness of the star in a manner that evokes her name but does not mislead customers, there can be no excuse. Regrettably, judges in advertisement law cases usually do not question if customers are genuinely confused. Cases of advertising seldom contain polls, for instance. In this method, a large segment of the rule of advertising cases, and even a subset of endorsement cases, finds little reason.

In the lack of any potential market misunderstanding, the right to publicity has been extended to "endorsement deals" like *Carson v. Here's Johnny Portable Toilets*²⁸, in which the respondent used Johnny Carson's tag line "Heeeeere's Johnny!" for a portable toilet; Spike Lee's successful suit against Viacom ordering the use of the name "Spike TV"; and *White v. Samsung*²⁹, where the defendant used a portable toilet; There is no doubt that in each of these cases, the defendants tried to invoke the complainant in the eyes of their potential buyers, and their ideas are likely to have worked. Yet it is highly doubtful that anybody was misled or thought the usage had been accepted to by the personality.

Some examples are nearer. For starters, in *Motschenbacher*, the defendant was using a photo of the car of automotive racing Lothar Motschenbacher in his cigarette advertisement. Although the facts showed that the vehicle was identifiable as his, it is far from obvious that a significant number of customers would believe that in that case he had endorsed the product solely because in a commercial an image of his car existed. It's not difficult for them to do so, but in order to determine what the right to

²⁵Midler v. Ford Motor Co., 849 F.2d 460

²⁶Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992)

²⁷Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974)

²⁸Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983)

²⁹White v. Samsung Elecs. Am., Inc., 989 F.2d 1512

publicity could extend, we would like to understand what exactly the customers were thinking, much as we would like to know in a patent case posing the very same false endorsement concept.

As in the normal trademark situation, the necessity of uncertainty constitutes a significant restriction on this justification for the right to publicity. For eg, this justification would not necessarily explain a postmortem right to publicity. Other justifications would need to be sought by complainants who want to avoid non-confusing uses. Sadly, in these situations, the inability of advertisement, courts to specifically recognize the justification of uncertainty causes them to depart from regularly imposing this criterion. The consequence is that several persons bring cases along the lines of *Vanna White's*, arguing that there is no misunderstanding but just acknowledgment.³⁰

However, the arguments could be similar to the latest transformation in several cases of "initial-interest confusion" to render any appeal of interest using a trademark unauthorized. This extension has been criticized; for now, the similarities among not just the valid facets of trademark law and the endorsement-based right to advertise cases, as well as between overenthusiastic trademark judgments and passion for the right to publicity cases are worth mentioning. Trademark courts have recently eliminated the initial uncertainty of interest, and the same should be done by the courts deciding cases on "Right of Publicity".

Thus, from these cases it can be drawn that like in cases of trademark there is a likelihood of conclusion may arise in relation to the usage of deceptively similar marks, similar situation may arise in case of 'personality merchandising' or false representation of a celebrity being in connection of the particular good or service.

Trademark rules are innate in fact and they are only related to products or services, but nothing beyond that. They lack the assets of merchandising. For example, trademark laws will not be allowed to cover the concept as a whole and in entirety in the event of any violation, this will only safeguard the section where even the character/celebrity is associated with the goods or utility. In *Chorion Rights Ltd. v. Ishan Apparel & Ors*³¹, the appellants have operations around the world pertaining to Noddy's merchandized character. The Defendants, on the other hand, have already licensed their trademark of the same name as Plaintiff in front of them and are involved in the textile industry. The Complainant brought a complaint against the defendant, but the Court ruled that the injunction could not have been issued because the Plaintiff was unable to make the argument that it was a former consumer and had already been registered by the defendant. It was decided that "if a trademark owner chooses to go into merchandising, he must, in order to have additional protection, properly protect his mark for the related products and services."

There is absolutely no intrinsic right to become the only one who trades on the value of a trademark to make money. In multiple cases where the defendant profits from access to the mark of the victims, the statute requires such "free riding" as long as the usage

³⁰*Id.* at 29.

³¹*Chorion Rights Limited V. Ishan Apparel and Ors.* (2010) ILR 5Delhi481

does not increase customer search costs. The doctrinal situation does not pay any better. As we have seen elsewhere, the courts are at best equally divided as to whether, in the absence of market uncertainty, a merchandising privilege still exists and are even more uncertain of its existence. Merchandising even in courts of law is expected to get a much colder welcome as the main focus of the courts is generally upon the core values relating to trademark law the least focus on rights relating to publicity might arise in context of generalized rights and can go further.

In the case of *Guglielmi v. Spelling-Goldberg Prods*³² it was held that claimants for the right do not only wish to prohibit the use of their names and photographs in commercial advertising that may unfairly indicate endorsement or obscure the association between the identity and the person. Instead, they strive to monitor the use for advantage of their name or picture or any other part of their "personality" even though the desire is to represent the complainant in an artistic or new style.³³

In the case of *Montana v. San Jose Mercury News, Inc.*, the court rejected a right of publicity claim by football player Joe Montana only because the defendant's use was a reproduction of a newspaper page, and newspapers were entitled to special protection.³⁴

It would seem ill advised, considering the limitations of the merchandising principle in trademarks disputes, to base too much of the right to publicity on an extended version of the right to merchandise.

Chapter 5- Right to Publicity in relation to Character Merchandising and its Position in India

A registered trademark owner can prohibit the use of deceptively similar or highly identical trademarks by others without the permission of the trademark owner under section 29 of Trademark Act, 1999. By filing their character as a trademark under the Trademark Act 1999, the creators or owners protect their rights and the prestige attributed to the character. The trademark owner has the sole right to associate the trademark with the products and services to be sold. Unauthorized use of such a trademark resulted in a violation of the owner's contractual rights³⁵.

Mostly in situation of an unregistered trademark, by ensuring that the trademark has a credibility, misinterpretation by the third party and the damage faced by the rights holder, the owner may launch an action to transfer off to protect the rights. Under the trademark act, celebrities are entitled to shield their identities. Celebrities have protected their names through registration, such as Beyonce, JayZ, Justin Bieber, Kaylie Monique, etc. In India, Sanjeev Kapoor has a registered trademark, 'Sanjeev Kapoor Khazana'. KHILADI" was registered as a trademark by Akshay Kumar on the basis of his series of films called the "Khiladi" series. Not just actors, but Sachin Ramesh Tendulkar has his 'SRT' initials protected. In order to shield their name and reputation and

³² Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454

³³ Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454

³⁴ Montana v. San Jose Mercury News, Inc, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995)

³⁵ Trademark Act, 1999, §29, No. 47, Acts of Parliament, 1999 (India)

monetize their fame, other celebrities such as Kajol, Shah Rukh Khan, Sunny Leone, Sanjeev Kapoor and Amitabh Bachchan have also joined the movement in protecting their names through the registration as trademarks.

As far as right to Publicity is concerned, it should be noted that there is an absence of separate legislation governing the same and it is also not developed through the availability of precedents on the subject.

It may be said that neither the legislature nor the judiciary has thought of development of this particular very important right in India but still the inference of available remedies may be drawn from various other sources:

- (1) **The Constitution of India, 1950**- The right to publicity is an integral part of the right to privacy secured by Articles 19³⁶ and 21³⁷ of the Indian Constitution. The right can be exercised by a writ issued by the court against government violation of the right to privacy of a person. Under the Constitution, the right to publicity can be imposed only against the state and would be hard to impose against a citizen, but this remedy is not enough as the same cannot be enforced against the private individuals. So, it is not a very effective remedy or course to be taken for enforcement of this right.
- (2) **The Trademark Act, 1999**- Section 14³⁸ of the Trade Marks Act 1999 states that, where an application has been submitted for recognition of a sign indicating a relation with any living individual or individual who has died 20 years before the date of filing of the application, the registrar of the marks may request the applicant to obtain the permission of the living human or the permission of the descendants of the dead individual and may decline to approve the registration of the applicant. Therefore, under the TMA, without the permission of the celebrity or his or her successor, a person cannot register a trademark relating to a celebrity (living or dead). In addition, the use of the name of a celebrity as part of a domain name will also be limited as per the provisions of TMA.³⁹

The right of publicity will be enforced by filing a civil law suit. Court that is qualified to prosecute the case. The case may, at the discretion of the appellant, be brought before a court within the jurisdiction of which the defendant lives or carries on business or a court within the jurisdiction of which the cause of action has arisen. In addition, before the action is launched, the pecuniary authority of the court must be taken into account.

There is no law on the purpose and duration of the applicability in India of the right of publicity. The Delhi High Court noted that only a person or any hint of the personality of a person will inherit the right to publicity. An person alone is thus entitled to benefit from the right to publicity. In addition, the right to advertise is inheritable and can also be passed to the legal representatives of the deceased after his or her death, but there is currently no clear statute or case law in India to justify this.⁴⁰

³⁶INDIA CONST. art. 19

³⁷INDIA CONST. art. 21

³⁸Trademark Act, 1999, §14, No. 47, Acts of Parliament, 1999 (India)

³⁹Diganth Raj Sehgal, *Prerequisites for delving into character merchandising*, IPLEADERS (5th February 2021, 12:12 PM) <https://blog.ipleaders.in/prerequisites-delving-character-merchandising/>

⁴⁰ ICC Development (International) Ltd v Arvee Enterprises, 2003 VIIAD Delhi 405

Shivaji Rao Gaikwad (aka Rajinikanth) v. Varsha Production⁴¹- *"The Court denied the defendant's plea that the case of the appellant should be dismissed on the basis that there is no concept of "Personality Right" and no law in India acknowledges this specific property right. "The Court noted that "although there is no definition of the right to personality under any law in India, in different judgments the courts in India have recognised the right to personality in the term." Therefore, an injunction was passed by the Court against the defendants to use the name/image/caricature/style of the claimant to deliver dialogues in their forthcoming project/film."*

TITAN Industries vs. M/s Ramkumar Jewellers⁴²- The court in this case formulated the validity and identifiability test to check unauthorized use of one's personality, It was held that *"No one was free to trade on another's name or appearance and claim immunity."*

A passing of case can also be filed against the infringer of the right, who without the permission of the right holder tries to associate the personality to the goods or services he has not licensed the use of his name or likeness. In some cases, the defamation suit may also be incorporated.

It must be noted that a lot of issues remain unanswered in absence of a specific statute to deal with the disputes that may arise out of the issues relating to character merchandising and the Right to publicity at large.

Conclusion

Character merchandising is described by the producer of the fictitious character or by one or more approved private entities as an alteration or supplementary exploiting. This manipulation relates to the character's important personality traits such as name, logo or appearance and is done to establish a connection between the goods and such personality characteristics in order to create an urge in the minds of consumers to purchase such item or use such service due to the attachment of the consumer to the character.

Whenever character merchandising is talked about there arises a question of rights which are there with the person whose name and likeness are being used for the promotion of the merchantable product or services, these rights can be specifically identified as Right to publicity.

Rights related to Publicity are separate rights that can only attract more popularity in the near future when the principle has now become known to a vast list of celebrities. The Judicial system of India has also started acknowledging these protections as part of the right to privacy, but it is time for the legislature to identify and devise a legislative legislation to fill the void with the economic and property rights component of it.

It is essential to inspect the existing rules from a new perspective and create a better direction that will be beneficial to the personalities who can experience the fame with no challenge as well as to the developers who, after spending their time, effort, and imagination in it, can bring the most out of their work. In such a scenario, if we do not

⁴¹Shivaji Rao Gaikwad (aka Rajinikanth) v. Varsha Production, 2015 (62) PTC 351 (Madras)

⁴² TITAN Industries vs. M/s Ramkumar Jewellers, 2012 (50) PTC 486 (Del)

have any clear laws, we can create a Guide for Dispute Settlement to decide the answer to these situations. It is essential to create a balance between the interests of the individual rights and the conservation of market competition.

This field of Intellectual property law has a lot of scope for development because, this right is an interesting interplay of personal, moral and economic rights of an individual. Along with landmark judicial decisions there is also a need of a specific legislation to answer a number of technical and non-technical issues which are necessary to address any infringement of these rights.

It is also evident that on one hand where it can be held that an analogy of the right to publicity may be drawn with Trademark Laws on the same time there are certain issues of merchandising, which if covered, would lead to an unreasonable expansion of the law. All these observations make it obvious that a whole field of intellectual property law is unexplored and a vast ground for effective litigation and development is there in the form of these celebrity rights which need to be systematically grown and developed in India.

Bibliography

Books & Articles

1. Debleena Ganguly, India: Character Merchandising, MONDAQ, (5th February 2021, 9:15 AM) <https://www.mondaq.com/india/trademark/768282/character-merchandising#:~:text=Character%20merchandising%20is%20a%20clever,%2Drecognized%20national%2Finternational%20appeal.>
2. CARL DOMINIK J. NIEDERSÜß, I DON'T EVEN RECOGNIZE YOU ANYMORE: THE LIMITS OF THE PROTECTION OF ALTERATION AND MODERNISATION OF FICTITIOUS CHARACTERS, 23 (Nomos Verlagsgesellschaft mbH 2015)
3. Stacey L. Dogan and Mark A. Lemley, What the Right of Publicity Can Learn from Trademark Law, 58 STANFORD LAW REVIEW 1161, 1164-1165 (2006)
4. RODNEY D. RYDER, INTELLECTUAL PROPERTY- LAW AND MANAGEMENT, 125 (Bloomsbury 2018)
5. Melville B. Nimmer, The Right of Publicity, 19 LAW AND CONTEMPORARY PROBLEMS 203, 218-219 (1954)
6. Raman Mittal, Licensing One's Persona: Analysing the Practice of Personality Merchandising, 52 JOURNAL OF THE INDIAN LAW INSTITUTE 16, 18 (2010)
7. Stacey L. Dogan, The Merchandising Right: Fragile Theory or Fait Accompli, STANFORD LAW SCHOOL 1, 22 (2004)
8. Samarth Krishan Luthra & Vasundhara Bakhru, Publicity Rights and The Right to Privacy in India, 31 National Law School of India Review 125, 131(2019)
9. Peter L. Felcher and Edward L. Rubin, The Descendibility of the Right of Publicity: Is There Commercial Life after Death? 89 The Yale Law Journal 1120, 1130 (1980)

Web sources & Blogs

1. Vartika Prasad, Character Merchandising, Through Trademark Licensing, IIPRD, (5th February 2021, 9:08 AM) <https://www.iiprd.com/character-merchandising-through-trademark-licensing/>

2. Debleena Ganguly, India: Character Merchandising, MONDAQ, (5th February 2021, 9:15 AM) https://www.mondaq.com/india/trademark/768282/character-merchandising#:~:text=Character%20merchandising%20is%20a%20clever,%2Drecognized%20national%2Finternational%20appeal_
3. Diganth Raj Sehgal, Prerequisites for delving into character merchandising, IPLEADERS (5th February 2021, 12:12 PM) <https://blog.ipleaders.in/prerequisites-delving-character-merchandising/>

Cases

1. Chorion Rights Limited V. Ishan Apparel and Ors, (2010)ILR 5Delhi481
2. Bi-Rite Enterprise v. Button Master, 555 F. Supp. 1188
3. 5. Cf ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 924
4. Midler v. Ford Motor Co., 849 F.2d 460
5. Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992)
6. Motschenbacher v. R. J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974)
7. Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983)
8. White v. Samsung Elecs. Am., Inc., 989 F.2d 1512
9. Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454
10. Montana v. San Jose Mercury News, Inc, 40 Cal. Rptr. 2d 639, 643 (Ct. App. 1995)
11. ICC Development (International) Ltd v Arvee Enterprises, 2003 VIIAD Delhi 405
12. Shivaji Rao Gaikwad (aka Rajinikanth) v. Varsha Production, 2015 (62) PTC 351 (Madras)
13. TITAN Industries vs. M/s Ramkumar Jewellers, 2012 (50) PTC 486 (Del)