

Legal Issues in 'IP in Fakes, Forgeries & MockUps'

Issue: Is There a Threshold for Enforcement of Personality Rights Against Third Parties?

Relevant Legal Provisions

❖ Trade Marks Act, 1999 –

• Section 2(m) –

*““mark” includes a device, brand, heading, label, ticket, **name**, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;” [Emphasis supplied]*

• Section 14 –

*“Use of names and representations of living persons or persons recently dead.— Where an application is made for the registration of a trade mark **which falsely suggests a connection with any living person, or a person whose death took place within twenty years prior to the date of application for registration of the trade mark, the Registrar may, before he proceeds with the application, require the 14 applicant to furnish him with the consent in writing of such living person or, as the case may be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnishes the Registrar with such consent.**” [Emphasis supplied]*

Relevant Legal Provisions (Contd.)

- **Section 35 [Contd.] –**

*“Saving for use of name, address or description of goods or services.— Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use **by a person of his own name** or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.” [Emphasis supplied]*

- ❖ **Copyright Act, 1957 –**

- **Section 2 (d) –**

“author” means, — (i) in relation to a literary or dramatic work, the author of the work; (ii) in relation to a musical work, the composer; (iii) in relation to an artistic work other than a photograph, the artist; (iv) in relation to a photograph, the person taking the photograph; 2 [(v) in relation to a cinematograph film or sound recording, the producer; and (vi) in relation to any literary, dramatic, musical or artistic work which is computer-generated, the person who causes the work to be created;]

Relevant Legal Provisions (Contd.)

- **Section 2 (qq) –**

*““performer” includes an **actor**, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance;]” [Emphasis supplied]*

Relevant Case Laws

- ❖ ***Amitabh Bachchan v. Rajat Nagi* [CS (COMM) 819/2022, Delhi High Court, Order dated November 25, 2022]**
 - 20. *“It cannot seriously be disputed that the plaintiff is a well-known personality and is also represented in various advertisements. The plaintiff is aggrieved by the defendants’ **unauthorized use** of his celebrity status to promote their own goods and services, without his permission or authorization.”*
 - 21. *“Having considered the contents of the plaint, the documents filed therewith, as also having heard the learned senior counsel for the plaintiff, I am of the opinion that the plaintiff has been able to make out a good prima facie case in its favour for grant of an ad-interim ex-parte injunction. The balance of convenience is also in favour of the plaintiff and against the defendants. The defendants appear to be using plaintiff’s celebrity status for promoting their own activities, without his authorization or permission. The plaintiff is, therefore, likely to suffer grave irreparable harm and injury of his reputation. In fact, **some of the activities complained of may also bring disrepute to him.**” [Emphasis supplied]*

Relevant Case Laws (Contd.)

❖ ***Titan Industries Ltd. v. Ramkumar Jewellers* [CS (OS) No. 2662/2011, Delhi High Court, Decided on April 26, 2012]**

- *“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.”*
- *“This right might be called a ‘right of publicity’. For it is common knowledge that many prominent persons (especially actors and ballplayers), 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.”*

“II. ‘Publicity right’ of a Celebrity

- *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 commercialize their identity but that the right to control when, where and how their identity is used should vest with the famous personality.” [Emphasis supplied]*

Relevant Case Laws (Contd.)

- ❖ ***Titan Industries Ltd. v. Ramkumar Jewellers* [CS (OS) No. 2662/2011, Delhi High Court, Decided on April 26, 2012] [Contd.]**

“The right to control commercial use of human identity is the right to publicity.”

III. The basic elements comprising the liability for infringement of the right of publicity:

Validity: The plaintiff owns an enforceable right in the identity or persona of a human being.

Identifiability: The Celebrity must be identifiable from defendant's unauthorized use.

Infringement of right of publicity requires no proof of falsity, confusion, or deception, especially when the celebrity is identifiable. The right of publicity extends beyond the traditional limits of false advertising laws.

IV. Methods of proving identification of the Plaintiff

- *If the plaintiff is very well known and widely recognized 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.*
- *“...the hoardings of the defendant clearly show Mr. Amitabh Bachchan and Mrs. Jaya Bachchan, being an exact replica of the plaintiff's own hording advertising its Tanishq Diamonds with Mr. Amitabh Bachchan and Mrs. Jaya Bachchan.” [Emphasis supplied]*

Relevant Case Laws (Contd.)

- ❖ ***Titan Industries Ltd. v. Ramkumar Jewellers* [CS (OS) No. 2662/2011, Delhi High Court, Decided on April 26, 2012] [Contd.]**

V. Other methods of proving significant identification:

- 1. Evidence of a number of elements in the context of defendant's use which add up at a geometric rate to point to the plaintiff.*
- 2. Direct or circumstantial evidence of the **defendant's intent to trade upon the identity of the plaintiff, from which identifiability can be presumed.***
 - The liability of infringement by the defendant is based on the identifiability of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan from the defendant's advertisement which is the exact replica of the plaintiff's advertisement being the proof of identifiability.*
 - The defendants use of the personality rights of Mr. Amitabh Bachchan and Mrs. Jaya Bachchan in its advertisement itself contains a clear message of endorsement and the message is false and misleading. Further, since Mr. Amitabh Bachchan and Mrs. Jaya Bachchan are clearly identifiable there would be an infringement of the right of publicity for it is not tied down to any proof of falsity. **The right to publicity extends beyond the traditional limits of false advertising laws.** [Emphasis supplied]*

Relevant Case Laws (Contd.)

- ❖ ***DM Entertainment Pvt. Ltd. v. Baby Gift House* [CS (OS) No. 893/2002, Delhi High Court, April 29, 2010]**
- *“To avail the right against the infringement of right to publicity, the plaintiff must be **“identifiable”** from defendant's unauthorized use. In this instant case, the evidence on record very well establishes **the primary requirement**. 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**. The right of publicity **protects against the unauthorized 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 i.e. doll.” “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.** [Emphasis supplied]*

Relevant Case Laws (Contd.)

- ❖ *DM Entertainment Pvt. Ltd. v. Baby Gift House* [CS (OS) No. 893/2002, Delhi High Court, April 29, 2010]
 - *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.*”
 - *“An individual claiming false endorsement must prove that the use of the identity likely misled consumers into believing the concerned personality endorsed the product at issue. In this case, it has been seen that the use of Mr. Mehndi's persona for the purpose of capitalizing upon his name by using its conjunction with the commercial product is not proper or legitimate; it amounts to a clear dilution of uniqueness of such personality and gives rise to a false belief that, plaintiff has either licensed or the Defendants have some connection with them (i.e. the plaintiff or the artist), to use its exclusive right to market images of the artist.*
 - 16. *“In a passing off action, one has to see as to whether the Defendant is selling goods/service so marked to be designed or calculated to lead purchasers to believe that they are plaintiff's goods. Even if a person uses another's well-known trademark or trade mark similar thereto for goods or services that are not similar to those provided by such other person...”* [Emphasis supplied]

Relevant Case Laws (Contd.)

- ❖ *DM Entertainment Pvt. Ltd. v. Baby Gift House* [CS (OS) No. 893/2002, Delhi High Court, April 29, 2010] [Contd.]
 - “....although it does not cause confusion among consumers as to the source of goods or services, it may cause damage to the well-known trade mark by reducing or diluting the trademarks power to indicate the source. **Further, where a person uses another person's well-known trade mark or trademark similar thereto for the purpose of diluting the trade mark, such use does not cause confusion among consumers but takes advantage of the goodwill of the well-known trade mark, it constitutes an act of unfair competition.**”
 - “In view of the above findings, it is clear that the plaintiff has also established its case for passing off. The evidence of the plaintiff has gone un-rebutted which includes loss of business, reputation and goodwill in the market.” [Emphasis supplied]

Relevant Case Laws (Contd.)

- ❖ ***Christian Louboutin SAS v. Nakul Bajaj* [CS (COMM) 344/2018, Delhi High Court, November 2, 2018]**
 - *“As per the plaint, the goods of the Defendants are impaired or are counterfeits. Apart from offering for sale and selling the Plaintiffs products, on the website of the Defendants, **the image of the founder of the Plaintiff is also used, and the names ‘Christian’ and ‘Louboutin’ are also used as meta-tags.** By using these meta-tags, the defendants attract traffic to their website.*
 - *According to the Plaintiff, the Defendants' website gives an impression that it is in some manner sponsored, affiliated and approved for sale of a variety of luxury products bearing the mark of the Plaintiffs genuine products. This results in infringement of the trademark rights of the Plaintiff, **violation of personality rights of Mr. Christian Louboutin** and dissolution of the luxury status enjoyed by their products and brands.” [Emphasis supplied]*

THANK YOU!

Questions?

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