

Status of Celebrity Marks in India

Dr. Ranjana Ferrão*

1. Introduction

A CELEBRITY is a person who is widely recognized in a given society and commands a degree of public and media attention. A person can be said to be a celebrity when he is popular in public eye. Famous people who are in constant spotlight in public, be it actors, sports persons, singers are asked to lend their name for promoting a wide range of products and services. The use of the celebrity's name captures the public's attention, sparks curiosity and creates interest in the products and services. In ancient times Queens and Popes were asked to endorse patent medicines.¹ This technique has never failed. No wonder, companies and manufacturers do not shy away from using celebrities to launch and market their products. The use of a celebrity in an advertisement may help to breathe life into a product². Many companies, however, are using celebrity names without their consent to promote their products. Hence IP experts suggest celebrities to protect their image rights by getting registered under the Intellectual Property laws. This paper is a small attempt to provide an overview about the status of celebrity marks in India.

2. Definition of Celebrity

The Intellectual Property Laws in India do not define the term 'celebrity'. However, the Indian Copyright Act defines the term "performer"³ which given a broad interpretation may include the term "celebrity" within its ambit. A 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'. Section 38 of the Indian Copyright Act gives special rights to performers. This is not a complete definition. Celebrities can be rightly defined as people who enjoy public recognition by a large share of a certain group of people. Hence, a performer is not always a celebrity and a celebrity is not always a performer. Attributes like attractiveness, extraordinary lifestyle or special skills are a few examples and specific common characteristics that are observed in celebrities generally. The term *celebrity* refers to an individual who is known to the public for his or her achievements.

3. Commoditization of Product

Companies invest significant amount of money in creating a product. They work very hard on creating a brand. To set an image for the product companies hire endorsers with qualities such as attractiveness, likeability and trustworthiness. To sell the product they try and advertise the product on all kinds of media from television to print and the social media. There are around 130 television channels in India broadcasting around 3 million television commercials each year. This provides a huge choice to the consumers. It can also create confusion in the minds of the consumer as to which product to buy and which product to reject. Consumers also tend to forget the names of the 80% products in just 24 hours. To deal with this problem, Indian companies have found the perfect solution of using 'Celebrity Endorsement' to create awareness about their products.⁴

For the company it is easy to choose a celebrity to market the product. For the consumer, it is difficult to establish an association between the product and the endorser. Since celebrities have a huge influence on the common man's life people tend to buy such products marketed by celebrities. The common man feels the product is a status symbol. It helps increase the recall value of the product. For the celebrity, endorsing products increases his celebrity quotient.

In India, the most sought after celebrities are film actors. In 2015, Forbes India conducted a survey which

*Assistant Professor, V.M. Salgaocar College of Law, Miramar, Goa

¹ Marketing with celebrities: How to use Celebrities in Advertising available at <http://www.marketing-schools.org/consumer-psychology/marketing-with-celebrities.html>. (Last Accessed on May, 2016).

² R. S. Demand, "What Are Five Advantages to Using Celebrities in Advertising?" Available at: <http://smallbusiness.chron.com/five-advantages-using-celebrities-advertising-34394.html>. (Last Accessed on May 27, 2016).

³ Friedman, Hershey H. and Linda Friedman, 'Endorser Effectiveness by Product Type', 19 (5), *Journal of Advertising Research*, 63-71(1979).

⁴ Sanyukta Kulkarni, "Impact of celebrity Endorsement on Overall Brand," available at: http://www.indianmba.com/occasional_papers/op88/op88.html (Last Accessed on May 28, 2016).

illustrated that Shah Rukh Khan topped the list with his earnings of Rs 257.5 crores.⁵ Shah Rukh Khan considers himself bigger than the brand which he endorses. In India Pepsi Company has used a number of celebrities like Aishwarya Rai, Hritikh Roshan, Amitabh Bachan, Kareena Kapoor etc. to help create recall value and market their product. With this strategy Pepsi has the highest recall value of 70% while its rival product Coke has a recall value of only 52%. This proves that Pepsi has really exploited the use of celebrities in their advertisements and it has worked in its favour. Hindustan Lever has used Bollywood actress to endorse its soap and the advertisement implies that these woman owe their stunning looks to the product. This message has been successful in making the product a “Beauty Soap”.

4. Reputation of the Celebrity

Celebrities usually charge a licence fee for the use of their name, image or other attributes in advertising or merchandising. An unauthorized use of a celebrity’s name or image to a product amounts to an act of passing off, unfair competition, misrepresentation and can cause damage to their reputation. It can also amount to a breach of confidence or a violation of privacy. The unauthorized use of the attributes of a celebrity can adversely impact both their economic as well as noneconomic interests. While economic interests are capable of being adequately compensated in monetary terms, non-economic interests such as the violation of privacy, damage to reputation, mental distress may not be entirely capable of satisfaction in terms of money. Such affected rights are personality rights which are not mere financial rights but rather a personal intellectual property right which is not inheritable or assignable.

4.1 Misuse of Celebrity Trademarks around the Globe

To prevent misuse of celebrity names, celebrities around the globe are protecting their names. The best solution may be however to actually register the celebrity’s name as a trade-mark. For tax reasons, a celebrity probably would want to ensure that the company owns the trade-mark registration. For example, several trade-marks registered in Canada using the words ELVIS PRESLEY are owned by a company, Elvis Presley Enterprises Ltd. This type of structure can easily be set up for the registration procedure, provided the celebrity’s written consent is filed with the Registrar of Trade-Marks. For instance, Paris Hilton has her name registered as a trademark for the sale of wide range of goods including clothes and perfumes and David Beckham has a trademark registration for clothing, footwear and headgear.⁶

In 1997, Mrs Frances Shand Kydd, the Lady Sarah McCorquodale and the Reverend and Right Hon. Richard John Carew Chartness, the Executors of the Will of Diana, Princess of Wales applied to register the trade mark DIANA, PRINCESS OF WALES MEMORIAL FUND. They also registered the name “Diana” which was the signature Diana and several photographs of Diana of Trademarks. They also wished to register DIANA, PRINCESS OF WALES as a trade mark for a wide range of goods and services. Hence the word Diana served as a “Signature Mark.” Franklin Mint Company of the USA opposed the registration of trademarks. This company sold Princess Diana’s memorabilia even when she was alive.

In *Cairns v. Franklin Mint Co*⁷ immediately after Princess Diana’s death, her executors registered in California as the successor-in-interest to Princess Diana’s “right of publicity” under California Civil Code § 990, the statute that grants the decedents of a celebrity the right to continue licensing (and receiving royalties for) the use of the celebrity’s name and likeness after the celebrity’s death. The executors also filed federal trademark registrations in various classes for the marks “Diana Princess of Wales” and “Diana Princess of Wales Memorial Fund.” Franklin Mint sought permission from Princess Diana’s executors to use her name and likeness on a number of commemorative products. On the same day, Franklin Mint also filed federal trademark applications for a variety of marks relating to Princess Diana, including “Diana, Queen of Our Hearts,” “Diana, Queen of Hearts,” “Diana, Angel of Mercy” and “Diana, the People’s Princess.” A month later, Princess Diana’s executors rejected the Franklin Mint’s request to license her name and image. Later, the U.S. Patent and Trademark Office also rejected Franklin Mint’s trademark applications, in part because the marks suggested a connection between Franklin Mint and Princess Diana.

⁵ Available at: <http://forbesindia.com/article/2015-celebrity-100/2015-forbes-india-celebrity-100-the-wheel-of-fame-and-fortune/41719/1> (Last Accessed on May 28, 2016).

⁶ Available at: <http://www.selvamandselva.in/blog/celebrity-rights-in-india-srk-and-his-trademark-move/> (Last Accessed on March 18, 2016).

⁷ 24 F. Supp.2d 1013 (C.D. Cal. 1998).

Franklin Mint started selling a number of commemorative Princess Diana items, including a “Diana, Princess of Wales Porcelain Portrait Doll,” a “Diana, Queen of Hearts Jeweled Tribute Ring,” a “Diana, England’s Rose Diamond Pendant,” “Diana, Forever Sparkling Classic Drop Earrings” and other pieces with similar names. The items were offered with a “certificate of authenticity” and, in the case of one item the “Princess Diana Tribute Plate” a promise by Franklin Mint to donate 100% of the purchase price to Princess Diana’s favourite charities. The executors of Princess Diana’s estate and the trustees of the Princess Diana Memorial Fund filed suit in May 1998 in the U.S. District Court for the Central District of California against Franklin Mint and Stewart and Lynda Resnick, the Franklin Mint’s owners. The U.S. District Court for the Central District of California granted the Franklin Mint summary judgment. Court found use of Diana’s persona so widespread that it could not indicate a source of goods. The court let Franklin Mint free to continue selling Princess Diana memorabilia without seeking permission from, or payment of royalties to, Princess Diana’s estate.⁸

The sports industry has many celebrities. English footballers such as Alan Shearer, Paul Gascoigne and David Beckham have also registered trademarks for their names. Cristiano Ronaldo, one of the most highly paid and recognizable athletes in the world, is known to fans by his initials and jersey number, CR7. In *Christopher Renzi v. JBS Textile Group A/S and Cristiano Ronaldo a.k.a. Cristiano Ronaldo Dos Santos Aveiro*⁹ the Phrase CR7 is used by football fans all around the world as a short form for Real Madrid Forward. A fitness enthusiast Christopher Renzi, a man from United States of America registered the trademark CR7 in 2009 and put it on jeans and T-shirts. According to him the words “CR7” are his own initials and his date of birth which was October 7. In 2013 a Danish Company launched “CR7” a underwear line by Cristiano Ronaldo at Madrid’s city hall. Christopher Renzi received letters from lawyers for the Danish company JBS Textile Group demanding he give up the trademark because it had plans to enter the U.S. market with Ronaldo’s CR7 underwear. JBS has also asked the U.S. Patent and Trademark Office to cancel Renzi’s trademark. JBS group alleged that CR7 was “so closely tied to the fame and reputation of Cristiano Ronaldo, that a connection with the soccer player would immediately be presumed by the general public when encountering” Renzi’s branded clothes.¹⁰ Ronaldo’s trademark was suspended. In *Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Bugar*¹¹ Celine Dion and her company own the domain name celine Dion.com. The Defendant started operating and carrying on business in the name of Celine Dion Club.com. WIPO ruled that the defendant’s domain name would be confusing.

In *Robyn Rihanna Fenty v Arcadia Group Brands Ltd*¹² Rihanna a famous pop star and style icon, issued proceedings against the defendant, a well-known high street fashion retailer, for selling a t-shirt bearing her image. The image had been photographed by an independent photographer during the video shoot for a single from her 2011 “Talk That Talk” album. D had a license from the photographer but no license from her. Rihanna contended the sale of the t-shirt without her permission infringed her rights on the grounds of passing off as the public would assume she had licensed the use of her image to the defendant. The defendant argued that customers would buy the shirt because they liked the product and the image for their own qualities. There was nothing on the t-shirt which represented it as an item of Rihanna’s merchandise and the public would not think it was. The t-shirt, the defendant maintained, was a high quality fashion-led garment that was very different from standard pop star merchandise. The Court recognized image Rights a substantial number of purchasers were likely to be deceived into buying the t-shirt because of a false belief that it had been authorized by Rihanna, then that would obviously be damaging to Rihanna’s goodwill. It would amount to sales lost to Rihanna’s merchandising business and represent a loss of control of Rihanna’s reputation in the fashion sphere.

5. Status of Celebrity Marks in India

Celebrities in India are registering their names as trademarks. This is done to prevent misuse of the name. It also prohibits use for commercial purposes, including films, TV, advertisements. There are many examples of celebrities registering their name as trademark. Kajol has made a number of submissions to trademark her name in various business categories including telecommunications, broadcasting, websites, household utensils,

⁸ Jeffrey L. Eichen, “Too famous to trademark: Diana case proves point,” *The National Law Journal of Intellectual Property* (October 16, 2000).

⁹ Case Number: 1:2014cv00341/ July 28, 2014

¹⁰ Available at: <http://www.reuters.com/article/us-ip-soccer-iduskbn0fz1zk20140730> (Last Accessed on January 22, 2016).

¹¹ Case No. D2000-1838.

¹² [2013] EWHC 2310 (Ch).

carpets, rugs, tents, sacks, bags, yarn and thread, among dozens of items.¹³ Divya Yog Mandir has made hundreds of applications to trademark Baba Ramdev, Swami Ramdev and Divya Yoga, seeking to stop those names being used by others on building materials, education and training. Sanjeev Kapoor has Registered trademark 'SANJEEV KAPOOR KHAZANA' which is registered in Class 29.¹⁴ Akshay Kumar has registered "KHILADI" as trademark. Sachin Ramesh Tendulkar, has his initials 'SRT' trademarked. Kajol, Shah Rukh Khan, Sunny Leone, Sanjeev Kapoor and Amitabh Bachchan belong to the long list of people who have trademarked their names and their images.

If a celebrity is allowed to trademark their voice it would pose legal questions. For example a singer trademarks his voice. The company with whom the singer signs a contract asks him to waive his rights for a lump sum payment. The company can now deal with the song in any manner they wish without any interference by the singer. In such a situation would a song come within the ambit of both the laws of copyright and trade mark? And whom does it actually belong to? In this present celebrity trademark generation these questions need to be resolved. In case of images, they are the property of the photographer (copyright of the author) or that of the individual who features in them (image trade mark)? And if the ownership of the photographs vests with the author, how can the same picture be trademarked by the individual? This is yet another legal issue.

In *D.M. Entertainment .v. Baby Gift House and Ors*¹⁵ a famous Indian performer and composer brought action against the defendant since he registered the domain name 'dalmehndi.net'. Delhi High Court restrained the defendant from using the trademark DALER MEHNDI, thus recognizing the fact that the performer's name had fame and reputation.

In *Tata Sons Limited v. Ramadasoft*¹⁶ the Chairman of Tata filed a complaint before World Intellectual Property Rights Organization Arbitration Panel seeking the transfer of domain name consisting of TATA. In *Sourav Ganguly v. Tata Tea*, Sourav Ganguly on returning from a successful England tour found a tea company trying to cash on his success by offering consumers a chance to congratulate the cricketer. It was implied that the cricketer had associated himself with the promotion. The dispute was settled amicably.

6. Trade marking a Person- A Possibility?

A person cannot be registered as a Trademark. Hence there is no legal justification to protect image marks as well. There is no specific provision in Trademarks Act 1999(hereinafter as the "Act"), which allows or disallows registration of names. Thus, it is safe to assume that registration of personal name is allowed. As per Section 2(zb) of the Act, "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors. The definition makes it clear that a trademark cannot be registered in isolation. It is registered to protect the brand value of a person.

Therefore if a celebrity is desirous of registering his/her name it should be with respect to a particular class of goods or/and services. Shah Rukh Khan too has filed applications to register trademark 'SRK', in almost all the 45 classes. However, one needs to keep in mind that if the registered trademark remains unused for a period of five consecutive years, then the mark may be removed from the trademark register. This acts as a remedy against defensive registration.

When a celebrity gets trademark for his/her name that does not mean that they can prevent others from using the name with regard to all goods and services. All it means is that they can prevent others from using the trademark in respect to those classes of goods and services which they have registered. Celebrities can receive trademark protection for their name if their name has acquired secondary meaning. A purported mark acquires secondary meaning when it "has become associated in the minds of consumers with a particular source.

The public primarily associates the mark with a particular producer, rather than the underlying product. Secondary meaning can be proven through factors like survey evidence, consumer testimony, exclusivity,

¹³ R. Bailav, Celebrities using trademark route to check name misuse: Celebrities using trademark route to misuse, available at <http://www.livemint.com/Consumer/Dss3fISYwLqa0bQr53dhfL/Celebrities-using-trademark-route-to-check-name-misuse.html>. (Last Accessed on May 05, 2016)

¹⁴ Available at: <http://trademarkalertz.com.au/trademark/1315754-sanjeev-kapoor-s-khazana>. (Last Accessed on May 10, 2016).

¹⁵ CS(OS) No. 893/2002 before the Hon'ble High Court of Delhi at New Delhi decided on 29.04.2010.

¹⁶ Case No. D2000-1713.

manner of use, and the length of use. In India, an individual may apply for protection of their name, likeness and nicknames, among other things, with the Indian Trademarks Registry in order to obtain statutory protection against misuse.

Section 14 of the Trademarks Act prohibits use of personal names and names of persons living or dead within period of 20 years prior to the date of registration of the Trademark. Names of Freedom fighters are prohibited from being registered as Trademarks under the Emblems and Names Prevention of Improper Use Act, 1950. Under the Act, unless the Government of India permits, names of national personalities cannot be used for trade, business or professional purpose.

In *ICC Development (International) Ltd. v. Arvee Enterprises*¹⁷ the court held that the right to publicity has evolved from the right to privacy and can inhere only in an individual or in any indication of the individual's personality like his name, personality trait, signature, voice etc. An individual may acquire a right to publicity by virtue of his association with an event, sport, movie etc. However, the right does not in here in the event in question, that made the individual famous, nor in any corporation that has brought about the organization of the event. Any effort to take away right of publicity from the individual, to the organizer/ non-human entity would violate Article 19 and 21 of the Constitution of India.

7. Remedial Measures

A celebrity may resort to an action of passing off in order to protect his or her publicity and image rights. However an action of passing off requires proof of: reputation of the individual, some form of misrepresentation and irreparable damage to the individual. The above standard of proof demonstrates the evasive intent of the legislature in treating an individual as a commodity or a commercial property. The law is silent on the right of individual to control his commercial value, restrict its dissemination etc.

8. Conclusion

The name/image of an individual like a celebrity is exclusively associated with him/her. The use of the name or image creates a distinct connection to the individual in the minds of the general public and is "capable of distinguishing the goods/services of one person from those of another". The name/image also carries goodwill. The idea behind registering the person's name as a trademark in a class is to prevent misuse of the name in the trade of any item within that class. This not only allows the individual to protect his name and image from being associated arbitrarily with a plethora of products, but also ensures that he is paid every time he lends his name to a product. It also allows the individual to prevent the use of his name in company names.

¹⁷ 2003(26) PTC 245 Del.