

INDIA'S TAKE ON LEGAL REMEDY OF PASSING- OFF: A CELEBRITY'S PERSPECTIVE

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ABSTRACT *The development of mass media led to the development of intrigue and curiosity around celebrities and their persona, and the profits hidden therein. Harping upon this intrigue, stakeholders realised the brand power behind celebrity personalities. However, problems arose when there was an increase in the unauthorised exploitation of celebrity personalities. While on the legal front, several remedies are resorted to, William Prosser narrowed down these into four, i.e., intrusion into one's private space, disclosure of one's personal and private facts, disclosure of incorrect facts that puts one under a false light and misappropriating one's personality for commercial gain. Hinged on the brand value of a celebrity's personality, the right to publicity emphasises the right of a celebrity to claim control over the commercial value of their identity. Remedy against the unauthorised commercial exploitation of a celebrity's identity is commonly found in the tort of passing off. The article assesses the contours of the remedy of passing off as availed by celebrities and implemented by the Indian Courts. The article also draws a comparison with the approaches employed by American and English law in their understanding of celebrity personality, contrasting the same with the Indian approach.*

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I. INTRODUCTION

Brand value sells, and with the increasing stakeholders and investments involved, concerned parties are prepared to go to lengthy extents to protect or exploit the same. The fundamental issue in this article's context, therefore, is to appreciate and assess how celebrities capitalize on the non-tangible assets that they possess and the legal remedies at their disposal in cases of unauthorized exploitation of this asset.¹

Throughout the world, legal systems have largely taken the help of varying approaches; including the recognition of rights in personalities themselves,² creating rights in images,³ unfair competition,⁴ and tortious liability, among many others.⁵ Some jurisdictions have also evolved a jurisprudence that presents a cocktail of the above as an underlying principal solution.⁶ The Indian approach is partially one of them. This which has not been spoken about at length in popular literature, probably because it is still in its initial stages.

While there is a farrago of rights associated with personality, it was William Prosser who tried to compartmentalise these into four, namely— intrusion into one's private space, disclosure of one's personal and private facts, disclosure of incorrect facts that puts one under a false light, and misappropriating one's personality for commercial gain.⁷ The right to publicity is an aspect of personality rights that recognises the commercial value of the celebrity's persona. The concept was introduced by Melville B Nimmer,

¹ Stuart B. Walzer & Jan C. Gabrielson, 'Celebrity Goodwill' [1986] *Journal of the American Academy of Matrimonial Lawyers* 35, 44.

² See Mark Bartholomew, 'A Right is Born: Celebrity, Property, and Postmodern Lawmaking' (2011) 44 *Connecticut Law Review* 301.

³ Jan-Jaap Kuipers, 'Towards a European Approach in the Cross-Border Infringement of Personality Rights' (2011) 12 *German Law Journal* 1681, 1706.

⁴ Restatement (Third) of Unfair Competition (1995) has stated that misappropriation of publicity rights is a form of unfair competition.

⁵ See annx 1.

⁶ Ingrid Pusey & Marc Morgan, 'Celebrity Personality Rights in Jamaica: A Path for Development' (2012) 61 *Social and Economic Studies* 99, 125.

⁷ William Prosser, 'Privacy' (1960) 48 *California Law Review* 383.

who advocated for the celebrity's "right to control the commercial value of their identity."⁸ Arising from Locke's labour theory, the right to publicity for celebrities is a form of incentive for their hard work in creating their persona and image. Hence, using a celebrity's image for promotion of one's goods and services without authorisation forms a part of unfair trade practice and can be actionable under the tort of passing off.

This article will attempt to look at the usage of the remedy of passing off by Indian celebrities in lieu of them protecting their intellectual property rights. Part I of this article will present a descriptive analysis of the development of the remedy of passing off, as extended to celebrities, in India. This part will analyse how American and English law and precedents look at personality rights and their approach to the remedy of passing off. This analysis will prove to be useful in Part II, where the authors will attempt to show that High Courts have taken different approaches with respect to the interpretation of the criteria of passing off—being (A) goodwill and reputation, (B) misrepresentation, and (C) damage to goodwill and reputation. The article will slightly stretch its ambit by discussing English and American developments for the purpose of comparison. The authors will try to show conflicting approaches by Indian courts as and when the essentials of passing off are dealt with in Part II; thereby concluding that the state of the remedy in India can be considered to be in a state of confusion.

II. DEVELOPMENT OF PASSING OFF LAWS IN INDIA

A. The Rising Cult of Indian Celebrity, Communication Standards, and Demand for Protection

The perception of the "social value of a personality"⁹ evolved considerably with the development of mass media, especially television.¹⁰ With various forms of mass media in India itself like Doordarshan¹¹ and All India Radio¹² (apart from India's very own thriving film industry, Bollywood¹³), there was

⁸ Melville B. Nimmer, 'The Right of Publicity' (1954) 19 *Law and Contemporary Problems* 203.

⁹ See Samantha Barbas, 'The Social Origins of the Personality Torts' (2015) 2 *Rutgers University Law Review* 393.

¹⁰ Robert Strunsky, 'The Cult of Personality' (1956) 25 *The American Scholar* 265, 272.

¹¹ Doordarshan is an autonomous public service broadcaster founded by the Government of India in 1959, owned by the Broadcasting Ministry of India.

¹² See Arvind Singhal & Everett M. Rogers, *India's Communication Revolution: From Bullock Carts to Cyber Marts* (Sage Publications 2001).

¹³ Kaushik Bhaumik, 'A Brief History of Cinema from Bombay to "Bollywood' (2004) 2 *History Compass* 1, 4; Stanley Rothman, 'The Media, Identity and Personality' (1997) 14 *International Journal on World Peace* 49, 80.

an increasing influence on the construction of a known face by the general public. This is when Indian celebrities started gaining recognition and popularity. A cult status accrued upon the Indian celebrities, as the general public started being intrigued by their lifestyles.¹⁴

Weilernotes the fact that celebrities needed public exposure to earn a livelihood, despite the risks of invasion that came alongside it.¹⁵ Such a conflict also had a huge impact on the development of tort law, as the development of law recognized the social interest involved in the protection of individual interest.¹⁶ The rise of endorsement businesses, wherein celebrities were used as endorsers in advertisements, was a testament to the fact that one's name and personality had property-like characteristics.¹⁷ Products sold more if they had the value of a relevant face attached to them,¹⁸ as alluring potential buyers with a personality attached to it had become a significant element of the "contemporary act of selling".¹⁹ Additionally, globalisation has brought many international brands to India, due to which there has been an increased demand for cultural and functional knowledge about the Indian value system.²⁰ With such developments, protection sought by celebrities with respect to their intellectual property increased and legal remedies have been expected to develop accordingly.

B. Indian Developments in Comparison with USA and England

In its early 19th century formulation, the law was meant to protect the name or trademark of a product/business alone.²¹ But as competition grew, the

¹⁴ See annex 2.

¹⁵ Fred M. Weiler, 'The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity' (1994) 13 *Cardozo Arts and Entertainment Law Journal* 223, 274.

¹⁶ Roscoe Pound, *Interests of Personality* (1915) 28 *Harvard Law Review* 343, 365.

¹⁷ Weiler (n 15).

¹⁸ Arpita Khare, 'Impact of Indian Cultural Values and Lifestyles on Meaning of Branded Products: Study on University Students in India' (2011) 23 *Journal of International Consumer Marketing* 365, 379.

¹⁹ Naeha Prakash, 'Stars in Their Eyes: The Dominance of the Celebrity Brand and Intellectual Property Norms Protection through Fan Goodwill' (2013) 35 *Hastings Communications and Entertainment Law Journal* 247, 276; See also St Michael Hylton & Peter Goldson, 'The New Tort of Appropriation of Personality: Protecting Bob Marley's Face' (1996) 55 *The Cambridge Law Journal* 56, 64.

²⁰ Khare (n 18); For example, an international brand like Loreal uses a local well-known face like Aishwarya Rai to enter the Indian market. See 'Katrina named the Indian face of L'Oréal Paris after Aishwarya, Sonam and Freida' (*India Today*, 21 January 2014) <<https://www.indiatoday.in/lifestyle/story/katrina-kaif-loreal-paris-aishwarya-rai-sonam-kaipoor-and-freida-pinto-177717-2014-01-21>> accessed 2 March 2020.

²¹ T. Vidya Kumari, 'Celebrity Rights as a Form of Merchandise – Protection under the Intellectual Property Regime' (2004) 9 *Journal of Intellectual Property Rights* 120, 135.

desire to earn quick and easy money resulted in the exploitation of the goodwill of other traders. Subsequently, in cases where the look of the business premises was passed off, or there was a misrepresentation as to goods,²² no action was maintainable in common law. Consequently, the present shape of the remedy makes it flexible enough²³ to encompass a wide spectrum of trade-related activities and descriptive material,²⁴ while still being an action for deceit.²⁵

i. American Developments

The heavily cited academic opinion by Warren & Brandeis²⁶ (which proposed the need for a tort law that would allow the “victims of press gossip to sue and recover damages for dignitary and emotional injuries”) played a significant role in shaping the current US regime on privacy. Appropriation was considered insufficient to protect commercial interests,²⁷ due to which a standalone right of publicity was developed to focus on the economic aspects of persona.²⁸

²² Anu Tiwari, ‘Passing off and the Law on ‘Trade Dress’ Protection: Reflections on *Colgate v Anchor*’ (2005) 10 *Journal of Intellectual Property Rights* 480, 490.

²³ Manzoor Elahi, ‘Passing Off and Infringement of Trademarks –India’ [2014] SSRN Electronic Journal <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2410451> accessed 2 March 2020; See Arpan Banerjee, ‘Goodwill in Passing Off Actions: in Search of Balance’ (2018) 59 *The Law Review of the Franklin Pierce Center for Intellectual Property* 1, 24.

²⁴ Passing off action is recognised both in respect of registered goods as well as non-registered goods: Section 27 of the Indian Trademarks Act, 1999: No action for infringement of unregistered trade mark. — (1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark. (2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

²⁵ Supreme Court of India in *Durga Dutt Sharma v Navaratna Pharmaceutical Laboratories* AIR 1965 SC 980, while explaining the difference between trademark infringement and passing off; See *Ellora Industries v Banarsi Das Goela* 1979 SCC OnLine Del 198: 1981 PTC 46 per Anand Behari Rohatgi, J.: “The gist of the conception of passing off is that the goods are in effect telling a story of falsehood about themselves, are saying something about themselves which is calculated to mislead (sic)”.

²⁶ Louis D. Brandeis and Samuel D. Warren, *The Right to Privacy* (1890) 4 *Harvard Law Review* 193, 220.

²⁷ See Graeme B. Dinwoodie and Megan Richardson ‘Publicity Right, Personality Right, or Just Confusion?’ in Megan Richardson and Sam Ricketson (eds), *Research Handbook on Intellectual Property in Media and Entertainment* (Edward Elgar Publications 2017) 425–445; See Rosina Zapparoni, ‘Propertising Identity: Understanding the United States Right of Publicity and Its Implications - Some Lessons for Australia’ (2005) 28 *Melbourne University Law Review* 690.

²⁸ ‘US-Style “Personality” Right in the UK – En Route from Strasbourg?’ in 20th BILETA Conference: Over-Commoditised; Over-Centralised; Over-Observed: The New Digital Legal World? Queen’s University of Belfast US-style 1–11; See Julius Pinckaers, From Privacy Toward a New Intellectual Property Right in Persona: The Right of Publicity

At present, celebrities in the USA have two options to protect their personality and its likeness from unauthorized commercial exploitation. The first pathway is through the federal statute dealing with trademarks in the US i.e., the Lanham Act; the other is through the publicity laws of individual states.²⁹

The primary purpose of protection under Lanham Act concerns the safeguarding of consumers from misrepresentation or deception. Hence, in order to bring a claim of right of publicity under the Lanham Act, it is important to show the misperception of the consumers that a celebrity has either endorsed the Defendant's product or is associated with it in some other way.³⁰

With respect to the state laws, the right of publicity arises from the doctrine of privacy, which stands for the right 'to be let alone'. The first case to extend privacy to encompass a separate right of publicity for celebrities was *Haelan Laboratories, Inc. v. Topps Chewing Gum Inc.*, dealing with baseball players and their rights to license their images to be used on baseball cards. The Court, while coining the term 'right of publicity', held that "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".³¹ While this claim of the right of publicity varies from state to state, the elements stay the same; the standard common law right of publicity claim that requires the Plaintiff to prove, (1) use of Plaintiff's identity by Defendant, (2) the use by Defendant leads to some commercial advantage to him, (3) lack of authorisation from Plaintiff, (4) use resulting injury.

The difference between remedies under the Lanham Act and the right to publicity under state laws is that the primary purpose of the former is to prevent consumer confusion, whereas the latter is concerned with protecting the rights of an individual against unjust infringement and misappropriation of their persona and ensuring the right to remuneration arising from it.

(United States) and Portrait Law (Netherlands) Balanced with Freedom of Speech and Free Trade Principles (Kluwer Law International 1996) 15.

²⁹ Jonathon Schlegelmilch, 'Publicity rights in the U.K. and the U.S.A: It is Time for the United Kingdom to Follow America's Lead' (2016) 1 Gonzaga Law Review 101, 119.

³⁰ *ibid.*

³¹ Souvanik Mullick & Swati Narnaulia, 'Protecting Celebrity Rights Through Intellectual Property Conceptions' [2008] NUJS Law Review 615.

In India, one of the first cases which recognized the right of publicity³² was *ICC Development (International) Ltd v Arvee Enterprises*.³³ The following two factors were considered essential to invoke the right:

- (i) validity: the plaintiff owns an enforceable right in the identity or persona of a human being; and
- (ii) identifiability: the Celebrity must be identifiable from a defendant's unauthorized use³⁴ (so much so that if identifiable, the Court does not require proof of falsity or confusion).³⁵

Furthermore, the practical application of the First Amendment to the right of publicity has been getting considerable attention.³⁶ Indian courts, on the other hand, are just starting to gear up for interference with the right to freedom of speech.³⁷ Additionally, the Supreme Court of India³⁸ found publicity to be an element of privacy that is protected as a fundamental right; thereby granting a constitutional status to the same. But since the case actually did not revolve around the issue of celebrity rights, it stands the risk of getting ignored by the lower courts by being deemed *obiter*.

³² *ICC Development (International) Ltd v Arvee Enterprises* 2003 SCC OnLine Del 2: (2003) 26 PTC 245, ('*ICC Development*').

³³ See *ibid* [14] "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."

³⁴ *Titan Industries Ltd v Ramkumar Jewellers* 2012 SCC OnLine Del 2382: (2012) 50 PTC 486 ('*Titan Industries*').

³⁵ The identifiability test was further upheld in *Shivaji Rao Gaikwad v Varsha Productions* 2015 SCC OnLine Mad 158: (2015) 2 CTC 113 ('*Shivaji*'); and *D.M. Entertainment (P) Ltd v Baby Gift House CS (OS) No. 893 of 2002, decided on 2-11-2010 (Del)*. ('*D.M. Entertainment*'), ("to avail the right against the infringement of right to publicity, the plaintiff must be "identifiable" from defendant's unauthorized use"); See *ibid* "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(sic)".

³⁶ Stephen Barnett, 'The Right of Publicity versus Free Speech in Advertising: Some Counterpoints to Professor McCarthy' (1995) 18 *Hastings Communications and Entertainment Law Journal* 593; See Roberta Kwall, 'The Right of Publicity vs the First Amendment: A Property and Liability Rule Analysis' 70 *Indian Law Journal* 47.

³⁷ Justice Bhat gives out a word of caution in *D. M. Entertainment* (n 35), stating "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 an 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."

³⁸ *K.S. Puttaswamy v Union of India* (2014) 6 SCC 433 ('*Justice K.S. Puttaswamy*'); Publicity rights in the form of the right to privacy were first recognized explicitly by the Indian Supreme Court in *R. Rajagopal v State of T.N.* (1994) 6 SCC 632.

ii. English developments

The English approach caters to the protection of the commercial value of the celebrity identity. English Courts have stretched the ends of passing off remedy in order to incorporate new developments.³⁹ *Routh v. Webster*⁴⁰ set the stage for English Law by referencing “an appropriation of personality by an unauthorized use of another’s name”.⁴¹ English Courts eventually narrowed it down to the classical *Trinity* test.⁴² The Supreme Court of India framed a similar definition of the tort in *Wander Ltd v Antox India (P) Ltd*⁴³ as follows:

1. a reputation (or goodwill) acquired by the plaintiff in his goods, name, mark, etc.,
2. a misrepresentation by the defendant leading to confusion, causing
3. damage to the plaintiff

This article will discuss two major English decisions (*Irvine and another v. Talksport Limited*⁴⁴ and *Fenty & Ors v. Arcadia Group Brands Ltd*⁴⁵) that have helped celebrities invoke the passing off remedy in order to protect their intellectual property.

III. ESSENTIAL INGREDIENTS OF PASSING OFF AND INDIAN COURTS’ REACTION

The Court, in *Anil Kapoor Film Co (P) Ltd v Make My Day Entertainment*⁴⁶ opined in favour of a tiered structure to passing off essentials.⁴⁷ The structure

³⁹ Hylton & Goldson (n 19); See Clive D. Thorne, ‘The Promotion and Protection of Celebrities under English Law’ (2006) 2 *Convergence* 45,57.

⁴⁰ *Routh v Webster* 10 Beav 561 (1847).

⁴¹ Julie King, ‘The Protection of Personality Rights for Athletes and Entertainers Under English Intellectual Property Law: Practical Difficulties in Relying on an Action of Passing Off’ (2000) 1 *Sports Lawyers Journal* 351, 374.

⁴² In *Reckitt & Colman Products Ltd v Borden Inc* (1990) 1 WLR 491: (1990) RPC 341 (HL) 405, their Lordships used the term “classical trinity” for goodwill, misrepresentation and damage as the three essentials to show passing off in a case; See *Conorzio Del Prosciutto Fi Parma v Marks & Spencer Plc* [1991] RPC 351 (CA) [368]– [369].

⁴³ *Wander Ltd v Antox India (P) Ltd* 1990 Supp SCC 727: (1991) RPC 351 (CA) 368–69.

⁴⁴ *Irvine v Talksport Ltd* 2002 EWHC 367 (Ch) (*Irvine*).

⁴⁵ *Fenty v Arcadia Group Brands Ltd* 2015 EWCA Civ 3 (*Fenty*).

⁴⁶ *Anil Kapoor Film Co (P) Ltd v Make My Day Entertainment* 2017 SCC OnLine Bom 8119(*Anil Kapoor*).

⁴⁷ See *ibid* [18] “There is a tiered structure to passing off actions, and a plaintiff and the court he approaches, must proceed down that well-worn path: first, reputation; then, misrepresentation; and then all the rest. (sic.)”

has been the usual path followed in major decisions.⁴⁸ A plaintiff, in an action for passing off, has to establish three basic ingredients, reiterated in numerous cases. This three-tiered structure comprises of,

- (1) goodwill and reputation of the plaintiff in the mark, amongst the public
- (2) representation by the defendant that article is that of the plaintiff
- (3) actual damage or real likelihood of damage to the plaintiff by the defendant.⁴⁹

The court in *Anil Kapoor* summed up the essence of passing off, i.e., deception caused to persons, other than the plaintiff himself and calculated actions of the defendant intended to deceive. For this, reputation has been held to be of utmost importance.⁵⁰ It must be shown that the name, description or get-up used by the defendant led to an association in the mind of the public to that of the plaintiff. The above elements of passing off in conjunction to celebrity personality have been discussed in the following paragraphs.

A. Goodwill and Reputation

A passing off suit is aimed towards protecting goodwill. While it is easier to describe goodwill, defining goodwill is not an easy task. As per the oft-cited definition given by Lord Macnaghten, “It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom”.⁵¹ The following paragraphs explore the approach taken by various Indian High Courts in defining goodwill requirements for passing off.

In a general Indian case scenario, proving goodwill is considered to be a “fairly straightforward task” wherein the plaintiff has to show “sufficient evidence of consumer purchasing the goods or services that the plaintiff seeks to protect.”⁵² English courts have also drawn a relationship between the number of customers and the goodwill of the product or service.⁵³ Goodwill

⁴⁸ But see *Star India (P) Ltd v Leo Burnett (India) (P) Ltd* 2002 SCC OnLine Bom 942 : (2003)105 (2) BOM LR 28 (*Star India*), where the Court discussed a third ingredient, namely reputation after building upon damage and misrepresentation respectively and serially.

⁴⁹ *ibid.*

⁵⁰ See *Anil Kapoor* (n 46).

⁵¹ *IRC v Muller & Co's Margarine Ltd*, 1901 AC 217.

⁵² Arpan Banerjee, ‘Spill-Over Reputation in Passing Off Actions: Indian and English law Compared’ (2014) 14 Oxford University Commonwealth Law Journal 21, 45.

⁵³ See *Fenty* (n 45).

can be proved only if there are customers to consume it;⁵⁴ this is very much applicable to celebrities as well, since they invite public attention due to the kind of work in which they are involved.

i. Hard-line approach v Soft line approach

English courts have held that concerned parties cannot gain reputation in other jurisdictions until and unless the party proves the presence of valid customers in the concerned jurisdiction.⁵⁵ This has been termed as the hard-line approach to goodwill; and as Banerjee⁵⁶ puts it, it “is essentially the result of a historical judicial *faux pas*- the ill-conceived transplantation of a narrow tax law concept to the field of intellectual property law.”

On the other hand, the Indian approach has been what scholars refer to as a soft-line approach.⁵⁷ Judges are sympathetic to reputation; this may spill into other jurisdictions owing to growing digital mass media,⁵⁸ websites having visits from internet protocol addresses in India,⁵⁹ e-commerce⁶⁰ and the presence of goods in duty-free shops at airports.⁶¹ This approach was further cemented by appreciating “trans-border reputation.”⁶²

Indian courts have focused on determining reputation rather than goodwill. It was expressly held in *Kamal Trading Co v Gillette UK Ltd*⁶³ that a product’s availability in the country does not have any influence on its reputation and goodwill. A wide reputation could also be attributed to the product by means of advertisements and newspapers, or through social media

⁵⁴ *Athlete’s Foot Mktg Associated Inc v Cobra Sports Ltd* 1980 RPC 343 (Ch).

⁵⁵ See *Amway Corp’n v Eurway International Ltd* 1973 FSR 213 (Ch) 222; *Alain Bernardin Et Compagnie v Pavilion Properties Ltd* [1967] RPC 581 (Ch).

⁵⁶ Banerjee (n 52).

⁵⁷ See *Star India* (n 48).

⁵⁸ See *Calvin Klein Inc v International Apparel Syndicate* 1994 SCC OnLine Cal 304 : (1996) 16 PTC 293; *William Grant & Sons Ltd v McDowell & Co Ltd* 1995 SCC OnLine Del 398 : [1994] FSR 690 (Delhi High Court) [716]-[717]; *Kamal Trading Co v Gillette UK Ltd* 1987 SCC OnLine Bom 754 : (1988) 8 PTC 1.

⁵⁹ *Easygroup IP Licensing Ltd v EasyJet Aviation Services (P) Ltd* 2013 SCC OnLine Del 3181 : (2013) 55 PTC 485.

⁶⁰ See *H&M Hennes & Mauritz AB v HM Megabrand (P) Ltd* 2018 SCC OnLine Del 9369.

⁶¹ *Cadbury UK Ltd v Lotte India Corp’n Ltd* 2014 SCC OnLine Del 367 : (2014) 57 PTC 422 (Delhi High Court); See *SC Cambatta & Co (P) Ltd v CEPT* AIR 1961 SC 1010 : (1961) 2 SCR 805 (Supreme Court of India).

⁶² See *N.R. Dongre v Whirlpool Corp’n* (1996) 5 SCC 714 : (1996) 16 PTC 293 (Calcutta High Court) (usage of a mark was restrained because the said product was sold to US diplomats despite not having sales in India; See Ishaan Saha, ‘Supreme Court of India Supplants the Doctrine of Transborder Reputation with the Territoriality Principle in Passing Off Actions’ (2018) 13 Journal Of Intellectual Property Law and Practice 442, 444.)

⁶³ *Kamal Trading Co v Gillette UK Ltd* 1987 SCC OnLine Bom 754 : (1988) 8 PTC 1 (Bombay High Court).

in today's time. In *Apple Computer Inc v Apple Leasing & Industries*,⁶⁴ the court stated that "it is not necessary in the context of the present-day circumstances to insist that a particular plaintiff must carry on business in a jurisdiction before improper use of its name or mark can be restrained by the court".

Soft-line approach in today's age of information and globalisation has been preferred by Banerjee.⁶⁵ In *Cadbury UK Ltd v Lotte India Corpn Ltd*,⁶⁶ the High Court of Delhi had held that reputation can be acquired in the modern day via advertisements or displays over the internet or social media. One of the major reasons for the refusal of the hard-line approach as observed in the UK is the requirement of protecting Indian consumers from being misused by local sellers purporting to be franchises of foreign traders. However, the potential drawback of this Soft-line approach has been highlighted by Banerjee as when local traders using a valuable mark in a bona fide manner would be disadvantaged in cases wherein their marks are similar to that of foreign traders.

ii. Goodwill v/s Reputation

Earning goodwill in India requires actual business to be transacted using the mark, either by making the products available or by providing services. Reputation, on the other hand, is the knowledge and awareness that a particular brand/mark commands, although the goods/service in connection with which the mark is used may not be available in a particular territory/market.⁶⁷ It will not be wrong to conclude that in cases involving celebrities, Indian judges have focused more on determination of reputation,⁶⁸ the onus of which is usually on the plaintiff.⁶⁹

In *Star India (P) Ltd v Leo Burnett (India) (P) Ltd*,⁷⁰ the conflict was between a serial and a ten-second commercial with characters similar to those in the serial. The plaintiffs' claim to reputation was based on the film and characters. But the Court noted that the "reputation does not extend to

⁶⁴ *Apple Computer Inc v Apple Leasing & Industries* (1992) 1 Arb LR 93 (Delhi High Court) [119].

⁶⁵ Banerjee (n 52).

⁶⁶ *Cadbury UK Ltd v Lotte India Corpn Ltd* (n 61).

⁶⁷ See Arpan Banerjee, 'Goodwill in Passing Off Actions: in Search of Balance' (2018) 59 *The Law Review of the Franklin Pierce Center for Intellectual Property* 1, 24; Sanjeev Chaswal, 'Indian Courts Judicial Approach to Principle of Territoriality and Trans-Border Reputation – A Comparative Study', (Mewar University 2019).

⁶⁸ Banerjee (n 23).

⁶⁹ See *Star India* (n 48).

⁷⁰ *ibid.*

or separately exist in any particular person or dialogue in or part of a serial so that any member of the public would associate any particular incident or script or word or sentence or scene in the film with the plaintiffs alone”.⁷¹ In another case,⁷² the judge noted that while mala fide intention is not necessary, intentional misrepresentation may prove that the reputation of the plaintiff is such that it is worthwhile for the defendant to cash upon it. It seems Indian courts have tilted towards the determination of reputation as a bi-product of misrepresentation and taking the help of the latter to prove the former.

On the contrary, in *Anil Kapoor*,⁷³ Justice Patel noted that it would not do any good for the plaintiff to allege misrepresentation and, on that basis, to try and establish reputation. He appears dissatisfied with the parties conveniently using the terms ‘reputation’ and ‘goodwill’ interchangeably;⁷⁴ yet chooses to avoid discussion regarding the differentiation. After expressing concern, he nevertheless allows the plaintiff to include goodwill within reputation.⁷⁵ He then goes on to focus on reputation and decides that no reputation can vest in a work in progress.⁷⁶

In *Shivaji Rao Gaikwad v Varsha Productions*,⁷⁷ popular Indian actor Rajinikanth sued the release of a film titled “Main Hoon Rajinikanth”, translating to ‘I am Rajinikanth’ in English. The Court concluded that if the audience is reminded of only one particular face after reading the title of the film, goodwill and reputation vested in the personality. Clearly, the judgment largely hinged on the awareness or familiarity with the celebrity’s image amongst consumers.⁷⁸

iii. Extending the arms of goodwill

Justice Patel of the Bombay High Court, well known for his meticulous and stringent opinions, had an opportunity to hear an application for an

⁷¹ See *Star India* (n 48) [12].

⁷² *Arun Jaitley v Network Solutions (P) Ltd* 2011 SCC OnLine Del 2660 (*‘Arun Jaitley’*).

⁷³ *Anil Kapoor* (n 46).

⁷⁴ See *ibid* (n 46) [10] “At this stage, this is the only material the Plaintiff shows of reputation and goodwill, even assuming the two can be conflated and treated as synonymous, which I very seriously doubt”.

⁷⁵ See *ibid* (n 46) [21] “A Plaintiff must show reputation (and I will again allow Mr Kadam the latitude of including in this the concept of goodwill), misrepresentation and damage”.

⁷⁶ See *ibid* (n 46) [13].

⁷⁷ *Shivaji* (n 35).

⁷⁸ See *Zee Entertainment Enterprises Ltd v Gajendra Singh* 2007 SCC OnLine Bom 920 (*‘Zee Entertainment’*) [157] “There can be really no doubt about the enormous reputation developed by the Plaintiff over the last fourteen years in its television game show. I am in fact at a loss to understand how the first Defendant could ever have denied the same.”

injunction for passing off.⁷⁹ The application was for the protection of the title of a mainstream Bollywood film titled ‘*Veere Di Wedding*’ which translates to “My Best Friend’s Wedding” against the title of the defendant’s film, ‘*Veere Ki Wedding*.’ Justice Patel was of the opinion that reputation cannot be considered an unfinished product. This was due to the fact that there could be no reputation in a creation which is in anticipation, viz., the plaintiff’s film. More importantly, Justice Patel took a strong view about not underestimating the average movie goer’s common sense of confusing two different films. He acknowledges that the time of 1950s-60s is not applicable here, given the advancement of various kinds of posters, movie promotion, internet, and proliferation of online material. This was not taken into account by the Madras High Court in *Shivaji*.⁸⁰

Despite taking note of evolving changes, Justice Patel failed to appreciate the importance of the build-up in reputation that movies have had through online promotions, months their releases. The Court also noted that the advertisements shown to prove reputation are essentially third-party comments. Reputation can be considered to be established here when somebody else, other than the owner of the product, talks about and discusses the work. The potential discourse of reputation is set out when the concerned audience engages in conversations and daily chit-chats regarding a particular work. The court failed to take this into account.

*Irvine*⁸¹ is a notable English case wherein the defendant was sued for using a doctored image of the plaintiff, resulting in a confusing endorsement. The court appreciated the handsome compensation that a famous person receives by endorsing a product, thereby attaching the “lustre” of a famous personality to their goods and services; this which enhances their attractiveness. Therefore, there was goodwill in the reputation of the famous personality which allowed the endorsee i.e., the celebrity to derive a benefit. It was due to this goodwill that the judge was convinced that passing off needs to be applied to false endorsement cases.

The Delhi High Court had an interesting set of facts to deal with in 2010. In the case of *D. M. Entertainment (P) Ltd v Baby Gift House*,⁸² small caricature dolls resembling the popular Indian pop star Daler Mehndi⁸³ were found to be sold. The Court was of the opinion that Mr. Mehndi had become an extremely famous artist and “brought an association in the mind of the

⁷⁹ *Anil Kapoor* (n 46).

⁸⁰ *Shivaji* (n 35).

⁸¹ *Irvine* (n 44).

⁸² *D.M. Entertainment (P) Ltd v Baby Gift House* (n 35).

⁸³ See annex 3.

public and trade alike” with his entertainment services. The Court also took note of the protection of personality as the inherent purpose of trademark law; and despite extending the wings of passing off remedy to celebrities, the opinion still chooses to remain in the grey overlapping area between passing off used for traders and passing off used for protection of personality.

Indian law has also considered goodwill in characters. Judges recognize personality rights only when the character has independently acquired public recognition. Intending to use such fame for merchandising products is essential.⁸⁴ If the popularity has not been used earlier, and if someone else tries to use similar methods for the promotion of their own goods or services, the case would not hold good.⁸⁵ Mere potential for merchandising the character is not sufficient by itself. This principle was reiterated in *Star India*.⁸⁶ However, the Court did note the possibility of the growth of a character beyond the film.⁸⁷

Inconsistency and confusion on how goodwill is to be determined in personality protection is apparent in the preceding paragraphs. While the usual trend has been that of the soft-line approach (where establishing reputation via advertisements and even social media campaigns has been enough), *Anil Kapoor* highlights a shift in the trend and a tilt towards a stricter regime.

B. Misrepresentation

Misrepresentation and possible deception to the customer is the crux of a passing off action. As per *Wander Ltd v. Antox India (P) Ltd*,⁸⁸ passing off consists of causing misrepresentation to the consumers, with the intention of damaging the goodwill of another’s trade. There are various elements of the consideration examined by courts in order to determine misrepresentation. These elements and the Indian approach to them are discussed in the following paragraphs.

⁸⁴ Suman Naresh, ‘Passing-Off, Goodwill and False Advertising: New Wine in Old Bottles’ (1986) 45 *The Cambridge Law Journal* 97, 125.

⁸⁵ See Manoranjan Ayilyath, ‘Character Merchandising and Personality Merchandising: The Need for Protection: An Analysis in the Light of UK and Indian laws’ [2012] *Entertainment Law Review* 1.

⁸⁶ *Star India (P) Ltd v Leo Burnett (India) (P) Ltd* (n 48) (The case revolved around the defendant’s commercial which was telecast with a similar title and similar characters from the plaintiff’s TV series).

⁸⁷ See *ibid* [12] “It is necessary for character merchandising that the characters to be merchandised must have gained some public recognition, that is, achieved a form of independent life and public recognition for itself independently of the original product or independently of the milieu/area in which it appears. Only then can such character be moved into the area of character merchandising”.

⁸⁸ *Wander Ltd v Antox India (P) Ltd* 1990 Supp SCC 727 : [1991] RPC 351 (CA) [368]– [369].

In India, what is generally held necessary in passing off is not just any misrepresentation, but one which damages the claimant's goodwill.⁸⁹ This has been reiterated by the Delhi High Court which held that causing damage by inciting confusion concerning the source of the goods may not be as necessary as proving that damage was caused to the goodwill of the trademark.⁹⁰ The expansion of misrepresentation to include misappropriation transgresses the well-established passing off jurisprudence and brings personal rights into the realm of commercial rights, which the court in *ICC*⁹¹ sought to keep separate.

i. Likelihood of Confusion & common field of activity

Even while applying the concept of trademark law to domain names, the Court in *Satyam*⁹² was of the opinion that it was sufficient for the plaintiff to establish the "likelihood of confusion in the minds of customers or likely customers." The test in passing off cases is whether there is a likelihood of confusion or deception arising in the minds of unwary customers, irrespective of dissimilarities in the trade name.⁹³

In what looked like more of a personality rights case, the Madras High Court in *Shivaji*⁹⁴ found that infringement of the right of publicity required no confusion, especially when the celebrity was identifiable. The Court did not require much convincing that the poster would confuse the audience with Rajnikanth, as the court heavily relied on his immense popularity. In *Anil Kapoor*,⁹⁵ the Bombay High Court was of the opinion that deception or likelihood of deception is important for a passing off action.⁹⁶ The Court in

⁸⁹ Tabrez Ahmad and Satya Ranjan Swain, 'Celebrity Rights: Protection under IP Laws' (2011) 16 Journal of Intellectual Property Rights 7, 16.

⁹⁰ *D.M. Entertainment* (n 35).

⁹¹ *ICC Development* (n 32) "An individual 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." Justice Surinder Aggarwal while holding that right of publicity did not vest in ICC cricketing events. In concluding so, he also pointed out that the copyright law, trademark law, dilution law and unfair competition law provide full protection against all forms of appropriation of property to legal entities due to which non-living entities are not entitled to publicity rights protection.

⁹² *Satyam Infoway Ltd v Siffynet Solutions (P) Ltd*, (2004) 6 SCC 145. ('*Satyam*').

⁹³ *Colgate Palmolive Co v Anchor Health & Beauty Care (P) Ltd* 2003 SCC OnLine Del 1005 : (2003) 27 PTC 478 (Del).

⁹⁴ *Shivaji* (n 35).

⁹⁵ *Anil Kapoor* (n 46).

⁹⁶ See Latha Nair, 'Tracking the Protection of Well-Known Marks in India: A Befuddled Path to Nirvana?' (2011) 101 The Trademark Reporter, International Trademark Association; *ICC Development* (n 32).

*Star India*⁹⁷ was of the opinion that because various episodes of series and a ten-second commercial were different fields of work, the likelihood of confusion was not possible. On the other hand, confusion amongst customers regarding the source of the product was not found to be essential if there was damage to goodwill in a passing off suit.⁹⁸

Likelihood of confusion amongst potential customers was followed in the *ICC judgement*⁹⁹ as well, where Justice Aggarwal opined that inclusion of a pictorial representation of a ticket with an imaginative seat and gate number saying “Cricket World Cup 2003” is not enough to show any likelihood of confusion. In *Zee Entertainment Enterprises Ltd v. Ganjendra Singh and Ors*¹⁰⁰ the question was whether the defendants were passing off their similar game show as that of the plaintiff’s. Establishing the likelihood of deception, the Court held that the “Defendant’s game-show is considered as nothing but the plaintiff’s game-show telecast earlier, but only in a new avatar.”¹⁰¹

In English jurisprudence, the need for a common field of activity was part of the historical baggage in the development of the tort, as the underlying intention was to protect the trader community.¹⁰² But today, proof of a common field of activity is not required in the extended action of passing off.¹⁰³ India has adopted a diluted approach. When the fields of activity of the plaintiff and the defendant in a passing off suit are different, establishing misrepresentation and the likelihood of confusion becomes even more difficult,¹⁰⁴ due to which Courts have considered the common field of activity as a “highly relevant consideration”.¹⁰⁵ However, the court also stated that it cannot be laid down as a rule of law, that in the absence of a common field of activity, there is no possibility of confusion or misrepresentation. Hence, while the absence of common field of activity is not fatal, yet it isn’t relevant also, in determining confusion in passing off in personality rights.¹⁰⁶

⁹⁷ *Star India* (n 48).

⁹⁸ *D.M. Entertainment* (n 35).

⁹⁹ *ICC Development* (n 32).

¹⁰⁰ *Zee Entertainment* (n 78).

¹⁰¹ See *Zee Entertainment* (n 78) [163].

¹⁰² P. Narayanan, *Law of Trade Marks and Passing off* (2004) 685.

¹⁰³ *Irvine* (n 44).

¹⁰⁴ *Star India* (n 48).

¹⁰⁵ *ibid*; See *Yahoo! Inc v Akash Arora* 1999 SCC OnLine Del 133 : 1999 Arb LR 620.

¹⁰⁶ *Aktiebolaget Volvo of Sweden v Volvo Sheets Ltd of Gujarat (India)* 1997 SCC OnLine Bom 578 : 1998 IPLR 63.

ii. Relevant customers

English Courts considered the remedy of passing off when t-shirts bearing a close-up shot of singer Rihanna's face were being sold by the defendants.¹⁰⁷ Rihanna's case was that putting up a picture on the said goods created an association between the goods and her likeness which was unauthorized and played a heavy role in the purchaser's motivation to buy the t-shirt due to which there was misrepresentation taking place. The Court sympathized with the facts of this particular case and heavily relied on previous instances¹⁰⁸ wherein the relevant audience believed that this apparent association was authorized by Rihanna.

The Court held that the establishment of likelihood of confusion amongst a substantial number of consumers (not necessarily all of them) had to be shown. "It was therefore plainly relevant to consider potential customers who were both fans of Rihanna and prepared to shop in a Topshop store."¹⁰⁹

In *Anil Kapoor*,¹¹⁰ while deciding misrepresentation amongst moviegoers, the Bombay High Court was cautious to not "assume that the public is so gullible, so infantile and quite so easily deceived that it does not know what it wants to see, hear or read."¹¹¹ Similarly, in *Zee*,¹¹² it was contended that the two shows in question cannot be similar because they aired on different channels. The Court answered in the negative, stating that misrepresentation cannot occur in the minds of regular viewers of the show.¹¹³

In terms of determining relevant consumers, courts in both the UK and India have followed a similar approach. In *Irvine*,¹¹⁴ the court had referred to "a not insignificant section of market" which must have been misled by the defendant. In *Fenty*,¹¹⁵ the court laid down that in passing off, a false

¹⁰⁷ *Fenty* (n 45).

¹⁰⁸ A shopping competition and a visit by Rihanna to Topshop.

¹⁰⁹ See *Fenty* (n 45) [61].

¹¹⁰ *Anil Kapoor* (n 46).

¹¹¹ See *Anil Kapoor* (n 46) [15].

¹¹² *Zee Entertainment* (n 78).

¹¹³ See *Zee Entertainment* (n 78) [160]. "Misrepresentation does not occur in the minds of viewers who may happen to see but one episode or casually while, if I may use the expression, "channel surfing". Passing off cannot be judged qua such viewers. Regular viewers of such game-shows would normally be expected to note the day and time when the same are telecast. If I am right, such a viewer, while accessing the show at a particular time, would of necessity be aware of the particular television channel to be accessed. There will thus be no confusion in the minds of the viewers as to on which channel a particular programme is to be telecast. In other words, it is not as if the viewer would access the programme on the third Defendant's channel thinking that it is the Plaintiff's television channel".

¹¹⁴ See *Irvine* (n 44).

¹¹⁵ *Fenty v Arcadia Group Brands Ltd* 2015 EWCA Civ 3.

belief must be engendered in the minds of a “potential customer”. The court took into account the previous efforts made by the defendant, Topshop, to emphasize a connection between themselves and Rihanna, such as a shopping competition to win a chance to meet her, publicity materials related to her, etc. These actions led to an assumption in the minds of the customers that there is some connection between t-shirts sold by them and the celebrity.

In *Star India*,¹¹⁶ the High Court of Bombay had referred to “reasonable people” who mistake an association between plaintiff and defendant, or a might possibly be confused. It was held that the public must be well aware of merchandising by the plaintiff in the field of defendant for a misrepresentation to happen.

iii. Dilution of uniqueness

However, Justice Bhat in *D.M. Entertainment*¹¹⁷ was more cautious regarding the protection of the purpose of trademark law, i.e., to indicate the source of the work with clarity without diluting its exclusivity. He was of the opinion that “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”.¹¹⁸ But the Court explored the possibility of damage to a trademark’s power to indicate the source by noting that although a similar trademark may not cause confusion, it may still “cause damage to the well-known trademark by reducing or diluting the trademarks power to indicate the source”¹¹⁹ as it takes “advantage of goodwill.” Similar sentiments are not necessarily shared by other judges, who speak of confusion as a complete element in itself.¹²⁰

It is clear that in Indian scenario, courts have considered field of activity as significant, though not essential. Inconsistency lies in the approach towards determining the relevant section of people for misrepresentation. While in certain judgments, a relevant section has been discerned in terms of regular viewers as given in *Zee*, the approach in others such as “reasonable people” in *Star India* or “public” *Anil Kapoor* is uncertain and open to various interpretations.

¹¹⁶ See *Star India* (n 48).

¹¹⁷ *D.M. Entertainment* (n 35).

¹¹⁸ See *D.M. Entertainment* (n 35) [16].

¹¹⁹ *ibid.*

¹²⁰ But see *Latha Nair* (n 96) (the author remarks: “This is perhaps the first and only case in India enjoining a defendant from using the plaintiff’s well-known mark on the sole ground of free-riding, without analysis of likelihood of confusion or deception” with respect to *Daimler Benz Aktiengesellschaft v Eagle Flask Industries Ltd* 1993 SCC OnLine Del 604 : AIR 1994 Del 239.

C. Injury to Goodwill and Reputation

The last requirement of a passing off action is injury to goodwill caused due to the unauthorized use of the celebrity's image. Acts such as false endorsement and merchandising lead to a false association with the celebrity in the minds of the consumer. This false association leads to injury to the celebrity's persona. The section explores the concept of injury as accepted by varied judgments of the High Courts.

i. False Endorsement

Davis¹²¹ suggests that in the UK, it is the nature of the damage rather than the nature of misrepresentation which is determinative of whether there has been passing off. In *Fenty*,¹²² the Court was of the opinion that the loss of control over reputation would result in damage of reputation. In *Irvine*,¹²³ the Court, referring to dilution principles, argued that the remedy is not restricted to action against unlicensed inferior goods but extends to usage of goodwill to reduce its exclusivity.¹²⁴ The Court also stressed upon the need to show that the defendant's actions gave rise to a false message,¹²⁵ which would be understood by a non-significant section of his market that his goods have some connection with the plaintiff.¹²⁶

Reduction in exclusivity was followed in *D. M. Entertainment*¹²⁷ where the Court noted that the use of Mr. Mehndi's persona for the purpose of capitalizing upon his name by using its conjunction with the commercial product resulted in a clear dilution of the uniqueness of such personality.¹²⁸

In Indian context, what the court has focused upon in *D.M. Entertainment*¹²⁹ is whether the use of another's mark or a similar one leads the purchaser to believe that there is some association between the Plaintiff and the use by Defendant, leading to the dilution of the uniqueness of the

¹²¹ Jennifer Davis, 'Why the United Kingdom Should have a Law Against Misappropriation' (2010) 69 Cambridge Law Journal 561, 581.

¹²² *Fenty* (n 115).

¹²³ *Irvine* (n 44).

¹²⁴ See *ibid* [34].

¹²⁵ See 'Is the UK Heading Towards Protection of Image Rights?' [2014] Athens Institute for Education and Research 1101.

¹²⁶ A major criticism of the decision in *Irvine* is that it effectively instructs that where a plaintiff cannot prove direct loss or damage to his goodwill, the damages for the defendant's wrongdoing will be calculated as if the defendant had acted properly in seeking a license prior to using the plaintiff's image. This result may not necessarily be a true reflection of the damage to the claimant's goodwill.

¹²⁷ *D.M. Entertainment* (n 35).

¹²⁸ See *ibid* [15].

¹²⁹ *ibid*.

personality. Focus is not so much on the business and commercial loss of the Plaintiff but on the confusion among consumers as to the source of goods and damage or dilution to the power of the mark to indicate the source. In case of famous celebrities, it was held in *Shivaji*,¹³⁰ “A celebrity must be identifiable from the defendant’s unauthorized use. Infringement of the right of publicity requires no proof of falsity, confusion, or deception, especially when the celebrity is identifiable.” An injunction would be granted in the favour of the Plaintiff if the said celebrity could be easily identified by the use of their name by the defendant.

ii. Extended version of damage

“Real likelihood of damage or probability of damage”¹³¹ appears to be essential for Indian judges while considering damage in a passing off claim. The Court in *Star India*¹³² was of the opinion:

*Establishing passing off by goods in which the claimant does not trade, calls for special evidence to establish that the defendants’ action would induce the belief, if any, that his goods are those of the claimant, at least that his business is an extension of or somehow connected with that of the claimant or that his goods have been somehow approved or authorized by the claimant.*¹³³

In *Anil Kapoor*,¹³⁴ the Court attempted to include deception in the extended version of damages by stating that the concerned “attempt must deceive, a calculated deception by the defendant to pass off his product or service as that of the plaintiff (or vice versa).”¹³⁵ On the other hand, when the tort was used in *D.M. Entertainment*,¹³⁶ the Court did not award more than nominal damages, which suggests that if this doctrine is adopted, celebrities may find it difficult to obtain a great amount of damages.¹³⁷

A general practice in India since the past few years has been to invoke all possible remedies since Courts have recognised them on paper, though

¹³⁰ See *Shivaji* (n 35).

¹³¹ *Star India* (n 48).

¹³² *ibid.*

¹³³ See *Star India* (n 48) [13].

¹³⁴ *Anil Kapoor* (n 46).

¹³⁵ See *ibid* [13].

¹³⁶ *D.M. Entertainment* (n 35).

¹³⁷ See Bhargavi Vadeyar, ‘The Commercial Appropriation of Personality in India’ (2015) 9 National University of Advanced Legal Studies Law Journal 1.

in passing.¹³⁸ An example of the same is the case of *Shivaji*,¹³⁹ wherein the plaintiff prayed for an injunction under passing off as well as infringement of personality rights. The Madras High Court was of the opinion that injury to reputation took place as the defendant's forthcoming feature film had the plaintiff's name (Rajnikanth) in the title and showed the protagonist (also named Rajnikanth) in a few immoral scenes. However, this can be in contradiction with the holding in *Anil Kapoor*,¹⁴⁰ where Justice Patel has taken the average movie goer's common sense of differentiation between similar-looking films into consideration. Application of this logic would yield a different result in *Shivaji*¹⁴¹ as an ardent fan of Rajnikanth would easily be able to not confuse the actor with a similarly-named protagonist in a completely different film. However, the Court ruled in favour of the plaintiff and an injunction was granted against the release of the film.¹⁴²

In *Sholay Media & Entertainment (P) Ltd v Parag Sanghavi*,¹⁴³ the defendant's film was under question for being similar to that of the plaintiff's cult classic titled 'Sholay'.¹⁴⁴ The Court was of the opinion that passing off their film or other productions using the plaintiff's trademark (trademark being SHOLAY) was against the law. Though this goes against the holding in *D. M. Entertainment*¹⁴⁵ where the Court was concerned about protecting the inherent purpose of trademark law, there is an indication of source and the underlying general understanding that passing off remedy is a tool for unregistered marks.¹⁴⁶

¹³⁸ See *ICC Development* (n 32); See *Sonu Nigam v Amrik Singh* 372/2013 (Bombay High Court) ("no third person should be commercially profited by using images of the celebrities without their consent, exploiting the personality right of the celebrities and observed that the heavy fine so imposed would act as a deterrent to people who intend to engage in such acts").

¹³⁹ *Shivaji* (n 35).

¹⁴⁰ *Anil Kapoor* (n 46).

¹⁴¹ *Shivaji* (n 35).

¹⁴² The film was then never released in South India to avoid further disputes and was released only in North India (with a changed title).

¹⁴³ *Sholay Media & Entertainment (P) Ltd v Parag Sanghavi* 2015 SCC OnLine Del 11644 : (2015) 223 DLT 152.

¹⁴⁴ Released in 1975, *Sholay* is considered to be a classic and one of the best Indian films. It broke records for continuous showings in many theatres across India, and according to some accounts, *Sholay* remains the highest-grossing Indian film of all time, adjusted for inflation.

¹⁴⁵ *D.M. Entertainment* (n 35).

¹⁴⁶ Even though the defendant's feature film was an adaptation of plaintiff's film, the fact that the former was produced without proper authorization rendered it an act of passing off as the plaintiffs were the owners of the names of the characters and the dialogues.

iii. Merchandising and Endorsement

Courts in India and the U.K. have drawn a subtle distinction between the terms endorsement and merchandising. The difference between the two terms and the extent of their use in passing off cases was highlighted by Justice Laddie in *Irvine*.¹⁴⁷ In endorsement deals, the celebrity attaches their name to the product, with the intent of informing the public of their approval of the said product, encouraging them into buying the product. Merchandising cases are different in the essence that their aim is to exploit the fame of images of the celebrity. Character merchandising, which was explained by Lord Justice Kitchin in *Fenty*,¹⁴⁸ pertained to activities focused on the use and exploitation of the likeness or name of a celebrity.

It was highlighted in *Irvine*¹⁴⁹ that as opposed to endorsement cases, perception in the mind of the public that the celebrity has endorsed the merchandised product is not necessary. Endorsement is not a necessary feature of merchandised products. Strong evidence will have to be led by the claimant to show significant goodwill and consequent public perception of endorsement, causing or likely to cause him damage to his goodwill and business. Following the judgment laid down in *Irvine*,¹⁵⁰ it is highlighted that public perception and belief as to whether the celebrity has endorsed the merchandise or not plays an immense role in character merchandising in the UK.

As per the jurisprudence set by the Indian precedents as well, public recognition forms an important requirement for passing off in character merchandising cases. It was held in *Star India*,¹⁵¹ that it is essential for the character being merchandised to have gained some public recognition that has achieved a form of independent life and recognition of itself, outside and discernible from the original production or the arena in which it appears. In *D.M. Entertainment*,¹⁵² while emphasizing on the requirement of identifiability, the court had added that as a secondary consideration, i.e., it was also essential to show that the unauthorized use by the defendant was adequate and substantial to identify that the defendant appropriated the personality and the attributes of celebrity.

There are discrepancies in the way that each court has approached the third requirement of passing off. While it is important to show that there is a

¹⁴⁷ *Irvine* (n 44).

¹⁴⁸ See *Fenty* (n 45).

¹⁴⁹ See *Irvine* (n 44).

¹⁵⁰ *ibid.*

¹⁵¹ See *Star India* (n 48).

¹⁵² See *DM Entertainment* (n 35).

false idea of association created by the defendant, the threshold of the same has varied. In *Shivaji* the court required the celebrity to be recognizable, while in *Anil Kapoor*, the court raised the bar such that even if the celebrity is recognizable, it is required to prove that the public formed a mistaken association in their minds between the celebrity and the defendant.

IV. CONCLUSION

There are evident discrepancies in the way with which High Courts have chosen to apply the concept of passing off in personality. Indian Courts have also kept themselves open to other remedies as judges have been inspired by the idea of creating a right in privacy,¹⁵³ publicity,¹⁵⁴ and personality¹⁵⁵ itself.¹⁵⁶ The same has not been discussed in detail here as that would be beyond the scope of this paper. Whilst some protection may be offered to celebrity identity through these regimes, they are allbi-products of some other subject-matter; hence, courts are struggling to afford meaningful protection to the personality rights of celebrities. High Courts have dealt with a good number of cases on passing off claims by celebrities. However, the cases are usually unable to reach the Supreme Court to get a more concrete ruling; this tends to point towards a general notion amongst parties and lawyers that infringement of publicity is important only till sufficient damages and injunctions are claimed, but not enough of a priority to appeal to the Apex Court.

In Indian context, there is a cocktail of remedies, often used in a concoction, and the lines differentiating them are blurred. Passing off, which emanates from the right of publicity, is just one of the remedies. While passing off has been resorted to in the majority of cases, there are other remedies available as well. Apart from publicity, celebrities have also resorted to right to personality and right to privacy, forming a part of Article 21 of Constitution of India. One of the earliest instances of recognition of the right to one's personality and privacy by the Indian judiciary was seen in *Phoolan Devi v Shekhar Kapoor*¹⁵⁷ wherein the right to privacy and protection against tarnishing of the images of celebrities were held to be important. The right to personality provides that there is an inherent right within every

¹⁵³ See *R. Rajagopal v State of T.N.* (n 38); See *K.S. Puttaswamy* (n 38); See *Phoolan Devi v Shekhar Kapoor* 1994 SCC OnLine Del 722.

¹⁵⁴ See *ICC Development* (n 32); See *Shivaji* (n 35); See *K.S. Puttaswamy* (n 38).

¹⁵⁵ See *Rajat Sharma v Ashok Venkatramani* CS (COMM) 15/2019.

¹⁵⁶ See annex 1.

¹⁵⁷ 1994 SCC OnLine Del 722 : (1995) 57 DLT 154)

person that allows them to control the commercial use of their identity. This cannot be exploited by others for commercial gains without authorisation.

One of the major obstacles which Indian courts are struggling to overcome is of demarcating the legal areas of passing off, infringement,¹⁵⁸ and personality rights.¹⁵⁹ Indian Courts seem to be comfortably sitting in the grey area; they refrain from differentiating the purpose and essentials of the above-stated remedies.¹⁶⁰ Parties are therefore found to be approaching courts with strategies involving every possible remedy thereby leading to a vicious cycle where Indian courts seem to be wandering in the overlapping uncertainty.

While it is interesting to see that more contested and novel terrain like internet domains have been addressed, it appears that Indian courts do not want to confine themselves to one remedy and out rightly reject the other. A firm stance on which remedy is to be resorted to in cases of violation of personality rights remains undetermined. Due to the availability of a variety of tools, the situation in India at this point in time can be said to be a bit confusing and baffling due to several overlapping remedies. A meaningful implementation of the legislative purpose of these provisions is only possible if pragmatic and consistent standards are set by the judiciary in dealing with passing off actions involving famous celebrities.

V. ANNEXURE 1

LEGAL REMEDY	RIGHT TO PRIVACY	RIGHT TO PERSONALITY	RIGHT TO PUBLICITY
LEGAL ELEMENTS	As per Samuel Warren and Louis Brandeis, all persons have the basic personal freedom and right	Personality forms part of an individual's identity via which they recognize their place in society.	To sue for the right of publicity, the party has to show immense reputation and that the action of defendants

¹⁵⁸ See *Raja Pocket Books v Radha Pocket Books* 1996 SCC OnLine Del 851 (Defendant's comic series character "NAGESH" was found to infringe copyright in the plaintiff's popular comic series character titled "NAGRAJ" over similarity in artistic manner).

¹⁵⁹ *Shivaji* (n 35).

¹⁶⁰ See *Tata Sons Ltd v Aniket Singh* 2015 SCC OnLine Del 13728.

	<p>of privacy, known as the 'Right to be let alone.'¹⁶¹ A subset of right of personality, right of privacy recognises the right of persons to prevent unreasonable intrusion.</p> <p>Privacy rights consist of following elements, 1. right to prevent intrusion upon the person's seclusion or solitude or into his private affairs, 2. right against public disclosure of embarrassing private facts about the person, 3. right against publicity which places the plaintiff in a false light in the public eye, 4. right against appropriation, for the defendant's advantage, of the person's name or likeness. India follows a three-pronged test required for the encroachment of any Article 21 right – legality-i.e., through an existing law; necessity, in terms</p>	<p>An individual invests efforts and conscious care via their actions and contributions to society to set expectations about themselves in the eyes of others. This personhood approach is derived from theories of Kant and Hegel, who viewed private property as embodiment of the personality. Out of this personality emanates the right to prohibit undue interference into the person's private sphere and to prohibit unjust or unauthorised manipulation of the individual's personality. Right of personality and right of publicity overlap in India. Right of publicity can, in a jurisprudential sense, be located within the individual's right and autonomy to permit or prohibit the commercial exploitation of his likeness or some attributes of his personality.</p>	<p>caused damage to such reputation. Infringement of the right of publicity does not require any proof of falsity, confusion, or deception, especially when the celebrity is identifiable.¹⁶² There is a subtle overlap between personality and publicity, i.e., the theory and justification for personality rights gives a leeway to publicity rights, which is an extension of personality.</p> <p>Further, at times it is also claimed that publicity and privacy claims overlap. However, the difference is privacy plaintiffs are concerned with unwanted intrusions into their personal lives,</p>
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¹⁶¹ Louis D. Brandeis and Samuel D. Warren (n 26).

¹⁶² Even though the Trade Marks Act does not make any specific provision for publicity rights, its definition of 'marks' includes names within its ambit. Hence, a number of celebrities have resorted to using the pre-emptive step of trade marking their names to stall any misuse.

	of a legitimate state objective and proportionality, that ensures a rational nexus between the object of the invasion and the means adopted to achieve that object. ¹⁶³		while publicity plaintiffs complain of uncompensated exploitation of their identities, making privacy remedies inadequate. ¹⁶⁴
POSITION IN INDIA	The right to privacy is protected as an intrinsic part of the right to life and personal liberty under Article 21 ¹⁶⁵ and as a part of the freedoms guaranteed by Part III of the Constitution. Although the right to publicity comes under the extended view of Article 21, this right is not absolute; reasonable restrictions can be placed thereon in public interest under Article 19(5). Further, freedom of speech and expression also includes freedom of press and the right to acquire and disseminate information, under Article 19(1) (a). Celebrities have voiced their resistance against this on grounds that	Few Indian High Courts have identified such rights as vesting in public figures by virtue of them having acquired a status and a personality that adds commercial value to their individual persona. But generally, personality rights tend not to be recognized as distinct legal rights but are instead recognized through the rights to privacy and publicity. Given the hype around celebrities, influence they hold and curiosity surrounding them, the media at times violates the personality rights of celebrities. The media either associates them with some product or activity that runs	High Courts have attempted to recognise the right of publicity. The same has evolved from the right of privacy and can only exist in an individual or an individual's personality like his name, personality trait, signature, voice, etc. Courts have laid down that in order to claim infringement of right to publicity, the plaintiff as a celebrity must be identifiable from the unauthorised use of the defendant.

¹⁶³ *K.S. Puttaswamy* (n 38).

¹⁶⁴ Melville B. Nimmer (n 8).

¹⁶⁵ Art 21 of the Constitution of India, 1950 provides that, "No person shall be deprived of his life or personal liberty except according to procedure established by law."

	under the garb of this freedom, media has violated their privacy.	contrary to or turns out to be harmful for the personality of the celebrity. In such cases, action of defamation can be sought and the celebrity could claim that their image has been tarnished.	
RELATIONSHIP WITH PASSING OFF REMEDY IN INDIA	<p>People generally tend to personalize celebrities and become curious about every personal aspect of their lives. The public has a huge appetite for gossip and scandal and that leads to hyping up of even the smallest of incidents that surround celebrities. Celebrities in turn try to control their personal information since the disclosure of the same might put them in a situation of embarrassment or humiliation resulting in a feeling of insecurity. Passing off cannot be termed to be a direct product of the right to privacy but can be through the right to personality</p>	<p>The 'wrongful appropriation of personality' could amount to passing off as the celebrity could be said to have a proprietary right in the exclusive marketing for gain in his personality. Indian law recognizes personality rights only when the character or the person has independently acquired public recognition¹⁶⁶</p>	<p>Right to publicity is a right to exploit the economic value of the name and fame of an individual. To claim this right, it is necessary to establish that fame is a form of merchandise. Hence, if someone uses the fame of a celebrity to promote his goods it would be termed as an unfair trade practice, misappropriation of intellectual property, or an act of passing off.</p>

¹⁶⁶ See text on [14].