

RE-THINKING CELEBRITY DOMAIN NAME ARBITRATION IN INDIA: ENFORCING THE RIGHT OF PUBLICITY THROUGH PRIVATE DISPUTE RESOLUTION *

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Abstract

In the recent past, there have been several cases of ‘cyber-squatting’ of celebrity names by Indian domain name holders. Almost decade ago, former US President and entrepreneur Donald Trump sought damages to the tune of USD 400000 against a Brooklyn-based man for having acquired and registered domain names ‘trumpindia.com’ and ‘trumpmumbai.com’ after it was announced in 2007 that the real estate mogul had plans to set up Trump-hotels in India in Delhi, Mumbai and Bangalore. Even before that, Hollywood actress and Academy Award winner, Julia Roberts faced a slew of cyber-squatters from India, having attempted to acquire domain name registration of her own, very identifiable name. More recently, Mark Zuckerberg paid a sum of USD 700 to purchase the domain “maxchanzuckerberg.com” from a boy in Kochi, who proudly admitted to having registered not one, but more such names, even “hashtagging” his Facebook status update with “#cyber_squatting!”.

Most cases of domain name cyber-squatting are resolved via the INDRP dispute resolution rules, an alternative dispute resolution mechanism for ‘.in’ domain names in India; or at the WIPO Arbitration and Mediation Centre, following the UDRP Rules. However, this paper seeks to address the question of right of publicity of the celebrities whose names have been misappropriated by the cyber-squatters. While remedies against unlawful taking of domain names may be claimed under Trademark Law or the common law passing off doctrine, more often than not, these cases also raise concerns of right of publicity. For example, in the case of the “tatacyrusmistry.com” domain name, the WIPO Tribunal did, albeit in passing, bring up the rights of publicity of the plaintiff, in furtherance of observations of the Delhi High Court (‘Delhi HC’). The right of publicity, most simply put, protects any individual’s marketable image or persona. While the right has always been envisaged as an economic right in India, similar to, however distinct from the passing -off remedy, Justice Kaul, in his separate opinion in the Supreme Court’s Puttaswamy decision, (that clarified the position of the right to privacy as a fundamental right guaranteed under Part III of the Constitution), went a step further. He elevated the right of publicity, otherwise having been previously enunciated only as a common law right,¹ to a being a facet of the fundamental guarantee of privacy.

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¹ Titan Industries Ltd. v M/s Ramkumar Jewellers, CS(OS) No.2662/2011, Delhi HC Decision of April 26, 2012 (“Titan case”); D.M. Entertainment Pvt. Ltd. v Baby Gift House and Ors, CS(OS) 893/2002, Delhi HC Decision of April 29, 2010 (“Daler Mehndi case”)

The conception of fundamental rights has always carried with itself its inherent inalienability, as opposed to the conception of property rights, which carries with itself a distinct characteristic of transferability. Thus, while most property disputes are arbitrable, including private disputes in relation to intellectual property,² questions of fundamental rights are NOT open to adjudication by private methods, as they relate to rights in rem and not rights in personam.³

This paper shall thus address the nature of the right of publicity, and whether Justice Kaul made an inadvertent error in equating an economic in personam interest to a fundamental right, an in rem interest, that is otherwise nonarbitrable, in light of the celebrity domain name arbitration cases. In reaching this conclusion, the paper shall look at both the primary rules and case rulings under the WIPO-UDRP, the auDRP and the INDRP as well as court decisions in India on personal name trademarks and passing off, alongside other case studies of actual practice and secondary materials such as other scholarly works on personality rights and personal domain name arbitration; thereby seeking to propose a methodology of how and why private arbitral tribunals can address right of publicity claims, as they continue to do.

Keywords: Arbitrability of IPR, Celebrity Domain Names, Cyber Squatting, Right of Publicity

1. Introduction

*“The internet is all-pervasive. With the internet today transcending all national boundaries, the protection of IP and penalising its infringement over the ‘world-wide-web’ has become even more difficult, given the territorial nature of the grant of the intellectual property right.”*⁴ In the fast-growing cyber space, it comes as no surprise that with an increase in e-commerce and e-commerce platforms on the World Wide Web, cyber-squatting is also on the rise, especially in India.⁵ It came to be reported in 2016 that over 700 domains with ‘.in’ and ‘.co.in’ were handed over to legitimate owners from illegal registrants in the past decade by NIXI – the National Internet Exchange of India (NIXI), an autonomous regulator for domain names in India.⁶ While the aforementioned is the more familiar, traditional and rampant form of cybersquatting, that includes *“the registration used for trafficking in the domain name corresponding to the trademark of another with a bad faith intent to profit from that trademark of another,”*⁷ it has also come to be increasingly observed that personal names of well-known persons – be it in the sporting, entertainment or even the public service industries (politics included), are being registered and held by unauthorised persons. In the recent past, there have been several cases of ‘cyber-squatting’ of Indian celebrity names and by Indian domain name holders. It was over half a decade ago that former US President Donald Trump sought damages to the tune of USD 400000 against a Brooklyn-based man for having acquired and registered domain names ‘trumpindia.com’ and ‘trumpmumbai.com’ after it was announced in 2007 that the real estate mogul

² Eros International v. Telemex Links India, 2016 SCC OnLine Bom 2179.

³ Booz Allen & Hamilton Inc v. SBI Home Finance Limited & Ors., AIR 2011 SC 2507 (“Booz Allen”)

⁴ Aakanksha Kumar, *Internet Intermediary (ISP) Liability for Contributory Copyright Infringement in USA and India: Lack of Uniformity as a Trade Barrier* 19(4) JIPR 272 (July 2014).

⁵ Rasul Bailey, As e-commerce grows, so does cybersquatting, ECONOMIC TIMES (January 21, 2016) http://economictimes.indiatimes.com/articleshow/50661553.cms?utm_source=contentofinterest&utm_medium=text&utm_campaign=cppst

⁶ *Ibid.*

⁷ Cybersquatting On Personal Names, Traverse Legal (September 27, 2013) <https://www.traverselegal.com/blog/cybersquatting-on-personal-names/>

had plans to set up Trump-hotels in India in Delhi, Mumbai and Bangalore.⁸ Even before that, Hollywood actress and Academy Award winner Julia Roberts faced a slew of cyber-squatters from India, having attempted to acquire domain name registration of her own, very identifiable name.⁹ More recently, Mark Zuckerberg paid a sum of USD 700 to purchase the domain ‘maxchanzuckerberg.com’ from a boy in Kochi, who proudly admitted to having registered not one, but more such names, even “hash tagging” his Facebook status update with “#cyber_squatting!”.¹⁰

Most cases of domain name cyber-squatting are resolved via the INDRP (.IN Domain Name Dispute Resolution Policy) dispute resolution rules, an alternative dispute resolution mechanism for ‘.in’ domain names in India; or at the WIPO’s (World Intellectual Property Organisation) Arbitration and Mediation Centre, following the UDRP (Uniform Domain-Name Dispute-Resolution Policy of the ICANN - Internet Corporation for Assigned Names and Numbers) Rules. However, this paper seeks to address the question of the other right that becomes entangled in such cases of cyber-squatting, i.e. the *right of publicity* of the celebrities whose names have been misappropriated by the cyber-squatters. Thus., while remedies against unlawful taking of domain names may be claimed under the trademark law or the common law passing off doctrine, more often than not, these cases also raise concerns of *right of publicity*. On August 24, 2017, the Supreme Court of India, issued a seminal decision¹¹, clarifying finally, the position of the *right to privacy* under Indian law as a fundamental right of all citizens, guaranteed under Part III of the Constitution. In his separate opinion, Justice Kaul went a step further and elevated the *right of publicity*, otherwise having been previously enunciated only as a common law right¹² to a being a facet of the fundamental guarantee of privacy. It is with this opinion that the researcher chooses to respectfully disagree, while highlighting specifically, cases where personal names have seen ADR procedures successfully adopted in domain name cyber-squatting matters.

The above argument comes in light of the fact that the conception of fundamental rights has always carried with itself its inherent inalienability, as opposed to the conception of property rights, which carries with itself a distinct characteristic of transferability. The *right of publicity*, as distinct from its privacy moorings¹³, is now recognised as a stand-alone right in several states in the USA¹⁴ and also as a manifestation of the common law tort of passing off, in Indian case law interpretation¹⁵. It has thus been enunciated as an intellectual property right, capable of licensing – as was the background in the *Titan case* wherein the Bachchans had transferred their *right of publicity* to Titan for their endorsement of the Tanishq Jewellery brand. In India, the test case for whether a subject

⁸ Laura Ly, Trump seeks damages in 'cybersquatting' case, CNN. <https://edition.cnn.com/2013/03/31/us/new-york-trump-lawsuit> (April 1, 2013)

⁹ Arik Hesseldahl, Legal battle being waged over Juliaroberts.com, FORBES <https://www.forbes.com/2000/06/05/mu3.html> (June 5, 2000)

¹⁰ Mark Zuckerberg Buys Domain Name from Engineering Student in Kochi, TIMES OF INDIA (April 16, 2016) http://timesofindia.indiatimes.com/articleshow/51847179.cms?utm_source=contentofinterest&utm_medium=text&utm_campaign=cppst

¹¹ K.S. Puttaswamy and Anr v. Union of India (2017) 10 SCC 1 (“Puttaswamy Case”).

¹² Refer Titan case, Daler Mehndi Case, *Supra* note 1.

¹³ Sheldon W Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS LAW JOURNAL 853 (1995), See also Opinion of Circuit Judge Frank in Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc, 202 F.2d 866 (2d Cir. 1953), at para 2. “. We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i. e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i. e., without an accompanying transfer of a business or of anything else.” (“Haelan case”)

¹⁴ Currently, 25 states have some form of right of publicity statute, with Louisiana, Alabama, Arkansas, New York and South Dakota among the most recent to pass a Right of Publicity legislation.’ Right of Publicity, (accessed Sep 23, 2022) <https://rightofpublicity.com/statutes>

¹⁵ Titan case, *Supra* note 1.

matter is objective arbitrable (objective arbitrability (or “arbitrability *ratione materiae*”) focuses on whether a certain subject-matter can be settled through arbitration), is the Supreme Court decision in *Booz Allen*¹⁶, wherein the right in question in the dispute to be referred to arbitration, needs to pass muster of the *in rem* versus *in personam* test. The *right of publicity*, as enunciated in India, by its very nature operates as an *in personam* right. Thus, its elevation to a fundamental right runs the risk of not just affecting its transferability, but also shifting a large chunk of dispute resolution cases away from the domain name ADR processes, back to the constitutional courts!

This paper, in the first part, shall look at a brief overview of the UDRP and the INDRP in relation to the types of disputes they cover and their applicability to personal name-domain name disputes, while also looking at sample cases (if any) that have dealt with, or addressed *right of publicity* issues. Part II of the paper shall look at the test for subject matter (objective) arbitrability in India, and case law that has addressed intellectual property arbitration in India. Part III of the paper shall look at the nature of the right of publicity in India and make the case for continuing ADR of *right of publicity* claims, as opposed to its enforcement as a fundamental right in the constitutional courts.

2. Personal name -Domain Name ADR: A Brief Overview

Most of the cases of personal domain name cyber-squatting are resolved under the trademark law in India, as unlike the USA¹⁷, India does not possess a special anti-cyber-squatting legislation. However, for a personal name owner to succeed against a cyber-squatter, it must be proved that there exists either a registered trademark in the personal name to claim statutory infringement, or that there are trademark rights in the nature of sustained goodwill to succeed in a common-law passing off action. Furthermore, instead of adopting the course of protracted trademark enforcement litigation, the legitimate owner of the personal name-domain name can also instead choose to seek an administrative remedy – an alternative dispute resolution (ADR) mechanism through the UDRP – which is the WIPO administered, ICANN mandated Policy. The UDRP is a global online dispute resolution procedure, incorporated into domain name registration agreements by reference such that domain name registrants are mandatorily bound to submit to an online arbitration if a third party complains about their *registration or use* of the domain name.¹⁸ Complaints are premised on the complainant’s assertion of trademark rights, compulsorily, corresponding with the relevant domain name.¹⁹

However, it may not always be the case that all legitimate personal names also have the requisite trademark rights to prove a case under the UDRP. In fact, this is a main distinguisher between claiming domain name protection for personal name rights under the UDRP, *versus* similar claims being brought under the core *right of publicity* regime. This has been explained in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions²⁰ to the effect that merely claiming ‘fame’ in a name, without the corresponding ‘trademark-like’ use being evidenced, would dis-entitle a celebrity plaintiff from bringing a UDRP cyber-squatting action.²¹ The WIPO Panel discussed this distinction in *The*

¹⁶ *Supra* note 3

¹⁷ The United States enacted the Anti-cybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125(d) in 1999. A detailed discussion on the ACPA is beyond the scope of this paper.

¹⁸ UDRP, Para 1, available at : <https://www.icann.org/resources/pages/policy-2012-02-25-en>

¹⁹ UDRP, Para 4.

²⁰ WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) available at : <https://www.wipo.int/amc/en/domains/search/overview3.0/#item13>

²¹ *Id.* At para 1.5.2 – “The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like

*Estate of Cheri Blum v. k, j*²², (“Cheri Blum Case”) answering the question of when and how can an un-registered personal name claim *trademark* rights under common law. It is pertinent to note here that the WIPO-UDRP Panel still requires showing trademark rights. The Panel has further observed : - “*distinction is made between trademark protection and the right of publicity. The difference, as noted in J. Thomas McCarthy’s well-known treatise, largely stems from the historical fact that the right of publicity had its origins in the law of “privacy,” whereas the law of trademarks had its origins in the tort of fraud. While the key to the right of publicity is the commercial value of a human identity, the key to the law of trademarks is the use of a word or symbol in such a way that it identifies and distinguishes a commercial source. Thus, while a trademark identifies and distinguishes a commercial source of goods and services, the “persona” protected by right of publicity law identifies a human being.*”²³

Thus, personal names may or may not really be ‘trademarked’.²⁴ Instead, the emerging right that protects personal names, is either the statutorily recognised (as in some states in USA) or common law, *sui generis* right – the *right of publicity*. The *right of publicity*, most simply put, protects any individual’s *marketable image or persona*. This formulation has been most succinctly put forth by McCarthy in his seminal work as – “*The right of publicity is not merely a legal right of the “celebrity,” but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.*”²⁵

In India, the ‘.INRegistry’ (set up by NIXI, the National Internet Exchange of India), functions as an autonomous body with the primary responsibility of maintaining the ‘.IN ccTLD’ and ‘*ensuring its operational stability*’²⁶. Registration can be sought and is made available to all parties from anywhere in the world, without requiring any other additional criteria to be fulfilled. The Registry had also published the INDRP -.IN Dispute Resolution Policy - which is also an online arbitration mechanism, that explains what types of disputes can be brought, and the criteria that will be considered by the arbitrators.²⁷ Interestingly, while the policy only covers “*a dispute between the Registrant and the Complainant, arising out of the registration and use of the .in Internet Domain Name*”²⁸ it is not as restrictive as the UDRP, in that it does not mandate trademark rights to be shown by the complainant.

Para 4 of the INDRP provides thus:

identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant’s goods or services.

Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint”.

²² WIPO Arbitration and Mediation Center, Case No. D2006-0103, *citing* Julia Fiona Roberts v. Russell Boyd, WIPO Case No. D2000-0210; Jeanette Winterson v. Mark Hogarth, WIPO Case No. D2000-0235; Dr. Michael Crichton v. In Stealth Mode, WIPO Case D2002-0874; Daniel C. Marino, Jr. v. Video Images Productions, et al. WIPO Case No. D2000-0598; Israel Harold Asper v. Communication X Inc, WIPO Case No. D2001-0540; Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems, WIPO Case No. D2000-0858; and Ahmanson Land Company v. Vince Curtis, WIPO Case No. D2000-0859.

²³ *Id.* at para 6.1.

²⁴ Jacqueline D. Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes*, 65 WASH. & LEE L. REV. 1445, 1449. (2008).

²⁵ J. THOMAS MCCARTHY, *RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2nd ed. 2005).

²⁶ Read more about the .INRegistry, here - <https://www.registry.in/about/in-registry>

²⁷ The .IN Domain Name Dispute Resolution Policy (INDRP), available at:

<https://www.registry.in/policies/dispute-resolution>

²⁸ INDRP, Para 2.

“Types of Disputes

Any Person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

(i) the Registrant’s domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(ii) the Registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the Registrant’s domain name has been registered or is being used in bad faith.

The Registrant is required to submit to a mandatory Arbitration proceeding in the event that a Complainant files a complaint to the .IN Registry, in compliance with this Policy and Rules thereunder.”

Thus, the INDRP does allow a complainant to show interest in a ‘name’ and not necessarily that the ‘name’ be a registered trademark. However, the pitfall of the INDRP remains that it is only for ‘.in’ domain names. On the contrary, the UDRP is broader in scope, with its coverage including “*second-level domain name registrations in the following gTLDs: .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and travel. The UDRP also applies to all New gTLDs.*”²⁹

While the decisions under the INDRP till date have not addressed the question of the *right of publicity* in personal names of famous persons, there have been decisions that have addressed the trademark rights in well-known personal names. For example, in *Kenneth Cole Productions Inc v. Viswas Infomedia*³⁰, the NIXI arbitral tribunal held that it was not necessary for the complainant to have a registered domain name bearing the well-known personal name and that the registrant’s use and registration of the domain name <kennethcole.in> was in bad faith, as it wholly incorporated the personal name registered trademark of the complainant. Earlier in the same year, in the case of *G.A. Modefine S.A. v. Naveen Tiwari trading as MKHOJ*,³¹ the sole arbitrator held that when the complainant had been trading under registration of personal name “ARMANI”, and given the fact that it had acquired well-known status, the mere fact of non- renewal of disputed domain name <armani.co.in> in 2007 by the complainant had not entitled the Respondent to adopt, register and use it. The sole arbitrator held that “*Even in the absence of prior adoption of disputed domain name <armani.co.in> the Complainant is entitled to take action against the Respondent. It is because the disputed domain name <armani.co.in> wholly incorporates the prior registered well-known trademark ARMANI of the Complainant.*”³² Similarly, in the case of *Ray Marks Co. LLC v Rachel Ray Techniques Pvt. Ltd*³³ the sole arbitrator transferred the disputed domain name <RACHELRAY.IN > to the complainants, on the finding that a mere spelling change was not enough to remove the likelihood of confusion based on the visual and phonetic similarity. Furthermore, the tribunal found that given that Ms. Rachel Ray was a well-known television personality, celebrity chef, talk show host and author, “*that only purpose for the registration of the disputed domain name was to capitalise on*

²⁹ Domain Name Dispute Resolution Service for Generic Top-Level Domains, WIPO available at: <https://www.wipo.int/amc/en/domains/gtld/>

³⁰ *Kenneth Cole Productions Inc v. Viswas Infomedia Respondent*, NIXI Award dated April 10, 2009.

³¹ *G.A. Modefine S.A. v. Naveen Tiwari trading as MKHOJ*, NIXI Award dated February 20, 2009.

³² *Id.* at para 5.16.

³³ *Ray Marks Co. LLC v Rachel Ray Techniques Pvt. Ltd.*, NIXI Award dated July 9, 2011.

the fame and reputation of Complainant and to make monetary benefit. The Respondent has got registered and used the disputed domain name in bad faith."³⁴

The WIPO -UDRP cases, specifically in relation to name rights of Indian famous persons, are equally intriguing. A few have if not directly, then in passing, addressed the question of *right of publicity* (this is in comparison to personal name as domain name cases of American famous persons being discussed under both trademark as well as the *right of publicity* regimes; distinguishable from each other, by the WIPO UDRP Panel³⁵). The most relevant case on this point relates to the disputed domain name <barkhadutt.com>³⁶. Famous Indian TV journalist and public figure, Barkha Dutt unfortunately found that her name had been cyber-squatted on by the respondent who claimed that her name wasn't distinctive, as it comprised of two Sanskrit words, combined to mean "rain/life giving". The WIPO sole arbitrator, while finding for the complainant, alluded to Barkha Dutt's name being famous, and that due to her easy public identifiability her consistent use of her name – the name had trademark status. Furthermore, the WIPO Sole arbitrator mentioned that – "*It is well recognized that a celebrity is entitled to the right of exploiting the economic value of his/her name and fame. Publicity rights are recognized as genre of intellectual property rights and are considered a reward or incentive for the celebrity's work, which can be used by the celebrity to derive monetary benefits through endorsements or merchandising products or services. Such rights are assignable and inheritable rights...The right to commercially use or exploit one's own name, vests with the person who has worked to create the fame and can lawfully restrict any other third party from exploiting that fame for commercial purposes.*"³⁷

Another interesting case, that forms part of a series of disputes regarding the Tata and Cyrus Mistry name-trademarks and domain names, relates to the disputed domain name - <tatacyrusmistry.com>.³⁸ The complainants had armed themselves with an earlier Delhi HC order granting *ex parte ad interim* injunction in their favour in the matter of *Tata Sons Ltd. & Anr. v. Mr. Dharmendrai.*³⁹ The defendant in that case had got registered the domain name <cyruspallonjimistry.com> on November 24, 2011, i.e., a day after the complainant's official public announcement of the appointment of Mr. Cyrus Mistry as its Deputy Chairman. The Delhi HC restrained the defendant from using the names Cyrus Pallonji Mistry or any other deceptively similar variant thereto amounting to invasion of the right to publicity/privacy of Mr. Mistry. The WIPO arbitral tribunal accepted the reliance on this case, and while the final ruling did not address the *right of publicity*, nonetheless, the arguments led by the complainants were entertained.⁴⁰

The aforementioned WIPO dispute arose *before* the Delhi HC decision in *Tata Sons Limited & Anr v. Aniket Singh*⁴¹. The Delhi HC matter dealt with two different domain names, viz. <cyrusmistry.co.uk> and <cyrusmistry.com>, wherein the plaintiffs, *inter alia*, sought a remedy against continued infringement of *right of publicity*. Citing the *Titan* and *Daler Mehndi* cases, the court recognised the *right of publicity* as a facet of the IP rights possessed by the Plaintiff and found that the continued use and registration by the defendant of the aforementioned domain names, was "*with the mala-fide and ulterior motive of holding the Plaintiffs to ransom and thereafter with the evil intention of extorting huge amounts of money from the plaintiffs...Such acts of the defendant amount to invasion of the right to publicity/privacy rights of Mr. Mistry, as well as passing off in right to protect his name,*

³⁴ *Id.* at para .21.

³⁵ Refer Cheri Blum Case, Supra note 22.

³⁶ Ms.Barkha Dutt v. Easyticket, WIPO Arbitration and Mediation Center, Case No D2009-1247.

³⁷ *Id.* at para 6.C

³⁸ Tata Sons Limited v. Deep Bhasin/PrivacyProtect.org, WIPO Arbitration and Mediation Center, Case No. D2012-2188.

³⁹ Tata Sons Ltd. & Anr. v. Mr. Dharmendra, CS(OS) No. 2963/2011.

⁴⁰ Tata Sons Limited v. Deep Bhasin/PrivacyProtect.org, Supra note 38 at para 5(A).

⁴¹ Tata Sons Limited & Anr v. Aniket Singh, CS(OS) 681/2012, Delhi HC Decision dated November 17, 2015.

persona or anything emanating out of these as enshrined in Article 21 of the Indian Constitution... it is a well settled position of law as has been upheld in a catena of judgments and judicial pronouncements of this court as well as of the Supreme Court that trademark law today extends to cover the Internet and that domain names deserve protection just like trademark and that personal names forming apart thereof constitute no exception. The same is necessary in order to prevent cyber-squatting or trafficking or trading in domain names or marks, involving well-known trademarks/personal names.”⁴²

An interesting parallel to draw at this juncture is Australia – that does not recognize any stand-alone *right of publicity* – either in statute or in common law. Australia’s .au Dispute Resolution Policy (auDRP), of the auDA (.au Domain Administration Limited. Rule 4(1)(a) reads *identical* to the INDRP, in that it requires submitting to the mandatory procedure if :

“(i) your domain name is identical or confusingly similar to a name [Note 1], trademark or service mark in which the complainant has rights; and...

...

Notes:

[1] For the purposes of this policy, auDA has determined that a "name ... in which the complainant has rights" refers to:

...

b) the complainant's personal name.”

This seems to, in plain reading of the text suggest that, even under the auDRP, like the UDRP, *trademark-style* rights must be shown, and claims of rights in famous persons’ personal names being used without authorization; without themselves having used the name as a trademark, would not lead to a successful claim. However, importantly, when the Australian domain names decisions are considered, they have even recognised rights in personal names where the complainant had not traded under his/her name; or where the complainant had no common law trademark rights by showing trademark-style use in the course of a business or vocation; or registered trademark rights. This is illustrated best by the decision in *Shane Keith Warne v Sure Thing Services Pty Ltd*,⁴³. The disputed domain names <warnie.com.au> and <warney.com.au> were claimed to have led to the creation of a false endorsement leading to a likelihood of confusion, as not only the domain name itself, but also the content on the website carried images of the famous celebrity cricketer, the late Shane Warne, alongside – “*products featuring his likeness, slogans such as “WARNEY FOR P.M.”, a statement that “donations go toward the Shane Warne Foundation (Charity for sick children)”*, a reference to “*VB WARNIE DOLLS*” (which alludes to one of the Complainant’s well known sponsorship arrangements with the brewer of VB beer) and a statement that “*Shane Warne, one of Australia’s most prominent and successful cricket players, seems to have taken up new business ventures*”⁴⁴

The claim also established rights in the nicknames being cyber-squatted on by the defendant by arguing that there are common law trademark rights in these nicknames for the complainant’s “celebrity services”. The Panel’s findings suggest that the requirement to prove unauthorized taking under auDRP includes not only absolute establishment over the right for trademarks, but also offers

⁴² *Id.* at paras 32-34.

⁴³ LEADR Case No auDRP10/08 (May 26, 2010)

⁴⁴ *Id.* at page 3, para 5.A.

the complainant a special provision that if the panel is entirely satisfied that the Complainant's rights over the title, then the panel can reconsider the status of the trademark with the respondent.⁴⁵ This conclusion is reached by the panel's consideration that the defendants did intend to leave the internet users confused because of a celebrity's affiliation, more so because of acquired *fame and notoriety* by the complainant.⁴⁶

Most recently, an equally illuminating decision, in a non-famous personal-name as domain name case was handed down by the Resolution Institute's Administrative Panel in *Varinder Singh Toor trading as Vicky Driving School Melbourne v Vikas Sharma*.⁴⁷ The disputed domain name is <vickydrivingschool.net.au>. Here, while the complainant had registered trademark rights in VICKY DRIVING SCHOOL and thus, the impugned domain name was found to be identical, nonetheless, the Panel found that unfortunately, the complainant had not been able to show common law rights in the name "Vicky" itself as it's a common nickname; "Driving School" is a descriptive expression and the complainant had not brought evidence on record to show that he had used VICKY DRIVING SCHOOL between 2012 and 2015 as claimed.⁴⁸ Thus, the domain name was allowed to be registered with the respondent. This case shows how "fame and notoriety" accrue to names that are more famous, without showing trademark use on the one hand, enabling successful actions; and common first name-personal names need to satisfy a heightened burden of proof to claim common law rights even in domain-name actions. Nonetheless, the bottom line remains that even the Australian practice shows that rights in the name as an indicia of persona of an individual, is treated as an intellectual property style right, and is hence a *right in personam*.

Further, it is submitted and argued that personal names of famous persons, whether or not used in the course of trade or vocation of these (mostly) famous individuals, constitute private rights in the nature of either trademark rights or are protectable through the *right of publicity* (without having to show trademark style rights). Thus, while *common law trademark-style rights* are protectable under a *misrepresentation regime* of the *passing-off* remedy, the *common law right of publicity* is protectable under a *misappropriation regime*. This right is not tantamount to a fundamental, inalienable, non-descendible right. Instead, in India, the claim for protection of personal names used in the course of trade, operates as a tortious claim like that of *passing off*, *misrepresentation*, or the gradually recognised, stand-alone, *misappropriation-type* common law claim of the *right of publicity*. Such rights are thus transferrable (license, not complete assignment)⁴⁹ and descendible⁵⁰, like an *intellectual property-type – economic right* – in the *economic associative value* of an individual's persona⁵¹.

3. Subject-matter arbitrability in India and the specific question of IPR – Arbitrability

⁴⁵ *Id* at page 7, para 2

⁴⁶ *Id* at page 8, para 4

⁴⁷ RI-auDRP03/22 (June 7, 2022).

⁴⁸ *Id* at page 9, para 2

⁴⁹ Refer facts in *Titan case and Daler Mehndi Case*, *Supra* note 1. The claims seeking protection and enforcement of the Right of Publicity were brought not by the individual celebrities but the legal entities in whom such right had been vested.

⁵⁰ The potential descendability of the right of publicity has been recognized by the Bombay HC in its *dicta* in *Chitra Jagjit Singh v Panache Media*, 2016. It is also currently in dispute before the Delhi HC and has been discussed in the *dicta* in the interim order of the court in *Krishna Kishore Singh v. Sarla S. Sarogi & Ors.*, CS(COMM) 187 OF 2021, Decision of Delhi HC on June 10, 2021.

⁵¹ David Tan, 'Beyond Trademark Law: What the Right of Publicity Can Learn From Cultural Studies' (2008) 25 CARDOZO ARTS & ENTERTAINMENT LAW JOURNAL 913 at 959 ("Tan, 2008")

The law of the land in India regarding the test for subject-matter arbitrability is the decision of the Supreme Court in *Booz Allen*⁵². The court observed, “...Generally and traditionally all disputes relating to rights in personam are considered to be amenable to arbitration; and all disputes relating to rights in rem are required to be adjudicated by courts and public tribunals, being unsuited for private arbitration. This is not, however a rigid or inflexible rule. Disputes relating to sub-ordinate rights in personam arising from rights in rem have always been considered to be arbitrable.”⁵³ Thus, it created the test of the *in rem* right versus *in personam* right, to answer the question of whether a particular subject matter was capable of settlement by arbitration. Much earlier, Justice Raveendran, in the landmark ADR case law in India, *M/S. Afcons Infra. Ltd. & Anr v. M/S Cherian Varkey Construction*⁵⁴ highlighted types of matters considered suitable and not suitable for ADR Processes, given their nature.⁵⁵ He pointed out, *inter alia* that “All other suits and cases of civil nature” as well as “All cases relating to tortious liability” are capable of settlement through ADR processes. Thus, it would seem that the common law claims of infringement of *right of publicity* and common law passing off and statutory infringement claims seeking enforcement of trademark rights are capable of settlement by ADR processes.

This is further qualified by the opinion of Justice Patel of the Bombay HC in the matter of *Eros International v. Telex Links India*.⁵⁶ While the final ruling deals with the question of arbitrability of copyright infringement claims (answered in the affirmative), in his obiter observations, Justice Patel explained the nature of trademark disputes and how trademark oppositions may not be arbitrable. He propounded that registration creates a right *in rem*, whereas trademark infringements operate *inter parties* - i.e. between the legitimate proprietor-owner and the defendant-infringer of the mark, thereby creating an *in personam* dispute in issue, capable of settlement by arbitration.⁵⁷ Furthermore, the Madras HC, in the *Lifestyle Equities v. Odseatoman Designs*⁵⁸ case held that patent disputes can be arbitrable if the dispute is about the licensing or infringement of a patent, but a dispute challenging the validity of the patent will not be arbitrable – thereby clearly distinguishing between *in rem* and *in personam* rights, whereby *infringement* or *violation* related disputes are arbitrable.

The *Booz Allen* test came to be used as the yardstick against which the *arbitrability* question came to be answered, until late 2020, when a 3-judge bench of the Supreme Court in the *Vidya Drolia v. Durga Trading*⁵⁹ decision expounded the “four-fold test”. The court observed⁶⁰ :

“we would like to propound a **four-fold test** for determining when the subject matter of a dispute in an arbitration agreement is not arbitrable:

(1) when cause of action and subject matter of the dispute relates to actions in rem, that do not pertain to subordinate rights in personam that arise from rights in rem.

(2) when cause of action and subject matter of the dispute affects third party rights; have erga omnes effect; require centralised adjudication, and mutual adjudication would not be appropriate and enforceable;

⁵² *Supra*, note 3.

⁵³ *Id.* at para 23.

⁵⁴ *M/S. Afcons Infra. Ltd. & Anr v. M/S Cherian Varkey Construction*, (2010) 8 SCC 24.

⁵⁵ *Id.* at paras 18 and 19.

⁵⁶ *Eros International Media Ltd. v. Telex Links India Pvt. Ltd. & Ors.*, 2016 Bom CR 3.

⁵⁷ *Id.* at para 17.

⁵⁸ *Lifestyle Equities Cv v. Qdseatoman Designs Pvt. Ltd.*, (2017) 8 MLJ 385.

⁵⁹ *Vidya Drolia v. Durga Trading Corporation*, (2021) 2 SCC 1

⁶⁰ *Id.* at para 45.

(3) *when cause of action and subject matter of the dispute relates to inalienable sovereign and public interest functions of the State and hence mutual adjudication would be unenforceable; and*

(4) *when the subject-matter of the dispute is expressly or by necessary implication non-arbitrable as per mandatory statute(s).*

These tests are not watertight compartments; they dovetail and overlap, albeit when applied holistically and pragmatically will help and assist in determining and ascertaining with great degree of certainty when as per law in India, a dispute or subject matter is non-arbitrable.

The court further pointed out that questions of *grant* of patents and trademarks have “*erga omnes effect*”⁶¹ as they are state-protected monopolies, and therefore remain sovereign prerogative and are hence not-arbitrable. This observation led to some concerns being expressed about the arbitrability of IPR matters in India. However the Delhi HC clarified the standard applicable, in the case of *Hero Electric Vehicles Pvt. Ltd. & Anr. v. Lectro E-Mobility Pvt. Ltd. & Anr.*⁶² While addressing a question of unauthorised use of trademarks under a family group assignment, the court observed⁶³ -

*“The controversy, in the present case, does not relate to grant, or registration, of trademarks. The trademarks already stood granted, and registered, prior to the FSA and TMNA. The dispute is regarding the Family Group to which the rights to use the said trademarks, in connection with electric cycles and eFSA and TMNA. This assignment is by contractual, not statutory, fiat. It does not involve any exercise of sovereign functions (unless, of course, the patriarchs of the four Family Groups are, in a limited sense, to be regarded as “sovereigns”). **In any event, no inalienable exercise of sovereign governmental functions can be said to be involved, in the assignment, to the various Family Groups, of their individual rights to use the existing trademarks, in respect of one, or the other, categories of goods.** The dispute does not, therefore fall under any of the categories of disputes excepted, by the Supreme Court, from the arbitral umbrella.”*

In a similar tune, a judgement of the Delhi HC in *M/S. Golden Tobie Private Limited v. M/S. Golden Tobacco Limited.*⁶⁴ reaffirmed the arbitrability of trademark disputes vis-à-vis trademark license agreements. While the defendants sought to rely on the *Vidya Drolia* test to oppose arbitration, the Delhi HC, while relying on its earlier pronouncement in the case of *Hero Electric*, created a distinction between rights emanating from a contract or agreement as opposed to rights arising out of a statutory act or sovereign function. The former lie in the gamut of rights *in personam* as they do not have any *erga omnes* implications, i.e.; they are disputes between one party seeking relief against a particular party, and hence capable of arbitration. The court in *Golden Tobie*, further clarified that since the facts in dispute actually related to the contractual relationship, and not directly the trademark itself, the subject matter would be furthermore arbitrable.

Thus, from the above judgements, it can be concluded that the arbitrability of IP disputes is limited to claims arising out a contract or agreement that function as inter-party disputes, as settled in *Golden Tobie*. Conversely, resonating with Justice Patel’s obiter in *Eros* and the Madras HC’s decision in

⁶¹ *Id.* at para 32 and para 46.

⁶² *Hero Electric Vehicles Pvt. Ltd. v. Lectro E-Mobility Private Ltd*, 2021 SCC OnLine Del 1058

⁶³ *Id.*

⁶⁴ *M/S. Golden Tobie Private Limited v. M/S. Golden Tobacco Limited CS(COMM)178/2021*, Delhi HC Decision dated June 4, 2021 (“Golden Tobie”).

Lifestyle Equities,⁶⁵ while each of them deal with a different kind of intellectual property, it is clear that disputes arising out of registration and ownership of rights *in rem* are reserved for public adjudication, which operate as disputes related to the public at large and are asserted vis-à-vis the whole world, and hence precluded from the scope of arbitration.

At this juncture it is pertinent to note (and repeat) that, for a dispute to be capable of settlement by arbitration *simpliciter*, nonetheless, the underlying relationship may or may not be contractual⁶⁶. The test of arbitrability continues to remain the test of the nature of the dispute and the nature of the underlying rights.

4. Understanding Right of Publicity: A Brief Overview of the Development of the Right in India

As explained before, the *right of publicity*, most simply put, protects any individual's *marketable image or persona*. This formulation has been most succinctly put forth by McCarthy in his seminal work as – “*The right of publicity is not merely a legal right of the "celebrity," but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.*”⁶⁷ Since celebrities are, simply put, “*brokers of their personae and traders in their own identities*”,⁶⁸ these identities are exploitable assets with pecuniary worth, liable to legal protection. Prof. David Tan calls this the “*economic associative value*” that a celebrity brings to a brand when he/she chooses to exploit this image asset, through the transfer of the perceived attributes of the celebrity – for example, success, glamour, beauty and talent – directly to the brand he or she is associated with.⁶⁹ Also, the more well-known and more well-liked an individual, the greater will be the potential commercial value of that identity.⁷⁰ This right is more well-developed in the United States through the recognition of the common law *right of publicity*, as a “misappropriation tort” (as opposed to the misrepresentation tort, understood as the passing-off claim in trademark law)⁷¹; however, in many states statutory publicity rights are also granted.⁷²

The modern formulations of the *right of publicity*, even in the US, are traced back in almost all leading texts to the *right of privacy* espoused in the influential law review article by Warren and Brandeis in 1890.⁷³ The authors, “*lamenting technological and cultural developments invading the private sphere...advocated a right of privacy to forbid the publication of idle gossip and restore*

⁶⁵ Justice Patel's obiter in *Eros* explicitly recognises infringement claims as being inter-party disputes, creating rights *in personam* and thus being capable of settlement by arbitration. Further, in *Lifestyle Equities*, the Madras HC recognises the arbitrability of patent infringement claims on grounds of similar reasoning.

⁶⁶ Refer S.7(1) of the Arbitration and Conciliation Act, 1996 (India) – “(1) In this Part, “arbitration agreement” means an agreement by the parties to submit to arbitration all or certain disputes which have arisen or which may arise between them in respect of a defined legal relationship, **whether contractual or not.**” – based in Article 7 of the UNCITRAL Model Law on International Commercial Arbitration.

⁶⁷ McCarthy, *Supra* note 25.

⁶⁸ PATRICIA LOUGHLAN, BARBARA McDONALD AND ROBERT VAN KRIEKEN, *CELEBRITY AND THE LAW*, 27 (2010).

⁶⁹ Tan 2008, *Supra* note 51.

⁷⁰ *Vanna White v. Samsung Electronics America Ltd.*, 971 F.2d 1395, 1399 (9th Cir, 1992) (‘Vanna White, 1992’); David Tan, “Affective Transfer and the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity” (2010) 9 Va. Sports & Ent. L.J. 272 at 278.

⁷¹ Loughlan et al, *Supra* note 68 at 34-50. The misrepresentation tort is more used in Australia and UK, however, due to the vast expanse of case-law availability from circuit courts in the US, the judges in both these jurisdictions are becoming increasingly partial to the misappropriation tort formulation of the celebrity personality right.

⁷² For example, California Civil Code CIV Section 3344.; Article 5 of the New York Civil Rights Law *etc.*

⁷³ Samuel D. Warren and Louis D. Brandeis, *The Right to Privacy*, IV(5) Harv.L.Rev.193 (December, 1890)

*propriety and dignity to the press.”*⁷⁴ However, with time, as pointed out above, celebrities came to view the right as very limited, not proffering them the opportunity to protect the economic value in their image. Subsequently, in 1953, the New York 2nd Circuit Court formulated the common law *right of publicity* in the matter of *Haelan Laboratories*.⁷⁵ The court held thus: “*In addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i. e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i. e., without an accompanying transfer of a business or of anything else. Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolises the fact that courts enforce a claim which has pecuniary worth.*

*This right might be called a ‘right of publicity’, for it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorising advertisements, popularising their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures”*⁷⁶

In India, the earliest judicial enunciation of a similar right’s existence can be traced back to the Supreme Court’s formulation of the *right to privacy* in what is popularly known as the *Auto Shankar*’s case.⁷⁷ The court opined that – “*The right to privacy as an independent and distinctive concept originated in the field of Tort law, under which a new cause of action for damages resulting from unlawful invasion of privacy was recognised. This right has two aspects which are but two faces of the same coin (1) the general law of privacy which affords a tort action for damages resulting from an unlawful invasion of privacy and (2) the constitutional recognition given to the right to privacy which protects personal privacy against unlawful governmental invasion. The first aspect of this right must be said to have been violated where, for example, a person's name or likeness is used, without his consent, for advertising or non-advertising purposes or for that matter, his life story is written whether laudatory or otherwise and published without his consent.. In recent times... this right has acquired a constitutional status.... Right to privacy is not enumerated as a fundamental right in our Constitution but has been inferred from Article 21.*”⁷⁸

Highly unfortunately, in the opinion of this researcher, the course taken for recognition of a *right of publicity*, post the *Auto Shankar* case in India, has not been as advanced as that in the USA, despite India being home to one of largest and oldest entertainment industries in the world. As mentioned, the case law development to give way to a right formulated in economic asset/property value preservation terms, has been sporadic and limited. There is no Supreme Court decision recognising the common law right, and therefore, guidance is being sought from jurisprudence available from High Court decisions, most of which is now being contributed to by the pro-active Delhi Judiciary. One of the most important decisions in this regard, is the April 2012 single-judge decision in *Titan Industries Ltd. v M/s Ramkumar Jewellers*.⁷⁹ Justice Manmohan Singh, held thus “*When the identity of a famous personality is used in advertising without their permission, the complaint is not that no one should not*

⁷⁴ ROBERT P. MERGES, PETER S. MENELL AND MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1020 (2010) at 1020.

⁷⁵ *Haelan* case, *Supra* note 13.

⁷⁶ *Id.* at para 3.

⁷⁷ *R. Rajagopal v State of Tamil Nadu*, (1994) 6 SCC 632.

⁷⁸ *Id.* at 639, para 9.

⁷⁹ *Titan* case, *Supra* note 1.

commercialise their identity but that the right to control when, where and how their identity is used should vest with the famous personality. The right to control commercial use of human identity is the right to publicity".⁸⁰ This further cites and modifies an earlier decision of the court in a mark-merchandising-passing-off matter, *D.M. Entertainment Pvt. Ltd. v Baby Gift House and Ors.*,⁸¹ wherein the single judge had observed that "*The right of publicity can, in a jurisprudential sense, be located with the individual's right and autonomy to permit or not permit the commercial exploitation of his likeness or some attributes of his personality.*"⁸² Justice Ravindra Bhat, also explained that "*..to avail the right against the infringement of right to publicity, the plaintiff must be "identifiable" from defendant's unauthorised use...As a secondary consideration, it is necessary to show that the use must be sufficient, adequate or substantial to identify that the defendant is alleged to have appropriated the persona or some of its essential attributes.*"⁸³ Thereby, a two-step test for infringement of the right was laid out- that of 'identifiability' of the celebrity from the unauthorised use; and the "substantiveness" of the use so as to sufficiently qualify as misappropriation of the image or attributes of the celebrity plaintiff.

Interestingly, there is a seeming inconsistency between the decision in the *Daler Mehndi* case and the *Titan* case. While the *right of publicity* has been explicitly recognized in both, the standard to conclusively establish the existence of the right varies. In *Daler Mehndi* case, the right is perceived through the lens of appropriation of personality indicia of the well-known individual. By extension, mere evocation is not sufficient to constitute a violation of personality rights. As Justice Bhatt points out in the *Daler Mehndi* case, "*the right of publicity protects against the unauthorised appropriation of an individual's very persona which would result in **unearned commercial gain** to another. In the present instance, the **commercial use** of an individual's identity is intended to increase the sales of product by fusing the celebrity's identity with the product and thereby the defendants were selling those dolls, on the basis of publicity value or goodwill in the artist's persona into the product*".⁸⁴ Thus, commercial exploitation *qua* misappropriation forms the nucleus of the publicity infringement claim. In contrast, in the *Titan* case, Justice Manmohan, in culling out the methods to evidence identification of the celebrity-plaintiff observes that, "*If the plaintiff is very well known and widely recognised celebrity a simple comparison of the defendant's use and the plaintiff's identifying features may itself be sufficient to create a strong inference of identifiability. This is termed as unaided identification.*"⁸⁵ Therefore, per the two-step test, the "identifiability" threshold of the plaintiff is satisfied even if there is a mere comparison of the defendant's use and the plaintiff's identifying feature, subject to the plaintiff being well-known, thus implying that *evocation* by itself is enough to amount to a transgression of the plaintiff's *right of publicity*. The author acknowledges that both these decisions, though certainly valuable in their explanations of the applicable standards, are only single-judge decisions from a High Court – thereby have only persuasive value outside the jurisdiction. The jurisprudence of the *right of publicity* in India, is still to evolve and reconcile the standards of identifiability.

Nonetheless, this absence of an explicit statutory recognition of the *right of publicity* in India, allows the right to be claimed and made actionable through different avenues. In *Shivaji Rao Gaekwad v. Varsha Productions*⁸⁶, the plaintiff, more commonly known as 'Superstar Rajinikanth', claimed violation of his *right of publicity*, while also bringing in claims under the common law action of

⁸⁰ *Id.* at para 15.II *citing*, Haelan Laboratories, *Supra* note 13.

⁸¹ *Daler Mehndi* case, *Supra* note 1.

⁸² *Id.* at para 14.

⁸³ *Id.* at para 13.

⁸⁴ *Id.*

⁸⁵ *Id.* at para 15.

⁸⁶ *Shivaji Rao Gaekwad v. Varsha Productions* 2015 SCC OnLine Mad 158.

passing-off as well as civil defamation. Transplanting the thresholds of identifiability from *Titan Industries*, Justice Subbiah of the Madras HC explained that “*infringement of right of publicity requires no proof of falsity, confusion, or deception, especially when the celebrity is identifiable.*”⁸⁷— thereby clearly distinguishing between the “*likelihood of confusion + goodwill*” requirements of claiming passing off, versus the easier threshold of the burden of proof on the plaintiff in a *right of publicity* claim. Further, he borrowed from the WIPO Arbitral Tribunal decision in *Ms. Barkha Dutt v. Easyticket*⁸⁸, to establish “*that an unauthorised use of a famous person's name is not a bonafide use and if such name is used to lure users, it does not confer rights or legitimate interests on the infringer*”.⁸⁹ Similarly, in *Rajat Sharma v. Zee Telefilms*⁹⁰, the Delhi HC cited the *Titan Industries* case and *Shivaji Rao Gaekwad* to injunct Zee Telefilms from publishing advertisements that contained the name of the plaintiff through the phrase “*Now, in India Rajat's 'ADALAT' is over*” (translated from Hindi to English). However, while the *Titan* case was cited, there was no mention of the two-step test of infringement. Nonetheless, it appears implicitly that the locus of success for the injunction lies in the plaintiff meeting the threshold of identifiability from the alleged taking in dispute.

Per contra, every unauthorised use of a name does not constitute personality right infringement. In *Gautam Gambhir v. D.A.P & Co & Anr*⁹¹, the cricketer-politician Gautam Gambhir sought an injunction against the owner of a restaurant by the name, “Blue Waves by Gautam Gambhir”. An argument led by the plaintiff, *inter alia*, was that his image and thus personality right was being tarnished because of association with the restaurant. While the personality right of Gautam Gambhir was recognised, in the absence of direct taking of the economic associative value of the plaintiff, the plaintiff was unable to succeed in his claim. The unauthorised taking must be for commercial gain substantiated by a direct identifiability of the plaintiff, similar to *Titan Industries*, which was missing in this case – more so because the defendant restaurateur’s name himself is “Gautam Gambhir”.

Again, while the aforementioned decisions also do throw light on the contours of the right, a lot of questions remain nonetheless, and the later observations post *Titan and Daler Mehndi* are all in Single Judge decisions from several High Courts. Further, it is interesting to note that in another matter⁹² where the *right of publicity* as formulated in the *Daler Mehndi* matter could have been easily put to use, **was not**, and expert advocates chose to instead rely on the passing off tort jurisprudence, and built their argument for Mr. Arun Jaitley on what the court articulated as a goodwill in his name thus “*Mr. Arun Jaitley falls in the category wherein it besides being a personal name has attained distinctive indicia of its own. Therefore, the said name due its peculiar nature/ distinctive character coupled with the gained popularity in several fields whether being in politics, or in advocacy, or in part of emergency protest, or as leader or as debator has become well known personal name/ mark under the trade mark law which ensures him the benefit to refrain others from using this name unjustifiably in addition to his personal right to sue them for the misuse of his name.*”⁹³

5. Recent decisions and cases on right of privacy and its descendability versus the right of publicity: What is the true nature of these rights?

⁸⁷ *Id.* at para 21.

⁸⁸ *Supra* note 36.

⁸⁹ Para 22, *Supra* note 86..

⁹⁰ *Rajat Sharma v. Zee Telefilms.*, CS(COMM) 15 OF 2009, Delhi HC Decision of January 11, 2019.

⁹¹ *Gautam Gambhir v. D.A.P & Co & Anr.*, CS(COMM) 395 of 2017, Delhi HC Decision of December 13, 2017.

⁹² *Mr. Arun Jaitley v Network Solutions Pvt. Ltd.*, CS(OS) 1745 OF 2009, Delhi HC Decision of July 4, 2011.

⁹³ *Id.* at para 31.

In the recent past, with the Indian film industry (all regional cinema included) becoming increasingly invested in bringing *biopics* to the screen, several cases of claims from family members of the deceased celebrities have been brought, carrying claims of unfavourable portrayals, and *interestingly* – *right of privacy* violations! Surprisingly, in **most** of these recent matters, the claims seeking protection of the deceased *right of publicity* have not been raised. For example, in the case concerning the posthumous privacy rights of the former Chief Minister of Tamil Nadu – the late Ms. Jayalalitha, a Division Bench of the Madras HC⁹⁴ held that the right of privacy of an individual is not inheritable. The claim had been filed by her niece before the single-judge of the Madras HC⁹⁵, seeking an injunction on further continuing production work and airing of any promotional materials for two *in-production* projects – the movie ‘Thalaivi’ and the web series ‘Queen’ that were purportedly based on the life of the late Ms. Jayalalitha. While reaching its conclusion on appeal, the DB held that “*right of privacy of an individual extinguishes with the human being*” while declining to comment on the larger question of inheritability of what the court dubbed ‘personality rights’.⁹⁶ Thus, it potentially allowed for a distinction between non-inheritable rights over reputation and personal privacy on one hand, and the right to *commercially exploit* one’s own image – the economic *right of publicity*. To reach the same conclusion, the court explained that what the *right of privacy* protects, is a right against reputational harm, and such *civil law* claims (as opposed to the criminal defamation claims that under IPC is inheritable)⁹⁷ are not available post-mortem and do not operate in the nature of transferrable rights over movable or immovable property (including intangible intellectual property rights). It can thus be argued, , that the subject matter of protection of *right of privacy* is clearly and categorically distinguishable from the subject matter of the *right of publicity* which is potentially descendible.

This came to be further elaborated in the interim order passed by a single judge of the Delhi HC⁹⁸ in the ongoing matter concerning the posthumous rights of the late actor Sushant Singh Rajput, who allegedly died by suicide in June 2020. While the order lacks any precedential value, it reads as a detailed enunciation of the distinction between the several rights that are recognised as part of the larger ‘celebrity rights’ bundle. The claim was brought by the late Sushant Singh Rajput’s father seeking to injunct the makers of the film ‘*Nyay: The Justice*’ from releasing the same, alleging that it was based on the events around the late actor’s death. While the plaintiffs sought to rely on the decision of the Gujarat HC in *Kirtibhai*⁹⁹, where the court allowed for posthumous rights to be preliminarily enforced via an injunction in favour of the legal heirs of the late Jalaram Bapa, the Delhi HC in the aforementioned matter distinguished the Gujarat HC order on facts and refused to entertain the plaintiff’s reliance on the same. The same was done while holding that even the Gujarat HC decision does not delve into the inheritability question at all, and instead the injunction has been given on balance of convenience being heavier in favour of Bapa’s heirs.

Nonetheless, relying on the observations of Justice Kaul in *Puttaswamy* read with the scope of the *right of privacy*, Justice Narula in his order continued to obliterate the distinct fields occupied by the subject matters of *right of publicity* and *right of privacy*. He opined that in the absence of *statutory* protections for distinct intellectual property rights applicable within the ‘celebrity rights’ bundle, both *privacy* and *publicity* seem to trace their roots to the Article 21 guarantee of the right to life and

⁹⁴ Deepa Jayakumar v. A.L Vijay MANU/TN/3107/2021

⁹⁵ *Id.*

⁹⁶ *Id.* at paras 33-35.

⁹⁷ S.499 of the Indian Penal Code, 1960 contains the definition of criminal defamation.

⁹⁸ Krishna Kishore Singh v. Sarla S. Sarogi & Ors., CS(COMM) 187 OF 2021, Decision of Delhi HC on June 10, 2021, *Supra* note 50..

⁹⁹ Kirtibhai Raval & Ors v. Raghuram Jaisukhran Chandrani Appeal from Order No. 262 of 2007, 20th January 2010 by the Gujarat High Court.

personal liberty.¹⁰⁰ Justice Narula explicitly *rejects*, the descendability of the *right of publicity*, while nonetheless affirming the descendability of certain intellectual property rights vested with the celebrity.¹⁰¹ This matter is currently pending trial, and it will be interesting to see what the court says on the question of the right of publicity.

The foregoing discussion on inheritability is nonetheless relevant to establish the claim that the author seeks to make – that *right of publicity* and rights over personal names, when used in the course of trade, function as *economic rights* – akin to trademark rights – that are transferrable, inheritable and therefore enforceable via private dispute resolution mechanisms. More recent instances of such ‘accepted’ transferable nature of the *right of publicity* in India are noticed from the case studies of two-time Olympic Gold medalist, Indian Badminton player P.V. Sindhu’s “unauthorized” image-taking by brands¹⁰² and Amazon finally rolling out its first Indian celebrity voice - celebrated and legendary Indian actor Amitabh Bachchan for Alexa’s India users¹⁰³ In P.V. Sindhu’s case, it is interesting to note that it was the sports marketing firm that manages her portfolio, *Baseline Ventures* (and not Sindhu herself), that sent legal notices to 20 Indian and foreign firms with presence in India, for using her image and its likeness (caricatures, sketches, evocative elements like shuttle cocks and badminton rackets alongside her name, *etc.*) on ‘congratulatory’ broadcasts, that also carried their name, branding, logo, taglines and/or insignia.¹⁰⁴ In the other case of the voice feature on Amazon Alexa, now including the Amitabh Bachchan baritone, what is equally intriguing is that Amazon is seemingly experimenting with its ‘neural speech technology’ to not have to keep pre-recording and to be able to closely replicate the unique baritone that is the USP of Mr. Bachchan.¹⁰⁵ While the terms of the contract between Mr. Amitabh Bachchan, his PR team and Amazon are not in the public domain, there can be speculation, arguably legitimate, that the subject matter *inter alia* entails a license over use of the baritone as personality indicia, alongside voice recordings of individual phrases being sought sound mark registrations for. As on August 20, 2021, a sound mark search in all possible classes, however, reveals no applications being made either in the name of Amazon or Mr. Amitabh Bachchan before the TM Registry in India. Nonetheless, these cases denote the property-style nature of the *right of publicity* and its containing indicia, rather than the ‘fundamental-inherent’ right -style nature of the *right of privacy*.

6. The Problem: Private Economic Right versus Fundamental Right – what is ADR-able?

The problem of the true nature of the *right of publicity* in India got magnified on August 24, 2017, when the Supreme Court issued a seminal decision¹⁰⁶, clarifying finally, the position of *the right to*

¹⁰⁰ Para 20, *Supra* note 50.

¹⁰¹ Para 21, *Supra* note 50..

¹⁰² Maryam Farooqui, PV Sindhu to send notices to 15 firms for using her name, pictures in ads, Money Control (August 7, 2021) <https://www.moneycontrol.com/news/trends/sports-trends/pv-sindhu-to-send-notices-to-15-firms-for-using-her-name-pictures-in-ads-7292371.html>

¹⁰³ Jagmeet Singh, Amazon Alexa Gets Amitabh Bachchan’s Voice in India, for a Price, Gadgets360 (August 19, 2021) <https://gadgets.ndtv.com/apps/news/amazon-alexa-amitabh-bachchan-voice-india-update-price-rs-149-2513811>

¹⁰⁴ Meenakshi Verma Ambwani, Baseline Ventures sends legal notices to 20 firms for unauthorised use of PV Sindhu’s image, The Hindu Businessline (August 6, 2021) <https://www.thehindubusinessline.com/news/baseline-ventures-sends-legal-notices-to-20-firms-for-unauthorised-use-of-pv-sindhus-image/article35770116.ece>

¹⁰⁵ Manish Singh, Amazon rolls out India’s first celebrity voice on Alexa with Amitabh Bachchan, TechCrunch (August 19, 2021) “The company said it is also applying neural speech technology to make Alexa sound like Bachchan even if there’s no direct pre-recording.” <https://techcrunch.com/2021/08/18/amazon-rolls-out-indias-first-celebrity-voice-on-alexa-with-amitabh-bachchan/>

¹⁰⁶ *Supra* note 11.

privacy under Indian law as a fundamental right of all citizens guaranteed under Part III of the Constitution. The majority decision, in part, provides for the horizontal applicability of the privacy right, finding the ground in the enunciation of the right as having both *common law* and *fundamental right* aspects, thereby enabling the simultaneous enforcement of the same right as against those entities that qualify the test of *state* under Article 12 as well as against private entities.¹⁰⁷ Interestingly, Justice Kaul went a step further. In his separate opinion, he elevated the *right of publicity*, otherwise having been previously enunciated only as a common law right,¹⁰⁸ to a being a facet of the fundamental guarantee of privacy. He opined thus – “*Aside from the economic justifications for such a right, it is also justified as protecting individual autonomy and personal dignity. The right protects an individual’s free, personal conception of the ‘self.’ The right of publicity implicates a person’s interest in autonomous self-definition, which prevents others from interfering with the meanings and values that the public associates with her.*”¹⁰⁹

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

➤ for one, fundamental rights, by their very nature, are non-assignable, and non-waivable.¹¹⁰ It is noteworthy that in his majority opinion, Justice Chandrachud in the *Puttaswamy* case has recognised that the *right to privacy* includes ‘decisional autonomy’. Further, as explained by celebrated expert Sr. Advocate Mr. Arvind Datar, “*This would include the right of a person to make an informed decision not to enforce his fundamental right. In other words, he can “waive” it.*”¹¹¹ Nonetheless, as suggested by McCarthy, the non-assignability of traditional privacy rights was one important reason for the creation of the separate concept of the *right of publicity*¹¹². The US courts have uniformly held that the *right of publicity* is a ‘property’ right, since the *Haelan Laboratories* decision. Courts also view the *right of publicity* as a form of ‘intellectual property’, having both similarities to and differences from other forms of intellectual property such as copyrights and trademarks.¹¹³ The nature of personality rights is such that it is separable from the persona embodying it, unlike the *right of privacy* which is inherent to the individual human person. This is further explained by Post, thus “[*P*]ersonality is commodified and becomes ‘something in the outside world, separate from oneself.’ For this reason, commodified personality can endure long beyond the living self of the individual who creates it and can also be owned and used by persons other than its creator.”¹¹⁴

➤ Further, fundamental rights in their essence were meant to be enforced by the citizen against the state (vertical application) and not against other citizens (horizontal application). One of the problems with *Rajagopal* is that it conceives of a very broad horizontal right to privacy, which has also been endorsed in *Puttaswamy*. As pointed out by Prashant Reddy, it is one thing to claim a strong fundamental right to privacy against the state, but what is the logic of a

¹⁰⁷ *Id.* at paras 397, 398 and 428.3.

¹⁰⁸ Refer Titan case and Daler Mehndi case, *Supra* note 1.

¹⁰⁹ *Supra* note 11 at para 626. See also Prashant Reddy, The Supreme Court’s Privacy Judgment Elevates Personality Rights to the Constitutional Plane, SpicyIP (August 26, 2017) <https://spicyip.com/2017/08/the-supreme-courts-privacy-judgment-elevates-personality-rights-to-the-constitutional-plane.html>

¹¹⁰ *Basheshar Nath v Commissioner of Income Tax*, [1955] 1 S.C.R.773 (“Basheshar Nath”).

¹¹¹ Arvind Datar, Can a Fundamental Right be waived?: Legal Notes by Arvind Datar, BAR&BENCH (September 11, 2017) <https://barandbench.com/can-fundamental-right-waived-arvind-datar/>

¹¹² McCarthy, *Supra* note 25 at §§ 10:6 to 10:13.

¹¹³ *Id.*

¹¹⁴ Robert C. Post, *Rereading Warren and Brandeis: Privacy, Property, and Appropriation*, 41 Case W. Res. L. Rev. 647, 668 (1991).

fundamental right to privacy against fellow citizens?¹¹⁵ Further, since the *Basheshar Nath*¹¹⁶ decision has not yet been overruled, fundamental rights are inalienable – **a very literal interpretation and application of Justice Kaul’s opinion would then seem to suggest that right of publicity is not alienable at all.** Such an absurd consequence definitely would not have been the intention!

This further leads to the problem of the arbitrability of these claims. Fundamental rights are rights held against the world at large – they do not create actions of infringement *in personam* but are enforceable only in the constitutional courts via their writ jurisdiction, as rights *in rem*. In further creating this artificial “equivocation” between *right of publicity* as a right in the nature of protection against commercial misappropriation and the *fundamental* guarantee of the *right of privacy* as a protection against unlawful invasion, the decision allows for now only *writ courts* to have *exclusive jurisdiction* over such claims. This would do little to further India’s aims to become an arbitration hub if private infringement claims of the right to publicity are believed to be enforcements of fundamental rights. It would potentially start flooding our already overburdened court system¹¹⁷ with even more matters that will have to undergo the preliminary ‘nature of right claimed’-style scrutiny. This would potentially furthermore lead to the absurdity of the appellate court system operating as first instance ‘summary’ disposal courts, thereby diluting the sanctity of the constitutionally vested writ process.

7. Concluding Observations

In India, celebrities have always had a limited right, under common law, to control the use of their image and personality. For example, if a particular company decides to give the impression that a celebrity has endorsed their product, they could be sued for the tort of passing off, or the Delhi HC style *right of publicity* tort itself which has emerged. The problem with Justice Kaul’s judgment is that he has converted this erstwhile common law right to a fundamental right and widened it to give every individual (not just celebrities) the right to control the manner in which their life and identity is portrayed to the world, for commercial purposes. Thus, while the debate on whether the *right of publicity* exists – and whether it even exists as a property type right, a standalone common law right, or a fundamental right might continue to remain open – what it decidedly cannot be – is a horizontally enforceable fundamental right as a prong of the right to privacy. Apart from the concern that the same would lead to a chilling effect on the free speech rights of legitimate takers; it would also have far-reaching consequences for the idea of a post-mortem *right of publicity*.

The author thus argues that the *right of publicity* claims in celebrity name-domain name disputes are definitely arbitrable. They have been since the beginning of domain name disputes themselves and shall continue to remain so. An absurd potential consequence of an Apex Court decision is to remain just that, a bleak potential, not a reality in application and action. Nonetheless, even though Justice Kaul is one judge giving a separate opinion, he does comprise a larger nine-judge bench, and his opinion has not been side-lined or discounted by the others. Hence, it is a cause of worry, especially since the earlier opinions are by single judge High Court benches, given that Article 141 of the Constitution provides that law declared by the Supreme Court binds all lower courts. Furthermore, if projections from the currently *sub judice* matter in the case of the rights of the late Sushant Singh

¹¹⁵ Reddy, *Supra* note 107.

¹¹⁶ *Supra* note 110.

¹¹⁷ According to the National Judicial Data Grid, there are 1,05,93,809 civil cases pending before the District and Taluka Courts and 41,37,251 civil cases pending before High Courts in India as of August 2021.

Rajput are looked at, it seems that the Delhi HC is unfortunately more inclined towards recognizing that the *right of publicity* is also ‘non descendible non inheritable’. The author sincerely hopes that this does not turn out to be true. One can only hope and keep a close watch as the matter unfolds¹¹⁸.

¹¹⁸ The matter is next listed for hearing on November 03, 2022.