

(2010) 04 DEL CK 0034
In the Delhi High Court
Case No : CS (OS) 893 of 2002

D.M. Entertainment Pvt. Ltd.

APPELLANT

Vs

Baby Gift House and Others

RESPONDENT

Date of Decision : 29-04-2010

Acts Referred:

Citation : (2010) 04 DEL CK 0034

Hon'ble Judges : S. Ravindra Bhat, J

Bench : Single Bench

Advocate : Pravin Anand and Divya Vijan, for the Appellant; None, for the Respondent

Judgement

S. Ravindra Bhat, J.—The plaintiff in the suit seeks permanent injunction against the defendants restraining from infringing his right of publicity and against false endorsement, leading to passing off. He claims damages and rendition of accounts.

2. The plaintiff company was incorporated in 1996, in which the letters DM stands for the initials of the name, Daler Mehndi (hereafter "the artist"). The company was originally incorporated to manage his advancing career. The plaintiff also helps in raising funds for charities, causes and to fund the DALER MEHNDI GREEN DRIVE project and has made a significant mark in providing employment and broad-based awareness in terms of music, ecological/environmental and social issues.

3. The history of the artist and the artist's works, is given under paras 3, 4 and 5 of the plaint, explaining his immense popularity as an entertainer, who has made an indelible mark in the show business. The details of the artist's works/albums as well as chart enumerated in the averments, are to the effect that the author is a well-known personality. Mr. Mehndi has received several awards recognizing his talents, a list of which is shown in Para 6 of the plaint.

4. The plaintiff claims its sales figure which explains the artist's popularity

worldwide, they are detailed as follows:

Album Sales Figures (Approx.) World Wide (Approx.) (Units of Cassettes/CDs)									
(Units of Cassettes/CDs)									
BOLO	TA	RA	RA	RA	(MAGNASOUND)	25	LAKHS	16	LAKHS
DARDI	RAB	RAB			(MAGNASOUND)	29	LAKHS	18	LAKHS
JAYEGI	BALLE	BALLE			(MAGNASOUND)	45	LAKHS	35	LAKHS
MRITYUDATA					(MAGNASOUND)	85	LAKHS	45	LAKHS
BEST	OF	DALER			MEHNDI	65	LAKHS	45	LAKHS
TUNAK	TUNAK	TUN			(MAGNASOUND)	45	LAKHS	48	LAKHS
ARJUN	PANDIT	(T			SERIES)	75	LAKHS	45	LAKHS
KHAUFF	(T				SERIES)	65	LAKHS	30	LAKHS
DANA	(TIPS)				25	LAKHS	28		LAKHS
NABI BUBA NABI (UNIVERSAL) Launched in NA 9.5 Lakhs in India in April 2001									

5. The Identity, Persona and reputation, of "Daler Mehndi" , as stated in Para 9 of plaint shows that the artist has become extremely famous and brings an instinctive association in the mind of the public and trade alike, with the high quality entertainment services, and products emanating him. Therefore, his persona, has assumed tremendous significance as a quasi-property right meant to protect the economic value associated with identity. The artist's business affairs and public persona have continued to grow at an exponential rate ever since he came into prominence. Subsequently, the artist has assigned all his rights, title and interest in his personality inherent in his rights of publicity along with the trademark DALER MEHNDI as well as goodwill vested therein, with effect from November 13th 1996, to the plaintiff Company.

6. In order to exercise control over the artist's image, the plaintiff and the artist have in agreements with artiste management and recording companies, specifically contracted for a clause prohibiting the use of his persona or aspects thereof in relation to any advertising or similar commercial purposes without his consent. It is claimed that the plaintiff has filed a suit before this Court being Suit No. 1147 of 2001 against the registrant of a domain name "dalermehndi.net" and a decree in favour of his terms of compromise arrived at

between parties resulting in transfer of the domain name. The plaintiff also submits to having filed a complaint registered as Case No. D2001-1267 under the Uniform Dispute Resolution Procedure (UDRP) against registrant of a website, "dalertmehndi.com" , in which the Administrative Panel at the WIPO Arbitration and Mediation Centre ruled in favor of the plaintiff and ordered the transfer of the domain name to the plaintiff. The plaintiff states that it has filed trademark applications in Classes 1 to 34 for the mark DALER MEHNDI dated 05.07.1999.

7. It is contended that the unauthorized or unlicensed use by any party of the said persona including any of its individual components, on account of the immense reputation of the artist and its deployment as a source of indicator in the music industry, in relation to goods and services or in any other manner, would leave a false impression on the public and members of the trade, that the goods or services either originate from the plaintiff or its sponsors, licensor or endorsee. Such misrepresentation would constitute acts of false endorsement and passing off by such third party and would lead to dilution and erosion of uniqueness and exclusivity associated with plaintiff's right, by reducing its capacity to identify and distinguish the services of the plaintiff as originating from a particular source. This would also result in generation of huge unearned commercial gains at the hands of person who have no right to use the persona and will cause great financial detriment to the plaintiff.

8. The plaintiff submits that if a famous person's persona or any individual aspect of his personality is used by another for commercial exploitation or gain, without such person's authorization or license, the act of using the said persona, or attributes of such personality constitute infringement of the famous person's right of publicity.

9. The first defendant, Baby Gift shop- The Toy Shop, operates a toy store at 13/18, Ajmal Khan Road, Karol Bhag, New Delhi; the second defendant is a gift gallery in Bengali Market, Delhi; the third defendant similarly is a shop selling gift items at Kamala Nagar, and the fourth defendant, Poonam Gift Palace operates at 133, Palika Bazaar, Connaught Place, New Delhi; (they are hereafter collectively referred to as "the defendants"). All defendants are engaged in the business of selling the impugned product, i.e. dolls, which, the plaintiff alleges, are cheap imitations of, and identical to the likeness of the artist. Such dolls, or three dimensional images are packaged under the brand or banner "SUN TOYS" indicating that there is a single source for all the products sold. The words, "MADE IN CHINA" appears at the bottom of the doll indicates that the same product is imported from China and sold by each defendant. It is submitted that the importation and sale, of such dolls or images, which claim to be able to sing a few lines of the artist's compositions, are a blatant infringement of the artist's right to control the commercial exploitation of his persona. The features of the Doll that contribute to the assertion that it seeks to evoke the artist's persona has been explained in Para 15 of the plaint. It is pertinent to note that the plaintiff has exhibited the first Defendant's cash memo reflecting the bill raised

for the sale of the Doll lists the words, "DALER MEHNDI" under the heading "Description Of The Article Sold".

10. The suit alleges that the defendants have, without the plaintiff's authority and consent misappropriated the artist's persona and likeness for their own ignoble ends, thereby invading the plaintiff's exclusive rights to market the personality of the artist and also infringed the copyright to the literary and musical works in the song, BOLO TA RA RA RA. Such acts of misappropriation of the plaintiff's exclusive right of publicity, by the defendants, and their persisting to sell such infringing products, containing false endorsements is completely mala fide and liable to be restrained. In addition to causing commercial loss to the plaintiff by infringing its exclusive right to market as well as caused tremendous loss and damage to the reputation of the plaintiff and the artist and further, the defendants attempt to induce the consumers and purchasers of such products, to believe that, plaintiff has either licensed or the Defendants have some connection with the plaintiff, or the artist, to use its exclusive right to market images of the artist.

11. This Court issued summons, and also made an ex-parte restraining order against the defendants. On the same day (2-5-2002), a Local Commissioner was appointed by the Court, to visit the defendant's premises and report the correct position vis-a-vis the defendants' activities and report to the court. The commissioner visited the Defendant's Kamla Nagar premises, along with representatives of the plaintiff company on 04-05-2002, and reported about the alleged infringing dolls. The commissioner also submitted that that the place of origin of such products is China and further the proprietor of the shop reported that he was unaware of the illegality involved in the sale of the dolls and after knowing about the litigation in respect of sale of such dolls, he (the proprietor) was no long interested in selling them; he also mentioned that the profit margin in the sale of these dolls was quite low i.e. Rs. 10/- to Rs. 20/- per doll. The Written Statement filed by the defendant, denies all the averments in the plaint. During the course of proceedings, the defendants absented themselves, and defaulted in contesting the proceedings; they were, accordingly, set down ex-parte.

12. The plaintiff contended that the character's potential being the artist's popularity to attract customers; on the basis of perceived attributes which is contributed by his reputation is the basis for its trademark and other commercial exploitation. On this aspect, the Bombay High Court, in *Star India Private Limited Vs. Leo Burnett (India) Private Limited*, was relied upon; that judgment explained the position thus:

Character merchandising involves the exploitation of fictional characters or the fame of celebrities by licensing such famous fictional characters to others. The fictional characters are generally drawings in which copyright subsists, e.g., cartoon and celebrities are living beings who are otherwise very famous in any particular field, e.g.; film stars, sportsmen. 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. This presumes that the character has independently acquired such reputation as to be a commodity in its own right independently of the goods or services to which it is attached or the field/area in which it originally appears.

Similar views were expressed recently, by this Court, in *Chorian Rights Limited v. Ishan Apparel and Ors.* CS(OS) 1154/2009 in this aspect.

13. To avail the right against the infringement of right to publicity, the plaintiff must be "identifiable" from defendant's unauthorized use. In this instant case, the evidence on record very well establishes the primary requirement. As a secondary consideration, it is necessary to show that the use must be sufficient, adequate or substantial to identify that the defendant is alleged to have appropriated the persona or some of its essential attributes. The right of publicity protects against the unauthorized appropriation of an individual's very persona which would result in unearned commercial gain to another. In the present instance, the commercial use of an individual's identity is intended to increase the sales of product by fusing the celebrity's identity with the product and thereby the defendants were selling those dolls, on the basis of publicity value or goodwill in the artist's persona into the product i.e. doll. In *Ali v. Playgirl Inc.* 447 F Supp 723, it was observed that;

The distinctive aspect of the common law right of publicity is that it recognizes the commercial value of the picture or representation of a prominent person or performer, and protects his proprietary interest in the profitability of his public reputation or persona.

A similar view is echoed in *Onassis v. Christian Dior - New York Inc.* 472 NYS 2d 261;

No one is free to trade on another's name or appearance and claim immunity because what he is using is similar to but not identical with the original.

14. 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. However, a word of caution has to be expressed here. In a free and democratic society, where every individual's right to free speech is assured, the over emphasis on a famous person's publicity rights can tend to chill the exercise of such invaluable democratic right. Thus, for instance, caricature, lampooning, parodies and the like, which may tend to highlight some aspects of the individual's personality traits, may not constitute infringement of such individual's right to publicity. If it were held otherwise, an entire genre of expression would be unavailable to the general public. Such caricature, lampooning or parody may be expressed in a

variety of ways, i.e. cartoons in newspapers, mime, theatre, even films, songs, etc. Such forms of expression cannot be held to amount to commercial exploitation, per se; if the individual is of the view that the form of expression defames or disparages him, the remedy of damages for libel, or slander, as the case may be, would then, is available to him.

15. An individual claiming false endorsement must prove that the use of the identity likely misled consumers into believing the concerned personality endorsed the product at issue. In this case, it has been seen that the use of Mr. Mehndi's persona for the purpose of capitalizing upon his name by using its conjunction with the commercial product is not proper or legitimate; it amounts to a clear dilution of uniqueness of such personality and gives rise to a false belief that, plaintiff has either licensed or the Defendants have some connection with them (i.e. the plaintiff or the artist), to use its exclusive right to market images of the artist.

16. In a passing off action, one has to see as to whether the Defendant is selling goods/service so marked to be designed or calculated to lead purchasers to believe that they are plaintiff's goods. Even if a person uses another's well-known trademark or trade mark similar thereto for goods or services that are not similar to those provided by such other person, although it does not cause confusion among consumers as to the source of goods or services, it may cause damage to the well-known trade mark by reducing or diluting the trademark's power to indicate the source. Further, where a person uses another person's well-known trade mark or trademark similar thereto for the purpose of diluting the trade mark, such use does not cause confusion among consumers but takes advantage of the goodwill of the well-known trade mark, it constitutes an act of unfair competition.

17. In view of the above findings, it is clear that the plaintiff has also established its case for passing off. The evidence of the plaintiff has gone un-rebutted which includes loss of business, reputation and goodwill in the market.

18. The suit therefore, deserves to succeed, as far as the claim for permanent injunction is concerned. However, so far as other reliefs are concerned, the court is of opinion that in the absence of any positive evidence of persistent or widespread appropriation of the persona, for commercial gain, the plaintiffs are entitled to token damages, in addition to costs. The suit is accordingly decreed to the extent of claim for permanent injunction; a decree for Rs. 1,00,000/- as damages, is also granted. The suit is decreed, in the above terms, with costs.