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Protecting brand value in age of sensationalism

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INDIRA SAHRAWAT,
MEGHNA ARORA, JANNAVI
SINGHA



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Introduction

With the sudden spike in the use of social media – heightened by almost two years of the world having come to a standstill due to the ongoing covid-19 pandemic – the reach of the digital world has reached alarming heights. With this, the influence wielded by celebrities over the behaviour of those who follow them has been unprecedented. This has not gone unnoticed by young entrepreneurs, who have been using celebrities' names, and even famous quotes or catchphrases, for the purpose of branding their businesses or ventures. Doing so is eye-catching and often results in an increase in the visibility of their products or services. Of course, the added assurance and bankability that attaches to their businesses when they are assumed to be associated with or endorsed by a famous person is also beneficial.

On the flipside, what might have become a lucrative business model for some has led to significant issues for celebrities. The unauthorised use of any attribute of a celebrity, such as their name, image or likeness, can cause serious loss to their reputation and meticulously built "brand value". Such acts may not only amount to actionable wrongs such as passing off, misrepresentation or even unfair competition, but can potentially lead to infringement of their right to privacy or even mental distress caused by damage to their reputation. Additionally, celebrities often make use of their brand value for commercial gain – for example,

through collaborations. This has led to celebrities becoming increasingly protective of their brand and taking appropriate enforcement action against the misuse of their celebrity status.

What's in a name?

In the case of *EUIPO v Messi Cuccittini*,⁽¹⁾ the of the European Court of Justice ruled in favour of footballer Lionel Messi and held that that he had the right to register his name as a trademark considering that he is a notable public figure. This came after Messi had tried to register his name at the EU Intellectual Property Office and his application had been rejected on the basis of an opposition filed by the owner of the prior registered trademark MASSI, in respect of cycling clothes and sports-related goods. Similarly, famous theoretical physicist and author, Stephen Hawking registered his name as a trademark in 2015 – one in a long of line celebrities and public personalities including J K Rowling, Usain Bolt and Roger Federer to have sought to have their names or other aspects attributable to their celebrity status trademarked.

There are various reasons behind celebrities acquiring such trademark rights. While one reason could be to prevent others from unfairly profiting from their fame, it has also helped some celebrities to profit off of their own brand value. An example in this vein is Paris Hilton, who made the catchphrase "That's Hot!" famous through her reality show. Given the phrase's rising popularity, Hilton subsequently got the phrase registered as a trademark. The phrase had become so famous that she made it the basis for a lawsuit against Hallmark over the use of the phrase on a greeting card.

The reason that such trademarks can be approved is because they have become so popular that the general public is able to associate the remark or phrase in question with the celebrity who said it instantly. The result of trademarking such catchphrases has yielded huge commercial profits to celebrities – one of the best examples would be how licensing the right to use his trademarked catchphrase "Let's Get Ready to Rumble!" resulted in the famous boxing announcer reportedly Michael Buffer raking in over \$400 million dollars in profit.

Comment

Celebrities' names are more susceptible to unauthorised use. This has led to celebrities trying to gain more control over the use of their name, which, in some cases, even adds to their own commercial value.

However, celebrities must be careful in this regard – often, the mere registration of such marks without using them can result in such protection being defective, making them liable to non-use cancellation.

For further information on this topic please contact Indira Sahrawat, Meghna Arora or Jannavi Singha at G&W Legal by telephone (+91 11 6134 8306) or email (indira.sahrawat@gnwlegal.com, meghnaarora@gnwlegal.com or jannavi.singha@gnwlegal.com). The G&W Legal website can be accessed at www.gnwlegal.com.

Endnotes

(1) T-554/14, ECLI:EU:T:2018:230.