LOGOS WITH HIDDEN MESSAGES THAT ARE BYPASSING THE TRADEMARK REFUSAL GROUNDS

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ABSTRACT

I purport to examine in this paper legal provisions in Indian Laws to deal with Trademarks containing obscene content or those contrary to public policy or to principles of morality including the penal provisions for the same with relevant case studies. Certain Logos/Trademarks carry hidden messages. These hidden messages are not understood by the public in most cases, unless they are revealed by the owners themselves. Recently, Myntra was on the News for their obscene hidden message of a woman’s genital in their logo. This was never disputed by them or their public relations and they silently accepted the allegation and has even changed their logo after public outrage. Similarly, Baskin Robinson has a hidden number “31” in their logo which refers to the number of flavors they originally have but they claim it to refer a flavor a day for the entire month. Had they agreed it to be the former, their logo would have been rejected on the grounds that they are descriptive in nature with regard to their quantity. When they are revealed, they go unpunished as there is lacuna in the legislation relating to trademark. There’s element of Mens rea, Actus rea and unfair competitive advantage and financial/business gains in this strategy devised by companies.

Keywords- Trademark, Obscenity, Unfair competition, Trademark Refusal.

CHAPTER – 1:

1. INTRODUCTION

To refrain other local brands from violating and carrying out their business under the earned goodwill of such standard trader/brand, and also to save the interest of the consumer, there needs to exist a definite symbol which marks out the origin of the goods and services of such standard traders. Such a symbol of distinction is called a trademark. It is a sign, symbol, logo, etc. which is capable of distinguishing the goods or services of one brand from those of others. These trademarks are protected under intellectual property rights. In India, the trademark is registered under the Trademark Act, 1999. The Madrid Agreement was an attempt to have internationally valid registrations of trademarks conceived in Continental Europe.

Trademark law in all jurisdictions has come a long way. It surfaced, centuries ago, as a guardian of traders who used “marks,” or symbols, to indicate the source of their wares and who wished to prevent competitors from using the same mark to deceive customers.

2 Ayush Verma, How India ratified the Madrid protocol, ileaders, (September 6, 2020), <https://blog.ipleaders.in/india-ratified-madrid-protocol/>
into buying the wrong product\textsuperscript{4}. The law now protects a broad array of devices—including shapes, colours, sounds, and smells—against use not only by competitors but also by sellers of even peripherally related products\textsuperscript{5}. But it is always wise to consider the effects of registering each and everything that is created especially, when it is against the standards of society, public policy, morality and other social sentiments\textsuperscript{6}. Thus, the legal provisions must be drafted careful enough to protect such societal attributes. The authorities should always look into the moral aspects of a proposed trademark before giving any kind of exclusive right to use that trademark to the adopter.

In the paper, we would focus on the types of restrictions and the content-based prohibitions contained in the Indian Trademark law, which prohibits registration of, inter alia, marks consisting of or comprising scandalous, immoral, or disparaging matter. We live in a generation that has an abundant sense of humour kept under wraps and an equal amount of sentimental intolerance on record\textsuperscript{7}. Sense of humour, jokes and innuendos are extremely subjective. The question is, is the government or the state machinery the sole custodian of measuring the obscenity, hurtfulness or immorality of expressions, in the case of Trademarks\textsuperscript{8}. Trademarks containing obscene content or those contrary to public policy or to principles of morality are generally refused registration in many jurisdictions\textsuperscript{9}.

\textbf{CHAPTER – 2: REGISTRATION OF IMMORAL OR SCANDALOUS MATTER}

Trademarks are used by the traders to promote its own products or services but also it is being used "as a mark", to indicate the source or sponsorship of those products or services.\textsuperscript{10} One reason for passing trademark statutes was for the express purpose of making it easy to afford protection to traders at less expense and less trouble\textsuperscript{11} as Diamond has pointed out, that a "Trademark does not necessarily guarantee good quality. What it does guarantee is consistency". Schechter stated that the "true functions of the trademark are, then, to identify a product as satisfactory and thereby to stimulate further purchases by the consuming public"\textsuperscript{12}. According to Diamond: The shift to an equitable remedy based upon the invasion of a property right did not come until the

\textsuperscript{5} Wertheimer, \textit{Broadened Protection of Names and Trade-Marks in the German Law}, p. 20,(1925).
\textsuperscript{9} Theodore H. Davis Jr., \textit{Registration of Scandalous, Immoral, and Disparaging Matter under Section 2(a)}
\textsuperscript{10} 15 U.S.C. §§ 1114, 1125 (2000) (prohibiting use "likely to cause confusion");
\textsuperscript{11} Malletier v. Burlington Coat Factory Warehouse Corp., 426 F.3d 532, 538 (2d Cir. 2005).
nineteenth century. A modern trademark is "any word, name, symbol or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

The main purpose of a trademark is to prevent unfair competition between companies that use consumer confusion to get more business. For example, if an independent diner used a golden, arched "M" as its logo, it could confuse customers who think the establishment is a McDonald's. Causing this type of confusion is against trademark laws in any country. The purpose of trademark law is twofold:

- A trademark helps customers distinguish between products,
- A trademark protects the owner's investment and reputation.

In the 1995 case of 'Qualitex Co. v. Jacobson Products Co.', the U.S Supreme Court described trademark law as "preventing others from copying a source-identifying mark" and assisting the customer in making purchasing decisions. The law also helps make sure the producer will get all the reputation-related and financial rewards associated with its product.

Thus, trademark law surfaced, centuries ago, as a guardian of traders who used "marks," or symbols, to indicate the source of their wares and who wished to prevent competitors from using the same mark to deceive customers into buying the wrong product. The law now protects a broad array of devices—including shapes, colours, sounds, and smells—against use not only by competitors but also by sellers of even peripherally related products.

2.2 IMMORAL OR SCANDALOUS MATTER

POSITION IN UNITED STATES

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register. The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was re-enacted as part of §2(a) of the Act of 1946.

In re McGinley, it was held that, although the words "immoral" and "scandalous" may have somewhat different connotations. In re Fox, it was held that "a substantial composite of the general public perceives" a scandalous meaning, even though the mark had a non-scandalous meaning in relation to the goods as well is enough to bar registration. Moreover, there is no requirement in §2(a) that a mark’s vulgar meaning be the only relevant meaning, or even the most relevant.

13 Diamond, supra note 2, at 287, 288.
16 Diamond, supra note 11 at p. 290.
19660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981), aff’g 206 USPQ 753 (TTAB 1979).
meaning. Thus, an examining attorney need to prove only the existence of one vulgar meaning to justify a §2(a) refusal.

In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined "scandalous" as, inter alia, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. In McGinley, it was held that ‘scandalous’ is a mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a "newsletter devoted to social and interpersonal relationship topics" and for "social club services". The statutory language "scandalous" has also been considered to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude as held in re Runsdorf.

The case of re Luxuria s.r.o., ended up finding a mark consisting of a bottle in the shape of a hand with middle finger extended upwards comprised matter that would be considered vulgar by a substantial composite of the general public.

Further, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace as held in Mavety Media, wherein “the evidence could include dictionary definitions, newspaper articles, and magazine articles”.

In another instance of Boston Red Sox Baseball Club Ltd. P’ship v. Sherman, the authorities held sustaining an opposition and finding that the mark SEX ROD was immoral and scandalous under §2(a) based on dictionary definitions designating the term "ROD" as being vulgar, and applicant’s admission that SEX ROD had a sexual connotation.

"Whether applicant intended the mark to be humorous, or even whether some people would actually find it to be humorous, is immaterial. A refusal is proper if the evidence shows that "the term would be perceived and understood as vulgar by a substantial portion of the purchasing public. To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.

2.3 POSITION IN UNITED KINGDOM

Within the European Economic Area, trade mark law is largely harmonised. The provision governing the registration of marks contrary to public policy and morality are therefore very similar at national and Community level. The Trade Marks

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20702 F.3d 633, 638, 105 USPQ2d 1247, 1250 (Fed. Cir. 2012) (holding scandalous a mark for rooster-shaped chocolate lollipops were, in the context of the goods
21660 F.2d at 486, 211 USPQ at 673
22171 USPQ 443, 444 (TTAB 1971).
23100 USPQ2d 1146 (TTAB 2011)
2433 F.3d at 1371-72, 31 USPQ2d at 1925-26
2588 USPQ2d 1581 (TTAB 2008)
Directive governs national law on this issue and has been implemented in the United Kingdom by Trade Marks Act 1994, Sec. 3(3)(a). A trade mark shall not be registered if it is—(a) contrary to public policy or to accepted principles of morality…” to quote one of the instances, decision was that of Simon Thorley QC in Ghazilian’s Application, which concerned an application to register the mark, TINY PEEENIS, in respect of clothing. The Registry’s hearing officer refused the application on the ground that, as clothes would be displayed in public, use of the alleged mark would cause offence to a substantial proportion of the purchasing public. On appeal, the Appointed Person upheld this decision. He approved the approach adopted by Aldous J in Re Masterman’s Application, interpreting equivalent morality provisions under the Registered Designs Act 1949.

In yet another case of Scranage, the applicant sought to register the mark FOOK in respect of clothing, footwear and headgear. The Registry’s hearing officer refused the application on the ground that the mark consisted exclusively of a word that was phonetically very similar to the offensive word F---U----C----K. As such, registration of the mark was contrary to accepted principles of morality. The applicant appealed to the Appointed Person, David Kitchin Q.C., who upheld the decision. Having made extensive reference to the decision in Ghazilian case he held that registration of the word “F---U----C----K” as a trade mark would be unacceptable because, although commonly employed, its “general use” would be “likely to cause justifiable outrage amongst a significant section of the public.”

2.4 FUNCTIONS OF A TRADEMARK

A trademark serves the purpose of identifying the source or the origin of goods. Trademark performs the following four functions.

- It identifies the product and its origin.
- It proposes to guarantee its quality.
- It advertises the product. The trademark represents the product.
- It creates an image of the product in the minds of the public particularly the consumers or the prospective consumers of such goods.

CHAPTER – 3: LEGISLATIVE PROVISION RELATING TO TRADEMARK REGISTRATION – AN INTERNATIONAL PERSPECTIVE

As far as the trademark legislation alone is concerned, anyone is free to make which would, in his opinion, be contrary to law or morality” (Registered Designs Act 1949, s. 43(1).

- O/182/05, 23rd June 2005.
- O/182/05, 23rd June 2005, [13].
- WIPO, Introduction to trademark law and practice- The basic concepts, publication No. 653 (E), ISBN 92-805-0167-4.

27 Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trademarks (“the Trade Marks Directive”),
28 In the United Kingdom, this harmonised morality and public policy exclusion has a series of statutory predecessors - Trade Marks Act 1938, s. 11; Trade Marks Act 1905, s. 11 and Patents, Designs and Trade Marks Act 1883, s. 73.
30 Nothing in this Act shall be construed as authorising or requiring the registrar to register a design the use of
identical wares or perform similar services; the exclusive right applies only to the use of the particular mark in association with these wares or services.

### 3.1 GROUNDS FOR REFUSAL OF INTERNATIONAL APPLICATION OF TRADEMARK REGISTRATION

Article 6 of the Paris Agreement provides for the grounds for cancellation or refusal of a mark under this provision includes ‘infringement, non-distinction, and immorality’. Where a mark has been duly registered in the country of origin, it must, on request, be accepted for filing and protected in its original form in the other Contracting States. Nevertheless, registration may be refused in well-defined cases, such as where the mark would infringe the acquired rights of third parties; where it is devoid of distinctive character; where it is contrary to morality or public order; or where it is of such a nature as to be liable to deceive the public.

### 3.2 CONTRAVENING PROVISIONS FOR TRADEMARK REFUSAL

Even Though various Legal Jurisdictions have separate provisions for refusal of trademark application or cancellation of trademark registration, Trademark laws are in each state itself contravenes to certain provisions of public interest and policies.

For instance, The Trademark Act of 1946 ("Lanham Act") of the United States employs several content-based criteria that bar trademark eligibility. Such criteria include inquiries into whether a mark is descriptive, generic, deceptive, or a government symbol; whether a mark resembles a living person or an existing mark; whether a mark is functional; and whether a mark is immoral, scandalous, or disparaging. At times, the criteria that bars trademark protection for immoral, scandalous, and disparaging marks—which refer to as the "morality bars"—have come under constitutional attack.

In re Tam, a majority of an en banc U.S. Court of Appeals for the Federal Circuit held that the morality bars violate the First Amendment. Yet in the face of the other content-based bars in trademark law, coupled with the lengthy history of the morality bars, the majority's holding is puzzling. The context of trademark law seems to justify the seeming offense to free speech. For if the morality bars violate free speech, it would seem that the other content-based criteria do

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37 Id at 718.
40 F.3d 1321 (Fed. Cir. 2015) (en banc), cert. granted, 137 S. Ct. 30 (2016).
41 Compare In re Boulevard Entm't, Inc., 334 F.3d 1336, 1343 (Fed. Cir. 2003) (ruling the antimmoral criterion of the Lanham Act does not violate the First Amendment), abrogated by Tam, 808 F.3d 1321, 1367, 1374 (Fed. Cir. 1994) (same), abrogated by Tam, 808 F.3d 1321, and In re McGinley, 660F.2d at 718, 720 (holding that the First Amendment does not allow the government to refuse to register disparaging marks simply because the government disapproves of the expressive messages conveyed by the marks).
as well.⁴² On the basis of speech, it is difficult to distinguish the morality bars from other content-based bars in trademark law.⁴³

On the other hand, we could see a much organised set of legal provisions that sets out the grounds of refusal of registration under the Australian Trademark Act, 1995 that includes Trademarks containing prohibited and prescribed signs (s39), non-graphical representation of the Trademark (s40), Trademarks not distinguishing goods or services (s41), Trademarks that are scandalous [s42(a)], Trademarks that are contrary to law [s42(b)], Trademarks likely to deceive or cause confusion [s43], Trade marks in conflict with other trademarks [s44].⁴⁴

Few other countries also have placed strict regulations with respect to obscene logos. One such instance was with respect to the Starbucks logo in Saudi Arabia. Starbucks dropped its name from the logo and focused its image on the mermaid.

She is a Siren, a 16th century Norse twin-tailed mermaid. The Siren signifies the maritime history of coffee and the seaports of Seattle, the city where Starbucks originated.⁴⁵ In countries like Saudi Arabia, Starbucks won’t be able to use their new stripped-down logo since putting the full-frontal nudity of the siren front-and-center is far too racy for some countries in the Middle East, namely Saudi Arabia, where the siren has not appeared on the logo for over a decade. The official Starbucks logo was changed on signage throughout Saudi Arabia to feature the siren’s crown floating on a sea. The siren was deemed morally inappropriate for Saudi Arabia and thus it was replaced with a crown swimming in the sea. But in no other countries, such interpretation was ever given for the new Starbucks logo.⁴⁶

CHAPTER 4: LEGISLATIVE PROVISION RELATING TO TRADEMARK REGISTRATION- AN INDIAN PERSPECTIVE

All marks used in the trade are not registrable. The trademark law does not provide for the registration of all marks used in trade and business. Marks those satisfy certain requirements are only registrable. A trademark as defined under Sec 2(zb) of the...
Trademarks Act, 1999\(^\text{48}\) the requirements that a mark should satisfy are as follows:

1. The mark should be capable of being represented graphically.
2. The mark should be capable of distinguishing the goods or services of one from those of others.
3. The mark must be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and services\(^\text{49}\).

For instance, 'apple' would be descriptive of the fruit 'apple' and would not be registrable as a trademark for that fruit. This is not an absolute prohibition and a descriptive mark is capable of registration if it has acquired secondary meaning, i.e., it has acquired such reputation and goodwill such that an average customer identifies the descriptive mark with the particular product\(^\text{50}\). This rule was spelt out by the Supreme Court in their \textit{Godfrey Philips India Ltd. v. Girnar Food and Beverages (P) Ltd}\(^\text{51}\). Another Supreme Court case that dealt with the issue of descriptive/hiding actual meaning of that mark was in \textit{J.P. Kapoor v. Micronix India}\(^\text{52}\), wherein the Supreme Court observed that the word ‘micro’ being descriptive/hiding meaning of micro technology used for production of electronic items of daily use, could not be claimed exclusively.

\textbf{4.2 GROUNDS FOR REFUSAL OF TRADEMARKS IN INDIA}

According to the Indian trademarks law, grounds for refusal for Trademark registration can be divided into two headings as absolute grounds and relative grounds\(^\text{53}\). Under Section 9(2)- A mark shall not be registered as a trade mark if-

(a) it is of such nature as to deceive the public or cause confusion;
(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
(c) it comprises or contains scandalous or obscene matter;
(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950)\(^\text{54}\).

\textit{a. Contains scandalous or obscene matter}\(^\text{55}\): Clause 3 talks about things that are against the principles of morality. Anything that contains scandalous or obscene matter shall not be registered as a trademark due to it being against the principles of morality. As held in the UK case of \textit{Ghazilian Trade Mark Application}\(^\text{56}\) the test whether a thing was against principles of morality was an objective one. It lies on the fact that a right-thinking member of the public might not himself or herself be outraged but would be able, objectively, to assess whether or not the mark in question was calculated to cause

\textit{\textsuperscript{49}} Origin IP solutions LLP, \textit{Grounds for refusal of trademark registration}, (26\textsuperscript{th} March, 2020),<https://www.origiin.com/2020/03/26/groun ds-for-refusal-of-trademark-registration/>\(^\text{50}\)
\textit{\textsuperscript{51}} 2005 (4) SCC 457
\textit{\textsuperscript{52}} 1994 Suppl. (3) SCC 215
\textit{\textsuperscript{54}} Origin IP solutions LLP, \textit{Grounds for refusal of trademark registration}, (26\textsuperscript{th} March, 2020),<https://www.origiin.com/2020/03/26/groun ds-for-refusal-of-trademark-registration/>\(^\text{50}\)
\textit{\textsuperscript{55}} Rao, supra note 58 at 28.
\textit{\textsuperscript{56}}[2001]RPC 654
“outrage” or “censure” amongst a relevant section of the public. In this case the trademark in question consisted of two words "Tiny Peenins" in class 25 in respect of clothing, footwear and headgear. The Registrar refused the registration on the ground that the mark was contrary to the accepted principles of morality. The appellate authority while dismissing the appeal, concluded that this trademark would cause greater offence than mere distaste to a significant section of the public. The offence resides in the fact that an accepted social and family value is likely to be significantly undermined.

4.3 STATUS OF REGISTRATION OF IMMORAL/OFFENSIVE MARKS IN INDIA:

Unlike the prohibition against registering surnames and geographical terms, the prohibition against registering immoral, scandalous, and similarly offensive marks is unaffected by secondary meaning. A in the case of a word that just needs to be reduced to something less than main importance. Because the only form of use that may make an offensive mark registrable is one that fundamentally changes the mark's meaning, there's a slim chance that an offensive mark will ever become registrable.

The case of Maqbool Fida Husain v. Raj Kumar Pandey is crucial in further discussed the removal of "obscenity" as a cause for the Trade Mark registration bar. In this case, Maqbool Husain, a famous painter, in one of his paintings, later titled “Bharat Mata” (Mother India), depicts India in the form of a naked woman. Husain sold it to a private collector in 2004. In 2006, the painting was advertised in an online charity auction for earthquake victims. The advertisement of the painting led to protests, and private complaints were filed in various parts of India. The Supreme Court consolidated and transferred the matter to Delhi. The Court held that Husain was not guilty under section 294 of the IPC, which deals with prevention of obscene acts performed in public. The mere fact that this painting was uploaded on a website that could be accessed by any person was not enough to constitute an offense under this provision. The Court also held that Husain had no deliberate intention to hurt religious feelings and was, therefore, not guilty under section 298 of the IPC. The Delhi High Court also held that a liberal tolerance of differing points of view has no negative consequences.

CHAPTER- 5: MAJOR CASES STUDIES THAT ARE AGAINST THE ‘LEVEL PLAYING FACTOR’

The controversy over a ‘logo’ of a company that has got the company in trouble is not so uncommon. Many logos have been threatened because they involuntarily (or not) suggested a different message from the one they should have conveyed. One such

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58 2008 Crl. LJ 4107
60 Nupur Amarnath, From Myntra to London Olympics, signs that landed in debacle, ET Bureau, (07 Feb 2021).
instance was of the 2012 London Olympic games logo. After the logo was revealed, a petition signed by over 48,000 citizens, was circulated in Great Britain to have the logo scrapped and redesigned. Many felt the logo didn't represent London at all and that it was too radical. It even invited a religious uproar when some said the word "Zion" was hidden in the symbol.  

What makes proprietor distinct from brands is the hidden message in logos. Through this, they’re able to incorporate branding and make themselves stand out from other companies. It gives them an edge due to the logo’s creativity because it sticks in people’s minds. There are also examples, when the creator of a logo has actually used his skills and innovations to create a unique logo or label with a bona fide intention to strengthen the customer and company bond. Similarly, the ‘Amazon’ logo is a hint at what you can buy from the online store. On a careful perusal one can see the Amazon logo contains a smile, but what doesn’t register easily is the arrow pointing from “a” to “z”, meaning the online giant carries most products under the sun.

Baskin Robbins has one of the famous logo designs in the world. But, what many may miss is the emphasis on the B and R in the logo. The curvings on the B and the stem on the R place an emphasis on the number 31.

They even created a slogan “31 flavour” in 1953, which supposed a flavour each day. But the company rejected this contention and confirmed that according to Baskin Robbins, the number represents the number of days in a month. This against the Trademark law as the number 31 in the logo is descriptive in nature. But no action has ever been taken against this and is violative of the legal provisions. This points towards a very serious lacunae in the implementation of the Trademark laws and thus pave ways for

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61 id
many unscrupulous logo adopters to adopt unacceptable logos that are against the public policies, morality, ethical standards, and most importantly the established legal principles. This scenario could be studied in detail through the ‘Myntra case’.

5.1 MYNTRA’S BACKGROUND
Myntra was founded back in 2007, which had been subsequently taken over by Flipkart in 2014 and later merged with e-commerce platform Jabong to expand its business and marketing. It is one of the largest e-commerce stores for fashion and lifestyle products in India.  

5.2 COMPLAINT FILED
The complaint stated that the official logo of Myntra, was offensive and insulting to woman as it is portraying the visual of a naked woman suggestively depicting her legs in a vulgar manner. They further submitted that the ‘overall placement of colour scheme’, of the letter ‘M’, in the logo was obscene in the eyes of any average person and claimed it was a deliberate attempt to corrupt the minds of the viewers and even excite them which can further lead to unwanted victimization of woman in the society. The complaint had been filed back in December, 2020 following which the police met up with the officials working at the company and concluded that Myntra will change its logo within a period of one month.

5.3 LEGAL INTERPRETATION
Taking into consideration the fact that the revised logo comprises of minor changes only, firstly, one shall analyse the application of Section 9(2)(c) of the Trade Marks Act, 1999, in the Myntra case. Secondly, it shall apply the Test of Contemporary Standards to examine whether the supposed obscenity in Myntra’s Logo is valid. Thirdly, one shall scrutinize how the reading of Section 9(2)(c) of the Trade Marks Act, 1999 with the Indecent Representation of Women (Prohibition) Act, 1986, in Myntra’s case is futile. Fourthly it shall also analyse the

Myntra has applied for a multi-class series application for its new logo on 13/01/2021, which has already been accepted by the Indian Trade Marks Registry. The logo is now been changed in the website, application and on packaging materials.

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**Notes:**


69 Id
international jurisprudence regarding the bar of Trade Mark Registration on the ground of obscenity, to analyse the correctness of the case. In finality, it should be considered, the possible consequences that Myntra and other brands may face in the coming future alongside the probable alternative that they could adopt for better damage control⁷⁰.

There were many instances worldwide when the trademark of a company was famous for the wrong reasons. In 1971, Ford launched a car named Pinto. The problem was that the word ‘pinto’ roughly translates to male genitals in Brazil. The car did not get much revenue for the company and was eventually withdrawn by them. Similarly, the logo of Arlington Pediatric Center got into the bad news when it launched its logo in 2009. Institute of Oriental Studies, are very famous examples of when things didn’t go very well for the companies with respect to their logos⁷¹.

In India, this issue received attention only recently through the Myntra obscene logo case wherein the Myntra logo was changed after it was claimed to be “offensive and derogatory to women”⁷². Though the Trademarks act lays down the grounds of refusal for registration of a trademark on it being obscene or scandalous, there has no proper definitions or interpretations given for these words, thus letting unscrupulous users to find loopholes in these laws and thereby ending up adopting unethical signs or logos for popularity overlooking the aspect of morality and public policies. No stringent laws have been made to curb this trend, neither there has been a bar till now to refuse a registration to such big business magnets on the grounds of public morality.

**CHAPTER – 6: OBSERVATION**

Section 9 per se is not an easy provision to get through, laying down several criteria for determining if a trademark is entitled to be accepted. While Section 9(1) is the most common provision one can perceive in an examination report, Section 9(2) is a provision which leaves no stones unturned.

9. Absolute grounds for refusal of registration.— (2) A mark shall not be registered as a trade mark if—

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

It comprises or contains scandalous or obscene matter;

The fact still remains that there aren’t many cases invoking these provisions⁷³.

Scandalous and Obscene are two words, which would connote different things to different people. What is obscene or

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scandalous to me might not even ruffle your feathers. But all said and done, we do have Section 9(2)I prohibiting trademarks that contain scandalous or obscene matter.\(^{74}\)

### 6.1 CHALLENGES IN ESTABLISHING MENS REA AND ACTUS REA AND UNFAIR COMPETITION

Section 9(2)I of the Trade Marks Act, 1999 ("1999 Act") provides that a Trade Mark shall not be registered if it comprises or contains "scandalous or obscene matter." The first point of conundrum that arises is that the Indian Legislature has failed to provide a straightforward definition for "scandalous or obscene matter" in the 1999 Act. This lack of definition leads to serious implications as it allows the Indian Courts to free ball in the already-subjective territory of interpretation of "scandalous or obscene matter" due to the laxity displayed by the Indian Legislature by failing to provide a clear-cut definition for the same. This attitude of the Indian Legislature and power given to the Courts – for interpretation of a grey area – proves counter-productive to the Indian Justice System.\(^{75}\)

Most likely Indian Courts will be given the leeway to interpret the already subjective definition of "scandalous or obscene matter" as the Indian Legislature has failed to give a standard definition for the same under Section 9(2)I. This leads us to the case of **Directorate General of Doordarshan v. Anand Patwardhan**\(^{76}\) wherein the Supreme Court held that: "The Indian Penal Code on obscenity grew out of the English Law, which made Court the guardian of public morals." The second point of conundrum that arises is the appointment of the Indian Courts as "guardian of public morals." The problem lies in the fact that if the Indian Courts are appointed as guardian of public morals, then there will be a major time-delay in the standardization of interpretation of "scandalous or obscene matter" under Section 9(2)I because there will exist conflicting decisions between various Courts in the absence of a standard definition that could have been possibly provided by the Indian Legislature. These conflicting decisions will arise due to the varying degrees of interpretation of "obscene and scandalous matter" given by various Courts unless finally settled by the Apex Court.\(^{77}\)

Thus, due to this high probability of subjective understanding and interpretation of "obscenity" by a judge, there will exist varied degrees of interpretation – for "scandalous and obscene matter" under Section 9(2)I – by the Indian Courts. Therefore, in Myntra’s case, this major time-delay in the standardization of interpretation of "scandalous or obscene matter" comes at the failure of the Indian Legislature to give a standard definition for the same under Section 9(2)I. This time-delay, in turn, may act counter-productive for efficient and effective delivery of justice until a fixed and standard definition is reached by the Indian Legislature, which is far from sight.\(^{78}\)

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\(^{75}\) ET Now Digital, *Myntra forced to change its “obscene” logo — what the controversy is about*, The Times Now, (2nd February, 2021), <https://www.timesnownews.com/bu

\(^{76}\) Appeal (civil) 613 of 2005, (25 August, 2006).

\(^{77}\) *id*

\(^{78}\) Gayathri Bisale, *Implications of Myntra Controversy*, The Hard Copy, (3rd February,
CHAPTER 7: SUGGESTION AND CONCLUSION

Any trademarks or logos should not be registered if it is against the principles of morality. Hidden messages in certain logos are appreciable but not accepted even if it is creative and morally accepted by all sectors of the society. If any person or group of people gets offended by a particular logo or brand name with a capacity to defame such a person, then it should be refused registration or if such an offence is not exposed during the time of registration and it comes to light after the logo has acquired popularity, then the logo needs to be removed or modified. I would necessarily point out here that, Indian Laws does not provide a comprehensive definition for the terms ‘scandalous’, ‘immoral’ or ‘obscene’ under the Trademark Act, 1999. Therefore, there has always been a vague interpretation for the provision of sec, 9(2) under the Act of 1999. We don’t have much of cases that deals with obscene logos or logos that carry hidden meanings or messages that have set precedents so as to set standards or stipulate certain guidelines to address these lacunae in the Indian trademark law. This aspect of law received a wide attention and interpretation in the above discussed case of Myntra Logo case, where different views were considered. Some were of the view that the logo of the said leading e-commerce fashion store were, “indecent, derogatory and denigrating to women” while other were of the opinion that the accusations were merely of those over-imaginative minds who always tries to find in anything and everything. This has brought us to the real issue in this case. Stringent laws are must to deal with such contingencies. I would clearly suggest that the interpretation of the Indian Trademark law needs to be revisited. The law and the courts have to determine and re-establish the existing accepted principles of morality. Faulty and vague interpretation of existing legal provisions dealing with obscene/scandalous content ultimately leads to imposition of arbitrary moral standards in IP practice. Courts could use the obscenity provision under IPC to appoint themselves as guardians of morals and could impose stringent punishments for defaulters of the legal provisions than merely requiring them to remove the obscenity. The courts and the law should also take into consideration the wrongful intention and unfair gains that such unscrupulous adopters display while adopting such obscene mars for their business and to gain unfair financial gains and illegal business popularity.

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