

## Legal Issues in ‘Trademark and Obscenity’

Issue: What is the Threshold for Obscenity under the Trade Marks Act, 1999?

## Relevant Provisions

### ❖ Section 9(2)(c) of the Trade Marks Act, 1999

- *A mark shall not be registered as a trade mark if—....*  
*(c) it comprises or contains scandalous or obscene matter. ‘*

### ❖ Draft Manual of Trademarks Practice and Procedure (“Draft Manual”)

- Scandalous marks are those likely to offend accepted principles of morality.
- Examiner must be objective, not subjective.
- ...objection under Section 9(2) (c) is ... to be justified ... if it would cause outrage or would be likely significantly to undermine religious, family or social values ... The outrage must be amongst an identifiable section of the public.
- Objections should be raised against explicit full-frontal nudes and offensive (scandalous) back views.

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## Relevant Provisions (Contd.)

### ❖ Proposed Trademark Manual for Comments (“Proposed Manual”)

48. “Mark containing scandalous or obscene matter”-

- Whether a mark is obscene is a question of fact and it is for the applicant to demonstrate that it is not so when faced with objections under this provision.
- Scandalous marks are those likely to offend accepted principles of morality.
- A mark which on its face appears to be offensive shall be refused.
- In this category will fall marks which could induce public disorder or incite the criminal or other offensive behaviour.
- The applicability of the objection must be decided objectively and non-discriminately.

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# Obscenity through the Test of Contemporary Standards over Hicklin's Test

## ❖ Hicklin Test

- Hicklin test postulated that a publication has to be judged for obscenity based on isolated passages of a work considered out of context and judged by their apparent influence on most susceptible readers, such as children or weak-minded adults.
- Hicklin's Test does not give comprehensive results by failing to consider a holistic perspective.

## ❖ Test of Contemporary Standards

- The test of contemporary standards examines the question of obscenity in the context in which the photograph appears and the message it wants to convey.
- It tests obscenity on the current standards and dynamics of the society as a whole from the viewpoint of a common person of prudent sense.

## Relevant Case Laws

❖ ***Samaresh Bose v. Amal Mitra* [1985 SCC (4) 289]**

[A] Judge with a puritan and prudish outlook may on the basis of an objective assessment of any book or story or article, consider the same to be obscene. It is possible that another Judge with a different kind of outlook may not consider the same book to be obscene on his objective assessment of the very same book.

❖ ***Aveek Sarkar v. State of West Bengal* [2005 (2) CHN 694]**

[A] picture of a nude/semi-nude woman, as such, cannot per se be called obscene unless it has the tendency to arouse feeling or revealing an overt sexual desire. The picture should be suggestive of deprave mind and designed to excite sexual passion in persons who are likely to see it, which will depend on the particular posture and the background in which the nude/semi-nude woman is depicted. Only those sex-related materials which have a tendency of “exciting lustful thoughts” can be held to be obscene, but the obscenity has to be judged from the point of view of an average person, by applying contemporary community standards.

## Myntra Logo Complaint

- ❖ In December 2020, Naaz Patel of Avesta Foundation NGO filed a complaint with the Cyber Crime Department of the Mumbai Police. The complaint alleged that Myntra’s Brand logo (legally called “Trade Mark”) is offensive to women.
- ❖ Mumbai Cyber Crime Department responded to the complaint wherein they “found” the logo to be offensive to women. It is pertinent to note that, herein, no further explanation or detailed reasoning was given by the Mumbai Cyber Crime Department. Such a reasoning was mandated because it would have allowed a better comprehension of what considerations went behind while determining the logo as “offensive to women.”
- 6 ❖ Immediately after the response by the Cyber Crime Department, an email was sent by them to Myntra due to which Myntra took the decision of revising its logo.
- ❖ As of date, Myntra has already applied on January 13, 2021, for a Multi-Class Series Application (Class 99) bearing trademark number 4819586 for its revised logo that has been revamped with minor changes.

## Gross Over-Observation

- ❖ S Rangarajan v. P Jagjivan Ram ( 1989 ) 2 SCC 574, held that the standards that are to be applied for judging a film – on the basis of obscenity – should be from the viewpoint of an ordinary person of common sense and prudence and not that of a “*hypersensitive man.*” Although the case deals with films, the core ingredient lies in that of testing obscenity.
- ❖ In Myntra’s case, a gross over-observation has been made in the Logo from the viewpoint of a hypersensitive person because, at the first few observations of the Logo, it is highly unlikely for a person to perceive it as derogatory and obscene to women.
- ❖ The same possibility of unlikelihood is proven from the fact that Myntra’s logo has not been objected till December 2020, *i.e.*, over 10 years since its registration as a trademark in India.

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## Indecent Representation of Women (Prohibition) Act, 1986

- ❖ 2(c) - “*Indecent Representation of Women*” as “*the depiction in any manner of the figure of a woman, her form or body or any part thereof in such a way as to have the effect of being indecent, or derogatory to, or denigrating, women, or is likely to deprave, corrupt or injure the public morality or morals.*”
  - ❖ Further, there is little to no interpretation given by the Indian Courts to such phrase in the context of intellectual property. 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*”.
  - ❖ A *prima facie* case of indecent representation of women has to be made which, in Myntra’s case, seems to be absent because, at a *prima facie* glance, the alphabet “M” does not represent the legs of a woman.
- 8 Thus, the 1986 Act is rendered inapplicable.



## Conclusion

- ❖ Due to the lack of a definition for “*obscene and scandalous matter*” under Section 9(2)(c), there will be varying degrees of interpretation for “obscene and scandalous mater” given by the Indian Courts.
- ❖ Removal of “*obscene and scandalous matter*” as a ground for bar on trademark registration under the 1999 Act seems to be an appropriate solution for now.
- ❖ Revision of Myntra’s Logo seems to be an unnecessary step because the nature of the complaint that has been raised seems hypersensitive.
- ❖ A solution that Myntra could have adopted and other brands, if faced with similar situations, may adopt in future, would be to explain the craftsmanship that had gone behind their Logo in a manner similar to that of PepsiCo who had given a detailed breakdown of their Logo and the social considerations that went behind it.

# THANK YOU!

## Questions?

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