

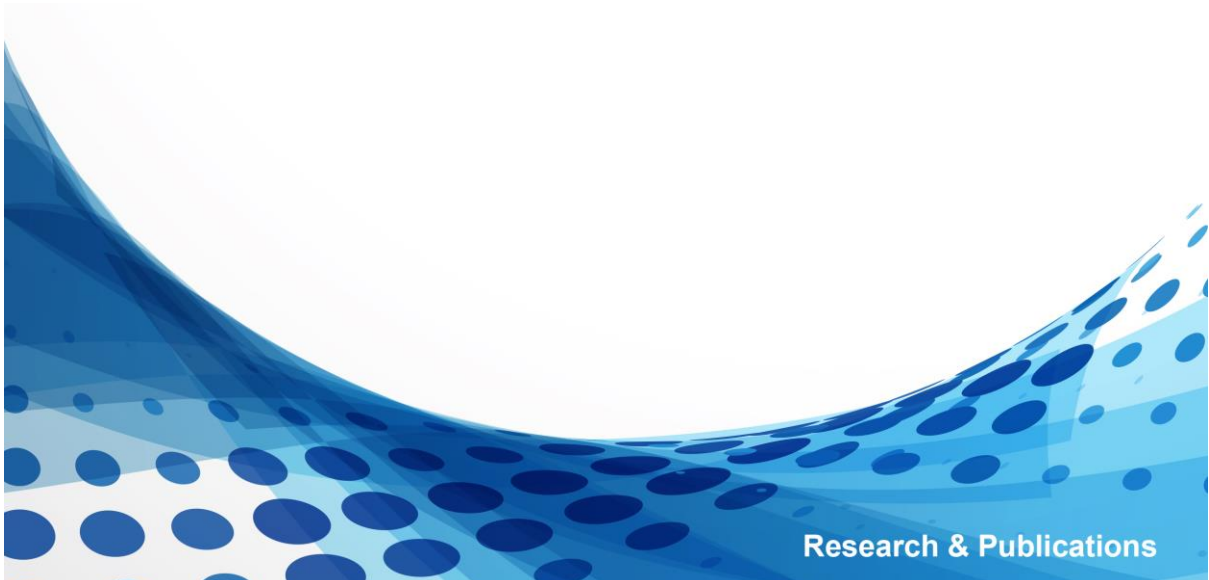


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‘Scandalous’ and ‘Obscene’ Trademark Law: Determining the scope of morality-based proscriptions in Indian Law

M P Ram Mohan & Aditya Gupta



Research & Publications

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‘Scandalous’ and ‘Obscene’ Trademark Law: Determining the scope of morality-based proscriptions in Indian Law

M P Ram Mohan* & Aditya Gupta[‡]

Abstract:

Morality-based restrictions on trademarks are a ubiquitous element of domestic trademark legislations, appearing in 163 out of 164 WTO member states. In 2019, the United States Supreme Court ruled against the constitutionality of these provisions in *Iancu v. Brunetti*, and opined that they run afoul of American free speech jurisprudence. The Court’s discomfort was with the structure of the legislative proscription, and they emphasized the significance of linguistic regulation rooted in moral principles within trademark law. The Indian counterpart of these provisions suffer from a unique problem: despite being a part of the legislative framework for over four decades, no legislative or judicial body has interpreted morality-based proscriptions in India. Examining the administrative practices of the Indian Trade Marks Registrar and reviewing the Indian Trade Marks Register convey an inconsistent application of this provision. The findings highlight a need to develop comprehensive guidelines. This paper underscores the legislative language of Australian law as the closest analogue to Indian law on the subject and proposes an overarching framework for discerning the import and meaning of ‘scandal’ and ‘obscenity’ within the context of Indian law.

Keywords: Trademarks, India, Scandalous and Obscene, Morality

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Introduction

Morality-based prohibitions on trademark registrations are a ubiquitous aspect of domestic trademark laws. A study compiled in 2016 suggests that out of the 164 members of the WTO, 163 member states include morality-based proscriptions on trademark registration.¹ However, the laws that established some of the world's first trademark registers² did not include such restrictions.³ It was only in 1875 that UK's Trade Mark Registrations Act prohibited the registration of *scandalous designs*.⁴

After 1875, the morality-based prohibitions on trademark registrations found recognition in the Paris Convention for the Protection of Industrial Property (Paris Convention) in 1883, which allowed member states to reject any marks “*contrary to morality or public order.*”⁵ The Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, 1994, did not change the morality-based proscriptions against trademark registration and allowed member states to deny registration of trademarks in line with the Paris Convention.⁶ The discretionary wording in these international treaties recognizes that moral standards differ between countries and that the law needs to reflect such diverse standards.⁷

¹ The only exception being Vietnam. See: Colin Edward Manning, ‘Moral Bars on Trade Mark Registration’ (LLM Theses and Essays, Law School, University College Cork 2016) 13 <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2875687>.

² It was only with the French Law in 1857 that reliable registration data began to emerge. US only began registration in 1860, while the United Kingdom began registrations in 1876. PAUL DUGUID, TERESA DA SILVA LOPES and AND JOHN MERCER, ‘Reading Registrations: An Overview of 100 Years of Trademark Registrations in France, the United Kingdom, and the United States’, *Trademarks, Brands, and Competitiveness* (Routledge 2010); Thomalyn Epps, ‘Trademark Law: How We Got to Where We Are Today Developments in Trademark Law: Part One: The Common Law, the States, and Historical Perspective’ (2010) 19 *Journal of Contemporary Legal Issues* 3, 4–6.

³ Manning (n 3) 8–12; Alysa Arcos Ziemer, Pedro Silveira Tavares and Marc John Randazza, ‘Morality and Trademarks: The South American Approach’ (2017) 40 *Suffolk Transnat’l L. Rev.* 221, 230.

⁴ Section 6, Trade Marks Registration Act, 1875, “*That it shall not be lawful to register as part of, or in combination with a trade mark...or any scandalous design,*” Edward Morton Daniel, *The Trade Marks Registration Act, 1875: And the Rules Thereunder, with Introd., Notes, and Practical Directions as to Registering Trade Marks: Together with the Merchandise Marks Act, 1862, with Notes and a Copious Index to the Whole* (Stevens & Haynes 1876) 38, 39 <https://www.google.co.in/books/edition/The_Trade_Marks_Registration_Act_1875_an/4x0tAQAAMAAJ?hl=en> accessed 18 March 2023.

⁵ Article 6quinquies, Paris Convention on Protection of Industrial Property, 1883.

⁶ Article 15(2), Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994, See: Teresa Scassa, ‘Antisocial Trademarks’ (2013) 103 *Trademark Rep.* 1172, 1178.

⁷ Christine Haight Farley, ‘A Research Framework on Intellectual Property and Morality’ in Irene Calboli and Maria Lillà Montagnani (eds), *Handbook of Intellectual Property Research: Lenses, Methods, and Perspectives* (Oxford University Press 2021) 794.

While the Paris Convention provides the primary international legal foundation for morality-based limitations,⁸ the legislative language used by domestic trademark statutes varies significantly. The contemporary English Trademark law prohibits registration when the subject marks are “*contrary to public policy or to accepted principles of morality.*”⁹ Alternatively, Australian law prohibits the registration of *scandalous* marks,¹⁰ and Canadian prohibition extends to *scandalous, obscene, and immoral trademarks.*¹¹ The Indian trademark statute prohibits registration of marks that might offend religious sensibilities of Indian residents¹² and marks which contain scandalous or obscene matter.¹³

The morality-based restrictions on trademark registrations are notorious for lacking judicial engagement. Prof. Farley notes, “The regulation of morality in trademark law is one of those topics which generates more law review articles than cases.”¹⁴ However, this position was substantially altered between 2017 and 2019 when the United States Supreme Court, in two different decisions, held that the restrictions against disparaging,¹⁵ scandalous, and immoral marks¹⁶ violate the principles of the First Amendment.¹⁷

On the other hand, the Indian legal framework on marks containing ‘scandalous’ and ‘obscene’ matter is considerably more ambiguous. Since its implementation in 1940, no judicial decisions have interpreted or examined the scope and meaning of the provision in the last eight decades. Further, while the provision traces its origins in English Trademark Law,¹⁸ it has deliberately diverged from the English model and instead adopted the legislative approach of Australia.¹⁹

⁸ Griffin M Barnett, ‘ICANN Morality Standards and the New gTLDs: A Comparative Analysis of Morality in International Trademark Law in the Internet Age’ (2013) 103 Trademark Rep. 1214.

⁹ Section 3(3)(a), English Trade Marks Act, 1994.

¹⁰ Section 42, Australian Trade Marks Act, 1995.

¹¹ Canadian Trade-marks Act, R.S.C. 1985, c. T-13, § 9(1)(j).

¹² Section 9(2)(b), Trade Marks Act, 1999.

¹³ Section 9(2)(c), Trade Marks Act, 1999.

¹⁴ Christine Farley, ‘Stabilizing Morality in Trademark Law’ (2014) 63 American University Law Review 1019, 1020.

¹⁵ *Matal v Tam* 137 S. Ct. 1744, 2017 U.S. LEXIS 3872 (United States Supreme Court).

¹⁶ *Iancu v Brunetti* 2019 U.S. LEXIS 2, 139 S. Ct. 782 (United States Supreme Court).

¹⁷ The First Amendment of the United States Constitution protects the right to freedom of religion and freedom of expression from government interference. The United States Supreme Court interprets the extent of the protection afforded to these rights. The most basic component of freedom of expression is the right to freedom of speech.

¹⁸ Irene GR Moses, ‘The Law and Practice under the Trade Marks Act, 1940’ (1946) 158 Nature 604; Rajagopala N Ayyangar, ‘Report of Shri Justice N. Rajagopala Ayyangar on Trade Marks Law Revision’ (Ministry of Commerce and Industry, Government of India 1955) <https://spicyip.com/wp-content/uploads/2015/02/Ayyangar_Committee_Report_Trademarks_2015.pdf> accessed 19 December 2021.

¹⁹ Ayyangar (n 20) 35–36.

The Office of the Controller General Patents, Designs & Trade Marks²⁰ appears to disregard the theoretical and legislative lineage of the prohibition, leading to unpredictable and inconsistent results.

This study represents a pioneering effort to identify the interpretation of the bar against ‘scandalous’ and ‘obscene’ marks in India by examining the legislative and jurisprudential ancestry of the provision. Further, by studying the guidelines and the conduct of the Trade Marks Registrar, the study highlights significant inconsistencies in the application of the proscription. This research, however, is only concerned with determining the interpretation of the Indian rule against ‘scandalous’ and ‘obscene’ trademarks. The constitutionality of the proscription within Indian free speech jurisprudence is beyond the scope of the present study.

Part 1 of the study underlines the importance of linguistic regulation in trademark law. While the section does not speak to the model of such regulation, it attempts to emphasize its importance in contemporary trademark statutes. To undertake this exercise, the authors study the United States Supreme Court’s decision in *Iancu v. Brunetti*, where the court deemed the prohibition of ‘scandalous’ and ‘immoral’ marks unconstitutional based on free speech principles. Despite striking down the provision, the Supreme Court acknowledges the pivotal role of linguistic regulation in trademark law. Part 2 traces the legislative origin of the morality-based restrictions in Indian trademark law to Australian Trade Mark Law. The section analyses Australian trademark jurisprudence to identify relevant guidelines for the application of morality-based proscriptions in Indian law. Part 3 is an applied study focusing on the Indian Manual of Trade Marks, and Indian Trade Marks Register. It aims to examine the axioms identified in Part 2 and applies them within the context of the Indian Trade Mark Registrar’s practices.

²⁰ Section 3, Trade Marks Act, 1999: For the purposes of The Trade Marks Act, 1999 and the Trade Marks Rules, 2017, the Controller General Patents, Designs & Trade Marks serves as the Registrar of Trade Marks.

1. Morality-Based restrictions in American Trademark law

Morality-based proscriptions first appeared in American Trademark Law in 1905²¹ and were later reenacted as Section 2(a) of the American Trademark Act, 1946 (Lanham Act).²² While the underlying rationale for the inclusion of such restrictions remains contested,²³ the provisions have received overwhelming criticism for being vague, undefined and difficult to apply. Profs. Carpenter and Murphy emphasize that because of a lack of sufficient definitional standards, trademark examiners continue to apply erratic explanations when applying the provision and arrive at inconsistent results.²⁴ Despite the vague mandate, the challenges to the constitutional validity of Section 2(a) remained unsuccessful until 2017.²⁵

In 2017, an Asian-American dance rock band attempted to register the mark ‘*The Slants*.’ The term was a derogatory slur taunting the ‘slanted eyes’ of some people of the Asian descent, at a time when America was at war with some Asian countries.²⁶ The band had adopted the mark in 2011 in an attempt to represent the Asian-American community.²⁷ The band name was an attempt to recode the racial, cultural and ethnic aspersions associated with the word ‘*Slants*.’²⁸ However, the United States Patents and Trademark Office (USPTO) accused their mark of disparaging the Asian-American population.²⁹ The band was being accused of perpetuating the trope associated with systemic racism, ironically undermining their efforts to counter those very stereotypes. This aspersion was confirmed by the Trademark Trial and Appellate Board (TTAB).³⁰

In 2017, while reviewing the registrability of the mark ‘*The Slants*,’ the United States Supreme Court in *Matal v. Tam* held that “*speech that demeans based on race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our*

²¹ The bar against disparaging marks was only added in 1946. Theodore H Davis Jr, ‘Registration of Scandalous, Immoral, and Disparaging Matter under Section 2 (a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark’ (1993) 83 Trademark Rep. 801, 339.

²² 15 U.S.C. § 1052(a).

²³ For a study of the potential justifications see; Anne Gilson LaLonde and Jerome Gilson, ‘Trademarks Laid Bare: Marks That May Be Scandalous or Immoral’ (2011) 101 Trademark Rep. 1476.

²⁴ Megan Carpenter and Kathryn Murphy, ‘Calling Bullshit on the Lanham Act: The 2 (a) Bar for Immoral, Scandalous, and Disparaging Marks’ (2010) 49 University of Louisville Law Review 465, 472–473.

²⁵ *In Re McGinley* 660 F.2d 481 (C.C.P.A. 1981); Davis Jr (n 23) 350.

²⁶ Philip Herbst, *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States* (Intercultural Press 1997) 207. Also see: U.S. Trademark Application Serial No. 77952263 (filed Mar. 05, 2010) (see prosecution history).

²⁷ They even wrote a song, the lyrics of which read, “*We sing for the Japanese/And the Chinese/And all the dirty knees/Do you see me?*”

²⁸ Simon Tam, ‘First Amendment, Trademarks, and the Slants: Our Journey to the Supreme Court’ (2018) 12 Buff. Intell. Prop. LJ 1.

²⁹ US Serial Number: 85472044, see office action dated 06.01.2012.

³⁰ *In re Shiao Tam*, 2013 TTAB LEXIS 485.

free speech jurisprudence is that we protect the freedom to express the thought we hate.”³¹ The Court held that the bar against disparaging marks constituted a viewpoint based discrimination,³² which embraces some viewpoints while restraining others. Such a law can be misused to silence minority or dissenting voices and is violative of the rights enshrined in the First Amendment.³³

Following the Supreme Court’s ruling on the invalidity of disparaging marks, a parallel rationale emerged two years later when the constitutionality of the prohibition on ‘scandalous’ and ‘immoral’ marks faced scrutiny.³⁴ Unlike the previous case, the court in *Iancu v. Brunetti* explicitly emphasized the significance of linguistic regulation and offered comprehensive guidelines on the scope of regulation under morality-based proscriptions.

1.1. Iancu v. Brunetti

Erik Brunetti, an artist famous for his assaults on the American culture critiquing capitalism, government, religion and pop culture, applied for the registration of the trademark ‘FUCTION.’ He alleged that the mark was an acronym for ‘Friends U Can’t Trust.’ Talking about the potentially controversial brand name’, which was a homonym for the word ‘Fucked,’ Brunetti said, “*It was very premeditated. We didn’t wanna just call it FUCTION to make it look crazy. We wanted it to be confusing.*”³⁵

The USPTO, and subsequently the TTAB, denied Brunetti’s attempt to register the mark for containing scandalous and immoral matter.³⁶ The TTAB held that the mark was “*highly offensive*” and “*vulgar*” with “*decidedly negative sexual connotations.*” The examiners also examined the advertising material associated with the brand and held that it was associated with “*extremely nihilistic*” imagery, which “*communicated misogyny depravity and violence.*”³⁷

³¹ *Matal v. Tam* (n 12) 1764.

³² ‘Viewpoint discrimination’ arises when government regulation discriminates between two opposed sets of ideas on the same topic. Clay Calvert, ‘Iancu v. Brunetti’s Impact on First Amendment Law: Viewpoint Discrimination, Modes of Offensive Expression, Proportionality and Profanity’ (2019) 43 Colum. JL & Arts 37, 45–54; Lackland H Bloom Jr, ‘The Rise of the Viewpoint-Discrimination Principle’ (2019) 72 SMU L. Rev. F. 20, 28–30.

³³ *Matal v. Tam* (n 17).

³⁴ *Iancu v. Brunetti* (n 13).

³⁵ Ian Michna, ‘Discussing the History of FUCTION & the Current Streetwear Market’ [2019] *Jenkem Magazine* <<https://www.jenkemmag.com/home/2019/05/23/discussing-history-fuction-current-streetwear-market/>> accessed 6 February 2023.

³⁶ *In re Brunetti* (2017) 2014 TTAB LEXIS 328 (Trademark Trial and Appeal Board).

³⁷ *ibid*; Claire Bosarge, ‘Iancu v. Brunetti: The First Amendment Takes Precedence over Lanham Act’s Prohibition of Trademarks Composed of Immoral or Scandalous Matter’ (2020) 22 Tul. J. Tech. & Intell. Prop. 225.

On appeal, the Court of Appeals for the Federal Circuit (CAFC) agreed that the mark contained scandalous and immoral material.³⁸ However, the CAFC did not find any substantial public interest in proscribing scandalous or immoral marks. Reversing the TTAB's decision, the CAFC did not find any public interest in banning scandalous and immoral marks, and held that the provision remains vague and ambiguous and fails the constitutional muster.³⁹

The Supreme Court admitted a writ of certiorari against the CAFC decision. The majority decision of the US Supreme Court in *Iancu v. Brunetti* was a logical extension of the principles established in *Matal v. Tam*.⁴⁰ Unlike the CAFC whose decision was predicated on ambiguity, the Supreme Court held that the ban against scandalous and immoral marks “discriminate against speech based on the ideas or opinions it conveys.”⁴¹ The majority asserted that the provision constituted a viewpoint based regulation which allows the registration of marks whose messages align with, rather than challenge, society's standards of decency and propriety.⁴² Explaining the reasoning of the court, Justice Alito explained that the decision of the majority was “not based on moral relativism, but on the recognition that a law banning speech deemed by government officials to be “immoral” or “scandalous” can easily be exploited for illegitimate ends.”⁴³

1.2. The continued relevance of linguistic regulation

While the issues surrounding viewpoint neutrality and the application of First Amendment jurisprudence pertain exclusively to American legal frameworks and are irrelevant to Indian law,⁴⁴ the focal point of studying the decision lies in the Court's nuanced stance. Despite outright condemnation of the extant statute's form, the Court underscored the intrinsic value

³⁸ *Iancu v Brunetti* 877 F.3d 1330 (United States Court of Appeals for the Federal Circuit) 1337–1341.

³⁹ *Iancu v. Brunetti* (n 35); Kyung-Lee Kelly Go, ‘Flaunting the Scarlet Letter: Consumer Regulation of Trademark Morality after *Iancu v. Brunetti*’ (2020) 35 Berkeley Tech. LJ 1213, 1219–1222.

⁴⁰ Go (n 40) 1214; Calvert (n 27) 40–42.

⁴¹ *Iancu v. Brunetti* (n 13); *Matal v. Tam* (n 12); *Rosenberger v Rector & Visitors of the Univ of Va* 515 U.S. 819, 115 S. Ct. 2510.

⁴² Coming to this conclusion, the Court cited many instances where the § 2(a) was applied in an inconsistent manner. For example, the PTO had allowed the registration of the mark JESUS DIED FOR YOU, but objected to the registration of the mark BONG HITS FOR JESUS. The Court held that the scandalousness provision was nothing more than a fishing license for government bureaucrats to strike down particular marks they deemed “off-putting.” *Iancu v Brunetti* OG 139 S. Ct. 2294.

⁴³ *Iancu v. Brunetti* (n 13) 2302.

⁴⁴ The principle of viewpoint and content discrimination does not form a part of Indian constitutional jurisprudence. See: Shrutanjaya Bhardwaj, ‘Freedom But Not Really: The “Unprotected” Zones of Art. 19 (1)(a)’ (2019) 4 Comparative Constitutional Law and Administrative Law Journal 27.

of linguistic regulation. This position was strikingly clear in the four minority opinions filed by the eight-judge bench.⁴⁵

This proposition was best explained by Justice Alito who explicitly suggested that the Supreme Court's decision in *Iancu* does not prevent Congress from adopting a more carefully worded statute.⁴⁶ Similarly, Justice Breyer also suggested that "*an applicant who seeks to register a mark should not expect complete freedom to say what she wishes, but should instead expect linguistic regulation.*"⁴⁷

The judges' keen interest in arguing in favor of linguistic regulation stemmed from concerns about the potential implications of the *Brunetti* decision on trademark law. The judges worried that the removal of the bar against 'scandalous' and 'immoral' marks could "*further coarsen our popular culture.*"⁴⁸ As Justice Breyer exclaimed, "*Just think about how you might react if you say someone wearing a T-shirt²³⁰³ or using a product emblazoned with a racial epithet.*"⁴⁹ Similarly Justice Sotomayor remarked that after *Brunetti*, there could be a rush to register "*the most vulgar, profane or obscene words and images imaginable.*"⁵⁰

The decision implies that American constitutional jurisprudence takes issue with regulations that impede the expression of ideas, rather than those that restrict the manner in which these ideas are expressed.⁵¹ Prof. Calvert explains this distinction through an example, in the phrase 'Fuck the Draft,' what is offensive is the use of the word 'Fuck,' which in and of itself is not a viewpoint, but only *a word that violates certain norms of civil discourse in polite society and this gives offense to some people by its very utterance.*⁵² For example, both 'Fucked up Clothing' and 'Messed up Clothing' convey a similar idea, yet the former is vulgar and offensive in its presentation. According to the *Iancu* decision, while the latter cannot be enjoined, the former can and should be.⁵³

⁴⁵ All the minority opinions agreed that the PTO should be allowed to obscene, vulgar, or profane language. See: Calvert (n 27) 54, 55.

⁴⁶ *Iancu v. Brunetti* (n 18) 2302.

⁴⁷ However, this statement was part of the dissenting opinion filed by Justice Breyer. *Iancu v. Brunetti* (n 18).

⁴⁸ *ibid* 2303.

⁴⁹ Breyer J., concurring in part and dissenting in part. *Iancu v. Brunetti* (n 18).

⁵⁰ Sotomayor J., concurring in part and dissenting in part. *ibid*.

⁵¹ Calvert (n 27) 54, 55.

⁵² The expression '*Fuck the Draft*,' and the reference to it comes from one of the most important free speech cases of the American jurisprudence. It is only used here as an example. For a more comprehensive view see, Clay Calvert, 'Merging Offensive-Speech Cases with Viewpoint-Discrimination Principles: The Immediate Impact of *Matal v. Tam* on Two Strands of First Amendment Jurisprudence' (2018) 27 William & Mary Bill of Rights Journal 829, 836.

⁵³ *Calvert* (n 27) 55.

Therefore, the *Iancu* decision, emphasizes the United States Supreme Court’s nuanced view on balancing freedom of speech and linguistic regulation. Unlike other jurisdictions, the U.S. deems morality-based restrictions unconstitutional.⁵⁴ However, as seen in opinions by Alito, Breyer and Sotomayor, the decision underscores that linguistic regulation is vital, even in a legal landscape valuing free speech.

The US Supreme Court's ruling highlights the crucial role of linguistic regulation in trademark law, specifically addressing morality-based proscriptions. However, as observed in American Trademark law, these provisions are notably plagued by vague definitions and inconsistent application.⁵⁵ The next section endeavors to analyze the scope and interpretation of morality-based proscriptions within the context of Indian trademark law.

2. Indian Trademark Law and the regulation of scandalous and obscene marks

The first statute to regulate trademarks in India was introduced in 1940,⁵⁶ and was “*essentially a copy of the UK Trade Marks Act, 1938.*”⁵⁷ Prior to 1940, Indian trademark matters were governed by English common law, with infringement issues addressed by the Specific Relief Act, 1877, and registration regulated by the Registration Act, 1908.⁵⁸ The concerns of morality were regulated by Section 8 of the Act of 1940, which emulated the English law on the subject,⁵⁹ and restricted the registration of marks which contain matter that is either scandalous or contrary to morality.⁶⁰

The Act of 1940 was replaced in 1958. Consolidating the various laws affecting trademark regulation in the country, the Act of 1958 was a result of a comprehensive review of Indian

⁵⁴ The American decisions are unique in the sense that, while similar challenges have been adjudicated in other jurisdictions, none have ruled against the constitutional validity of these positions, *Constantin Film Produktion GmbH v EUIPO* [2020] Bus LR 1422; Alvaro Fernandez-Mora, ‘Inconsistencies in European Trade Mark Law: The Public Policy and Morality Exclusions’ (2020) 4 Intellectual Property Quarterly 271; In fact, acknowledging the inconsistent application of the concomitant provision in European Law, the EU Intellectual Property Network has actually committed a project for creating a common practice for interpretation and application. Brady, Rachel Claire, ‘Trade Marks Contrary to Public Policy or to Accepted Principles of Morality - a Critical Analysis of CP14’ (2023) 45 European Intellectual Property Review 472.

⁵⁵ For prevailing inconsistencies in EU Law see: Fernandez-Mora (n 56), Singaporean Law: Anil Samtani, ‘Trade Marks That Are Contrary to Public Policy or Morality: The Search for the Right-Thinking Man’ [2012] Intellectual Property Quarterly 39, Australian Law: Vicki Huang, ‘Comparative Analysis of US and Australian Trade Mark Applications for The Slants’ (2018) 40 European Intellectual Property Review 429.

⁵⁶ Trade Marks Act, 1940, Moses (n 20).

⁵⁷ VK Unni, ‘Transnational Influences in Trade Mark and Domain Name Protection: The Indian Experience’ in Srinivas Burra and R Rajesh Babu (eds), *Locating India in the Contemporary International Legal Order* (Springer India 2018) 186; Moses (n 57); WC Smith, ‘Recent Developments in Indian Trade-Marks Practice’ (1951) 41 Trademark Rep. 202, 203.

⁵⁸ Unni (n 58) 186–187.

⁵⁹ Section 11, UK Trade Marks Act, 1938.

⁶⁰ Section 8(c), Trade Marks Act, 1940.

trademark laws,⁶¹ conducted by a committee chaired by Justice Ayyangar in 1955.⁶² Following the committee's suggestions, an amending bill was introduced and after a process of consultation and revision,⁶³ it was enacted as the Trade and Merchandise Marks Act, 1958.⁶⁴

In his report, the committee suggested that Section 8 of the Act of 1940 and its concomitant provision in English Law had suffered some judicial criticism and should be amended. To reenact a provision that is “*simple, elegant and with the least amount of ambiguity*,” the committee turned to Australian Trademark Law.

The final language of the renewed provision was adopted from Section 28 of the Australian Trade Marks Act, 1955.⁶⁵ The resultant provision, Section 11(c) of the Act of 1958 prohibited the registration of marks which “*comprises or contains scandalous or obscene matter*.” The Trade Marks and Merchandise Marks Act, 1958 has since been repealed by the Trade Marks Act, 1999.⁶⁶ However, the statutory language concerning the ban against obscene and scandalous marks remains unrevised, and follows the Australian statutory language.⁶⁷

While an unabridged version of the prohibition against registration of scandalous or obscene marks has survived in Indian law for over four decades, no judicial decisions have interpreted or examined the scope and the meaning of the provision.⁶⁸ The lack of judicial commentary and minimal academic engagement with the issue adds to the confusion and incoherency regarding the meaning and interpretation of the terms ‘scandalous’ and ‘obscene.’

In investigating the legislative origins of Indian trademark law and interpreting the term ‘scandalous,’ Australian trademark law emerges as the closest linguistic parallel.⁶⁹

⁶¹ ‘With the rapid growth and development of commerce and industry. During the last decade, there has been a persistent demand from the commercial public for revision of the law is dealing with trademarks and trade descriptions.’ ‘Lok Sabha Debates, Fourth Session’ (Lok Sabha Secretariat 1958) Second Series Volume XVI <https://eparlib.nic.in/bitstream/123456789/1960/1/lsd_02_04_05-05-1958.pdf>.

⁶² Ayyangar (n 20); The only deviation from the English statute was a prohibition against the registration of marks which can hurt the religious susceptibilities of a person, See: Jithin Saji Isaac, ‘A Nod to Appropriating Deity’ (2015) 10 Journal of Intellectual Property Law & Practice 2.

⁶³ After the report was submitted by Justice Ayyangar, a joint parliamentary committee was constituted to evaluate the Trade and Merchandise Marks Bill.

⁶⁴ PB Venkatasubramanian, ‘The Law of Trademarks in India’ (1979) 7 World Development 737, 738–739.

⁶⁵ Ayyangar (n 63) 35–36.

⁶⁶ For further details on legislative history see: Tamali Sen Gupta and Dhruv Shekhar, *Intellectual Property Law in India* (3rd edition, Kluwer Law International 2022) 96.

⁶⁷ Section 9(2)(c), Trade Marks Act, 1999.

⁶⁸ Pushpit Singh, ‘The Point Where Intellectual Property and Obscenity Intersect: Analysis of Section 9(2)(c) of Trademarks Act, 1999 in Context of the Myntra Case - Part 1’ (*NLUJ Law Review*, 27 February 2021); Adyasha Samal, ‘From Iancu v. Brunetti to Constantin Film: Should Morality Interfere with Trademark Law?’ (*SpicyIP*, 10 July 2020).

⁶⁹ The Courts have also considered and accommodated the Ayyangar Committee report to examine the evolution of the trademark statute, For eg, see: The Delhi High Court explicitly held that the Ayyangar Committee report

Consequently, the following section examines the interpretation of ‘scandalous’ in Australian law. While these stipulations cannot be superimposed on Indian law, in light of the absolute dearth of judicial engagement with the provision in Indian law, the Australian law provides essential guidelines.

2.1. What is scandalous: Australian foundation for determining scandal

The prohibition against the registration of scandalous marks in Australia, traces its lineage to colonial trade mark statutes.⁷⁰ It appeared as Section 114 in the Trade Marks Act, 1905, which established Australia’s first national trade mark register.⁷¹ The provision prohibited the registration of scandalous designs and marks which would be contrary to morality.⁷²

When the Australian Trade Marks Act, 1905 was replaced by the Trade Marks Act, 1955, the mandate of Section 114 was absorbed by Section 28.⁷³ However, the newly enacted provision deleted the reference to marks which would be *contrary to morality* and reduced its scope to *scandalous* marks. The importance of this deletion was emphasized by the Australian Attorney General’s report from 1950, which laid the foundation for the new Australian Trademark law.⁷⁴ The report emphasized that “*Clause 28, while in different words, has in substance the same effect as section 114 of the present act (Trade Marks Act, 1905), but it relieves the registrar of the court from the consideration of ‘morality’.*”⁷⁵ The position of the Attorney General regarding the reference to morality was reaffirmed in 1992 when an Australian Working Party Report on Trade Mark Law emphasized that matters of morality are “*inappropriate for the bureaucracy to determine.*”⁷⁶ The opinions from the Attorney General and the Australian Working Party clearly suggest that when examining potentially ‘scandalous’ marks, the examiners should not make a reference to morality.

provided valuable insights when examining the evolution of the trade mark statute. *Dr Reddys Laboratories Ltd v Fast Cure Pharma*, 2023 SCC OnLine Del 5409.

⁷⁰ Amanda Scardamaglia, ‘The Colonial Trade Mark Regime: Parallel Rationales, Theories and Frameworks’ [2015] King’s Law Journal 258–262.

⁷¹ *ibid.*

⁷² Section 114, Trade Marks Act, 1905.

⁷³ *New South Wales Dairy Corp v Murray Goulburn Co-operative Co Ltd* (1990) 97 ALR 73 (HIGH COURT OF AUSTRALIA).

⁷⁴ J Barton Hack, ‘The Australian Trade Marks Act 1955 Special Issue: III - Reports from Foreign Nations’ (1956) 46 The Trademark Reporter 741.

⁷⁵ As cited in *New South Wales Dairy Corp v Murray Goulburn Co-operative Co Ltd* (n 73) and; *RIV-OLAND MARBLE CO (VIC) PTY LTD v SETTEF SpA* (1988) 83 ALR 677 (Federal Court of Australia, General Division); Mark James Davison and Ian Horak, *Shanahan’s Australian Law of Trade Marks and Passing Off* (Sixth edition, Thomson Reuters (Professional) Australia Limited 2016) 250–251.

⁷⁶ DAVISON AND HORAK (N 75) 249.

Therefore, in tracing the origin the prohibition against scandalous mark, it is clear that the Australian law has moved away from a restriction against immoral marks and has narrowed its restriction to scandalous marks. Prof. Amanda Scardamaglia notes: “*it is evident that the emphasis in Australia has certainly shifted over time, from a concern with morality to the current emphasis on marks that are deemed scandalous.*”⁷⁷ The determination of what constitutes a scandalous mark is handled by the (Australian) Trade Marks Office as a matter of practice.⁷⁸

The Trade Marks Act, 1955 has since been repealed by the Trade Marks Act, 1995. However, the statutory language concerning the ban against scandalous marks remains unrevised.⁷⁹ Section 42(a) of the Trade Marks Act, 1995 continues to restrict its scope to marks which “*contains or consists of scandalous matter.*”

2.2. A framework for determining Scandalous content in Australia

The Australian Trade Marks Manual suggests that the bar against scandalous marks intercepts marks: 1) with elements of personal abuse, 2) with racial or ethnic abuse, 3) incorporating abuse of the national flag, 4) incorporating religious intolerance/ abuse,⁸⁰ and 5) trademarks inciting violence or supporting terrorism.⁸¹ In dealing with these categories and determining whether a term is scandalous, the Registrar’s decision “*must be made on the merits of each case, taking into account the words or images applied for, the intended market for the goods/services involved and the level of acceptance of the terms within the general population.*”⁸²

Prof. Huang suggests that the determination of whether a mark is scandalous involves a two-prong inquiry: First, the meaning along with the social and cultural relevance of the mark should be established. After then, the effect of the mark in reference to the relevant goods

⁷⁷ Amanda Scardamaglia, ‘Are You Nuckin Futs? Registering “Scandalous” Trade Marks in Australia’ (2012) 34 European Intellectual Property Review 628, 628.

⁷⁸ Davison and Horak (n 75) 249–250; See: Sophia O’Sullivan, ‘Scandalous Trademarks in Australia and the United States: Constitutional Validity, Uncertainty and Inconsistency’ (2018) 3 Perth International Law Journal 10.

⁷⁹ Section 9(2)(c), Trade Marks Act, 1995; *Re Hanlon* [2011] ATMO 45. Section 9(2)(c), Trade Marks Act, 1995; *ibid.*

⁸⁰ This particular kind of scandalous marks are intercepted in Indian Trade Marks Act, 1999 by Section 9(2)(b).

⁸¹ Australia Trade Mark Examiner’s Manual, Part 30 Signs that are Scandalous and Use Contrary to Law, <https://manuals.ipaustralia.gov.au/trademark/1.-introduction9>. Patricia Loughlan, ‘Oh Yuck! The Registration of Scandalous Trade Marks.’ [2005] Intellectual Property Forum: Journal of the Intellectual and Industrial Property Society of Australia and New Zealand 38; Barnett (n 10) 1224, 1225.

⁸² Australia Trade Mark Examiner’s Manual, Part 30 Signs that are Scandalous and Use Contrary to Law, <https://manuals.ipaustralia.gov.au/trademark/1.-introduction9>.

should be examined.⁸³ However, when considering the context of use, the prohibition is only concerned with the normal, expected usage of the relevant marks, rather than the possible usage. For example, if a mark is applied in reference to T-shirts, the Registrar is not required to consider whether the use of the T-Shirt in a church would be considered offensive, as that is a possible but not the normal use of the product.⁸⁴

Based on the difference between the normal and potential use of a mark, a distinction can be drawn between marks which are scandalous and ones that have a propensity to be scandalous. In 2012, an appeal was filed before the Australian Trade Marks Office (ATMO) against the examiner's rejection to register the mark 'POMMIEBASHER.' In rejecting the application for registration, the examiner held that the mark was offensive to English people.⁸⁵ On appeal, the ATMO clarified that the Registrar should clearly differentiate between marks which have a tendency to be scandalous and marks that are actually scandalous.⁸⁶ The Court held that while the word 'POMMIEBASHER' refers to an individual who is biased against English people, perhaps to an unpleasant degree, it is not an offensive word per se. The fact that it can be used offensively by a subset of people cannot preclude the mark from registration.⁸⁷

Another important learning from the Australian Trade Marks practice relates to the role of moral standards in trademark prosecution inquiries. While adjudging the registration applications, the registrar is expected to give effect to moral standards rather than setting them.⁸⁸ Further, these moral standards are fluid, and with change in societal standards, the meaning of the term 'scandalous' is susceptible to change.⁸⁹ For example, in 2011 an Australian Trade Marks examiner rejected the registration of the mark NUCKIN FUTS. The examiner argued that the mark was an obvious spoonerism for the offensive term: 'Fucking Nuts.' On appeal, the applicant argued that "the word 'fuck' or 'fucking' is now part of the

⁸³ Vicki Huang, 'COVID-19 as a Trade Mark in Australia: Issues and Implications' (2020) 42 *European Intellectual Property Review* 576, 581–582.

⁸⁴ Australia Trade Mark Examiner's Manual, Part 30 Signs that are Scandalous and Use Contrary to Law, <https://manuals.ipaustralia.gov.au/trademark/1.-introduction9>.

⁸⁵ Huang (n 57).

⁸⁶ *Re Hanlon* (n 79).

⁸⁷ *ibid* 42.

⁸⁸ Rosalyn Gladwin, 'Bullshit, I Can't Believe That Was Registered.' [2006] *Intellectual Property Forum: Journal of the Intellectual and Industrial Property Society of Australia and New Zealand* 38.

⁸⁹ Marc J Randazza, 'Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights' (2015) 16 *Nev. LJ* 107, 112–117.

universal discourse of the ordinary Australian language.”⁹⁰ The argument persuaded the ATMO, and the mark was registered with the condition that it would not be marketed to children.⁹¹

In other cases, the ATMO has allowed the registration of marks such as FUCT,⁹² FUCKERWARE.⁹³ While these marks can be potentially scandalous, their inventive and imaginative spoonerism saved them from the bar against registration. The continued existence of such marks on the Australian trademarks register suggests the term ‘scandalous’ entails a high bar.⁹⁴

While high, the bar set by use of the word ‘scandalous’ is not impenetrable. Direct references to obscene words have been intercepted by Australian law. For example, in *Kuntswear Pty. Ltd.*,⁹⁵ a Dutch clothing brand sought the registration of the mark ‘KUNT.’ The examiner rejected the registration, claiming that the mark very closely resembles or is a phonetic equivalent of the obscene word ‘CUNT’.^{96,97}

Therefore, by reviewing the actions of the ATMO and the principles outlined in the Australian Trade Marks Manual, the following framework for the determination of scandalous marks emerges:

- The bar against scandalous marks does not allow the bureaucracy to engage in matters related to morality.
- There is a clear difference between scandalous marks and marks which tend to be scandalous. Many words in the dictionary can be used offensively. However, not all those words can be denied registration.⁹⁸ Eg: POMMIEBASHER.
- The context of the use of any mark is relevant to determining whether the mark is scandalous.⁹⁹ Eg: NUCKIN FUTS

⁹⁰ Scardamaglia (n 77) 629–630.

⁹¹ *ibid* 630; Catherine Lee, ‘Nuckin Futs: What The ...?’ (*IPKat*, 21 January 2012) <<https://ipkitten.blogspot.com/2012/01/nuckin-futs-what.html>> accessed 2 November 2023.

⁹² *Re: Die Hard Pty Ltd*[1995] ATMO 26 as cited in *Re Hanlon* (n 79).

⁹³ *Cosmetic, Toiletry and Fragrance Association Foundation v Fanni Barns Pty Ltd*(2003) 57 IPR 594, as cited in *ibid*.

⁹⁴ Gladwin (n 88); O’Sullivan (n 78).

⁹⁵ *Kuntstreetwear Pty Ltd’s Trade Mark Application* (2007) 73 I.P.R. 438; as cited in Masoomeh Ozgoli and Lasantha Ariyaratna, ‘Barring Registration of Offensive Trade Marks: A Comparative Analysis of Scandalous Trade Marks in Australia and the United States’ (2019) 41 *European Intellectual Property Review* 364.

⁹⁶ *Kuntstreetwear Pty Ltd’s Trade Mark Application* (n 95) as cited in; Ozgoli and Ariyaratna (n 95); See: David Price, ‘The Multicultural Trade Mark: The Registration in Australia of Trade Marks with Foreign Language Elements’ (2008) 1 *Journal of the Australasian Law Teachers Association* 171, 178–180.

⁹⁷ *Kuntstreetwear Pty Ltd’s Trade Mark Application* (n 95); as cited in Ozgoli and Ariyaratna (n 95).

⁹⁸ *Re Hanlon* (n 79).

⁹⁹ Loughlan (n 83); Barnett (n 10).

- The boundaries of scandalous language fluctuate with shifting cultural norms. The Trade Mark Registrar is only expected to give effect to the societal norms rather than setting them.¹⁰⁰

With an understanding of the guidelines which dictate the meaning of scandalous marks, the next section examines the Indian legislative history and scope of the provision against the registration of obscene marks.

2.3. What is obscene: Identifying the foundation for determining obscene matter

The proscription against obscene mark is somewhat of an oddity in Indian trade mark law. How the term “obscene” came to be included in Section 9(2)(c) of the Indian Trade Marks Act, 1999 is not made clear in the provision’s legislative history. As explained earlier in Part 2, Section 9(2)(c) of the Indian Trade Marks Act, 1999 employs identical language to Section 11(c), of the Trade and Merchandise Marks Act, 1958. In 1958, when the Indian trademark law was reshaped, the language of Section 11(c) was adopted from Section 28 of the Australian Trade Marks Act, 1954.¹⁰¹ However, the Australian law, both at the time of adoption¹⁰² and till date,¹⁰³ does not include a prohibition against registration of ‘obscene’ marks. The Australian trade mark jurisprudence suggests that obscene marks form a subset of scandalous marks.¹⁰⁴

The Ayyangar Committee, which is credited with the development of the Act of 1958, did not suggest the use of the term ‘obscene.’¹⁰⁵ After the Committee’s report was submitted, the Ministry of Commerce conducted consultations within the business community to gauge their expectations from a revamped trademark legislation. Some of these suggestions were included as amendments in the new law.¹⁰⁶ The resulting bill amalgamated the Trade Marks Act, 1940, the Merchandise Marks Act, 1889 and provisions from the Indian Penal Code into a comprehensive law regarding the regulation of trademarks: The Trade and Merchandise Marks Bill.¹⁰⁷ The renewed Bill was then referred to a Joint Parliamentary Committee (JPC) and later translated to the Trade and Merchandise Marks Act, 1958.¹⁰⁸ The JPC submitted meticulous

¹⁰⁰ Huang (n 85) 431.

¹⁰¹ Ayyangar (n 63) 35–36.

¹⁰² Section 28, Australian Trade Marks Act, 1955.

¹⁰³ Section 42(a), Australian Trade Marks Act, 1995.

¹⁰⁴ O’Sullivan (n 78) 13; *Kunststreetwear Pty Ltd’s Trade Mark Application* (n 95).

¹⁰⁵ India, *Parliamentary Debates*, Lok Sabha, 7 May 1958, 1854-1856. Message from Lok Sabha to join the Joint Committee.

¹⁰⁶ ‘Lok Sabha Debates, Fourth Session’ (n 62) 13198–13200.

¹⁰⁷ India, *Parliamentary Debates*, Lok Sabha, 5 May 1958, 13196-13216.

¹⁰⁸ India, *Parliamentary Debates*, Lok Sabha, 5 May 1958, 13196-13216; India, *Parliamentary Debates*, Lok Sabha, 7 May 1958, 1854-1856. Message from Lok Sabha to join the Joint Committee.

evidence of their discussions¹⁰⁹ and suggested several amendments to the proposed bill.¹¹⁰ However, the JPC did not make any comments or suggestions regarding the bar against scandalous or obscene marks.

Therefore, it is unclear how and at what stage the bar against obscene marks was introduced in the resulting statute. Given the absence of any administrative debate, any inference regarding the origin of the bar must remain hypothetical. Further, a significant complication in interpreting this clause is the absence of judicial, scholarly, or legislative engagement. However, in order to identify broad guidelines for examining the import of the word ‘obscene,’ the authors turn to Indian criminal law.

Prior to examining Indian criminal law, it is important to highlight that the nature of regulation within Section 292, IPC is very different to the regulation offered by Section 9(2)(c) of the Trade Marks Act, 1999. Unlike trademark law which potentially regulates protected and unprotected commercial speech,¹¹¹ criminal law can extend its reach to encompass non-commercial, artistic, and political expression.¹¹² Further, given that Section 9(2)(c) of the Trade Marks Act entails a civil penalty affecting only mark registration, not its marketplace usage,¹¹³ the constitutional scrutiny applied to Section 292 of the IPC would be notably more rigorous. Given the distinct regulatory approaches of criminal law and trademark law, particularly in the context of Section 292 of the IPC and Section 9(2)(c) of the Trade Marks Act, the construction of obscenity within these two legal frameworks could significantly differ. This potential disparity is influenced by trademark law’s potential focus on commercial speech, which enjoys reduced degree of protection.¹¹⁴

¹⁰⁹ Joint Committee on The Trade and Merchandise Marks Bill, 1958, ‘Evidence’ (Lok Sabha Secretariat 1958) C.B. (II) No. 67.

¹¹⁰ Joint Committee, ‘The Trade Marks and Merchandise Marks Bill, 1958’ (Lok Sabha Secretariat 1958) C/B (II) No. 68.

¹¹¹ While the qualifications of what constitutes commercial speech is not entirely clear, and it has also not been clarified as to what distinguishes protected and unprotected commercial speech, judicial precedent suggests that not all commercial speech is provided constitutional protection. See for e.g., *Telecom Watchdog v Union of India*, MANU/DE/3175/2012.

¹¹² This is also referred to as social or political speech. Restrictions on non-commercial speech must be narrowly tailored to serve a compelling state interest. For example see: *S. Rangarajan v. P. Jagjivan Ram*, (1989) 2 SCC 574, where the Supreme Court struck down a ban against a film based on the grounds of potential public disorder. The Court held that the mere possibility of a law and order violation does not constitute sufficient grounds for imposing a restriction on freedom of speech and expression.

¹¹³ The Trade Mark Registry’s decision not to register a trademark does not mean that the mark cannot be used in commerce. See Section 28, Trade Marks Act, 1999. Not only can a proprietor use an unregistered mark, the Trade Marks Act, 1999 through Section 27 protects such unregistered user’s common law right against passing off.

¹¹⁴ *Mahesh Bhatt and Kasturi and Sons v Union of India* 147 (2008) DLT 561; Bhardwaj (n 46) 43; Shantanu Dey, ‘The Commercial Speech Doctrine - Expository Analysis of the Constitutional Conception within the Indian Free Speech Paradigm’ (2017) 7 Indian Journal of Constitutional Law 89.

However, the debate regarding the interaction between trademark law and the commercial speech doctrine is not entirely settled.¹¹⁵ There can be situations where even trademarks constitute non-commercial speech and convey political and social messages.¹¹⁶ This was evident in the case of *The Slants*, where Alito J. argued that “*trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limit but they can say. But powerful messages can sometimes be conveyed in just a few words.*”¹¹⁷ Further, in the CAFC decision in *Iancu v. Brunetti*, Judge Moore argued that the bar against scandalous and immoral registrations hinges on the expressive, not the source identifying nature of the marks.¹¹⁸

Hence, although criminal law governs a distinct subset of ‘speech,’ there can be instances where trademarks encompass social or political messages. In such cases, the interpretation of ‘obscenity’ in trademark law should be equally restrained, mirroring the constitutional scrutiny afforded to criminal law. However, when trademarks lack such messaging, leaning on criminal law merely functions as an initial step in comprehending obscenity within trademark law. This reliance becomes more pronounced in the absence of clear judicial, academic, or administrative guidance elucidating the nuances of obscenity in the context of trademark law.

2.3.1. Evolving contours of ‘obscenity’

Within Indian law, obscenity has been defined by Section 292 of the Indian Penal Code, 1860 (IPC).¹¹⁹ The provision provides that any material is said to be obscene if 1) it is lascivious or

¹¹⁵ There are judicial decisions which suggest that advertisements constitute commercial speech and the use of a trademark within comparative or disparative advertisement enjoys the limited protection of A. 19(1)(a). For an overview of the judicial decisions in this area see, *Reckitt Benckiser (India) (P) Ltd v Hindustan Unilever Ltd* (2022) 5 SCC (Del) 672. However, it is not clear whether the use of a trademark in the marketplace simpliciter i.e., the commercial use of the mark qualifies as commercial speech.

¹¹⁶ For a more nuanced understanding of this position see: Kristian D Stout, ‘Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)’s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks’ (2015) 25 Albany Law Journal of Science & Technology 213; MP Ram Mohan and Aditya Gupta, ‘Litigating Barbie: Trademark Infringement, Parody, and Free Speech’ (2022) 47 Delaware Journal of Corporate Law 33.

¹¹⁷ *Matal v. Tam* (n 12); Alvaro Fernandez De La Mora Hernandez, ‘A Counterintuitive Approach to the Interaction Between Trademarks and Freedom of Expression in the US and Europe: A Two-Way Relationship’ [2022] Berkeley Journal of International Law 293, 305–310.

¹¹⁸ *Iancu v. Brunetti* (n 35) citing *Matal v. Tam* (n 12).

¹¹⁹ There are multiple other statutes which include regulations on speech on the basis of decency and morality. These include cinematograph act of 1952, the dramatic performance act of 1876, the customs act of 1962 and the post office act of 1898, the indecent representation of women Prohibition act of 1896, the young persons, harmful publications act of 1956 and the information technology act of 2000. Gautam Bhatia, *Offend, Shock, or Disturb: Free Speech under the Indian Constitution* (First edition, Oxford University Press 2016); For a legislative history of the provision see: Vishnu D Sharma and F Wooldridge, ‘The Law Relating to Obscene Publications in India’ (1973) 22 The International and Comparative Law Quarterly 632. In India, multiple other statutes including the Cinematograph Act, 1952 and the Information Technology Act, 2000 which regulate speech in line with decency and morality, See: Bhatia; For a legislative history of the provision see: Sharma and Wooldridge.

2) it appeals to the prurient interest, or 3) its effect is such to tend to deprave and corrupt persons, who are likely to read, see or hear the matter contained or embodied in the said material.¹²⁰ Interpreting this provision, the Supreme Court held that obscenity *denotes the quality of being obscene which means offensive to modesty or decency; lewd, filthy and repulsive.*¹²¹

The very first case to interpret the scope of obscenity was *Ranjit Udeshi v. State of Maharashtra* in 1965.¹²² In *Ranjit Udeshi*, the Supreme Court sat in judgement over the sale and publication of the unexpurgated copies of DH Lawrence's *Lady Chatterley's Lover*. The novel spoke about the extramarital relationship between an aristocratic woman and her gamekeeper. Adopting a morally paternalistic approach,¹²³ the Court held that regardless of any artistic or literary merit, obscenity has to be adjudged in line with the effect of the subject creative medium on '*children and weak-minded adults.*'¹²⁴ The standard effectively meant that all speech in the public domain has to be adjudged on the basis of an especially susceptible group of people.¹²⁵

After *Ranjit Udeshi*, multiple courts reinterpreted and restricted the scope of *obscenity*.¹²⁶ In *Raj Kapoor*, the Court held that many of the world's greatest forms of arts would be "*asphyxiated by law, if prudes and prigs and State moralists prescribe paradigms and proscribe heterodoxies.*"¹²⁷ In *Samaresh Bose*, the Court differentiated between obscenity and vulgarity and held that mere reference to sexual themes does not render a material obscene.¹²⁸ Unless there is something which would shock or offend the taste of ordinary and decent minded people, vulgarity cannot be equated with obscenity.¹²⁹ The Supreme Court further dissociated

¹²⁰ Section 292(1), Indian Penal Code, 1860, RA Nelson, *Indian Penal Code*, vol 2 (11th edn, Lexis Nexis 2015). Section 292(1), Indian Penal Code, 1860, *ibid*.

¹²¹ 'Ranjit D. Udeshi v State of Maharashtra' A.I.R. 1965 SCR (1) 65.; Mansi Sood and Siddhant Bhatt, 'Ranjit Udeshi and Aveek Sarkar: The Curious Case of Obscenity' (2014) 3 National Law University Delhi Student Law Journal [i]. 'Ranjit D. Udeshi v State of Maharashtra'; Sood and Bhatt.

¹²² *Ranjit Udeshi v State of Maharashtra* 1965 AIR 881.

¹²³ Bhatia (n 117) 119; Dikshit Sarma Bhagabati, 'Obscene or Artistic? The Poetics and Politics of the Obscenity Law in Indian Art and Literature' (2019) 3 Indian Law Review 33.

¹²⁴ Shrutanjaya Bhardwaj and Ayush Baheti, 'Precedent, Stare Decisis and the Larger Bench Rule: Judicial Indiscipline at the Indian Supreme Court' (2022) 6 Indian Law Review 58; Aanchal Kabra and Rohit Gupta, "'De-X-Ing'the XXX: The Constitutional Validity of India's Porn Ban' (2022) 4 Nat'l LU Delhi Stud. LJ 1, 23.

¹²⁵ Sharma and Wooldridge (n 117).

¹²⁶ See: *Chandrakant Kalyandas Kakodkar v State of Maharashtra* [1970] 2 SCR 80.; *Ajay Goswami v Union of India* (2007) 1 SCC 143; *Samaresh Bose v Amal Mitra* (1985) 4 SCC 289; After *Ranjit Udeshi*, the Indian Penal Code was amended and substantial protections were legislated in the statute. See: Sharma and Wooldridge (n 117) 636–639.

¹²⁷ *Raj Kapoor and Others v State and Others* 1980 A.I.R. 258.

¹²⁸ *Samaresh Bose v Amal Mitra* (n 124).

¹²⁹ Nelson (n 118); Shrutanjaya Bhardwaj, 'Obscenity in the Kiss' (2017) 4 National Law University Delhi Student Law Journal [i].

itself from the *Ranjit Udeshi* case in 2007¹³⁰ and 2010.¹³¹ The Court repeatedly insisted that the test for obscenity must be based on the contemporary community standards which reflect the sensibilities as well as the tolerance levels of an average reasonable person, not someone who is inherently prone to being corrupted.

2.3.2. From moral paternalism to community standards

The seeds of dissent sown by in 2010 and 2012 led the Supreme Court to overrule the *Ranjit Udeshi*'s obscenity standard in 2014.¹³² In *Aveek Sarkar v. State of West Bengal*,¹³³ the Court was concerned with a magazine cover featuring a Caucasian tennis star, Boris Becker, posing semi-nude with his dark-skinned wife, Barbaba Feltus.¹³⁴ The State of West Bengal had labelled the cover obscene, and a bookstore owner was prosecuted and convicted under S. 292 of IPC. In substantiating their position, the State of West Bengal, placed reliance on the *Ranjit Udeshi* standard. The Supreme Court argued that with time the standard for adjudging obscenity must also change. Accordingly, a new 'community standards' test was laid down. The test shifted its focus from the most vulnerable group and impressionable minds to an average person.¹³⁵ Writing for the Court Justice Radhakrishnan observed:

*“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 the contemporary community standards.”*¹³⁶

Between *Ranjit Udeshi* and *Aveek Sarkar*, the test of 'obscenity' has undergone a huge metamorphosis.¹³⁷ However, in the absence of any legislative developments, it continues to be tainted with ambiguities.¹³⁸ Before the community standards test was adopted by the Supreme Court, the Calcutta High Court had remarked, “A very difficult aspect of the law of obscenity

¹³⁰ *Ajay Goswami v Union of India* (n 124) The complainant approached the Court to restraint the unrestrained liberty of the press in obscene publications in newspapers. ; Kabra and Gupta (n 122) 23.

¹³¹ *Khushboo v Kanniamal* (2010) 5 SCC 600.

¹³² Bhardwaj (n 56).

¹³³ *Aveek Sarkar v State of WB* (2014) 4 SCC 257.

¹³⁴ In an interview Boris Becker admitted that the photo was supposed to shock. However, he said that the message he was trying to communicate was that “an interracial relationship is okay.” Latika Vashist, ‘Disgust for the Sexual: The Emotional Side of Obscenity Law in India’ (2022) 22 Oxford University Commonwealth Law Journal 150, 22.

¹³⁵ *Aveek Sarkar v State of WB* (n 135); Bhardwaj (n 131); Bhagabati (n 125); However, the paternalistic and emotional nature of the obscenity law was retained by the Court. Multiple statements from the Court's obiter can be read to suggest that “the only form of love morally permissible between humans was the one negotiated through marriage and accepted by family. Vashist (n 136).

¹³⁶ *Aveek Sarkar v State of WB* (n 135) ‘The law seeks to protect not those who can protect themselves but those whose prurient minds take delight and secret sexual pleasure from erotic writings.’; Bhagabati (n 125).

¹³⁷ For a more detailed and contextualised understanding of obscenity law in India see: Vashist (n 136).

¹³⁸ Bhagabati (n 121) 27.

is lack of any precise definition. Perhaps no authority in the world has been able to define obscenity in any concrete terms."¹³⁹ This remains true to date and the community standards test remains vague and ambiguous, which leads to inconsistent application of the standard.¹⁴⁰

In terms of learnings for trademark law, obscenity of marks should be adjudged in accordance with the 'community standards test,' giving effect to the sensibilities of an average reasonable person. Further, a review of the cases regulating obscene materials reveals that the bar against obscenity is primarily concerned with regulating sexual themes. Unlike other common law countries that use the community standards test to prohibit just the most offensive hard-core pornographic material, Indian courts take a far broader view.¹⁴¹

Despite the Indian court's paternalistic stance towards sexual undertones, the law of obscenity does not intercept issues without sexual connotations. For example, dealing with the question of whether filthy abuses constitute obscenity, the Chhattisgarh High Court held that, "*So far as obscenity is concerned, it should be something to do with morals or sex and it should have tendency of depraving impressionable minds. Filthy abuses, therefore, cannot be said to be obscene abuses.*"¹⁴²

¹³⁹ *Kavita Phumbhra v Commissioner of Customs (Port)* 2011 SCC OnLine Cal 2378.

¹⁴⁰ Bhagabati (n 121); For example see: Shardha Rajam, 'Devidas Ramachandra Tuljapurkar v. State of Maharashtra Case Comment' (2016) 5 Christ University Law Journal 88; *TVF Media Labs (P) Ltd v State (NCT of Delhi)* 2023 SCC OnLine Del 1382 In TVF, the Court read obscenity and vulgarity to refer to the same position. This is starkly against the guidance of the Supreme Court.

¹⁴¹ Michael P Fix, 'Understanding the Mechanisms Driving the Evolution of Obscenity Law in Five Common Law Countries' (2018) 13 J. Comp. L. 147, 159–160.

¹⁴² *Ratneshwar v State of CG* 2010 SCC OnLine Chh 319.

3. Examining the application of the bar against scandalous and obscene matter

Having identified the possible meanings of the terms ‘obscene’ and ‘scandalous,’ this section examines how the Registrar of Trade Marks administers Section 9(2)(c). The examination is carried out through 1) The Trade Marks Manual,¹⁴³ which explains the practice and procedure of the Trade Marks Registry, and 2) The Trade Marks Register,¹⁴⁴ which contains a record of all the trademark applications filed before the Trade Marks Registry.

3.1. Trade Marks Manual

Section 98 of the Trade Marks Act, 1999 gives due recognition to the practice of the trademark registry. This provision empowers the Registrar of Trade Marks to participate in legal proceedings where the relief sought involves the alteration or rectification of entries in the Trade Marks Register, or in matters concerning the operational procedures of the Registry.¹⁴⁵ In order to promote consistency and transparency in the discretionary powers exercised by the functionaries of the Trade Marks Registry, a Trade Marks Manual is prepared. The manual encapsulates the provisions and practices outlined in Trade Marks Act, 1999, and Trade Marks Rules, 2017, presenting them along with the office procedures in a simplified and coherent manner.¹⁴⁶ It derives its relevance from Section 98, and functions as a general guide enumerating and explaining the practice of the Trade Marks Registry. This section explores the interpretation of Section 9(2)(c) by the Indian Trade Marks Manual.

The interaction of morality and scandal plays a controversial role in trademark law. Expressing their disagreement with the English law’s approach to this interaction, the Indian lawmakers turned to the Australian legal model in 1955, which expressly dissociates morality from scandal.¹⁴⁷ The Indian Trade Marks Manual fails to accommodate this statutory lineage and its effect on the interaction of morality and scandal. The Manual notes, “*Scandalous marks are those likely to offend accepted principles of morality.*”¹⁴⁸ The manual’s explicit reference to

¹⁴³ In 2015, the Trade Marks Manual was published in its ‘Draft’ stage. However, Indian courts have admitted the Draft Manual as a proof of conduct of the Trade Mark Registry. See for example: *Armasuisse v. The Trade Mark Registry and Ors.* MANU/DE/0001/2023 & *Dart Industries Inc. v. Cello Plastotech*, MANU/TN/1629/2017.

¹⁴⁴ Section 6, Trade Marks Act, 1999.

¹⁴⁵ Section 98, Trade Marks Act, 1999,

¹⁴⁶ Office of the Controller General Patents, Designs and Trademarks, CG/TMR/Public Notice/2015/83 (Issued on March 10, 2015); KC Kailasam and Ramu Vedaraman, *Law of Trade Marks & Geographical Indications: With Commentary on the Trade Marks Act, 1999 & Geographical Indications of Goods (Registration and Protection) Act, 1999 : Law, Practice & Procedure* (3rd edn, LexisNexis Butterworths Wadhwa Nagpur 2013).

¹⁴⁷ *New South Wales Dairy Corp v Murray Goulburn Co-operative Co Ltd* (n 75); *RIV-OLAND MARBLE CO (VIC) PTY LTD v SETTEF SpA* (n 75); This position was reiterated in 1992. Davison and Horak (n 75) 249–251.

¹⁴⁸ Office of Controller General Patents, Designs & Trade Marks, ‘A Draft of Manual of Trade Marks Practice & Procedure’ (Ministry of Commerce and Industry, Government of India 2015) 60 <https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf>.

morality is contrary to the legislative origin of the bar against scandalous marks and can lead to overbroad regulation.

Apart from considerations of morality, the Australian law also distinguishes between scandalous marks and marks that are in ‘crude,’ ‘bad taste’¹⁴⁹ and marks which have the potential to be used offensively.¹⁵⁰ The Indian Trade Marks Manual makes both these distinctions. It differentiates between marks which are merely distasteful and ones which are scandalous or obscene. Differentiating between these diverse categories of marks requires an examination of the context of use. Some trademarks may be acceptable when used in connection with products marketed to adults but may be unacceptable when used in connection with products marketed to children.¹⁵¹ The Indian Manual accommodates both these axioms. It notes that “*For goods intended for adults such as alcohol and contraception there may be less cause for concern.*”¹⁵²

An objection within Section 9(2)(c) would be justified only when the mark would *cause outrage or significantly undermine religious, family or social values, to an identifiable section of the public.*¹⁵³ This assessment should be conducted objectively only giving effect to the current public opinion without setting new moral standards.¹⁵⁴

Lastly, when determining the meaning of the term ‘scandalous,’ it is important to identify the relevant population which finds the subject term offensive. The Australian Trade Marks Manual and the ATMO have clarified this position in the *Kuntswear Pty. Ltd.*, where it was held: “*it is sufficient if the result of the user of the trade mark will be that a not insubstantial number of people will be, or are likely to be, shocked.*”¹⁵⁵ Similarly, the Indian Trade Marks Manual notes that a scandalous mark should cause outrage within an *identifiable section of the public.*¹⁵⁶

¹⁴⁹ Andrew Stewart and others, *Intellectual Property in Australia* (Sixth edition, LexisNexis Butterworths 2018) 720–730; Loughlan (n 81) 40; For example in: *Cosmetic, Toiletry and Fragrance Association Foundation v Fanni Barns Pty Ltd* [2003] ATMO 10 a potentially offensive mark was registered. ; *Kuntstreetwear Pty Ltd’s Trade Mark Application* (n 95).

¹⁵⁰ See: *Re Hanlon* (n 81); *Cosmetic, Toiletry and Fragrance Association Foundation v Fanni Barns Pty Ltd.* (n 151).

¹⁵¹ Loughlan (n 83); Barnett (n 10).

¹⁵² Office of Controller General Patents, Designs & Trade Marks (n 150) 61.

¹⁵³ Office of Controller General Patents, Designs & Trade Marks (n 144) 60–61.

¹⁵⁴ *ibid.*

¹⁵⁵ *Kuntstreetwear Pty Ltd’s Trade Mark Application* (n 95); Enrico Bonadio, ‘Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks’ (2015) 19 Marq. Intell. Prop. L. Rev. 39.

¹⁵⁶ Office of Controller General Patents, Designs & Trade Marks (n 150) 61.

Unlike the term ‘scandalous,’ the Trade Marks manual does not identify the meaning for the term ‘obscene.’ Further, it suggests that while vulgar and racially insulting marks would be subjected to a blanket objection, obscene marks can be permissible in certain situations.¹⁵⁷ This proposition poses two significant problems. First, as discussed in Part 2.2, Indian courts draw a clear distinction between obscene and vulgar language, with the latter being tolerated and the former being entirely prohibited.¹⁵⁸ It would appear that the manual suffers from a doctrinal inconsistency where vulgarity is considered more heinous than obscenity. Secondly, Section 9(2)(c) clearly stipulates a ban against marks which contain “*scandalous or obscene*” matter. Principles of statutory interpretation dictate that the use of “or” in statutory language is disjunctive.¹⁵⁹ This means that both the words before and after ‘or’ must be given effect.¹⁶⁰ Consequently, the word “obscene” must receive individual interpretation and definition. Thus, the manual’s position that obscene marks can be allowed in some circumstances is manifestly incorrect.

3.1. Trade Marks Register

In scrutinizing the Trade Marks Manual, Section 3.1 of the study underscores the inconsistencies in delineating the criteria for barring ‘scandalous’ or ‘obscene’ matter. Despite being identified as a compendium of the Trade Mark Registry’s office actions, the Trade Marks Manual is conspicuously unclear and furnishes inaccurate guidance on the application of Section 9(2)(c). As expounded in this section, these ambiguities contribute to pronounced inconsistency and incoherence in the operations of the Trade Marks Registry.

This section of the study takes an anecdotal approach to identifying potentially scandalous marks in the Indian Trade Marks Register. To do so, the authors conducted a literature review to uncover terms that have previously been deemed scandalous, immoral, or obscene.¹⁶¹ With categories ranging from religious themes to profanity and vulgarity,¹⁶² the authors used these

¹⁵⁷ Office of Controller General Patents, Designs & Trade Marks (n 142) 60–61.

¹⁵⁸ *Samaresh Bose v Amal Mitra* (n 126).

¹⁵⁹ Guru Prasanna Singh and AK Patnaik, *Principles of Statutory Interpretation: Including the General Clauses Act, 1897 with Notes* (10th edn, LexisNexis 2016) ch 5.

¹⁶⁰ *ibid.*

¹⁶¹ Megan M Carpenter and Mary Garner, ‘NSFW: An Empirical Study of Scandalous Trademarks’ (2015) 33 *Cardozo Arts & Ent. LJ* 321; Barton Beebe and Jeanne C Fromer, ‘Immoral or Scandalous Marks: An Empirical Analysis’ (2018) 8 *NYU J. Intell. Prop. & Ent. L.* 169; LaLonde and Gilson (n 23); Loughlan (n 81); Fernandez-Mora (n 54); Farley (n 14); Farley (n 7).

¹⁶² LaLonde and Gilson (n 23) 1510–1530.

terms to conduct randomized searches of the Indian trade mark register in order to identify potentially scandalous marks.

To effectively present their findings, the authors adopt the framework proposed by Profs. Beebe and Fromer, who surveyed 3.6 million trademark applications filed with the USPTO and identified 1,901 applications that were objected to on the basis of containing scandalous or immoral content under Section 2(a) of the Lanham Act.¹⁶³ Beebe and Fromer categorized these marks into three distinct categories that highlight the overbroad and incoherent nature of the bar against scandalous and immoral marks. They are, 1) those where similar marks already subsist on the register, 2) those where marks were allowed to overcome the objection, and 3) those where identical marks were not issued a similar objection.¹⁶⁴

The authors in the present study use this approach to categorize the identified trademarks from the Indian register into the same three categories. By doing so, the present study highlights the inconsistencies and confusions in the application of Section 9(2)(c) of the Trade Marks Act, 1999. While this approach is anecdotal in nature, it provides valuable insights into the issues surrounding the application of this section and its potential impact on trademark registration in India.

3.1.1. Combined Section 9(2)(c) and Section 11 objections

In some cases, the Registrar opposes a trademark application on the grounds that it contains obscene or scandalous matter,¹⁶⁵ and also claims that an identical or confusingly similar mark already exists on the trade marks registry.¹⁶⁶ Such objections imply that while the subject trademark application contains scandalous or obscene matter, similar marks continue to subsist on the register. Beebe and Fromer suggest that such objections provide the strongest evidence of the arbitrary and inconsistent application of the morality-based proscriptions in trademark law.¹⁶⁷ The present paper identifies the marks in this category by conducting representative searches of potentially scandalous and obscene terms on the Trade Marks Register.

For example, an applicant applied for registration of the mark DICKS in reference to food materials including, tea, coffee, salt mustard etc. Objecting to the application, the Trade Marks

¹⁶³ 15 U.S.C. § 1052 (a).

¹⁶⁴ Beebe and Fromer (n 161).

¹⁶⁵ Section 9(2)(c), Trade Marks Act, 1999.

¹⁶⁶ Section 11, Trade Marks Act, 1999.

¹⁶⁷ Beebe and Fromer (n 161) 182, 183.

Registrar issued an examination report where Section 9(2)(c) and Section 11(1) was used concurrently. It was argued that the mark DICKS is similar to the mark DEEKS.¹⁶⁸ Interestingly, the Trade Marks Registrar did not raise an objection under Section 9(2)(c) while registering the mark DEEKS.¹⁶⁹

A similar treatment can be seen in the case of mark SEX DRIVE. An objection for scandalous or obscene nature was issued in concurrence with the bar against registration of similar marks.¹⁷⁰ The Registrar objected that the mark SEX DRIVE is similar to the marks SEX HIT¹⁷¹ and SEX BOMB.¹⁷² Neither of the cited marks received an objection for containing scandalous or obscene language.

This category is best illustrated in the prosecution of the mark SANSKARI SEX (Cultured Sex). The mark was applied for by the Digital Radio (Delhi) Broadcasting Limited. The proprietor filed two applications, one for a word mark and one for a device mark. The Registrar held that while the device mark was scandalous and also similar to multiple marks subsisting on the register,¹⁷³ the word mark was only scandalous and not similar to any subsisting marks.¹⁷⁴

3.1.2. Applications that overcame an objection under Section 9(2)(c)

In some cases, the Trade Marks Registrar objects to the registration of a mark for containing scandalous or obscene matter, but then allows the mark to be published. A review of such applications provides further evidence of the arbitrary conduct of the Trade Marks Registrar.

For example, the Chennai Trade Marks Office objected to registration of the mark BOOBS & BUDS for containing scandalous or obscene matter.¹⁷⁵ The applicant's reply to the Registrar's objections did not contain any arguments about the scandalous or obscene content of the mark. The applicant only stated that the objection is "not sustainable and may thus kindly be waived." The registrar waived the objection and the mark was advertised on November 18, 2022. When

¹⁶⁸ Application No. 5285293 with examination report dated 10.02.2022.

¹⁶⁹ Trade Mark Application No. 3431018.

¹⁷⁰ Application No. 1994465 with examination report dated 01.07.2011.

¹⁷¹ Application No. 1294398 with examination report dated 11.08.2004.

¹⁷² Trade Mark Application No.1171823.

¹⁷³ Application No. 4344761 with examination report dated 11.12.2009.

¹⁷⁴ Trade Mark Application No. 4344760 with examination report dated 27.11.2019.

¹⁷⁵ Trade Mark Application No. 5335706 with examination report dated 29.03.2022.

a similar response was submitted by an applicant who applied for the mark BIG BOOBS, the Ahmedabad Trade Marks Office did not waive the objection and the mark was refused.¹⁷⁶

Similarly, in 2019 an applicant applied for the mark NANGA PUNGA (Nude/Naked). The examination report objected to the registration of the mark under Section 9(2)(c) of the Trade Marks Act, 1999.¹⁷⁷ In his reply, the applicant merely noted that when viewed as a whole, the mark did not convey any relationship with the goods in reference to which it is sought to be applied. The objection was revoked, and the mark was advertised in October 2019.

3.1.3. Applications for Scandalous or Obscene marks that never received a Section 9(2)(c) refusal

This subsection deals with marks where the Trade Marks Registrar has not issued an objection under Section 9(2)(c) while similar or identical marks have been objected as scandalous or obscene. The Indian Trade Marks Register is replete with examples of such incoherent treatment. Similar to the other two categories discussed above, relying on terms identified after a literature review, the authors conduct randomized representative search of the Trade Marks Register and discuss the results below.

For example, an applicant applied the mark BAKCHODI CORNER¹⁷⁸ in reference to hotels restaurant and catering services. The Chennai trade marks office objected to the registration of the mark for being scandalous and obscene and eventually refused the registration of the mark.¹⁷⁹ Similar marks such as BOB BAAP OF BAKCHOD,¹⁸⁰ AIB ALL INDIA BAKCHOD¹⁸¹ have been registered in the Trade Marks register, while the mark TOH SHURU KARTE HAIN BINA KISI BAKCHODI KE proceeded without any objection for scandalous and obscene matter.¹⁸²

¹⁷⁶ Trade Mark Application No. 4981217 with examination report dated 14.06.2021.

¹⁷⁷ Trade Mark Application No. 4138993 with examination report dated 16.05.2019.

¹⁷⁸ Bakchodi is a slang term used in Hindi, and means 'gossips with no foundations.' The term is highly derogatory and frequently employed as profanity in Hindi.

¹⁷⁹ Trade Mark Application No. with examination report dated 13.02.2017 and refusal order dated 26.02.2019.

¹⁸⁰ Trade Mark Application Nos. 3277951 & 3277949.

¹⁸¹ Trade Mark Application No. 2835126.

¹⁸² Trade mark Application Nos. 4273956 & 4273419 with examination reports dated 17.09.2019 & 13.09.2019 respectively.

For the mark BIG BOOBS, the Ahmedabad registry cited that the mark is scandalous or obscene.¹⁸³ However, similar marks containing the constituent term BOOBS did not receive an objection under Section 9(2)(c). For BOOBS BOOM, the registry did not cite an objection for scandalous or obscene matter.¹⁸⁴

For the constituent term BITCH, the mark BEACH BITCH was objected to and refused registration for being scandalous or obscene.¹⁸⁵ However, similar marks such as BOSS BITCH,¹⁸⁶ BEING BITCH¹⁸⁷ and CHILLY BITCH¹⁸⁸ were not objected under Section 9(2)(c). At the same time, multiple marks such as BASIC BITCH,¹⁸⁹ LAZY BITCH¹⁹⁰ and SKINNY BITCH¹⁹¹ did not receive an objection and continue to subsist on the register.

Similar trends can be observed for the term SEX. The marks SEX O PLEASE,¹⁹² NO SEX PLEASE,¹⁹³ SANSKARI SEX¹⁹⁴ and AS-SEX¹⁹⁵ have been objected for being scandalous or obscene. However, multiple marks including the term SEX continue to subsist on the register, including LUNIO SEX EDUCATION,¹⁹⁶ SEX HIT,¹⁹⁷ SEX GEL¹⁹⁸ and BTS BETTER THAN SEX.¹⁹⁹

This confusion is best reflected in the mark SEX X applied for in 2016. The applicant had filed two applications for the registration of the mark in two different sets of goods. In reference to dietetic and energy boosting food the Trade Marks Registrar objected the mark for being

¹⁸³ Trade Marks Application No. 4981217 with examination report dated 14.06.2021 and refusal order dated 17.08.2022.

¹⁸⁴ Trade Mark Application No. 5288264 with examination report dated 19.02.2022.

¹⁸⁵ Trade Mark Application No. 4882735 with examination report dated 10.03.2021 and refusal order dated 12.12.2022.

¹⁸⁶ Trade Mark Application No. 3709529.

¹⁸⁷ Trade Mark Application No. 4178984.

¹⁸⁸ Trade Mark Application No. 4057178.

¹⁸⁹ Trade Mark Application No. 3783780.

¹⁹⁰ Trade Mark Application No. 4462931.

¹⁹¹ Trade Mark Application No. 3708421.

¹⁹² Trade Mark Application No. 3604003 with examination report dated 28.08.2017.

¹⁹³ Trade Mark Application No. 3062506 with examination report dated 09.08.2016.

¹⁹⁴ Trade Mark Application No. 4344761 & 4344760 with examination report dated 11.12.2019 & 27.11.2019 respectively.

¹⁹⁵ Trade Mark Application No. 3390755 with examination report dated 16.03.2020.

¹⁹⁶ Trade Mark Application No. 5185972.

¹⁹⁷ Trade Mark Application No. 1294398.

¹⁹⁸ Trade Mark Application No. 2098997 & 2099005.

¹⁹⁹ Trade Mark Application No. 2571580.

scandalous or obscene.²⁰⁰ However, no such objection was issued in the application for registration in reference to medicinal and pharmaceutical preparations.²⁰¹

4. Conclusion

Morality-based proscriptions on registration of trademarks suffer from a unique disability in India: the absolute lack of judicial and academic engagement. The present paper attempts to address this disability in two steps. First, determining the ideal scope and interpretation of the terms ‘scandalous’ and ‘obscene’ in Indian trademark law. Second, examining the conduct of the Indian Trade Marks Registrar to identify the implementation of Section 9(2)(c) of the Indian Trade Marks Act, 1999.

The legislative history of the prohibition against ‘scandalous’ marks point to a purposeful legislative choice to depart from English law and embrace Australian law. Therefore, the precedents and guidelines from Australian law should be influential in understanding what constitutes ‘scandal’ in Indian trademark law. Unlike the bar against ‘scandalous’ matter, there is no guidance as to why, how, and at what stage Indian trademark law rejected the registration of marks which contain ‘obscene’ matter. However, the word may have been borrowed from Indian criminal law, which employs a ‘community standards test’ to identify obscene material.

The current guidelines notified by the Registrar of Trade Marks completely disregard the statutory text and legislative history of Section 9(2)(c). Further, a representative review of the Trademarks Register does not reveal any consistent framework for implementing Section 9(2)(c). Virtually identical marks have been subjected to different treatment, demonstrating that the Indian Trade Marks Registrar does not provide any coherent guidelines for implementing the ban against scandalous and obscene marks.

²⁰⁰ Trade Mark Application No. 3276374 with examination report dated 19.01.2018.

²⁰¹ Trade Mark Application No. 3276373 with examination report dated 17.10.2019.