



Drinks maker and police collide

Remfry & Sagar's **Gaurav Mukerjee** describes the recent actions taken by the makers of the liquor Jägermeister against the Tamil Nadu Police for the use of its trademarks in a 'don't drink and drive' campaign

The manufacturer of the herbal liquor Jägermeister, recently approached the High Court of Madras by way of a writ petition against the Tamil Nadu Police for removal of signage bearing images of its product and registered trademarks in relation to a 'don't drink and drive' campaign. The Tamil Nadu Police was making unauthorised use of the images of Mast-Jägermeister SE's products and its registered trademarks, including JÄGERMEISTER alongside a picture of a fatal accident in respect of a 'don't drink and drive' signage. Thereby, implying that accidents occur/could occur on account of consumption of Mast-Jägermeister SE's product. The signage had been brought to the attention of Mast-Jägermeister SE by a German tourist travelling through the state of Tamil Nadu earlier this year.

Mast-Jägermeister SE dedicated to the cause of 'responsible drinking', while supportive of the initiative of the Tamil Nadu Police was aggrieved on account of the detrimental use. Mast-Jägermeister SE through its Indian counsel made several representations to the police emphasising that it was aware of its social responsibility, and uses a specific marketing code which ensures that its sales, marketing, communication and advertising activities promote responsible enjoyments of its product by adults of legal drinking age. Along with making requests to remove the objectionable signage. However, despite its best efforts, the signage was not removed. Consequently, Mast-Jägermeister SE was constrained to approach the High Court of Madras seeking appropriate directions for removal of the signage and/or images of its products, registered trademarks, and so on.

Mast-Jägermeister SE contended that it was aggrieved by the arbitrary and discriminatory action of the police which maligned it/its product without any justification and that the conduct was in violation of

certain constitutional guarantees available to all irrespective of nationality, origin, and so on. In all fairness, it was stated that though there was sufficient cause of action for Mast-Jägermeister SE to sue the Tamil Nadu Police for infringement, thereby entitling it to not just the statutory relief of permanent injunction but also damages, it was not inclined to tread this path as the misuse involved a government agency and the cause was one which it avidly supported. It was unambiguously clarified that the intention was to have the objectionable signage removed and the litigation, which at any rate, it was constrained to initiate, had no pecuniary inclinations.

While Mast-Jägermeister SE succeeded in the action, there may exist a school of thought which would contend that the use complained of constitutes 'fair use', or that the signage is not performing the classic trademark function of identifying the source and, hence, outside the purview of misuse. One may also go out on a limb and say that as there is no use of the mark in commerce or use in the course of trade, there is no likelihood of confusion or deception among the consumers. A comparatively conservative opinion would be that protection from such misuse would only extend to marks having a reputation (well-known) in India.

The (Indian) Trade Marks Act, 1999 is fairly comprehensive at least insofar as identifying the various scenarios in which a registered mark may be infringed. Ranging from classical infringement, the legislation envisages situations which involve rival marks not being used in respect of similar and/or identical goods or services or when the use complained of is confined to that as a trade name. The legislature in its foresight has enacted a specific provision wherein a registered trademark is infringed by any advertising of the same if such advertising is detrimental to its distinctive character or reputation. The said provision does not lay down any pre-requisites of the advertising

being in the course of trade or the mark being a well-known trademark in the country. The legislative intent behind enactment of the provision in question is clear and it is unlikely that such random and discriminatory use of third party trademarks even on the part of government agencies and in public interest would be successfully defended by taking refuge of the commercial nature of trademark jurisprudence.

Another notable achievement of the case at hand is that contrary to the popular belief of litigation in India tending to be protracted and time consuming, the case was disposed of under a month and in three hearings, with counsel appearing before the court on behalf of the Tamil Nadu police, undertaking before the Court on October 11, 2013, that the signage would be removed. Mast-Jägermeister SE's writ petition was, accordingly, disposed of by the court with directions to the Tamil Nadu police to comply with its undertaking forthwith.

Author



Gaurav Mukerjee is a partner-designate in the firm's litigation group. Beginning his career in 2002 as a legal officer in a large Indian conglomerate, a fortuitous

brush with copyright litigation fuelled a permanent interest in intellectual property. Gaurav joined the firm in early 2004 and is today a trademark, copyright, unfair competition and domain disputes expert. Anti-counterfeiting and anti-piracy measures are also his niche. His knowledge of Indian courts apart, Gaurav handles the firm's operations in the People's Republic of China. He often delivers talks on enforcement issues before various international fora.