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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 21593 OF 2024
IN
COMMERCIAL IP SUIT (L) NO. 20315 OF 2024
WITH
COMMERCIAL IP SUIT (L) NO. 20315 OF 2024

Metro Brands Limited

...Plaintiff

Versus

Metro Footwear and others

...Defendants

Mr. Venkatesh Dhond, Senior Advocate a/w Mr. Rashmin Khandekar, Mr. Alhan Kayser, Ms.Varsha Vasave & Ms. Gauri Sansare i/b Mr. Avesh Kayser, for the Plaintiff.
None for the Defendants.

CORAM : SHARMILA U. DESHMUKH, J.

DATE : NOVEMBER 10, 2025

P. C. :

INTERIM APPLICATION (L) NO. 21593 OF 2024

1. This is an Interim Application for infringement of trademark and passing off the Defendant's goods as that of the Plaintiff. The previous orders indicate that time and again, adjournments were sought by the Defendants under the pretext of settlement of the matter. However, the settlement has not taken place. Neither the affidavit in reply has

been filed as directed by the order of 16/10/2025. By order of 04/11/2025, the Leave Petition under Clause XIV of Letters Patent was allowed.

2. Today, none appears on behalf of the Defendants. The record does not indicate any response filed by the Defendants.

3. It is submitted by Mr. Dhond, learned Senior Advocate appearing for the Plaintiff that the rival marks are 'METRO' and 'METRO FOOTWEAR'. The Plaintiff is using the mark METRO since the year 1955 and is engaged in the business of footwear, bags & accessories, leather goods and services relating thereto and is also engaged in the business of allied and cognate goods and services. He submits that as on the date of filing of the Suit, the Plaintiff has over 826 showrooms exclusive of the mark METRO in about 100 cities in India. He further submits that the Plaintiff has obtained registration of the METRO mark in class 18 and 25, 35, 36, 37, 38, 39, 40, 41 and 42. He points out the registration of the Plaintiff's word and device marks in various classes and in particular the registration of the METRO mark in class 25 on 21/12/1972. Mr. Dhond has taken this Court through the averments in the plaint and submits that the products sold under the Plaintiff's marks have been ranked among the top ten footwear brands in India and have been bestowed with several other recognitions. Pointing out to the sales turnover of the Plaintiff he submits that for the period

1987 to 2022 the cumulative turnover of the Plaintiff was over Rs.13,000 Crores and the cumulative advertisement and promotional expenses for the period 1987 to 2022 is over Rs.380 Crores.

4. As regards the Defendants, he submits that on 01/12/2022, the Plaintiff became aware of being Defendant No.1 operating a store under the name and style of METRO FOOTWEAR carrying on business in the same class as that of the Plaintiff. He submits that the Cease and Desist notice was issued on 17/12/2022 to which the response by the Defendant No.1 was that the Defendant was using the name METRO FOOTWEAR since the year 1982. He submits that subsequently, there were further Cease and Desist notices issued in which the same defense was raised by the Defendant No.1. He submits that the Defendants have stalled the proceedings under the pretext of settling the matter and neither the settlement has taken place nor any reply has been filed. He submits that the material on record prima facie establishes the proprietary right of the Plaintiff in respect of the registered mark and the infringement by the Defendants by use of the impugned mark in respect of the same class.

5. I have considered the submissions and perused the record.

6. The list of registration of the Plaintiff's mark METRO annexed to the plaint prima facie indicates that the earliest registration was on 21/12/1972 in class 25. The Plaintiff has submitted that the

Defendant's mark METRO FOOTWEAR is an unregistered mark. The entire registered mark of the Plaintiff has been subsumed in the Defendant's mark METRO FOOTWEAR and the addition of the word "footwear" is immaterial as the same is descriptive. The leading presence of the Plaintiff in respect of the footwear, bags and accessories and the services relating thereto is prima facie demonstrated from the sales turnover which for the period 1987 to 2022 is over Rs.13,000 Crores as well as the advertisement and promotional expenses which is over Rs.380 Crores. The Plaintiff's domain name also uses the trademark. Though the Defendants have replied to the Cease and Desist notice claiming to be using the name METRO FOOTWEAR since the year 1982, prima facie, the defense of prior user is not available to the Defendants considering the registration of the Plaintiff's mark METRO in the year 1972. There is no material which has been produced by the Defendants on record even to substantiate the defense of prior user. The registration of the Plaintiff's mark in the year 1972 prima facie grants an exclusive right to the Plaintiff to use the METRO mark which is infringed by the use of the Defendants of the impugned mark METRO FOOTWEAR.

7. Insofar as the action for passing off is concerned, the goodwill and reputation of the Plaintiff is prima facie demonstrated from the sales turnover as well as the advertisement and promotional expenses.

The leading presence of the Plaintiff to the market of footwear, bags and accessories requires no reinforcement. The manner in which the Defendants are marketing its goods and services under the impugned mark METRO FOOTWEAR makes it prima facie evident that the Defendants have designed its products in a manner so as to pass off its goods as that of the Plaintiff. The use of the impugned mark by the Defendants is likely to cause injury to the Plaintiff's goodwill and reputation, which is amply demonstrated from the material placed on record. Mr. Dhond further points out page 212 of the plaint which shows the advertisement as regards the Plaintiff's mark in the year 1955. It is therefore prima facie evident that the Plaintiff has been using the mark METRO continuously and uninterruptedly from the year 1955.

8. In the light of above, a case is made out for grant of interim relief in terms of prayer clauses (a) and (b) which read as under :

“(a) Pending hearing and final disposal of the Suit, a temporary order and injunction restraining and prohibiting the Defendants and/or its partners, proprietors, stockists, directors, owners, servants, subordinates, representatives, employees, suppliers, affiliates, agents, distributors, dealers, subsidiaries, franchisees, licensees, assigns, predecessors and /or all persons/ entity claiming through them or acting on their behalf the Defendant from in any manner (directly or indirectly), using, manufacturing, selling, distributing, advertising, displaying, or stocking any products bearing the said marks / trademarks / trade name / label / packaging

/trade dress / theme of "METRO" and its variants, more particularly the impugned marks, i.e. "METRO FOOTWEAR" as well as the graphical representations thereof and/or any other mark identical and/or deceptively similar to the Plaintiff's [well-known] registered "METRO" series of marks in respect of any goods and/or services for which the Plaintiff are registered and/or for goods and/or services which are similar thereto in any manner whatsoever so as to infringe the Plaintiff's registered "METRO" series of marks;

(b) Pending hearing and final disposal of the Suit, a temporary order and injunction restraining and prohibiting the Defendants and/or its partners, proprietors, stockists, directors, owners, servants, subordinates, representatives, employees, suppliers, affiliates, agents, distributors, dealers, subsidiaries, franchisees, licensees, assigns, predecessors and /or all persons/ entity claiming through them or acting on their behalf, the Defendants from in any manner (directly or indirectly), using, manufacturing, selling, distributing, advertising, displaying, or stocking any products bearing the said marks / trademarks / trade name /label/ packaging /trade dress / theme of "METRO" and its variants, more particularly the impugned marks, i.e. "METRO FOOTWEAR" as well as the graphical representations thereof and/or any other mark identical and/or deceptively similar to the Plaintiff's [well-known] registered "METRO" series of marks in respect of any goods and/or services for which the Plaintiff are registered and/or for goods and/or services which are similar thereto in any manner whatsoever so as to pass of as the Plaintiff's registered "METRO" series of marks."

9. Mr. Dhond, learned Senior Advocate points out that in prayer clauses (a) and (b) the Plaintiff's registered mark is referred to as a well-known mark which issue will be addressed subsequently.

10. In the light of the above the Interim Application is allowed in terms of prayer clauses (a) and (b) except the bracketed portion.

[SHARMILA U. DESHMUKH, J.]