



2023:DHC:8346



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI****Reserved on : 3 November 2023****Pronounced on : 21 November 2023**

+ CS(COMM) 700/2021

SCRUM ALLIANCE, INC Plaintiff
Through: Mr. Anirudh Bakhru, Mr.
Yashwardhan Singh and Ms. Vijay Laxmi
Rathi, Advs.

versus

MR. PREM KUMAR S. & ORS. Defendants
Through: Mr. Gagan Gupta, Adv.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T

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21.11.2023**I.A. 17424/2021 (Order XXXIX Rules 1 and 2 of the CPC)****Facts**

1. Management of projects, in industries and enterprises in which project requirements can change rapidly, is a challenge. Technologies, known as Agile methodologies, have developed, over time, to deal with such eventualities. Among the industries which profit the greatest from the use of Agile methodologies, is the software development industry. Scrum is one such form of Agile methodology which provides incremental innovative solutions for project management and development in software engineering, and is the




Agile methodology of choice adopted by some of the largest corporate enterprises in the world, including Fortune 500 companies like Google, Apple, Facebook, Amazon, Netflix and HSBC.

2. Proficiency in Scrum, like proficiency in any other enterprise, is certifiable. The plaintiff Scrum Alliance Inc, based in Westminster, Colorado, USA, traces its history to 2001, and claims, as per the plaint in the present case, to be the largest, most established and influential Scrum certification organization. Worldwide, the plaintiff claims to have certified over 12.48 lakh practitioners as “Scrum Masters”, of which over 1.72 lakh certificates have been issued in India alone. It is also claimed that the “Certified ScrumMaster (CSM)” certification issued by the plaintiff is the first known professional Scrum certification.


3. The plaintiff is the proprietor of the following Certification Trade Marks (“CTMs”, hereinafter), registered in India under the Trade Marks Act, 1999

Sr. No.	Trade Mark	Reg. No.	Class	Date of Application	Use Claim
1.	CERTIFIED SCRUMMASTER	3298086	42	30 June 2016	31 May 2005
	CLASS: 42 Providing information in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; computer software consultancy and advisory services; computer software development consultancy and				




	advisory services; project management services, product development services, product development and design consultation; product manufacturing consultation; computer software development and project management services.				
2.	CSM	3298080	42	30 June 2016	26 March 2009
	<p>CLASS: 42</p> <p>Providing information in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; computer software consultancy and advisory services; computer software development consultancy and advisory services; project management services, product development services, product development and design consultation; product manufacturing consultation; computer software development and project management services.</p>				
3.		3298084	42	30 June 2016	3 September 2013
	<p>CLASS: 42</p> <p>Providing information in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; computer software consultancy and advisory services; computer software development consultancy and advisory services; project management services, product development services, product development and design consultation; product manufacturing consultation; computer software development and project management services.</p> <p>Conditions: The Applicant wishes to claim rights in all colors.</p>				
4.	CERTIFIED SCRUMMASTER	3298087	41	30 June 2016	31 May 2005
	<p>CLASS: 41</p> <p>Qualifications, proficiency and training in product design and</p>				



	development methodology and project management methodology, including in the field of software development; qualifications and proficiency of training, mentoring and tutoring services in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; training, mentoring, and tutoring services; educational services including conducting classes, seminars, workshops in the fields of product development, product development consultation, product manufacturing consultation, computer software development management and computer software project management; providing educational assessment services, including, educational assessment services to others who teach, train, and provide information in the fields of project management and product development.				
5.	CSM	3298081	41	30 June 2016	26 March 2009
	CLASS: 41 Qualifications, proficiency and training in product design and development methodology and project management methodology, including in the field of software development; qualifications and proficiency of training, mentoring and tutoring services in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; training, mentoring, and tutoring services; educational services including conducting classes, seminars, workshops in the fields of product development, product development consultation, product manufacturing consultation, computer software development management and computer software project management; providing educational assessment services, including, educational assessment services to others who teach, train, and provide information in the fields of project management and product development.				
6.		3298085	41	30 June 2016	3 September 2013



	<p>CLASS: 41</p> <p>Qualifications, proficiency and training in product design and development methodology and project management methodology, including in the field of software development; qualifications and proficiency of training, mentoring and tutoring services in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; training, mentoring, and tutoring services; educational services including conducting classes, seminars, workshops in the fields of product development, product development consultation, product manufacturing consultation, computer software development management and computer software project management; providing educational assessment services, including, educational assessment services to others who teach, train, and provide information in the fields of project management and product development.</p> <p>Conditions: The Applicant wishes to claim rights in all colors.</p>				
7.		3298083	41	30 June 2016	3 September 2013
	<p>CLASS: 41</p> <p>Qualifications, proficiency and training in product design and development methodology and project management methodology, including in the field of software development; qualifications and proficiency of training, mentoring and tutoring services in the fields of product development, product design, product development consultation, product manufacturing consultation, computer software development and computer software development management; training, mentoring, and tutoring services; educational services including conducting classes, seminars, workshops in the fields of product development, product development consultation, product manufacturing consultation, computer software development management and computer software project management; providing educational assessment services, including, educational assessment services to others who teach, train, and provide information in the fields of project management and product development.</p>				



Conditions: The Applicant wishes to claim rights in the color ‘Orange’ as reflecting in the mark.

4. The CTM regime under the Trade Marks Act:

4.1 Before proceeding further, it is necessary to briefly refer to the CTM regime in the Trade Marks Act, as CTMs, their registration, and their demographics, including the provisions relating to infringement and the like, follow a somewhat different protocol as compared to other trade marks.

4.2 “Certification trade mark” is defined, in Section 2(1)(e) of the Trade Marks Act as “a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person”.

4.3 Chapter IX of the Trade Marks Act is dedicated to CTMs, and comprises Sections 69 to 78. Section 69¹ excludes, from Chapter IX, the applicability of

¹ **69. Certain provisions of this Act not applicable to certification trade marks.** – The following provisions of this Act shall not apply to certification trade marks, that is to say, -

- (a) clauses (a) and (c) of sub-section (1) of Section 9;
- (b) Sections 18, 20 and 21, except as expressly applied by this Chapter;
- (c) Sections 28, 29, 30, 41, 42, 47, 48, 49, 50, 52, 54 and sub-section (2) of Section 56;



- (i) Sections 9(1)(a) and (c), 28, 29, 30, 41, 42, 47, 48, 49, 50, 52, 54 and 56 (2),
- (ii) Sections 18, 20, 21, except to the extent they are expressly applied by Chapter IX,

and of Chapter XII, except Section 107. Section 70, which provides for registration of CTMs, prohibits registration of a mark as a CTM “in the name of a person who carries on a trade in goods of the kind certified or trade of the provision of services of the kind certified”. Section 71 deals with the specifics of applications to be submitted for registration of CTMs. Sections 71, 72, 73 and 74 deal with applications for registration of CTMs, their consideration, opposition to registration of CTMs, and filing of regulations governing the use of a CTM. Section 71(1)² requires each application, for registration of a CTM, to be made in the prescribed manner by the proprietor of the CTM, accompanied by a draft of the regulations governing the use of the CTM, as envisaged by Section 74. Section 74 deals with filing of regulations governing the use of the CTM. Sub- section (1)³ requires regulations, governing the use of any registered CTM to be filed in the Trade Marks Registry, and sub- section (2)⁴ empowers the Registrar to

(d) Chapter XII, except Section 107.

² **71. Applications for registration of certification trade marks. –**

(1) An application for the registration of a mark as a certification trade mark shall be made to the Registrar in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft of the regulations to be deposited under Section 74.

³ **74. Filing of regulations governing use of a certification trade mark. –**

(1) There shall be filed at the Trade marks Registry in respect of every mark registered as a certification trade mark regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the certification trade mark, and may contain any other provisions which the Registrar may by general or special order, require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations); and regulations so filed shall be open to inspection in like manner as the register as provided in Section 148.

⁴ (2) The regulations so filed may, on the application of the registered proprietor, be altered by the Registrar.



alter the said regulations, on application by the proprietor of the registered CTM. Section 75⁵ deals with infringement of CTMs and, therefore, corresponds to Section 29, which deals with infringement of trade marks other than CTMs. Section 76⁶ excludes certain acts from the taint of infringement. Section 77 deals with the power of the Registrar to cancel or vary the registration of CTMs. Section 78⁷, which is a heavily truncated CTM parallel to Section 28, confers, on the registrant of a CTM, exclusivity in respect of use of the CTM in

⁵ **75. Infringement of certification trade marks.** – The right conferred by Section 78 is infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorised by him in that behalf under the regulations filed under Section 74, using it in accordance therewith, uses in the course of a trade, a mark, which is identical with, or deceptively similar to the certification trade mark in relation to any goods or services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken as being a use as a trade mark.

⁶ **76. Acts not constituting infringement of certification trade marks.** –

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered certification trade mark—

(a) where a certification trade mark is registered subject to any conditions or limitations entered on the register, the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place, country or territory or in any other circumstances, to which having regard to any such limitations, the registration does not extend;

(b) the use of a certification trade mark in relation to goods or services certified by the proprietor of the mark if, as to those goods or services or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the mark;

(c) the use of a certification trade mark in relation to goods or services adapted to form part of, or to be accessory to, other goods in relation to which the mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods or services are certified by the proprietor.

(2) Clause (b) of sub-section (1) shall not apply to the case of use consisting of the application of a certification trade mark to goods or services, notwithstanding that they are such goods or services as are mentioned in that clause if such application is contrary to the regulations referred to in that clause.

(3) Where a certification trade mark is one of two or more trade marks registered under this Act, which are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

⁷ **78. Rights conferred by registration of certification trade marks.** –

(1) Subject to the provisions of Sections 34, 35 and 76, the registration of a person as a proprietor of certification trade mark in respect of any goods or services shall, if valid, give to that person the exclusive right to the use of the mark in relation to those goods or services.

(2) The exclusive right to the use of a certification trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.



relation to the goods or services in respect of which it has been registered, subject to any conditions or limitations governing the registration.

5. Mr. Anirudh Bakhru drew my attention to Regulations II(F) and III(A) of the Regulations filed in respect of the mark “CERTIFIED SCRUMMASTER”, along with the application seeking registration of the said mark, which read thus:

“II. PROCEDURES TO OBTAIN AND MAINTAIN CERTIFICATION:

F. Through Scrum Alliance’s requirement for renewal every two (2) years, Scrum Alliance achieves its quality control management over all certified individuals.

III. RIGHTS AND OBLIGATIONS OF CERTIFIED INDIVIDUALS:

A. Certified individuals may use the Certification mark as set forth in these Rules, in the executed Agreement and as detailed on the Site. Such approved use of the Certification mark by an individual indicates that individual has been approved by Scrum Alliance as knowledgeable and skilled in the Scrum methodology; has attended the certification course, passed the certification examination and is able to use such knowledge in providing services as a project manager, project developer, or the like.”

6. Defendant 1 applied for registration of the word mark CSM on 23 November 2012. Registration was granted, to the said mark, on 17 July 2014. The defendants’ CSM mark was, however, not registered as a CTM, but as a regular trade mark in Class 41, covering “Online examination, certification, and training on information technology”. The defendants claimed use of the CSM mark since 10 September 2012.




7. As against this, as already noted *supra*, all registrations of the plaintiff's trademarks are w.e.f. 30 June 2016. Against the plaintiff's applications, therefore, Defendant 1's CSM mark, as well as the CSM word mark and CSM device mark of Colonia Santa Maria Hotels (P) Ltd ("Santa Maria", hereinafter) were cited as rival similar marks, in the First Examination Report (FER) dated 13 July 2016, issued by the Trade marks Registry. The mark CSM was registered in favour of the defendants w.e.f. 23 November 2012 in Class 41 for "Online Examination, Certification and Training Information Technology", whereas the word and device CSM marks were registered in favour of Santa Maria in Class 41, but with respect to "Entertainment Services, including Live Entertainment Services featuring Musical and Theatrical Performances; Sporting, Recreational and Leisure Activities; Health Services". On this aspect, the plaintiff responded thus, in its reply dated 22 September 2016, to the FER:

"b) The applicant honestly and bonafidely adopted the unique and inherently distinctive mark CSM as early as 26th March, 2009 to use the same services. Ever since its adoption, the Applicant has been using the mark CSM, continuously, extensively and exclusively in its name. Owing to the continuous and wide spread use of the mark, the same has acquired immense reputation and goodwill, all of which accrues in the name of the Applicant herein. The Applicant is prior adopter and user of the applied mark/ has gained concurrent rights, and is hence entitled to the registration of the mark."

Mr. Bakhru seeks to contend that the plea of concurrent user, in the reply dated 22 September 2016 advanced by the plaintiff in response to the FER was intended to apply to the CSM word and device marks registered in favour of Santa Maria.



8. On 16 December 2016, the defendants filed an opposition, before the Trade marks Registry, to the plaintiff's Application No.


3298082 for registration of the device mark , in which the following grounds of opposition were urged, on which Mr. Bakhru places reliance:

“13. The impugned trademark was inherently not adopted to distinguish and was further inherently incapable of distinguishing the applicants' services as on the date of the application for registration of the trade mark. The applicants' applied mark does not acquire any distinctiveness in favour of the applicants. In fact, it has become synonymous to the services of the opponent and none else. Therefore, the applicants' application is barred under Sub- Section 1(a) of the Section 9 of the said Act.

14. That the opponent is the legitimate proprietor & true REGISTERED owner of the trademark “CSM” which is valid and subsisting on records. The mark under the impugned trade mark “CSM” adopted and applied by the applicants are identical and/or deceptively similar to the well known mark of the opponent therefore, the use of the impugned trade mark by the applicants will lead to confusion and deception in the minds of public at large. Hence, the application is required to be rejected under Sub Section 2(a) of Section 9 of the said Act.”

9. On 23 January 2018, the defendants wrote to the plaintiff's trademark agent, informing him that “considering the facts and possible litigation”, the defendants were inclined to withdraw the notice of opposition to Application No. 3298082 of the plaintiff. Following this, on 8 February 2018, the defendants withdrew the



aforesaid notice of opposition to the plaintiff's application for registration of the  device mark.

10. On 21 June 2018, the plaintiff wrote to the defendants, proposing certain steps to be taken by the defendants and seeking the defendants' concurrence in that regard. These were that (i) the defendants would not use the word marks CSM or CERTIFIED SCRUM MASTER and would adopt, for its logo, a style which would surely distinguish it from the plaintiff's logo, (ii) the defendants would either darken or lighten the colour of its logo to distinguish it from the colour of the plaintiff's logo and (iii) wherever the defendants used its logo, it would enter the following disclaimer:

“GAQM is not affiliated with Scrum Alliance, Inc. the services, course offerings, and certifications of GAQM are not sponsored by or approved by Scrum Alliance, Inc. and are in no way related to Scrum Alliance, Inc.'s CERTIFIED SCRUMMASTER (CSM) courses or certifications.”

11. The defendants responded on 21 June 2018, agreeing to the plaintiff's suggestions to the extent of darkening the colour of its logo and inserting the above disclaimer on its website. The plaintiff replied on 4 July 2018, requiring the defendants to insert the above disclaimer on their GAQM website as well as on authorised third-party sites through which the defendants were offering CSM courses or tests. In the event of the defendants agreeing to this suggestion and further agreeing to darken the colour of its logo so as to distinguish it from the plaintiff's Scrum Alliance logo, the plaintiff suggested that it





would prepare a letter of undertaking to be signed and dated by the defendants.

12. Further correspondences ensued till, on 8 April 2021, the defendants wrote to the plaintiff, stating that they had inserted the disclaimer, as drafted by the plaintiff, on Defendant 1’s website.

13. Mr. Bakhru, arguing for the plaintiff, drew my attention to the website of the defendants, to point out that the defendants, without

holding any registration in that regard, had adopted the  logo,

which was deceptively similar in appearance to the plaintiff’s  logo, particularly in view of the use, by the defendants, of the “sun” motif. He submits that the defendants did not hold any registration for

the  logo as a device mark, or even for the word mark “Certified Scrum Master”. He further points out that, on their website, the defendants have falsely declared that “Certified Scrum Master (CSM)[®] is a Registered Trademark of GAQM”.

14. Mr. Bakhru further points out that, on 1 April 2014, the defendants entered into a License Agreement with one Mr. Satish Gurnani, in which Defendant 1, as the licensor, licensed the right to use various brand names, including CSM, in favour of Mr. Gurnani.



As such, he submits that the defendants are using the impugned CSM mark as a trademark, for commercial purposes.

15. On 5 July 2022, this Court directed both parties to file affidavits, indicating

- (i) the total number of employees and/or certified professionals employed by the plaintiff and Defendant 1 to impart training in Agile methodologies and Scrum certifications as well as employees of any alleged licensees,
- (ii) the total number of professionals certified by them till date, and the countries to which they belonged,
- (iii) the manner of providing training in Agile methodologies and
- (iv) their annual turnover figures in India.

In their affidavit, submitted in compliance with the above directions, the defendants explained the manner in which they provided training, in para 6, thus:


“6. That the manner in which the Defendants provide training involves “Self-paced learning” wherein the candidate can learn and finish the course by fixing his schedule and time as desired by him/her. It is a specific learning method in which the learner is able to control the amount of material they consume as well as the duration of time they need to learn the new information properly. That is the candidate need not complete or submit the required assignments with the other candidates who have availed the Scrum course.”


Rival Submissions



13. Mr. Bakhru submits that the plaintiff had honestly adopted the CTM “CERTIFIED SCRUMMASTER” in May 2003, and the abbreviated mark “CSM”, for the certification services which it provided. The plaintiff also holds registrations, as tabulated in para 3 *supra*, dating back to 2016 in India. He further submits that the plaintiff has been continuously and extensively using the aforesaid marks both internationally as well as in India since 2005. The first CERTIFIED SCRUMMASTER certificate was issued by the plaintiff to an Indian in 2005.


14. The defendants, submits Mr. Bakhru, are using the marks CSM,

CERTIFIED SCRUM MASTER and the logo , which are deceptively similar to the registered trademarks of the plaintiff. The impugned marks are used for providing identical certification services, thereby enhancing the possibility of confusion. The defendants are using the impugned marks as trademarks and in the course of trade, as is apparent from the defendants’ claims on their website, the brochure of Defendant 3 which prominently displays the

impugned  logo and the license agreement executed between Defendant 1 and Satish Gurnani. Thus, a case of infringement, by the defendants, of the plaintiff’s registered CTMs, within the meaning of Section 75 of the Trade Marks Act, stands made out.



15. Mr. Bakhru further submits that the defendants cannot seek protection under Section 76(3) of the Trade Marks Act as (i) Section 76(3) cannot protect the use, by the defendants of the impugned marks

CERTIFIED SCRUM MASTER or the impugned  logo, (ii) the defendants had sought registration for the mark CSM as a normal trademark and not as a CTM, and, therefore, could not be permitted to provide certification services under the said mark, (iii) the plaintiff is the prior adopter and user of the word mark CSM, (iv) the plaintiff has filed an application for rectification of the registration of the word mark CSM in favour of Defendant 1, and (v) it was the defendants' own claim – which the plaintiff did not admit – that CSM was *publici juris*.

16. Inasmuch as the plaintiff is the prior user of the mark CSM, Mr. Bakhru submits that the defendants cannot claim the benefit of Section 34⁸ of the Trade Marks Act, either. Nor can Section 35⁹ come to the aid of the defendants, as the use, by the defendants, of the

⁸ 34. **Saving for vested rights.** – Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior –

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his; whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

⁹ 35. **Saving for use of name, address or description of goods or services.** – Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods or services.



impugned marks cannot be regarded as *bona fide* descriptive of the character of quality of the services rendered by the defendants.

17. Mr. Bakhru submits that, in view of the withdrawal, by Defendant 1, of its opposition to the plaintiff's Application No 3298082, the plaintiff believed that Defendant 1 had acknowledged the superior rights of the plaintiff and was inclined to amicably resolve the issue. Despite concerted efforts, however, no settlement could be concluded. It is thus, submits Mr. Bakhru, that the plaintiff has been constrained to approach this Court.

18. Mr. Bakhru further submits that it is not open to the defendants to question the validity of the trademark registrations held by the plaintiff, as the defendants have never instituted any challenge against the said marks, despite being aware of their existence. Even otherwise, at the *prima facie* stage, Mr. Bakhru submits that the plaintiff's marks are entitled to a presumption of validity under Section 31(1)¹⁰ of the Trade Marks Act. Besides, having themselves obtained registration for the word mark CSM, which is merely an abbreviation for "Certified Scrum Master", the defendants cannot be heard to argue that the mark "Certified Scrum Master" is not entitled to registration, as it comprises generic or common words which cannot be monopolised. The objection of the mark being, to the trade, he submits, is not applicable to CTMs.

¹⁰ 31. **Registration to be prima facie evidence of validity.** –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



Submissions of Mr. Gagan Gupta by way of response

19. Mr. Gupta, the very outset, invokes Section 76(3) of the Trade Marks Act to submit that, as Defendant 1 is the proprietor of the registered trademark “CSM”, the use of the said mark can never be infringing. He submits that the defendants are merely carrying out their legitimate business activities, using the CSM mark which is registered in Defendant 1’s favour. He further submits that, having pleaded, in its response to the FER dated 13 July 2016, issued by the Trade marks Registry by way of objection to the plaintiff’s application No 3298082 seeking registration of the CSM word mark, the defence of concurrent user, vis-à-vis, *inter alia*, the defendants’ CSM word mark registration, and having secured registration of the CSM word mark upon that representation, the plaintiff cannot turn around and now seek to challenge the use, by the defendants, of its registered CSM word mark. In this context, Mr. Gupta places reliance on the judgment of the Division Bench of this Court in ***Raman Kawatra v. KEI Industries Ltd***¹¹.

20. Mr. Gupta further points out that, while contesting IA 01 of 2020 in Commercial Suit 1 of 2020 instituted by CSM Technologies Pvt. Ltd. (“CTPL”, hereinafter) against it before the learned District Judge, Khurda at Bhubaneswar, the plaintiff, as the opposite party, asserted that its CSM certification trademark was “distinct to the services rendered by it” and that there was “no scope for any


¹¹ 296 (2023) DLT 529 (DB)



confusion between” the plaintiff’s CSM mark and the CSM trademark of CTPL and that, therefore there was no possibility of the plaintiff, by using its registered trademarks, passing off its services at those rendered by CTPL. In this context, Mr. Gupta has referred to para 16 of the plaint and the corresponding para of the written statement, which read thus:

Para 16 of plaint

“16. In the spirit of full disclosure, the Plaintiff humbly submits that it has registrations in Clause 42 bearing nos. 3298080 for the

mark CSM and 3298084 for the mark , have rectifications filed against them before the Trademarks Registry by a third-party. The same third-party has also instituted a suit before the Hon’ble Commercial Court at Bhubaneswar, Odisha. In this regard, it is relevant to state that the rectification petition and the commercial suit have been filed on frivolous and baseless grounds and the Plaintiff is duly pursuing these proceedings before the Trade marks Registry and the Commercial Court at Khurda, Bhubaneswar, respectively. Pertinently, the Learned the Commercial Court at Khurda, Bhubaneswar has refused the interim injunction application under Order 39 Rules 1 & 2 CPC on merits in favour of the Plaintiff and the said party has preferred an appeal against the said order before the Hon’ble High Court of Orissa, which is pending and is likely to be decided in favour of the Plaintiff, herein.”

Para 16 of the written statement

“In reply to paras 16, the Defendant submits that admittedly the impugned trademarks “CSM” and the device “Scrum Alliance CSM Certified” of the Plaintiff is under scrutiny as rectification is filed for the cancellation of registration of the said trademarks by a third party by name M/s. CSM Technologies Pvt Ltd and the same is pending before the appropriate authority. Therefore, the Plaintiff is not entitled for any relief or else it will lead to conflicting judgments. In addition to that the Plaintiff who is the Defendant in the suit in Commercial Suit No. 1 of 2020 on the file of Learned Dist. Judge Khurda at Bhubaneswar has specifically pleaded that the registered trade mark “CSM” of the Plaintiff therein is different



as to that of the trade mark “CSM” of the Defendants therein (the Plaintiff herein). It is an admitted fact that the ad-interim injunction was not granted and the Plaintiff herein cannot take a different plea in the present suit stating that the Defendant trademark “CSM” is infringing the trademark “CSM” of the Plaintiff.”

21. Mr. Gupta has also invoked Section 33(1)¹² of the Trade Marks Act to plead acquiescence. He submits that it is an admitted position that the plaintiff was aware of the Defendant 1’s marks at least since 13 July 2016. The present suit, which was instituted on 22 December 2021 is, therefore, he submits, barred by acquiescence. The only exception to application of Section 33(1), submits Mr. Gupta, is where the application of the defendant, for registration of the impugned mark, is not in good faith. He points out that there is no assertion or averment, anywhere in the plaint, that the application of Defendant 1, for registration of the word mark CSM, was not in good faith. Rather, in para 31(a) of the plaint, the plaintiff has acknowledged the fact that it was made aware of Defendant 1’s CSM registration in 2016 – Mr. Gupta points out that the actual date was 13 July 2016. Cease-and-desist notices were sent, thereafter, by the plaintiff on 20 December 2017 and 25 January 2018. The plaintiff, thereafter, chose to wait till 2023 to institute the present suit, directly bringing into play, thereby, Section 33. He submits that the explanation, in para 31(g) of the

¹² 33. **Effect of acquiescence.** –

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

(a) to apply for a declaration that the registration of the later trade mark is invalid,
or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was not applied in good faith.



plaint, that the plaintiff was relying on the withdrawal, by Defendant 1, of its opposition to the plaintiff's registration as an assurance that Defendant 1 would not use its mark, cannot be accepted. He further submits that, though there were subsequent deliberations between the parties, they were only with respect to the use, by the defendant, of the



logo , and not with respect to the use of the mark CSM or "Certified Scrum Master" per se.

22. Mr. Gupta further submits that, having acceded to the plaintiff's requests for changing the colour of its logo, and for insertion of a disclaimer on its website, the defendant could not now be justifiably enjoined from altogether using the impugned marks.

23. Mr. Gupta further submits that, in fact, the defendants are prior users as well as prior registrants of the CSM mark. Defendant 1 had, while applying for registration of the CSM word mark on 23 November 2012, claim user of the mark from 10 September 2012. As against this, all applications, by the plaintiff, for registration of its marks, were filed on 30 June 2016. As on the date when Defendant 1 commenced use of its CSM mark in 2012, the plaintiff had, worldwide, only 39,475 customers with 5457 customers in India. It could not, therefore, be even said that, by the time the plaintiff applied for registration of its marks, the mark had attained secondary significance or reputation.



24. In fact, submits Mr. Gupta, the plaintiff cannot be allowed to monopolise the mark “CERTIFIED SCRUM MASTER”, as it is a combination of three generic English words. He has also invited my attention, in this context, to documents filed with the written statement indicating the use of the mark “Certified Scrum Master” by others; inter alia on the websites Beingcert.org, iccacouncil.org and atlassian.com. “Scrum”, he submits, is a certification course, and “Certified Scrum Master” merely refers to a person who has qualified the course and is adept in the Scrum technology. Allowing exclusivity, to the plaintiff, to use the mark “Certified Scrum Master”, he submits, would amount to granting the plaintiff a monopoly to grant Scrum Master certification, which is completely impermissible. He has also drawn my attention, in this context, to the following response on the “Quora” website from one Tony Arriagada on 22 January 2018:

“Yes it is, as well as any other. Your mastery over the release Scrum Framework from the Scrum Guide is what matters. I don’t care if your certification comes from GAQM, PMI, Scrum Alliance, Scrum.org or your Employer. There is no industry standard organisation that is the official Scrum website like Project Management Professional from PMI.

We shouldn’t be so cult like for our certification. If a company dares to only accept GAQM, Alliance, they will open themselves up to a lawsuit. What’s worth it??? Get the certificate from who ever!!! I was trained on UDEMY and study the Scrum Guide from scrumguide.org. I got my Scrum Master Certification from GAQM and Product Owner certification from my Job/Scrum.org.

I know people who took the Scrum Exam from Scrum Alliance via there job and it was open book!!!! When I took the exam by GAQM, I was watched by a webcam and screen sharing. You can’t take exams by Paper from GAQM.



I chose GAQM, because I can take my exam from anywhere. All said in done, it does not matter where you get your exam or cert. What really matters is how you practice.”

Thus, submits Mr. Gupta, the entire claim of the plaintiff is misconceived. Scrum certification is granted by various agencies, including the plaintiff and the defendants. The defendants are not holding themselves out as agents of the plaintiff or as granting Scrum certification on behalf of the plaintiff. The plaintiff cannot monopolise and arrogate, to itself, the entire right to grant Scrum certification.

25. Mr. Gupta submits, further, that the very registration of the marks that the plaintiff seeks to assert in the present suit is vitiated, as the plaintiff was in breach of Section 70 of the Trade Marks Act. He relies, for this purpose, on para 3(I) of the revised affidavit filed by the plaintiff on 23 August 2022 in compliance with the directions contained in the order dated 5 July 2022 passed by this Court, which reads as under:

“I. *‘Total number of employees and/or certified professionals employed by the Plaintiff to impart training in Agile methodologies as also Scrum certifications’* – in this regard, it is submitted as under –

a) As of the signing of this affidavit, the Plaintiff has 247 Certified Scrum Trainers. Trainers are not employees of the Plaintiff, rather they are licensed to operate training activities for Scrum Certifications.”

(Italics in original; underscoring supplied)

Mr. Gupta’s contention is that, by providing training activities, whereby Scrum certifications could be obtained, the plaintiff has breached Section 70. In contrast, he submits that, in the case of the



defendants, Defendant 1 is the owner of the impugned marks, whereas certifications are issued by Defendant 3.

26. The plaintiff marks were, submits Mr. Gupta, additionally disentitled to registration in view of Section 9(1)(b)¹³ of the Trade Marks Act, which does not stand excluded from application in the case of CTMs by Section 69. He submits that the expression “Certified Scrum Master” is clearly descriptive of the services provided by the plaintiff under the said mark. Ergo, submits Mr. Gupta, the mark could not have been registered. He relies, in this context, on paras 10, 14, 29 and 37 of the oft-cited decision of the Division Bench of this Court in *Marico Ltd v. Agro Tech Foods Ltd*¹⁴.

27. Mr. Gupta also seeks the benefit of Section 76(3), as “CSM” is registered as a word mark in favour of Defendant 1 in Class 41. He submits that the benefit of Section 76(3) is also available to a mark which is not registered as a CTM.

28. While the plaintiff’s marks were registered in 2017 w.e.f. 30 June 2016, Defendant 1’s mark, points out Mr. Gupta, was registered on 17 July 2014 with effect from 23 November 2012. Both

¹³ 9. **Absolute grounds for refusal of registration.** –

(1) The trade marks –

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

¹⁴ 174 (2010) DLT 279 (DB)



registration and user, by Defendant 1, of its mark is, therefore, anterior in point of time to the plaintiff. Inasmuch as the plaintiff does not even have any office in India, Mr. Gupta submits, on the basis of the figures of the number of persons who, as per para 22 of the plaint, were registered as Certified Scrummaster, in India, by the plaintiff, that it could not be said that, by 2012, when Defendant 1 had applied for registration of the CSM mark, or even by 2016 when the plaintiff so applied, the plaintiff had any substantial transborder reputation in India, applying the principles in that regard laid down by the Supreme Court in *Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd*¹⁵. Besides, submits Mr. Gupta, the number of persons who were certified as Scrummasters by the plaintiff, as reflected in para 22 of the plaint, could not be said to be reflective of the number of new registrants, in view of Clause II(F) of the Regulations governing the plaintiff, which read thus:

“F. Through Scrum Alliance’s requirement for renewal every two (2) years, Scrum Alliance achieves its quality control management over all certified individuals.”

29. Apropos Mr. Bakhru’s contention that Defendant 1 had admitted, before the Trade marks Registry, the likelihood of confusion between the defendant and plaintiff’s marks, Mr. Gupta submits that the said admission was in respect of Application No 3298082 of the

plaintiff for registration of the  mark, and not with respect to the CSM mark per se. He submits that his client is willing to change


¹⁵ (2018) 2 SCC 1



2023:DHC:8346



the logo presently being used by it, to one which could not be

confusing *vis-à-vis* the plaintiff's  mark.

30. Mr. Gupta also places reliance on para 9 of the plaint and para 10 of the rejoinder filed by the plaintiff in the present application, in which the plaintiff has asserted that numerous Fortune 500 companies and other reputed organisations regard the plaintiff's certification as a matter of recognition and prestige. Such clients, submits Mr. Gupta, would certainly be aware of the institution which had provided the certification, so that there could be no possibility of confusion between the plaintiff and the defendants or, therefore, of the defendants passing off the services provided by them as those of the plaintiff. In assessing the possibility of confusion, Mr. Gupta submits that the Court has necessarily to bear in mind the class of consumers or clients who would be accessing the rival marks. In this context, Mr. Gupta places reliance on para 87, 88 and 94 of *CFA Institute v. Brickwork Finance Academy*¹⁶. Para 94 of the said decision, points out Mr. Gupta, distinguishes the judgment in *Association for Investment Management and Research v. The Institute of Chartered Financial Analysts of India*¹⁷, on which Mr. Bakhrui relies. Mr. Gupta also places reliance, apropos honest and concurrent user under Section 12¹⁸, on the judgment of a learned Single Judge of this Court in *Alkem Laboratories Ltd v. Mega International (P) Ltd*¹⁹.

¹⁶ MANU/DE/1833/2020

¹⁷ 2006 (33) PTC 352

¹⁸ 12. **Registration in the case of honest concurrent use, etc.** – In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any



31. Finally, Mr. Gupta as drawn my attention to several documents, filed with the written statement, reflecting use, by various persons and agencies, of the expression “Certified Scrum Master”. The plaintiff, therefore, he submits, cannot be permitted to monopolise the said expression.

Mr. Bakhru’s submissions in rejoinder

32. In rejoinder, Mr. Bakhru submits, initially, that Mr. Gupta’s plea of acquiescence is completely misguided, in view of the cease-and-desist notices, as well as the opposition and rectification filed by the plaintiff to the registration of the CSM mark in favour of Defendant 1. He further submits that, on 8 February 2018, when Defendant 1 withdrew his opposition to Application No 3298082 of the plaintiff, there was no talk of settlement or any chance of settlement visible on the horizon. He has also invited my attention, once again, to the email communications between the plaintiff and Defendant 1 to emphasise that there was no communication from Defendant 1 after 14 July 2018, when the plaintiff suggested the furnishing of an undertaking by Defendant 1, so that no settlement ever fructified. Apropos Defendant 1’s contention that it had entered a disclaimer on its website, Mr. Bakhru points out that no such disclaimer was visible on the opening page of the website.

such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

¹⁹ ILR (2007) I Delhi 811



33. Mr. Bakhru disputes Mr. Gupta's contention that "Certified Scrummaster" was not entitled to registration as it was a descriptive mark. He submits that "Scrummaster" was clearly a coined and invented word and could not be regarded as lacking in distinctiveness. *Marico*, he submits, stands distinguished by this Court in its decision in *Procter & Gamble Manufacturing (Tianjin) Co Ltd v. Anchor Health & Beauty Care Pvt Ltd*²⁰.

34. Mr. Gupta's plea that "Certified Scrum Master" was used by various agencies and was, therefore, "common to the trade" and *publici juris*, submits Mr. Bakhru, cannot be accepted in the absence of any details regarding the extent and longevity of such used by such other persons. He relies, for this purpose, on the judgment of the Division Bench of this Court in *Pankaj Goel v. Dabur India Ltd*²¹ and my judgment in *Bacardi & Co. Ltd v. Bahety Overseas Pvt Ltd*²². He reiterates that, in any case, the marks were registered in favour of the plaintiff are entitled to the presumption of validity provided by Section 31(1), the application of which, to CTMs, does not stand excluded by Section 69.

35. Inasmuch as the marks of the plaintiff and the defendants are identical, and they are being used in respect of identical services catering to the same client base, Mr. Bakhru submits that the triple identity test, on the basis of which infringement or passing off is to be decided, stands satisfied in the present case. This principle would

²⁰ 211 (2014) DLT 466 (DB)

²¹ 2008 (38) PTC 49 (Del)

²² 284 (2021) DLT 529



continue to apply, even if the applicability of Section 29 stands excluded in the case of CTMs. Mr. Bakhru submits that, given the identity of the marks and identity of the services provided thereunder, there is, at the very least, a clear chance of likelihood of confusion applying the initial interest test.

36. Mr. Bakhru emphatically resists the contention of Mr. Gupta that the plaintiff has infringed Section 70 of the Trade Marks Act. He submits that Section 70 applies only where the proprietor of the CTM carries on a trade in the certified services. No such trade, he submits, is being carried on by his client.

37. The fact of adoption, by the defendants, of the “sun” device, submits Mr. Bakhru, is indicative of dishonest intention on their part. The plaintiff is, *ipso facto*, therefore, entitled to injunction.

38. Insofar as the plea of concurrent user, taken by the plaintiff in the opposition proceedings against the application filed by it for registration of its CSM word mark, Mr. Bakhru points out that, of the three rival marks cited by the Trade marks Registry in its FER against the plaintiff’s mark, the two marks relating to Santa Maria claimed user prior to 2009, whereas the use claimed by Defendant 1 was of 2012. The plea of concurrent user was, therefore, apropos the marks registered in favour of Santa Maria, and not apropos Defendant 1’s CSM mark. *Toyota*, submits Mr. Bakhru, is not applicable, as the plaintiff is not claiming transport border reputation but priority of



user. He submits that his client has seven years' priority of user, as compared to the defendants, in the very same field.

39. Mr. Bakhru also contests Mr. Gupta's assertion that the plaintiff has not specifically pleaded bad faith adoption, by the defendant, of its registered CSM mark. He submits that bad faith adoption is specifically pleaded, not only in para 20 of the rectification application filed by his client, against the said mark before the High Court of Madras, but also in para 45 of the present plaint. The dishonest adoption, by the defendants, of the "sun" motif which was deceptively similar to the logo used by the plaintiff, he submits, itself entitles the plaintiff to injunction. For this purpose, Mr. Bakhru cites the judgment of this Court in *Hindustan Pencils Pvt Ltd v. India Stationery Products*²³.

Analysis

A. Is a case of infringement made out?

40. Section 75 defines what constitutes infringement of CTMs. Infringement, as per Section 75, takes place when a person, who is not authorised to use the registered CTM, uses an identical, or deceptively similar mark, in the course of trade, as a trade mark, in relation to goods or services in respect of which the CTM is registered. Thus, the ingredients which have cumulatively to be satisfied in order for a CTM to have been infringed by another mark are that

²³ AIR 1990 Del 90



- (i) the infringing mark must be used by a person who is neither the proprietor of the registered CTM nor a person authorised, by the proprietor, to use the CTM,
- (ii) the infringing usage must be in the course of trade,
- (iii) the infringing mark must be either
 - (a) identical, or
 - (b) deceptively similar,to the registered CTM,
- (iv) the usage must be in relation to goods or services in respect of which the CTM is registered and
- (v) the manner of usage must be such as to render the use likely to be taken as trade mark usage.

41. The expression “use as a trade mark” has to be understood in the light of the definition of “trade mark” as contained in Section 2(1)(zb)(ii)²⁴ of the Trade Marks Act. As per the said definition, if the mark indicates a connection, in the course of trade, between the goods or services in relation to which it is used, and the person who has the right to use the mark, it constitutes “use as a trademark”.

²⁴ (zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—

(i) in relation to Chapter XII (other than Section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;”



42. Section 2(1)(zb)(ii) statutorily includes, within the meaning of the expression “used as a trade mark”, CTMs. The very use of CTMs, therefore, statutorily constitutes their use as trademarks. The impugned marks of the defendant, in the present case, are, however, not CTMs. The only registration that Defendant 1 holds is of the word mark “CSM”. The defendants do not possess any registration of a device mark, or of the word mark “Certified Scrum Master”. Inasmuch as the impugned marks of the defendants are not CTMs, their use, assuming the other prerequisites of Section 75 are fulfilled, can be regarded as infringing in nature only if they are used as trade marks – meaning that their use must be such as to indicate a connection in the course of trade between the services provided by the defendants and the defendants themselves.

43. It is *ex facie* apparent that this last condition stands fulfilled, as the defendants are clearly using the impugned marks for providing certification as Scrum Masters, so as to indicate a connection between the marks and the defendants, and are doing so on a commercial basis, as is apparent from the use, by the defendants, of the impugned



mark on their brochure, as well as by the agreement dated 1 April 2014 executed with Mr Satish Gurnani. The impugned marks are, therefore, clearly being used as trade marks.


44. The defendants had neither any registered proprietorial rights over the plaintiff’s registered CTMs, nor were they authorised by the



plaintiff to use the said CTMs, in accordance with the regulations governing their use as submitted by the plaintiff under Section 74(1). All that is left to be seen, apropos Section 75 and the aspect of infringement, is, therefore, whether the impugned marks are identical with, or deceptively similar to, the plaintiff's registered CTMs.

45. A mark is defined in Section 2(1)(h) as being “deceptively similar” to another mark “if it so nearly resembles that other mark as to be likely to deceive or cause confusion”. The plaintiff's registered CTMs are the word marks “CERTIFIED SCRUMMASTER”, “CSM”,

and the device marks  and . It is obvious that the

impugned marks “CSM”, “Certified Scrum Master” and  are similar – and, in the case of the mark CSM, identical – to the plaintiff's registered CTMs.

46. Mr. Gupta sought to contend that there was no likelihood of confusion, as the persons who would have to deal with the marks, and the certifications represented thereby, would be able to distinguish whether the certification was issued by the plaintiff or by the defendants. The argument cannot be accepted, for the simple reason that likelihood of confusion, in trademark infringement or passing off, is to be assessed on the basis of the initial impression conveyed by the allegedly infringing mark; referred to, otherwise, as “initial interest confusion”. No doubt, the possibility of confusion would not be



evaluated, in the case of a CTM, on the basis of the perception of the average consumer on the street, who has nothing to do with the CTMs concerned, as the targeted client base is also a relevant factor to be borne in mind while assessing the likelihood of confusion. Mr. Gupta's submission is that, even as per the plaintiff's own case, the persons who employ, or had to deal with, professionals bearing the "Certified Scrum Master" certification, are companies of standing, who would be able to appreciate the difference between a certification issued by the plaintiff and one issued by the defendants. The submission begs the issue at hand. The question is whether a person, who sees the defendants' impugned marks, and is aware of the plaintiff's registered CTMs, is, or is not, likely to be confused at the immediate initial stage. "Confusion", in this context, is best explained by the judgment of the Division Bench of this Court in *Shree Nath Heritage Liquor Pvt Ltd v. Allied Blender & Distillers Pvt Ltd*²⁵, as a "state of wonderment". Viewed thus, it is clear, in my opinion, that the initial impression conveyed by the defendants' impugned marks would certainly be one of confusion as to whether the certification, designated by the impugned marks, has been granted by the defendants or the plaintiff. It is, in fact, almost impossible, absent prior hindsight knowledge, to divine, from a mere glance at the defendants' marks, whether they have been issued by the defendants or the plaintiff, as "CSM" and "CERTIFIED SCRUMMASTER" are both registered CTMs of the plaintiff. The possibility of confusion is exacerbated by the use, by the defendants, of the "sun" motif which,

²⁵ 221 (2015) DLT 359



except for the difference in colour, resembles the “sun” motif used by

the plaintiff in its  mark.

47. I am also inclined to accept, in this context, the submission of Mr. Bakhru that the use of the sun motif is not pure coincidence, but reflects an intent to imitate the plaintiff and, possibly, mislead the public. Mr. Gupta has not advanced any explanation as to why the defendants adopted the “sun” motif. Nor is it Mr. Gupta’s case that the “sun” motif, in respect of such CTMs, was a matter of common usage. In the absence of any other explanation, therefore, I am *prima facie* inclined to believe that the idea of the “sun” motif was in fact borrowed from the “sun” motif used by the plaintiff in its



mark.


48. Where there is a conscious attempt at imitation, and at approximating to the mark of another, the law frowns. Lindley, LJ, in *Slazenger & Sons v. Feltham & Co.*²⁶ spoke, of such instances, nearly a century and a half ago, thus:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”


²⁶ (1889) 6 RPC 531




Lord Lindley’s dictum remains a guiding principle to this day, having been followed by courts in this country times without number, including the Supreme Court in *Khoday Distilleries Ltd v. Scotch*

*Whisky Association*²⁷. The  mark of the defendants being, *prima facie*, a conscious depiction of “Certified Scrum Master” encased in a “sun” motif, the intent to confuse the certification provided by the defendants with that provided by the plaintiff appears, to me, to be *prima facie* apparent. Applying *Slazenger*, therefore, I would presume success in the endeavour of the defendant to imitate the plaintiff and, consequently, positive likelihood of confusion.

48. Besides, “Certified Scrum Master” constituting the prominent

feature of the impugned  mark, and the plaintiff being the registrant of the registered CTM “CERTIFIED SCRUMMASTER”, even if one were to ignore the “added matter” in the form of the outer “sun” motif within which the defendants have encased the words

“Certified Scrum Master”, the impugned  mark nonetheless remains infringing of the plaintiff’s registered CTM mark “CERTIFIED SCRUMMASTER”, applying the principles enunciated in the following passage from *K.R. Chinna Krishna Chettiar v. Shri Ambal & Co.*²⁸:


²⁷ (2008) 10 SCC 723

²⁸ (1969) 2 SCC 131




“9. The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device. The case of *De Cordova v. Vick Chemical Co.*²⁹ is instructive. From the appendix printed at p. 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word “Vaporub” and another registered trade mark consisting of a design of which the words “Vicks Vaporub Salve” formed a part. The appendix at p. 226 shows that the defendants advertised their ointment as “Karsote Vapour Rub”. It was held that the defendants had infringed the registered marks. Lord Radcliffe said: “... a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features”.



The only difference between  and “CERTIFIED SCRUM MASTER”, insofar as their textual component is concerned, is that the plaintiff has combined the words “SCRUM” and “MASTER” to read “SCRUMMASTER”, whereas the defendants have retained “SCRUM” and “MASTER” as separate words. This minuscule distinction makes no difference to the aspect of deceptive similarity and, consequently, of infringement. It is obvious that a person who is familiar with the plaintiff’s CTM “CERTIFIED SCRUMMASTER”,



and who comes across the defendants  mark, is likely, even if for a fleeting moment, to wonder whether it is not the plaintiff who is providing the said certification. That momentary feeling of wonderment would, by itself and without anything else, suffice to constitute “likelihood of confusion”. The possibility of confusion

²⁹ 1951 68 RPC 103




would only stand enhanced if the person in question recollects the fact


that the plaintiff, too, uses a “sun” motif in its mark



49. The defendants are obviously not the registered proprietors of the plaintiff’s registered CTMs. They have not been authorised, by the plaintiff, to use the said marks. The plaintiff is the proprietor of the registered CTMs “CERTIFIED SCRUMMASTER”, “CSM”, and

the device marks  and . The impugned “CSM” mark is identical to the plaintiff’s registered CTM word mark “CSM”. The

impugned “CERTIFIED SCRUM MASTER” and logo  are deceptively similar to the plaintiff’s registered “CERTIFIED

SCRUMMASTER” and  CTMs, as, owing to the use of “Certified Scrum Master” and the “sun” motif, there is every chance of likelihood of confusion or deception in the mind of the person who comes across the mark. The defendants are clearly using the impugned marks as trademarks, as they are intended to indicate a connection in the course of trade between the services provided by the defendants and the impugned marks themselves.

50. Resultantly, all ingredients envisaged by Section 75 of the Trade Marks Act stand satisfied. A *prima facie* case of infringement,



by the defendants, of the plaintiff's registered CTMs, within the meaning of Section 75, therefore, exists.

B. Re. Section 76(3)

51. The defendants seek amnesty under Section 76(3).

52. The various sub-sections of Section 76 operate as exceptions to Section 75. As such, if the facts of the case justify invocation of any of the three sub-sections of Section 76 then, notwithstanding the marks of the defendants being infringing of the plaintiff's CTMs within the meaning of Section 75, no case of infringement can be said to exist, and no injunction against the use, by the defendants, of the impugned marks, can be granted. It would be fallacious, therefore, for a Court to hold, even *prima facie*, that the defendants' mark infringes the registered CTMs of the plaintiff merely by examining the matter from the point of view of Section 75 without, additionally, assessing whether it would also not attract one or more of the exceptions engrafted to infringement in Section 76.

53. We are concerned, in the present case, only with Section 76(3).


54. The opening words of Section 76(3) indicate that it applies in a case "where a certification trade mark *is one of* two or more trade marks registered under this Act". The words "is one of" are of stellar significance. They indicate that Section 76(3), in order to apply, does not require both the rival marks to be registered CTMs. All that it



requires is that both the marks must be registered under the Trade Marks Act. So long as both the marks are registered under the Trade Marks Act, *and one of them* is a CTM, the fact of registration would entitle *each* of the said marks to be used as a trademark, and no injunction against such use can be granted, irrespective of whether the mark is, or is not, infringing. This does appear peculiar, but peculiarities are not foreign to statutory instruments, and the Court is required to defer to statutory peculiarities, when and where it finds them.

55. In the present case, there is no dispute that Defendant 1 is the proprietor of the registered trade mark “CSM”, registered as a word mark, even if the registration is not as a CTM. There can, therefore, be no injunction against the use, by Defendant 1, of “CSM” as a word mark. The plaintiff’s prayer for injunction against use, by the defendants, of the mark “CSM”, as a word mark cannot, therefore, be granted.

56. Section 76(3) would not, however, come to the rescue of the

defendants “CERTIFIED SCRUM MASTER” or  marks, as they are not registered in favour of any of the defendants, either as CTMs or as ordinary trade marks.

C. Plaintiff’s response to FER dated 13 July 2016, apropos Application 3298082



57. Mr. Gupta has placed reliance on the response, dated 22 September 2016³⁰, of the plaintiff to the FER dated 13 July 2016 whereby the Trade Marks Registry objected to Application 3298082 of the plaintiff for registration of the word mark “CSM”. Having pleaded “concurrent right” to use the CSM mark with the CSM marks which had earlier been registered by the Trade Marks Registry, Mr. Gupta’s contention is that the plaintiff cannot, now, seek to injunct the user, by the defendant, of its registered CSM mark.

58. I have already refused the prayer of the plaintiff for an injunction against use, by the defendant, of its registered CSM word mark. No finding need, therefore, be returned, regarding this objection of Mr Gupta. I need not, therefore, dwell, either, on the applicability of the judgment of the Division Bench of this Court in *Raman Kawatra*, either.

D. Re. stand adopted by plaintiff before learned District Judge, Khurda in Commercial Suit 1 of 2020

59. The exact stand adopted by the plaintiff in its pleadings before the learned District Judge, Khurda in Commercial Suit 1 of 2020 is unknown, as the pleadings in that suit are not on record. Mr. Gupta relies on the following observation contained in para 3 of the order dated 18 February 2021 of the learned District Judge:

³⁰ Refer para 7 *supra*



“According to the opposite party, its certification trademark is distinct to the services rendered by it and there is no space for any confusion between the two trademarks and as such there is no scope for passing off of the trade mark of the petitioner by the opposite party.”

60. Again, it is not necessary for me to render any finding on this submission, as the rival marks before the learned District Judge, Khurda, were both “CSM”, and I am, in any event, not injuncting the defendant from using the word mark “CSM”.

E. Section 33(1) of the Trade Marks Act

61. Mr Gupta has also sought to rely on Section 33(1) of the Trade Marks Act to plead acquiescence.


62. The plea of acquiescence can only protect the defendant against injunction of its registered mark. Inasmuch as the only registration held by the defendants is of the CSM word mark, and I am not injuncting the use thereof, it is not necessary for me to return any finding on the plea of acquiescence.

F. Relevance of interceding deliberations between the parties

63. Both sides referred to emails which had been exchanged between the parties from time to time. Mr. Bakhru, for the plaintiff, submitted that the defendant had failed to comply with their assurances, as the disclaimer was not even apparent on the opening



page of the defendants' website. Mr. Gupta submitted, *per contra*, that the defendant had, in fact, inserted the requisite disclaimer and had

also lightened the colour of their  logo, and that, therefore, it was entirely unreasonable for the plaintiff to seek an absolute injunction against the use by the defendant, of the mark CERTIFIED

SCRUM MASTER” or  logo.

64. The fact of the matter remains that the plaintiff and defendant have not been able to reach any middle ground. No useful purpose would, therefore, be served by adverting to the *inter se* communication between them. At the end of the day, the Court has, before it, an application by the plaintiff, seeking interlocutory relief, which is opposed by the defendant. The Court has, therefore, to consider whether a case for grant of interim relief is, or is not, made out.

G. Re: Mr. Gupta's claims of prior user

65. Mr. Gupta claims of priority of user, by the defendant, of the “CSM” mark is also bereft of substance. The defendant, in fact, acknowledged the fact that, in 2012, when the defendant commenced user of the impugned “CSM” mark, the plaintiff had in fact certified 5457 persons as CERTIFIED SCRUM MASTERS, using the plaintiff's mark. User, by the plaintiff, of its mark is claimed since



2005. The plaintiff has also provided the following tabular statement of the number of persons who had applied for certification with the plaintiff and whom the plaintiff had certified, from 2005 till 2021:

Year	Number of people who applied/ obtained CERTIFIED SCRUMMASTER (CSM) certification per year	Number of People who registered for CERTIFIED SCRUMMASTER (CSM) in India per year
2005	2,551	32
2006	6,688	173
2007	8,502	591
2008	14,849	891
2009	20,989	1,396
2010	28,643	2,234
2011	37,645	4,003
2012	39,475	5,457
2013	46,122	6,530
2014	53,576	8,650
2015	69,723	14,605
2016	85,974	16,578
2017	102,981	19,758
2018	111,201	22,974
2019	113,233	26,834
2020	86,382	17,780
2021	86,846	18,943



66. As Mr. Bakhru correctly submits, the plaintiff is not pleading trans-border reputation, but actual user of the CERTIFIED SCRUMMASTER/CSM mark since 2005. As Defendant 1 pleads user of its CSM mark only since 2012, it is obvious that the defendants' plea of priority of user of the mark, vis-à-vis the plaintiff, has no legs to stand on.

H. Re: Mr. Gupta's contention of the mark "Certified Scrum Master" being generic

67. Mr. Gupta sought to contend that the mark CERTIFIED SCRUM MASTER was not entitled for registration as it was a combination of three generic English words, namely, "Certified", "Scrum" and "Master". Moreover, he submits that the mark was descriptive in nature, as it described the nature of the certification issued thereunder.

68. The very entitlement of the defendants to raise this contention is seriously open to question as the defendant is itself the proprietor of a registration for mark "CSM" and, admittedly, "CSM" is merely an acronym for "CERTIFIED SCRUM MASTER". Having itself obtained a registration for the acronym for "CERTIFIED SCRUM MASTER", the defendants cannot, *prima facie*, contend that "CERTIFIED SCRUMMASTER" is not entitled for registration.



69. That apart, the defendant has itself, on its website, entered the following “trade mark acknowledgement”:

“Certified Scrum Master (CSM)[®] is a Registered Trademark of GAQM.”

70. Though the aforesaid acknowledgement is false on facts, it reflects the defendants’ own understanding that “CERTIFIED SCRUM MASTER” was entitled for registration. In that view of the matter, and keeping in mind the fact that Section 31(1) of the Trade Marks Act envisages registration of a trade mark as itself constituting *prima facie* evidence of the validity of the mark, coupled with the fact that the defendant has not instituted any proceedings against any of the registrations asserted by the plaintiff in the present suit, I am not inclined, at a *prima facie* stage, to invoke Section 9(1)(b) of the Trade Marks Act as a ground to disentitle the plaintiff to interlocutory relief.

71. At the interlocutory stage, the court is required to examine the matter *prima facie*. What has to be seen is whether, viewed *prima facie*, the evidentiary scales are tilted in favour of the plaintiff or in favour of the defendant. While, ordinarily, the onus to establish a *prima facie* case is originally on the plaintiff who seeks interlocutory relief under Order XXXIX, Section 31(1) of the Trade Mark alters that position, where the plaintiff is the proprietor of a registered trade mark, by providing that the very factum of registration constitutes *prima facie* evidence of the validity of the mark. The initial onus which otherwise rests on the plaintiff stands, therefore, statutorily discharged by Section 31(1) of the Trade Marks Act. Where the



plaintiff is the proprietor of a registered trade mark, therefore, it would be for the defendants to lead evidence, *prima facie*, to establish that the plaintiff's mark is invalid. Where such evidence is overwhelmingly available, the court can legitimately take cognizance thereof, in order to deny interim relief to the plaintiff even though it is a proprietor of a registered trade mark. In other words, where there is overwhelming evidence that the registration of the trade mark is invalid, the court can, even at the Order XXXIX stage, rely on such evidence to deny interim relief to the plaintiff.

72. That, however, is not the situation which obtains here. The defendants' plea of invalidity of the plaintiff's "CERTIFIED SCRUMMASTER" mark is predicated on Section 9(1)(b). It is only where the mark designates the kind, quality or nature of the service provided under the mark that the mark becomes disentitled to registration under Section 9(1)(b). The issue of whether the mark "CERTIFIED SCRUM MASTER" is descriptive of the services provided under the said mark is, to my mind, at the very least arguable. Mr. Bakhru has sought to submit that "SCRUMMASTER" even by itself, is an invented expression and cannot be regarded as *prima facie* indicative of the services provided by the plaintiff through the mark "CERTIFIED SCRUMMASTER".

73. It cannot, therefore, be said that the plaintiff has succeeded in making out an overwhelmingly clear case of invalidity of the defendants' "CERTIFIED SCRUMMASTER" mark so as to invoke Section 9(1)(b) in response to the plaintiff's charge of infringement.



74. The plea of Mr. Gupta to that effect has, therefore, to be rejected.

I. Re: Section 70

75. The registrability of the plaintiff's "CERTIFIED SCRUMMASTER/CSM" mark has also been contested by Mr. Gupta on the basis of Section 70 of the Trade Marks Act. Section 70 proscribes registration of a mark as a CTM in the name of a person, carrying on a trade in goods of the kind, certified or a trade of the provision of services of the kind certified.

76. Mr. Bakhru submits – and I agree – that that it cannot be said that the plaintiff is carrying on a trade of the provision of services of the kind certified by it. The reliance, by Mr. Gupta, on para 3(I) of the revised affidavit filed by the plaintiff on 23 August 2022, in support of this allegation, is *prima facie* misconceived. For ready reference, the said paragraph is reproduced once again as under:

“I. *Total number of employees and/or certified professionals employed by the Plaintiff to impart training in Agile methodologies as also Scrum certifications*’ – in this regard, it is submitted as under –

- a) As of the signing of this affidavit, the Plaintiff has 247 Certified Scrum Trainers. Trainers are not employees of the Plaintiff, rather they are licensed to operate training activities for Scrum Certifications.”

(Italics in original; underscoring supplied)



77. By no means can it be said that the afore-extracted passage, from the revised affidavit filed by the plaintiff, indicates that the plaintiff is carrying on a trade of the provision of services of the kind certified by the “CERTIFIED SCRUMMASTER” mark asserted in the plaint. In this context, it is important to note the exact words used in Section 70. What Section 70 proscribes is the applicant, who seeks registration of a mark as a CTM, *carrying on a trade of the provision of the services of the kind certified*. The words “trade of a provision of the kind certified” are of great significance. The services certified by the “CERTIFIED SCRUMMASTER” CTMs asserted in the plaint are the services of a Scrum Master, i.e., a person who is adept in Scrum Agile methodology.

78. Para 3(I) of the revised affidavit only deposes that the plaintiff has 247 certified scrum trainers who impart training in Agile methodology and Scrum certifications. Imparting of training in Agile methodology, which would entitle the trainee to obtain a Scrum certification, cannot be regarded as training in the provision of the services rendered using the Scrum Agile methodology. If the plaintiff were to itself provide Scrum services for commercial consideration, Section 70 would have applied. The plaintiff does not do so. The invocation of Section 70 by the defendants is, therefore, based on a fundamental misreading of the section.

J. Passing off



79. In order for a plea of passing off to succeed, the plaintiff would have to establish acquisition of goodwill and reputation, by use of the marks asserted in the plaint. The number of persons granted certified SCRUMMASTER registration by the plaintiff from 2005 till 2021 has been tabulated in para 65 *supra*. Mr. Gupta has also pointed out that certification, once granted by the plaintiff, has to be renewed every two years. As such, the number of certifications reflected in the above table in any particular year cannot definitively be said to represent the number of new certifications for that year.

80. Even otherwise, the number of certifications is not so substantial as to enable the Court to arrive, *prima facie*, at a conclusion that the plaintiff has accumulated sufficient goodwill and reputation to hold that the defendants are seeking to pass off their services as those of the plaintiff. At the very least, this aspect is arguable, and may have to suffer a trial.

81. As such, no *prima facie* finding of passing off in favour of the plaintiff and against the defendants can be returned.

Conclusion


82. For the aforesaid reasons, I am of the considered opinion that, while the defendants cannot be enjoined from using the word mark “CSM”, the plaintiff is entitled to an interlocutory injunction, pending disposal of the suit, against the use, by the defendants as well as all



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others acting on its behalf, of the mark “CERTIFIED SCRUM

MASTER” and the logo  .

83. An interlocutory injunction to the said effect shall, accordingly, issue.

84. IA 17424/2021 stands partly allowed, in the aforesaid terms.

85. List CS (Comm) 700/2021 before the learned Joint Registrar (Judicial) for further proceeding on 15 December 2023.

C. HARI SHANKAR, J.

NOVEMBER 21, 2023

dsn

Click here to check corrigendum, if any