

O-763-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3515979

IN THE NAME OF

PROJACS INC

TO REGISTER

The logo for Projacs is written in a fluid, cursive script. The letters are interconnected, with a prominent 'P' at the start and a 's' at the end. The overall style is elegant and handwritten.

AND

Projacs

AS A SERIES OF TWO (2) TRADE MARKS

IN CLASS 42

AND

THE OPPOSITION THERETO UNDER NUMBER OP000422408

BY

PROJACS INTERNATIONAL PROJECT MANAGEMENT CO. WLL

Background and pleadings

1. On 26 July 2020, Projacs Inc. (“the Applicant”) applied to register a series of two (2) trade marks in the UK, as shown on the cover page of this decision. The application, which carries a priority date of 17 July 2020 based on its earlier filing in Canada, was accepted and published in the Trade Marks Journal for opposition purposes on 11 September 2020; in relation to the following services:

Class 42 Full-service engineering, architecture, planning, environmental, project, program and construction management and economic development, engineering for the petroleum, chemical, mineral refining, oil & gas.

2. Projacs International Project Management Co. WLL (“the Opponent”) opposes the trade mark on the basis of Section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is on grounds of its alleged earlier rights in “Projacs Academy”. It claims to have been providing *training courses in business and professional issues including engineering, project and construction management, mechanical, civil, technical and electrical engineering, architecture and information technology* under this sign throughout the UK since 2011; and to have acquired “a substantial reputation and goodwill” under the sign. The Opponent contends further that use of the contested mark would amount to a misrepresentation to the public that would result in damage to its goodwill.

3. The Applicant filed a counterstatement denying the claims made and puts the Opponent to strict proof of its opposition claims. “The applicant denies that use of their UK trade mark application no. 3515979 would cause misrepresentation and damage to the goodwill the opponent has allegedly generated (and for which they must prove) and is put to strict proof of this claim.”

4. In these proceedings, the Opponent is represented by Novagraaf UK and Barker Brettell LLP represents the Applicant. Evidence was filed by the Opponent only, together with submissions; the Applicant choosing to file submissions in lieu of a hearing only. I will summarise the evidence to the extent that it is considered necessary; the written submissions will be referred to as and where appropriate during

this decision. A hearing was neither requested, nor considered necessary; and so, this decision is taken following a careful consideration of the papers before me.

Relevant date

5. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

6. The Applicant has not claimed, nor filed any evidence, that it has been using its mark before the date of the application; therefore, the relevant date at which the Opponent must establish its goodwill and that the use of the Projacs Academy mark was liable to be prevented, by virtue of the law of passing off, is 26 July 2020.

Evidence

7. The Opponent's evidence takes the form of two witness statements, with exhibits, from Elian Al Achy, Senior Training Manager at Projacs International Project Management Co, a position he has held since September 2012; and Laura Morrish, Chartered Trade Mark Attorney at Novagraaf.

8. Mr Al Achy asserts that his company was founded in 1984 in the Middle East; and that it provides “a wide range of professional training courses delivered by highly qualified experts and trainers around the world, including in the UK. These courses are operated through our subsidiary business Projacs Academy, which has been running courses since 1984”. Projacs Academy courses have been delivered “in the UK, specifically London, since 2011”; and in Manchester.

9. Mr Al Achy reproduces and shows, as **Exhibit EA1**, a series of invoices from two main venues (Crowne Plaza Hotel and Radisson Blue) in London, for events run at those venues on dates in 2018 and 2019, in the name of either: Projacs, or Projacs International, or either of the former in care of a third party. According to the witness evidence, “[t]hese invoices are for room hire and the provision of refreshments to our delegates”. Some invoices also show virtual addresses in the format of either @projacs.com or @projacsacademy.com. It is also apparent from the invoices, that there were no more than three attendees at a time. Mr Al Achy states that “we offer a large number of courses for small and big groups of participants, as well as personalised and tailored courses”. The courses or events, on the invoices exhibited, were titled: Excellence in Leadership and Creativity; Creative Leadership, Management; and The Vision, Leadership and Change.

10. **Exhibit EA2** consists of listings of courses offered annually, on numerous dates between 2012 and 2021, in “London/UK”, by Projacs Academy. Mr Al Achy states that the listings are webpages from www.projacsacademy.com; however, this web address is not evident on any of those pages, which are also undated, save and except for the various course dates next to each listing (between 2012 and 2021). Each annual listing is headed with two marks, with figurative elements; one bearing the mark Projacs and the other in the name of Projacs Academy. The copyright notice, “© 2021 Projacs International, All rights reserved”, also appears at the end of each annual listing. The courses on offer include: The PROJACS Negotiation Program, Oil and Gas Fundamentals...; Treatment Process for Crude Oil...; New Technologies in Manufacturing Crude Oil; Planning, Design and Follow-up Technical and Engineering Projects – Certified Program; PROJACS Certified Fire Protections Specialist (CFPS), According to NFPA; and PROJACS Program on Management (to name a few). Course fees, where indicated, are stated in US Dollars. For example, under Exhibit EA3, the

course fee for the Construction Contract and Tendering – Preparation, Submittal, Analysis and Award – Certified Program, a five-day course, is listed as “4500 US\$”.

11. Mr Al Achy exhibits various course brochures as **Exhibit EA3**. These show course titles, the dates they were scheduled to be delivered (for example dates in July, August and October 2019), information on the respective courses and that they were being held in “London/UK”. At the top of the cover page of each brochure is a composite mark, consisting of a figurative element and the word Projacs. There is also a tagline beneath the mark in the words: “Projacs Training and Development”. The bottom of the cover page also carries another composite mark, composed of a figurative element and the words “A member of:” and “Projacs Academy”, at the top and bottom of the figurative element, respectively. The said composite marks are also found at the top of the contents pages of the brochures. The virtual address, www.projacsacademy.com, appears at the bottom of each page, including the front cover.

12. “The number of attendees”, according to Mr Al Achy’s testimony, “at [the Opponent’s] externally run courses in the UK between 2017 and 2019 were as follows:

- 2019: 44 Participants
- 2018: 54 Participants
- 2017: 66 Participants”.

13. **Exhibit EA4** comprises of “[r]eports on course attendance, both in the UK and around the world”, according to Mr Al Achy’s statement. The reports exhibited are headed: “Confirmed Registration During the Year 2017+A651”; “Confirmed Registration During the Year 2018”; and “Confirmed Registration During the Year 2019”. The reports show columns headed: “No”, “Date”, “Course Title”, “Bahrain”, “Qatar”, “UAE”, “Oman”, “Kuwait”, “Saudi”, “Others”, “Total” and “Venue”. The venue for each course is listed as London/UK. It is therefore apparent that all the courses were held in UK, and that they were attended by citizens from the said Gulf Cooperation Council countries. For example, the 2017 report shows a delivery date of 10-14 April, for the course Excellence in Leadership and Strategic Planning, with the

number 6 in the corresponding “Saudi” column, and 6 in the “Total” column; and London/UK in the corresponding “Venue” column. The “Managing Multiple Projects – Certified Program”, held on 3-7 July, was attended by a total of seven participants (three from the State of Qatar and four from the Kingdom of Saudi Arabia) at a London/UK venue.

14. An example of a “Certificate of Completion” is also included under Exhibit EA4. This certificate bears the two composite marks (respectively consisting of the elements Projacs and Projacs Academy). This exhibit further includes “a copy of a signing in sheet from a course run in London in 2019”. This document shows the names of three participants, the countries from whence they attended (Oman and Saudi Arabia), the dates of attendance and (as it seems) the signatures of two of the participants. I shall therefore order that this information is redacted from the public file.¹ The relevant material gleaned from this document are composite marks and the virtual address, all containing the mark at issue or a variant of same.

15. The witness evidence puts forward the following “sales figures relating to courses run in the UK between 2013 and 2015”:

Year	Turnover by cash
2013	£ 73,400
2014	£150,000
2015	£130,000

16. **Exhibit EA5** provides a “sample of [Projacs Academy’s] invoices to clients for attendance on [its] courses”. There are two invoices under this exhibit: invoice numbers 5873 and 5874, both dated 21 December 2015. The Projacs composite mark appears at the top of the invoices, together with Projacs International Co. (B.S.C), the course name, date and venue (London/UK) and one named participant, on each invoice (to be redacted from the public file). Invoice 5873 is addressed to an entity in the Kingdom of Bahrain and records a sales figure of 1,658.800, in Bahraini Dinars

¹ Pursuant to Rule 58(3)(d) of the Trade Mark Rules 2008 (as amended).

(BHD). The 5874 invoice, addressed to entity based in Kuwait, shows an amount of 3,740.00 in United States Dollars (USD). There are payment instructions on both invoices; the Bahraini invoice gives the option to effect payment in either USD or BHD; whereas the invoice addressed to the Kuwait entity gives the option to pay in either USD or Kuwaiti Dinars.

17. The final exhibit from Mr Al Achy, **Exhibit EA6**, adduces “samples of the advertisements run on Facebook for [the Opponent’s] London based courses”. The witness evidence further attests that the courses are otherwise “recommended by word of mouth, or through advertising campaigns run by the larger business and in other countries”. The Facebook exhibits show posts, under the handle *@projacsacademy*, dated 25 and 28 January 2018, 7 May 2018 and 13 August 2018. These advertise different courses, over various dates, in London, under the Projacs Academy mark. The respective posts display public engagement in the form of the number of “likes”, as follows: 55, 97, 34 and 59.

18. The evidence from Ms Laura Morrish consists of a brief witness statement accompanied by three exhibits. Ms Morrish states that the additional evidence has been taken from the Opponent’s internal files and records. **Exhibit LM1** is a copy of a perpetual agreement between Projacs Academy Ltd and Project and Construction Center (Saudi Projacs) (SP), effective 1 January 2014, for the provision of “support services and exchange of information in the field of training and development on a mutual basis”. A term of the contract specifies that Projacs Academy will provide: “Logistical support for SP activities in UK and Europe including the sourcing and provision of training facilities, accommodation, catering and printing and IT services”.

19. At **Exhibit LM2**, Ms Morrish reproduces and shows “a selection of attendee sign in sheets for London courses run by Projacs Academy in 2015”. These take the form of those exhibited at EA3; and will also be redacted from the public file.

20. **Exhibit LM3** comprises “a selection of Attendee sign in sheets and certificates of completion for London courses run by Projacs Academy from 2016 to 2020. These show the names and signatures of participants and will therefore be redacted from the public file. This exhibit also contains an invoice addressed to Projacs for goods and services provided by Radisson Blu Portman Hotel in London.

21. The evidence from Ms Morrish, for the most part, confirm that Projacs Academy provided courses in the UK (London, in particular); and that they were provided for and/or attended by citizens from Gulf Cooperation Council countries.

22. That concludes my review of the Opponent’s evidence (the Applicant having chosen not to file evidence), insofar as it is relevant to these proceedings; and I turn to consider the ground upon which the opposition has been brought.

Decision

23. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

24. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

25. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

26. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Goodwill

27. To satisfy the first criteria for passing off, the Opponent must show that as at 26 July 2020, it had acquired the necessary goodwill or reputation in its business distinguished by the sign PROJACS ACADEMY. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

28. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

And later said , at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the

jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

29. The claimant in that case did not have any goodwill in the UK that would give it the right to prevent BSkyB from using the name "NOW TV" in relation to its internet protocol TV service. This was because the customers for Starbucks' broadcasting services under the name NOW were based in Hong Kong. The services could not be bought here. The fact that the service was sometimes accessed via the internet by Chinese speakers in the UK did not mean that Starbucks had customers here.

30. In this case, the Opponent's business is based in the Middle East. Taking the authorities cited above into account, that of itself would not be a bar to the Opponent acquiring goodwill and reputation in the UK. It would still be possible for the Opponent to have customers in this jurisdiction. However, the evidence shows that there was low sales of Projacs Academy courses to individuals and/or an affiliate institution in the Middle East.² The sales figures provided are considered to be low in the light of the high prices of said courses.³ Low turnover/sales, in absolute terms, of a high-priced product/service, supports the conclusion that use of the sign in question has not been sufficient to establish goodwill.⁴ A finding of passing off would not automatically follow the possession of any, or nominal, goodwill; an essential part of the test (for the tort of passing off) is whether there is significant goodwill. Even supposing the Opponent was

² It logically follows that it could not be said that the courses had actually been booked from/within the UK. Although the brochures and webpages were (almost) exclusively written in English, the prices were in US dollars and payment was accepted (according to invoice evidence) in either US Dollars or in Dinars from the respective states of the Gulf Cooperation Council.

³ Course fees are not provided for the years for which turnover figures are disclosed (2013, 2014 and 2015). However, taking the nearest comparison, in 2016 the Construction Site Management and Successful Management Skills course was listed for 7500 US\$, excluding VAT.

⁴ *Smart Planet Technologies, Inc. v Rajinda Sharma* BL O/304/20

able to establish any goodwill in the UK, its evidence of sales volumes is not sufficient to support a conclusion that the Applicant's use of the mark in question would cause substantial damage to it.

31. The evidence also shows that the courses were delivered in the UK, to participants from Gulf Cooperation Council countries; whilst there is no evidence of UK-based attendees (or customers with a UK billing address). Furthermore, the evidence does not suggest/show that the courses were promoted in the UK. Evidence in relation to advertising via social media does not establish that this genuinely targeted the UK, and instead shows that it was directed at a general or global audience. According to the witness evidence, "advertising campaigns [were] run by the larger business and in other countries". Furthermore, no figures or details are provided beyond broad statements of internet advertising. There is also a lack of information as to the extent of such advertising before the relevant date, save and except for the examples of low levels of social media engagement provided in Mr Al Achy's evidence.

32. It is worth addressing the Opponent's website evidence, particularly given the global prevalence of internet websites, through which courses can be booked directly from the UK. However, the evidence merely indicates the existence of a domain name/s and such existence does not necessarily mean that the trade mark has garnered any recognition, let alone goodwill in the UK. There is no evidence that there was a functioning website at the domain addresses: www.projacsacademy.com or www.projacs.com, at the relevant date. The webpages exhibited do not display either of these domains and they were not dated; though the copyright notice is dated 2021, it does not display the date/s of the prior version/s. Additionally, there is no evidence in relation to website analytics, showing whether the site was actually accessed and, if accessed, the location of visitors to the site; and more significantly, whether the site generated commercial activity, to point towards goodwill.

33. The Opponent's evidence appears to attach significance to its alleged "longstanding and continuous use of the mark ... in the UK", having had training courses delivered in this jurisdiction, to support its claim to a reputation and goodwill here.⁵ However, this fact is of no assistance in demonstrating that the Opponent had established any goodwill or reputation, in the UK, at the date of the application at issue. It is clear from the evidence, that even though the training courses are delivered in the UK, the customers of those courses are based outside of the UK. Further, delivering courses in the UK does not alter the fact that they were provided exclusively to a Middle Eastern market. I consider it unlikely that the mark is associated in the mind of the UK public with any business or any goods or services, or that there would have been even reasonable awareness of the courses in the UK at the relevant date, where use of the mark in the UK appears to have been isolated; and inevitably insufficient to support the Opponent's claim to goodwill.

34. I find that at the relevant date the Opponent has failed to demonstrate it had established any goodwill or reputation associated with the mark in the UK. This means that I need not go on to consider the question of misrepresentation and damage, as these would not occur in the absence of goodwill. Therefore, the opposition under Section 5(4)(a) fails.

Summary

35. Trade mark application number 3515979 shall proceed to registration, subject to appeal, for all of the applied-for class 42 services.

COSTS

36. The Applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Applicant the sum of **£1,150** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

⁵ The Opponent states that it first used the mark in the United Kingdom in 2011, but there is nothing in the evidence which establishes use at that date.

Considering statement and preparing counterstatement	£400
Considering opponent's evidence	£450
Preparing written submissions	£300
TOTAL	£1,150

37. I therefore order Projacs International Project Management Co. WLL to pay Projacs Inc the sum of **£1,150**. The said sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of October 2021

**Denzil Johnson
For the Registrar,
The Comptroller-General**