

**IN THE MATTER OF AN OPPOSITION by Canadian Olympic Association to application No. 823,343 for the trade-mark OLYMTIC filed by SmithKline Beecham Biologicals S.A.**

On September 16, 1996, the applicant, SmithKline Beecham Biologicals S.A., filed an application to register the trade-mark OLYMTIC based on proposed use of the trade-mark in Canada by the applicant itself or through a licensee or by the applicant itself and through a licensee in association with “Vaccines for human use for the treatment/prevention of lyme disease”.

The opponent, Canadian Olympic Association, filed a statement of opposition to registration of the trade-mark OLYMTIC on October 7, 1997, a copy of which was forwarded to the applicant on November 13, 1997. The applicant served and filed a counter statement in response to the statement of opposition on December 5, 1997. The opponent filed as its evidence the affidavit of John N. Allport while the applicant submitted as its evidence the affidavits of Karen E. Thompson and Alan Sinclair Cox. Karen E. Thompson was cross-examined on her affidavit, the transcript of the cross-examination forming part of the record of the present opposition. The applicant alone filed a written argument and both parties were represented at an oral hearing.

The first ground of opposition is based on subsection 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant’s application does not comply with subsection 30(i) in that, at the time of filing its application, the applicant was aware of the opponent’s marks and therefore could not have been satisfied that it was entitled to use its trade-mark OLYMTIC in Canada in association with the wares covered in the present application. While the onus or legal burden is on

the applicant to show that its application complies with the provisions of section 30 of the *Trade-marks Act*, there is an evidential burden on the opponent to prove the allegations of fact being relied upon by it in support of its subsection 30(i) ground [see *Joseph Seagram & Sons v. Seagram Real Estate*, 3 C.P.R.(3d) 325 at pp.329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293 (F.C.T.D.)].

As the applicant has formally complied with the provisions of subsection 30(i) of the *Trade-marks Act* by including the required statement in its application, the issue arises as to whether or not the applicant has substantively complied with that section. In this regard, the opponent has not shown that the applicant was aware of the opponent's marks prior to filing the present application or that the applicant could not have been satisfied that it was entitled to use its trade-mark OLYMTIC in Canada in association with the wares covered in the present application. In this regard, and even had the applicant been aware of the opponent's marks and name prior to filing the present application, such a fact is not inconsistent with the statement in the present application that the applicant was satisfied that it was entitled to use the trade-mark OLYMTIC in Canada on the basis that it did not consider its trade-mark to so nearly resemble as to be likely to be mistaken for any of the opponent's official marks or to be confusing with the opponent's trade-name. Thus, the success of this ground would be contingent upon a finding that the applicant's trade-mark is confusing with the opponent's trade-name or so nearly resembles as to be likely to be mistaken for one, or more, of the opponent's official marks. Thus, the determination of the remaining grounds of opposition will effectively decide the subsection 30(i) ground.

As its second ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark OLYMTIC in view of section 16 of the *Trade-marks Act* in that the applicant's trade-mark is confusing with its trade-name Canadian Olympic Association which had previously been used in Canada. The opponent has not adduced any evidence of use of its trade-name and has therefore failed to meet the burden on it under subsections 16(5) and 17(1) of the *Trade-marks Act* of establishing its prior use and non-abandonment of its trade-name in Canada. I have therefore rejected the second ground of opposition.

The third, fourth, fifth and sixth grounds of opposition are based on the provisions of subparagraph 9(1)(n)(iii) and paragraph 12(1)(e) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark OLYMTIC and that the trade-mark is not registrable in that the opponent had public notice given of the following official marks pursuant to paragraph 9(1)(n)(iii) of the *Act* in the *Trade-marks Journal* of January 29, 1975:

Canadian Olympic Association Olympique Canadienne & Design  
Canadian Olympic Association  
Association Olympique Canadienne

and had public notice given in the *Trade-marks Journal* of March 5, 1980 of the following official marks:

Olympic Games  
Olympiad  
Olympian  
Olympic  
Olympique  
Summer Olympics

Canada's Olympic Teams  
Winter Olympics  
Winter Olympic Games

and had public notice given in the *Trade-marks Journals* of May 9, 1984 and June 11, 1986, respectively, of the following official marks:

Olympia  
Olympus

and had public notice given in the *Trade-marks Journals* of January 29, 1975, March 23, 1983, May 9, 1984 and July 12, 1989 of the official marks identified in Schedule "E" to the statement of opposition.

Paragraph 9(1)(n)(iii) of the *Trade-marks Act* provides that no person shall adopt in connection with a business, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, any mark adopted and used by any public authority in Canada as an official mark in respect of which the Registrar has given public notice of its adoption and use. With respect to these grounds, I would note the following comments of Board Member Martin in *WWF-World Wide Fund for Nature v. 615334 Alberta Ltd.*, 6 C.P.R. (4th) 247 (T.M.O.B.) at pp.253-254 concerning a ground of opposition based on paragraph 12(1)(e) of the *Act*:

"The material time for considering the circumstances respecting the third ground of opposition would appear to be the date of my decision: see the decisions in *Canadian Olympic Assn. v. Allied Corp.* (1989), 28 C.P.R. (3d) 161 (F.C.A.), and *Canadian Olympic Assn. v. Olympus Optical Co.* (1991), 38 C.P.R. (3d) 1 (F.C.A.). Furthermore, the opponent is not required to evidence use and adoption of the official marks it is relying on, at least not in the absence of evidence suggesting that the marks were not used: see page 166 of the *Allied* decision. Finally, if the applicant is able to cast doubt as to whether or not an official mark owner qualifies as a public authority, the opponent may be required to evidence that status before relying on any such official mark: see page 216 of the trial level decision in *Big Sisters Assn. of*

Ontario v. Big Brothers of Canada (1999), 86 C.P.R. (3d) 504 (F.C.A.); affirming (1997), 75 C.P.R. (3d) 177 (F.C.T.D.), and Heritage Canada Foundation v. New England Business Service, Inc. (1997), 78 C.P.R. (3d) 531 (T.M.H.O.) at 536 and 538.

As stated in Section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. At pages 218-219 of the trial level decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 8-9 of the unreported decision of the Federal Court of Appeal in Techniquip Ltd. v. Canadian Olympic Assn. (Court No. A-266-98; November 10, 1999) [reported 3 C.P.R. (4th) 298].”

Further, in *Canadian Olympic Assn. v. Health Care Employees Union of Alberta*, 46 C.P.R. (3d) 12 (F.C.T.D.) at p.19, Mr. Justice Rothstein commented as follows concerning the test for assessing the resemblance between marks:

“The question must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.”

In the present case, the applicant submitted that the average consumer of its wares would be doctors, nurses, pharmacists, or the like and that such persons would associate the mark OLYMTIC with Lyme’s Disease and not the opponent in view of the syllable LYM combined with the suffix TIC which is the means by which the disease is carried [see para. 7, Cox affidavit]. However, I am far from convinced that the person to be considered in assessing the resemblance between the applicant’s mark and the opponent’s official marks in relation to the subparagraph 9(1)(n)(iii) grounds ought to be restricted to those who are consumers of the applicant’s wares. In this regard,

the applicant's wares might be advertised or promoted in the media and might therefore come to the attention of the average person who would not be likely to associate the applicant's mark with Lyme's Disease.

Apart from the foregoing, the agent for the opponent indicated at the oral hearing that the opponent was not relying on a family of marks in the present opposition. In any case, the opponent has not shown use of any of its official marks and therefore has not established the existence of a family of official marks [see *Techniquip Ltd. v. Canadian Olympic Assn.*, 80 C.P.R. (3d) 225 at p.232]. Since the opponent is not relying on a family of marks, I consider the applicant's state of the register evidence to be of limited relevance to the determination of the opponent's subparagraph 9(1)(n)(iii) grounds. In particular, the most relevant of the official marks being relied upon by the opponent is its official mark Olympic and the state of the register evidence revealed the existence of eight relevant registrations comprising or including the word OLYMPIC and standing in the names of different owners and seven additional registered trade-marks standing in the name of one further owner. I would be prepared to infer that, at most, a couple of these trade-marks may have been in use in Canada; and no other evidence of use of any third party mark comprising or including the word OLYMPIC has been adduced by the applicant. As a result, the possible use of a couple of third party OLYMPIC marks does not, in my view, have any measurable impact on the determination of whether a person might reasonably be likely to mistake the applicant's trade-mark OLYMTIC for the official mark Olympic.

In the present opposition, the applicant's trade-mark OLYMTIC is not identical to any of the

opponent's official marks identified above. As for the second aspect of the test, since the applicant's trade-mark is similar in appearance and very similar in sounding to the official mark Olympic, I find that a person, as a matter of first impression and imperfect recollection, would be likely to mistake the applicant's mark for it. Consequently, the applicant has not met the legal burden on it of satisfying the Registrar that its trade-mark OLYMTIC is registrable. On the other hand, since there is only a limited degree of similarity in appearance and in sounding and no similarity in the ideas suggested by the applicant's trade-mark OLYMTIC and the remaining official marks relied upon by the opponent, I find that the average person would not be likely to mistake the applicant's mark for any of the other official marks relied upon by the opponent. Thus, the subparagraph 9(1)(n)(iii) and paragraph 12(1)(e) ground is successful in view of the opponent's official mark Olympic.

The final ground of opposition relates to the alleged non-distinctiveness of the applicant's trade-mark, the opponent relying upon its official marks identified above in asserting that the applicant's trade-mark is not adapted to distinguish the applicant's wares from the wares and services of others and, more particularly, the wares and services of the opponent's official marks. Having concluded that the subparagraph 9(1)(n)(iii) ground of opposition is successful, it follows that the applicant's mark was not adapted to distinguish its wares as of the date of opposition, the material date for considering this ground. Thus, the non-distinctiveness ground of opposition is also successful.

Having been delegated by the Registrar of Trade-marks pursuant to subsection 63(3) of the *Trade-marks Act*, I refuse the present application pursuant to subsection 38(8) of the *Trade-marks*

*Act.*

DATED AT HULL, QUEBEC THIS 20<sup>th</sup> DAY OF DECEMBER, 2001.

G.W. Partington,  
Hearing Officer.