

IN THE MATTER OF AN OPPOSITION by Canadian Olympic Association to application No. 823,341 for the trade-mark ALYMPIA 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 ALYMPIA based upon 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 or 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 ALYMPIA on October 7, 1997, a copy of which was forwarded to the applicant on October 22, 1997. The applicant served and filed a counter statement in response to the statement of opposition on November 24, 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. & Design opposition but subsequently elected not to proceed with that cross-examination. The applicant alone filed a written argument and both parties were represented at an oral hearing.

As the first ground of opposition, the opponent alleged that the applicant’s application does not comply with subsection 30(i) of the *Trade-marks Act* 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 ALYMPIA 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.)]. In other words, the opponent must make out a ‘prima facie’ case that the applicant has not complied with the provisions of subsection 30(i) of the *Act*.

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, that is, was the statement true when the application was filed? Even had the applicant been aware of the opponent’s marks and name prior to filing the present applications, such a fact is not inconsistent with the statement in the applications that the applicant was satisfied that it was entitled to use the trade-mark ALYMPIA in Canada on the basis *inter alia* that its trade-mark does not so nearly resemble as to be likely to be mistaken for any of the opponent’s marks and is not confusing with the opponent’s trade-name. Thus, the success of this ground is contingent upon a finding that the applicant’s trade-mark is confusing with the opponent’s trade-name or so nearly resemble as to be likely to be mistaken for the opponent’s official marks. I will therefore consider the remaining grounds of opposition.

As its second ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark ALYMPIC 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. As the opponent has not adduced any evidence relating to its use of its trade-name, the opponent has failed to establish its prior use of its trade-name in Canada and has therefore failed to meet the burden upon it under subsections 16(5) and 17(1) of the *Trade-marks Act* in respect of the section 16 ground. I have therefore rejected this ground of opposition.

The third, fourth and fifth grounds of opposition are based on of the provisions of sections 9 and 11, 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 ALYMPIA and that the trade-mark is not registrable in that the opponent had public notice given in the *Trade-marks Journal* of January 29, 1975 of the following official marks pursuant to paragraph 9(1)(n)(iii) of the *Act*:

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 also 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

Paragraph 9(1)(n)(iii) of the *Trade-marks Act* provides, in part, 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. The material time for considering the paragraph 9(1)(n)(iii) grounds of opposition would appear to be the date of my decision [see *Allied Corporation v. Canadian Olympic Association*, 28 C.P.R.(3d) 161 (F.C.A.); affg. 16 C.P.R.(3d) 80 (F.C.T.D.); revg. 6 C.P.R.(3d) 500 (T.M.O.B.); and *Olympus Optical Company Limited v. Canadian Olympic Association*, 38 C.P.R.(3d) 1 (F.C.A.); affg. 31 C.P.R.(3d) 479; revg. 16 C.P.R.(3d) 455 (T.M.O.B.)]. While the legal burden is on the applicant to show that its mark is not a prohibited mark, to the extent that the facts alleged by the opponent are not self-evident or admitted, there is in accordance with the usual rules of evidence an evidential burden on the opponent to support the facts alleged [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. The opponent is not required to evidence use and adoption of each official mark relied on [see page 166 of the Federal Court of Appeal's reasons in the *Allied* case, referred to above]. Finally, the test to be applied is one of straight comparison of the marks in question apart from any marketplace considerations such as the wares, services or trades

involved [see page 166 of the *Allied Corporation* decision; and page 65 of the Trial Division's decision in *Canadian Olympic Association v. Konica Canada Inc.*, 39 C.P.R.(3d) 400 (F.C.A.); revg. on other grounds 30 C.P.R.(3d) 60 (F.C.T.D.)]. As stated in Section 9(1)(n)(iii) of the *Trade-mark Act*, that test 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, the official mark? [see *Ontario Federation of Anglers and Hunters v. Murphy*, 34 C.P.R.(3d) 496 (T.M.O.B.)].

The applicant's trade-mark ALYMPIC is not identical to any of the opponent's official marks identified above. However, from a visual comparison of the applicant's trade-mark ALYMPIC and the opponent's paragraph 9(1)(n)(iii) marks, I find the applicant's trade-mark to be similar visually to the opponent's official mark OLYMPIC. Moreover, I find the applicant's trade-mark ALYMPIC and the opponent's official mark OLYMPIC to be quite similar in sounding, bearing in mind that the test for resemblance under subsection 9(1) is not restricted to a visual comparison of the marks but rather includes all three aspects of resemblance referred to in paragraph 6(5)(e) of the *Trade-marks Act* [see *WWF-World Wide Fund for Nature v. 676166 Ontario Ltd.*, 44 C.P.R.(3d) 563, at p. 567]. On the other hand, I consider there to be only a limited degree of similarity both visually and in sounding between the applicant's trade-mark ALYMPIC and the remaining official marks relied upon by the opponent than between the applicant's mark and the opponent's official mark OLYMPIC. Further, there is no similarity in the ideas suggested by the applicant's trade-mark and any of the opponent's official marks.

The opponent's agent submitted at the oral hearing that the state of the register evidence adduced by way of the Thompson affidavit was of no relevance to the paragraph 9(1)(n)(iii) grounds of opposition. While I had my doubts as to the relevance of state of the register evidence to a paragraph 9(1)(n)(iii) ground of opposition [see *Canadian Olympic Association v. IMI Norgren Enots Ltd.*, 23 C.P.R. (3d) 389] prior to the decision of the Federal Court, Trial Division in *Canadian Olympic Association v. Health Care Employees Union of Alberta and The Registrar of Trade-marks*, 46 C.P.R. (3d) 12 (F.C.T.D.), it may well be that such evidence is of relevance in so far as it negates any proprietorial significance of the common feature of the official marks relied upon by an opponent. In this regard, the results of the Thompson search point to the existence of over eighty registered trade-marks or official marks incorporating the four letters or word OLYM, many of which are quite similar to a number of the opponent's official marks being relied upon in the present proceeding. As a result, the state of the register evidence supports the conclusion that little weight can be accorded the opponent's official marks were the same to be considered to constitute a family or series of such marks.

I would note that the opponent has not specifically asserted that it is relying upon a family or series of official marks. Nevertheless, I am of the view that I must consider this issue in view of the number of official marks comprising the OLYMP component being relied upon by the opponent. Having regard to the *Health Care Employees Union* decision, referred to above, I am obliged to consider that a public authority can rely upon a series or family of official marks and that the public authority need not evidence use of its Section 9 marks in order to establish the existence of the family of official marks. While I disagree with the decision reached in the *Health Care Employees*

Union case, I cannot conclude that the learned trial judge went so wrong as to preclude my ignoring this decision [see *Canadian Olympic Association v. Express services, Inc.*, 51 C.P.R. (3d) 102]. In the present case, the common characteristic of the opponent's official marks are the initial letters OLYMP and I have concluded that the opponent has submitted evidence relating to the existence of an alleged family of marks comprising these letters. However, as noted above, the state of the register evidence submitted by the opponent significantly reduces any significance which might be accorded such a family of marks.

In view of the above, I have concluded that one would not be likely to mistake the applicant's trade-marks OLYMEL and OLYMEL & Design for any of the opponent's official marks identified above. Consequently, the applicant has met the legal burden upon it in respect of the Sections 12(1)(e) and 9(1)(n)(iii) grounds of opposition in both proceedings and I have therefore dismissed these grounds.

The final ground of opposition in each opposition relates to the alleged non-distinctiveness of the applicant's trade-marks. In each case, the opponent has relied upon its official marks identified above in asserting that the applicant's trade-marks are not adapted to distinguish the applicant's wares and services from the wares and services of others and more particularly the wares and services of the opponent's official marks. However, having rejected the grounds of opposition based on Section 9(1)(n)(iii), I have likewise dismissed the non-distinctiveness grounds of opposition.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's oppositions to application Nos. 678,637 and 711,842 pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 20th DAY OF DECEMBER, 1997.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.