



**OLYMPIC TRADE-MARKS: SEE YOU IN... COURT!**

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The Federal Court of Canada recently granted a judicial review application quashing a decision of the Registrar of Trade-marks to publish notices of official trade-marks. [*See You In - Canadian Athletes Fund Corporation v. Canadian Olympic Committee*, 2007 FC 406 (Phelan, J., April 18, 2007), notice of appeal filed May 17, 2007].

**The Law**

The Canadian *Trade-marks Act* (R.S.C. 1985 c. T-13) contains provisions whereby certain marks are reserved for the exclusive use of governments and certain national and international organisations. For example, marks which would reproduce the Red Cross emblem or the armouries of the Canadian government are prohibited marks in Canada.

Section 9(1)(n)(iii) *Trade-marks Act* also provides that :

9.(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

...  
(n) any badge, crest, emblem or mark

...  
(iii) adopted and used by any public authority, in Canada as an official mark for wares or services,

Organisations which have qualified as “public authorities”, such as the Canadian Olympic Committee, have relied on this provision in order to rapidly obtain the exclusive use of certain marks for the purposes of their activities. Official trade-marks in Canada are regarded as marks with “superpowers” as the process by which they are obtained is fast-tracked and the requirements much less onerous than for a “regular” trade-mark: in fact, an official mark can issue even though it may have been previously used and/or registered by another person in association with similar wares

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or services! Two main requirements must be met by an official mark applicant under Section 9(1)(n)(iii) *Trade-marks Act*: 1) the applicant must be a public authority and 2) it must demonstrate that the mark has been adopted and used at the time of filing of the application.

Once the Registrar of Trade-marks gives public notice of an official mark, there is, in principle, no manner in which a person can request that an official mark be struck from the register.

## The Facts

The Applicant, Canadian Athletes Fund Corporation, exists since 2002. Its main objective is to raise money to support Canadian athletes in international competitions. In 2003, the Applicant filed four trade-mark applications with the prefix “SEE YOU IN ...”, namely as SEE YOU IN ATHENS, SEE YOU IN TORINO, SEE YOU IN BEIJING and SEE YOU IN VANCOUVER.

Approximately ten months later, the Respondent requested that public notice be given in relation to the trade-marks SEE YOU IN TORINO, SEE YOU IN BEIJING and SEE YOU IN VANCOUVER. Two months later, the Registrar of Trade-marks gave public notice pursuant to Section 9(1)(n)(iii) *Trade-marks Act* in the *Canadian Trade-marks Journal* of the adoption and use of the Respondent’s official trade-marks.

The practical effect of the aforementioned public notice by the Registrar is that the Applicant was precluded from obtaining the registration of its four pending trade-mark applications. However, to the extent that the Applicant had used its four trade-marks prior to the public notice, it could continue to use them, but only in association with the same wares and services that it had offered for sale or sold prior to the issuance of the public notice.

Applicant filed an application of judicial review of the decision of the Registrar of Trade-marks on the basis that the Respondent had not fulfilled the legal requirements to obtain the official trade-marks and that the Registrar of Trade-marks has not applied the relevant test in its analysis of the Respondent’s official trade-mark application.

## The Federal Court Judgement

Justice Phelan of the Federal Court of Canada was seized of five sub-issues in order to rule on the application for judicial review, namely:

- “1. Can the Applicant bring forward evidence not before the Registrar?”

2. Can the Court (and should the Court) draw an adverse inference from the COC's failure to answer relevant questions, particularly as to adoption and use?
3. Has the COC adopted and used the COC marks other than as a licensee?
4. Is the COC a licensee (agent or trustee) of the IOC and if it is, has it adopted and used the marks?
5. Is the COC a public authority?"

On the first question, Justice Phelan ruled that in light of the relevant case law, the additional affidavit evidence filed by both the Applicant and the Respondent was admissible and that the application for judicial review should be decided taking into consideration this evidence. In the Court's view, since a public notice of an official trade-mark may curtail third party rights, it would be unfair to prevent these parties from putting forward evidence challenging the decision of the Registrar of Trade-marks since they have no prior ability to participate in the process.

In the present case, the affidavit filed by the Applicant addressed the procedural unfairness of the Registrar's decision and purported to highlight the lack of evidence of adoption and use of the Respondent's official trade-marks.

On the second, third and fourth questions, the Court writes that when the Applicant put in issue the adoption and use of the official trade-marks, the burden then shifts to the Respondent to adduce evidence of such adoption and use. After reviewing the evidence of the Respondent, the Court noted that in its official mark application, only an unsupported assertion by counsel for the Respondent of the adoption and use of the official trade-marks was put before the Registrar. In the Court's view, this would be insufficient to meet the requirements set out in the *Trade-marks Act* and the jurisprudence. In addition, on judicial review, the Respondent had filed only summary affidavit evidence of its adoption and use of the official marks, and on cross-examination, it had not answered any questions relating to the issue of adoption and use of the official trade-marks.

As for the Registrar's initial decision to give public notice of the official marks, the Court stated that the Registrar had gone into great detail in its analysis of the Respondent's public authority status, but that there was no train of inquiry on the issue of adoption and use of the official marks (which as mentioned previously, was limited to a statement by counsel for the Respondent). In Justice Phelan's words:

The potential effect on third parties of the Registrar's decision to publish certainly justifies some better level of diligence.

Justice Phelan determined that the Registrar's decision was therefore unreasonable and the publication of the notice of official trade-marks neither correct nor reasonable. Finally, on the fifth question, the Court noted that the Registrar had engaged in an in-depth review of all of the factors relating to the public authority status of the

Respondent and therefore deference should be given to the Registrar's decision on this issue.

Justice Phelan granted the application for judicial review and quashed the Registrar's decision to publish notices of the official trade-marks.

## Conclusion

Canada continues to maintain its official trade-marks scheme for public authorities, *i.e.* entities who come under the control of government, but Section 9(1)(n)(iii) *Trade-marks Act* continues to generate much controversy .

This judgement highlights the fact that because of the extensive case law that emphasizes an official trade-mark applicant's responsibility to demonstrate that it is a public authority, little attention has been given to the level of evidence required to demonstrate that the official mark has been adopted and used. In this judgement, the Federal Court notes that the Registrar of Trade-marks has also erroneously applied the law by failing to insist on better evidence of adoption and use of the official marks and therefore if the situation is not cured, third party rights may be prejudiced without proper justification.

One of the consequences of this judgment, if it is upheld on appeal, is that official trade-mark applicants will from this point forward have to present more complete records to demonstrate that, not only are they entitled to an official mark because they are a public authority, but also because they have in fact adopted and used the marks for which they seek public notice. This will have as a consequence to increase the costs relating to official trade-mark applications. However, in the overall trade-mark scheme of things, this may be a small price to pay in order to ensure that both the applicant's and third party rights are respected.

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