

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2165204
BY OLYMPIC OILS LIMITED
TO REGISTER A TRADE MARK IN CLASS 29**

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DECISION AND GROUNDS OF DECISION

On 28 April 1998, Olympic Oils Limited, Gaskill Road, Speke, Liverpool, L24 9SG, applied to register a series of 2 marks for a specification of goods of "Oils and fats; cooking oils and fats; corn oil; sunflower oil; groundnut oil; vegetable oil; frying oil; vegetable ghee; coconut oil".

The marks are represented below:

OLYMPIC



Objection was taken to the application under Section 3(5) of the Act on the grounds that the marks consist of, or contain, a specially protected emblem. The first mark consisting of the word "OLYMPIC" and the second mark consisting of the word OLYMPIC in combination with an Olympic torch, both marks being or containing controlled representations within the meaning of the Olympic Symbol etc. (Protection) Act 1995. Objection was also taken to the marks under Section 41(2) of the Act in that they did not constitute a series.

At a hearing, at which the applicants were represented by Mr GWA Johnston of William A Shepherd & Son, their trade mark agents, the objections were maintained. A period of time was allowed for the applicants to approach the proprietor of the Olympic Association Right for permission to use either or both of the marks applied for under the terms of Section 4(5)(b). The outcome would also determine whether the applicants would divide or delete

5 one of the marks to overcome the series objection. In the event, no more was heard and the application was subsequently refused. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

10 Firstly, I turn to the objections under Section 41(2). The agent acknowledged that the marks do not constitute a series but asked that the matter be put in abeyance until the other objections were resolved. Therefore, the issue is not a matter of dispute. The marks will be divided or one deleted if the other objections are overcome.

Turning to the objection under Section 3(5) of the Act, this reads as follows:

15 “3(5) A trade mark shall not be registered in the cases specified, or referred to, in Section 4 (specially protected emblems).”

On 21 September 1995 the Olympic Symbol, etc (Protection) Act 1995 came into force. Section 13 of the Act amends Section 4 of the Trade Marks Act. It reads as follows:-

20 “13(2) In Section 4 of the Trade Marks Act 1994 (which specifies cases where a trade mark shall not be registered) there shall be inserted at the end-

25 “(5) A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc. (Protection) Act 1995 shall not be registered unless it appears to the registrar-

30 (a) that the application is made by the person for the time being appointed under section 1(2) of the Olympic Symbol etc. (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics association right), or

(b) that consent has been given by or on behalf of the person mentioned in paragraph (a) above.” ”

35 It goes on to say at Section 13(3) of the Olympic Symbol Act:

“13(3) This section has effect in relation to applications for registration made on or after the day on which this Act comes into force.

40 A “controlled representation” is defined in the same Act as follows:

“3(1) A person infringes the Olympics association right if in the course of trade he uses -

45 (a) a representation of the Olympic symbol, the Olympic Motto or a protected word, or

(b) a representation of something so similar to the Olympic Symbol or the Olympic Motto as to be likely to create in the public mind an association with it,

5 (in this Act referred to as a “controlled representation”).”

Section 3(1)(a), above, refers to “a protected word”. This is defined at Section 18(2) of this Act as follows:

10 “18(2) For the purposes of this Act each of the following is a protected word, namely, “Olympiad”, “Olympiads”, “Olympian”, “Olympians”, “Olympic” and “Olympics” ”. (My underlining)

15 It seems clear from the above that since the Olympic Symbol Act came into force in 1995 and the trade mark application was not made until 1998 that Section 13(3) of that Act applies and therefore this application is bound by the conditions set out in the Olympic Symbol etc. (Protection Act) 1995. Therefore, evidence of use filed prior to the hearing which showed that the applicants had been using their marks on a significant scale since 1990 is of no assistance. This was pointed out to the applicants prior to the hearing and reiterated to the
20 applicants’ agent at the hearing.

It is clear from the above that the first mark in the series “consists” of a “protected word” which is a “controlled representation”. The second mark “contains” a “protected word” which is a “controlled representation”. As such, both require the consent outlined in Section 4(5)(b)
25 of the 1994 Trade Marks Act (as amended). In the absence of that consent I find that the application is debarred from registration by Section 3(5) of the Act.

In this decision I have considered all the documents filed by the applicant and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it is debarred from
30 registration under Sections 4(5)(b) and 3(5) of the Act.

Dated this 16 day of February 2000

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40 **R A JONES**
For the Registrar
The Comptroller General