

## Trade Marks and Olympic Symbols

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1. It has long been the case that royal and national emblems including flags have received special protection against registration as trade marks.<sup>1</sup> The EU Trade Mark Directive itself permits member states to prohibit registration of marks that are of 'high symbolic value in particular a religious symbol' and 'badges, emblems and escutcheons' of public interest. From the outset, *Trade Marks Act 1994* granted a number of specially protected emblems. protection in this regard under s.4.<sup>2</sup> However, it was not until 1995 that the Olympic insignia were specifically included in the 1994 Act.
2. In 1995, s.4 of the *Trade Marks Act 1994* was amended by the *Olympic Symbol etc (Protection) Act 1995* ('OSPA 1995') which added a new subsection (5). This provides that a trade mark which consists of or contains a controlled representation of Olympic insignia shall not be registered without the consent of the proprietor (currently the British Olympic Association). Section 4 in full reads as follows:

### **Section 4 Specially protected emblems**

- (1) A trade mark which consists of or contains -
  - (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,
  - (b) a representation of the Royal crown or any of the Royal flags,
  - (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or
  - (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.
- (2) A trade mark which consists of or contains a representation of -
  - (a) the national flag of the United Kingdom (commonly known as the Union Jack), or
  - (b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

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<sup>1</sup> Paris Convention for the Protection of Industrial Property 1883(as amended), Art 6 ter.; Trade Marks Act 1938, s.61 and *Trade Marks and Service Marks Rules 1986*, rule 16.

<sup>2</sup> Directive 89/104, Art 3(2).

shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in -

section 57 (national emblems, &c of Convention countries), or  
section 58 (emblems, &c of certain international organisations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains\_

- (a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or
- (b) insignia so nearly resembling such arms as to be likely to be mistaken for them, unless it appears to the registrar that consent has been given by or on behalf of that person.

Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to the laws of arms.

(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

- (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.

Section 5 is applicable to applications made after 20<sup>th</sup> September 1995.<sup>3</sup>

### **Definition of A Controlled Representation**

3. OSPA 1995 created the Olympic Association Right<sup>4</sup> which granted exclusive rights in relation to the use of the Olympic symbol, the Olympic motto and any of the listed protected words which are the singular and plural form of the following: Olympiad(s); Olympian(s) and

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<sup>3</sup> s. 13 (3), Olympic Symbol etc (Protection) Act 1995: "This section has effect in relation to applications for registration made on or after the day on which this Act comes into force" and Art.2 *Olympic Symbol etc (Protection) Act 1995 (Commencement) Order 1995* SI 1995/2472 providing the Act comes into force on 20<sup>th</sup> September 1995.

<sup>4</sup> s. 2, OSPA 1995.

Olympic(s).<sup>5</sup> This includes translations in any language of the Olympic motto or a protected word.<sup>6</sup> The Olympic motto is "Citius, Altius, Fortius" which means Faster Higher Stronger.

### Owner of the Olympic Association Right

4. The Olympic Association Right is exercisable by the person that the Secretary of State has appointed by order made by statutory instrument.<sup>7</sup> The British Olympic Association (a company limited by guarantee) has been appointed as proprietor.<sup>8</sup>

### Registration of Trade Marks

5. The effect of the amendment to s.4 is that from 20<sup>th</sup> September 1995, that any mark that consists of or contains any of the controlled representations cannot be registered unless the application is made by the British Olympic Association or the British Olympic Association has given their consent.

### Trade Mark Registry Works Manual

6. If an application is made to register a mark which consists of or containing controlled indicia, the Works Manual makes clear that examiners will object under s.3(4)(use prohibited by enactment)<sup>9</sup> and s.3(5) (specially protected emblems).
7. The prohibition against registration is absolute under both s.3(5) and s. 4(5) ('shall not be registered'). It is only possible to overcome an objection by obtaining the written consent of

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<sup>5</sup> s.18(2) OSPA 1995.

<sup>6</sup> s.18(3) OSPA 1995.

<sup>7</sup> s.1(2) OSPA 1995.

<sup>8</sup> *Olympics Association Right (Appointment of Proprietor) Order 1995* SI 1995/2473

<sup>9</sup> A trade mark shall not be registered if or to the extent that its use is prohibited in the UK by any enactment or rule of law or any provision of Community law.

the British Olympic Association. The relevant sections of the Trade Mark Registry Works Manual are as follows:

### **38.12.3 Olympic Symbol or Word**

The Olympic Symbol, the Olympic Motto (Citius, Altius, Fortius) and the words Olympic(s), Olympian(s) and Olympiad(s) are protected under the Olympic Symbol, etc (Protection) Act 1995. Protection extends to signs which are sufficiently similar to the Olympic Symbol or the Olympic Motto as to be likely to create in the public mind an association with those signs. Where an application is made consisting of or containing the Olympic symbol or words, examiners should object under Section 3 (4) and Section 3(5) of the Trade Marks Act.

### **38.12.6 Overcoming objections in respect of signs protected under National Legislation**

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Olympic symbol, etc- An objection may be overcome by obtaining the written consent of the British Olympic Association which is the proprietor of the Olympics Association Right. However the British Olympic Association has indicated that it would not normally grant such consent.

## **Cases**

8. There are around 50 marks registered in the UK that include the word 'Olympic' many of which are not owned by the British Olympic Association but all were filed before 20<sup>th</sup> September 1995.<sup>10</sup> These marks include Olympic Airways<sup>11</sup>, Olympic Blinds<sup>12</sup>, the word Olympic for electric razors owned by Hitachi<sup>13</sup>; for milk products owned by Milk Products (N.Z.) Ltd<sup>14</sup>; and for pet food owned by Grain Harvesters Limited.<sup>15</sup>
9. In the UK, application for marks including controlled representations (such as the words Olympic etc.) must be refused unless the consent requirements are met. This is the case even where the applicant can show that he has been using the mark on a significant scale. Conversely, the Office for Harmonisation in the Internal Market ('OHIM') which administers the

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<sup>10</sup> Although cf. Trade Mark No.2202481 'Olympian Consultancy'. Filed and registered in 1999 for personnel recruitment.

<sup>11</sup> Trade Mark No. 1564273. Filed in 1994; Registered in 1997.

<sup>12</sup> Trade Mark No.1292000. Filed in 1986; Registered in 1988.

<sup>13</sup> Trade Mark No. 1321685. Filed in 1987; Registered 1988

<sup>14</sup> Trade Mark No. 1405071. Filed in 1989; Registered 1992.

<sup>15</sup> Trade Mark No. 1513882. Filed in 1992; Registered 1996.

Community Trade Mark Register has on occasion rejected opposition by Olympic Committees and permitted registration of marks that would be absolutely prohibited without consent in the UK.

***Olympic Oils*** (O/081/00)<sup>16</sup>

UK Trade Mark Registry refusing ex parte a 1998 application by Olympic Oils to register word Olympic and with torch device for cooking oils and fats as debarred by s.4(5)(b) and 3(5) TMA 1994.

***Compulympics***<sup>17</sup>

OHIM refusing to register 'Compulympics' in various categories (jewellery, paper, clothing and telecommunications) following opposition by IOC. It was noted that the word 'Olympic' has a double meaning both the modern Olympics and the games of classical antiquity. Applying *Adidas AG v Fitness World Trading Ltd* that it is sufficient if the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the two. The Applicant argued that the mark only contained an association of a tournament and pointed symbolically to the spirit of ancient Olympia. This was rejected as the Applicant had failed to demonstrate that the 'ulympics' suffix would be recognised by consumers as constituting a broad cultural reference to the high ideals of the spirit of Olympia. Rather, the use was likely to take unfair advantage of or be detrimental to the distinctive character and reputation of the earlier mark. By suggesting the concept of Computer Olympics, it immediately added value as it would be easier to remember as whole, being reminiscent of a reputed sign. Overall reputation of the Olympic brand and its advertising value will suffer.

***Family Club Belmont Olympics***<sup>18</sup>

OHIM allowing opposition by IOC to mark 'Family Club Belmont Olympic' for paper and printed matter, advertising and storage of goods. Very similar to the *Compulympics* decision. Use of the word 'Olympic' was likely to take unfair advantage of the Olympic mark and allow the applicant to put into commercial use free of any confinements this word even in connection with average or poor quality goods.

***Astral Olympics***<sup>19</sup>

OHIM allowing registration of 'Astral Olympics' for pumps for swimming pools and water apparatus. The application was opposed by the French National Olympic Committee relying on the mark 'L'Arc Olympique'. The opposition was rejected on the grounds that the two marks were phonetically and visually dissimilar and gave a different overall impression. There was no evidence that the opposition mark enjoyed a reputation in machines or water apparatus and there was no likelihood of confusion or association.

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<sup>16</sup> <http://www.patent.gov.uk/tm/legal/decisions/2000/o08100.pdf>

<sup>17</sup> Decision No. 3461/2004. <http://oami.eu.int/LegalDocs/Opposition/2004/en/3461-2004.pdf>

<sup>18</sup> Decision No. 81/2000. <http://oami.eu.int/LegalDocs/Opposition/2000/en/0081-2000.pdf>

<sup>19</sup> Decision No.301/2001.  
<http://oami.eu.int/LegalDocs/Opposition/2001/en/0301-2001.pdf>

*Vallejo Sobrino Application* (six dots device)<sup>20</sup>

OHIM allowing registration of six black dots for clothing and advertising and rejecting opposition by the Swedish Olympic Committee relying on the Olympic symbol. The graphical features gave rise to a considerably different impact and were not similar in their overall impression. Swedish consumers would not be lead to think there was a common origin between goods and services marketed under the respective signs.

**Infringement of the Olympic Association Right**

10. The Olympic Symbols etc Protection Act 1995 sets out what acts amount to infringement of the Olympic Association Right. The right is infringed by a person who in the course of trade uses:
  - (1) a representation of the Olympic Symbol, the Olympic motto or a protected word or
  - (2) a representation of something so similar to the Olympic symbol or the Olympic motto as to be likely to created in the public mind an association with it.<sup>21</sup>
11. Unlike trade mark infringement, there is no qualification in respect of similar goods or services, all that is required is 'use in the course of trade.' The second limb also shows how wide the protection granted is. All that is required is a 'representation of something so similar to the symbol or motto as to create in the public mind an association with it'. For these purposes a person uses a controlled representation if he:
  - (1) affixes it to goods and packaging;
  - (2) incorporates it in a flag or banner;
  - (3) offers or exposes for sale, puts on the market or stocks for those purposes goods or packaging which bear it;

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<sup>20</sup> Decision No. 2073/2044  
<http://oami.eu.int/LegalDocs/Opposition/2004/en/2073-2004.pdf>

<sup>21</sup> s.3(1), *Olympic Symbol etc (Protection) Act 1995*.

- (4) imports or exports goods which bear it;
  - (5) offers or supplies services under a sign which consists of or contains it or
  - (6) uses it on business paper or advertising.<sup>22</sup>
12. The remedies available are 'all such relief by way of damages, injunctions, accounts or otherwise' as is available in respect of the infringement of a property right.<sup>23</sup> There are also criminal offences created for dealing with intent to gain or to cause loss to another.

### Exceptions

13. There are number of exceptions where the Act deems there is no infringement:
- 1. Use in a literary, dramatic, musical or artistic work, a sound recording or a film (within the meaning of the Copyright Designs and Patents Act 1988) where
    - 1. the user does not intend the work to be used in relation to goods and services in circumstances which would involve infringement of the Olympic Association Right; and
    - 2. provided the use is in accordance with honest practices in industrial or commercial matters.<sup>24</sup>
  - 2. Use in a literary, dramatic, musical or artistic work, a sound recording or a film (within the meaning of the Copyright Designs and Patents Act 1988) where:
    - 1. the use is not in relation to goods or services. In this context, any use in relation to a work about the Olympic Games or Olympic movement is disregarded<sup>25</sup>; and
    - 2. provided the use is in accordance with honest practices in industrial or commercial matters.<sup>26</sup>

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<sup>22</sup> s.3(2) *Olympic Symbol etc (Protection) Act 1995*.

<sup>23</sup> s.6(2) *Olympic Symbol etc (Protection) Act 1995*.

<sup>24</sup> s.4 (1) *Olympic Symbol etc (Protection) Act 1995*.

<sup>25</sup> s.4(4) *Olympic Symbol etc (Protection) Act 1995*. See also s.4(5) use disregarded where work is about the Olympic Games/Movement and the use is not for gain or intent to cause loss.

<sup>26</sup> s.4(2) *Olympic Symbol etc (Protection) Act 1995*.

3. In the case of a protected word, use that does not ordinarily create an association with (a) the Olympic Games/Movement or (b) 'a quality ordinarily associated with the Olympic Games or the Olympic Movement'.<sup>27</sup>
4. In the case of a protected word, use that creates an association with the Olympic Games/Movement where the association fairly represents a connection between the two, provided the use is in accordance with industrial or commercial honest practices.<sup>28</sup>
5. Use in relation to goods/packaging (which are not themselves infringing goods) for the purposes of importing or exporting and offer or supplying services under a sign which contains the representation.<sup>29</sup>
6. Use in relation to goods which have been put on the market in the EEA with the consent of the British Olympic Association and the representation was used when they were put on the market.<sup>30</sup> This exception doesn't apply where there are legitimate reasons for the BOA to oppose further dealings with the goods (eg. quality/condition has been impaired).<sup>31</sup>
7. Use for the purpose of an undertaking where it has been continuously used for that purpose prior to commencement (20<sup>th</sup> September 1995).<sup>32</sup>
8. In the case of protected words, use as part of a company name or use as a business name which pre-dates 20<sup>th</sup> September 1995.<sup>33</sup>
9. Use under a right that subsisted before commencement.<sup>34</sup>
10. Use taking place under a right created by pre-commencement registration of a registered design or a trade mark.<sup>35</sup>
11. Use for judicial or parliamentary proceedings, Royal Commission or statutory inquiry.<sup>36</sup>

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<sup>27</sup> s. 4(6) *Olympic Symbol etc (Protection) Act 1995*.

<sup>28</sup> s.4(7) *Olympic Symbol etc (Protection) Act 1995*.

<sup>29</sup> s. 4(8) *Olympic Symbol etc (Protection) Act 1995*.

<sup>30</sup> s.4(9) *Olympic Symbol etc (Protection) Act 1995*.

<sup>31</sup> s.4 (10) *Olympic Symbol etc (Protection) Act 1995*.

<sup>32</sup> s.4(11) *Olympic Symbol etc (Protection) Act 1995*.

<sup>33</sup> s.4 (12) *Olympic Symbol etc (Protection) Act 1995*.

<sup>34</sup> s.4(13) *Olympic Symbol etc (Protection) Act 1995*.

<sup>35</sup> s.4(14) *Olympic Symbol etc (Protection) Act 1995*.

<sup>36</sup> s.4 (15) *Olympic Symbol etc (Protection) Act 1995*.



## Groundless Threats

14. The Act provides that a person aggrieved by groundless threats of infringement proceedings made by the proprietor (ie. the BOA) may bring an action for relief which includes a declaration that the threats are unjustifiable, an injunction against the continuance of the threats and damages in respect of any loss sustained by the threats. However, this does not apply where the infringement alleged was application to goods/packaging of a controlled representation; importation of goods to which representation had been applied; or the supply of services under a sign which consists of or contains such representation.<sup>37</sup>

## London Olympics Bill

15. The London Olympics Bill was introduced into the House of Commons on 14<sup>th</sup> July 2005. Royal Assent is expected in Spring 2006. Essentially, it puts in place the infra-structure that allows the 2012 Olympics to take place and honours various commitments made to the IOC in the bid. One aspect of the Bill concerns brand protection, makes provision to combat ambush marketing and makes some consequent amendments to the Olympic Symbols etc (Protection) Act 1995. The relevant sections of the Bill are included herewith.

## Proposed Amendments to the Olympic Symbol etc (Protection) Act 1995

16. The existing Olympic Association Right will be widened to make an infringement any use in the course of trade 'a word so similar to a protected word as to be likely to create in the public mind an association with the Olympic Games/Movement'.<sup>38</sup> The Bill also creates the 'Paralympics Association Right' which gives similar rights over the words Paralympics, Paralympiad(s), Paralympian(s) and the motto 'Spirit In Motion'.<sup>39</sup>

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<sup>37</sup> s. 16 (1) *Olympic Symbol etc (Protection) Act 1995*.

<sup>38</sup> Sch 2, para 3, London Olympics Bill.

<sup>39</sup> Sch 2, para 6.

17. The exceptions listed above [currently in s.4(1) - (10)] will be entirely substituted and the only exceptions will be:<sup>40</sup>
- (1) use in the course of publishing or broadcasting a report of a sporting or other event forming part of the Olympic Games or in the course of advertising the same;
  - (2) as an incidental inclusion in an artistic work, sound recording, film or broadcast or advertising anything of this sort;
  - (3) using a protected word in a manner not likely to suggest an association with the Olympic Games/Movement;
  - (4) use in relation to goods put on to the EEA market by the proprietor (BOA) where the representation was used in relation to the goods when they were put onto the market and the proprietor does not oppose further dealings in the goods for legitimate reasons (eg. that condition of the goods has since changed or been impaired).
18. The maximum fine on summary conviction for criminal infringement (under s.8 OSPA 1995) during the period from Royal Assent of the London Olympic Act up until 31<sup>st</sup> December 2012 is increased to £20,000.

### **London Olympics Association Right**

19. The Bill creates the London Olympics Association Right which confers exclusive rights in relation to the use of any visual or verbal representation (of any kind) in a manner likely to create in the public mind an association between the London Olympics and (a) goods or services or (b) a person who provides goods or services.<sup>41</sup>

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<sup>40</sup> Sch 2, para 4.

<sup>41</sup> Sch 3, para 1.

20. The right is infringed by use in the course of trade in relation to goods or services any visual or verbal representation (of any kind) in a manner likely to create in the public mind an association between the London Olympics and (a) the goods or services or (b) a person who provides the goods or services.
21. The Bill deems various combinations of words as likely to create such an association in the absence of evidence to the contrary.<sup>42</sup>

Group 1	Group 2
games	gold
Two thousand and twelve	silver
2012	bronze
twenty-twelve	London
	medals
	sponsor
	summer

22. Combinations deemed likely to create an association are (1) any of the expressions in the first group together with (2) any of the words in the second group or (3) with any other expressions in the second group.

### **Proposed Exceptions**

23. The right is not infringed by:

- (1) use authorised by the London Organising Committee.<sup>43</sup>

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<sup>42</sup> Sch 3 para 3.

<sup>43</sup> Sch 3, para 4.

- (2) use of a trade mark registered under the Trade Marks Act in relation to goods and service for which it is registered.<sup>44</sup>
- (3) use by a person of his own name or address provided use is in accordance with honest commercial practice.<sup>45</sup>
- (4) use concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services or other characteristics of goods or services. (provided use is in accordance with honest commercial practice).<sup>46</sup>
- (5) use of a representation in the course of publishing or broadcasting a report of a sporting or other event forming part of the London Olympics.<sup>47</sup>
- (6) use in relation to goods put on to the EEA market with the authorisation of the London Organising Committee where the representation was used in relation to the goods when they were put onto the market and the LOC does not oppose further dealings in the goods for legitimate reasons (eg. that condition of the goods has since changed or been impaired).<sup>48</sup>

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<sup>44</sup> Sch 3, para 6.

<sup>45</sup> Sch 3, para 7 (a).

<sup>46</sup> Sch 3, para 7 (b).

<sup>47</sup> Sch 3, para 8.

<sup>48</sup> Sch 3, para 9.

### Some Further Reading

*Stop the Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112(S.D.N.Y 1980)

*San Francisco Arts & Athletics Inc v US Olympics Committee* 483 U.S. 522 (1987).

*New Zealand Olympic and Commonwealth Games Association Inc v Telecom New Zealand*[1996] FSR 757

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