IN THE MATTER OF AN OPPOSITION
by Hollywood Chamber of Commerce to
application No. 777,650 for the trade-mark
HOLLYWOOD VIDEO & Design filed by
Hollywood Entertainment Inc.

The applicant, Hollywood Entertainment Inc., filed an application to register the trade-mark HOLLYWOOD VIDEO & Design based on proposed use in Canada for the following services:

> **retail sales and rental of audio cassettes, audio-video cassettes, laser discs, floppies and computer software, computers, printers, computer keyboards, modems, computer glare shields and computer accessories.**

The application was amended to include a disclaimer to the words HOLLYWOOD and VIDEO and was subsequently advertised for opposition purposes on December 6, 1995.

The opponent, Hollywood Chamber of Commerce, filed a statement of opposition on May 6, 1996, a copy of which was forwarded to the applicant on May 17, 1996. The first ground of opposition is that the applicant's application does not comply with Section 30(e) of the Trade-marks Act because the applicant did not intend to use the applied for trade-mark itself or through an authorized licensee. The second ground of opposition is that the applicant's application does not comply with Section 30(i) of the Act in view of the prior use and making known of the opponent's marks in Canada. In further support of this ground, the opponent alleged that the applicant's trade-mark is an infringement of the opponent's copyright in its "HOLLYWOOD Designs."

The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is deceptively misdescriptive of the place of origin of the services. The fourth ground is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with a series of trade-marks comprising or including the word HOLLYWOOD previously used or made known in Canada by the opponent. The fifth ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Kathy Roy. The applicant did not submit evidence. Only the applicant filed a written argument and no oral hearing was conducted.

In her affidavit, Ms. Roy identifies herself as a secretary with the firm representing the opponent. The Roy affidavit serves to introduce into evidence dictionary definitions for the word HOLLYWOOD which indicate that it is a district of the city of Los Angeles and was once the center of the film industry in the United States. Also appended to the Roy affidavit are copies of maps illustrating the location of Hollywood.

As for the first ground of opposition, there was an initial burden on the opponent to adduce evidence in support of its allegation that the applicant did not intend to use its trade-mark in Canada. Since the opponent failed to submit evidence on point, the first ground is unsuccessful.

As for the first aspect of the second ground, it is not in compliance with Section 38(3)(a) of the Act and therefore fails to raise a proper ground of opposition. The mere fact that the opponent may have previously used or made known its marks in Canada does not, by itself, preclude the applicant from making the statement required by Section 30(i) of the Act. The opponent did not even allege that the applicant was aware of the opponent's marks.

As for the second aspect of the second ground of opposition, it also is not in compliance with Section 38(3)(a) of the Act because the opponent failed to adequately identify the "HOLLYWOOD Designs" relied on. Even if properly pleaded, however, the ground would have been unsuccessful since the opponent failed to file evidence establishing that the opponent owned copyright in Canada in any designs.

As for the third ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of

Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the services. Furthermore, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

Assuming the applicant's services do not originate from Hollywood, California, it is necessary to consider whether or not the applicant's trade-mark is deceptively misdescriptive of the place of origin of the services. At page 186 of the Atlantic Promotions decision, Cattanach, J. commented as follows regarding the test for ascertaining whether a trade-mark is deceptively misdescriptive of the place of origin:

> **In my view the proper test to be applied to the determination as to whether a trade mark in its entirety is deceptively misdescriptive must be whether the general public in Canada would be misled into the belief that the product with which the trade mark is associated had its origin in the place of a geographic name in the trade mark.**

In the present case, there is no evidence that the average user of the applicant's retail sales and rental services in Canada would be aware that Hollywood is known as a source of such services. In fact, there is no evidence that Hollywood is, in fact, even a source of such services. At most, the opponent's evidence establishes that Hollywood was once the center of the United States film industry. Thus, even if the average Canadian consumer was aware of the existence of Hollywood, there is no evidence suggesting that he might be misled by the applicant's trade-mark into the belief that the applicant's services have their place of origin in Hollywood. As a result, the applicant's trade-mark HOLLYWOOD VIDEO & Design is not deceptively misdescriptive of the place of origin of its services and the third ground of opposition is unsuccessful.

As for the fourth ground of opposition, the opponent has failed to evidence use or making known of any of its trade-marks prior to the applicant's filing date. Thus, the fourth ground is also unsuccessful.

As for the fifth ground of opposition, the opponent has failed to evidence use of its trade-marks in Canada at any time and has failed to evidence any reputation for those marks in Canada. Thus, the opponent has failed to meet its initial evidentiary burden and the fifth ground is also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 21st DAY OF NOVEMBER, 1997.

David J. Martin,
Member,
Trade Marks Opposition Board.