

**IN THE MATTER OF AN OPPOSITION
by G4S Cash Services (UK) Limited and
Group 4 Securicor plc to application No.
1,144,577 for the trade-mark
SECURICORE in the name of Securicore
Inc.**

On June 27, 2002, Rahul Narsimhan filed an application to register the trade-mark SECURICORE (the “Mark”). The application was initially based upon proposed use of the Mark in Canada in association with the following wares and services:

Computer hardware; computer software used for anti-virus, database encryption, file and email encryption, intrusion detection, firewall and enterprise information technology security monitoring.

Monitoring and management of firewalls; implementation and monitoring of network intrusion detection systems, consulting services related to network availability and security.

The application was advertised for opposition purposes in the Trade-marks Journal of February 25, 2004.

On April 26, 2004, Securicor Cash Services Limited (the “Original Opponent”) filed a statement of opposition against the application. Mr. Narsimhan filed and served a counter statement, in which he denied the allegations contained in the statement of opposition.

An affidavit of Sean O’Brien was filed pursuant to r. 41 of the *Trade-marks Regulations (1996)*.

An affidavit of Rahul Narsimhan was filed pursuant to r. 42. Mr. Narsimhan was cross-examined on his affidavit. A copy of the transcript of the cross-examination and the answer to an undertaking given form part of the record.

An affidavit of Leslie Murray was filed pursuant to r. 43.

By letter dated July 25, 2006, the Trade-marks Opposition Board advised that a request for leave

to file a supplemental affidavit of Rahul Narsimhan under r. 44(1) would not be considered.

On September 21, 2006, an assignment was recorded that transferred the Mark and its application to Securicore Inc. Both Rahul Narsimhan and Securicore Inc. will hereafter be referred to as the “Applicant”, depending on the point of time being referenced.

By letter dated October 12, 2006, the Trade-marks Opposition Board granted leave to amend the statement of opposition to identify the opponent as G4S Cash Services (UK) Limited and Group 4 Securicor plc. Apparently the Original Opponent changed its name to G4S Cash Services (UK) Limited and the Canadian trade-mark registrations relied upon in this opposition were subsequently acquired by Group 4 Securicor plc. G4S Cash Services (UK) Limited and Group 4 Securicor plc will hereafter be collectively referred to as the “Current Opponent”, while the term “Opponent” will be used to refer collectively to both the Original Opponent and the Current Opponent.

Each party filed a written argument and was represented at an oral hearing.

Immediately prior to the oral hearing, the Applicant sought leave to file a further affidavit of Mr. Narsimhan. Leave was denied at the oral hearing and subsequently confirmed in writing by letter dated October 23, 2007.

Shortly after the oral hearing, the Applicant applied to amend the statement of wares in its application. As set out in the Office Letter of October 23, 2007, the statement of wares now reads:

Computer hardware used for anti-virus, anti-spam, database encryption, file and email encryption, intrusion detection, firewall and enterprise information technology security monitoring; computer software used for anti-virus, database encryption, file and email encryption, intrusion detection, firewall and enterprise information technology security monitoring.

Summary of O'Brien Evidence

At the time of his affidavit (January 4, 2005), Mr. O'Brien was the Vice-President, Sales and Marketing of Securicor Canada Limited. Mr. O'Brien attests that the Original Opponent entered into a trade-mark licence agreement with Securicor Canada Limited effective April 26, 2000, pursuant to which it had direct or indirect control of the wares and services provided in Canada by Securicor Canada Limited under the terms of the licence.

Mr. O'Brien employs the term "Securicor" in his affidavit to collectively refer to Securicor Canada Limited and the Original Opponent, which results in some ambiguity.

Mr. O'Brien attests:

- "Securicor, a division of Group 4 Securicor plc, is a global leader offering security solutions operating in one hundred countries worldwide."
- "Securicor is an industry leader in the cash logistics, manned guarding and justice services market."
- In early 2000, Securicor entered the Canadian marketplace with the purchase of a major cash services provider.

Presumably he is referring to the Original Opponent in these statements.

Mr. O'Brien provides as Exhibits A certified copies of the two registrations relied upon in these proceedings, TMA484019 and TMA562712.

As Exhibit B, Mr. O'Brien provides advertising and promotional literature describing the Opponent's services. These materials are as follows:

- undated pages from the website www.armoreduniverse.com,
- one page from the website www.armoreduniverse.com dated 1/5/2005,
- undated ads that indicate that Securicor is a sponsor of Kids Help Phone,
- an ad for SECURICOR security services that appears to have existed as of 3/2/2004, and
- undated ads for SECURICOR financial security and cash logistics services.

Mr. O'Brien states that Securicor undertakes advertisement and promotional endeavours to

generate the awareness of the mark SECURICOR and he lists various Canadian publications, conferences and events used to this end. He does not however indicate when these activities took place or the exposure that any of these promotions would have received. He does provide as Exhibit D copies of representative ads and advises, "Securicor's advertising/promotional expenditures are approximately \$250,000 annually." Given the ambiguity of the latter statement, I am not prepared to accept that all of the \$250,000 necessarily relates to Canada; nor can I determine what years, other than perhaps that immediately preceding the date of his affidavit (2005), the annual expenditures are meant to relate to.

Mr. O'Brien has informed us that Canadian sales of services have exceeded one hundred million dollars in each of the fiscal years 2001 through 2003 and he provides representative invoices, each of which display the SECURICOR trade-mark.

Summary of Narsimhan Evidence

Mr. Narsimhan is the founder, Director and President of Securicore Inc. He states that Securicore Inc. is a registered value added reseller for a number of vendors whose products are relevant to and only used in Internet and computer network security.

It is to be noted that Mr. Narsimhan's affidavit was executed on January 29, 2005, when he was still the owner of the present application. Although he identifies himself as the "Applicant" in his affidavit, he then proceeds to refer to the materials that he has provided as being those of the Applicant, despite the fact that the materials refer to Securicore Inc., rather than to him. Such materials include the following:

- Exhibit D: parts of the Applicant's website, which bear a copyright notice of 2002-2004 and refer to Securicore Inc. (the Mark is displayed in the top right-hand corner of each page)
- Exhibit E: a representative list of Securicore Inc.'s customers and copies of invoices pertaining to wares and/or services sold to them, all dated 2004 (the Mark is displayed at the top of the invoices; the total value of the eleven invoices is about \$46,000)
- Exhibit F: a screen print of advertising on the Internet, which refers to www.securicor.ca, not to the Mark

On cross-examination, the information elicited included the following:

- Mr. Narsimhan has never used the Mark and there is nothing in writing whereby he allowed Securicore Inc. to use the Mark; Question 27 is reproduced below:

Q. And to date there is nothing in writing whereby you allow Securicore Inc. to use the mark?

A. Well, it is given because it is purely for company purposes that I am using. So, the company is using the mark. I am not using it for any personal. [sic]

According to Question 58, Mr. Narsimhan is the only employee of Securicore Inc.

- The Applicant's customers "are anybody, it doesn't matter whether they are in a public sector, financial, healthcare; everybody who has a computer network is a potential customer of mine". (Question 56)
- The Applicant's list of representative customers lists more than 200 clients. (Question 76)
- The Opponent and the Applicant have a common client, DirectCash ATM. (Question 148)
- Thousands of individuals have accessed the Applicant's website. (Question 204)

Summary of Murray Evidence

Ms. Murray's evidence relates to an incident where a supplier of marketing and design services incorrectly referred to the Original Opponent as Securicore, rather than Securicor. This evidence was filed in response to Mr. Narsimhan's cross-examination, wherein he advised that he first became aware of the Original Opponent when he inappropriately received an invoice from this supplier.

Onus

An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"). There is however an initial burden on an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Grounds of Opposition

The Opponent has pleaded four grounds of opposition, each of which turns on the issue of the likelihood of confusion between the Mark and the Opponent's mark SECURICOR, which the Opponent pleads it has previously used and registered in Canada in association with the following wares and services:

TMA484019

Wares:

Burglar alarms; fire alarm equipment, namely, fire alarms, fire detectors; intruder alarm equipment, namely, intruder alarms; CCTV equipment, namely, close circuit TV surveillance and monitoring apparatus; property access control apparatus; electric locks; mobile and point-to-point radio equipment, namely, vehicle mounted and hand-portable mobile radio transceivers, point-to-point fixed radio transceivers and data multiplexers, base-station transceivers, radio frequency power amplifiers and transmitters; letter-bomb detectors; watchmen's clocks; personal and baggage explosive detectors; electric typewriters; public address systems; safes and cash boxes; time clocks; cars and trucks; printed matter namely periodicals; books and booklets; instructional and teaching manuals with respect to security-related subjects.

TMA562712

Services:

- (1) Advertising, import and export agency, offset printing, document shredding and telephone answering services; services for the rental of office machinery and for the distribution of prospectuses; locating vehicles and goods by computer; maintenance of archives; preparation of pay packets.
- (2) Insurance and safe deposit services; leasing of real estate property; issue of traveller's cheques; the secure storage of cash and other valuables; the counting and checking of cash and credit services on behalf of financial institutions and depositors.
- (3) Cleaning of buildings and of windows; installation and repair of alarms; installation, maintenance and repair of telecommunications apparatus; maintenance and repair of safes and of strongrooms; rental of warm air hand and hair dryers; installation, maintenance and repair of alarms and of monitoring, checking and controlling apparatus and instruments; maintenance and servicing of security cards, alarms, fire alarm systems and of automated teller machines; custom construction of vehicle bodies; fitting of armour plating to vehicles.
- (4) Message sending, telephone and radio communication and broadcast transmission services; consultancy services relating to telecommunications; transfer of information or data by radio or telephone.
- (5) Guarded transportation of valuables, delivery of goods after transportation, rental of strongrooms, rental of vehicles and the booking of seats for travel; consultancy services relating to transportation and to storage; agency services for arranging travel; armoured vehicle transport services; courier services for the delivery of goods; transportation of

goods by air and land; arranging the transportation of goods by land, sea and air; supply of office equipment; storage of archives.

(6) Animal training services; training services relating to the use of fire fighting equipment, to security apparatus and to the carrying out of searches; rental of video cassette tapes and of sound recordings; training of personnel in management, finance, security, security systems, transportation, storage, guarding, office services, distribution, cleaning, installation and repair, message sending, radio communications, broadcasting, booking courier services, editing, duplicating, metal plating, interior designing, and interior garden landscaping, provision and supply of tickets; record master production; archive library services; recording studio services.

(7) Security guard and patrol, lithographic printing, alarm and electronic surveillance monitoring services; care and rental of potted plants; rental of clothing, of soap dispensers and of towel dispensers; consultancy services relating to security, to computers, to information technology and to interior design relating to plants and interior garden landscaping

The grounds of opposition are as follows:

1. non-compliance with s. 30(i) in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant had knowledge of the use of the Opponent's confusingly similar trade-mark when it filed its application;
2. non-registrability under s. 12(1)(d) based on the Opponent's registrations Nos. TMA484,019 and TMA562,712 both for SECURICOR, for the aforementioned wares and services;
3. non-entitlement under s. 16(3) due to confusion with the Opponent's previously used SECURICOR mark;
4. non-distinctiveness because the Mark does not actually distinguish, and is not adapted so as to distinguish, the Applicant's wares and services from the Opponent's wares and services.

I will first address the registrability ground of opposition.

Section 12(1)(d) Ground of Opposition

The material date with respect to this ground of opposition is today's date. [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]

As the Opponent's registrations are in good standing, the Opponent has met its initial burden. I

note that the registrations issued in the name of Securicor Cash Services Limited but that a change of ownership in favour of G4S Cash Services (UK) Limited was recorded on October 21, 2005. On July 25, 2006, a further change of ownership in favour of Group 4 Securicor plc was recorded.

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion.]

I shall now assess each of the surrounding circumstances.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Both SECURICORE and SECURICOR suggest that their associated wares and services will provide the user with security. Given that the two marks are almost identical, neither has an advantage with respect to inherent distinctiveness.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. In this regard, it appears that the Opponent has the upper hand. It has offices

across Canada and has generated more than 100 million dollars in the sale of services in each of the years 2001 through 2004. Its trade-mark appears at the top of its invoices and it appears to actively promote its services in association with its mark. On the other hand, the Applicant has only a single office and appears to promote its services primarily on the Internet. The evidence concerning the volume of the sales or promotions conducted in association with its Mark is that there were sales of about \$46,000 in 2004, the Applicant has about 200 clients, and there have been thousands of hits on its website.

s. 6(5)(b) - the length of time each trade-mark has been in use

The Opponent claims use of its mark SECURICOR in Canada since at least 2001. The application indicates that the Applicant was not using its Mark as of June 27, 2002, but it appears that use commenced shortly thereafter.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

This is a contentious factor in the present case, the Opponent arguing that the parties' wares/services overlap and the Applicant arguing that they are very different.

The Opponent describes itself as "a global leader offering security solutions... an industry leader in the cash logistics, manned guarding and justice services market". It states that it is Canada's premier financial security services provider and that it provides a wide range of cash solutions, including:

- cash transportation;
- cash processing;
- deposit consolidation;
- cash centers
- coin management
- ABM management
- valuable transport.

(O'Brien affidavit, paragraphs 2 and 5)

The Opponent's registrations are not based on use of its mark in Canada but on use and

registration in the United Kingdom and cover a broader range of wares and services than those referred to above. In *Unisys Corp. v. Northwood Technologies Inc.* (2002), 29 C.P.R. (4th) 115 at paragraph 19, I summarized the case law regarding the interpretation of statements of wares and services as follows:

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in the application or registration at issue [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optical Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

I summarize some of the Opponent's submissions concerning the relationship between the parties' wares and services as follows:

- the Opponent's mark is a house mark for a portfolio of services
- services evolve with customers' needs
- the Opponent markets itself as a complete security provider
- ABMs are connected to database networks whereby data flows
- the Applicant's wares/services are at most a small step from the Opponent's existing activities
- the parties' target clients overlap
- there is no credence to an argument that the Applicant's clients are necessarily sophisticated, since virtually every company with a computer network is a potential client of the Applicant
- the Applicant is using its Mark only with services, not with wares, as it is a vendor of third party wares that are sold under the suppliers' trade-marks

I summarize some of the Applicant's submissions concerning the relationship between the parties' wares and services as follows:

- the Opponent’s registered wares and services should be read in context; the reference to “consultancy services relating to security, to computers, to information technology” in the services identified as (7) in registration TMA562,712 could be referring to the use of computers by security guards
- there is no evidence that the Opponent provides IT services
- the parties are in completely different trades
- the Opponent’s services are very hands on whereas the Applicant can provide its services remotely
- the physical security items covered by registration TMA484,019 represent the Opponent’s essential business
- the Applicant typically deals with the IT technical individuals at a client company, due to the technical nature of its wares and services

I agree with the Applicant that it does not appear that the Opponent at present offers services of the type that are being offered by the Applicant. However, the Opponent’s registration No. TMA562,712 does include “maintenance and repair of telecommunications apparatus ... consultancy services relating to telecommunications ... consultancy services relating to security, to computers, to information technology” and these appear to overlap with some of the services applied for by the Applicant, in particular “consulting services related to network availability and security”.

Regarding the parties’ wares, it is noted that the Opponent’s registration covers intruder alarm equipment while the Applicant’s application covers computer hardware and software used for intruder detection.

Of course, it is to be remembered that s. 6(2) of the Act indicates that use of a trade-mark may cause confusion with another trade-mark whether or not the wares or services are of the same general class.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The two marks are essentially identical; the extra e on the end of the Applicant's Mark does not serve to differentiate its Mark from the Opponent's mark in appearance, sound or idea suggested.

In its written argument, the Applicant states, "The degree of resemblance between his applied for mark and the opponent's Marks is due to the common use of the descriptive portion SECUR or SECURI." This statement totally disregards the fact that the marks share more than that, they share the entire four syllables SECURICOR. Overall, the Applicant would appear to be arguing that the Opponent ought not to be able to monopolize the use of the ordinary, descriptive word SECURITY. I do not disagree with that general proposition but it is not the word SECURITY that is at issue here, nor is it simply the prefix SECURI; the marks are SECURICOR and SECURICORE, two very similar invented words. I further note that there is no evidence that similar marks have been adopted by third parties.

other surrounding circumstances

There is evidence that a U.S. marketing company, which was providing services to the Opponent, incorrectly sent an invoice to the Applicant. However, this is not evidence of actual confusion between the two parties' trade-marks. It is merely an instance of error, and certainly not an error as to source. I note that the company in question was neither a client of the Opponent, nor a Canadian company.

The Applicant's written argument includes submissions concerning the state of the Register but no evidence has been filed to support such submissions. The Registrar will not exercise her discretion to check the Register in circumstances such as the present one. [For two circumstances in which the Registrar will exercise such discretion, see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.) and *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.)]

conclusion re likelihood of confusion

Having considered all the surrounding circumstances, I conclude that the Applicant has not satisfied its onus. In particular, I find that it is more probable than not that an ordinary consumer, with an imperfect recollection of the Opponent's SECURICOR mark, would be likely, as a matter of first impression, to conclude that the SECURICORE services and wares covered by the Applicant's application are somehow associated with the provider of the SECURICOR services and wares. I have reached this conclusion primarily because of the very high degree of resemblance between the two marks and the fact that both parties are engaged in providing security services, in one form or another, to the market at large. In addition, there is no evidence that the scope of protection to which the Opponent's mark is entitled has been restricted by third party use of similar marks.

Section 16(3) Ground of Opposition

With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16]. The Opponent has not shown that its mark was in use in Canada prior to June 27, 2002, as per s. 4 of the Act. Mr. O'Brien does state that the Opponent entered the Canadian market in early 2000 and he does provide sales figures for 2001 but he does not make it clear that any of the materials that display the mark provided by him relate to a time before June 27, 2002. This ground is accordingly dismissed.

Distinctiveness Ground of Opposition

In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. The Opponent's evidence satisfies its initial burden given that Mr. O'Brien has provided invoices that display the Opponent's mark, which predate the filing of the opposition.

This ground of opposition differs from the registrability ground of opposition in several ways. First the material date is more than three years earlier. Second, the wares or services of the Opponent to be considered are significantly narrower since the ground can only be based upon those wares/services for which the Opponent had acquired a reputation in Canada as of April 26, 2004. Therefore my analysis of the likelihood of confusion necessarily differs with respect to the factors listed in s. 6(5)(a) and (c).

Regarding the extent to which the Opponent's mark had become known as of April 26, 2004, we have Mr. O'Brien's statement that revenues generated by the sale of the Opponent's services in Canada exceeded \$100 million in each of the three preceding fiscal years. These sales may have been restricted to armoured car services and coin processing (according to the invoices provided). The only ad that predates April 26, 2004 promotes the Opponent as providing security services, in particular in the field of cash logistics. So the question becomes whether the Opponent's use of SECURICOR in this particular field impacts on the ability of the Applicant's Mark to be distinctive with respect to its applied for wares and services. Although the Opponent's case is weaker in this regard than it is with respect to its registrability ground of opposition, I still find that the Applicant has not met its legal onus with respect to the distinctiveness ground of opposition.

The Opponent has argued that the distinctiveness of the Mark has also been affected by the fact that the individual Mr. Narsimhan owned the Mark before 2006 but the company Securicore Inc. was using the Mark, without a license being in place. I will not however deal with this s. 50 argument any further in view of the conclusions already set out.

Section 30(i) Ground of Opposition

This ground of opposition fails for two reasons: i) the Opponent has not evidenced that the Applicant was aware of the Opponent's prior rights when it filed this application (in fact the cross-examination of Mr. Narsimhan elucidated evidence to the contrary); and ii) where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [See *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155.]

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 7th DAY OF NOVEMBER 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board