



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 52
Date of Decision: 2011-03-24

**IN THE MATTER OF AN
OPPOSITION by RSA Security
Inc. to application No. 1,245,903
for the trade-mark SECURIDENT
in the name of Cryptometrics
Canada Incorporated**

FILE RECORD

[1] On February 3, 2005, BioDentity Systems Corporation filed an application to register the trade-mark SECURIDENT, based on use of the mark in Canada since at least as early as November 1999 on the services listed below and since at least as early as June 19, 2001 on the wares listed below:

services

consultation services, research and development services, design services, manufacturing services, supply services, hardware and software integration services, installation services, training and support services, advertising and promoting the goods and services of others, and sales of wares for others, **all in association with machine-assisted biometric identification systems**, namely service delivery systems, security and protection systems, access control systems, surveillance systems, identification card and document personalization systems, identification card and document inspection and authentication systems, and personal identification systems all using automated capture and recognition of human characteristics and/or behavioral traits to establish or confirm the identity of persons and/or to determine the rightful holder of an identification card or document.

(emphasis added)

wares

(1) machine-assisted **biometric identity confirmation systems** comprised of cameras and lighting devices for taking pictures, and/or image scanners, and/or fingerprint scanners, and/or iris scanners, and/or range finders, and/or presence detection sensors, and computer hardware and computer software for automated capture and recognition of human characteristics and/or behavioral traits to establish or confirm the identity of persons and/or to determine the rightful holder of an identification card or document.

(2) machine-assisted service delivery systems, protection and security systems, and access control systems, all comprised of cameras and lighting devices for taking pictures, and/or image scanners, and/or fingerprint scanners, and/or iris scanners, and/or range finders, and/or presence detection sensors, and computer hardware and computer software for the automated capture and recognition of human characteristics and/or behavioral traits to establish or confirm the identity of persons, and where required, to confirm a match with the human characteristics and/or behavioral traits recorded on an identification card or document or in a database to determine the rightful holder of an identification card or document.

(3) automated camera systems for use in machine-assisted **biometric identification systems**, service delivery systems, security and protection systems, access control systems, surveillance systems, identification card and document personalization systems, identification card and document inspection and authentication systems, and personal identification systems, all comprised of cameras and lighting devices for taking pictures, and/or image scanners, and/or fingerprint scanners, and/or iris scanners, and/or range finders, and/or presence detection sensors, and computer hardware and computer software for the automated capture and recognition of human characteristics and/or behavioral traits to establish or confirm the identity of persons and/or to determine the rightful holder of an identification card or document.

(4) computers and computer software for clearing passengers crossing international borders.

(5) computers and computer **software for enrolling biometric details** on persons.

(6) computers and computer software for identity verification, namely confirming a person's identity by **comparison of the person's biometric data** to biometric data stored on an identification card or document or in a database.

(7) computers and computer software for identity fraud detection, namely **comparing a person's biometric data** to biometric data stored in a database to determine if the biometric data matches more than one person.

(8) computers and computer software for watch-list identity detection, namely **comparing a person's biometric data** to biometric data of

individuals stored in a watch-list database and identifying potential matches.

(9) communication software for use in electronic communication, namely electronic communication of information, data, audio and images via a global communication network, via an intranet or local area network, via a wide area network, via wireless electronic communication, via telephone, via radio, via microwave transmission, and via satellite transmission.

(10) computers and computer software for storing, maintaining and retrieving information through local and wide area computer networks and via global computer networks.

(emphasis added)

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 23, 2007 and was opposed by RSA Security Inc. on February 25, 2008. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on March 27, 2008, as required by s. 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. During the course of this proceeding the name of the applicant was changed to Cryptometrics Canada Incorporated.

[3] The opponent's evidence consists of the affidavit of Samuel J.J. Curry, with Exhibits 1 to 23. The applicant elected not to file any evidence in support of its application. Only the opponent filed a written argument. Neither party responded to the Registrar's notice dated January 28, 2010, to schedule an oral hearing. Thus, the disposition of this proceeding has been determined without the benefit of oral argument from either party.

STATEMENT OF OPPOSITION

[4] Various grounds of opposition are pleaded in the statement of opposition, including the allegations that (i) the applied for mark SECURIDENT is not registrable, pursuant to s.12(1)(d) of the *Trade-marks Act*, because it is confusing with the opponent's registered mark SECURID and (ii) the applicant is not entitled to register the applied for mark SECURIDENT, pursuant to s.16(1)(a) of the *Act*, because at the material dates November 30, 1999 and June 19, 2001, it was confusing with the

opponent's mark SECURID previously used in Canada. The opponent's registration for the mark SECURID covers the wares "non-predictable code calculator for accessing a host data bank computer."

OPPONENT'S EVIDENCE

Samuel J.J. Curry

[5] Mr. Curry identifies himself as the Vice President of Products and Strategy for the opponent company. The opponent RSA is a provider of security solutions to over 20,000 companies, institutions and government agencies worldwide. The opponent protects information assets using cryptology and access control and identity authentication technologies. The opponent sells authentication hardware and software to help clients authenticate the identities of users interacting with the client's data, applications and devices to prevent unauthorized access. One product line is sold under the brand SECURID, although the mark is usually employed in the mixed upper and lower case form "SecurID."

[6] The opponent will provide consulting, design, implementation and training for support services relating to its security products, including its SECURID product. The SECURID product requires individuals to identify themselves with two factors namely, a code generated by hardware or software and a secret personal identification number. Other factors such as biometrics can be added to the SECURID product to increase the layers of authentication. The opponent has added fingerprint identification as a biometric, as announced by the opponent in a press release on June 19, 2003, included as Exhibit 6 to Mr. Curry's affidavit:

RSA Security will integrate . . . fingerprint identification technology with RSA SecurID Passage smart card software and the RSA SecurID USB Token to enable strong protection and validation of a user's identity based on a biometric.

A press release in 2005 (included as Exhibit 7) announced a joint research collaboration with a third party to integrate biometric bone-scanning technology into the opponent's SECURID product. A press release in 2006 (included as Exhibit 11) describes a telephone authentication product based on live voice biometrics developed and sold by the opponent.

[7] The opponent has been selling its SECURID hardware and software in Canada since the 1980s' and by 1998 the opponent had sold its SECURID product to over 700 customers. As of February 2009 the opponent had sold its SECURID product to about 2,000 Canadian customers at about 4,500 locations. The opponent markets its SECURID product through an employee sales force and a network of over 80 product resellers, solutions providers, consultants and distributors across Canada. Sales of the SECURID product in Canada averaged \$12.5 million US annually in the four year period 2005 - 2008. Paragraphs 29 – 38 of Mr. Curry's affidavit describe how the opponent advertises and promotes its SECURID product through print media, press releases, trade shows, conferences, seminars and the like.

[8] After reviewing the trade-mark application which is the subject of this proceeding and the applicant's website (attached as Exhibit 22), Mr. Curry concludes that "RSA and Cryptometrics Canada are in the same security business." I note that part of Exhibit 22 reads as follows:

Our SecurIDTM face recognition products are unique in their ability to track and recognize multiple faces in one image in real time, without the active participation of subjects under surveillance. And our FingerSURETM fingerprint recognition products provide added layers of security, requiring users to authenticate their identity via finger print analysis, protecting access to computer systems and sensitive data.

Exhibit 23 of Mr. Curry's affidavit provides a further example of the applicant using the applied for mark SECURIDENT in the form "SecurIDent," that is, with both lowercase and uppercase letters similar to the opponent's form of use if its mark (see paragraph 5, above).

MAIN ISSUE AND LEGAL ONUS

[9] The main issue in this proceeding is whether the applied for mark SECURIDENT is confusing with the opponent's mark SECURID. The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability: see *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) 413 at 424 (F.C.A.); (ii) the dates of claimed first use of the

mark, in this case November 30, 1999 and June 19, 2001, with respect to the ground of opposition alleging non-entitlement: see s.16(1) of the *Trade-marks Act*.

[10] The legal onus is on the applicant to establish, on a balance of probabilities, that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark SECURIDENT and the opponent's mark SECURID:

The 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 . . . sold . . . or performed by the same person, whether or not the wares or services are of the same general class.

Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's wares and services sold under the mark SECURIDENT as being provided by or endorsed by the opponent.

SECTION 6(5) FACTORS

[11] Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

Consideration of s.6(5) Factors

[12] The opponent's mark SECURID possesses relatively little inherent distinctiveness in relation to the opponent's wares and services as the mark would be understood to mean "secure ID" or "secure identification." Similarly, the applied for mark SECURIDENT

possesses relatively little inherent distinctiveness. I infer from Mr. Curry's evidence of sales and advertising that the opponent's mark had acquired a fair reputation in Canada at all material times. Given the absence of evidence from the applicant, I cannot infer any more than a minimal reputation for its mark SECURIDENT at any material time. The length of time that the marks in issue have been in use favours the opponent, as the opponent's use of its mark SECURID predates the applicant's use of its mark SECURIDENT by about 19 years.

[13] I do not accept Mr. Curry's conclusion (see paragraph 8, above) that the opponent and the applicant "are in the same security business." It appears to me, from the evidence of record, that the parties' are in related businesses, and that persons interested in the applicant's security wares and services would likely also be interested in the opponent's products. However, it does not follow that the converse is true. That is, it appears less probable that persons interested in the opponent's products would also be equally likely to be interested in the applicant's products. However, it appears likely that there will be some overlap in the parties' businesses and their channels of trade.

[14] The applicant's mark SECURIDENT and the opponent's mark SECURID resemble each other to a fairly high degree in all respects, that is, in appearance, in sounding and in ideas suggested. The resemblance is to be expected since the applicant's mark incorporates the whole of the opponent's mark. Further, as a surrounding circumstance, I have taken into consideration that the applicant's use of its mark in the marketplace in the form of having the letters ID in uppercase accentuates the visual resemblance between the applied for mark and the opponent's mark as the opponent's mark is used in the same form. This surrounding circumstance tends to increase the likelihood of confusion.

DISPOSITION

[15] I am aware of the principle in trade-marks law that small differences in "weak marks" may suffice to avoid confusion: see *GSW Ltd. v. Great West Steel Industries* (1975) 22 C.P.R.(2d) 154 at 163-164 and at 169 (F.C.T.D.). However, considering the close resemblance between the marks in issue in the instant case, the other s.6(5) factors as discussed above and the surrounding circumstance of the form of use of the marks in

issue, I find that the applicant has not met the onus on it, at any material time, to show that on a balance of probabilities there is no reasonable likelihood of confusion between the applied for mark and the opponent's mark.

[16] It follows that the application must be refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board