



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

Citation: 2010 TMOB 62
Date of Decision: 2010-05-10

**IN THE MATTER OF AN OPPOSITION
by Air Miles International Trading B.V.
to application No. 1,203,411 for the trade-
mark TAXIMILES in the name of
TaxiMiles Inc.**

[1] On January 15, 2004, TaxiMiles Inc. (the Applicant) filed an application to register the trade-mark TAXIMILES (the Mark) based upon proposed use of the Mark in Canada. The wares and services, as revised, are as follows:

Wares: Vouchers, coupons and printed inserts that are redeemable for transportation by taxi and discounts for transportation by taxi;

Services: Advertising and promotion of wares and services of others by means of incentive rewards programs and social responsibility programs, namely, the provision of vouchers and coupons redeemable for transportation by taxi to those individuals who are not able to drive a car; organization, operation and supervision of sales and promotional incentive schemes for others and social responsibility programs, namely the provision of vouchers and coupons redeemable for transportation by taxi to those individuals who are not able to drive a car.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 5, 2005.

[3] On September 5, 2005, Air Miles International Trading B.V. (the Opponent) filed a statement of opposition against this application, a copy of which was forwarded to the Applicant on January 24, 2006. The grounds of opposition can be summarized as follows:

1. The application does not conform to the requirements of s. 30(a), (e) and (i) of the *Trade-marks Act* (R.S.C. 1985, c. T-13) (the Act);
2. The Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with 22 registered trade-marks owned by the Opponent including the marks MEGA MILES (TMA496,228), YOUR MILES (TMA541,038) and a large number of marks comprising the words “AIR MILES” (of particular note is registration No. TMA443,821 for the word mark AIR MILES);
3. The Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(3)(a), (b) and (c) of the Act in that at the date of filing of the application, the Mark was confusing with 33 trade-marks and 6 trade-names which had been previously used in Canada by the Opponent or for which an application for registration had been previously filed in Canada by the Opponent, and which had not been abandoned at the date of advertisement of the Applicant’s application for the Mark;
4. The Mark is not distinctive within the meaning of s. 2 of the Act in that i) it does not distinguish and is not adapted to distinguish the Applicant’s proposed wares and services from the business, wares and services of the Opponent and the Opponent’s trade-marks or trade-names identified in paragraphs 2 and 3 above, and ii) “the Applicant does not use or intend to use the [Mark] in Canada in association with the wares and services enumerated in the application therefore; and/or has abandoned the [Mark]”.

[4] The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed as its evidence in chief, the affidavits of Michael Louis Kline, the Senior Vice-President, Legal Services and Secretary of Loyalty Management Group Canada Inc. (Loyalty), the Opponent’s exclusive licensee in Canada, sworn December 19, 2006; Jimmy L. Partington, Associate Director, Virtual Retail, Loyalty Marketing Services, at Loyalty, sworn December 19, 2006; Cliff Swaters, Research Director of Lieberman Research Worldwide and former Account Group Head with Maritz: Thompson Lightstone (MTL), a marketing and survey research organization, sworn December 18, 2006; Daniel Park, Project Director of Consumer Contact, an organization that conducts quantitative consumer and business surveys, sworn December 19, 2006; and Donald Easter, Vice-President, Internal

Operations and Television, of BBM Canada (formerly known as the Bureau of Broadcast Measurement), sworn December 19, 2006.

[6] In support of its application, the Applicant filed as its evidence in chief, copies of various trade-mark registrations and applications as certified by the Registrar of Trade-marks.

[7] The Opponent filed as reply evidence, the affidavit of Lucy Rooney, a trade-mark clerk within the law firm representing the Opponent in this proceeding, sworn December 20, 2007.

[8] Only the Opponent filed a written argument and was represented at an oral hearing.

Onus

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

Grounds of opposition

Section 12(1)(d) ground of opposition

[10] The Opponent has provided through the Kline affidavit, certified copies of the twenty or so trade-mark registrations relied upon in support of its s. 12(1)(d) ground of opposition. The most relevant of the Opponent's trade-marks is AIR MILES, which is the subject of Canadian trade-mark registration No. TMA443,821 for the following services (as amended by the Registrar on February 4, 2010 following the decision rendered by Board Member Sprung in *Sea Miles LLC. v. Air Miles International Trading B.V.*, 2009 CarswellNat 3294 (T.M.O.B.)): “[a]dvertising and promotion of wares and services of others; organization, operation and supervision of sales and promotional incentive schemes”. I will focus my analysis on this trade-

mark and these services. A consideration of the issue of confusion between that mark and the Applicant's Mark will effectively decide the outcome of this ground of opposition.

[11] The certified copies of the registrations satisfy the Opponent's initial burden. The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark. The material date with respect to this ground of opposition is the date of my decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[12] 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.

[13] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have 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 in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [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* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[14] Both of the parties' marks have a certain degree of inherent distinctiveness. While they do not clearly describe the character or quality of their associated wares or services, they are both somewhat suggestive of a travel reward program where a member can accumulate "miles" or redeem such "miles" for rewards.

[15] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is no evidence that the Applicant's proposed Mark has been used or become known to any extent in Canada. By contrast, the Opponent's mark has been widely and extensively used throughout Canada and has become well-known in this country. An overview of the Opponent's evidence will show why I say so.

[16] Mr. Kline states in his affidavit that Loyalty is licensed to exclusively use and sub-license the Opponent's family of trade-marks including the mark AIR MILES in Canada [paragraphs 1, 5 and 10 of the Kline affidavit]. Since 1992, Loyalty has operated an incentive reward program in Canada in association with the AIR MILES trade-mark (the Program) [paragraph 8 of the Kline affidavit].

[17] As Mr. Kline attests, the AIR MILES Program provides participating licensed users (the Sponsors) of the AIR MILES trade-mark, that is businesses that sell goods and services to consumers, with a way to reward their loyal customers by issuing AIR MILES reward miles [paragraph 9 of the Kline affidavit]. Program Sponsors enter into an agreement (the Program Participation Agreement) with Loyalty to secure a license to issue AIR MILES reward miles in connection with the sale of products or services in a particular category in a particular region of Canada and a sub-license to use the AIR MILES trade-mark in connection with those activities. The Sponsors pay fees to Loyalty based upon the number of AIR MILES reward miles issued in connection with the sale of their goods and services [paragraph 10 of the Kline affidavit].

[18] The Program has over 100 Sponsors in Canada representing approximately 14,000 participating retail and service locations [paragraphs 13 and 31 of the Kline affidavit]. I will revert to this point later when considering the nature of the wares, services or business and the nature of the trade.

[19] Members of the public in Canada may enrol in the Program as AIR MILES "Collectors" [paragraph 14 of the Kline affidavit]. An individual's membership status as a Collector is evidenced by that individual's possession and use of an AIR MILES Collector card issued by Loyalty [paragraph 14 of the Kline affidavit, Exhibit 4]. When a Collector makes a qualifying purchase of goods or services from a Sponsor, the Collector presents his or her card to the retailing Program Sponsor. The card is scanned and the Collector is credited with reward

miles that can be accumulated and redeemed through Loyalty to acquire a wide variety of goods and services from a catalogue identified as “TRAVEL & MORE® Your AIR MILES® Magazine” [Exhibit 5 to the Kline affidavit]. Since the spring of 1999, catalogues have been published and distributed semi-annually to Collectors in Canada. The companies whose reward merchandise and services are listed in the catalogues are designated as “Reward Suppliers” [paragraphs 15, 18, 24 and 25 of the Kline affidavit].

[20] At regular intervals, each Sponsor notifies Loyalty that it has issued reward miles to Collectors whereupon Loyalty allocates the appropriate number of reward miles to the accounts maintained by it for each Collector [paragraphs 19 and 21 of the Kline affidavit]. Also at regular intervals, Loyalty mails out statements to Collectors detailing their accumulated reward miles and that information is also available to Collectors on-line via Loyalty’s website at www.airmiles.ca [paragraphs 22 and 23 of the Kline affidavit].

[21] Mr. Kline attests to the overwhelming success and pervasiveness of the Program. By May 2004, 16 billion AIR MILES reward miles had been issued to AIR MILES Collectors in Canada and 13 million redemption transactions (i.e. when an AIR MILES Collector redeems accumulated AIR MILES reward miles for redemption goods and services) had been processed in Canada. Since 1999, over 60% of all Canadian households had an AIR MILES Collector. This represents more than 12.5 million AIR MILES Collectors enrolled in Canada [paragraph 31 of the Kline affidavit].

[22] Loyalty revenues from the operation of the AIR MILES Program in Canada have consistently exceeded \$100 million per year [paragraph 31 of the Kline affidavit]. Loyalty and its Sponsors have together spent millions of dollars in advertising the AIR MILES Program in print, in electronic media and on radio and television in Canada [paragraph 32 of the Kline affidavit]. Loyalty alone spent over \$5.6 million dollars on advertising and promotion from 1992 to 1997 [paragraph 39 of the Kline affidavit]. From 1998 to the present, Loyalty alone spent over \$15 million dollars annually [paragraph 40 of the Kline affidavit]. Mr. Kline details the various direct mail initiatives, television, radio and print ad campaigns conducted by Loyalty and the millions of on-site posters, information guides and brochures distributed annually to Sponsors for use on-site. In addition, Loyalty mails out millions of MEGA MILES vouchers twice a year to

Collectors (MEGA MILES is a promotion whereby Collectors are provided with vouchers redeemable for bonus AIR MILES reward miles during certain periods upon purchasing particular goods or services from Program Sponsors) [paragraphs 15, 37, 53-62 of the Kline affidavit, Exhibits 5-7, 13, 20, 21, 22.1., 23.1, 23.2, 28 and 29].

[23] The pervasiveness of the Opponent's AIR MILES mark in Canada is further attested by the collateral affidavits of Cliff Swaters, Daniel Park, Donal Easter and Jimmy L. Partington.

[24] In his affidavit, Mr. Swaters states that MTL was commissioned by Loyalty in December 2001 to conduct a study to track levels of awareness of and membership in various reward programs and credit card programs in the Canadian market. Mr. Swaters details the results of that study which shows that the AIR MILES Program had by far the highest public recognition by consumers of any of the different various reward programs with an unaided recognition rate of about 50% [paragraphs 7-10 of the Swaters affidavit, Exhibits 1-3]. As Mr. Kline has evidenced continuing substantial use of the AIR MILES mark subsequent to the date of the study, it seems likely that the conclusions of that study are still relevant today.

[25] In his affidavit, Mr. Park attests to the regularity of the manner in which the study referred to in the Swaters affidavit was conducted.

[26] In his affidavit, Mr. Partington attests to a particular radio campaign in Canada in relation to the AIR MILES Program that was conducted by M2 Universal Communications Management and that ran during the period January, 2002 to December, 2004. Mr. Partington provides a list of where and when the radio ads were placed including potential audience for each ad. By way of example, Mr. Partington attests to the fact that the audience ran well over the hundreds of thousands per radio spot of such advertisements broadcast in the City of Toronto alone [paragraph 15 of the Partington affidavit].

[27] In his affidavit, Mr. Easter confirms the accuracy of the calculation of the estimated audience size for certain broadcasts of certain radio spots in the radio commercial campaign for the AIR MILES Program that was conducted in 2002 by M2 Universal Communications Management [paragraph 9 of the Easter affidavit].

[28] Before concluding on this first factor, I wish to revert to the license use of the AIR MILES trade-mark. Mr. Kline has attached as Exhibit 1 to his affidavit, excerpts from the license agreement between “AMIH”, that is the acronym of “Air Miles International Holdings N.V.”, and Loyalty detailing how the AIR MILES mark may be used and setting out the standards to be followed by Loyalty and its sub-licensees.

[29] While the agreement does not expressly identify the Opponent, Mr. Kline explains in paragraph 5 of his affidavit that the Opponent is the successor-in-interest to ownership of the AIR MILES family of trade-marks and the AIR MILES Program previously owned by AMIH. As such, Mr. Kline states that the license agreement binds both the Opponent as AMIH’s successor and Loyalty, which statement is further supported by a number of the provisions of the excerpts from the agreement that refer to “AMIH, its Affiliates, successors and assigns”.

[30] Mr. Kline describes in his affidavit how, pursuant to this license agreement, the Opponent maintains control over the character and quality of the wares and services to which Loyalty associates the AIR MILES trade-mark in Canada. He further states that in addition to the license agreement, public notice has been given in Canada in advertising, publications, direct mailings and on Loyalty’s website, that the AIR MILES mark is the property of the Opponent and is used under license in Canada by Loyalty [paragraphs 6 and 7 of the Kline affidavit, Exhibit 2].

[31] Mr. Kline further explains how the Program Participation Agreements referred to above and entered into with the Sponsors provide that Loyalty, on its own behalf and on behalf of the Opponent has direct or indirect control over the character or quality of the wares and services provided in association with the AIR MILES mark. He has attached as Exhibit 3 to his affidavit, excerpts from the Program Participation Agreement currently employed by Loyalty which sets out the character and quality standards that apply to the use of the AIR MILES trade-mark. Among other things, the Program Participation Agreement provides that Sponsors are required to clearly indicate in all advertising, promotional and other material depicting the AIR MILES trade-mark that the owner of the mark is the Opponent and that the AIR MILES trade-mark is used under license by Loyalty [paragraphs 10, 11 and 12 of the Kline affidavit].

[32] The above satisfies the requirements of both s. 50(1) and (2) of the Act in respect of the licensed use of the AIR MILES trade-mark. To conclude, I am satisfied that use of the AIR MILES mark by Loyalty enures to the benefit of the Opponent, and that the first factor far favours the Opponent.

(b) the length of time the trade-marks have been used

[33] For the reasons given above, this factor also favours the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

[34] Considering the type of wares or services and the nature of the trade, I must compare the Applicant's statement of wares and services with the statement of services in the Opponent's registration [see *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.)]. 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. The evidence of the parties' actual trades is useful in this respect [see *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 Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[35] As indicated above, the Applicant's evidence does not speak to the use or intended use of the Mark in Canada. By contrast, the Opponent's evidence establishes that the AIR MILES Program has over 100 Sponsors including, in the automotive sector: *National Car and Truck Rental* (car rental), *Shell Canada* (fuel), *Goodyear* (brand and truck tires), *Speedy Glass* (automotive glass), *Carstar Quality Collision Service* (vehicle repair and maintenance service); in the travel agency sector: *Travel Plus* and *Club Voyages*; in the hospitality and accommodation sector: *The InterContinental Hotels Group*, and in the financial services sector: *Bank of Montreal* and *Amex Bank of Canada* [paragraph 13 of the Kline affidavit, Exhibit 5].

[36] The Opponent contends that the Applicant's proposed incentive reward programs and social responsibility programs in Canada appear to operate in a fashion that is the same or similar

to the AIR MILES Program in Canada, except that the TAXIMILES programs appear more limited in redemption inasmuch as TAXIMILES reward points do not appear to be redeemable for merchandise *per se*. I agree and wish to add that the Applicant's proposed vouchers, coupons and printed inserts appear to overlap with the Opponent's advertising of the AIR MILE Program done through, among others, vouchers, catalogues and the like.

[37] The Opponent further contends that given the Opponent's empirical data in the Kline affidavit that AIR MILES Collectors reside in 60% of Canadian households, it is highly likely that a portion of those consumers would be marketed by the Applicant in conjunction with a proposed Canadian TAXIMILES reward program, or that a consumer participating on the TAXIMILES reward program might use a credit card of a participating AIR MILES reward program Sponsor (a *MASTERCARD* or an *AMERICAN EXPRESS* card) to fund his or her participation in the TAXIMILES reward programs. The Opponent further contends that the parties' channels of trade also appear to overlap in the packaged vacation travel and automotive related sector. I agree.

[38] In view of the foregoing, these third and fourth factors favour the Opponent.

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

[39] The greatest degree of resemblance between the trade-marks is in the ideas suggested by them. As indicated above, they are both suggestive of a travel reward program. They also bear some degree of resemblance in appearance and sound as they both share the identical suffix "MILES".

(f) further surrounding circumstances

[40] This brings me to consider as a further surrounding circumstance, the certified copies of the 17 trade-mark registrations and applications for third party marks that end with the word "MILES" filed as evidence by the Applicant.

[41] As stressed by the Opponent, these certified copies are not supported by any affidavit or other evidence that supports either the state of the marketplace or the state of the register necessary to put those certificates in context.

[42] Furthermore, six of these registrations have been expunged from the register of trademarks (namely TRAVELODGE MILES; TRAVELODGE MILES & Design; SUPERMILES & Design; CLICKMILES; WORLDMILES and EUROMILES).

[43] Four are for registrations or applications that do not claim services in the nature of an incentive reward program such as the AIR MILES Program (namely MILES FOR KIDS IN NEED & Design for charitable donations; GREENER MILES for the promotion of environmentally-conscious behavior and carbon off-set programs; TV MILES for the services of developing, producing and distributing TV and computer programs for teaching, educating and entertaining; and AMERICAN EXPRESS MEMBERSHIP MILES & Design for charge card services and for arranging travel tours).

[44] One (E-MILES) is an application filed by the Opponent in this proceeding. One (CARE MILES) is the subject of a settlement between the Opponent and the registrant pursuant to which the registrant specifically agreed not to claim or perform services in the operation of an incentive reward program [paragraph 8 of the Rooney affidavit]. One (MILLION MILE CLUB) is for an awards program to promote industry drivers who have achieved one million miles of preventable accident free driving. The remaining four (DIVIDEND MILES, DIVIDEND MILES PROGRAM, SKYMILES and DIVIDEND MILES PREFERRED) are all marks of airlines that claim association with services in the nature of frequent flyer programs and not an incentive promotional reward program such as the AIR MILES Program.

[45] There is no evidence that any of the references cited are in active use in Canada.

[46] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.*

(1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[47] In the present case, the number of marks referred to by the Applicant is not sufficient to make any meaningful inferences about the state of the marketplace.

[48] As an additional circumstance, the Opponent has evidenced at least some use of its other “MILES” marks, namely, MEGA MILES (TMA496,228) and YOUR MILES (TMA541,038) [paragraphs 59-61 of the Kline affidavit]. Transposing the comments of former Board Member Martin in *Air Miles International Trading B.V. v. SeaMiles LLC*, 2009 CarswellNat 2084 (T.M.O.B.), to the present case, the use of a small family of trade-marks, while not of great significance, does increase the likelihood of consumers assuming that TAXIMILES is simply another aspect of the Opponent’s AIR MILES Program.

Conclusion re: likelihood of confusion

[49] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Having considered all the surrounding circumstances, I find that the Applicant has not satisfied the onus on it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties’ wares or services. I reach this conclusion particularly in view of the extensive use and pervasiveness of the Opponent’s registered trade-mark AIR MILES, the similarities or overlap existing between the parties’ wares or services and channels of trade and the fair degree of resemblance between the parties’ marks.

[50] The s. 12(1)(d) ground of opposition accordingly succeeds.

Section 16(3)(a) ground of opposition

[51] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act on the basis that the Mark is confusing with, among others, the Opponent’s AIR MILES registered trade-mark, which had been previously used and made known in Canada by the Opponent, and which had not been abandoned by the Opponent at the date of advertisement of the Applicant’s application for the Mark.

[52] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its AIR MILES trade-mark prior to the date of filing of the Applicant's application and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16]. As outlined above, the Opponent has met this burden as well. This ground of opposition therefore remains to be decided on the issue of confusion between the Applicant's Mark and the Opponent's AIR MILES trade-mark as of January 15, 2004.

[53] As the difference between the relevant dates for the grounds of opposition based on s. 12(1)(d) and s. 16(3)(a) does not affect my earlier analysis following which I determined that there is a likelihood of confusion between the marks under review, the s. 16(3)(a) ground of opposition also succeeds insofar as it is based on prior use of the Opponent's registered trade-mark AIR MILES.

Non-distinctiveness ground of opposition based on likelihood of confusion

[54] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish and is not adapted to distinguish the Applicant's proposed wares and services from the business, wares and services of the Opponent and the Opponent's trade-marks or trade-names enumerated in its statement of opposition, including the Opponent's registered trade-mark AIR MILES, which had been previously used in Canada by the Opponent.

[55] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark or trade-name had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. The Opponent has met this burden at least in respect of its AIR MILES registered trade-mark.

[56] As I came to the conclusion that, based on the evidence filed in the record, the Mark is confusing with the Opponent's AIR MILES trade-mark and because the difference in relevant dates does not affect my analysis, the non-distinctiveness ground of opposition therefore succeeds insofar as it is based on prior use of the Opponent's registered trade-mark AIR MILES.

Other grounds of opposition

[57] As I have already found in favour of the Opponent under more than one ground, it is not necessary for me to address the remaining grounds of opposition.

Disposition

[58] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office