

o/086/18

**IN THE MATTER OF APPLICATION NO 3192086
BY
PROFESSIONAL ASSOCIATION FOR CHILDCARE AND EARLY YEARS
TO REGISTER THE TRADE MARK**



IN CLASSES 9, 16, 28, 35, 38, 41, 43 AND 45

**AND OPPOSITION THERETO
UNDER NO 408422
BY
INTERNATIONAL NEW MEDIA LIMITED**

BACKGROUND

1. On 19 October 2016 Professional Association for Childcare and Early Years ('the applicant') applied to register the above trade mark in the classes shown on the cover page of this decision under the Nice Classification system¹. The parts of the specification which have been opposed are as follows:

Class 35: Compilation and management of databases including in relation to childcare; business introduction services including in the field of childcare; advisory, consultancy and information services in relation to the aforesaid.

Class 38: Internet messaging and forum services; providing access to computer databases.

Class 41: Education and training services; advisory and information services in relation to education and training.

Class 43: Childcare services; advisory and information services in relation to childcare.

Class 45: Babysitting and nanny services; advisory and information services in relation to babysitting and to nanny services; legal advisory and information services including in relation to childcare; social networking services.

2. The application was published on 4 November 2016, following which International New Media Limited ('the opponent') filed a notice of opposition against the application.

3. The opposition was brought under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 ('the Act').

4. The opponent outlines its objections as follows:

"The Trade Mark applied for consists of two dominant elements, namely the words "SearchChildcare" (even though the words are put together without

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

a space between them, by use of the capital letters it is clear that these are two separate words) and the figurative representation of a magnifying glass, otherwise known as a spy glass. There is also a word element "Powered by pacey" which is not dominant in any way and appears in much smaller text than "SearchChildcare" and in a non-dominant position in relation to the Mark as a whole.

Taken individually, the words which form the most distinctive element of the composite Mark, namely "Search" and "Childcare" are clearly descriptive of the services of searching a database for childcare services. Even when taken together, there is no meaning that is more than the sum of its parts, i.e. there is nothing more other than the meaning denoted by the terms side-by-side.

...representations of magnifying glasses are commonly used in relation to the word "search"; in the Mark applied for this figurative element even appears over the word "Search". Thus, it is not sufficient to confer distinctive character on the Mark opposed; the graphic element does not imbue the Mark with any additional distinguishing characteristic...

It is widely recognised that, in general, a combination of figurative and word elements, which if considered individually devoid of distinctive character, also gives rise to a non-distinctive Mark."

5. The applicant filed a counterstatement which denied all of the grounds raised in the notice of opposition.

6. Both parties filed evidence and skeleton arguments. A hearing took place by video conference. The applicant was represented by Mr Jamie Muir Wood of Counsel, instructed by Bates Wells & Braithwaite London LLP. The opponent was represented by Ms Charlotte Blythe of Counsel, instructed by Brothers IP Limited.

Opponent's evidence

A witness statement by Christopher Michael Brothers and exhibits CMB-A-CMB-H

7. Mr Brothers is an attorney employed by the opponent's instructing representative. His statement is dated 3 May 2017.

8. Mr Brother's evidence comprises examples of magnifying glass icons (used on various websites and searched on *Google* images), a Wikipedia entry and two exhibits relating to searches 'powered by *Google*'.

Applicant's evidence

A witness statement by Catharina Waller and exhibits CW1 – CW3

9. Ms Waller is an attorney employed by the applicant's instructing representative. Her statement is dated 3 July 2017.

10. Ms Waller's evidence comprises a copy of the trade mark examination report for the contested application and prints taken from the UK and EU trade mark registers showing trade marks using 'powered by' and trade marks which Ms Waller describes as descriptive for some of the goods and services but including a magnifying glass and a 'spatial orientation of the marks'.

Opponent's evidence in reply

A second witness statement by Christopher Michael Brothers, dated 17 August 2017.

11. Whilst I have listed all of the evidence filed by the parties, I do not intend to summarise it further but will refer to it and the respective submissions as necessary below.

THE DECISION

12. Section 3(1) of the Act is as follows:

“3. - (1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

13. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*², the Court of Justice of the European Union (‘CJEU’) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies

² *Case C-329/02 P*

each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

The opposition under section 3(1)(c)

14. Section 3(1)(c) of the Act is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest

underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

15. Both sides accept that the words, ‘SearchChildcare’ are descriptive and non-distinctive for the services at issue in this case. The opponent’s position is that the figurative elements of the magnifying glass, font and shading of the two words are insufficient to imbue the mark with distinctiveness and the additional words, ‘powered by pacey’ are negligible within the mark as a whole such that it remains exclusively descriptive.

16. The applicant’s position is that the phrase ‘powered by pacey’ refers to the entity behind the mark and that it is capable of acting to identify the origin of the services. In its view, this is enhanced by the fact that a different font is used for the word ‘pacey’ and the individual letters are presented in different shades of grey. The applicant submits that whilst it is smaller than the word ‘SearchChildcare’ it is not so small as to be indistinct. It accepts that magnifying glasses, generally, may indicate a search

function, however it claims that the combination of the magnifying glass with the word 'SearchChildcare' forms a visual device which creates a non-descriptive element.

17. In *Campina Melkunie BV and Benelux-Merkenbureau*³, the CJEU stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.”

18. In *PutterScope* BL O/96/11, the appointed person said:

“8...Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see *Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and

³ Case C-265/00

envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a particular source or would they consider that it simply indicated the function of the goods?”

19. The parties’ acceptance that the words ‘SearchChildcare’ are descriptive and non-distinctive for the opposed services is entirely realistic given that the mark describes a service where the consumer may search childcare providers and advice relating to the same.

20. With regard to the other elements of the mark applied for, the opponent’s view is that the magnifying glass in the application is a symbolic portrayal of a search function and reinforces the descriptive meaning of the applicant’s mark. The applicant submits that a distinctive combination is formed by the merging of the magnifying glass with the letter ‘S’ and the separation of the letter ‘S’ from the rest of SearchChildcare.

21. The opponent’s evidence provides example screen shots taken from a number of websites, showing the way in which search boxes are routinely presented on websites.⁴ It also provides a print from Wikipedia titled ‘Magnifying Glass’, which includes the following:

“The magnifying glass ...is commonly used as a symbolic representation for the ability to search or zoom, especially in computer software or websites.”⁵

22. The pages were printed after the relevant date but I am content that it reflects a fairly commonplace practice, which has existed for some time, where a website provides a search box with a small magnifying glass icon to the side of it. One of the examples provided by the opponent is from the Intellectual Property Office website which appears in the following form:⁶

⁴ See exhibit CMB-A

⁵ See exhibit CMB-B

⁶ See exhibit CMB-C

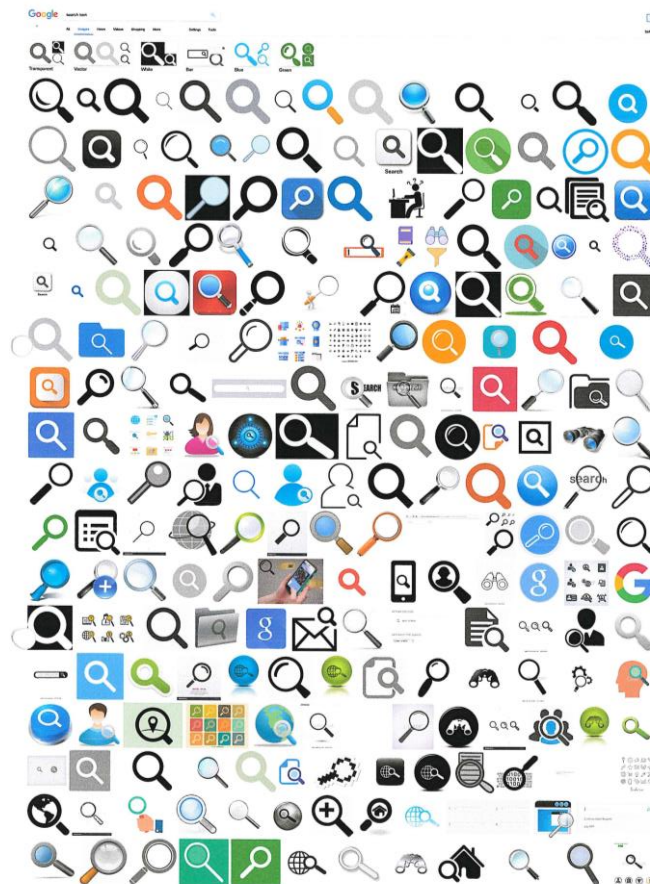


23. Whilst I accept the opponent's point, it does not help its case here. The magnifying glass in the application surrounds the first letter and is part of the word, it is not presented next to a blank search box.

24. At exhibit CMB-D the opponent provides what it describes as 'a print out from a Google images search for 'search icon'. It concludes:

"...the vast majority are representations of magnifying glasses, some of which also include the word 'search'."

25. The pages appears as follows:





26. This evidence does not advance the opponent's case. I have no indication of where these icons are used or in what context and it takes the opponent no further than my earlier statement that I accept that magnifying glasses are used to denote a search option/function on a number of websites. What I must assess is the applicant's mark, as a whole, including the extent to which the particular magnifying glass used in that mark imbues the mark with distinctive character.

27. In the mark at issue the magnifying glass is a simple black outline, with the handle a little thicker than the rest of it. The magnifying glass is presented as if it were over the first letter 'S' which falls within the round part of the magnifying glass and is slightly larger than the rest of the text, as if it were slightly magnified. The handle of the magnifying glass falls diagonally to the right below the letter 'S'. Since the magnifying glass is descriptive in relation to searching and the stylisation is extremely minimal, in this case, it simply reinforces the descriptive meaning of the words 'SearchChildcare'.

28. With regard to the shading in the mark, I do not find that this adds anything in terms of distinctiveness. Case law makes clear that it is commonplace for traders to present words in a variety of shades/colours and such presentation does not result in otherwise

non-distinctive/descriptive words achieving distinctiveness. This is particularly so in this case where the shading simply makes the separation of two descriptive/non-distinctive words more obvious to the consumer. Furthermore, I find that the claimed difference in shade between the letters in the word 'pacey' would not be noticed by the consumer.

29. With regard to the words 'Powered by pacey', the opponent submits in its skeleton argument:

27...the element "powered by pacey" is negligible within the Contested Mark such that the mark as a whole remains exclusively descriptive.

28. The element 'powered by pacey' is extremely small in comparison with the element "SearchChildcare" and the magnifying glass. It is also positioned in a subsidiary position, tucked away in the bottom right corner of the mark, and appears in a paler shade of grey. In my submission, the result of this is that the element "powered by pacey" would be lost or buried in the mark as a whole and would go unnoticed by the average consumer, who would see the mark and refer to the mark simply and purely as 'SearchChildcar', being clearly the dominant element of the mark as a whole.

29. Moreover, the words "powered by" alone have no distinctive value whatsoever. They would not be understood to indicate origin in and of themselves and, it is submitted, would be ignored completely by the average consumer.

30. The applicant submits that whilst the words, 'Powered by pacey' are smaller than the words, 'SearchChildcare', they are, nonetheless, clearly visible and form part of the mark. The applicant concludes:

"As a result, the 'Powered by pacey' element cannot be excluded from the assessment of the mark as a whole."

31. In support of this submission the applicant provides prints taken from the European Trade Mark Register which show seven marks, all of which include 'powered by x' as part of the mark. It concludes that the average consumer is accustomed to viewing such marks as distinctive and not descriptive. I do not find this evidence helpful. The fact that some marks which include 'powered by' followed by another element are registerable as trade marks, certainly cannot lead to a conclusion that all such marks meet the legal requirements to become registered marks *prima facie*. Each case must be decided on its own merits. In this case, I have no evidence as to whether the marks shown in the EUIPO prints are used or where they are used. Some of the marks contain additional figurative elements, in some the 'powered by' element occupies a much more dominant position within the mark as a whole and a number of the examples include other distinctive words. All of them relate to different goods and services to the ones at issue here. In the absence of any reasoning from the applicant as to why these marks are relevant to its case, I will say no more about this evidence.

32. I agree with the applicant that the 'Powered by pacey' element in its mark cannot be excluded from my assessment. It is smaller than other elements in the mark but is not so small as to go unnoticed by the relevant average consumer of the opposed services.

33. The applicant submits that 'pacey' is the initial letters of 'Professional Association for Childcare and Early Years'. Whilst I accept that to be the applicant's intention, the presentation of 'pacey' within the mark is not that of an acronym, rather it appears to be an invented word. The letters are all lower case and joined together to form a pronounceable word and in my view, that is how it will be viewed by a significant number of the relevant public.

34. Whatever the reason for the adoption of 'pacey' by the applicant, in the context of a mark which clearly indicates that it enables the consumer to search childcare, the 'Powered by pacey' element provides the consumer with an indication of the provider of those services. It is certainly not descriptive of any of the services in the applied for specification and is a distinctive element of the mark.

35. When considering the mark as a whole, I must assess the overall impression created by the mark in its totality, with reference to the services for which registration is sought. With that in mind, the opponent draws my attention to *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*,⁷ Arnold J. held that a descriptive word with a minor figurative embellishment was not registrable under the provision in the Community Trade Mark Regulation which is equivalent (and identical to) to s.3(1)(c) of the Act.

36. The mark at issue was:



37. The judge said that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive

⁷ [2013] FSR 29

marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

38. The opponent concludes, in its skeleton argument:

“11. Thus, additional elements could be deemed to be so insignificant and negligible that they go unnoticed, or at least are held to have no distinctive impact, by the average consumer. In other words, the descriptive matter so overwhelms any possibly distinctive element of the mark that the mark should still be refused under s. 3(1)(c).”

39. There is no doubt that the words ‘SearchChildcare’ dominate the mark and are descriptive of the services applied for. However, the situation here is not on all fours with the decision in the NOW case referred to above. That case concerned the addition of six lines, with minimal stylisation, to an otherwise descriptive word. In this case, the additional element, ‘Powered by pacey’ is a distinctive element, the only debate about which is whether its size within the mark is significant enough to be noticed and to therefore play a role in the overall impression of the mark to the extent that the mark as a whole can be considered prima facie, registerable. In my view, ‘Powered by pacey’ will be noticed by relevant average consumers. I find that it combines with the descriptive elements in the application to form a trade mark that does not consist exclusively of signs or indications which are descriptive.

40. In making such a finding, I have borne in mind the opponent’s submission at paragraph 30 of its skeleton argument:

“...the Opponent relies on the possible adverse consequences of registration of the Contested Mark. It is entirely foreseeable that the Applicant will seek to enforce its mark against signs which do not include the “powered by pacey” element or anything like it, and just consist of words akin to SEARCH and CHILDCARE. As Arnold J said in Starbucks, the Registry should be astute to the consequence of registering descriptive marks, in this case, under the cover of a subsidiary and negligible distinctive word element.”

41. As I have already stated earlier in this decision, the parties agree that the words 'SearchChildcare' are non-distinctive/descriptive for the contested services. Clearly, the words can only succeed to registration where they are part of a trade mark that in its totality possesses the necessary distinctiveness to enable it to be registered. The resulting trade mark rights rest in the totality of a mark achieving registration and do not provide the proprietor with a mark from which particular bits can be chosen in order to bring actions against third parties. I am not persuaded that this is a valid argument for refusal of the applicant's trade mark in this case.

42. In conclusion, I do not consider the evidence is sufficient to make good the claims made by the opponent and thus the objection to the application founded on section 3(1)(c) of the Act fails.

The objection under section 3(1)(b)

43. With regard to its claim under this section the opponent stated in its notice of opposition:

"3(1)(b)... The verbal element "SearchChildcare" of the Mark is dominant and it conveys a message which is descriptive. The figurative element, which is also dominant is a commonly used in trade in respect of searching web-powered databases. The figurative element also merely reinforces the descriptive message, or even supplements to it with further description. As a result, the Mark as a whole does not convey a message of origin when encountered by the relevant public, without further education. Thus, the Mark is devoid of distinctive character.

44. In its skeleton argument the opponent submitted:

34. With regards to the distinctive character of the mark, it is emphasised that even if you were to find that the mark is not "exclusively" descriptive as a result of the presence of the words "powered by pacey", it is submitted that it is caught by s. 3(1)(b) as the Contested Mark as a whole is not able

to fulfil the mark's essential function of distinguishing the Applicant's goods from those of others...

35. It is submitted that the more the words at the centre of a mark look like a generic description of the services, the less likely it is that the average consumer's perception of the sign will be changed by minor elements of get-up or surplus materials. In the case of this mark, it is submitted that the element 'SearchChildcare' is highly descriptive, such that the average consumer would for all intents and purposes ignore the other, negligible elements of the mark. The element "powered by pacey" would effectively not be seen as part of the sign at all.

36. In summary, the only even arguably distinctive element 'powered by pacey' is proportionately too small, or is de minimis, within the Contested Mark such that the mark when assessed as a whole will not identify the trade source of the services to the average consumer.

45. Other than its submissions in respect of 'Powered by pacey' the opponent's submissions are that the applicant's mark is descriptive, which are the same submissions put forward under s. 3 (1)(c). Clearly, the 'Powered by pacey' element of the applicant's mark is smaller than the words 'SearchChildcare' but, that is not to say that it will not be noticed at all. As I have found earlier in this decision it will be noticed by average consumers. In my view, the presence of this feature will allow the mark as a whole to perform its essential function of distinguishing the applicant's services from those of other undertakings. The mark therefore has some, albeit relatively little, distinctive character. Consequently, the opponent's pleading under 3(1)(b) cannot succeed.

46. The opposition under s.3(1)(b) fails.

Conclusion

47. The opposition fails under sections 3(1)(b) and 3(1)(c) of the Act.

COSTS

48. The opposition having failed the applicant is entitled to an award of costs. Both parties are content with an award of costs in accordance with the scale provided in Annex A of Tribunal Practice Notice 2 of 2016.

I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparation for and attending a hearing:	£600
Filing and considering evidence:	£500
Total	£1300

49. I order International New Media Limited to pay Professional Association for Childcare and Early Years the sum of £1300. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of February 2018

**Ms AI Skilton
For the Registrar,
the Comptroller-General**