

O/0792/25

TRADE MARKS ACT 1994

CONSOLIDATED  
PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003859288

BY LUK HOLDINGS LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

ELF CAST

IN CLASSES 9, 41 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000440152

BY MR NIGEL DEMMING

AND

IN THE MATTER OF

TRADE MARK REGISTRATION NO. UK00003271816

IN THE NAME OF

MR NIGEL DEMMING

IN CLASS 9

AND

AN APPLICATION FOR

REVOCATION FOR NON-USE THERETO

UNDER NO. CA000505994

## BACKGROUND AND PLEADINGS

### The opposition

1. On 14 December 2022, LUK Holdings Limited (“Party B”) applied to register the trade mark shown below and the application was published for opposition purposes on 13 January 2023.

## ELF CAST

2. The registration is sought for the following goods and services:

Class 9      Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; computer software; entertainment software; motion picture films; animated cartoons; computer game software; computer and video games; downloadable e-books; mobile phone covers; downloadable television programmes and films; data storage apparatus, cards and other storage media for podcasts, sound recordings, audio books and video recordings; audiovisual recordings; podcasts; downloadable podcasts; sound recordings; audio books.

Class 41      Entertainment; education; providing of training; sporting and cultural activities; providing online video games, online computer games, and temporary use of non-downloadable video games; production of television series and films; distribution of television series and films; theatrical performances; provision of film clips, photographs and other multimedia materials via a website; amusement park and theme park services; live or pre-recorded shows and/or movies; providing on-line publications (non-downloadable);

production of entertainment shows featuring actors, dancers and singers; provision of non-downloadable films and television programmes via online streaming services; provision of entertainment via podcast; production of podcasts; creation [writing] of podcasts; audio production; rental and publication of audio books; sound recording services; rental and publication of sound recordings; information, advisory and consultancy services relating to all these services.

Class 42 Software as a service; platform as a service; design and development of computer hardware and software; electronic storage of entertainment media content; hosting of podcasts; hosting multimedia educational content; hosting multimedia entertainment content; hosting of digital content; hosting of digital content online; providing temporary use of non-downloadable interactive entertainment software; digitalization of sound and images; design and development of hardware and software for the recording, production and editing of podcasts, sound recordings, audio books and videos; information, advisory and consultancy services relating to all these services.

3. Mr Nigel Demming (“Party A”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) having filed a Form TM7 on 14 May 2023. The opposition is directed against the following of Party B’s goods:

Class 9 Computer software; entertainment software; computer game software; computer and video games; downloadable e-books; downloadable television programmes and films; [data storage apparatus, cards and other storage media for] ... audio books

and video recordings;<sup>1</sup> audio visual recordings; podcasts; downloadable podcasts; sound recordings; audio books.

4. Party A relies on the trade mark below, number UK00003271816, which was filed on 20 November 2017 and registered on 23 February 2018.

## Screen Elf

5. Of the goods for which this mark is registered, Party A relies just on the following goods:

Class 9      Computer software; Recorded computer software; Computer games software; Computer games entertainment software; Downloadable interactive entertainment software for playing computer games; Interactive entertainment software for use with computers; Interactive entertainment software for use with personal computers; Computer application software featuring games and gaming; Computer games software for use with on-line interactive games; Computer games entertainment software; Computer games programs downloaded via the internet [software]; Computer software for controlling the operation of audio and video devices; Computer video game software; Computer software for creating and editing music and sounds; Software (Computer -), recorded; Computer software for audibly controlling a computer and the operation thereof; Computer software applications, downloadable; Computer software downloadable from global computer information networks; Computer software concerned with children's education; Data carriers for computers having software recorded thereon; Downloadable computer software

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<sup>1</sup> These are my square brackets which enclose relevant missing words from the full term as set out in Party B's specification.

for the transmission of data; Operating and user instructions stored in digital form for computers and computer software [in particular on floppy disks or CD-ROM].<sup>2</sup>

6. In its notice of opposition, filed on 14 May 2023, Party A argues that the respective goods are identical or similar and that the marks are similar, and that as such, there will be a likelihood of confusion between the marks.
7. Party B filed a Form TM8 denying the claims made.

### The revocation application

8. On 11 April 2023, Party B filed an application to revoke Party A's earlier mark on the grounds of non-use. Details of Party A's mark are set out at paragraph 4. The application for revocation is directed against all of Party A's goods as follows:

Class 9      Add-on circuit boards for connecting computers to networking software; Cards encoded to access computer software; Cartridges [software] for use with computers; Communication software for connecting computer network users; Communication software for connecting global computer networks; Communications processing computer software; Computer antivirus software; Computer application software; Computer application software featuring games and gaming; Computer application software for TV; Computer application software for mobile phones; Computer application software for mobile telephones; Computer application software for use in implementing the Internet of Things [IoT]; Computer application software for use with wearable computer devices; Computer communication software to allow customers to

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<sup>2</sup> These are my square brackets which enclose relevant missing words from the full term as set out in Party A's specification.

access bank account information and transact bank business; Computer e-commerce software; Computer e-commerce software to allow users to perform electronic business transactions via a global computer network; Computer firewall software; Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones; Computer game software for use with on-line interactive games; Computer games entertainment software; Computer games programmes [software]; Computer games programmes downloaded via the internet [software]; Computer games programmes for simulating financial securities trading [software]; Computer games programs [software]; Computer games programs downloaded via the internet [software]; Computer games programs recorded on tapes [software]; Computer games software; Computer gaming software; Computer graphics software; Computer software; Computer software [programmes]; Computer software adapted for use in the operation of computers; Computer software applications; Computer software applications, downloadable; Computer software concerned with children's education; Computer software designed to estimate costs; Computer software designed to estimate resource requirements; Computer software development tools; Computer software downloadable from global computer information networks; Computer software downloaded from the internet; Computer software for Global Positioning Systems; Computer software for Global Positioning Systems (GPS); Computer software for accessing computer networks; Computer software for accessing databases; Computer software for accessing information directories that may be downloaded from the global computer network; Computer software for accessing, browsing and searching online databases; Computer software for

administration of local area networks; Computer software for advertising; Computer software for analysing market information; Computer software for application and database integration; Computer software for assisting in the design of sports equipment; Computer software for audibly controlling a computer and the operation thereof; Computer software for authorising access to data bases; Computer software for biometric systems for the identification and authentication of persons; Computer software for business purposes; Computer software for cellular phones; Computer software for communicating purposes between microcomputers; Computer software for communicating with users of hand-held computers; Computer software for communication between computers over a local network; Computer software for computer aided software engineering; Computer software for controlling amplifiers; Computer software for controlling and managing access server applications; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for converting document images into electronic formats; Computer software for creating and editing music and sounds; Computer software for creating dynamic websites; Computer software for creating searchable databases of information and data; Computer software for database management; Computer software for document management; Computer software for electronic bulletin boards; Computer software for encryption; Computer software for generation of typefaces and fonts; Computer software for instrument tuning; Computer software for inter-network accounting in the telecommunications field; Computer software for interpreting fingerprints or palm prints; Computer software for mobile applications that enable interaction and interface between vehicles and mobile devices; Computer software for mobile

phones; Computer software for monitoring the use of computers and the internet by children; Computer software for organizing and viewing digital images and photographs; Computer hardware for use in computer-assisted software engineering; Computer interface software; Computer operating software; Computer operating system software; Computer programs [downloadable software]; Computer programs and software for image processing used for mobile phones; Computer screen saver software; Computer screen saver software, recorded or downloadable; Computer search engine software; Computer telephony software; Computer video game software; Computer whiteboard software; Computer-aided design (CAD) software; Computer-aided manufacturing software; Controlling software for computer printers; Data carriers for computers having software recorded thereon; Computer hardware for use in computer-assisted software engineering; Computer interface software; Computer operating software; Computer operating system software; Computer programs [downloadable software]; Computer programs and software for image processing used for mobile phones; Computer screen saver software; Computer screen saver software, recorded or downloadable; Computer search engine software; Computer telephony software; Computer video game software; Computer whiteboard software; Computer-aided design (CAD) software; Computer-aided manufacturing software; Controlling software for computer printers; Data carriers for computers having software recorded thereon; Downloadable computer game software; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer security software; Downloadable computer software; Downloadable computer software applications; Downloadable computer software for designing and modelling of three

dimensional printable products; Downloadable computer software for remote monitoring and analysis; Downloadable computer software for the management of data; Downloadable computer software for the management of information; Downloadable computer software for the transmission of data; Downloadable computer software for the transmission of information; Downloadable computer utility software; Downloadable interactive entertainment software for playing computer games; Electronic device software drivers that allow computer hardware and electronic devices to communicate with each other; Electronic sports training simulators [computer hardware and software-based teaching apparatus]; Games (cartridges for computer -) [software]; Games software for use with computers; Interactive computer software; Interactive computer software enabling exchange of information; Interactive computer software that provides navigational and travel information; Interactive entertainment software for use with computers; Interactive entertainment software for use with personal computers; Magnetic cards being computer software; Network management computer software; Operating and user instructions stored in digital form for computers and computer software, in particular on floppy disks or CD-ROM; Operating computer software for main frame computers; Personal computer application software for document control systems; Personal computer application software for managing document control systems; Programs (Computer -) [downloadable software]; Recorded computer game software; Recorded computer software; Recorded computer software for safe car driving; Recorded computer software for safe vehicle driving; Computer software; Computer software [programmes]; Computer software adapted for use in the operation of computers; Computer software applications; Computer software applications,

downloadable; Computer software concerned with children's education; Computer software designed to estimate costs; Computer software designed to estimate resource requirements; Computer software development tools; Computer software downloadable from global computer information networks; Computer software downloaded from the internet; Computer software for Global Positioning Systems; Computer software for Global Positioning Systems (GPS); Computer software for accessing computer networks; Computer software for accessing databases; Computer software for accessing information directories that may be downloaded from the global computer network; Computer software for accessing, browsing and searching online databases; Computer software for administration of local area networks; Computer software for advertising; Computer software for analysing market information; Computer software for application and database integration; Computer software for assisting in the design of sports equipment; Computer software for audibly controlling a computer and the operation thereof; Computer software for authorising access to data bases; Computer software for biometric systems for the identification and authentication of persons; Computer software for business purposes; Computer software for cellular phones; Computer software for communicating purposes between microcomputers; Computer software for communicating with users of hand-held computers; Computer software for communication between computers over a local network; Computer software for computer aided software engineering; Computer software for controlling amplifiers; Computer software for controlling and managing access server applications; Computer software for controlling self-service terminals; Computer software for controlling the operation of audio and video devices; Computer software for converting

document images into electronic formats; Computer software for creating and editing music and sounds; Computer software for creating dynamic websites; Computer software for creating searchable databases of information and data; Computer software for database management; Computer software for document management; Computer software for electronic bulletin boards; Computer software for encryption; Computer software for generation of typefaces and fonts; Computer software for instrument tuning; Computer software for inter-network accounting in the telecommunications field; Computer software for interpreting fingerprints or palm prints; Computer software for mobile applications that enable interaction and interface between vehicles and mobile devices; Computer software for mobile phones; Computer software for monitoring the use of computers and the internet by children; Computer software for organizing and viewing digital images and photographs; Simulation software for use in digital computers; Software (Computer -), recorded; Software for computers; Software for searching and retrieving information across a computer network; Software for tablet computers; Typeface font computer software; Video games on disc [computer software]; Video games programs [computer software].

9. The cancellation applicant seeks revocation of the contested mark under sections 46(1)(a) and (b) of the Act.
  
10. Revocation is sought under section 46(1)(a) as a result of alleged non-use during the 5-year time period immediately following the date of completion of the registration procedure i.e. 24 February 2018 to 23 February 2023 (“the first relevant period”). On this basis, the cancellation applicant requests revocation of the contested mark with effect from 24 February 2023.

11. Alternatively, revocation is sought under section 46(1)(b) as a result of alleged non-use for the 5-year period 11 April 2018 to 10 April 2023 (“the second relevant period”), with effect from 11 April 2023.
12. Because the second relevant period runs up until the day of the cancellation application, section 46(3) of the Act is not engaged in this instance.
13. Party A filed a counterstatement, dated 19 July 2023, denying the claims made.

### Consolidation

14. On 18 October 2023, the Tribunal wrote to the parties, directing that these cases be consolidated in accordance with Rule 62(1)(g) of the Trade Mark Rules 2008. From that point on, the two cases proceeded as one consolidated set of proceedings.
15. Party B filed written submissions in lieu of a hearing, whereas Party A did not file any written submissions. Neither party requested a hearing, and so this decision is made following careful consideration of the papers.
16. Party A filed evidence as detailed below.
17. Party A is unrepresented, and Party B is represented by Bird & Bird LLP.

### **Preliminary issues**

#### Issue 1

18. In its statement of grounds for its opposition case, Party A says the following:

“The term ELF CAST has been used to refer to a screen cast, screen capture, broadcast or podcast using software applications bearing the SCREEN ELF trademark since its inception and I claim priority use of the mark in class 9 of the register.”

19. It is not relevant to an opposition based on section 5(2)(b) which party used its mark first. This is an issue that may be relevant to a claim under section 5(4)(a) of the Act. No such claim has been filed and so in respect of the opposition case before me I must restrict myself to examining the section 5(2)(b) claim and the issues relevant to the same. Party A’s earlier mark is, for the purpose of these proceedings, a valid earlier mark in accordance with section 6 of the Act, and it is on this basis that I must proceed.

## Issue 2

20. In its submissions in lieu of a hearing, Party B argues that:

“11. ... In this case, Party A ticked the box on the TM8(N) indicating that its evidence was being sent with the Form. As a result, Party A should not have been given any further opportunity to file evidence in defence of the Earlier Registration.

12. As such, the evidence filed by Party A on 19 July 2023 is the only relevant evidence to be taken into consideration for Party A's defence to the non-use revocation aspect of the proceedings. The evidence that Party A filed after that date, including the evidence and witness statement filed on 17 December 2023, should only be taken into consideration for the opposition aspect of these consolidated proceedings.”

21. I disagree with this analysis. As far as I am concerned, the Tribunal’s letter of 9 November 2023 set the evidence rounds for the consolidated proceedings as a whole and, as a result, Party A’s witness statement of 17

December 2023 and the exhibits filed along with it can be taken into account in respect of the revocation application. I will also consider the evidence that was originally filed with Party A's counterstatement.

### Issue 3

22. In an email of 17 April 2024, Party A challenged the annexes to Party B's submissions in lieu of a hearing as evidence which should be excluded from the proceedings.
23. Annex 1 is a list of Party A's goods from the register which it is legitimate to enclose with submissions. I find that Annex 2, being Companies House information, is admissible as evidence for me to consider in response to Party A's claim for costs. Annex 3 is a copy of a previous case: it is legitimate for parties to provide copies of cases that they consider to be relevant to the matter at hand with their submissions.

### **Evidence**

24. In its Form TM8(N) in response to the revocation application, Party A provided a statement in answer to point 9. on the form, "Evidence in support of the counterstatement" and filed some evidence in the form of Google invoices, with the reference Exhibit MR1.
25. Party A filed further evidence in the form of a witness statement setting out "evidence/submissions" from Mr Nigel Demming, who is "the proprietor of the registered trademark Screen Elf and ... is also a director in the limited company Screen Elf Ltd as well as a Director in the Limited company, Company Jobs Direct Ltd", signed and dated 17 December 2023.
26. The witness statement is accompanied by Exhibits ND01 to ND05.

## DECISION

### The law in relation to revocation and genuine use

27. Section 46 of the Act states that:

“(1) The registration of a trade mark may be revoked on any of the following grounds–

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)...

(d)...

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (“the variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

[...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation,

or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

28. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

29. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023)

requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

30. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36];

*Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

*Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. Arnold LJ followed his summary of the principles to be applied when assessing proof of use with the following paragraph:

“107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

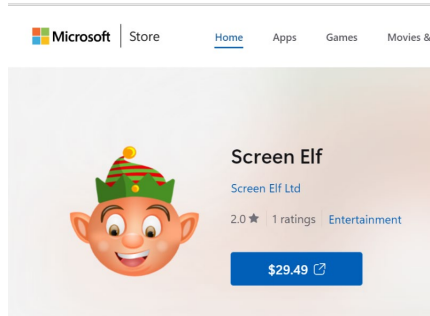
...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

### Form of the mark

32. There are instances of the mark appearing in the evidence as registered.

33. The mark also appears alongside a picture of an elf's head, as per the extract from Exhibit ND01 below.



34. Were the elf's head considered to be part of the mark, I am mindful of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that (with my emphasis added):

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

35. When the word mark is used in conjunction with the picture of the elf's head, the picture reinforces the word "Elf" in "Screen Elf" and "Screen Elf" will continue to be perceived as indicative of the origin of the product at issue. The picture does not detract from the distinctive character of the mark. Therefore, were the elf's head considered to be part of the mark, it would be acceptable variant use of the mark as registered.

### Evidence of use

36. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>3</sup>

37. I remind myself that the first relevant period is 24 February 2018 to 23 February 2023 and the second relevant period is 11 April 2018 to 10 April 2023.

38. In its Form TM8(N) in response to the revocation application, Party A provided the following statement in answer to point 9:

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<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“1. The mark has been advertised and sold on goods in the Microsoft online store since 2018 and continues to be advertised and sold on goods in the microsoft online.

<https://apps.microsoft.com/store/detail/screenelf/9N6D2HTFWV85?hl=en-gb&gl=gb&cid=storebadge&ocid=badge&rtc=1>

2. The mark has been advertised and used on goods sold on the screenelf.com website since 2018 and continues to be advertised [sic] on the screenelf.com website.

<https://screenelf.com>

3. Advertising of the mark has taken place on the Google Adwords platform since 2018. Google invoices are attached for the advertising. Exhibit MR1”

39. Party A’s witness statement setting out “evidence/submissions” primarily sets out arguments in support of Party A’s opposition case, but it does say the following at paragraph 4:

“My trademark SCREEN ELF has been registered since 2017. It is used primarily on software applications used to provide electronic media casting operations, for example screen casts, screen capture, screen recordings, sound recordings, podcasts, live streaming and internet broadcasting, computer gaming and internet gaming and entertainment.

It has been sold thorough [sic] the Microsoft online store since 2018 and continues to be sold.”

40. The statement also gives a brief description of exhibits ND01 to ND05 as follows:

## EXHIBITS

5.14 Please see the following exhibits.

### ADVERTISEMENTS

Exhibit 1 - SCREEN ELF currently advertised in the Microsoft Store (since 2017)

Exhibit 2 - SCREEN ELF currently advertised on screenelf.com website ( since 2017)

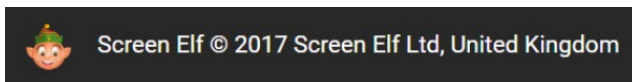
Exhibit 3 - SCREEN ELF google AdWords and Facebook advertising campaign by Company Jobs Direct Ltd (2018 – 2021)

### SEARCH

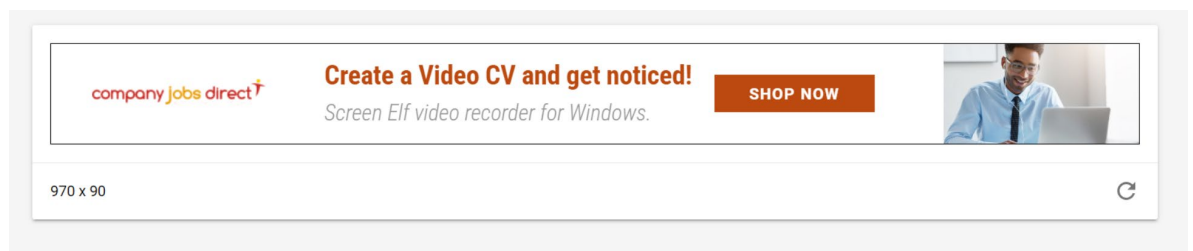
Exhibit 4 - Microsoft Online Store – Search results for ELF CAST showing SCREEN ELF trademarked product.

Exhibit 5 – Google Play store – search results for ELF CAST would bring up SCREEN ELF trademarked product

41. Exhibit ND04 and Exhibit ND05 are offered principally in support of Part A's opposition case, but I will consider them to see if they show any evidence of use.
42. Exhibit ND01 consists of a screenshot from the Microsoft Store showing the Screen Elf app being offered for sale for \$29.49 which is not indicative of the goods being offered for sale in the United Kingdom. The app is described as "a multi-functional App providing HD Live Streaming, Screen Recording, Screen Capture and Dictation". The app has had one 2-star review. The app has a release date of "6/27/2018" – the American date format for 27 July 2018. It is not known when the screenshot was taken, but a copyright notice, "© Microsoft 2023", is shown.
43. Exhibit ND02 is, according to Party A, pages from the screenelf.com website (not a United Kingdom website domain name). The pages describe the features of the Screen Elf app which is said to be available in the Microsoft Store. There is one testimonial from a UK user – Gina Lacey, HR Manager, UK". The pages are undated, but there is a copyright notice:



44. Exhibit ND03 is headed up “**EXHIBIT 3 – SCREEN ELF google AdWords and Facebook advertising campaign by Company Jobs Direct Ltd (2018 to 2021)**”. The exhibit features an extract from Google Web Designer preview mode showing various sizes of advert as per the extract below.



45. The previews of the adverts are undated and because they are previews this evidence does not actually show the adverts as having been finalised and released.

46. I consider Exhibit ND03 alongside Exhibit MR1, which Party A says are Google invoices for advertising on the Google Adwords platform since 2018. The invoices cover the period 17 July 2018 to 30 September 2021. The total expenditure during this period, adjusted for credits, is £917.60. There are 14 invoices, all of which are addressed to “nigel demming, Company Jobs Direct Ltd”. There is no mention of Screen Elf anywhere on these invoices which means it is not possible to tell directly from the exhibit that the invoices were for adverts for Screen Elf, but I note that Party A attests that they were.

47. Exhibit ND04 shows undated search results of the Microsoft Store for “elf cast” returning one instance of the Screen Elf app, priced in US dollars.

48. Exhibit ND05 shows undated search results of the Google Play store for “elf cast”. There are no references to Screen Elf in this evidence.

## Sufficient use

49. Party A has filed no evidence of having accrued any revenue whatsoever from its Screen Elf app, and so there are no turnover figures, or any breakdown of sales provided.
50. The app can be taken to have been in existence in 2017, prior to the relevant periods, in that the copyright statement of Party A's own website has that date. The website promotes the features of the app and says that it is available in the Microsoft Store.
51. There are only two instances in the evidence of the app being offered for sale, both being in screenshots from the Microsoft Store, priced in US dollars, and so this is not indicative of the app being offered for sale in the UK. The app was released in July 2018. One screenshot has a copyright statement of 2023, and the other one is undated. By 2023, the app had garnered one 2-star review.
52. In terms of marketing activity. the only adverts offered in evidence are undated and in a preview state. The Google AdWords invoices are for a total of £917.60 between July 2018 and September 2021, a modest sum. They make no mention of Screen Elf, but Party A attests to them having been for advertising the mark.
53. Party A has not given me any figures in respect of page views of its website or downloads of its app.
54. Nor have I been supplied with information as to market share or the size of the market in question, although the size of the market for apps which support live streaming, screen recording, and so on, must be considerable.
55. Party A has said that its mark has been advertised and sold on goods in the Microsoft Store and screenelf.com since 2018 and continues to be so, and that its goods have been advertised on Google AdWords and Facebook. However, the evidence put forward with a view to corroborating these

statements is extremely thin and further limited by the lack of evidence showing use directed at the relevant territory.

56. I have looked at the evidential picture as a whole and find that it has not been proven that a market for Party A's app and its other goods was established and then preserved during the relevant periods. It should have been open to, and entirely possible for, Party A to supply concrete evidence of revenue having been accrued, but it has not done so.
57. In that regard, I remind myself that, as per section 100 of the Act and the *Awareness Limited* case, the burden lies on the registered proprietor to prove use and I repeat the words of Arnold LJ in *easyGroup Ltd* where it was stated that "genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned."
58. I find that the material provided is inconclusive and wholly insufficient to demonstrate genuine use within the relevant periods and therefore Party A has not shown genuine use of its mark for any of its goods.
59. The application for revocation on the grounds of non-use against Party A's registration has been entirely successful and it will be revoked with effect from the earliest date of 24 February 2023.

#### The opposition

60. Although Party A's mark has been revoked with effect from 24 February 2023, Party A's opposition action of 14 May 2023 remains valid. This is because the effective date of revocation falls after the filing date of the contested mark in the opposition, which is 14 Dec 2022. This means that the earlier mark was still a validly registered mark on the filing date of the contested mark in the opposition proceedings. Therefore, the outcome of the revocation has no bearing upon the opposition, as per the decision of Professor Ruth Annand, sitting as the Appointed Person in *TAX ASSIST* (BL O/220/12).

61. This issue was also the subject of a recent appeal decision from Mr Iain Purvis KC, sitting as the Appointed Person in *MOORES ROWLAND* (BL O/0689/25). Purvis confirmed, as was the case in *TAX ASSIST*, that where the earlier mark is revoked from a date which falls after the filing date of the contested mark, it can still be relied upon in the opposition. It also does not matter that the opposition proceedings were launched on a date which post-dates the revocation date on which point I quote paragraph 21 of *MOORES ROWLAND*:

“I should say that in Tax Assist Prof Annand did not explicitly deal with the situation in which the earlier mark had been revoked from a date prior to the date on which the Application for a declaration of invalidity commenced. In Tax Assist itself as in many of the authorities which she cited, the date of revocation was after the date of commencement of the Application to revoke. However, I am at a loss to understand why this distinction could matter. If the relative rights as between the proprietors of conflicting marks are to be decided as of the date of application of the Later Mark (which is the correct and logical position given the wording of s6(1)), there is no obvious reason why it should matter that the Earlier Mark had ceased to exist by the date of commencement of Opposition proceedings, any more than it should matter that it had ceased to exist by the date of the Decision.”

62. What matters is only that the earlier mark was extant on the register at the filing date of the contested mark.

### **Section 5(2)(b)**

63. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

64. By virtue of its earlier filing date of 21 July 2015, the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act. As it was registered on 24 June 2016, more than five years prior to the date the contested mark was filed, this mark could be subject to proof of use in accordance with section 6A of the Act. However, the applicant requested proof of use for goods and services that are not covered by the earlier mark. On being given the opportunity by the Tribunal to amend its counterstatement in this respect, the applicant did not do so, and so the counterstatement went forward on the basis of proof of use not being requested.

65. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

## Comparison of the goods

66. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

67. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a. The respective uses of the respective goods or services;
- b. The respective users of the respective goods or services;
- c. The physical nature of the goods or acts of service;
- d. The respective trade channels through which the goods or services reach the market;
- e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

68. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

69. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“the GC”) stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

70. The goods for comparison are as follows:

<b>Party A’s goods</b>	<b>Party B’s goods</b>
Class 9	Class 9
Computer software; Recorded computer software; Computer games software;	Computer software; entertainment software; computer game software;

<p>Computer games entertainment software; Downloadable interactive entertainment software for playing computer games; Interactive entertainment software for use with computers; Interactive entertainment software for use with personal computers; Computer application software featuring games and gaming; Computer games software for use with on-line interactive games; Computer games entertainment software; Computer games programs downloaded via the internet [software]; Computer software for controlling the operation of audio and video devices; Computer video game software; Computer software for creating and editing music and sounds; Software (Computer -), recorded; Computer software for audibly controlling a computer and the operation thereof; Computer software applications, downloadable; Computer software downloadable from global computer information networks; Computer software concerned with children's education; Data carriers for computers having software recorded thereon; Downloadable computer software for the transmission of data; Operating and user instructions stored in digital form for computers and computer software [in particular on floppy disks or CD-ROM].</p>	<p>computer and video games; downloadable e-books; downloadable television programmes and films; [data storage apparatus, cards and other storage media for] ... audio books and video recordings; audio visual recordings; podcasts; downloadable podcasts; sound recordings; audio books.</p>
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71. Party B's "computer software" is identical to Party A's "Computer software".
72. Party B's "computer game software" is identical to Party B's "Computer games software".
73. Party B's "computer and video games" is identical to Party A's "Computer games software".
74. Party B's "entertainment software" is *Merix* identical to Party A's "Computer software".
75. I compare Party B's [data storage apparatus, cards and other storage media for] ... audio books and video recordings" with Party A's "Data carriers for computers having software recorded thereon". I take data carriers to be storage media and so they are similar in nature, purpose and method of use to Party B's goods. However, Party B's goods are blank media designed for the storage of audio books and video recordings whereas Party A's goods hold recorded software. I find these goods to be of medium similarity.
76. I compare Party B's "downloadable e-books", "downloadable television programmes and films", "audio visual recordings," "podcasts", "downloadable podcasts", "sound recordings" and "audio books" with Party A's "Computer games software. All are forms of electronic media that are used for entertainment purposes, albeit Party B's content is passively consumed whereas Party A's content is interactive. While there is some overlap in trade channels, such goods would be shelved separately. The goods are not complementary and only in competition to the extent that one might consider different options as to forms of entertainment. Overall, I find these goods to be of low similarity.

## Average consumer and the purchasing act

77. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

78. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A. V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

79. The average consumer for software at large, computer games, other forms of entertainment, and storage media, is a member of the general public who will pay a reasonable amount of attention to the form of software, the type of entertainment, and the specification of the storage media that they are purchasing, although the price of such goods is unlikely to be prohibitive. Overall, I consider the level of attention that would be paid by the average consumer to be of a medium level.

80. Visual considerations will predominate during the purchasing process which will typically be via website pages and the selection of items at the click of a mouse. Verbal factors will play a part when the goods are bought from physical premises.

### **Comparison of the marks**

81. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

82. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

83. The respective trade marks are shown below:

Earlier mark	Contested mark
Screen Elf	ELF CAST

Party A's "evidence/submissions"

84. At paragraph 5.10 of his "evidence/submissions", Party A furnishes me with a definition of the word "casting", albeit he does not cite the source:

5.10 'Casting' Dictionary definition

play (video or audio content from a computer, phone, etc.) on a television screen or other device, usually via a wireless connection, without mirroring the screen of the original device. "the app can cast your device's photos and videos"

There would be a likelihood of confusion on the digital platforms in the minds of the public over a product whose primary role is casting called SCREEN ELF and another product named ELF CAST engaged in similar casting activity.

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85. The digital platforms that Party A refers to are those run by Google, Apple and Microsoft which Party A says are the principal means by which its and Party B's products are consumed.

86. At paragraphs 5.12 and 5.13, Party A says that:

"5.12 The two word mark Elf Cast is phonetically, visually and conceptually similar to the two word mark Screen Elf and is likely to lead to confusion on the part of the public which includes the likelihood of association with the earlier trademark. This is particularly so if the two marks are presented in on line digital platforms where 99% of the global market is dominated by just two major tech companies ...

5.13 I rely on the judgement of the European Court of Justice regarding the similarity of two-word trademarks where one of the words is common. This judgement was delivered in the case of 'Pink Lady' vs 'Wild Pink'".

87. Party A then provides me with a link to a court case. It is not the practice of Hearing Officers to follow such links. However, I do not consider quoting the above case to be of assistance to Party A. While the court<sup>4</sup> annulled the Board of Appeal's decision that the marks in question were dissimilar and found that there was some degree of similarity between them, subsequent cases involving these marks ultimately led to a finding that there was no likelihood of confusion between them.

#### Party B's submissions in lieu

88. Party B draws my attention to the preliminary indication that was issued in respect of this case that notwithstanding any similarity between the contested Class 9 goods, the marks were not considered to be sufficiently similar to support a finding of a likelihood of confusion. However, I note that I am not bound by preliminary indications.

89. Party B contends, at paragraph 39 of its submissions, that "There is only very limited visual similarity between the respective marks ... The three letters ELF is the only common element, but it is placed in different positions in the respective marks. Further, the word ELF is only three letters in length, so the addition of the longer words CAST and SCREEN in the respective marks have a significant impact when visually comparing the marks; this is particularly so for the Earlier Mark, since the word SCREEN is placed at the beginning of the Earlier Mark where it would instantly catch the public's attention - established case law states that in general the beginning of a sign has a significant influence on the general impression made by a mark [at which point Party B footnotes "T-412/08, Trubion; T-109/07, Spa Therapy"], which is relevant here."

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<sup>4</sup> It was actually the General Court, not the CJEU, that made this finding.

90. Party B further contends that there is “no real aural similarity” and “no conceptual similarity” between the marks.

### My analysis

91. The earlier mark consists of the plain words “Screen Elf” whereby the overall impression made by the mark lies in the words themselves.

92. The contested mark consists of the plain words “ELF CAST” whereby the overall impression made by the mark lies in the words themselves.

93. The earlier mark consists of the two words, “Screen Elf” whereas the contested mark consists of the two words “ELF CAST”. As such, the marks share the word “Elf”/ “ELF” but differ in the words “Screen” and “CAST”. Overall, the marks are of medium visual similarity.

94. Aurally, the marks are “Screen Elf” v “ELF CARST”. I find them to be of medium aural similarity.

95. Conceptually, the marks share the concept of an elf, an imaginary being. They differ in respect of the concepts of a screen as in a TV or computer screen and the word “cast”, being short for the word broadcast, as in the broadcast of a radio or television programme. I find them to be of medium conceptual similarity.

### **Purported evidence of actual confusion**

96. In considering Party A’s purported evidence of actual confusion between the marks, Party B’s response at paragraph 49 of its submissions in lieu is as follows:

“i) He submitted Exhibit 4 [Exhibit ND04] on 17 December 2023, which is a screenshot of a search conducted by Party A on the Microsoft Online Store for the mark ELF CAST which shows the SCREEN ELF product in

the search results. However, this does not prove that there is a risk of confusion. The results show lots of different apps, including Party A's app. It does not prove that there is confusing similarity between the two marks. The search clearly included SCREEN ELF in its results because of the inclusion of the word ELF: but this kind of search algorithm has no bearing the assessment of likelihood of confusion. On that logic, the Microsoft Store algorithm seems to suggest that the app name 'Math Commander', which is the first generated result, is also similar to the Opposed Mark! Clearly this is nonsensical. In fact, we believe that these search results demonstrate that there is no chance of confusion – there is no way that a potential buyer of Party B's ELF CAST product would, upon receiving those search results, choose the SCREEN ELF product by mistake;

and

ii) He has also submitted Exhibit 5 [Exhibit ND05], which is a screenshot of a search conducted by Party A on the Google Play store for the mark ELF CAST which he says would bring up the SCREEN ELF product. However, the SCREEN ELF product does not appear in the list of app results at all, so if anything, the evidence suggests that searching for ELF CAST on the Google Play store would not bring up the SCREEN ELF product.”

97. I concur with Party B's analysis of the evidence that Party A has filed. I find that Party A has not supplied evidence of actual confusion between the marks in the marketplace.

### **Distinctive character of the earlier mark**

98. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public –

*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

99. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

100. The earlier mark is a word mark, “Screen Elf”, neither word being an invented word. “Screen” is mildly suggestive of Party A’s goods, whereas “Elf” is not suggestive of the goods. Overall, I find the earlier mark to be inherently distinctive to a medium degree.

101. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks,<sup>5</sup> the word “Elf”/“ELF”. To that extent, I confirm that my view is that that word alone is inherently distinctive to a medium degree.

102. The evidence of use of the earlier mark is not sufficient to raise its level of distinctiveness beyond its inherent level.

### **Likelihood of confusion**

103. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

104. I have found the parties’ marks to be visually, aurally and conceptually similar to a medium degree. I have found that the average consumer of the goods at issue would pay a medium degree of attention during the purchasing

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<sup>5</sup> See *Kurt Geiger v A-List Corporate Limited* (BL O-075-13)

process where visual considerations will predominate, verbal factors playing a part when the goods are bought from physical premises.

105. I have found that the parties' goods range from identical to a low level of similarity. I have also found that the earlier mark has a medium level of inherent distinctive character and that the word alone that is common to both marks is of a medium level of inherent distinctiveness.

106. On the basis of normal and fair use, both marks are word marks and so they could be rendered as capitalised words or in all capitals.

107. The marks share the word "Elf"/"ELF", but it is in a different position in the respective marks. It is at the end of the earlier mark and at the beginning of the contested mark. The marks contain different words – "Screen" and "CAST". Consequently, having seen "Screen Elf" and "ELF CAST", the reasonably circumspect and observant consumer will have noticed and will recall these differences such that there is no likelihood of direct confusion, even where the goods are identical.

108. I will also consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of

the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

109. I am also conscious of the examples referred to in the *L.A. Sugar* case:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

110. While I am aware that the above list is not intended to be exhaustive, the marks before me certainly do not fit neatly into any of examples (a), (b) and (c).

111. Both marks contain words which could be said to be mildly suggestive of the goods at issue: one sits at a computer screen when utilising computer software or playing computer games and content such as films in Party B’s application could be streamed or broadcast. However, the marks are not plausible brand variants of each other by virtue of the word “Elf”/“ELF” being positioned at different points in the respective marks.

112. “Screen Elf” is a phrase which denotes something that helps a computer user operate a computer screen efficiently (in the same way that computer software will often have a “wizard” that enables easy installation), hence a logical brand variant would be a mark such as “Keyboard Elf”. One could just about imagine the brand variant “Cast Elf” as a device that helps one to broadcast content, but not “ELF CAST”.
113. “ELF CAST” could be indicative of a product of the “Elf” company that enables broadcasting (or perhaps it would be seen as a broadcast about elves and other supernatural beings). However, the position of the word “Elf” in the earlier mark means that the average consumer would not see that mark as indicative of a product of the “Elf” company.
114. The average consumer would not consider the two marks to have an economic connection. Rather, they would see the presence of the word “Elf”/“ELF” as coincidental.
115. There is no likelihood of indirect confusion in this case.
116. The opposition fails in its entirety and all of Party B’s Class 9 goods, both opposed and unopposed, proceed to registration along with its applied for Class 41 and Class 42 services.

## **CONCLUSION**

117. Subject to any appeal, the application for revocation on the grounds of non-use against Party A’s registration has been entirely successful and it will be revoked with effect from 24 February 2023. However, that did not prevent Party A’s opposition from being valid as the effective date of revocation fell after the filing date of the contested mark in the opposition. That being said, Party A’s opposition has failed in its entirety.

## **COSTS**

118. Party B has been entirely successful, and I award it costs in line with Tribunal Practice Notice 1 of 2023, detailed below.

Official fees:	£200
Preparing statements and considering considering the other side's statements:	£500
Considering and commenting on the other side's evidence:	£600
Preparation of submissions:	£350
<b>Total:</b>	<b>£1650</b>

119. I order Mr Nigel Demming to pay LUK Holdings Limited £1650. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of August 2025**

**John Williams**  
**For the Registrar**