

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**

[2022] SGIPOS 8

Trade Mark No. 40202006901U

**IN THE MATTER OF A TRADE MARK APPLICATION BY
ARANGUR UG (HAFTUNGSBESCHRANKT)**

FOUNDATIONS OF DECISION

TABLE OF CONTENTS

INTRODUCTION..... 1

PROCEDURAL HISTORY 2

THE APPLICANT’S CASE 3

THE LAW..... 7

DECISION..... 12

 WHO MAKES UP THE RELEVANT PUBLIC 13

 THE PERCEPTION OF THE RELEVANT PUBLIC..... 13

CONCLUSION 21

**In the matter of a Trade Mark Application by
ARANGURU UG (HAFTUNGSBESCHRANKT)**

[2022] SGIPOS 8

Trade Mark No. 40202006901U
IP Adjudicator David Llewelyn
11 March 2022

26 April 2022

IP Adjudicator David Llewelyn :

Introduction

1 While slogans can play an important role in advertising and promotion, attempts to protect them as registered trade marks are often unsuccessful in the absence of evidence of their use in the marketplace. Slogans are often comprised of ordinary words and phrases which are laudatory or calls to action, such as WE TRY HARDER and HAVE A BREAK, making it difficult for them to satisfy the basic requirement of distinctiveness as an indication of trade origin that is necessary for registration as a trade mark. This application raises for determination the question of whether a trader should be given the advantages of registration of a trade mark comprising a slogan without adducing any evidence of its use in Singapore.

2 In this application (the “Subject Application”), Arangur UG (haftungsbeschränkt) (the “Applicant”) seeks to register the following as a trade mark:

PARTY LIKE GATSBY

(the “Application Mark”).

3 The Application Mark is sought to be registered in Classes 41 and 43 in respect of the following services:

Class 41

Audio, video and multimedia production, and photography; providing publications from a global computer network or the Internet which may be browsed; education, entertainment and sports; entertainment booking services; entertainer services; cabarets and discotheques; night clubs; presentation of live performances; ticketing and event booking services for cultural, sports and entertainment events; providing information in the field of entertainment; radio and television entertainment; publication of texts and images, including in electronic form, except for advertising purposes; entertainment information; organisation of conferences, exhibitions and competitions; organisation of parties; organisation of cultural events; organisation of entertainment events; planning (party -) [entertainment]; presentation of variety shows; production of video and/or sound recordings; publishing services; ticket reservation for cultural events; entertainment booking services; entertainment services; arranging and conducting of concerts; rental of audio equipment, photographic and video cameras; rental of lighting apparatus for theatrical sets; rental of public address systems; rental of musical instruments; publication of books, magazines, almanacs and journals; digital video, audio and multimedia entertainment publishing services; presentation of circus performances.

Class 43

Food and drink catering; temporary accommodation; making reservations and bookings for restaurants and meals; rental of furniture, linens and table settings; providing conference, exhibition and meeting facilities; services for providing food and drink; temporary accommodation; temporary accommodation reservations; accommodation bureaux [hotels, boarding houses].

Procedural history

4 On 15 June 2020, the examiner examining the Subject Application issued the first office action objecting to the Application Mark under Section 7(1)(b) of the Trade Marks Act 1998 (the “Act”). In brief, the examiner found

the Application Mark to be devoid of any distinctive character. The examiner's view was that the Application Mark, which consists of the statement "PARTY LIKE GATSBY", serves as a promotional statement suggesting that the services filed for allow its consumers to host or be part of a party like Gatsby from the book and movie "The Great Gatsby", a story revolving around a man being invited to a decadent party in the 1920s by the eponymous host Jay Gatsby at the host's mansion. Hence, in the absence of an accompanying house mark, or other elements that would confer distinctiveness such as a high degree of stylisation, the examiner took the view that it is unlikely that the mark will be perceived as a badge of origin without prior education to the average consumer that it is one. At the conclusion of the first office action, the examiner invited the Applicant to file evidence of use in order to overcome the Section 7(1)(b) objection.

5 The Section 7(1)(b) objection was maintained, notwithstanding two rounds of submissions made by the Applicant to persuade the examiner otherwise. In both the second and third examination reports, the Applicant was again invited to file evidence of use to overcome the Section 7(1)(b) objection, but declined to do so.

6 On 18 January 2022, the Applicant filed a request for an *ex parte* hearing. The *ex parte* hearing was held on 11 March 2022.

The Applicant's Case

7 The Applicant's case before me broadly mirrors its earlier submissions made to the examiner. First, the Applicant submits that the examiner erred in finding (in his first examination report) that the Application Mark serves as "*a promotional statement suggesting that the services filed for allow its consumers*

to host or be part of a party like Gatsby from the book and movie ‘The Great Gatsby’”. According to the Applicant:

(a) It is not grammatically correct to read “Party Like Gatsby” to be a message that the services allow the Applicant’s consumers to “*host... like Gatsby*” because the word “party” would be interpreted as a verb (to mean to enjoy oneself at a social gathering, drinking, dancing or talking to people) by the relevant English-speaking public, given that the syntactical structure of the expression is that of a simile.¹

(b) It is not strictly accurate with reference to the novel “The Great Gatsby” to read the Application Mark to suggest that the services filed for allow one to “*be part of a party like Gatsby*”, as “[i]t is widely known that ... Jay Gatsby had only hosted his lavish parties in the hopes of attracting his former lover, but that he was not an avid party-goer himself”.²

8 Secondly, in respect of the examiner’s view in the second examination report that even if Jay Gatsby did not himself enjoy the parties he hosted, it “*does not mean he is not associated with such parties or give rise to sufficient confusion over the statement leading to the mark’s distinctiveness*”, the Applicant submits that although the name “Gatsby” may be associated with lavish parties, the whole slogan “Party Like Gatsby” is sufficiently distinctive. The Applicant makes the following arguments in support of the distinctiveness of the Application Mark:

¹ The Applicant’s Written Submissions dated 24 February 2022 at [16]–[17].

² The Applicant’s Written Submissions dated 24 February 2022 at [18].

(a) The Application Mark is not purely promotional or laudatory.³ The Application Mark conveys very contradictory ideas and is a surprising and unexpected juxtaposition (the fun and enjoyment of a party versus the loneliness, broodiness and aloofness of Jay Gatsby).⁴ There is a perceptible difference between the reference to the character of Jay Gatsby in the Application Mark and the theme of a “Great Gatsby” party.⁵ While the latter conveys the ideas of luxury, extravagance and decadence, the former does not.⁶

(b) The fact that the Application Mark could “*give rise to sufficient confusion*” over the distinctiveness of the Application Mark points towards inherent distinctiveness, as it suggests that the Application Mark is sufficiently vague or impenetrable in meaning to trigger a cognitive process in the minds of the relevant consumer.⁷ The “confusion” in the minds of the relevant public and the questions regarding the underlying meaning of the Application Mark involve the identity of “Gatsby” (who is Gatsby?), the association between the name “Gatsby” and parties (why party like Gatsby?), or the reconciliation of the character of Gatsby and the idea of parties (how did Gatsby party?).⁸

(c) The word “like” triggers a cognitive process on the part of the relevant consumer as it will prompt “*one ... to wonder of the likeliness*”

³ The Applicant’s Written Submissions dated 24 February 2022 at [22].

⁴ The Applicant’s Written Submissions dated 24 February 2022 at [22] and [24].

⁵ The Applicant’s Written Submissions dated 24 February 2022 at [22].

⁶ The Applicant’s Written Submissions dated 24 February 2022 at [22].

⁷ The Applicant’s Written Submissions dated 24 February 2022 at [25].

⁸ The Applicant’s Written Submissions dated 24 February 2022 at [25].

of Gatsby and ask, 'how did Gatsby party?' or 'how to party like Gatsby'".⁹

(d) While the examiner did not provide any evidence that the name “Gatsby” is widely known in Singapore, or that the general public in Singapore would draw a link between the name “Gatsby” and the novel “The Great Gatsby”, and draw an even further connection to 1920s themed parties, some intellectual effort on the part of the consumer is required to draw the link, assuming that the general public has the relevant knowledge.¹⁰

(e) As regards the examiner’s statement that “*a consumer who chances upon a mark with multiple meanings would only ponder about its meanings rather than prima facie regard the mark as an indication of trade source*”, the Applicant submits that the reverse is true, that is, a mark which has multiple meanings causes consumers to ponder on the underlying meanings of the mark, and requires at least some interpretation by the relevant public possesses a certain level of originality which renders it sufficiently distinctive.¹¹

(f) The Application Mark may not be highly imaginative, but it has a certain originality which is likely to be remembered by consumers.¹² The meaning and the originality of the Application Mark will be perceived as an incitement to purchase, but does not constitute a mere

⁹ The Applicant’s Written Submissions dated 24 February 2022 at [26]-[27].

¹⁰ The Applicant’s Written Submissions dated 24 February 2022 at [32]-[33].

¹¹ The Applicant’s Written Submissions dated 24 February 2022 at [37]-[38].

¹² The Applicant’s Written Submissions dated 24 February 2022 at [39].

piece of information.¹³ On the contrary, the Application Mark will enable consumers to identify the commercial origin of the services at issue.¹⁴

9 It will become obvious later on that the Applicant has crafted its case in line with the factors/characteristics found by European Union (“EU”) courts to point towards a finding of distinctiveness.

The Law

10 It is uncontroversial that, in order to be registered, trade marks must perform the most basic function of *distinguishing* the goods of the trader from those of his competitors in the marketplace (*Han’s F&B Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 at [57]). Therefore, the necessary ingredient of a registrable trade mark is distinctiveness, in the sense of indicating the origin of goods or services bearing the mark (*Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2017] 1 SLR 35 (“*KitKat*”) at [21]). Under the Act, this requirement of distinctiveness finds expression in, among others, Section 7(1)(b) of the Act which provides:

“7.—(1) The following must not be registered:

...

(b) trade marks which are devoid of any distinctive character; ...”

11 A summary of the principles governing distinctiveness was set out by the Singapore Court of Appeal in *KitKat* at [22], citing *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) at para 8-016:

¹³ The Applicant’s Written Submissions dated 24 February 2022 at [39].

¹⁴ The Applicant’s Written Submissions dated 24 February 2022 at [39].

(a) For a mark to possess a distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, and thus distinguish those goods or services from goods or services of other undertakings.

(b) The distinctive character of a mark must be assessed by reference to: (i) the goods or services in respect of which registration is applied for; and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well informed, observant and circumspect.

(c) The criteria for assessing distinctive character are the same for all categories of marks. Nevertheless, the perception of the relevant public may not always be the same for all categories of marks, and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.

12 At the end of the day, the critical question to ask is whether the average consumer would appreciate the indication of origin significance of the trade mark in question without first being educated that it is used for that purpose (*KitKat* at [33]). It also bears noting that the assessment is done by examining the inherent nature, features and characteristics of the mark, absent consideration of its use, promotion or marketing by the promoter of the mark (*Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 (“*Love & Co*”) at [35] and [53]).

13 As mentioned above at [11(c)], slogans are a category of marks for which it is often more difficult to establish distinctiveness than it is for others. It has been observed that slogans often suffer from a disability from a trade mark

point of view since they are usually laudatory about some aspect or quality of the goods or services in question (*Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 16th Ed, 2018) at para 10-085). The Court of Justice of the European Union ("CJEU") has also noted that where a slogan serves a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, it could be taken into account that average consumers are not in the habit of making assumptions about the origin of products on the basis of slogans (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GmbH* (C-64/02) ("*Erpo*") at [35]).

14 In support of its submissions, the Applicant cites a number of EU decisions which have considered and allowed the registration of slogans under the equivalent of Section 7(1)(b) of the Act. It will be useful to take a closer look at these cases, given the dearth of Singapore case law on the registrability of slogans, although obviously these are in no way binding or authoritative in Singapore.

15 I begin with the decision of the CJEU in *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-398/08) ("*Audi AG*"). The case concerned the application for registration of the expression "*Vorsprung durch Technik*" (a German expression meaning in English 'advance or advantage through technology') in various classes of goods and services. The registration was refused, save for the registration in respect of Class 12 which was accepted on account of the distinctive character which the mark had acquired in respect of vehicles and apparatus for locomotion by land.

16 On appeal, the CJEU found the expression to be sufficiently distinctive for registration. The following points in the CJEU’s judgment are noteworthy:

(a) In so far as the public perceives the mark as an indication of the origin of goods or services, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character (at [45]).

(b) Where the expression can have a number of meanings, constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, the presence of such characteristics is *likely* to endow that mark with distinctive character, although the existence of such characteristics is not a necessary condition for establishing that a slogan has distinctive character (at [47]).

(c) Slogans, which generally express objective messages, can still be capable of indicating to the consumer the commercial origin of the goods or services in question, if they are not descriptive for the purpose of the EU’s equivalent of Section 7(1)(c) of the Act and “*possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public*” (at [57]).

17 On the facts, the CJEU took the view that even if it were to be supposed that the slogan conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, the slogan only suggests a causal link and accordingly requires a measure of interpretation on the part of the public (at [58]-[59]). The CJEU also found that the slogan exhibited a certain originality and resonance which makes it easy to remember (at [59]). Further, since the mark was a widely known slogan which

had been used by Audi for many years, the fact that members of the relevant public are used to establishing the link between that slogan and Audi's motor vehicles makes it easier for them to identify the commercial origin of the other goods or services covered by the application (at [59]).

18 The Applicant also relies on *Pro-Aqua International GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-133/13), in which the slogan "Wet Dust Can't Fly" was found to be sufficiently distinctive for registration. The EU General Court took the view that the expression "wet dust can't fly" called for an interpretative effort on the part of consumers who would not be able to associate it immediately with the goods and services in question (at [50]). It was also of the view that the slogan exhibited a degree of originality and a certain resonance which made it easy to remember (at [50]). In reaching its view, the EU General Court took into account, in particular, that the concept of "wet dust" is literally inaccurate, since dust is no longer dust when it is wet. Hence, the juxtaposition of those two words gave that concept a fanciful and distinctive character (at [49]).

19 In *Lidl Stiftung & Co. KG v EUIPO* (T-305/16) ("*Lidl Stiftung*"), the slogan "Love to Lounge" was found to be sufficiently distinctive. There, it was argued that the expression will, first and foremost, be perceived as a piece of information and not as an indication of the commercial origin of the goods which it covers. The EU General Court held that the slogan was sufficiently distinctive. Among other things, the Court stated:

93 Next, it must be pointed out, as the Board of Appeal found, that the contested mark conveys an abstract message referring to the interest of potential consumers in relaxing. The Board of Appeal was likewise right in noting that the contested mark requires some cognitive effort on the part of the relevant public. It is a syntactically-correct combination of English words, which can be used in a great number of contexts. Consequently, when the contested mark is used in relation to

the goods in question, namely clothing, footwear and items of headgear, the relevant public will have to place that mark in a certain context, which requires an intellectual effort.

94 Furthermore, even though that mark is not highly imaginative, it has a certain originality which is likely to be remembered by consumers. In that regard, the Board of Appeal was right in pointing out that the contested mark is not without a certain elegance, given the clever use of only two nouns and a preposition and the repetition of the letter 'l', all of which combined lend a degree of euphony to the mark as a whole.

95 The meaning and the originality of the contested mark will be perceived as an incitement to purchase, but do not constitute a mere piece of information as the applicant claims. On the contrary, the contested mark will enable consumers to identify the commercial origin of the goods at issue. Consequently, that mark has inherent distinctive character.

20 Before turning to address the Applicant's submissions, I note that the EU decisions cited by the Applicant have set out various characteristics of marks that may point in favour of a finding of distinctive character as a trade mark. While these characteristics may be useful indicators of distinctiveness, I do not consider that the EU courts intended for them to be considered in a formulaic or mechanistic manner so as to mandate a finding of distinctive character (as an indication of trade origin) whenever one or more of these characteristics are present. Every case must turn on its facts. My view is consistent with *Audi AG* in which the CJEU stated that "*as a rule, the presence of those characteristics is **likely** to endow that mark with distinctive character*" (emphasis added in bold), referring to the General Court's finding that the mark could have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered (*Audi AG* at [47]).

Decision

21 At the outset, I note the Applicant's point that it has not amassed sufficient evidence of use of the Application Mark to support a claim that the

Application Mark has acquired distinctiveness as a result of its use in Singapore.¹⁵ Hence, the present case turns entirely on the inherent distinctiveness (or lack thereof) of the Application Mark.

Who makes up the relevant public

22 The question of distinctive character under Section 7(1)(b) of the Act is to be answered from the perspective of the average consumer who is deemed to be reasonably well-informed, reasonably observant and circumspect (see *Love & Co* at [33]). Hence, the antecedent question is who makes up the relevant class of persons. The Applicant submits that the relevant class of persons is the general public in Singapore.¹⁶ Given the range of services claimed, I accept the Applicant’s submission in this regard. In the local context, this would be the average discerning man or woman on the Mass Rapid Transit (“MRT”). As will be explained below, I am not satisfied that this man or woman on the MRT would perceive the Application Mark as a badge of origin *without first being educated that it is one*.

The perception of the relevant public

23 It bears reiterating that while the same test as to distinctiveness applies across all categories of trade marks, it has been recognised that the perception of the relevant public may not be the same for all marks (see above [11(c)]). In this regard, the Applicant asserts that “*in today’s market environment, consumers are now highly accustomed to the usage of slogans as both promotional statements and a brand or trade name*”.¹⁷ I am, however, unable to

¹⁵ The Applicant’s Written Submissions dated 24 February 2022 at [7].

¹⁶ The Applicant’s Written Submissions dated 24 February 2022 at [30].

¹⁷ The Applicant’s Written Submissions dated 24 February 2022 at [11].

place weight on this assertion as there is no evidence that this is indeed the case for the relevant public in the present case.

24 Here, it is important to consider what the relevant public would understand “Party Like Gatsby” to mean. This, in part, turns on what the relevant public understands about the word “Gatsby” when used in the context of the services claimed. I have not found it easy to make sense of the Applicant’s submissions on this issue. It seems that the difficulty stemmed from the Applicant’s attempt to have its cake and eat it too, by refusing to concede that the relevant public has the relevant knowledge of “Gatsby”, but at the same time building a case on distinctiveness on the basis that the relevant public has such knowledge. On the one hand, the Applicant criticises the examiner’s decision for failing to “*provide any evidence that the name ‘Gatsby’ is widely known in Singapore, or that the general public in Singapore would draw a link between the name ‘Gatsby’ and the novel ‘The Great Gatsby’, and draw an even further connection to 1920s themed parties*”.¹⁸ During the hearing on 11 March 2022, counsel also clarified that the Applicant’s primary position was that there is no evidence that the relevant public in Singapore would know who Jay Gatsby is.

25 On the other hand, however, the Applicant does not explain the implications of this “primary position”. Instead, its entire case on distinctiveness appears to rest on the assumption that the relevant public would have the relevant knowledge of the novel “The Great Gatsby”, the character of Jay Gatsby and the link between Gatsby and 1920s themed parties. Among other things, the Applicant asserts that:

¹⁸ The Applicant’s Written Submissions dated 24 February 2022 at [32].

(a) The Application Mark contains contrary and conflicting ideas about the fun and enjoyment of a party versus the loneliness, broodiness and aloofness of Jay Gatsby.

(b) Some intellectual effort on the part of the consumer is required to link the name “Gatsby” to the novel “The Great Gatsby” and then to the idea of 1920s themed parties.

26 Further, the Applicant seems to go beyond an “assumption” to expressly “*acknowledge[s] that there is an association between the name ‘Gatsby’ and the idea of parties*”,¹⁹ seemingly accepting that the relevant public would be able to make this association. In its submissions dated 7 July 2021, the Applicant informed the examiner that the Application Mark “*is merely allusive of the idea of the fun and enjoyment that one may experience at the Applicant’s shows...*” and “*is also a nod to the 1920’s theme that the novel The Great Gatsby was set in*”. Counsel confirmed during the hearing the Applicant’s position that the Application Mark has an allusive element to it.

27 In view of the above and in particular the fact that the Applicant’s entire case on distinctiveness is constructed on the average discerning consumer’s knowledge of The Great Gatsby, the character of Jay Gatsby and the association with 1920s themed parties, it seems only fair to regard the Applicant’s position to be that the relevant public has the aforementioned knowledge and I will proceed on this basis.

28 In my view, it is more likely than not that the average discerning consumer in Singapore would have a general sense of what “The Great Gatsby” novel/movie is about such that the use of the word “Gatsby” in the context of

¹⁹ The Applicant’s Written Submissions dated 24 February 2022 at [34].

the services applied for would call to his/her mind parties from the 1920s. I note that the novel is generally regarded as a classic and has been made into a film on a number of occasions, the most recent of which starred Leonardo DiCaprio, a Hollywood star of some fame. I note further that this film was aired in cinemas in Singapore. In any event, it bears emphasis that the Applicant has acknowledged this association between “Gatsby” and both the idea of parties and the 1920s. That said, I would not expect the average discerning consumer to be sufficiently acquainted with the storyline of “The Great Gatsby” to appreciate the contrast between the fun and enjoyment of a party and Jay Gatsby’s “*loneliness, broodiness and aloofness*”, so as to perceive the Application Mark to be imaginative, surprising or unexpected. It is more likely that A-level students studying English Literature would have this level of appreciation or understanding of “The Great Gatsby”, but this would not be representative of the average man or woman on the MRT.

29 When viewed as a whole, I do not consider that the Application Mark is inherently distinctive as an indication of trade origin so as to surmount the objection under Section 7(1)(b) of the Act. First, I agree with the CJEU’s observation in *Erpo* that consumers are not in the habit of perceiving slogans to be badges of origin (see [13] above). Hence, it is, as a starting point, practically more difficult to establish the necessary distinctiveness in respect of a slogan, though the test is no different for slogans.

30 Secondly, I do not accept the Applicant’s argument that the Application Mark would be perceived to be imaginative, surprising or unexpected, especially given the association between “Gatsby”, the idea of parties and the 1920s. As I have found above at [28], the average consumer would not be sufficiently familiar with the storyline of “The Great Gatsby” or the character of Jay Gatsby to appreciate the contrary and conflicting ideas the Application

Mark apparently contains. I am also not persuaded that the inclusion of the word “like” adds to the distinctiveness of the Application Mark. Even if the average consumer does not understand the word “Gatsby” or understands “Gatsby” to mean something else (for instance, a particular brand of hair gel), he would at least be able to infer that “Gatsby” is indicative of the manner in which one is encouraged to party, given the word “like”. In my view, the Application Mark, when read in its entirety and especially when used in the context of the claimed services, would be understood as a purely promotional puff or call to action (in particular, an invitation or encouragement to be part of a 1920s themed party, or if the consumer does not understand the word “Gatsby” or understands “Gatsby” to mean something else, an invitation or encouragement to be part of a certain type of party), as opposed to something that is *both* a promotional statement and a badge of origin.

31 Thirdly, even if I accept the Applicant’s assertions that the Application Mark will trigger a cognitive process in the mind of the average consumer, I do not consider this *per se* is sufficient to endow the Application Mark with the distinctive character required by the TMA. In the first place, what the CJEU said was that slogans could be capable of indicating commercial origin if they “**possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public**” (emphasis added in bold). It seems to me that the “*cognitive process*” must follow from the “*originality or resonance*” of the trade mark in question. This would make more sense given that even a task as basic as reading entails a cognitive process and I do not consider that the CJEU intended to suggest that marks that require reading, for example, would necessarily be distinctive in a trade mark sense. Further, the fact that a slogan is able to trigger a cognitive process in the minds of the relevant public was not the sole or decisive basis for the finding of distinctive character in the cases

cited by the Applicant. For example, in *Audi AG*, the CJEU also took into account, *inter alia*, the fact that members of the relevant public were used to establishing the link between the slogan and the motor vehicles manufactured by Audi and was of the view that this made it easier for that public to identify the commercial origin of the goods or services covered in the application (see above at [17]). In *Lidl Stiftung* which concerned the “*Love to Lounge*” mark, the EU General Court considered that the mark had “*a certain originality which is likely to be remembered by consumers*” as it “*is not without a certain elegance*” (see above at [19]). Although reasonable people may disagree with that view, it bears emphasis that the critical question is whether the average discerning consumer is able to immediately perceive the Application Mark to be a badge of origin, not whether the Application Mark triggers any cognitive process. For the reasons given above, I do not consider that the Application Mark would be immediately perceived by the relevant public to be a badge of origin.

32 Moving on, I note that the Applicant has highlighted various other trade marks on the register to support its case, including the registration of “ROBIN HOOD” for, *inter alia*, financial services and debt recovery services and “GULLIVERS TRAVEL ASSOCIATES” for travel agency services. It is trite that the state of the register is irrelevant to the factual inquiry on distinctiveness. The observations of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305, cited with approval in *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165 at [193], are germane:

Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has

long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.

33 In any event, I do not see how the examples cited would assist the Applicant given that they are not in the nature of slogans. The position on registrability may be quite different if the marks were to be “TRAVEL LIKE GULLIVER” or “STEAL LIKE ROBIN HOOD”. For completeness, I note that the Applicant has also drawn my attention to a recent registration of a stylised mark bearing the words “The Great Gatsby Party”. For the same reason stated above at [32], I am not inclined to place weight on this mark.

34 Finally, the Applicant urges the Registrar to consider accepting the Application Mark for the services which do not relate to the planning of parties. It has proposed the following amendments to the specification of services:

Class 41

Audio, video and multimedia production, and photography; providing publications from a global computer network or the Internet which may be browsed; education, entertainment and sports; entertainment booking services; entertainer services; cabarets and discotheques; night clubs; presentation of live performances; ticketing and event booking services for cultural, sports and entertainment events; providing information in the field of entertainment; radio and television entertainment; publication of texts and images, including in electronic form, except for advertising purposes; entertainment information; organisation of conferences, exhibitions and competitions; ~~organisation of parties~~; organisation of cultural events; organisation of entertainment events; ~~planning (party)~~ **[entertainment]**; presentation of variety shows; production of video and/or sound recordings; publishing services; ticket reservation for cultural events; entertainment booking services; entertainment services; arranging and conducting of concerts; rental of audio equipment, photographic and video cameras; rental of lighting apparatus for theatrical sets; rental of public address systems; rental of musical instruments; publication of books, magazines, almanacs and journals; digital video, audio

and multimedia entertainment publishing services;
presentation of circus performances.

Class 43

Food and drink catering; temporary accommodation; making reservations and bookings for restaurants and meals; rental of furniture, linens and table settings; providing conference, exhibition and meeting facilities; services for providing food and drink; temporary accommodation; temporary accommodation reservations; accommodation bureaux [hotels, boarding houses].

35 The Applicant submits that there is no evidence that consumers would immediately associate the novel “The Great Gatsby” or the character of Jay Gatsby with the remaining services and, further, that the relevant public will have to place the Application Mark in a certain context, which requires an intellectual effort.

36 While it is, in appropriate cases, possible for objections to be overcome by narrowing the scope of the specification, I do not consider the Applicant’s proposed amendment saves the Subject Application from rejection in this case. In *Intercontinental Exchange Holdings, Inc v EU Intellectual Property Office* (Case T-430/16), the EU General Court stated at [37]:

[I]t is apparent from settled case-law that, although the decision of the competent authority refusing registration of a trade mark must, in principle, state reasons in respect of each of the goods or services concerned, the competent authority may nevertheless use purely general reasoning where the same ground of refusal is used in a category of goods or services which are interlinked in a sufficiently direct and specific way, to the point where they form a sufficiently homogenous category or group of goods or services...

37 As I pointed out in *Intercontinental Exchange Holdings, Inc v Chicago Mercantile Exchange Inc* [2018] SGIPOS 20 at [37], the General Court’s approach is a common-sense one that should be adopted when considering services of an interlinked nature. In the present case, the services filed for are

generally related to entertaining or the hosting/planning of parties/events. During the hearing, the Applicant’s counsel accepted that the specification sets out what is effectively a package of services which surrounds the events organised by the Applicant. Given the interlinked nature of the services claimed, I am of the view that the objection under Section 7(1)(b) applies to all those services as a sufficiently homogeneous group. I also note that the effect of the proposed amendment to the scope of the Applicant’s rights, if granted, would be minimal. Bearing in mind that the exclusive rights of a trade mark proprietor extend to use on similar goods or services, the Applicant could rely on the Application Mark, if granted, to threaten with infringement proceedings any traders who use the expression “Party Like Gatsby” for party planning services, arguing that they are similar services.

Conclusion

38 Having considered all the submissions made, the objection under Section 7(1)(b) of the Act is maintained.

David Llewelyn
IP Adjudicator

Ms Gillian Tan and Mr Mark Teng (That.Legal LLC) for the Applicant
