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

[2025] SGIPOS 7

Trade Mark No. 40202116551R

IN THE MATTER OF A TRADE MARK APPLICATION BY

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LTD

GROUNDS OF DECISION

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[2025] SGIPOS 7

Trade Mark No. 40202116551R
Principal Assistant Registrar Mark Lim Fung Chian
21 July 2025, 18 August 2025

29 October 2025

Principal Assistant Registrar Mark Lim Fung Chian:

Introduction

1 This is the third time this Tribunal has been asked to decide on the registrability of a slogan as a trade mark in recent years. In each case, the applicant did not rely on any evidence of use of the relevant slogan to support the application.

2 In *In the matter of a trade mark application by Aranguru UG (Haftungsbeschrankt)* [2022] SGIPOS 8 ("*Aranguru*"), IP Adjudicator David Llewelyn rejected the application to register "PARTY LIKE GATSBY" as a trade mark for services in classes 41 and 43.

3 Less than a year later, in *In the matter of a trade mark application by Schweiger, Martin Rainer Gabriel* [2023] SGIPOS 1 ("*Schweiger*"), IP Adjudicator Vince Gui allowed the registration of the slogan "STRONG BY CHOICE" for goods in class 25.

4 In the present case, I have been asked to determine the registrability of "UNLEASH INNOVATION" for goods and services in classes 9, 40 and 42.

5 I reject the application and set out my reasons below.

Procedural background

6 On 13 July 2021**,** the Applicant applied to register Singapore Trade Mark No. 40202116551R ("UNLEASH INNOVATION") for the following goods and services ("the Application Goods and Services"):

> Class 9: Semiconductors; computer memory chips; wafers, namely, silicon wafers and semiconductor circuits.
>
> Class 40: Custom manufacture of semiconductors, memory chips, wafers and integrated circuits.
>
> Class 42: Product research, custom design and testing for new product development, and technology consultation services regarding electrical and electronic products, semiconductors, semiconductor systems, semiconductor cell libraries, wafer and integrated circuits.

(the "Application Mark").[1]

7 There followed a series of correspondence between the Applicant and the trade mark examiner who examined the application ("the Examiner") and the senior trade mark examiner who reviewed the Examiner's decision ("the Senior Examiner"). The correspondence concluded with the Senior Examiner, in agreement with the Examiner, maintaining that the Application Mark is not eligible for registration under s 7(1)(*b*) of the Trade Marks Act 1998 ("TMA"). This provision states that *"trade marks which are devoid of any distinctive character"* must not be registered.

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[1] The Applicant claimed a right of priority under s 10 of the Trade Marks Act 1998 based on its prior filing of the mark in the same classes in the U.S.A. on 21 June 2021. The claim for priority does not impact the merits of the present application, and is mentioned in this footnote for completeness.

8 For the most part, the arguments raised by the Applicant before me are a detailed elaboration of the submissions made to the Examiner/Senior Examiner. In this section, I therefore only briefly mention the Examiner/Senior Examiner's objections and the Applicant's responses by way of background. I will consider these in greater detail in my Grounds of Decision below.

9 On 3 September 2021, the Examiner issued an initial examination report objecting to the Application Mark under s 7(1)(*b*) TMA. To overcome this objection, the Applicant was invited to submit evidence of acquired distinctiveness through use in Singapore for at least five years before the application date.

10 On 29 December 2021, the Applicant declined to submit evidence of use. It argued that the Application Mark possesses inherent distinctive character and should be registered even in the absence of any evidence of use.

11 On 5 July 2022, the Examiner maintained her objection under s 7(1)(*b*) TMA. In addition, the Examiner introduced a new objection under s 7(1)(*c*) TMA, asserting that the mark cannot be registered as it *"*consists exclusively of signs that may serve in trade to designate the kind, quality [or] intended purpose*"* of the Application Goods and Services.

12 On 27 October 2022, the Applicant argued that the objections under both s 7(1)(*b)* TMA and s 7(1)(*c*) TMA should be waived.

13 On 21 November 2023, the Examiner maintained both objections.

14 On 7 March 2024, the Applicant made a "request for reconsideration." Under this process, a fresh panel of experienced examiners (referred to in this case as the "Senior Examiner") will review the Examiner's decision.[2]

15 On 5 February 2025, the Senior Examiner agreed to waive the objection under s 7(1)(*c*) TMA. However, she maintained the objection under s 7(1)(*b*) TMA.

16 On 3 June 2025, the Applicant requested for an *ex parte* hearing under rule 24(2)(*b*) of the Trade Mark Rules 2008 and sought to persuade this Tribunal to accept the Application Mark. The matter was heard by me on 21 July 2025. At the hearing, I directed the Applicant to provide some additional information and make further submissions on a certain issue (discussed at [60] – [69] and [74] – [75] below). The Applicant duly did so on 18 August 2025.

Applicant's Submissions

17 In its Written Submissions ("WS"), the Applicant relies on the following grounds to argue that the Application Mark is inherently distinctive in relation to the goods and services applied for:

(a) the Application Mark possesses resonance and originality that induce substantial cognitive effort from average consumers (Argument 1);

(b) the distinctive character of the Application Mark is especially pronounced in relation to the services applied for in Class 40 (Argument 2); and

[2] See Trade Marks Registry Circular No. 8/2015 dated 13 Oct 2015.

(c) foreign trade mark registrations for the Application Mark are indicative of its distinctive character (Argument 3).[3]

18 At the hearing before me, the Applicant raised an additional argument that the Application Mark should be registered on the ground that, in the words of the Applicant's counsel Mr Tjia, *"*certain analogous Singapore registrations*"* had been accepted previously. The Application Mark should therefore similarly be registered. (Argument 4). This argument had been made to, and rejected by, both the Examiner and Senior Examiner.[4]

19 I will analyse each of these arguments in detail below. Before doing so, I discuss more generally the registrability of slogan marks under Singapore law.

Registrability of Slogan Marks under s 7(1)(*b*) TMA

20 The main purpose of trade mark law is to prevent consumer confusion by ensuring that businesses use unique identifiers (i.e. trade marks) to distinguish their goods or services from those of other traders.

21 The registration of a trade mark confers on the proprietor powerful rights. Under s 26(1) TMA, the proprietor of a registered trade mark has the exclusive rights to use the trade mark and to authorise other persons to use the trade mark, in relation to the goods or services for which the trade mark is registered.

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3 WS at [12].

4 See the Applicant's letter to IPOS dated 27 October 2022 at [23] and [24], and the letters from IPOS to the Applicant dated 21 November 2023 (at [2]) and 5 February 2025 (at [2.12]).

22 This right is infringed by a person who uses in the course of trade a sign which is identical with the trade mark on such goods and services, without the proprietor's consent (s 27(1) TMA).

23 Importantly, especially in the context of the current case, infringement also occurs if the sign used is similar to the trade mark and is used in relation to goods or services which are similar to those for which the trade mark is registered. In these situations, the proprietor must additionally show that there exists a likelihood of confusion on the part of the public (s 27(2) TMA).

24 Accordingly, before a trade mark can be registered, it must meet a number of conditions. Among other things, s 7(1)(*b*) TMA mandates that "trade marks which are devoid of any distinctive character" "*must* not be registered" (emphasis added). Both the Examiner and the Senior Examiner rejected the Application Mark under this provision (see [9] – [15] above).

25 As noted by Professor Ng-Loy Wee Loon, S.C. in *Law of Intellectual Property of Singapore* (Third Edition, 2021, Sweet & Maxwell) (*"Ng-Loy"*) at [21.3.1]: *"*Distinctiveness is a term of art in trade mark law. It refers to the ability of a mark to function as the badge of origin of the goods or services in question."

26 It is self-evident that no single trader should be permitted to monopolise a mark which is devoid of any distinctive character; other traders should equally be permitted to use such marks in relation to their own goods or services.

27 To ascertain whether a mark is inherently distinctive, "[t]he critical question to ask is whether the average consumer would appreciate the trade mark significance of the mark in question without being educated that it is used

for that purpose*."* (*Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2017] 1 SLR 35 ("*KitKat*") at [33])

28 Of particular relevance to the present case, the Court of Appeal in *KitKat* also made clear that:

> …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**.
>
> (*KitKat* at [22(c)], citing *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) at para 8-016; emphasis in bold and underlining mine)

29 The learned IP Adjudicator in *Aranguru* further observed at [1] that:

> 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.

30 At the start of my grounds of decision, I mentioned this Tribunal's recent decisions in *Aranguru* and *Schweiger*, which also involved applications to register slogans as trade marks. I now examine these decisions in greater detail.

31 *Aranguru* involved an application to register the slogan "PARTY LIKE GATSBY" for entertainment and hospitality services in Classes 41 and 43 (*Aranguru* at [2] & [3]). The examiner in that case found the mark to be devoid of distinctive character as it served 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.*"* (*Aranguru* at [4]).

32 The decision extensively discussed case law from the European Union ("EU") on the inherent distinctiveness of slogans under their equivalent of s 7(1)(*b*) TMA (while making clear that "obviously these [cases] are in no way binding or authoritative in Singapore*"* (at [14])). For example, the IP Adjudicator cited the propositions set out by the Court of Justice of the European Union ("CJEU") in *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case C-398/08) at [47] & [57] that a slogan is likely to be distinctive if it "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" or if it has "a certain originality or resonance, requiring at least some interpretation by the relevant public, or set[s] off a cognitive process in the minds of that public*"* (*Aranguru* at [16(b) & (c)]). The applicant had argued that "PARTY LIKE GATSBY" created contradictory ideas - the fun of a party versus Jay Gatsby's "loneliness, broodiness and aloofness" - which would trigger cognitive processes in consumers' minds (*Aranguru* at [8]).

33 However, the IP Adjudicator rejected these arguments, finding that the average consumer would not appreciate these literary contrasts and would instead perceive the mark as *"*a purely promotional puff or call to action (in particular, an invitation or encouragement to be part of a 1920s themed party)" rather than as both a promotional statement and badge of origin (*Aranguru* at [30]). The IP Adjudicator emphasized that while triggering a cognitive process is relevant, it must follow from the mark's *"originality or resonance."* The application was ultimately refused as the IP Adjudicator found that the mark

would not be immediately perceived by the relevant public as a badge of origin (*Aranguru* at [31]).

34 The *Schweiger* case concerned the slogan "STRONG BY CHOICE" applied for in class 25 for "shorts" and "T-shirts" (*Schweiger* at [1]). It was heard by a different IP Adjudicator.

35 The examiner in *Schweiger* refused registration, viewing the slogan as a *"*commercial tagline or an advertising phrase which simply serves to suggest that the Applicant is committed to providing shorts and T-shirts which are able to withstand wear, i.e. durable and lasting" (*Schweiger* at [2(a)]).

36 The IP Adjudicator disagreed with the examiner's assessment, finding that *"strong"* is not commonly used to describe T-shirts and shorts as being *"durable,"* and noting that *"*it is not common to hear people describing a T-shirt or shorts as 'strong'*"*. Further, the slogan must be viewed holistically without undue emphasis placed on the word "strong". The IP Adjudicator found "STRONG BY CHOICE" to be "an interesting play of words" that is "unusual in its meaning and syntax" and "ambiguous in that it can interpreted to mean different things by different people" (*Schweiger* at [16]).

37 Like in the case of *Aranguru*, the IP Adjudicator in *Schweiger* also referred to several EU decisions. Ultimately, he was satisfied that the phrase "Strong by Choice" "exudes a certain degree of originality in relation to T-shirts and shorts, which enables consumers to identify the commercial origin of the goods." He concluded that "[c]onsumers would not immediately perceive, without further thought, that the Applicant is committed to providing durable T-shirts and shorts. The phrase is ambiguous and calls for some interpretive and cognitive effort on the part of the relevant consumers in discerning its

appropriate meaning." According to the IP Adjudicator, this distinguished it from *Aranguru*, where the slogan "PARTY LIKE GATSBY" "was found to be nothing more than a promotional statement encouraging the reader to party in a certain way or be part of a certain type of party, in relation to the type of services for which registration was sought*"* (*Schweiger* at [27]).

38 At first blush, it does not appear that the cases of *Aranguru* and *Schweiger* can be so easily reconciled. In both cases, the average consumer of the goods or services in question was found to be the general public in Singapore (see *Aranguru* at [22] and *Schweiger* at [16][5]). Intuitively, it would seem that the general public in Singapore is more likely to associate the slogan "Strong by Choice" with a desirable trait like "durability" when used on T-shirts and shorts, than she would think that the slogan "PARTY LIKE GATSBY" suggests that consumers of the entertainment and hospitality services of interest would be able to host or be part of a party like Gatsby from the book and movie *"The Great Gatsby."*

39 But on closer examination, the findings of the IP Adjudicator in *Aranguru* were premised on how the applicant had argued its case. This had led the IP Adjudicator to proceed 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*"* (see *Aranguru* at [24] – [27]). In these circumstances, it was not at all surprising that

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5 For completeness, it should be mentioned that the IP Adjudicator in *Schweiger* did not expressly state that the average consumer in the case before him referred to the general public in Singapore. Instead, he referred simply to *"the average consumer buying T-shirt and shorts"* (at [16]). But it is reasonably clear from the context that he viewed such consumers to be the general public in Singapore (see the references to the "average consumer" in [4(e)], [12] – [14], [18] – [19]).

the IP Adjudicator concluded that "PARTY LIKE GATSBY" was not inherently distinctive for entertainment and hospitality services.

40 The key takeaway from *Aranguru* and *Schweiger* is that the assessment as to whether a specific slogan is registrable as a trade mark is a nuanced exercise, which is highly dependent on the specific facts, the evidence adduced, and the arguments raised in each case.[6] It should be added that in many cases, reasonable people may well disagree as to whether a particular slogan is (or is not) inherently distinctive in relation to the goods or services applied for.

Registrability of Application Mark

41 I turn now to consider the arguments raised by the Applicant in the present case.

42 For ease of reference, these are as follows

(a) the Application Mark possesses resonance and originality that induce substantial cognitive effort from average consumers (Argument 1);

(b) the distinctive character of the Application Mark is especially pronounced in relation to the services applied for in Class 40 (Argument 2);

(c) foreign trade mark registrations for the Application Mark are indicative of its distinctive character (Argument 3); and

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6 For more examples of cases discussing whether a slogan is inherently distinctive, see *Intellectual Property of Singapore TM Work Manual (Version 3.1), Chapter 14 on Slogans* and European Union Intellectual Property Office ("EUIPO") Boards of Appeal *Case-law Research Report – The distinctive character of slogans (October 2021).*

(d) the Application Mark should be registered on the ground that analogous Singapore registrations had been accepted previously and the Application Mark should therefore similarly be registered (Argument 4).

Argument 1: The Application Mark Possesses Resonance and Originality that Induce Substantial Cognitive Effort from Average Consumers

43 The Applicant's WS centred mainly on this argument.[7] This ground was rejected by both the Examiner and Senior Examiner.[8]

44 According to the Applicant, the combination of the words "UNLEASH" and "INNOVATION" is unique and unusual. This is premised on the Applicant's contention that the verb "unleash" is typically paired with nouns associated with the uncontrollable, the irrational, or the unpredictable. In contrast, "innovation" is typically measured and controlled. This is particularly true when the Application Mark is viewed through the lens of the average consumer of the Application Goods and Services, which would likely be *"professionals and specialists within the semiconductor and information technology industries."*[9]

45 The Applicant argues[10] that *"[t]hese qualities of the Application Mark are hallmarks of inherent distinctiveness."* It relies in particular on the case of *Lidl Stiftung & Co. KG v EUIPO* [2017] Case T-305/16 ("*Lidl Stiftung*") at [93]

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7 See WS at [13] – [40]. In comparison, the submissions in support of Ground 2 were set out in seven (7) paragraphs ([41] – [47]), for Ground 3 in three (3) paragraphs ([48] – [50]) and Ground 4 was only raised in the course of oral submissions.

8 See the Procedural Background set out at [9] – [15] above.

9 WS at [15] – [24].

10 WS at [23].

– [95], noting that the IP Adjudicator in *Schweiger* (at [23]) also relied on these same passages:

> 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.
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> 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**.
>
> (emphasis added by Applicant)

46 I am prepared to accept that the average consumers of the Application Goods and Services are likely to be *"professionals and specialists within the semiconductor and information technology industries."* This was the position taken by both the Examiner[11] and Senior Examiner,[12] and also accepted by the Applicant.[13]

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11 See IPOS letter to the Applicant dated 5 July 2022 at [2].

12 See IPOS letter to the Applicant dated 5 February 2025 at [2.9].

13 WS at [21].

47 However, I am unable to accept that the combination of the words "UNLEASH" and "INNOVATION" is unique and unusual, which ultimately is the foundation on which the Applicant's case rests.

48 I disagree with the Applicant that the word "innovation" would typically be paired only with verbs such as "stimulate" and "foster", and that *"the verb 'unleash' is… antithetical to the noun 'innovation'."*[14]

49 While innovation can of course take place in a measured and controlled manner, there is no reason why it cannot be spontaneous. As an example, at the hearing, I mentioned to the Applicant's counsel the well-known story of how the exclamation "Eureka" became associated with a sudden triumphant discovery.[15] Interestingly, Eureka is the motto of California, which is home to the innovation hub of Silicon Valley.

50 As observed by the Examiner:

> The intended meaning of the [Application Mark] is the idea of setting free and perpetuating innovation. This is a desirable and achievable ideal that can be realised through the Applicant's products and services in the semi-conductor industry. Thus, we are of the view that the mark would be perceived as a promotional message to advertise the Applicant's goods and services with the promise of enabling the consumers to achieve a desired outcome and an inspirational message. The average consumers, who is [*sic*] not in the habit of relying on such statement alone to identify the trade source of the goods and services claimed, would not rely on the mark, which does not

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14 WS at [16] – [18].

15 As the story goes, the famous Greek mathematician, Archimedes, was trying to work out how to calculate the volume of an irregularly-shaped object. When he stepped into a bath, he noticed that the water level rose. He had a flash of inspiration and suddenly understood that the volume of the water displaced must be equal to the volume of the part of his body which he had submerged. In his excitement, he proclaimed *"Eureka! Eureka!"* and ran naked through the streets of Syracuse to share his discovery with others. (This version is taken from the entry in *Wikipedia* on *"Eureka (word)"* (accessed on 22 September 2025).)

> have any other element that could indicate trade origin, as an unambiguous badge of origin.[16]

51 The Applicant argued that the Application Mark can *"be used in multiple different contexts. This is because an average consumer must exercise cognitive and intellectual effort to place the Application Mark into context."*[17]

52 The Applicant agreed that the Application Mark can be interpreted as conveying one of more of the following statements, but argued that these statements *"have substantive differences in meaning as illustrated below*:

S/N	Statement	What fosters innovation	Subject matter of the innovation
1	"the Applicant has a strong and desirable culture of promoting innovation"	Applicant	Applicant's corporate culture
2	"the Applicant offers innovative and cutting-edge goods and services"	Applicant	Applicant's goods and services
3	"the Applicant's goods and services enable their customers to produce innovative creations"	Applicant's goods and services and/or Applicant's customers	Creations of the Applicant's customers

"[18]

[16] See IPOS letter to the Applicant dated 21 November 2023 at [2].

[17] WS at [25].

[18] WS at [27] – [28].

53 I disagree. As succinctly stated by the Senior Examiner, the Application Mark is just *"an ordinary statement promoting positive attributes of the Applicant or its goods and services."*[19]

54 In refusing the Application Mark, both the Examiner and Senior Examiner also highlighted to the Applicant numerous articles (13 in total) where the exact slogan "UNLEASH INNOVATION" had been used by other traders such as Amazon Web Services and Intel.[20] The Applicant sought to distinguish these examples by arguing that the slogan was being used in a different context and in respect of different goods and services.[21]

55 Leaving aside the fact that several of the articles cited were discussing the semiconductor business, the point remains that the Application Mark is a slogan which many different traders would like to use when talking about innovation. It is clearly not a slogan which should be monopolised by a single trader such as the Applicant.

56 To reiterate the test in *KitKat* (at [33]), *"[t]he critical question to ask is whether the average consumer would appreciate the trade mark significance of the mark in question without being educated that it is used for that purpose."* I find that the average consumer in the present case would not view the Application Mark as an indication of trade origin.

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19 See IPOS letter to the Applicant dated 5 February 2025 at [2.9].

20 See IPOS letters to the Applicant dated 21 November 2023 at [2] and 25 February 2025 at [2.8].

21 WS at [31] – [40].

Argument 2: The Distinctive Character of the Application Mark is Especially Pronounced in relation to the Services Applied for in Class 40

57 As a fallback argument, the Applicant asserted that even if the Application Mark is rejected for goods and services in Classes 9 and 42, it should be accepted for the services applied for in Class 40, namely, *"custom manufacture of semiconductors, memory chips, wafers and integrated circuits"* (emphasis added). According to the Applicant, *"in the context of such services for manufacturing, the role of such manufacturers is not to innovate, but to build in a controlled and careful manner, according to fixed specifications and designs."*[22]

58 This argument was not made to the Examiner or Senior Examiner. It was raised for the first time before me.

59 I am not persuaded that the Application Goods and Services should be delineated so finely such that the Application Mark can be said to be distinctive of the Applicant's services of interest in Class 40 ("custom manufacture") but not Class 42 ("custom design").

60 At the hearing, I also pointed out that registration of the Application Mark for the Applicant's services of interest in Class 40 could extend protection to the Applicant's goods of interest in Class 9 (i.e. *"semiconductors; computer memory chips; wafers, namely, silicon wafers; and semiconductor circuits"*). This is because, under s 27(2) TMA, infringement can occur if a trade mark is used in relation to goods which are similar to those services for which the trade

[22] WS at [41] – [47]. The extract quoted is from [42].

mark is registered.[23] On the authority of the High Court's decision in *Sunrise Plus v Sunrider Corporation* [2025] SGHC 51 ("*Sunrise*") at [52] – [59], the Class 9 goods are likely to be considered similar to the Class 40 services.

61 As the case of *Sunrise* was only drawn to the Applicant's attention at the hearing, I enquired if the Applicant would like to make further submissions to address the point which I had raised. On 28 July 2025, the Applicant confirmed that it wished to do so, and it duly filed its Further Submissions ("FS") on 18 August 2025.

62 The Applicant argued that the inherent distinctiveness of a mark must be assessed with respect to the specific goods and services for which registration is sought.[24] I have no doubt that this is correct. To use a commonly-used illustration of this principle, the word "APPLE" cannot be registered as a trade mark for "apples" (in Class 31), but can be registered as a trade mark for "computers" (in Class 9).

63 The query I had raised pertains to a much narrower issue. Essentially, assuming a mark is not registrable for certain goods, can an applicant obtain protection for such goods by the back door by registering the mark for the service of manufacturing these same goods?

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[23] S 27(2) TMA provides that: A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign where because —

(*a*) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(*b*) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.

[24] FS at [5] – [21].

64 The Applicant says that it can. It argues that no unjustifiable monopoly would be granted by allowing registration of the Application Mark in Class 40.[25] According to the Applicant, *"if… the Application Mark is more descriptive in nature, it should be allowed to register. This is because a mark of a more descriptive nature is less likely to be infringed upon."*[26] The Applicant's argument appears to be that allowing registration for the services of interest in Class 40 would not prevent other traders from using the mark on the goods of interest in Class 9, since such use would be descriptive and not infringing;[27] or that such use (being descriptive) would not give rise to a likelihood of confusion, which is one of the elements required to establish infringement under s 27(2) TMA.

65 In particular, the Applicant relies on *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2018] SGHC 81 (*"Big Box"*) at [44] – [45], which it quotes in full[28] as follows:

> [44] Under European trade mark law, it was once thought that the European Court of Justice ("**ECJ**") in Procter & Gamble Company v OHIM (BABY DRY) [2002] RPC 17 ("**Baby Dry**") had moved towards the position whereby it was permissible to take into account defences (such as the "own name" defence) in determining distinctiveness. This led Jacob J (as he then was) in Nichols Plc's Trade Mark Application [2003] RPC 16 ("**Nichols**") at [15] to comment that Baby Dry appeared to have "shifted the balance towards trade mark owners who have the resources and foresight to use the registration system and against the public in general and weaker and less organised companies." For this reason, Jacob J decided to refer the issue to the ECJ with the comment at [14] that the problem with saying "registration will not harm the public: if a third party wants to use the mark descriptively he has a defence" is that

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25 FS at [11] – [13], [22] – [27].

26 FS at [23].

27 See the Court of Appeal's decision in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 2 SLR 382 at [38].

28 FS at [11] – [12].

> "in the practical world powerful traders will naturally assert their rights even in marginal cases." In the end, the ECJ made clear at the reference that **the fact that the effects of registration of the trade mark were limited by the exceptions under the applicable European Union … law had no impact on the assessment of distinctiveness:** see Nichols Plc v Registrar of Trade Marks [2005] RPC 12 at [34].
>
> [45] Whilst this point has not been authoritatively decided in Singapore, I note that academic commentators are **supportive** of the more rigorous approach which **ignores defences when assessing distinctiveness**: see Ng-Loy Wee Loon, Law of Intellectual Property of Singapore (Sweet & Maxwell, 2nd Ed, 2014) at para 21.3.38. Whilst it is not necessary to decide the point, **I am of the view that this is the correct approach.** The distinctiveness requirement is **assessed in its own right and should not be affected by the issue of defences to infringement.** Thus, in the case of names, distinctiveness of the name as a trade mark must be **assessed in relation to the market and the goods or services in question.** Does the name enable the public to distinguish those goods or services from those of other traders? This is a matter that is addressed **from the perspective of the average, reasonably well-informed consumer**. …"
>
> (emphasis in bold added by the Applicant; footnote in FS providing alternative citations for the case of *Nichols* omitted)

66 It is helpful to briefly set out the facts in *Nichols*, which is relied on by the Applicant[29] and discussed in *Big Box* in the paragraphs reproduced above. These facts are straightforward. The applicant in that case (Nichols Plc) applied to register "Nichols" as a trade mark for certain goods. The United Kingdom Trade Marks Registry rejected the application on the basis that "Nichols" is a common surname and not distinctive. The question therefore was whether a fairly common surname should be regarded as "devoid of distinctive character." The appellant argued that "Nichols" says nothing about the goods in question and should therefore be registrable. Further, if a person wished to use her

[29] FS at [11], [12] and [22].

surname "Nichols" on her own goods, she could always rely on the "own name" defence.[30]

67 It was in this context that Jacob J (as he then was) stated in a well-known paragraph (*Nichols* at [14]) which is cited in part in *Big Box*, and which I reproduce in full below:

> The problem with saying "registration will not harm the public: if a third party wants to use the mark descriptively he has a defence" is this: that in the practical world powerful traders will naturally assert their rights even in marginal cases. By granting registration of a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark one is placing a powerful weapon in powerful hands. Registration will require the public to look to its defences. With such words or phrases the line between trade mark and descriptive use is not always sharp. Moreover it must not be forgotten that the monopoly extends to confusingly similar marks. In any marginal case defendants, SMEs particularly, are likely to back off when they receive a letter before action. It is cheaper and more certain to do that than stand and fight, even if in principle they have a defence.

68 These observations apply with equal force in the case before me. In *Nichols*, the court opined that the mark in question should not be registered as other traders who legitimately wish to use the mark would then need to rely on the "own name" defence. In the present case, if the Application Mark is registered in Class 40, other traders who wish to use the mark in Class 9 must be satisfied they can establish that such use is descriptive or that the Applicant will not be able to establish a likelihood of confusion.

69 Thus, far from supporting the Applicant's arguments, *Nichols* in my view sets out persuasive reasons why the Application Mark should not be registered for the services of interest in Class 40. To permit registration is

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30 This defence was applicable at the material time.

tantamount to allowing registration for the goods of interest in Class 9 for which the Application Mark is not distinctive.

70 I should also reiterate that, as mentioned above at [59], I am not persuaded that the Application Mark is distinctive of the Applicant's services of interest in Class 40 in the first place.

Argument 3: Foreign Trade Mark Registrations for the Application Mark are Indicative of its Distinctive Character

71 The Applicant highlights that the Application Mark has been registered for the Application Goods and Services in Hong Kong, Europe, the United Kingdom, the United States of America, Japan and the People's Republic of China.[31]

72 The Applicant accepts the Examiner and Senior Examiner's view that registration in other jurisdictions is not sufficient to establish that a mark is registrable in Singapore.[32]

73 However, the Applicant asserts that *"[t]he foreign registrations represent a uniform view across foreign trade mark offices that the Application Mark possesses sufficient distinctive character for registration... [and] clearly illustrates that the inherent distinctiveness of the Application Mark is a reasonable and defensible conclusion."*[33]

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31 WS at [48] & [49]. Details of the foreign trade mark registrations obtained are exhibited in the Applicant's Bundle of Documents at "Tab D".

32 See WS at [50] and letters from IPOS to the Applicant dated 5 July 2022 (at [2]), 21 November 2023 (at [2]) and 5 February 2025 (at [2.11]).

33 WS at [50].

74 At the hearing before me, I pointed out that the registration certification for the corresponding application in the UK only showed that the mark was registered in Class 9. I enquired whether the application had been filed in Classes 40 and 42 as well, and if so, what was the outcome of the application. I also asked whether corresponding applications had been made in any other common law jurisdictions.

75 The Applicant informed me in its Further Submissions that the UK application was only filed in Class 9. The Applicant also shared that the corresponding application had also been registered in and India, and is pending in Canada.[34]

76 On the surface, there is certainly some attraction in the argument that the position in Singapore should not differ from other jurisdictions whose laws relating to inherent technical distinctiveness are generally aligned with Singapore law. It is, however, trite (and accepted by the Applicant) that foreign registrations are not binding in Singapore. This is because trade mark law is territorial, and the relevant laws and practices in different jurisdictions may differ. The submissions made and evidence adduced before the trade mark registries in these jurisdictions may also be different.

77 Further, trade mark registries around the world receive and process a vast number of trade mark applications, of which only a very minute number will be contested.[35] In the present case, I note that none of the various jurisdictions where the corresponding application has been accepted for registration has issued a decision explaining the reasons for such acceptance.

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34 FS at [28] – [31]. Details of the additional foreign trade mark registrations/applications are exhibited in the Applicant's Supplementary Bundle of Documents.

35 See [83] – [84] below for some statistics pertaining to the situation in Singapore.

There is therefore no way to assess the cogency of the position taken in these other jurisdictions, and no way to know whether these positions would survive a challenge by a third party.

78 Both the Examiner and the Senior Examiner were not persuaded to change their position by the registration of the corresponding application in other jurisdictions. I likewise maintain my position that the Application Mark is "devoid of distinctive character" and "must not be registered" pursuant to s 7(1)(*b*) TMA.

Argument 4: The Application Mark should be Registered on the Ground that Analogous Singapore Registrations had been Accepted Previously and the Application Mark should Therefore Similarly be Registered

79 Finally, the Applicant points out that the Trade Mark Registry had previously accepted *"analogous"* applications containing the word "INNOVATION." This argument was not included in the Written Submissions but orally raised at the hearing before me. It was also previously made to the Examiner.[36]

80 In particular, the Applicant relied on a prior registration for "EMPOWERING INNOVATION" in respect of (among other things) "semiconductor integrated circuit" (in Class 9) and "semiconductor integrated circuit design services, development services and technology consultation services" (in Class 42).[37]

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[36] See letter from the Applicant to IPOS dated 27 October 2022 at [23] – [24].

[37] Singapore TM No. T0415788Z (Class 9) and Singapore TM No. T0415790A (Class 42).

81 Essentially, the argument is that the Trade Marks Registry should adopt a consistent practice when examining such marks. The Application Mark is therefore also deserving of registration by parity of reasoning.

82 Both the Examiner and Senior Examiner rejected this argument. As they observed, the prior registrations are not identical to the Application Mark and/or are used for different goods or services. The Senior Examiner also observed that *"the Registry's decisions in the past can do no more than to give an indication of what has or has not been thought acceptable at that time."*[38]

83 I agree with these observations. In addition, what often goes unsaid is that there are tens of thousands of trade mark applications a year, the majority of which secure registration. For example, in the last three (3) years, the number of trade mark applications and registrations was as follows:[39]

	Applications			**Registrations**		
	2022	**2023**	**2024**	**2022**	**2023**	**2024**
Total (Classes)	60,166	55,109	55,080	40,635	52,699	67,529

84 It is very rare for an applicant whose mark is rejected by the Trade Mark Registry to request this Tribunal to reverse an examiner's decision. In a typical

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38 See letters from IPOS to the Applicant dated 21 November 2023 (at [2]) and 5 February 2025 (at [2.21]).

39 See IPOS Statistics (2022-2023) and IPOS Statistics (2023-2024). The numbers are reflected on a per class basis, so the Application Mark would count as three (3) applications as it is applied for in three classes. It should also be noted that many of the registrations for each year are likely to be in respect of applications made in previous years; there is a time lag between application, examination, advertisement (to enable third parties to object to the registration), and issuance of the registration certificate. Nonetheless, the statistics give a good indication of the volume of cases which are handled by the Trade Marks Registry.

year, this Tribunal only hears between one (1) to three (3) such cases, and often none at all. For example, in the last three (3) years, there were three (3) such hearings in 2022,[40] and one (1) each in 2023[41] and 2024.[42] Accordingly, an examiner's decision is almost never subject to elaborate scrutiny by this Tribunal, with the aid of detailed submissions (supported by case authorities and supporting documents) from the relevant applicant.

85 In these circumstances, and particularly since there is no clear bright line between a mark that is *"devoid of distinctive character"* and one which barely crosses this threshold, a diligent applicant will almost certainly be able to locate prior registrations which purportedly support its own application. It is therefore not surprising at all that the Trade Marks Registry has consistently maintained that such local "precedents" are of limited (if any) persuasive value.

86 Further, at the oral hearing before me, I asked the Applicant's counsel if he found any analogous marks which had been rejected when conducting the search to uncover the allegedly analogous registered marks which he is relying on. His answer was that he is not personally aware as he had not joined the Applicant's agent at that time and did not conduct the searches.

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40 These were the cases of *Schweiger* (which was heard in 2022) and *Aranguru*, which I have discussed in some detail in these grounds of decision; and *In the matter of a Trade Mark Application by Floor Xpert Pte. Ltd.* [2022] SGIPOS 9.

41 *In the matter of a trade mark application by Louis Vuitton Malletier* [2023] SGIPOS 10. The relevant mark was applied for in four (4) classes, which explains why IPOS Statistics (2022-2023) states that there were four (4) *ex parte* hearings in 2023 as the statistics are provided on a "per class" basis for ease of comparison.

42 *In the matter of a trade mark application by BioMedical Research Group Inc. & Anor.* [2024] SGIPOS 3.

87 Accordingly, even if it were permissible to look to prior applications to try to ascertain a consistent practice, this would not be possible in the present case since the picture presented to me is incomplete.

Summary and Conclusion

88 S 7(1)(*b*) TMA provides that a trade mark which is *"devoid of any distinctive character"* must not be registered. This means that the average consumer of the Application Mark must be able to appreciate that goods or services with the slogan "UNLEASH INNOVATION" originate from the Applicant without being educated that it is used for this purpose. (*KitKat* at [33]; *Ng-Loy* at [21.3.1])

89 In this case, the average consumers in question are professionals and specialists within the semiconductor and information technology industries (see discussion at [46] above).

90 It is more difficult to establish distinctive character for the Application Mark as the average consumer may not perceive an advertising slogan to denote origin. (*KitKat* at [33]; *Aranguru* at [1])

91 I am not persuaded that registrations for the corresponding mark in other jurisdictions or allegedly "analogous" trade marks which had been registered in Singapore assist the Applicant. I have no knowledge of the evidence adduced or arguments (if any) made in any of these cases. Further, none of these registrations was subject to the same scrutiny as in the present case, and there is no document explaining the reasons for accepting these marks for registration. For the foreign registrations, the relevant laws and practices may also differ.

92 Based on the facts and the evidence adduced in the present case, I agree with the Examiner and Senior Examiner that the Application Mark would be perceived as a promotional message, and not as a badge of origin. I would likewise refuse the mark for registration.

93 Other traders should be able, without improper motive, to use the slogan "UNLEASH INNOVATION" for their own goods and services. They should also be able to use a similar slogan on similar goods/services without putting themselves at risk of a trade mark infringement suit.

94 For the record, I am grateful to the Applicant's counsel for his helpful submissions.

Mark Lim Fung Chian
Principal Assistant Registrar

Mr Lucas Tjia and Mr Teo Shu Xiang (Amica Law LLC) for the Applicant