

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2187193
BY GARY FRANK DORRINGTON AND PHILLIP ANTONY CURRAN
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 49927 KY KARSTEN MANUFACTURING CORPORATION**

TRADE MARKS ACT 1994

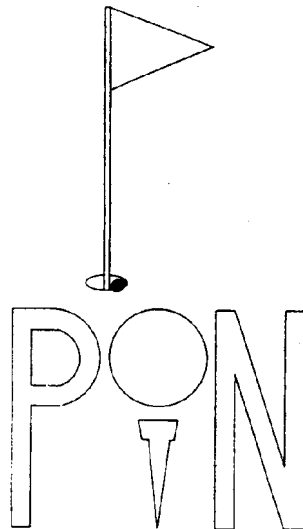
**IN THE MATTER OF Application Number 2187193
by Gary Frank Dorrington and Phillip Antony Curran to register
a Trade Mark in Class 25**

and

**IN THE MATTER OF Opposition thereto under
Number 49927 by Karsten Manufacturing Corporation**

BACKGROUND

1. On 25 January 1999 Gary Frank Dorrington and Phillip Antony Curran applied to register the following trade mark:



in Class 25 for "Clothing, footwear, headgear".

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 30 June 1999 Mewburn Ellis on behalf of Karsten Manufacturing Corporation filed a Notice of Opposition stating that the opponent is the registered proprietor of the following United Kingdom registered trade marks:-

Mark	Registration No.	Registration Date	Class	Goods
PING	1197329	8 June 1983	28	Sporting articles (other than clothing) for use in playing the game of golf

PING	1313897	23 June 1987	25	Articles of outerclotthing; articles of waterproof clothing; all included in Class 25
PING	1432807	19 July 1990	18	Travelling bags, sports bags, umbrellas; parts and fittings for all these goods; all included in Class 18
PING DAY	B1014338	14 July 1973	28	Golf clubs
PING E-Z-LITE	1228240	13 October 1984	28	Sporting articles (other than clothing) for playing the game of golf

In summary, the grounds of opposition were:-

1. Under Section 5(2)(b) of the Act because the mark applied for is confusingly similar to registration 1313897 (above), owned by the opponent and registered for the same and similar goods.
2. Under Section 5(3) of the Act because the mark applied for is similar to the opponents earlier trade mark registrations 1197329, 1432807, B1014338 and 1228240 (above), which qualify as famous trade marks under the provisions of Section 56 of the Act, such that even if the applicants' mark were to be registered for goods which are not identical or similar to those for which the opponent's mark is protected, the use by the applicant's of their mark would take unfair advantage of and be detrimental to the distinctive character and repute of the opponent's mark.
3. Under Section 5(4)(a) of the Act by reason that use of the mark applied for by the applicant in respect of the goods the subject of their application is liable to be prevented by the law of passing off.
4. Under Section 3(1) of the Act because the mark applied for is devoid of any distinctive character, in respect of the goods applied for, such that it is incapable of distinguishing such goods of one undertaking from those of another.
5. Under Section 3(3)(b) of the Act in that use of the mark applied for by the applicant following registration would result in deception on the part of the public, in the light of the substantial reputation and goodwill existing in the opponent's marks.
6. Under Section 3(4) of the Act because use of the mark by the applicants would be prohibited by the law of passing off or the provisions of Section 56 of the Act.
7. Under Section 3(6) of the Act by reason of the application being made in bad faith.
8. Under the Registrar's discretion.

3. On 20 September 1999 the applicants filed a counterstatement denying the above grounds and asked for the application to proceed to registration. Both sides asked for an award of costs in their favour. Both sides filed evidence and the matter came to be heard on 23 January 2001 when the applicants for registration were represented by Mr Farrington of Langner Parry and the opponents by Mr Grimshaw of Mewburn Ellis.

Opponents' Evidence

4. This consists of a statutory declaration by John Clark dated 16 February 2000. Mr Clark is the managing director of Ping Europe Limited, the European subsidiary of Karsten Manufacturing Corporation (the opponents). Mr Clark states that he has held his present position for the last two years, has worked for the company for approximately five and a half years and that the facts and evidence presented in his declaration are based on his own knowledge or are taken from public record or the records of his company.
5. Mr Clark firstly confirms that his company's parent, the opponents, is the registered proprietor of UK registrations Nos. 1197329, 1313897, 1432807, 1014338 and 1228240 which are all in force and refers to Exhibit JC1 to his declaration which consists of print outs from the UK Patent Office containing details of these registrations.
6. Mr Clark goes on to state that his company's mark PING has been continuously in use throughout the UK since at least as early as 1970 with the consent of and control of the parent (opponent) company. The mark is used on all products that his company distributes and sells in the UK including golf clubs, golf bags, golf balls, golf accessories, clothing (e.g. pullovers, shirts, waistcoats, sweaters, jackets and trousers), and headgear (e.g. caps, visors and straw hats). In support of this, Mr Clark draws attention to a number of samples of the opponent's catalogues and brochures, in particular the following Exhibits attached to his declaration:-

Exhibit JC2 - a sample of a brochure relating to the opponent's golf clubs;

Exhibit JC3 - a sample of a brochure relating to the opponent's golf bags;

Exhibits JC4, JC5, JC6, JC7, JC8 and JC9 - samples of brochures advertising the mark PING in relation to various items of clothing from 1993, 1994, 1995, spring 1996, autumn 1996 and spring 1997 respectively;

Exhibit JC10 - a sample of a brochure advertising the mark PING in relation to various items of headgear;

Exhibit JC11 - a sample of a brochure advertising the mark PING in relation to golf accessories such as umbrellas, ties, belts, wood head covers, head covers, headgear and key rings.
7. Mr Clark also provides the following details of the annual turnover figures of his company for the United Kingdom since 1973 and the money spent on marketing, including advertising, in association with the mark PING in the United Kingdom since 1990:

Table 1

YEAR	TOTAL TURNOVER (£)
1973	37,532
1994	120,768
1975	260,086
1976	323,969
1977	474,341
1978	817,543
1979	904,572
1980	1,244,025
1981	1,288,464
1982	1,409,138
1983	1,932,324
1984	2,351,568
1985	2,912,836
1986	4,389,443
1987	6,715,847
1988	7,066,452
1989	7,336,939
1990	8,700,002
1991	8,931,904
1992	9,383,399
1993	11,840,621
1994	11,944,172
1995	11,336,439
1996	14,125,492
1997	10,169,876
1998	13,203,508

1999 (to 30/11/99)	14,001,482
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Table 2

YEAR	MARKETING (£)
1990	746,428
1991	785,619
1992	756,442
1993	706,524
1994	635,621
1995	834,302
1996	745,823
1997	923,783
1998	1,039,415
1999 TO 30/11/99	1,013,262

8. Next, Mr Clark sates that the trade mark PING has been and is currently advertised in a number of magazines and trade publications and Exhibit JC12 in his declaration sets out details of these magazines and publications from 1998 onwards. The mark is also advertised on television and Exhibit JC13 to the declaration consists of a "working sheet" showing television advertisement numbers (spots) from 1998 onwards.
9. Mr Clark goes on to state that his company also carries out additional marketing activity in relation to the PING mark which includes exhibition stands at the British Open for the last fifteen years, the United Kingdom Golf Trade Show for the last ten years and strong representation on the European mens, ladies and senior tours, including the sponsorship of players.
10. Mr Clark points out that the products which his company supplies are available in both high street and specialist golf stores and Exhibit JC14 to his declaration is a list of retailers who sell goods under the PING trade mark in the UK.
11. Mr Clark concludes by stating that the mark PING is also used on the stationery, invoices, pamphlets, business cards, brochures, boxes, crates and labels with and in which the opponents goods are supplied to UK customers and Exhibit JV15 contains examples of such stationery, envelopes, compliment slips and business cards. Since 1996 Mr Clark's company has spent £21,000 each year on stationery bearing the PING mark in the UK.

Applicants' Evidence

12. The Applicants' Evidence consists of a statutory declaration by Gary Frank Dorrington, dated 17 May 2000, who states that he is one of the joint applicants for trade mark number 2187193.
13. Mr Dorrington goes on to state that he conceived the trade mark applied for as an original idea. It occurred to Mr Dorrington that golfers or golf fans do not have any identifying form of attire in the same way for instance that replica football shirts provide an identity to soccer fans. He says that his idea was based on the flag or pin which is the essential aim of the sport of golf - to get the ball into the hole where the pin is placed. Mr Dorrington showed his concept to his friend Antony Curran (the other joint applicant) who was enthusiastic and had his sister in law (a graphical artist) work on the original design. One of the designs that resulted is the mark which is now applied for.
14. Mr Dorrington refers to the evidence of John Clark filed on behalf of the opponents and notes that there is only one registration of the word PING in Class 25. He states that while the opponents have provided turnover figures for the business as a whole, they are not broken down to show turnover in relation to clothing items. In Mr Dorrington's belief, sales of clothing form only a small part of the opponent's business and there is no evidence as to why there would exist a likelihood of confusion on part of the public if the opponents are relying on a reputation for goods other than clothing.
15. Mr Dorrington concludes by arguing that there is a considerable difference between the applicant's mark and the opponent's mark. He states that the word PIN, as contained in the mark applied for, is formed in a clever design which serves to emphasize that PIN means the "pin" or plug which the golfer aims for and that the terms PING and PIN whilst phonetically similar are entirely different conceptually, particularly in the mind of golfers, as PING in golf has its own special meaning and refers to the "short high pitched resonant sound" which is made when a golf club strikes a golf ball sweetly.

Opponents' Evidence in Reply

16. This consists of a further statutory declaration by John Clark which is dated 16 August 2000 and contains the following table which shows the annual turnover figures for clothing and headwear bearing the mark PING sold in the UK since 1995:

YEAR	TURNOVER (£)		
	Clothing	Headwear	TOTAL
1995	392,995.47	289,022.68	682,018.15
1996	687,129.47	281,836.88	968,966.34
1997	477,318.78	180,128.69	657,447.47
1998	475,024.81	327,062.65	802,087.46
1999	955,797.05	322,119.42	1,277,916.40

17. Mr Clark states that the figures shown are based on trade prices and that a typical retail mark-up is 50-70%.
18. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

19. At the hearing Mr Grimshaw withdrew the grounds of opposition under Sections 3(1), 3(3)(b), 3(4) and 3(6) of the Act, and under the Registrar's discretion (which, of course, is not provided for under the 1994 Act).

20. I turn first to the ground of opposition under Section 5(2)(b) which reads 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.

21. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1) In this Act an 'earlier trade mark' means -

- (a)..... a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

22. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

23. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

24. The respective specifications are set out at the start of this decision. In light of the applicant's registration 1313897 in Class 25, it was common ground before me that identical and/or similar goods are involved. It was not argued at the hearing (correctly in my view) that the opponent's registrations in classes 19 and 28 covered similar goods to the applicants and these registrations were used to support the Section 5(3) ground.

25. At the hearing Mr Grimshaw argued that there was visual, aural and conceptual similarity between the marks, concentrating his arguments on the aural issue. In Mr Grimshaw's view the applicants mark would be described as 'PIN' in aural use and as such could not be distinguished from the opponents mark 'PING'. He drew my attention to a number of precedents which although decided under the 1938 Act, were he submitted, complimentary to and assisted in the interpretation of the current law and its application to mark in suit by establishing certain principles e.g. the importance of first impression when comparing marks, that allowance should be made for imperfect recollection and that aural similarity alone can suffice to demonstrate a likelihood of confusion. Mr Grimshaw also pointed out that both the applicant and the opponent were aiming their products at the same customers ie. golfers, and that the opponents had a considerable reputation for their goods, particularly amongst golfers. Furthermore, in Mr Grimshaw's view it is not unusual for clothing (particularly clothing for golfers) to be purchased either on the basis of aural recommendation or over the telephone.

26. For the applicant for registration, Mr Farrington concentrated on the overall differences between the mark in suit and the opponent's mark, arguing that notional and fair use would be in the form of the mark applied for. He stated that the likelihood of confusion must be appreciated globally.
27. Mr Farrington went on to argue that visually the marks at issue were very different and that conceptually any allusion to the word PIN that may exist would clearly be to a golf pin which has a clearly different connotation to the dictionary word PING. Mr Farrington conceded that the opponents' strongest challenge was on aural similarity but he argued strongly that the mark in suit should not be regarded as merely being a PIN mark given the very strong visual nature of the mark and its overall make up. He stressed that it was not enough for the opponent's to show that there may be an association between the marks, but that a likelihood of confusion must be demonstrated.
28. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In this case I accept that identical goods involved and that the opponent's mark possesses a reasonably high distinctive character, especially amongst the likely customers for the goods ie. golfers. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:
- "The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."
29. In my consideration of whether there are similarities sufficient to show that a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.
30. The mark PING is an ordinary dictionary word and is registered in that form. On the other hand, the mark applied for is very much a composite mark consisting of the device of a golf hole with flag (pin), letters P and N in capitals and the device of a golf ball on a tee. The opponents surmise that the positioning of the golf ball on the tee between the letters P and N leads it to read as the word PIN and that this concept is reinforced by the device of a golf pin within the mark.
31. Turning firstly to a visual comparison of the marks I find them quite different. The device elements within the applicant's mark are strong and overall it has a considerable impact upon the eye. Indeed, I find it very arguable that the word PIN would be drawn out of the mark, particularly on first impression.
32. On the consideration of aural use of the mark, the applicant's case depends on the proposition that not only will the substantial device element in the applicant's mark be insufficient to indicate a different trade origin but also that the word PIN will be picked out from the applicant's mark and confused with the opponent's mark. In my view the impact of the device element in the applicant's mark should be

taken into account in assessing the likelihood of aural confusion as the applicant's mark appeals primarily to the eye. It is possible that some people, encountering the applicant's mark may think it is aurally reminiscent of the opponent's mark but in my view it does not follow that a likelihood of confusion exists.

33. Furthermore, the following comments appeared in a recent Registry Decision (In the matter of Application No. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under No. 45787):

There is no evidence to support Ms Clarke's submission that, in the absence any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.'

34. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285, at 289 lines 22 to 26).
35. Conceptually I also believe the marks to be quite different. As stated previously, I consider the applicant's mark to appeal primarily to the eye. While it may bring to mind a golf pin (hole and flag), the applicant's registration of the word PING brings to mind its dictionary definition - a high pitched resonant sound, or as Mr Grimshaw stated during the hearing, of the opponent's by virtue of their reputation.
36. Given the overall differences between the marks I believe the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. I conclude that the opposition under Section 5(2)(b) fails.
37. I next consider the ground of opposition based on Section 5(4) which reads:

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

- (1) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

38. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that to succeed in a passing off action, it is necessary for the opponent's to establish, at the relevant date (23 December 1994), that: (in) they had acquired goodwill under their mark; (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

39. I have already found that the opponent has goodwill under the name PING for goods in Class 25. However, I concluded that this was not enough to result in a likelihood of confusion under Section 5(2). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground of opposition under Section 5(4) therefore fails.

40. This leaves the ground opposition under Section 5(3) which states:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

41. The term "earlier trade mark" is itself defined in Section 6(1) of the Act, which is set out earlier in this decision.

42. The opponent has three registrations in Class 28 (1197329, B104330 and 1228240) and one registration in Class 18 (1432807), comprising or incorporating the word PING, for goods which are not identical or similar to those of the applicants.

43. In my view the opponent has an undoubted reputation for goods in Class 28 under the mark PING and a lesser reputation in Class 18. However, having already concluded that there is no likelihood of confusion under Section 5(2) I have to consider whether use of the applicant's mark in Class 25 would, without due course, take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponent's marks.

44. In *RBS Advanta v Barclays Bank Plc* 1996 RPC p307, Laddie J. considered the meaning of the proviso to Section 10(6) of the Act which deals with comparative advertising. The second half of the proviso contains wording identical with the wording in Section 5(3) of the Act. Laddie J. expressed the following view on the meaning of the above words in that context:

"At the most these words emphasis that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered mark which is above the level of de minimis".

45. In summary, the opponent's case seems to be that consumers seeing or coming across the applicant's mark will think of them. Mr Grimshaw, if I understood him correctly, contends that this, of itself, takes unfair advantage of the opponent's goodwill and reputation. Mr Grimshaw pointed to the sales and promotional figures provided. I am prepared to accept that the applicant's mark may remind some people of the opponent's mark. However, I do not consider that simply being reminded of another trade mark with a reputation for dissimilar goods necessarily amounts to taking unfair advantage of the repute of that mark. Accordingly, the objection founded under Section 5(3) fails.
46. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay to them the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22 day of February 2001

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**