

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2190470
BY GARY FRANK DORRINGTON TO REGISTER
A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 50050 BY KARSTEN MANUFACTURING CORPORATION**

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by Gary Frank Dorrington to register
a Trade Mark in Class 25**

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**IN THE MATTER OF OPPOSITION thereto under
No 50050 by Karsten Manufacturing Corporation**

BACKGROUND

1. On 2 March 1999 Gary Frank Dorrington applied to register the following trade mark:



in Class 25 for "Tee shirts, polo shirts, hats, shorts, trousers, shirts, socks, underwear".

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 5 August 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 outerclothing; 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 opponent's 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 applicant's 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 be 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 applicant 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 9 November 1999 the applicant 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 applicant for registration was represented by Mr Farrington of Langner Parry and the opponent's by Mr Grimshaw of Mewburn Ellis.

Opponent's 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 had held his present position for the last two years, has worked for the company for approximately 5½ 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 opponent, is the registered proprietor of United Kingdom registration 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 United Kingdom Patent Office containing details on 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 (eg pullovers, shirts, waistcoats, sweaters, jackets and trousers), and headgear (eg 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 golf accessories such as umbrellas, ties, belts, wool head covers, head covers, headgear and key rings.

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

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 states that the trade mark PING has been and is currently advertised in a number of magazines and trade publications and Exhibit JC12 to 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 JC15 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.

Applicant's Evidence

12. The applicant's evidence consists of a statutory declaration by Gary Frank Dorrington, dated 17 May 2000, who states that he is the applicant for trade mark number 2190470.
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 Phillip Curran who was enthusiastic and Mr Curran 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)

- (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.

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.

23. 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 registration in Classes 18 and 28 covered similar goods to the applicants and those registrations were used to support the Section 5(3) ground.

24. 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.

25. 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. 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 opponent's strongest challenge was an 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 mark, but that a likelihood of confusion must be demonstrated.
27. 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 as 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."
28. In my consideration of whether there are similarities sufficient to show 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 and 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.
29. The mark PING is an ordinary dictionary word and is registered in that form. On the other hand, the mark applied for is a composite mark consisting of the letters P, N and G, L, F in capitals, the letter I in capitals with a pennant containing the numeral 1 above the I (placed between the letters P and N), the device of a golf ball on a tee (placed between the letter G and LF) and the words "who wants to be 2nd...." The mark also contains different colour elements but is not limited to colour. The opponents surmise that, notwithstanding the device and colour elements, the mark would essentially be seen and described aurally as a "Pin Golf" mark.
30. Turning firstly to a visual comparison of the marks I find them quite different. The device elements of the applicant's mark impact upon the eye and although the words PIN GOLF are likely to be drawn out of the mark, it is visually distinct. In my view there is no likelihood of confusion in a visual context.

31. On consideration of aural use of the mark, the applicant's case depends on the proposition that the device element in the applicant's mark will be insufficient to indicate a different trade origin and that the word PIN or words PIN GOLF will be picked out from the applicant's mark and be confused with the opponents mark. While I take into account the device element and its impact, it seems to me that, in aural use, the mark in suit is likely to be described as a PIN GOLF mark as the stylization of the letters I and O within the mark is not sufficiently strong to substantially detract from the whole being described as the words PIN GOLF.
32. Having found that in aural use, the applicant's mark is likely to be described as a PIN GOLF mark I now go onto consider whether this would lead to a likelihood of confusion. In my view the word PIN is very difficult to distinguish from the word PING in aural use and as Mr Grimshaw pointed out at the Hearing, it is very common for the "G" sound to be dropped in aural use of words ending with the suffix "ing" or the letters "ing". I would add that the word GOLF follows the word PIN and this may result in a "g" sound becoming apparent after the word PIN making it increasingly difficult to distinguish PIN GOLF clothing and PING golf clothing in aural use. Furthermore, the addition of the non-distinctive words GOLF and "who wants to be 2nd...." do not assist in distinguishing the marks, especially as the goods are primarily targeted at the golfing market.
33. Next, I take into consideration the comments 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. Whilst I accept the public rely primarily on visual means to identify the trade origin of clothing, the above decision makes it clear that aural means of identification can be relied upon. In the current case I believe that the applicant's mark is likely to be described as a PIN GOLF mark, that the words PIN and PING 'are' very difficult to distinguish in aural use and in practice they will often prove impossible to distinguish, especially when one takes into account that it is common for the "G" sound to be dropped in aural use of words ending with the suffix "ing" or the letters "ing", or that the word "GOLF" following the word "PIN" in the applicants mark may emphasize the "G" sound in the words PIN GOLF. Furthermore, it seems to me that items of clothing for golfers are likely to be bought as presents through aural requests e.g. at Christmas or birthdays, or through aural recommendations provided in e.g. a club house, given that golf is a major participant sport with an active and dedicated following.

36. Finally, on a conceptual comparison, there are differences. While the applicant's mark brings to mind a golf pin, 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, the opponents by virtue of their reputation.
37. To conclude, while I believe that on a visual and conceptual comparison the marks are different, the degree of aural similarity is such that on a global appreciation there exists a likelihood of confusion. The opposition under Section 5(2)(b) is successful.
38. As I have found for the opponents under Section 5(2) of the Act I have no need to consider the grounds of opposition raised under Sections 5(3) and 5(4).
39. 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**