

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed:
June 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Karsten Manufacturing Corporation

v.

D. Kent Pingel

Opposition No. 91189542
to Application No. 77612277

John D. Titus of Hartman Titus PLC for Karsten Manufacturing Corporation.

D. Kent Pingel, *pro se*.

Before Quinn, Cataldo and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

D. Kent Pingel (applicant), an individual, has filed an application to register the mark:



Opposition No. 91189542

for "advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium" in International Class 35.¹ The term "WI FI" has been disclaimed.

Karsten Manufacturing Corporation (opposer) has opposed registration of applicant's mark under Section 2(d) of the Trademark Act on the ground of priority and likelihood of confusion. Specifically, opposer pleaded, *inter alia*, that it is the owner of thirty-four trademark registrations for PING marks (for the term by itself or in conjunction with other terms or designs) and that these registrations cover various goods and services, including golf-related equipment, sponsoring golf professionals and tournaments, providing training and educational services regarding the fitting of golf clubs; that opposer "directly and/or through its wholly owned subsidiary Ping, Inc. has used the mark PING [and other PING-formative marks] in an open and public manner...prior to the first use claimed in the above-referenced application"; that PING is a famous mark within the meaning of Section 43(c) (involving dilution) of the Act; and that applicant's mark should be refused

¹ Application Serial no. 77612277 was filed on November 11, 2008 based on an allegation of first use in commerce on December 14, 2005.

registration because it is likely to cause confusion with opposer's marks.²

Applicant, in his answer, admitted the allegation that "opposer directly and/or through its wholly owned subsidiary Ping, Inc. has used the mark PING in an open and public manner in the United States since prior to the date of first used claimed in [applicant's] application, and has not abandoned such use." Applicant otherwise denied all other salient allegations in the notice of opposition.

The Record

The record automatically consists of the pleadings and the file of the involved application. Opposer submitted the trial testimony, with exhibits, of: Steven Chance Cozby, Director of Tournament Player Relations for Ping, Inc.; Steven Bostwick, Forecasting Manager and Market Analyst for Ping, Inc.; David Engelking, Subsidiary Operations Manager for opposer; Susan Naylor, co-owner of Darrell Survey; Peter Samuels, Head of Marketing Communications for Ping, Inc.; and Frankie Ho, Director of Intellectual Property for Ping, Inc. Opposer also submitted, under notices of reliance,

² Opposer appears to have attempted to plead a claim of dilution under Section 43(c) of the Act; however, opposer did not specifically plead that its PING mark became famous prior to the filing date of the subject application. Moreover, opposer did not argue this ground in its brief. Rather, in the brief's "statement of the issues," only priority and likelihood of confusion is identified as a ground for which opposer believes the Board should refuse registration. We therefore construe any possible dilution ground as having been waived by opposer.

copies of applicant's responses to requests for admission and interrogatories, and a copy of a Business Wire article.

In particular, we note that opposer properly introduced all but one of its thirty-four pleaded registrations of record.³ Opposer submitted, as exhibits to Mr. Ho's deposition, printouts for thirty-three pleaded registrations from the USPTO TARR electronic database along with copies of the actual registrations.⁴ In addition, opposer submitted the same for six additional registrations that it owns but were not pleaded in the notice of opposition.

Applicant did not take any testimony or submit any evidence. It also does not appear that applicant was present or represented by counsel at any of the aforementioned testimonial depositions noticed by opposer.

Only opposer has filed a trial brief.

Standing

Opposer has established that it is the owner of the pleaded registrations and that said registrations are valid

³ Opposer pleaded ownership of Registration No. 704552 for the mark PING for "golf clubs" (issued on September 20, 1960 and renewed). However, opposer failed to submit printouts from the USPTO electronic database or otherwise properly introduce this registration into the record by showing the status and title thereof. The fact that this registration is not of record is not fatal to opposer's claim and does not affect the outcome of this proceeding in light of our determination, discussed *infra*, that opposer has established common law rights in the mark PING in connection with "golf clubs" long before the filing date of the subject application.

⁴ The simpler approach is to submit the USPTO electronic database printouts for each of the pleaded registrations under a notice of reliance. See Trademark Rule 2.122(d)(1).

and subsisting. Accordingly, opposer has shown that it has a personal interest in this proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority and Opposer's Registrations

Opposer's proof of ownership of its pleaded registrations removes priority as an issue with respect to the goods and services covered by the registrations, vis-à-vis the recited services in the subject application. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer's pleaded registrations of record include the following marks in connection with golf-related goods or services:

PING

for: golf accessories, namely, umbrellas and travelling bags;⁵

for: sponsoring golf professionals;⁶

⁵ Registration No. 1647448 issued on June 11, 1991; renewed. Section 8 and 15 affidavits accepted and acknowledged.

⁶ Registration No. 1633477 issued on January 29, 1991; renewed. Section 8 and 15 affidavits accepted and acknowledged.



for: golf clubs;⁷

PING

for, *inter alia*,: travel covers for golf bags;⁸

for: training and educating sporting goods dealers to fit golf clubs to customers, golf club fitting, sponsoring amateur golf tournaments for men, women and for junior golfers, and sponsoring professional golf tournaments;⁹

PING (in typed lettering)

for: newsletters on professional golf;¹⁰

for: sporting goods; namely, golf bags, golf balls, and head covers for golf clubs;¹¹



for: golf playing equipment; namely, golf clubs;¹²

PING DISCOVER

for: golf bags;¹³

⁷ Registration No. 2923069 issued on February 1, 2005. Section 8 and 15 affidavits accepted and acknowledged.

⁸ Registration No. 2773222 issued on October 14, 2003. Section 8 and 15 affidavits accepted and acknowledged.

⁹ Registration No. 2870863 issued on August 10, 2004. Section 8 and 15 affidavits accepted and acknowledged.

¹⁰ Registration No. 1638323 issued on March 19, 1991; renewed. Section 8 and 15 affidavits accepted and acknowledged.

¹¹ Registration No. 1632445 issued on January 22, 1991; renewed. Section 8 and 15 affidavits accepted and acknowledged.

¹² Registration No. 1647510 issued on June 11, 1991; renewed. Section 8 and 15 affidavits accepted and acknowledged.

¹³ Registration No. 3320110 issued on November 23, 2007.

PING RETRO

for: golf bags;¹⁴ and

PING JUNIOR SOLHEIM CUP (in typed lettering)
for: organizing and conducting golf tournaments.¹⁵

Opposer's other pleaded registrations of record for the mark PING (either stylized or in typed letters) cover various non-golf specific goods, including: sun block, metal key rings, pocket knives, computer carrying cases, refrigerator magnets, calculators, lamps, watches, pens, stationery items, travel document cases, toiletry cases, gloves, belts, chairs, plastic water bottles sold empty, mugs, wastepaper baskets, lanyards for eyeglasses, towels, articles of clothing, caps, visors, mittens, rugs, and drinking water.

As previously alluded to, opposer also introduced six other registrations that it owns, but were not pleaded in the notice of opposition.¹⁶ These registrations, all for the mark PING (in typed letters or with a standard character claim), cover goods and services such as: application service provider services featuring non-downloadable software, computer software, computers, downloadable video recordings, consumer telecommunications services, and entertainment and educational services in the fields of

¹⁴ Registration No. 3033057 issued on December 20, 2005.

¹⁵ Registration No. 2949957 issued on May 10, 2005.

¹⁶ Registrations Nos. 3505238, 2599013, 3617336, 3703528, 3728814, and 3795969.

Opposition No. 91189542

sports and entertainment. Although these registrations were not pleaded by opposer, applicant did not object to their introduction. We therefore treat the issue of opposer's ownership of registrations as tried by consent and the notice of opposition deemed to be amended accordingly. Fed. R. Civ. P. 15. Nevertheless, we note that opposer does not argue in its brief how these six registrations are relevant to the opposition other than showing various other goods and services for which opposer registered the PING mark; opposer does not argue that any of the services and goods covered by the registrations are related to the advertising and promotional services recited in the subject application.

Opposer's Common Law Rights

As noted, opposer has not properly introduced Registration No. 704552 (see footnote 3) for the typed mark PING for "golf clubs"; however, opposer has clearly proven through the testimonial depositions and exhibits that it has used that mark on golf clubs since at least 1960, long before the filing date of the subject application. Accordingly, we find that opposer has prior common law rights in the PING mark for golf clubs. *Mason Engineering v. Mateson Chemical*, 225 USPQ 956, 961 (TTAB 1985) (in the absence of evidence regarding its date of first use, the earliest date on which applicant can rely is the filing date

of its application); see also, *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).¹⁷

In addition to relying upon the services covered by its pleaded registrations, opposer argues in its trial brief that it renders services it describes as "promoting golf professionals and the sport of golf [since 1984]" and "promoting golf shaft manufacturers [since 1984]." Brief, p. 9. Opposer further states that "[a]s established by the testimony of Peter Samuels and others, for at least the past 20 years, Opposer has been engaged in the business of promoting the services of third parties such as golf professionals, golf shaft manufacturers, and golf tournament events; and has been engaged in the business of publishing news about third parties such as golf professionals and tour events." *Id.*, p. 16.

Opposer's asserted "promotional" services involving the goods and services of third parties are not encompassed by the "sponsorship...training...educating" services found in the pleaded registrations. Moreover, and based on the entire record before us, we cannot conclude that opposer actually prepares advertisements or promotes the goods and services of others as a routine matter of business.¹⁸ In

¹⁷ We have no testimony or other evidence from applicant regarding its use, if any, of the applied-for mark.

¹⁸ We further note that opposer also did not plead rights in the PING mark with respect to advertising and promotional services nor moved to amend the notice of opposition to conform to the

Opposition No. 91189542

other words, the evidence fails to show that opposer renders or offers promotional services to others under any of its PING marks.

In spite of our finding that opposer has not shown that it renders advertising or promotional services for others in commerce, the testimony and exhibits submitted by opposer have probative value. This evidence elaborates upon applicant's sponsorship and other services, as well as its golf-related goods, by showing the type and manner of opposer's own advertising used in connection with the sponsorship services and indicates, as well, the level of exposure accorded to applicant's PING mark.

In sum, we find opposer has established common law rights in its mark PING on golf clubs, but it has not established rights in the mark in connection with any advertising and promotional services for others, as asserted in its brief. Accordingly, for purposes of our likelihood of confusion analysis, we consider only opposer's use of the PING mark on golf clubs as well as the other various goods and services covered by opposer's registrations vis-à-vis the applied-for mark and the services recited in the application.

evidence submitted. Because there is no evidence that opposer actually renders these services, we need not reach the question of whether any such unpleaded rights, had they existed, were tried by implicit consent in order to deem the pleadings amended in this regard.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Fame

We begin our likelihood of confusion analysis with the *du Pont* factor involving opposer's asserted fame of its PING mark. Fame, if it exists, plays a significant role in our analysis because a famous mark enjoys a broad scope of protection. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Upon careful review of the record in this case, we are persuaded that opposer's PING mark is famous within the sport of golf, including many goods and services related thereto. Applicant has also admitted that opposer's PING mark "is widely recognized by the general public as being associated with the golf clubs manufactured by opposer." Admission Request No. 11.

As to the testimony and evidentiary materials submitted by opposer to establish the fame of its PING mark, we are mindful that certain portions and figures have been designated as "confidential." Nevertheless, we are able to point to several factors in general terms which have been

Opposition No. 91189542

borne out by the record and helped us reach our conclusion regarding the fame of opposer's PING mark. They are: opposer has been using the mark PING for over fifty years on golf clubs and for many years in connection with a variety of golf-related goods and services; opposer's golf clubs are regarded by its consumers as being of very high quality; opposer has acquired several of the top market share positions for various types of golf clubs and golf bags for the last ten years; opposer's annual sales of golf clubs and golf bags in the United States for the last ten years is very substantial; opposer's advertising expenses for the past ten years have also been significant and opposer is among the top five golf equipment manufacturers in terms of money spent on advertising; opposer has placed television advertisements during some of the most important golf tournaments, being first or second, with Nike as one of the other major advertisers; opposer has sponsored many amateur and professional golf tournaments as well as sponsored golfers who went on to win major golf tournaments; several other corporations have sought to co-brand their products or services with opposer's PING mark; opposer and opposer's founder have been featured in several articles; and opposer has licensed its PING mark to a clothing company for a line of clothing distributed through some major retailers as well as golf pro shops, and some of this PING-licensed apparel

has received exposure by being worn by professional golf players.

Inasmuch as we have found opposer's PING mark to be famous in connection with golf-related equipment and services, we accord the mark a wide latitude of legal protection which certainly favors opposer and a finding of a likelihood of confusion.

Similarity of the Marks

We turn now to the *du Pont* factor of the similarity or dissimilarity of the marks, when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Here, we waste little time in finding that the dominant element of applicant's mark is PING. To the extent that applicant's mark also contains the wording WI FI and a triangle design, these elements have much less source-identifying significance. The triangle design, as applicant admits, is merely a "common geometric form." Admission Request No. 6. As to the term "wi fi," we note that the application's recitation of services specifically states that advertising or promotional services will be rendered online, i.e., via the internet, and applicant has admitted that "in the field of computers, the term 'Wi-Fi' refers to

wireless connectivity to a network such as The Internet.” Admission Request No. 4. Thus, the disclaimed term “WI FI” is descriptive of a manner or method in which applicant renders his services.

As to commercial impression and connotation, we take notice that the word “ping” is defined as:¹⁹

PING (n.)

1. A sharp, high-pitched sound, as that made by a bullet striking metal.
2. See knock. *intr.v.* **pinged, ping·ing, pings**
To make a sharp, high-pitched, metallic sound.

Based on the definition, we speculate that the term “ping” may be suggestive of the sound made by a metal golf club striking a golf ball; yet there is no evidence that the public would necessarily make such a connection. We can further speculate that applicant’s use of the term PING derives from his own last name, Pingel. Again, this is only speculation and there is no evidence that consumers of applicant’s services will be aware of applicant’s surname or otherwise make such a connection. Thus, we cannot say with any certainty that the term PING, as it appears in the parties’ marks and in connection with their respective goods

¹⁹ *The American Heritage Dictionary of the English Language* (Fourth Edition 2000). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Opposition No. 91189542

and services, will be understood by consumers as having any specific meaning or connotation. Rather, we assume each party's use of the term PING is arbitrary and will be perceived as such by consumers.

Considering applicant's mark in its entirety, as we must, we find that it is similar in appearance and sound to opposer's PING mark. Because the term PING is used arbitrarily in both marks, it will also convey the same impression on consumers. It is significant that the dominant element of applicant's mark, PING, is the same as opposer's mark and this outweighs any dissimilarity. Accordingly, we find the *du Pont* factor regarding the similarity of the marks weighs in favor of finding a likelihood of confusion.

Relationship of the Goods and Services; Trade Channels;
and Classes of Purchasers

We now consider the *du Pont* factor involving the relationship, if any, between the services recited in the application and the goods and services of opposer. In doing so, we also consider the *du Pont* factors involving the classes of purchasers for the respective services and goods as well as their trade channels.

It is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a

Opposition No. 91189542

holding of likelihood of confusion. It is sufficient that the respective goods and services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether consumers will confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. In *re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the goods and/or services identified in opposer's pleaded registration(s). *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Our analysis must also include a comparison between applicant's services and whatever goods and/or services for which opposer owns superior common law rights.

Opposition No. 91189542

With the above principles in mind, we begin our comparison of the parties' respective goods and services by noting that applicant's "advertising and publicity services" are broadly described in the application. There is no restriction to the markets in which these services are offered or the class(es) of prospective consumers. Rather, the recitation states "promoting the goods, services, brand identity and commercial information and news *of third parties,*" and the consumer may be a corporation or an individual receiving such services. Finally, the media used by applicant in rendering the advertising and publicity services essentially runs the gamut, *i.e.*, "through print, audio, video, digital and on-line medium." Given such a broad recitation of advertising and publicity services, we must consider the possibility that applicant's services are offered to those involved in the field of the sport of golf and could include: publicity services for professional golfers, advertising and publicity services for golf tournament organizations, promotion and advertising services for companies that manufacture golf equipment, etc.

Although there is insufficient evidence to support opposer's contention that it actually renders advertising and promotional services for others as a course of business, we find that a relationship exists between opposer's sponsorship services in the golf field and applicant's

Opposition No. 91189542

services. First, based on the respective recitations of services, the same golfers that opposer sponsors may also retain applicant for publicity services. Likewise, the same golf tournament organizations that seek opposer's sponsorship services may also retain applicant's promotional services. Second, and perhaps more importantly, the record demonstrates that certain conditions and activities surrounding opposer's sponsorship services bridge the gap with applicant's advertising and publicity services. In particular, opposer frequently places advertisements in magazines and other media containing a picture of a sponsored player using opposer's PING golf clubs. In addition to obviously promoting the PING golf clubs, the record shows that these advertisements also promote and/or provide publicity to the player shown in the advertisement. See Samuels dep., p. 43-87; e.g., at 44:13-16 ("[t]his [advertisement] includes our Tour professional Bob Eastwood, who represented us on Tour at that time. So we're promoting him. It also promotes a couple of our golf clubs..."), at 48:9 ("Well, here we're promoting Ken Green who was one of our staff professionals who won this particular tournament..."); see also Cozby Dep. pp. 49-68. Thus, one of the effects of opposer's advertisements involving its sponsored players and PING golf clubs serves the same purpose as applicant's recited services, i.e., promoting or

publicizing the player and his/her accomplishments in the same media used by applicant. While the sponsorship of golfers and golf tournaments may not be the type of services that will directly compete with applicant's advertising and publicity services, there is a commercial relationship between said services.

In view of the foregoing, we find it plausible that both applicant and opposer may offer their services to the same consumers, golfers and golf tournament organizations. There is also a degree of relationship between opposer's sponsorship services with the unrestricted advertising and publicity services in the opposed application. Accordingly, the *du Pont* factors of the similarity of the services and classes of purchasers favor a finding of a likelihood of confusion.

Balancing of Factors

As discussed above, several *du Pont* factors weigh in favor of finding a likelihood of confusion. Most notably, we have found that opposer's PING mark is famous, at least within the field of golf, and is entitled to a wider scope of protection commensurate with said fame. Opposer's mark is also similar to applicant's proposed mark. While opposer's goods and services are mostly directed to the golf market and that is where the fame of its PING mark rests, applicant's advertising and publicity services are not

Opposition No. 91189542

restricted and may be offered as well to entities involved in the sport of golf, e.g., golfers and golf tournament organizations. With these factors in play, we find there is a sufficient relationship between opposer's sponsorship services and applicant's advertising and publicity services, so that the similarity between opposer's famous mark and applicant's mark is likely to give rise to the mistaken belief that the respective services originate from the same source. In other words, consumers such as golfers and golf tournament organizations, already familiar with opposer's sponsorship services offered under the famous PING mark, are likely to mistakenly believe that applicant's advertising and publicity services emanate from the same source when they are offered to the same consumers under a similar mark.

We finally note that applicant has not presented any evidence or set forth any argument as to why or how the parties' services are so different that there could be no likelihood of confusion. However, to the extent that any doubts might exist in this regard, we resolve such doubts in favor of the party with prior rights in its mark, opposer, and against applicant. See *Century 21 Real Estate Corp.*, *supra*; *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Opposition No. 91189542

In this case and on this record, we find that opposer has demonstrated by a preponderance of the evidence that a likelihood of confusion exists when the parties' marks are used in connection with the respective services.

Decision: The opposition is sustained and registration of applicant's mark is refused.