Paper No. 9
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Burkard Publishing Corporation
and Eugene R. Burkard
v.
John A. Towsley

Opposition No. 101,017
to application Serial No. 74/652,080
filed on March 27, 1995

Neil F. Martin and Barry F. Soalt of Brown, Martin, Haller & McClain for opposer

John A. Towsley, *Pro Se*

Before Sams, Hairston and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Burkard Publishing Corporation and Eugene R. Burkard (opposers) filed their opposition[1] to the application of John A. Towsley to register the mark NICE BUN for "men's and

[1] The record contains no evidence regarding the relationship, if any, between the two opposers in this case. The two opposers have filed all papers jointly by making single filings on behalf of both opposers. Nonetheless, standing and the merits of the opposition must be established as to each opposer herein.

women's clothing, namely, jeans, slacks, shorts, underwear, and swimwear."[2]

As grounds for opposition, opposers assert that applicant's mark, when applied to applicant's goods, so resembles opposers previously used and registered mark BUNS for "underwear pants for men and women"[3] as to be likely to cause confusion under Section 2(d) of the Trademark Act. Opposers allege, further, that opposers have been engaged in the clothing business since prior to applicant's filing date and have continuously used the mark BUNS on clothing products, including underwear, since at least as early as December 13, 1974; that BUNS is opposers' principal mark in connection with men's and women's underwear pants and is well-known throughout the United States; that opposers have adopted and are the owners of the registered marks WARM BUNS for "hosiery" (Registration No. 1,360,748); SKI BUNS for "men's, women's and children's ski wear, namely, underwear and pants" (Registration No. 1,504,938), and BUNDERWEAR for "men's, women's and children's underwear" (Registration No. 1,612,990).

[2] Application Serial No. 74/652,080, filed March 27, 1995, in International Class 25, based upon an allegation of a bona fide intention to use the mark in commerce.

[3] Registration No. 1,023,313, issued October 21, 1975, in International Class 25. [Renewed for a term of ten years from October 21, 1995; Sections 8 and 15 affidavits accepted and acknowledged, respectively.] The registration issued, originally, to Brawn of California.

Applicant, in his answer, denied the salient allegations of the likelihood of confusion claim.

The Record

The record consists of the pleadings; the file of the involved application; a certified copy of Registration No. 1,023,313, which shows that the registration is owned by opposer Eugene R. Burkard; and opposers' Request for Admissions to applicant.[4] Both the copy of the pleaded registration and opposers' Request for Admissions were submitted by way of opposers' notice of reliance. Applicant did not take any testimony or submit any evidence during his testimony periods. Only opposers filed a brief on the case.

Analysis

We begin by finding that the sparse record before us contains no facts that would establish either the standing of opposer Burkard Publishing Corporation or the merits of the case with respect to opposer Burkard Publishing Corporation. Thus, the opposition is dismissed as to opposer Burkard Publishing Corporation due to a failure of proof.

[4] Opposers state, in the notice of reliance, that applicant did not respond or object to the requested admissions. Thus, opposers' requested admissions are deemed to be admitted by applicant since applicant neither responded to opposers' request nor objected thereto within thirty days after the date of service of opposers' request for admissions. See, FRCP 36(a) and *Trademark Trial and Appeal Board Manual of Procedure* (*TBMP*), Section 411.01.

Our discussion turns now to consideration of the merits of this opposition with respect to Eugene R. Burkard (opposer). Inasmuch as a certified copy of the pleaded registration for the mark BUNS is of record, and that copy shows title to the registration in the name of Eugene R. Burkard, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations in this case are the similarities between the goods and the similarities between the marks. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). This is especially true in cases where, as here, there is little evidence bearing on the other factors enumerated in the *duPont* case.[5]

With respect to the goods and services of the parties, we observe that at least two facts deemed admitted by

[5] In his notice of opposition, opposer made a number of allegations regarding, *inter alia*, use of his mark BUNS, the renown of that mark, and that he owns several other specified registrations. These allegations are not established by the record and, thus, are not considered in our determination herein.

applicant due to his failure to respond to opposer's Request for Admissions are relevant. Applicant is deemed to have admitted, *inter alia*, that the channels of trade are the same for applicant's goods identified by the mark NICE BUN and opposer's goods identified by the mark BUNS; and that the products in connection with which the parties' respective marks are used are substantially the same type of products. Further, the identification of goods in the application includes "underwear" which is substantially the same as the recited goods in the pleaded registration. Thus, we conclude that the goods of the parties are identical and closely related.

Not only is applicant deemed to have admitted that the trade channels for the parties' goods are the same, but, in view of the broad wording of both identifications of goods, we must presume that the goods and services of applicant and opposer are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the goods of applicant and opposer are sold through the same channels of trade to the same classes of purchasers.

Turning to the marks, while we must base our determination on a comparison of the marks in their

entireties, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.,* 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this regard, we find that BUN is the dominant portion of applicant's mark NICE BUN, as NICE is an adjective that merely modifies and describes the noun BUN. As such, the dominant portion of applicant's mark is substantially similar to opposer's mark BUNS. The fact that applicant's BUN is singular and opposer's mark BUNS is plural does not distinguish these terms. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall commercial impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.,* 209 USPQ 179 (TTAB 1980). In this case, we find that when opposer's and applicant's marks are considered in their entireties, they create substantially similar overall commercial impressions. Because applicant's mark essentially encompasses opposer's mark and merely modifies it with the adjective NICE, it is likely that, when

considered in relation to the respective goods of the parties, consumers may mistakenly believe that applicant's goods are a specialty line of clothing from opposer.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of opposer's mark BUNS in Registration No. 1,023,313 and applicant's mark NICE BUN, their contemporaneous use on the identical and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The opposition is sustained as to Eugene R. Burkard. The opposition is dismissed as to Burkard Publishing Corporation.

J. D. Sams

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board