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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Justin Botos and Matthew J. Botos

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Serial No. 78922977

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Ronald A. DiCerbo of McAndrews, Held & Malloy, Ltd. for  
Justin Botos and Matthew J. Botos.

Heather Biddulph, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Rogers, Drost, and Zervas, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 5, 2006, Justin Botos and Matthew J. Botos  
(hereinafter applicant) filed an intent-to-use application  
(Serial No. 78922977) to register the mark EVIL EYE  
CLOTHING (in standard character form) on the Principal  
Register for the following goods and services:

All purpose sport bags; all-purpose carrying bags;  
backpacks; beach bags; book bags; luggage; tote bags  
in Class 18

Bathing suits; belts; blazers; bras; bustiers;  
camisoles; caps; caps with visors; dresses; footwear;  
jackets; jeans; knit shirts; leggings; panties; pants;

shirts; shorts; skirts; skull caps; socks; sweat pants; sweat shirts; sweat suits; swim wear; T-shirts; tank tops; teddies; trousers; undergarments; undershirts; warm up suits in Class 25

Mail order services featuring clothing, headwear, backpacks, carrying bags, luggage, belts, footwear, eyeglasses, sunglasses, and accessories therefore; On-line retail store services featuring clothing, headwear, backpacks, carrying bags, luggage, belts, footwear, eyeglasses, sunglasses, and accessories therefore; Retail stores featuring clothing, headwear, backpacks, carrying bags, luggage, belts, footwear, eyeglasses, sunglasses, and accessories therefore in Class 35.

Applicant has disclaimed the word "Clothing."

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark EVIL EYES and design shown below for "Clothing, namely, adults, teens, and children's t-shirts, shorts, pants, hats, caps, underwear, jackets, dress shirts and bandanas" in class 25.<sup>1</sup>



When the refusal was made final, applicant filed a request for reconsideration and this appeal.

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<sup>1</sup> Registration No. 3080307 issued April 11, 2006.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

"The first *DuPont* factor requires examination of 'the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), quoting *du Pont*, 177 USPQ at 567). In this case, registrant's mark includes the wording EVIL EYES and the design of a pair of eyes. Applicant's mark consists of the words EVIL EYE CLOTHING. Inasmuch as applicant's mark is in standard character form,

we must assume that the displays of the wording in applicant's and registrant's marks are identical.

*Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"). The differences in the marks are: applicant's use of the singular and registrant's use of the plural of the word "eye," the presence of the disclaimed term "clothing" in applicant's mark, and the presence of the design of a pair of eyes in registrant's mark. We do not find these differences to be significant. A "[s]ide by side comparison is not the test." *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

Applicant argues that:

The use of the singular as opposed to the plural is significant in this matter. Applicant's mark is singular; indicating a single eye. As set forth below, Applicant's use of the singular emphasizes Applicant's distinctive connotation of the "evil eye." Registrant's mark is plural; indicating two eyes. Registrant's design consisting of two eyes emphasizes the connotation of two "evil eyes." Consumers saying and/or seeing each of the marks would perceive the dissimilarities in the marks. [By] using the singular phrase, Applicant's mark creates a different visual and auditory impression than that of the cited mark.

Brief at 4.

It is not apparent that many consumers would remember the difference between the singular and plural of the word "eye" or rely on that difference to distinguish the marks. *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word "Zombie" and they will therefore be regarded here as the same mark"). Even if they did, the difference between the singular and plural would not necessarily have the different meanings applicant maintains. For example, applicant submitted a Wikipedia article with a request for reconsideration. The article points out that the "evil eye is a folk belief." The same article uses the plural when it describes (emphasis added) how "lemons are crushed by the vehicle and another new lemon is hung with chillies [sic] in a bead to ward off any future evil eyes." Other websites sell single "eye" charms but use the plural "eyes" for these charms. See [www.religiousmall.com](http://www.religiousmall.com) ("small gifts: Blue Evil Eyes") and [www.tulumba.com](http://www.tulumba.com) ("Evil Eye Charms - In many parts of the world, Evil Eyes are believed to carry magical powers").<sup>2</sup>

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<sup>2</sup> We point out that the sites do not appear to be foreign websites, as applicant suggests. Indeed, the [tulumba.com](http://www.tulumba.com) site refers to "Upcoming Community Events" in various U.S. cities.

We have also considered the presence of the disclaimed term "clothing" in applicant's mark. The term "clothing" is a generic term for applicant's numerous clothing items in class 25. Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to ALE, the Board noted that the term is generic and that the registrant disclaimed it in its registration. Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under DuPont. As a generic term, ALE simply delineates a class of goods"). Applicant's term simply informs consumers of the fact that clothing items are some of the items on which applicant uses the mark or services with which applicant's services are associated.

The only other difference is the presence of the "eyes" design. Both marks include the words "evil eye(s)." To many people, especially those without knowledge of folk lore, the design of a pair of eyes would simply reinforce the "evil eye" words in both marks, rather than distinguish the marks. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal

Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there still was a likelihood of confusion) and *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Applicant also argues that the "words EYE and EVIL are dilute[d]." Reply Br. at 3. To support this argument, applicant includes a list of registrations in the request for reconsideration. "The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record." *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). *See also In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). The examining attorney advised applicant that to "make registrations proper evidence of record, soft copies of the registrations or the complete electronic equivalent ... must be submitted." Denial of Request for Reconsideration at 1. In the appeal brief and reply brief, applicant has now attached copies of these registrations without submitting these registrations in a second request for reconsideration or a request for

remand. The examining attorney has objected to these registrations on the ground that this evidence "was never properly made of record." Brief at 1. We agree with the examining attorney. This evidence was not timely made of record as the case law above sets out and we will not rely on this evidence. Therefore, we cannot conclude that, based on the evidence properly of record, the registered mark is entitled to only a narrow scope of protection. We add that the fact that "evil" and "eye" may be registered separately in other registrations hardly supports applicant's conclusion that the term at issue here, "EVIL EYE(S)," is weak or diluted. The examining attorney maintains that the term "evil eye" or "evil eyes," when "used in connection with goods in classes 18, 25 and 35, is undiluted on the Register appearing only in the prior registrant's mark and the applicant's mark." Denial of Request for Reconsideration at 1.

When we compare the marks in their entireties, we find that the marks EVIL EYE CLOTHING and EVIL EYES and eye design are dominated by the common term EVIL EYE(S) and they are very similar in sound and appearance. Also, their meanings and commercial impression are similar, if not overlapping.

Next, we consider whether the goods of the registrant and applicant are related. Registrant's goods are t-shirts, shorts, pants, hats, caps, underwear, jackets, dress shirts and bandanas. Applicant's goods are: clothing items; mail order and retail services featuring, inter alia, clothing; and various bags, including sports, carrying, book, tote, and beach bags, as well as luggage. In determining whether goods are related, we must consider the goods as they are described in the identification of goods. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

We begin by noting that some of applicant's clothing items are identical to registrant's clothing items (T-

shirts, shorts, pants, caps, and jackets). Other items (dress shirts/shirts and hats/caps) are legally identical. "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Therefore, we find that these goods in class 25 are identical or related to registrant's goods.

Next, we look at applicant's services in Class 35. Here, the services specifically include "mail order services featuring clothing... online retail store services featuring clothing ... [and] retail stores featuring clothing." Registrant's goods include numerous clothing items that would be sold in mail order, online retail store, and retail stores services featuring clothing. The Federal Circuit has discussed the question of whether the mark BIGGS for furniture was confusingly similar to the mark "bigg's" for general merchandise store services. The Court determined that there was a relationship between these goods and services.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their

principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance. The respective marks will have their only impact on the purchasing public in the same marketplace.

*In re Hyper Shoppes*, 837 F.2d 1025, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). See also *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms). Therefore, we conclude that registrant's clothing items are related to applicant's mail order, online, and retail store services featuring clothing.

We add that we do not have to determine if there is a likelihood of confusion for every item in each class of goods or services. Confusion is likely if there is confusion between any item in each class of goods for which applicant seeks registration and the cited registration. *Tuxedo Monopoly Inc. v. General Mills Fun*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or

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under a license, for such item"); and *In re La Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008) ("Likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application or registration").

We also must consider whether applicant's all purpose sport bags, all-purpose carrying bags, backpacks, beach bags, book bags, luggage, and tote bags are related to registrant's clothing items. The examining attorney has submitted some evidence that suggests these items are related. For example, the J. Crew Men's Shop shows J. Crew online retail services selling J.Crew.com only totes as well as messenger bags, laptop satchels, driving caps and knit hats. These ads associate the J. Crew mark with applicant's and registrant's goods and services including the class 18 goods. Similarly, the A/X Armani Exchange website shows the sale of various bags and caps and hats and the DKNY website shows the sale of various clothing items and satchels. The Banana Republic website shows various bags also sold with items of clothing. See also Registration No. 3170729 (beach tote bags and belts for women and T-shirts); No. 2923375 (clothing including pants, shorts, shirts, jackets, hats, and caps and luggage, backpacks, tote bags, diaper bags, and travel bags); and

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No. 29865568 (clothing including T-shirts, jackets, hats, shorts, and pants and tote bags, duffel bags, beach bags, backpacks, and knapsacks). These registrations suggest that these goods of applicant and registrant can originate from a common source. See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

We add one other point that would suggest that applicant's bags in class 18 are related to registrant's clothing. Applicant's mark is EVIL EYE CLOTHING. Registrant's mark EVIL EYES and eye design is registered for various clothing items. Applicant's own mark EVIL EYE **CLOTHING**, when it is used on bags, will suggest to purchasers that there is some connection between the EVIL EYE CLOTHING mark for bags and the EVIL EYES and design mark actually used on clothing.

While applicant's bags and registrant's clothing items are not identical, we find that they are related.

In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources.

*McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001). Consumers here are likely to believe that goods with applicant's and registrant's marks for various bags and clothing items originate from a common source.

Furthermore, the purchasers and channels of trade for these goods and services are either overlapping or similar. To the extent that the goods are identical or the goods are clothing and the services involve selling clothing, the purchasers are identical and the channels of trade would overlap. Furthermore, the evidence suggests that purchasers and channels of trade for various bags and clothing items would be similar, if not overlapping.

*Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003)

("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels

of trade"). We also add that while applicant argues that the decision to purchase applicant's and registrant's goods "is typically a careful decision," (Brief at 18), the evidence does not support a conclusion that the purchasers of these ordinary consumer items and services would necessarily be careful purchasers.

We also cannot agree with applicant that the likelihood of confusion here "is de minimis." Brief at 18. Quite the contrary, when marks are as similar as the marks in this case and the goods and services are identical or related, we find that the potential for confusion is significant. Furthermore, applicant's argument that despite "concurrent use, there has been no confusion" (Brief at 19) does not eliminate the likelihood of confusion. We have little evidence to conclude that there has been a significant opportunity for actual confusion to occur between applicant's mark filed under the intent-to-use provision of the Trademark Act and registrant's mark. The Federal Circuit has explained:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no

likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 52 C.C.P.A. 981, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

*Majestic Distilling*, 65 USPQ2d at 1205. See also *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).

When we balance the evidence in view of the *du Pont* factors, we conclude that there is a likelihood of confusion. The marks are very similar and they would be dominated by the common term EVIL EYE(S). The goods are in part identical or otherwise related. When prospective purchasers encounter the marks EVIL EYE CLOTHING and EVIL EYES and eye design, they would assume that there would be some relationship between the source of applicant's goods and services. As required, we have resolved any doubt about the likelihood of confusion in registrant's favor. *Hyper Shoppes*, 6 USPQ2d at 1026.

Decision: The examining attorney's refusal to register applicant's mark EVIL EYE CLOTHING for the identified goods and services on the ground that it is

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likely to cause confusion with the mark EVIL EYES and design used in connection with registrant's goods under Section 2(d) of the Trademark Act is affirmed.