


I. Introduction

Applicant has applied to register the mark CONQUER for the following services in Class 35: “Retail store services featuring a variety of goods, namely, sporting goods, sport team and league merchandise, gaming merchandise, souvenirs, mugs, glassware, gift items, clothing, clothing accessories, books and magazines, food and beverages.”

In the Office Action dated March 14, 2019, the Examining Attorney refused registration of Applicant’s CONQUER mark under § 2(d) of the Trademark Act, based on a purported likelihood of confusion with (i) U.S. Reg. No. 3,656,809 for the mark CONQUER in Class 25; (ii) U.S. Reg. No. 4,190,396 for the mark CONQUER in Class 28; and (iii) U.S. Reg. No. 4,278,393 for the mark

 CONQUER in Class 25 (collectively the “Cited Marks”), all issued in the name of Felix Garcia (“Garcia”).

The Examining Attorney has taken the position that confusion is likely because Garcia’s goods are likely to be sold at Applicant’s retail stores, and thus consumers encountering both Applicant’s retail stores and Garcia’s goods would believe that they emanate from a common source. However, as discussed below, Applicant has amended its identification of services to avoid any potential overlap between the goods sold in Applicant’s retail stores and the goods covered by the Cited Marks. As such, Applicant’s registration of the mark CONQUER for its services as amended is unlikely to result in confusion with the Cited Marks, and the § 2(d) refusal should be withdrawn.

II. There Is No Likelihood of Confusion Between Applicant’s CONQUER Mark As Amended and the Cited Marks

Applicant has amended its identification of services herein to remove the following categories of goods from within the scope of Applicant’s retail store services:

- Sporting goods
- Sport team and league merchandise
- Clothing
- Clothing accessories


Thus the scope of Applicant’s retail store services as amended includes only the following categories of goods: gaming merchandise, souvenirs, mugs, glassware, gift items, books and magazines, food and beverages. Apart from gaming merchandise, none of those categories of goods would be classified within Classes 25 and 28, and Garcia’s Class 28 registration does not cover any gaming merchandise or related goods. As such, there is no overlap or relationship between the goods sold by Applicant and the goods covered by the Cited Marks.

Accordingly, Applicant’s and Garcia’s respective goods and services are clearly different in nature and are unlikely to be encountered by the same classes of purchasers. Consumers seeking to purchase the goods sold in Applicant’s CONQUER retail stores (namely, gaming merchandise, souvenirs, mugs, glassware, gift items, books and magazines, food and beverages) are unlikely to

believe that Applicant's services are associated with Garcia, who sells clothing and athletic equipment under his CONQUER mark. As such, there is no likelihood of confusion and the § 2(d) refusal should be withdrawn.

III. Prior Filed Applications

The Examining Attorney also cited three prior-filed applications as potential barriers to registration in the event that they mature to registration. At the outset, Applicant notes that two of those applications (Appl. No. 88032587 for CONQUER CLOTHING CO. and Appl. No.

88093765 for ) have been abandoned and thus no longer constitute potential barriers to registration of Applicant's CONQUER mark.

Further, regarding Appl. No. 87831990 for the mark CONKER, while that application covers clothing in Class 25 and sporting equipment in Class 28 (among other goods), Applicant's deletion of clothing and sporting goods from the scope of its retail store services is sufficient to render any potential confusion with that mark unlikely. Further, the terms CONKER and CONQUER are significantly different in appearance and connotation to avoid any likelihood of confusion. The term "conker" means a dark brown nut from a horse chestnut tree,¹ while the term "conquer" means to overcome or take control of something.² Given the clear and unmistakable differences in meaning, consumers are unlikely to believe there is a relationship between CONQUER and CONKER, as further evidenced by the fact that Felix Garcia's cited registrations for the mark CONQUER in Classes 25 and 28 were not cited as barriers to registration of Appl. No. 87831990 for CONKER in those classes. Accordingly, issuance of a § 2(d) refusal in this case based on any registration that may issue from Appl. No. 87831990 would be improper.

IV. Conclusion

In light of the foregoing, all bases for refusal to register Applicant's CONQUER mark have been overcome, and this application is therefore in prima facie condition for publication. Accordingly, Applicant requests that the Examining Attorney withdraw the refusal to register Applicant's CONQUER mark and approve this application for publication.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully invited.

¹ See Ex. A, Oxford English Dictionary definition of "conker", available at <https://www.lexico.com/en/definition/conker>.

² See Ex. B, Oxford English Dictionary definition of "conquer", available at <https://www.lexico.com/en/definition/conquer>.