

**Mark:** CONQUEST (and design) (U.S. Trademark Application No. 88/231,502)

**Goods/Services:** Holograms; Optical disc recordings; Computer application software featuring games and gaming; Computer application software; Computer application software for mobile telephones; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones; Computer programs for video and computer games; Computer programs; Computer programs for accessing, browsing and searching online databases; Computer programs for pre-recorded games; Computer screen saver software, recorded or downloadable; Computer software applications, downloadable; Computer software designed to estimate resource requirements; Downloadable screen savers for computers; Downloadable screen savers for phones; Downloadable software; Downloadable software applications; Downloadable application software for smart phones; Downloadable wallpapers for computers and phones; Freeware; Interactive computer game programs; Image recognition software; Interactive multimedia software for playing games; Multimedia software; Mobile software; Mobile apps; Programs for computers; Programs for smartphones; Publishing software; Screen savers; Software downloadable from the internet; Software and applications for mobile devices; Animated cartoons; Animated cartoons in the form of cinematographic films; Audio books; Books recorded on disc; Cinematographic films; Cinematographic film, exposed; Digital books downloadable from the Internet; Downloadable comic strips; Downloadable computer graphics; Downloadable digital photos; Downloadable electronic books; Downloadable movies; Downloadable image files; Downloadable graphics for mobile phones; Downloadable electronic brochures; Electronic databases recorded on computer media; E-books; Electronic magazines; Electronic publications recorded on computer media; Electronic publications, downloadable; Electronic publications, downloadable, relating to games and gaming; Holographic images; Interactive DVDs; Instruction manuals in electronic format; Prerecorded exercise DVDs; Pre-recorded DVDs; Pre-recorded DVDs featuring games; Prerecorded motion picture videos; Video films (IC 9) - Printed matter; Books; Art pictures; Art prints; Brochures; Booklets relating to games; Comics; Computer game instruction manuals; Comic books (IC 16) - Toys, games, playthings and novelties; Computer game apparatus; Controllers for game consoles; Controllers for video game machines; Joysticks for video games; Protective cases for video game device remote controls; Video

game apparatus; Apparatus for games; Board games; Chessboards; Chess pieces; Chess games; Cases for play accessories; Cases for playing cards; Chips and dice; Collectable toy figures; Compendiums of board games; Controllers for toys; Dice; Electronic board games; Electronic games; Electronic games apparatus; Games; Games relating to fictional characters; Game boards for trading card games; Kits for the construction of scale models; Kits of parts for constructing models; Kits of parts for making toy models; Modeled plastic toy figurines; Models for use with role playing games; Models for use with war games; Miniatures for use in games; Miniatures for use in war games; Playing cards; Portable games and toys incorporating telecommunication functions; Positionable toy figures; Puzzles; Role playing games; Scale model figures; Scale model vehicles; Scale model vegetation; Scale model structures; Scale model kits; Scale model buildings; Scale model aeroplanes; War games using model soldiers; Video game machine cases; Trading cards (IC 28)

**Our Ref:** 130927.000002

Argument:

The Examining Attorney refused registration for the mark CONQUEST (and design) and raised three issues in an Office Action dated March 17, 2019. Each of the three issues are addressed herein.

A. Potential Section 2(d) Refusal – Pending Application

The Examining Attorney identified a pending trademark application as a potential refusal to registration of the Applicant’s mark under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. The pending application, U.S. Application Serial No. 88/152,657, is for the mark CONQUEST MAPS in connection with various goods in Class 16. Since the issuance of the Office Action, the Patent and Trademark Office issued a registration for CONQUEST MAPS, U.S. Registration No. 5,768,161. As such, the pending application may be referred to as the “**Registration**” throughout this response. As more fully elaborated below, this response by Applicant seeks to clarify and delete certain goods from its application, which renders this objection moot. Additionally, Applicant submits there is no likelihood of confusion between the two marks.

1. The Applicant’s Amended Goods Render the Objection Moot

Specifically, the Registration identified by the Examining Attorney lists goods that include “art pictures,” “art prints,” and “mounted posters.” These are the only goods identified in the Registration that arguably overlap with the Applicant’s stated goods in Class 16; however, as more fully elaborated in Section B, below, Applicant will remove “art pictures,” “art prints,” “posters,” and “art books” as a part of the clarification of Applicant’s goods requested by the Examining Attorney. With such removal, Applicant

respectfully submits that this first issue has been addressed and rendered moot, allowing for Applicant's application to proceed to publication, considering the additional issues addressed in this response.

As more fully elaborated below, Applicant offers additional arguments positing that no likelihood of confusion exists between Applicant's mark and the cited mark identified by the Examining Attorney.

## 2. No Likelihood of Confusion Exists

Applicant's mark, CONQUEST (and design), and the cited mark, CONQUEST MAPS, are not likely to be confused in commerce by the consuming public. Applicant's mark includes a distinctive "dragon head" design lacking in the cited mark. Furthermore, the following cases illustrate that federal courts and the Trademark Trial and Appeal Board ("T.T.A.B." or "Board") have long held that registration should not be denied automatically because two marks contain common words, sound similar, and are applied to similar goods or services. In particular, differences in connotation and meaning are a key factor in assessing likelihood of confusion. Revlon, Inc. v. Jerell, Inc., 713 F. Supp. 93, 98, 11 U.S.P.Q.2d 1612, 1616 (S.D.N.Y. 1989) ("Differing connotations themselves can be determinative, even where identical words with identical meanings are used").

If marks in their entireties convey different commercial impressions, likelihood of confusion between marks that add or delete a word can be avoided. See, e.g., In re Farm Fresh Catfish Co., 231 U.S.P.Q. 495 (T.T.A.B. 1996) (BOBBER for restaurant services created a different commercial impression than CATFISH BOBBER for fish). For instance, in In re Sears, Roebuck, & Co., 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987), the Board held that the marks CROSS-OVER for bras and CROSSOVER for ladies sportswear conveyed different meanings. In this case, the words were almost identical, and the goods and services were similar in that they both relate to women's clothing, yet the Board found there was no likelihood of confusion between the marks because of the different commercial impressions conveyed.

In the case of In re Po Folks, 231 U.S.P.Q. 313, the Board held that although both marks PO FOLKS and KOUNTRY FOLKS contained the word FOLKS, a different commercial impression was created in each mark by combining the word FOLKS with an additional word. T.T.A.B. 1986. Similarly, in Smith v. Tobacco By-Prods. Chem. Corp., 113 U.S.P.Q. 339 (C.C.P.A. 1957), the court held that although both marks, GREEN LEAF and BLACK LEAF, contained the word LEAF, the different meanings of GREEN LEAF and BLACK LEAF for plant spray created an additional distinction showing that there was no likelihood of confusion between the two marks.

In ConAgra, Inc. v. Saavdra, 4 U.S.P.Q.2d 1245 (T.T.A.B. 1987), the Board held that the marks PATIO for Mexican style food and TAPATIO for related hot sauce were not likely to be confused, notwithstanding the common components between the two marks. The fact that the mark PATIO had a definite meaning to the American consumer, while the mark TAPATIO merely suggested something Spanish, eliminated the likelihood of consumer confusion. Other cases have been decided in a similar manner. See

Chaussures Bally Societe Anonyme de Fabrication v. Dial Shoe Co., 345 F.2d 216 (C.C.P.A. 1965) (LA VALLI for women’s shoes registrable over BALLY for boots, shoes, sandals, moccasins, and bath slippers); Shoe Corp. of America v. Juvenile Shoe Corp. of America, 266 F.2d 793 (C.C.P.A. 1959) (LAZY PALS registrable over LAZY BONES, both for footwear); Holiday Casuals v. M. Beckerman & Sons, Inc., 228 F.2d 224 (C.C.P.A. 1955) (HAPPY DEBS registrable over HONEY DEBS, both for shoe merchandise); The Stouffer Corp. v. Health Valley Natural Foods, Inc., 1 U.S.P.Q. 2d 1900, 1904–06 (T.T.A.B. 1987) (LEAN LIVING not likely to cause confusion with LEAN CUISINE, both for healthy food products).

Applicant’s use of its mark on any goods within Class 16 (as amended in this response) does not overlap with any of the goods used in connection with the cited mark. Average consumers of tabletop and downloadable electronic games will not confuse the two marks, as they represent fundamentally different types of goods. As its name suggests, the cited mark, CONQUEST MAPS, is used in conjunction with maps and map-related artwork. The amended goods associated with Applicant’s mark do not include maps. Respective consumers of both goods associated with the Registration and goods associated with the instant application will not be able to draw any connection between the two types of goods, as there is no overlap between the two. Goods associated with the Registration and goods associated with the instant application are likely unrecognizable to average consumers of both.

Additionally, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. See In re Shell Oil Co., 992 F.2d 1204 (Fed. Cir. 1993). Given the Applicant’s amended goods within this response, the actual goods provided in connection with the cited mark and Applicant’s goods are uncompetitive and used for completely different purposes. Also, the marks do not share trade channels or prospective purchasers.

A cursory review of the trademark database reveals U.S. Registration No. 5,206,857 for MULTIVERSE: COSMIC CONQUEST (see registration attached as Appendix A), which is used in connection with “art pictures” and “posters” in Class 16. If a registration can issue for the mark CONQUEST MAPS in view of a this prior registration for the mark MULTIVERSE: COSMIC CONQUEST when both are used with overlapping goods (i.e., art pictures and posters), it proves that no single entity owns exclusive rights in the term “CONQUEST” in connection with goods in Class 16 and both marks are relatively weak. Put another way, if registrations for the marks CONQUEST MAPS and MULTIVERSE: COSMIC CONQUEST can co-exist in Class 16 when used with overlapping goods, Applicant’s mark CONQUEST (and design) used with non-overlapping goods certainly can coexist as well.

In view of the inherent differences between the goods associated with Applicant’s mark and those associated with the cited mark, the different appearance of the marks provided by Applicant’s design element, that Applicant’s goods and the goods associated with the cited mark are offered to different consumer bases, and the relative weakness of the cited mark, Applicant respectfully submits that there is no likelihood of confusion between Applicant’s mark and the cited mark and requests withdrawal of this rejection.

## B. Classification and Identification of Goods

The Examining Attorney has identified many of the Applicant's identified goods in Classes 9, 16, and 28 as being indefinite and in need of clarification. Applicant hereby adopts the following amended goods (by Class) in connection with the CONQUEST mark, as suggested by the Examining Attorney:

Class 9 – Downloadable software, namely, software for playing video games and instructing in the field of video games, computer gaming, modelling, painting; Downloadable software applications for playing video games and instructing in the field of video games, computer gaming, modelling, painting; Downloadable application software for smart phones, namely, software for accessing, browsing, and searching online databases; Downloadable wallpapers for computers and phones, namely, downloadable images in the field of video games; Mobile apps, namely, downloadable mobile applications for playing video games and accessing, browsing, and searching online databases; Programs for computers, namely, computer programs for instruction in the field of video games, computer gaming, modelling, painting; Downloadable image files containing war games, skirmish games, role playing games, battle games, fantasy/science fiction games, fantasy and science fiction; Downloadable graphics for mobile phones; Electronic databases in the field of rules, unit characteristics, and points related to war games, skirmish games, role playing games, battle games, fantasy/science fiction games, fantasy and science fiction recorded on computer media; Downloadable electronic publications in the nature of manuals, books, art books, painting guides, rule books, codexes, journals, magazines, brochures, newsletters, pamphlets, information flyers, information sheets, comics, novels, novellas in the field of games and gaming; Downloadable holographic images in the field of war games, skirmish games, role playing games, battle games, fantasy/science fiction games, fantasy and science fiction; Instruction manuals in downloadable electronic format, namely, instruction sheets in the field of war games, skirmish games, role playing games, battle games, fantasy/science fiction games, fantasy and science fiction

Class 16 – Printed matter, namely, manuals, books, rule books, codexes, journals, magazines, brochures, newsletters, pamphlets, information flyers, information sheets, instruction sheets, painting guides, instructional and teaching material, novels, novellas featuring war games, skirmish games, role playing games, battle games, fantasy/science fiction games, fantasy and science fiction; Booklets relating to games; Comics; Computer game instruction manuals; Comic books; Trading cards, other than for games

Class 28 – Toys, games, playthings, and novelties, namely, board games, tabletop games, model toy vehicles, card games, playing cards; Board games; Cases for play accessories; Cases for playing cards; Game equipment, namely, chips and dice; Collectable toy figures; Compendiums

of board games; Games, namely, board games and tabletop games, featuring fictional characters; Kits for the construction of scale models, namely, scale model kits; Kits of parts for constructing models in the nature of scale model kits; Kits of parts for making toy models in the nature of scale model kits; Modeled plastic toy figurines; Models, namely, soldiers, armies, aliens, vehicles, landscapes, mythical creatures for use with role playing games; Models, namely soldiers, armies, aliens, vehicles, landscapes, mythical creatures for use with war games; Playing pieces in the nature of miniature action figures for use in playing role playing games; Playing pieces in the nature of miniature action figures for use in playing war games; Playing cards; Positionable toy figures; Puzzles; Role playing games; Scale model figures; Scale model vehicles; Scale model vegetation; Scale model kits; Scale model buildings; Scale model aeroplanes; Tabletop hobby battle games in the nature of war games using toy model soldiers; Trading cards for games

#### C. Amended Mark Description

The Examining Attorney has asserted that the description of the mark in the instant application is unacceptable as incomplete and not describing all the significant aspects of the mark. Applicant hereby adopts the following amended description of the mark suggested by the Examining Attorney:

The mark consists of the stylized word "CONQUEST", with the letter "C" formed by a miscellaneous design with spikes extending therefrom, and a pair of lines extending horizontally from the letter "C", one line above the letters "ONQUEST" and the other line below the letters, each line terminating in an angled portion extending away from the letter "T", and wherein the tail of the "Q" interrupts the lower horizontal line.

#### D. Conclusion

With the amended goods and mark description outlined in this response, Applicant respectfully submits that it has resolved all three issues raised by the Examining Attorney in the Office Action dated March 17, 2019. Applicant again asserts there is no significant likelihood of confusion between Applicant's mark, CONQUEST (and design), and the cited mark, CONQUEST MAPS, when used in connection with their respective goods, despite the fact the marks share common words. In light of these arguments, Applicant respectfully submits that the instant application is suitable for registration.

APPENDIX A

**United States of America**  
United States Patent and Trademark Office

**Multiverse: Cosmic Conquest**

**Reg. No. 5,206,857**

THREE-POINT PERSPECTIVE LIMITED (UNITED KINGDOM Private Limited Company )

**Registered May 23, 2017**

33-35 Daws Lane  
London NW7 4SD

**Int. Cl.: 9, 16, 28, 41**

UNITED KINGDOM

**Service Mark**

CLASS 9: Cinematographic film, exposed; computer game software; computer graphics software; downloadable computer game programs; downloadable music files; downloadable image files containing artwork, pictures, text, audio, video, games; electronic game programs; electronic game software; electronic game software for wireless devices; recorded computer game programs; video and computer game programs

**Trademark**

**Principal Register**

CLASS 16: Art pictures; cardboard; trading cards; comic books; graphic art prints; graphic art reproductions; paper; paperboard; photographs; pictures; placards of paper or cardboard; posters; printed publications, namely, magazines in the field of board games and trading cards; trading cards other than for games; writing or drawing books

CLASS 28: Board games; card games; checkerboards; game cards; parlour games; party games; playing cards; playing cards and card games; trading card games

CLASS 41: Entertainment information; entertainment services, namely, arranging and conducting of competitions in the field of board games, trading card games; organisation of games; providing entertainment information via a website; providing on-line computer games; publication of texts, other than publicity texts; publishing of electronic publications

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

OWNER OF INTERNATIONAL REGISTRATION 1304640 DATED 05-18-2016, EXPIRES 05-18-2026

SER. NO. 79-189,809, FILED 05-18-2016

CYNTHIA YOUKO RINALDI, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office