

ITAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,357,839
Registered June 13, 2000
Trademark ART BASIX

-----	X	
ColArt Americas, Inc.,	:	
	:	
	:	Petitioner, : <u>PETITION TO CANCEL</u>
	:	
-v-	:	
	:	Cancellation No _____
Pentech International Inc.,	:	
	:	
	:	09-09-2002
	:	U.S. Patent & TMO/c/TM Mail Rcpt Dt. #61
-----	X	

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Petitioner, ColArt Americas, Inc., a New Jersey corporation, with its principal place of business at 11 Constitution Avenue, P.O. Box 1396 Piscataway, NJ 08855-1396, believes that it will be damaged by the continued existence on the Principal Register of the above-identified registration for the trademark ART BASIX and hereby petitions to cancel the same.

As grounds for cancellation, it is alleged that:

1. Petitioner is and for many years has been engaged in the manufacture and marketing of paints, artist supplies and paper products.
2. On November 20, 2001, Petitioner filed a Section 1(a) application with the United States Patent and Trademark Office ("PTO") to register the mark BASICS (Stylized) on the Principal Register for "artists supplies, namely, acrylic paints, colors, watercolors" in International Class 2 and "paper products, namely, writing paper and drawing paper for use by artists or on handicraft or for use in handicraft; quills, paint storage boxes for artists' use, artists' paint brushes, artists' canvas, artists' palettes, artists' saucers for holding paints, artists' easels,



artists' drawing boards, artists' paper drawing books, printed forms, printed teaching and instructional material in the field of arts; modeling clay, modeling compound, paste for stationery or household purpose" in International Class 16. The application was assigned Serial No. 76/341,125. A copy of the filing receipt for Petitioner's application is attached hereto as Exhibit A.

3. On March 5, 2002, the Examining Attorney issued an Office Action refusing registration of Applicant's mark on the grounds that (1) Applicant's marks were likely to be confused with Reg. No. 2,357,839 (hereinafter referred to as "the cited mark"), and (2) Applicant must amend the identification of goods.

4. On September 5, 2002, Applicant filed a timely response to the Office Action, by amending its identification of goods to "artists' supplies, namely, acrylic paints, acrylic paint colors and watercolor paints" in International Class 2, and "paper products, namely, writing paper and drawing paper for use by artists or on handicraft or for use in handicraft; quills, plastic and cardboard paint storage boxes for artists' use, artists' paint brushes, artists' canvas, artists' palettes, artists' saucers for holding paint, artists' easels, artists' drawing boards, artists' paper drawing books, printed forms, printed teaching and instructional material in the field of arts; modeling clay, modeling compound, paste for stationery or household purpose" in International Class 16. Applicant also requested that the application be suspended, pending the outcome of this cancellation proceeding.

5. Respondent's mark, as set forth in the registration to be cancelled, so resembles Applicant's mark as to be likely, when applied to Applicant's goods, to cause confusion, mistake or to deceive for purposes of Section 2(d) of the Lanham Act.

6. The record owner of the cited mark is Pentech International Inc, a Delaware corporation with an address at 195 Carter Drive, Edison, New Jersey 08817.

7. The goods listed in the registration for the cited mark are “art and craft paints, namely, finger paints, poster paints, water colors, glitter paints, fabric paints, acrylic paints, paints in stick form” in International Class 2 and “writing instruments, namely, pens, pencils, mechanical pencils, marking pens, crayons, plastic crayons, sketching pencils, coloring pencils, chalk, charcoal pencils; modeling clays and compounds; paint sets for artists and children; artist brushes, paint sponges, paint stamps; etching tools, namely, files and scrapers; rubber stamps and stamp pads therefore; art and drawing paper, sketch pads, poster paper; stencils; adhesive paste, glue, colored glue, glittered glue, glue in stick form, adhesive tape, and decorative and colored adhesive tapes for stationery and household purposes; drawing and drafting compasses; drawing and ungraduated rulers” in International Class 16.

8. Since as early as 1993, and long prior to any use by Respondent, Petitioner, through a predecessor in interest, used the mark BASICS (Stylized) in connection with, inter alia, paints, art supplies and paper products. Petitioner’s use of the mark BASICS (Stylized) in connection with said goods has been continuous.

9. Upon information and belief, Respondent made no use of the mark ART BASIX prior to December 14, 1999, which Respondent claimed as its date of first use in Reg. No. 2,357,839.

10. Petitioner will be damaged by the continued existence on the Register of the cited mark, Reg. No. 2,357,839, because it will give color of rights to Respondent and will continue to be an impediment to Petitioner’s ability to register the marks BASICS (STYLIZED), Serial No. 76/341,125.

WHEREFORE, Petitioner prays that this petition to cancel be granted and that Reg. No. 2,357,839 for the mark ART BASIX be cancelled forthwith.

Dated: New York, New York
September 5, 2002

ColArt Americas, Inc.

By: Perla M Kuhn
Perla M. Kuhn
Attorney for Petitioner
Hughes Hubbard & Reed LLP
One Battery Park Plaza
New York, New York 1004
(212) 837-6000

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

on September 5, 2002
HUGHES HUBBARD & REED LLP

Dated: 9/5/02 By: [Signature]
Name: CL M GLENN