

ITAB



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U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: December 20, 2002

Pentech International Inc.

195 Carter Drive
Edison, NJ 08817

Cancellation No. 92041291

Reg. No. 2357839

PERLA M. KUHN
HUGHES HUBBARD & REED LLP.
ONE BATTERY PARK PLAZA
NEW YORK, NY 10004

COLART AMERICAS, INC.

V.

Pentech International Inc.

LATRICIA HARRISON, LEGAL ASSISTANT:

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as

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well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open: **January 09, 2003**

Discovery period to close: **July 08, 2003**

30-day testimony period for party
in position of plaintiff to close: **October 06, 2003**

30-day testimony period for party
in position of defendant to close: **December 05, 2003**

15-day rebuttal testimony period
for plaintiff to close: **January 19, 2004**

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

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: Perla M Kuhn
Name: CL M KUHNER