


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kabushiki Kaisha Pilot Corporation :
TA Pilot Corporation :
Serial No.: 88/212,408 : Kerry A. Nicholson :
Examining Attorney :
Law Office 120 :
Mark:  :
Filing Date: November 30, 2018 :
Our Ref: KKPC 1812010 :

RESPONSE TO OFFICE ACTION

This is in response to the Office Action mailed on January 22, 2020.

REMARKS

Noting the Examining Attorney’s objections to the specimens submitted with Applicant’s Allegation of Use, Applicant has submitted substitute specimens for the goods in Classes 2 and 16, along with a supporting declaration signed by Applicant’s principal attesting to use in commerce as of the relevant time period to file the Allegation.

Applicant’s substitute specimen for Class 16 clearly shows the mark ENSO applied to packaging for goods named in the application. Such specimen should be deemed acceptable and obviates the objection based on the prior specimen comprising advertising material.

As to Class 2, the Examiner objected to the original specimen since it shows the applied-for mark in use in commerce in connection with fountain pen ink sets, calligraphy sets, fountain pen sets, coloring sets, lettering pens, and hand lettering kits, but not with “watercolor paints” which is the operative goods description in Class 2 (along with “painting sets for artists”).

In response, Applicant also submits a substitute specimen for Class 2 showing the mark used with watercolor paints contained in brush pens.

D | Watercolor Brush Pens

This unique brush pen collection features seven extra fine, colorful brush tip pens ideal for detailed work, and one bold tip black brush pen that delivers rich, dark, flowing lines. The Ensō Brush pens are ideal for hand lettering, personalized greeting cards and your everyday calligraphy needs.



Bold

Extra Fine



Pilot Ensō Watercolor Brush Pen Hand Lettering Kit

\$19.51

Applicant submits that this suffices to show use of the mark on “watercolor paints.” The fact that these are sold in brush pen format does not change the composition of the paint component. Applicant notes that “watercolor paints” comprises also those watercolors that are

applied through brush pens. Therefore, Applicant submits that the use of the mark on packaging for watercolor brush pens, i.e., brush pens that contain watercolor paint, should suffice as acceptable specimens to show use of the mark in Class 2 and withdraw the rejection.