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

Proceeding	92047056
Party	Plaintiff TERRA SUL CORPORATION A/K/A CHURRASCARIA BOI NA BRASA
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Terra Sul Corporation a/k/a	§	
Churrascaria Boi Na Brasa	§	
	§	
Petitioner	§	
	§	
V.	§	Cancellation No. 92047056
	§	
Boi Na Braza, Inc.,	§	
	§	
Registrant.	§	

**PETITIONER’S REPLY TO RESPONDENT’S**  
**FINAL BRIEF ON THE MERITS**

Pursuant to 37 C.F.R. § 2.128(a) and Rule 801.02(c) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Petitioner Terra Sul Corporation, a/k/a Churrascaria Boi Na Brasa (hereinafter “Terra Sul” or “Petitioner”) hereby submits its Reply Brief for consideration by the Board. Petitioner maintains its contention that the federal registration of the mark BOI NA BRASA (No. 2,534,608) should be cancelled. Petitioner’s factual and legal support for this contention is set forth as follows:

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I.

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## II.

### **DESCRIPTION OF THE RECORD**

The evidence of record consists of the documents and materials relied upon in Petitioner's and Respondent's respective Trial Briefs and the evidence previously made of record and incorporated by reference herein.

### III.

#### **REPLY TO RESPONDENT'S TRIAL BRIEF**

Registrant Boi Na Braza, Inc. (“Boi Na Braza” or “Registrant”) submitted its response to Petitioner’s Trial Brief on April 15, 2009. Registrant’s Brief seeks to distract the Board from three very simple facts: First, while Registrant hints at allegedly inconsistent corporate filings and individual statements, Registrant has no evidence that Petitioner has ever abandoned its continual use of the mark CHURRASCARIA BOI NA BRASA in conjunction with Petitioner’s restaurant business in New Jersey. Secondly, Registrant was not the first to conceive and use the mark “Boi Na Braza” to be used in conjunction with restaurant services. Lastly, and most importantly, Registrant cannot rebut the fact that its mark BOI NA BRAZA does not operate as a trademark because it fails to identify and distinguish the source of the goods of Registrant from those of others, namely Petitioner.

**1. Petitioner has never abandoned or ceased use of its service mark CHURRASCARIA BOI NA BRASA.**

Churrascaria Boi Na Braza Corp., the predecessor entity to Terra Sul Corp., was formed in early 1996. It was later incorporated by the State of New Jersey on March 28, 1996 and thereafter began conducting business via the restaurant known as “Churrascaria Boi Na Braza” located at 70 Adams Street in Newark, New Jersey. *See* Exhibits A-1, A-2 and A-3. Registrant has not – and cannot – dispute these facts. Contrary to Registrant’s claims, Petitioner’s evidence and testimony supporting “first use” and priority are fully supported by documents, including government certifications issued by the State of New Jersey. Correspondingly, as of March 28, 1996, Registrant admittedly was not conducting business in the United States and had yet to even conceive of the name “Boi Na Braza.”

Farid Saleh was the President of Churrascaria Boi Na Brasa Corp.. Exhibit A, at page 6-7.<sup>1</sup> Mr. Saleh is also currently the President of Terra Sul Corp. Exhibit A-18. The manner of use of Petitioner's BOI NA BRASA service mark has not varied in any way after Mr. Saleh formed Terra Sul Corp. in 1999 and transferred the rights to the mark to Terra Sul. Exhibit A, page 51, lines 16-25. Mr. Saleh is the common link between the two entities. There is also a consistent chain of ownership of the service mark CHURRASCARIA BOI NA BRASA.

Registrant, however, seeks to undermine the continuity of Petitioner's use of the mark. First, Registrant claims that under New Jersey law, there was not a proper transfer of trademark rights between Churrascaria Boi Na Brasa Corp. and Terra Sul Corp. Registrant cites to the New Jersey statutes on trademark law and suggests that any assignment of trademark rights must be "by instruments in writing..."<sup>2</sup> Petitioner does not dispute that this is an accurate reading of the particular statute. This provision, however, is for *registered* trademarks. Petitioner instead relies upon its common law rights in its CHURRASCARIA BOI NA BRASA mark. The New Jersey statute on trademarks clearly reads that "[n]othing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law."<sup>3</sup> Furthermore, the statute includes a provision on the abandonment of marks, common law or otherwise. To "abandon" a mark, the owner must:

(1) When its use has been discontinued with intent not to resume that use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall constitute prima facie evidence of abandonment. (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark.<sup>4</sup>

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<sup>1</sup> See also Exhibit A-1 (with Farid Saleh identified as the registered agent).

<sup>2</sup> See Registrant's Br. at 7.

<sup>3</sup> N.J. STAT. ANN. § 56:3-13.13 (1995).

<sup>4</sup> *Id.* at § 56:3-13.1a

Neither Petitioner, nor Farid Saleh in his individual capacity, ever intended to abandon any rights to the CHURRASCARIA BOI NA BRASA mark. The statute also prevents Registrant from “inferring” any such intent to abandon. Moreover, there has never been a discontinuity in the use of the mark, much less a two-year gap. Lastly, there is no evidence that Petitioner’s common law mark has ever lost significance as a trademark. Registrant has offered no evidence to the contrary.

Instead, Registrant seeks to show a quasi-abandonment of Petitioner’s mark because of an alleged failure to maintain corporate formalities. This attack, however, undermines the purpose of trademarks – which is to identify to the *consuming public* the proper source of goods and services.<sup>5</sup> Furthermore, “[a] trademark owner has a property right only insofar as is necessary to prevent customer confusion as to who produced the goods and to facilitate differentiation of the trademark owner’s goods.”<sup>6</sup> Petitioner’s service mark has been an identification of the goods/services associated with the “Churrascaria Boi Na Brasa” restaurant located at 70 Adams Street in Newark, New Jersey since 1996. In contrast, the existence of U.S. Registration No. 2,534,608 (Registrant’s mark) will only serve to confuse consumers as to the source of goods and services. Registrant’s attempt at misdirecting the Board from the central issue does not change the significance of Petitioner’s mark in the eyes of the relevant public.

Meanwhile, Farid Saleh is a Portuguese-speaking Brazilian national.<sup>7</sup> Mr. Saleh is not a lawyer in any country. Mr. Saleh is neither an expert on trademark law nor corporate law.

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<sup>5</sup> See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 2:1 (2008). “The interest of the public in not being deceived has been called the basic policy.” See also § 2:14. “Trademark law has many presumptions, assumptions and a few overriding public policies, but the central key is customer perception.”

<sup>6</sup> *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 208 U.S.P.Q. 718 (9<sup>th</sup> Cir. 1980), cert. denied, 452 U.S. 941, 69 L. Ed.2d 956, 101 S. Ct. 3086, 213 U.S.P.Q. 1056 (1981) (citing treatise).

<sup>7</sup> Both of Mr. Saleh’s depositions – the discovery deposition and the testimony deposition, respectively – were conducted with the assistance of a Portuguese-to-English translator.

Yet Registrant now seeks to exploit Mr. Saleh's lack of expertise and hold him to improper heightened standards of conduct. For example, Registrant points to the alternate-name registration filed by Mr. Saleh on behalf of Terra Sul in February 2007.<sup>8</sup> This alternative-name application was hastily filed in response to the threatening letter sent to Mr. Saleh by Registrant's corporate counsel in January 2007. Exhibit A-21. Further, while the face of the alternate-name application does (incorrectly) indicate that as of January 16, 2007, that Terra Sul Corp. (and Farid Saleh, individually) had not used the name "Churrascaria Boi Na Brasa" apart from the corporate name – the evidence in the record clearly shows otherwise. *See generally*, Exhibits A-15, A-18, A-20, and A-22. The Board can easily discern from the evidence that the mark CHURRASCARIA BOI NA BRASA was in continual use by from 1996 through the present day, that the use of this mark was controlled by Churrascaria Boi Na Brasa Corp. from 1996 (with Farid Saleh as the individual overseeing this use in his role as President), and that the use of this mark was controlled by Terra Sul as of January 1999 (again with Farid Saleh as the individual overseeing this use in his role as President).

Registrant also directs the Board's attention to an intent-to-use trademark application filed by Farid Saleh on behalf of Terra Sul. *See* Registrant's Exhibit C. Registrant claims this is evidence that Petitioner only had an "intent-to-use" the CHURRASCARIA BOI NA BRASA mark as of March 2002. Registrant, however, fails to note the distinction in the application. The actual application is for the mark "Churrascaria Boi Na Brasa *Corp.*" (emphasis added). This is not the mark made of issue by Petitioner in this proceeding. Thus, Registrant's Exhibit C is wholly irrelevant to the analysis of Petitioner's use of the CHURRASCARIA BOI NA BRASA service mark.

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<sup>8</sup> *See* Registrant's Br. at 9. *See also* Exhibit A-19.

Nevertheless, Registrant merely seeks to exploit Mr. Saleh's status as a non-attorney. Mr. Saleh did file the intent-to-use application as an individual and did not directly identify Terra Sul Corp. as the applicant. Saleh, however, *did* identify the applicant's address as "70 Adams St., Newark, New Jersey."<sup>9</sup> This is not Mr. Saleh's home address. Since 1996, the only building located at 70 Adams Street in Newark has been a restaurant – Churrascaria Boi Na Brasa.<sup>10</sup> This is a business address, which operates to show Mr. Saleh's intent to file on behalf of Terra Sul. Registrant's reliance on this particular documentary evidence does not disprove that Petitioner was the senior user of the mark nor does it prove that Petitioner has abandoned or discontinued use of its service mark.

In short, Registrant is grasping at straws and has no actual evidence to dispute that the restaurant identified as "Churrascaria Boi Na Brasa" and located at 70 Adams Street in Newark, New Jersey has been open for business since 1996 and is the source of goods and services identified by Petitioner's CHURRASCARIA BOI NA BRASA mark.

**2. Registrant is not the first to conceive of a BOI NA BRASA mark and Petitioner is the actual senior user and owner of any trademark rights.**

Registrant's Brief sets forth the demarcation line of "first use." Specifically, Registrant unambiguously admits that its first use of the BOI NA BRAZA mark (with a "z") was on July 19, 1999. Registrant therefore cannot claim any trademark rights pre-dating July 19, 1999. The senior user of a trademark is the one who is the first to use the mark in the United States – not just conceive of it.<sup>11</sup> Trademark rights grow out of use, not mere adoption of a name.<sup>12</sup> In this instance, Petitioner began using the mark in commerce shortly after Churrascaria Boi Na Brasa Corp. was incorporated in New Jersey on March 28, 1996. Petitioner has provided evidence of

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<sup>9</sup> See Registrant's Exhibit C.

<sup>10</sup> Exhibits A-2, A-20.

<sup>11</sup> *MNI Mgmt. Inc. v. Wine King, LLC*, 542 F. Supp. 2d 389, 405 (D. N.J. 2008) (emphasis added).

<sup>12</sup> *Id.*

advertisements – evidence of use of its mark in commerce – where these advertisements are dated September 1997. Exhibit A-15. Whatever Petitioner’s actual date of “first use” may be, Registrant cannot dispute that as of September 1997 it had not acquired any trademark rights in the marks “Boi Na Brasa” or “Boi Na Braza.”

Further, assuming, *arguendo*, that even if Terra Sul Corp. failed to properly acquire the rights to the goodwill associated with Churrascaria Boi Na Brasa Corp. and the CHURRASCARIA BOI NA BRASA service mark (as Registrant alleges), Terra Sul was nonetheless incorporated in New Jersey on January 19, 1999 and began doing business at the same location (70 Adams Street) at that time.<sup>13</sup> While the record lacks an advertisement in a newspaper for Petitioner between January and July 1999, there is overwhelming evidence that “Churrascaria Boi Na Brasa” was open as a restaurant in that timeframe and was using the service mark at issue to identify this restaurant.<sup>14</sup> For example, the State of New Jersey issued Terra Sul a Certificate of Authority with a “Tax Effective Date” of April 1, 1999.<sup>15</sup> Common sense dictates that the State could not collect taxes unless an actual business was in operation. Thus, even if the pre-1999 use by Churrascaria Boi Na Brasa Corp. is ignored, Terra Sul’s January 1999 and beyond uses of the mark pre-date Registrant’s admitted date of first use by at least three months and as much as *six months*.

Registrant’s defense is directed to the alleged lack of evidence transferring trademark rights from Churrascaria Boi Na Brasa Corp. to Terra Sul Corp. Registrant asserts there is no proof of an assignment or transfer of rights to Petitioner.<sup>16</sup> Registrant states that “ownership

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<sup>13</sup> See Exhibits A-18 and A-20. Furthermore, the advertisements identified by A-15 are entirely consistent in the use of the name and logo and show continued use from September 1997 through November 1999.

<sup>14</sup> *Id.*

<sup>15</sup> Exhibit A-20.

<sup>16</sup> See Registrant’s Br. at 7.

rights” can be transferred only by a written assignment or by “operation of law.”<sup>17</sup> Registrant, however, overlooks the fact that a transfer of the CHURRASCARIA BOI NA BRASA mark to Terra Sul *has* been made via an “operation of law.”

Various state laws have made allowances for a transfer of trademark rights between entities after a review of individual circumstances, such as a merger or inheritance of property rights.<sup>18</sup> Here, Terra Sul has acquired substantially all of the property and rights previously associated with Churrascaria Boi Na Brasa Corp. There is also a common ownership interest, namely Mr. Farid Saleh serving as President of both entities. Essentially, whether or not there has been a formal “merger” between the entities is immaterial. In this instance, at the very least the original entity (Churrascaria Boi Na Brasa Corp.) has acquiesced to the acquisition, ownership and use of the CHURRASCARIA BOI NA BRASA service mark by Terra Sul Corp. There is no evidence that the corporate entity “Churrascaria Boi Na Brasa Corp.” ever objected to Terra Sul’s use of the mark. Registrant cannot show otherwise. This acquiescence sets forth an implicit transfer of ownership of the mark to Terra Sul. Essentially, there has been a transfer of rights via “operation of law” and there has been continued use of the mark by Petitioner (and its successor entity) beginning in 1996.

Registrant is not the senior user. Petitioner is. Accordingly, Boi Na Braza, Inc.’s federal registration for BOI NA BRAZA should be cancelled.

**3. Registrant’s alleged mark does not serve as a trademark to the relevant public.**

Contrary to Registrant’s assertions, Terra Sul can – and has – established sufficient grounds for cancellation of the registration. Registrant is only entitled to a federal registration if

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<sup>17</sup> *Id.* (citing McCarthy at § 18).

<sup>18</sup> *See generally*, [http://www.sos.state.co.us/pubs/business/helpFiles/TDMK\\_TRF\\_IND\\_HELP.pdf](http://www.sos.state.co.us/pubs/business/helpFiles/TDMK_TRF_IND_HELP.pdf) (citing to Colorado Revised Statutes § 7-70-106 (rev. 2007) and stating that “Examples of a transferee succeeding to the rights and interests in the trademark by operation of law are a merger of business entities or inheritance.”)

its mark actually serves as a trademark. Here, however, Registrant's mark "[c]onsists of or comprises a mark which so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Accordingly, pursuant to 15 U.S.C. § 1064(3), Petitioner has a legitimate basis for cancelling the registration at issue.

BOI NA BRAZA fails to serve as a trademark because it does not signify to the relevant public (as defined by Registrant<sup>19</sup>) the actual source of the goods/services associated therewith and so resembles Petitioner's own service mark as to cause confusion in the marketplace. Additionally, as shown herein and previously in Petitioner's Trial Brief, Registrant is not the senior user.<sup>20</sup> Petitioner has been using its service mark since 1996. Registrant's confusingly similar mark was not in use in commerce until admittedly July 1999. As the first user of the mark in commerce, Petitioner has senior common law rights that supersede Boi Na Braza, Inc.'s rights. The user who first appropriates the mark obtains an enforceable right to exclude others from using it.<sup>21</sup> This would be Petitioner.

Also, the prior user of an unregistered mark is entitled to common law protection for its continued use of the mark in the areas of use that pre-date registration.<sup>22</sup> Petitioner Terra Sul is the owner of any rights that may be associated with the marks at issue. Registrant lacks any basis for asserting trademark rights that would be sufficient to maintain a federal registration.

Registrant cannot claim that its mark clearly identifies Boi Na Braza, Inc. as the proper source of goods/services associated with the mark. For example, while Petitioner has no

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<sup>19</sup> See Petitioner's Br. at 13. See also Petitioner's Exhibit D, Interrogatory No. 28.

<sup>20</sup> See Petitioner's Br. at 4-5.

<sup>21</sup> *Patsy's Italian Rest., Inc. v. Banas*, 508 F. Supp. 2d 194, 217 (E.D.N.Y. 2007).

<sup>22</sup> *Id.*

evidence of actual confusion in its geographic region (the tri-state area), Registrant has previously sworn that “on several occasions, members of its staff at the Atlanta, Georgia and Dallas, Texas locations were approached by consumers claiming to have dined at Boi Na Braza’s restaurant in New Jersey.” *See* Petitioner’s Br. at 12.<sup>23</sup> This simple admission undermines Registrant’s entire basis for claiming that its mark accurately distinguishes its goods/services from others. Registrant’s mark is incapable of serving as a trademark and should not be afforded the protections of a federal registration.

Petitioner has used its mark – and has not abandoned any use – since 1996. Furthermore, Registrant’s mark is also likely to confuse or deceive the relevant public. Petitioner Terra Sul has therefore shown by a preponderance of the evidence that it has superior rights in any trademark. U.S. Registration No. 2,534,608 should therefore be cancelled.

#### IV.

#### CONCLUSION

Petitioner has met its burden of proving, by a preponderance of the evidence, that Registrant’s mark BOI NA BRAZA is not eligible to maintain a federal registration and should be cancelled. First, Petitioner has provided evidence of use of its own CHURRASCARIA BOI NA BRASA service mark that pre-dates Registrant’s use by more than three years. Secondly, despite Registrant’s attempts to undermine Petitioner’s evidence of use, there is no evidence of abandonment or a lack of continued use by Petitioner. Petitioner’s testimonial evidence is corroborated by official documents and government certifications. Lastly, Registrant’s mark does not serve to distinguish its goods/services from those of Petitioner (and others). Petitioner therefore respectfully requests that the Board cancel U.S. Registration No. 2,534,608.

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<sup>23</sup> *See also* Exhibit D to Petitioner’s Br., Interrogatory No. 35.

Date: April 30, 2009

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of "PETITIONER'S REPLY TO RESPONDENT'S FINAL BRIEF ON THE MERITS" was served on the parties listed below, via First Class U.S. Mail on the 30<sup>th</sup> day of April 2009.

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