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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Terra Sul Corporation A/K/A Churrascaria Boi Na Brasa
v.
Boi Na Braza, Inc.

Cancellation No. 92047056

Eamon J. Wall of Wall & Tong, LLP for Terra Sul Corporation
A/K/A Churrascaria Boi Na Brasa

Remy M. Davis of Thompson & Knight LLP for Boi Na Braza,
Inc.

Before Quinn, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Terra Sul Corporation A/K/A Churrascaria Boi Na Brasa,
petitioner, has petitioned to cancel Registration No.
2534608 owned by Boi Na Braza, Inc., respondent, issued on
January 29, 2002 for the mark BOI NA BRAZA for restaurant
services in International Class 42. The registration
includes the following translation: The English translation
of BOI NA BRAZA means OX IN EMBERS.

As grounds for cancellation petitioner asserts the claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). More specifically, petitioner alleges that respondent's mark BOI NA BRAZA, as used in connection with its services, so resembles petitioner's previously used mark BOI NA BRASA for restaurant services as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

In addition, petitioner alleges that respondent's mark is "merely descriptive or deceptively misdescriptive of them within the meaning of Section 2(e) of the Trademark Act, primarily geographically descriptive of them within the meaning of Section 2(e) of the Trademark Act, and/or primarily geographically deceptively misdescriptive of them within the meaning of Section 2(e) of the Trademark Act."¹ Petition to Cancel ¶ 6.

Respondent in its answer denied the salient allegations.²

¹ In its brief, petitioner appears to limit its argument to mere descriptiveness and we consider any claims under Trademark Act Sections 2(e)(2) and 2(e)(3) to be waived.

² Respondent also asserted several affirmative defenses in its answer; however, respondent did not pursue these defenses in its brief and we consider them to have been waived.

EVIDENCE OF RECORD

The evidence of record consists of the pleadings herein; the file of the registration sought to be cancelled; trial testimony of Mr. Farid Saleh, petitioner's owner and president, with related exhibits, taken by petitioner; respondent's discovery responses and an official record from the state of Texas submitted by petitioner under a notice of reliance; and the discovery deposition of Mr. Saleh with exhibits, and an official record from the state of New Jersey submitted by respondent under a notice of reliance.

STANDING

As discussed below, petitioner has established trademark rights in the mark BOI NA BRASA as used in connection with restaurant services and has demonstrated a real interest in cancelling the registration for the mark BOI NA BRAZA. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Thus, petitioner has established its standing.

PRIORITY/LIKELIHOOD OF CONFUSION

The record shows and respondent does not dispute that the marks BOI NA BRASA and BOI NA BRAZA are similar, the

restaurant services are identical and the trade channels overlap. In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In view thereof, we hold that a likelihood of confusion exists between the marks BOI NA BRASA and BOI NA BRAZA used in connection with restaurant services.

The only issue in dispute is the question of priority and petitioner's trademark rights. Because petitioner has not pleaded any registrations, petitioner must rely on its common law use to prove its priority. Inasmuch as respondent has not established use of its mark in connection with its services prior to the filing date of the registration's underlying application, the earliest date upon which respondent may rely for priority purposes is July 1, 1999. Thus, in order to establish priority, petitioner must show that it used its mark in connection with its services prior to July 1, 1999.

Mr. Saleh, petitioner's owner and president, testified as follows:

Q. From 1996 to the present time, has Churrascaria Boi Na Brasa ever shut down?

A. No.

Q. From 1996 to the present time, has Churrascaria Boi Na Brasa ever stopped doing business at its current location in New Jersey?

A. No.

Q. From 1996 to the present time, has Churrascaria Boi Na Brasa ever identified itself by a different name to the public?

A. No.

Saleh Test. p. 48.

Q. When did Churrascaria Boi Na Brasa first use this logo in association with its restaurant?

A. Since the day we open. It came out on the menu and after that it came out - I don't know how you call that thing in the front of the restaurant that we put on, canopy.

Q. Are you referring to a sign?

A. Yes, the sign, a design with a logo and the name. I have pictures back home.

Q. When did Churrascaria Boi Na Brasa open?

A. April of 1996. ...

Q. What is Terra Sul Corp.?

A. The Terra Sul Corp. is a corporation that I have opened and it owns Churrascaria Boi Na Brasa.

Q. When did Terra Sul Corp. acquire ownership of Churrascaria Boi Na Brasa?

A. It was in 1999.

Q. Is Terra Sul a registered corporation?

A. Yes.

Saleh Test. p. 51.

A. Okay. From '98 -actually '99, Churrascaria Boi Na Brasa Corp. owned Churrascaria Boi Na Brasa. I was the president. In '99, we changed the corporation and I was the president, and then it went to Terra Sul. However, this insurance policy - so the period on this policy is until the fifth month. So the next one probably - so to tell you the truth, if I'm going to answer, now I would say that Churrascaria Boi Na Brasa Corp. was the owner until '99 and as of 1999, we've created another corporation that became the owner and I was the president.

Q. And what was this corporation in 1999 that became the owner?

A. Terra Sul Corp.

Saleh Test. p. 28

Q. And from June 14th, 1999 to June 14th, 2000, who was the owner of Churrascaria Boi Na Brasa?

A. Terra Sul Corp, having myself as a president.

Saleh Test. p. 29

Q. What is Terra Sul Corp.?

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A. The Terra Sul Corp. is a corporation that I have opened and it owns Churrascaria Boi Na Brasa.
Q. When did Terra Sul Corp. acquire ownership of Churrascaria Boi Na Brasa?
A. It was in 1999.

Saleh Test. p. 51

A. Terra Sul Corp. was incorporated on January 19, 1999.

Saleh Test. p. 52.

Q. On July 19, 1999, was Churrascaria Boi Na Brasa open for business?
A. Yes, it was.
Q. Was your restaurant Churrascaria Boi Na Brasa open for business before July 19, 1999?
A. Yes.

Saleh Test. p. 63.

A. ... when we started the restaurant, it was just myself, my wife, Paula, his wife, and my wife's sister. It was just the family.

Saleh Test. p. 76.

Q. But does Gullas Corporation own Terra Sul Corporation?
A. I said that they are two different companies and that I own both.
Q. Individually, you own the shares?
A. Yes.
Q. Does either of these two corporations have any other shareholders besides yourself?
A. My wife but I'm the owner.
Q. So besides you and your wife, there are no other shareholders?
A. No.

Saleh Test. p. 88.

This testimony establishes that the restaurant BOI NA BRASA has been providing restaurant services since 1996 and that it is currently owned and operated by petitioner Terra Sul Corporation. It also establishes that the mark BOI NA

BRASA has been and currently is displayed on menus and signage. While petitioner did not submit a picture of the sign or menus, respondent made one undated menu of record which serves to corroborate petitioner's testimony regarding its use of the mark as depicted in the drawing in petitioner's Exhibit No. 17. Saleh Test. p. 49. The logo depicted on the menu is shown below.



In addition, the testimony is supported by the newspaper advertisements shown below dated September 1997 and November 1999. Saleh Test. Exh. No. 15.



Petitioner's other exhibits, e.g., insurance policies, checks, and a real estate lease, also serve to corroborate Mr. Saleh's testimony regarding the provision of restaurant services under the mark BOI NA BRASA.

While the advertisements and drawings of the mark also include a design element and the word CHURRASCARIA in close proximity to BOI NA BRASA, CHURRASCARIA is the Portuguese word for grill room or rotisserie,³ or barbeque restaurant.⁴ In view of the highly descriptive nature of the word CHURRASCARIA, petitioner's common law trademark rights lie in the phrase BOI NA BRASA and, as such, the examples of use in the record that depict BOI NA BRASA in conjunction with the descriptive word are probative as to petitioner's common law trademark rights in BOI NA BRASA. While the evidence also establishes common law rights in petitioner's logo mark, the wording creates a separate impression from the design element and these examples of use support trademark rights in the words alone.

We further find that the mark BOI NA BRASA is inherently distinctive. *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) While the translation of the mark from Portuguese to English, OX IN EMBERS, could be suggestive of the grill-style restaurant services, without more, we cannot say that it is descriptive of the restaurant services.

³ Compact Portuguese and English Dictionary (NTC Publishing 1997). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ Portuguese Concise Dictionary (Harper Collins 1998).

Respondent argues that both petitioner and the prior user Churrascaria Boi Na Brasa Corporation (CBNBC) are New Jersey corporations and under "New Jersey law, any mark, registration or application for registration is assignable with the goodwill of the business in which the mark is used. The statute very clearly requires, however, that any such assignment 'shall be by instruments in writing duly executed and shall be recorded with the Secretary of State upon payment of the recording fee payable to the Secretary of State.'" Br. p. 7.

The New Jersey statute provides:

Any mark and its registration or application for registration shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and shall be recorded with the Secretary of State upon the payment of the recording fee payable to the Secretary of State. An assignment of any registration under this act shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is filed for recording with the Secretary of State within 20 days after the date of the assignment or prior to the subsequent purchase or transfer.

N.J.S.A. 56:3-13.6(a).

Petitioner argues that the statute only pertains to trademark registrations and not common law rights and points to another section of the statute which provides:

Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

N.J.S.A. 56:3.13.

It is not clear if the New Jersey statutory code requires that the transfer of common law trademark rights between two corporations related by ownership in a few family members must be in writing. The wording "any mark *and* its registration or application for registration" (emphasis added) combined with the wording that "any assignment of any registration under this act shall be void" suggests this section pertains specifically to registrations or applications.

The record shows that it was the intent of Mr. Saleh, the owner and president of CBNBC and petitioner and the creator and operator of the restaurant BOI NA BRASA, to transfer the trademark rights residing in CBNBC from 1996 to 1999 to petitioner, the new corporation operating the restaurant, since 1999. We find that under the totality of the circumstances presented that petitioner acquired the trademark rights in BOI NA BRASA in 1999 and may rely on the use, beginning in 1996, of the prior holder CBNBC. However, we also find, in the alternative, that petitioner's own use of the mark BOI NA BRASA began during the spring or at the latest June, 1999, which predates respondent's July 1, 1999 first use date.

Respondent also attempts to undercut Mr. Saleh's testimony arguing that it is self-serving inasmuch as the

witness is the president and owner of petitioner. In particular, respondent contends that the testimony "has not been clear about when the mark as first used, the alleged transfer of the mark, and the ways his corporation allegedly used the mark from 1996-1999." Br. p. 15. Respondent further contends that the testimony is contradicted by the documentary evidence of record. Respondent relies, inter alia, on petitioner's filing for Registration of Alternate Name with the State of New Jersey wherein petitioner states in the form that it had not used the alternative name BOI NA BRASA prior to January 16, 2007 and a trademark application form for registration that was never filed with the USPTO that names Mr. Saleh as the owner of the mark.

The testimony of a witness can be sufficient to prove priority. See 3 J. Thomas McCarthy: McCarthy on Trademarks and Unfair Competition § 16.06(2) (4th ed. 2005). We find that the witness was competent to testify as to petitioner's use of the mark BOI NA BRASA in connection with its restaurant and the testimony is not characterized by bias, contradictions or inconsistencies. The testimony makes clear that petitioner operated a restaurant prior to respondent's filing date, and the mark BOI NA BRASA continues to be used by petitioner in connection with the provision of restaurant services.

The corporate documents and Mr. Saleh's prior statements made in a discovery deposition relied on by respondent do not reveal contradictions or inconsistencies as to the use of the mark BOI NA BRASA for a restaurant or the ownership of the resultant common law trademark rights.⁵ The documents and any inferences to be drawn from them are not sufficient to render Mr. Saleh's testimony unreliable.

In view of the evidence and testimony presented as to petitioner's use prior to respondent's July 1, 1999 filing date, petitioner has established its priority with respect to its common law rights in the mark BOI NA BRASA for restaurant services.

Accordingly, petitioner has proven its claim of likelihood of confusion under Section 2(d) of the Trademark Act.

DESCRIPTIVENESS

Petitioner argues that respondent's mark "is at most descriptive and not suggestive once translated from Portuguese into English. If the mark is eligible for protection as a trademark, it must therefore have acquired some level of secondary meaning among the relevant public. Registrant Boi Na Braza has not produced or provided any evidence of secondary meaning (no surveys, tests, polls or

⁵ The appropriateness of the statement made in the filing with the state of New Jersey is not for us to decide. Its only purpose here is its impact, if any, on Mr. Saleh's testimony.

other evidence)." Br. p. 14. Petitioner relies on the following interrogatory responses from respondent:

...Boi Na Braza responds that the name "boi na brasa" is a well known name that is often used in Brazil. Based on their knowledge of the name from its use in Brazil, the Matheus brothers chose this name for their restaurant business and began marketing the business as such at least as early as July 1, 1999. The Matheus brothers changed the "s" to a "z" to give the name more distinctiveness.

Response to Interrogatory No. 16, Pet. NOR Exh. No. 1.

We begin by noting that under Section 7(b) of the Trademark Act respondent's registration enjoys the presumption of validity and it is petitioner's burden to rebut that presumption not respondent's burden to prove it. By its argument and evidence, petitioner has not articulated in what way the mark is descriptive or submitted evidence to prove descriptiveness. Therefore, petitioner has not proven its claim of descriptiveness under Section 2(e)(1) of the Trademark Act.

Decision: The petition for cancellation is granted based on the claim of likelihood of confusion under Section 2(d) and dismissed as to the claim of descriptiveness under Section 2(e)(1).