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ESTTA Tracking number: **ESTTA173004**

Filing date: **11/06/2007**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Brazilian Travel Service, Ltd.
Granted to Date of previous extension	11/07/2007
Address	16 West 46th Street, 2nd Floor New York, NY 10036 UNITED STATES
Party who filed Extension of time to oppose	Brazilian Travel Service
Relationship to party who filed Extension of time to oppose	The corporate designation "Ltd." was inadvertantly omitted from the opposer's business name in the request for an extension of time to oppose the application. The opposer is the same entity and it's name did not change.

Attorney information	Andrea L. Calvaruso Donovan & Yee LLP 110 Greene Street, Suite 700 New York, NY 10012 UNITED STATES acalvaruso@yeellp.com, ccastro@yeellp.com Phone:2122267700

Applicant Information

Application No	76651891	Publication date	07/10/2007
Opposition Filing Date	11/06/2007	Opposition Period Ends	11/07/2007
Applicant	ONLINE TRAVEL SERVICES INC 459 COLUMBUSE AVE, SUITE 364 NEW YORK, NY 10024 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 1997/00/00 First Use In Commerce: 1997/00/00 All goods and services in the class are opposed, namely: Travel agency services, namely, making reservations and bookings for transportation and tour tickets; travel and tour information services
Class 043. First Use: 1997/00/00 First Use In Commerce: 1997/00/00 All goods and services in the class are opposed, namely: Travel agency services, namely, making reservations and bookings of hotels for others

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)

Torres v. Cantine Torresella S.r.l.Fraud	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant's 2(f) declaration contains false statements which were false at the time the declaration was made in that the Applicant has never had bone fide trademark use of the applied-for mark and the Applicant did not have substantially exclusive and continuous trademark use of the applied-for mark for five years immediately prior to Applicant's 2(f) Declaration.

Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BRAZILIAN TRAVEL SERVICE (SER NO. 77321138)		
Goods/Services	International Class 039: Travel agency services, namely, obtaining reservations and bookings for transportation for others; arranging and organizing vacations and tours for others; travel and tourist information services; travel and tour ticket reservation service; providing an on-line computer database in the field of travel information services.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BRAZILIAN TRAVEL		
Goods/Services	Travel agency services, namely, obtaining reservations and bookings for transportation for others; arranging and organizing vacations and tours for others; travel and tourist information services; travel and tour ticket reservation service; providing an on-line computer database in the field of travel information services.		

Attachments	Notice of Opp with Exhibit.pdf (17 pages)(641268 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/Andrea L. Calvaruso/
Name	Andrea L. Calvaruso
Date	11/06/2007

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

IN THE MATTER OF TRADEMARK APPLICATION
SERIAL NO. 76/651,891 PUBLISHED IN THE
OFFICIAL GAZETTE ON July 10, 2007
MARK: BRAZILIANTRAVEL.COM

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BRAZILIAN TRAVEL SERVICE, LTD. :

Opposer, : **OPPOSITION NO.**

v. :

ONLINE TRAVEL SERVICES, INC. :

Applicants. :

----------x

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

NOTICE OF OPPOSITION

Brazilian Travel Service, Ltd. ("Opposer" or "Brazilian Travel") is a corporation organized under the laws of New York with a principal place of business at 16 West 46th St., New York, New York 10036. Opposer believes it will be damaged by registration of the mark BRAZILIANTRAVEL.COM as shown in the above-identified application and hereby opposes the same.

The grounds for opposition are as follows:

1. Since at least as early as 1981, Opposer has used the marks BRAZILIAN TRAVEL SERVICE and BRAZILIAN TRAVEL ("Opposer's Marks") in connection with its

travel agency services, including arranging reservations and booking worldwide transportation for others, arranging and organizing vacations and tours for others, providing travel and tourist information services for others, and providing an on-line computer database in the field of travel information services (collectively "Opposer's Services"). Brazilian Travel provides these services both directly to the public and on a wholesale basis to other travel agencies.

2. Brazilian Travel has continually used the trademarks BRAZILIAN TRAVEL SERVICE and BRAZILIAN TRAVEL in connection with the sale of Opposer's Services since as early as April 1981. The marks BRAZILIAN TRAVEL SERVICE and BRAZILIAN TRAVEL have become distinctive of Opposer's Services by reason of substantially exclusive and continuous use in commerce by Brazilian Travel for over twenty-five (25) years.

3. Accordingly, the marks BRAZILIAN TRAVEL SERVICE and BRAZILIAN TRAVEL have acquired distinctiveness in relation to Opposer's Services pursuant to 15 U.S.C. §1052(f). Brazilian Travel has filed its own trademark application for the mark BRAZILIAN TRAVEL SERVICE with the United States Patent and Trademark Office (Ser. No. 77/321138) on these bases, which is currently pending review.

4. By reason of Brazilian Travel's professionalism and integrity, travel services provided by Opposer have come to be known to the public as being of the highest quality. As a result, the trademarks and goodwill associated with Opposer's Marks are of inestimable value to Opposer.

5. Applicant seeks to register the trademark BRAZILIANTRAVEL.COM for use in connection with "travel agency services" in the nature of "making reservations and bookings for transportation and tour tickets and travel and tour information services" in Class 39 and "making

reservations and bookings of hotels for others" in class 43, based upon its alleged use of the mark in commerce since 1997. On March 9, 2007, in response to an objection by the Trademark Examiner, Applicant alleged under oath pursuant to Section 2(f) of the Trademark Act that the mark BRAZILIANTRAVEL.COM has become distinctive of Applicant's travel agency services.

6. Publication of Applicant's mark was in the July 7, 2007 issue of the Official Gazette. On August 6, 2007, the Board granted Opposer an extension of time to oppose the Application up to and including November 7, 2007.

7. Opposer clearly has priority of use over Applicant, whose filing date and alleged first use date of 1997 is long subsequent to Opposer's first use of its BRAZILIAN TRAVEL and BRAZILIAN TRAVEL SERVICE Marks in 1981.

8. Applicant's BRAZILIANTRAVEL.COM mark is confusingly similar, in appearance, sound and meaning, to Opposer's Marks BRAZILIAN TRAVEL SERVICE and BRAZILIAN TRAVEL inasmuch as they sound nearly identical and are nearly identical in appearance. The only distinguishing feature between BRAZILIANTRAVEL.COM and Opposer's BRAZILIAN TRAVEL Marks is the addition of a domain name extension ".COM." As the term SERVICE in Opposer's BRAZILIAN TRAVEL SERVICE mark will not likely be viewed as significant to the purchasing public, Applicant's BRAZILIANTRAVEL.COM mark is virtually identical in sound and appearance to Opposer's Marks. The parties' marks are used on substantially similar services and, upon information and belief, will be marketed through the same and/or similar channels of trade. The close resemblance of the marks to each other will cause confusion or cause consumers to believe that Opposer has authorized or endorsed the quality of Applicant's services.

9. Applicant's registration and use of BRAZILIANTRAVEL.COM is likely to create confusion and deceive purchasers into believing that Applicant's services originate with or are in some way sponsored, endorsed, licensed, associated or otherwise authorized or connected with Opposer. Such confusion would irreparably harm and damage Opposer because Opposer has no control over the nature or quality of the services provided or produced by Applicant under the BRAZILIANTRAVEL.COM mark. In fact, Opposer has received reports of actual confusion from consumers as a result of Applicant's use of the mark BRAZILIANTRAVEL.COM. Accordingly, the Application should be refused registration.

10. On information and belief, Applicant adopted and applied for the proposed BRAZILIANTRAVEL.COM mark with knowledge of Opposer's Marks and related travel services, and with the intent to trade on the good name as well as the reputation of Opposer's Services.

11. The Application should also be refused registration because Applicant has no current bona fide trademark use of the mark BRAZILIANTRAVEL.COM in commerce and had no bona fide trademark use of the BRAZILIANTRAVEL.COM mark in commerce on May 9, 2007, at the time Applicant executed its declaration claiming acquired distinctiveness pursuant to Section 2(f) of the Trademark Act.

12. The Application for the BRAZILIANTRAVEL.COM mark includes Applicant's March 9, 2007 declarations under oath, through its President, Sabrina Carvalho, that: (1) Applicant had current trademark use of the BRAZILIANTRAVEL.COM mark in commerce at the time the declaration was made on March 9, 2007; and (2) Applicant had "substantially exclusive and continuous use in commerce" of the BRAZILIANTRAVEL.COM mark "for at

least the five years immediately before the date of this statement," dated March 9, 2007; and (3) Applicant "believes Applicant to be the owner of the mark sought to be registered; to the best of her knowledge and belief, no other person, firm, corporation or association has the right to use the above-identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to couse mistake, or to deceive." These allegations were false at the time they were made by Ms. Carvalho's own admissions in her sworn affidavit dated July 31, 2006, which was filed with the Supreme Court of the State of New York in connection with a related lawsuit[1]. A copy of Ms. Carvalho's affidavit is attached hereto as Exhibit A.

13. Specifically, in Paragraph 16 of her affidavit dated July 31, 2006, Ms. Carvalho declares that her use of the mark BRAZILIAN TRAVEL was "generic in nature and incapable of functioning as a trademark." *See* Exhibit A at ¶ 16. Accordingly, Applicant's declaration that it had exclusive and continuous trademark use of the BRAZILIANTRAVEL.COM mark was false at the time it was made to the Trademark Office on March 9, 2007.

14. In Paragraphs 5, 7, 26 and 29 of Ms. Carvalho's affidavit, she also claims she sold the "website" brazilian-travel.com to a third party in February 2006 and ceased offering travel services under the name Brazilian Travel in 2003. *See* Exhibit A. Accordingly, Applicant's declaration to the Trademark Office on March 9, 2007 that it was the current owner of the mark was false at the time it was made.

15. Moreover, upon information and belief, Ms. Carvalho and Applicant were well

1 Upon information and belief, Applicant's president, Ms. Carvalho, owns and operates one travel business under many different corporate names. The corporate defendant in the New York State litigation in connection with which Ms. Carvalho filed the attached affidavit shares a business address with the Applicant, and upon information and belief is related to and/or indistinguishable from the Applicant corporation.

aware of Opposer's longstanding and prior use of the marks BRAZILIAN TRAVEL and BRAZILIAN TRAVEL SERVICE for travel agency services, both at the time the Application was filed in December 2005, and at the time the Section 2(f) declarations were made in March 2007. Indeed, by Ms. Carvalho's own admission, she received notice that Opposer claimed prior ownership of the mark BRAZILIAN TRAVEL as early as 1998. *See* Exhibit A at ¶ 14.

16. Accordingly, Applicant's allegation that it had "substantially exclusive" use in commerce of the mark BRAZILIANTRAVEL.COM for five years immediately preceding its statement to the Trademark Office on March 9, 2007, was false at the time it was made.

17. Applicant knew that the aforementioned allegations of ownership and use in the Application made by declaration of its President on March 9, 2007 were false at the time they were made and filed with the U.S. Trademark Office.

18. Applicant intentionally made these false statements in the Application on March 9, 2007 with the intent to fraudulently induce the U.S. Trademark Office to act in reliance thereon by passing the Application to publication.

19. Applicant's acts constitute fraud on the Trademark Office and have wrongfully induced the Trademark Office to pass the Application to publication, which action the Office would not have taken but for the fraudulent statements. The Application for registration should therefore be refused.

20. For all of the foregoing reasons, Opposer will be damaged by Applicant's registration of the mark BRAZILIANTRAVEL.COM.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that

the registration by Applicant of the mark BRAZILIANTRAVEL.COM be refused.

A Certificate of Service evidencing service upon the attorney of record for the subject Application, and the fee required are enclosed herewith.

Respectfully submitted,
Donovan & Yee LLP

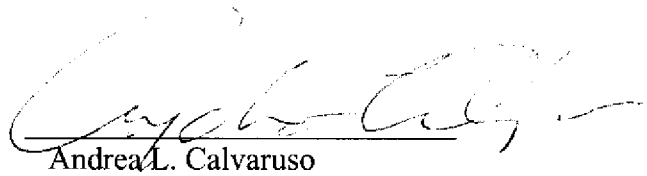
Dated: New York, New York
November 6, 2007

By: Andrea L. Calvaruso, Esq.
Attorneys for Opposer
110 Greene St, Suite 700
New York, NY 10012
(212) 226-4271

CERTIFICATE OF SERVICE

I, Andrea L. Calvaruso, an attorney associated with Donovan & Yee LLP, attorneys for Opposer Brazilian Travel Service, Ltd., hereby affirm under the penalties of perjury, that on that on November 6, 2007, I caused a true and correct copy of the foregoing Notice of Opposition to be served, via Express Mail, upon the correspondent and attorney of record for the subject trademark application owned by Applicant Online Travel Services, Inc.:

SAMUEL FRIEDMAN
225 BROADWAY STE 1804
NEW YORK, NY 10007-3749



Andrea L. Calvaruso

EXHIBIT A

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

BRAZILIAN TRAVEL SERVICES, LTD., d/b/a BRAZILIAN TRAVEL and BRAZILIAN AMERICAN SYSTEMS, INC., d/b/a BACC AND BACC TRAVEL.

Plaintiffs,

- against -

BRAZILIAN TRAVEL DISCOUNT, TROPICAL TRAVEL, SABRINA CARVALHO and ALEX VIERA,

Defendants

Index No.:160194/06

AFFIDAVIT IN SUPPORT

STATE OF NEW YORK)
: ss.:
COUNTY OF NEW YORK)

SABRINA CARVALHO, being duly sworn, deposes and says:

1. I am one of the named Defendants with respect to the above-referenced action and, as such, I am familiar with all of the prior facts and proceedings heretofore had herein.

2. I submit the instant Affidavit in support of Defendant's cross-motion to Petitioner's motion which seeks an order for the following relief;

a. Pursuant to CPLR 3211(a)(2), for the dismissal of Plaintiff's Complaint, or in the alternative;

b. Pursuant CPLR §3212, for summary judgment;

c. For costs, disbursement and attorneys fees; and

d. Any and all other relief which this Court may deem just, proper and equitable under the circumstances herein.

3. For the following reasons, it is respectfully requested that the Defendant's cross-motion be granted in its entirety.

5. From the outset, it should be noted that I have read the accompanying affirmation of my attorney, Keith S. Barnett, Esq. and that I understand and agree with both the factual history and legal agreements set forth therein and incorporates same into the instant affidavit as if same where more fully set forth herein at length.

5. In May of 1999, your Affiant incorporated her business under the name Brazilian Travel Discount, Inc. with offices at 62 West 45th Street, Room 901, New York, NY 10036.

6. Pursuant to the filing with the Department of State, your Affiant was listed as the Chairman or Chief Executive Officer with a residence at 33 West 76th Street, apartment 1B, New York, NY 10023.

7. From the period of May 1999 until June 23, 2003, when said corporation was dissolved by proclamation, said company offered discount travel services primarily to the Brazilian community. A copy of the correspondence dated February 1, 2002 confirming that the Certificate of Dissolution had been filed with the Secretary of State, Division of Corporations is annexed hereto as Exhibit I.

8. As evidenced by the accompanying affirmation of my attorney, it is respectfully maintained that Plaintiff's lawsuit must be dismissed, as this Court lacks jurisdiction over the subject matter/claims raised by such Plaintiff, or because no genuine factual issues exist.

9. Although the Plaintiff makes claims of torturous business interference and fraud, in actuality, Plaintiff's claims are based upon a belief that the Defendants have engaged in deceptive business practices in violation of their trademark for BACC and/or trade name, Brazilian Travel.

10. Its your Affiant's understanding, that such claims must be brought in Federal Court which has jurisdiction regarding trademark claims.

11. Therefore, as the Plaintiff has improperly instituted suit in State Supreme Court, all stays should be immediately lifted and the underlying Complaint should be dismissed.

12. Additionally, it is also maintained herein that the Plaintiff is precluded from the relief sought in his Order to Show Cause and Complaint since at common law, a term which is "**generic**", is incapable of functioning as a trademark.

13. In fact, my attorney has advised me that the Lanham Act provides for the cancellation of a registered mark if at any time it "becomes the common descriptive name of an article or substance" and that under existing case law, proof of a secondary meaning cannot transform a generic term into a subject for trademark.

14. As this Court will note, on or about February 5, 1998, counsel for the Plaintiff, Gerorge Karp, Esq., wrote to your Affiant a letter advising that his client's trade name, Brazilian Travel was protected by Common Law and that if I fail to stop using the name Brazilian Travel or other similar

derivations of such name, which would purportedly confuse and mislead the public, that a lawsuit will be brought for injunctive and monetary damages for infringement of his clients trade name. A copy of this letter is annexed hereto as Exhibit C .

15. Following the receipt of such letter, your Affiant retained the Law Firm of Baker & Friedman to address the aforementioned letter.

16. Subsequently, by letter dated February 25, 1998, your Affiant's counsel advised Plaintiff's counsel that its Complaints were unfounded and without merit as the words Brazilian Travel were generic in nature and incapable of functioning as a trademark(Exhibit D).

17. In fact, in such letter, Mr. Karp was advised that many firms have recognized that the terms "Brazil" and "Brazilian" were generic terms particularly, when one is directing travel services to the Brazilian community.

18. In fact, in such letter, my then attorney lists 28 separate and distinct companies with addresses and phone numbers with offices throughout the country which use the words Brasil, Brazil or Brazilian Travel in their name and to reflect services offered to the Brazilian community.

19. My prior counsel also made it very clear in such letter that if any action were taken against your Affiant and her business, attorney's fees and sanctions will be sought as a result of the commencement of frivolous litigation.

20. Following my attorney's letter of February 25, 1998 and up until the commencement of the underlying action in June of 2006, the Plaintiff herein took absolutely no legal action against the named Defendants to protect its alleged trademark and/or trade name.

21. Moreover, from 1994 through May of 1998 the Defendant, Brazilian Travel Discount was a client of the Plaintiff, Brazilian Travel Services and purchased tickets from such Plaintiff for its clients. For this Court's ready review and reference, numerous invoices reflecting the business dealings between the parties during a five year period are annexed hereto as Exhibit E .

22. It should also be noted, that as a result of Plaintiff's failure to pay the Defendant commissions owed in connection with services rendered regarding the sale of discount travel tickets, the Defendant, Brazilian Travel Discount instituted a lawsuit against Plaintiff for $7,000.00, which was ultimately settled for the sum of $3,000.00. A copy of the general release issued to the Plaintiff in connection with Defendant's claims is annexed hereto as Exhibit J .

23. Given the fact that the Plaintiff herein voluntarily conducted business with the Defendant for several year and without objection during their business relationship to Defendant's use of the name Brazilian Travel Discount, it is apparent that the Plaintiff itself recognized the generic nature of said name and Defendant's entitlement to use same.

24. If should also be noted that the Defendant's herein have never held themselves out to be affiliated with BACC Travel and have never conducted business under such name.

25. According to the searches recently conducted by your Affirmant (Exhibit H), there are approximately 40,000.00 listings provided by Yahoo under the key word BACC Travel, and 1,020.000.00 listings under BACC and approximately 80,500.00 listings under BACC Travel provided by Google, which relate to travel services offered to the Brazilian community.

26. Since our former company Brazilian Travel Discount provided similar services to the Brazilian community, the website which I established and registered in 1997, www.brazilian-travel.com appears under both the Yahoo and Google search listings.

27. The Defendants herein have absolutely nothing to do with Yahoo or Google's search engine which provides users with travel related information.

28. It should also be noted that no confusion existed regarding our respective companies, since the Plaintiff advertised its services under the name BACC Travel, whereas the Defendants advertised under the name Brazilian Travel Discount (Exhibit K).

29. Moreover, it should be noted that your Affiant no longer operates the above website as same was sold to the Defendant, John Howell in February of 2006, who subsequently re-registered same website with Network Solutions (Exhibit L).

30. Additionally, it should also be noted that while the Defendants business was in operation, a few hundred thousand dollars had been expended over the years to advertise same in Brazilian and American newspapers, magazines, guides and in movie venues (Exhibit M).

31. Given the fact that Plaintiff's lawsuit is totally without merit and that Plaintiff's counsel was advised in 1998 of same, as well as Defendant's insistence upon recovering legal fees if an action were brought, it is herewith maintained that said Plaintiff should be responsible for all legal fees and costs now incurred by the Defendants some eight years later with respect to defending the present baseless action.

WHEREFORE, based upon the reasons set forth herein, it is respectfully requested that this Honorable Court deny Plaintiff's motion, and grant the Defendant's cross-motion with any and all additional relief which this Court may deem just, proper and equitable under the circumstances herein.

Sworn to before me
this 3rd July of 2006.

SABRINA CARVALHO

Notary Public

KEITH S. BARNETT
NOTARY PUBLIC, State of New York
No. 02BA5035578
Qualified in New York County
Commission Expires November 7, 2008

Supreme Court of the State of New York
County of NEW YORK

BRAZILIAN TRAVEL SERVICES, LTD., d/b/a BRAZILIAN TRAVEL and BRAZILIAN AMERICAN SYSTEMS, INC., d/b/a BACC and BACC TRAVEL,

Plaintiff(s)

against

BRAZILIAN TRAVEL DISCOUNT, TROPICAL TRAVEL, SABRINA CARVALHO and ALEX VIERA,

Defendant(s)

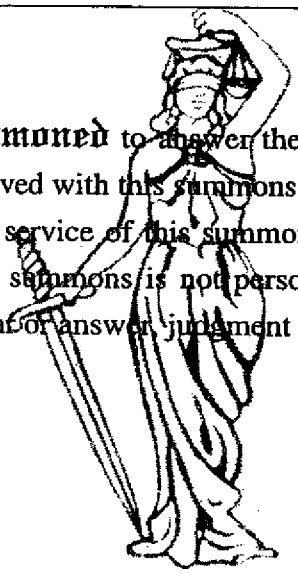
Index No.
Date purchased

Plaintiff(s) designate(s) NEW YORK County as the place of trial.

The basis of the venue is
Plaintiffs offices in NY Cour

Summons

Plaintiff(s) reside(s) at
16 West 46th Street
County of New York



To the above named Defendant(s)

You are hereby summoned to answer the complaint in this action and to serve a copy of your answer, or, if the complaint is not served with this summons, to serve a notice of appearance, on the Plaintiff's Attorney(s) within 20 days after the service of this summons, exclusive of the day of service (or within 30 days after the service is complete if this summons is not personally delivered to you within the State of New York); and in case of your failure to appear or answer, judgment will be taken against you by default for the relief demanded in the complaint.

Dated, May 22, 2006

Defendant's address:
459 Columbus Avenue - Suite 364
New York, New York 10024

GEORGE KARP, ESQ.

Attorney(s) for Plaintiff

Office and Post Office Address
299 Broadway
New York, New York 10007
(212) 732-4845

Notice: The nature of this action is
Action for a Permanent Injunction
Action for monetary damages for
Tortious Business Interference

The relief sought is
Permanent Injunction
Monetary Damages

Upon your failure to appear, judgment will be taken against you by default for the sum of $ 500,000.00 with interest from January 1, 2003 19 and the costs of this action.

Exhibit M