

THIS OPINION IS
NOT A PRECEDENT
OF THE T.T.A.B.

Mailed:
March 4, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Unique Motorcars

v.

Carroll Hall Shelby Trust

Opposition No. 91150352

to application Serial No. 75586777

and

Opposition No. 91155242

to application Serial No. 76279667

W. Wheeler Smith, Esq. for Unique Motorcars.

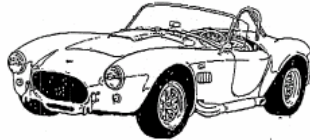
Robert F. Helfing of Sedgwick, Detert, Moran & Arnold LLP
and Edward A. Sokolski, Esq. for Carroll Hall Shelby Trust.

Before Quinn, Zervas and Bergsman, Administrative Trademark
Judges.

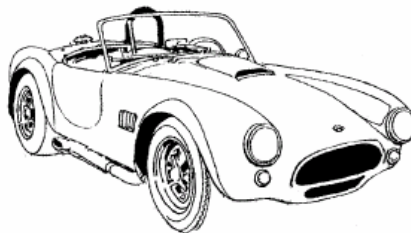
Opinion by Zervas, Administrative Trademark Judge:

This consolidated proceeding involves two trademark
applications owned by Carroll Hall Shelby Trust

("applicant"). The first application [Serial No. 75586777 ("`777"), filed November 12, 1998] is for the configuration



for "automobiles" in International Class 12. The `777 application claims acquired distinctiveness under Section 2(f) of the Trademark Act, 35 U.S.C. § 1052(f), and identifies April 6, 1965 as the date of first use anywhere and first use in commerce. The parties have referred to the configuration of the `777 application as "Cobra 427 S/C" and we do the same in our decision. The second application [Serial No. 76279667 ("`667"), filed July 2, 2001] is for the configuration



for "automobile namely a racing car" in International Class 12. The `667 application claims acquired distinctiveness under Section 2(f), identifies September 1, 1962 as the date of first use anywhere and first use in commerce, and contains the following description of the mark: "The mark

consists of the overall configuration of the Shelby FIA 289 Cobra automobile."

Unique Motorcars ("opposer") has opposed registration of both of applicant's configuration marks. In the notices of opposition, opposer claims that over the last 30 years, it has manufactured and sold automobiles which are replicas of the vehicles depicted in the '777 and '667 applications; that applicant has not acquired distinctiveness in such shapes; that applicant has abandoned any trademark rights in such shapes because it has ceased use for more than twenty years; that the shapes of the automobiles which are the subject of the applications are generic; and that applicant is barred from registering its marks because of fraudulent representations made in its application with respect to its assertions in its applications that no other entity has the right to use the mark in commerce.

Applicant has filed answers denying all of the salient allegations of the notices of opposition. The consolidated oppositions have been fully briefed.

Evidentiary Issues

Opposer, during its testimony period, submitted only one item of evidence, namely, a discovery deposition of its own witness. On August 7, 2008, the Board granted applicant's motion to strike this deposition as conceded by

opposer. Thus, opposer concluded its testimony period without any evidence in the record.

Rather than seizing the advantage presented to applicant and moving for judgment under Trademark Rule 2.132(b), 37 C.F.R. § 2.132(b), due to applicant's failure to present any evidence into the record to establish its standing or to support its claims, applicant filed two notices of reliance during its testimony period, submitting thousands of pages of evidence. After applicant's testimony period closed, the following occurred:

(i) opposer filed a rebuttal notice of reliance on July 1, 2008;

(ii) opposer filed hundreds of pages of exhibits with its main brief on September 5, 2008;

(iii) applicant filed an "Augmented Notice of Reliance" on October 20, 2008; and

(iv) opposer filed a motion on November 21, 2008 to use a discovery deposition taken in a civil action, after applicant filed its main brief.

Essentially all of the evidence which both parties filed pursuant to notices of reliance is not appropriate for introduction by way of a notice of reliance. See Trademark Rules 2.122(e); TBMP § 704 (2d ed. rev. 2004). Opposer has not objected to the admissibility of any of applicant's evidence, and in fact relies on much of this evidence in its main and rebuttal briefs. Opposer even lists a report on a survey conducted by applicant as part of its "Description of the Record," which applicant submitted with a notice of

reliance even though a survey report is not appropriate for a notice of reliance absent a stipulation between the parties. Moreover, opposer consented to the filing of applicant's "Augmented Notice of Reliance," despite the fact that opposer had already filed its main brief and was without an opportunity to submit additional evidence in rebuttal.

We therefore consider all of applicant's evidence, construing opposer's lack of any objection to any of applicant's evidence filed within its testimony period as opposer's consent to the submission of such evidence by means of a notice of reliance. As for the applicant's evidence submitted outside of its testimony period, i.e., with applicant's "Augmented Notice of Reliance," in light of opposer's consent thereto, we also consider that evidence.

We now address opposer's submission with its rebuttal notice of reliance. Applicant's objections to most of this evidence are overruled because (i) our consideration of this evidence does not change the outcome of these oppositions, or (ii) applicant has not offered a valid objection.¹

¹ For example, applicant has objected to the November 17, 2006 discovery deposition of Maurice Weaver in *ERA Replica Automobile v. Carroll Shelby Trust*, Cancellation No. 92040723, on the basis that opposer did not bring a motion seeking submission of this deposition testimony. The Board, however, has construed the term "testimony," as used in Trademark Rule 2.122(f), 37 C.F.R. § 2.122(f), as meaning only trial testimony, or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding. See TBMP §§ 530 and 704.13. There is no indication that the *ERA Replica* case ever went to

However, we sustain applicant's objection to the December 13, 2007 discovery deposition of Maurice Weaver taken in the present proceeding. This deposition is the same deposition that the Board struck in its August 7, 2008 order, mentioned above. Opposer's attempt to submit this deposition transcript a second time after it had already been stricken is nothing more than an attempt to hoodwink the Board into considering this evidence. If we had the power to sua sponte impose monetary sanctions against opposer's counsel for such behavior, we would do so here.

As for the evidence submitted with opposer's main brief, applicant has objected to most of this evidence as not having been timely filed, an objection which is well taken. See Trademark Rule 2.121(a)(1), 37 C.F.R. § 2.121(a)(1); and TBMP § 704.05(b). However, some of this evidence was also submitted with opposer's rebuttal notice of reliance, which we have not excluded. Thus, we affirm applicant's objection to the material submitted with opposer's main brief, namely, the copies of "The Complete Guide to Cobra Replicas," "Kit Car" and "Kit Car Illustrated," but overrule applicant's objection to that material which was also submitted with opposer's rebuttal notice of reliance.

trial. Thus, the discovery deposition is objectionable because there is no motion and because it is a discovery deposition which was not used at trial.

Next, we consider opposer's motion to use a discovery deposition from *Carroll Shelby et al. v. Superformance International, Inc.*, Case No. 00-cv-12581, a civil action in the Massachusetts district court. The Board has not received a response from applicant to opposer's motion. However, the certificate of service attached to the motion identifies the paper served as a "Motion to Extend Time for Taking Testimony" and incorrectly identifies applicant's attorney's postal zip code as 90053 rather than 90503. We therefore cannot be sure that applicant's counsel ever received the motion and had an opportunity to respond. See Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a); TBMP § 113. Additionally, opposer's attempt to introduce evidence in this proceeding after the conclusion of trial, and after applicant had its last opportunity to make its case, goes beyond the pale, and makes a mockery of the rules of evidence. Further, opposer has not explained why it waited until after applicant filed its main brief to submit testimony from 2001. Opposer's motion is therefore denied and we do not give the discovery deposition any further consideration.

The Record

In addition to the pleadings, the files of the opposed applications are part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

Taking into account our evidentiary rulings, the record includes discovery depositions, some (but not all) with exhibits,² excerpts from printed publications, survey reports with exhibits, and applicant's responses to certain discovery requests propounded by opposer, all introduced by way of notices of reliance.

Background

Carroll Hall Shelby, identified as the trustee of the Carroll Hall Shelby Trust, is a former race car driver who raced and built automobiles in the 1960s. His company, Shelby American Inc., completed and sold automobiles having the shapes depicted in the two involved applications. In the period from 1961 to 1966, his company completed approximately (i) six-hundred model "260s and 289s," with the 260s being "about the same thing" as the 289s; (ii) three hundred fifty model 427s; (iii) twenty model 289 FIAs; and (iv) fifty model 427 S/Cs. Shelby dep. at 35 - 43, ex. I, applicant's augmented notice of reliance. All of these vehicles bore the name Cobra. *Id.* at 46. Sales of such vehicles spanned from 1961 until "the early '70s." *Id.*

² We consider the discovery depositions of Maurice Weaver (November 17, 2006 in Opposition No. 91151113/Cancellation Nos. 92040723 and 92041950), Richard Weaver (June 22, 1989 in Civ. Action No. CA3-86-2570-T, Northern Dist. Texas), and Carroll Shelby and David Davis (March 19 - 20, 2002 and June 6, 2002, respectively, in the *Superformance* action).

at 79. In 1993 or 1994, Shelby American resumed production of Cobra 427s and 289 FIAs. *Id.* at 132 - 133.

Since 1979, opposer has been manufacturing replicas of Cobra vehicles produced in the mid-1960s, with its primary products being replicas of the 427 SC Cobra and the 289 FIA Cobra. Maurice Weaver dep. pp. 11 - 12, ex. E-1, opposer's rebuttal notice of reliance; Richard Weaver dep. p. 34, ex. H., opposer's rebuttal notice of reliance. The replicas are complete automobiles ("somewhere in the neighborhood of three to five ... per year") and "kit" cars (between 30 - 40 units per year). According to Maurice Weaver, a "kit" car is "a complete body assembled sitting on a complete chassis assembled with no engine or transmission, no tires and wheels and no paint and some of the accessories that go with the engine and things like that." M. Weaver dep. pp. 12 - 13.

Analysis

We first consider opposer's standing to bring this opposition and then consider each of opposer's pleaded claims. Opposer has also argued that it is entitled to relief based on various claims which it did not plead in its notices of opposition; we later address those claims.

Standing

To establish standing in an opposition, an opposer must show that it has a "real interest" in the outcome of the

proceeding; that is, that it has a direct and personal stake in the outcome of the opposition. 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). Because opposer manufactures replicas of Cobra automobiles produced in the mid-1960s, R. Weaver dep. pp. 34 - 35, and because applicant has not contested opposer's standing, we find that opposer has a real interest in the outcome of this proceeding and has standing to pursue its claims.

No Acquired Distinctiveness

The Federal Circuit, in *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004-05 (Fed. Cir. 1988), addressed the burdens of each party in an opposition involving an application under Section 2(f) when the plaintiff alleges that acquired distinctiveness has not been established:

[O]ne opposing a Section 2(f) registration published for opposition on the basis of that section must have at least the initial burden of challenging or rebutting the applicant's evidence of distinctiveness made of record during prosecution which led to publication of the proposed mark.

An opposer to an application submitted under Section 2(f) sufficiently meets its initial burden if it produces sufficient evidence or argument whereby, on the entire record then before the board, the board could conclude that the applicant has not met its ultimate burden of showing acquired distinctiveness. ...

Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact. ...

If the opposer does present its prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing and to establish that the mark has acquired distinctiveness.

In this case, because applicant seeks registration for its subject design on the basis of a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, it is opposer who has the initial burden of showing that the evidence which applicant submitted with its application is insufficient to establish such a claim. See *Goodyear Tire and Rubber Co. v. Interco Tire Corp.* 49 USPQ2d 1705 (TTAB 1998). If that initial burden is met, the burden of going forward shifts to applicant to show, by a preponderance of the evidence of record, that its automobile designs have in fact acquired distinctiveness and thus function as trademarks.

Clearly, opposer has not met its initial burden of providing evidence at the close of its testimony period challenging or rebutting applicant's evidence of distinctiveness made of record during prosecution of its applications - all of opposer's evidence submitted during its testimony period has been stricken. Additionally, opposer has not argued in its briefs that applicant's

evidence of acquired distinctiveness made of record during prosecution of its applications is insufficient. Because opposer has not met its initial burden, opposer's claims of no acquired distinctiveness are dismissed.³

Abandonment

At p. 12 of its brief, opposer, under the heading "Shelby Re-Entered the Cobra Industry After a 20-Year Absence," argues that "In 1996, Shelby American, Inc. began selling the ... Cobra replica. This car has the same body shape as the original Cobra 427 S/C. Shelby American continues to sell the [replica] to the present, at prices exceeding \$100,000." At p. 7 of its reply brief, applicant argues "Applicant and Opposer have both used the subject trade dress concurrently from 1990 to the present time. Opposer has averaged sales of twenty-five (25) Cobra replicas per year since 1990 ... Applicant has not disclosed its sales during this time period, but it is probably about the same, because Applicant demands a higher price for its vehicles by advertising the vehicles as 'original Cobras.'" Further, Mr. Shelby has stated in his deposition that he has been building and selling Cobra 289s and 427s since 1989 and

³ Because opposer did not introduce any evidence or make any argument regarding the sufficiency of applicant's showing of acquired distinctiveness during the prosecution of the applications, we need not consider applicant's evidence of acquired distinctiveness, including the survey reports submitted by applicant.

has built "two or three hundred" Cobra 427s. See Shelby dep. pp. 122-123, 129, 132-133, 148, 217, 219 and 225. This uncontroverted testimony is sufficient to establish that applicant is manufacturing and selling automobiles with the applied-for configurations.

Opposer, in its briefs, has argued strenuously that applicant abandoned its mark from approximately 1970 until approximately 1990 when it resumed use. We find opposer's abandonment argument irrelevant in view of opposer's concession that applicant has resumed manufacturing and selling automobiles with the applied-for configurations. Abandonment and resumption of use are material when priority of use is at issue, and priority of use is not an issue here. Further, opposer's claim at paragraph 6 of both notices of opposition that applicant ceased manufacture of the 289 and 427 S/C vehicles and did not recommence making replicas of such vehicles until about 1990, over twenty years later, even if true, has no consequence and does not preclude registration of applicant's configurations; opposer is not contending that applicant currently is not using the marks.

Opposer's claims of abandonment therefore are dismissed.

Genericness

Opposer's claims that the configurations of the '777 and '667 applications are generic are based on opposer's allegation that "dozens" of automobile manufacturers have manufactured and sold replicas of applicant's designs without any control or permission from Mr. Shelby, and that applicant was aware of this "prolific uncontrolled use." See both paragraphs numbered "3" in the notices of opposition.

The Board does not often have the occasion to consider a claim involving the genericness of a design. Accordingly, there is little Board precedent on this issue. The Federal Circuit, our principal reviewing court, however, has confirmed that "generic name" in Section 14 of the Lanham Act 15, U.S.C. Section 1064(3), applies to a product configuration. *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532 (Fed. Cir. 1999) (vacating the Board's dismissal of a claim to cancel a registration for a "metallic nautical rope design" for clocks, watches and jewelry on the ground of genericness because of the trademark's incontestable status). The court stated that "generic name" "must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as names, words, symbols, devices, or trade dress." It reasoned that "[a]ny narrower

interpretation of 'generic name' would allow incontestable trademarks other than names that become generic to retain incontestable status despite their inability to serve as source designators. This would directly contravene the purpose of the Lanham Act." *Id.* at 1535.

Other courts have also recognized a claim of genericness regarding a product configuration. For example, in *Abercrombie & Fitch Stores Inc. v. American Eagle Outfitters Inc.*, 61 USPQ2d 1769 (6th Cir. 2002), the Sixth Circuit stated that "no designer should have a monopoly on designs regarded by the public as the basic form of a particular item." In *Walker & Zanger, Inc. v. Paragon Industries, Inc.*, 549 F. Supp. 2d 1168, 84 USPQ2d 1981, 1985 (N.D. Cal. 2007), the district court found various stone and ceramic decorative tiles generic, stating that "[c]ases addressing product design suggest that the term 'genericness' covers three situations: (i) if the definition of a product design is overbroad or too generalized; (ii) if a product design is the basic form of a type of product; or (iii) if the product design is so common in the industry that it cannot be said to identify a particular source."

Opposer's tack in this case is based on no. (iii) above, i.e., that the product design is so common in the industry that it cannot be said to identify a particular source. The evidence of record reflects that third-parties

have manufactured replicas of the automobiles depicted in the involved applications. According to Richard Weaver, seven replica manufacturers "have popped up starting in 1980, '81, and in the years since. Some of them have come and gone, new names, new owners, disappeared for 6 or 8 months and re-emerged, but for the most part it all happened - it happened all in about a four year period from late 1979 to 1984 that all these people came up." R. Weaver dep. pp. 87 - 90. Maurice Weaver stated in his 2006 deposition that there are about 25 to 26 Cobra replicar builders in the United States, and that companies come into existence and go out of existence. M. Weaver dep. at p. 37. Mr. Shelby, on p. 73 of his 2001 deposition stated, without further elaboration, "So all these guys, these 40 companies - or whatever number it is - that have knocked them off, they - they call themselves - they call them Cobra replicas."

There is some evidence in the record too as to opposer's sales activities. Richard Weaver has stated that opposer's total sales of kits and completed replica cars since opposer began making such kits and cars was approximately 300; and that opposer sold 35 kits in 1987, the most opposer had ever sold. Richard Weaver dep. p. 141.

Based on this record, however, we cannot conclude that the product designs are so common in the industry that they cannot be said to identify a particular source. At a

minimum, the evidence does not reflect when the third-party manufacturers sold their replicas, how many they sold or the market share of opposer and the third-party manufacturers.⁴ Without such evidence, we cannot conclude that the configurations are generic.

Opposer has also argued that "[t]here was no attempt by Shelby [applicant] to judicially enforce his claim to exclusive use except his action against Superformance, which resulted in a judgment in favor of Superformance ... and his action against Factory Five, which was settled by the parties."⁵ Reply at p. 7. It is true that trade dress may become generic "as a result of the trademark owner's failure to police [it] ... so that widespread usage by competitors leads to generic usage among the relevant public, who see many sellers using the same [product design]." 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:1 (4th ed. 2009). Although a party need not police every

⁴ Richard and Maurice Weaver were shown various issues of "Kit Car Illustrated" in their depositions and discussed the magazine advertisements in such magazines. Because opposer did not submit the deposition exhibits, we are unable to consider the advertisements themselves. With regard to Richard and Maurice Weaver's statements regarding these advertisements and the identity of the advertisers, their statements violate Fed. R. Evid. 1002 and 1003, which require an original or duplicate to prove the content of a "writing." We therefore do not consider their testimony regarding third-party advertisements.

Additionally, we give limited weight to Maurice Weaver's "guess" at p. 16 of his deposition that ERA Automobiles of New Britain, Connecticut builds approximately fifty 427 SC and 289 FIA Cobra replicas per year because his "guess" is speculative.

⁵ The *Superformance* case is discussed, *infra*.

potential infringing third-party use, complete failure to police the product design is evidence that a product configuration is generic. See *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554 (Fed. Cir. 1995); *McCarthy on Trademarks and Unfair Competition*, § 17:17. We assume for purposes of our discussion on this argument that there indeed are third-party manufacturers with more than a minor market share and consider whether applicant has policed its claimed configurations.

Mr. Shelby stated in his deposition that he sent six or eight letters to replica manufacturers beginning in June 1990. Shelby dep. p. 100. As noted earlier in this decision, Richard Weaver indicated that replica manufactures went in and out of business over the years. Although there is no evidence on this point, we cannot discount the possibility that some of these manufacturers ceased manufacturing due to Mr. Shelby's letters. The record also contains three letters from applicant's counsel dated October 15, 2008 asserting rights in "the 1960s Shelby Cobra Roadster vehicle[]." Exhibits F(25), F(26) and F(27), applicant's augmented notice of reliance. Further, opposer has pointed out two proceedings in which applicant has asserted a claim involving its product configurations against third parties.

From this evidence, we accept that Mr. Shelby has made some effort to protect the configurations which are identified in the subject applications. This evidence of policing favors applicant and weighs against opposer's claim that the configurations are generic.

In order to prevail on the ground of genericness, a plaintiff must establish genericness by a preponderance of the evidence. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). Considering all the evidence, and keeping in mind the burden a plaintiff faces in establishing that a mark is or has become generic, we find that opposer has not met its burden. Opposer's claims of genericness are dismissed.

Fraud

Because opposer has not discussed its pleaded fraud claim in its brief, we deem opposer to have waived this claim.

Unpleaded Claims

Opposer has made three arguments in its briefs pertaining to claims which it did not plead in its notice of opposition, i.e., claims of res judicata, functionality and laches. A plaintiff may not rely on unpleaded claims, unless those claims were tried by implied consent.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised

that the evidence was being offered in support of the issue.

TBMP §§ 314 and 507.03(b). See also Fed. R. Civ. P. 15(b). In this case, because the parties submitted some evidence after the close of trial and even after briefing, in certain instances without any objection from the non-offering party, we consider the claims for which there is evidence, namely, the claims of res judicata and laches. We do not consider the unpleaded claim of functionality because there is no evidence in the record regarding functionality; the claim cannot be said to have been tried by the implied consent of the parties.⁶

A. Res Judicata

Opposer has argued in its main brief that we are bound by the decision in *Carroll Shelby et al. v. Superformance International, Inc.*, 251 F. Supp.2d 983 (D. Mass 2002), the same *Superformance* action mentioned earlier in this decision. On a motion for partial summary judgment, the district court, inter alia, dismissed plaintiffs' trade dress claims, finding that plaintiffs had not established a protectable right in the design of the Cobra automobile. Specifically, the district court found that plaintiffs had not established acquired distinctiveness because the survey

⁶ If we considered the functionality claim, we would deny it. Applicant has only addressed the doors, windshield and "air scoop - ventilator" in the configurations, when the configurations contain other features.

plaintiffs relied on improperly concluded that the survey respondents identified one source, namely, "Shelby," as the source of the vehicle's design when the respondents actually identified various sources. *Id.* at 985. ("Not only are [the expert] Pollner's conclusions illogical in a very basic sense, but they are also completely unreliable and bear no weight on Shelby's secondary meaning argument.")

The Board addressed the issue of res judicata with respect to the *Superformance* decision prior to trial. After learning of the court's decision in the *Superformance* case, the assigned interlocutory attorney ordered applicant to show cause why judgment should not be entered on opposer's behalf. When applicant responded, the interlocutory attorney in her February 2, 2007 order stated that the doctrine of collateral estoppel (or issue preclusion) does not apply due to the amount of time that had passed since the *Superformance* decision and due to "the possibility of changed circumstances."

Opposer, by raising the issue of res judicata again, is apparently seeking review of the interlocutory attorney's decision as it pertains to opposer's claim of no acquired distinctiveness. We therefore consider whether the district court's *Superformance* decision is preclusive of any issue in this case.

In *Montana v. United States*, 440 U.S. 147, 153-55, 99 S.Ct. 970, 59 L.Ed.2d 210 (1979), the Court summarized the requirements of collateral estoppel or issue preclusion as (1) the identity of an issue in a prior proceeding, (2) the identical issue was actually litigated, (3) a determination of the issue was necessary to the judgment in the prior proceeding, and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. We focus on the first element, whether the acquired distinctiveness issue in the prior proceeding is identical to the issue in this proceeding.

The issue of acquired distinctiveness in the prior proceeding is not identical to the issue of acquired distinctiveness in this proceeding. First, the court did not apply the same burdens of persuasion as we must do in this case. See *Yamaha International, supra*; and discussion on burdens of persuasion, *supra*. Second, in this proceeding, acquired distinctiveness must be considered in view of the facts that exist at the time registrability is being considered. *McCormick & Co., Inc. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); and *General Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984). Facts based on events that occurred subsequent to the filing date of the application may be considered. TMEP § 1212.01. The court's finding in 2002 therefore does not preclude our

consideration of acquired distinctiveness in this proceeding which was tried six years later.

Thus, the decision of the interlocutory attorney was correct, and we are not bound by the court's decision in *Superformance* on the question of acquired distinctiveness. Opposer's unpleaded claim of res judicata is dismissed.

B. Applicant's Laches in Registering its Mark

At p. 35 of its main brief, applicant has argued:

Shelby [opposer] should not be allowed to now register trade dress of the Cobra. He is guilty of laches by failing to act. The twenty-five (25) existing replicar companies have built the replicar industry while Shelby retired from the Cobra industry. He should not be allowed an interest or ownership in the replicar industry when he did nothing to justify such a windfall.

At p. 8 of its reply brief in addressing "laches," applicant explains that "Applicant's delay in seeking registration and his failure to 'police his claims until 1997,' encouraged the widespread development of replica manufacturers [and] he is unable to show that he had 'substantially exclusive' use of the trade dress of the Cobra for the five (5) years before the date of his application for registration."

To the extent that opposer argues laches, opposer's argument is legally insufficient because laches is an affirmative defense and not a ground for opposing the registration of a mark. See *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385,

1401 n. 39 (TTAB 1994). Opposer's unpleaded claim of laches is hence dismissed.

Conclusion

In summary, because opposer has not properly introduced any evidence into the record during its testimony period supporting its claims of no acquired distinctiveness, opposer has not met its initial burden of establishing that applicant's marks have not acquired distinctiveness. Also, because opposer has acknowledged that opposer is using the mark, and priority is not an issue in this case, opposer's claims of earlier abandonment are irrelevant. As for opposer's claims of genericness, opposer simply has not persuaded us that applicant's configurations are generic. Finally, opposer's unpleaded claims of claim preclusion and laches are without merit.

DECISION: The oppositions to both applications are dismissed on all grounds.