

THIS OPINION
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THE T.T.A.B.

Hearing:
April 9, 2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Factory Five Racing, Inc.
v.
Carroll Shelby and Carroll Hall Shelby Trust¹

Opposition No. 91150346
to Application Serial No. 75586777
Filed on 11/12/1998

Steven E. Snow and Randall T. Weeks, Jr. of Partridge Snow
& Hahn LLP for Factory Five Racing, Inc.

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

Before Rogers, Walsh and Bergsman, Administrative Trademark
Judges.

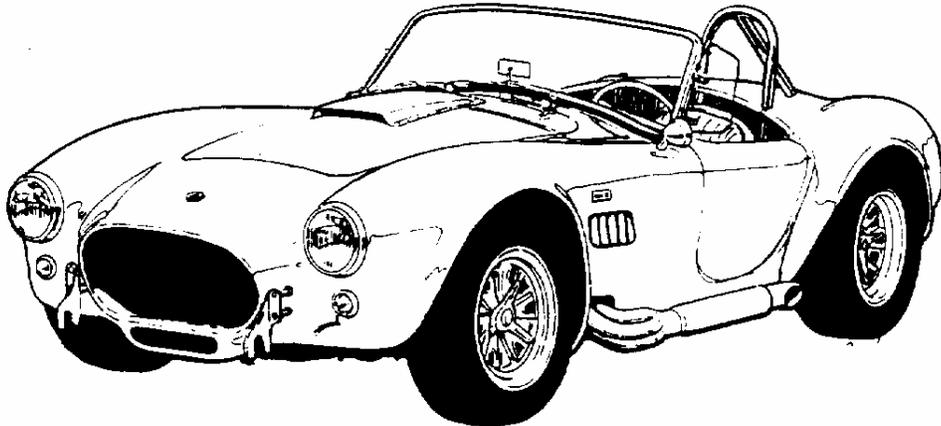
Opinion by Walsh, Administrative Trademark Judge:

Factory Five Racing, Inc. (opposer) has opposed the
application filed by the Carroll Hall Shelby Trust

¹ The papers in this proceeding refer to both Carroll Shelby and Carroll Hall Shelby Trust as applicant/defendant. The Board added Carroll Hall Shelby Trust as a defendant in an order dated March 12, 2008, to facilitate discovery. Also, in an assignment recorded on August 26, 1999, at Reel/Frame 1952/0958, Carroll Shelby assigned the opposed application to Carroll Hall Shelby Trust. In this opinion we will refer to the applicant/defendants simply as "applicant."

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(applicant) to register the mark shown here for
"automobiles" in International Class 12.



The application includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). The application also includes the following statements: "The mark is the configuration of the goods."; and "The lining in the drawing is for shading purposes and does not indicate color." The application claims first use of the mark anywhere and first use of the mark in commerce on April 6, 1965. In its brief, opposer refers to the mark as the "Cobra 427 S/C vehicle shape"; in its brief and in the application, applicant refers to the mark as the "Cobra 427 S/C trade dress." For consistency we will refer to the alleged mark as the "Cobra 427 S/C Design."

Grounds

As grounds for the opposition opposer alleges that the Cobra 427 S/C Design is generic, that the Cobra 427 S/C Design has not acquired distinctiveness, that applicant has abandoned all rights in the Cobra 427 S/C Design and that applicant has committed fraud in prosecuting the opposed application.

With respect to opposer's claim that the Cobra 427 S/C Design has not acquired distinctiveness, opposer also asserts that applicant is barred by the doctrine of issue preclusion from asserting that the Cobra 427 S/C Design has acquired distinctiveness as a result of the determination of that issue by the U.S. District Court for Massachusetts in *Carroll Shelby v. Superformance Intl. Inc.*, 251 F.Supp.2d 983 (D. Mass. 2002), as affirmed by the United States Court of Appeals for the First Circuit in *Shelby v. Superformance Intl. Inc.*, 435 F.3d 42, 77 USPQ2d 1792 (1st Cir. 2006).

In an order dated August 13, 2007, The Board granted opposer's motion to amend its notice of opposition to assert the additional ground that the Cobra 427 S/C Design is functional. The Board granted the motion as conceded. However, opposer has not maintained this ground in its brief, and therefore, we conclude that opposer has

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abandoned this ground, and we have given it no consideration.

In its answer applicant has denied the essential allegations in the notice of opposition.

Opposer and applicant have filed briefs and both took part in an oral argument before the Board.

We sustain the opposition.

Background

We provide some minimal background at the outset to provide context for the issues and motions we must address before considering the merits.

Carroll Shelby is a highly recognized designer of cars, in particular, high performance sports cars. Beginning in the early 1960s, Mr. Shelby joined with Ford Motor Company to design and produce a series of high performance sports cars identified as Cobras. Mr. Shelby achieved some success and additional notoriety in racing those cars. In 1965 Shelby introduced the Cobra 427 S/C, one of the cars in that series. Ford and Shelby ceased the production of the original Cobras, including the 427 S/C, in 1968. After Ford and Shelby ceased production of the original Cobras, numerous third parties began to produce replicas of Cobras, principally in kit form, including the Cobra 427 S/C. Third parties have continued to do so

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through 2009 in spite of Shelby's attempts to prevent them from doing so.

In the early 1990s, Shelby also began to produce "continuation" models or his particular replicas of original Cobras, including the Cobra 427 S/C, also principally in the form of kits. Shelby continued to do so at least through the trial in this case in 2009.

The focus of this proceeding is whether the Cobra 427 S/C Design has acquired distinctiveness. That is, we must determine whether potential purchasers of the Cobra 427 S/C models, now sold principally in kit form, recognize Shelby as the source of those vehicles.

As discussed more fully below in our analysis of whether Cobra 427 S/C design has acquired distinctiveness, the ongoing resale, at auction or otherwise, of the original Cobras from the 1960s is not relevant for purposes of this determination. Furthermore, we find no meaningful distinction between what applicant often refers to as a continuation, on the one hand, and a replica, on the other hand. Both applicant's "continuations" and the third-party replicas are being sold principally in kit form. It is evident that both are intended to replicate the original 1960s Cobras, including the Cobra 427 S/C.

Issue Preclusion

Before proceeding further, we will address opposer's arguments regarding issue preclusion because our determination of this issue could affect the scope of our consideration of the claims and evidence in this proceeding.

As we stated above, opposer argues that the doctrine of issue preclusion applies here with respect to its claim that the Cobra 427 S/C Design has not acquired distinctiveness based on a decision of the District Court for Massachusetts, as affirmed by the United States Court of Appeals for the First Circuit.

The District Court had granted a motion for summary judgment filed by the defendant, Superformance Intl. Inc., on the claim of plaintiff in that case, applicant in the proceeding before us, asserting trade dress infringement. The Court granted the defendant's motion on the basis that applicant, then plaintiff, had failed to show that the Cobra 427 S/C Design had acquired distinctiveness or secondary meaning, a necessary element of that claim. *Carroll Shelby et al. v. Superformance Intl. Inc.*, 251 F.Supp.2d at 987.

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The Board first addressed issue preclusion with respect to this prior decision in its summary judgment order of March 19, 2007, in this case. The Board stated the relevant requirements:

In order for issue preclusion to apply the following requirements must be met: 1) the issue to be determined must be identical to the issue involved in the prior litigation; 2) the issue must have been raised, litigated and actually adjudged in the prior action; 3) the determination of the issue must have been necessary and essential to the resulting judgment; and the party precluded must have been fully represented in the prior action. *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 397 (Fed. Cir. 1983); *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

Order of March 19, 2007, at 7.

Also, as a general proposition, a party may defend against the application of issue preclusion by showing that changed circumstances arising subsequent to the earlier determination dictate a different result. *In re Honeywell Inc.*, 8 USPQ2d 1600, 1601 (TTAB 1988).

In applying the requirements to the *Superformance Intl.* case, the Board concluded that the doctrine applied and stated: "With regard to the civil action involving the applicant and a third party, C.A. 00-12581-RWZ, which adjudicated the issue of acquired distinctiveness, we find that a genuine issue of material fact remains as to whether

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there are changed circumstances as asserted by applicant.”
Id. at 8.

We adhere to the Board’s prior ruling in this case and conclude that issue preclusion applies as a result of the District Court’s determination of the issue of acquired distinctiveness in its August 21, 2002, decision, and the affirmance of that decision on appeal. However, consistent with the earlier Board order in this case, we will consider whether changed circumstances since the date of that decision, August 21, 2002, dictate a different conclusion with regard to acquired distinctiveness.

Also, in the end, the application of the issue preclusion doctrine in this case is of only marginal significance. We must, in any case, focus on more recent evidence of acquired distinctiveness. Evidence that a mark had acquired distinctiveness seven years earlier would not suffice to show that the mark is distinctive now, which is what we must do.

Pending Motions

Before proceeding further we will address several pending motions.

At the oral hearing in this case on April 9, 2010, applicant asked that the Board reconsider the earlier denial of applicant’s motion to augment its notice of

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reliance. Applicant's request to reconsider was late and not in writing. A request for reconsideration of a decision on a motion must be filed in writing and within 30 days of the decision. Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b). We would deny the request on those grounds alone, but for completeness, we will address the request further.

In the order dated January 28, 2010, the Board denied the request from applicant to augment its notice of reliance. Applicant submitted the motion to augment on November 30, 2009, concurrently with its trial brief. Applicant's testimony period had closed on July 18, 2009, the deadline for submission of a notice of reliance. Applicant provided no reason for its delay. The documents applicant moved to submit after trial were available to applicant no later than September 2007, long before trial. The Board's decision in denying the motion to augment was entirely proper, and therefore, we deny the request to reconsider that decision on the merits, in addition to our denial on the ground of untimeliness.

We note further that among the documents applicant wished to submit under the augmented notice of reliance was a survey conducted by Dr. Jacob Jacoby which purported to determine whether the Cobra 289 Design, an earlier version

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of the Cobra, had acquired distinctiveness. Apart from the timeliness problem, such a survey is not among the types of documents which may be submitted under a notice of reliance. Trademark Rule 2.122, 37 C.F.R. § 2.122. We mention this document, in particular, because we will later discuss the apparent confusion between two designs/models Dr. Jacoby surveyed separately in September 2007 for applicant, the Cobra 289 Design, noted above, and the Cobra 427 S/C Design, the subject of this proceeding.

Next, opposer has moved to disqualify Dr. Jacob Jacoby, applicant's survey expert, from testifying and to exclude any evidence from Dr. Jacoby. Applicant has opposed the motion.

Opposer filed this motion on July 14, 2008, prior to trial. In fact, during trial it was opposer, not applicant, who submitted Dr. Jacoby's survey. Opposer submitted Dr. Jacoby's discovery deposition by notice of reliance and the survey as an attachment to the deposition. Applicant did not submit trial testimony from Dr. Jacoby or submit the survey during applicant's testimony period. Consequently, opposer is now in the position of objecting to evidence opposer submitted. We could deny the motion to exclude the evidence on that basis alone, but we will

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address the merits of the motion in any event for completeness.

By way of background, Dr. Jacoby conducted a survey for applicant in this case which purports to determine whether the Cobra 427 S/C Design has acquired distinctiveness. Based on that survey, Dr. Jacoby concludes that the Cobra 427 S/C Design has acquired distinctiveness.

Opposer alleges that Dr. Jacoby has a conflict of interest in that Dr. Jacoby conducted a survey of that same issue in 2001 for opposer in an earlier litigation that began in 2000 between opposer and applicant in the United States District Court for the District of Massachusetts, C.A. No. 00-10409-RWZ. In the district court proceeding, Dr. Jacoby found that the Cobra 427 S/C Design had not acquired distinctiveness, and furthermore criticized applicant's survey and survey expert in scathing fashion.

Opposer argues that opposer disclosed confidential information to Dr. Jacoby while Dr. Jacoby worked for opposer in 2001 in conducting the survey for opposer. Opposer argues further that this fact results in a conflict of interest now that Dr. Jacoby has changed sides and has conducted a survey for applicant on the exact same question in this proceeding.

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Applicant argues that there is no conflict of interest and no basis to disqualify Dr. Jacoby, nor to exclude his evidence. Among other reasons, applicant argues that opposer cannot point to any specific confidential information which opposer disclosed to Dr. Jacoby during the 2001 engagement. Applicant argues that, in the absence of such a disclosure, there is no basis for a disqualification or exclusion of evidence. The parties do not disagree as to this standard.

We concur with applicant on this point. In the district court case, as in this case, Dr. Jacoby had been retained and used as a testifying expert, not a mere consultant. As a testifying expert, Dr. Jacoby's entire involvement with the party who retained him, which in the district court case would be opposer, is subject to discovery and not protectable. It would be unreasonable for opposer to assume otherwise under the circumstances. In fact, in this case opposer has secured documents from and deposed Dr. Jacoby with regard to his full involvement with applicant in his new role as applicant's testifying survey expert in this case. Accordingly, we deny opposer's motion to disqualify Dr. Jacoby as an expert and to exclude his evidence in this proceeding.

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Also, on October 30, 2009, opposer moved to strike several documents applicant filed under its notice of reliance, and applicant responded to that motion. In its order of January 28, 2010, the Board acted on certain of the items and deferred action until final decision as to others. We will address each of the items in order.

First, under its own notice of reliance opposer filed certain interrogatory responses from applicant. In part B. of applicant's notice of reliance applicant included copies of transcripts of the depositions of six individuals taken in other proceedings which applicant had attached to its interrogatory responses. Applicant now claims that the documents are necessary to establish context with regard to the interrogatory responses under Trademark Rule 2.120(j)(3)(i), 37 C.F.R. § 2.120(j)(3)(i). Opposer moved to strike five of the transcripts identified as B.2. through B.6. The deposition transcripts in question are voluminous to say the least.

At the oral hearing in this proceeding, the Board advised applicant that it was not proper to "dump" this volume of documents into the record without identifying the portions of the documents which were necessary to provide context and without providing an explanation as to why the documents were needed to establish context. The Board

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ordered applicant to do so within 30 days of the hearing.

Applicant filed papers on May 6, 2010, in response to that order. In the case of the first three transcripts for the witnesses Geddes, McCluskey and Luft, applicant states, "... the first three depositions were not cited by either party in their trial briefs or at oral hearing, and there is no specific testimony to address." Applicant's May 6, 2010, submission at 2. In view of this response, we grant opposer's motion to strike the Geddes, McCluskey and Luft transcripts.

As to the fourth transcript relating to Mr. Cummings, applicant identifies pages 8 and 9, as relevant because they are necessary to explain the relationship between certain Shelby entities. We find the explanation acceptable and grant opposer's motion to strike the Cummings transcript except for the portions applicant has now identified.

As to the fifth transcript relating to Mr. Davis, applicant identifies page 14 and 15, as relevant because they are necessary to provide evidence as to the perception of a Cobra replica. We find the explanation acceptable and

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grant opposer's motion to strike the Davis transcript except for the portions applicant has now identified.²

Opposer had also moved to strike certain documents listed under Part C. of applicant's notice of reliance arguing that they did not qualify as printed publications under Trademark Rule 2.122(e). The Board disposed of those objections in its order of January 28, 2010, but afforded applicant the opportunity to provide additional information with regard to the documents numbered C.28. and C.29. to establish their admissibility. Applicant has not done so. Accordingly, we grant opposer's motion to strike these two documents.

Also in its motion to strike opposer states the following as to Parts D. Certificates of Homologation, E. Cease and Desist Letters, and F. License Agreements of applicant's notice of reliance, "While opposer has no reason to question the authenticity of such documents, authenticity is not the test of admissibility. The Applicant has not stipulated to the admissibility of these documents and they are obviously rank hearsay. They all must be excluded." Opposer's Motion to Strike at 4 (emphasis in the original).

² As noted above, opposer objected to only five of the six deposition transcripts.

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As to the Certificates of Homologation, applicant argues that they too were attached to its interrogatory responses on which opposer relies. In its May 6, 2010, papers, applicant did not address these documents. Consequently we have no explanation as to why they are necessary to establish context for the interrogatory responses, nor do we find any basis in Trademark Rule 2.122 for the filing of these documents under a notice of reliance. Nor, for that matter, do we perceive any probative value the documents might have with regard to whether the Cobra 427 S/C Design has acquired distinctiveness. Accordingly, we grant opposer's motion to strike these documents.

With regard to the licenses and cease and desist letters, we note that these documents were addressed in the 2009 testimony of Mr. Shelby at pages 29-33, testimony opposer, the objecting party, has made of record. During that testimony the parties agreed that Mr. Cummings, an attorney for applicant, would furnish an affidavit to authenticate those documents, rather than requiring Mr. Shelby, who was experiencing vision problems, to do so as part of his testimony.

We find no affidavit from Mr. Cummings in the record, but opposer does not now dispute the authenticity of the

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documents in his objections. Accordingly, we find that the documents are adequately authenticated. Under the circumstances, we overrule the objection and will consider the licenses and cease and desist letters for whatever probative value they have. In view of the fact that we have little or no testimony to support these documents, we find that they have little probative value, as we explain further below.

Finally, opposer moves to strike the eight documents listed under Part G. of applicant's notice of reliance, and designated as "Other Documents." Opposer objects on the grounds of failure to authenticate and hearsay. Applicant argues that the objections are curable, procedural objections which were not raised promptly and that the documents are admissible again because they were attached to applicant's interrogatories which opposer relies on here.

We find that the objections are not purely procedural, and furthermore, as we explained above, we provided applicant with the opportunity following the oral hearing to explain why the documents would be necessary to establish context for applicant's interrogatory responses, which opposer submitted under its notice of reliance. Applicant did not address these documents in its May 6,

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2010, papers filed after the hearing. Therefore, we will consider the admissibility of these documents according to the standards which generally apply to documents which may be submitted under a notice of reliance under Trademark Rule 2.122.

With regard to documents G.1. Settlement Agreement and G.2. Joint Press Statement, these documents are not proper subject matter for a notice of reliance, and therefore, we grant the motion to strike these documents.

As to documents G.3. and G.4., letters from Sterling Moss and Lee Iacocca, these are part of the record because they are in the file of the opposed application. *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352 92 USPQ2d 1626, 1628-1629 (Fed. Cir. 2009). Accordingly, we overrule the objection as to these documents.

The remainder of the documents, G.5. - G.8., are copies of pages from various websites. The documents conform to the standards which the Board recently adopted for acceptance of materials from websites under notices of reliance. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Accordingly, we overrule opposer's objections as to these documents.

The Record

The record includes the contents of the file for the opposed application and the pleadings filed in this proceeding. Trademark Rule 2.122. Opposer and applicant have each filed one timely notice of reliance. The documents filed under those notices of reliance are part of the record, subject to the above-stated rulings on objections. We note that, although neither party filed a testimonial deposition, opposer's notice of reliance includes the deposition of Carroll Shelby taken in 2009, which appears to begin with direct testimony from Mr. Shelby, taken by his counsel, before opposer proceeded with what appears to be a discovery deposition of Mr. Shelby.

Thus, the notices of reliance include deposition testimony from Mr. Shelby from 2001, 2002 as well as 2009. The Shelby testimony from 2001 and 2002 was taken in other proceedings and the parties have stipulated to its use in this proceeding. As noted, the 2009 Shelby testimony was taken in this proceeding. We will refer to the year of the testimony from Mr. Shelby to distinguish the source.

Also, at the time opposer filed its notice of reliance, the Board treated the entire submission as confidential. It is not clear why this was done. A few

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selected portions do bear confidential markings. We cannot shield from the public information that is not appropriately confidential. Trademark Rule 2.27(d) and (e), 37 C.F.R § 2.27(d) and (e). It is apparent that little, if any, of this material is confidential. Therefore, within thirty days of the mailing date of this decision, we order opposer to resubmit a redacted copy of its notice of reliance, filed on May 19, 2009, with only those portions which truly need to be kept confidential redacted. The redacted copy will be placed in the public record. If opposer does not make such a submission, all of the materials filed under its notice of reliance will become part of the public record.

Standing

Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, that is, whether opposer's belief that it will be damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). Opposer has pleaded and shown a sufficient interest. Specifically, opposer filed

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testimony from applicant, Carol Shelby, stating that opposer is one of the principal sellers of replicas which incorporate the Cobra 427 S/C Design which applicant seeks to register here. Shelby 2009 at 23.

Facts

As we stated above, Carroll Shelby is a highly recognized designer and builder of high performance cars. He began his career as a racer and transitioned to car design with a focus on the design of high performance sports cars and race cars. Shelby 2002 at 8-20. As of 2009, Mr. Shelby had designed about 165 different car models. Shelby 2009 at 78.

In the early 1960s, Mr. Shelby began to design and build a series of cars in conjunction with the Ford Motor Company which are identified as Cobras. Shelby 2002 at 12-20. From 1961 until 1968, Shelby and Ford designed and produced approximately 1,000 Cobras in several distinct models. *Id.* at 38-47. In 1965, Shelby designed and built the Cobra 427 S/C, one of the last models in the series, and the subject of this proceeding. Shelby built approximately 50 original Cobra 427 S/Cs. *Id.* at 43-45.

After Shelby discontinued regular production of the original Cobras, through the 1970s and 1980s, Shelby maintained his automobile production facilities, sold Cobra

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parts and built a small number of additional Cobras from left-over parts and some new parts. Shelby 2002 at 94-95; Shelby 2001 at 355. Shelby completed no more than 43 cars during that period, and possibly as few as 10 to 15. Shelby 2001 at 356-366. During the 1970s and 1980s Shelby had plans to resume production of Cobras in some form.

In 1992, Shelby began to produce "continuations" or replicas of the original Cobras, including the Cobra 427 S/C, primarily in kit form. Shelby 2001 at 88-89; Shelby 2009 at 9. A kit typically includes a chassis and body, but the purchaser is then required to assemble and complete the car with a transmission and engine and possibly other parts. Mr. Shelby identified the replicas of the Cobra 427 S/C with the designation CSX 4000. Shelby 2009 at 55. Shelby has sold the Cobra replica kits for \$50,000 to \$150,000. Shelby 2001 at 88-89. Between 2002 and 2009, Shelby, and its licensees, produced between 100-300 Cobras per year, including an unspecified number of Cobra 427 S/Cs continuations or replicas. Shelby 2009 at 9, 16 and 78-79. As of the date of Mr. Shelby's 2009 testimony, only one company, Superformance Intl. Inc., was producing the Cobra replicas under license from Shelby. *Id.* at 9.

The original Cobras, including the Cobra 427 S/C, have received a high degree of recognition among sport and race

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car enthusiasts since they were first built. Collectors value the original Cobras highly and purchase them through sales and auctions. One of the most valued original Cobras, one owned by Mr. Shelby, was sold at auction for \$5.5 million. Shelby 2009 at 12. A story from *The New York Times* of May 25, 2008, introduced during the deposition of Dr. Jacoby states, "Fewer than 1,000 were built, but the Cobra became one of those larger-than-life legends that spawned a zillion hot-rodder stories and helped to inflate the car's value as a highly desirable collectible. There's nothing like a high-powered, pretty car made in very low numbers to run up prices. The car cost less than \$6,000 in the mid-1960s, but a nice, but not-so-special one sold for \$800,000 at a recent auction." Jacoby 2009, Exh. 23. The author's assessment of the place of the Cobras in the history of high performance cars is consistent with the assessments in the many publications in the record.

Although both Mr. Shelby and the Cobras, including the original 427 S/C and continuations or replicas of that model, are frequent subjects in media directed to sport and race car enthusiasts, Shelby has not engaged in significant advertisement for the sale of his Cobra continuations or replicas. Shelby 2009 at 9-16.

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Since the early 1970s, third parties, up to 200, have produced replicas of the Cobras, including the Cobra 427 S/C, without Mr. Shelby's authorization. Shelby 2001 at 67, 75 and Shelby 2009 at 22. By 2001, there were as many as 50 parties making and selling unauthorized replicas. Shelby 2001 at 369. By 2009, as many as ten unauthorized third parties, including opposer, were still producing Cobra replicas. There have been more unauthorized replicas made and sold than original Cobras or authorized Cobra replicas. Shelby 2001 at 70. The unauthorized third-party replicas, like the authorized replicas, are sold largely in kit form. The unauthorized replicas vary in cost from \$10,000 to \$120,000. Shelby 2001 at 88.

The fact that unauthorized replicas were being sold is well known in the industry. Shelby 2001 at 137. One producer of unauthorized replicas claims to have made as many as 1,600 Cobra kits over a fifteen-year period. Shelby 2001 at 143. A Shelby website states that, "The Cobra became the most replicated design in automotive history with literally hundreds of companies capitalizing on the popularity of the design." Shelby 2009, Exh. 3. Numerous publications discuss the Cobra kit industry and one issue of *Kit Car* magazine features a photo of Mr. Shelby appearing with seven replicas from kits. Shelby

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2001, Exh. 30. The same story from *The New York Times*, dated May 25, 2009, noted above and introduced during the deposition of Dr. Jacoby, states, "The car's [Cobra's] history has fueled an industry that makes relatively low-cost Cobra replicas. There are now perhaps two dozen companies turning out about 1,200 replicas a year; prices range from about \$12,000 for a very basic kit, to \$45,000 for a complete, self-assembled fiberglass car like ours, to \$110,000 for a ready-to-drive car with an aluminum body." Jacoby 2009, Exh. 23. We rely on this article not for proof of the facts asserted in the article, but merely as confirmation of facts Mr. Shelby himself generally acknowledges.

Applicant provided copies of 28 licenses with its notice of reliance. Applicant states in its brief that only six of the licenses relate to the production of automobiles. Applicant's Brief at 16. The remainder of the licenses cover die-cast and plastic models of Cobras and collateral goods, such as, clothing and video games. As we noted above, as of 2009, Superformance was the only Shelby licensee producing Cobra replicas.

Applicant also provided copies of 25 cease and desist letters, again without any supporting testimony, under its notice of reliance. Five of the letters were sent before

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2002. Many of the letters relate to marks other than the Cobra 427 S/C design and many of the letters relate to goods other than automobiles. For example, we note the letters of April 1, 2005, to American Greetings concerning collateral goods.

More importantly, we have little or no testimony as to the results of the letters or other enforcement efforts, that is, whether the recipients ceased their activities as the letters demanded. We have no evidence that applicant took legal action against anyone to enforce its alleged rights in the Cobra 427 S/C Design, or any of the other Cobra designs, between 2002 and 2009. Applicant refers to only two cases before or during 2002 where it took legal action to enforce its rights in the Cobra 427 S/C Design, both referenced above. The first case involved Superformance Intl. Inc. where the court found the Cobra 427 S/C Design had not achieved acquired distinctiveness. That case later settled and Superformance Intl. Inc. became a licensee of applicant. The second case involved opposer, and the issue of whether the Cobra 427 S/C/ Design had achieved acquired distinctiveness was never decided by the court.

Both opposer and applicant have provided copies of publications concerning Mr. Shelby and the Cobras under

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their respective notices of reliance. The articles establish Mr. Shelby's notoriety as a designer of high performance cars beyond all question. The parties do not dispute this fact. The articles also establish that the original Cobras, including the Cobra 427 S/C, have achieved a high degree of recognition among race and sport car enthusiasts. See, e.g., Applicant's Notice of Reliance, Part E.35. - *Octane: Fueling the Passion* (January 2009) "Greatest Race Car Ever." In his 2009 testimony, Mr. Shelby testifies as to the continuing media attention he receives, as well as the media attention his creations, including the Cobras, receive. Shelby 2009 at 8-16.

Dr. Jacob Jacoby conducted a survey in September 2007 for applicant for use in this proceeding. The stated objective of the survey was "... to determine (whether and, if so, to what extent) the exterior shape, design or appearance of the Shelby Cobra 427 had acquired secondary meaning within the relevant marketplace." Jacoby, Exh. 13, Survey Report at 1.³ Dr. Jacoby reaches the following conclusion: "If one relies upon the answers to the traditional survey question used to assess secondary meaning (namely, Question 2), then it can be seen that more

³ This refers to the Discovery Deposition of Dr. Jacob Jacoby of January 23, 2009, and relevant Exhibits, filed under opposer's notice of reliance. From here forward we will refer to the Survey Report and its exhibits as Jacoby 2007 427 Survey.

than half the respondents (55.4%) said they associated the design and appearance of the Shelby Cobra 427SC with cars that came from one company." *Id.* at 16. We defer further discussion of the survey until our analysis below.

Discussion

Acquired Distinctiveness

We begin our analysis with opposer's claim that the Cobra 427 S/C Design has not acquired distinctiveness or secondary meaning.

In a recent case very similar to this one, the Board summarized the controlling law:

Configurations of products are not inherently distinctive and may only be registered as marks upon a showing of acquired distinctiveness. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 US 205, 54 USPQ2d 1065 (2000). In an opposition proceeding, opposer has the initial burden to present prima facie evidence or argument upon which we could reasonably conclude that applicant's mark has not acquired distinctiveness. If opposer does so, the burden of proof shifts to applicant to prove by at least a preponderance of the evidence that the mark has acquired distinctiveness. *Yamaha Int. Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004-1008 (Fed. Cir. 1988). "[T]he only relevant issue before this court on appeal, as it should have been before the board, is which party should prevail on the entire record." *Yamaha*, 6 USPQ2d at 1006. However, the burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on the applicant. *Id.*

"Distinctiveness is acquired by 'substantially exclusive and continuous use' of the mark in

commerce." In re Owens-Corning Fiberglas Corporation, 774 F.2d 1116, 227 USPQ 417, 424 n. 11 (Fed. Cir. 1985), citing, Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939, 942 (Fed. Cir. 1984). An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness. See In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); In re Ennco Display Systems Inc., 56 USPQ2d 1279 (TTAB 2000).

Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, however, the burden is heavier for product configurations. In re Ennco, 56 USPQ2d at 1283 (product configurations face a heavy burden to establish secondary meaning). See also Yamaha, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness. Moreover, the burden is particularly heavy when that use has not been exclusive. In re Gibson Guitar Corp., 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use not sufficient given similarity of configuration to other guitars). See also Flowers Industries Inc. v. Interstate Brands Corp., 5 USPQ2d 1580, 1588-89 (TTAB 1987) ("long and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive").

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Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp., 94 USPQ2d 1549, 1554 (TTAB 2009).

As the District Court also noted in applicant's suit against Superformance, citing *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 59 USPQ2d 1720, 1730 (1st Cir. 2001), consumer surveys are one of the few forms of direct evidence to show acquired distinctiveness. In this case, the survey is potentially the crucial piece of evidence.

We now turn to the analysis of the evidence of acquired distinctiveness.

First, in this case, opposer has submitted the deposition testimony of Mr. Shelby which establishes that Shelby's use of the Cobra 427 S/C Design has not been exclusive, neither prior to 2002, nor more importantly for our purposes, after 2002. Mr. Shelby testified that as many as ten companies, including opposer, continued to make Cobra replicas, including Cobra 427 S/Cs, as of the date of his 2009 testimony. This is more than sufficient as prima facie evidence that the Cobra 427 S/C Design has not acquired distinctiveness and that there has been no significant change of circumstances in this regard in the post-2002 period. This shifts the burden to applicant to establish acquired distinctiveness.

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Furthermore, the apparent ongoing prevalence of unauthorized third-party sales of Cobra replicas, including Cobra 427 S/Cs, has an obvious impact on applicant's ability to show acquired distinctiveness. This circumstance raises serious doubt as to whether applicant's use of the Cobra 427 S/C Design is substantially exclusive. Both the length of time and extent of the unauthorized sales is not something we can dismiss as insignificant. *Cf. L.D. Kichler Co. v. Davoil Inc.*, 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999). On the other hand, the current evidence of third-party use is not sufficiently strong and specific to warrant an outright rejection of applicant's claim of acquired distinctiveness on this basis alone. However, we do consider this a significant factor, along with applicant's other evidence, in our final determination of the issue of acquired distinctiveness.

Applicant's circumstantial evidence of acquired distinctiveness is not impressive. Over the life of all Cobras, both originals and continuations or replicas, the level of sales appears modest, at best. There were only 50 original Cobra 427 S/Cs built between 1965 and 1968. Although the sales arguably cover nearly fifty years, during much of that period, in particular, from 1968 until 1992, the sales were minimal and intermittent to

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nonexistent. In the period from 2002 to 2009, applicant's sale of all Cobras is generally small, 100 to 300. Also, we have no sales figures specific to the Cobra 427 S/C, the subject of the opposed application. Therefore, we must conclude that those sales were something less than 100-300.

Therefore, we conclude that both the length of use and level of sales provide little support for the conclusion that the Cobra 427 S/C Design has achieved acquired distinctiveness.

Applicant also readily concedes that Shelby has done little or no advertising for any Cobras, not during the sales of the all original Cobras, and not before or after 2002. Instead, applicant relies on the fact that Mr. Shelby, and all Cobras, his creations, have been the subject of constant media attention since the introduction of all of the original Cobras in the 1960s. Opposer does not dispute this contention and we take it as fact.

However, the media attention directed at Mr. Shellby and all of the original Cobras is not probative of whether relevant purchasers of Cobras perceive the Cobras 427 S/C Design as a source indicator for the goods being offered for sale today, that is, the continuations or replicas sold principally in kit form. To the extent that media attention has focused on replica makers, it is not helpful

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to applicant's position. Rather, it highlights the competition from unauthorized producers.

In our analysis we regard the sale, or more accurately, the resale, at auction or otherwise, of the original Cobras to be of limited, if any, relevance. Our focus is on the current product, that is, continuations or replicas which are being sold to the public, principally in kit form, for the first time.

It is one thing to recognize the legendary status of Mr. Shelby and the original Cobras, including the 427 S/C, and quite another to assert that purchasers and potential purchasers view Cobra continuations or replicas, sold primarily as kits, which employ the Cobra 427 S/C Design as coming from a single source. The fact that Cobra replicas, sold primarily as kits, which employ the 427 S/C Design, have been sold by numerous third parties for more than three decades, including between 2002 and 2009, precludes us from drawing that conclusion. Accordingly, we find applicant's evidence based on media coverage of Mr. Shelby and all of the Cobras not probative of the issue of acquired distinctiveness.

We also find the evidence of Shelby's attempts to police the third-party sale of Cobras weak, both before and after 2002. For the post-2002 period, the only evidence of

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policing we have are copies of cease and desist letters, with no testimony to explain how effective these efforts have been. There is no evidence of legal actions taken against unauthorized replica makers. The evidence that as many as ten parties, not authorized by Shelby, continued to produce Cobras in 2009 suggests that these efforts have been less than fully successful. The two litigations applicant brought before 2002, discussed above, provide no support for applicant's position that the Cobra 427 S/C Design has achieved acquired distinctiveness post 2002.

Applicant also relies on prior registrations it owns for the design of other Cobra models and on another Board proceeding where the Board dismissed an opposition brought by another opposer against the application opposed here (Opposition No. 91155242). In a proceeding such as this the existence of prior registrations for arguably related marks has little probative value when we view the totality of the record. Likewise, the decision in an earlier proceeding involving a different opposer and a different record has little, if any, probative weight.

In sum, applicant's circumstantial evidence of acquired distinctiveness is insufficient. Also, we find no basis on which to conclude that the general circumstances

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which prevailed up to 2002 have changed in any significant way.

Thus, applicant's survey becomes the crucial piece of evidence.

As we stated above, Dr. Jacob Jacoby conducted a survey on behalf of applicant and issued a report in September 2007. The stated objective of the survey "... to determine (whether and, if so, to what extent) the exterior shape, design or appearance of the Shelby Cobra 427 had acquired secondary meaning within the relevant marketplace." Jacoby 2007 427 Survey at 1. Dr. Jacoby arrives at a figure of 55.4% recognition and concludes that the results show that the Cobra 427 S/C Design has achieved secondary meaning or acquired distinctiveness.

Needless to say, opposer takes issue with the validity of the survey. In its criticism, opposer concentrates on a comparison of what Dr. Jacoby did in his 2001 survey on behalf of applicant, where Dr. Jacoby found that the Cobra 427 S/C Design had not achieved secondary meaning, and the Jacoby 2007 427 survey which reaches the opposite conclusion. While there are certainly some curious inconsistencies, we find it more useful to direct our attention to the merits of the Jacoby 2007 427 survey.

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We find that the survey is of little or no probative value for several principal reasons. First, in the overall design of the survey, Dr. Jacoby failed to take into account the marketplace conditions which attend the current sale and purchase of all Cobras, including the Cobra 427 S/Cs, namely, that they are sold principally in kit form as continuations or replicas of the original 1960s models. First and foremost, a survey design must reflect to the maximum extent possible the real world conditions which attend the sale of the product at issue.

The 2007 Jacoby survey, as designed, draws no distinction between any of the original Cobras which are resold or auctioned and all newly made Cobras, the continuation or replica kits, which are now on the market. For the purpose of determining acquired distinctiveness, we are not concerned with the resale or auction activity, as we discussed above.

As of result of this conceptual flaw, the universe Dr. Jacoby screened for was not reflective of potential purchasers of the Cobra 427 S/Cs which are now on the market. As a further consequence of this flaw, the questions Dr. Jacoby posed were not probative of relevant purchasers' perception of the Cobra 427 S/Cs available for sale. Secondly, the stimulus Dr. Jacoby used to test

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respondents' perception of the Cobra 427 S/C shows a model which differs significantly from the mark in the drawing and specimen of use in this application.

We begin with the problem with the stimulus. Jacoby 2007 427 Survey, Appendix B. The drawing and specimen of use in the opposed application show a model with conspicuous external exhaust pipes running from the front to the back wheel. In his 2009 deposition, Dr. Jacoby was asked why the stimulus he used in the 2007 survey of the Cobra 427 S/C did not include this feature and consequently differed from the photo he had used in the Cobra 427 S/C survey he performed in 2001 on behalf of opposer. Dr. Jacoby's testimony in response follows:

A. You know, this is interesting to me. Number one, these photographs were provided by Mr. Cummings. Why he didn't provide a photo with that very distinguishing feature, exhaust pipes, would be a question for him. I took what I was provided with.

...

Q. Well, let me ask you this. Do you know for sure that the photographs that were used in the 2007 study that we've been provided which relates to the 427SC are in fact a 427SC as opposed to the Shelby Cobra 289.

A. Again, I don't know which is which. We had photos for both the 289 and the 427SC. Dr. Kaplan's people compiled - it's possible that the photos that were supposed to go with the 289 and those which were supposed to go with the 427 were mixed up. That I don't know.

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Jacoby at 156-157.

Dr. Kaplan is the principal in the firm which executed the survey under Dr. Jacoby's direction. Jacoby at 193. There is no later discussion to clarify this important discrepancy. Applicant did not address it in its examination of Dr. Jacoby at the deposition and, as we noted, applicant has not presented any trial testimony from Dr. Jacoby, or anyone else for that matter, which might explain this discrepancy.

It is apparent that the photo used in the survey shows a model which differs from the drawing and specimen in this case. On this record, it is unclear whether Dr. Jacoby used a photo of the right model; he acknowledges that he may have mixed up the photos of the 289 and 427 S/C. Earlier in his testimony he had acknowledged that there are a number of differences between these two models, in addition to the external exhaust pipes. *Id.* at 57. This discrepancy calls into question the reliability of the survey. *Government Employees Insurance Co. v. Google Inc.*, 77 USPQ2d 1841, 1847 (E.D. Va. 2005) (discrepancies between stimulus shown to respondents and actual pages Internet users are likely to see weakened the reliability of survey results). Obviously, this reliability problem diminishes the probative value of the survey.

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Turning to the overall design of the survey, as we noted, Dr. Jacoby does not take into account (1) the significant fact that what is being sold in the marketplace, including continuations by applicant and replicas by third parties, are replicas of a car which was produced nearly four decades earlier, and (2) the fact that both applicant and the unauthorized third parties sell the replicas primarily in kit form.

In his testimony Dr. Jacoby seems to be unaware of the fact that the Shelby Cobra "continuations" were replicas in spite of the fact that he conducted a survey for both opposer in 2002 and applicant in 2007. *Id.* at 85. Dr. Jacoby indicates only a vague awareness of the production of third-party replicas. *Id.* at 86.

Dr. Jacoby exhibits an attitude toward the appearance of car models, based on the routine car market, which fails to take into account the significant differences between that market and the marketplace for replicas sold in kit form. He states, "... but if you take a look at cars, generally they're aesthetic. I mean, each year we have new models and we as consumers, I'm not talking about high performance sports cars, we know which models identify which brand name, which company, you know. That's my

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layperson's perspective. You know, I can tell you what's a Chevy and what's a Ford just by their shape." *Id.* at 144.

Although he seems to acknowledge that something different may apply with high performance sports cars, that important difference, in particular, the difference based on the sale of replicas in kit form, is not reflected in his survey design. This flaw in the survey design is manifest in the choice of the respondents surveyed, the universe, and in the survey questions.

A fundamental problem is that the universe Dr. Jacoby surveyed is overly broad. In screening for relevant consumers, Dr. Jacoby accepted persons who, during the past five years, had bought or helped decide to buy a high performance sports or muscle car or a custom or specialty car with enhanced performance or appearance. Also, Dr. Jacoby accepted persons who, in the coming two or three years, thought they would have an interest in buying such a car. Jacoby 2007 427 S/C Survey Report, Appendix C.

In addition, Dr. Jacoby accepted anyone who had ever or who then had (1) an interest in either high performance sports or custom cars for personal transportation, (2) high performance sports or custom cars used for racing, (3) high performance sports or custom cars used for road rallies, (4) automobile shows featuring high performance sports or

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custom cars, or (5) high performance sports or custom car collections. Dr. Jacoby expands the universe of acceptable respondents still further by accepting (1) anyone who over the past year or so had read or browsed through any magazine that featured articles on high performance sports or custom cars, (2) anyone who over the past year or two, whether in person or on TV, had watched any high performance sports or custom car racing, or (3) anyone who had gone to any automobile show to see high performance sports or custom cars. *Id.*

The universe of respondents is overly broad in numerous respects. It extends well beyond potential purchasers of the relevant goods, principally replicas of high performance sports or race cars sold principally in kit form. The universe also extends well beyond potential purchasers to persons with some interest, however limited, in high performance sports or custom cars.

The potential purchasers of the Cobra 427 S/C continuation or replica kits, or similar kits, are, by definition, a rather sophisticated group of people. The purchaser of a kit, as the *New York Times* article illustrates, is a rare creature who is not only knowledgeable about the product but capable of completing or arranging the completion of the product. The

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significant cost of a kit is further evidence of the care and sophistication which would be typical in such a purchase. This marketplace reality stands in stark contrast to the low level of interest and sophistication required to qualify as a respondent for this survey.

Accordingly, we conclude that the overly broad universe Dr. Jacoby surveyed severely limits the probative value of the survey.

Also, the questions Dr. Jacoby asked were not truly probative of the issue, again, because they did not take into account the nature of the goods, principally replicas sold in kit form, and the specialized marketplace for those goods. Dr. Jacoby views the responses to Question 2, as the most critical.

After being shown the stimulus, the photos of a Cobra (again, it is unclear which Cobra), and confirming that it was something the respondent had seen before, Question 2. asks:

2. Do you associate the design and appearance of this car ...
 - 1 with cars that come from one company, or
 - 2 with cars that come from more than one company?

Id. (emphasis in the original). 55.4% of the respondents said one company in response to this question.

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The fundamental problem with the question, as opposer points out, is that a respondent viewing the photos of the Cobra, may view the photo as a photo of an original Cobra, and may view the question as seeking to probe an historical fact regarding the original Shelby Cobras, which, of course, were designed and built by Mr. Shelby in conjunction with the Ford Motor Company. Also, the broad universe of respondents surveyed may be unaware of the "other sources" for Cobras in the kit market. *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1202 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

Furthermore, there is no follow-up question to Question 2, such as, "Why do you say that?" Such a question could have shed some light on the nature of the responses to Question 2 and revealed how respondents were interpreting Question 2.

Question 3 goes on to ask "What company do you think makes or puts out the car shown in these photos?" Although this is an open-ended question, the interviewer is given a range of choices numbered 1-10, including "4 Cobra/Cobra 427/427/427SC" and "8 Shelby/Shelby 427" and "Shelby Cobra/Shelby Cobra 427," which can be matched up with the actual responses, as well as a choice of "X OTHER (RECORD

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VERBATIM) : _____" and "Y DON'T KNOW." *Id.* 22.3% of respondents were classified as answering either Shelby and/or Cobra to this question.

For the record, we accept applicant's point that a properly designed survey which shows that relevant purchasers view a product as coming from a single though anonymous source would suffice, even without evidence of an ability to name the source.

Again here, we do not know whether the respondent is viewing the photos as historical photos and simply providing answers based on historical knowledge regarding the original Shelby Cobras.

Also, again there is no follow-up question, such as, "Why do you say that?" which could have shed some light on the nature of the responses to Question 3. Neither do we have true verbatim Responses to Question 3. The following transpired at Dr. Jacoby's deposition: "Q. To your knowledge, was a transcript of the answers each respondent made ever done for the 2007 survey? A. I don't think so. I would have to check on that. One was not done before the report or it would have been in the report." Jacoby at 142. Dr. Jacoby suggests that there may have been time pressure to produce the report which led to this omission. *Id.* at 141.

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In sum, due to the numerous, serious flaws in the design and execution of the survey, we conclude that it has little, if any, probative value on the question of whether the Cobra 427 S/C design has acquired distinctiveness.

In further support of its argument that the Cobra 427 S/C Design had acquired distinctiveness, applicant also relies on two 1999 letters from Lee Iacocca and Stirling Moss during the prosecution of the opposed application. Each states that that the drawing depicts the Cobra 427 S/C and that they and "any enthusiast" would recognize the design and associate it with Carroll Shelby and no one else. We do not find these letters to be probative. They merely reflect the fact that the original Cobras are associated with Mr. Shelby. We conclude likewise in the case of the statement by Mr. Davis in his deposition to the same effect.

In sum, we conclude that applicant has failed to meet its burden in the showing of acquired distinctiveness in this case. In the case of a product design that burden is heavier than otherwise might apply. *In re Ennco Display Systems Inc.*, 56 USPQ2d at 1283.

Applicant has failed to show that its use of the Cobra 427 S/C Design in the current marketplace is substantially exclusive. The record is, at best, ambiguous on this

point. Furthermore, the totality of the evidence, including the circumstantial evidence both before and after 2002, and the 2007 Jacoby survey, fail to show that the Cobra 427 S/C Design has acquired distinctiveness.

Genericness

Again, in the *Fender* case, the Board summarized the law governing genericness in cases like the one before us:

In the context of product design, genericness may be found where the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source. See *Walker & Zanger Inc v. Paragon Industries Inc.*, 465 F.Supp.2d 956, 84 USPQ2d 1981, 1985 (N.D. Cal. 2006) ("Cases addressing product design suggest that the term 'genericness' covers three situations: (1) if the definition of a product design is overbroad or too generalized; (2) if a product design is the basic form of a type of product; or (3) if the product design is so common in the industry that it cannot be said to identify a particular source"). Further, "[c]ourts exercise 'particular caution' when extending protection to product designs because such claims present an acute risk of stifling competition." *Id.* at 1984, citing, *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 42 USPQ2d 1641, 1646 (2nd Cir. 1997). This is because "[w]hile most trademarks only create a monopoly in a word, a phrase or a symbol, granting trade dress protection to an ordinary product design ... create[s] a monopoly in the goods themselves." *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 59 USPQ2d 1813 (2nd Cir. 2001). Cf. *Wal-Mart*, 54 USPQ2d at 1069 (in discussing whether product design could ever be inherently distinctive the court stated: "Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates

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plausible threats of suit against new entrants based upon alleged inherent distinctiveness").

"[C]ases have recognized that competitor use is evidence of genericness." *BellSouth Corp. v. DataNational Corp.*, 35 USPQ2d at 1558.

Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp., 94 USPQ2d at 1554-1555.

We find that opposer has failed to meet its burden on the genericness ground. Unlike the opposers in the *Fender* case, opposer here has failed to show the particulars as to the specific third parties and the exact extent to which those third parties have produced cars employing the Cobra 427 S/C Design, in particular, in the 2002 to 2009 time frame which is most critical. Opposer has not even provided testimony as to the extent to which opposer itself has produced replicas from 2002 to 2009. Also, opposer has not provided other evidence, for example, a survey, to show that the Cobra 427 S/C Design has been so widely used by others that it has become generic.

Accordingly, we dismiss opposer's claim that the Cobra 427 S/C Design has become generic.

Abandonment

Opposer has also asserted that applicant abandoned any rights it may have acquired in the Cobra 427 S/C Design. Our conclusion that applicant has failed to establish such

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rights in the first place logically renders the abandonment claim moot.

Accordingly, we dismiss opposer's claim that applicant abandoned its rights in the Cobra 427 S/C Design as moot.

Fraud

It is abundantly clear that Mr. Shelby has a sincere, good-faith belief that he is the owner of the rights to the Cobras 427 S/C Design and to other Cobra designs. Shelby 2001 at 351. Opposer has failed to show that applicant filed and/or prosecuted its application for the Cobra 427 S/C Design with the intent to deceive the U.S. Patent and Trademark Office. Without such a showing of intent the fraud claim must fail. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

Accordingly, we dismiss opposer's fraud claim.

* * *

Finally, we note that both opposer and applicant have presented numerous additional arguments. We have considered all arguments and competent evidence presented in this case whether or not we have specially discussed the particular arguments and evidence in this opinion.

* * *

Decision: We sustain the opposition on the ground that applicant has failed to show that the Cobra 427 S/C

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Design has acquired distinctiveness. We dismiss opposer's claims based on genericness, abandonment and fraud. The application is refused.

Furthermore, within thirty days of the mailing date of this decision, we order opposer to resubmit a redacted copy of its notice of reliance filed on May 19, 2009, with only those portions which truly need to be kept confidential redacted. The redacted copy will be placed in the public record. If opposer does not make such a submission, all of the materials filed under its notice of reliance of May 19, 2009, will become part of the public record.