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U.S. Patent & TMO/c/TM Mail Rpt Dt. #70

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

Unique Motorcars

Opposer,

v.

Carroll Shelby

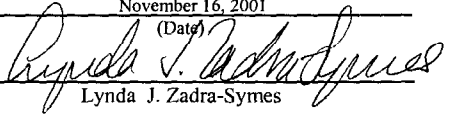
Applicant.

) Opposition No. \*

) I hereby certify that this correspondence and all marked  
) attachments are being deposited with the United States Postal  
) Service as first-class mail in an envelope addressed to:  
) Assistant Commissioner for Trademarks, 2900 Crystal Drive,  
) Arlington, VA 22202-3513, on

) November 16, 2001

) (Date)

)   
) Lynda J. Zadra-Symes

NOTICE OF OPPOSITION

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

ATT: BOX TTAB FEE

Dear Sir:

Unique Motorcars, a Business organizing and existing under the laws of the state of Alabama, having a principal place of business at 230 East Broad Street, Gadsden, Alabama 35903, believes that it will be damaged by registration of the mark shown in Serial No. 75/586,777 filed November 12, 1998, and hereby opposes the same.

The description of applicant's mark is as follows:

Mark:



Title: Appearances of the Body of the Shelby 427 S/C Vehicle.

Serial No.: 75/586,777

Filed: November 12, 1998

11/21/2001 KGIBBONS 00000022 75586777

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DD

Published: November 13, 2001

Alleged First Use: April 6, 1965

Goods: Automobiles

International Class: 12

As grounds for Opposition, it is alleged that:

### **I. THE 427 S/C VEHICLE SHAPE IS GENERIC**

#### **A. There Has Been Widespread Uncontrolled Third Party Use of the Cobra 427 S/C Shape Over The Last 30 Years**

1. The Cobra 427 S/C, shape which is the subject of Application Serial No. 75/586,777 described above, is a generic shape for replica's of Cobra 427 S/C automobiles manufactured between 1965 to 1967.

2. In 1953 AC Cars, Ltd., a British company, introduced a two-seat open-top sportscar called the AC Ace, which was based on a previous race car body design created by John Tojeiro. The AC Ace enjoyed significant racing success in the United States in the late 1950s and early 1960s. AC Cars also sold the AC Ace directly to customers in the United States, long before Carroll Shelby had any involvement with the automobile. Between 1965 and 1967, Applicant Carroll Shelby, doing business as Shelby American, produced and sold cars in the United States bearing the shape shown in Application Serial No. 75/586,777, known as the Cobra 427 S/C, which was made from the AC chassis and body and imported from AC Cars in the United Kingdom. At the end of 1967, the Shelby American factory was shut down, and Shelby American ceased production of the 427 S/C.

3. Over the last 30 years, dozens of automobile manufacturers have manufactured and sold in the United States replicas of the Cobra 427 S/C incorporating the shape shown in Application Serial No. 75/586,777. In the early 1970's Arntz Engineering began offering a replica of the Cobra 427 S/C using the Cobra 427 S/C body shape. Arntz was followed by dozens of others including: Unique Motorcars, Red Stallion Limited, Contemporary Motorcars, ERA Replica Automobiles; Lone Star Classics; Factory Five Racing, Superformance, Shell Valley Companies, Contemporary Classic Motor Car, Aurora, North American Fiberglass,

Elegant Motors, Specific Coast Cobra, West Cobra, Cobra Enterprises, Ron Ayres Classic Cars, Glaspac, Metaline, Unique Autocraft, DJ Sports cars, Beribo Replica Automobiles, A.C. Autokraft, Kirkham Engineering and Sales, and Classic Motors. Each manufacturer produced replica vehicles using the Cobra 427 S/C body shape without any control or permission from Carroll Shelby and without any association with Carroll Shelby's companies. By 1992, approximately 30 Cobra replica manufacturers were in operation. There are now thousands more replicas in the marketplace than there are original Cobra 427 S/C vehicles.

**B. Applicant Was Aware of And Acquiesced in Widespread Uncontrolled Third Party Use of The Cobra 427 S/C Body Shape**

3. Applicant has been aware of this prolific uncontrolled use in the replica car industry of the shape of the Cobra 427 S/C for at least the last 20 years, as evidenced by the following examples of interviews with Applicant published in national publications:

- In a 1981 interview with Car and Driver Magazine, Applicant discussed the Cobra replica manufacturers.
- In a 1986 interview with Kit Car Illustrated, Applicant stated that he "really didn't worry" when "everybody" started making kits because they were called "Cobra replicas". Applicant expressed the opinion that, "you can't stop anybody from making these kits".
- In a 1988 interview with Kit Car Illustrated, when asked about the manufacturers of replica Cobras, Applicant said "[n]othing you can do about it." In a second interview with Kit Car Illustrated in 1988, Applicant stated "I don't mind people making copies of that old car if that's what they want to do". He further stated "I don't mind if people do it. It's a compliment".
- Applicant even participated in a *Road & Track* feature that compared the performance of several replica Cobra 427 S/C vehicles, all using the Cobra 427 S/C shape, to an original bearing the same shape.
- In 1993, Applicant again appeared in Kit Car magazine in a photograph in which he posed with seven Cobra replicas.

**C. Applicant Has Admitted In Federal Court That The Cobra 427 S/C Vehicle Shape Is Generic**

4. In or about April 1992, Applicant Carroll Shelby d/b/a Shelby American Management Company and Shelby American, Inc. filed a Complaint for Declaratory Judgment against Ford Motor Company, Civil Action No. 92-2571 CBM (JGx) (hereinafter the Shelby v. Ford lawsuit). In that Complaint, Applicant alleged that:

**"scores of replicators in both the United States and abroad, have manufactured, advertised and sold, in interstate, intrastate and foreign commerce, cars which replicate the overall design and appearance of the 'COBRA' cars, and particularly the 'COBRA 427 S/C' roadster, and said replicas have been and are being advertised, offered for sale and sold in either kit form, to be built by the purchaser, or as completed, 'turn-key' automobiles (hereinafter referred to as 'replicas')."**

5. In addition, in a Memorandum in Opposition to Defendant's Motion for Summary Judgment filed in the Shelby v. Ford lawsuit, Applicant alleged that:

**"The key point is that no one manufacturer is exclusively associated with the design or the COBRA name which identifies the design."**

**II. APPLICANT HAS ABANDONED ANY TRADEMARK RIGHTS IN THE COBRA 427 S/C VEHICLE SHAPE**

**A. Applicant Ceased Use Of The Cobra 427 S/C Shape For More Than 20 Years**

6. Applicant ceased manufacture of Cobra 427 S/C vehicles in 1967, and did not recommence making replicas of such vehicles until in or about 1990, over 20 years later. The current Shelby produced replica, known as the CSX-4000, has only been in production since 1995, competing in the market alongside replicas from numerous different manufacturers, unassociated with Applicant, all utilizing the same Cobra 427 S/C shape.

7. Since Applicant ceased production of the original Cobra 427 S/C vehicles in 1967, dozens of manufacturers have produced thousands of replica's of the Cobra 427 S/C vehicles. All these replica vehicles share the same overall body configuration as the Cobra 427 S/C shape shown in Application Serial No. 75/586,777.

**III. APPLICANT HAS NOT ACQUIRED DISTINCTIVENESS IN THE COBRA 427 S/C VEHICLE SHAPE**

8. As discussed above, the shape of the Cobra 427 S/C automobile is used widely in the United States by dozens of manufacturers of replica's of Cobra 427 S/C vehicles, and has been so used during the past 30 years without any control by Applicant. Thus, Applicant has not established, and cannot establish that the Cobra 427 S/C shape which is the subject of Application Serial No. 75/586,777 has become distinctive of Applicant's automobiles. Nor can Applicant establish that the Cobra 427 S/C shape has acquired secondary meaning as a source of origin of applicant's automobiles. Indeed, as discussed above, Applicant admitted in the Shelby v. Ford lawsuit that the design of the Cobra 427 S/C is not associated exclusively with any one manufacturer.

**IV. APPLICANT IS BARRED FROM OBTAINING A REGISTRATION BY VIRTUE OF FRAUDULENT REPRESENTATIONS MADE IN ITS APPLICATION.**

9. At the price of filing the subject application, Applicant was fully aware of the widespread third party use of the Cobra 427 S/C body shape by replica car manufacturers, and had admitted in the Shelby v. Ford lawsuit filed in 1992 that the Cobra 427 S/C shape was not exclusively associated with one manufacturer. Accordingly, statements in the subject application to the effect that "Applicant has presented strong evidence to show that the vehicle configuration of the application is distinctively different from that of other vehicles" is knowingly false. (See, e.g. Applicant's Response to Office Action dated January 1, 2000). Applicant had knowledge of the falsity of such statements by virtue of his prior knowledge of the widespread uncontrolled third party use of the overall shape of the Cobra 427 S/C vehicle, and made such false statements with the intent to induce the Examiner to rely on such false statements by allowing publication and eventually registration of his purported trademark.

Opposer alleges that it would be damaged by Applicant's registration of the alleged trademark as it would interfere with use by Opposer and others in the field of replica car manufacture in the exercise of their right to use the shape of the Cobra 427 S/C vehicle.

Wherefore, Opposer prays that said application, Serial No. 75/586,777, be rejected, that no registration be issued thereon to Applicant and that this opposition be sustained in favor of Opposer.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 11/16/01

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