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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. 91150352
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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

February 25, 2002

(Date)

Lynda J. Zadra-Symes
Lynda J. Zadra-Symes

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND PROCEEDING

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



02-28-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #61

Dear Sir:

Opposer Unique Motorcars ("Unique") hereby opposes Applicant's Motion to Suspend Opposition Proceedings on the following grounds:

Applicant has moved to suspend the above captioned proceeding pending the disposition of Civil Action 00 CV 10409 RWZ filed by Applicant in the District Court for the District of Massachusetts. On February 18, 2002, the parties in Civil Action 00 CV 10409, RWZ dismissed with prejudice all claims in the Action.

Furthermore, Applicant Shelby dismissed with prejudice "all claims that have been asserted or could have been asserted relative to the trade dress or designs of FFR's [Factory Five Racing's] kit cars, bearing the same shape as the Cobra 427 S/C shape which is the subject of Applicant's purported mark, Serial No. 75/586,777, and this Opposition Proceeding (See Exhibit

"A", Paragraph 9). A true and correct copy of the Injunction and Final Judgment by Consent as to claims by Ford Motor Company and Carrol Shelby is attached hereto as Exhibit "A".

Accordingly, because the litigation upon which Applicant relied has now been dismissed with prejudice, Unique, the Opposer, respectfully requests that the Board deny Applicant's request to suspend these Opposition Proceedings.

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

Dated: 2/25/02

By: Lynda J. Zadra-Symes
Lynda J. Zadra-Symes
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(949) 760-0404
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND PROCEEDING** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on February 25, 2002, addressed as follows:

Edward A. Soloski, Esq.
3868 Carson Street, 105
Torance, CA 90503

Lynda J. Zadra-Symes
Lynda J. Zadra-Symes

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

DOCKETED

FORD MOTOR COMPANY,)
)
Plaintiff,)
)
v.)

C.A. No. 00-10399 RWZ

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FACTORY FIVE RACING, INC.,)
)
Defendant.)

CARROLL SHELBY, AN INDIVIDUAL,)
CARROLL SHELBY LICENSING, INC.)
AND SHELBY AMERICAN, INC.)

DOCKETED

Plaintiffs,)
)
v.)

C.A. 00-CV-10409 RWZ

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FACTORY FIVE RACING, INC.)
)
Defendant.)

INJUNCTION AND FINAL JUDGMENT BY CONSENT
AS TO CLAIMS BY FORD MOTOR COMPANY AND CARROLL SHELBY, ET. AL.

These cases having come before the Court upon the Complaints of Ford Motor Company ("Ford") and Carroll Shelby and Carroll Shelby Licensing, Inc. and Shelby American, Inc. ("Shelby") against Factory Five Racing, Inc. ("FFR"), for trademark infringement, counterfeiting, dilution, and unfair competition under the Lanham Act and Massachusetts law, and Ford, Shelby and FFR, having agreed to the terms set forth herein, IT IS HEREBY ORDERED that:

1. The Court has jurisdiction over the parties and subject matter hereof.
2. The Court declares that the following trademarks are incontestable, valid, federal trademarks under 15 U.S.C. §§ 1114 *et seq.*: COBRA, COBRA Snake Design, FORD, which are

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EXHIBIT A

owned by Ford, and 427 S/C, SHELBY 427 S/C, FIA 289 and GT350, which are owned by Shelby (collectively, the "Ford/Shelby Marks").

3. Pursuant to their consent, FFR, its agents, affiliates, heirs, successors, assigns, servants, employees and attorneys are permanently enjoined from:

3.1 using through any medium, including the Internet, the names or marks COBRA, FORD, COBRA Snake Design, 427 COBRA, 427 S/C, 427 S/C COBRA, SHELBY, SHELBY COBRA, DAYTONA COUPE, DAYTONA COUPE COBRA, FIA 289, FIA 289 COBRA, GT350, 289 COBRA, GT350 COBRA, any confusingly similar design of a snake, or any other confusingly similar name or mark, or derivative of the Ford/Shelby Marks, as a trademark, trade name or domain name, on or in connection with the marketing, sale or distribution of motor vehicles, kit cars, parts and accessories for kit cars, automotive parts and accessories, or any other products not made by Ford or Shelby or their duly authorized licensees.

The prohibited acts include:

3.1.1 FFR's affixation of the Ford/Shelby Marks or names or any derivative upon any of its kit cars, parts, or accessories sold after February 11, 2002;

3.1.2 FFR's sale of any badges that bear the Ford/Shelby Marks or names or any derivative or use of any such badges upon any of its kit cars, parts, or accessories, sold after February 11, 2002;

3.1.3 FFR's marketing, sale or distribution of any motor vehicle, kit car, parts and accessories for kit cars, automotive parts and accessories, or any other product that bears the Ford/Shelby Marks and names, any other confusingly similar mark or design, or any other trademark owned by Ford or Shelby;

3.1.4 FFR's use or display of the Ford/Shelby Marks and names or any derivative or any other confusingly similar mark or design in promotions (including car shows, trade shows, races and other competitions), signage, advertising or other materials, except as otherwise stated in this Order. Any display of FFR's customers cars in FFR's promotions, signage, advertising or other materials shall be altered so that any of the marks which may appear on them are illegible. With respect to web site use, FFR shall have thirty (30) days from the entry of this Injunction to comply with this paragraph. With respect to printed materials, FFR shall have six (6) months from entry of this Injunction to comply with this paragraph.

3.1.5 Notwithstanding the foregoing, FFR shall not be prohibited from promotional distribution of reprints of publicly available articles of independent publishers describing FFR products which use the Ford/Shelby Marks, providing FFR did not participate in the financing, writing, development, production, or original distribution of the article other than by the provision of information on inquiry from the independent publishers; provided further, that FFR include the following disclaimer attached on the face of the reprinted article in the same typeface as the original article:

"COBRA and the COBRA Snake Design are the registered trademarks of Ford Motor Company, and Carroll Shelby is its exclusive licensee. Shelby, 427 S/C, and FIA 289 are the registered trademarks of Carroll Shelby. Factory Five Racing does not and cannot authorize the use of these trademarks on its products."

3.2 using the Ford/Shelby Marks and names or any similar name or mark that is likely to dilute the distinctiveness of the Ford/Shelby Marks and names or likely to tarnish the goodwill of the Ford/Shelby Marks and names; and

3.3 using the Ford/Shelby Marks and names or any similar name or mark in a way that is likely to induce the belief that FFR's business or products are in any way connected

with Ford's or Shelby's businesses, products or services or are sponsored or approved by Ford or Shelby.

4. FFR shall not issue any certificate of origin which states or suggests that FFR kits are replicas of any car designed, engineered, built or raced by Shelby or Ford, including the 289 COBRA, FIA 289 COBRA, 427 COBRA, 427 S/C COBRA, SHELBY COBRA, DAYTONA COUPE, DAYTONA COUPE COBRA, GT350, or GT350 COBRA.

5. FFR shall not make any direct or indirect use of or link to web sites of builders or dealers which identify, suggest, or imply that FFR products or designs are based on, modeled on, or derived from any car designed, engineered, built, or raced by Shelby or Ford, including the 289 COBRA, FIA 289 COBRA, 427 COBRA, 427 S/C COBRA, SHELBY COBRA, DAYTONA COUPE, DAYTONA COUPE COBRA, GT350, or GT350 COBRA.

6. To the extent that any of FFR's customers, builders, or individuals or entities that assemble FFR's kits for resale display finished kit cars that bear the Ford/Shelby Marks and names (other than on genuine Ford components) in venues such as car shows, trade shows, races, other competitions, enthusiast gatherings, and FFR sponsored events, Ford and Shelby will take action against only the persons that sold such non-kit components bearing Ford/Shelby Marks and names, provided further that FFR does not authorize or actively encourage such customers, builders or individuals to use the Ford/Shelby Marks and names and provided that FFR shall, at all times, comply with § 3.1.4, and provided further that FFR shall provide affirmative written notice to its customers, builders, and dealers that it does not and cannot authorize the use of Ford/Shelby Marks on FFR's products. This notice shall be provided to customers together with the certificate of origin at the time of sale.

7. It shall not be a violation of this Order for FFR to make use of any of Ford's trademarks or do any other thing if FFR receives prior written authorization from Ford to do so.

8. FFR is ordered to assign to Ford within fifteen (15) days of the date of this Final Judgment all domain name registrations that contain the term "Cobra" to which FFR maintains ownership or rights as of the date hereof.

9. All claims and defenses that have been asserted or could have been asserted as of this date for use of the Ford/Shelby Marks and names or any confusingly similar name, mark or domain name, are hereby satisfied and extinguished and dismissed with prejudice, subject only to each party's right to assert those names or marks in an attempt to enforce compliance with this Final Judgment. Shelby dismisses with prejudice all claims that have been asserted or could have been asserted relative to the trade dress or designs of FFR's kits, including but not limited to the kits known as the 427 Roadster and the Type 65 Coupe.

10. In the event that Ford or Shelby believes that FFR has violated any of the terms and conditions of this Final Judgment, judicial enforcement of this Final Judgment may not be pursued unless Ford or Shelby first give written notice to FFR of the alleged violation and FFR fails to cure or remedy the situation to Ford's or Shelby's satisfaction within thirty (30) days of FFR's receipt of notice.

11. FFR, Ford and Shelby shall assume their respective costs and expenses relative to the hereto action.

12. Judgement shall enter in accordance herewith.

SO ORDERED AND DECREED:

Dated: February 11, 2002

[Signature]
UNITED STATES DISTRICT JUDGE

CONSENTED TO BY:

FORD MOTOR COMPANY, INC.

By: [Signature]

Name: DANIEL M. STOKK

Title: MANAGING COUNSEL

Date: February 11, 2002

FACTORY FIVE RACING, INC.

By: [Signature]

Name: DAVID T. SMITH

Title: PRESIDENT

Date: February 11, 2002

CARROLL SHELBY, CARROLL SHELBY LICENSING, INC., and SHELBY AMERICAN, INC.

By: [Signature]

Name: CARROLL SHELBY

Title: President

Date: February 11, 2002