



05-10-2002

U.S. Patent & TMOtc/™/Mail Rcpt Dt. #22

Exhibits

TTAB

ERAREP.006M

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

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

May 7, 2002

(Date)

Lynda J. Zadra-Symes (Signature)

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

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 12581 RWZ, filed by Applicant in the District Court for the District of Massachusetts, attached hereto as Exhibit A. Although this case is still pending, no trial date has been set.

The Trademark Trial and Appeal Board ("Board") has a considerable amount of discretion in deciding whether or not to suspend proceedings before it. "Whenever it shall come to the attention of the Trademark Trial and Appeal Board that...parties to a pending case are

TRADEMARK TRIAL AND APPEAL BOARD
MAY 20 02 AM 11:23

mas

engaged in a civil action...which may have a bearing on the case, proceedings before the board may be suspended until termination of the civil action.” 35 U.S.C. § 2.117(a)(emphasis added). “Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board.” TBMP § 510.02(a)(emphasis added). The language of the statute and of the Trademark Trial and Appeal Board Manual of Procedure clearly indicate that the Board is not bound to suspend a proceeding before it simply because the parties are also involved in a related lawsuit.

“It is...obvious that the Board in arriving at a decision to suspend must necessarily take into account the feasibility of moving forward in a Patent Office proceeding in light of the issues set forth in the complaint in the civil action.” In the above-referenced Opposition, a decision by the Board is not only feasible, but it would actually be helpful to the court in the civil action pending in the Massachusetts District Court. While a decision by the Board may not necessarily be binding on a district court, many courts respect the Board’s expertise in determining the validity of trademarks. See Data Connections, Inc. v. Data Connection Corporation, 1995 U.S. Dist. LEXIS 16899, *6-7.

Indeed, in Nat’l Marketing Consultants, Inc. v. Blue Cross and Blue Shield Ass’n, 1987 U.S. Dist LEXIS 10840, the court suspended a trademark infringement suit before it, pending the resolution of an opposition proceeding in front of the Board which involved the same parties and the same marks. See *id.* at *10-11. The court states that the issue before the Board - likelihood of confusion - was central to the case before the court. See *id.* at *5. The court continued that “the TTAB’s determination will be a material aid in ultimately deciding the remaining issues in this case.” *Id.* at *6. The court reasoned that, even though it had the power to resolve the issue of

trademark infringement, "it is wise and proper practice to defer to the TTAB's expertise in such matters since they routinely make such determinations." *Id.*

Much like the case of Nat'l Marketing Consultants, the issues before the Board in this Opposition are central to the litigation before the District Court of Massachusetts. In the current Opposition, Unique has alleged, inter alia, that the appearance of the Cobra 427 S/C car which Applicant is attempting to register is generic and/or abandoned, and therefore not registrable because it does not indicate Applicant as a source of origin. A determination by the Board of the genericness of Applicant's car shape would assist the court in determining the validity of Applicant's alleged trade dress.

Furthermore, in a related lawsuit filed by Applicant, Case No. 00-10399/00CV-10409 RWZ, also pending before the Massachusetts District Court, Applicant dismissed with prejudice all of its trade dress claims against Factory Five Racing, which was manufacturing and selling, and is continuing to manufacture and sell, Cobra 427 S/C replica cars kits bearing the same overall appearance as the purported trademark which Applicant seeks to register. See Exhibit B, paragraph 9, attached hereto.

///

///

///

///

///

///

///

///

Accordingly, Unique, the Opposer, respectfully requests that the Board deny Applicant's request to suspend these Opposition Proceedings because the District Court Case will greatly benefit from the Trademark Trial and Appeal Board's experience in trademark matters.

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

Dated: 5/7/07

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** Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on May 7, 2002, addressed as follows:

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

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