

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

UNIQUE MOTOR CARS)
Opposer)

V.)

) Opposition NO. 91150352

CARROLL SHELBY)
Registrant)

MOTION TO CONSOLIDATE OPPOSITION PROCEEDINGS

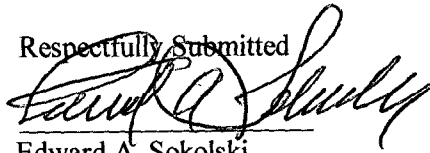
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

It is respectfully requested that the above indicated Opposition Proceeding be consolidated with Oppositions no.91150349(SHELL VALLEY COMPANIES, INC.); 91151113(ERA REPLICIA AUTOMOBILES); 91150348(LONE STAR CLASSIC, INC.); 91150350 (SUPERFORMANCE INTERNATIONAL, INC.); and 91150346(FACTORY FIVE RACING INC. All of these Oppositions involve the same single issue, namely, the registerability of Applicant's trademark application no. 75/586,777 for the outward appearances of the Shelby 427 S/C vehicle.

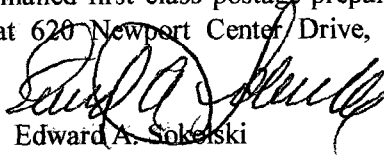
Date 4/17/02

Respectfully Submitted



Edward A. Sokolski
Attorney for Applicant/Petitioner
3868 Carson Street, suite 105
Torrance, CA 90503
Tel..(310) 540-5631

A copy of the above Motion has been mailed first class postage prepaid on 4/17/02 to Lynda J. Zadra-Symes, Attorney for Opposer at 620 Newport Center Drive, sixteenth floor, Newport Beach, CA 92660.



Edward A. Sokolski
Attorney for Applicant

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

UNIQUE MOTOR CARS
Opposer

V.

CARROLL SHELBY
Registrant

Opposition NO. 91150352

MOTION TO SUSPEND OPPOSITION PROCEEDINGS

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

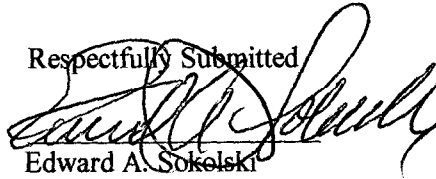
Dear Sir:

It is respectfully requested that the above indicated Opposition Proceeding be suspended in view of pending litigation 00CV 12581 RWZ pending in the United States District Court for the District of Massachusetts against Superformance International Inc. A copy of the complaint of this litigation is enclosed. A specific issue set forth in this Action found in the complaint of this pending litigation is Shelby's rights in the design shape of the Shelby Cobra 427 S/C which is the subject of the Opposition Proceeding. This is set forth in par.14-17, 25,26. Therefore, an issue to be decided in the litigation is Shelby's rights in the trademark in the design shape of the 427S/C which is

covered by the Application and is the subject of the above Opposition.

Date 4/17/02

Respectfully Submitted



Edward A. Sokolski

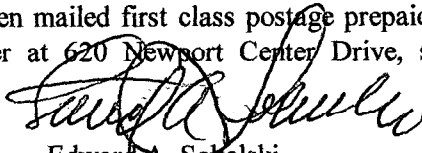
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Edward A. Sokolski

Attorney for Applicant

COPY

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Civil Action No.

11/15/11
10:14 AM

00 cv 12581 RWZ

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

v

SUPERFORMANCE INTERNATIONAL,
INC, d/b/a SUPERFORMANCE
COMPLETE REPLICARS,
Defendant

COMPLAINT

This is an action for trademark infringement, counterfeiting, dilution, and unfair or deceptive trade practices, all in violation of the laws of the United States and the Commonwealth of Massachusetts.

Jurisdiction and Parties

1. Plaintiff, Carroll Shelby is an individual with his place of residence in Los Angeles, California. Plaintiff, Carroll Shelby Licensing, Inc. is a Texas corporation with its principal place of business located in Gardena, California. Plaintiff, Shelby American, Inc. is a manufacturing and sales corporation with its principal place of business in Las Vegas, Nevada. Carroll Shelby, Carroll Shelby Licensing, Inc., and Shelby American, Inc. are referred to here as "Shelby." Shelby is engaged in business in the Commonwealth of Massachusetts.

2. Defendant, Superformance Internatioanl, Inc., d/b/a Superformance Complete Replicars (here "Superformance") is an Ohio corporation, with a place of business located at 2647 Morgan Lane, Ross, Ohio. Superformance is engaged in business in the Commonwealth of Massachusetts.

3. This court's subject matter jurisdiction arises: (i) under the Trademark Laws of the United States, 15 U.S.C. §§ 1051-1127, jurisdiction conferred by 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338; (ii) complete diversity of citizenship and an amount in controversy in excess of seventy-five thousand dollars (\$75,000), jurisdiction conferred under 28 U.S.C. § 1332(a); and (iii) by virtue of the fact that certain state law claims are joined with substantial and related claims under the Trademark Laws of the United States, 15 U.S.C. §§ 1051-1127, jurisdiction conferred by 28 U.S.C. § 1338(b) and 28 U.S.C. § 1367. This court's personal jurisdiction arises from the Massachusetts long arm statute, G.L. c.223A, §§1 *et seq.*, because Superformance is engaged in business in the Commonwealth. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b).

Facts

4. Since at least 1965, Shelby has engaged in manufacturing, marketing, advertising and selling automobiles and related products and services, including but not limited to specialty vehicles, automotive parts and accessories.

5. At all times mentioned here, Plaintiff Carroll Shelby Licensing, Inc. was and now is a licensing company engaged in the business of licensing, marketing and advertising a variety of famous and distinctive trademarks, designs, and shapes. Both Carroll Shelby and the Carroll Shelby Trust dated March 28, 1985 (the Trust) are the owner/assignee of United States Trademark registrations Nos. 864,154, 1,768,020, 1,538,090, and 1,728,573. These registrations are valid and

subsisting and in accordance with section 7(b) of the United States Trademark Act (15 U.S.C. §1057(b)) are *prima facie* evidence of the ownership and validity of the marks. Both Carroll Shelby and the Trust are the owner/assignee of the mark which is the subject of pending application Serial No. 75-453,027 for FIA 289.

6. United States Trademark registration Nos. 864,154 is the trademark, SHELBY, for: automobile parts and accessories, namely roll bars, hoodpin kits, rear quarter window kits, wheels, wheel covers, steering wheels and suspension components, including shock absorbers, stabilizer bars, traction bars, and front end parts. This registration is valid and subsisting and in accordance with section 7(b) of the United States Trademark Act (15 U.S.C. §1057(b)) is *prima facie* evidence of ownership and validity of the mark.

7. United States Trademark registration No. 1,768,020 is the trademark, SHELBY 427 S/C, for automobiles. This registration is valid and subsisting and in accordance with section 7(b) of the United States Trademark Act (15 U.S.C. §1057(b)) is *prima facie* evidence of ownership and the validity of the mark.

8. United States Trademark registration No. 1,538,090 is the trademark, SHELBY, for automobiles. This registration is valid and subsisting and in accordance with section 7(b) of the United States Trademark Act (15 U.S.C. §1057(b)) is *prima facie* evidence of the ownership and validity of the mark.

9. United States Trademark registration Number 1,728,573 is 427 S/C for automobiles, and structural parts and accessories. This registration is valid and subsisting and in accordance with section 7(b) of the United States Trademark Act (15 U.S.C. §1057(b)) is *prima facie* evidence of ownership and the validity of the mark.

10. Ford Motor Company ("Ford") is the owner of its trademark, COBRA, and COBRA SNAKE designs and pursuant to 15 U.S.C. sections 1065 and 1115(b), Ford Motor Company has an incontestible federal registration of COBRA under U.S. registration Nos. 807,185 and 1,562,071 and California registration No. 090,349 covering automobiles, engines, and parts.

11. Carroll Shelby has an agreement with Ford, under which Ford has granted an exclusive worldwide license to Carroll Shelby for the use of COBRA and the COBRA SNAKE designs in connection with 1960s vintage automobiles created, designed, and made by Carroll Shelby. Carroll Shelby has in turn, transferred his rights to the Trust for the use of COBRA and the COBRA SNAKE designs in connection with 1960s vintage automobiles created, designed, and made by Carroll Shelby.

12. Carroll Shelby Licensing, Inc. operates under an agreement with the Trust, granting Carroll Shelby Licensing, Inc. the exclusive right to license SHELBY, the SHELBY 427 S/C, 427 S/C, FIA 289 and other trademarks and to stand in the place and stead of the Trust for all litigation purposes.

13. Since the early 1960s, Carroll Shelby has been engaged in the manufacture, marketing, sale, licensing, and promotion of automobiles, automobile parts, automobile accessories and related products, services, and other goods under the name, trademarks and trade shapes consisting of, but not limited to SHELBY, COBRA, and the COBRA SNAKE designs as these relate to the vintage 1960s automobiles created, designed, and made by Carroll Shelby. Carroll Shelby also has used in conjunction with his business, the trademarks, both formally registered and unregistered, SHELBY, CARROLL SHELBY, 427 S/C, FIA 289 and SHELBY 427 S/C. The trademarks in the above paragraphs are sometimes hereinafter jointly and severally referred to as The Marks.

14. Carroll Shelby is the creator of the SHELBY COBRA 427 S/C and continues to manufacture, produce, market, license, and promote this vehicle in its original form, design, and shape.

15. The design shape of this vehicle is inherently distinctive and unique and either serves to identify Carroll Shelby as the source of the vehicle or suggests that the vehicle has been manufactured with the approval of Shelby.

16. Each year Shelby sells hundreds of thousands of dollars worth of automobiles, parts, and accessories and other merchandise bearing the SHELBY and COBRA names, marks and shapes throughout the United States through Shelby companies and licensees. Shelby has spent considerable time and money advertising and promoting its SHELBY and COBRA names, marks, and shapes.

17. By virtue of Shelby's long use, manufacture, advertising, club and association sponsorships and marketing, licensing, and general promotion, the SHELBY and COBRA names, marks, and shapes are now famous and represent an extremely valuable goodwill owned by Shelby.

18. By virtue of Shelby's long use, advertising, and promotion, The Marks are distinctive and famous, signifying Shelby and the automotive goods it offers, and representing an extremely valuable goodwill owned by Shelby throughout the United States, including the Commonwealth of Massachusetts.

19. Superformance manufactures, advertises, markets and sells motor vehicles, kit cars, parts and accessories for kit cars, and automotive parts and accessories under or in connection with the mark COBRA, including but not limited to vehicles which are based on the original SHELBY COBRA vehicles, throughout the United States, including the Commonwealth of Massachusetts.

20. Superformance operates a World Wide Web Internet site under the domain name Superformance.com that can be accessed throughout the United States, including the Commonwealth of Massachusetts. Superformance advertises its infringing automotive products on its web site.

21. Superformance began to market and continues to sell its infringing automotive products with apparent knowledge of Shelby's rights in The Marks.

22. Superformance's use of The Marks is without Shelby's authorization or consent.

23. Superformance's unauthorized use of The Marks irreparably injures Shelby by depriving Shelby of the right to use and control its marks.

COUNT I
INFRINGEMENT OF FEDERALLY REGISTERED TRADEMARKS

24. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

25. As a result of its unauthorized use of The Marks in connection with its infringing automotive products, as well as its web site, Superformance has intended to cause, has caused and is likely to continue to cause confusion, or to cause mistake or to deceive the public.

26. Superformance is likely to mislead prospective purchasers as to the affiliation, connection or association of Superformance, its infringing automotive products, or its web site, with Shelby or Shelby's automotive goods, or as to the origin, sponsorship, or approval of Superformance's infringing automotive products or its web site by Shelby, intending to cause purchasers to rely thereon.

27. Superformance has knowingly offered said products in commerce, on information and belief, with knowledge of the falsity and misleading effect of such designations, in violation of 15 U.S.C. §§1114 and 1125.

28. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill, and will sustain loss of revenues and profits:

29. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

COUNT II
TRADEMARK COUNTERFEITING

30. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

31. Superformance's use of The Marks, on information and belief, in connection with its infringing automotive products constitutes use of spurious designation identical with, or substantially indistinguishable from Shelby's federally registered or licensed federally registered trademarks, and is without Shelby's consent or authorization.

32. Superformance's aforesaid acts have been willful, intentional, or in reckless disregard of Shelby's aforesaid rights.

33. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill, and will sustain loss of revenues and profits.

34. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

COUNT III
FEDERAL TRADEMARK DILUTION

35. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

36. As a result of its unauthorized use of The Marks in connection with its infringing automotive products, as well as its web site, Superformance has intended to cause, has caused and is likely to continue to cause dilution of the distinctive quality of The Marks in violation of 15 U.S.C. § 1125(c).

37. Superformance's aforesaid acts are likely to tarnish or injure Shelby's business reputation.

38. Superformance willfully intended to trade upon Shelby's reputation.

39. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill, and will sustain loss of revenues and profits.

40. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

COUNT IV
TRADEMARK DILUTION UNDER MASSACHUSETTS LAW

41. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

42. As a result of its unauthorized use of The Marks in connection with its infringing automotive products, as well as its web site, Superformance has caused and is likely to continue to cause dilution of the distinctive quality of The Marks in violation of G.L. c. 110B § 12.

43. Superformance's aforesaid acts are likely to injure Shelby's business reputation.

44. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill and will sustain loss of revenues and profits.

45. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

COUNT V
UNFAIR COMPETITION

46. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

47. As a result of its unauthorized use of The Marks in connection with its infringing automotive products, as well as its web site, Superformance has intended to cause, has caused and is likely to continue to cause confusion or to cause mistake or to deceive the public.

48. As a result of its unauthorized use of The Marks in connection with its infringing automotive products, as well as its web site, Superformance has caused and is likely to continue to cause dilution of the distinctive quality of The Marks in violation of 15 U.S.C. § 1125(c).

49. Superformance has knowingly offered its infringing automotive products in commerce with apparent knowledge of the falsity and misleading effect of such designations, in violation of the common law of unfair competition of the Commonwealth of Massachusetts and the Lanham Act, 15 U.S.C. § 1051 *et seq.*

50. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill, and will sustain loss of revenues and profits.

51. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

COUNT VI
UNFAIR COMPETITION IN VIOLATION OF
MASSACHUSETTS UNFAIR BUSINESS PRACTICES ACT

52. Shelby repeats and realleges each and every allegation of paragraphs 1-23 as though fully set forth herein.

53. Both Shelby and Superformance engage in trade and commerce, and the actions and transactions constituting the unfair methods of competition by Superformance occurred primarily and substantially within the Commonwealth of Massachusetts, since Superformance actively does business in the Commonwealth of Massachusetts. As a result of its unauthorized use of The Marks

in connection with its infringing automotive products, as well as its web site, Superformance has caused and is likely to continue to cause confusion or to cause mistake or to deceive the public.

54. Superformance is likely to mislead prospective purchasers, distributors and retailers as to the affiliation, connection, or association of Superformance, its infringing automotive products, or its web site with Shelby or Shelby's automotive goods, or as to the origin, sponsorship, or approval of Superformance's infringing automotive products its web site by Shelby, intending to cause purchasers to rely thereon.

55. Superformance has knowingly offered its infringing automotive products in commerce with apparent knowledge of the falsity and misleading effect of such designations.

56. The use of The Marks in Superformance's advertising and promotional materials is designed to profit both from the strong recognition The Marks have developed and from association of The Marks with Shelby. Superformance's conduct will cause potential customers and consumers to believe that Shelby either authorized or approved Superformance's use of The Marks, when in fact no such authorization or approval exists.

57. Superformance in its advertising and promotional materials has taken no appropriate action to distinguish Superformance or its products from Shelby and The Marks, thus further reinforcing the belief that Shelby either authorizes or approves Superformance's use of The Marks and the manufacture of its replica vehicles, when in fact no such authorization or approval exists. In advertising and promoting its vehicles as "replicas" of Shelby vehicles, Superformance improperly suggests to its customers and potential customers that the vehicles produced by Superformance are equivalent to the vehicles produced by Shelby, when in fact they are not.

58. The conduct of Superformance as alleged in this Count VI is in violation of the Massachusetts Unfair Business Practices Act, G.L. c. 93A §§ 2, 11.

59. By reason of Superformance's acts, Shelby has suffered and will continue to suffer damage and injury to its business, reputation and goodwill, and will sustain loss of revenues and profits.

60. Unless enjoined by this court, Superformance will continue to perform the acts complained of here and cause said damages and injury, all to the immediate and irreparable harm of Shelby. Shelby has no adequate remedy at law for Superformance's wrongful acts.

WHEREFORE, Shelby asks for judgment:

1. Permanently enjoining and restraining Superformance, its officers, agents, employees, dealers, attorneys, representatives, and all others acting in concert and participation with any of them from:

a.) using the mark COBRA, stylized COBRA Snake designs, or the mark, SHELBY, or any domain names containing The Marks, or any other colorable imitation of The Marks, or any other mark that is confusingly similar to The Marks;

b). doing any other act or thing likely to induce the belief that Superformance's business or products are in any way connected with Shelby's businesses, products or services or are sponsored or approved by Shelby;

c.) doing any other act or thing likely to dilute the distinctive quality of Shelby's COBRA trademarks, its stylized COBRA Snake Design trademark or its Shelby trademarks; and

d.) doing any other act or thing likely to tarnish or injure Shelby's business reputation.

2. Directing Superformance to:

a.) halt any orders for any parts or accessories for kits sold under or in connection with The Marks, or any other motor vehicles or automotive parts or accessories sold under or in connection with The Marks;

b.) withdraw or recall from any and all channels of distribution products and advertising materials distributed by it or anyone acting in concert or participation with it bearing any description or representation in violation of the Lanham Act, 15 U.S.C. § 1051 *et seq.*;

c.) deliver up to Shelby for destruction all infringing goods, labels, signs, prints, packages, wrappers, receptacles, photographs, advertisements and other printed material in its possession or control bearing The Marks, or any reproduction, counterfeit, copy or colorable imitation of The Marks, as well as all plates, models, matrices, masters, tapes, film negatives and other means of making such unauthorized reproductions, counterfeits, copies or colorable imitations of The Marks, in accordance with 15 U.S.C. § 1118;

d.) remove all references to The Marks from the World Wide Web site under the domain name Superformance.com;

e.) pay to Shelby all damages Shelby has suffered as a result of the acts of Superformance complained of here, together with prejudgment interest, and a sum equal to three times the damages in accordance with 15 U.S.C. § 1117, G.L. c. 93A,

Of counsel

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December 19, 2000

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