

ESTTA Tracking number: **ESTTA647343**

Filing date: **12/29/2014**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	FORD MOTOR COMPANY
Granted to Date of previous extension	12/28/2014
Address	ONE AMERICAN ROAD DEARBORN, MI 48126 UNITED STATES
Attorney information	Elizabeth F. Janda and Hope V. Shovein BROOKS KUSHMAN P.C. 1000 Town Center, 22nd Floor Southfield, MI 48075 UNITED STATES smgibbons@brookskushman.com, ejanda@brookskushman.com, hshovein@brookskushman.com Phone:248-358-4400

Applicant Information

Application No	85860662	Publication date	07/01/2014
Opposition Filing Date	12/29/2014	Opposition Period Ends	12/28/2014
Applicant	The Trustees of the CARROLL HALL SHELBYTRUST, the trustees comprising M. Neil Cummings and Joe Conway, both U.S. citizens SUITE 1050 LOS ANGELES, CA 900641817 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. First Use: 1965/01/01 First Use In Commerce: 1965/01/01 All goods and services in the class are opposed, namely: Land vehicles, namely, automobiles

Applicant Information

Application No	85860715	Publication date	07/01/2014
Opposition Filing Date	12/29/2014	Opposition Period Ends	
Applicant	The Trustees of the CARROLL HALL SHELBYTRUST, the trustees comprising M. Neil Cummings and Joe Conway, both U.S. citizens SUITE 1050 LOS ANGELES, CA 900641817 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. First Use: 1967/01/01 First Use In Commerce: 1967/01/01
 All goods and services in the class are opposed, namely: Land vehicles, namely, automobiles

Applicant Information

Application No	85860799	Publication date	07/01/2014
Opposition Filing Date	12/29/2014	Opposition Period Ends	
Applicant	The Trustees of the CARROLL HALL SHELBYTRUST, the trustees comprising M. Neil Cummings and Joe Conway, both U.S. citizens SUITE 1050 LOS ANGELES, CA 900641817 UNITED STATES		

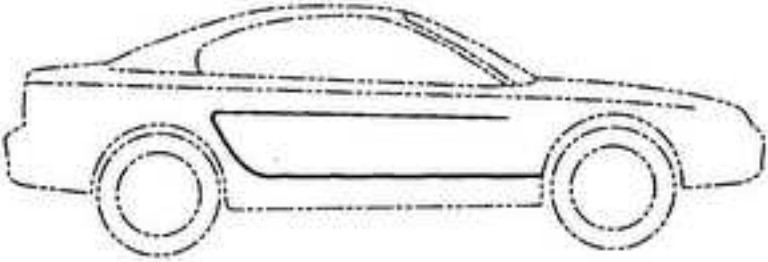
Goods/Services Affected by Opposition

Class 012. First Use: 1967/08/01 First Use In Commerce: 1967/08/01
 All goods and services in the class are opposed, namely: Land vehicles, namely, automobiles


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3052331	Application Date	06/21/2004
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of the configuration of a C-scoop on the side of an automotive vehicle.		
Goods/Services	Class 012. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 Motor vehicles, namely, automobiles and structural parts therefor		

U.S. Registration No.	3052330	Application Date	06/21/2004
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of the configuration of the roof line on an automotive vehicle.
Goods/Services	Class 012. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 Motor vehicles, namely, automobiles and structural parts therefor

Attachments	76598674#TMSN.png(bytes) 76598673#TMSN.png(bytes) Not of Opp Shelby 12-29-14.pdf(324222 bytes)
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Certificate of Service

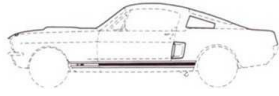
The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/hope v shovein/
Name	Elizabeth F. Janda and Hope V. Shovein
Date	12/29/2014

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

In re Trademark Application Serial No. 85860662

Filed: February 26, 2013

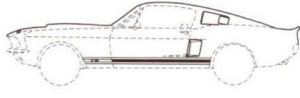
Trademark:  GT 350 & DESIGN

Class: 12

Published for Opposition on July 1, 2014

In re Trademark Application Serial No. 85860715

Filed: February 26, 2013

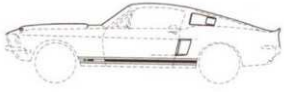
Trademark:  GT 500 & DESIGN

Class: 12

Published for Opposition on July 1, 2014

In re Trademark Application Serial No. 85860799

Filed: February 26, 2013

Trademark:  GT 500 & DESIGN

Class: 12

Published for Opposition on July 1, 2014

FORD MOTOR COMPANY)

Opposer,)

v.)

Opposition No. _____

THE TRUSTEES OF THE)

CARROLL HALL SHELBY TRUST,)

THE TRUSTEES COMPRISING)

NEIL CUMMINGS AND JOE CONWAY)

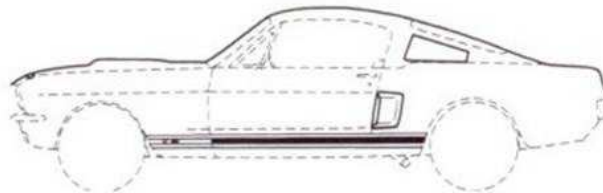
Applicant.)

NOTICE OF OPPOSITION

FORD MOTOR COMPANY ("FORD"), a Delaware corporation with a place of business at One American Road, Dearborn, Michigan 48126, believes that it is and will continue to be damaged by the Applicant's registration of the design elements claimed in the above referenced GT 350 & DESIGN and two GT 500 & DESIGN marks for goods in Class 12, as set forth in Applications Serial No. 85860662, 85860715, and 85860799 (hereinafter referred to as the "CONFIGURATION MARKS"), and hereby opposes such registrations of these design marks.

As grounds for opposition, the Opposer alleges as follows:

1. Applicant, THE TRUSTEES OF THE CARROLL HALL SHELBY TRUST, THE TRUSTEES COMPRISING NEIL CUMMINGS AND JOE CONWAY (hereinafter "SHELBY TRUST"), is seeking to register the trademark GT 350 & DESIGN for "land vehicles, namely, automobiles" in Class 12, as set forth below:

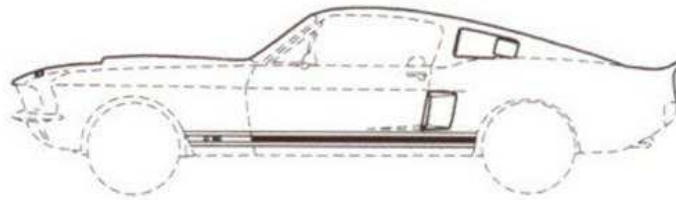


The mark is described as follows:

Color is not claimed as a feature of the mark. The mark consists of the roof line of an automobile and a solid stripe extending from the front edge of the door to the rear wheel well with a double outline above and below the stripe and the alphanumeric "GT 350" between the rear edge of the front wheel well and front edge of the door with a double outline above and below, a representation of an air scoop on the rear portion of the vehicle above the stripe and a trapezoid rear side window cover. The outline of the automobile does not form a part of the mark and is shown in dashed lines only to indicate placement of the mark on the goods.

This application is evidenced by its publication in the *Official Gazette* on July 1, 2014. This Application Serial No. 85860662 was filed on February 26, 2013, based upon a claim of first use as of January 1, 1965.

2. Applicant is seeking to register the trademark GT 500 & DESIGN for “land vehicles, namely, automobiles” in Class 12, as set forth below:

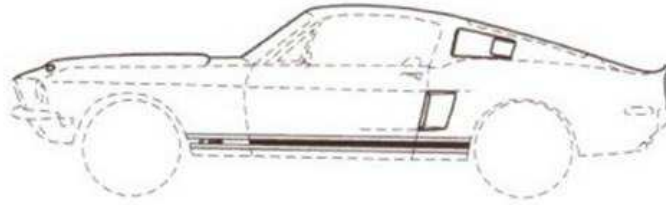


The mark is described as follows:

Color is not claimed as a feature of the mark. The mark consists of the roof line of an automobile and a solid stripe extending from the front edge of the door to the rear wheel well with a double outline above and below the stripe and the alphanumeric "GT 500" between the rear edge of the front wheel well and front edge of the door with a double outline above and below, a representation of an air scoop on the rear portion of the vehicle above the stripe and a double trapezoid rear side window cover. The outline of the automobile does not form a part of the mark and is shown in dashed lines only to indicate placement of the mark on the goods.

This application is evidenced by its publication in the *Official Gazette* on July 1, 2014. This Application Serial No. 85860715 was filed on February 26, 2013, based upon a claim of first use as of January 1, 1965.

3. Applicant is seeking to register the trademark GT 500 & DESIGN for “land vehicles, namely, automobiles” in Class 12, as set forth below:



The mark is described as follows:

Color is not claimed as a feature of the mark. The mark consists of the roof line of an automobile and a solid stripe extending from the front edge of the door to the rear wheel well with a double outline above and below the stripe and the alphanumeric "GT 500" between the rear edge of the front wheel well and front edge of the door with a double outline above and below, a representation of an air scoop on the rear portion of the vehicle above the stripe and a double trapezoid rear side window cover. The outline of the automobile does not form a part of the mark and is shown in dashed lines only to indicate placement of the mark on the goods.

This application is evidenced by its publication in the *Official Gazette* on July 1, 2014. This Application Serial No. 85860799 was filed on February 26, 2013, based upon a claim of first use as of January 1, 1965.

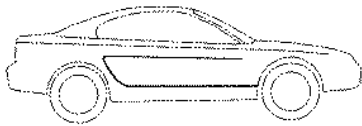
4. Opposer, FORD, designs, develops, manufactures, services, repairs, and sells motor vehicles and parts therefor and related products and services, including accessories, merchandise and activities related to its vehicles.

5. Opposer, FORD, has for many years designed, developed, manufactured, serviced, repaired, and sold automobiles and parts therefor and additional products and services under the famous MUSTANG mark. FORD has sold its distinctive MUSTANG vehicles since at least as early as April 17, 1964. Opposer has sold billions of dollars worth of MUSTANG automobiles over the past 50 years.

6. Opposer and Applicant have worked together on many projects over the years. Specifically, the vehicles branded with the Applicant's word marks GT-500 and GT-350 are

derivatives of FORD's MUSTANG vehicles, and also bear Opposer's marks. These vehicles are sold through Opposer's dealers. The parties have entered into many agreements, but none related to the specific design elements of the subject CONFIGURATION MARKS, or the parties' respective ownership thereof.

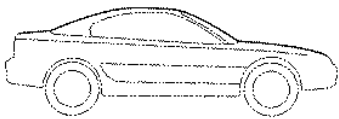
5. Opposer is the owner of U.S. Trademark Registration No. 3052331 for the



mark

which is described as follows: "The mark consists of the configuration of a C-scoop on the side of an automotive vehicle. The stippling shown indicates placement of the mark and is not claimed as part of the mark." This application was filed on June 21, 2004, based upon first use as of 1964, and the registration issued January 31, 2006. This mark is incontestable, valid and subsisting, uncancelled and unrevoked.

6. Opposer is the owner of U.S. Trademark Registration No. 3052330 for the



mark

which is described as follows: "The mark consists of the configuration of the roof line on an automotive vehicle. The stippling shown indicates placement of the mark and is not claimed as part of the mark." This application was filed on June 21, 2004, based upon first use as of 1964, and the registration issued January 31, 2006. This mark is incontestable, valid and subsisting, uncancelled and unrevoked.

7. Since Applicant's claimed CONFIGURATION MARKS are based upon vehicles derived from Opposer's vehicles, covered in part by FORD's registrations, Applicant is not

entitled to obtain exclusive rights against Opposer to the entirety of the claimed elements in the subject applications.

8. There is no issue as to priority. The Applicant's claimed marks are based upon vehicles derived from Opposer's vehicles.

9. The CONFIGURATION MARKS for which the Applicant seeks registration are used on goods sold by both Applicant and Opposer.

10. Since the mark and goods as described in the application are identical to or substantially identical to the Opposer's mark and goods, confusion as to the origin of the Applicant's and Opposer's goods bearing the mark would occur, all to the damage and detriment of the Opposer. Such use would cause confusion in the trade resulting in damage and injury to the Opposer.

11. The Applicant's use or registration of the design elements claimed in the CONFIGURATION MARKS in connection with its designated goods is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of the Applicant with the Opposer, or as to the origin, sponsorship or approval of the Applicant's goods by the Opposer under Section 2(d) of the Lanham Act, 15 USC 1052(d), and to any exclusive claim thereof. Opposer does not object to Applicant's claim of ownership of the GT-350 or GT-500 word portions of the subject applications.

12. If the Applicant were granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use of the design elements claimed in the CONFIGURATION MARKS in connection with its goods. Such registration would be a source of injury and damage to the Opposer.

WHEREFORE, the Opposer, FORD MOTOR COMPANY, prays that Applications Serial No. 85860662, 85860716, and 85860799, for the CONFIGURATION MARKS be rejected, denied and refused.

Respectfully submitted,

By /elizabeth f janda/
Elizabeth F. Janda
Hope V. Shovein
Attorneys/Agents for Opposer

Date: December 29, 2014
(Filed electronically via USPTO.ETTA)

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email: ejanda@brookskushman.com,
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Our File: FMCTA29458OC

CERTIFICATE OF SERVICE

I certify that I served:

NOTICE OF OPPOSITION

on December 29, 2014 by:

 delivering

 X mailing (via first-class mail) and via email

a copy to:

THE TRUSTEES OF THE CARROLL HALL SHELBY TRUST,
THE TRUSTEES COMPRISING NEIL CUMMINGS AND JOE CONWAY
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mneil@mncalaw.org

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