

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

UNIQUE MOTORCARS,

OPPOSER,

VS.

OPPOSITION NUMBER:92041950

CARROLL HALL SHELBY TRUST,
a Texas Revocable Trust, the Trustees
comprising of Carroll Hall Shelby,

APPLICANT.

SUBMISSION OF THE ORDER OF THE UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

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

Dear Sir:

Submitted herewith is the Appellate Decision of the United States Court of Appeals, dated January 18, 2006, which dismisses the appeal of Carroll Shelby, et al. and leaves intact the partial Summary Judgment entered by the United States District Court for the District of Massachusetts (Carroll Shelby, et al. v. Superformance International, Inc., Case No. DIV-A.00-12581). I have also attached hereto, for your convenience, a copy of the decision of the District Court for the District of Massachusetts.

The judgment of the United States Court of Appeals is believed to be final, as the time for appeal has lapsed and no notice of appeal has been received.

Therefore, Opposer requests that the proceedings be restored to the active docket, or that a decision will be entered in accordance with the findings of the United States District Court for the District of Massachusetts, as may be appropriate.

Respectfully submitted,

Dated: March 1, 2006

W. WHEELER SMITH, P. C.

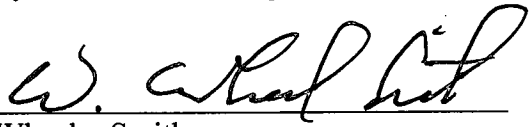
By: 

W. Wheeler Smith,
Attorney for Opposer
3500 Independence Drive
Birmingham, AL 35209
205/879-9595



CERTIFICATE OF MAILING

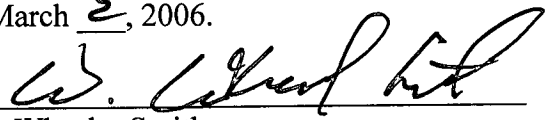
I hereby certify that I mailed a copy of this **Submission of the Order of the United States Court of Appeals for the First Circuit** by United States Postal Service, by express mail, with correct postage paid, in an envelope addressed to the Assistant Commissioner for Patent and Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Avenue, Arlington, VA 22202-3513 on the 2 day of March, 2006.



W. Wheeler Smith

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **Submission of the Order of the United States Court of Appeals for the First Circuit** upon Edward A. Sokoloski, Attorney for Applicant, 3868 Carson Street, Suite 105, Torrance, CA 90053 by depositing one copy thereof in the United States Mail, first-class postage prepaid, on March 2, 2006.



W. Wheeler Smith

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**United States Court of Appeals
For the First Circuit**

No. 05-1307

CARROLL SHELBY ET AL.,

Plaintiffs, Appellants,

v.

SUPERFORMANCE INTERNATIONAL, INC.,

Defendant, Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF MASSACHUSETTS

[Hon. Rya W. Zobel, U.S. District Judge]

1/18/2006

Before

Selya, Lipez and Howard, Circuit Judges.

R. David Hosp, with whom R. Todd Cronan, Mark S. Puzella, and Goodwin Procter LLP were on brief, for appellants.

Steven E. Snow, with whom Randall T. Weeks, Jr., Robert K. Taylor, and Partridge Snow & Hahn LLP were on brief, for Shell Valley Companies, Inc., International Automobile Enterprises, Inc., B & B Manufacturing, Inc., Backdraft Racing, Inc., and Unique Motorcars, L.L.C., amici curiae.

January 18, 2006

SELYA, Circuit Judge. The appellants, Carroll Shelby, Shelby American, Inc., and Carroll Shelby Licensing, Inc. (collectively, Shelby), cloak this appeal in the raiment of trade-dress law. That masquerade ignores the central question of mootness (an issue that Shelby attempted to obscure in its appellate filings). For the reasons that follow, we conclude that Shelby's appeal must be dismissed and that vacation of the decision below is unwarranted.

The predicate facts are straightforward. In the 1960s, Shelby manufactured and sold the Shelby Cobra 427 S/C. After the

initial commercial production of the automobile had run its course, a Cobra replica industry emerged. Defendant-appellee Superformance International, Inc. is a player in that industry. It markets, imports, and sells the Superformance 427 S/C - a rolling chassis identical in design to the Shelby Cobra 427 S/C. Superformance uses the same mark (427 S/C) and emblem badges (Cobra) on its replicas as Shelby used on the originals.

In late 2000, Shelby commenced a civil action against Superformance in the United States District Court for the District of Massachusetts. Its complaint contained a host of trademark- and trade-dress-based claims premised on theories of infringement, counterfeiting, dilution, unfair competition, and the like. Superformance answered the complaint and filed counterclaims. After a great deal of skirmishing, not relevant here, the district court granted Superformance's motion for partial summary judgment on Shelby's trade-dress claims (comprising parts of five of the seven counts contained in Shelby's amended complaint). Carroll Shelby Licensing, Inc. v. Superformance Int'l, Inc., 251 F. Supp. 2d 983, 988 (D. Mass. 2002).

The court's decision focused on the issue of secondary meaning - a showing necessary to Shelby's success on the trade-dress-related claims. See id. at 986. Although Shelby submitted survey evidence of secondary meaning, the district court deemed that

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