

ESTTA Tracking number: **ESTTA343023**

Filing date: **04/19/2010**

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

Proceeding	91192093
Party	Plaintiff Pirelli Tyre S.p.A.
Correspondence Address	Virginia L. Carron Finnegan 901 New York Avenue NW Washington, DC 20001-4413 UNITED STATES virginia.carron@finnegan.com
Submission	Motion to Consolidate
Filer's Name	Virginia L. Carron
Filer's e-mail	virginia.carron@finnegan.com
Signature	/Virginia L. Carron/
Date	04/19/2010
Attachments	Pirelli's Motion to Consolidate ZERO MX w others.pdf ( 5 pages )(15093 bytes )

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

PIRELLI TYRE S.P.A.  v.  ZERO MOTORCYCLES, INC.,  PIRELLI TYRE S.P.A. AND PIRELLI & C. S.P.A.,  v. ZERO MOTORCYCLES, INC.,	Consolidated Opposition No. 91192093    Opposition No. 91192475 Cancellation No. 92051520 Cancellation No. 92051859
PIRELLI TYRE S.P.A. AND PIRELLI & C. S.P.A., v. ZERO MOTORCYCLES, INC.,	Opposition No. 91194280

**PIRELLI'S MOTION TO CONSOLIDATE**

Opposers/Petitioners Pirelli Tyre S.p.A. and Pirelli & C. S.p.A (collectively "Pirelli"), through their undersigned counsel, hereby move to consolidate Opposition No. 91194280 with the consolidated proceedings for Opposition Nos. 91192093 and 91192475 and Cancellation Nos. 92051520 and 92051859.

Fed. R. Civ. P. 42(a), as made applicable by Trademark Rule 2.116(a), provides that when actions involving a common question of law and fact are pending before the Board, it may order all the actions consolidated. In determining whether to consolidate cases, the Board weighs the savings in time, effort, and expense that may be gained from consolidation against any prejudice or inconvenience that may be caused by consolidation. TBMP § 511 and cases cited therein.

Opposition No. 91192093 started out as a consolidated opposition involving application Serial No. 77616233 for ZERO X, Serial No. 77665628 for ZERO SS, and Serial No. 77665629 for ZERO S, all owned by Applicant Zero Motorcycles, Inc. Each of the applications includes the goods “electric motorcycles; motorcycles and structural parts therefor”, and Application Serial No. 77616233 for ZERO X also includes “motorcycles for motocross.” Opposition No. 91192475 involves application Serial No. 77793886 for ZERO DS ,also owned by Applicant Zero Motorcycles, Inc. Like the ZERO X application, it is for “electric motorcycles; motorcycles and structural parts therefor; motorcycles for motocross.” Cancellation No. 92051520 involves Registration No. 3661976 for the ZERO, also owned by Zero Motorcycles, Inc. The goods of the registration are essentially identical to those of the applications subject to both Oppositions. They are “electric vehicles, namely motorcycles.” The Opposers and Petitioner in all of the above cases are the same, namely Pirelli Tyre S.p.A. and Pirelli & C., S.p.A. is an opposer and Petitioner in all but the original Consolidated Opposition No. 91192093

On December 22, 2009, the Board granted the parties' Joint Motion to Consolidate Opposition No. 91192093, Opposition No. 9192475 and Cancellation No. 92051520, finding that all three proceeding “involve the same parties and common questions of law and fact.” So these proceedings are now consolidated into one and maintained as Opposition No. 9192093.

Thereafter, on January 19, 2010, the parties filed another joint motion to consolidate Cancellation No. 92051859 with the other three consolidated proceedings. Cancellation No. 92051859 involves Registration No. 3669900 for the mark ZERO

MOTORCYCLES, also owned by Zero Motorcycles, Inc. The goods of that registration are essentially identical to those of the other applications and registrations and are “electric vehicles, namely, motorcycles; Motorcycles.”

On January 25, 2010, the Board granted the parties' Joint Motion to Consolidate Cancellation No. 92051859 with Opposition No. 91192093, Opposition No. 9192475 and Cancellation No. 92051520. All four of these proceedings are now consolidated into one and maintained as Opposition No. 9192093.

As with each of the four proceedings that have been consolidated in Opposition No. 91192093, Pirelli has alleged as the grounds for cancellation in this proceeding, Opposition No. 91194280, likelihood of confusion based on Pirelli's registered and common law rights in its ZERO marks, including but not limited to Reg. Nos. 2749340, 1625883, 2847159, 2783614, 3038910, and 2337503 for their ZERO formative marks.

Consolidation is appropriate because the consolidated oppositions and cancellations and this opposition involve the common factual and legal issues. Although Applicant has not yet filed an Answer in this proceeding, Applicant presumably will shortly do so and likely will include identical affirmative defenses and allegations as those plead in the consolidated proceedings. Further, all of the proceedings are still in the very early stages. Under the circumstances, further consolidation of the oppositions and cancellation, and this cancellation, will reduce the number of filings before the Board, and assist both the Board and the parties in maintaining all of the cases on the same schedule.

In addition, given the similarity of the marks at issue, the similar grounds for opposition, much of the discovery and evidence at trial will likely be the same in all of

the cases, in the event that a settlement is not reached. If proceedings move forward, the parties are likely to present the same arguments and evidence in all proceedings. Absent consolidation, both parties will be compelled to conduct piecemeal discovery and prosecution of the three separate proceedings. Accordingly, consolidation of these cases will result in a significant savings of time and resources for both the parties and the Board.

Accordingly, Pirelli respectfully requests that the Board grant their Motion to Consolidate Opposition No. 91192073 and Opposition No. 91194280. Further, Pirelli respectfully requests that the Board reset the dates for the newly consolidated proceedings.

These requests are made in good faith and are not for the purpose of mere delay.

Respectfully submitted,

Dated: April 19, 2010

By: /s/Virginia L. Carron  
Virginia L. Carron  
Laurence R. Hefter  
Finnegan  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413  
Virginia.carron@finnegan.com  
(404) 653-6452  
Attorneys for Opposers

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing PIRELLI'S MOTION TO CONSOLIDATE was served by agreement, by email transmission this 19th day of April 2010, upon counsel for Applicant:

Mike Rodenbaugh  
Rodenbaugh Law  
548 Market Street  
San Francisco, CA 94104  
mike@rodenbaugh.com

/s/Virginia L. Carron