

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Mailed: June 21, 2010**

**Opposition No. 91192093**

PIRELLI TYRE S.P.A.

v.

ZERO MOTORCYCLES, INC.

**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 TYRE S.P.A. and PIRELLI &  
C. S.P.A.

v.

ZERO MOTORCYCLES, INC.

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

The first four proceedings listed above were consolidated by the Board in orders dated December 22, 2009 and January 25, 2010. On April 19, 2010, opposers moved to add Opposition No. 91194280 to the consolidated proceeding. Although applicant indicated it "generally consents" to the motion, applicant expressed its

Opposition Nos. 91192093; 91192475; 91194280; Cancellation Nos. 92051520; 92051859

opinion that consolidation may not be necessary at this time in view of its pending motion to suspend for civil litigation (addressed later in this order).

The Board agrees that joining Opposition No. 91194280 to the existing consolidated proceeding is appropriate for docketing purposes and judicial economy. In addition, the cases appear to present common questions of law and fact. See Fed. R. Civ. P. 42(a); and TBMP §511 (2d ed. rev 2004).

Accordingly, Opposition No. 91194280 is hereby joined to the consolidated proceeding having Opposition No. 91179281 as the "parent" case. The consolidated cases may be presented on the same records and briefs. As the parties are aware, the record will be maintained in Opposition No. **91179281** as the "parent" case, but all papers filed in these cases should include each proceeding number in ascending order.

Applicant has not yet filed its answer in Opposition No. 91194280. In view of the suspension occasioned herein, addressed below, the time for applicant to file an answer will be reset in the event proceedings are resumed.<sup>1</sup>

These consolidated proceedings also come up on applicant's fully briefed motion, filed April 20, 2010, to suspend

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<sup>1</sup> In an exception to the practice allowing a party to file all papers in the "parent" case in a consolidated proceeding, the answer is to be filed in the case for which it will be operative (Opposition No. 91194280).

proceedings pending final disposition of a civil action between the parties.<sup>2</sup>

In support of its motion, applicant states it filed a lawsuit against opposers in federal district court seeking a declaratory judgment that no trademark infringement and no unfair competition exists. Applicant also asks the court to order cancellation of Pirelli's Registration No. 2749340 for the mark ZERO<sup>3</sup> and to enjoin Pirelli from further interfering with applicant's trademark applications and registrations. Applicant argues that the federal court action and the Board proceedings have core issues in common, that a determination in the federal court will have a bearing on the Board proceedings, and that suspension of the Board proceedings will avoid duplicative and costly litigation.

In response, opposers argue that they are foreign entities not subject to jurisdiction in California and it is unlikely applicant's case in district court will go forward; and that applicant has not yet served opposers with the district court action. With respect to the latter, opposers note that applicant may serve them through the Hague Service Convention, but opposers will continue to contest jurisdiction, and the Board cases may take years to resolve instead of being resolved on schedule next

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<sup>2</sup> *Zero Motorcycles, Inc. v. Pirelli Tyre S.p.A. and Pirelli & C. S.p.A.*, Case No. CV 10-01290 LB in the United States District Court for the Northern District of California.

<sup>3</sup> Such registration is the subject matter of a counterclaim in Cancellation No. 92051859.

year. Opposers express their belief that applicant's motion was brought for purposes of delay and to avoid serving their discovery responses; and that applicant is forum shopping. Thus, opposers argue, applicant has not shown good cause for the requested suspension and the Board proceedings should continue to move forward.

In reply, applicant argues it has shown good cause for the requested suspension. Applicant states tht it served opposers in the civil action in accordance with the Hague Convention and the district court action remains pending. Applicant notes that any decision made by the Board is subject to review in the district court notwithstanding either party's domicile; and that the district court where the civil action resides recently exercised personal jurisdiction over a foreign trademark licensor in view of the licensor's trademark application. Applicant states the motion to suspend was not brought for purposes of delay.

Whenever it comes to the attention of the Board that a party (or parties) to a case pending before it is involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. To the extent that a case in Federal district court involves issues in common with those in the proceeding before the Board, the decision of the court is often binding on the Board, while the decision of the Board is not binding upon the court. See TBMP §510.02 (2d ed. rev. 2004). It is not

necessary that the claims or issues be identical, only that the determination of issues presented to the court may have a bearing on the issues presented to the Board. Moreover, judicial economy lies in the suspension of the Board proceeding because the Board has limited jurisdiction, involving the issue of registrability only, and any decision of the Board is appealable to U.S. District Court, including the court in which the parties are involved in a civil suit. See Trademark Act Section 21.

The Board has reviewed the pleadings submitted from the district court action and determined that adjudication therein may have a bearing on at least some of the issues presented herein. It is up to the district court to determine whether it has personal jurisdiction over opposers and to address any issues with respect to service.

Accordingly, applicant's motion to suspend proceedings is granted, and proceedings are suspended pending final disposition of the civil action between the parties. Trademark Rule 2.117(c).

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

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