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

Proceeding	91192093
Party	Defendant Zero Motorcycles, Inc.
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Date	07/22/2011
Attachments	ZERO - REPLY TO TTAB re POTENTIAL APPEAL OF CIVIL ACTION.txt (3 pages)(4977 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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PIRELLI TYRE S.P.A. and PIRELLI & C. S.P.A.,
)

Opposers,
)

)
Consolidated Proceeding No. 91192093

)
v.
)
Mark: ZERO X

)
Serial No. 77616233

ZERO MOTORCYCLES, INC.,
)
Filed: November 17, 2008

Applicant.

)
Published: June 2, 2009
Mark: ZERO SS
Serial No. 77665628
Filed: February 6, 2009
Published: June 2, 2009
Mark: ZERO S
Serial No. 77665629

Filed: February 6, 2009
Published: June 2, 2009
Mark: ZERO DS
Serial No. 77793886
Filed: July 30, 2009
Published: October 27, 2009
Mark: ZERO MOTORCYCLES
Registration No. 3669900
Filed: May 27, 2007
Registered: August 18, 2009
Mark: ZERO

Registration No. 3661976
Filed: April 19, 2007
Registered: July 28, 2009
Opposition No. 91194280
Mark: ZERO MX
Serial No. 77757810
Filed: June 11, 2009
Published: March 16, 2010

RESPONSE TO TTAB REQUEST FOR STATUS OF CIVIL ACTION

Applicant Zero Motorcycles, Inc. hereby replies to the TTAB Attorney's request dated June 22, 2011, for a report regarding the status of the civil matter between Applicant and Opposers, filed by Applicant in the Northern District of California and styled Zero Motorcycles, Inc. v. Pirelli Tyre, S.p.A., Case No. C 10-01290 SBA.

As reported by Opposers on July 20, 2011, this case has been dismissed by the District Court, for lack of personal jurisdiction over the Opposers, via Order dated July 15, 2011.

However, Applicant is currently considering whether to appeal that ruling to the Ninth Circuit Court of Appeal, and has until August 14, 2011, to file a Notice of Appeal. Moreover, the District Court specifically held that the District Court in Washington, D.C. would have personal jurisdiction over the Opposers in this matter because they have voluntarily consented to the jurisdiction of that court. (Order, pg. 22, citing 15 U.S.C. ? 1071(b)(4) and Opposers' admission in their Reply brief.)

It is clear under the TBMP that when parties to a pending TTAB action are 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. TBMP ? 510.02(a) (emphasis added).

See also 37 CFR ? 2.117 (a) (?Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action . . .?) (emphasis added).

A proceeding is considered to have been finally determined when a decision on the merits of the case . . . has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. TBMP ? 510.02 (b) (emphasis added). See, e.g., *Softbelly's, Inc. v. Ty, Inc.*, 2002 WL 1844210, *2-3 (TTAB 2002) (finding suspension appropriate because civil action had not been finally determined, even after a final judgment had been entered by a district court, and time to appeal had not elapsed); *George Vais v. Vais Arms, Inc.*, 2004 WL 390936, *1 (TTAB 2004) (granting suspension pending a final disposition in an action filed in the Western District of Texas, including any appeals taken from the decision of the District Court?).

Applicant has not yet decided whether to appeal the District Court ruling, and has until August 14 to do so. Applicant instead may refile the case in the District Court in Washington, D.C. Or, Applicant may elect to move forward before the TTAB. This decision will be made by Applicant shortly. Meanwhile, it is premature to lift the suspension of these proceedings until at least August 15, 2011. Therefore, Applicant respectfully requests that the Board maintain the

suspension of these proceedings until at least August 15, 2011.

Dated: July 22, 2011

Respectfully submitted,

By: /s/ Mike Rodenbaugh

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing RESPONSE TO TTAB REQUEST FOR STATUS OF CIVIL ACTION has been served on Virginia L. Carron, counsel for opposing party, by delivering a copy via email to her usual place of business, per prior agreement with her, at:

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Respectfully submitted,
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