

ESTTA Tracking number: **ESTTA327521**

Filing date: **01/19/2010**

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	01/19/2010
Attachments	FINAL Joint Motion to Consolidate ZERO MOTORCYCLES w others.pdf ( 6 pages )(16057 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
PIRELLI TYRE S.P.A. AND PIRELLI & C. S.P.A.,  v.  ZERO MOTORCYCLES, INC., Registrant.	Cancellation No. 92051859  Registration No. 3669900 Mark: ZERO MOTORCYCLES Issue Date: August 18, 2009

**JOINT MOTION TO CONSOLIDATE**

Opposers and Petitioners Pirelli Tyre S.p.A. and Pirelli & C. S.p.A (collectively “Pirelli”) and Applicant/Registrant Zero Motorcycles, Inc. (“Registrant”), through their undersigned counsel, hereby jointly move to consolidate Cancellation No. 92051859 with the consolidated proceedings for Opposition Nos. 91192093 and 91192475 and Cancellation No. 92051520.

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 and 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.”

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.

As with each of the three proceedings that have been consolidated in Opposition No. 91192093, Pirelli has alleged as the grounds for cancellation in this proceeding, Cancellation No. 92051859, likelihood of confusion based on Pirelli’s registered and

common law rights in their 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 opposition/cancellations and this cancellation involve the common factual and legal issues. Although Registrant has not yet filed an Answer in this proceeding, Registrant will shortly do so and 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 and Registrant respectfully and jointly request that the Board grant their Joint Motion to Consolidate Opposition Nos. 91192073 and Cancellation No. 92051859. Further, Pirelli and Registrant respectfully request that the Board reset the dates for the newly consolidated proceedings as indicated below, which are the deadlines currently set in the consolidated proceeding under Opposition No. 91192093:

Deadline for Discovery Conference	January 10, 2010
Discovery Opens	January 10, 2010
Initial Disclosures Due	February 9, 2010
Expert Disclosures Due	June 9, 2010
Discovery Closes	July 9, 2010
Plaintiff's Pretrial Disclosures	August 23, 2010
30-day testimony period for Plaintiff's testimony to close	October 7, 2010
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	October 22, 2010
30-day testimony period for Defendant and Plaintiff in the counterclaim to close	December 6, 2010
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	December 21, 2010
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	February 4, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	February 19, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	May 21, 2011
Brief for plaintiff due	June 20, 2011
Brief for defendant and plaintiff in the counterclaim due	July 19, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	August 19, 2011
Reply brief, if any, for plaintiff in the counterclaim due	September 3, 2011

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

Respectfully submitted,

Dated: January 19, 2010

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

By: /s/Mike Rodenbaugh  
Mike Rodenbaugh  
Rodenbaugh Law  
548 Market Street  
San Francisco, CA 94104  
mike@rodenbaugh.com  
Attorney for Applicant

**CERTIFICATE OF SERVICE**

I certify that a true and accurate copy of the foregoing JOINT MOTION TO CONSOLIDATE was served by agreement, by email transmission this 19th day of January 2009, upon counsel for Applicant:

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

/s/Virginia L. Carron