

ESTTA Tracking number: **ESTTA909842**

Filing date: **07/17/2018**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Reinalt-Thomas Corporation
Granted to Date of previous extension	07/18/2018
Address	20225 North Scottsdale Road Scottsdale, AZ 85255 UNITED STATES

Attorney information	Brian W. LaCorte Ballard Spahr LLP 1 East Washington Street, Suite 2300 Phoenix, AZ 85004 UNITED STATES Email: phx_tmddocketing@ballardspahr.com, WilsonJA@ballardspahr.com, LaCorteB@ballardspahr.com Phone: 602-798-5400
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Applicant Information

Application No	87570980	Publication date	03/20/2018
Opposition Filing Date	07/17/2018	Opposition Period Ends	07/18/2018
Applicant	Mavis Tire Supply LLC 358 Saw Mill River Road Millwood, NY 10546 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1973/06/15 First Use In Commerce: 1973/06/30 All goods and services in the class are opposed, namely: On-line retail store services featuring tires, automobile parts and accessories; Retail tire, automobile parts and accessory stores
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1319968	Application Date	02/13/1981
Registration Date	02/12/1985	Foreign Priority Date	NONE
Word Mark	DISCOUNT TIRE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1975/04/29 First Use In Commerce: 1975/04/29 Retail Auto and Light Truck Tire Store Services		

U.S. Registration No.	2597123	Application Date	09/18/2000
Registration Date	07/23/2002	Foreign Priority Date	NONE
Word Mark	DISCOUNT TIRE DIRECT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1994/05/02 First Use In Commerce: 1994/05/02 Online retail ordering services, retailstores and mail order catalog services featuring automobile and light truck tires		

U.S. Registration No.	4639389	Application Date	06/26/2013
Registration Date	11/18/2014	Foreign Priority Date	NONE
Word Mark	DISCOUNT TIRE		

Design Mark	<h1>DISCOUNT TIRE</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1960/03/01 First Use In Commerce: 1970/11/01 Retail store services, namely, automobile and light truck tires and wheels

Attachments	73297040#TMSN.png(bytes) 76130277#TMSN.png(bytes) 85971152#TMSN.png(bytes) Mavis Discount Tire TM Opposition.pdf(66689 bytes)
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Signature	/Brian W. LaCorte/
Name	Brian W. LaCorte
Date	07/17/2018

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

In the Matter of Trademark Application Serial No. 87/570980
Filed: August 16, 2017
Mark: MAVIS DISCOUNT TIRE
Published: March 20, 2018
Extensions to Oppose Granted Through: July 18, 2018

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Trademark Application Serial No. 87/585780
Filed: August 28, 2017
Mark: MAVIS DISCOUNT TIRE
Published: March 20, 2018
Extensions to Oppose Granted Through: July 18, 2018

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The Reinalt-Thomas Corporation, :
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 Opposer, :
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v. : Opposition No. _____
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Mavis Tire Supply LLC, :
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 Applicant. :
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Commissioner for Trademarks
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

CONSOLIDATED NOTICE OF OPPOSITION

Opposer The Reinalt-Thomas Corporation (d/b/a “Discount Tire”), a Michigan corporation with its principal place of business at 20225 N Scottsdale Road, Scottsdale, Arizona 85255, U.S.A., believes that it will be damaged by the registration of the MAVIS DISCOUNT TIRE marks shown in Application Serial Nos. 87/570980 and 87/585780 (the “Applications”) by

Mavis Tire Supply LLC (“Mavis”) and hereby opposes the same, by and through its attorneys, Ballard Spahr LLP, based upon the following grounds:

1. Opposer Discount Tire has used its flagship DISCOUNT TIRE trademark widely and continuously since at least 1960 when it opened its first retail store selling tires and wheels in Ann Arbor, Michigan.

2. Over the past fifty years, Discount Tire has spent many millions of dollars promoting the DISCOUNT TIRE mark nationwide. Specifically, Discount Tire has promoted, sponsored, and advertised the “DISCOUNT TIRE” mark through television commercials, radio commercials, print advertisements, billboards, store signage, sponsorships, and marketing materials.

3. For over twenty years, Discount Tire has promoted over the Internet its DISCOUNT TIRE mark in connection with the sale of tires and wheels.

4. Discount Tire has also used its “DISCOUNT TIRE DIRECT” mark widely and continuously since at least 1994 to promote a platform for the online sale of tires and wheels, retail stores, and mail order catalog services.


5. Discount Tire has created and registered the domain names <discounttire.com> and <discounttiredirect.com>. From their inception, these domains and related websites have promoted Discount Tire’s retail stores and the wide selection of tires and wheels and related services offered in those stores. Consumers use these internet sites to access an array of options, including locating a Discount Tire store, determining the availability of brands or sizes of tires for a particular vehicle, and setting service appointments. At least as early as December 1996, consumers could use one or more of Discount Tire’s websites to search its tire and wheel inventory for online purchases directly from Discount Tire and Discount Tire Direct (Discount


Tire's e-commerce site). Throughout this time, from 1995 to the present, Discount Tire has continuously invested in upgrading its online platform to enhance the consumer's online purchase experience.

6. As such, the DISCOUNT TIRE and DISCOUNT TIRE DIRECT trademarks have earned a strong reputation in the tire and wheel industry. Discount Tire has invested a significant amount of time, effort, and money to promote its tire and wheel business under the marks. As a result of Discount Tire's efforts, its DISCOUNT TIRE mark has accumulated substantial goodwill.

7. Through its marketing campaign over the past fifty years, Discount Tire has acquired significant common law rights and substantial secondary meaning in the DISCOUNT TIRE mark.

8. In addition to its significant common law rights, Discount Tire owns exclusive rights in the DISCOUNT TIRE word mark, the DISCOUNT TIRE design mark, and DISCOUNT TIRE DIRECT mark (collectively, "Discount Tire Marks") as evidenced by its federal registrations.

9. Discount Tire is owner of Registration No. 1,319,968, filed February 13, 1981, for the mark  in connection with: (Class 42) Retail auto and light truck store services.

10. Discount Tire is also owner of Registration No. 2,597,123, filed September 18, 2000, for the mark  in connection with: (Class 35) Online retail ordering services, retail stores and mail order catalog services featuring automobile and light truck tires.

11. Both the DISCOUNT TIRE and DISCOUNT TIRE DIRECT design marks are incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. This constitutes conclusive


and independent evidence of Discount Tire’s exclusive right to use these marks in connection with “retail auto and light truck tire store services” and “online retail ordering services, retail stores and mail order catalog services featuring automobile and light truck tires.”

12. Discount Tire is owner of Registration No. 4,639,389, filed June 26, 2013, for the mark **DISCOUNT TIRE** in connection with: (Class 35) Retail store services, namely, automobile and light truck tires and wheels.

13. Discount Tire obtained its registration pursuant to Section 2(f) of the Lanham Act based on evidence that the mark had acquired distinctiveness for Discount Tire’s goods and services. Specifically, customer survey results show that approximately eighty-one percent of relevant purchasers were able to evidence their ability to distinguish between a brand name and a common name and that the principal significance of DISCOUNT TIRE is that of a brand name or trademark.

14. Applicant Mavis is a Delaware company with an office at 358 Saw Mill River Road, Millwood, New York 10546, U.S.A.



15. On August 21, 2017, Mavis applied to register the mark  (Serial No. 85/570980). The application claimed rights in connection with the following goods and services: (Class 35) On-line retail store services featuring tires, automobile parts and accessories; Retail tire, automobile parts and accessory stores.

16. On August 28, 2017, Mavis applied to register the mark **MAVIS DISCOUNT TIRE** (Serial No. 87/585780), in connection with the following goods and services: (Class 35) Retail tire, automobile parts and accessory stores; On-line retail store services featuring tire, automobile parts and accessories.

17. The Applications must be denied under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because they so resemble Discount Tire's DISCOUNT TIRE and DISCOUNT TIRE DIRECT Registrations as to be likely, when used on or in connection with Mavis's goods or services, to cause confusion, or to cause mistake or to deceive.

18. With respect to both of the opposed applications, Mavis entered disclaimers of "discount tire." These disclaimers, however, do not avoid or diminish the likelihood of confusion with the Discount Tire Marks. On the contrary, it was an error of law to allow the disclaimer of a mark registered under Section 2(f) based on overwhelming evidence of acquired distinctiveness.

19. Discount Tire's Consolidated Notice of Opposition against the Applications is appropriate under 37 C.F.R. § 2.104(b) and Fed. R. Civ. P. 42(a) because Discount Tire's claims involve two applications owned by the same Applicant and they raise common questions of law and fact.

WHEREFORE, Discount Tire believes it will be damaged by the registration of the Applications for the goods and services identified in class 35 therein and respectfully requests that the Consolidated Opposition be sustained, that the registration of the MAVIS DISCOUNT TIRE marks be denied, and that the Trademark Trial and Appeal Board grant such and other further relief as it deems just and appropriate.

Payment has been provided in the requisite amount to cover the statutory filing fee for filing a Consolidated Notice of Opposition. All communications should be addressed to Discount Tire's counsel, Ballard Spahr LLP, at the address stated below.

Dated: July 17, 2018

Respectfully submitted,

By: /s/ Brian W. LaCorte

Brian W. LaCorte

BALLARD SPAHR LLP

1 East Washington Street, Suite 2300

Phoenix, AZ 85004

(602) 798-5400

Attorney for Opposer,

The Reinalt-Thomas Corporation