

ESTTA Tracking number: **ESTTA952880**

Filing date: **02/07/2019**

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

Proceeding	91242454
Party	Plaintiff The Reinalt-Thomas Corporation
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Attachments	D.I. 001--Complaint.pdf(967869 bytes)

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION**

THE REINALT-THOMAS
CORPORATION d/b/a DISCOUNT
TIRE,

Plaintiff,

v.

MAVIS TIRE SUPPLY LLC,

Defendant.

Civil Action No. _____

JURY TRIAL DEMANDED

COMPLAINT

The Reinalt-Thomas Corporation, doing business as Discount Tire (“Plaintiff”) for its Complaint against Mavis Tire Supply LLC (“Defendant”), alleges as follows:

NATURE OF THE ACTION

1. Plaintiff is the largest independent tire and wheel retail chain in the nation with over 1,000 stores in 35 states. Since 1960, Plaintiff has developed enormous goodwill around its DISCOUNT TIRE trademarks, which are protected nationwide by federal trademark registrations dating back to 1985, including U.S. Reg. Nos. 1319968 and 4639389.

2. Plaintiff has a particularly robust presence in Georgia, with 34 DISCOUNT TIRE stores serving consumers across the greater metropolitan Atlanta

area and the surrounding counties (collectively, the “Greater Atlanta Area”). As a result of Plaintiff’s longstanding use and promotion of the federally registered DISCOUNT TIRE marks, consumers in Georgia and elsewhere in the Southeast have come to know and trust goods and services offered by Plaintiff under the DISCOUNT TIRE brand.

3. Defendant is based in the northeastern United States where, until recently, Defendant confined its business. Recently, however, Defendant purchased certain third-party tire retailers in the Southeast (including Kauffman Tire, a long-time direct competitor of Plaintiff) and began re-branding those retailers under the name MAVIS DISCOUNT TIRE.

4. Defendant knowingly and intentionally entered geographic territories where Plaintiff and its DISCOUNT TIRE marks were well established, with the intent to trade off on the enormous goodwill embodied in the DISCOUNT TIRE marks and to confuse consumers into believing Defendant’s MAVIS DISCOUNT TIRE stores are affiliated or connected with Plaintiff’s DISCOUNT TIRE stores – when they are not.

5. Defendant’s strategy to mislead and confuse consumers in the Southeast has proven successful. In the short time that Defendant’s re-branded MAVIS DISCOUNT TIRE stores have been operating in this market, Plaintiff has

encountered and documented numerous instances of actual consumer confusion arising from Defendant's use of its confusingly similar trademark.

6. In addition to this overwhelming evidence of a likelihood of confusion and infringement of Plaintiff's DISCOUNT TIRE marks, Defendant's use of MAVIS DISCOUNT TIRE is likely to dilute Plaintiff's DISCOUNT TIRE marks by tarnishing and diminishing the capacity of Plaintiff's DISCOUNT TIRE marks to identify and distinguish Plaintiff's goods and services from those of others.

7. In an effort to protect the public from ongoing confusion and deception and to prevent the further dilution of Plaintiff's valuable trademarks, Plaintiff brings this action to preliminarily and permanently enjoin Defendant from using the MAVIS DISCOUNT TIRE mark. Plaintiff also seeks monetary damages and, because Defendant's conduct is willful, wanton, and in total disregard of Plaintiff's prior trademark rights, punitive damages and attorneys' fees.

8. This is an action for federal and common law trademark infringement, false designation of origin, dilution, unfair competition, and related state law claims arising from Defendant's use of the infringing MAVIS DISCOUNT TIRE mark.

Specifically, Plaintiff brings this action seeking, among other things, a judgment that Defendant has:

- a. infringed Plaintiff's federally registered trademarks in violation of Lanham Act § 32, 15 U.S.C. § 1114(1);
- b. engaged in unfair competition in violation of Lanham Act § 43(a), 15 U.S.C. § 1125(a), by, for example, using MAVIS DISCOUNT TIRE in a manner likely to cause confusion, mistake, or deception as to the affiliation, connection, or association with Plaintiff;
- c. engaged in deceptive trade practices in violation of the Georgia Uniform Deceptive Trade Practices Act, O.C.G.A. § 10-1-370 *et seq.*;
- d. diluted by tarnishing and diminishing the capacity of Plaintiff's distinctive DISCOUNT TIRE marks to identify and distinguish Plaintiff's goods and services in violation of O.C.G.A. § 10-1-451(b);
- e. engaged in unfair competition in violation of O.C.G.A. § 23-2-55 and the common law of Georgia; and
- f. violated Plaintiff's common law trademark rights under Georgia law.

PARTIES

9. Plaintiff, which does business under the name Discount Tire, is a Michigan corporation with its principal place of business in Scottsdale, Arizona. At

all relevant times, Plaintiff has been the exclusive licensee or, more recently, the owner of all federal, state, and common law rights in and to all DISCOUNT TIRE marks asserted in this action.

10. Defendant is a Delaware company, with its principal place of business at 358 Saw Mill River Road, Suite 1, Millwood, NY 10546-1051.

JURISDICTION AND VENUE

11. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. §§1121 and 1125 and 28 U.S.C. §§1331 and 1338(a) and (b).

12. This Court has supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. §1367(a).

13. This Court has personal jurisdiction over Defendant because it is present in Georgia—operating tire stores in the state—and, alternatively, under O.C.G.A. § 9-10-91(1) because Defendant transacts business within Georgia and Plaintiff's claims arise in substantial part from Defendant's acts and omissions in connection with Defendant's business transactions in Georgia.

14. Specifically, Defendant operates MAVIS DISCOUNT TIRE stores in Georgia and also operates stores in Georgia under the names Dekalb Tire, Kauffman Tire, and Savannah Tire, which, on information and belief, Defendant is in the process of rebranding as MAVIS DISCOUNT TIRE. Plaintiff's claims for

trademark infringement, unfair competition, and dilution, among others, arise from Defendant's operation of and advertisements related to MAVIS DISCOUNT TIRE stores in Georgia.

15. This Court also has personal jurisdiction over Defendant under O.C.G.A. § 9-10-91(2) because Defendant has committed tortious acts in Georgia and Plaintiff's claims arise from Defendant's commission of those tortious acts. Specifically, Defendant infringes and dilutes Plaintiff's trademarks in Georgia.

16. Venue is proper in this District pursuant to 28 U.S.C. §1391(b)–(d) because Defendant is subject to personal jurisdiction in this district and a substantial portion of the events or omissions giving rise to this claim occurred in this district.

FACTUAL ALLEGATIONS

A. The “DISCOUNT TIRE” Trademarks are Famous and Distinctive

17. Plaintiff is one of this country's great business success stories. Indeed, the story of Mr. Bruce T. Halle and Plaintiff represents the American dream.

18. In 1960, Mr. Halle started his business as “Discount Tire,” a one-man operation with a single storefront in Michigan and an inventory of six tires (four of which were retreads). By the end of 1972, Plaintiff had multiple DISCOUNT TIRE stores in two different states—at least four in Arizona and twelve in Michigan. Through extraordinary hard work and determination, Mr. Halle turned his business

into the world's largest independent tire and wheel retailer with the most recognized brand name in the industry.

19. Plaintiff is the largest independent tire and wheel retail operation in the nation. In 2018, Plaintiff ranked 95th on the Forbes' list of "America's Largest Private Companies."

20. Today, Plaintiff employs more than 22,000 people and operates over 1,000 DISCOUNT TIRE stores in 35 states from Seattle, Washington to Tallahassee, Florida, and from Minneapolis, Minnesota, to Brownsville, Texas (Texas's southern-most tip).

21. Plaintiff has used its flagship DISCOUNT TIRE mark, widely and continuously since at least 1960 when Mr. Halle opened the first Discount Tire Co. store on Stadium Boulevard in Ann Arbor, Michigan.

22. Plaintiff has promoted the word mark DISCOUNT TIRE without any associated design elements. Since at least as early as 1975, Plaintiff has also simultaneously used continuously and widely its stylized trademark:



23. Additionally, Plaintiff has used the related DISCOUNT TIRE DIRECT mark widely and continuously since at least 1994 to promote Internet sales of tires and wheels and to promote its retail stores.

24. Over the past 58 years, Plaintiff has spent over a billion dollars promoting its DISCOUNT TIRE marks in association with its tire and wheel business nationwide.

25. Specifically, Plaintiff has promoted, sponsored, and advertised its DISCOUNT TIRE marks through television commercials, radio commercials, print advertisements, billboards, store signage, sponsorships, and marketing materials.

26. One of Plaintiff's earliest television commercials (first aired in 1975) was a ten-second feature showing a little old lady throwing a tire through a glass storefront of a "Discount Tire" store.



The commercial included the following statement: “If ever you’re not satisfied with one of our tires, please feel free to bring it back. Thank you, Discount Tire Company.”

27. The commercial, which came to be known as the “Thank You ad,” was named “The World’s Best Broadcasting Advertisement” by the Hollywood Radio and Television Society in 1976.

28. The Thank You ad was so popular with the public that Plaintiff continues to air the original commercial to the present date, and in October 2004, the Thank You ad earned Plaintiff a place in the Guinness World Records for the Longest Running TV Commercial.

29. As a result of Plaintiff’s marketing campaign over the past 58 years, the scope and extent of its promotion and use of the DISCOUNT TIRE marks, the iconic status of its “Thank You ad,” and the pervasive advertisement of DISCOUNT TIRE for retail tire stores, the DISCOUNT TIRE marks have become well known.

30. Since 1995, Plaintiff has used the Internet, including its e-commerce platforms at www.discounttire.com and www.discounttiredirect.com, to promote its DISCOUNT TIRE marks in connection with the sale of tires, wheels, and related services.

31. The DISCOUNT TIRE brand has a substantial place in professional racing, particularly NASCAR. For nearly ten years, Plaintiff has sponsored a NASCAR race car, driven by Brad Keselowski and Joey Lugano, with prominent display of DISCOUNT TIRE:



32. In partnership with Team Penske, Plaintiff continues to sponsor NASCAR drivers Brad Keselowski, Ryan Blaney, and Joey Logano with primary sponsorship of the No. 2 Ford Fusion in the Monster Energy NASCAR Cup Series (MENCs). Plaintiff also sponsors the No. 22 Ford Mustang in the NASCAR XFINITY Series

33. Through its use of its DISCOUNT TIRE marks in all manner of retail and online promotion, advertising, sponsorships, and marketing, Plaintiff has

achieved billions of dollars in retail sales and acquired distinctiveness and secondary meaning.

34. As a result of Plaintiff's long-term and continuous use, the DISCOUNT TIRE marks are famous and widely recognized by the general consuming public in Georgia, Florida, and elsewhere throughout the United States as a source of Plaintiff's tires, wheels, and related services.

B. The "DISCOUNT TIRE" Federal Registrations

35. On February 13, 1981, Plaintiff's late owner and founder, Mr. Bruce Halle filed an application for federal registration of the mark DISCOUNT TIRE CO. INC. plus stylized design with the United States Patent and Trademark Office ("USPTO"), claiming first use in commerce at least as early as April 29, 1975.

36. The USPTO issued a registration for that mark on February 12, 1985, in connection with "retail auto and light truck tire store services" (U.S. Reg. No. 1,319,968). This registration was later amended in 2008 to reflect Plaintiff's use of the mark as simply DISCOUNT TIRE & Design:



A true and correct copy of U.S. Reg. No. 1,319,968 is attached as **Exhibit 1**.

37. The DISCOUNT TIRE design mark registration is incontestable under Lanham Act § 15, 15 U.S.C. § 1065.

38. On September 18, 2000, Mr. Halle filed an application for federal registration of DISCOUNT TIRE DIRECT, claiming first use in commerce on May 2, 1994.

39. The USPTO issued a registration for the DISCOUNT TIRE DIRECT mark on July 23, 2002, in connection with “online retail ordering services, retail stores and mail order catalog services featuring automobile and light truck tires” (U.S. Reg. No. 2,597,123). A true and correct copy of U.S. Reg. No. 2,597,123 is attached as **Exhibit 2**.

40. The DISCOUNT TIRE DIRECT registration is “incontestable” under Lanham Act §15, 15 U.S.C. § 1065.

41. On June 23, 2013, Mr. Halle filed an application for federal registration for the word mark DISCOUNT TIRE (without any design element) claiming first use in commerce on November 1, 1970. The application was based on Lanham Act § 2(f) and supported by evidence that the word mark had become distinctive for the goods and services.

42. Renowned survey expert Gerald L. Ford submitted survey evidence and an expert opinion in support of the application. Based on the survey, he reported that

an astounding 80% of survey respondents recognized DISCOUNT TIRE as a brand name (and not a “common name”). He concluded:

It is my considered opinion, based upon my education, background, and professional experience, and based upon my review and analysis of the results of the survey conducted in this matter, that the results of the survey support a finding that the principal significance of DISCOUNT TIRE is that of a brand name or trademark and not that of a generic term or designation. Additionally, the magnitude of acquired distinctiveness or secondary meaning evidenced by the survey results supports a finding that DISCOUNT TIRE is a strong and famous mark among the relevant universe of people who are potential tire purchasers.

43. Persuaded by this and other evidence that DISCOUNT TIRE was neither generic nor merely descriptive, the USPTO issued a registration on November 18, 2014, for the word mark DISCOUNT TIRE in connection with “retail store services, namely, automobile and light truck tires and wheels” (U.S. Reg. No. 4,639,389). A true and correct copy of U.S. Reg. No. 4,639,389 is attached as **Exhibit 3**.

44. At all relevant times, Plaintiff has been either the exclusive licensee, or, more recently, the owner by assignment, of all federal, state, and common law rights in and to the DISCOUNT TIRE marks, including, without limitation, the rights associated with the above-referenced federal registrations.

C. Geographic Scope of Plaintiff's Rights

45. Plaintiff operates stores under the DISCOUNT TIRE marks in the following 35 states: Alabama, Arizona, Arkansas, California, Colorado, Florida, Georgia, Idaho, Illinois, Indiana, Iowa, Kansas, Kentucky, Louisiana, Michigan, Minnesota, Mississippi, Missouri, Montana, North Carolina, Nebraska, New Mexico, Nevada, Ohio, Oklahoma, Oregon, South Carolina, South Dakota, Tennessee, Texas, Utah, Virginia, Washington, Wisconsin, and Wyoming.

46. Plaintiff has not yet¹ opened retail stores in several of the North Eastern states, including New York, New Jersey, Connecticut, Massachusetts, and Eastern Pennsylvania, where Defendant has, until recently, confined its business.

47. In particular, Plaintiff for many years has operated retail stores in Georgia, Florida, Alabama, North Carolina, South Carolina, and Texas, among other states. For example, Plaintiff has used the DISCOUNT TIRE marks in Georgia since 2001 and today operates 34 stores in the Greater Atlanta Area alone.

¹ As the owner of the senior federal registration, Plaintiff has the right to enter the Atlantic Northeast when appropriate for its business expansion strategy. For the present, Plaintiff only seeks to exclude Defendant from encroaching on Plaintiff's existing markets.

48. In all 35 states where Plaintiff has used its DISCOUNT TIRE marks, it has built substantial goodwill, with the result that Plaintiff's DISCOUNT TIRE marks are well known, distinctive, strong, and famous.

D. Defendant's Use of DISCOUNT TIRE

49. Defendant offers the same goods and services, i.e., relating to the sale of tires and wheels, as Plaintiff.

50. On information and belief, in 1972, Defendant's predecessor(s) began as "Mavis Tire Supply Corporation" with three New York stores.

51. On information and belief, in the 1970's and 1980's, the business expanded throughout New York and into New Jersey under the operating name Mavis Tire Supply.

52. On information and belief, Defendant later made its first use of MAVIS DISCOUNT TIRE as a trademark, at which time it had notice and knowledge of Plaintiff's adoption, acquisition, and registration of senior prior rights, both federally registered and common law, in the DISCOUNT TIRE marks.

53. Defendant copied the design elements of Plaintiff's mark, namely the jumbled lettering of the word "discount," as depicted here:



54. Plaintiff did not give, and has never given, Defendant or any of its predecessors in business permission to use its DISCOUNT TIRE marks for any reason.

55. In May 1994, Defendant's predecessor Mavis Tire Supply Corporation registered MAVIS (U.S. Reg. No. 1,685,669) alone without any claim to "discount tire" as a trademark.

56. In 2012, Mavis Tire Supply Corporation merged with and into Defendant.

57. On information and belief, until recently, Defendant's and its predecessor's business operations under the Mavis Discount Tire name were restricted to the Atlantic Northeast (New York, Massachusetts, Connecticut, New Jersey and Eastern Pennsylvania) where Plaintiff had no retail stores.

E. Defendant's 2018 Expansion

58. On December 31, 2017, Defendant acquired the Kauffman Tire chain, which has retail stores in Georgia and Florida, as well as Kauffman Tire's wholesale

distribution business operating in Alabama, Florida, Georgia, North Carolina, Ohio, South Carolina, and Texas.

59. Since that time, Defendant has also acquired the Florida-based Sun Tire, the Georgia-based Savannah Tire and Dekalb Tire retail chains, and Express Oil Change & Tire Engineers.

60. Defendant has rebranded several Kauffman Tire stores in Georgia, including in Atlanta, and Kauffman Tire, and Sun Tire stores in Florida, as MAVIS DISCOUNT TIRE stores. By doing so, Defendant has expanded its presence into geographic areas where Plaintiff has operated retail stores for many years under its DISCOUNT TIRE marks, which are well known to tire consumers, as well as the general public, in these areas as distinctive and famous.

61. On information and belief, Defendant has already or will soon rebrand dozens of stores in Georgia and across the Southeast under the infringing and diluting trademark MAVIS DISCOUNT TIRE. Although this rebranding only recently started, it is apparent that Defendant intends to rebrand dozens of its recently acquired tire stores across the Southeast.

F. Defendant's Federal Trademark Applications

62. Defendant has filed two federal trademark registration applications for MAVIS DISCOUNT TIRE (U.S. Serial Nos. 87570980 and 87585780).

63. Because MAVIS DISCOUNT TIRE is confusingly similar to Plaintiff's previously registered DISCOUNT TIRE marks, Plaintiff filed an opposition to block the federal registration of MAVIS DISCOUNT TIRE (Trademark Trial and Appeal Board Proceeding Number 9124244), which opposition is pending as of the filing of this Complaint. Plaintiff will promptly notify the USPTO of this Complaint and will move to suspend the opposition pending resolution of this action.

COUNT ONE
Federal Trademark Infringement
in Violation of Lanham Act § 32

64. Plaintiff repeats and realleges the allegations set forth in the preceding paragraphs 1–63.

65. At all relevant times, Plaintiff has been the exclusive licensee or, more recently, the owner of all federal, state, and common law rights in and to all DISCOUNT TIRE marks, including the rights associated with the above-referenced U.S. Reg. No. 1,319,968, U.S. Reg. No. 4,639,389, and U.S. Reg. No. 2,597,123.

66. Defendant's unauthorized use of DISCOUNT TIRE as a trademark component of MAVIS DISCOUNT TIRE to advertise and sell directly competing goods is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendant with Plaintiff.

67. Defendant is likely to cause confusion and mistake as it expands into the market zone outside the Northeast and into market zones like Atlanta, Georgia, where Plaintiff has done business under its DISCOUNT TIRE marks for many years and where consumers perceive Plaintiff's DISCOUNT TIRE marks as distinctive, well known, and famous.

68. Defendant has acted willfully and deliberately and with full knowledge of Plaintiff's rights in the DISCOUNT TIRE marks.

69. Plaintiff has been, and continues to be, irreparably damaged by Defendant's actions, and it has no adequate remedy at law.

70. Unless this Court immediately and permanently enjoins Defendant's unlawful use of MAVIS DISCOUNT TIRE, Defendant's unlawful actions will continue to injure the public and cause Plaintiff irreparable injury.

71. Defendant's intentional and bad faith actions render this an exceptional case and entitles Plaintiff to treble damages and attorneys' fees under Lanham Act § 35(a), 15 U.S.C. § 1117.

COUNT TWO

Unfair Competition in Violation of Lanham Act § 43(a)

72. Plaintiff repeats and realleges the allegations set forth in the preceding paragraphs 1–63.

73. At all relevant times, Plaintiff has been the exclusive licensees or, more recently, the owner, of all federal, state, and common law rights, registered and unregistered, in and to the DISCOUNT TIRE marks.

74. Defendant is likely to cause confusion and mistake as it expands into the market zone outside the Northeast and into market zones like Atlanta, Georgia, where Plaintiff has done business under its DISCOUNT TIRE marks for many years and where consumers perceive Plaintiff's DISCOUNT TIRE marks as distinctive, well known, and famous.

75. Defendant's unauthorized use of MAVIS DISCOUNT TIRE to advertise and sell directly competing goods and services is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendant's goods or services with Plaintiff or its DISCOUNT TIRE marks, or as to the origin, sponsorship or approval of Defendant's goods or services.

76. Defendant has acted willfully and deliberately and with full knowledge of Plaintiff's rights in the DISCOUNT TIRE marks.

77. Plaintiff has been, and continues to be, irreparably damaged by Defendant's actions, and it has no adequate remedy at law.

78. Unless this Court immediately and permanently enjoins Defendant's unlawful use of MAVIS DISCOUNT TIRE, Defendant's unlawful actions will continue to injure Plaintiff and the public.

79. Defendant's intentional and bad faith actions render this an exceptional case and entitles Plaintiff to treble damages and attorneys' fees under Lanham Act § 35(a), 15 U.S.C. § 1117.

COUNT THREE

Trademark Dilution in Violation O.C.G.A. § 10-1-451(b)

80. Plaintiff repeats and re-alleges the allegations set forth in the preceding paragraphs 1–63.

81. Plaintiff's DISCOUNT TIRE marks are distinctive and identify Plaintiff as the source of the goods and services.

82. Without Plaintiff's permission, Defendant has adopted and used a trademark that is similar to Plaintiff's DISCOUNT TIRE marks.

83. Defendant's use of a similar trademark creates a likelihood of dilution of the distinctive quality of Plaintiff's DISCOUNT TIRE marks.

84. Defendant's wrongful conduct has been and continues to be intentional, willful, and without regard for Plaintiff's rights in the DISCOUNT TIRE marks.

85. Defendant knew of Plaintiff's prior use of and established rights in and to the DISCOUNT TIRE marks.

86. Defendant's wrongful actions have substantially harmed the public and caused Plaintiff irreparable injury.

87. Unless this Court immediately and permanently enjoins Defendant's use of MAVIS DISCOUNT TIRE in violation of O.C.G.A. § 10-1-451(b), Defendant's unlawful actions will continue to injure the public and cause Plaintiff irreparable injury.

COUNT FOUR

Violation of the Uniform Deceptive Trade Practices Act

88. Plaintiff repeats and re-alleges the allegations set forth in the preceding paragraphs 1–63.

89. Defendant's infringing use of MAVIS DISCOUNT TIRE in the course of its business is likely to cause confusion or misunderstanding as to the source, sponsorship, or approval of Defendant's goods and services; and is likely to cause others to be confused or deceived into believing or form the mistaken belief that there is an affiliation, connection, or association between Defendant and Plaintiff or that Defendant's goods and services originate from or are sponsored or approved by Plaintiff.

90. Defendant's actions constitute deceptive acts or practices in the course of a business, a trade, or commerce in violation of the Uniform Deceptive Trade Practices Act, O.C.G.A. § 10-1-370 *et seq.*

91. Defendant's wrongful actions have substantially harmed the public and caused Plaintiff irreparable injury.

92. Unless this Court immediately and permanently enjoins Defendant's use of MAVIS DISCOUNT TIRE in violation of O.C.G.A. § 10-1-370 *et seq.*, Defendant's unlawful actions will continue to injure the public and cause Plaintiff irreparable injury.

93. Defendant willfully, wantonly, intentionally, and maliciously engaged in the wrongful and deceptive acts described here.

94. Defendant's intentional and bad faith actions render this an exceptional case under O.C.G.A. § 10-1-373(b).

COUNT FIVE
Unfair Competition in Violation of O.C.G.A. § 23-2-55

95. Plaintiff repeats and realleges the allegations set forth in the preceding paragraphs 1–63.

96. By its use of MAVIS DISCOUNT TIRE, Defendant has attempted to encroach upon the business of Plaintiff by the use of a confusingly similar trademark.

97. Defendant intended to deceive and mislead the general consuming public when it entered Georgia and Plaintiff's other market zones with knowledge that Plaintiff had long established prior rights in these areas.

98. Defendant's unauthorized use of the DISCOUNT TIRE marks falsely tends to induce buyers to believe that they are purchasing products and services from Plaintiff or one of its affiliates and unfairly allows Defendant to arrogate for itself Plaintiff's goodwill and rights in DISCOUNT TIRE, which is likely to confuse, deceive, and injure the public.

99. Plaintiff has been, and continues to be, irreparably damaged by Defendant's actions, and it has no adequate remedy at law.

100. Unless this Court immediately and permanently enjoins Defendant's use of MAVIS DISCOUNT TIRE in violation of O.C.G.A. § 23-2-55, Defendant's unlawful actions will continue to injure the public and cause Plaintiff irreparable injury.

COUNT SIX
Common Law Trademark Infringement

101. Plaintiff repeats and realleges the allegations set forth in the preceding paragraphs 1–63.

102. Plaintiff has common law rights in Georgia and throughout the market zones where it is doing business.

103. Defendant's use of MAVIS DISCOUNT TIRE is likely to cause confusion and mistake as to the source or origin of Defendant's goods and services or to be confused or mistaken for an affiliation with Plaintiff.

104. Defendant has acted, and continues to act, willfully, deliberately, and with full knowledge of Plaintiff's use of and common law rights to the DISCOUNT TIRE marks and without regard to the likelihood of confusion of the public created by Defendant's actions.

105. Plaintiff has been, and continues to be, irreparably damaged by Defendant's actions, and it has no adequate remedy at law.

106. Unless this Court immediately and permanently enjoins Defendant's unlawful use of MAVIS DISCOUNT TIRE, Defendant's unlawful actions will continue to injure the public and cause Plaintiff irreparable injury.

JURY DEMAND

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff demands trial by jury on all issues so triable.

PRAYER FOR RELIEF

Wherefore, Plaintiff respectfully requests that this Court:

A. Enter a judgement in favor of Plaintiff and against Defendant on all counts alleged in this Complaint;

B. Enter an injunction enjoining Defendant, its officers, directors, employees, agents, licensees, attorneys, subsidiaries, and affiliate companies,

successors, and assigns, and any and all persons in active concert or participation with any of them, from directly or indirectly:

1. Using the DISCOUNT TIRE marks, including, without limitation, the MAVIS DISCOUNT TIRE mark or any other copy, reproduction, or colorable imitation or confusingly similar variation thereof, in connection with Defendant's goods and services in any geographic area where Plaintiff has preexisting retail stores, including without limitation Georgia, Florida, Alabama, Louisiana, North Carolina, South Carolina, and Texas;
2. Engaging in any action suggesting or tending to suggest that any good or service promoted, advertised, distributed, or offered for sale by Defendant originates from or is directly or indirectly sponsored by, approved by, affiliated with, or connected with Plaintiff;
3. Conveying the impression to the public through signage, domain names, displays, advertising, packaging, or otherwise that any good or service offered by Defendant originates from or is directly or indirectly sponsored by, approved by, affiliated with, or connected with Plaintiff;

4. Using any trademark, service mark, trade dress, name, logo, design, source designation of any kind on or in connection with Defendant's good and services that dilutes or is likely to dilute the distinctiveness of Plaintiff's DISCOUNT TIRE marks; and
5. Registering or using, in any manner, any domain name that incorporates the letter string "discounttire" or common misspellings thereof, including mavisdiscounttire.com;

C. Enter an order instructing the Trademark Trial and Appeal Board to sustain Plaintiff's opposition (Proceeding No. 9124244) to Defendant's pending applications to register marks incorporating the phrase "DISCOUNT TIRE" (U.S. Serial Nos. 87570980 and 87585780);

D. Award Plaintiff its actual damages, including lost revenue, a reasonable royalty, and/or the cost of corrective advertising;

E. Enter an order requiring Defendant to account for and disgorge all profits made by Defendant as a result of Defendant's unlawful actions;

F. Award Plaintiff its costs of for this action and reasonable attorneys' fees;

G. Based on Defendant's willful and deliberate conduct, award Plaintiff treble damages and an enhancement of Defendant's profits pursuant to 15 U.S.C. §1117;

H. Award Plaintiff the cost of this action and its reasonable attorneys' fees pursuant to 15 U.S.C. §1117 and the state statutes cited in this Complaint;

I. Based on Defendant's willful, wanton, intentional, malicious, and bad faith actions, which were done with specific intent to cause harm to Plaintiff, award Plaintiff punitive damages, pursuant to O.C.G.A. § 51-12-5.1, in an amount sufficient to punish, penalize and deter;

J. Award Plaintiff pre-judgment and post-judgment interest;

K. Enter an order requiring Defendant to file with the Court and serve upon Plaintiff a written report under oath setting out in detail the manner and form in which Defendant has complied with the injunction and judgment within 30 days after the service of the injunction and judgment on Defendant; and

L. Award Plaintiff such other and further relief as this Court deems just and proper.

Dated: December 26, 2018

Respectfully submitted,

/s/Lawrence K. Nodine

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Of counsel for Plaintiff The Reinalt-Thomas Corp.

EXHIBIT 1

Int. Cl.: 42

Prior U.S. Cls.: 101 and 103

United States Patent and Trademark Office

Reg. No. 1,319,968

Registered Feb. 12, 1985

SERVICE MARK
Principal Register

DISCOUNT
TIRE CO. INC.

Bruce T. Halle (United States citizen)
c/o Discount Tire Company
4711 E. Cactus Rd.
Phoenix, Ariz. 85032

For: RETAIL AUTO AND LIGHT TRUCK
TIRE STORE SERVICES, in CLASS 42 (U.S. Cls.
101 and 103).

First use Apr. 29, 1975; in commerce Apr. 29,
1975.

No claim is made to the exclusive right to use the
words "Discount Tire Co. Inc.", apart from the mark
as shown.

Sec. 2(f).

Ser. No. 297,040, filed Feb. 13, 1981.

DAVID A. HERDMAN, Examining Attorney

EXHIBIT 2

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,597,123

United States Patent and Trademark Office

Registered July 23, 2002

**SERVICE MARK
PRINCIPAL REGISTER**



HALLE, BRUCE T. (UNITED STATES INDIVIDUAL)
14631 N. SCOTTSDALE ROAD
SCOTTSDALE, AZ 85254

OWNER OF U.S. REG. NO. 1,319,968.

FOR: ONLINE RETAIL ORDERING SERVICES, RETAIL STORES AND MAIL ORDER CATALOG SERVICES FEATURING AUTOMOBILE AND LIGHT TRUCK TIRES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DISCOUNT TIRE DIRECT", APART FROM THE MARK AS SHOWN.

SER. NO. 76-130,277, FILED 9-18-2000.

FIRST USE 5-2-1994; IN COMMERCE 5-2-1994.

ELISSA GARBER KON, EXAMINING ATTORNEY

EXHIBIT 3

United States of America
United States Patent and Trademark Office

DISCOUNT TIRE

Reg. No. 4,639,389

BRUCE T. HALLE (UNITED STATES INDIVIDUAL)
20225 N. SCOTTSDALE ROAD
SCOTTSDALE, AZ 85255

Registered Nov. 18, 2014

Int. Cl.: 35

FOR: RETAIL STORE SERVICES, NAMELY, AUTOMOBILE AND LIGHT TRUCK TIRES AND WHEELS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

FIRST USE 3-1-1960; IN COMMERCE 11-1-1970.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,319,968, 2,597,123, AND 2,673,789.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TIRE", APART FROM THE MARK AS SHOWN.

SEC. 2(F).

SER. NO. 85-971,152, FILED 6-26-2013.

KAMAL PREET, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or reminder of these filing requirements.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.