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

Proceeding	91242454
Party	Defendant Mavis Tire Supply LLC
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Signature	/Neil K. Roman/
Date	11/13/2019
Attachments	Joint Motion for Amendments and Conditioned Withdrawal of Opposition - Rein- alt-Thomas v. Mavis_FINAL.pdf(110610 bytes) Exhibit A.pdf(179415 bytes) Exhibit B.pdf(162273 bytes)

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

In the Matter of Application Serial Nos. 87/570,980 and 87/585,780
For the Marks: MAVIS DISCOUNT TIRE & Design and
MAVIS DISCOUNT TIRE (Stylized)
Published in the *Official Gazette* on March 20, 2018
Opposition Filed on July 17, 2018

The Reinalt-Thomas Corporation,

Opposer,

v.

Mavis Tire Supply LLC,

Applicant.

Opposition No. 91242454

**Joint Motion for Concurrent Use Registrations Pursuant to Court Order
and for Conditioned Withdrawal**

Opposer, The Reinalt-Thomas Corporation (d/b/a “Discount Tire”) and Applicant Mavis Tire Supply LLC (collectively, “the parties”), hereby notify the Trademark Trial and Appeal Board (the “Board”) of the August 27, 2019 Order (“Court Order”) issued in the civil action filed by the Opposer against Applicant (*The Reinalt-Thomas Corporation v. Mavis Tire Supply LLC*, USDC NDGA Case No. 1:18-cv-05877-TCB) (“Civil Action”) and request amendments to the involved registration and to one of the subject applications pursuant to the Court Order resulting in concurrent use registrations for the Parties and for withdrawal of one of the subject applications. Conditioned on the entry of the amendments herein requested in accordance with the Court Order, Opposer withdraws the Opposition with prejudice.

Background

On July 17, 2018 Opposer filed an opposition, designated Opposition No. 91242454 (“Opposition”), opposing Applicant’s applications for registration of the marks



, Application Serial Number 87/570,980 (“MAVIS DISCOUNT TIRE

Logo”) and **MAVIS DISCOUNT TIRE**, Application Serial Number

87/585,780 (“MAVIS DISCOUNT TIRE Stylized”) on the ground that such marks are likely to cause consumer confusion with Opposer’s previously registered marks DISCOUNT TIRE,

Registration Number 4,639,389 (“DISCOUNT TIRE Word Mark”), **DISCOUNT TIRE DIRECT**,

Registration Number 2,597,123 (“DISCOUNT TIRE DIRECT Logo”) and



, Registration Number 1,319,968 (“DISCOUNT TIRE Logo”).

Opposer filed the Civil Action on December 26, 2018, and the Parties filed a Consented Motion with the Board on January 8, 2019, requesting suspension of the Opposition until the final determination of the Civil Action.

The Opposition was suspended by the Board on June 20, 2019.

The United States District Court for the Northern District of Georgia, Atlanta Division (“Court”) subsequently made a preliminary finding in favor of Opposer, which Applicant appealed in part.

To resolve their dispute, the Parties have consented to allow concurrent registration of their respective marks based on separation into different geographic areas reflecting their respective prior use contentions. The Court found geographic separation as agreed to by the Parties sufficient to avoid confusion and issued the Court Order, attached as Exhibit A.

Argument

Pursuant to TMEP 1207.04(a), there are two bases on which a concurrent use registration may be issued: (1) a determination by the Board, in either a prior or to-be-instituted concurrent use proceeding, that the applicant is entitled to a concurrent registration; or (2) a final determination by a court of competent jurisdiction of the concurrent rights of the relevant parties to use the same or similar marks in commerce. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.99; TBMP §1102.02.

Given the Court Order, the Parties are requesting that concurrent use registrations be issued on the basis of the latter. When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all the following conditions are fulfilled:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and
- (2) The court decree specifies the rights of the parties; and
- (3) A true copy of the court decree is submitted to the examining attorney; and
- (4) The concurrent use application complies fully and exactly with the court decree; and
- (5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

TMEP 1207.04(f). Applicant is entitled to registration of MAVIS DISCOUNT TIRE Stylized (Application Serial Number 87/585,780) subject only to the concurrent lawful use of Opposer thus fulfilling TMEP 1207.04(f)(1). The Court Order specifies the rights of the Parties and thus TMEP 1207.04(f)(2) is fulfilled. A true copy of the Court Order is attached hereto as Exhibit A

fulfilling TMEP 1207.04(f)(3).¹ The amendments to MAVIS DISCOUNT TIRE Stylized (Application Serial Number 87/585,780) requested herein comply fully and exactly with the Court Order thus fulfilling TMEP 1207.04(f)(4).

As to TMEP 1207.04(f)(5), the Parties desire for the involved registration, DISCOUNT TIRE Word Mark (Registration Number 4,639,389), to be restricted in accordance with the Court Order to fulfill the final requirement for obtaining concurrent use registrations without instituting a concurrent use proceeding before the Board. However, because the DISCOUNT TIRE Word Mark was merely relied upon and not subject to cancellation or counterclaim by Applicant as part of the above-captioned Board proceeding, the Parties believe that it is possible that the Board may conclude that it does not have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) and that it cannot therefore restrict Registration Number 4,639,389 in accordance with the Court Order. 37 C.F.R. §2.133; TBMP 514.

Therefore, out of the abundance of caution, the Parties have simultaneously filed the request to the Office of the Solicitor in accordance with TMEP 1610, attached as Exhibit B, requesting that the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) be amended in accordance with the Court Order. Additionally, the Court has been instructed to provide a certified copy of the Court Order to the Office of the Solicitor.

If the Board determines that it does not have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) to amend accordingly, the Parties hereby request that the Opposition be suspended until the Office of the Solicitor acts on the Parties' request and

¹ Though TMEP 1207.04(f)(3) states that the Court Order should be submitted to the examining attorney, in this case the examining attorney does not have jurisdiction over the MAVIS DISCOUNT TIRE Stylized (Application Serial Number 87/585,780). The Parties believe that TMEP 1207.04(f)(3) is fulfilled in this case by submitting the Court Order to the Board, which has jurisdiction over the application.

restricts the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) in accordance with the Court Order.

If the Board determines that it does have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389), the Parties hereby request that the registration for the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) be amended pursuant to the Court Order to *exclude* the following geographic regions from the registration (hereinafter referred to as the “Mavis Geographic Region”):

- The entire State of New York;
- The entire State of New Jersey;
- In Connecticut, the following counties: Litchfield, Fairfield, New Haven, and Hartford;
- In Massachusetts, the following counties: Berkshire, Hampshire, Franklin, and Hampden; and
- In Pennsylvania, the following counties: Cameron, Tioga, Lycoming, Union, Snyder, Juniata, Perry, Cumberland, Adams, Bradford, Sullivan, Columbia, Montour, Northumberland, Dauphin, York, Susquehanna, Wyoming, Luzerne, Schuylkill, Lebanon, Lancaster, Wayne, Lackawanna, Monroe, Carbon, Lehigh, Berks, Chester, Pike, Northampton, Bucks, Montgomery, Philadelphia, and Delaware.

Either by action of the Office of the Solicitor or amendment by the Board, the final requirement for obtaining concurrent use registrations without instituting a concurrent use proceeding before the Board will be fulfilled.

Accordingly, upon action of the Office of the Solicitor or amendment by the Board to the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) as requested herein pursuant to the Court Order, the Parties request the following pursuant to the Court Order and as otherwise agreed between the parties:

1. MAVIS DISCOUNT TIRE Stylized (Application Serial Number 87/585,780) be restricted to the Mavis Geographic Region, and

2. MAVIS DISCOUNT TIRE Logo (Application Serial Number 87/570,980) be expressly abandoned.

Subject to, and conditioned upon the entry of the requested restriction to the DISCOUNT TIRE Word Mark (Registration Number 4,639,389), the entry of the requested restriction to MAVIS DISCOUNT TIRE Stylized (Application Serial Number 87/585,780), and abandonment of MAVIS DISCOUNT TIRE Logo (Application Serial Number 87/570,980), Opposer hereby withdraws the Opposition, with prejudice.

Respectfully submitted,

Mavis Tire Supply LLC

By: /Neil K. Roman/
Neil K. Roman
Covington & Burling LLP
Counsel for Mavis Tire Supply, LLC

The Reinalt-Thomas Corporation

By: /Brian W. LaCorte/
Brian W. LaCorte
BALLARD SPAHR LLP
Counsel for The Reinalt-Thomas Corporation

November 13, 2019

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

In the Matter of Application Serial Nos. 87/570,980 and 87/585,780
For the Marks: MAVIS DISCOUNT TIRE & Design and
MAVIS DISCOUNT TIRE (Stylized)
Published in the *Official Gazette* on March 20, 2018
Opposition Filed on July 17, 2018

<p>The Reinalt-Thomas Corporation, Opposer, v. Mavis Tire Supply LLC, Applicant.</p>
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Opposition No. 91242454

CERTIFICATE OF SERVICE

I hereby certify that on November 13, 2019, I caused the foregoing Joint Motion for Concurrent Use Registrations Pursuant to Court Order and for Conditioned Withdrawal to be served on counsel for the Applicant, via email, at the following addresses:

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/Neil K. Roman/

Neil K. Roman

Counsel for The Reinalt-Thomas Corporation

Exhibit A

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. 1:18-cv-05877-TCB

**REINALT-THOMAS CONSENT ORDER REGARDING
CONCURRENT REGISTRATION OF THE PLAINTIFF'S AND
DEFENDANT'S RESPECTIVE TRADEMARKS**

Based on the consent of Plaintiff Reinalt-Thomas Corporation d/b/a Discount Tire ("RTC") and Defendant Mavis Tire Supply LLC ("Mavis") (collectively, "Parties"), and pursuant to 15 U.S.C. § 1052(d) and T.M.E.P. § 1207.04, the Court finds that the Parties are entitled to use their respective marks in commerce in separate geographic areas according to the stipulated findings set out below.

Mavis has pending Trademark Application Serial No. 87/585780 for MAVIS DISCOUNT TIRE (and design), which RTC opposed based an allegation of likelihood of confusion with RTC's Registration No. 4,639,389 for DISCOUNT TIRE. *See The Reinalt-Thomas Corporation v. Mavis Tire Supply LLC*, Opposition

No. 91242454 (consolidated in re Trademark Application Serial Nos. 87/570980 and 87/585780), United States Trademark Trial and Appeal Board (“TTAB Opposition”).

The TTAB Opposition has been stayed pending the outcome of the above styled litigation in this Court, where RTC has alleged that the mark MAVIS DISCOUNT TIRE infringes RTC’s mark DISCOUNT TIRE.

Mavis has denied infringement, claimed prior use in certain Northeastern states (defined below), and counterclaimed for cancellation of RTC’s Registration No. 4,639,389.

This Court has made a preliminary finding of infringement, which Mavis has appealed.

To resolve their dispute, the Parties have consented to allow concurrent registration of their respective marks based on separation into different geographic areas reflecting their respective prior use contentions. The Court finds that this geographic separation is sufficient to avoid confusion.

Accordingly, based on the consent of the Parties, and pursuant to 15 U.S.C. § 1052(d) and 37 C.F.R. 2.99(f), the Court finds that each of the Parties is entitled under Lanham Act § 1052(d) to a concurrent federal trademark registration for their respective marks in commerce in separate geographic areas. Section 1052(d)

of the Lanham Act, 15 U.S.C. § 1052(d) authorizes the Director of the United States Patent and Trademark Office¹ to issue concurrent registrations where, as here, confusion is not likely because the Parties use their marks in different geographic areas. Section 1052(d) further provides: “Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce.” *See also* 37 CFR § 2.99 (same).

Other than the geographic restrictions set out below, all information necessary to effect these concurrent registrations (mode of trademark use; owner’s names; goods and services; claimed dates of use) is already of record in Registration No. 4.639,389 and Application No. 87/585780. The only information not of record are the geographic restrictions, as set out below.

Accordingly, the Director of the United States Patent and Trademark Office is **DIRECTED** to cause the amendment of RTC’s United States Trademark Registration No. 4,639,389 to exclude the following geographic regions:

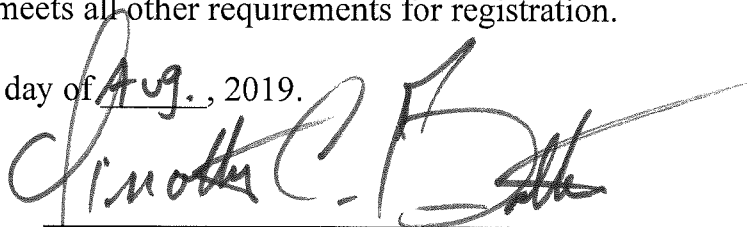
- The entire State of New York;

¹ *See* 15 U.S.C. § 1127 (“The term ‘Director’ means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.”).

- The entire State of New Jersey;
- In Connecticut, the following counties: Litchfield, Fairfield, New Haven, and Hartford;
- In Massachusetts, the following counties: Berkshire, Hampshire, Franklin, and Hampden; and
- In Pennsylvania, the following counties: Tioga, Lycoming, Union, Snyder, Juniata, Perry, Cumberland, Adams, Bradford, Sullivan, Columbia, Montour, North Cumberland, Dauphin, York, Susquehanna, Wyoming, Luzerne, Schuylkill, Lebanon, Lancaster, Wayne, Lackawanna, Monroe, Carbon, Lehigh, Berks, Chester, Pike, Northampton, Bucks, Montgomery, Philadelphia, and Delaware.

Further, based on the consent of the Parties, it is **ORDERED** that (1) the Director of the United States Patent and Trademark Office allow Applicant Mavis to amend and restrict its Application Serial No. 87/585780 to the territory above excluded from RTC's Registration No. 4,639,389; and (2) once Mavis's Application Serial No. 87/585780 has been restricted to the above territory, dismiss RTC's opposition to the Application Serial No. 87/585780 and allow the opposed mark to be registered, assuming that it meets all other requirements for registration.

IT IS SO ORDERED this 27th day of Aug., 2019.



Timothy C. Batten, Sr.
United States District Judge

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November 13, 2019

By U.S. Mail

Office of the Solicitor
United States Patent and Trademark Office
Mail Stop 8, Director of the United States Patent and
Trademark Office, P.O. Box 1450
Alexandria, Virginia 22313-1450

Re: Restriction of DISCOUNT TIRE, Reg. No. 4,639,389 pursuant to Court Order


Dear Counsel:

The Reinalt-Thomas Corporation (d/b/a “Discount Tire”) (“RTC”) hereby requests that the registration of DISCOUNT TIRE, Registration Number 4,639,389, be restricted pursuant to the August 27, 2019 Order (“Court Order”) issued in the civil action filed by RTC against Mavis Tire Supply, LLC (“Mavis”) captioned *The Reinalt-Thomas Corporation v. Mavis Tire Supply LLC*, USDC NDGA Case No. 1:18-cv-05877-TCB (“Civil Action”) in the United States District Court for the Northern District of Georgia, Atlanta Division (“Court”). A certified copy of the Court Order is being sent by the Court to the Office of the Solicitor, and a copy of the Court Order is included herewith. RTC and Mavis are referred to herein collectively as the “Parties.”


Background

On July 17, 2018 RTC filed an opposition with the Trademark Trial and Appeal Board (“Board”), designated Opposition No. 91242454 (“Opposition”), opposing Mavis’s




applications for registration of the marks , Application Serial Number 87/570,980 (“MAVIS DISCOUNT TIRE Logo”) and




, Application Serial Number 87/585,780 (“MAVIS DISCOUNT TIRE Stylized”) on the ground that such marks are likely to cause consumer confusion with RTC’s previously registered marks DISCOUNT TIRE, Registration



Number 4,639,389 (“DISCOUNT TIRE Word Mark”), , Registration Number 2,597,123 (“DISCOUNT TIRE DIRECT Logo”) and



, Registration Number 1,319,968 (“DISCOUNT TIRE Logo”).

RTC filed the Civil Action on December 26, 2018, and the Parties filed a Consented Motion with the Board on January 8, 2019, requesting suspension of the Opposition until the final determination of the Civil Action.

The Opposition was suspended by the Board on June 20, 2019.

The Court subsequently made a preliminary finding in favor of RTC, which Mavis appealed in part.

To resolve their dispute, the Parties have consented to allow concurrent registration of their respective marks based on separation into different geographic areas reflecting their respective prior use contentions. The Court found geographic separation as agreed to by the Parties sufficient to avoid confusion and issued the Court Order, a copy is attached as Exhibit A.

Petition

Pursuant to TMEP 1207.04(a), there are two bases on which a concurrent use registration may be issued: (1) a determination by the Trademark Trial and Appeal Board, in either a prior or to-be-instituted concurrent use proceeding, that the applicant is entitled to a concurrent registration; or (2) a final determination by a court of competent jurisdiction of the concurrent rights of the relevant parties to use the same or similar marks in commerce. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.99; TBMP §1102.02.

Given the Court Order, the Parties are requesting that concurrent use registrations be issued on the basis of the latter. When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all the following conditions are fulfilled:

- (1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and
- (2) The court decree specifies the rights of the parties; and
- (3) A true copy of the court decree is submitted to the examining attorney; and
- (4) The concurrent use application complies fully and exactly with the court decree; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

TMEP 1207.04(f).

The Parties have simultaneously filed with the Board a Joint Motion for Concurrent Use Registrations Pursuant to Court Order and Conditioned Withdrawal of the Opposition (“Motion”), attached as Exhibit B, which fulfills the first four requirements set forth above.

As to TMEP 1207.04(f)(5), the Parties desire for the involved registration, DISCOUNT TIRE Word Mark (Registration Number 4,639,389), to be restricted in accordance with the Court Order to fulfill the final requirement for obtaining concurrent use registrations without instituting a concurrent use proceeding before the Board. However, because the DISCOUNT TIRE Word Mark was merely relied on and not subject to cancellation or counterclaim by Mavis as part of the above-captioned Board proceeding, the Parties believe that it is possible that the Board may conclude that it does not have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) and that it cannot therefore restrict Registration Number 4,639,389 in accordance with the Court Order. 37 C.F.R. §2.133; TBMP 514.

Therefore, out of the abundance of caution, simultaneously with filing the Motion, the Parties are filing this request that the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) be amended in accordance with the Court Order.

If the Board determines that it does not have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389), RTC hereby requests that the Director amend

the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) according to the Court Order to *exclude* the following geographic regions from the registration (hereinafter referred to as the “Mavis Geographic Region”):

- The entire State of New York;
- The entire State of New Jersey;
- In Connecticut, the following counties: Litchfield, Fairfield, New Haven, and Hartford;
- In Massachusetts, the following counties: Berkshire, Hampshire, Franklin, and Hampden; and
- In Pennsylvania, the following counties: Cameron, Tioga, Lycoming, Union, Snyder, Juniata, Perry, Cumberland, Adams, Bradford, Sullivan, Columbia, Montour, Northumberland, Dauphin, York, Susquehanna, Wyoming, Luzerne, Schuylkill, Lebanon, Lancaster, Wayne, Lackawanna, Monroe, Carbon, Lehigh, Berks, Chester, Pike, Northampton, Bucks, Montgomery, Philadelphia, and Delaware.

In the event that the Board determines that it does not have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389), the Parties have also requested in the Motion filed with the Board that the Opposition be suspended until the Solicitor’s Office or Director acts on this request and restricts the DISCOUNT TIRE Word Mark (Registration Number 4,639,389) in accordance with this request and the Court Order.

If the Board determines that it does have jurisdiction over the DISCOUNT TIRE Word Mark (Registration Number 4,639,389), RTC’s request herein is moot.

Office of the Solicitor
November 13, 2019
Page 6

Very truly yours,



Brian W. LaCorte

BWL/tmc
Enclosures

cc: Neil K. Roman