

**IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

Michelin North America, Inc.,

Plaintiff,

VS.

Tri-Ace Wheel & Tire Corporation,

Defendant.

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CIVIL ACTION FILE

NO. _____

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Michelin North America, Inc. (hereinafter “Michelin”), for its Complaint against Defendant Tri-Ace Wheel & Tire Corporation (“Tri-Ace”), hereby alleges, upon personal knowledge as to itself and its own acts, and on information and belief as to all other matters, based on an investigation made by and through its counsel, as follows:

NATURE OF THE ACTION

1. This is a civil action for infringement of United States Design Patent No. D728,457 (hereinafter “’457 patent”) in violation of the Patent Act of the United States, 35 U.S.C. § 101 *et. seq.* The making, use, sale, offer for sale, and/or importation of tires having the tire tread presented by Defendant Tri-Ace’s tire sold under the name ALL TERRAIN II under the BLACK BEAR brand infringes the claimed tire tread design of the ’457 patent. Accordingly, Michelin seeks damages for Tri-Ace’s infringement, a permanent injunction barring Tri-Ace from further tortious actions, and other appropriate relief.

PARTIES

2. Plaintiff Michelin is a New York corporation having its principal place of business at 1 Parkway S., Greenville, South Carolina, 29605, United States.
3. Defendant Tri-Ace exists under the laws of the State of Texas as a domestic for-profit corporation with its principal place of business at 3203 S Sam Houston Parkway East, Suite 100, Houston, Texas 77047. The BLACK BEAR website, <http://blackbeartire.com/index.php?case=archive&act=list&catid=14>, purports to identify a BLACK BEAR entity only as “Black Bear USA” but provides no corporate or other legal entity designation and lists its United States address as: 3203 S Sam Houston Parkway East, Suite 100, Houston, Texas 77047, i.e. the address for Tri-Ace. Further, a press release presented on the BLACKBEAR site, at <http://www.blackbeartire.com/index.php?case=archive&act=list&catid=3>, is titled “Dust Brothers Motorsports with TRI-ACE tires” and references use of TRI-ACE brand tires. Upon information and belief, BLACK BEAR is a brand of Defendant Tri-Ace.
4. Upon information and belief, Plaintiff alleges that Defendant Tri-Ace is engaged in importing, selling, and/or offering for sale, in the United States, the tires at issue in this lawsuit, including importing such tires from China, displaying such tires at the Specialty Equipment Market Association (SEMA) tradeshow in Las Vegas, Nevada, and selling such tires through a United States distributor, SimpleTire LLC, of Trevose, PA, and on the AMAZON website.

JURISDICTION AND VENUE

5. This is an action for design patent infringement arising under the Patent Act, 35 U.S.C. § 101 *et seq.* The Court has subject matter jurisdiction over this action pursuant to 28

U.S.C. § 1331 (federal question) and 28 U.S.C. § 1338(a) (action arising under the Patent Act).

6. The Court has personal jurisdiction over Tri-Ace for one or more of the following reasons:

- a. Tri-Ace is incorporated in the State of Texas and resides in this District;
- b. Tri-Ace maintains an in-state registered agent for service of process. That registered agent is Peter Chen, 3203 S Sam Houston Parkway East, Suite 100, Houston, Texas 77047. When said agent is served with copies of the Summons and Complaint in this matter, Tri-Ace will be subject to the jurisdiction of this Court.
- c. The exercise of personal jurisdiction over Tri-Ace by this Court is consistent with the Federal Due Process Clause, Tri-Ace having established minimum contacts within this forum such that the exercise of jurisdiction over Tri-Ace would not offend traditional notions of fair play and substantial justice;
- d. Upon information and belief, Tri-Ace has done and continues to do business in the State of Texas, including in this District; and
- e. Upon information and belief, Tri-Ace directs into the State of Texas, including in this District, commerce, goods and services.

7. Venue is proper in this District pursuant to 28 U.S.C. § 1400(b) because Tri-Ace resides in this District, in that it is incorporated within the State of Texas and has a registered office within this District.

FACTUAL BACKGROUND

8. Michelin is a leader in manufacturing and innovation in the field of vehicle tires and tire tread designs. Michelin's tire brands include MICHELIN[®], BFGOODRICH[®], and UNIROYAL[®]. Michelin is devoted to bringing cutting-edge designs and technology to the consuming public, for example through tires manufactured and sold by Michelin, including the BFGOODRICH ALL-TERRAIN T/A[®] KO2 tire.
9. On May 5, 2015, United States Design Patent No. D728,457 was duly and legally issued by the United States Patent and Trademark Office. A true and correct copy of the '457 patent is attached as Exhibit A. The '457 patent is valid, enforceable and currently in full force and effect.
10. Michelin is the owner and assignee of all substantial rights, title and interest in the '457 patent, including the right to bring this action and enforce the '457 patent against infringers, and to collect damages for all relevant times.
11. Michelin makes, sells and promotes tire products whose ornamental tire tread designs are protected by the '457 patent. These products include tires sold under the name ALL-TERRAIN T/A[®] KO2 under the BFGOODRICH[®] brand, which are offered for sale and/or sold in the United States, including in Texas.
12. Michelin has practiced the '457 patent in connection with the commercialization of its BFGOODRICH ALL-TERRAIN T/A[®] KO2 tires, as shown for example in the side-by-side comparison of the treads of the '457 patent and the Michelin tire below:

'457 Patent	BFGOODRICH ALL-TERRAIN T/A® KO2 Tire
	

13. Michelin has extensively promoted, advertised and used the tread design of the '457 patent, through Michelin's BFGOODRICH ALL-TERRAIN T/A® KO2 tire, in a variety of media, including, but not limited to, brochures, point of purchase display materials, advertisements, trade show displays, and on the Internet.
14. The claimed design of the '457 patent includes a portion thereof disposed on the tire sidewall, as indicated in Figure 1 below at A1-A3, and a portion thereof disposed at the tire tread center, as indicated in Figure 2 below at A4-A6. *See also* Exhibit A at Figures 1 and 2. The sidewall portion includes repeating pairs of alternating two-lobed elements A1 and A2 above the sidewall and generally U-shaped elements A3 extending down onto the sidewall from respective adjacent pairs of two-lobed elements.

Figure 1

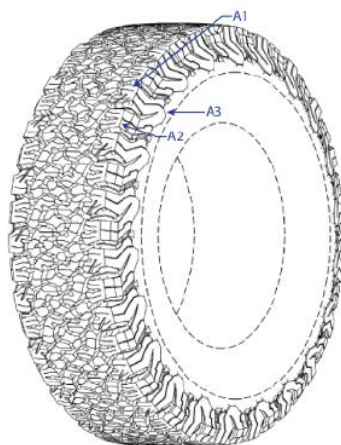


FIGURE -1-

15. The central portion, depicted below at A4-A6 and in Figure 2 of Exhibit A, comprises a series of repeating groups of a right-facing generally C shaped element A4, a center generally S shaped element A5, and a left-facing generally C shaped element A6.

Figure 2

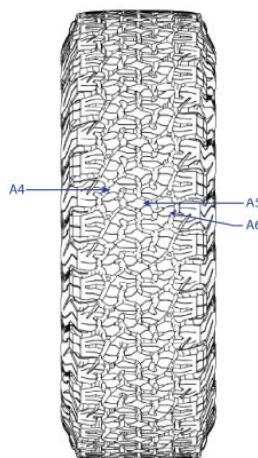


FIGURE -2-

16. Michelin and Tri-Ace both compete in the tire industry. Tri-Ace sells its BLACK BEAR ALL TERRAIN II tire in competition with Michelin.
17. Upon information and belief, Tri-Ace owns and operates the website <http://blackbeartire.com/>. Upon information and belief, Tri-Ace offers tire products, including the BLACK BEAR ALL-TERRAIN II tire, for sale in the United States through distributors and through the AMAZON website <http://www.amazon.com>. Photographs of a BLACK BEAR ALL-TERRAIN II tire that was purchased from SimpleTire LLC, of Trevose, PA, (the “BLACK BEAR Tire”), are provided below at Paragraph 20, Figures 3-6 and Paragraph 23, Figure 8.
18. Upon information and belief, the BLACK BEAR Tire was manufactured in China (DOT PPMP 2617¹) and imported by Tri-Ace into the United States.
19. The Tri-Ace BLACK BEAR ALL-TERRAIN II tire includes a tread design that nearly identically replicates the ornamental design of the ’457 patent.
20. As shown in Figures 3-6 below at Paragraph 20, the BLACK BEAR ALL-TERRAIN II tire tread design has a sidewall portion with repeating pairs of alternating two-lobed elements B1 and B2. Generally U-shaped elements B3 extend down onto the sidewall from respective adjacent pairs of two-lobed elements.
21. As depicted in Figures 3-6 below, the BLACK BEAR ALL-TERRAIN II tread design has a central portion having a series of repeating groups of a right-facing generally C

¹ The “PP” notation is as plant code that indicates the BLACK BEAR Tire was manufactured by Shandong Guofeng Rubber & Plastic Co., LTD in Dawang Town, Guangrao, China. See TSG, *Tire DOT Plant Codes – Sorted by Plant Code*, <http://www.tiresafetygroup.com/tire-dot-plant-codes-sorted-plant-code/> (last visited Nov. 21, 2019); HARRIGER, *New Tire Manufacturers Plant Codes*, Tire List 7 Code N1-V4, <http://www.harriger.com/tire7.htm> (last visited Nov. 21, 2019).

shaped element B4, alternating center elongated elements B5 and B6, and a left-facing generally C shaped element B7.

Figure 3

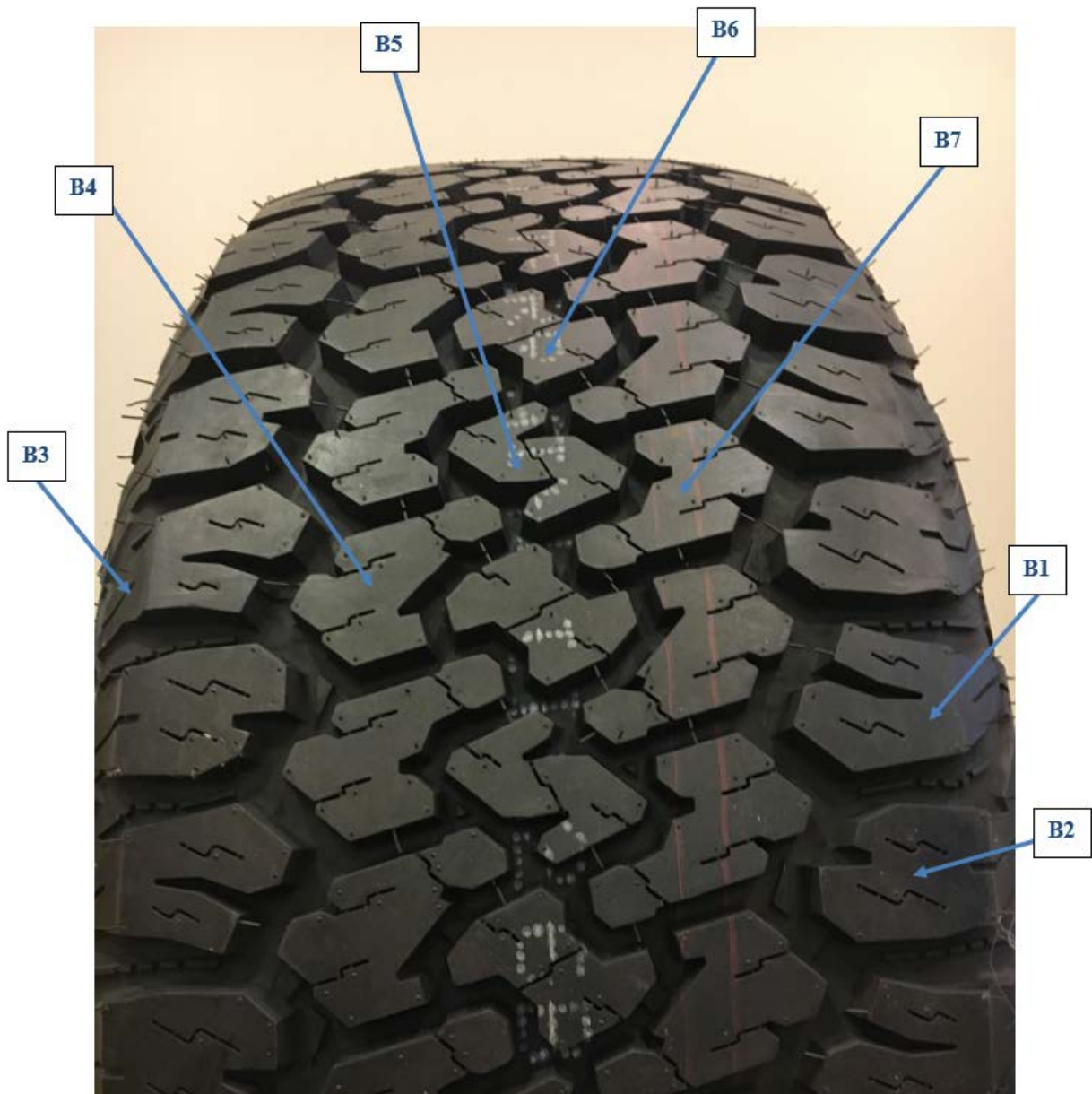


Figure 4

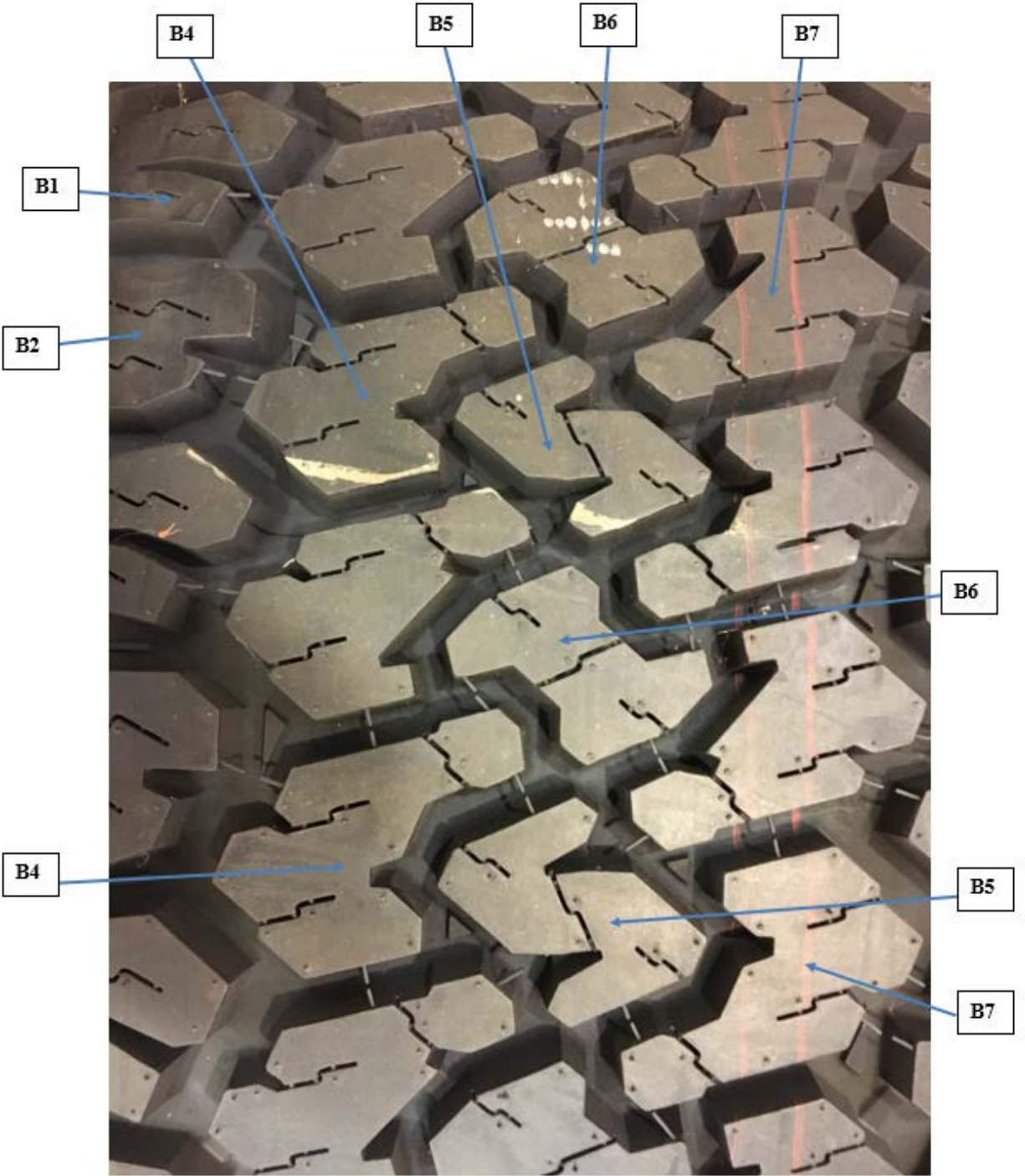


Figure 5

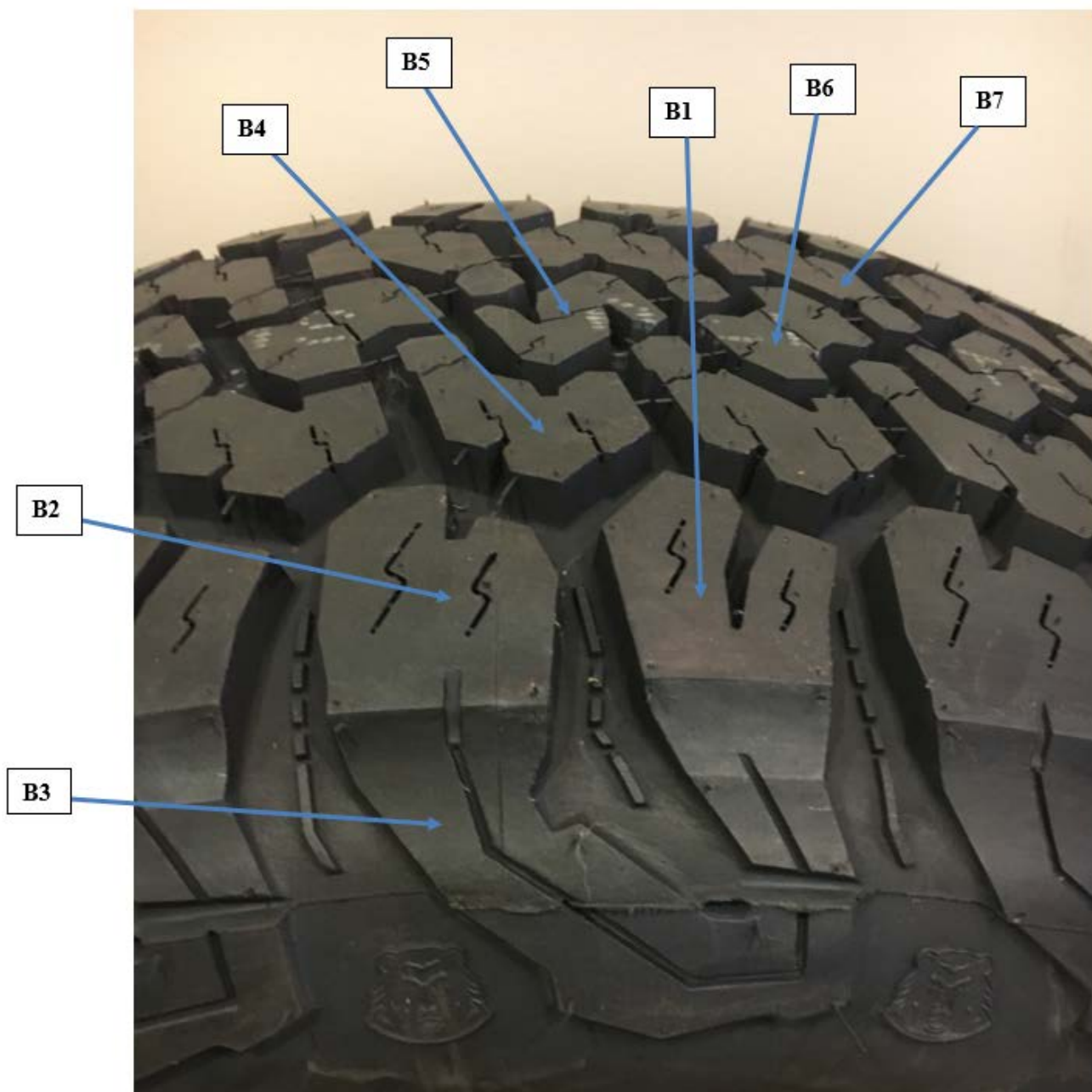
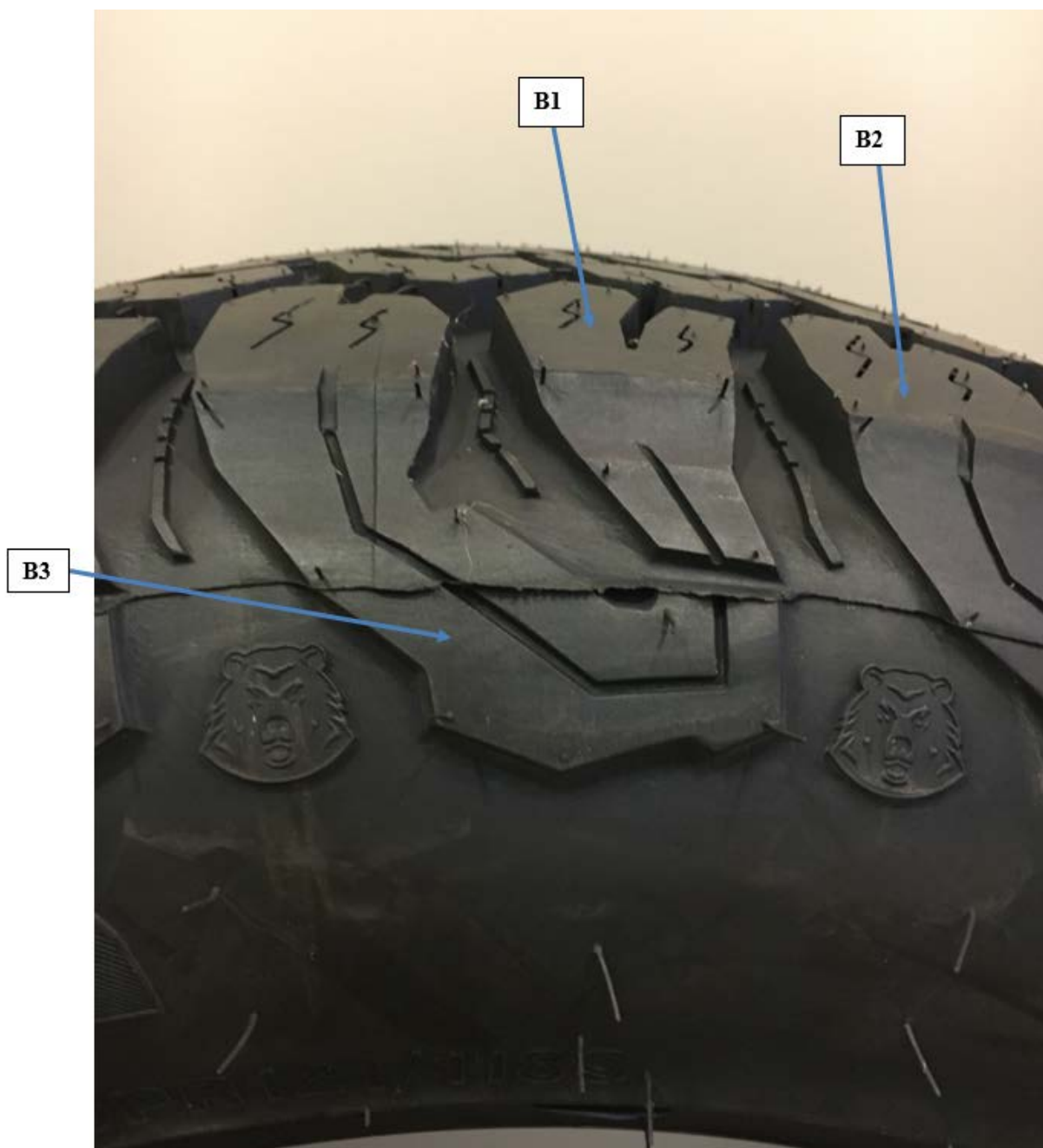


Figure 6



22. Side-by-side comparisons of the '457 patented design and the BLACK BEAR ALL-TERRAIN II tire tread design are provided below in Figures 7 and 8:

Figure 7

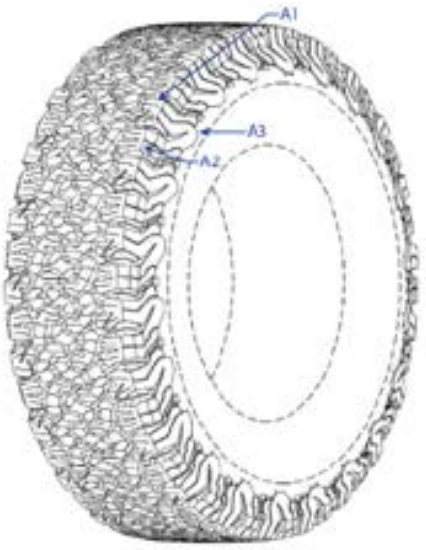
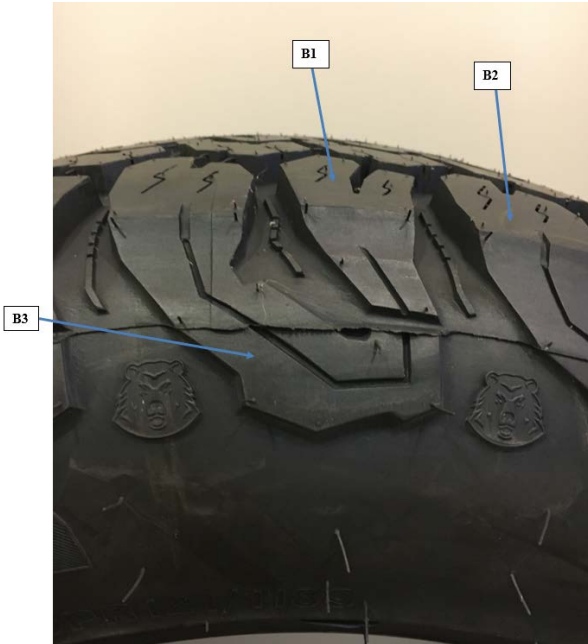
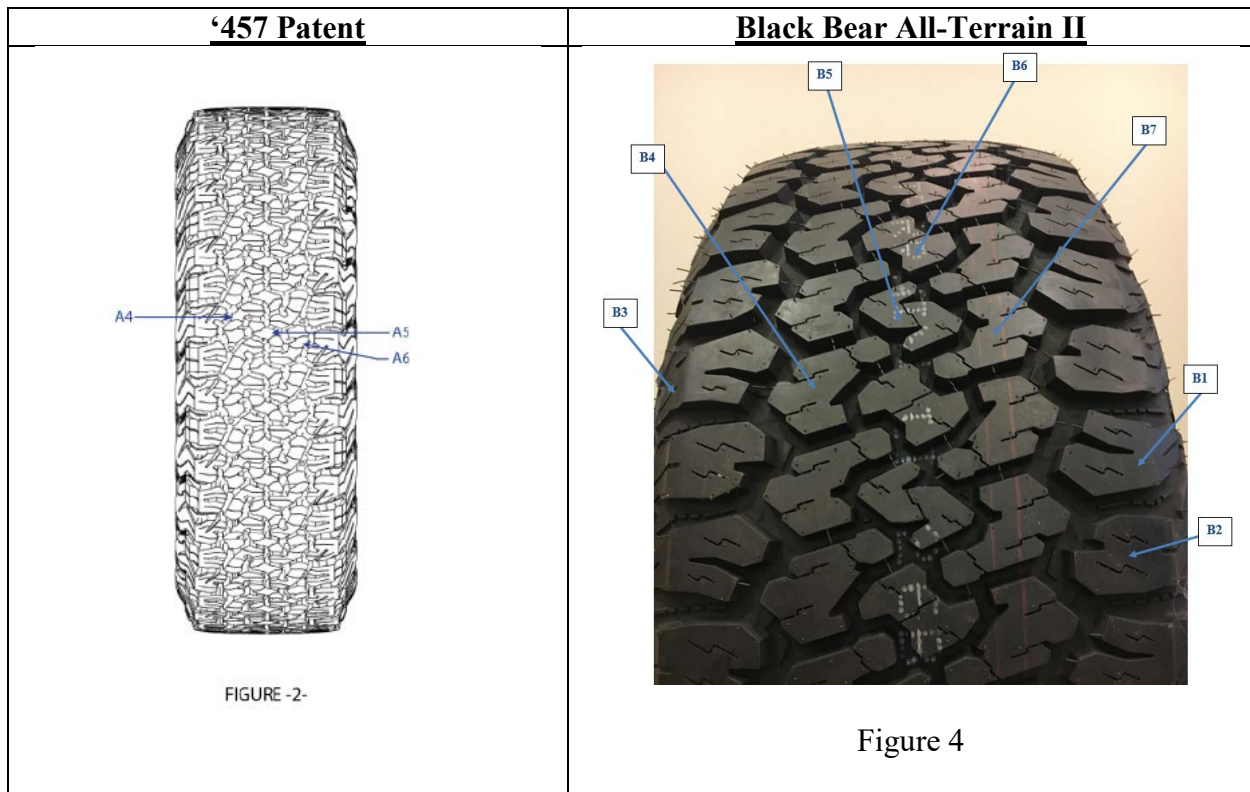
<u>'457 Patent</u>	<u>Black Bear All-Terrain II</u>
 <p>FIGURE -1-</p>	 <p>Figure 6</p>

Figure 8



23. A visual comparison of the BLACK BEAR ALL-TERRAIN II tire tread design and the '457 patented design demonstrates that the infringing BLACK BEAR tire has a tread design that is the same or substantially the same as the tread design of the '457 patent.
24. The tread designs are so similar as to be nearly identical, such that an ordinary observer familiar with the relevant prior art, giving such attention as a purchaser usually gives, would find the claimed design of the '457 patent and the tread design of the BLACK BEAR tire to be substantially the same, such that the ordinary observer would be deceived into believing the BLACK BEAR tire tread design is the design claimed by the '457 patent.

25. Michelin has not granted a license or any other authorization to Tri-Ace to make use, offer for sale, sell, or import tires that embody the tread design in the '457 patent and which is proprietary to Michelin.

COUNT I

TRI-ACE'S INFRINGEMENT OF UNITED STATES PATENT NO. D728,457

26. Michelin incorporates by reference the allegations, and figures, contained in paragraphs 1-25 above.
27. Tri-Ace has directly infringed and continues to directly infringe the '457 patent by, *inter alia*, making, using, offering for sale, selling and/or importing in the United States products infringing the ornamental design covered by the '457 patent in violation of 35 U.S.C. §§ 271 and 289, including but not limited to the BLACK BEAR ALL-TERRAIN II tire.
28. Tri-Ace has infringed the '457 patent because, *inter alia*, the tread of the BLACK BEAR ALL-TERRAIN II tire is virtually identical to the design claimed by the '457 patent, and, looking at the two products as a whole, an ordinary observer would find the tread designs of the BLACK BEAR ALL-TERRAIN II tire and of the '457 patent to be substantially the same.
29. Upon information and belief, Tri-Ace also induced, and continues to induce, others to infringe the '457 patent by encouraging and promoting the use and/or sale by others of tires that infringe the '457 patent, including the BLACK BEAR ALL TERRAIN II tires, in violation of 35 U.S.C. § 271(b).
30. Tri-Ace has had actual knowledge of the '457 patent since at least the date on which Tri-Ace received service of the complaint in this Action.

31. Tri-Ace's direct and induced infringement of the '457 patent has caused damage to Michelin.
32. Tri-Ace's infringing activities will continue unless enjoined by this Court pursuant to 35 U.S.C. § 283 and/or its equitable powers.
33. Tri-Ace's infringement of the '457 patent was undertaken without authority, permission, or license from Michelin in violation of 35 U.S.C. § 271.
34. Michelin is entitled to a complete accounting of all revenues and profits derived by Tri-Ace from the unlawful conduct alleged herein, including without limitation, Tri-Ace's total profit pursuant to 35 U.S.C. § 289.
35. Michelin is entitled to a permanent injunction preventing Tri-Ace from further infringing the '457 patent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff, Michelin, prays for the following relief:

- A. A judgment entered in favor of Michelin on its claim that Tri-Ace has directly and/or indirectly infringed the '457 patent;
- B. A permanent injunction enjoining Tri-Ace, its respective officers, directors, agents, and employees and all those in concert or participation with it who receive notice of this judgment by personal service or otherwise, from making, importing, selling, using, and offering to sell infringing products practicing the '457 patent and from otherwise infringing, contributing to infringement of, and actively inducing infringement of the '457 patent;
- C. A judgment and order that Tri-Ace make an accounting to Michelin and pay over to Michelin the extent of Tri-Ace's total profit and revenue realized and derived from its

infringement of the '457 patent, and actual damages to Michelin in an amount not less than a reasonable royalty for Tri-Ace's infringement;

- D. An award of costs of this action together with Michelin's reasonable attorney fees, pursuant to 35 U.S.C § 285 for this case being exceptional, and as permitted under other applicable laws;
- E. An award of interest, including prejudgment interest, on all damages; and
- F. An award to Michelin of such further relief as the Court deems just and proper.

DEMAND FOR TRIAL BY JURY

Michelin hereby demands a trial by jury as to all issues so triable.

Dated: December 17, 2019

Respectfully submitted,

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