

IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION

_____)	
O.E. WHEEL DISTRIBUTORS, LLC,)	
)	
Plaintiff,)	
)	Civil Action No.: 8:21-cv-02573-CEH-SPF
vs.)	
)	
)	Jury Trial Demanded
MOBILE HI-TECH WHEELS, LLC)	
and WHEEL PROS, LLC,)	
)	
Defendants.)	
_____)	

**SECOND AMENDED COMPLAINT FOR PATENT INFRINGEMENT AND
DEMAND FOR JURY TRIAL, INJUNCTIVE RELIEF SOUGHT**

Plaintiff O.E. Wheel Distributors, LLC (hereinafter “OE Wheels” or “Plaintiff”), brings this action against Mobile Hi-Tech Wheels, LLC d/b/a MHT Luxury Alloys and Wheel Pros, LLC (collectively the “Defendants”) for infringing OE Wheels’ patented design, U.S. Patent No. D890,069 (**Exhibit 1**). OE Wheels seeks preliminary and permanent injunctions; treble damages; accounting of profits; compensatory damages; reasonable royalty including for the period following publication of the application; pre-judgment interest; attorneys’ fees; and all costs resulting from Defendants’ infringement of OE Wheels’ patented design.

THE PARTIES

1. Plaintiff OE Wheels is a Florida limited liability company with its principal offices located at 1916 72nd Drive East, Sarasota, Florida 34243.

2. OE Wheels has been in business in the State of Florida since May 2001.

3. Defendant Mobile Hi-Tech Wheels, LLC d/b/a MHT Luxury Alloys (“MHT Luxury Alloys”) is a Delaware limited liability company with its principal office located at 6101 Knott Avenue, Buena Park, California 90620.

4. On information and belief, Defendant MHT Luxury Alloys operates a distribution facility at 3719 Corporex Park Drive, Tampa, Florida 33619.

5. Defendant Wheel Pros, LLC (“Wheel Pros”) is a Delaware limited liability company with its principal office located at 5347 South Valentia Way, Suite 200, Greenwood Village, Colorado 80111-3145 and a registered address at 1200 South Pine Island Road, Plantation, Florida 33324.

6. On information and belief, Defendant Wheel Pros operates a distribution facility at 7022 TPC Drive, Suite 750, Orlando, Florida 32822.

7. On information and belief, Defendant Wheel Pros merged with ‘MHT Luxury Wheels, Inc.’ in May 2019, thereafter operating as a joint enterprise and selling the Accused Products under the ‘Wheel Pros’ name. **Exhibit 2.**

8. On information and belief, Defendants operate as a joint enterprise.

JURISDICTION AND VENUE

9. This is an action for design patent infringement under 35 U.S.C. §§ 271 and 289.

10. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338, both because the action involves a federal question and also because the action involves a patent.

11. This Court has personal jurisdiction over Defendants because they (a) have sold infringing products in the State of Florida, within the Middle District of Florida; (b) have purposely directed their activities toward the State of Florida; and (c) have established systematic and continuous contacts with the State of Florida, including distributing the infringing products in the Middle District of Florida from facilities operated by Defendants located in the Middle District of Florida.

12. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391 and 1400 because (a) a substantial part of the acts of infringement that give rise to OE Wheels' claims occurred in this District, (b) Defendants have sold and offered to sell infringing products in this District; and (c) Defendants have a sufficient connection with the Middle District of Florida, including having a regular and established place of business in the Middle District of Florida, to make venue proper in this District.

BACKGROUND

13. OE Wheels is an industry leader in the design, engineering, manufacturing and sales of Original Equipment wheels, replica wheels, aftermarket wheels, and automotive parts. Incorporated in 2001, OE Wheels' operation comprises 108,000 square feet of warehouse and office space in Southwest Florida, holding an inventory base of up to 80,000 wheels.

14. Among its staff, OE Wheels counts engineers, accountants, marketing specialists, wheel technicians, customer service representatives, inventory specialists and graphic designers.

15. OE Wheels is also an accredited member of the Better Business Bureau (with an A+ rating) and a reputation for high customer satisfaction (*e.g.*, 4.9/5 stars on Google).

16. Utilizing complete supply chain control, OE Wheels offers wholesale pricing to the public while maintaining an unsurpassed focus on product safety and quality. Over the past 21 years, OE Wheels has forged relationships with some of the world's highest quality, ISO 9001 certified wheel manufacturers. Many of these same facilities also produce wheels for some of the largest names in the US domestic OEM brand lineup. All of the products are designed, engineered manufactured and tested to adhere strictly to all SAE-J2530 requirements and are backed by a lifetime structural warranty.

17. OE Wheels sells wheel rims with unique and distinctive designs, many of which are protected by valid and enforceable U.S. patents.

18. For example, OE Wheels owns U.S. Patent No. D890,069 entitled “Wheel Rim” to protect its unique proprietary design (hereinafter the “’069 Design Patent”). **Exhibit 1**.

19. OE Wheels is the exclusive authorized manufacturer and distributor of products that practice the ’069 Design Patent in the United States.

20. Without authorization, Defendants have made, used, sold and offered to sell, and continue to make, use, sell and offer to sell wheel rims which infringe the ’069 Design Patent.

21. On August 14, 2020, OE Wheels caused a letter to be sent to Defendant Wheel Pros, identifying the ’069 Design Patent and encouraging Defendants to examine the Accused Product in light of ’069 Design Patent. **Exhibit 19**.

U.S. DESIGN PATENT NO. D890,069

22. OE Wheels’ rights in the ’069 Design Patent were assigned to it via an agreement executed on July 24, 2018 and recorded October 7, 2020. **Exhibit 3**.

23. OE Wheels filed an international design registration application pursuant to the Hague Agreement Concerning the International Registration of Industrial Designs (the “Hague Agreement”), on December 4, 2018. This application was reviewed by the World Intellectual Property Organization

(“WIPO”) and assigned International Registration No. DM/202267 (the “International Application”). The International Application designated both Canada and the United States as contracting parties. The International Application published to the public on August 16, 2019.

24. WIPO transmitted the application to the United States Patent and Trademark Office (“USPTO”) which assigned U.S. Application Number No. 35/507,229 (the “’229 Application”). The ’229 Application received the benefit of the International Application file date, December 4, 2018. The ’229 Application issued on July 14, 2020 as the ’069 Design Patent. **Exhibit 1**.

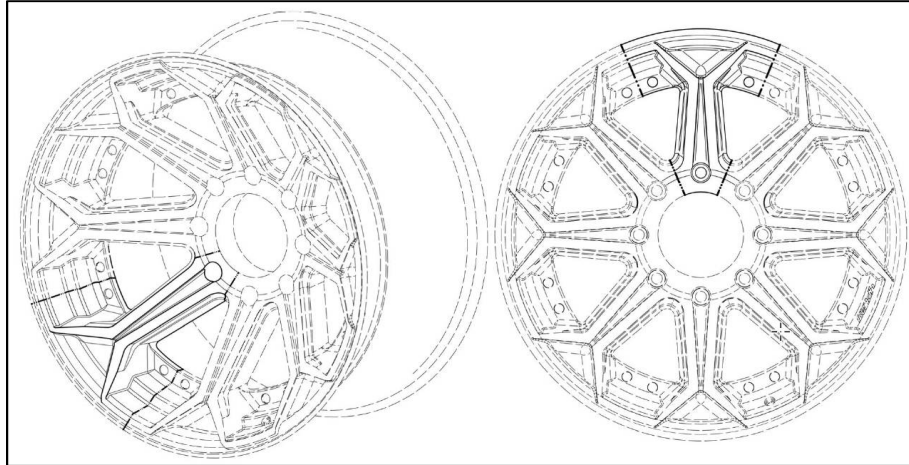
25. The patent claim and the drawings from the ’069 Patent are identically present in the International Application as it published on August 16, 2019.

26. OE Wheels obtained provisional rights in the ’069 Design Patent no later than August 16, 2019, when the International Application was published designating the United States as a contracting party. *See* 35 U.S.C. § 154(d).

27. The ’069 Design Patent is presumed valid and enforceable.

28. The validity of the ’069 Design Patent has never been challenged.

29. The ’069 Design Patent claims “[t]he ornamental design for [a] wheel rim” as shown below:



30. The claim scope of the '069 Design Patent does not include the “bolt-hole.”

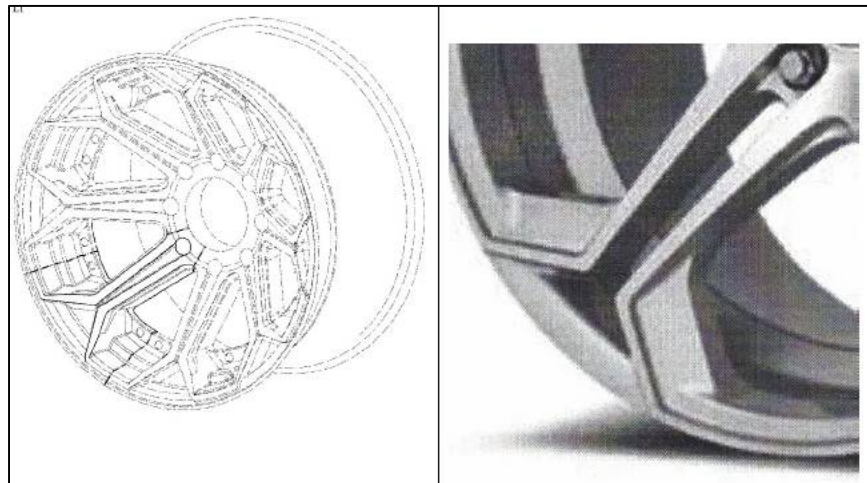
31. The “bolt-hole” depicted in the '069 Design Patent is purely functional.

32. In a sworn declaration executed on December 2, 2010 and filed as ECF 38 in Case No. CV09-07583, styled *Mobile Hi-Tech Wheels vs. Direct Tire & Wheel, Inc.*, in the Central District of California, Arthur Hale, Jr., said: “The lug nut holes shown in the patents for the Big Homie wheels are purely functional.” See **Exhibit 29**.

33. In a sworn declaration executed on December 1, 2010 and filed as ECF 36 in Case No. CV09-07583, styled *Mobile Hi-Tech Wheels vs. Direct Tire & Wheel, Inc.*, in the Central District of California, Rick Pruden said: “The lug nut holes shown in the patents for the Big Homie wheels are purely functional.” See **Exhibit 30**.

34. The lug nut holes depicted in the '069 Design Patent are purely functional.

35. There are substantial differences in the overall visual appearance as between the '069 Design Patent (below, left) and Defendants' "Foose" wheel (below, right), which Defendants' have asserted as prior art.



36. The '069 Design Patent discloses a wheel rim that is concave.

37. No portion of '069 Design Patent is convex.

38. The Foose wheel is not concave.

39. The Foose wheel is substantially flat.

40. A portion of the Foose wheel is convex.

41. The spoke of the '069 Design Patent is a single member with no void in its base.

42. Each spoke of the Foose wheel is comprised of two members (resembling a pair of hockey sticks) wherein a void is formed between them.

43. The '069 Design Patent includes a decorative hole to the right and left side of the top of the spoke.

44. The Foose wheel does not include decorative holes to the right or left side of the top of the spoke.

45. OE Wheels sells a line of wheel rims called '4Play,' certain of which models practice the '069 Design Patent, including the 4P80 (hereinafter the "OE Wheels Representative Product") (see below).

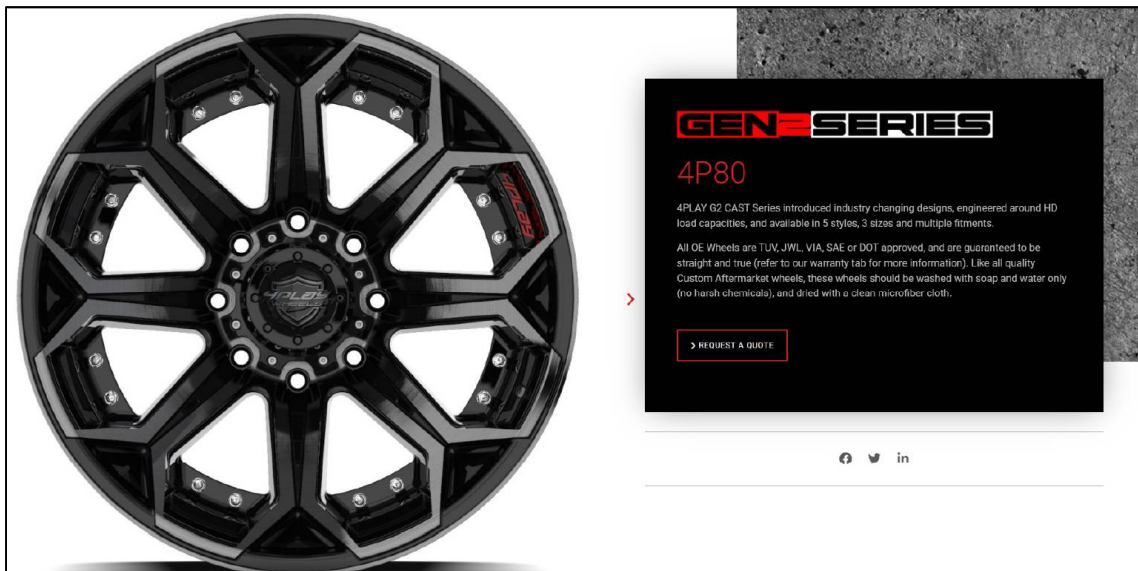


Exhibit 4

46. Each OE Wheels Representative Product complies with the marking requirements of 35 U.S.C. § 287(a). See **Exhibit 4** (reproduced below):



DEFENDANTS' WILLFUL INFRINGEMENT

47. Defendants sell wheel rims that infringe the '069 Design Patent, including the "Siege" line of wheel rims under the "Fuel" brand including at least model numbers "D704" (gloss black), "D705" (platinum), and "D706" (matte black), including each of the unique "Part #'s" associated with each model (collectively the "Accused Product"). See Exhibit 24 through Exhibit 28 (showing Part #s for each of the 18", 20", 22", 24" and 26" diameter iterations of the Accused Product).

48. The Accused Products come in many of the same sizes and finishes as the OE Wheels Representative Products.

49. For example, Defendant MHT Luxury Alloys offers to sell and sells the Accused Products via www.mhtwheels.com, including "through a network of authorized retailer/installers." Exhibit 5; see also Exhibit 6 through Exhibit 8 (website); Exhibit 13, Exhibit 14 (exemplary retailers).

50. By way of further example, Defendant Wheel Pros offers to sell and sells the Accused Products, including via its 2020 catalog (Exhibit 9 (shown

below)) and on its website. See Exhibit 10 through Exhibit 12; see also Exhibit 18 (2021 catalog, pg. 78, also available at <https://www.flipsnack.com/wheelpros/2021-wheelpros-catalog-13lgm85tk5/full-view.html>).



51. By way of further example, on February 6, 2020 OE Wheels caused four Accused Products (Siege Model D704, Gloss Black, 6-lug, size 20x10) to be purchased from Wheel Tec, located at 8060 W. Waters Avenue, Tampa, Florida 33615, in this District. Exhibit 20; see also Exhibit 21.

52. By way of further example, on September 24, 2021, OE Wheels caused one Accused Product (Siege Model D706, Matte Black, 8-lug, size 20x10) to be purchased from CarID.com and shipped to 1906 72nd Drive East, Sarasota, Florida 34243, in this District. Exhibit 22; see also Exhibit 23.

53. On April 29, 2022, Defendants represented that the Accused Wheels were off the market.

54. On April 29, 2022, Defendants were still offering to sell and selling the Accused Products.

55. On information and belief, OE Wheels has lost sales and has been otherwise harmed on account of Defendants offering an identically designed product at a lower price point. **Exhibit 15** (collecting evidence).

56. There is also evidence that consumers have acknowledged the striking similarity between OE Wheels' 4Play line of rims (which embody the '069 Design Patent) and the Accused Product. **Exhibit 16** (collecting evidence); *see also* **Exhibit 17** (below, depicting striking similarity between the '069 Design Patent and the Accused Products, as well as the OE Wheels Representative Product:



57. Defendants' infringement has caused irreparable harm to OE Wheels, including, but not limited to, loss of goodwill, damage to reputation and loss of business opportunities. Here, the patented feature of the infringing wheel rims drives demand for that product, since the patented feature is the design of the wheel rim itself.

58. The balance of equities favors OE Wheels. For example, OE Wheels has not licensed others under the '069 Design Patent. As another example,

Defendants' ongoing conduct undermines the work and money spent developing, validating and commercializing OE Wheels' patented design.

59. A preliminary injunction would be in the public interest, at least because a robust patent system is in the public interest.

COUNT I - WILLFUL DIRECT PATENT INFRINGEMENT

35 U.S.C. § 271(a)

All Defendants

60. OE Wheels re-alleges and incorporates the preceding paragraphs by reference.

61. Defendants have directly infringed and continue to directly infringe OE Wheels' '069 Patent through making, using, selling, and/or offering to sell and distribute the Accused Products.

62. The '069 Patent protects OE Wheels' unique proprietary design, and the Defendants infringe upon the '069 patent by making, using, selling, and/or offering to sell and distribute the Accused Products.

63. Defendants have literally infringed and continue to infringe on the '069 Design Patent.

64. Defendants have infringed and continue to infringe on the '069 Patent pursuant to the Doctrine of Equivalents.

65. On information and belief, Defendants use and have used a network of authorized retailers and installers to sell the Accused Products to consumers.

66. On information and belief, Defendants have had knowledge of the claim of the '069 Patent since at least August 16, 2019 when the International Application published to the public.

67. Defendants have had knowledge of the '069 Design Patent at least since August 14, 2020, by virtue of the notice letter (**Exhibit 19**) but have repeatedly refused to cease their direct infringement.

68. Defendants have had knowledge of the '069 Design Patent and OE Wheels' claims of infringement since email and telephone exchanges between counsel for OE Wheels and counsel for Defendants following the notice letter wherein OE Wheels sought in good faith to avoid litigation.

69. On information and belief, Defendant Wheel Pros offers to sell and does sell the Accused Products. *See Exhibit 9*. Accordingly, Defendant Wheel Pros had knowledge of and/or was willfully blind with respect to the '069 Patent. Since they operate as a single entity, each Defendant's knowledge is imputed to the other, including as it pertains to willful infringement.

70. Defendants have willfully infringed and continue to willfully infringe the '069 Patent. Despite their knowledge of the '069 Patent, Defendants have sold and continue to sell the Accused Products in complete and reckless disregard of OE Wheels' patent rights.

71. As a result of Defendants' unlawful activities, OE Wheels has suffered and will continue to suffer irreparable harm.

72. Defendants' direct infringement of the '069 Patent has injured and continues to injure OE Wheels in an amount to be proven at trial, but not less than a reasonable royalty.

COUNT II - INDIRECT PATENT INFRINGEMENT
35 U.S.C. § 271(b)
All Defendants

73. OE Wheels re-alleges and incorporates the preceding paragraphs by reference.

74. Defendants actively induce others, including customers, resellers, and end-users to make, use, sell, and/or offer to sell and distribute the Accused Products.

75. Defendants have induced and continue to induce infringement of the '069 Patent claim under 35 U.S.C. § 271(b).

76. In addition to directly infringing the '069 Patent, Defendants indirectly infringe by instructing, directing, and/or requiring others, including customers, third party resellers, and end-users to directly infringe the '069 Patent, either literally or under the Doctrine of Equivalents, by making, using, selling, and/or offering to sell and distribute the Accused Products.

77. Defendants also induce end-users to use the Accused Products, including through advertising and marketing efforts.

78. The end-users directly infringe the '069 Patent by using the Accused Products on their vehicles.

79. By advertising, making, using, selling, and offering to sell the Accused Products to others, Defendants have knowingly and intentionally aided, abetted, and induced others to directly infringe the '069 Patent.

80. Defendants' pre-suit knowledge of the '069 Patent, as well their familiarity with OE Wheels as a competitor, and their knowledge that the 4P80 wheels are protected by the '069 Patent, evidences that Defendants knew that the other parties' conduct constituted infringement of a valid patent.

81. The Accused Products have no substantial non-infringing use.

COUNT III - ACCOUNTING AGAINST DEFENDANTS

82. OE Wheels re-alleges and incorporates the preceding paragraphs by reference.

83. OE Wheels is entitled, pursuant to 35 U.S.C. § 289, to recover Defendants' total profit received from their acts of infringement.

84. OE Wheels is entitled, pursuant to 35 U.S.C. § 284, to actual damages sustained by virtue of Defendants' acts of infringement.

85. OE Wheels is entitled, pursuant to 35 U.S.C. § 284 to no less than a reasonable royalty.

86. The specific amount of money due from Defendants to OE Wheels is unknown to OE Wheels and cannot be ascertained without a detailed accounting by Defendants of the precise number of units of infringing material offered for distribution and distributed by Defendants.

PRAYER FOR RELIEF

WHEREFORE, OE Wheels prays that this Court:

1. Enter judgment that all Defendants have directly infringed and continue to directly infringe the '069 Design Patent in violation of 35. U.S.C. §§ 271(a) and 289.
2. Enter judgment that all Defendants have indirectly infringed and continue to indirectly infringe the '069 Design Patent in violation of 35. U.S.C. §§ 271(b);
3. Enter judgment that all Defendants have willfully infringed the '069 Design Patent, both directly and indirectly;
4. Enter a preliminary injunction pursuant to 35 U.S.C. § 283;
5. Enter a permanent injunction pursuant to 35 U.S.C. § 283 enjoining all Defendants, their agents, servants, employees, and attorneys and all those acting in concert or participation with any of the Defendants from making,

using, selling, and/or offering for sale which infringe the '069 Design Patent, including, but not limited to, the Accused Products or colorable imitations thereof, or inducing others to do the same;

6. Enter an Order impounding and calling for the destruction of any and all infringing wheel rims in the possession of any Defendant, including, but not limited to, the Accused Products and the molds from which the accused products are made;

7. Enter an Order declaring that Defendants hold in trust, as constructive trustees for the benefit of OE Wheels, their illegal profits obtained from their distribution of products that infringe OE Wheels' design patent, and requiring Defendants to provide OE Wheels a full and complete accounting of all amounts due and owing to OE Wheels as a result of Defendants' illegal activities;

8. Award to OE Wheels the full amount of damages sustained, including, but not limited to, any and all damage remedies available pursuant to the patent laws of the United States, 35 U.S.C. §§ 271, *et seq.*, which include but are not limited to provisional rights, lost profits, a reasonable royalty, infringers' profits, prejudgment interest, post judgment interest, and treble damages;

9. Enter an Order that this is an exceptional case pursuant to 35 U.S.C. § 285;
10. Enter an Order for Defendants to pay to OE Wheels both the costs of this action and the reasonable attorneys' fees incurred by it in prosecuting this action; and
11. Grant to OE Wheels such other and additional relief as is just and proper.

DEMAND FOR JURY TRIAL

Plaintiff, O.E. Wheel Distributors LLC hereby demands trial by jury of all issues so triable.

This the 8th day of August, 2022.

Respectfully Submitted,

/s/ Mindi M. Richter
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Second Amended Complaint was filed electronically with the Court on August 8, 2022 providing notice to all counsel of record.

/s/ Mindi M. Richter