

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

MICHELIN NORTH AMERICA, INC.,)	
)	Civil Action No. _____
Plaintiff,)	
)	<u>JURY TRIAL DEMANDED</u>
v.)	
)	
MAXAM TIRE NORTH AMERICA INC.,)	
)	
Defendant.)	

COMPLAINT FOR PATENT AND TRADE DRESS INFRINGEMENT

Plaintiff Michelin North America, Inc. (“Plaintiff” or “Michelin”), for its Complaint against Defendant MAXAM Tire North America Inc. (“Defendant” or “MAXAM”), hereby alleges as follows:

NATURE OF THE ACTION

1. This is a civil action for the infringement of United States Design Patent No. D610,073 S (“the D’073 patent” or “patent-in-suit”) under the Patent Laws of the United States, 35 U.S.C. § 100 *et seq.*, and for violation of the Lanham Act, 15 U.S.C. § 1051, *et seq.*, and M.G.L. c. 93A, arising from MAXAM’s manufacture, importation, use, offer to sell and/or sale of infringing tire products.

THE PARTIES

2. Plaintiff Michelin North America, Inc. is a New York corporation having its principal place of business at 1 Parkway South, Greenville, South Carolina, 29615, United States.

3. Upon information and belief, Defendant MAXAM Tire North America Inc. is a Massachusetts corporation having its principal place of business at 300 Rosewood Drive, Suite 102, Danvers, Massachusetts, 01923 United States.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over this complaint pursuant to 28 U.S.C. §§ 1331 and 1338, because this is an action arising under the Patent and Trademark Laws of the United States, 35 U.S.C. § 100 *et seq.* and 15 U.S.C. § 1051 *et seq.* This Court has supplemental jurisdiction over Plaintiff's Massachusetts law claims under 28 U.S.C. § 1367, because those claims are substantially related to Plaintiff's federal claims.

5. This Court has personal jurisdiction over MAXAM because (a) MAXAM is a Massachusetts corporation having its principal place of business in Danvers, Massachusetts, (b) upon information and belief, MAXAM regularly conducts business in Massachusetts through the manufacture and/or sale of products in Massachusetts, and (c) MAXAM committed tortious acts within the Commonwealth of Massachusetts giving rise to this action.

6. Venue is proper under 28 U.S.C. §§ 1391(b) and (c), and/or 1400(b), because MAXAM is subject to personal jurisdiction in this district, and MAXAM has committed tortious acts in the District, including acts of patent infringement and unfair competition.

THE PATENT-IN-SUIT

7. On February 16, 2010, the D'073 patent, entitled "Pneumatic Tire," was duly and legally issued by the U.S. Patent and Trademark Office ("USPTO"). A true and correct copy of the D'073 patent is attached as **Exhibit A**. The D'073 patent is valid, enforceable and currently in full force and effect.

8. Michelin is the exclusive licensee of the D'073 patent, with sole rights to bring this action (including in its own name) and enforce the D'073 patent against infringers, and to collect damages for all relevant times.

THE TRADE DRESS-IN-SUIT

9. The trade dress that is the subject of this suit, which includes the Original XDR Trade Dress and the XDR2 Trade Dress, comprises the elements illustrated and described in paragraphs 17 (Original XDR Trade Dress) and 18 (XDR2 Trade Dress) below (collectively “the XDR Trade Dress”) and is subject to protection under the Lanham Act.

10. Michelin’s reputation and sales have been and will continue to be harmed by the infringement of the XDR Trade Dress by MAXAM for at least the reason that Michelin is the sole manufacturer and distributor in the United States of the tires embodying the XDR Trade Dress and consumers will mistakenly believe that the inferior tire products being sold by MAXAM bearing the XDR Trade Dress are Michelin XDR products, or are endorsed or sponsored by or affiliated with Michelin, resulting in injury to Michelin’s sales and business reputation in the United States.

FACTUAL BACKGROUND

The Parties

11. Michelin is a leader in tire manufacture and innovation, and it conducts business in the United States, including in Massachusetts. Michelin offers tire brands including MICHELIN®, BFGoodrich® and UNIROYAL®. Michelin manufactures and sells tires used for mining vehicles, in particular. Michelin expends significant effort in creating distinctive tread designs and quality tires.

12. Upon information and belief, MAXAM, based in Danvers, Massachusetts, manufactures and offers for sale in the United States tires, including tires for mining vehicles, and is a competitor of Michelin in the field of tires for mining.

13. Upon information and belief, MAXAM owns and operates the website www.maxamtirena.com (see also www.maxamtire.com). Through its website, at its principal

place of business, and/or through third parties MAXAM offers tire products for sale, including MS403 tires.

The Products

14. Michelin makes, sells and promotes tire products whose ornamental tire tread designs are protected by the D'073 patent. These products include without limitation MICHELIN XDR2 S tires. Michelin's tread designs constitute protectable trade dress, which covers other tires in the XDR line.

15. Michelin launched the original XDR line of tires in 2001, and followed up with the XDR2 line of tires in 2011 (which includes without limitation the XDR2 S tires), in order to continue its well-established reputation for providing quality tires for the mining industry. Michelin has produced and sold mining tires since 1959, during which time it has maintained rigorous performance and quality standards for its products.

16. Renderings of Michelin's XDR and XDR2 S tires from marketing materials are below:



XDR



XDR2 S

17. Michelin's Original XDR Trade Dress consists of the overall nonfunctional design of a tread for mining tires comprising the distinctive configuration of the following design elements and as shown in the figure below:

- (1) a centerline block consisting of circumferentially arranged centerline lugs, the centerline lugs being separated from adjacent centerline lugs (in the circumferential direction) by a zigzag pattern; and
- (2) circumferentially arranged left shoulder lugs and right shoulder lugs, wherein (i) the left shoulder lugs curve in a direction different from the direction of curvature of the right shoulder lugs (as viewed in the axial direction) and (ii) the left and right shoulder lugs are separated from the centerline lugs by a sawtooth pattern.

An illustration of these design elements is depicted below:

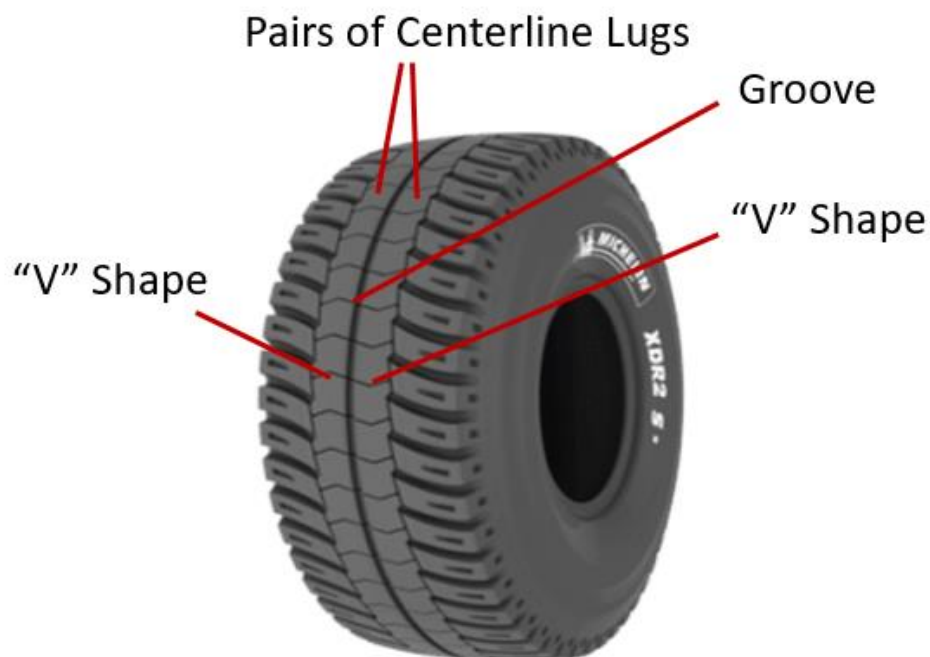


18. Michelin's XDR2 Trade Dress consists of the overall nonfunctional design of a tread for mining tires comprising the distinctive configuration of all of the elements of the Original XDR Trade Dress in further combination with the following design elements and as shown in the figure:

(1) that the centerline block comprises a groove that divides the centerline block into pairs of circumferentially arranged centerline lugs; and

(2) that the zigzag pattern separating adjacent pairs of centerline lugs forms a "V" shape¹ for each lug of the pair.

An illustration of these additional design elements is depicted below:



19. The overall commercial impression of the XDR Trade Dress is unique and inherently distinctive.

¹ A "V" shape pattern is also known as a chevron pattern.

20. As evidenced by numerous other tread designs, there is no requirement for mining tires to use treads that are confusingly similar to the XDR Trade Dress. In this regard, the XDR Trade Dress is nonfunctional because the overall configuration of the design elements comprising the XDR Trade Dress is not essential to the use or purpose of the XDR tires and does not, as a whole, affect the cost or quality of the XDR tire. Notably, there are numerous third-party tread designs in the industry that are not confusingly similar to the XDR Trade Dress.

21. Michelin crafted the XDR Trade Dress to be unique and function as a source identifier, as evidence by the fact that no other market players were using the elements, or confusingly similar variations of the XDR Trade Dress when Michelin first introduced the XDR tires embodying the XDR Trade Dress, including the Original XDR Trade Dress and XDR2 Trade Dress.

22. The XDR and XDR2 lines of tires have revolutionized the performance of the mining tires by providing additional productivity through a slower wear rate, and are recognized by consumers as emanating from Michelin due to the distinctive tread design. Thanks to the XDR line of tires, sales have tripled since 2005; in 2020, the sales of Michelin mining tire have increased by over 50% since 2010, the year before the introduction of the XDR2 tire.

23. Michelin has advertised tires featuring the XDR Trade Dress at trade shows, as well as digital and print media circulated nationwide. Michelin has invested heavily in marketing the tread design of the relevant XDR tires, expending significant resources to promote the aggressive look and feel of the treads of the tires. Michelin has also prominently displayed the Trade Dress in advertising materials because it serves as a strong source indicator.

24. Because of Michelin's efforts, the XDR Trade Dress has become well-known to mining tire customers and end-users, and the mining tire trade generally, as identifying Michelin

as the source of such tires in the United States, which are of high quality and performance capability.

25. Through its website, at its principal place of business, and/or through third parties MAXAM offers tire products for sale, including MS403 tires. An image of an MS403 tire is below:



26. As shown, MAXAM's MS403 tire design includes all of the features of the Original XDR Trade dress: (1) a centerline block consisting of circumferentially arranged centerline lugs, the centerline lugs being separated from adjacent centerline lugs (in the circumferential direction) by a zigzag pattern, and (2) circumferentially arranged left shoulder lugs and right shoulder lugs, wherein (i) the left shoulder lugs curve in a direction different from the direction of curvature of the right shoulder lugs (as viewed in the axial direction) and (ii) the left and right shoulder lugs are separated from the centerline lugs by a sawtooth pattern.

27. In addition, MAXAM's MS403 tire design also includes all of the features of the XDR2 Trade Dress, which includes all of the features of the Original XDR Trade Dress, wherein: (1) the centerline block comprises a groove that divides the centerline block into pairs of

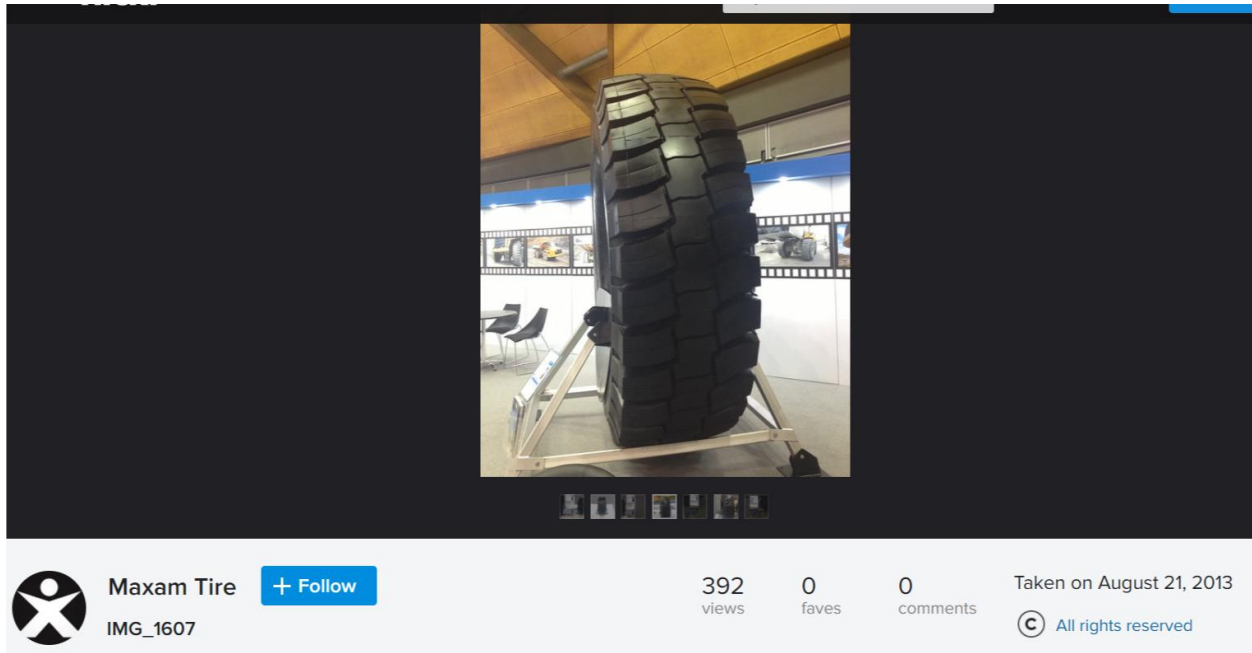
circumferentially arranged centerline lugs; and (2) the zigzag pattern separating adjacent pairs of centerline lugs forms a “V” shape for each lug of the pair.

28. Further, MAXAM’s current marketing materials for its MS403 tire show renderings of the MS403 tire, an example of which is below:



(see <https://maxamtirena.com/en-us/products/mining/ms403/>; see also **Exhibit B**)

29. As shown, the rendering of the MS403 tire lacks a centerline groove, which replicates Michelin’s Original XDR Trade Dress. Upon information and belief, MAXAM previously marketed this version of its MS403 tire, as shown below:



<https://www.flickr.com/photos/maxamtire/9612523621/>

30. Upon information and belief, MAXAM switched from the version of the MS403 tire without the centerline groove (“Version 1”), which infringes the Original XDR Trade Dress, to the current version (“Version 2” (*see* paragraph 25 above)) with the centerline groove, which infringes the Original XDR Trade Dress and the XDR2 Trade Dress, only after Michelin introduced its XDR2 tire embodying the XDR2 Trade Dress.

31. Moreover, Michelin has highlighted in advertising materials the tread design of its XDR2 line as worn. A marketing rendering of an XDR2 tire at 50% worn is below:



XDR2 at 50% Worn

32. The treads of the MAXAM MS403 tire, as worn, are similar to the Michelin XDR2 line as worn. This similarity presents the risk that any quality problems with worn MAXAM's MS403 tires would be improperly attributed to Michelin. A comparison of the MS403 tire and the XDR2 tire, after wear, is provided below:



MAXAM MS403



Michelin XDR2

33. Upon information and belief, MAXAM markets its mining tires to the same customer and end-user base as Michelin.

34. Upon information and belief, a MAXAM salesperson (who formerly worked for Michelin) visited a mining facility of a Michelin customer using Michelin credentials, which causes further confusion as to the source of the MAXAM tires bearing the XDR Trade Dress.

FIRST CLAIM FOR RELIEF

INFRINGEMENT OF THE D'073 PATENT

35. Michelin hereby incorporates by reference paragraphs 1-34 as if fully set forth herein.

36. The claimed design of the D'073 patent is shown in Figures 1 through 4 of the patent and described in the accompanying figure descriptions. See **Exhibit A**. Representative images are below:

FIG. 1

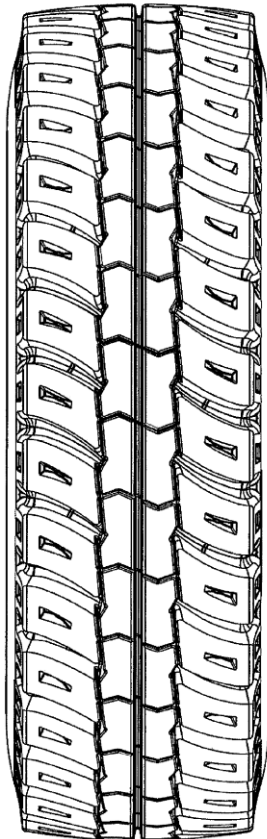
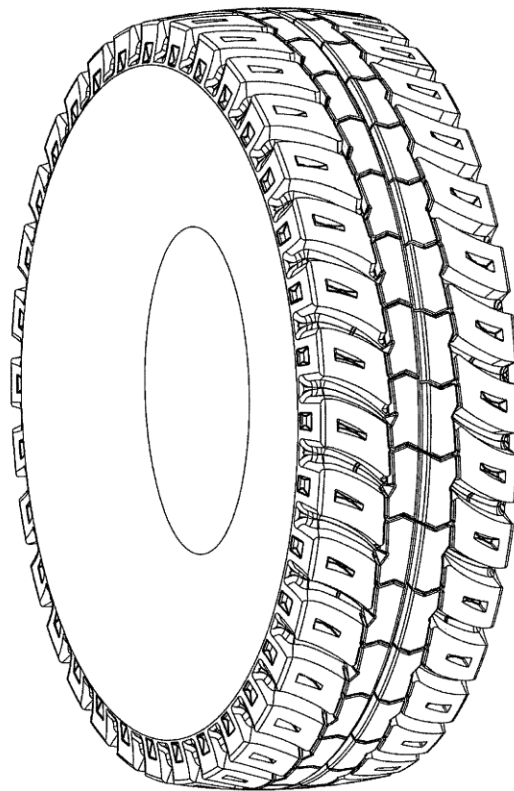


FIG. 2



37. MAXAM offers, at least, the MS403 tires for sale, in various sizes. Representative images of an MS403 tire, photographed from a MAXAM trade display are below:



38. On October 5, 2021, MAXAM announced an additional size option for the MS403 tires—specifically, the MS403 59/80R63 size (<https://maxamtirena.com/en-us/newsroom/press-release/maxam-tire-rigid-haul-truck-ms403-boasts-its-largest-size/>). MAXAM’s press release for the new size option touts the tread pattern as being “aggressive”.

39. In the eye of the ordinary observer familiar with the relevant prior art, giving such attention as a purchaser usually gives, the claimed design of the D’073 patent and the tread design of at least the current version of MAXAM’s MS403 tires are substantially the same, such that the ordinary observer would be deceived into believing that the tread design of MAXAM’s MS403 tire is the design claimed in the D’073 patent.

40. Michelin did not give MAXAM authorization or license to make, use, import, offer to sell, or sell the infringing products.

41. MAXAM has directly infringed, and continues to directly infringe, the D'073 patent by making, using, offering to sell, selling and/or importing tires, including MS403 tires, having substantially the same ornamental design as the design claimed in the D'073 patent, in violation of 35 U.S.C. §§ 271(a) and 289.

42. Upon information and belief, MAXAM also induced, and continues to induce, others to infringe the D'073 patent by encouraging and promoting the use and/or sale by others of tires that infringe the D'073 patent, including but not limited to MS403 tires, in violation of 35 U.S.C. § 271(b).

43. MAXAM has had actual knowledge of the D'073 patent since at least the date on which MAXAM received service of the complaint in this action.

44. Upon information and belief, MAXAM has sold and continues to sell, offer to sell, distribute and market tire products that infringe the D'073 patent, including the MS403 tires, to end consumers and/or resellers with the intent that these parties will use, market, offer to sell and/or sell the products in the United States in a manner that infringes the D'073 patent.

45. Upon information and belief, MAXAM knew or should have known that the use, marketing, offering to sell and selling of the infringing products by MAXAM or its resellers and/or customers would directly infringe the D'073 patent.

46. MAXAM's direct and induced infringement of the D'073 patent has caused and will continue to cause damage to Michelin.

47. MAXAM's direct and induced infringement has also caused and will continue to cause irreparable harm to Michelin unless and until such infringing conduct is enjoined pursuant to 35 U.S.C. § 283 and/or the equitable powers of this Court.

48. Upon information and belief, MAXAM's acts of infringement have been or will be undertaken with knowledge of the D'073 patent. Such acts constitute willful infringement and make this case exceptional pursuant to 35 U.S.C. §§ 284 and 285, and entitle Michelin to enhanced damages and reasonable attorney fees.

SECOND CLAIM FOR RELIEF

UNFAIR COMPETITION IN VIOLATION OF THE LANHAM ACT

49. Michelin hereby incorporates by reference paragraphs 1-48 as if fully set forth herein.

50. This is a claim for unfair competition arising under the Lanham Act Section 43(a) (15 U.S.C. § 1125(a)), for MAXAM's intentional unauthorized use in commerce of trade dresses (in Versions 1 and 2 of the MS403 tires) that are confusingly similar with the Original XDR Trade Dress and XDR2 Trade Dress.

51. As set forth above, Michelin is the only entity with rights to manufacture and sell tires in the United States having the overall look-and-feel of the Original XDR Trade Dress and the XDR 2 Trade Dress. Maxam's unauthorized use of the XDR Trade Dress is likely to cause consumers to mistakenly believe that Maxam is authorized to manufacture and sell Michelin tires, or that Michelin is affiliated with or endorses Maxam.

52. MAXAM's tire design for the MS403 tires is confusingly similar to the XDR Trade Dress, as can be seen by the side-by-side comparison of (on information and belief) Version 1 and Version 2 of the MS403 tire with Michelin the Original XDR Trade Dress and XDR2 Trade Dress as embodied in two Michelin XDR tires, below:



MAXAM MS403 (Version 1)



Michelin XDR



MAXAM MS403 (Version 2)



Michelin XDR2 S

53. MAXAM's current depictions of the MS403 tire in marketing materials are also likely to cause consumer confusion as to the source of the products bearing the Original XDR Trade Dress. A rendering of the MS403 tire from MAXAM marketing materials is below:



(see <https://maxamtirena.com/en-us/products/mining/ms403/>)

54. Therefore, MAXAM's marketing, promotion, and sale of MS403 tires violates Michelin's rights in and to the Original XDR Trade Dress and XDR2 Trade Dress, and constitutes trade dress infringement, false designation of origin, and unfair competition in violation of the Lanham Act.

55. MAXAM's acts constitute a willful and deliberate violation of 15 U.S.C. § 1125(a).

56. MAXAM has earned illicit profits, and Michelin has suffered lost profits, and will continue suffering lost profits from consumer confusion until MAXAM's infringing misconduct is stopped. Damages are yet unknown, but will be proven at trial.

57. Additionally, Michelin's business reputation has been and will continue to be irretrievably harmed due to consumers believing that Maxam's inferior products bearing the XDR Trade Dress are Michelin products, or that Michelin is affiliated with or endorses Maxam and

Maxam's products. Such harm is irreparable, in that it is non-monetary, unquantifiable, and not capable of being cured without equitable or injunctive relief. Pursuant to 15 U.S.C. § 1116(a), Michelin is entitled to a rebuttable presumption of irreparable harm caused by Maxam's misconduct complained of herein.

THIRD CLAIM FOR RELIEF

UNFAIR COMPETITION IN VIOLATION OF M.G.L. c. 93A

58. Michelin hereby incorporates by reference paragraphs 1-57 as if fully set forth herein.

59. MAXAM and Michelin are engaged in trade or commerce for purposes M.G.L. c. 93A § 11.

60. MAXAM's actions complained of herein constitute unfair and deceptive trade practices in violation of M.G.L. c. 93A § 11.

61. Upon information belief, MAXAM's actions have caused consumer confusion as to the source and sponsorship of MAXAM's goods and MAXAM has unlawfully derived and will continue to derive income, profits, and ever-increasing goodwill from its activities, causing Michelin to suffer actual damages and irreparable injury.

62. Michelin has suffered damages as a result of MAXAM's unfair and deceptive trade practices, and will continue to suffer harm unless and until enjoined by this Court.

63. MAXAM's unfair and deceptive acts occurred primarily and substantially in the Commonwealth of Massachusetts for at least the reason that MAXAM's place of business is in Massachusetts and its marketing and sales efforts related to the accused products take place from within Massachusetts.

PRAYER FOR RELIEF

WHEREFORE, Michelin respectfully requests the following relief:

A. Entry of a judgment that MAXAM has directly and/or indirectly infringed the D'073 patent and that such infringement has been willful;

B. Entry of a judgment that MAXAM has violated 15 U.S.C. § 1125(a), and that such violations were willful, *i.e.*, with knowledge of the illegality of the actions and of Michelin's prior exclusive rights;

C. Entry of a judgment that MAXAM has violated M.G.L. c. 93A § 11, by engaging in unfair and deceptive trade practices, and that such violations were willful or knowing;

D. Entry of a permanent injunction against MAXAM, pursuant to 35 U.S.C. § 283, 15 U.S.C. § 1116(a), M.G.L. c. 93A § 11, and/or the equitable powers of this Court, and the to prevent further direct and/or induced infringement of the D'073 patent and XDR Trade Dress;

E. An award of damages, in an amount to be determined, adequate to compensate Michelin for the infringement that has occurred, pursuant to 35 U.S.C. § 284, 15 U.S.C. § 1117(a), and/or M.G.L. c. 93A § 11, and that such damages be increased three times;

F. An Order requiring MAXAM to account for and pay to Michelin monetary damages including without limitation any and all profits made by MAXAM from sales of its infringing products pursuant to 35 U.S.C. § 289, 15 U.S.C. § 1117(a), and/or M.G.L. c. 93A § 11, and that such damages be increased three times;

G. An order requiring MAXAM to deliver to Michelin for destruction all marketing materials and products bearing the XDR Trade Dress pursuant to 15 U.S.C. § 1118;

H. An Order requiring MAXAM to pay Michelin its costs and attorneys' fees in this action pursuant to 35 U.S.C. § 285, 15 U.S.C. § 1117(a), M.G.L. c. 93A § 11, and/or other applicable laws;

I. An award of pre-judgment and post-judgment interest; and

J. Such other and further relief as the Court may deem just and proper.

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a trial by jury on all issues triable as of right by a jury.

Respectfully submitted,

Date: January 13, 2021

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