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

Proceeding	91200832
Party	Defendant Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
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Attachments	Opp to MTC_PUBLIC REDACTED VERSION.pdf(76405 bytes) Decl and Exhibits ISO Opposition to Motion to Compel - Redacted.pdf(4945325 bytes)

BRIGGS & STRATTON CORPORATION)	
and KOHLER CO.,)	
)	
Opposers,)	
)	Opposition No. 91200832 (parent)
v.)	
)	Opposition No. 91200146
HONDA GIKEN KOGYO KABUSHIKI)	
KAISHA,)	Application Serial No. 78924545
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Applicant.)	
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**APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA’S OPPOSITION TO
OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.’S
MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

[PUBLIC REDACTED VERSION]

I. INTRODUCTION

Opposers Briggs and Stratton Corporation and Kohler Co.’s, (collectively, “Opposers”) Motion to Compel the production of documents responsive to two broad categories of documents—(1) “all documents referring or relating to” an unknown number of engine models manufactured by six third parties; and (2) documents regarding a series of Honda engines that are not at issue in this case, and which are not offered, sold, or marketed in the United States—is baseless and violates the fundamental rules of relevance and proportionality that govern discovery in proceedings before the Board. The Board has repeatedly recognized that the scope of discovery in its proceedings is more limited than in district court proceedings, and that the burden of production must be proportional to its benefit. *Frito-Lay N. Am., Inc. v. Princeton*

Vanguard, LLC, 100 U.S.P.Q.2d 1904, 2011 WL 6012209, at *4 (T.T.A.B. 2011); TBMP § 402.01. Because the requested documents are irrelevant to the issues in this case, and searching for and identifying potentially responsive documents to these overly broad requests would be unduly burdensome to Honda, the Board should deny Opposers' Motion to Compel.

Throughout the course of these proceedings, Opposers have repeatedly served discovery requests that are excessive both in scope and number, forcing Honda to incur enormous costs responding to and attempting to negotiate more reasonable requests. During three years of discovery, Honda has responded to nearly *four hundred* interrogatories and requests for admission and has produced more than *100,000 pages* of requested documents. Opposers now seek to compel the production of documents in response to another 21 discovery requests, which are overbroad and go far beyond what is relevant in this action.

The actual record demonstrates that Honda has acted in good faith throughout discovery, and has already produced much of what Opposers' motion seeks. With respect to the documents regarding the third party engines, after attempting repeatedly and unsuccessfully to obtain additional clarification or guidance from Opposers about the particular third party engine models for which they sought documents, Honda made a good faith effort to identify documents regarding testing of at least those engines that it could identify, and has now produced those documents. Accordingly, that portion of Opposers' Motion is moot.¹ As discussed below, the remaining requests are irrelevant to these proceedings and disproportionately burdensome. Opposers' Motion should therefore be denied.

¹ In light of this production, Honda has requested that Opposers withdraw the portion of the Motion relating to the third party engines. Declaration of Sarah R. Frazier in Support of Applicant Honda Giken Kogyo Kabushiki Kaisha's Opposition to Opposers Briggs & Stratton Corporation and Kohler Co.'s Motion to Compel Production of Documents ("Decl. of Frazier"), ¶ 13, Ex. J. To date, Opposers have not responded to that request.

II. FACTUAL BACKGROUND

On April 4, 2014, years into the discovery process, Opposers served a fifth set of discovery requests, including 33 requests for production. Opposers currently seek to compel production in response to 21² of those requests regarding two categories of documents: 1) documents relating to an *unspecified* number of engine models from six *third party* engine manufacturers (Generac, V Power, Lifan, Jiangdong, Blue Max, and All Power) (“Third Party Engines”); and 2) documents relating to Honda’s GP 160 and GP 200 engines (“GP Engines”), which have never been sold or offered for sale in the United States. The requests for production (“RFP”) at issue are as follows:

GP Engine Requests

RFP No. 58: All documents referring or relating to the design of the external appearance of the Honda GP160 or GP200 engine.

RFP No. 59: All documents referring or relating to the styling of the Honda GP160 or GP200, including but not limited to the decision to use a black plastic recoil cover with a white fan cover.

RFP No. 60: All documents referring or relating to differences in the external appearance of the Honda GP160 or GP200 engines and any of the Honda GX engines, including but not limited to the differences in color.

Third Party Engine Requests

Opposers served three document requests for each of the following third party engine manufacturers: Generac (Nos. 62-64), V Power (Nos. 67-69), Lifan (Nos. 72-74), Jiangdong (Nos. 76-78), Blue Max (Nos. 79-81), and All Power (Nos. 84-86). For example:

RFP No. 72: All documents referring or relating to Lifan horizontal shaft engines offered for sale since September 14, 2008, including but not limited to the engines attached hereto as Ex. C.

² It appears that Opposers are seeking to compel the production of documents responsive to Requests for Production Nos. 58-60, 62-64, 67-69, 72-74, and 76-80. *See, e.g.*, Opposers’ Motion at 8. While Opposers’ Motion makes no mention of Requests Nos. 81 or 84-86, it is Honda’s belief that this was an inadvertent omission by Opposers. Accordingly, for purposes of responding to Opposers’ Motion, Honda will proceed with this understanding unless notified otherwise.

RFP No. 73: All documents referring or relating to Applicant's or American Honda's knowledge of Lifan horizontal shaft engines offered for sale since September 14, 2008, including but not limited to Applicant's or American Honda's first knowledge of the engines attached hereto as Ex. C.

RFP No. 74: All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of Lifan horizontal shaft engines offered for sale September 14, 2008, including but not limited to the engines attached hereto as Ex. C.

See Decl. of Frazier, ¶ 2, Ex. A (Opposers' Fifth Set of Requests for Production).

A. Opposers' Requests For Documents Regarding Third Party Engines And Honda's Production Of Responsive Documents

In Opposers' Fifth Set of Requests for Production, 28 document requests were directed at the Third Party Engines. Decl. of Frazier, Ex. A (Opposers' Fifth Set of Requests for Production, Nos. 61-88). Honda produced all documents responsive to several of these requests related to enforcement efforts and settlement agreements with the third parties. Decl. of Frazier, Ex. B (Honda's Responses to Opposers' Fifth Set of Requests for Production, Nos. 61, 65-66, 70-71, 75, 82-83, and 87-88). With respect to the remaining categories of requests relating to an *unspecified* number of engine models from six third party engine manufacturers, namely: (1) all documents *referring or relating* to the Third Party's Engines; (2) all documents referring or relating to Honda's *knowledge* of the Third Party's Engines; and (3) all documents referring or relating to Honda's *purchase, inspection, or testing* of the Third Party's Engines, Honda objected on the grounds that they were irrelevant, overly broad, and unduly burdensome. Decl. of Frazier, Ex. B (Nos. 62-64, 67-69, 72-74, 76-81, and 84-86).

Simply determining the engines covered by these requests is burdensome. The websites of these third party engine manufacturers reveal that V Power produces *at least four* models of horizontal shaft engines, that All Power America produces *at least six* models of horizontal shaft engines, that Jiangdong produces *at least ten* models of horizontal shaft engines, and that Lifan

produces *at least twelve* models of horizontal shaft engines. Decl. of Frazier, ¶ 15, Ex. L (webpages of V Power, All Power, Jiangdong, and Lifan).³ In spite of the undefined number of engine models for which Opposers seek documents, and the overbreadth of the requests, in an effort to cooperate, Honda repeatedly attempted to negotiate a reasonable narrowing of these requests.

During a telephonic meet and confer, Honda expressed its concerns that these requests were irrelevant, overly broad, and unduly burdensome, in part because Opposers failed to identify the specific engine models for which they were seeking discovery. Decl. of Frazier, ¶ 4. In subsequent communications, Honda maintained its objections with respect to the first two categories of documents (documents *referring or relating* to the Third Party's Engines and documents referring or relating to Honda's *knowledge* of the Third Party's Engines), but indicated that it was investigating the existence of documents regarding the inspection or testing of the Third Party Engines. Decl. of Frazier, ¶ 6, Ex. D. Thereafter, the parties continued to negotiate the scope of the requests regarding the *inspection and testing* of the Third Party Engines, which was ultimately unsuccessful due to Opposers' refusal to reasonably narrow these requests. Decl. of Frazier, ¶¶ 7-11, Exs. E-I. Opposers did not actively pursue their broader requests, including the requests for "all documents referring or relating" to the Third Party Engines. *See id.*

Despite Opposers' refusal to meaningfully narrow the requests directed at testing of the Third Party Engines, in an effort to move this case along to the merits, and avoid further burdening the Board with discovery disputes, Honda searched for all testing documents regarding engines manufactured by the six companies identified in Opposers' requests. Decl. of

³ As to the other engine manufacturers—Generac and Blue Max—Honda has been unable even to determine the number of engine models they produce. Generac's website displays only complete products with engines incorporated (not individual engines), and Blue Max does not appear to have its own website. Decl. of Frazier, ¶ 15.

Frazier, ¶¶ 6 and 13, Exs. D and J. This search revealed that no responsive documents existed with respect to four of the six manufacturers. *See* Decl. of Frazier, Ex. K (Honda's First Supplemental Responses to Opposers' Fifth Set of Requests for Production, Nos. 64, 69, 81, and 86). All testing documents regarding engines made by the other two manufacturers have been produced. *See* Decl. of Frazier, Ex. K (Nos. 74 and 78). Therefore, Opposers' Motion—which, consistent with the parties' negotiations, focuses almost exclusively on the inspection and testing documents—should be denied as moot.

To the extent Opposers' Motion seeks to compel documents responsive to the first two categories—as Opposers' failure to actively pursue these documents implicitly shows—the remaining requests should be denied as irrelevant, overly broad, and unduly burdensome.

B. Opposers' Requests For Documents Regarding The GP Engines And Their Failure To Make A Good Faith Effort To Resolve All Issues Prior To Filing The Motion To Compel

In its responses to Opposers' Fifth Set of Requests for Production, Honda objected to producing documents responsive to Requests for Production Nos. 58-60 because: (1) documents regarding the GP Engines—which have never been sold or offered for sale in the United States—are irrelevant to these proceedings; and (2) the burden of such a production would outweigh any benefit. Decl. of Frazier, Ex. B. The parties telephonically met and conferred *once* to discuss these requests, and Opposers and Honda had only *one* email exchange regarding the purported relevance of these documents. Decl. of Frazier, ¶¶ 4-6, Exs. C and D. Since that email exchange, which ended on June 3, 2014, Opposers made no mention at all of their requests directed to the GP Engines, even in the parties' most recent meet and confer prior to Opposers' filing of their Motion on October 3, 2014. Decl. of Frazier, ¶ 12. Instead, to Honda's surprise, Opposers chose to file a motion to compel nearly *3 ½ months after* they last raised the issue,

without providing any notice of its intention to move to compel the production of the GP Engine documents, and without providing any opportunity for further discussion. Unlike the requests regarding the Third Party Engines, where Opposers clearly communicated their belief that the parties were at an “impasse” and that they intended to file a motion (*see* Decl. of Frazier, ¶ 11, Ex. I), no such communication was made here with respect to the GP Engine requests. Thus, Opposers did not adequately attempt to resolve the issues with respect to these requests, as required by 37 CFR § 2.120(e)(1).

III. LEGAL STANDARDS

A request for production is improper when “the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties’ resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues.” Fed. R. Civ. P. 26(b)(2)(C)(iii); *see also* Fed. R. Civ. P. 26(g)(1)(B)(iii). Rule 26’s emphasis on proportionality is particularly important in the context of T.T.A.B. cases, because “the scope of discovery in Board proceedings is generally narrower than in court proceedings.” *Frito-Lay*, 2011 WL 6012209, at *4; TBMP § 402.01. The burden to ensure that requests are properly tailored lies with the requesting party who must “make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.” *Luehrmann v. Kwik Copy Corp.*, 2 U.S.P.Q.2d 1303, 1987 WL 123810, at *3 (T.T.A.B. 1987).

IV. ARGUMENT

A. The Board Should Not Compel The Production Of Documents Related To The Third Party Engines.

Honda already has produced all testing documents that it has been able to identify regarding the Third Party Engines. Decl. of Frazier, ¶¶ 13-14, Exs. J (Honda’s Oct. 22, 2014

letter to Opposers) and K (Nos. 64, 69, 74, 78, 81, and 86). Given that these documents are at the core of Opposers' Motion with respect to Third Party Engines, that portion of Opposers' Motion should be moot. What remains are Opposers' overly broad requests for: (1) *all documents referring or relating to an unspecified number of engines from six third-party manufacturers*; and (2) all documents referring or relating to Honda's *knowledge* of these engines. But as the history of the parties' communications shows, Opposers have not actively pursued these overly broad categories of documents, focusing instead on the more targeted set of testing documents. Thus, Opposers' own actions call into question the relevance of these requests. Accordingly, to the extent Opposers are still seeking documents responsive to these two categories of requests, Opposers' Motion should be denied.

1. The Remaining Requests Related To Third-Party Engines Are Not Relevant To Secondary Meaning, Functionality, Genericness Or Abandonment.

Opposers make three primary arguments as to why the requested Third Party Engine documents are relevant: (1) that engines manufactured by these third-parties have the same or similar *general configuration* as the proposed mark (*see, e.g.*, Opposers' Motion at 2, 7-8, and 14); (2) Honda agreed that knowledge "of engines with a *similar configuration* is directly relevant to the issues in this case" (Opposers' Motion at 15) (emphasis added); and (3) "the Board has already determined that the documents like the ones sought here are relevant" (Opposers' Motion at 16). All three arguments fail for the same reason: Opposers continue to misconstrue the scope of the proposed mark. Honda is not claiming that the *general configuration* of the GX Engine (*i.e.*, fuel tank on the top right above the fan cover, high-mounted air cleaner, carburetor cover below the air cleaner) is itself a trademark; rather it is claiming as a trademark the *specific look* of the GX Engine (*i.e.*, the "total image and overall

appearance” of a product, or the totality of the elements). *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (internal quotation marks omitted).

First, Opposers contend that “[the GX Engine] is an *industry standard compact engine configuration* and the industry does not associate this cubic shape or engine configuration with Applicant,” and “[t]herefore, Applicant’s knowledge of the Third Party Engines is relevant to the issue of distinctiveness, secondary meaning and abandonment.” Opposers’ Motion at 14. Opposers’ argument is flawed not only because it assumes what they are trying to prove (*i.e.*, assuming that the GX Engine is an industry standard configuration to prove that knowledge of these third party engines with the same or similar configuration is evidence that the GX Engine is an industry standard configuration), but also because it does not relate to the *specific look* of the applied-for mark.

Second, Opposers contend that Honda has agreed that knowledge “of engines with a similar configuration is directly relevant to the issues in this case,” citing to Honda’s motion to compel where it sought the production of all documents “evidencing the purchase of Honda’s engines *embodying the GX Engine Trademark*.” Opposers’ Motion at 15 (emphasis added) (internal quotation marks omitted). This assertion similarly conflates the *general configuration* of the GX Engine (and other engines) with the *specific look* of the GX Engine. Honda has *not* at any point agreed that knowledge of engines with a “similar configuration” is directly relevant to the issues in this case, and in fact rejected that notion in its opposition to Opposers’ Motion for Summary Judgment. *See* Dkt. 80 at 12. Honda’s consistent position has been that third party engines with the same or similar *general configuration* have no bearing on the issues in this case. In keeping with that position, the specific request that was the subject of Honda’s motion to compel cited by Opposers references engines “*embodying the GX Engine Trademark*” which

is not the same as engines with a “similar configuration” as the proposed mark. Opposers’ Motion at 15 (internal quotation marks omitted).

Third, Opposers argue that the Board already determined that documents like the ones being sought are relevant, and point to the Board’s Order compelling production of “documents *embodying the GX engine* as a model for testing and analysis” Opposers’ Motion at 16 (quoting Dkt. No. 40 at 7) (emphasis added). Specifically, the Board ordered production of “documents concerning the purchase by Opposers . . . for purposes of testing, or analysis or modeling, of a Honda engine *embodying the applied-for mark*.” See Dkt. No. 40 at 10 (emphasis added). Once again, Opposers confuse engines having the same general configuration with engines embodying the applied-for mark. Neither Honda nor the Board has ever stated that merely having the same general configuration is enough to “embody” the GX Engine Trademark.

Thus, Opposers have not showed, and cannot show, that the requested documents regarding third party engines with the same or similar “general configuration” as the proposed mark are relevant to the issues in these proceedings.

2. The Remaining Requests Related To Third Party Engines Are Overly Broad, And Production Would Be Unduly Burdensome.

Opposers argue that “the requests are narrowly tailored to include only those third party engines with the same or similar shape and configuration as the Proposed Mark.”⁴ Opposers’ Motion at 14. However, this argument runs headlong into Opposers’ assertion that the general configuration of the GX Engine is an industry standard. If Opposers are correct in that assertion, then Opposers’ requests necessarily seek all documents in Honda’s possession regarding every

⁴ Opposers’ original requests regarding the Third Party Engines were not limited to “engines with the same or similar shape and configuration as the Proposed Mark.” Decl. of Frazier, Ex. A (Briggs’ Fifth Set of Requests for Production). Rather, Opposers subsequently “narrowed” these requests as such during the parties’ negotiations regarding the Third Party Engines. See Decl. of Frazier, ¶ 5, Ex. C (Opposers’ May 19, 2014 email to Honda) (Opposers “limit[ed]” their Third Party Engine Requests to “horizontal shaft engines with high-mount air cleaner covers”).

horizontal shaft engine made by each of the third party manufacturers. That is the opposite of “narrowly tailored.” Even if Opposers were to identify specific model numbers for the Third Party Engines, the inherently overbroad nature of these requests cannot be cured or minimized. Consequently, given that these documents have little to no relevance to the issues in these proceedings (as demonstrated above), whatever marginal benefit the requested documents might give Opposers does not outweigh the undue burden to Honda of searching for and producing these documents.

B. There Is No Basis To Compel The Production Of Documents Related To The GP Engines.

Documents related to the GP Engines are not relevant to these proceedings. Opposers’ claims of relevance are limited to unsupported assertions that these documents are related to functionality, and the argument that these documents may show secondary meaning for a color combination that Honda does *not* seek to register. Opposers’ Motion at 11. Indeed, Opposers’ own inaction leading up to their motion further supports that these requests are irrelevant, and suggests that Opposers’ Motion is just another attempt to harass and impose unnecessary costs on Honda. The GP Engine documents’ lack of relevance, combined with the undue burden associated with their production, militates against compelling Honda to produce any documents related to the GP Engines.

1. GP Engine Documents Are Not Relevant To Secondary Meaning.

Opposers are incorrect that any decision to differentiate the GP Engines through the use of a different color scheme is relevant to secondary meaning because it “evidences Honda’s awareness that the GX Engines’ red, white and black color combination ... is the source indicator” for several reasons. Opposers’ Motion at 11. *First*, the GX Engine is not sold exclusively in the red, white and black color combination; it comes in a spectrum of colors

including at least two shades of black and orange. *See, e.g.*, Decl. of Frazier, ¶¶ 16 and 17, Exs. M (S. Conner Depo. Tr. at 214:19-215:9) [REDACTED] and N (photographs of GX Engines in multiple color combinations). Contrary to Opposers' argument, [REDACTED] [REDACTED] (Opposers' Motion, Ex. A at 98), to differentiate the GP Engines does not suggest that Honda believes the red, white, and black color combination is associated with the GX Engine any more than it suggests that Honda believes these other colors are associated with the GX Engine.

Second, the secondary meaning inquiry is focused on the relevant purchasing population—*i.e.* consumers of the product in the area where the product is sold or offered. *See In Re Kawneer Co.*, 121 U.S.P.Q. 631, 1959 WL 6096, at *1 (T.T.A.B. 1959) (holding that statements made by Applicant's Canadian dealers "could not ... indicate that the [mark] had acquired secondary meaning in the United States"). Thus, secondary meaning may vary by market. *See, e.g., Popular Bank of Florida v. Banco Popular de Puerto Rico*, 9 F. Supp. 2d 1347, 1353-56, 1358-59 (S.D. Fla. 1998) (finding plaintiff's mark had acquired secondary meaning in South Florida, even though defendant's similar mark likely had secondary meaning in Puerto Rico). Even accepting as true the assertion that Honda chose to make the GP Engines white in order to differentiate them from the red, white, and black combination used on some GX Engines, given that the GP Engines are sold only in emerging markets, and not the United States, this assertion can have no bearing on whether or not consumers in the United States associate the red, white, and black color combination with GX Engines.

Finally, secondary meaning based on color and based on design are not mutually exclusive. Even if Honda believed that consumers associate a specific color scheme with Honda

(which it does not), that does mean that those same consumers do not *also* attribute the engine design (excluding color) to Honda. Documents Opposers believe may show that certain colors are associated with Honda are of no relevance since the applied-for mark, and thus the secondary meaning inquiry, does not include color. *See In Re Haggard Co.*, 217 U.S.P.Q. 81, 1982 WL 51971, at *2 (T.T.A.B. 1982) (“separate features” may independently “serve to identify the goods of the owner of the mark”).

2. GP Engine Documents Are Not Relevant To Functionality.

Because the GP Engines were [REDACTED] [REDACTED] (Opposers’ Motion, Ex. A at 97-98), documents relating to the external appearance of those engines are irrelevant to the issue of functionality of the applied-for mark. Further, Opposers contend that the external appearance of the GP Engines is “virtually identical to both the GX Engines and the Proposed Mark” (Opposers’ Motion at 10), but also concede that the GP Engines are “lower cost” than the GX Engines (Opposers’ Motion at 5-6). The fact that a cheaper engine can embody the same mark demonstrates that the design is *not* functional.

Over the course of discovery in this case, Honda has already produced thousands of pages of documents related to functionality, including documents about the GX Engines themselves and other copy engines that embody Honda’s mark. The fact that the GP Engines may also embody the applied-for mark does not warrant permitting Opposers to embark on a fishing expedition for documents relating to a completely different Honda engine that is sold for different applications and in different markets than the GX Engine that is the subject of these proceedings.

3. The Burden of Producing Documents Related To The GP Engines Is Not Proportional To Their Benefit.

Both the Board and the Federal Rules of Civil Procedure emphasize that the burden of production must be proportional to its benefit. *See* Fed. R. Civ. P. 26(b)(2)(C)(iii); Fed. R. Civ. P. 26(g)(1)(B)(iii); TBMP § 402.01. In line with these fundamental rules of relevance and proportionality, the Board has previously limited discovery in this proceeding to activities *within the United States*. *See* Dkt. 40 (Board's Jan. 23, 2013 Order) at 26. Because the GP Engines are not offered, sold or marketed in the United States, the requested documents fall outside the appropriate scope of discovery, and thus would be unduly burdensome to produce, particularly given their minimal relevance to the issues in these proceedings.

Opposers improperly analogize their requests to Honda's request for, and the Board's order compelling the production of, documents regarding Opposers' 550 and SH 265 engines. *See, e.g.*, Opposers' Motion at 11-14. Unlike Opposers' engines, which are sold and offered *in the United States*, the GP Engines are developed, sold and marketed *exclusively outside of the United States*. Moreover, the Board clearly limited discovery of Opposers' engines to Opposers' activities *within the United States*. *See, e.g.*, Dkt. 40 at 26 ("As long as this request is limited to the United States, as clarified herein, the response is not unduly burdensome."); *see also id.* at 14 (Honda's RFP Nos. 31 (Briggs); 46 (Kohler), as modified by the Board), 18-19 (Honda's RFP Nos. 9 and 18 (Briggs); 24 and 33 (Kohler), as modified by the Board), 21 (Honda's RFP Nos. 13 and 20 (Briggs); 28 and 35 (Kohler), as modified by the Board), 24-26 (Honda's RFP Nos. 12 and 22 (Briggs); 27 and 37 (Kohler), as modified by the Board). The Board should do the same now.

Similarly, Opposers' reliance on *Tequila Centinela* and *Laker Airways Ltd.*, is misplaced. In addition to Opposers' mischaracterization of these cases,⁵ neither case requires the production of irrelevant documents, or documents that would be unduly burdensome to produce. On the contrary, those cases make clear that discovery is only permitted if the requested documents are "ordinarily discoverable." See *Tequila Centinela, S.A. de C.V. v. Bacardi & Co.*, 242 F.R.D. 1, 12-13 (D.D.C. 2007). Because the "the burden or expense of the proposed discovery outweighs its likely benefit," the Board should deny Opposers' motion to compel as it relates to Honda's GP Engines. See Fed. R. Civ. P. 26(b)(2)(C)(iii).

V. CONCLUSION

For the foregoing reasons, Honda respectfully requests that the Board deny Opposers' request for an order compelling Honda to produce documents responsive to Requests for Production Nos. 58-60, 62-64, 67-69, 72-74, and 76-80. To the extent Opposers are requesting that the Board compel the production of documents responsive to Requests for Production Nos. 81 and 84-86, Honda respectfully requests that the Board deny Opposers' request.

⁵ Opposers characterize *Centinela* as an appeal of "a decision by the TTAB denying discovery of a number of documents relating to the use of a mark similar to the applied for mark outside of the United States." Opposers' Motion at 12. However, *Centinela* did not appeal any TTAB denial of discovery. Rather, it appealed the TTAB's summary judgment decision, in which the Board held that *Centinela*'s application was fraudulent and its mark was not registrable. See Decl. of Frazier, Ex. O (*Tequila Centinela, S.A. de C.V. v. Bacardi Co.*, No. 04-CV-02201, 2004 WL 3121681 (D.D.C. December 20, 2004) (Complaint)). The district court in *Centinela* considered a motion to compel in the first instance, but all of the requests at issue that related to the mark's use were universally limited to use in the United States. See Decl. of Frazier, Ex. P (*Centinela*, No. 04-CV-02201, 2006 WL 1422916 (D.D.C. April 24, 2006) (*Centinela*'s motion to compel discovery)).

Opposers similarly mischaracterize *Laker*. The *Laker* court ultimately did *not* order any party to produce documents in contravention of foreign law. Rather, the court held that if the foreign "authorities do not grant permission as needed to satisfy the discovery rights of plaintiff in this action, the Court will consider their rulings in" later proceedings. See *Laker Airways Ltd. v. Pan Am. World Airways*, 103 F.R.D. 42, 47-48 (D.D.C. 1984).

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Applicant Honda Giken Kogyo Kabushiki Kaisha's Opposition to Opposers Briggs & Stratton Corporation and Kohler Co.'s Motion to Compel Production of Documents [PUBLIC REDACTED VERSION] was served by Federal Express, this 30th day of October, 2014 upon:

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Sarah R. Frazier

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
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Applicant.)	
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**DECLARATION OF SARAH R. FRAZIER IN SUPPORT OF
APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA’S OPPOSITION TO
OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.’S
MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

I, Sarah R. Frazier, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am an attorney duly licensed to practice law in the Commonwealth of Massachusetts. I am an Associate at the law firm Wilmer Cutler Pickering Hale and Dorr LLP, counsel for Honda Giken Kogyo Kabushiki Kaisha (“Honda”), the Applicant in the above-entitled proceedings.

2. On April 4, 2014, Opposer Briggs & Stratton Corporation (“Briggs”) served its Fifth Set of Requests for Production of Documents on Honda (“Requests”). The Requests were directed at obtaining documents relating to engines produced by six third party engine manufacturers (Generac, V Power, Lifan, Jiangdong, Blue Max, and All Power) (“Third Party Engines”) and documents relating to Honda’s GP 160 and GP 200 engines (“GP Engines”). A true and correct copy of the Requests is attached hereto as **Exhibit A**.

3. On May 9, 2014, Honda served its Objections and Responses to Briggs' Fifth Set of Requests for Production. A true and correct copy of these objections and responses is attached hereto as **Exhibit B**.

4. On May 16, 2014, the parties telephonically met and conferred regarding Honda's objections to Requests for Production Nos. 58-60 (the "GP Engine Requests"), and 62-64, 67-69, 72-74, 76-78, 79-81, and 84-86 (the "Third Party Engine Requests"). During this meet and confer, Honda expressed its concerns that the Third Party Engine Requests were irrelevant, overly broad, and unduly burdensome, in part because Opposers failed to identify the specific engine models for which they sought discovery. Honda also stated that the GP Engine Requests were irrelevant, overly broad, and unduly burdensome, in part because the GP Engines were not offered, sold, or marketed in the United States.

5. On May 19, 2014, Opposers emailed Honda and purportedly "limit[ed]" their Third Party Engine Requests to "horizontal shaft engines with high-mount air cleaner covers," and asserted without explanation that these requests were "clearly relevant to issues such as functionality, secondary meaning, abandonment and genericness." A true and correct copy of this email is attached hereto as **Exhibit C**.

6. On June 3, 2014, Honda emailed Opposers and maintained its objections to those Third Party Engine Requests that sought documents "referring or relating" to the Third Party Engines without any further qualification, and those seeking documents regarding Honda's "knowledge" of the Third Party Engines; indicated to Opposers that Honda was investigating the existence of documents regarding the inspection and testing of the Third Party Engines; and reiterated its objections to producing documents responsive to the GP Engine Requests, in part

because the GP Engines are not developed in, nor sold in the United States. A true and correct copy of this email is attached hereto as **Exhibit D**.

7. On June 25, 2014, Opposers emailed Honda and asked whether it had any of the testing documents referenced in Honda's June 3, 2014 email. A true and correct copy of this email is attached hereto as **Exhibit E**.

8. On June 30, 2014, Honda emailed Opposers and asked for the model numbers of the third party engines depicted in the referenced exhibits to the Requests. A true and correct copy of this email is attached hereto as **Exhibit F**.

9. On July 24, 2014, Opposers emailed Honda and refused to provide the model numbers of the third party engines depicted in the referenced exhibits to the Requests. A true and correct copy of this email is attached hereto as **Exhibit G**.

10. On August 5, 2014, Honda responded to Opposers' July 24, 2014 email and explained the difficulty of obtaining model numbers from the referenced exhibits to the Requests; indicated that the requested testing information regarding the third party engines was more easily obtained from other sources, such as the third parties' public websites and through Opposers' subpoenas to the third parties; and renewed its offer to search for testing documents of the third party engines depicted in the referenced exhibits to the Requests. A true and correct copy of this email is attached hereto as **Exhibit H**.

11. On August 6, 2014, Opposers emailed Honda and reiterated their refusal to narrow the Third Party Engine Requests to the specific engines depicted in the referenced exhibits to the Requests. Opposers also indicated that they believed the parties were at an impasse, and expressed their intention to file a motion with the Board with respect to the Third Party Engine Requests. A true and correct copy of this email is attached hereto as **Exhibit I**.

12. On October 3, 2014, the parties telephonically met and conferred regarding documents that are not the subject of Opposers' Motion to Compel. Opposers did not at any point during the meet and confer mention the GP Engine Requests.

13. On October 22, 2014, Honda produced testing documents regarding the Third Party Engines responsive to Requests for Production Nos. 64, 69, 74, 78, 81, and 86, to the extent that such documents existed. This production was accompanied by a letter requesting that Opposers withdraw their Motion to Compel with respect to these requests. A true and correct copy of this letter is attached hereto as **Exhibit J**.

14. On October 28, 2014, Honda served its First Supplemental Responses to Opposers' Fifth Set of Requests for Production Nos. 64, 69, 74, 78, 81, and 86. A true and correct copy of these supplemental responses is attached hereto as **Exhibit K**.

15. On October 29, 2014, I visited the websites of Generac, V Power, Lifan, Jiangdong, and All Power: <http://www.generac.com/all-products>; vpowerequipment.com; <http://www.lifanpowerusa.com/engines/>; <http://www.enginejd.com/>; and <http://allpoweramerica.com/?p=42>, respectively. Attached hereto as **Exhibit L** are true and correct copies of pages from the websites of V-Power, All Power, Jiangdong, and Lifan accessed that day, which depict at least four models of V-Power horizontal shaft engines (420cc 13 HP, 346cc 11 HP, 212cc 7 HP, and Handy Man Special 212cc), at least six models of All Power America horizontal shaft engines (APE7007, APE7009, APE7009SE, APE7013E, APE7015, and APE7015SE), at least ten Jiangdong horizontal shaft engines (JF120, JF154, JF169N, JF240N, JF270N, JF340N, JF390N, JF420N, JF168SL, and JF200SL), and at least twelve models of Lifan horizontal shaft engines (LF139F, LF152F, LF160F, LF168F, LF168F-2, LF170F, LF173F, LF177F, LF182F, LF188F, LF190F, and LF2V78D). The Generac website displays only

complete products with engines incorporated, not individual engines. I was unable to find a website for Blue Max.

16. Attached hereto as **Exhibit M** is a true and correct copy of excerpts from the August 9 and 10, 2013 deposition of Honda Vice President Scott Conner in these proceedings.

17. Attached hereto as **Exhibit N** are true and correct copies of photos fairly and accurately depicting black, matte black, yellow, and blue GX Engines produced by Honda in these proceedings as AHGX001896-AHGX001899.

18. Attached hereto as **Exhibit O** is a true and correct copy of the Complaint filed in *Tequila Centinela, S.A. de C.V. v. Bacardi Co.*, No. 04-CV-02201, 2004 WL 3121681 (D.D.C. Dec. 20, 2004).

19. Attached hereto as **Exhibit P** is a true and correct copy of the Motion to Compel Discovery in *Tequila Centinela, S.A. de C.V. v. Bacardi Co.*, No. 04-CV-02201, 2006 WL 1422916 (D.D.C. April 24, 2006).

I declare under the penalty of perjury that the foregoing is true and correct.

Date: October 30, 2014



Sarah R. Frazier (BBO No. 681656)

EXHIBIT A

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and TBMP Section 406 et seq., Opposer Briggs & Stratton Corporation (hereinafter “Opposer”) request that Applicant Honda Giken Kogyo Kabushiki Kaisha (“Applicant”) produce the following documents for inspection thirty (30) days after service of these requests at the offices Reed Smith LLP, 101 Second Street, San Francisco, CA 94105, or such other time and place as the parties may mutually agree upon.

DEFINITIONS

The following definitions shall apply to the document requests that follow:

A. The terms “YOU” and “YOUR” mean Applicant Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.), a corporation organized under the laws of Japan, and its predecessors, successors and assigns, including any person or entity acting under its control, or on behalf, of any and all of its parents, subsidiaries, branches, entities, affiliates, departments, divisions, operating units, partners, joint ventures or related companies, and any employee, officer, director, principal, agent, sales representative or attorney who now serves, or at any relevant time served, it in such capacity.

B. The terms “Briggs” or “Opposer” refer to Opposer Briggs & Stratton Corporation and its affiliated companies.

C. The term “document” or “documents” shall be given the broadest meaning as contemplated by Rule 34, including but not limited to, notes, letters, correspondence, communications, e-mails, telegrams, memoranda, contracts, lease agreements, summaries or records of telephone conversations, summaries or records of personal conversations or meetings, diaries, reports, research reports and notebooks, charts, plans, drawings, diagrams, illustrations, photographs, video images, minutes or records of meetings, summaries of interviews, reports or

investigations, opinions or reports of consultants, opinions of counsel, agreements, reports or summaries of negotiations, brochures, pamphlets, advertisements, circulars, trade letters, press releases, drafts of documents and all other material fixed in a tangible or electronic medium of whatever kind known to you or in your possession or control. A draft or nonidentical copy is a separate document within the meaning of this term.

D. “Referring,” “relating”, and “regarding” include the following: pertaining to, making reference to, concerning, comprising, evidencing, alluding to, responding to, connected with, commenting on, with respect to, about, regarding, resulting from, embodying, explaining, supporting, discussing, showing, describing, reflecting, analyzing, constituting, setting forth, in respect of or having any logical or factual connection with the subject matter in question.

E. The terms "person" and "persons" include natural persons and entities such as any individual or firm, association, organization, joint venture, trust, partnership, corporation, or other collective organization or entity.

F. The singular includes the plural number and vice versa, any use of gender includes both genders and a verb tense includes all other verb tenses where the clear meaning is not distorted by addition of another tense or tenses.

G. Whenever the conjunctive is used, it shall also be taken in the disjunctive, and vice versa.

INSTRUCTIONS

The following instructions apply to the discovery requests below and should be considered as part of each subject request:

A. If any information is withheld under a claim of privilege, state the nature of the privilege claimed and provide sufficient information to permit a full determination of whether

the claim is valid. For allegedly privileged documents, include: an identification of the sender and the recipients of the document; the date of the document; a description of the contents or nature of the document; the number of the discovery request to which the document is responsive; and a statement of the basis for the asserted claim of privilege.

B. If Applicant objects to any subpart or portion of a request for information or objects to providing certain information requested, state Applicant's objections and answer the unobjectionable subpart(s) of the request for information and supply the unobjectionable information requested.

C. If any of the following requests for information cannot be responded to in full after exercising reasonable diligence to secure the information, please so state, supply the information for those portions Applicant is able to answer, and supply whatever information it has concerning the portion which cannot be answered in full. If Applicant's response is qualified in any particular respect, set forth the details of such qualification.

D. Unless otherwise stated, the geographic scope of each of the following requests is limited to the United States of America.

DOCUMENT REQUESTS

REQUEST FOR PRODUCTION NO. 55:

An updated AHM GX Phase I and Phase 2 inventory report, in the form shown in Exhibit 19 to the Conner deposition.

REQUEST FOR PRODUCTION NO. 56:

Documents sufficient to show the number of Honda GX engines available for purchase in the United States bearing the precise design shown in Applicant's trademark drawing (i.e. excluding engines bearing the 2011 redesign).

REQUEST FOR PRODUCTION NO. 57:

All documents discussing or referencing the factors that effect, influence or determine whether a customer is sold a Honda GX bearing the precise design shown in Applicant's trademark drawing or the 2011 redesigned version.

REQUEST FOR PRODUCTION NO. 58:

All documents referring or relating to the design of the external appearance of the Honda GP160 or GP200 engine.

REQUEST FOR PRODUCTION NO. 59:

All documents referring or relating to the styling of the Honda GP160 or GP200, including but not limited to the decision to use a black plastic recoil cover with a white fan cover.

REQUEST FOR PRODUCTION NO. 60:

All documents referring or relating to differences in the external appearance of the Honda GP160 or GP200 engines and any of the Honda GX engines, including but not limited to differences in color.

REQUEST FOR PRODUCTION NO. 61:

All documents referring or relating to Applicant's opposition proceeding settlement agreement with Cummins Inc.

REQUEST FOR PRODUCTION NO. 62:

All documents referring or relating to Generac pressure washers, including but not limited to the pressure washers attached hereto as Ex. A.

REQUEST FOR PRODUCTION NO. 63:

All documents referring or relating to Applicant's or American Honda's knowledge of Generac horizontal shaft engines, including but not limited to Applicant's first knowledge of the engines shown on the pressure washers attached hereto as Ex. A

REQUEST FOR PRODUCTION NO. 64:

All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of Generac horizontal shaft engines, including but not limited to the engines shown on the pressure washers attached hereto as Ex. A.

REQUEST FOR PRODUCTION NO. 65:

All documents referring or relating to Applicants's or American Honda's GX engine trade dress enforcement efforts, if any, against Generac.

REQUEST FOR PRODUCTION NO. 66:

All documents referring or relating to any trade dress settlement agreement between Applicant or American Honda and Generac.

REQUEST FOR PRODUCTION NO. 67:

All documents referring or relating to V Power Equipment horizontal shaft engines, including but not limited to the engines attached hereto as Ex. B.

REQUEST FOR PRODUCTION NO. 68:

All documents referring or relating to Applicant's or American Honda's knowledge of V Power Equipment horizontal shaft engines, including but not limited to Applicant's or American Honda's first knowledge of the engines attached hereto as Ex. B.

REQUEST FOR PRODUCTION NO. 69:

All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of V Power Equipment horizontal shaft engines, including but not limited to the engines hereto as Ex. B.

REQUEST FOR PRODUCTION NO. 70:

All documents referring or relating to Applicants's or American Honda's GX engine trade dress enforcement efforts, if any, against V Power Equipment.

REQUEST FOR PRODUCTION NO. 71:

All documents referring or relating to any trade dress settlement agreement between

Applicant or American Honda and V Power Equipment.

REQUEST FOR PRODUCTION NO. 72:

All documents referring or relating to Lifan horizontal shaft engines offered for sale since September 14, 2008, including but not limited to the engines attached hereto as Ex. C.

REQUEST FOR PRODUCTION NO. 73:

All documents referring or relating to Applicant's or American Honda's knowledge of Lifan horizontal shaft engines offered for sale since September 14, 2008, including but not limited to Applicant's or American Honda's first knowledge of the engines attached hereto as Ex. C.

REQUEST FOR PRODUCTION NO. 74:

All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of Lifan horizontal shaft engines offered for sale September 14, 2008, including but not limited to the engines attached hereto as Ex. C.

REQUEST FOR PRODUCTION NO. 75:

All documents referring or relating to Applicants's or American Honda's GX engine trade dress enforcement efforts, if any, against Lifan horizontal shaft engines offered for sale since September 14, 2008.

REQUEST FOR PRODUCTION NO. 76:

All documents referring or relating to Jiandong horizontal shaft engines offered for sale since September 14, 2008, including but not limited to the engines attached hereto as Ex. D.

REQUEST FOR PRODUCTION NO. 77:

All documents referring or relating to Applicant's or American Honda's knowledge of Jiandong horizontal shaft engines offered for sale since September 14, 2008, including but not limited to Applicant's first knowledge of the engines attached hereto as Ex. D.

REQUEST FOR PRODUCTION NO. 78:

All documents referring or relating to Applicant's or American Honda's purchase,

inspection, or testing of Jiandong horizontal shaft engines offered for sale since September 14, 2008, including but not limited to the engines attached hereto as Ex. D.

REQUEST FOR PRODUCTION NO. 79:

All documents referring or relating to Blue Max horizontal shaft engines, including but not limited to the engines attached hereto as Ex. E.

REQUEST FOR PRODUCTION NO. 80:

All documents referring or relating to Applicant's or American Honda's knowledge of Blue Max horizontal shaft engines, including but not limited to Applicant's or American Honda's first knowledge of the engines attached hereto as Ex. E.

REQUEST FOR PRODUCTION NO. 81:

All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of Blue Max horizontal shaft engines, including but not limited to the engines hereto as Ex. E.

REQUEST FOR PRODUCTION NO. 82:

All documents referring or relating to Applicants's or American Honda's GX engine trade dress enforcement efforts, if any, against Blue Max.

REQUEST FOR PRODUCTION NO. 83:

All documents referring or relating to any trade dress settlement agreement between Applicant or American Honda and Blue Max.

REQUEST FOR PRODUCTION NO. 84:

All documents referring or relating to All-Power horizontal shaft engines, including but not limited to the engines attached hereto as Ex. F.

REQUEST FOR PRODUCTION NO. 85:

All documents referring or relating to Applicant's or American Honda's knowledge of All-Power horizontal shaft engines, including but not limited to Applicant's or American Honda's first knowledge of the engines attached hereto as Ex. F.

REQUEST FOR PRODUCTION NO. 86:

All documents referring or relating to Applicant's or American Honda's purchase, inspection, or testing of All Power horizontal shaft engines, including but not limited to the engines hereto as Ex. F.

REQUEST FOR PRODUCTION NO. 87:

All documents referring or relating to Applicants's or American Honda's GX engine trade dress enforcement efforts, if any, against All Power.

REQUEST FOR PRODUCTION NO. 88:

All documents referring or relating to any trade dress settlement agreement between Applicant or American Honda and All Power.

DATED: April 4, 2014

By:

/s/ Robert N. Phillips

Robert N. Phillips

Reed Smith LLP

Nina Habib Borders

Reed Smith LLP

Attorneys for Opposer

BRIGGS & STRATTON CORPORATION

EXHIBIT A





EXHIBIT B



EXHIBIT C





EXHIBIT D





EXHIBIT E





EXHIBIT F





CERTIFICATE OF SERVICE

I hereby certified that a true copy of the foregoing OPPOSER BRIGGS & STRATTON CORPORATION'S FIFTH SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS TO APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA was served on the following counsel of record, by depositing same in the U.S. mail, first class postage prepaid, this 4th day of April, 2014:

Michael J. Bevilacqua, Esq.
Vinita Ferrera, Esq.
Silena Y. Paik, Esq.
Sarah R. Frazier, Esq.
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109-1800
Telephone (617) 526-6448
Facsimile: (617) 526-5000

Elizabeth Townsend Bridge
Donald Daugherty
Whyte Hirschboeck Dudek S.C.
555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202
Telephone: (414) 273-2100
Facsimile: (414) 223-5000

/s/ Deborah Kalahale

Deborah L. Kalahale

EXHIBIT B
Filed Under Seal

EXHIBIT C

Hoffman, Shira

From: Phillips, Robert N. (Rob) <RobPhillips@ReedSmith.com>
Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

Silena and Sarah,

I write to follow up on our meet and confer telephone conference regarding Honda's responses to Briggs' Fifth Set of Requests for Production.

Regarding Request No. 57, as I stated, we are skeptical that no responsive documents exist. Please discuss with your client, and let us know the steps Honda has taken to confirm that no responsive documents exist.

Regarding Request Nos. 58-60, as I explained on our call, these Requests are relevant to functionality and secondary meaning. These engines clearly embody most or all of the features of the applied-for mark, and thus Honda's considerations in designing them are relevant to functionality. Similarly, any decisions made to differentiate these engines from the GX via styling changes, including but not limited to the different coloring, is relevant to the secondary meaning of the GX's specific styling and color and therefore to the secondary meaning of the applied-for mark. The fact that these engines are not sold in the United States does not render the requests irrelevant. Please let us know by May 23 whether Honda will agree to produce documents responsive to these Requests.

Regarding Request Nos. 62-88, you stated on the call that Honda believed that many of these requests were overbroad in that they included information related to all horizontal shaft engines sold by the identified third parties. While Briggs disagrees that these Requests are overbroad, to address Honda's concerns, Briggs proposes to limit these requests to horizontal shaft engines with high-mount air cleaner covers sold by the identified third parties. Honda's knowledge of, inspection and testing of, and enforcement against third party engines with this configuration is clearly relevant to issues such as functionality, secondary meaning, abandonment, and genericness, and the Requests are narrowly tailored to include just those third party engines with the same or similar shape and configuration as the applied-for mark. Please let us know by May 23 whether Honda will agree to produce documents responsive to these Requests as modified herein.

We look forward to Honda's responses on these issues.

Regards,

Rob

Robert N. Phillips | Reed Smith LLP

101 Second Street - Suite 1800 San Francisco, CA 94105
Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
robphillips@reedsmith.com | www.reedsmith.com

* * *

This E-mail, along with any attachments, is considered confidential and may well be legally privileged. If you have received it in error, you are on notice of its status. Please notify us immediately by reply e-mail and then delete this message from your system. Please do not copy it or use it for any purposes, or disclose its contents to any other person. Thank you for your cooperation.

* * *

To ensure compliance with Treasury Department regulations, we inform you that, unless otherwise indicated in writing, any U.S. Federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of (1) avoiding penalties under the Internal Revenue Code or applicable state and local provisions or (2) promoting, marketing or recommending to another party any tax-related matters addressed herein.

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EXHIBIT D

Hoffman, Shira

From: Frazier, Sarah
Sent: Tuesday, June 03, 2014 10:04 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John
Subject: RE: Briggs and Kohler v Honda

Rob,

Regarding Request No. 57, as stated in Honda's responses and during our meet and confer, no documents exist regarding whether a customer is sold an EPA Phase 3 engine or an earlier model. As Scott Conner noted during his deposition, the inventory is "mix and match," and as Mike Rudolph testified, customers know whether they are receiving an EPA Phase 3 engine by the model number. Honda has confirmed with the appropriate individuals that no responsive documents exist.

Regarding Request Nos. 58-60, Honda maintains its objections to these requests as irrelevant, overly broad, and unduly burdensome. As confirmed during the depositions of several Honda witnesses, these engines were not developed in, nor are they sold in, the United States. Because the secondary meaning inquiry is focused on the relevant purchasing population, the design of the GP engine is thus irrelevant to that issue. Further, Mr. Sugimoto testified in his recent deposition that the GP engine was developed for a different purpose than the GX engine and that it does not use the same components. It is thus similarly irrelevant to the issue of functionality.

Regarding Request Nos. 62-88, Honda has already agreed to, and in fact has produced all documents responsive to those requests related to enforcement efforts against the third parties identified therein (Nos. 65, 75, 82, and 87). Honda has also confirmed that no documents responsive to request numbers 66, 70, 83, or 88 exist. The remaining requests, even as narrowed below, are still overly broad and unduly burdensome. Nonetheless, Honda is investigating the existence of documents (beyond those already produced) regarding the inspection or testing of the external components of engines manufactured by the identified third parties, and with the same relative placement of components (e.g., fuel tank on top of fan cover, air cleaner on the top left of engine) as shown in the exhibits to Briggs' requests.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [mailto:RobPhillips@ReedSmith.com]
Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

Silena and Sarah,

I write to follow up on our meet and confer telephone conference regarding Honda's responses to Briggs' Fifth Set of Requests for Production.

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We look forward to Honda's responses on these issues.

Regards,

Rob

Robert N. Phillips | Reed Smith LLP

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Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
robphillips@reedsmith.com | www.reedsmith.com

* * *

This E-mail, along with any attachments, is considered confidential and may well be legally privileged. If you have received it in error, you are on notice of its status. Please notify us immediately by reply e-mail and then delete this message from your system. Please do not copy it or use it for any purposes, or disclose its contents to any other person. Thank you for your cooperation.

* * *

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EXHIBIT E

Hoffman, Shira

From: Phillips, Robert N. (Rob) <RobPhillips@ReedSmith.com>
Sent: Wednesday, June 25, 2014 7:05 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Sarah:

Without waiving our position that Requests Nos. 62-88 with regard to the identified third party engines with the high mount air cleaner design are properly tailored and highly relevant, and reserving all rights to move on such requests, have you determined whether Honda has any of the documents you indicated you were investigating below?

Rob

From: Frazier, Sarah [<mailto:Sarah.Frazier@wilmerhale.com>]
Sent: Tuesday, June 03, 2014 7:04 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John
Subject: RE: Briggs and Kohler v Honda

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manufactured by the identified third parties, and with the same relative placement of components (e.g., fuel tank on top of fan cover, air cleaner on the top left of engine) as shown in the exhibits to Briggs' requests.

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Sarah

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Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

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Regarding Request Nos. 62-88, you stated on the call that Honda believed that many of these requests were overbroad in that they included information related to all horizontal shaft engines sold by the identified third parties. While Briggs disagrees that these Requests are overbroad, to address Honda's concerns, Briggs proposes to limit these requests to horizontal shaft engines with high-mount air cleaner covers sold by the identified third parties. Honda's knowledge of, inspection and testing of, and enforcement against third party engines with this configuration is clearly relevant to issues such as functionality, secondary meaning, abandonment, and genericness, and the Requests are narrowly tailored to include just those third party engines with the same or similar shape and configuration as the applied-for mark. Please let us know by May 23 whether Honda will agree to produce documents responsive to these Requests as modified herein.

We look forward to Honda's responses on these issues.

Regards,

Rob

Robert N. Phillips | Reed Smith LLP

101 Second Street - Suite 1800 San Francisco, CA 94105
Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
robphillips@reedsmith.com | www.reedsmith.com

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EXHIBIT F

Hoffman, Shira

From: Frazier, Sarah
Sent: Monday, June 30, 2014 8:24 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Hi Rob,

Please provide the model numbers of the engines depicted in exhibits A through F to Opposers' Fifth Set of Requests for Production.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [mailto:RobPhillips@ReedSmith.com]
Sent: Wednesday, June 25, 2014 7:05 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Sarah:

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Rob

From: Frazier, Sarah [mailto:Sarah.Frazier@wilmerhale.com]
Sent: Tuesday, June 03, 2014 7:04 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John
Subject: RE: Briggs and Kohler v Honda

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Thanks,
Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]
Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

Silena and Sarah,

I write to follow up on our meet and confer telephone conference regarding Honda's responses to Briggs' Fifth Set of Requests for Production.

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EXHIBIT G

Hoffman, Shira

From: Phillips, Robert N. (Rob) <RobPhillips@ReedSmith.com>
Sent: Thursday, July 24, 2014 5:00 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Sarah:

My apologies for the delay in getting back to you on this. Requests Nos 62 – 88 were not limited to any specific model numbers. Rather, as we discussed, they are intended to discover Honda's information regarding third party horizontal shaft engines with high mount air cleaners in the same general overall configuration as the Honda GX, as shown in Exhibits A through F. Those photos show similarly shaped engines put out under the brand names Generac, V Power, Lifan, Blue Max, All Power, and Jiang Dong. The engine photos came from the websites referenced in the corresponding requests for admissions which will whatever additional information you seek concerning model numbers. To the extent Honda has possession of any of these engines, or documents regarding these engines, or any other horizontal shaft engines put out under those brands with high mount air cleaners, those should be produced. Please let me know whether Honda will withdraw its objections and agree to produce all such responsive documents.

Rob

Robert N. Phillips | Reed Smith LLP

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Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
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Sent: Monday, June 30, 2014 5:24 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Hi Rob,

Please provide the model numbers of the engines depicted in exhibits A through F to Opposers' Fifth Set of Requests for Production.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]
Sent: Wednesday, June 25, 2014 7:05 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Sarah:

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Sent: Tuesday, June 03, 2014 7:04 AM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John
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Thanks,

Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]
Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

Silena and Sarah,

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EXHIBIT H

Hoffman, Shira

From: Frazier, Sarah
Sent: Tuesday, August 05, 2014 3:46 PM
To: Phillips, Robert N. (Rob)
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Rob,

Honda remains willing to look for documents regarding the specific models depicted in the exhibits to Opposers' Fifth set of RFAs. However, there is not a one-to-one correspondence between the websites listed in Opposers' Fifth Set of RFAs and those exhibits, nor is the burden on Honda to define Opposers' requests. If Opposers wish to provide Honda with the list of model numbers, Honda will search its files for potentially responsive documents.

As we discussed, it is unreasonable and unduly burdensome to ask Honda to review all testing documents—a majority of which are kept in Japan—in an attempt to determine whether the engines tested had high-mount air cleaners. Furthermore, the information Opposers seek regarding these third-party engines can be more easily obtained through other sources. Indeed, as represented below, Opposers identified these engines on public websites, many of which include specifications and testing information. Opposers have also subpoenaed several of the manufacturers identified for documents related to “horizontal shaft engines with high mount air cleaners.” Honda thus maintains its objections to RFP Nos. 62-88.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [mailto:RobPhillips@ReedSmith.com]
Sent: Thursday, July 24, 2014 5:00 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

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101 Second Street - Suite 1800 San Francisco, CA 94105
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robphillips@reedsmith.com | www.reedsmith.com

From: Frazier, Sarah [<mailto:Sarah.Frazier@wilmerhale.com>]

Sent: Monday, June 30, 2014 5:24 AM

To: Phillips, Robert N. (Rob)

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

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Sent: Wednesday, June 25, 2014 7:05 PM

To: Frazier, Sarah

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

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Sent: Monday, May 19, 2014 3:37 PM

To: Paik, Silena; Frazier, Sarah

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)

Subject: Briggs and Kohler v Honda

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EXHIBIT I

Hoffman, Shira

From: Phillips, Robert N. (Rob) <RobPhillips@ReedSmith.com>
Sent: Wednesday, August 06, 2014 6:49 PM
To: Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen
Subject: RE: Briggs and Kohler v Honda

Sarah:

Again, these requests are not limited to any specific model numbers, and so your offer to have Honda search for the specific models shown in the photos does not go far enough.

Clearly, Honda studies the competition, and will have in its possession documents regarding third party horizontal shaft engines with high mount air cleaners having overall configurations similar to the GX. It would not be burdensome to ask your client to review its files and produce those documents regarding such engines and/or or power equipment products put out by Generac, V Power, Lifan, Blue Max, All Power, and Jiang Dong. If the search were limited by model number, as you propose, it is highly likely that relevant documents would not be produced as model numbers vary or may not even be referenced in the documents. What doesn't vary, however, is the brand name, and the standard overall configuration that is being used in the industry, and this is highly relevant, and documents regarding such third party use should be produced by Honda. The fact that we have obtained some of these documents from third parties is irrelevant. Obviously, documents related to **Honda's** testing, purchase, inspection, monitoring, or knowledge of the identified engines cannot be obtained from any source but Honda, and these are relevant to functionality, lack of secondary meaning, genericness, and abandonment, which are all at issue in this case.

It appears that we are at an impasse, and will need to file a motion with the Board. If you have any other suggestions, please feel free to let me know.

Regards,

Rob

Robert N. Phillips | **Reed Smith** LLP

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From: Frazier, Sarah [mailto:Sarah.Frazier@wilmerhale.com]
Sent: Tuesday, August 05, 2014 12:46 PM
To: Phillips, Robert N. (Rob)

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

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Rob,

Honda remains willing to look for documents regarding the specific models depicted in the exhibits to Opposers' Fifth set of RFAs. However, there is not a one-to-one correspondence between the websites listed in Opposers' Fifth Set of RFAs and those exhibits, nor is the burden on Honda to define Opposers' requests. If Opposers wish to provide Honda with the list of model numbers, Honda will search its files for potentially responsive documents.

As we discussed, it is unreasonable and unduly burdensome to ask Honda to review all testing documents—a majority of which are kept in Japan—in an attempt to determine whether the engines tested had high-mount air cleaners. Furthermore, the information Opposers seek regarding these third-party engines can be more easily obtained through other sources. Indeed, as represented below, Opposers identified these engines on public websites, many of which include specifications and testing information. Opposers have also subpoenaed several of the manufacturers identified for documents related to “horizontal shaft engines with high mount air cleaners.” Honda thus maintains its objections to RFP Nos. 62-88.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]

Sent: Thursday, July 24, 2014 5:00 PM

To: Frazier, Sarah

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

Subject: RE: Briggs and Kohler v Honda

Sarah:

My apologies for the delay in getting back to you on this. Requests Nos 62 – 88 were not limited to any specific model numbers. Rather, as we discussed, they are intended to discover Honda's information regarding third party horizontal shaft engines with high mount air cleaners in the same general overall configuration as the Honda GX, as shown in Exhibits A through F. Those photos show similarly shaped engines put out under the brand names Generac, V Power, Lifan, Blue Max, All Power, and Jiang Dong. The engine photos came from the websites referenced in the corresponding requests for admissions which will whatever additional information you seek concerning model numbers. To the extent Honda has possession of any of these engines, or documents regarding these engines, or any other horizontal shaft engines put out under those brands with high mount air cleaners, those should be produced. Please let me know whether Honda will withdraw its objections and agree to produce all such responsive documents.

Rob

Robert N. Phillips | Reed Smith LLP

101 Second Street - Suite 1800 San Francisco, CA 94105
Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
robphillips@reedsmith.com | www.reedsmith.com

From: Frazier, Sarah [<mailto:Sarah.Frazier@wilmerhale.com>]

Sent: Monday, June 30, 2014 5:24 AM

To: Phillips, Robert N. (Rob)

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

Subject: RE: Briggs and Kohler v Honda

Hi Rob,

Please provide the model numbers of the engines depicted in exhibits A through F to Opposers' Fifth Set of Requests for Production.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]

Sent: Wednesday, June 25, 2014 7:05 PM

To: Frazier, Sarah

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John; Dow, Colleen

Subject: RE: Briggs and Kohler v Honda

Sarah:

Without waiving our position that Requests Nos. 62-88 with regard to the identified third party engines with the high mount air cleaner design are properly tailored and highly relevant, and reserving all rights to move on such requests, have you determined whether Honda has any of the documents you indicated you were investigating below?

Rob

From: Frazier, Sarah [<mailto:Sarah.Frazier@wilmerhale.com>]

Sent: Tuesday, June 03, 2014 7:04 AM

To: Phillips, Robert N. (Rob)

Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com); Paik, Silena; Ferrera, Vinita; Regan, John

Subject: RE: Briggs and Kohler v Honda

Rob,

Regarding Request No. 57, as stated in Honda's responses and during our meet and confer, no documents exist regarding whether a customer is sold an EPA Phase 3 engine or an earlier model. As Scott Conner noted during his deposition, the inventory is "mix and match," and as Mike Rudolph testified, customers know whether they are receiving

an EPA Phase 3 engine by the model number. Honda has confirmed with the appropriate individuals that no responsive documents exist.

Regarding Request Nos. 58-60, Honda maintains its objections to these requests as irrelevant, overly broad, and unduly burdensome. As confirmed during the depositions of several Honda witnesses, these engines were not developed in, nor are they sold in, the United States. Because the secondary meaning inquiry is focused on the relevant purchasing population, the design of the GP engine is thus irrelevant to that issue. Further, Mr. Sugimoto testified in his recent deposition that the GP engine was developed for a different purpose than the GX engine and that it does not use the same components. It is thus similarly irrelevant to the issue of functionality.

Regarding Request Nos. 62-88, Honda has already agreed to, and in fact has produced all documents responsive to those requests related to enforcement efforts against the third parties identified therein (Nos. 65, 75, 82, and 87). Honda has also confirmed that no documents responsive to request numbers 66, 70, 83, or 88 exist. The remaining requests, even as narrowed below, are still overly broad and unduly burdensome. Nonetheless, Honda is investigating the existence of documents (beyond those already produced) regarding the inspection or testing of the external components of engines manufactured by the identified third parties, and with the same relative placement of components (e.g., fuel tank on top of fan cover, air cleaner on the top left of engine) as shown in the exhibits to Briggs' requests.

Thanks,
Sarah

From: Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]
Sent: Monday, May 19, 2014 3:37 PM
To: Paik, Silena; Frazier, Sarah
Cc: Herring, Seth B.; Donald A. DAD Daugherty (DDAUGHERTY@whdlaw.com); Giftos, Melinda MG (6076) (MGiftos@whdlaw.com)
Subject: Briggs and Kohler v Honda

Silena and Sarah,

I write to follow up on our meet and confer telephone conference regarding Honda's responses to Briggs' Fifth Set of Requests for Production.

Regarding Request No. 57, as I stated, we are skeptical that no responsive documents exist. Please discuss with your client, and let us know the steps Honda has taken to confirm that no responsive documents exist.

Regarding Request Nos. 58-60, as I explained on our call, these Requests are relevant to functionality and secondary meaning. These engines clearly embody most or all of the features of the applied-for mark, and thus Honda's considerations in designing them are relevant to functionality. Similarly, any decisions made to differentiate these engines from the GX via styling changes, including but not limited to the different coloring, is relevant to the secondary meaning of the GX's specific styling and color and therefore to the secondary meaning of the applied-for mark. The fact that these engines are not sold in the United States does not render the requests irrelevant. Please let us know by May 23 whether Honda will agree to produce documents responsive to these Requests.

Regarding Request Nos. 62-88, you stated on the call that Honda believed that many of these requests were overbroad in that they included information related to all horizontal shaft engines sold by the identified third parties. While Briggs disagrees that these Requests are overbroad, to address Honda's concerns, Briggs proposes to limit these requests to horizontal shaft engines with high-mount air cleaner covers sold by the identified third parties. Honda's knowledge of, inspection and testing of, and enforcement against third party engines with this configuration is clearly relevant to issues such as functionality, secondary meaning, abandonment, and genericness, and the Requests are narrowly tailored to include just those third party engines with the same or similar shape and configuration as the applied-for mark. Please let us know by May 23 whether Honda will agree to produce documents responsive to these Requests as modified herein.

We look forward to Honda's responses on these issues.

Regards,

Rob

Robert N. Phillips | Reed Smith LLP

101 Second Street - Suite 1800 San Francisco, CA 94105
Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269
robphillips@reedsmith.com | www.reedsmith.com

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EXHIBIT J

October 22, 2014

Sarah R. Frazier

VIA FEDERAL EXPRESS

+1 617 526 6022 (t)
+1 617 526 5000 (f)
sarah.frazier@wilmerhale.com

Robert N. Philips, Esq.
Seth B. Herring, Esq.
Reed Smith LLP
101 Second Street, Suite 1800
San Francisco, California 94105

Donald A. Daugherty, Jr., Esq.
Whyte Hirschboeck Dudek S.C.
555 East Wells Street, Suite 1900
Milwaukee, WI 53202

Re: Briggs & Stratton Corporation and Kohler Co. v. Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.), TTAB Opposition No. 91200832 (parent)

Dear Counsel:

Enclosed for production in the above-referenced matter is a CD containing documents Bates labeled AHGX0102034- AHGX0102039. The enclosed CD contains documents designated as "Attorneys' Eyes Only" pursuant to the terms of the protective order entered in this matter. The CD has been encrypted using TruCrypt encryption software. I will send the password in a separate email.

This production contains documents responsive to Briggs' Requests for Production Nos. 64, 69, 74, 78, 81, and 86 to the extent that any exist. Please confirm that Opposers will withdraw their Motion to Compel with respect to these requests, and inform the Board as required by TBMP Rule 523.03 and 37 CFR § 2.120(e).

Sincerely,



Sarah R. Frazier

Enclosure

EXHIBIT K
Filed Under Seal

EXHIBIT L

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CATEGORY

- [Under 5 HP Engines](#) (0)
- [5.5 - 7 HP Engines](#) (2)
- [11 - 14 HP Engines](#) (2)
- [Engine Parts & Carburetors](#) (36)
- [Handy Man Special Engines](#) (1)

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[420cc 13HP Horizontal Shaft Engine](#)

Regular Price: ~~\$279.00~~
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Regular Price: ~~\$249.00~~
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[5.5 Vertical Shaft Lawnmower Engine](#)

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[212 CC air filter fits predator engine](#)
\$4.95



[oil plug with dip stick](#)
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[valve cover with internal breather filter](#)
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[212cc complete cylinder head](#)
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[Valve Cover Gasket for 11-15HP \(346-420cc\) Engine](#)
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[Recoil Starter for 346cc - 420cc \(11hp - 15hp\)](#)
\$19.99



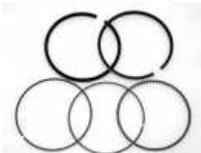
[Ignition Coil for 5.5-7hp \(160-212cc\)](#)
\$14.95



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[Piston Ring Set for 346cc - 420cc \(11 - 15hp\)](#)
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6 HP 173cc
Vertical Gasoline Engine

- APE7007



208cc Gasoline Engine

- APE7009



291cc Gasoline Engine

- **APE7013E**



389cc Horizontal
Gasoline Engine With Electric Start

- **APE7015**



420cc L Type
Gasoline Engine
With Electric Start

- **APE7210N**



10HP 418cc
Single Cylinder Air Cooled
Diesel Engine

- **APE7009SE**



302cc Snow Blower
Engine With Electric Start

▪ APE7015SE



420cc Snow Blower
Engine With Electric Start



APE7013E

389cc Horizontal

Gasoline Engine

With Electric Start



APE7009

291cc

Gasoline Engine



APE7007

208cc

Gasoline Engine



APE7006V

6 HP 173cc

Vertical Gasoline Engine



APE7015

420cc L Type

Gasoline Engine

With Electric Start



APE7015SE

420cc Snow Blower

Engine With Electric Start



APE7210N

10 HP 418cc

Single Cylinder Air

Cooled Diesel Engine



APE7009SE

302cc Snow Blower

Engine With Electric Start

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- Diesel Generator
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PRODUCT

Gasoline Engine

HOME > Gasoline Engine

- Water Pump
- Diesel Engine
- Multi-cylinder Diesel Engine
- Single-cylinder Diesel Engine
- Gasoline Engine
- Gasoline Generator
- Diesel Generator
- Tractor
- LPG Generator
- Agricultural & Gardening
- Premium Pressure Washer
- Lawn Mower
- Cultivator
- Rice Transplanter
- SNOW PLOW
- Harvester



JF154

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- Industrial Grade Single Cylinder Four-Stroke Gasoline Engine
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2.5MHP (97.7cc)

- Industrial Grade Single Cylinder Four-Stroke OHV Gasoline Engine
- Recoil Start
- Horizontal Keyway Output Shaft

4-7MHP (118cc-210cc)

- Industrial Grade Single Cylinder Four-Stroke OHV Gasoline Engine
- Recoil/Electric Start
- Horizontal Keyway, Tapered, Threaded Output Shaft
- 2:1 Clutch Reducer
- 6:1 Gear Reducer

8-9MHP (242cc-270cc)

- Industrial Grade Single Cylinder Four-Stroke OHV Gasoline Engine
- Recoil/Electric Start
- Horizontal Keyway, Tapered, Threaded Output Shaft
- 2:1 Clutch Reducer
- 6:1 Gear Reducer

11-15MHP (337cc-420cc)

- Industrial Grade Single Cylinder Four-Stroke OHV Gasoline Engine
- Recoil/Electric Start
- Horizontal Keyway, Tapered, or Threaded Output Shaft
- 2:1 Clutch Reducer
- 6:1 Gear Reducer
- 18-22amp Charger

22MHP V-TWIN (688cc)

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NOTE: MHP refers to Maximum Horsepower.
OHV refers to Overhead Valve.



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Part Number	Power Output	Type
LF139F (http://www.lifanpowerusa.com/engines/1-5mhp-coming-soon/)	1.5MHP (34.6cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF152F (http://www.lifanpowerusa.com/engines/2-5mhp/)	2.5MHP (97.7cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF160F (http://www.lifanpowerusa.com/engines/4mhp/)	4MHP (118cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF168F (http://www.lifanpowerusa.com/engines/5-5mhp/)	5.5MHP (163cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF168F-2 (http://www.lifanpowerusa.com/engines/6-5mhp/)	6.5MHP (196cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF170F	7MHP (212cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF173F (http://www.lifanpowerusa.com/engines/8mhp/)	8MHP (242cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF177F (http://www.lifanpowerusa.com/engines/9mhp/)	9MHP (270cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF182F (http://www.lifanpowerusa.com/engines/11mhp/)	11MHP (337cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF188F (http://www.lifanpowerusa.com/engines/13mhp/)	13MHP (389cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF190F (http://www.lifanpowerusa.com/engines/15mhp/)	15MHP (420cc)	4-Stroke, Single Cylinder, OHV, Horizontal Output
LF2V78D (http://www.lifanpowerusa.com/engines/22mhp-v-twin/)	22MHP (688cc)	4-Stroke, Twin-Cylinder, OHV, Horizontal Output

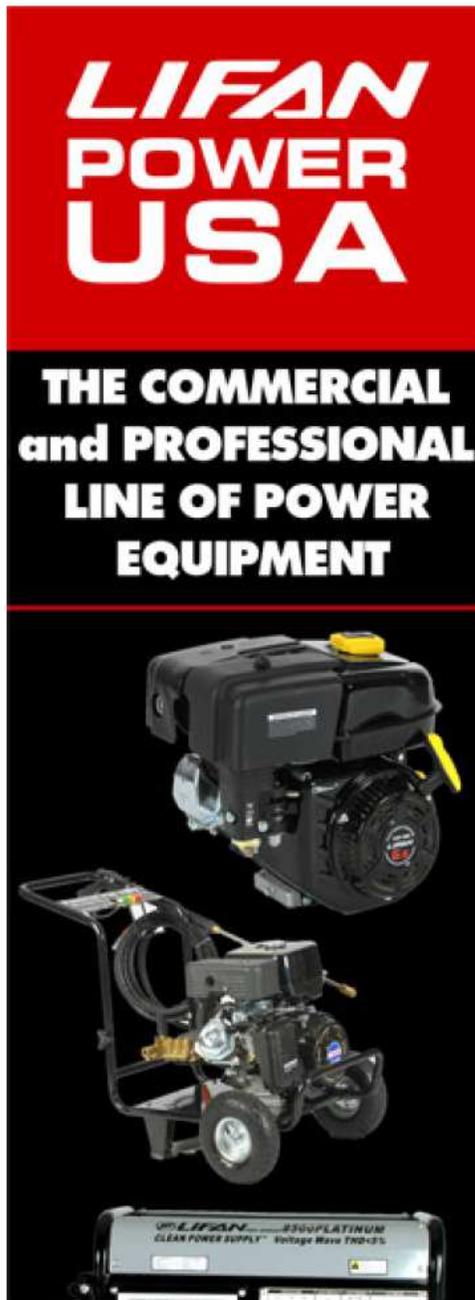
[Interactive Whiteboards \(http://www.polyvision.com\)](http://www.polyvision.com) by PolyVision

NOTE: MHP = Maximum Horsepower

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EXHIBIT M
Filed Under Seal

EXHIBIT N

Honda Black (Matte)



Honda Black 5.5 HP



Honda Blue 5.5 HP



Honda Yellow



EXHIBIT O

2004 WL 3121681 (D.D.C.) (Trial Pleading)
United States District Court, District of Columbia.

Tequila CENTINELA, S.A. de C.V., Kilometro 2.5 Carretera Arandas-Tepatitlan Arandas, Jalisco Mexico 47180
Plaintiff,
v.
BACARDI COMPANY LIMITED, claimed successor in interest to Grupo Industrial Tlajomulco S.A. de C.V.
f/k/a Tequila Cazadores S.A. de C.V., Defendant.

No. 04-CV-02201.
December 20, 2004.

Complaint

Jeffrey H. Kaufman (D.C Bar No. 955286), Jonathan Hudis (D.C. Bar No. 418872), 1940 Duke Street, Alexandria, Virginia 22314, (703) 413-3000, Fax: (703) 413-2220, E-Mail: jkaufman@oblon.com, E-Mail: jhudis@oblon.com, Attorneys for Plaintiff, Tequila Centinela, S.A. de C.V.

Plaintiff, TEQUILA CENTINELA, S.A. de C.V. ("Centinela"), as and for its Complaint against Defendant, BACARDI COMPANY LIMITED, alleged successor in interest to GRUPO INDUSTRIAL TLAJOMULCO S.A. de C.V. f/k/a TEQUILA CAZADORES S.A. de C.V. ("Bacardi"), alleges as follows.

Introduction

1. By this action, Centinela seeks review and reversal of the March 5, 2003, February 24, 2004, and October 19, 2004 Decisions and Orders of the Trademark Trial and Appeal Board (the "TTAB" or the "Board"), to the extent they were adverse to Centinela, in Opposition No. 91/125,436 (the "Opposition"):

- a) deferring and ultimately denying Centinela's motion to amend Application Serial No. 76/112,825 for the mark CABRITO & (GOAT) Design (the "CABRITO Application"), to revise the dates of first use and to narrow the identification of goods;
- b) denying Centinela's motion for summary judgment that there is no likelihood of confusion and no dilution as between Centinela's CABRITO & (GOAT) Design mark and the various marks comprising and/or incorporating the term CAZADORES (with and without other terms and/or designs) for tequila, as cited in the Opposition;
- c) granting Bacardi's motions to join as a party-plaintiff in the Opposition, to amend the Notice of Opposition to assert a claim of fraud in the filing of the CABRITO Application, and for summary judgment on Bacardi's amended claim of fraud; and
- d) finding that Bacardi had standing to bring and maintain the Opposition.

2. Centinela also seeks a determination by the Court that:

- a) Centinela was entitled to amend the CABRITO Application during the course of the Opposition to revise the dates of first use and narrow the identification of goods;
- b) summary judgment should have been granted to Centinela, on the issues of no likelihood of confusion and no dilution;
- c) the Board's finding of fraud, on Bacardi's motions to amend the Notice of Opposition and for summary judgment, was based upon a lack of substantial evidence and a misapplication of applicable law; and that

d) Bacardi did not have standing to maintain the Opposition.

The Parties

3. Plaintiff, TEQUILA CENTINELA, S.A. de C.V. (“Centinela”), is a corporation organized and existing under the laws of Mexico, and whose address is Kilometro 2.5 Carretera Arandas-Tepatitlan Arandas, Jalisco, Mexico 47180.

4. Upon information and belief, Defendant, BACARDI COMPANY LIMITED (“Bacardi”), is a corporation organized and existing under the laws of Liechtenstein, and whose address is 1000 Bacardi Road, Nassau, Bahamas.

5. Upon information and belief, based on a series of *mesne* assignments, Defendant Bacardi alleges to be the successor in interest from GRUPO INDUSTRIAL TLAJOMULCO S.A. de C.V. (a Mexico corporation) f/k/a TEQUILA CAZADORES S.A. de C.V., (a Mexico corporation) in and to various marks comprising and/or incorporating the term CAZADORES for tequila.

Jurisdiction and Venue

6. This Court has subject matter jurisdiction over this matter pursuant to 15 U.S.C. § 1071(b), because this is a civil action to appeal Decisions and Orders issued by the TTAB that resulted in a final disposition of the Opposition and the CABRITO Application.

7. This Court has personal jurisdiction over Bacardi pursuant to 15 U.S.C. § 1071(b)(4), and because Bacardi has purposefully availed itself of the privileges and benefits of doing business in the District of Columbia by engaging in business, by having a continuing corporate presence directed toward advancing Bacardi’s objectives and/or by engaging in a systematic course of conduct in this District.

8. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and (c), and pursuant to 15 U.S.C. § 1071(b)(4).

Background

9. On August 21, 2000, Centinela filed Application Serial No. 76/112,825 for the mark CABRITO & (GOAT) Design for alcoholic beverages including tequila (the “CABRITO Application”).

10. On May 9, 2002, TEQUILA CAZADORES S.A. de C.V. (a Mexico corporation) opposed registration of the CABRITO Application on the grounds of likelihood of confusion with, and the dilution of, various marks comprising and/or incorporating the term CAZADORES (with and without other words and/or designs) for tequila.

11. Centinela answered the Notice of Opposition of TEQUILA CAZADORES S.A. de C.V. on June 24, 2002. On August 30, 2002, Centinela moved before the TTAB, prior to a claim of fraud ever being raised, to amend the CABRITO Application to revise the dates of first use and to narrow the identification of goods.

12. On September 4, 2002, Bacardi moved before the Board to substitute itself as the party-plaintiff in the Opposition, to amend the Notice of Opposition to assert a claim that the CABRITO Application was fraudulently filed, and for summary judgment based upon the amended claim of fraud.

13. On November 1, 2002, Centinela moved before the Board for summary judgment that there is no likelihood of confusion and no dilution as between Centinela’s CABRITO & (GOAT) Design mark and the various marks comprising and/or incorporating the term CAZADORES (with and without other words and/or designs) for tequila, as cited in the Opposition.

14. In its Decision and Order of March 5, 2003, the Board denied Bacardi's motion to substitute itself as party-plaintiff in the Opposition because Bacardi did not adequately prove its chain of title to the CAZADORES marks upon which the Opposition was based. Therefore, Bacardi's motions to amend the Notice of Opposition and for summary judgment were given no consideration as they were filed by an entity not a party to the proceedings. In that same Decision and Order, the Board deferred ruling on Centinela's motion to amend the CABRITO Application until final disposition of the Opposition or on summary judgment. The Board also denied Centinela's motion for summary judgment that there is no likelihood of confusion and no dilution, without specifying a single outstanding genuine issue of material fact that remained for trial, and without stating that Centinela could not prevail as a matter of law.

15. On April 15, 2003, Bacardi filed renewed motions to substitute itself as party-plaintiff in the Opposition, to amend the Notice of Opposition to again assert a claim that the CABRITO Application was fraudulently filed, and for summary judgment based upon the amended claim of fraud.

16. On October 20, 2003, the Board issued an Order stating that Bacardi had not sufficiently provided documentation to adequately prove its chain of title to the CAZADORES marks upon which the Opposition was based. The Board provided Bacardi 20 days to supply the missing documentation.

17. Bacardi supplied supplemental documentation to the Board, which Centinela objected still did not adequately prove Bacardi's chain of title to the CAZADORES marks upon which the Opposition was based.

18. On February 24, 2004, the Board issued a Decision and Order granting Bacardi's motion to amend the Notice of Opposition to assert that the CABRITO Application was fraudulently filed. The Board also granted Bacardi's motion for summary judgment that the CABRITO Application was fraudulently filed. The basis for the Board's summary judgment decision was that Centinela included more **goods** in its use-based application under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), than those on which Centinela was using the CABRITO & (GOAT) Design mark at the time that Centinela filed the CABRITO Application. Further, said the Board, Centinela's attempt to narrow the identification of goods in the CABRITO Application did not cure the original fraudulent filing. The Board finally stated that there remained outstanding issues of fact regarding Bacardi's standing to maintain the Opposition, and provided Bacardi 60 days to supply documentation to adequately prove Bacardi's chain of title to the CAZADORES marks upon which the Opposition was based.

19. Once more, Bacardi supplied supplemental documentation to the Board, which Centinela again objected did not adequately prove Bacardi's chain of title to the CAZADORES marks upon which the Opposition was based.

20. On October 19, 2004, the Board issued a Decision and Order granting Bacardi's motion for summary judgment on the issue of its standing. Notwithstanding the infirmities Centinela noted in Bacardi's chain of title to the CAZADORES marks upon which Opposition was based, the Board held that Bacardi had a real interest in the proceeding sufficient to imbue it with standing. The Board sustained the Opposition, and refused registration to Centinela on the ground of fraud.

21. In combination, the Board's decisions: (i) were arbitrary, capricious, and an abuse of discretion by unfairly denying Centinela an opportunity to correct a mistake in its trademark application; (ii) allowed the Opposition to proceed with Bacardi as the party-plaintiff, without first definitively resolving the factual question of Bacardi's standing; (iii) erroneously denied Centinela's motion for summary judgment of no likelihood of confusion and no dilution, without specifying a single genuine issue of material fact that remained for trial, and without stating that Centinela could not prevail as a matter of law; (iv) erroneously found on summary judgment that Centinela had fraudulently filed the CABRITO Application, without supporting its decision with substantial evidence of, *inter alia*, Centinela's scienter and intent to deceive; (v) erroneously found on summary judgment that Centinela had fraudulently filed the CABRITO Application, notwithstanding the totality of circumstances underlying the filing of the application; and (vi) found on summary judgment that Bacardi had standing to bring and maintain the Opposition, notwithstanding unresolved factual questions concerning the infirmities in Bacardi's chain of title to the CAZADORES marks upon which the Opposition was based.

Cause of Action

Appeal of TTAB Order

22. Centinela repeats the allegations of paragraphs 1 through 21 above.

23. Pursuant to 15 U.S.C. § 1071(b), this Court may review a final disposition of the TTAB in connection with a trademark opposition.

24. The Court's review of the March 5, 2003, February 24, 2004, and October 19, 2004 Decisions and Orders of the Board in Opposition No. 91/125,436 decision will determine whether: (i) the TTAB's actions were arbitrary, capricious, and an abuse of discretion in denying Centinela the opportunity to cure a mistake in the CABRITO Application; (ii) the TTAB's denial of Centinela's motion for summary judgment of no likelihood of confusion and no dilution was proper, given that the Board did not identify a single genuine issue of material fact that remained for trial, and did not state that Centinela could not prevail as a matter of law; (iii) the TTAB's factual findings of fraud and standing were based on substantial evidence; (iv) additional evidence to be presented before this Court for *de novo* consideration constitutes grounds for reversal; and (v) whether the Board's legal conclusions were based upon a correct application of applicable law.

25. The TTAB's actions were arbitrary, capricious, and an abuse of discretion in denying Centinela the opportunity to cure a mistake in the CABRITO Application.

26. The TTAB's denial of Centinela's motion for summary judgment that there is no likelihood of confusion and no dilution was erroneous, given that the Board did not identify a single genuine issue of material fact that remained for trial, and did not state that Centinela could not prevail as a matter of law.

27. The TTAB's decision on summary judgment regarding the fraudulent filing of the CABRITO application was not based on substantial evidence.

28. The TTAB's decision on summary judgment regarding the fraudulent filing of the CABRITO application was based upon unresolved factual issues that should have been viewed in the light most favorable to Centinela, the non-moving party, including but not limited to the issues of scienter and the intent to deceive.

29. The TTAB's decision on summary judgment regarding the fraudulent filing of the CABRITO application was based upon a misapplication of the law of fraud, including but not limited to Centinela's scienter and intent to deceive.

30. The TTAB's decision on summary judgment regarding the fraudulent filing of the CABRITO application improperly evaluated the totality of the evidence (particularly, the facts underlying the filing of the application) and, therefore, reached erroneous conclusions of law regarding Centinela's alleged fraudulent trademark filing.

31. The TTAB's decision on summary judgment regarding Bacardi's standing to maintain the Opposition was based upon unresolved factual issues that should have been viewed in the light most favorable to Centinela, the non-moving party.

32. The TTAB's decision on summary judgment regarding Bacardi's standing to maintain the Opposition was not based on substantial evidence.

33. hi toto, the TTAB's findings of fact were not supported by substantial evidence and further, the TTAB's conclusions of law were clearly erroneous.

Prayer for Relief

For these reasons, Plaintiff, TEQUILA CENTINELA, S.A. de C.V., requests that:

A. upon final determination of this action, judgment be entered reversing the TTAB's March 5, 2003, February 24, 2004, and October 19, 2004 Decisions and Orders, to the extent that they were adverse to Centinela;

B. the Court declare that the CABRITO Application was not fraudulently filed;

C. the Court declare that there is no likelihood of confusion or dilution with respect to the CABRITO & (GOAT) Design mark and various marks comprising and/or incorporating the term CAZADORES (with and without other words and/or designs) for tequila, as asserted in the Opposition;

D. the Court declare that Centinela is permitted to amend the dates of first use and narrow the scope of the identification of goods in the CABRITO Application

E. the Court declare that Bacardi did not have standing to maintain the Opposition; and

F. Centinela be granted such other and further relief to which it may be justly entitled.

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EXHIBIT P

2006 WL 1422916 (D.D.C.) (Trial Motion, Memorandum and Affidavit)
United States District Court, District of Columbia.

Tequila CENTINELA, S.A. DE C.V., Plaintiff,
v.
BACARDI COMPANY LIMITED, claimed successor in interest to Grupo Industrial Tlajomulco S.A. de C.V.
f/k/a Tequila Cazadores S.A. de C.V., Defendant.

No. 1:04CV002201 (RCL).
April 24, 2006.

Plaintiff's Motion to Compel Discovery and to Amend Scheduling Order and Discovery Plan with Statement of Points and Authorities

Oblon, Spivak, McClelland, Maier & Neustadt, P.C., Jeffrey H. Kaufman (D.C. Bar No. 955286), Jonathan Hudis (D.C. Bar No. 418872), 1940 Duke Street, Alexandria, Virginia 22314, Telephone: (703) 413-3000, Facsimile: (703) 413-2220, JKaufman@oblon.com, JHudis@oblon.com, Attorneys for Plaintiff, Tequila Centinela, S.A. de C.V.

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I. MOTION

Plaintiff, Tequila Centinela, S.A. de C.V. (“Centinela”), hereby moves, under Rules 6, 16, 26, 33, 34, 36, and 37, Fed. R. Civ. P., and Local Civ. R. 7, for an Order directing Defendant, Bacardi Company Limited (“Bacardi”):

- (1) to execute the parties’ Stipulated Protective Order;
- (2) to serve a log of documents withheld due to claims of privilege or work product;
- (3) to produce for deposition a knowledgeable representative or representatives under Rule 30(b)(6), Fed. R. Civ. P., to testify as to matters known or reasonably available to Bacardi as listed in Centinela’s Notice of Deposition, in Washington, D.C. at a date and time agreed to by the parties.
- (4) to respond in full to Centinela’s Interrogatories Nos. 2-4;

- (5) to serve a verification of Bacardi's answers to Centinela's interrogatories by an authorized representative;
- (6) to produce documents responsive to Centinela's Requests for Production of Documents and Things Nos. 4, 7, 8, 10, 12-28, and 36-38; and
- (7) to respond properly and in full to Centinela's Requests for Admissions Nos. 28, 31-42, 61, and 62.

Discovery is scheduled to close on May 8, 2006. Due to Bacardi's delays and failure to fully respond to Centinela's outstanding discovery requests, Centinela requests that the Court vacate the current discovery deadline of May 8, 2006, and re-set the close of discovery for 90 days following the Court's decision on this Motion.

Pursuant to Local Civ. R 7(m), the parties have conferred in good faith to narrow the discovery issues in dispute. This Motion addresses the remaining areas of dispute. This Motion most likely will be opposed.

II. NATURE OF THIS ACTION

Centinela seeks review and reversal of the March 5, 2003, February 24, 2004, and October 19, 2004, Decisions and Orders of the Trademark Trial and Appeal Board (the "TTAB" or the "Board"), to the extent they were adverse to Centinela, in Opposition No. 91/125,436 (the "Opposition"):

- a) deferring and ultimately denying Centinela's motion to amend Application Serial No. 76/112,825 for the mark CABRITO & GOAT Design (the "CABRITO Application"), to revise the dates of first use and to narrow the Identification of Goods therein;
- b) denying Centinela's motion for summary judgment that there is no likelihood of confusion and no dilution as between Centinela's CABRITO & GOAT Design mark and the various marks comprising and/or incorporating the term CAZADORES (with and without other terms and/or designs) for tequila, as cited in underlying the Opposition;
- c) granting Bacardi's motions to join as a party-plaintiff in the Opposition, to amend the Notice of Opposition to assert a claim of fraud in the filing of the CABRITO Application, and for summary judgment on Bacardi's amended claim of fraud; and
- d) finding that Bacardi had standing to bring and maintain the Opposition. Centinela also seeks a determination by the Court that:
 - a) Centinela was entitled to amend the CABRITO Application during the course of the Opposition to revise the dates of first use and narrow the identification of goods;
 - b) summary judgment should have been granted to Centinela, on the issues of no likelihood of confusion and no dilution;
 - c) the Board's finding of fraud, on Bacardi's motions to amend the Notice of Opposition and for summary judgment, was based upon a lack of substantial evidence and a misapplication of applicable law; and that
 - d) Bacardi did not have standing to maintain the Opposition.

III. DISCOVERY DISPUTES

A. Centinela's Discovery Requests

On March 31, 2005, Centinela served its first set of interrogatories, first request for production of documents and things, and

first requests for admissions. (Hudis Decl., Exhs. A, B, and C). On April 29, 2005, Bacardi served its deficient responses to Centinela's first sets of written discovery. (Hudis Decl., Exhs. D, E, and F). Centinela served its second request for production of documents and things on March 2, 2006 and its notice of deposition of Bacardi under Rule 30(b)(6), Fed. R. Civ. P., on March 22, 2006. (Hudis Decl., Exhs. G and H). On April 2, 2006, Bacardi served its response to Centinela's second request for production of documents and things. (Hudis Decl., Exh. J). Bacardi supplemented its responses to Centinela's first request for production of documents and things on March 7, 2006, and supplemented its responses to Centinela's first requests for admissions on April 7, 2006. (Hudis Decl., Exhs. I and K). Bacardi has not yet supplemented its responses to Centinela's first set of interrogatories, even though Bacardi represented that it would do so. (Hudis Decl., Exh. R).

In order to receive full and complete responses to its discovery requests, on March 29, 2006, Centinela sent to Bacardi's counsel a proposed Stipulated Protective Order (the language of which was agreed upon by the parties' counsel), signed by Centinela and its counsel, for the signatures of Bacardi and its counsel. (Hudis Decl., Exh. L). Bacardi has yet to return a fully signed copy for filing with the Court.

B. Good Faith Efforts to Resolve Discovery Disputes

Centinela attempted multiple times, in good faith, to resolve its disputes with Bacardi as to its deficient discovery responses. In a letter dated January 31, 2006, Centinela brought to Bacardi's attention Bacardi's deficient discovery responses. (Hudis Decl., Exh. M). Centinela explained, in great detail, the deficiencies in Bacardi's responses to Centinela's first sets of discovery requests. *Id.* A month after not receiving any response from Bacardi to Centinela's good faith efforts, Centinela sent a reminder to Bacardi on March 3, 2006; when Centinela also served its log of withheld documents. (Bacardi has yet to serve its log of withheld documents). (Hudis Decl., Exh. N). On March 7, 2006, Bacardi stated its position regarding its discovery responses that Centinela asserted were deficient. (Hudis Decl., Exh. O). In Centinela's follow-up letter of March 22, 2006, Centinela reminded Bacardi that its discovery responses remained deficient. (Hudis Decl., Exh. P). On March 27, 2006, tie parties met and conferred by telephone. (Hudis Decl., Exh. Q). Centinela memorialized the results of that meeting in a letter dated March 28, 2006. (Hudis Decl., Exh. R). Bacardi has not disputed Centinela's summary of the teleconference. On April 4, 2006, Centinela wrote to Bacardi reminding Bacardi of its promises to provide supplemental responses to Centinela's discovery requests and to return a signed copy of the parties' Stipulated Protective Order. (Hudis Decl., Exh. S). On April 5, 2006, Bacardi represented that it would be returning a signed copy of the parties' Stipulated Protective Order and stated that it was working on supplementing its discovery responses. (Hudis Decl., Exh. V). As of April 17, 2006, Bacardi had not returned the signed copy of the parties' Stipulated Protective Order and had not supplemented a majority of its deficient discovery responses. (Hudis Decl., Exh. W).

In addition to the deficiencies in Bacardi's discovery responses, Bacardi has yet to comply with Centinela's Rule 30(b)(6) Notice of Deposition. (Hudis Decl., Exh. T). Centinela disputed Bacardi's objections. (Hudis Decl., Exh. U). Bacardi represented that it would provide a witness for its Rule 30(b)(6) deposition in the United States upon the condition that Centinela also would do so. (Hudis Decl., Exhs. Vand W). However, to date, Bacardi has not served any Rule 30(b)(6) Notice of Deposition upon Centinela. On April 17, 2006, Centinela adjourned the Rule 30(b)(6) deposition of Bacardi *sine die* because of Bacardi's deficient discovery responses, Bacardi's failure to return a signed copy of the Stipulated Protective Order, and Bacardi's continued refusal to produce, unconditionally, an appropriate witness or witnesses for its Rule 30(b)(6) deposition. (Hudis Decl., Exh. W).

C. Bacardi's Deficient Discovery Responses and Centinela's Requested Relief

Centinela, in great detail, specified the numerous deficiencies in Bacardi's discovery responses. The parties attempted to resolve their discovery disputes. However, there are many areas that remain unresolved.

1. Stipulated Protective Order

Bacardi's continuing deficient discovery responses, in large part, are due to the lack of a protective order in this case. On March 29, 2006, Centinela provided its signed copy of an agreed upon Stipulated Protective Order to Bacardi. (Hudis Decl., Exh. L). However, after numerous requests and notwithstanding Bacardi's representations to the contrary, Bacardi has failed to return the document signed by an authorized representative and defense counsel (Hudis Decl., Exhs. P, R, S, V, and W). Centinela requests that the Court direct Bacardi to return immediately the fully signed Stipulated Protective Order, which Centinela will promptly file with the Court for approval and entry.

2. Privilege Log

Among Bacardi's general objections to Centinela's requests for production of documents and things were unspecified claims of privilege and/or work product. (Hudis Decl., Exhs. E, I, and J). Such general objections of privilege or work product are improper. Bacardi is required to "make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed." Rule 26(b)(5), Fed. R. Civ. P. Bacardi failed to identify the particular privilege or immunity it was asserting, the information or documents withheld, or the basis for the claim of privilege or immunity in sufficient detail to permit Centinela and the Court to assess the validity of those objections. Rule 26(b)(5), Fed. R. Civ. P.

Recently, the Ninth Circuit Court of Appeals in *Burlington Northern & Santa Fe Rwy. Co. v. Kapsner*, 408 F.3d 1142, 1149 (9th Cir. 2005), had occasion to discuss that blanket discovery objections are uniformly inappropriate, and described the circumstances under which a privilege log should be provided by the party claiming privilege as the basis for withholding discovery information and/or documents:

We hold that boilerplate objections or blanket refusals inserted into a response to a *Rule 34* request for production of documents are insufficient to assert a privilege. However, we also reject a *per se* waiver rule that deems a privilege waived if a privilege log is not produced within Rule 34's 30-day time limit. Instead, using the 30-day period as a default guideline, a district court should make a case-by-case determination, taking into account the following factors: **the degree to which the objection or assertion of privilege enables the litigant seeking discovery and the court to evaluate whether each of the withheld documents is privileged (where providing particulars typically contained in a privilege log is presumptively sufficient and boilerplate objections are presumptively insufficient)**; the timeliness of the objection and accompanying information about the withheld documents (where service within 30 days, as a default guideline, is sufficient); the magnitude of the document production; and other particular circumstances of the litigation that make responding to discovery unusually easy (such as, here, the fact that many of the same documents were the subject of discovery in an earlier action) or unusually hard. These factors should be applied in the context of a holistic reasonableness analysis, intended to forestall needless waste of time and resources, as well as tactical manipulation of the rules and the discovery process. They should not be applied as a mechanistic determination of whether the information is provided in a particular format. Finally, the application of these factors shall be subject to any applicable local rules, agreements or stipulations among the litigants, and discovery or protective orders, (emphasis added).

Centinela requested numerous times that Bacardi provide a log of withheld documents, and Bacardi represented to Centinela that it would do so. (Hudis Decl., Exhs. M, P, and R). To date, this has not happened. Centinela requests that the Court direct Bacardi to serve upon Centinela a log of withheld documents simultaneously with its final production of responsive documents.

3. Rule 30(b)(6) Notice of Deposition

Centinela served a Notice of Deposition for Bacardi under Rule 30(b)(6), Fed. R. Civ. P., on March 22, 2006. The deposition was to take place in Washington, D.C. on April 18, 2006. (Hudis Decl., Exh. H). During the parties' March 27, 2006, telephone conference, Centinela inquired whether Bacardi would comply with the Notice of Deposition. (Hudis Decl., Exh. U). However, Bacardi's counsel was not in a position to say anything with respect to Bacardi's deposition at that time. *Id.* On

March 28, 2006, Centinela informed Bacardi of Centinela's intent to proceed with Bacardi's deposition on April 18, 2006. (Hudis Decl., Exh. R, p. 5). On April 4, 2006, Bacardi sent a letter objecting to Centinela's deposition notice. (Hudis Decl., Exh. T).

In its letter of April 4, 2006, Bacardi claims that it "does not market, sell, distribute, or otherwise handle the CAZADORES branded goods." Bacardi further states that other unidentified Bacardi companies "that are not directed or controlled" by Bacardi conduct such activities. *Id.* Bacardi summarily concluded it would not be the "appropriate" party for such inquiries. In its e-mail of April 20, 2006, Bacardi reiterated "that we do not believe that there are any Bacardi & Company witnesses that can answer questions about a number of topics put forth in your Notice of Deposition." (Hudis Decl., Exh. W). Bacardi also refused to designate a witness or witnesses for deposition on the grounds that "one or more of the named deponents will not be in the United States." (Hudis Decl., Exh. T.)

Bacardi's reasons for objecting to the deposition are without merit. In the Opposition proceedings below, Bacardi relied on its ownership of the federally registered CAZADORES mark and its common law U.S. trademark rights in the CAZADORES mark. If Bacardi's claims that it (1) "does not market, sell, distribute, or otherwise handle the CAZADORES branded goods" but that (2) some other unidentified Bacardi company over which Bacardi exercises no direction or control were true, then Bacardi, the purported owner of the CAZADORES mark, would not be exercising control over the use of its mark by a third party. Bacardi, therefore, would be engaging in naked licensing.

Naked licensing results in the abandonment of a trademark. *See* 15 U.S.C. § 1127 ("A mark shall be deemed to be 'abandoned' when ... any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark"), *see, e.g., Stanfield v. Osborne Indus., Inc.*, 52 F.3d 867, 871 (10th Cir. 1995) ("When a trademark owner engages in naked licensing, without any control over the quality of goods produced by the licensee, such a practice is inherently deceptive and constitutes abandonment of any rights to the trademark by the licensor."). It is unlikely that Bacardi intended such a result. Therefore, Bacardi's excuses for not producing a witness or witnesses for deposition are without merit.

Bacardi claims that there are not any Bacardi witnesses that can answer questions regarding the topics stated in Centinela's Notice of Deposition. (Hudis Decl., Exh. W). The facts state otherwise. Bacardi has designated Bacardi U.S.A., Inc. as "the sole authorized importer and distributor of, and [as] the primary source of supply for, products bearing" the Tequila CAZADORES mark. (Hudis Decl., Exh. X). Bacardi U.S.A., Inc. is a subsidiary of Bacardi International, Inc., which in turn is a subsidiary of Bacardi. (Hudis Decl., Exh. Y). Therefore, Bacardi, through its subsidiary Bacardi U.S.A., Inc., has knowledge sufficient for Bacardi to designate a representative or representatives to testify in the United States on behalf of Bacardi. Even if Bacardi has limited knowledge (which it does not) about the topics recited in Centinela's Notice of Deposition, Bacardi is still obligated to produce a witness who will testify "as to matters known or reasonably available" to Bacardi. *See* Rule 30(b)(6), Fed. R. Civ. P. Bald representations that Bacardi has little knowledge of the noticed topics are insufficient to excuse Bacardi's duty to produce a knowledgeable witness.

Bacardi claims that the only persons who may be knowledgeable about Centinela's noticed deposition topics are outside the United States. (Hudis Decl., Exh. T). Bacardi may argue that its deposition must take place at its offices in the Bahamas, since Rule 30(b)(6) depositions are normally taken at the deponent corporation's principal place of business. *In re Vitamins Antitrust Litig.*, 2001 U.S. Dist. LEXIS 24025 at *28 (D.D.C. Nov. 30, 2001). (Hudis Decl., Exh. Z). However, the Court has significant discretion in setting the location of depositions when disputes arise depending on the circumstances. *Id.* There are numerous cases in which courts have ordered depositions of foreign defendants in the U.S. rather than at the defendant's principal place of business. *Id.* at *29 (citing cases). In this instance, requiring the deposition of Bacardi in the United States, specifically Washington, D.C., is appropriate for several reasons. First, Bacardi resides and does regular business in the United States through its subsidiary Bacardi, U.S.A., Inc. *See e.g., Powell v. Int'l Foodservice Sys., Inc.*, 52 F.R.D. 205 (D.P.R. 1971) (requiring a deposition in Puerto Rico of a president of corporation because the corporation had subsidiaries in Puerto Rico). Second, this lawsuit had to be brought in this Court and this Court has personal jurisdiction over Bacardi. 15 U.S.C. § 1071(b) Third, Bacardi states that the people with the most knowledge are in Bacardi's Geneva, Switzerland office. (Hudis Decl., Exh. V). However, Rule 30(b)(6) depositions are not allowed in Switzerland. *In re Vitamins Antitrust Litig.*, at *33 n. 9. Bacardi should not be able to evade attending a properly noticed deposition due to the location of its most knowledgeable employees. Finally, Bacardi already offered to bring its witness or witnesses to Washington, D.C. to be deposed. (Hudis Decl., Exh. V). Therefore, as a matter of equity and fairness, special circumstances exist to require the Rule 30(b)(6) deposition of Bacardi to take place in Washington, D.C.

Bacardi stated that “[t]hey are amenable to potentially having this person come to [Washington] D.C. to be deposed if [Centinela] confirm[s] that deponents designated by Tequila Centinela under our proposed 30(b)(6) Notice of Deposition would likewise be coming to Washington, D.C.” (Hudis Decl., Exh. V). On the surface, Bacardi’s offer seems reasonable. However, to date Bacardi has not served *any* Notice of Deposition upon Centinela. Bacardi has conditioned its compliance with Centinela’s Notice of Deposition upon a non-existent condition precedent. This is inappropriate gamesmanship in an effort to avoid compliance with a properly noticed deposition Centinela requests that the Court direct Bacardi to produce a knowledgeable witness or witnesses pursuant to Centinela’s March 22, 2006 Notice of Deposition in Washington D.C., at a date and time agreed to by the parties.

4. Bacardi’s Deficient Responses to Interrogatories

a) Lack of Verification

Initially, Bacardi’s response to Centinela’s First Set of Interrogatories were “not signed by the person making them, [nor were] the objections signed by the attorney making them.” (Hudis Decl., Exh. D). *See* Rule 33(b)(2), Fed. R. Civ. P. Bacardi subsequently served Centinela with the signature of Bacardi’s counsel as to its objections. However, Bacardi has not served a signed verification by an authorized representative. (Hudis Decl., Ex. P). Centinela requested the signed verification on several occasions. Bacardi represented that the verification would be forthcoming. (Hudis Decl., Exhs. M, P, and R). Bacardi still has yet to serve the verification. Centinela requests that the Court direct Bacardi to serve upon Centinela a signed verification of Bacardi’s interrogatory answers.

b) Bacardi’s Specific Deficient Responses

Bacardi’s outstanding deficient responses to Centinela’s interrogatories are listed below, with Bacardi’s initial response and Bacardi’s representation (through counsel) after the parties’ March 27, 2006, telephone conference.

INTERROGATORY NO. 2

Identify all agreements (including but not limited to, licenses, permissions or consents) entered into and/or negotiated (but not consummated) between Defendant and any other persons or entities regarding the use in commerce of any of Defendant’s Marks, and identify those documents regarding each such agreement(s).

RESPONSE

Defendant objects to this interrogatory in that it is overbroad and to the extent that it calls for confidential information or documentation. Notwithstanding the same, Defendant notes document number 1128.

REPRESENTATION

Bacardi will supplement this interrogatory and the corresponding document requests Nos. 11 and 39 when the Stipulated Protective Order signed by the parties and their counsel has been submitted to the court. As we understand, a rather large purchase agreement is part of the responsive documents that will be produced.

As discussed, Bacardi has not yet returned a fully signed copy of the parties’ Stipulated Protective Order even after several reminders and Bacardi’s representations that it would do so. (Hudis Decl., Exh. P, R, S, V, and W). Centinela requests that

the Court direct Bacardi to return a fully signed copy of the parties' Stipulated Protective Order immediately, and by a date certain serve a full and complete answer to Interrogatory No. 2.

INTERROGATORY NO. 3

Identify each marketing investigation (such as a survey, study and/or focus group inquiry) conducted by or on behalf of Defendant, or its predecessor in interest, in the United States regarding confusion, likelihood of confusion, dilution or likelihood of dilution as between Defendant's Goods bearing any of Defendant's Marks and Plaintiff's Goods bearing Plaintiff's Mark.

RESPONSE

Defendant objects to this interrogatory in that it is overbroad and to the extent that it calls for information or documentation that is confidential, seeks attorney client work-product or information or documentation protected by attorney-client privilege.

REPRESENTATION

Bacardi will supplement this interrogatory and the corresponding document requests Nos. 19 and 39 by stating that no relevant marketing investigations etc. have been conducted, or by identifying and producing responsive documents. If any such documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

Bacardi has yet to supplement *any* of its responses to interrogatories and has yet to serve a log of withheld documents. Centinela requests that the Court direct Bacardi to serve its supplemental response to Centinela's Interrogatory No. 3, as it promised to do, immediately. In addition, the Court should direct Bacardi to produce its log of withheld documents immediately after its final production of responsive documents.

INTERROGATORY NO. 4

State the factual and legal bases for Defendant's claim in the Opposition that Application Serial No. 76/112,825 was fraudulently filed and or prosecuted.

RESPONSE

Defendant objects to the extent it calls for legal conclusions. Notwithstanding this objection, Defendant notes document numbers 1-8, 38-67, 840-887, 1129-1185. Defendant also notes that the factual bases have been put forth before the TTAB and all documentation is in Plaintiff's possession and/or a matter of public record.

REPRESENTATION

You Bacardi will endeavor to clear up the confusion by identifying (by production numbers) those documents that Bacardi has produced which are responsive to this interrogatory and corresponding document request. No. 39.

Centinela informed Bacardi that no such documents existed bearing production numbers 872-887. (Hudis Decl, Exh. M).

Bacardi first apologized for the inconsistency based on a clerical error; the correct range was supposed to be 840-871. (Hudis Decl., Exh. O, p. 2). However, a document bearing the production number 871 was never produced. (Hudis Decl., Exh. P, p. 3). Moreover, Bacardi has yet to supplement *any* of its responses to interrogatories or to serve a log of withheld documents. Centinela requests that the Court direct Bacardi to serve immediately a supplemental response to Centinela's Interrogatory No. 4, as it promised to do, to clear up the confusion.

5. Bacardi's Deficient Responses to Production Requests

Bacardi provided numerous deficient responses to Centinela's document requests that remain unresolved and outstanding. The specific deficiencies are organized below by Centinela's requested remedy.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 4

Produce copies of those documents regarding each trademark search covering the United States and/or its territories conducted by or on behalf of Defendant, or Defendant's predecessors in interest, regarding Plaintiff's Mark.

RESPONSE:

Defendant objects to this Request because the Request calls for documents that are confidential and/or subject to attorney/client privilege, and/or constitute attorney work product.

REPRESENTATION:

In a formal supplemental response, Bacardi will identify whether any searches of the type call for in Production Request No. 4 were conducted. If no documented evidence of such searches can be located, Bacardi's formal supplemental response will so state. Otherwise, uncovered responsive documents reflecting such searches will be produced. If any such documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

Bacardi has yet to serve its supplemental responses to Centinela's first set of production requests as represented during the parties' March 27, 2006 telephone conference. Bacardi has yet to serve a log of withheld documents either. Centinela requests that the Court direct Bacardi to serve immediately its supplemental response to Document Request No. 4, as it promised, and serve its log of withheld documents after the last set of responsive documents are produced.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 7

Produce those documents showing the dollar volume expended by or on behalf of Defendant, or Defendant's predecessors in interest, to advertise or promote in the United States Defendant's Goods bearing each of Defendant's Marks from the date of first use to the present.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects noting that said documents are confidential.

REPRESENTATION:

After submission of the Stipulated Protective Order to the Court, Bacardi will produce the advertising documentation called for in Production Request No. 7.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 10

Produce those documents pertaining to Defendant's use of any of Defendant's Marks at any trade shows or fairs in the United States which Defendant, or Defendant's predecessors in interest, has organized, promoted, and/or in which it has participated.

RESPONSE:

Defendant objects to this request in that it is overbroad and/or seeks confidential information.

REPRESENTATION:

After submission of the Stipulated Protective Order to the Court, Bacardi will produce the trade show documentation called for in Production Request No. 10

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 12

Produce those documents showing or describing the demographic profiles of the types of persons who are or will be targeted as purchasers in the United States of Defendant's Goods bearing each of Defendant's Marks.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this request in that it is overbroad and/or seeks confidential information.

REPRESENTATION:

After submission of the Stipulated Protective Order to the Court, Bacardi will produce the demographics documentation called for in Production Request No. 12 to the extent that non-confidential documents of this type have not already been produced.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 16

Produce those documents supporting Defendant's claim of likelihood of confusion between Plaintiff's Mark and any of Defendant's Marks in the Opposition.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request to the extent that it seeks attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 17

Produce those documents supporting Defendant's claim in the Opposition of dilution or likelihood of dilution of any of Defendant's Marks by the registration of Plaintiff's Mark.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request to the extent that it seeks attorney workproduct.

REPRESENTATIONS FOR NOS. 16 AND 17:

As we understand from yesterday's telephone discussion, Bacardi believes it has produced non-confidential documents responsive to Production Requests Nos. 16 and 17, but it will not identify these documents by production number. After submission of the Stipulated Protective Order to the Court, Bacardi will produce further responsive documents that it believes are confidential, such as the results of demographic studies.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 18

Produce a copy of each marketing investigation (such as a survey, study and/or focus group inquiry) conducted by or on behalf of Defendant, or Defendant's predecessors in interest, regarding the fame, strength and/or notoriety of any of Defendant's Marks in the United States, including the results thereof.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S. C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege and/or constitute attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 19

Produce a copy of each marketing investigation (such as a survey, study and/or focus group inquiry) conducted by or on behalf of Defendant, or Defendant's predecessors in interest, in the United States regarding confusion, likelihood of confusion, dilution or likelihood of dilution as between Defendant's Goods bearing any of Defendant's Marks and Plaintiff's Goods bearing Plaintiff's Mark, including the results thereof.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege and/or constitute attorney work product.

REPRESENTATIONS FOR NOS. 18 AND 19:

As we understand from yesterday's telephone discussion, Bacardi believes that it has produced non-confidential documents responsive to Production Requests Nos. 18 and 19, but it will not identify these documents by production number. After submission of the Stipulated Protective Order to the Court, Bacardi will produce further responsive documents that it believes are confidential.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 25

Produce those documents in Defendant's possession, custody and/or control concerning any third party uses in the United States of which Defendant is aware of the design of an animal having horns as a mark or indicia of origin for alcoholic beverages intended for human consumption.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this Request to the extent that it seeks confidential information, attorney-client privileged material or attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 26

Produce those documents in Defendant's possession, custody and/or control concerning any third party uses in the United States of which Defendant is aware of the design of an animal having horns as a mark or indicia of origin for tequila products intended for human consumption.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this Request to the extent that it seeks confidential information, attorney-client privileged material or attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 27

Produce those documents in Defendant's possession, custody and/or control concerning any all third party uses in the United States of which Defendant is aware of Spanish words beginning with the letters "C-A" as a mark, name or indicia of origin for alcoholic beverages intended for human consumption.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is he decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. 1071 (b). Defendant also objects to this Request to the extent that it seeks confidential information, attorney-client privileged material or attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 28

Produce those documents in Defendant's possession, custody and/or control concerning any third party uses in the United States of which Defendant is aware of Spanish words beginning with the letters "C-A" as a mark, name or indicia of origin for tequila products intended for human consumption.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this Request to the extent that it seeks confidential information, attorney-client privileged material or attorney work product.

REPRESENTATIONS FOR NOS. 25-28:

Bacardi believes it has produced non-confidential documents responsive to Production Requests Nos. 25-28, but it will not identify them by production number. After submission of the Stipulated Protective Order to the Court, Bacardi will produce additional confidential documents called for in Production Requests Nos. 25-28.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 36

Produce a chart or schedule showing all Directors, officers and authorized representatives of Defendant having supervisory decision making authority with respect to Defendant's use of Defendant's Marks and/or Defendant's Goods in the United States.

RESPONSE:

Defendant objects to this request in that it is overbroad and/or seeks confidential information.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 37

Produce those documents showing the locations of all offices of Defendant in the United States.

RESPONSE:

Defendant objects to this request in that it is overbroad and/or seeks confidential information.

REPRESENTATIONS FOR NOS. 36 AND 37:

After submission of the Stipulated Protective Order to the Court, Bacardi will produce documents showing the personnel and U.S. offices information called for in Production Requests Nos. 36 and 37. If Bacardi produces knowledgeable witnesses responsive to Tequila Centinela 's Rule 30(b)(6) deposition notice, this may no longer be a contested issue.

Bacardi's refusal to provide a fully signed copy of the parties' Stipulated Protective Order largely is the cause of Bacardi's continued deficient responses to Centinela's production requests Nos. 7, 10, 12, 16-19, 25-28, 36, and 37. Centinela requests that the Court direct Bacardi to provide a fully signed copy of the parties' Stipulated Protective Order that Centinela will file promptly with the Court. In addition, the Court should direct Bacardi to produce documents responsive to document requests Nos. 7, 10, 12, 16-19, 25-28, 36, and 37 upon the Court's approval and entry of the parties' Stipulated Protective Order.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 8

Produce those documents relating to the cessation of use of any of Defendant's Marks in the United States since the date(s) of first use thereof, whether there was cessation of use of the mark(s) in its or their entirety or only in connection with a particular product or products.

RESPONSE:

Defendant does not believe any such documents exist.

REPRESENTATION:

In a formal supplemental response, Bacardi will state that it is not in possession of the cessation-of-use documents called for in Production Request No. 8.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 13

Produce those documents regarding any instance of which Defendant is aware of any confusion, deception or mistake occurring in the United States concerning any connection between Defendant, or Defendant's predecessors in interest, and

Plaintiff.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this request in that it is overbroad and/or seeks confidential information.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 14

Produce those documents related to any instance of which Defendant is aware of any confusion, deception or mistake occurring in the United States concerning any connection between Defendant's Goods bearing any of Defendant's Marks and Plaintiff's Goods bearing Plaintiff's Mark.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this request in that it is overbroad and/or seeks confidential information.

REPRESENTATIONS FOR NOS. 13 AND 14:

In formal supplemental responses, Bacardi will confirm that it has no responsive documents regarding actual confusion of the type called for in Production Requests Nos. 13 and 14.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 22

Produce those documents regarding any formal or informal objections to Defendant's registration or use in the United States of any of Defendant's Marks.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege.

REPRESENTATION:

As we understand from yesterday's telephone discussion, a third party did oppose Bacardi's registration of the CAZADORES mark. In a supplemental response, Bacardi will provide relevant documents regarding this opposition.

Bacardi's refusal to serve supplemental responses and documents responsive to Centinela's production requests, contrary to the representations counsel made during the parties' March 27th telephone conference, is the cause of Bacardi's continued deficient responses to Centinela's document requests Nos. 8, 13, 14, and 22. Centinela requests that the Court direct Bacardi to serve supplemental responses and documents responsive to Centinela's production requests Nos. 8, 13, 14, and 22.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 15

Produce those documents supporting Defendant's claim of trademark priority as between Defendant's Marks and Plaintiff's Mark.

RESPONSE:

Defendant objects that this Request is overbroad, seeks confidential information or documents, attorney work product and/or attorney-client privileged materials.

REPRESENTATION:

After submission of the Stipulated Protective Order to the Court, Bacardi will produce the priority documentation called for in Production Request No. 15, or state in a formal supplemental response that no documents exist other than what Bacardi already has produced. If any such documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 23

Produce those documents regarding any formal or informal objections by Defendant, or Defendant's predecessors in interest, to the registration(s) or use(s) by others in the United States of a mark, name, term or symbol on the grounds of confusing similarity to, or dilution of, Defendant's Marks.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request to the extent that it seeks attorney work product. Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 24

Produce those documents regarding Defendant's, or Defendant's predecessors', enforcement of any of Defendant's Marks including, but not limited to, demand letters, lawsuits, settlement agreements and/or licensing agreements.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant further objects to this Request because it appears to be related to the March 5, 2003 decision of the TTAB in Opposition 91125436, and the Plaintiff failed to file a timely appeal of that decision, pursuant to 15 U.S.C. § 1071(b), so Plaintiff is now barred by the statute of limitations from seeking information relevant to that decision in this proceeding. Defendant also objects to this Request to the extent that it seeks attorney work product. Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege.

REPRESENTATIONS FOR NOS. 23 AND 24:

As we understand from yesterday's telephone discussion, additional oppositions may have been filed by Bacardi other than pending Opposition No. 91/116,808, the documents for which would be responsive to Production Request No. 23. Bacardi will provide those documents in a formal supplemental response. After submission of the Stipulated Protective Order to the Court, Bacardi will produce the non-public/confidential documentation called for in Production Requests Nos. 23 and 24 - regarding Bacardi's objections to third party marks and/or enforcement of Defendant's Marks. If any such documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

As already stated, Bacardi has not provided: (1) a fully signed copy of the parties' Stipulated Protective Order, (2) supplemental responses and responsive documents to Centinela's production requests, and (3) a log of withheld documents. Centinela requests that the Court direct Bacardi to provide a fully signed copy of the parties' Stipulated Protective Order, supplement its responses to Centinela's document requests Nos. 15, 23 and 24, and serve its log of withheld documents after producing the last set of responsive documents.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 20

Produce those documents showing when Defendant, or Defendant's predecessors in interest, first became aware of Plaintiff's Mark: a) in Mexico, and b) in the United States.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege and/or constitute attorney work product.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 21

Produce those documents showing the consideration by any persons affiliated with Defendant, or Defendant's predecessors in interest, of the existence of Plaintiff's Mark or a possible conflict between Plaintiff's Mark any of Defendant's Marks in

the United States.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Defendant also objects to this Request because the Request calls for documents that are confidential and/or subject to attorney-client privilege and/or constitute attorney work product.

REPRESENTATIONS FOR NOS. 20 AND 21:

As we understand from yesterday's telephone discussion, Bacardi did not receive many documents during the due diligence associated with the purported purchase of the assets of Tequila Cazadores. After submission of the Stipulated Protective Order to the Court, Bacardi will produce whatever responsive documentation it has that is called for in Production Requests Nos. 20 and 21 - regarding Bacardi's (or its predecessor's) first awareness of Tequila Centinela 's Mark, including any consideration thereof. If any such documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

REQUEST FOR PRODUCTION OF DOCUMENTS NO. 38

Produce those documents relating to the maintenance of Defendant's United States Registration No. 1,863,882 including all Petitions, Declarations, specimens and correspondence fled in connection therewith in the United States Patent and Trademark Office.

RESPONSE:

Defendant objects to this Request because it is outside of the scope of Plaintiff's appeal of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Notwithstanding, Defendant has no greater access to such documents than Plaintiff, other than documents that are confidential and/or subject to attorney-client privilege.

REPRESENTATION:

As we discussed during yesterday's telephone conference, in a formal supplemental response Bacardi shall state that it has no further documents regarding the file history for U.S. Trademark Registration No. 1,863,882 other than what is contained in publicly available records at the U.S. Patent and Trademark Office. If Bacardi has additional documents, it will produce them. If any other responsive documents exist that Bacardi will not produce on grounds of privilege or work product, information regarding these documents will be provided on a privilege log.

Centinela requests that the Court direct Bacardi to serve a fully signed copy of the parties' Stipulated Protective Order, to produce documents responsive to Centinela's production requests Nos. 20, 21, and 38, and to provide its log of withheld documents after producing the last set of responsive documents.

6. Bacardi's Deficient Responses to Requests for Admissions

The outstanding deficient responses to Centinela's Requests for Admissions are listed below, with Bacardi's initial response and Bacardi's representations made during the parties' telephone conference of March 27, 2006 or Bacardi's supplemental Responses to Centinela's Requests for Admissions.

REQUEST 28

Admit that the animal shown in the CABRITO & Design mark of Application Serial No. 76/112,825 is a goat (see Exhibit I).

RESPONSE

Defendant objects to this Request because it is beyond the scope of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b). Despite this objection, Defendant is without sufficient knowledge to admit or deny.

REPRESENTATION

Bacardi continues its refusal to admit or deny whether the animal shown in the CABRITO & Design mark of Application Serial No. 76/112,825 is a goat in responding to Admission Request No. 28. This matter will have to be resolved by the Court.

Bacardi's assertion that this proceeding is limited to an appeal of the TTAB's October 19, 2004, decision is patently incorrect. This proceeding is an appeal of the TTAB's March 5, 2003, February 24, 2004, and October 19, 2004 Decisions and Orders. (Complaint If 1.) Therefore, the material requested is relevant. Further, Bacardi's statement that it "is without sufficient knowledge to admit or deny" is insufficient because Bacardi fails to state whether it made a reasonable inquiry. Rule 36(a), Fed. R. Civ. P. Centinela requests that the Court direct Bacardi to serve a complete response to Admission Request No. 28.

REQUEST 31

Admit that Defendant promotes its goods bearing Defendant's Marks to liquor stores in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 32

Admit that Defendant promotes its goods bearing Defendant's Marks to restaurants in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 33

Admit that Defendant promotes its goods bearing Defendant's Marks to grocery stores in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 34

Admit that Defendant promotes its goods bearing Defendant's Marks to convenience stores in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 35

Admit that Defendant promotes its goods bearing Defendant's Marks directly to potential customers in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 36

Admit that Defendant promotes its goods bearing Defendant's Marks to state alcoholic beverage control boards in the U.S.

RESPONSE

Defendant denies that it directly promotes its goods.

REQUEST 37

Admit that Defendant sells its goods bearing Defendant's Marks directly to liquor stores in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REQUEST 38

Admit that Defendant sells its goods bearing Defendant's Marks directly to restaurants in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REQUEST 39

Admit that Defendant sells its goods bearing Defendant's Marks directly to grocery stores in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REQUEST 40

Admit that Defendant sells its goods bearing Defendant's Marks directly to convenience stores in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REQUEST 41

Admit that Defendant sells its goods bearing Defendant's Marks directly to potential customers in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REQUEST 42

Admit that Defendant sells its goods bearing Defendant's Marks directly to state alcoholic beverage control boards in the U.S.

RESPONSE

Defendant denies that it directly sells its goods.

REPRESENTATIONS FOR NOS. 31-42

Bacardi continues its refusal to fully admit or deny Admission Requests Nos. 31-42 regarding its promotion and sales activities in the U.S. This matter will have to be resolved by the Court.

By limiting each Response with the term “directly,” Bacardi has provided only partial answers to these Requests. The Requests do not distinguish between direct or indirect selling or promoting. Centinela requests that the Court direct Bacardi to admit or deny the remainder of each of the Requests for Admissions Nos. 31-42, by stating whether Bacardi sells or promotes its goods indirectly.

REQUEST 61

Admit that a trademark search conducted by a predecessor in interest of Defendant disclosed Plaintiff’s Mark.

RESPONSE

Defendant objects to this Request because it is beyond the scope of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b).

SUPPLEMENTAL RESPONSE

Applicant is without sufficient knowledge to admit or deny.

REQUEST 62

Admit that a trademark search conducted on behalf of a predecessor in interest of Defendant disclosed Plaintiffs Mark.

RESPONSE

Defendant objects to this Request because it is beyond the scope of the October 19, 2004 decision of the TTAB in Opposition 91125436, which is the decision that Plaintiff has appealed to this Court pursuant to 15 U.S.C. § 1071(b).

SUPPLEMENTAL RESPONSE

Applicant is without sufficient knowledge to admit or deny.

Bacardi’s statements in its supplemental responses to Centinela’s first requests for admissions (Hudis Decl., Exh. K) that it “is without sufficient knowledge to admit or deny” is insufficient because Bacardi fails to state whether it made a reasonable inquiry. Rule 36(a), Fed. R Civ. P. Centinela requests that the Court direct Bacardi to serve complete responses to Centinela’s Admission Requests Nos. 61 and 62.

IV. REQUEST TO AMEND SCHEDULING ORDER

Pursuant to Rules 6(b) and 16(b), Fed. R. Civ. P., Centinela requests that the Court amend the Scheduling Order of March 7, 2005, to extend the discovery period by 90 days following the Court's decision on this Motion. Centinela needs the extra time to complete discovery because of Bacardi's refusal to return a fully signed copy of the parties' Stipulated Protective Order, Bacardi's numerous deficiencies in responding in full to Centinela's interrogatories and requests for admissions, Bacardi's failure to produce numerous documents responsive to Centinela's requests, and Bacardi's refusal to designate and produce a knowledgeable representative or representatives for a Rule 30(b)(6) deposition or depositions.

V. CONCLUSION

Bacardi has not returned a fully signed Stipulated Protective Order, has served many deficient responses to Centinela's written discovery requests, has failed to produce completely documents responsive to Centinela's requests, and has failed to designate a knowledgeable representative or representatives for a Rule 30(b)(6) deposition or depositions. The parties have met and conferred to resolve these issues. Many deficiencies remain. Centinela requests that the Court direct Bacardi:

- (1) to execute and return the parties' Stipulated Protective Order;
- (2) to produce for deposition a knowledgeable representative or representatives under Rule 30(b)(6), Fed. R. Civ. P., to testify as to matters known or reasonably available to Bacardi as listed in Centinela's Notice of Deposition, in Washington, D.C., at a date and time agreed to by the parties.
- (3) to respond in full to Centinela's Interrogatories Nos. 2-4;
- (4) to serve a verification of Bacardi's responses to Centinela's interrogatories by an authorized representative;
- (5) to produce documents responsive to Centinela's Requests for Documents and Things Nos. 4, 7, 8, 10, 12-28, and 36-38;
- (6) to serve a log of documents withheld due to claims of privilege or work product; and (7) to respond in full to Centinela's Requests for Admissions Nos. 28, 31-42, 61, and 62.

Discovery is scheduled to close on May 8, 2006. Due to Bacardi's delays and failure to fully respond to Centinela's outstanding discovery requests, Centinela requests that the Court vacate the May 8, 2006 discovery deadline and re-set the dose of discovery for 90 days following the Court's decision on this Motion