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Filing date: **08/26/2015**

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.)
Correspondence Address	SARAH R FRAZIER WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE ST BOSTON, MA 02109 UNITED STATES michael.bevilacqua@wilmerhale.com, john.regan@wilmerhale.com, shira.hoffman@wilmerhale.com, sarah.frazier@wilmerhale.com, si- lena.paik@wilmerhale.com,
Submission	Reply in Support of Motion
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Signature	/shira hoffman/
Date	08/26/2015
Attachments	Paik Decl. - Public Version.pdf(188585 bytes)

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

BRIGGS & STRATTON CORPORATION and)	
KOHLER CO.,)	
)	
Opposers,)	Opposition No. 91200832 (parent)
)	
v.)	Opposition No. 91200146
)	
HONDA GIKEN KOGYO KABUSHIKI)	Application Serial No. 78924545
KAISHA,)	
)	FILED UNDER SEAL
Applicant.)	
)	
)	

**DECLARATION OF SILENA PAIK IN SUPPORT OF APPLICANT’S REPLY IN
SUPPORT OF ITS MOTION TO STRIKE IMPROPER EXPERT TESTIMONY
OF FACT WITNESS JEFF WHITMORE**

I, Silena Paik, 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 and California. I am a Counsel 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 March 26, 2014, Honda took the discovery deposition of Opposer Briggs & Stratton Corporation’s (“Briggs”) witness Mr. Peter Hotz. A true and correct copy of excerpts from this deposition is attached hereto as **Exhibit A**.

3. On January 3, 2012, Briggs served its responses to Honda’s First Set of Interrogatories. In response to Honda’s Interrogatory No. 2, Briggs stated “that at least Peter Hotz, Jeff Whitmore, and Ron Weber have knowledge about the design and development of the 550 Series Engine.” A true and correct copy of excerpts from Briggs’ responses to Honda’s First Set of Interrogatories is attached hereto as **Exhibit B**.

4. On June 1, 2015, Opposers Briggs and Kohler Co. (collectively, “Opposers”) served their pretrial disclosures on Honda. These disclosures stated that Dr. John Reisel was Opposers’ functionality expert and that he would offer testimony regarding “[t]he functionality of the applied-for mark and its component parts.” A true and correct copy of these pretrial disclosures is attached hereto as **Exhibit C**.

5. On July 16, 2015, Opposers took the testimonial deposition of Dr. John Reisel. A true and correct copy of excerpts from this testimonial deposition is attached hereto as **Exhibit D**.

6. On March 27, 2014 Honda took the discovery deposition of Mr. Jeff Whitmore. A true and correct copy of excerpts from this deposition is attached hereto as **Exhibit E**.

Dated: August 26, 2015

/s/ Silena Y. Paik
Silena Y. Paik (BBO No. 682376)

EXHIBIT A
Filed Under Seal

EXHIBIT B

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



BRIGGS & STRATTON CORPORATION,

Opposer,

vs.

HONDA GIKEN KOGYO KABUSHIKI
KAISHA,

Applicant.

Opposition No. 91/200832

OPPOSER'S RESPONSE TO APPLICANT'S FIRST SET OF INTERROGATORIES

Opposer Briggs & Stratton Corporation ("Opposer") hereby responds to Applicant Honda Motor Co., Ltd's ("Applicant") First Set of Interrogatories as follows:

General Objections

1. Opposer objects to Applicant's definition of "Applicant's Mark" as vague and ambiguous to the extent it includes the phrase "any other mark used by Applicant that is a colorable imitation of the mark."
2. Opposer objects to the Applicant's definition of "Opposer's Products" as argumentative and inaccurate to the extent it infers that Opposer's 550 Series of engines, or any other engines manufactured or sold by Opposer, have a design that is "substantially similar" to "Applicant's Mark."
3. Opposer objects to the extent the Interrogatories seek documents or information protected by the attorney-client privilege, that is protected by the work product doctrine, or which constitutes or discloses the mental impressions, conclusions, opinions, or legal theories of any attorney or the representative of Opposer concerning this opposition (hereinafter "Privileged Information"). Such information shall not be provided in response hereto, and inadvertent

INTERROGATORIES

INTERROGATORY NO. 1:

Please state the date on which you first sold or offered each and every different engine in Opposer's 550 Series of engines, specifying the product for each date.:

RESPONSE: Subject to and without waiving the General Objections, Opposer responds that it first offered 550 Series engines for sale in the United States in or about May 2009.

INTERROGATORY NO. 2:

Please identify each person involved in the origination, design, development, addition or selection of each of Opposer's Products and for each person, identify the nature and extent of such involvement and identify documents concerning such involvement.

RESPONSE: Opposer objects to Interrogatory No. 2 as being vague, ambiguous, burdensome, overbroad, irrelevant to the subject matter of this action, and not likely to lead to the discovery of admissible evidence. Opposer further objects to the interrogatory to the extent it seeks Privileged Information. Opposer further objects to the interrogatory to the extent it requests documents concerning "such involvement" as vague, ambiguous, overbroad, burdensome and oppressive, irrelevant to the subject matter of this action, and not likely to lead to the discovery of admissible evidence. Subject to and without waiving the foregoing objections and General Objections, Opposer states that at least Peter Hotz, Jeff Whitmore, and Ron Weber have knowledge about the design and development of the 550 Series engine.

INTERROGATORY NO. 3:

Please describe the circumstances under which you first learned of Applicant's use of Applicant's Mark.

RESPONSE: Opposer objects to Interrogatory No. 3 as being vague, ambiguous, burdensome, overbroad, irrelevant to the subject matter of this action, and not likely to lead to the discovery of admissible evidence. Opposer further objects to the interrogatory to the extent it seeks

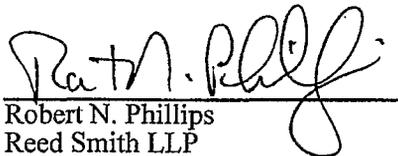
(c) Peter Hotz
Briggs & Stratton Corporation
12301 W. Wirth St.
Wauwatosa, WI 53222-2110

INTERROGATORY NO. 18:

Identify each expert that you expect to call as a witness in this proceeding and state the subject matter on which each expert is expected to testify, the substance of the expert's opinion, and the grounds of the opinion.

RESPONSE: Opposer objects to Interrogatory No. 18 as premature to the extent it seeks information that will be the subject of expert opinion. Opposer further objects to the interrogatory to the extent it seeks Privileged Information.

January 3, 2012

By: 
Robert N. Phillips
Reed Smith LLP

Nina Habib Borders
Reed Smith LLP

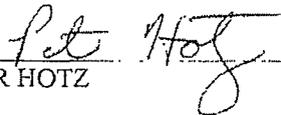
Attorneys for Opposer
BRIGGS & STRATTON
CORPORATION

VERIFICATION

I, Peter Hotz, am Vice President Engine Product Development of Briggs & Stratton Corporation, and am authorized to make this Verification on its behalf. I have read the foregoing OPPOSER'S RESPONSE TO APPLICANT'S FIRST SET OF INTERROGATORIES, and know its contents. I am informed and believe that the matters stated therein are true.

I declare under penalty of perjury under the law of the United States of America that the foregoing is true and correct.

Executed at Wauwatosa, Wisconsin on this 3rd day of January, 2012.



PETER HOTZ

CERTIFICATE OF SERVICE

In accordance with Rule 2.105(a) of the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing OPPOSER BRIGGS & STRATTON CORPORATION'S RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES was served on the following counsel of record for Applicant, by depositing same in the U.S. mail, first class postage prepaid, this 3rd day of January, 2012:

Michael J. Bevilacqua, Esq.
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109-1800
Phone: (617) 526-6448
Fax: (617) 526-5000


Deborah L. Kalahela

EXHIBIT C

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

BRIGGS & STRATTON CORPORATION)	
)	
Opposer,)	Opposition No. 91200832 (Parent)
vs.)	
)	
HONDA GIKEN KOGYO KABUSHIKI KAISHA,)	
)	
Applicant.)	
)	
KOHLER CO.)	
)	
Opposer,)	Opposition No. 91200146
vs.)	
)	
HONDA GIKEN KOGYO KABUSHIKI KAISHA,)	
)	
Applicant.)	
)	

United States Patent and Trademark Office
 Trademark Trial and Appeal Board
 P.O. Box 1451
 Alexandria, Virginia 22313-1451

**OPPOSERS BRIGGS & STRATTON CORPORATION’S AND KOHLER CO.’S
PRETRIAL DISCLOSURES**

Pursuant to TBMP §702.01 and Rule 26(a)(3) of the Federal Rules of Civil Procedure, Opposers Briggs & Stratton Corporation and Kohler Co. (“Opposers”) provide this pretrial disclosure to Applicant HONDA GIKEN KOGYO KABUSHIKI KAISHA (“Applicant”).

Witness	Address	Subject(s)	Documents
Mr. Jeffrey Whitmore –	Briggs & Stratton Corp.	Design and development,	Documents related to the design,

<p>Engineering Senior Manager – Contract Manufactured Engines and Small Horizontal NPD at Briggs & Stratton Corp.</p>	<p>3300 North 124th St., Milwaukee, WI, 53222 (414) 259-5333</p> <p>Mr. Whitmore should be contacted through counsel for Briggs.</p>	<p>functionality, third party use, appearance (including shapes and colors), marketing, sale and commercial viability of horizontal shaft utility engines, including Briggs and Honda engines and alternatives thereto; OEM marketplace for horizontal shaft utility engines.</p>	<p>development, marketing and sale of Briggs engines; evidence of third party use of horizontal shaft utility engines.</p>
<p>Mr. Peter Hotz – VP Global Technical Service at Briggs & Stratton Corp.</p>	<p>Briggs & Stratton Corp. 3300 North 124th St., Milwaukee, WI, 53222 (414) 259-5333</p> <p>Mr. Hotz should be contacted through counsel for Briggs.</p>	<p>Design and development, functionality, third party use, appearance (including shapes and colors), marketing, sale and commercial viability of horizontal shaft utility engines, including Briggs and Honda engines and alternatives thereto; OEM marketplace for horizontal shaft utility engines.</p>	<p>Documents related to the design, development, marketing and sale of Briggs engines; evidence of third party use of horizontal shaft utility engines.</p>
<p>Mr. Cameron Litt – Manager - Marketing at Kohler Co.</p>	<p>Kohler Co. 444 Highland Drive Kohler, WI 53044 (920) 457-4441</p>	<p>Design and development, functionality, third party use, appearance</p>	<p>Documents related to the design, development, marketing and sale of Kohler engines;</p>

	Mr. Litt should be contacted through counsel for Kohler.	(including shapes and colors), marketing, sale and commercial viability of horizontal shaft utility engines, including Kohler and Honda engines and alternatives thereto; OEM marketplace for horizontal shaft utility engines.	evidence of third party use of horizontal shaft utility engines.
Mr. Manuel Rumao – International Product Manager at Kohler	Kohler Co. 444 Highland Drive Kohler, WI 53044 (920) 457-4441 Mr. Rumao should be contacted through counsel for Kohler.	Design and development, functionality, third party use, appearance (including shapes and colors), marketing, sale and commercial viability of horizontal shaft utility engines, including Kohler and Honda engines and alternatives thereto; OEM marketplace for horizontal shaft utility engines.	Documents related to the design, development, marketing and sale of Kohler engines; evidence of third party use of horizontal shaft utility engines.
Mr. Hal Poret – Opposers’ Secondary Meaning Survey Expert	ORC International 625 Avenue of the Americas New York, NY 10011 (914) 772-5087 Mr. Poret should be contacted through	Survey evidence demonstrating the lack of secondary meaning of the applied-for mark.	Survey materials.

	counsel for Opposers.		
Dr. John Reisel – Opposers’ Functionality Expert	3200 North Cramer St. Milwaukee, WI 53211 (414) 229-4671 Dr. Reisel should be contacted through counsel for Opposers.	The functionality of the applied-for mark and its component parts.	Utility patents and utility models; evidence of third party use of horizontal shaft utility engines; evidence regarding the functionality of Opposers’ and Honda’s engines; Honda’s trademark application materials.
Affiant for Subaru Industrial Power Products	905 Telser Road Lake Zurich, IL 60047 800-277-6246	Functionality, marketing, sale, and distribution of Subaru engines.	Documents related to the functionality, marketing, sale, and distribution of Subaru engines.
Affiant for Generac Power Systems, Inc.	S45W29290 Wisconsin 59 Waukesha, WI 53189 (888) 436-3722	Functionality, marketing, sale, and distribution of Generac engines.	Documents related to the functionality, marketing, sale, and distribution of Generac engines.
Affiant for Lifan Power USA	2205 Industrial Park Road Van Buren, AR 72956 (866) 471-7464	Functionality, marketing, sale, and distribution of Lifan engines.	Documents related to the functionality, marketing, sale, and distribution of Lifan engines.
Affiant for Jiang Dong North America Corp./All Power USA	16273 E. Gale Ave City Of Industry, CA 91745 (888) 988-2299	Functionality, marketing, sale, and distribution of Jiang Dong/All Power engines.	Documents related to the functionality, marketing, sale, and distribution of Jiang Dong/All Power engines

Opposers reserve the right to supplement this disclosure in the event that additional individuals are identified that may need to testify to support Opposers’ claims or defenses or in

the event that additional topics of testimony or documents are identified for the foregoing individuals.

Dated: June 1, 2015

By: /s/ Robert N. Phillips
Robert N. Phillips
Seth B. Herring
Reed Smith LLP
101 Second Street
San Francisco, CA 9410

Attorneys for Opposer
Briggs & Stratton Corporation

Dated: June 1, 2015

By: /s/ Kenneth R. Nowakowski
Kenneth R. Nowakowski
Melinda S. Giftos
Whyte Hirschboeck Dudek, S.C.
535 East Wells Street, Suite 1900
Milwaukee, WI 53202

Attorneys for Opposer *Kohler Co.*

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing OPPOSERS BRIGGS & STRATTON CORPORATION'S AND KOHLER CO.'S PRETRIAL DISCLOSURES has been served on the following counsel of record, via email and by depositing same in the U.S. mail, first class postage prepaid, this 1st day of June, 2015:

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

Kenneth R. Nowakowski
Melinda S. Giftos
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555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202
Telephone: (414) 273-2100
Facsimile: (414) 223-5000

/s/ Deborah L. Kalahele

Deborah L. Kalahele

EXHIBIT D

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

3 - - - - -
4 BRIGGS & STRATTON CORPORATION and
KOHLER COMPANY,

5
6 vs.

Opposers,

Opposition No.
91200832 (parent)
Opposition No.
91200146

7 HONDA GIKEN KOGYO KABUSHIKI
8 KAISHA,

Application Serial
No. 78924545

Applicant.

9
10 - - - - -
11 DEPOSITION OF: MR. JOHN REISEL
12 TAKEN AT: WHYTE HIRSCHBOECK DUDEK, S.C.
13 LOCATED AT: 555 East Wells Street, Suite 1900
Milwaukee, Wisconsin

14 July 16, 2015

15 9:00 a.m. to 2:40 p.m.

16 REPORTED BY: VICKY L. ST. GEORGE, RMR.
17
18 - - - - -
19
20
21
22
23
24
25

Page 2	Page 4
<p>1 A P P E A R A N C E S</p> <p>2 REED SMITH, by</p> <p>3 MR. SETH HERRING</p> <p>4 101 Second Street</p> <p>5 San Francisco, California 94105</p> <p>6 (415) 543-8700</p> <p>7 sherring@reedsmith.com</p> <p>8 Appeared on behalf of the Opposers, Briggs</p> <p>9 and Stratton.</p> <p>10</p> <p>11 WHYTE HIRSCHBOECK DUDEK, S.C., by</p> <p>12 MR. KEN NOWAKOWSKI</p> <p>13 33 East Main Street, Suite 300</p> <p>14 Madison, Wisconsin 53701-1379</p> <p>15 (608) 255-4440</p> <p>16 knowakowski@whdlaw.com</p> <p>17 Appeared on behalf of the Opposers, Kohler Company.</p> <p>18</p> <p>19 WILMER CUTLER PICKERING HALE AND DORR, LLP, by</p> <p>20 MS. VINITA FERRERA</p> <p>21 MS. CARRIE SEARES</p> <p>22 60 State Street</p> <p>23 Boston, Massachusetts 02109</p> <p>24 (617) 526-6208</p> <p>25 vinita.ferrera@wilmerhale.com</p> <p>26 carrie.seares@wilmerhale.com</p> <p>27 Appeared on behalf of the Applicant, Honda.</p> <p>28</p> <p>29 ALSO PRESENT: MR. AARON MITCHELL, Senior IP Attorney,</p> <p>30 Kohler Company.</p> <p>31</p> <p>32 I N D E X</p> <p>33 WITNESS PAGE</p> <p>34 MR. JOHN REISEL 6</p> <p>35 DIRECT EXAMINATION BY MR. NOWAKOWSKI 6</p> <p>36 CROSS-EXAMINATION BY MS. FERRERA 63</p> <p>37 REDIRECT EXAMINATION BY MR. NOWAKOWSKI 177</p> <p>38 RECROSS-EXAMINATION BY MS. FERRERA 179</p> <p>39</p>	<p>1 Applicant's Photograph of Subaru SP170 Engine 79</p> <p>2 Exhibit 26</p> <p>3 Applicant's Photograph of Briggs and Stratton 79</p> <p>4 Exhibit 27 750 Engine</p> <p>5 Applicant's Photograph of Predator 346 cc Engine 79</p> <p>6 Exhibit 28</p> <p>7 Applicant's Photograph of Champion 338 cc Engine 79</p> <p>8 Exhibit 29</p> <p>9 Applicant's Photograph of Lifan 190F Engine 79</p> <p>10 Exhibit 30</p> <p>11 Applicant's Photograph of Kawasaki FJ180 Engine 79</p> <p>12 Exhibit 31</p> <p>13 Applicant's Photograph of All-Power 208 cc 79</p> <p>14 Exhibit 32 Engine</p> <p>15 Applicant's Drawing 97</p> <p>16 Exhibit 33</p> <p>17 Applicant's Photograph of Tiller with Honda GX 147</p> <p>18 Exhibit 34 Engine</p> <p>19 Applicant's Photograph of Honda GX200 PowerShot 147</p> <p>20 Exhibit 35 Gas Pressure Washer</p> <p>21 Applicant's Photograph of Kohler Command Pro 7 165</p> <p>22 Exhibit 36 engine</p> <p>23 Applicant's United States Patent Des. 309,458 168</p> <p>24 Exhibit 37</p> <p>25 Applicant's United States Design Patent Number 171</p>
Page 3	Page 5
<p>1 E X H I B I T S</p> <p>2 NUMBER DESCRIPTION PAGE</p> <p>3 OPPOSERS</p> <p>4 Opposers' Curriculum Vitae 10</p> <p>5 Exhibit 23</p> <p>6 Opposers' List of Documents Reviewed 23</p> <p>7 Exhibit 24</p> <p>8 Opposers' Pictures of Engines 35</p> <p>9 Exhibit 25</p> <p>10</p> <p>11 APPLICANT'S</p> <p>12 Applicant's Photograph of Kohler Command Pro 6 78</p> <p>13 Exhibit 19 Engine</p> <p>14 Applicant's Photograph of Kawasaki FE250 Engine 79</p> <p>15 Exhibit 20</p> <p>16 Applicant's Photograph of Briggs and Stratton 79</p> <p>17 Exhibit 21 Intek 900 Engine</p> <p>18 Applicant's Photograph of Subaru EX35 Engine 79</p> <p>19 Exhibit 22</p> <p>20 Applicant's Photograph of Subaru EX17 Engine 79</p> <p>21 Exhibit 23</p> <p>22 Applicant's Photograph of Vanguard 9 Engine 79</p> <p>23 Exhibit 24</p> <p>24 Applicant's Photograph of Kawasaki FE170 Engine 79</p> <p>25 Exhibit 25</p>	<p>1 Exhibit 38 US D595,737S</p> <p>2 Applicants United States Design Patent No. 172</p> <p>3 Exhibit 39 D605,611S</p> <p>4 Applicants United States Patent No. Des. 174</p> <p>5 Exhibit 40 282,071</p> <p>6</p> <p>7</p> <p>8</p> <p>9 (Original exhibits attached to original transcript.)</p> <p>10</p> <p>11 (Original transcript was delivered to Attorney</p> <p>12 Nowakowski.)</p> <p>13</p> <p>14</p> <p>15</p> <p>16</p> <p>17</p> <p>18</p> <p>19</p> <p>20</p> <p>21</p> <p>22</p> <p>23</p> <p>24</p> <p>25</p>

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1 PROCEEDINGS

2 MR. JOHN REISEL called as a witness

3 herein, after having been first duly sworn on oath,

4 was examined and testified as follows:

5 DIRECT EXAMINATION

6 BY MR. NOWAKOWSKI:

7 Q. Good morning, Professor Reisel. Could you please

8 provide your full name and address to the reporter?

9 A. John Reisel, R E I S E L, and 7415 North Lombardy,

10 L O M B A R D Y, Road in Fox Point, Wisconsin.

11 Q. Professor Reisel, have you been retained by Opposers

12 Briggs and Stratton and Kohler to render expert

13 testimony in this trademark opposition matter?

14 A. Yes.

15 Q. Specifically have you been asked to render expert

16 testimony regarding the Honda trademark applied for

17 and previously identified as Applicant Exhibit 6?

18 A. Yes.

19 Q. Professor Reisel, what is your fee in this matter?

20 A. I am paid \$200 an hour.

21 Q. Do you have any financial interest in the outcome of

22 this opposition proceeding?

23 A. No.

24 Q. I'd like to have you give your educational background

25 after high school. So if you can just provide that

Page 7

1 generally to the reporter, and then we'll ask some

2 specific questions as necessary. So can you explain

3 that for us, please?

4 A. Okay. I received my bachelor of mechanical

5 engineering degree from Villanova University in 1989.

6 I received my masters of science in mechanical

7 engineering from Purdue University in 1991 and my

8 Ph.D. in mechanical engineering from Purdue

9 University in 1994.

10 Q. What was the subject of your doctoral thesis?

11 A. The subject -- the broad subject of my doctoral

12 dissertation was the -- was the measurement and

13 modeling of nitric oxide which is a pollutant from

14 laminar flames.

15 Q. And how long was your graduate program?

16 A. In total five years.

17 Q. Does that include the masters and the Ph.D. program?

18 A. Yes.

19 Q. Together with your undergraduate program then you've

20 essentially had nine years of post high school study

21 in engineering?

22 A. As a student, yes.

23 Q. Do you have any licensing or certifications?

24 A. I am a registered professional engineer in the State

25 of Wisconsin.

Page 8

1 Q. Are there any continuing education requirements as a

2 result of that professional engineering

3 certification?

4 A. Yes. The State of Wisconsin instituted continuing

5 education requirements for that beginning in the last

6 renewal cycle, so that has been going on for three or

7 four years now.

8 Q. And I take it you are current on your necessary

9 continuing education to maintain your professional

10 engineering certification?

11 A. Yes.

12 Q. You're a mechanical engineer; is that correct?

13 A. Yes.

14 Q. Can you describe, please, the field of mechanical

15 engineering?

16 A. In a simple, general definition of mechanical

17 engineering, it would be the design, analysis and

18 manufacturing of devices that involve moving parts.

19 Q. As part of your education in mechanical engineering,

20 did you learn any general principles in mechanical

21 engineering that apply to the design, analysis and

22 manufacturing of devices with moving parts?

23 A. Yes.

24 Q. Can you describe some of those principles for us?

25 A. Well, some of the broad topical areas that I learned

Page 9

1 included heat transfer, thermodynamics, fluid

2 mechanics, design of mechanical systems, vibrations,

3 engineering economics.

4 Q. Do those general principles of mechanical engineering

5 apply to small general purpose internal combustion

6 engines?

7 MS. FERRERA: Objection.

8 THE WITNESS: Yes.

9 BY MR. NOWAKOWSKI:

10 Q. We talked a little bit about your education as a

11 student. Let's talk a little bit about your job

12 history. Can you describe for us your job history

13 after graduation?

14 A. After graduation I spent a few months as a post doc

15 in the laboratory I was working at at Purdue

16 University. That was to carry over over the summer

17 between when I graduated in May and when my job

18 started in August, my permanent job. And that was at

19 the University of Wisconsin at Milwaukee as an

20 assistant professor. That was in 1994 that I

21 started, August of 1994.

22 Since then I've been promoted to associate

23 professor and full professor and have been there for

24 almost 21 full years now.

25 Q. And can you generally describe for us the activities

Page 22

1 A. Yes.

2 Q. And did that supervision and the recommendations

3 involve, again, these general principles of

4 mechanical engine -- mechanical engineering that

5 you've testified to today?

6 MS. FERRERA: Objection.

7 THE WITNESS: Yes, as well as their

8 specific application to the utility engines.

9 BY MR. NOWAKOWSKI:

10 Q. I'm going to shift topics a little bit, come back to

11 this particular matter. Professor Reisel, can you

12 estimate the time you've spent with regard to your

13 engagement in this matter, that is the opinions that

14 you have to render regarding the opposition?

15 A. At this point it is right around 80 hours.

16 Q. And that was over the several years of work?

17 A. That was starting in 2012, yes.

18 Q. And in general terms can you describe what you did,

19 Professor Reisel?

20 A. As my work on this matter, I reviewed materials, both

21 provided to me and that are readily publicly

22 available, I met with engineers at Briggs and

23 Stratton and Kohler, and I conducted my own analysis

24 of the different aspects of the proposed trademark

25 and to develop my opinion as to their potential

Page 23

1 functionality.

2 (Opposers' Exhibit 24 marked.)

3 BY MR. NOWAKOWSKI:

4 Q. Professor Reisel, I've handed you what has been

5 marked as Opposer Exhibit 24. Do you have that in

6 front of you?

7 A. Yes.

8 Q. Can you please identify that for me?

9 A. This appears to be a listing of the various documents

10 that I have reviewed as part of my expert witness

11 work on this project.

12 Q. Professor Reisel, you prepared several reports in

13 connection with your work on this opposition; is that

14 right?

15 A. Yes.

16 Q. And during the course of the preparation of those

17 reports, you included the materials that you

18 reviewed, correct?

19 A. Yes.

20 Q. And is this a listing of those materials and

21 information that you obtained and reviewed in

22 connection with your work on this matter?

23 A. Yes.

24 Q. You said that you interviewed people at Briggs and

25 Stratton and Kohler in connection with your work.

Page 24

1 Can you tell me who it was at those companies that

2 you talked to?

3 A. At those companies I met with engineers, and in

4 general there would be one or two legal

5 representatives present at those meetings as well.

6 Q. All right. Why did you speak with the engineers at

7 Kohler and Briggs and Stratton?

8 A. I met with the engineers to gain a couple of pieces

9 of information. One, I wanted to understand what the

10 requirements in the marketplace of these engines

11 were, and I also wanted to learn and understand their

12 reasoning for making their design choices as to how

13 they were trying to meet the marketplace

14 requirements.

15 Q. Did you believe it was important to speak with

16 engineers from Briggs and Stratton and Kohler in

17 connection with the opinions that you would render in

18 this matter?

19 A. Yes.

20 Q. Why is that?

21 A. By meeting with the engineers, I was able to get a

22 better understanding of the marketplace that they

23 were trying to meet, and also I thought it was

24 important to understand their thought process as to

25 why they would have made particular choices in their

Page 25

1 designs.

2 Q. As a professor in mechanical engineering, I take it

3 you are presented with different applications for the

4 general mechanical engineering principles from time

5 to time?

6 A. Yes.

7 Q. And is it your regular practice as someone who works

8 in the mechanical engineering field to examine the

9 particular application, that is the particular

10 equipment or engine as it may be, in connection with

11 drawing any inferences or opinions regarding that

12 when applying the general engineering principles you

13 testified to in this?

14 A. Yes, you would like to be able to see the object and

15 observe the object and investigate the object as

16 closely as possible.

17 Q. Is the information you received from your interviews

18 with Briggs and Stratton and Kohler engineers and the

19 information you obtained for your review of the

20 documents at Exhibit 24 the type of information you

21 would typically seek out and rely upon in rendering

22 opinions or drawing inferences regarding engines and

23 in particular utility engines?

24 A. Yes.

25 Q. Based on your education, experience and expertise,

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1 the materials you reviewed and the interviews you
 2 conducted, have you formed any opinions regarding the
 3 trademarks shown in Exhibit 6?
 4 A. Yes.
 5 Q. What are those opinions?
 6 A. Well, it is my opinion that there are at least seven
 7 elements of the claimed trademark description that
 8 directly impact the functionality and cost
 9 competitiveness of the competing engine, of the
 10 competing engines.
 11 Those elements would be, first, the
 12 overall cubic design; second, the slanted fan cover;
 13 third, the position of the fuel tank on the right
 14 side of the engine above the fan cover; fourth, the
 15 position of the air cleaner on the left side of the
 16 engine; fifth, the recessed area on the carburetor
 17 cover for the control levers; six, rectangular shape
 18 of the fuel tank and the presence of a rib on that
 19 fuel tank; and 7th, the cubic shape of the air
 20 cleaner cover.
 21 Q. We'll go into detail on each of those opinions,
 22 Professor Reisel. But before I do that, you used the
 23 term functionality. Can you tell me the definition
 24 of that term as you used it in your opinion?
 25 A. The way that I am using functionality is that I am

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1 considering it to be the ability of a product to
 2 successfully meet the intended use and purpose of the
 3 engine in a manner that is competitive from a
 4 performance and quality standpoint as well as a cost
 5 competitive standpoint.
 6 Q. Let's talk about each of your opinions regarding the
 7 trademark features shown on applicant Exhibit 6.
 8 Starting first with overall cubic design, what is
 9 your understanding of how Honda uses the term overall
 10 cubic design?
 11 A. My understanding of Honda's use of the term of the
 12 overall cubic design is that it is a -- that there
 13 are a few elements to this. First, if you look at a
 14 two dimensional frontal projection, so if you were
 15 looking face-on at the engine itself, it would give a
 16 square-ish appearance. It wouldn't have to be a
 17 perfect square, but an appearance that is basically
 18 if somebody were to look at it, they would say that
 19 looks like a square to me.
 20 In addition, it has a box-like design for
 21 its individual accessory components such as the fuel
 22 tank and for the air cleaner, that if someone were to
 23 look at that, they would say that looks like a
 24 rectangular box as they would see it. In order to
 25 meet these, this is also going to result in a design

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1 that has a lot of straight lines involved with it.
 2 So that is my understanding of Honda's interpretation
 3 or use of the term of an overall cubic design.
 4 Q. Did you come to this understanding through review of
 5 some of the materials on Exhibit No. 24, Opposer
 6 Exhibit No. 24?
 7 A. Yes. I came to that understanding primarily through
 8 the deposition of Mr. Fujita who was presented by
 9 Honda who is an employee of Honda who was presented
 10 as one of their people most knowledgeable in their
 11 design of this product.
 12 Q. And is your understanding of Honda's use of the term
 13 overall cubic design consistent with what you
 14 understand overall or cubic design to be?
 15 A. Yes. I would have -- and in fact initially I would
 16 have looked at it as the entire three dimensional
 17 shape of the engine being roughly a cube design,
 18 again, something that may not be a perfect
 19 geometrical cube but something that if someone were
 20 to be asked what does that overall shape most closely
 21 resemble, they would think a cube.
 22 So an object that has roughly straight
 23 edges -- straight sides, straight top, flat top, flat
 24 bottom and with those sides and tops and bottoms
 25 meeting at 90 degree angles. That fits in well with

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1 the way that Honda is considering an overall cubic
 2 design because if you were to take that three
 3 dimensional object that I was referring to and look
 4 at that straight on, it's going to be a square or
 5 square-ish in nature. And in order to efficiently
 6 fit in the various components into that square-ish
 7 design, they're going to take on a box-like nature to
 8 fit in most -- to best use that entire space.
 9 Q. Is your understanding of Honda's use of the term
 10 overall cubic design the understanding upon which you
 11 based your opinions in this opposition?
 12 A. Yes.
 13 Q. And what is your opinion with respect to the overall
 14 cubic design component of the Honda trademark shown
 15 at Applicant Exhibit No. 6?
 16 A. It is my opinion that the overall cubic design is
 17 necessary from a functional and cost competitive
 18 standpoint for this engine.
 19 Q. Can you explain that, please?
 20 A. As revealed by several -- many sources including a
 21 deposition from Mr. Connor from Honda, from Honda's
 22 own website on their development of the GX engine as
 23 well as discussions with engineers at Briggs and
 24 Stratton and Kohler, the marketplace for this type of
 25 engine demands that the engine be compact in

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1 MR. NOWAKOWSKI: Sure.

2 (Recess taken.)

3 BY MR. NOWAKOWSKI:

4 Q. Professor Reisel, we're back on the record. We were

5 about to have you talk about your opinions regarding

6 the carburetor cover and controls. Before I do that,

7 I did realize during the break that I forgot to ask

8 you a question regarding the position of the air

9 cleaner, and my question is simply this.

10 In your opinion is there any impact on the

11 cost of the engine shown in the Honda trademark based

12 upon the position of the air cleaner on the left side

13 of the engine?

14 A. Yes. By placing the air cleaner on the left side of

15 the engine, you are, again, able to reduce the amount

16 of piping that you need to deliver the air to the

17 intake valve. So by positioning -- if it were to be

18 positioned on the right, you would have to have

19 additional passageways, additional piping, put in,

20 and that's going to carry an additional cost along

21 with it.

22 Q. Great. Okay, Professor Reisel, let's move to your

23 opinions regarding the carburetor cover and controls

24 with regard to the Honda trademark. First, can you

25 express your opinion for us, please?

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1 A. It is my opinion that the carburetor cover requires a

2 recessed area for the positioning of the control

3 levers in order to provide adequate durability and

4 performance and functionality of the engine.

5 Q. Is there, in your opinion, any reason to have the

6 controls near the carburetor as opposed to someplace

7 else on the engine?

8 A. Yes. First of all, we want to have the carburetor,

9 again, over by the intake valve. And because the

10 further that you place the carburetor away from the

11 intake valve, there is a greater likelihood that fuel

12 will fall out of the fuel air stream.

13 So the carburetor is placing fuel droplets

14 into the air as the air passes through there. And

15 those droplets are heavier than the air stream.

16 Those droplets can start to accumulate over a longer

17 passageway and potentially fall out and not reach the

18 engine cylinder in a desired fashion. So you want to

19 have the carburetor close to the intake valve to

20 minimize that possibility.

21 Q. Professor, before you go further, where is the intake

22 valve as shown on the trademark Exhibit No. 6?

23 A. It's hidden in there, but what it's going to be is

24 it's going to be located on the left side of the

25 engine in the cylinder head as we've already

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1 described as being on the left side.

2 Q. Fair enough. Continue, please.

3 A. So we want the carburetor to be over close to the

4 intake valve, and we want the control levers to be

5 close to the carburetor to increase their durability

6 and -- or potential durability and also to decrease

7 their initial cost. To position the control levers

8 further from the carburetor would require a more

9 complex mechanism to transmit any change in the

10 position of the control lever to the appropriate

11 control object in the carburetor that you're trying

12 to control. So the longer that mechanism becomes,

13 the more expensive it becomes to implement and build

14 into the system.

15 In addition, that longer control mechanism

16 would make it potentially more easy to -- it would

17 give it the ability to break in more locations. So

18 to maintain that simplicity and cut down on the

19 material costs that are necessary in the first place

20 and hopefully increase its durability, you want those

21 control levers close to the carburetor.

22 Q. And that's as shown on trademark Applicant Exhibit

23 No. 6?

24 A. Correct, as shown on the trademark from Honda, and

25 they're shown on the left side by the carburetor.

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1 Q. And do you have an opinion with respect to the

2 recessed area that's part of the trademark, the Honda

3 trademark, shown on Applicant Exhibit No. 6?

4 A. Yes. Having the control levers in a recessed area as

5 shown on the trademark should increase their

6 durability or at least it gives them the potential to

7 increase their durability and, therefore, make the

8 engine more desirable to the customer.

9 By being recessed, these levers are not

10 protruding out from the engine as much as they

11 otherwise would have to be if they were mounted onto

12 a flat surface in front of there. That is going to

13 reduce the potential of something brushing up against

14 it, breaking off the lever, changing the position of

15 the lever in an undesirable fashion.

16 And as you can see now, while the rewind

17 handle for the starter is -- does not have to be in

18 the position as shown in the trademark application,

19 that is a common configuration. And as you can see,

20 if that is to be pulled and then be flying back into

21 the starter, if you have exposed protruding control

22 levers, they're going to be potentially knocked off

23 by that -- as the control lever rewinds. And they

24 can also interfere with the pull start in the first

25 place for that.

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1 than perhaps a half inch or an inch further to the
 2 right, you would want to be providing additional
 3 support to help stabilize that component.
 4 Q. Why is that?
 5 A. Because that's going to move the center of gravity
 6 over. And as it -- the further and further it moves
 7 out, the more torque it's going to put onto the
 8 engine. And that torque is going to have to be
 9 counterbalanced by a cantilevered support.
 10 Q. When you talk about torque, would that essentially
 11 cause the engine to vibrate?
 12 A. There would likely be additional vibrations. It's
 13 doubtful that it would be enough weight in that fuel
 14 tank to cause the engine itself to tip over. But
 15 potentially if it was pushed out far enough, that
 16 would have to be considered as well.
 17 Q. And that cantilevered support would require
 18 additional cost or expense in your opinion?
 19 A. Yes.
 20 Q. And would that be true with moving the air cleaner
 21 cover out to the left as well?
 22 A. It would be true. It would be -- you would have a
 23 little bit more leeway with that as the air cover
 24 cleaner is lighter, so it wouldn't need to be as
 25 supported as quickly. But it would also be a factor

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1 there.
 2 MR. NOWAKOWSKI: That's all I've got.
 3 Thanks.
 4 RECROSS-EXAMINATION
 5 BY MS. FERRERA:
 6 Q. Professor Reisel, I have a couple of quick follow-up
 7 questions. You agree that it would be possible to
 8 move the fuel tank out slightly to the right in
 9 Exhibits 34 and 35, correct?
 10 A. Yes.
 11 Q. And in fact you agree that you could move the fuel
 12 tank to the right by as much as an inch or two inches
 13 without requiring any additional support, correct?
 14 A. Two inches I would be a little bit concerned with.
 15 But an inch I would be comfortable with, yes. And
 16 that also would depend on the actual model and the
 17 size of the engine in the first place as to how soon
 18 that would have to be considered. For a smaller
 19 engine you would have less leeway to move it out
 20 before it would start being an issue.
 21 Q. So you would agree that you could move it out at
 22 least a half inch to an inch, correct?
 23 A. Correct.
 24 Q. And then if it's a bigger engine, you might be able
 25 to move it out even more than that, correct?

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1 A. If it was at the top-end size of the utility engines,
 2 that might be possible to move out an additional half
 3 inch or inch.
 4 Q. And so similarly, you could move the air cleaner
 5 cover out at least a half inch to an inch without
 6 requiring additional support, correct?
 7 A. Correct.
 8 Q. And maybe even more than that since it's lighter?
 9 A. Correct. Although, again, with a smaller engine I
 10 would be a little bit more concerned if you had a
 11 larger air cover cleaner on there. But yes.
 12 MS. FERRERA: No further questions.
 13 MR. NOWAKOWSKI: That's it.
 14 (At 2:40 p.m., the deposition concluded.)
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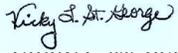
1 CERTIFICATE
 2 STATE OF WISCONSIN)
) SS
 3 MILWAUKEE COUNTY)
 4 I, VICKY L. ST. GEORGE, Registered Merit
 5 Reporter and Notary Public in and for the State of
 6 Wisconsin, do hereby certify that the preceding deposition
 7 was recorded by me and reduced to writing under my
 8 personal direction.
 9 I further certify that said deposition was
 10 taken at the offices of WHYTE HIRSCHBOECK DUDEK, S.C., 555
 11 East Wells Street, Suite 1900, Milwaukee, Wisconsin on
 12 July 16, 2015, commencing at 9:00 a.m. and concluding at
 13 2:40 p.m.
 14 I further certify that I am not a relative or
 15 employee or attorney or counsel of any of the parties, or
 16 a relative or employee of such attorney or counsel, or
 17 financially interested directly or indirectly in this
 18 action.
 19 In witness whereof, I have hereunto set my hand
 20 and affixed my seal of office at Milwaukee, Wisconsin,
 21 this 23rd day of July, 2015.
 22
 23 
 24 VICKY L. ST. GEORGE
 Notary Public in and for the State of Wisconsin
 Commission Expires 1/29/2017
 25

EXHIBIT E
Filed Under Seal