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

Proceeding	91200146
Party	Plaintiff Kohler Co.
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Attachments	Redacted Brief.pdf (8 pages)(98294 bytes) Supplemental Dec-Redacted.pdf (2 pages)(10402 bytes) EXHIBIT001-Redacted.pdf (1 page)(166320 bytes) Certificate of Service.pdf (1 page)(33743 bytes)

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

BRIGGS & STRATTON CORPORATION and
KOHLER CO.,

Opposers,

v.

HONDA GIKEN KOGYO KABUSHIKI KAISHA,

Applicant.

Opposition No. 91200832 (parent)

Opposition No. 91200146

Application Serial No. 78924545

**OPPOSERS' REPLY BRIEF IN SUPPORT OF MOTION
FOR LEAVE TO FILE AMENDED NOTICES OF OPPOSITION
[UNREDACTED VERSION FILED UNDER SEAL]**

INTRODUCTION

Applicant Honda Giken Kogyo Kabushiki (“Honda”) largely ignores the fact that under Fed. R. Civ. P. 15(a), motions to amend are liberally granted in the interests of justice unless the amendment would violate settled law or be prejudicial to the non-movant. Nearly all of Honda’s brief addresses the merits of the amendments proposed by Kohler Company (“Kohler”) and Briggs & Stratton Corporation (“Briggs” and, collectively with Kohler, “Opposers”), not whether the amendments should be allowed in the first place. The merits, of course, are for the Board to consider in determining ultimately whether the mark (the “Mark”) in Honda’s U.S. Trademark Application Serial No. 78,924,545 (the “Application”) is registerable, based on all the evidence that will be submitted at trial. Although Honda’s brief shows that, not surprisingly, there will be a sharp dispute between the parties on the amended claims of abandonment, genericness and failure to use as a mark, Honda does not establish that the new claims violate settled law. Further, Honda makes no effort to show how it would be prejudiced by the proposed

amendments. Thus, it is clear that at this stage of the proceeding, justice requires that Opposers be permitted to present to the Board claims that they only learned of during the course of recent discovery.

ARGUMENT

I. OPPOSERS' MOTION FOR LEAVE TO AMEND SATISFIES THE REQUIREMENTS OF FED. R. CIV. P. 15(A).

“In deciding . . . a motion [for leave to amend], the Board will grant the motion unless entry of the proposed amendment would violate settled law or would be prejudicial to applicant.” *Karsten Mfg. Corp. v. Editoy AG*, 79 U.S.P.Q.2d 1783, 1786 (TTAB 2006) (citing *Boral Limited v. FMC Corp.*, 59 U.S.P.Q. 2d 1701, 1702 (TTAB 2000) (citing additional cases)); *see also Zanella Ltd. v. Nordstrom Inc.*, 90 U.S.P.Q.2d 1758, 1759 (TTAB 2008); *Hurley Internat'l LLC v. Volta*, 82 U.S.P.Q.2d 1339, 1341 (TTAB 2007).

By its silence on the issue, Honda effectively concedes that it will not suffer any prejudice. Unlike Opposers, Honda knew at the time the Notices were filed that [REDACTED]

[REDACTED]

and thus, it could easily have anticipated the amended grounds for opposition. Furthermore, not only did Opposers seek leave to amend well before discovery closes in late August 2012, the parties jointly asked the Board recently to extend the discovery deadline until late October 2012, giving Honda even more time to prepare its response to the new claims. Presumably, Honda declined to argue prejudice because of these facts.

Honda also fails to argue how the new facts alleged in the amended Notices – namely, that Honda “for many years, either by written contract, or express or implied consent or acquiescence, permitted several third-parties to manufacture and sell engines in the United States with designs that incorporate many or all of the elements of the Applicant’s Mark” and that “[o]n

information and belief, Applicant has redesigned its GX series of horizontal shaft engines” -- do not support their amended claims or otherwise violate settled law. *See Opposers' Motion*, Exhs. A, ¶¶ 10-14 & B, ¶¶ 5-9. Indeed, the Board has previously recognized that similar allegations adequately state a claim of abandonment. *See TBC Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d 1311, 1314 (TTAB 1989) (holding that proposed counterclaim stated proper claim of abandonment by alleging that trademark owners had allowed numerous third parties to use subject mark without objection and that, further, merits of such claim were to be determined at trial).

Honda's refusal to stipulate to the amendments and its current, vociferous protest underscore the fact that justice requires that Opposers be allowed to put these additional grounds before the Board.

II. OPPOSERS DID NOT UNDULY DELAY IN SEEKING LEAVE, NOR WOULD THEIR AMENDED CLAIMS BE FUTILE.

Rather than argue that it would suffer prejudice or that the amendments would violate settled law, Honda contends that Opposers unduly delayed in seeking to assert the additional grounds for opposition or, alternatively, that the proposed amendments would be “futile.” Unless Honda can establish undue delay or futility, leave to amend “should, as [Rule 15(a)] require[s], be ‘freely given.’” *Foman v. Davis*, 371 U.S. 178, 182 (1962). Honda does not carry its burden.

1. Opposers Did Not Delay In Seeking Leave to Amend.

Honda contends that Opposers should have included the three additional claims in their original Notices and that the failure to do so resulted in “undue delay.” *Honda Brief*, at 2-5. As an initial matter, however, “the concept of ‘undue delay’ is inextricably linked with the concept of prejudice to the non-moving party,” *Marshall Field & Co. v. Mrs. Fields Cookies*, 11

U.S.P.Q.2d 1355, 1359 (TTAB 1989); because, again, Honda does not argue that it would be prejudiced by any “delay,” this contention is doomed from the outset.

Furthermore, there is a world of difference between alleging generally that other products have a similar look to the mark that the Applicant is trying to register (as Opposers did in their original Notices) and learning that the Applicant [REDACTED]

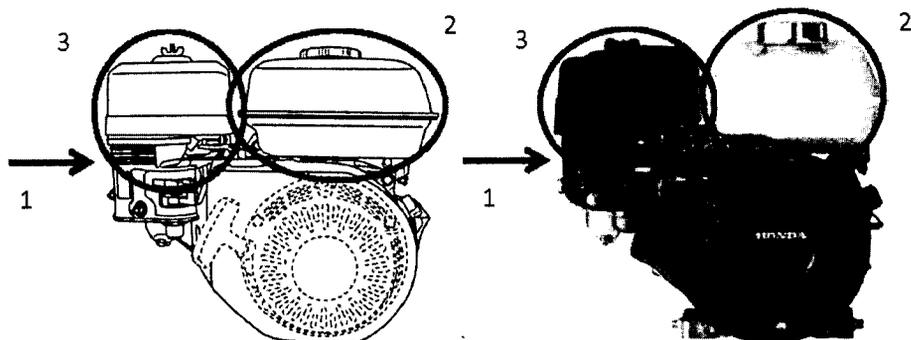
[REDACTED] Opposers only learned the latter in April and May, 2012, when Honda provided the settlement agreements and responses to requests to admit that Opposers have submitted in support of the instant motion. *See Declaration of Donald A. Daugherty, Esq. (“Daugherty Decl.”)*, ¶¶ 2, 5 & Exhs. 1, 4.¹ Promptly thereafter, Opposers requested that Honda stipulate to allowing the amendments, Honda declined, and on May 30, Opposers sought leave from the Board. *See Daugherty Decl.*, ¶ 7.

Also, Honda omits the fact that for three months last Fall, Kohler and it were engaged in settlement discussions and asked the Board to suspend this proceeding. *Suppl. Daugherty Decl.*, ¶ 2. Honda was responsible for further delay when it produced the settlement agreements four to five months after they were due. *Id.*, ¶ 3.

Opposers learned of the new claims when they received Honda’s discovery responses this past Spring, and the new design for the GX engine displayed on Honda’s website is merely additional evidence that reinforces the claims. The new design not only lacks four ribs on the carburetor cover (as Honda acknowledges), *see* Fig. 1, *infra*, but other features claimed for the proposed Mark are also now missing. For example, the fuel tank on the new versions do not remain “roughly rectangular,” but have become roughly square, as they are narrower but the

¹ The Daugherty Declaration (and Exhibits) was filed with Opposers’ motion. A Supplemental Declaration of Donald A. Daugherty, Esq. (“Suppl. Daugherty Decl.”) is filed herewith in support of the motion.

same height. See Fig. 2, *infra*. Similarly, the air cleaner no longer features a cube shape. See Fig. 3, *infra*.



Drawing, U.S. Trademark
Application Serial No. 78,924,545

New Version of the GX 120

Thus, not only has the alleged Mark been “non-intentionally” abandoned because it has lost its significance as a result of Honda’s acquiescence, but it also appears that in the new GX design, Honda has actually abandoned important features of the Mark that are described in the Application.

Lastly, assuming, *arguendo*, that Opposers did somehow delay, that alone is not enough to refuse to allow the proposed amendment.’ The very cases cited by Honda show this. For example, leave to amend was not denied in *Media On-line, Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q. 2d 1285, 1286-87 (TTAB 2008) solely because support for the new claims had been available from the dictionary and on the applicant’s website before the movant filed its notice of opposition; rather, the Board found “that respondent would suffer prejudice if petitioner is permitted to add the claims at this juncture,” after the respondent had moved for judgment on the pleadings. By contrast, Honda does not point to any prejudice it would suffer, and at this relatively early juncture, allowing the amendments will not hurt its ability to defend the Mark.

Similarly, in *Trek Bicycle Corp. v. StyleTrek, Ltd.*, 64 U.S.P.Q.2d 1540, 1541-42 (TTAB 2002), the movant’s proposed claim in its amended pleading was legally insufficient and, further,

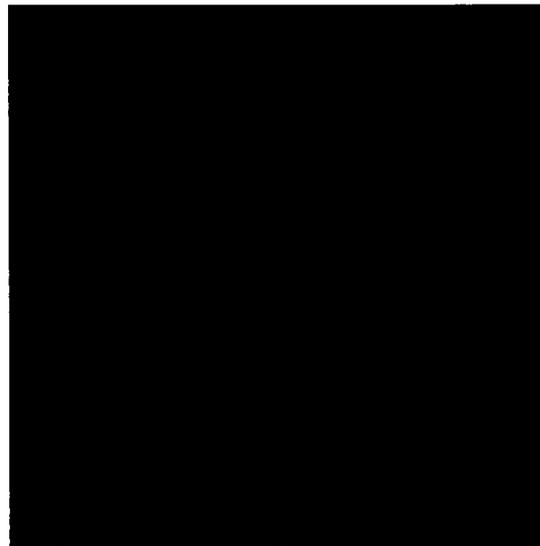
the movant failed to explain to the Board why it had not plead the claim earlier. By contrast, Honda does not argue that Opposers have failed to plead all the elements legally necessary for their amended claims, and Opposers have explained that they moved for leave to amend promptly after discovering grounds for doing so, *see Daugherty Decl.*, ¶ 7.

2. The Amendments Would Not Be “Futile.”

In arguing futility, Honda states that Opposers “have failed to identify any evidence that supports their allegation that Honda consented to third parties use of engine configurations that are the same or substantially similar to the claim trademark.” *Honda Brief*, at 5 (emphasis original). However, [REDACTED]

[REDACTED]
[REDACTED] See

Daugherty Declaration, ¶¶ 2, 5 & Exhs. 1, 4.



Suppl. Daugherty Declaration, ¶ 3 & Exh. 1. Contrary to Honda’s argument, few, if any, of the differences [REDACTED] and the Mark are “substantial,” and most are not even readily perceptible. Whether such [REDACTED] have “substantial differences”

from the proposed mark such that they do not support Opposers' new claims will be one of the issues for the Board to decide based on all the evidence submitted at trial.² *See Focus 21 Internat'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (whether movant can prove allegations in proposed amendment is to be determined after introduction of evidence at trial and not at time of motion for leave to amend); *Flatley v. Trump*, 11 U.S.P.Q.2d 1284, 1286 (TTAB 1989) (same).

Finally, Honda's reliance on [REDACTED]

[REDACTED]
See Honda Brief, at 5-6. [REDACTED]

neither Opposers nor the Board are bound by those concessions, and Briggs and Kohler strenuously disagree that the GX engine is materially different from [REDACTED]

[REDACTED] Again, such issues are ultimately for the Board to decide in determining whether the Mark is registerable.

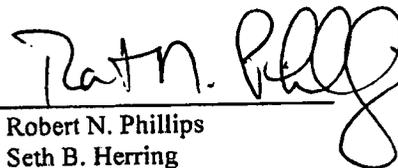
CONCLUSION

For the foregoing reasons, as well as those set forth in Opposers' motion, this Court should grant leave to amend and accept for filing the Amended Notices of Opposition that are attached as Exhibits A and B to Opposers' motion.

² Also for trial will be the issue of whether the recent changes to the design of the GX engine are merely "minor variations" that do not constitute abandonment, as Honda argues. *See Honda Brief*, at 9-11. Honda's actions have forced it to take contradictory positions: on the one hand, Honda argues that the differences between the drawing in its Application drawing and its recent redesign are "minor," but on the other hand, argues that differences between its design [REDACTED] engine are "substantial." These conflicting positions further underscore the need for a trial on the merits of Opposers' defenses.

Dated: July __, 2012

By:



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Dated: July 9, 2012

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KAISHA, .

Application Serial No. 78924545

Applicant.

**SUPPLEMENTAL DECLARATION OF DONALD A. DAUGHERTY, ESQ.
[UNREDACTED VERSION FILED UNDER SEAL]**

Donald A. Daugherty, Jr., makes the following declaration pursuant to 28 U.S.C. § 1746:

1. I am an attorney with the law firm of Whyte Hirschboeck Dudek S.C., counsel for opposer Kohler Co. ("Kohler") in the above-captioned action. I am licensed to practice law in the State of Wisconsin and have been admitted to appear in this matter before the United States Patent and Trademark Office. I make this Supplemental Declaration in support of the Opposers' Motion for Leave to File Amended Notices of Opposition.

2. In this proceeding on September 13, 2011, Kohler filed a Motion for Suspension for Settlement With Consent. In this proceeding on December 9, 2011, Kohler filed a Consented Motion to Resume Proceedings and Consent to Reschedule Trial Dates.

3. On or about October 25, 2011, co-opposer Briggs & Stratton Corporation ("Briggs") served requests for production of documents on applicant, Honda Giken Kogyo Kabushiki Kaisha ("Honda"). Honda did not produce [REDACTED]
[REDACTED]

██████████ that were responsive to Briggs' requests and submitted in support of Opposers' motion until April and May, 2012, which was roughly four to five months after the documents were due.

4. Attached hereto as **Exhibit 1** is a true and correct copy of a photograph of the

██████████

Dated this 9th day of July, 2012.

s/Donald A. Daugherty, Jr.
Donald A. Daugherty, Jr.

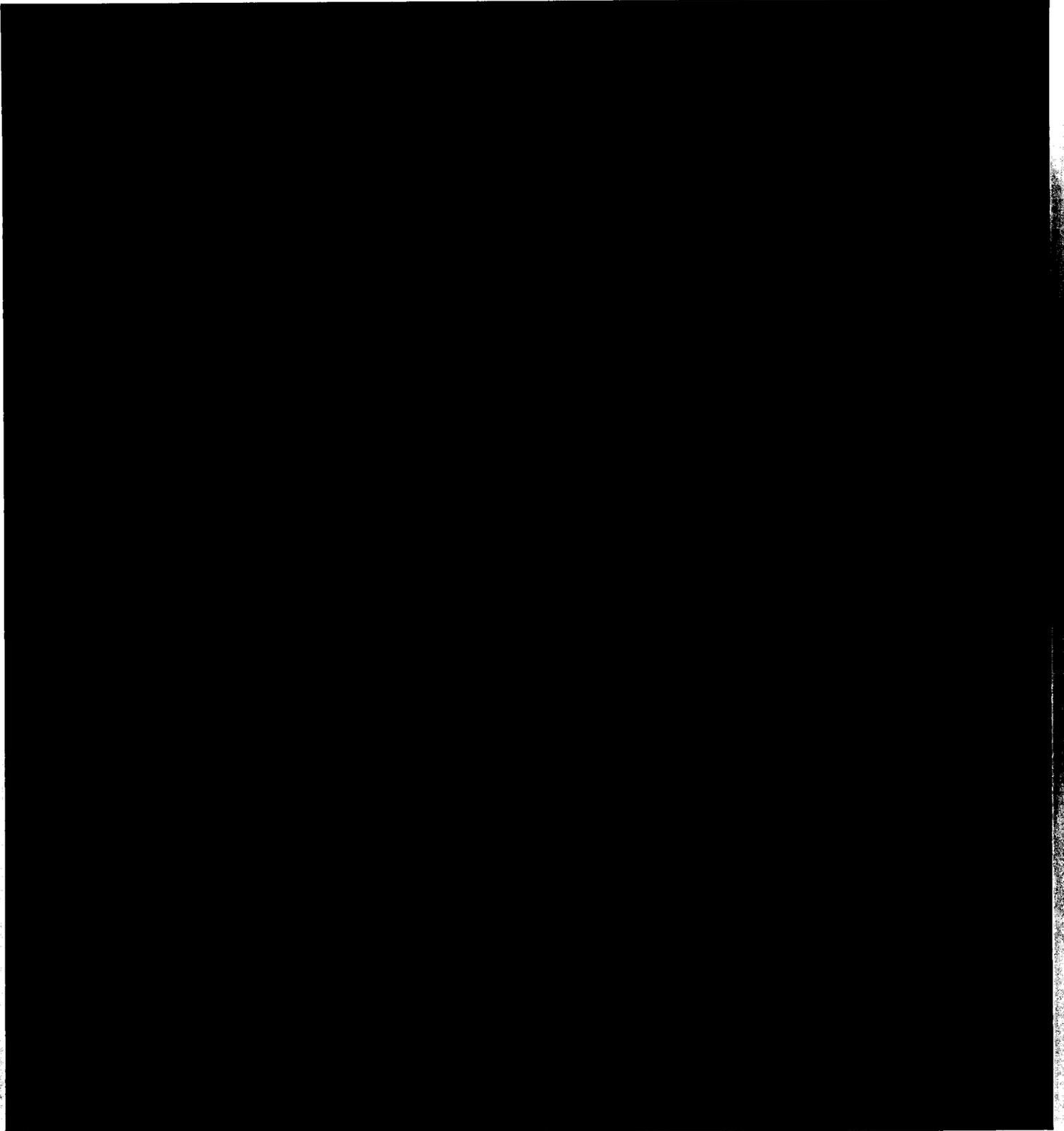


EXHIBIT 1

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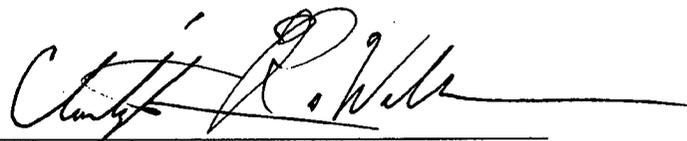
Application Serial No. 78924545

CERTIFICATE OF SERVICE

I CERTIFY that attached hereto is a copy of the Opposers' Reply Brief in Support of Motion for Leave to File Amended Notices of Opposition [Unredacted Version Filed Under Seal] and the Supplemental Declaration of Donald A. Daugherty, Jr., Esq. [Unredacted Version Filed Under Seal] which were served upon the following party on the 9th day of July, 2012 by United Parcel Service:

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Ms. Barbara Barakat
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Dated: July 9, 2012.



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