

ESTTA Tracking number: **ESTTA490328**

Filing date: **08/21/2012**

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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Date	08/21/2012
Attachments	Applicant's Motion to Compel.pdf ( 35 pages )(1769572 bytes ) Proposed Order.pdf ( 2 pages )(7974 bytes ) Exhibits_REDACTED.pdf ( 1 page )(1985 bytes )



## I. INTRODUCTION

Applicant Honda Giken Kogyo Kabushiki Kaisha (“Honda”) respectfully requests that the Board compel Opposers Briggs & Stratton Corporation (“Briggs”) and Kohler Co. (“Kohler”) (collectively, “Opposers”) to produce documents in response to Honda’s First Requests for the Production of Documents, served over *eight* months ago. These requests seek critical documents concerning Opposers’ grounds for opposing Honda’s trade dress registration.

Briggs and Kohler have opposed the registration of Honda’s Application, Serial No. 78,924,545, which seeks to register the unique aesthetic look of the GX Series Engines (“GX Engine Trademark”) on the grounds that the claimed trade dress lacks secondary meaning and is functional.<sup>1</sup> Dkt. No. 1 (Briggs’ Notice of Opposition) in Opposition No. 91200832 (parent); Dkt. No. 1 (Kohler’s Notice of Opposition) in Opposition No. 91200146. While Briggs and Kohler together have served three sets of document requests (totaling 53 requests), three sets of requests for admission (totaling 228 requests), and one set of interrogatories (totaling four interrogatories), they have not produced relevant documents responsive to most of Honda’s requests, which are reasonable in scope.

In response to Honda’s First Set of Requests for Production, Briggs agreed to produce documents responsive to only *six* of Honda’s 36 requests. In the few instances where Briggs agreed to produce responsive documents, it was frequently with caveats, including the provision that Briggs would only produce documents “it intends to rely upon.” *See* Declaration of Sarah R. Frazier in Support of Applicant Honda Giken Kogyo Kabushiki Kaisha’s Motion to Compel Production of Documents From Opposers Briggs & Stratton Corporation and Kohler Co. (“Decl.

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<sup>1</sup> Opposers are currently seeking leave to amend their notices of opposition to add additional grounds of abandonment, genericness, and failure to use the GX Engine Trademark as a trademark or service mark. Honda has opposed Opposers’ motion on the grounds that it is untimely and futile.

of Frazier”), Ex. EE (Briggs’ Second Supplemental Responses to Applicant’s First Set of Requests for Production at Nos. 2, 3 and 4) (responding to requests for “all documents that support or relate to” contentions that Applicant’s Mark is nondistinctive, lacks secondary meaning, and is functional). This approach is contrary to the letter, spirit, and goals of the Board’s discovery process.

On the other hand, Kohler agreed to produce documents in response to a majority of Honda’s requests, but has simply failed to do so. In contrast to Honda’s production of nearly 100,000 pages of documents to date, Briggs and Kohler have produced respectively a mere 218 and 146 *pages* of documents, largely consisting of publicly-available pictures of third party engines and correspondence between Honda and Opposers already in Honda’s possession. Honda has yet to receive a production of substantive documents in this matter from *either* Opposer concerning important topics relevant to the issues of functionality and secondary meaning raised by Opposers.

Opposers repeatedly ignored Honda’s requests for a meet and confer until Honda threatened to file a motion to compel, while at the same time making near-daily demands for immediate action by Honda with respect to Opposers’ own excessive discovery requests.<sup>2</sup> Even now, having met, conferred, and reached impasse, Opposers continue to refuse to produce important categories of documents despite: (1) Honda’s clear explanation of the relevance of those documents to the issues in this proceeding; and (2) Honda’s repeated efforts to reach an acceptable compromise regarding the scope of its requests.

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<sup>2</sup> With the close of discovery more than two months away Opposers have already served 285 formal discovery requests. In addition to these formal requests, Opposers have made frequent informal discovery-related inquiries including requests that specific documents be produced at specific times and that documents within productions be identified for them prior to conducting their own review. *See, e.g.*, Decl. of Frazier, ¶¶ 20-22, 27, 29, 35, 37, 38, 40, 52, 55, 57, and 62, Exs. J, N, O, T, V, AA, BB, DD, and FF (emails).

Accordingly, Honda seeks relief from the Board to compel Opposers to produce the following categories of documents, which are a subset of the categories in Honda's Document Requests:

1. Documents concerning Opposers' purchase of Honda engines embodying the GX Engine Trademark [RFP Nos. 28 (Briggs) and 43 (Kohler)];
2. Documents concerning differences or similarities between Opposers' Knock-Off Products and Honda engines embodying the GX Engine Trademark [RFP Nos. 31 (Briggs) and 46 (Kohler)];
3. Documents concerning the design and manufacture of Opposers' Knock-Off Products [RFP Nos. 9, 18 and 21 (Briggs) & 24, 33 and 36 (Kohler)];
4. Documents concerning the marketing and advertisement of Opposers' Knock-Off Products [RFP Nos. 13 and 20 (Briggs) & 28 and 35 (Kohler)];
5. Business plans concerning the use, manufacture, sale or offering for sale of Opposers' Knock-Off Products [RFP Nos. 12 and 22 (Briggs) & 27 and 37 (Kohler)]; and
6. Correspondence between Briggs and its advertising agencies referring or relating to the GX Engine Trademark. [RFP No. 36 (Briggs)].

While the burden of discovery in an opposition proceeding may be disproportionately on the Applicant, that does not mean there is *no* encumbrance on the Opposers. The Board has recognized that discovery surrounding Opposers' allegedly similar products is relevant. *See, e.g., Frito-Lay N. Am., Inc. v. Princeton Vanguard LLC*, 100 U.S.P.Q.2d (BNA) 1904, 1910 (T.T.A.B. 2011). Opposers' failure to comply with their discovery obligations by refusing to produce critical documents related to their grounds for opposition is significantly impairing Honda's ability to prepare its case and defenses. At this juncture, Opposers have already deposed Scott Conner, a key Honda Vice President, for two days in both his personal capacity and as Honda's representative. During the deposition, Opposers questioned Mr. Conner regarding more than sixty documents produced by Honda during discovery.

Honda has requested to depose Opposers and the individuals identified in their initial disclosures in September and October. Opposers' failure to produce documents responsive to Honda's requests which are relevant to the issues in this proceeding is obstructing Honda in its preparation for those depositions. To avoid prejudice, Honda asks that the Board order Briggs and Kohler to produce the requested documents so that Honda might exercise the same rights at the upcoming depositions of Briggs and Kohler witnesses that Opposers have already exercised against Honda.

## II. FACTUAL BACKGROUND

Honda served its First Requests for Production of Documents on Briggs and Kohler on October 28, 2011 and December 13, 2011, respectfully. *See* Decl. of Frazier, Ex. E.1 (Honda's First Requests for Production of Documents on Briggs); Ex. F.1 (Honda's First Requests for Production of Documents on Kohler). Briggs and Kohler served their responses on January 3, 2012 and January 31, 2012, respectively. *See* Decl. of Frazier, Ex. G (Briggs' Responses to Honda's First Requests for Production of Documents); Ex. H (Kohler's Responses to Honda's First Requests for Production of Documents).

Honda made its first document production on January 9, 2012 and has continued to produce documents on a rolling basis, totaling nearly 100,000 pages to date. Decl. of Frazier, ¶ 66. On March 22, 2012, more than two months after Honda's first production, Briggs produced 111 *pages* of documents, 94 pages of which were from publicly-available websites (including 18 pages from Honda's own website). Decl. of Frazier, ¶ 15. Having not received any documents from Kohler, Honda wrote on March 28, 2012, to both Briggs and Kohler concerning the inadequacies and deficiencies in their responses and document production, providing detailed explanations for each deficiency. Decl. of Frazier, Ex. K (March 28, 2012 letter from Honda to

Briggs); Ex. L (March 28, 2012 letter from Honda to Kohler). Opposers chose to ignore Honda's legitimate discovery concerns and requests for a meet and confer, and instead made frequent improper requests including requests for the identification of dozens of documents in Honda's production by Bates number *before* Opposers had conducted any reasonable review of those documents, and for the production of documents concerning likelihood of confusion, an issue Opposers themselves have acknowledged is not relevant in those proceedings. Decl. of Frazier, ¶¶ 17, 19, 20-22, 23-25, 27-30, Exs. J, M, N, O and P (emails); *see also* Ex. Q at 2 (Briggs' April 20, 2012 letter to Honda, expressly acknowledging that "likelihood of confusion is not one of the grounds for the Opposition, and therefore irrelevant for discovery purposes.").

Finally, several weeks after receiving Honda's March 28, 2012 letter, Opposers responded to the issues raised by Honda. Opposers acknowledged that discovery "relate[d] to the registrability of the applied-for mark" is relevant to this proceeding and agreed to provide supplemental responses and document productions. Decl. of Frazier, Ex. R at 1 (Opposers' April 30, 2012 letter to Honda). Nevertheless, Opposers continued to "stand by the objections in their original discovery responses" and refused to provide the vast majority of the requested information and documents that are highly relevant to the issues at hand. *Id.*

Notwithstanding promises to supplement their discovery responses and document productions, Opposers ignored for *weeks* Honda's repeated requests that they do so. Decl. of Frazier, ¶ 36, Exs. T and U (emails). Instead, Opposers continued to send Honda near-daily emails asking for immediate responses to their excessive discovery requests. Decl. of Frazier, ¶¶ 35, 37-42, Exs. T and V (emails). Finally, on May 4, 2012, Kohler made its first production of documents. Decl. of Frazier, ¶ 33. This production consisted of 117 pages, including 44 pages

that appear to be from publicly-available websites<sup>3</sup>, and 33 pages of correspondence between counsel for Honda and counsel for Kohler (which was already in Honda's possession). *Id.* On May 14, 2012, Briggs produced an additional 61 pages including a single market research document and product brochures. Decl. of Frazier, ¶ 46.

Honda's repeated requests for a meet and confer were also ignored by Opposers. Decl. of Frazier, ¶¶ 28, 30 and 44, Exs. J and V (emails). Only after Honda threatened to seek the Board's assistance in obtaining the requested discovery, did Opposers meet and confer telephonically on May 25, 2012 to discuss the outstanding discovery disputes. Decl. of Frazier, ¶¶ 47 and 50, Ex. T. Despite Honda's clear explanation of the relevance of its discovery requests and repeated efforts to compromise (*see* Decl. of Frazier, Ex. Z (Honda's June 1, 2012 confirming letter)), Opposers continued to refuse to provide documents responsive to numerous requests (*see* Decl. of Frazier, Ex. CC (Opposers' June 15, 2012 joint response to Honda's June 1, 2012 confirming letter)). Instead, Opposers continued to make burdensome discovery demands on Honda. *See* Decl. of Frazier, ¶¶ 52, 55, 57, and 62, Exs. AA, BB, DD and FF (emails).

The relevant responsive documents sought by Honda in this motion to compel include:

1. Documents concerning Opposers' purchase of Honda engines embodying the GX Engine Trademark [RFP Nos. 28 (Briggs) and 43 (Kohler)];
2. Documents concerning differences or similarities between Opposers' Knock-Off Products and Honda engines embodying the GX Engine Trademark [RFP Nos. 31 (Briggs) and 46 (Kohler)];
3. Documents concerning the design and manufacture of Opposers' Knock-Off Products [RFP Nos. 9, 18 and 21 (Briggs) & 24, 33 and 36 (Kohler)];
4. Documents concerning the marketing and advertisement of Opposers' Knock-Off Products [RFP Nos. 13 and 20 (Briggs) & 28 and 35 (Kohler)];

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<sup>3</sup> The web pages included in this production do not include URL addresses or dates.

5. Business plans concerning the use, manufacture, sale or offering for sale of Opposers' Knock-Off Products [RFP Nos. 12 and 22 (Briggs) & 27 and 37 (Kohler)]; and
6. Correspondence between Briggs and its advertising agencies referring or relating to the GX Engine Trademark [RFP No. 36 (Briggs)].<sup>4</sup>

These document categories comprise less than the full volume of documents requested by Honda in its formal discovery requests.

Having exhausted every avenue to resolve these discovery disputes in an efficient and expedited manner, Opposers have left Honda no choice but to seek the Board's assistance in compelling Opposers to comply with their discovery obligations so that Honda may prepare its case and defenses in the same manner that Opposers have done with their case.

### III. ARGUMENT

The scope of requests for production in *inter partes* proceedings before the Board is governed by Federal Rule of Civil Procedure 26. *TBMP* § 406.02. Under Rule 26(b), the parties may obtain discovery "regarding any matter, not privileged, which is relevant to the claim or defense of any party." A motion to compel may be used to require the production of documents and is appropriate where, as here, objections to discovery requests are improper. *See TBMP* § 423.01 and cases cited therein.

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<sup>4</sup> On June 25, 2012, Briggs served its Second Supplemental Responses to Honda's First Set of Requests for Production. Decl. of Frazier, Ex. EE. On June 26, 2012, Kohler produced one page of updated engine financials. On June 28, 2012, Kohler produced 26 pages constituting an allegedly representative sample of its advertising materials. This "representative" sample consists of only a *single* advertisement of the Kohler SH265 engine that Honda alleges infringes the GX Engine Trademark. Decl. of Frazier, ¶ 60. On July 2, 2012, Briggs produced 36 pages of engine photos and advertisements. Decl. of Frazier, ¶ 61.

**A. The Board Should Compel the Production of Documents Concerning Opposers' Purchase of Honda Engines Embodying the GX Engine Trademark, Because They Are Relevant to Secondary Meaning, Functionality, and Genericness [RFP Nos. 28 (Briggs) & 43 (Kohler)]**

Opposers have recently begun to market and sell products with designs that are the same as or substantially similar to the GX Engine Trademark (“Opposers’ Knock-Off Products”). These products include Briggs’ 550 Series engines and Kohler’s SH265 engine. *See* Decl. of Frazier, Ex. A (cease and desist letter to Briggs); Ex. B (cease and desist letter to Kohler). Documents evidencing the purchase of Honda engines embodying the GX Engine Trademark are clearly relevant to the issues of secondary meaning and genericness to the extent they reveal Opposers’ motivation to copy the GX Engine Trademark. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1379 (Fed. Cir. 2012) (copying is a factor to consider in assessing secondary meaning). Honda agreed to narrow this request to exclude purchases of Honda engines that occur in the regular course of business for incorporation into products manufactured by Opposers. Decl. of Frazier, Ex. Z at 5. Opposers rejected this proposal, and instead agreed only to produce documents referencing the GX Engine Trademark in connection with the design of their horizontal shaft engines. Decl. of Frazier, Ex. CC at 3.

Opposers’ refusal to produce documents responsive to this request, except those that explicitly reference the GX Engine Trademark, is not justifiable. For example, documents showing that an engine embodying the GX Engine Trademark was purchased to be used as a model during the design of Opposers’ Knock-Off Products may *not* reference the GX Engine Trademark expressly, but are nonetheless highly relevant to the issues of secondary meaning and genericness. Similarly, documents relating to the purchase of engines embodying the GX Engine Trademark for testing and analysis bear on the functionality of the claimed elements of the GX Engine Trademark, even if they do not expressly reference the GX Engine Trademark.

Accordingly, Honda respectfully requests that the Board compel Opposers to produce documents concerning their purchases of Honda engines embodying the GX Engine Trademark as requested in the Proposed Order.

**B. The Board Should Compel the Production of Documents Concerning Differences or Similarities Between Opposers' Knock-Off Products and Honda Engines Embodying the GX Engine Trademark Because They Are Relevant to Secondary Meaning, Functionality, and Genericness [RFP Nos. 31 (Briggs) & 46 (Kohler)]**

Documents concerning the differences or similarities, whether they be physical or technical, between Opposers' Knock-Off Products and Honda engines embodying the GX Engine Trademark are relevant to the issues of distinctiveness, functionality and genericness. The extent to which "substantial differences" (*see* Dkt. No. 1 (Briggs' Notice of Opposition) in Opposition No. 91200832) in appearance between Honda engines embodying the GX Engine Trademark and Opposers' Knock-Off Products can or cannot be shown bears on the distinctiveness of Honda's mark. Moreover, any such "substantial differences" in the appearance of design elements Honda claims as part of its trade dress are evidence of the nonfunctionality of those designs. *In re 3M Co.*, 2012 TTAB LEXIS 154, at \*6-7 (T.T.A.B. May 10, 2012) (holding that one factor in determining functionality is "facts pertaining to the availability of alternative designs").

In addition, to the extent Opposers contend there are differences between the appearance of their Knock-Off Products and the GX Engine Trademark, these alleged differences are highly relevant to Opposers' claim that Honda's proposed mark is generic. In other proceedings, the Board has compelled discovery on opposer's products that use the mark at issue. *See, e.g., Frito-Lay N. Am., Inc. v. Princeton Vanguard LLC*, 100 U.S.P.Q.2d (BNA) 1904, 1910 (T.T.A.B.

2011) (ordering production of documents concerning “assessing, evaluating or considering any methods of describing” Opposers’ allegedly similar products in a trademark case).

Moreover, Opposers have made the similarities and differences between their Knock-Off Products and the GX Engine Trademark a subject of discovery by asking Mr. Conner numerous questions on the topic during his deposition. *See, e.g.*, Decl. of Frazier, Ex. HH (Excerpts of Mr. Conner’s August 9, 2012, 106:17-118:22. Nonetheless, despite the clear relevance of the requested documents, Opposers only agreed to produce a very narrow subset of responsive documents, namely “any remaining images of their products *they will rely* on as evidence of third party use, as well as correspondence between the parties in which Opposers have noted the differences between its [*sic*] horizontal shaft engine products and the Honda GX Engine.” Decl. of Frazier, Ex. CC at 4 (emphasis added). Clearly, numerous categories of relevant documents responsive to Honda’s requests would fall outside this limited scope, including non-privileged internal documents and communications with current or prospective customers discussing the differences or similarities between Opposers’ Knock-Off Products and Honda engines embodying the GX Engine Trademark. Opposers’ agreement to produce the documents “they will rely on” is insufficient to fulfill their obligations and counter to the purpose of the discovery process, which also is intended to disclose documents of Opposers that only Honda may wish to rely upon. *Id.*

Opposers have refused to produce requested documents regarding similarities and differences between their products and Honda’s on the grounds that “Honda has defined ‘Opposers’ Products’ to include every horizontal shaft engine ever sold by Opposers” and that for both Opposers “there are at least 21 such engines.” Decl. of Frazier, Ex. CC at 1. This is inaccurate. Honda narrowly defined “Opposer’s Products” as “any engine in Opposer’s 550

Series of engines manufactured and sold by Opposer and any other engine manufactured or sold by Opposer *having a design substantially similar to Applicant's Mark.*" See Decl. of Frazier, Ex. E.1 at 1; Ex. E.2 at 4; Ex. F.1 at 1; Ex. F.2 at 4 ("Opposer's Products' refers to any engine manufactured or sold by Opposer having a design substantially similar to Applicant's Mark."). It was *Opposers*— not Honda— that chose to identify "Opposers Products" as *all* of their horizontal shaft engines. They cannot now use their self-serving definition in one discovery request as justification to avoid responses to others. Given the late stage in the discovery process, Honda is willing to limit its request to documents concerning the differences and similarities between only the Briggs' 550 Series engines, Kohler's SH265 engine, and any other engine models Honda identifies as infringing the GX Engine Trademark.

Accordingly, Honda respectfully requests that the Board compel Opposers to produce the requested documents concerning the differences or similarities between Opposers' Knock-Off Products and Honda engines embodying the GX Engine Trademark as requested in the Proposed Order.

**C. The Board Should Compel the Production of Documents Concerning the Design and Manufacture of Opposers' Knock-Off Products Because They Are Relevant to the Issues In This Proceeding, and Opposers Have Not Provided a Valid Justification For Their Refusal to Provide These Documents [RFP Nos. 9, 18 and 21 (Briggs) & 24, 33 and 36 (Kohler)]**

Documents concerning the selection, adoption and use of any aspect of the GX Engine Trademark by Opposers in their Knock-Off Products are relevant to the issues of secondary meaning, functionality and genericness. Copying a mark is a factor to be considered in determining whether it has secondary meaning. *Coach Servs.*, 668 F.3d at 1379. Documents concerning the design of Opposers' Knock-Off Products may demonstrate that they selected their designs in order to trade off the recognition and goodwill of the GX Engine Trademark, thus

confirming the acquired distinctiveness of that mark. These documents may show what, if any, alternative designs were considered and the rationale for incorporating the various design elements of Opposers' Knock-Off Products. In addition, documents concerning the manufacture of Opposers' Knock-Off Products are relevant to the availability of designs that provide the same performance and functionality as the GX Engines, and/or that cost the same (or less) to manufacture. As set forth above, the Board has found information concerning an opposer's use of the claimed trademark to be relevant to an opposition proceeding.

As these requests are limited to the claimed aspects of the trade dress at issue and Opposers' Knock-Off Products (currently one for each Opposer), these requests are narrowly tailored and do not pose an undue burden. Accordingly, the Board should compel the production of these documents as requested in the Proposed Order.

**D. The Board Should Compel the Production of Documents Concerning the Marketing and Advertisement of Opposers' Knock-Off Products Because They are Relevant to Secondary Meaning and Functionality [RFP Nos. 13 and 20 (Briggs) & 28 and 35 (Kohler)]**

Advertisements and marketing materials of Opposers' Knock-Off Products, as well as documents showing the motivation and strategy behind advertisement decisions, are relevant to secondary meaning. To the extent that advertisements promote other features of Opposers' Knock-Off Products as bearing on performance and quality, they are relevant to the issue of functionality because they tend to show that the features Honda claims as part of its trade dress are not functional. However, once again, in refusing to produce these requested documents, Opposers merely provide general boilerplate objections, namely that these requests are overbroad, unduly burdensome, and more properly served in an infringement lawsuit. Decl. of Frazier, Ex. CC at 4. Opposers unilaterally decided to produce *representative* samples of

advertising materials for their horizontal shaft engines thereby limiting Honda's ability to review other advertisements of Opposers products. *Id.* Kohler's "representative" advertising sample consists of only a single image of the SH265 engine that Honda alleges infringes the GX Engine Trademark.

While the Board has discretion to limit the production of documents to representative samples in instances where compliance with a request would be unduly burdensome (*see* TBMP 402.02), a party cannot unilaterally decide it will produce "representative documents" (as Opposers have in this matter). Because the requested documents concern a small subset of Opposers' products (currently one for each Opposer) that have been on the market for only a few years, Opposers' selective determination of which advertisements or marketing materials they wish to produce is improper here. *See e.g., EnFleur Corp. v. Microsoft Corp.*, 1998 TTAB LEXIS 275, at \*5-6 (T.T.A.B. Apr. 21, 1998) (granting respondent's motion to compel and holding that a representative sample was inadequate because "[p]etitioner ha[d] not shown that it would be burdensome to provide all documents.").

Ironically, while objecting that these requests are overly broad and unduly burdensome, Opposers requested that Honda produce *all* documents pertaining to the advertising of products containing the GX Engine Trademark. *See* Decl. of Frazier, Ex. C (Briggs' First Set of Requests for Production to Honda) at No. 11. Notwithstanding the fact that the GX engines have been sold since 1983, decades longer than Opposers Knock-Off Products, Honda complied with this request. Opposers then demanded that Honda *reproduce* all of its advertising materials in color even though *color is not an element of the trademark* at issue. *See* U.S. Trademark Application Serial No. 78/924,545. Given the large volume and age of some of the documents, Honda requested that Opposers identify specifically which they wanted in color. Decl. of Frazier, ¶ 53,

Ex. AA. Rather than make any effort to narrow the request, Opposers instead provided Honda the list of Bates ranges associated with *all* of Honda's responsive marketing materials and advertisements and requested they *all* be reproduced in color. Decl. of Frazier, ¶ 62, Ex. FF. Honda complied with this request to the extent color versions were reasonably available.

Requesting that Honda incur the cost and burden associated with *reproducing* decades worth of advertising materials in color, while selectively producing samples from three recent years of marketing materials, is yet another example of Opposers' efforts to treat the discovery process as a one-way street.

Accordingly, Honda respectfully requests that the Board compel Opposers to produce all advertisement and marketing materials pertaining to Opposers' Knock-Off Products as requested in the Proposed Order.

**E. The Board Should Compel the Production of Business Plans Concerning the Use, Manufacture, Sale or Offering For Sale of Opposers' Knock-Off Products Because They are Relevant to Secondary Meaning, Functionality and Genericness, and Opposers Have Failed to Provide a Single Valid Objection for Their Refusal To Do So [RFP Nos. 12 and 22 (Briggs) & 27 and 37 (Kohler)]**

Business plans regarding Opposers' Knock-Off Products are relevant to the issues of secondary meaning, genericness, and functionality. To the extent Opposers' business plans concerning their Knock-Off Products show a desire to make their engines look more like the GX Engine Trademark in order to better compete, they are relevant to secondary meaning and genericness. To the extent these documents show technical justifications for changing any claimed feature of the GX Engine Trademark, they are relevant to functionality.

In the interest of compromise, during the May 25, 2012 meet and confer, Honda agreed to narrow the requested information to business plans regarding Opposers' Knock-Off Products that discuss: (1) "Applicant's Mark" and (2) any claimed element of that mark. Decl. of Frazier, ¶ 51, Ex. Z at 2. Notwithstanding Honda's proposed compromise, Opposers once again refused to produce the requested information.

Opposers' sole reason for refusing to provide business plans concerning Opposers' Knock-Off Products that discuss the GX Engine Trademark is that "such business plans are likely to contain a large amount of irrelevant information" because Briggs purchases Honda GX engines which are part of Honda's definition of "Applicant's Mark." Decl. of Frazier, ¶ 56, Ex. CC at 2. As an initial matter, this objection is misplaced since Honda's definition of "Applicant's Mark" makes clear that it "refers to the *design* of the Applicant's GX engine that is the subject of United States trademark application Serial No. 78/924545" and *not* any aspect of the GX engines. *See, e.g.*, Decl. of Frazier, Ex. E.1 at 1; Ex. E.2 at 4. Moreover, the mere fact that the requested documents *may* contain additional information not relevant to this proceeding is insufficient to justify their non-production, if they also contain information that *is* relevant to the issues in dispute. *See* Fed. R. Civ. P. 26(b) ("Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense.").

Opposers' refusal to provide business plans concerning Opposers' Knock-Off Products that discuss any claimed element of the trade dress at issue centers on their contention that the claimed elements are standard due to their functional benefits, and that information responsive to this request will include practically every business plan related to these products in Opposers' possession because of the widespread use of these elements by Opposers. Decl. of Frazier, ¶ 56, Ex. CC at 2. These are not valid objections. First, this request is narrowly tailored to include

only the small subset of products (currently one for each Opposer) that have a design substantially similar to the GX Engine Trademark, and therefore would not be unduly burdensome. Second, Opposers' stated reason for refusing to produce relevant documents is circular—it improperly assumes the very thing they are required to show, namely that the claimed elements are functional.

In sum, Opposers' objections are meritless and the Board should compel the production of the requested business plans as requested in the Proposed Order.

**F. The Board Should Compel the Production of Correspondence Between Briggs and Its Advertising Agencies Referring or Relating to the GX Engine Trademark Because They are Relevant to Secondary Meaning [RFP No. 36 (Briggs)]**

Correspondence between Briggs and its advertising agencies referring or relating to the GX Engine Trademark is highly relevant to secondary meaning because such communications may evidence Briggs' desire to trade off of the goodwill associated with the GX Engine Trademark by emphasizing similar design elements in Briggs' own advertising. In its response to this request, Briggs stated it would “produce responsive nonprivileged communications between [Briggs] and its advertising agencies, if any, *regarding Applicant's claim that its alleged mark has acquired distinctiveness and is not functional.*” Decl. of Frazier, Ex. G at No. 36. Redefining the request in this manner excludes from its scope numerous types of documents that would be relevant to this proceeding.

During the May 25, 2012 meet and confer, counsel for Honda explained its position and requested that Briggs investigate whether it had any responsive documents. In its formal response on the issue however, Briggs' counsel replied that “Briggs has no documents in its possession *that it agreed to produce.*” Decl. of Frazier, ¶ 56, Ex. CC at 4. Honda is not seeking

the narrow subset of documents Briggs “agreed to produce”; rather it is seeking the documents that Honda originally requested.

Accordingly, Honda requests that the Board compel Briggs to produce any correspondence between Briggs and its advertising agencies that refers or relates to the GX Engine Trademark as requested in the Proposed Order.

**G. Opposers’ Failure to Produce Substantive Documents Is Highly Prejudicial to Honda**

Opposers’ refusal to provide substantive documents responsive to the vast majority of Honda’s requests has precluded Honda from obtaining critical information related to Opposers’ grounds for opposition, thereby impairing Honda’s ability to prepare its case and defenses, including Honda’s ability to prepare for depositions of those individuals identified in Briggs’ and Kohler’s Initial Disclosures.

For example, Kohler has identified Cameron Litt, Kohler’s Marketing Manager, as an individual that is likely to have discoverable information concerning Kohler’s claims or defenses, and has the following categories of relevant documents in its possession, custody or control:

- a. Documents related to the functionality of Applicant’s claimed engine configuration;
- b. Documents related to the lack of inherent or acquired distinctiveness of Applicant’s claimed engine configuration, including but not limited to evidence of use of similar designs by third parties.

Decl. of Frazier, Ex. I (Kohler’s Initial Disclosures).

However, Honda has yet to receive a *single* document relating to functionality and has received only *one* substantive document relating to secondary meaning, namely a financial document concerning Kohler's products.

Similarly, Briggs has identified Pete Hotz, Ron Weber and Mike Miller as individuals that are likely to have discoverable information concerning Briggs' claims or defenses and has identified the following categories of documents in its possession, custody or control:

- a. Documents related to the functionality of Applicant's claimed engine configuration;
- b. Documents related to the lack of inherent or acquired distinctiveness of Applicant's claimed engine configuration, including but not limited to evidence of use of similar designs by third parties.

Decl. of Frazier, Ex. D (Briggs' Initial Disclosures).

However, as with Kohler, Briggs has not produced a *single* document related to functionality and has produced only *two* documents relevant to secondary meaning, namely *one* market study and *incomplete* financials.<sup>5</sup>

Honda is unable to proceed with the depositions of Opposers' witnesses until it receives the substantive documents relating to functionality and secondary meaning requested by Honda more than *eight* months ago. Opposers' inexcusable failure to provide the requested discovery, in spite of numerous requests and proposals of compromise from Honda, has severely prejudiced Honda in preparing its case and defenses in this proceeding.

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<sup>5</sup> Honda originally raised the deficiencies with the financials produced by Briggs' more than *four* months ago. See Decl. of Frazier, Ex. K at 3. To date, Honda has not received complete financial information for the engines identified in Briggs' response to Honda's First Set of Interrogatories, No. 4. See Decl. of Frazier, Ex. Z at 3-4.

#### IV. CONCLUSION

For the reasons stated above, Honda respectfully requests that the Board enter an Order requiring Briggs and Kohler to produce documents responsive to Requests for Production Nos. 9, 12, 13, 18, 20, 21, 22, 28, 31 and 36 (Briggs) and 24, 27, 28, 33, 35, 36, 37, and 43 (Kohler) within ten (10) days of its Order and grant Honda any such further relief as is just.

HONDA GIKEN KOGYO KABUSHIKI KAISHA  
(HONDA MOTOR CO., LTD.)

By its attorneys,

  
\_\_\_\_\_  
Vinita Ferrera  
John Regan  
Silena Paik  
Sarah Frazier  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, Massachusetts 02109  
(617) 526-6000

Date: August 21, 2012

CERTIFICATION PURSUANT TO 37 CFR § 2.120(e)

I, Sarah R. Frazier, counsel for Applicant, hereby certify that pursuant to 37 CFR § 2.120(e), I made a good faith effort through conference and correspondence to resolve the issues raised by this Motion but that the parties have been unable to agree on a resolution.

August 21, 2012

  
\_\_\_\_\_  
Sarah R. Frazier

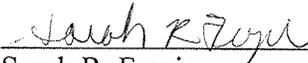
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Applicant Honda Giken Kogyo Kabushiki Kaisha's Motion to Compel Production of Documents From Opposers Briggs & Stratton Corporation and Kohler Co. was served by first class mail, postage prepaid, this 21<sup>st</sup> day of August, 2012 upon:

Donald Daugherty  
Whyte Hirschboeck Dudek S.C.  
555 E. Wells Street, Suite 1900  
Milwaukee, Wisconsin 53202

And

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

  
\_\_\_\_\_  
Sarah R. Frazier



Trademark. True and correct copies of these letters are attached hereto as **Exhibit A** and **Exhibit B**, respectively.

3. On October 25, 2011, Briggs served its First Set of Requests for Production to Honda. A true and correct copy of these requests is attached as **Exhibit C** hereto.

4. On October 25, 2011, Briggs served its Initial Disclosures on Honda. A true and correct copy is attached as **Exhibit D** hereto.

5. On October 28, 2011, Honda served its First Set of Requests for Production to Briggs, which incorporates by reference the definitions set forth in Honda's First Set of Interrogatories to Briggs. A true and correct copy of these requests and definitions are attached as **Exhibit E.1** and **Exhibit E.2** hereto.

6. On December 13, 2011, Honda served its First Set of Requests for Production to Kohler, which incorporates by reference the definitions set forth in Honda's First Set of Interrogatories to Kohler. A true and correct copy of these requests and definitions are attached as **Exhibit F.1** and **Exhibit F.2** hereto.

7. On January 3, 2012, Briggs served its responses to Honda's First Set of Requests for Production. A true and correct copy of these responses is attached as **Exhibit G** hereto.

8. On January 31, 2012, Kohler served its responses to Honda's First Set of Requests for Production. A true and correct copy of these responses is attached as **Exhibit H** hereto.

9. On January 31, 2012, Kohler served its Initial Disclosures on Honda. A true and correct copy is attached as **Exhibit I** hereto.

10. On February 28, 2012, Briggs and Kohler each requested an index of Honda's document production. True and correct copies of these emails are attached hereto at page 14 of **Exhibit J**.

11. On March 12, 2012, Briggs requested that Honda provide Bates ranges for dozens of documents. A true and correct copy of this email is attached hereto at pages 13-14 of **Exhibit J**.

12. On March 13, 2012, Honda informed Briggs that the documents for which Briggs was seeking Bates ranges were forthcoming. A true and correct copy of this email is attached hereto at page 13 of **Exhibit J**.

13. Later that same day, on March 13, 2012, Briggs requested information regarding what additional documents would be forthcoming, and that the specific documents requested in Briggs' March 12, 2012 email be identified by Bates number when produced. A true and correct copy of this email is attached hereto at pages 12-13 of **Exhibit J**. Briggs had not produced any documents in this proceeding as of the date of this email.

14. Later that same day on March 13, 2012, Briggs renewed a request that Honda identify dozens of documents by Bates number when produced, inquired as to when additional documents would be produced, requested the contact information of third parties whose consent Honda was seeking in order to produce confidential documents, and requested likelihood of confusion documents from a prior case.<sup>1</sup> A true and correct copy of this email is attached hereto at pages 11-12 of **Exhibit J**.

15. On March 22, 2010, Briggs made its first production of documents in this proceeding. This production consisted of 111 pages, many of which are publicly-available web pages.

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<sup>1</sup> Likelihood of confusion is not an issue in these proceedings.

16. On March 28, 2012, Honda sent Briggs and Kohler letters identifying numerous deficiencies in Opposers' discovery responses and productions. True and correct copies of these letters are attached hereto as **Exhibit K** and **Exhibit L**, respectively.

17. On April 4, 2012, in response to a production made that day by Honda, Briggs requested that Honda identify specifically the requests the documents were responsive to and identify multiple documents by Bates number. A true and correct copy of this email is attached hereto at page 10 of **Exhibit J**.

18. On April 5, 2012, Kohler stated that a response to Honda's March 28, 2012 letter regarding deficiencies in Kohler's discovery responses would "be forthcoming by the end of next week." A response was not received until April 30, 2012, two weeks after the promised date. A true and correct copy of this email is attached hereto at pages 1-2 of **Exhibit M**.

19. On April 10, 2012, Honda asked Briggs to "please advise when [Honda] can expect a response to the letter from [Honda's counsel] to [Briggs' counsel] dated March 28th." A true and correct copy of this email is attached hereto at page 9 of **Exhibit J**.

20. On April 10, 2012, Briggs requested that Honda reproduce in color certain documents previously produced in black and white.<sup>2</sup> A true and correct copy of this email is attached hereto at page 2 of **Exhibit N**.

21. On April 17, 2012, Briggs sent numerous discovery-related requests and inquiries to Honda including further requests for the identification of specific documents by Bates number, the reproduction of previously-produced documents in color, for alterations to the confidentiality

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<sup>2</sup> Color is not part of the trademark at issue in these proceedings.

designations of certain produced documents, and likelihood of confusion documents from a prior case. A true and correct copy of this email is attached hereto at pages 6-8 of **Exhibit J**.

22. On April 17, 2012, Briggs asked Honda to identify what documents were produced that day by Honda. A true and correct copy of this email is attached hereto at page 1 of **Exhibit O**.

23. On April 18, 2012, Honda responded to numerous discovery-related requests from Opposers, stated that Honda was still awaiting a response to its March 28, 2012 letter, suggested a call to discuss the outstanding issues associated with Briggs' deficient responses to Honda's discovery requests, and requested an update on the status of a supplemental production. A true and correct copy of this email is attached hereto at pages 2-3 of **Exhibit P**.

24. On April 18, 2012, having received a response from Honda to multiple prior inquiries by Briggs, Briggs sent three more emails to Honda with various discovery-related inquiries. True and correct copies of these emails are attached hereto at pages 1-2 of **Exhibit P**.

25. On April 18, 2012, Honda responded to Kohler's April 5, 2012 email and requested a response to Honda's March 28, 2012 letter concerning deficiencies in Kohler's discovery responses. Later that same day, Kohler responded that its "response will be forthcoming (along with the documents responsive to Honda's requests) next week." A true and correct copy of these emails is attached hereto at page 1 of **Exhibit M**. Honda did not receive a response to its letter by the following week as promised.

26. On April 20, 2012, Briggs responded *in part* to Honda's March 28, 2012 letter regarding deficiencies in Briggs' responses to Honda's discovery requests and document production. A true and correct copy of this letter is attached hereto as **Exhibit Q**.

27. On April 25, 2012, Briggs requested that Honda change the confidentiality designation of excerpts of a previously-produced document and refused to meet and confer regarding likelihood of confusion documents from a prior case. A true and correct copy of this email is attached hereto at pages 3-4 of **Exhibit J**.

28. On April 26, 2012, Honda responded to Briggs' request to immediately produce likelihood of confusion documents from a prior case, requested a response to the numerous outstanding issues raised in Honda's March 28, 2012 letter to Briggs, and requested that the parties conduct a meaningful meet and confer to resolve outstanding issues. A true and correct copy of this email is attached hereto at pages 2-3 of **Exhibit J**.

29. On April 27, 2012, Briggs emailed Honda regarding Opposers' numerous discovery requests. With regard to the likelihood of confusion documents from a prior case, the relevance of which Honda disputes, Briggs threatened to file a motion to compel if it was not produced that day. A true and correct copy of this email is attached hereto at page 2 of **Exhibit J**.

30. In response, later that same day on April 27, 2012, Honda renewed its request for a meet and confer to discuss outstanding discovery issues. Honda stated that Opposers "persistent requests and demand for immediate action by Honda [were] unreasonable in light of [Opposers'] extremely delayed response to [Honda's] numerous concerns which [Honda] identified on March 28th-- nearly one month ago." A true and correct copy of this email is attached hereto at page 1 of **Exhibit J**.

31. On April 30, 2012, Kohler responded on behalf of both Opposers to Honda's March 28, 2012 letters regarding deficiencies in Opposers' discovery responses and document productions. A true and correct copy of this letter is attached hereto as **Exhibit R**.

32. On May 3, 2012, Briggs asked when documents responsive to two specific requests would be produced. A true and correct copy of this email is attached hereto at page 2 of **Exhibit S**.

33. On May 4, 2012, Kohler made its first production of documents in this proceeding. This production consisted of 117 pages, 44 pages of which are publicly-available web pages, and 33 of which are correspondence between Honda and Kohler already in Honda's possession.

34. On May 7, 2012, Kohler produced one additional page of documents.

35. On May 7, 2012, Briggs renewed its request that Honda change the confidentiality designation of excerpts of a previously produced document. Briggs also requested information on the confidentiality designation of a likelihood of confusion document from a prior case. A true and correct copy of this email is attached hereto at page 7 of **Exhibit T**.

36. Later that day, on May 7, 2012, Honda responded to Briggs numerous requests and requested that Opposers provide Honda with a date certain by which Honda could expect to receive supplemental productions and discovery responses. True and correct copies of these emails are attached hereto at pages 6-7 of **Exhibit T** and page 1 of **Exhibit U**.

37. On May 9, 2012, Briggs acknowledged that Honda was juggling multiple requests from Opposers, but demanded a response to the inquiry regarding the confidentiality designation of a likelihood of confusion document from a prior case. Briggs indicated that unless Honda responded by the close of business that day, Briggs would assume the document could be produced and would obtain it from Honda's opposing counsel in the prior litigation. A true and correct copy of this email is attached hereto at page 5 of **Exhibit T**.

38. Later on May 9, 2012, Briggs provided a redacted version of excerpts of a previously produced document designated “Attorneys Eyes Only” for which Briggs was seeking re-designation and indicated that if Briggs did not hear from Honda by the close of business that day, it would assume Briggs could treat the excerpts with a lower confidentiality designation. A true and correct copy of this email is attached hereto at page 5 of **Exhibit T**.

39. Honda responded that same day on May 9, 2012, stating that Honda was “working on [Opposers’] numerous requests” and that they “should never assume during the course of this opposition that Honda has consented to any request (including but not limited to the production of designated confidential materials) until Honda has provided its actual consent.” Honda stated that it would provide a response regarding the likelihood of confusion document from a prior case by “this Friday” (May 11, 2012). A true and correct copy of this email is attached hereto at pages 3-4 of **Exhibit V**.

40. In response, on May 9, 2012, Briggs stated an unwillingness to wait two days with regards to the likelihood of confusion document from a prior case. Briggs carbon copied Honda’s opposing counsel in the prior litigation and, without confirmation from Honda that the report was not designated as confidential, told her to provide Briggs with a copy. A true and correct copy of this email is attached hereto at page 3 of **Exhibit V**.

41. On May 10, 2012, Honda reiterated that Opposers “should never assume during the course of this opposition that Honda has consented to any request (including, but not limited to production of designated confidential materials) until Honda has provided its actually consent.” A true and correct copy of this email is attached hereto at page 4 of **Exhibit T**.

42. Later that same day on May 10, 2012, Briggs responded. A true and correct copy of this email is attached hereto at pages 3-4 of **Exhibit T**.

43. On May 11, 2012, Briggs served Supplemental Responses to Honda's First Set of Requests for Production. A true and correct copy of these responses is attached hereto as **Exhibit W**.

44. On May 11, 2012, Honda renewed its request for a meet and confer with regards to Briggs' deficient responses and document production to Honda's discovery requests. A true and correct copy of this email is attached hereto at page 1 of **Exhibit V**.

45. On May 14, 2012, Briggs made an inquiry regarding the contents of Honda's latest document production that had been made that morning. A true and correct copy of this email is attached hereto at page 1 of **Exhibit X**.

46. On May 14, 2012, Briggs made its second production of documents consisting of 61 pages which included a single market research document and product brochures.

47. On May 17, 2012, Honda renewed its request to meet and confer with Briggs regarding the outstanding deficiencies in its discovery responses and document productions. Honda wrote: "If we do not hear from you by Monday, May 21, 2012 with your availability for a meet and confer, you leave us no choice but to seek the Board's assistance by filing a motion to compel." A true and correct copy of this email is attached hereto at pages 2-3 of **Exhibit T**.

48. On May 17, 2012, Briggs acknowledged Honda's requests for a meet and confer for the first time. Briggs stated that if Honda answered its re-designation request of a previously

produced document, Briggs would be willing to schedule a date to meet and confer. A true and correct copy of this email is attached hereto at page 2 of **Exhibit T**.

49. On May 18, 2012, Honda requested to meet and confer with Kohler and asked when “a supplemental production as well as supplemental responses to Honda’s Requests for Production” could be expected. A true and correct copy of this email is attached hereto at page 1 of **Exhibit Y**.

50. On May 25, 2012, the parties met and conferred telephonically regarding various outstanding deficiencies in Opposers’ responses and productions to Honda’s discovery requests.

51. On June 1, 2012, Honda sent a confirming letter memorializing the telephonic meet and confer to Opposers. A true and correct copy of this letter is attached hereto as **Exhibit Z**.

52. On June 8, 2012, having received more than 85,000 pages of requested documents, Briggs requested that “Honda complete its document production at least 10 days prior” to depositions scheduled for the week of June 25, 2012 (more than two months prior to the then-scheduled close of discovery date) and that “reasonably in advance of the depositions” Honda provide “color copies of *all* of its responsive marketing materials and advertisements, including those it produced in black and white from prior litigations.” A true and correct copy of this email is attached hereto at pages 3-4 of **Exhibit AA** (emphasis added).

53. On June 11, 2012, Honda told Opposers that due to the volume and age of the requested documents, re-production of *all* responsive marketing materials in color was unduly burdensome and requested that Opposers “identify the particular advertisements” they wished to be re-produced in color. Honda also indicated that “[w]e have not heard from you in response to

[Honda's] June 1<sup>st</sup> letter regarding the numerous outstanding issues with Briggs' production. Please respond by this Wednesday, June 13<sup>th</sup> or Honda will be forced to proceed with a motion to compel regarding these issues. Please also note that your failure to address these issues in a timely manner is delaying our ability to identify witnesses and move forward with fact discovery." A true and correct copy of this email is attached hereto at pages 2-3 of **Exhibit AA**.

54. On June 11, 2012, Briggs indicated that Opposers' would provide Bates numbers for the marketing materials and advertisements previously produced by Honda that Opposers requested be *reproduced* in color. A true and correct copy of this email is attached hereto at page 2 of **Exhibit AA**.

55. On June 15, 2012, Briggs asked Honda to identify what documents were produced by Honda that day. A true and correct copy of this email is attached hereto at page 1 of **Exhibit BB**.

56. On June 15, 2012, Opposers responded to Honda's June 1, 2012 confirming letter regarding the meet and confer. A true and correct copy of this letter is attached hereto as **Exhibit CC**.

57. On June 19, 2012, Briggs made another inquiry regarding the contents of Honda's production. A true and correct copy of this email is attached hereto at page 1 of **Exhibit DD**.

58. On June 25, 2012, Briggs served its Second Supplemental Responses to Honda's First Set of Requests for Production. A true and correct copy of these responses is attached hereto as **Exhibit EE**.

59. On June 26, 2012, Kohler produced one additional document page.

60. On June 28, 2012, Kohler made its fourth production of documents consisting of 36 pages. This production included only one advertisement depicting the Kohler SH265 engine that Honda alleges infringes the trade dress at issue in this proceeding.

61. On July 2, 2012, Briggs made its third production of documents consisting of 36 pages of engine photographs and advertisements.

62. On July 18, 2012, Kohler renewed Opposers' request for "color copies of *all* of Honda's responsive marketing materials and advertisements," and provided a corresponding list of Bates ranges of over 150 documents. A true and correct copy of this email and its attachment are attached hereto as **Exhibit FF** (emphasis added).

63. On July 26, 2012, Honda emailed Opposers stating that "[b]ased on our numerous exchanges and discussion over the past four months, it appears we have reached an impasse with regards to a number of Honda's requests for production. We assume Opposers continue to stand by their objections and positions set forth in [Opposers'] June 15<sup>th</sup> letter to [Honda] and do not agree to produce the documents as requested by Honda in [Honda's] June 1<sup>st</sup> letter. Unless we hear differently by Monday, July 30<sup>th</sup>, Honda intends to file a motion to compel . . . ." A true and correct copy of this email is attached hereto on page 1 of **Exhibit GG**.

64. On August 9 and 10, 2012, Opposers deposed Honda Vice President, Scott Conner. A true and correct copy of excerpts of the rough transcript of this deposition are attached hereto as **Exhibit HH**.

65. To date, Honda has not received a response to its July 26, 2012 email.

66. Honda made its first document production on January 9, 2012 and has continued to produce documents on a rolling basis, totaling nearly 100,000 pages to date.

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

Date: August 21, 2012

  
\_\_\_\_\_  
Sarah R. Frazier (BBO No. 681656)

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	)	
KAISHA,	)	Application Serial No. 78924545
	)	
Applicant.	)	
	)	
	)	
	)	
	)	
	)	
	)	
	)	
	)	
	)	

**[PROPOSED] ORDER GRANTING APPLICANT HONDA GIKEN KOGYO  
KABUSHIKI KAISHA’S MOTION TO COMPEL PRODUCTION OF DOCUMENTS  
FROM OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.**

WHEREFORE, having considered the submissions, arguments, facts and circumstances of the parties presented to the Trademark Trial and Appeal Board , it is hereby ORDERED that Applicant Honda Giken Kogyo Kabushiki Kaisha’s Motion to Compel Production of Documents is GRANTED.

Opposers Briggs & Stratton Corporation and Kohler Co. (“Opposers”) are hereby ORDERED to produce to Applicant Honda Giken Kogyo Kabushiki Kaisha within ten (10) days of this Order:

1. Documents concerning Opposers' purchase of Honda engines embodying the GX Engine Trademark but excluding documents concerning purchases that occurred during the regular course of Opposers' business for incorporation into Opposers' products [Request for Production Nos. 28 (Briggs) and 43 (Kohler)];
2. Documents concerning differences or similarities between the Briggs & Stratton 550 Series engines or the Kohler SH265 engine and Honda engines embodying the GX Engine Trademark, including but not limited to internal documents and communications with customers discussing the differences or similarities and any testing documents regarding the differences or similarities [Request for Production Nos. 31 (Briggs) and 46 (Kohler)];
3. Documents concerning the design and manufacture of the Briggs & Stratton 550 Series engines and the Kohler SH265 engine, including but not limited to all documents concerning alternative external designs considered, all documents regarding the selection of any feature of the GX Engine Trademark, and all documents pertaining to any redesign of the external appearance of those engines [Request for Production Nos. 9, 18 and 21 (Briggs) & 24, 33 and 36 (Kohler)];
4. All marketing materials and advertisements concerning Briggs & Stratton 550 Series engines and the Kohler SH265 engine created or published since the engines were first marketed for sale in the United States [Request for Production Nos. 13 and 20 (Briggs) & 28 and 35 (Kohler)];
5. All business plans concerning the use, sale or offering for sale of the Briggs & Stratton 550 Series engines and the Kohler SH265 engine that discuss the GX Engine Trademark or any element of the GX Engine Trademark [Request for Production Nos. 12 and 22 (Briggs) & 27 and 37 (Kohler)]; and
6. All correspondence between Briggs and its advertising agencies referring or relating to the GX Engine Trademark [Request for Production No. 36 (Briggs)].

IT IS SO ORDERED

Dated: \_\_\_\_\_

\_\_\_\_\_

By the Trademark Trial and Appeal Board

**EXHIBITS A THROUGH HH  
REDACTED**