

ESTTA Tracking number: **ESTTA714280**

Filing date: **12/11/2015**

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

Proceeding	91200832
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Attachments	Opposers Briggs & Stratton Corporation's and Kohler Co.'s Trial Brief (REDACTED PUBLIC VERSION).pdf(2095307 bytes)

**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 TRIAL BRIEF**

Respectfully submitted on December 11, 2015,

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I. PRELIMINARY STATEMENT

In the early 1980s Honda designed its GX engine, a new general purpose utility engine. General purpose utility engines typically are sold to Original Equipment Manufacturers (OEMs) or distributors for installation in various types of equipment. General purpose utility engines must be compact, lightweight, adaptable to a wide variety of applications and easy to maintain. Honda shaped and configured its engine to accomplish these technical requirements as well as to provide a durable, fuel efficient engine. Now, over 30 years later, Honda seeks federal trademark protection for this functional design.

Briggs & Stratton and Kohler (“Opposers”) are competitors in the general utility engine market and oppose Honda’s application.¹ Honda’s functional applied-for mark has become the standard in the industry. Numerous competitor engines share the applied-for mark’s shape and configuration, reflecting its essential functionality and rebutting any secondary meaning as a source identifier for Honda. Honda’s own history of the development and patenting of the GX design and its own witnesses, including Messrs. Fujita, Conner and Meiritz, support Opposers’ position. For the reasons more fully set forth below, Opposers respectfully request the Board to reject Honda’s registration.

II. STATEMENT OF THE ISSUES

1. Whether the applied-for mark is a functional product configuration of an engine.
2. Whether the applied-for mark has been abandoned.
3. Whether the applied-for mark is generic.
4. If the applied-for mark is not functional, generic and has not been abandoned, whether the applied-for mark has obtained secondary meaning.

III. EVIDENTIARY OBJECTIONS TO HONDA’S EVIDENCE

Opposer objects to certain testimony offered by Honda’s expert witness on functionality, James Mieritz, on the grounds that such testimony lacks foundation, is unreliable

¹ Opposers have standing to oppose Honda’s trademark application because, as direct competitors of Honda who use similar product configurations in the small engine industry, Opposers have a real interest in this proceeding and will suffer damage if the applied-for mark is registered. *See Richie v. Simpson*, 170 F.3d 1092, 1095, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999)(“Section 13 of the Lanham Act establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 U.S.P.Q.2d 1912, *5 (T.T.A.B. 2011).

and is irrelevant. Opposer further objects to Honda's attempt to introduce documents relating to prior, unrelated litigation. The reasons for Opposers' objections are set forth in Appendix 1.

IV. SUMMARY OF THE RECORD

A. EVIDENCE SUBMITTED BY OPPOSERS

1. Trial Testimony

- a. Prof. J. Reisel, Opposers' expert on the issue of functionality (dkt. 164/165).
- b. J. Whitmore, senior engineer at Briggs and Stratton (dkt. 166/169).
- c. C. Litt, marketing manager at Kohler Corp. (dkt. 162/163).
- d. H. Poret, Opposers' survey expert on the issue of secondary meaning (dkt. 199).

2. Declarations of Third-Party Engine Manufacturers regarding use of engine configuration (via stipulation) (dkt. 130/131, Exs. HH-KK).

3. Honda's U.S. patents and Japanese utility models - Opposers' Sixth Notice of Reliance (O6NOR) – Exs. M-GG (dkt. 127/128).

4. Honda responses filed in prosecution for '385 Patent - Opposers' Twelfth Notice of Reliance (012NOR) Exs. SS1 – 11/13/1986 Response; SS2:6/5/1987 Response (dkt. 177).

5. Advertising of the engines at issue in this case

- a. Opposers' Second Notice of Reliance (O2NOR); Ex. G - Internet pages showing 3rd party use of similar engines; Ex. H - Internet pages regarding Honda's marketing and sale of the engine (dkt 117/118)
- b. Opposers' Thirteenth Notice of Reliance (013NOR) - TT: Internet pages regarding marketing and sale of Honda GX engines with cyclone air cleaners, which are relevant to abandonment of applied-for trademark (dkt. 180).
- c. Opposers' Fourteenth Notice of Reliance (014NOR) – Ex. UU-DDD – advertisements for engines by Honda, Opposers and other third-party manufacturers. (dkt. 178).

6. Discovery Depositions and Exhibits

- a. Conner, S. (Honda's Rule 30(b)(6) designee on secondary meaning and certain abandonment and functionality issues) - Opposers' Tenth Notice of Reliance (10NOR) – Ex. QQ-QQ2 (dkt. 173/174).
 - b. Fujita, M. (excerpt) (Honda's Rule 30(b)(6) designee on functionality issues) - Opposers' Fifth Notice of Reliance (05NOR) – Exs. L (p. 54 of deposition); L1 - Ex. 190 of deposition of Motohiro Fujita (dkt. 125/126).
 - c. Hoag, K. (excerpts from prior case) (Honda's expert on functionality issues) - Opposers' Second Notice of Reliance (02NOR) Ex. I; Opposers' Eighth Notice of Reliance (08NOR) – Ex. OO (dkt. 117/118 and 169/170).
 - d. Hotz, P. – Opposers' Seventh Notice of Reliance (07NOR) Ex. NN; Opposers' Ninth Notice of Reliance (09NOR) – Ex. PP-PP2 (dkt. 167/168 and 171/172).
 - e. Lally, J. - Opposers' Fourth Notice of Reliance (04NOR) - Exs. K; K1-K12-K31 (dkt. 121, 123, 159, 160).
 - f. Rumao, M. (excerpts) - Opposers' Seventh Notice of Reliance (07NOR) Exs. LL–MM (dkt. 167/168).
 - g. Sugimoto, Y. – (Honda's Rule 30(b)(6) designee on the GX engine redesign / abandonment) - Opposers' Third Notice of Reliance (03NOR) - Exs. J, J1-J9; J-114 (dkt. 122, 124, 161).
7. Honda's Discovery Responses - Opposers' First Notice of Reliance (01NOR) - Exs. A- F (dkt. 114/116)
 8. Shari Diamond Article on Proper Use of Controls in Surveys - Opposers' Eleventh Notice of Reliance (11NOR) – Ex. RR - (dkt. 176).

B. EVIDENCE SUBMITTED BY HONDA

1. Trial Testimony

- a. M. Fujita, Honda's senior engineer (dkt. 200).
- b. J. Mieritz, Honda's expert on functionality (dkt. 197).
- c. S. Conner, Honda's senior vice president of Honda's power equipment division (dkt. 189).
- d. G. Mantis, Honda's expert on the issue of secondary meaning (dkt. 185).

2. Opposers' Discovery Responses

- a. Briggs & Stratton responses - Applicant's Third Notice of Reliance – Ex. C and D (dkt. 151/152) and Applicant's Fifth Notice of Reliance – Ex. G (dkt. 148/149).
- b. Kohler responses - Applicant's Fourth Notice of Reliance – Ex. E and F (dkt. 150); Applicant's Sixth Notice of Reliance – Ex. H (dkt. 147).

3. Discovery Depositions and Exhibits

- a. Hotz, P. – Applicant's First Notice of Reliance – Ex. A, A1-A16 (deposition excerpts and exhibits) (dkt. 191/192).
- b. Rumao, M. – Applicant's Second Notice of Reliance – Ex. B, B1-B11 (deposition excerpts and exhibits) (dkt. 193/194).
- c. Fujita, M. - Applicant's Ninth Notice of Reliance – Ex. N, N1 (deposition excerpts and exhibit) (dkt. 144/145).
- d. Hoag, K. – Applicant's Tenth Notice of Reliance – Ex. O-P (report and deposition) (dkt. 195/196)

4. Community Trademark - Applicant's Seventh Notice of Reliance – Ex. I (dkt. 146/148).

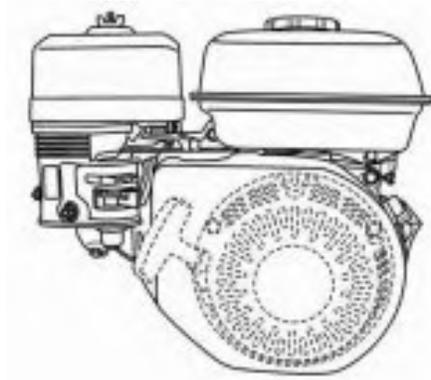
5. Orders, Instructions and Verdict in Prior, Unrelated Cases - Applicant's Eighth Notice of Reliance – Ex. J-M (dkt. 157).

6. Reference Guide on Survey Research - Applicant's Eleventh Notice of Reliance – Ex. Q, R (reference materials) (dkt. 141).

V. STATEMENT OF FACTS

A. THE APPLIED-FOR MARK

On July 7, 2006, Honda filed trademark application, U.S. Serial No. 78/924545, seeking trademark protection in the overall appearance of its GX engine product configuration:



The applied-for mark is described in the application as follows:

Color is not claimed as a feature of the mark. The mark consists of the configuration of an engine with an overall cubic design, with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located to the left of the fuel tank. The air cleaner cover features a cube shape with beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and the top of the belt-like area is aligned with a rib of the fuel tank. The carburetor cover features four ribs along its outside edge and a recessed area where control levers are located. The fuel tank is roughly rectangular. The engine features a beveling that runs around its top circumference. The broken lining in the drawing is not part of the mark and serves only to indicate position.

In addition to expressly disclaiming color, and disclaiming the recoil cover and rewind handle of the engine by displaying them in dotted lines, Honda entered the following disclaimer:

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE DESIGN MARK'S PURELY FUNCTIONAL COMPONENTS, NAMELY LEVERS, BOLTS, NUTS AND CAPS APART FROM THE MARK AS SHOWN.

During the four and a half year prosecution history of the applied-for mark, the USPTO refused registration of the applied-for mark, first for lack of distinctiveness, then on the grounds that it is functional. Honda convinced the examining attorney to withdraw the first refusal and publish the mark by submitting evidence purporting to show that the applied-for mark has acquired distinctiveness in the marketplace. (Office Action Resp. 6/11/07.) However, the Commissioner of Trademarks, in granting a Letter of Protest, held "that a clear error has been made in allowing this mark to be published" because

the engine design is functional. This finding was supported by three Honda utility patents and Honda's product materials that describe the functionality of the applied-for mark. (Admin. Resp. 7/29/08.)

The examining attorney then found that "the evidence suggested that the configuration of the engine components shown in the mark may enable the applicant's engines to fit into a more compact space and to have a lower center of gravity." (Office Action 9/2/08.) Honda responded, claiming that the refusal was unwarranted because "there is absolutely nothing in the materials that have been made of record in this application that would even suggest that the configuration at issue makes it easier for such engine to fit into a compact space or that the engine has a lower center of gravity than other comparable engines." Honda also claimed that its applied-for mark is "intentionally styled to have a 'cubic' look" and that the look has "arbitrary embellishments." Lastly, Honda argued that none of the U.S. patents cited "even remotely show the configuration which is the subject of the present application."² (Resp. 3/4/09.)

Based on Honda's arguments, the examining attorney withdrew the functionality refusal and approved the application for publication. The Commissioner once again intervened and remanded to the examining attorney, with the following determination:

In this case, the evidence suggests that the configuration of engine components shown in the mark may enable the applicant's engines to fit into a more compact space and to have a lower center of gravity. Further, the configuration enables the fuel tank and the muffler to have large capacities, and to be safely positioned very close to each other, such a large capacity muffler being better able to reduce engine exhaust noise. Because the muffler is not located under the fuel tank, that empty space can be easily accessed or used, and the lower portion of the fuel tank can be made larger, thereby allowing an increased overall capacity of the fuel tank. Moreover, the fuel tank and muffler can be simplified in their shapes, resulting in increased flexibility in designing these components. ... In sum, the applicant may not register a trademark for the entire engine design in this particular configuration, which contains several functional elements.

(Office Action 2/5/10.) Notwithstanding the above findings, Honda inexplicably overcame this refusal by amending its description of the mark to the current identification set forth above,³ and by entering the additional disclaimer for levers, bolts, nuts and caps. Notably, Honda also added this "Additional Statement:" "while there are functional portions of the design, the shape and position of such portions

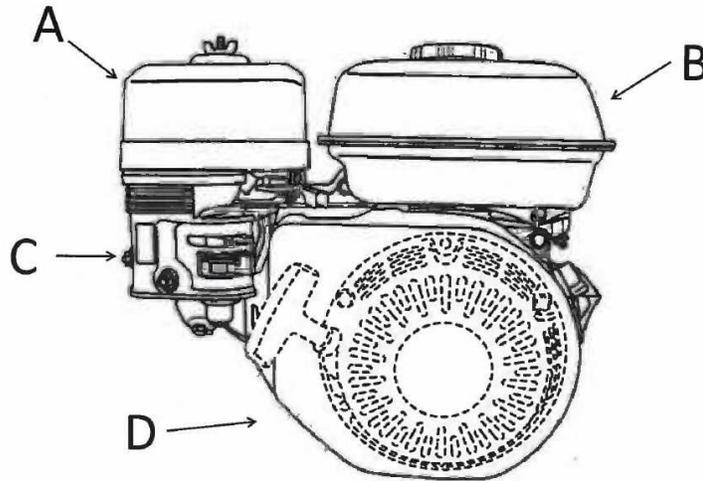
² Notably, in its response, Honda disclosed that it obtained a design patent for the configuration in the U.S., but did not disclose it had obtained utility models for the engine from the Japan Patent Office.

³ The prior description was "the mark consists of the configuration of an engine with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located above the fan cover on the left. The broken lining in the drawing is not part of the mark and serves only to indicate position."

constitute part of the design.” (Resp. 8/4/10 (emphasis added).) The application was published on January 25, 2011 (Notice of Publication 1/25/11) and Opposers subsequently brought this proceeding.

B. THE ENGINE CONFIGURATION DEPICTED IN THE APPLIED-FOR MARK

The drawing below depicts Honda’s applied-for mark with letters pointing to the four component parts that are visible from the front view of the engine configuration. The letter A points to the air cleaner cover, B points to the fuel tank, C points to the carburetor cover and D points to the fan cover. (Mieritz 141:11-142:11.)



As set forth in Sections C and E below, the general shape and relative position of the major component parts shown in the applied-for mark is now the industry standard for single cylinder horizontal shaft general purpose utility engines in the marketplace. When designing this type of engine, marketing and sales groups start by determining the horsepower needed. Engineers then determine the bore and stroke and cubic inch displacement required for that horsepower range. The engine is then designed from the inside out. Engineers first create the short block, or the power plant of the engine, then add on external components, such as the fuel tank, air cleaner, fan, and carburetor. (Mieritz 12:4-13:19; 139:3-140:20.)

The short block includes the cylinder head, crankshaft, piston, connecting rod and cap, valve train, crank case cover, lubrication system and engine governor. The crankshaft is generally located at the center of the engine. The engine cylinder is located behind the fan cover (D) and extends upward toward the left of the engine at a slant. The cylinder head, which is the hottest part of the engine, is located behind the carburetor (C). The dimensions of the short block for engines in the general purpose market are generally the same. Once the short block is developed, engineers typically then develop the fan and

ignition systems. The fan is located toward the bottom and to the center right of the engine shown in the image above with the letter D. (Mieritz 139:13-140:9, 142:12-143:6, 144:22-146:12, 211:12-23.)

The fan rotates and must be mounted to the crankshaft, which is generally at the center of the engine. The fan cover has three purposes: (1) it includes the rewind starter; (2) it serves as a safety cover for the fan and rotating screen behind it; and, crucially (3) it directs cooling air to the engine. The slant on the left side of the fan cover serves the purpose of directing cool air to the cylinder head, the hottest part of the engine. (Mieritz 34:8-36:7, 142:18-146:14, 214:3-9; Reisel 37:12-39:16; Whitmore 45:4-46:13; O2NOR I-21-24.⁴) Honda engineers chose the [REDACTED] for the slant of the GX's fan cover. (O10NOR QQ-41:14-42:12.)

The purpose of the carburetor is to take air that comes through the air cleaner and mix it with fuel from the fuel tank to create a combustible mixture. Spark-induced combustion of this mixture pushes down the piston inside of the cylinder, producing a revolution and powering the engine. The carburetor and carburetor cover are placed near the intake valve on the cylinder head as shown in the image above with the letter C. This location is ideal as it allows for better flow of fuel into the carburetor via gravity. The carburetor cover has three purposes: (1) it acts as an air cleaner base; (2) it includes an elbow used to connect the clean air to the carburetor; and (3) the cover incorporates a choke lever and fuel shut-off lever which control functions of the carburetor itself. The choke lever and fuel shut-off lever are located in a recessed area where they are less likely to be damaged. (Mieritz 58:10-18, 146:15-151:10, 215:9-12; Reisel 51:8-52:21; Whitmore 14:1-16:2; O2NOR I-25-26, 44-45.)

The purpose of the air cleaner depicted above with the letter A, is to provide clean air to enter the intake valve and mix with the fuel in the carburetor. It also removes particulates from the air which could inhibit performance of the engine. The placement of the air cleaner above the carburetor allows the air cleaner to provide clean air to the carburetor. Moving the air cleaner further away from the carburetor would require additional materials and expense. Placing the air cleaner at the top of the engine also allows for easy maintenance of the engine. The purpose of the air cleaner cover is to protect the air cleaner

⁴ Appendix 2 to Opposers' Trial Brief contains an index identifying the witness through which each trial exhibit was introduced.

element. (Mieritz 46:13-14, 151:11-154:8, 215:16-22; Reisel 44:5-48:13; Whitmore 35:2-36:7; 37:21-38:2; O2NOR I-27-28, 41-44.)

The purpose of the fuel tank, identified by the letter B, is to hold fuel. The fuel tank must be located above the carburetor as these are gravity fed engines. If the fuel tank is not located above the carburetor, a fuel pump would have to be added. The fuel tank is located on the right side of the engine as the left side is already occupied by the air cleaner and carburetor, and it maintains the engine's compact shape. (Mieritz 19:23-24; 21:13-17; 154:20-155:4; Reisel 40:2-43:9; O10NOR QQ-31:10-21; Whitmore 42:22-43:20; O2NOR I-29-31, 32-34.) The fuel tank is also located on the top of the engine to make it more compact. (O10NOR QQ-32:17-25.) The rib on the GX's fuel tank is a seam that holds together the top and bottom halves of the tank, and is formed as a result of a manufacturing process that is the subject of an expired utility patent. (*Id.* at QQ-46:8-48:10.)

Engine manufacturers endeavor to make their utility engines, such as the GX, as small and compact as possible so that they fit into the various power equipment applications they power. (Mieritz 104:24-106:7; Reisel 29:20-31:15.) Hoag agrees, testifying on behalf of Honda in a prior case that there is a "market advantage in making the [engine] as compact as possible." (O2NOR I-31-32.) In fact, according to Hoag, minimizing the size of the engine is a "prime rule of engineering." (*Id.* at I-52.)

C. THE DESIGN AND DEVELOPMENT OF THE GX ENGINE.

The Honda GX engine is a general purpose utility engine used to power a wide variety of applications and equipment, such as pressure washers, portable generators, rototillers and water pumps. Honda sells its GX engine to OEMs, who incorporate the engines into their products. Honda also creates its own products that are powered by GX engines, and sells loose GX engines to engine distributors, rental yards and individuals who want to incorporate an engine in a product they are making or repowering. (Conner 18:24-22:24.)

As set forth in Honda's historical account of the design and development of the GX engine featured on Honda's website (*see* Fujita Ex. 189-A), Honda engineers, led by Yoshinobu Yamaguchi, began developing the GX engine in Southeast Asia in 1980. Honda's goal was to develop a new engine that would allow Honda to expand its market share in the small engine industry. The GX engine – or ZE

engine as it was referred to in early planning documents – was designed to replace Honda’s ME line of general utility engines (pictured on right). The ME was a high quality, low cost engine tank that had some success in the marketplace. However, OEMs told Honda they would not buy the ME because it didn’t fit into their product size specifications. Even though the ME cost less



than its competitors, its failure to fit in OEM machines made it expensive, difficult and cumbersome to install and test. Accordingly, Honda set out to develop an engine with an "ideal design" that was high quality and fit within the OEMs’ installation dimensions or “envelope.” (See Fujita 12:2, 17:21-22; 59:8-10, Ex. 189-A, p. 4-5, 7, 10, 13.)

At that time, OEMs’ standard installation dimensions for general utility engines were based on side valve, or SV engines. However, SV engines consumed a lot of gasoline and oil, were noisy and were hot. Honda knew that the overhead valve or OHV engine was a more fuel efficient, high output alternative, and decided to adopt the OHV design as its next generation engine line. Unfortunately, the OHV engine was larger, taller, heavier and more costly than the SV. Further, the OHV’s increased height meant the engines had a higher center of gravity and significant amounts of vibration. The OHV design also affected engine manageability when installed in a work machine. For these reasons, most manufacturers never seriously developed the OHV engine for general purpose applications. Honda, however, was confident that it could develop an OHV engine that would solve the problems in the marketplace and fit within OEM requirements. (See Exs. 188-A, 189-A, p. 7, 10, 13.)

While exploring potential designs that could fit within the OEM envelope, Honda came up with the idea of setting the engine cylinder at an incline, which, together with a boxy design of the auxiliary engine components, allowed Honda to fit an OHV engine within the existing OEM envelope. The new engine design offered all of the advantages of the OHV engine – namely, higher performance and better fuel economy – as well as the added benefits of a lower center of gravity and reduced vibration. In addition, the compact cubic size and design of the engine enhanced design flexibility, and allowed Honda to fit within the specifications for OEM machines. (See Fujita 23:4-8, Ex. 189-A, pp. 13, 19.)

The sole GX development document produced by Honda depicts an engine design (right) that corresponds directly with the applied-for mark. [REDACTED]

[REDACTED]

Honda released its new GX engine in 1983. Since that time, manufacturers of general purpose engines around the world have adopted the OHV/inclined cylinder concept, making it the de facto standard in the industry. (Ex. 189-A, 19.)

D. HONDA PATENTED VARIOUS ASPECTS OF THE GX IN JAPAN AND THE U.S.

Not surprisingly, Honda sought utility patent protection for its new engine design.

1. The '344 Utility Model.

On April 13, 1982, Honda filed a Japanese utility model application for a “GENERAL-PURPOSE INTERNAL COMBUSTION ENGINE” that was published on August 29, 1988 and issued as No. S63-32344 (“the ‘344 Utility Model”). (O6NOR, EE.) The ‘344 Utility Model claims the engine's overall cubic shape and position of major component parts discussed above:

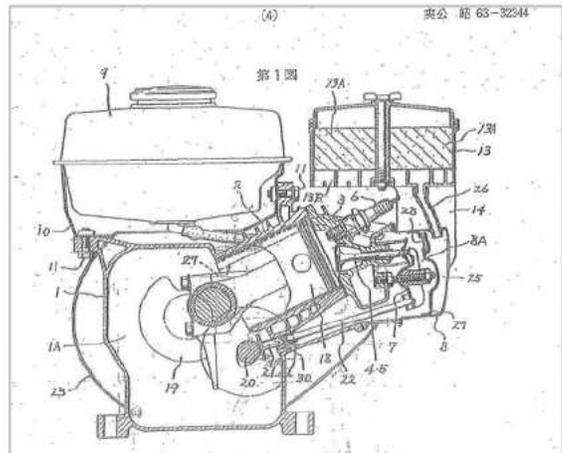
A general-purpose internal combustion engine with a cylinder inclined slightly upward from the horizontal direction and with intake and exhaust valve system in an overhead

⁵ This planning document makes no mention of styling the engine to look different in the marketplace from competitors.

arrangement, characterized in that said intake and exhaust valve system is supported in a substantially horizontal position, said engine further comprising: a head cover that is removably installed in a substantially horizontal position relative to said cylinder head; a fuel tank that is located above said crankcase and cylinder and is supported by said crankcase and cylinder; a carburetor located on one side of said cylinder head and is connected to a suction port of the cylinder head; an air cleaner located above said cylinder head and over said carburetor and is connected to the latter; a muffler that is also positioned above said cylinder head but on the side thereof opposite to said air cleaner and that is connected to an exhaust port of said cylinder head, whereby the air cleaner and the muffler are located above the cylinder head and the head cover and on the left and right sides thereof, respectively, the upper surfaces of the fuel tank, air cleaner, and muffler are arranged to be substantially flush with one another; the fuel tank, carburetor, air cleaner and muffler are arranged substantially between a vertical surface that includes a crankshaft protrusion surface of the crankcase and a vertical surface that includes an outer surface of a fan cover located on the opposite side.

(Emphasis added.) In the “Detailed Description of the Innovation,” Honda states that “[i]nternal combustion engines of this kind are not only compact and lightweight, but also adaptable to a wide variety of applications.” The ‘344 Utility Model specifies that the new engine design allows for “downsizing the engine and stabilizing the engine during use.” The innovator of the invention is identified

as Yoshinobu Yamaguchi, the lead engineer for the GX engine. The drawings in the ‘344 Utility Model include a drawing of the back of the engine (right), which shows the external component parts of the engine in the same general shape and positions as the applied-for mark. (See EE-5-6, 191-A at 315805.) The drawing is also nearly identical to the drawing of the back of the engine shown in the GX design document. (Ex. 191-A, 4.)



According to Honda’s functionality expert, James Mieritz (“Mieritz”), the ‘344 Utility Model claims and/or describes an engine with a compact cubic design like the GX in the applied-for mark with the approximate same height and width from the front, and rectangular/boxy auxiliary components in the same general shape and position as in the applied-for mark. (Mieritz 164:21-169:4.)

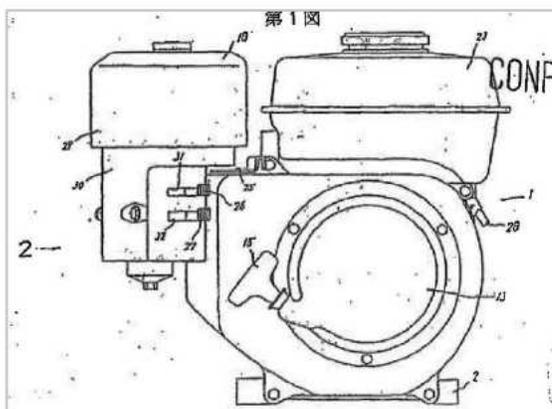
2. The ‘961 Utility Model.

On September 22, 1982, Honda filed a Japanese utility model application for a “GENERAL PURPOSE ENGINE” that was published on August 31, 1987 and issued as No. S62-33961 (“the ‘961

Utility Model”). The ‘961 Utility Model claims, among other things, a general purpose engine with the air cleaner located above the carburetor, and fuel valve and choke levers adjacent to one another and facing the fan cover:

A general purpose engine comprising: a carburetor installed on a fan cover side relative to an engine cylinder; an air cleaner located above the carburetor; a cover made integrally with an air cleaner case disposed outside of and facing the carburetor; a choke lever of the carburetor disposed to face the fan cover; and a fuel valve lever arranged adjacent to said choke lever, wherein said choke lever and said valve lever protrude outward through long holes formed in said cover.

The “Detailed Description of the Innovation states “[t]his innovation relates to a general purpose engine, and more specifically, relates to improvements in the engine operability.” It also states that the innovation prevents overlooked or wrong operations because the controls of the general purpose engine, such as a recoil starter, choke and valve levers are installed on the same plane, thus improving functionality because individual operations can be completed on a single plane. The innovator of the invention is identified as GX lead designer, Yoshinobu Yamaguchi. The drawings in the ‘961 Utility Model depict an engine (above) that is almost identical to the applied-for mark. (O6NOR, Ex. BB 4-6.)

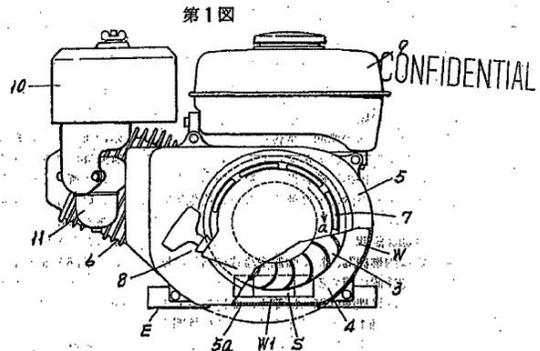


According to Mieritz, Figure 1 in the ‘961 Utility Model shows an engine in the same shape and configuration as the GX in the applied-for mark. In addition, he says Figure 1 shows a general utility engine with a compact, cubic design with boxy components, located in the same positions as the applied-for mark. (Mieritz 176:24-181:9.)

3. The ‘160 Utility Model.

On October 20, 1980, Honda filed a Japanese utility model application for a “COOLING DEVICE FOR INTERNAL COMBUSTION ENGINE” that was published on September 19, 1988 and issued as No. 63-35160 (“the ‘160 Utility Model”). The claims of the ‘160 Utility Model describe a cooling device for a general purpose engine with forced air cooling. The ‘160 Utility Model describes how the invention works based on the design of the engine, which allows for air movement needed to

cool the engine. The drawings of the invention include a depiction of an engine in the same configuration and position of component parts as the applied-for mark, and a slant on the left side of the fan cover (right). (O6NOR, FF.)



4. The '385 Patent

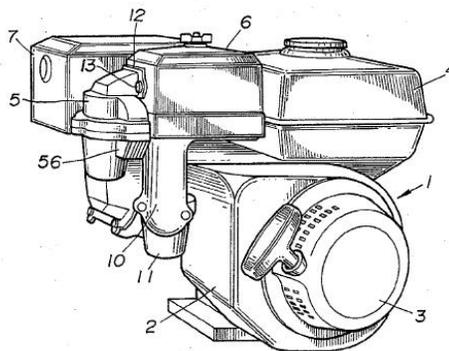
Honda also filed for and was issued a utility patent in the United States for a general purpose internal combustion engine that has the same shape and configuration of the applied-for mark. U.S. Patent 4,813,385 (“the ‘385 Patent’”) was filed by Honda in 1988 and was issued on March 21, 1989. The listed inventors identify lead GX designer, Yoshinobu Yamaguchi, and two other inventors from Japan. The background of the invention states:

The present invention relates to a general-purpose internal combustion engine for use as a prime mover in various machines for agricultural, civil construction, and other uses in various portable machines such as electric generators and pumps, and more particularly to such a general-purpose internal combustion engine having an air cleaner with a pre-cleaner.

U.S. Patent Mar. 21, 1989 Sheet 1 of 4 **4,813,385**

In the ‘385 Patent, Honda claimed the same position of the fuel tank and air cleaner as shown in the applied-for mark (claim 1), as well as a fuel tank on the top of the engine and a fuel tank, muffler and main air cleaner “substantially rectangularly shaped as viewed in plan.” The drawings include a drawing

FIG. 1



(right) of an engine with the same shape and configuration as the applied-for mark. (See O6NOR, Ex. M.)

5. Additional U.S. Patents and Japanese Utility Models.

Honda also applied-for and obtained numerous additional U.S. patents and Japanese utility models that claim, depict or otherwise describe the applied-for mark and/or components and features thereof. Six additional U.S. patents have been introduced into the record through Opposers’ Sixth Notice of Reliance, Exhibits N-S. Eleven additional Japanese utility models have been introduced into the record through Opposers’ Sixth Notice of Reliance, Exs. T-AA, CC-DD and GG.

E. THERE IS WIDESPREAD THIRD PARTY USE OF SUBSTANTIALLY SIMILAR ENGINE DESIGNS

Due to the GX's small/compact and cubic shape – which, as discussed above, was an express design goal for the GX – OEMs began building their applications around the GX. (Whitmore 75:22-76:18; O10NOR, Ex. QQ-37:22-38:17.) Honda witness Conner confirmed that OEMs prefer more compact engines because they can make their products smaller. (O10NOR QQ-49:10-24.) Engines that do not fit within the compact “envelope” of the GX often do not succeed in the marketplace. (Opp. 6; Whitmore 77:13-80:11; Litt 19:2-10, 58:1-5)(“to compete in the marketplace less than 15 horsepower, you need to fit in a certain package, otherwise you’re not going to be able to sell engines.”)

The compact overall cubic shape and dimensions, and the configuration of the major component parts of the applied-for mark have become the industry standard. (Whitmore 74:16-75:20; 25:24-26:14; 40:24-42:7; Litt 23:10-18; 60:24-62:3; Fujita Ex. 189-A, 19.) Specifically, “the industry standard configuration would be the configuration where the high mount air cleaner is in the upper left-hand corner, the fuel tank is mounted directly to the right of it, and then below that is a fan cover with an upward slant towards the carb cover.” (Whitmore 75:1-6; Litt 46:23-48:10.) The industry standard shape of the fuel tank and air cleaner cover is also rectangular. (Whitmore 75:8-20.)

Dozens of manufacturers of horizontal shaft engines use the same overall cubic shape (roughly equivalent height and width) and configuration (general shape and relative position of the major component parts) (“shape and configuration”) as the applied-for mark. (*See* Fujita 55:11-5:8) (cubic design of the GX reflected in the square appearance of the engine from the front and boxy individual components). For example, Exhibit Opp. 25 shows seventeen third party engines that are substantially similar to the applied-for mark. Each of these engines has a cubic design, with a slanted fan cover, a fuel tank located above the fan cover on the right, and the air cleaner located to the left of the fuel tank. These engines also feature roughly rectangular fuel tanks and square air cleaner covers.

Similarly, Exhibit Opp. 56 shows nine third party engines with substantially similar shape and configuration as the applied-for mark. Honda's Senior Vice President Steven Conner confirmed that each of these engines has the same position and orientation of the major component parts as the applied-

for mark. (Conner 246:8-253:22.) Opposers also submitted over one hundred pages of U.S. websites where engines with substantially similar shapes and configurations offered for sale. (O2NOR G1-112.)

In addition, four engine manufacturers that sell engines with the same shape and configuration as the applied-for mark have prepared and signed declarations in this case. (See Opp. 9-12, dkt. 130-131 Exs. HH-KK.) Each of those manufacturers sell engines with a substantially similar shape and configuration to the applied-for mark in the U.S., and have done so for many years. (*Id.*; Whitmore 69:20-72:16; Fujita 112:15-114:14.) In sum, there is overwhelming evidence of substantially similar third party engine designs:



Honda GX



Generac



Predator



Robin Subaru EX21



All-Power 208 cc



Lifan (EquipSource)



Champion



Blue Max



Briggs 550



Kawasaki

F. HONDA’S ADVERTISING FOR THE GX ENGINE FOCUSES ON FEATURES OTHER THAN THE APPLIED-FOR MARK.

To differentiate the GX from the sea of other substantially similar third party engines, Honda’s marketing material focuses on three aspects of the GX: 1) the HONDA trademark, 2) the engine’s functional features, and 3) Honda’s distinctive red, white and black color scheme. (Opp. 38-44; App. 67-69, 78-81; O14NOR UU, VV.)

Honda’s advertising for the GX engine strongly promote the famous Honda brand. (O4NOR K-91:4-13)(HONDA trademark ranked among top 20 of the world’s most valuable brands). For example, App. 78 tells the consumer to “[j]ust make sure you get a Honda” and App. 79 states “[w]ith Honda engines, all seems right with the world.” (*See also* App. 83) (“find out more concrete reasons to choose Honda”); Opp. 37 (nothing makes an impression like the legendary reliability of a Honda”); Opp. 38 (“more and more contractors demand Honda engines”); Conner 145:6-9.) Similarly, the GX engines themselves almost always include the HONDA and GX trademarks in the middle of the recoil cover. (Conner 145:10-25.) Honda’s Manager of Advertising and e-Commerce, John Lally, underscored the importance of the Honda name when he testified that he would need to see “Honda” on the application drawing to know whether it was a Honda GX engine. (O4NOR K-20:24-22:23.) Lally explained that it was the Honda name – not the shape, configuration, or any design element – that would distinguish a GX engine in a room full of similar engines. (O4NOR K-100:6-101:17.)

Honda also extensively promotes the functional features of the engine, including its compactness. App. 78 touts the engine’s “reliability and durability” and notes that Honda engines “start easily” and are “fuel efficient.” App. 79 describes the engine as being “incredibly tough, reliable, and quiet.” Opp. 38

calls the engine “tough, quiet, and fuel efficient.” Indeed, even the patent drawing from the ‘344 Utility Model is shown in numerous Honda marketing materials for the GX. (App. 68 at 676; App. 76.) Notably, Opp. 55 describes Honda engines as having a “compact design that ensures compatibility with a wide range of installations,” while Opp. 62 explains that the “low fuel consumption, high output, and **compact size** of the commercial-grade GX engines have made them the best sellers engine.” Similar examples can be found in essentially all of Honda’s marketing materials in the record. [REDACTED]

[REDACTED]

[REDACTED]. (O4NOR K-9-30; K-118:3-24; Conner 37:6-16.) Honda’s practice of promoting the functional features of the GX in its marketing materials is consistent with industry practice. (O14NOR WW-DDD; *see also* Litt 33:10-24.)

Finally, Honda consistently promotes the distinctive red, white and black color scheme that it has used since the engine first launched in 1983, and refers to it as the “standard” version of the GX. (App. 67; Conner 14:10-15:20; O4NOR K-47:24-48:8.) Honda marketing materials almost always feature a “hero shot” of the engine – an image of the engine



from the same frontal perspective as the applied-for mark – with the red, white, and black color scheme. (Conner 112:5-114:17; O4NOR K-44:17-46:19; App. 67-69, 78-81; Opp. 38-43.) Even Honda’s black and white marketing materials for the GX engine show the three color scheme with the white fuel tank, black air cleaner cover, and fan cover in some third shade of grey. (Conner 121:7-20; Opp. 32.) Similarly, the Honda website exclusively shows the GX engines in red, white, and black, and the press kit for the GX line shows GX engines in red, white, and black. (O2NOR H-90-159; O14NOR UU, VV; Opp. 31). Even third party distributors use the distinctive three color scheme of the GX to distinguish it from other similar engines. (Opp.61 (marketing materials distinguishing the Subaru Robin EX from the Honda GX by color); Conner 268:9-269:22.) [REDACTED]

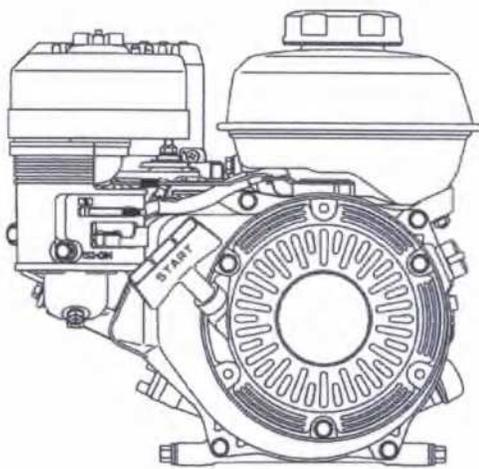
[REDACTED] (Conner 152:22-153:5.)

Notably, Honda has never conducted any “look for” advertising regarding the appearance of the

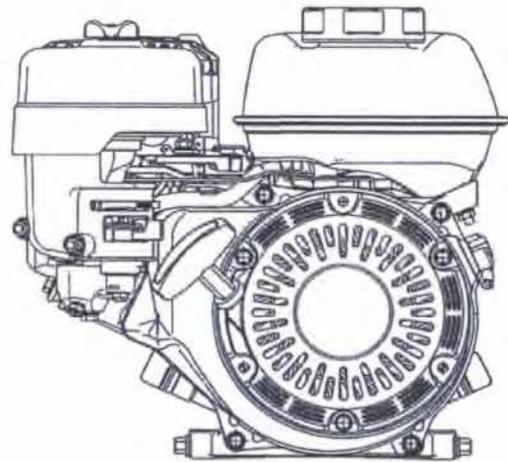
GX engine. (Conner: 143:23-145:1; O4NOR K-33:15-24.) While Honda had one advertising campaign that featured the red recoil cover of the GX with the HONDA trademark, neither of those elements are claimed as part of the applied-for mark. (Opp. 38, 40; App. 6.)

G. HONDA’S REDESIGN OF THE GX ENGINE AND TERMINATION OF THE APPLIED-FOR DESIGN IN THE U.S.

In 2008, Honda redesigned the GX engine to comply with the EPA’s “Phase 3” emissions regulations. (Conner 61:25-63:21.) The redesign included numerous changes to the external appearance of the front view of the engine.



Original Honda GX Engine



Redesigned Honda GX Engine

Specifically, Honda made the following obvious changes to the external appearance of the GX: 1) rounded the beveling on the outside corners of the air cleaner cover; 2) changed the belt-like area on the air cleaner cover to look like a skirt; 3) eliminated the ribs on the carburetor cover; 4) rounded the bottom portion of the carburetor cover; 5) rounded the beveling around the front and corners of the fuel tank; and 6) moved the fuel spill-off channel to the front of the fuel tank. (Conner 64:5-65:5, 165:13-166:24; Opp. Exs. 47-49.)

As a result of this redesign, engines bearing the design of the applied-for mark are no longer marketed or sold in the U.S., and Honda has no plans to further market or sell the old design. All of Honda’s new marketing materials show the redesigned GX, and [REDACTED]

[REDACTED] (O4NOR K-65:6-22, 66:2-25; Conner 170:13-171:1.) Only

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] (App. 28; Opp. 50-53; Conner 171:11-

176:24; O13NOR TT (showing GX with cyclone style air cleaner); O3NOR J-3-14 (same)).

VI. ARGUMENT

A. THE APPLIED-FOR PRODUCT CONFIGURATION IS FUNCTIONAL

Honda’s trademark application claims the overall cubic shape of its GX engine and the position of the major component parts of the engine that can be seen from the front view of the engine, namely, the fuel tank, air cleaner cover, carburetor cover and slanted fan cover. The application also claims small design flourishes, such as beveling, a rib on the fuel tank, a belt-like area on the air cleaner cover and four ribs on the carburetor cover.

The USPTO properly refused registration of the applied-for mark on the grounds that the configuration is functional. The USPTO properly noted that Honda owned several utility patents and other materials that demonstrate that the compact engine design allows the engine to fit within smaller spaces and to have a lower center of gravity. Honda overcame the refusal by claiming the cited patents did not apply to the Honda GX design and by claiming the examiner had no evidence that the configuration makes it easier for the engine to fit into a compact space or that the engine has a lower center of gravity. The Board now has that evidence. Indeed, the record is replete with documents and testimony from Honda which demonstrate that the overall configuration and cubic design are functional. The compact and overall “cubic” shape of the engine allows the engine to fit within OEM requirements and to have a lower center of gravity. The particular positions and shapes of the component parts are also functional and dictated by utilitarian and engineering requirements. Further, the record now contains more of Honda’s patents, which include several Japanese utility models that were issued for the Honda GX engine and an additional U.S. patent that the USPTO did not initially consider. If the USPTO had the evidence that is now before the Board, it would not have approved the application for publication.

The evidence also reflects that there are numerous manufacturers in the engine industry –

including Opposers – who manufacture and have manufactured general purpose utility engines in essentially the same cubic shape and configuration for many years. Allowing Honda to obtain a monopoly in the applied-for mark would inappropriately hinder competition and would prevent other engine manufacturers in the marketplace not only from competing effectively, but participating. Accordingly, the Board should find that Honda’s applied-for mark is functional.

1. BURDEN OF PROOF

Opposers “bear the initial burden of establishing a *prima facie* case of functionality.” Once a *prima facie* case is established, the burden then shifts to Applicant to prove the product configuration is non-functional. *See Kistner*, 97 U.S.P.Q.2d at *5; *Valu Eng’g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 U.S.P.Q.2d 1422, 1429 (Fed. Cir. 2002).

2. LEGAL STANDARD

Section 2(e)(5) of the Trademark Act prohibits registration of a mark if it “comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052 (e)(5). Product design may be protected and registered as a trademark, but only subject to certain conditions. *Kistner*, 97 U.S.P.Q.2d at *7. The Supreme Court has consistently proceeded with caution in according trademark protection to product design because product design “almost invariably serves purposes other than source identification.” *See id.*; *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 U.S.P.Q.2d 1001 (2001); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 U.S.P.Q.2d 1065 (2000). “The design of a product is functional and cannot serve as a trademark if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* The issue comes down to whether “the design of the product works better in the configuration at issue.” *Id.*

A key policy underlying the functionality doctrine is the “preservation of competition.” *Valu Engineering*, 61 U.S.P.Q.2d at 1428; *In re Florists’ Transworld Delivery, Inc.*, No. 77590475 2013 WL 2951796, at *2 (T.T.A.B. Mar. 28, 2013). Indeed, the “effect upon competition” is really “the crux” of the functionality inquiry and, accordingly, the functionality doctrine preserves competition by ensuring competitors the right to compete effectively. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1341, 213 U.S.P.Q. 9, 15-16 (C.C.P.A. 1982). It also serves to guard against the “misuse” and “over-

extension” of trademark protection for product designs. *Kistner*, 97 U.S.P.Q.2d at *7. The Supreme Court has stated:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 34 U.S.P.Q.2d 1161, 1163-64 (1995). The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. *Kistner*, 97 U.S.P.Q.2d at *7. Similarly, the Lanham Act does not protect trade dress in a functional design even if an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller. *Id.*

In addition to the above guiding principles, the Board must consider the following factors when determining whether a product configuration is functional: (1) the existence of a utility patent that discloses the utilitarian advantages of the registered design; (2) advertising by the registrant that touts the utilitarian advantages of the registered design; (3) facts pertaining to the availability of alternative designs; and (4) facts pertaining to whether the registered design results from a comparatively simple or inexpensive method of manufacture. *See Morton-Norwich*, 671 F.2d 1332.

3. HONDA’S OVERALL PRODUCT CONFIGURATION IS FUNCTIONAL. THE FEW MINOR FLOURISHES HONDA CLAIMS CANNOT RENDER IT NONFUNCTIONAL.

Before an overall product configuration can be recognized as a trademark, the *entire* design must be arbitrary, that is, not *de jure* functional. *Kistner*, 97 U.S.P.Q.2d at *6; *see also* Section 23(c) of the Trademark Act, 15 U.S.C. § 1091 (c). The inclusion of one or more nonfunctional features will not render an otherwise functional configuration distinctive and therefore registrable. *See In re Bose Corp.*, 476 F.3d 1331, 81 U.S.P.Q.2d 1748 (Fed. Cir. 2007). “The reason for this is self-evident – the right to copy better working designs would, in due course, be stripped of all meaning if overall functional designs were

accorded trademark protection because they included a few arbitrary and non-functional features.” *Kistner*, 97 U.S.P.Q.2d at *8; *see also In re Bose Corp.*, 81 U.S.P.Q.2d at 1748; *In re Becton, Dickinson, and Co.*, 675 F.3d 1368, 1374 (Fed. Cir. 2012) (“a mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.”).

The record in this case contains abundant documentation and testimony which demonstrates that the overall cubic design and configuration of the GX engine for which Honda is seeking trademark protection is functional. Honda’s own web site history reveals that Honda developed this new engine design with a slant cylinder and the boxy component parts in their respective positions in 1983 for the purpose of creating a compact, high performance engine that would fit within OEM installation dimensions existing at that time, and would allow Honda to become a leader in the industry. [REDACTED]

[REDACTED] just as the examining attorney previously suspected. Honda accomplished those goals, as the Honda GX engine was the first OHV engine developed to fit within the compact OEM package size and was a superior design to prior SV engine alternatives. Since the Honda GX engine was released, the engine configuration has become industry standard for general purpose utility engines.

In addition to Opposers' witnesses who testified that the overall shape and configuration of the applied-for mark is not only functional, but also necessary to compete in the marketplace (Reisel 26:5-62:8; Whitmore 77:13-80:11; Litt 19:2-10, 58:1-5), Honda's corporate designee who designed the GX engine conceded that each component of the engine had a specific function and that the "boxy" shape of the engine and components contributed to the compactness of the engine. He also conceded that the engine has good fuel economy, reduced vibration and has a low center of gravity. (Fujita 59:4-21, 60:13-61:13, 67:14-68:8, 70:18-71:2, 73:16-75:5, 77:23-78:5, 79:14-25, 80:17-22, 83:10-12, 85:25-86:16, 88:12-18; *see also* discussion on Section 6, p. 35-38, *infra*.)

Similarly, and quite notably, Honda's own expert on the issue of functionality, Mieritz, conceded that common engineering principles dictate the overall configuration and position of the external components of the engine, and that the overall cubic design of the engine contributes to the compactness

of the engine, enables easy maintenance and the ability to fit within a wide variety of OEM applications, and reduces shipping cost. (Mieritz 105:8-12, 118:15-119:20, 136:23-137:11, 137:12-23, 138:1-13, 141:11-155:4, 156:8-157:11.)

After analyzing the evidence, the only elements of the applied-for mark that could arguably be purely ornamental are minor design flourishes, such as the belt-like area on the air cleaner cover and the four ribs on the carburetor cover. Well established Federal Circuit principles prohibit granting Honda a monopoly over a functional overall engine configuration by simply adding minor features. *See, e.g., Petersen Mfg. Co., Inc. v. Central Purchasing, Inc.*, 740 F. 2d 1541, 1550, 222 U.S.P.Q 563 (Fed. Cir. 1984) *abrogated on other grounds by Beatrice Foods Co. v. New England Printing and Lithographing Co.*, 899 F.2d 1171, 1177–78 (Fed.Cir.1990)(“An overall design is not removed from the category of a non-protectable shape (*i.e. de jure* functional) merely because it includes some arbitrary features.”); *see also Secalt S.A. v. Wuxi Shenxi Constr. Mach. Co.*, 668 F.3d 677, 684, 101 U.S.P.Q.2d at 1553 (9th Cir. 2012) (where the arrangement of parts “is designed to result in superior performance, it is semantic trickery to say that there is still some sort of separate ‘overall appearance’ which is non-functional.”).

4. HONDA HAS PROTECTED THIS PRODUCT CONFIGURATION WITH UTILITY MODELS AND PATENTS

One of the four *Morton-Norwich* factors, the presence of a patent disclosing utilitarian advantages of a mark, is accorded substantial weight. *See Traffix Devices, Inc.*, 532 U.S. at 30. A prior utility patent has vital significance as it is strong evidence that the features claimed in the trademark application are functional. *See id.* The existence of one or more utility patents that claim or describe the features for which trademark protection is sought “is often critical to a determination that the features are functional.” *Kistner*, 97 U.S.P.Q.2d at *10. “Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.” *Traffix*, 532 U.S. at 30. In reviewing applicable utility patents during a functionality determination, the Board is not limited to reviewing only the language of the claims – it may also consider the additional disclosures and drawings in the patent. *See id.*; *see also In re Bose Corp.*, 772

F.2d 866, 227 U.S.P.Q. 1 (Fed. Cir. 1985).

Honda has numerous utility models and patents that claim or describe features of the applied-for mark. The '344, '961 and '160 Utility Models were filed in Japan at the time Honda was developing the GX. The '344 and '961 Utility Models identify Yoshinobu Yamaguchi, the individual identified on Honda's web site as the lead engineer who developed the GX engine, as the inventor.

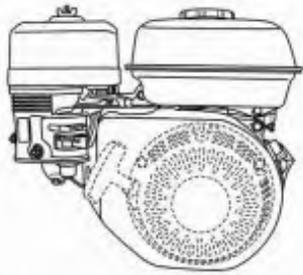
The '344 Utility Model claims a general-purpose internal combustion engine with an inclined cylinder with component parts having the same shape and configuration as the applied-for mark. The description of the invention states: “[i]nternal combustion engines of this kind are not only compact and lightweight, but also adaptable to a wide variety of applications.” It also allows for “downsizing the engine and stabilizing the engine during use.”

The '961 Utility Model claims a general purpose engine with the same shape and configuration as the applied-for mark. The description of the invention states “[t]his innovation relates to a general purpose engine, and more specifically relates to improvements in engine operability.” It also states that the invention prevents overlooked or wrong operations because the controls, such as recoil starter, choke, and valve levers are all installed on the same (front) plane, just as they are on the GX.

The '160 Utility Model claims a general combustion engine with forced air cooling. The patent describes how the invention works based on the design of the engine, which allows for air movement needed to cool the engine.

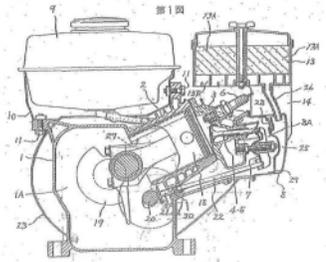
The '385 Patent was filed in the United States and claims a general purpose internal combustion engine with component parts in the same positions as the applied-for trademark. Yoshinobu Yamaguchi, the lead engineer for the Honda GX engine, is identified as one of the inventors. The background of the invention describes a general purpose internal combustion engine for use in many industries and with various portable machines. The claims include a general-purpose internal combustion engine comprising various components in various shapes, including a fuel tank on the top of the engine and an air cleaner beside the fuel tank, and a fuel tank, muffler and main air cleaner substantially rectangularly shaped as viewed in plan.

All four patents reveal drawings that are substantially similar to the applied-for mark.

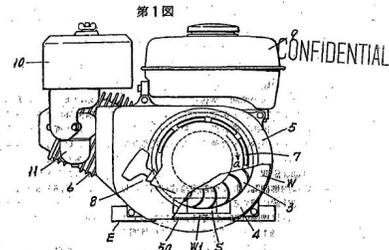


Applied-for Trademark

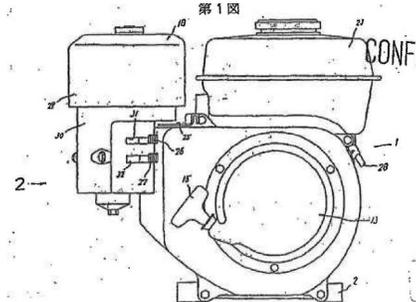
(6) 表意用 43-32548



'344 Utility Model (back view)



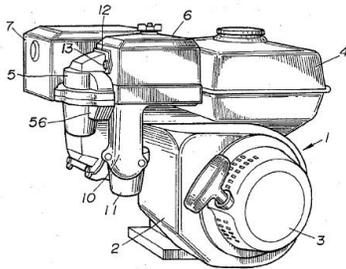
'160 Utility Model



'961 Utility Model

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FIG. 1



'385 Patent

All of Honda's above-referenced utility models and patents for its GX engine have now expired, and only one of them, the '385 Patent, was disclosed by Honda to the examining attorney. Opposers have more than met their burden of establishing a *prima facie* case that Honda's applied-for mark is functional. Honda cannot meet the heavy burden of proving that its overall shape and configuration is ornamental or arbitrary.

5. HONDA TOUTS FUNCTIONAL ASPECTS OF ENGINE RATHER THAN ORNAMENTAL FEATURES IN ITS ADVERTISING.

In addition to seeking and obtaining utility patents for its engine design, the record reflects that Honda routinely touts the functional features of its GX engine in its advertising, such as reliability, durability, superior fuel efficiency, low emission levels, performance, value and, most notably,

compactness. (See App. 78, 79, 81; Opp. 38, 55; O4NOR K-9-30.) Advertisements which tout utilitarian features of the applied-for mark constitute “strong evidence of functionality.” See *Kistner*, U.S.P.Q.2d at *15 [REDACTED]

[REDACTED]

[REDACTED] (Conner 37:6-16.)

Further, Honda has failed to engage in any “look-for advertising” which directs potential customers to look for the applied-for mark as a source identifier. (Conner 143:23-145:1; O4NOR K-33:15-25.) While Honda frequently includes a “hero shot” or photograph of the GX engine in its advertising (Conner 112:5-114:17), it is well settled that the mere use of a picture of the product is not the type of “look for” advertising that rebuts the functionality of the design. *Kistner*, 97 U.S.P.Q.2d 1912, *19; *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 U.S.P.Q.2d 1549, 1572 (T.T.A.B. 2009) (“‘Look for’ advertising refers to advertising that directs the potential consumer in no uncertain terms to look for a certain feature to know that it is from that source. It does not refer to advertising that simply includes a picture of the product or touts a feature in a non source-identifying manner.”).

This advertising constitutes *prima facie* evidence that Honda’s applied-for design is functional.

6. THE AVAILABILITY OF ALTERNATIVE DESIGNS IS IRRELEVANT SINCE THE CONFIGURATION IS FUNCTIONAL, BUT EVEN IF IT WERE RELEVANT, THERE ARE NO COMMERCIALY VIABLE ALTERNATIVE DESIGNS AVAILABLE.

Where other factors establish the functionality of the product design, “there is no need to consider the availability of alternative designs.” *Valu Eng’s Inc.*, 61 U.S.P.Q.2d at 1427; *Kistner*, 97 U.S.P.Q.2d at *20 (“in view of respondent’s utility patents, the existence of alternative designs need not be considered.”). Functional designs may not be given trade dress protection simply because alternative designs are available. *Valu Eng’s, Inc.*, 61 U.S.P.Q.2d at 1429; *In re Van Valkenburgh*, 97 U.S.P.Q.2d 1757, 1763 (T.T.A.B. 2011) (finding a proposed mark functional where the mark was previously disclosed by a utility patent and was an “efficient and superior design,” despite the presence of “well over 85” alternative designs.),

In this case, there is ample evidence that the applied-for mark is functional. In addition to the utility patents and advertising discussed above, Opposers' expert on functionality, Reisel, enumerated numerous functional aspects of the applied-for mark in his report and trial deposition. Those features include, *inter alia*, (1) the overall compact, cubic design is required to fit within OEM requirements; costs less as it has less parts; is more cost effective to ship as it is smaller and more engines will fit on a pallet; and is preferable in terms of easy maintenance; (2) the slanted fan cover affects engine performance as it directs cooling air toward the hottest part of the engine; (3) the positioning of the fuel tank above the carburetor is preferable as it is a gravity-fed engine and adding a pump would add cost; (4) positioning the fuel tank on the right side of the engine is necessary as it is away from the hottest part of the engine on the left; (5) positioning the air cleaner on the left side of the engine above the carburetor is necessary as the components need to be close in proximity to each other and to the air intake valve; (6) placing the control levers in a recessed area on the carburetor cover reduces the need for extra parts and improves durability; (7) using a rectangular, box-shape fuel tank is preferable as that size and shape holds the most fuel; (8) adding a rib on the fuel tank is the result of the easiest and most cost-effective way to manufacture the tank; (9) adding beveling to the fuel tank is preferable as it makes it easier to remove the parts from the die during the manufacturing process; and (10) using a cubic or square shape of the air cleaner provides the most effective way to draw air around the air cleaner element. (*See generally* Reisel 26:5-62:8.)

While Honda's functionality expert, Mieritz, holds the contrary view that the applied-for mark is non-functional, he admitted that the basic function of the GX engine dictates the overall configuration and position of the external components of the engine. (Mieritz 141:11-155:4.) He also conceded that the overall cubic design of the engine contributes to the compactness of the engine and that the goal of designers of engines such as this is to develop a small engine. (Mieritz 136:23-137:11, 137:12-23, 138:1-13, 105:8-12; *see also* Conner 185:12-186:1 ("cubic design" in the description of the mark means engine would fit into a cube).) He further conceded that the applied-for engine design enables easy maintenance, the ability to fit within a wide variety of OEM applications and reduced shipping cost. (Mieritz 156:8-157:11, 118:15-119:20.) Hoag, who submitted an expert declaration in support of Honda's application, made similar admissions in a deposition in a prior case. (O2NOR I-31-32, 47-52.)

Likewise, Honda's only GX team engineer witness, Fujita, conceded that the GX engine is compact, has a better fuel economy, reduced vibration and a lower center of gravity than its predecessor engine, the ME. He also admitted that each component part of the engine had a function and was designed with a "boxy" shape to ensure compactness of the engine. (Fujita 59:4-21, 60:13-61:13, 67:14-68:8, 70:18-71:2, 73:16-75:5, 77:23-78:5, 79:14-25, 80:17-22, 83:10-12, 85:25-86:16, 88:12-18.) Opposers' witnesses also explained the competitive necessity for the shape and configuration of the applied-for mark, explaining that engines that do not fit within the compact "envelope" of the GX often do not succeed in the marketplace. (Whitmore 77:13-80:11; Litt 19:2-10, 58:1-5.)

Taking all the evidence together, the applied-for mark is functional. Therefore, it is irrelevant whether there are any alternative designs available. Nonetheless, even if it were appropriate to consider alternative designs, Honda has not demonstrated that there are any functionally equivalent alternatives. The record is clear that the small utility engine market comprises numerous engines from numerous manufacturers that encompass the overall shape and configuration of the applied-for mark. Honda has not shown that there are viable alternatives to this overall, industry standard design.

Honda's only attempt at showing an alternative design for the overall configuration came from its expert, Mieritz. Mieritz tried to claim that moving the high mount air cleaner so that it is a flat panel or "low mount" design would be an alternate design. However, when pressed on this alternate, Mieritz admitted that the flat panel design is not really an alternative because it would not fit within many OEM specifications. (Mieritz 5221:16-24, 222:3-223:21, 223:22-224:5.) That is consistent with Briggs' experience. Briggs considered a flat panel configuration for its 550 Series engine, but switched to a high mount set up after testing the flat panel design and confirming that it would not fit within certain OEM power equipment. (Whitmore 29:8-34:23; Opp. 4.) This case is therefore quite similar to the Board's recent decision in *In re Heatcon, Inc.*, 116 U.S.P.Q.2d 1366 (T.T.A.B. 2015). As here, the applied-for mark in *Heatcon* involved the arrangement of functional features. *Id.* at 1368. And as here, there was evidence of similar utility patents that covered certain features of the applied-for mark. *Id.* at 1371-73. The Board found that the alternative designs submitted by the applicant were irrelevant for two reasons: first and foremost, the other evidence in the record indicated the mark was functional. Second, the

alleged alternative designs did not work as well as the applied-for mark. *Id.* at 1375-77. So too here, there is overwhelming evidence showing functionality, so any alternative designs are irrelevant. And Honda's purported "alternatives" – engines with a flat panel air cleaner – are inferior to the applied-for mark for a number of reasons, including that there are products in which they do not fit. Thus, as in *Heatcon*, the Board should find the applied-for mark here functional.⁶

7. MANY OF HONDA'S CLAIMED FEATURES RESULT FROM COMPARATIVELY SIMPLE AND/OR INEXPENSIVE METHODS OF MANUFACTURE.

This factor involves a consideration of whether Honda's design results from a comparatively simple or cheap method of manufacture. "While evidence that a product feature makes the product cheaper to manufacture may be probative in showing functionality, evidence that it does not affect its cost is not necessarily proof of non-functionality." *Kistner*, 97 U.S.P.Q.2d at *232. Here, Honda's functionality expert and GX engineer both testified that certain features cost more for Honda to make and/or that certain features did not affect the quality or cost of the engine. However, those statements were conclusory and lacked any foundation or supporting evidence. Indeed, Honda did not present any quantitative evidence whatsoever on the relative costs of manufacturing engines or their component parts. Thus, the record contains no information from which the Board could assess this factor either for or against a finding of functionality.

Because of the overwhelming evidence of functionality, the Board should find that Honda's applied-for mark is functional.

B. THE APPLIED-FOR PRODUCT CONFIGURATION LACKS SECONDARY MEANING

The issue of secondary meaning is irrelevant when the applied-for mark is functional. However, even if Honda could demonstrate the engine configuration is non-functional, there is no evidence to support a finding of secondary meaning of the claimed configuration.

⁶ Honda's witnesses that broached the topic of alternative designs also discussed minor flourishes of the applied-for mark. They discussed moving the rib on the fuel tank, adding different beveling or rounding to the edges of component parts and lining up components slightly differently. *See, e.g.*, Conner 242:12-252:5, Mieritz 31:5-32:3, 33:9-34:3, 37:24-41:25. However, the plain language in Honda's description of its applied-for mark encompasses the overall configuration of the engine and the position of its component parts, not solely the additional small flourishes to which Honda relies. Thus, Honda's purported design "alternatives" are not truly alternatives to the claimed design.

1. Honda Has a Heavy Burden to Prove Secondary Meaning

A mark that consists of a product design is registerable on the Principal Register only upon a showing of acquired distinctiveness. *Wal-Mart Stores, Inc.* 529 U.S. at 210, 213-214. To prove that a product configuration has secondary meaning, Honda “must show that the primary significance of the product configurations in the minds of consumers is not the product but the producer.” *In re Ennco Display Sys., Inc.*, 56 U.S.P.Q.2d 1279, 1283 (T.T.A.B. 2000). In determining whether the proposed mark has acquired distinctiveness, the Board should consider: (1) length and exclusivity of use by Honda of the mark in the United States; (2) the type, expense and amount of advertising of the mark by Honda in the United States; and (3) Honda’s efforts, such as unsolicited media coverage and consumer studies, in the United States to associate the mark with the source of the goods identified in the application. *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005).

Because “consumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or product packaging trade dress,” Honda faces a heavy burden to prove that its product configuration has acquired distinctiveness. *In re Ennco Display Sys., Inc.* 56 U.S.P.Q.2d at 1284; *see also Yamaha Int. Corp.*, 6 U.S.P.Q.2d at 1008. Honda's burden is even further heightened because several similar third party designs exist in the marketplace. *In re UDOR U.S.A., Inc.*, 89 U.S.P.Q.2d 1978, 1986-87 (T.T.A.B. 2009) (where “many third parties are using similarly-shaped configurations” to the applied-for mark, “a registration may not issue except upon a substantial showing of acquired distinctiveness.”).

2. Honda Does Not Have Exclusive Use of the Applied-For Engine Configuration

As discussed above, the record contains dozens of examples of third party engines with substantially similar shapes and configurations to the applied-for mark being sold in the U.S. Engine manufacturers such as Subaru, Kawasaki, Briggs & Stratton, Kohler, All-Power, EquipSource, Generac, Champion all manufacture and sell compact, cubic engines with slanted fan covers, fuel tanks located above the fan cover on the right, and the air cleaner located to the left of the fuel tank, and with rectangular fuel tanks and air cleaner covers. For example, Subaru, which sells nearly 10 different engines with substantially similar shapes and configuration to the applied-for mark, has been selling these

industry standard engines for the last 15 years. As such, Honda cannot prove secondary meaning as a matter of law. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 U.S.P.Q. 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *see also In re Gibson Guitar Corp.*, 61 U.S.P.Q.2d 1948, 1952 (T.T.A.B. 2001) (66 years of use not sufficient to prove secondary meaning given similarity of configuration to other guitars).

Critically, in order to preclude acquired distinctiveness “the third-party uses do not have to be identical to applicant’s mark.” *Saint-Gobain Corp. v. 3M Company I*, 90 U.S.P.Q.2d 1425, 1440 (T.T.A.B. 2007); *see also In re White Jasmine LLC*, 106 U.S.P.Q.2d 1385, 1395 (T.T.A.B. 2013) (“Evidence that third parties in applicant’s field use the same or substantially the same wording as the alleged mark, or very similar wording as the mark, as in this case, tends to indicate the mark has not acquired distinctiveness.”). Thus, the minor differences between the myriad third party engines and the applied-for mark do not save Honda from a finding of lack of secondary meaning.

3. Honda’s Advertising and Marketing Materials Cut Against Secondary Meaning of the Applied-For Mark

Honda relies on various advertisements and marketing materials in support of its claim of secondary meaning. These materials, however, are insufficient to establish secondary meaning, and in fact they cut against it.

i. Honda’s Advertising and Marketing Materials Lack Any “Look-For” Advertising for the Applied-For Mark

To support secondary meaning, advertisements “must demonstrate the promotion and recognition of the specific configuration embodied in the applied-for mark and not of the goods in general.” *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 U.S.P.Q.2d 1829, 1838-39 (T.T.A.B. 2013). Honda’s advertisements do not satisfy this requirement, as they do not tell consumers to look for any features of the applied-for mark. (Conner: 143:23-145:1; O4NOR K-33:15-24; App. 67-69, 78-81; Opp. 38-43.) In fact, the only design element that Honda ever specifically featured in an advertisement is the red recoil cover (Opp. 38-40), which Honda does not claim as part of the applied-for mark. Otherwise, Honda

advertisements simply show the product itself. Simply showing the engine is not enough. This absence of “look for” advertising specifically calling out the alleged trademark strongly cuts against Honda’s claim of secondary meaning. *Stuart Spector Designs*, 94 U.S.P.Q.2d at 1572-74 (“In short, there is nothing in the record that promotes the configurations in a way that would imbue them with source-identifying significance; rather, the advertising simply shows the product like any advertising would.”); *In re ic! berlin brillen GmbH*, 85 U.S.P.Q.2d 2021, 2023 (T.T.A.B. 2008) (the “chief reason” of no secondary meaning is “the absence of evidence of the advertising and/or promotion by applicant of the [applied-for mark] as a trademark.”); *In re Edward Ski Prods., Inc.*, 49 U.S.P.Q.2d 2001, 2005 (T.T.A.B. 1999) (“The deficiency in applicant’s claim of acquired distinctiveness lies in the absence of any evidence of the promotion by applicant of the configuration of its ski mask as a *trademark*. While the product design may be shown on each and every advertisement, there is no indication that potential purchasers would view this as more than a picture of the goods.”) (emphasis in original).

ii. **To the Extent Honda’s Advertising Creates Consumer Association in the GX Design, it does So in Combination With the Distinctive Three Color Scheme.**

When Honda shows the GX in its marketing material, it exclusively shows the engine in the distinctive red, white and black color scheme it has used for decades. As such, if the marketing materials create any association of the engine design with Honda, it creates association in the design *in color*.

Honda has featured the “Honda” name in the color red “for a number of generations.” (Conner 117:23-119:9.) A Honda advertisement shows a red fingerprint to signify a “Genuine Honda.” (Opp. 37.) The logo for the Honda Power Equipment Division, under which the GX engine is sold, is red, white, and black. (App. 67; Conner 116:2-17.) The logo for the Honda Engine Division is red and black against a white background. (App. 69; Conner 116:18-117:3.) The Honda “Three Year Warranty” logo for the GX engine is red, white, and black. (App. 82; Conner 117:11-22; O4NOR K-37:22-38:10.) Likewise, the Honda engine that preceded the GX, the ME, was red with a white fuel tank. (O2NOR H-48, 69.) Consumer association of the ME’s red and white color scheme with Honda was so strong that Honda tells the story of rival engine manufacturers designing their engines in red and white because consumers so often asked for “that red and white engine.” (Fujita 189-A at 4.)

It is therefore no surprise that Honda decided to sell and market the GX engine in its “standard” three color scheme. For instance, as discussed, the hero shot in GX advertisements is *always* featured in red, white, and black, and even the black and white marketing materials show the three color scheme. Similarly, the Honda website exclusively shows the GX engines in red, white, and black, and the press kit for the GX line shows the GX engines in red, white, and black. [REDACTED]

[REDACTED] Honda’s marketing materials also specifically promote the color of the engine, using play on words such as “all of our engines are green” or highlighting the distinctive white of the fuel tank or red of the recoil cover. Even third party distributors use the distinctive three color scheme of the GX to distinguish it from other similar engines. Honda acknowledged the distinctiveness of the GX’s three-color scheme in a foreign trademark proceeding where it asserted that [REDACTED]

[REDACTED] (O1NOR E-67) (emphasis in original). Further recognizing the color scheme’s distinctiveness, Honda decided to keep the same scheme for the redesigned GX. (O3NOR J-3-3; Opp. 48.) Notably, Honda’s alternative all-black version of the GX engine is sold to OEMs primarily for use in OEM-branded power equipment that have their own distinctive color schemes, and are meant to blend in with the OEM branding and not stand out to consumers. (Conner 125:14-128:12; Opp. 33-35 (showing black GXs incorporated into OEM products with distinctive color schemes); App. 72 (same).) Thus, it is the color, or at most the combination of the color with the GX engine design, that Honda promotes as a source identifier – not the applied-for mark.

iii. Honda’s Advertising and Marketing Materials for the GX Promote the Distinctive Honda Name.

Honda’s advertising and marketing material for the GX engine also strongly promote the famous Honda name. For instance, certain Honda advertisements tell the consumer to “[j]ust make sure you get a Honda” and “[w]ith Honda engines, all seems right with the world.” Others ask the reader to “find out more concrete reasons to choose Honda” and explain that “nothing makes an impression like the legendary reliability of a Honda.” (App. 79; Opp. 37.)

iv. **Honda's Advertising and Marketing Materials Tout the Functional Features of the GX Engine.**

Instead of promoting ornamental features of the GX in its advertising materials, Honda touts the functional features of the engine, such as its reliability, durability, fuel efficiency, toughness, quietness, and compactness. [REDACTED]

Because Honda's advertisements tout the engine's functional features instead of promoting the shape and configuration as a trademark, not only are Honda's advertisements not evidence of secondary meaning, they "directly undermine [] such a finding." *Stuart Spector Designs*, 94 U.S.P.Q.2d at 1573 (quoting *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662, 36 U.S.P.Q.2d 1065, 1071 (7th Cir. 1995)).

4. Honda has Purposefully Diluted Consumer Association of the Applied-For Mark With Honda.

Honda's has diluted consumer association of the applied-for mark by allowing major OEMs to label the Honda GX engine with the OEM's own trademarks, thereby diluting any possible consumer association of the applied-for mark with Honda, and instead causing consumers to associate the engine configuration with the OEM, or the OEM *and* Honda. (Opp. 33-35; Conner 130:12-136:4.) For instance,

[REDACTED] (Opp. 33 and 34.) In each of these instances, the OEM logo is placed higher, larger, and more prominently than the GX logo.



This practice is likely to dilute any possible consumer association of the applied-for mark with Honda, further undermining its case for secondary meaning. *See British Seagull Ltd. Brunswick Corp.*, 28 U.S.P.Q.2d 1197, 1203 (T.T.A.B. 1993) (“When such a party has sold its own goods, bearing a [mark] which it asserts has become distinctive of its goods, to third parties for resale to the consuming public as the products of those third parties, such practice detracts even further from the alleged distinctiveness of the [mark] as that party’s trademark.”); *Edward Weck Inc. v. IM Inc.*, 17 U.S.P.Q.2d 1142, 1145 (T.T.A.B. 1990) (no acquired distinctiveness where “third parties are also selling as their own some of applicant’s instruments.”).

5. Survey Evidence Confirms No Secondary Meaning in the Applied-For Mark Without Color.

Both sides hired survey experts in this case. The results of their surveys confirm that there is no secondary meaning in the applied-for mark.

i. The Poret survey is Reliable and Demonstrates No Secondary Meaning in the Applied-For Mark.

Opposers’ survey expert, Poret, has performed over 200 surveys in the areas of trademarks and trade dress, including roughly 75 secondary meaning surveys. He has been accepted as an expert in trademark surveys by a number of federal courts as well as the T.T.A.B. He received his JD from Harvard Law School in 1998, and has published a number of papers and given multiple talks regarding trademark surveys. (7/20/15 Poret (“Poret 1”) 7:19-8:5, 8:6-9:21; Opp. 63.)

Poret designed two surveys to test whether the applied-for mark has achieved secondary meaning. In both surveys, the universe consisted of purchasers of the types of engines that would embody the mark, and purchasers of the types of power equipment that would use such engines. Poret reviewed prior surveys done on behalf of Honda by Honda’s expert in this case, George Mantis, as well as Honda discovery in this case, to make sure he had the correct universe. Poret then used SIC codes to identify the actual businesses to contact. These were the same SIC codes that Mantis previously used. Finally, Poret contacted these organizations and screened them to make sure they were qualified to take the survey. (Poret 1 12:5-15:5; 16:19-19:13; 20:15-23:25; Opp. 64, 65.)

Poret performed two surveys. In Poret’s first survey, he used a test photograph of a midsize

Honda GX engine digitally altered to show every component in generally the same grey color (“greyscale”), and with all other brand cues removed including the Honda name, GX 160 product identifier, label, and all engine decals:



(Opposer 66; “Poret 1” 25:24-28:11.) The control photograph showed the Subaru Robin EX 21 engine, similarly digitally altered with a greyscale appearance and all branding cues removed.



(Opposer 67; Poret 1 30:11-33:15.) The Subaru engine was selected as the control because Honda has specifically stated that it does not embody the applied-for mark. (Poret 1 32:8-33:5; Conner 248:3-249:3; App. 93 [REDACTED])

[REDACTED] The test photograph yielded 41.1% association with Honda. The control photograph yielded 23% association with Honda. The difference between these percentages equals the net association that can be attributed to the applied-for mark, which in this case is 18.1%. This rate of association does not support secondary meaning. (Poret 1 38:3-40:15); *see Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 137 U.S.P.Q. 413, 428-29 (S.D.N.Y. 1963) (25% association was insufficient to prove secondary meaning).)

Poret’s second survey involved color photographs. The objective of this survey was to demonstrate the role that color plays in creating consumer association with Honda. (Poret 1 40:19-42:3.)

The test photograph was the midsize Honda GX in color, with the Honda name, GX 160 product identifier, and engine decals removed.



(Opp. 68; Poret 1 42:9-43:7.) The result of the questioning on this photo was a 59% association with Honda.⁷ (Poret 1 43:2-7.) The control photograph showed the Subaru Robin EX 21 engine digitally-altered to have the same three-color scheme as the Honda GX, but with all other brand cues removed.



(Opp. 69; Poret 1 43:13-45:1.) The result of the questioning on this photo was a 50% association with Honda.⁸ Subtracting the control association from the test association yielded a net association that can be attributed to applied-for mark of 9%. The results of this survey show a strong tendency to name Honda due to the distinctive three color scheme whether or not the engine embodies the applied-for mark. These figures do not support secondary meaning in the applied-for mark without color. (*Id.* at 44:15-45:22; 46:15-22.)

⁷ The fact that the red, white, and black test photo had almost 50% more Honda association than the greyscale test photo (41.1% to 59%) demonstrates the strong consumer association of those colors with Honda. (Poret 1 45:23-46:14.)

⁸ The fact that an engine that Honda believes to not be confusingly similar to the Honda GX has a 50% association with Honda when dressed with the red, white, and black color scheme further demonstrates the strong consumer association of those colors with Honda.

ii. The Mantis Survey is Unreliable Because it Did Not Test For Secondary Meaning in the Design Alone.

Honda also commissioned a secondary meaning survey. Honda's expert, Mantis, showed participants a black and white test photograph of a midsize Honda GX. The distinctive three color scheme of the GX was visible in the photo.



(App. 59.) This test photo resulted in a 51.3% association with Honda. (Mantis 43:2-12.) Mantis's control photograph did not contain the same three color scheme. Instead, Mantis chose an all-black control engine.



(App. 60; Mantis 153:10-13.) This control yielded 8.9% association with Honda, for a net association of 42.4%. (Mantis 46:5-23.)

The secondary meaning survey done by Mantis is fundamentally flawed and should be accorded little weight, if any, for several reasons. First and foremost, unlike Poret's greyscale photo that completely eliminated color, Mantis's black and white test photo revealed the distinctive three color scheme of the Honda GX. Mantis acknowledged that his test photo shows a white fuel tank, black air filter, and fan cover in a shade between white and black. Mantis also acknowledged that he was aware that the GX is sold in red, white, and black. (Mantis 97:3-98:22.) Mantis understood from past surveys

he had done for the GX that the prospective respondents of his secondary meaning survey would likely associate the three color scheme with Honda. (Mantis 98:23-107:1; Opp. 29, 30.) In fact, Mantis' three color scheme test photo resulted in a 51.3% association with Honda, not too far from the 59% association that Poret's full color test photo generated. (Mantis 43:2-12.)

By Mantis's own admission, it was improper to include color cues in his test photo. In critiquing Poret's color survey, Mantis noted prior Board holdings that "the introduction of such data, not claimed as part of the mark, produces information that is not relevant and **destroys the probative value of the study.**" (Mantis 66:17-67:15.) Indeed, federal courts and the Board have consistently accorded little weight to surveys that introduce unclaimed subject matter. *See, e.g., Spraying Systems Co. v. Delavan, Inc.*, 975 F.2d 387, 394 (7th Cir. 1992) (upholding rejection of secondary meaning survey that failed to properly isolate the mark); *Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S.P.Q.2d 1445, 1459-60 (T.T.A.B. 1986) (introducing "irrelevant matter" to a survey sample "destroy[s] any probative value of the survey for our purposes."); *McDonough Power Equipment, Inc. v. Weed Eater, Inc.*, 208 U.S.P.Q. 676, 685 (T.T.A.B. 1981) (criticizing survey for introducing "additional identification and differentiation factors" such as color and house marks).

Mantis compounded his problem when, unlike Poret, he totally failed to control for color in his control photo. Instead, Mantis chose an all-black control engine and attempted to control for color merely by not counting specific test-photo responses where color was the only reason given in the verbatim responses to the question of why the respondent associated the engine with Honda. This was improper for two reasons. First, according to leading survey scholar Ms. Shari Diamond, a proper control is a separate group of respondents shown a stimulus that has all of the elements of the test except for the claimed mark whose influence is being assessed.⁹ (O11NOR RR-11, 13.) Mantis recognizes that Ms. Diamond is an authority in surveys and has read her work, and agrees with this specific principle but failed to follow it. (Mantis 90:8-25, 91:22-92:3.) Second, it is fundamentally improper to control via verbatim responses because respondents don't always say what they are thinking. (10/8/15 Poret ("Poret 2") 23:14-24:13.) It

⁹ The Mantis control photo also improperly shows a silver muffler, which is not visible in the test photo and may have revealed to respondents that the engine was not a GX. (Poret 2 33:9-35:24)

is possible that respondents formed associations with Honda from Mantis' test photo because of the visible three color scheme but simply failed to mention it, particularly given that the three color scheme is distinctive to Honda. Indeed, 27 respondents in Mantis's survey specifically mentioned color, indicating a strong association with that unclaimed element. Mantis's failure to properly control for color renders his survey meaningless. See *Innovation Ventures, LLC v. N2G Distrib., Inc.*, No. 08-CV-10983, 2011 WL 6010206, at *5 (E.D. Mich. Nov. 30, 2011) (control improper due to "blatantly obvious differences" between control and test); *THOIP v. The Walt Disney Co.*, 788 F. Supp. 2d 168, 99 U.S.P.Q.2d 1323, 1332 (S.D.N.Y. 2011) (control improper because it "shared very few similarities" with the test); *Skechers U.S.A. v. Vans, Inc.*, No. CV 07-01703 DSF PLAX, 2007 WL 4181677, at *9 (C.D. Cal. Nov. 20, 2007) (control improperly failed to resemble the test "in every respect except [the mark].").¹⁰

Even if it were proper to control for irrelevant cues by making judgments based on the verbatim responses, Mantis did not perform this task correctly. First, Mantis counted responses that indicated association with Honda based on both color *and* design. (App. 62; Mantis 47:18-48:9, 130:13-138:15.) But there is no way for Mantis to know whether color was a necessary cause of these respondents associating the engine with Honda. (Poret 2 24:14-25:24.) Second, Mantis counted responses that identified the engine as a Honda based on the "type" or "appearance" of the engine, but did not mention any specific elements of the applied-for mark. (App. 62; Mantis 144:14-149:1.) It is impossible to tell whether these respondents identified Honda due to the three color scheme or the applied-for mark, but Mantis chose to nevertheless count them as Honda responses. (Mantis 147:24-148:14; Poret 2 15:4-15.) Finally, Mantis counted responses that only mentioned the fuel tank without specifying whether it was the tank's white color or its shape that triggered an association with Honda. (Mantis 138:20-140:13.) These responses could evidence association with the tank's white color, but Mantis chose to nevertheless count them as Honda responses. (Poret 2 14:21-15:3.) These defects illustrate the impropriety of attempting to control via verbatim responses instead of using a proper control photograph, as they result in a

¹⁰ While these cases address likelihood of confusion surveys, the guidelines regarding proper controls used in these surveys are the same as the those regarding proper controls in secondary meaning surveys. See *THOIP*, 788 F. Supp. 2d at 181 ("a control should share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.") (citation omitted).

significantly overstated percentage of association.

Mantis's survey contains a number of other defects that also contribute to its unreliability. First and foremost, Mantis counted responses indicating association with Honda plus one or more other companies. (App. 62; Mantis 114:20-116:11.) This methodology improperly presumes that the applied-for mark has secondary meaning, which is the very question the survey should be setting out to answer. (Poret 2 38:13-42:10.)¹¹ Second, Mantis left certain decals on the test photo that multiple respondents associated with Honda. (Mantis 52:10-19; 53:11-18.) Mantis admitted that these decals were not part of the applied-for mark. (Mantis 80:3-81:5.) Mantis failed to control for these decals, representing yet another example of Mantis failing to control for subject matter that is not part of the applied-for mark. (Poret 2 28:19-31:6.) Finally, Mantis asked the improper question of whether respondents associated the *engine*, rather than the *appearance of the engine*, with a single source. (App. 62, p. 1.) Mantis acknowledges that this is not the test for secondary meaning (Mantis 82:11-15), and asking the question in this way improperly opens the door to positive responses simply because respondents associate engines of this type or this general layout with Honda. (Poret 2 31:7-33:8.)

All together, these flaws in Mantis's survey, particularly his inclusion of the GX's three color scheme in his test photo but not in his control photo, render Mantis's results unreliable and irrelevant to the issue at hand: namely, whether the applied-for mark, without regard to color, has secondary meaning.

C. HONDA HAS ALLOWED THE APPLIED-FOR MARK TO BECOME GENERIC

The applied-for mark has become generic due to the widespread third party use of substantially similar designs.

1. Common Product Configurations Are Generic

Generic product configurations cannot be registered. *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 U.S.P.Q.2d 1532, 1535 (Fed. Cir. 1999); *Stuart Spector Designs*, 94 U.S.P.Q.2d at 1554 (sustaining opposition based on generic shape of applied-for mark). A product design is generic if it is "so common in the industry that it cannot be said to identify a particular source." *Id.* at 1555; *see also BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 U.S.P.Q.2d 1554, 1558 (Fed. Cir. 1995)

¹¹ Removing these respondents would lower the net association by 10%.

(“competitor use [of logo] is evidence of genericness”).

2. Widespread Third Party Use has Rendered the Applied-For Mark Generic

As discussed above, there is widespread use of the applied-for mark. Dozens of third party engines use a substantially similar overall cubic shape and configuration, which has become the industry standard for horizontal shaft engines. This widespread use has led to the applied-for mark becoming generic.

Honda has knowledge of many of these substantially similar third party engines, and in some cases has expressly agreed to their use. [REDACTED]

[REDACTED] In sum, the use of this engine configuration is so common in the industry in cannot be said to identify a particular source.

D. HONDA HAS ABANDONED THE APPLIED-FOR MARK

As set forth above, the overall shape and configuration of the applied-for mark is functional and is therefore not registrable under established legal principles. Assuming *arguendo* that it were possible to protect the minor embellishments identified in the application, Honda has abandoned those arbitrary flourishes. In 2008, Honda changed the external appearance of the front view of its GX engines. Honda no longer sells the version that embodies the applied-for mark, and does not intend on selling it again in the future. Honda has therefore abandoned the applied-for mark.

1. Legal Standards

A mark is abandoned when “its use has been discontinued with intent not to resume.” *Imperial Tobacco, Ltd., Assignee of Imperial Grp. PLC v. Philip Morris, Inc.*, 899 F.2d 1575, 14 U.S.P.Q.2d 1390, 1393 (Fed. Cir. 1990). The Board evaluates whether changes to a mark result in abandonment under the “same, continuing commercial impression” standard. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 U.S.P.Q.2d 1129, 1132 (Fed. Cir. 2015). In the closely related concept of tacking, the Federal Circuit explained the standard for showing a continuing commercial impression: “The previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark.” *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 U.S.P.Q.2d 1866, 1868 (Fed. Cir. 1991), *abrogated on other grounds by Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 910 (2015).

The Board has frequently held that changes in applied-for marks resulted in different commercial impressions. *See, e.g., Pro-Cuts v. Schilz-Price Enters., Inc.*, 27 U.S.P.Q.2d 1224, 1226-1227 (T.T.A.B. 1993) (PRO-KUT and PRO-CUTS); *Am. Paging Inc. v. Am. Mobilphone Inc.*, 13 U.S.P.Q.2d 2036, 2038-39 (T.T.A.B. 1989) (AMERICAN MOBILPHONE and AMERICAN MOBILPHONE PAGING); *Viviane Woodard Corp. v. Roberts*, 181 U.S.P.Q. 840 (T.T.A.B. 1974) (ALTER EGO and EGO); *Owens-Illinois, Inc. v. Optimist Int’l*, 173 U.S.P.Q. 120 (T.T.A.B. 1972) (removing letters from design background); *Unitec Indus., Inc. v. Cumberland Corp.*, 176 U.S.P.Q. 62 (T.T.A.B. 1972) (change from three “Cs” in a circle to two “Cs” in a circle) .

2. Honda has Ceased Use of the Applied-For Mark

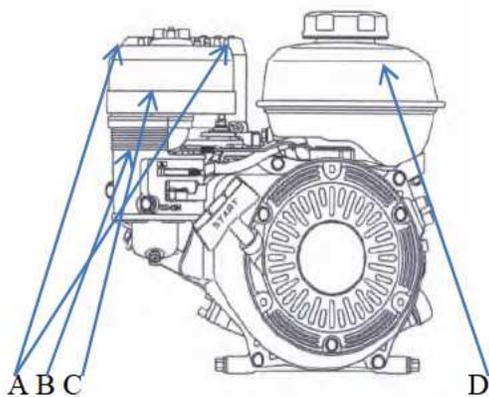
i. Honda No Longer Sells the Prior Version of the GX Engine.

As discussed, Honda redesigned the GX engine to comply with the EPA’s Phase 3 emissions regulations in 2008. The redesign included numerous changes to the external appearance of the front view of the engine. As a result of the redesign, the design shown in the applied-for mark is no longer being marketed and sold in the U.S.¹²

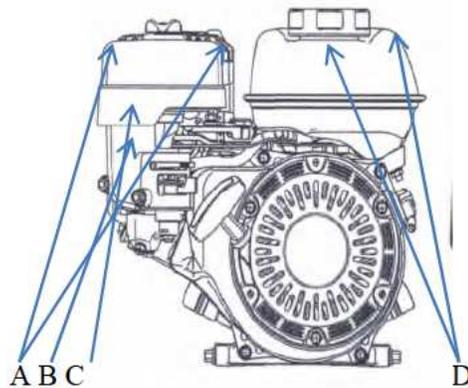
¹² The large-sized GX engines with Phase 2 designs remaining in Honda’s inventory do not save Honda from abandonment. because only the mid-sized Phase 2 engines embody the design of the applied-for mark.

ii. The Redesigned GX Has a Different Commercial Impression Than the Prior Version.

The redesigned GX engine is not the “legal equivalent” of the prior version because Honda changed the very features it claims are distinctive of the applied-for mark. In prosecution, the Examiner repeatedly forced Honda to specifically identify the elements of the applied-for mark. (See 8/15/07 Office Action; 4/27/09 Office Action.) Ultimately, in addition to the overall cubic shape of the engine, and the shape and location of its component parts, Honda identified the following elements: 1) beveled outside edges of air cleaner cover; 2) belt-like area on air cleaner cover; 3) ribs on carburetor cover; 4) beveling around the circumference of the fuel tank. Honda’s witnesses opined that these specific elements were distinctive and ornamental. (Conner 211:5-16 (ribs on carburetor cover are “specific unique features of the trade dress of the GX engine”); Mieritz 19:25-20:11, 25:12-17, 27:25-28:21, 29:22-30:19, 46:15-47:4, 51:10-13, 53:6-55:19, 86:21-88:1, 88:22-89:20, 90:18-91:20 (beveling distinctive and ornamental); 53:25-55:1 (distinguishing shape of air cleaner cover of Subaru Robin from shape of air cleaner cover of applied-for mark); 92:16-94:8 (same with different third party engine); 191:21-192:6 (ribs are distinctive and ornamental).) Honda argued to the Examiner that these four elements were “ornamental” to avoid functionality. (3/4/09 Resp. to Office Action at 4-5.) Honda changed each of these elements when it redesigned the GX. (Conner 203:9-212:5.) A comparison of the drawings is instructive:



Original Honda GX Engine



Redesigned Honda GX Engine

(Opp. 49.) Label A shows the beveling on the outside corners of the air cleaner cover, which were rounded as part of the redesign. Label B shows the ribs on the carburetor cover of the prior GX, which

(Conner 162:20-164:22.)

are not present on the redesigned GX (the shape of the carburetor cover also changed). Label C shows the belt-like area on the air cleaner cover of the prior GX, which has become more of a skirt on the redesigned engine. Finally, Label D shows the beveling around the front and corners of the fuel tank, which were rounded and eliminated, respectively, in the redesigned GX. Honda specifically claimed each of these features as elements of the applied-for mark, repeatedly argued that they were ornamental and distinctive, and changed them all when it redesigned the GX.

Internal and external Honda marketing materials underscore the differences between the applied-for mark and redesigned GX. [REDACTED]

[REDACTED] (O3NOR J-3-3; O3NOR J-82:1-83:8.) Similarly, customer-facing marketing material describes the redesigned GX as “completely redesigned for 2011.” (O14NOR VV.) Honda took all new photography for its advertisements following the redesign. (O4NOR K-59:7-16.) And the only Honda advertisement that does not feature the GX engine in color is an advertisement specifically aimed at drawing the viewer’s attention to the redesign’s new external appearance. (App. 83.)

Honda’s witnesses also confirm the lack of a continuing commercial impression. According to Mieritz, Honda’s customers could identify the differences between the applied-for mark and the redesigned GX. (Mieritz 190:21-191:21.) This testimony is crucial to the abandonment analysis, as the “commercial impression that a mark conveys must be viewed through the eyes of a consumer.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 U.S.P.Q.2d 1753, 1757 (Fed. Cir. 2012). Similarly crucial is the testimony of Honda’s corporate representative on the redesign, who admitted that Honda changed the external appearance of the GX to make the new engine [REDACTED]

[REDACTED] (O3NOR J-22:14-24:2.)

Thus, by altering the original elements that Honda itself claimed were distinctive so as to make the newly designed GX [REDACTED] over the applied-for mark, Honda’s changes give the redesigned GX a different commercial impression than the applied-for mark, and Honda has ceased use of the applied-for mark. *PBI Performance Prods., Inc. v. NorFab Corp.*, 514 F. Supp. 2d 725, 730 (E.D. Pa.

2007) (“A change in the form of a mark can be protected only if the *distinctive characteristics of the mark* before and after the alteration maintain the same, continuing commercial impression.”) (emphasis added); *see also In re CTB, Inc.*, 52 U.S.P.Q.2d 1471, 1476 (T.T.A.B. 1999) (deletion of “distinctive subject matter” constituted a material alteration of the mark).

3. Honda has no Intent to Resume Use of the Applied-For Mark

The second prong of the abandonment test is clearly satisfied. Multiple Honda witnesses admitted that Honda has no intent to resume use of the prior version of the GX. Conner 171:2-10; O4NOR K-65:6-66:25. In fact, it is currently a violation of the Clean Air Act to import or manufacture for sale in the U.S. the prior version of the GX. (Conner 167:7-168:21; 40 CFR §§1068.101, 1068.125, 1068.301, 1068.335.) There is no evidence in the record that Honda ever intends to resume use of the applied-for mark, and Honda has therefore abandoned it.

CONCLUSION

For all the foregoing reasons, Opposers' opposition should be sustained.

APPENDIX 1: OPPOSERS' OBJECTIONS TO HONDA'S EVIDENCE

I. OPPOSERS OBJECT TO CERTAIN TESTIMONY OF JAMES MIERITZ

Applicant offered the testimony of James Mieritz (“Mieritz”) “regarding the non-functionality of the Honda GX Engine Trade Dress.” (Applicant’s Pretrial Disclosures (dkt. 132); Mieritz Trial Deposition (dkt. 197).) Opposers object to the two categories of testimony proffered by Mieritz and identified below on the grounds that the testimony lacks reliability and foundation.¹³

A witness who is qualified as an expert may testify in the form of an opinion, but only if (a) the expert’s specialized knowledge “will help the trier of fact to understand the evidence or determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case.” Fed. R. Evid. 702. In other words, an expert’s opinion testimony is only admissible if the expert is qualified by knowledge, skill, experience, training or education on the subject matter of the testimony; his testimony is reliable, that is, based on sufficient facts or data and the product of reliable principles and methods reliably applied to the facts of the case; and his testimony is relevant, that is, it must assist the trier of fact. *Daubert v. Merrill Dow Pharm., Inc.*, 509 U.S. 579, 27 U.S.P.Q 1200, 1204-05 (1993).

Normally, shortcomings in the bases for and sources of an expert opinion go to the weight to be assigned to that opinion rather than to its admissibility. However, if an opinion is fundamentally unsupported, then it offers no expert assistance to the trier of fact, and its lack of reliable support may render the opinion more prejudicial than probative, making it inadmissible under Fed. R. Evid. 403. *Viterbo v. Dow Chemical Co.*, 826 F.2d 420, 422 (5th Cir. 1987); *see also Cook ex. Rel. Estate of Tessier v. Sheriff of Monroe Cty., Fla.*, 402 F.3d 1092, 1113 (11th Cir. 2005.)

¹³ For ease of reference, Opposers set forth the page and lines of objectionable testimony, together with the question(s) eliciting the testimony.

A. Testimony Comparing Components of the Honda GX Engine with Components of Other General Purpose Engines.

First, Mieritz offered his opinion on the comparative performance and quality of the GX engine to other general purpose engines. Opposers do not question Mieritz's qualifications to render opinions in this category of testimony. However, Mieritz's testimony lacks reliability as it is not based on sufficient facts or data, nor is it the product of reliable principles and methods reliably applied to the facts of the case.

Applicant asked Mieritz the following questions and elicited the following opinions regarding the comparison of components of the Honda GX engine to components of other engines in the market with respect to performance, quality and manufacturing cost:

32:4-20

4 Q. How do the fuel tanks in Applicant's
5 Exhibits 17, 21, 24 and 43 compare to the fuel
6 tank on the GX engine, in terms of performance?

7 MR. HERRING: Objection. Lacks
8 foundation.

9 Q. Mr. Mieritz, have you had actual
10 experience with the engines shown in Exhibits 17,
11 21, 24, and 43?

12 A. Yes, I have.

13 Q. And based on your experience, how do
14 the fuel tanks in those exhibits compare to the
15 fuel tank on the GX engine, in terms of
16 performance?

17 MR. HERRING: Same objection.
18 Foundation.

19 A. They all perform equally with respect
20 to the fuel tank.

32:21-33:8

21 Q. And how do the fuel tanks in
22 Applicant's Exhibits 17, 21, 24 and 43 compare to
23 the fuel tank on the GX engine in terms of
24 quality?

25 MR. HERRING: Same objection. Also
1 vague.

2 A. In terms of quality, I assume they all
3 perform the same as the Honda.

4 Q. And what does "quality" mean to you?

5 A. "Quality" means, to me, whether the
6 parts can withstand the life of the engine,
7 whether they crack, whether they fail before any
8 of the other engine components break.

44:23-45:5

23 Q. Now, based on your experience with the
24 engine in Exhibit 21, how does the fan cover on
25 that engine compare to the fan cover on the GX
1 engine, in terms of cost to manufacture?

2 MR. HERRING: Same objections.

3 MS. FRAZIER: You can answer.

4 A. Based on my experience, the
5 manufacturing costs would be similar.

43:15-44:2

15 Q. -- based on your experience with the
16 Briggs Intek engine, how does the fan cover on
17 that engine shown in Exhibit 21 compare to the
18 fan cover on the GX engine in terms of
19 performance?

20 A. My experience with Intek engines,
21 again, I was in the Vanguard line, but the
22 engineering departments run the same tests, run
23 the same comparative tests.

24 I would expect this shape to provide
25 adequate cooling for the performance of the
1 engine in all different circumstances, which
2 would be equivalent to what Honda has.

45:10-17

10 Q. -- have you seen any data indicating
11 that there's a difference in the performance
12 between the fan covers shown on Applicant's
13 Exhibit 17, 43, and 44 and the fan cover on the
14 GX engine?

15 MR. NOWAKOWSKI: Objection.

16 Foundation.

17 A. No, I haven't.

45:18-25

18 Q. Have you seen any data indicating there
19 is a difference in terms of cost to manufacture
20 the fan covers shown in Applicant's Exhibits 17,
21 43, and 44 as compared to the fan cover on the GX
22 engine?

23 MR. NOWAKOWSKI: Objection.

24 Foundation.

25 A. No, I haven't.

55:20-24

20 Q. How does the air cleaner cover in
21 Applicant's Exhibit 24 compare to the air cleaner
22 cover on the GX engine, in terms of performance?

23 A. It performs just as well as the Honda
24 engine.

55:25-56:24

25 Q. How does it perform in terms of cost to
1 manufacture?
2 MR. HERRING: Object to --
3 MR. NOWAKOWSKI: Objection to
4 foundation.
5 MR. HERRING: And the last question, as
6 well. Same objection.
7 Q. Mr. Mieritz, what engine is in
8 Applicant's Exhibit 24?
9 A. The Vanguard 9-horsepower.
10 Q. Do you have personal experience testing
11 the air cleaner cover on the Vanguard
12 9-horsepower engine?
13 A. Yes, I do.
14 Q. And based on that experience, how does
15 the air cleaner cover in the exhibit, Applicant's
16 Exhibit 24 compare with the Honda GX air cleaner
17 cover?
18 MR. HERRING: Same objection. Lacks
19 foundation. Also outside the scope of the
20 numerous expert reports.
21 MS. FRAZIER: You may answer.
22 A. In my experience, I would expect -- I
23 feel that the air cleaner cover performs as --
24 equally as well as the Honda air cleaner cover.

56:25-57:11

25 Q. And do you have experience with the
1 cost to manufacture the air cleaner cover shown
2 in Applicant's Exhibit 24?
3 A. Yes, I do.
4 Q. And based on your experience, how does
5 the cost to manufacture that air cleaner cover
6 compare to the cost to manufacture the type of
7 air cleaner cover shown in Honda's application?
8 MR. HERRING: Same objections. Lacks
9 foundation. Outside the scope of the expert
10 reports.
11 A. It would be similar in cost.

68:12-19

12 Q. In your opinion, do the differences you
13 just described between the locations of the
14 controls in Exhibits 17 and 21, as compared to
15 the GX engine, have any impact on the performance
16 of those controls?
17 MR. HERRING: Objection. Foundation.
18 A. No. These do not have any effect on
19 the performance.

68:20-69:1

20 Q. And, in your opinion, do any of the
21 differences you described, would they have any

22 impact on the cost to manufacture the controls?
23 MR. NOWAKOWSKI: Objection.
24 A. No. These variations that I've
25 described do not have an effect on the cost to
1 manufacture.

74:25 – 75:5

25 Q. Using that definition, what, if any,
1 impact does the overall cubic design shown in
2 Honda's application have on the performance of
3 the engine?
4 A. It has no effect on the performance of
5 the engine.

75:6-10

6 Q. What, if any, impact does the overall
7 cubic design shown in Honda's application have on
8 the quality of the engine?
9 A. The overall cubic design has no effect
10 on the quality of the GX engine.

75:11-15

11 Q. What, if any, impact does the overall
12 cubic design shown in Honda's application have on
13 the cost to manufacture the engine?
14 A. The overall cubic design has no effect
15 on the manufacturing cost of the engine.

75:16-20

16 Q. What, if any, impact does the overall
17 cubic design in Honda's application have on the
18 competitiveness of the engine?
19 A. The overall cubic appearance has no
20 effect on the competitiveness of the GX engine.

Mieritz's opinions and testimony were nothing more than conclusory answers that lack factual foundation and analytical support.¹⁴ Indeed, Applicant elicited no foundational facts to support Mieritz's conclusory statements regarding a comparison of the GX engine to competitor engines, and Mieritz offered no such specific factual predicate. For example, there is no evidence in the record that Mieritz ever performed any comparison testing between components of the GX engine and competitor engines

¹⁴ Applicant asked Mieritz generally whether he was familiar with costs associated with the manufacture of engines and whether he became familiar with competitor engines while he worked at Briggs & Stratton. However, in response, Mieritz merely described a general process regarding determination of cost at Briggs & Stratton but offered no testimony regarding actual component costs at Briggs & Stratton, Honda or other engine manufacturers, nor any comparative cost testing or data for components of the different engine manufacturers. Further, Mieritz has been retired and out of the small engine industry since 2006. (Mieritz 9:18-10:20; 138:20-25.)

with respect to performance, quality or cost of manufacture. There is no testimony in the record that Mieritz reviewed any comparison testing done by others. In fact, the record reflects the contrary. Mieritz admitted that before he rendered any opinions in this matter, he did not talk to any engineer at Honda involved with the design of the Honda GX engine (Mieritz 107:20-108:1), he did not talk to anybody at Honda regarding the styling of the GX engine (Mieritz 108:2-5), nor did he review any documents from Honda's styling group or any third party industrial designer hired by Honda for the GX engine (Mieritz 110:21-111:7).

And critically, even though Meiritz admits that data exists regarding the performance, quality and cost of manufacture of the components of the GX engine and components of the other engines about which he opined, he never asked for any such data, never talked to Honda about any such data, and never reviewed any such data (Mieritz 227:22-230:21.) Mieritz has not done any testing on the GX in the applied-for mark to compare its weight, mountability, reduced engine height, compactness, improved performance, improved quality or reduction of cost with any other engine in the market, except the Briggs Vanguard 9-horsepower engine at Exhibit 24. (Mieritz 258:2-13.) However, that testing was done in the mid-1980s and likely would not apply to engines on the market today. (Mieritz 258:14-18.)

The answers to the questions elicited above are naked conclusions, unsupported by any factual predicate, and therefore provide no assistance to the Board. Accordingly, these questions and answers should be stricken.

B. Testimony of Mieritz Regarding Industry Recognition of the Look of the GX Engine

Mieritz also testified about his perception of the market recognition of the GX engine appearance. However, Mieritz is not an expert in consumer research and, therefore, this testimony is beyond the scope of his expertise. Opposers specifically object to the admission of the following testimony:

96:12-97:8; 97:20-98:11

Q. During your time at Briggs & Stratton, did you have an opportunity to speak with any OEMs, distributors or dealers about competitors' engines?

A. Yes, I did.

Q. For what purpose?

A. We would -- I would go to the OEMs,

distributors and dealers with our sales and marketing people periodically. I was there usually with a new engine or we're trying to get a new customer. I was there as engineering support.

Q. Approximately how many times did you speak to OEMs, distributors or dealers about competitor engines during your time at Briggs?

A. OEMs, I visited approximately 20 times. Distributors, maybe ten times. Dealers, I would often go off on my own and talk to dealers. And it might be over 100 times.

Q. Did you ever discuss the Honda GX engine in any of those conversations?

A. Yes, we did.

* * * * *

Q. Based on those conversations, did you observe the extent to which people in the industry recognized the look of the GX engine?

NOWAKOWSKI: Objection.

Foundation.

A. Yes. I discussed with them the overall look of engines.

Q. And what was your observation with that respect?

NOWAKOWSKI: Same objection.

A. In discussing with them and even colleagues, it became apparent that the Honda engine, the overall look was easily identified throughout the industry.

Q. Based on your --

NOWAKOWSKI: I'd also object on hearsay grounds.

This testimony reflects Honda's attempt to offer Mieritz's anecdotal testimony on the issue of secondary meaning from someone who is not qualified to provide such testimony. Mieritz admits that he is not an expert in market research, either by education or experience (Mieritz 219:14-17.) He has never designed, conducted or analyzed a consumer survey (Mieritz 219:18-20.) He has no opinion to a reasonable degree of scientific probability within the area of consumer research that OEMs, distributors, dealers or other potential customers would immediately recognize the look of the GX engine and associate it with Honda (Mieritz 220:17-24.) Any testimony that he offers regarding customer recognition of the Honda GX based on its "overall look" is therefore outside the scope of his expertise and is not the product of reliable

principles and methods. Accordingly, his testimony does not meet the requirements of Fed. R. Evid. 702 or the basic standards for admissibility of expert testimony under *Daubert*.

Moreover, even if Applicant were attempting to offer Mieritz's testimony as lay opinion testimony, it is fundamentally unreliable and irrelevant. Mieritz admits that he does not remember asking OEMs, distributors or dealers what specific characteristics of the Honda engine caused them to recognize the engine as a Honda other than the "overall visual look" of the engine from a distance (Mieritz 220:25-221:15). There is no evidence in the record that Mieritz's "impression" was based on any OEM, distributor or dealer recognition of the Honda engine based on the specific features in Honda's claimed trademark. Accordingly, even if this testimony were somehow an admissible lay opinion, it is not reliable nor relevant to any issue or fact in this case.

II. OPPOSERS OBJECT TO THE ADMISSION OF DOCUMENTS RELATING TO HONDA'S PRIOR LITIGATION WITH THIRD PARTIES.

Through Applicant's Eighth Notice of Reliance, Honda offers for admission certain pleadings from two different trade dress actions commenced by Honda against parties other than Opposers in Federal Court. Specifically, Applicant offers Jury Instructions (Applicant Trial Ex. L), Jury Verdict (Applicant Trial Ex. K), and Permanent Injunction Order (Applicant Trial Ex. J) from *Powertrain, Inc., et al v. American Honda Motor Co., Inc.*, 1:03-cv-00688-MPM (N.D. Miss.) and Summary Judgment Order (Applicant Trial Ex. M) from *American Honda Motor Co., Inc. v. The Pep Boys, et al*, 2:05-cv-08879-WDK-VBK (C.D. Cal. Nov. 13, 2007.) These documents are not relevant to any issue or fact in this case and, therefore, are inadmissible.

The trade dress asserted in both the *Pep Boys* case and the *Powertrain* cases – which comprised all six sides of the GX engine – included many features which are not claimed in the applied-for mark, such as the valve cover shape and design; the engine oil fuel cap cover; the muffler heat shield design; the oil alert system placement; the location, shape, and design of the oil fill cap and drain cap; the number, location and size of the air cooling fins; the trapezoidal shape and size of the base pad; the wing-nut design of the air cleaner housing; the label placement and bolt location and orientation on the carburetor; and the design and orientation of the fuel tank mount. (Applicant Trial Ex. M at 2-3, footnote 2 and 3;

Applicant Trial Ex. J at 2-3.) In addition, because these documents pre-dated Honda's change to the appearance of the GX engine in 2008, (Conner 61:25-63:21, 64:5-65:5), the GX engine at the time of these cases included certain features of the Honda applied-for mark that the current GX engine does not.

Regarding the jury verdict in the *Powertrain* case, Honda failed to submit any testimony, documents, or other evidence admitted at that trial from which the Board could determine what swayed the jury to find Honda's asserted trade dress protectable and infringed, or whether or to what extent such evidence overlaps with the record before the Board here. The Court's Injunction flowed directly from the jury's determination. These documents are therefore irrelevant, confusing and prejudicial and should be stricken.

The Summary Judgment Order in the *Pep Boys* case suffers from the same factual distinctions from this trademark Opposition as do the *Powertrain* documents. Not only did *Pep Boys* involve a significantly different asserted trade dress than the applied-for mark, there are also references in the Summary Judgment Order to many documents not in evidence in this Opposition. Moreover, the *Pep Boys* court applied different legal standards than the Board will use here. There, the court found that "[t]o avoid summary judgment, Honda need only make 'some showing of nonfunctional features' of its trade dress." (Ex. J at p. 7:22-25.) Here, under Federal Circuit law, the standard is exactly the opposite: the existence of only a few minor non-functional elements does not render the claimed design non-functional. *See supra*. Given the different legal standards, the *Pep Boys* decision loses any preclusive effect. *Larami Corp. v. Talk To Me Programs, Inc.*, 36 U.S.P.Q.2d 1840, *14 (T.T.A.B. 1995) (district court finding concerning priority of use not binding in view of differences in interpretation of Trademark Act § 7(c) by Board and court). Finally, the Summary Judgment Order merely determines that Honda raised factual issues which precluded summary judgment. The T.T.A.B. has already made a similar finding in Opposers' Summary Judgment Motion in this case. (dkt. 88.) But neither determination is relevant to whether Honda's applied-for mark is registrable, on the complete record in this matter.

CONCLUSION

For the reasons set forth herein, Opposers' respectfully request the board to strike the testimony of Mieritz identified herein, as well as Applicant's proffered evidence relating to prior, unrelated litigation.

APPENDIX 2: INDEX OF TRIAL EXHIBITS

<u>WITNESS</u>	<u>EXHIBIT NUMBERS.</u>
WHITMORE, JEFF	Opp. 1-12; App. 1-9
LITT, CAMERON	Opp. 13-22; App. 10-18
REISEL, JOHN	Opp. 23-25; App. 19-40
MIERITZ, JAMES	Opp. 26-28; App. 41-52
MANTIS, GEORGE	Opp. 29-30; App. 53-65
CONNER, STEVEN SCOTT	Opp. 31-62; App. 66-105
PORET, HAL	Opp. 63-74
FUJITA, MOTOHIRO	Ex. 187-195

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing OPPOSERS BRIGGS & STRATTON CORPORATION'S AND KOHLER CO.'S TRIAL BRIEF has been served on the following counsel of record by depositing same in the U.S. Mail, first class postage prepaid this 11th day of December, 2015:

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