

ESTTA Tracking number: **ESTTA493696**

Filing date: **09/11/2012**

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

Proceeding	91200832
Party	Plaintiff Briggs & Stratton Corporation
Correspondence Address	ROBERT N PHILLIPS REED SMITH LLP 101 SECOND STREET SAN FRANCISCO, CA 94105 UNITED STATES ipdocket-chi@reedsmith.com, nborders@reedsmith.com, robphillips@reedsmith.com, ddaugherty@whdlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Robert N. Phillips
Filer's e-mail	robphillips@reedsmith.com
Signature	/RobertNPhillips/
Date	09/11/2012
Attachments	Briggs Stratton - Declaration of Connor Litt.pdf (7 pages)(234467 bytes)

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

BRIGGS & STRATTON CORPORATION
and KOHLER CO.,

Opposers,

v.

HONDA GIKEN KOGYO KABUSHIKI
KAISHA,

Applicant.

Opposition No. 91200832 (parent)

Opposition No. 91200146

Application Serial No. 78924545

DECLARATION OF CAMERON LITT

Cameron Litt makes the following declaration pursuant to 28 U.S.C. § 1746:

1. I am the Marketing Manager for the Kohler Engines division of Opposer Kohler Co. (“Kohler”) in the above-captioned action. I make this Declaration in response to the Honda Giken Kogyo Kabushiki Kaisha (“Honda”) Motion to Compel Production of Documents from Opposers Briggs & Stratton Corporation and Kohler Co (“Motion to Compel”).

2. I make this declaration based on my personal knowledge and on the business records of Kohler that were made at or near the time of the events they record and kept in the regular course of activities conducted by Kohler, because it is and was the regular practice of Kohler to maintain and retain such records.

3. In this proceeding on August 21, 2012, Honda filed a Motion to Compel. In this proceeding on August 24, 2012, the Trademark Trial and Appeal Board (“Board”) issued a Suspension Order pending disposition of the Motion to Compel. In this proceeding on August 31, 2012, Opposers Briggs and Kohler filed a Motion for Leave to File a Motion for Summary Judgment.

4. Kohler is a Wisconsin corporation with 30,000 employees located in over 50 countries.

5. Kohler's Engine Division is composed of approximately 1,100 employees located in Wisconsin, Mississippi and China. The division reports to Kohler Global Power regarding design, marketing and other business strategy, and Global Power is comprised of roughly 16 executive-level employees located in Kohler, Wisconsin.

6. The development team for the design of Kohler's horizontal gas shaft engines is composed of approximately 65 employees.

7. The Engine Division's marketing department consists of more than 15 individuals.

8. Kohler has manufactured horizontal-shaft engines since the 1920's, and since the 1950's, it has offered such engines for sale. Development of the SH265 engine began in approximately 2007, and the product went to market in 2009.

9. Kohler Engine's data storage is globally dispersed, and it has data that resides in three data centers located in Kohler, WI, Shanghai, China, and Cheltenham, England. Kohler Engine employees and other associates have individual storage on the network. Where the individual storage is located depends on the location of the individual. The estimated global amount of used storage within Kohler Engine's storage attached network (SAN) and application and files servers is 60 terabytes.

10. Responding to Honda's request for documents concerning the design, development, manufacture, sale, advertising and promotion of Kohler's horizontal shaft engines (including but not limited to the SH265 Series) would require an investigative effort to identify relevant data pertinent to design, creation, marketing, etc. This would require coordination of

different globally dispersed groups for identification and discovery efforts. Because Kohler's Corporate Security team does not have the resources to manage such an undertaking, it would have to incur the enormous expense of outsourcing the investigation and gathering of information to mitigate the business impact to the company.

11. Furthermore, without a more defined set of criteria in which to search on than as provided by Honda's discovery requests, it would take an enormous amount of time to complete. This is based on a plan of internal investigative discovery, planned global cooperation, and to reduce technical and business impact. Additionally the volume of information generated would need to be further reviewed for relevancy to the case as well as protection of Kohler Co. IP, and by Kohler's outside counsel for attorney-client privilege and other issues.

12. Besides having to attempt to get information and documents from many if not most of the current employees in Kohler Engine and Global Power, responding to Honda's discovery request would be further hampered by the fact that the lead marketing and engineering employees for the SH265 project are no longer with Kohler.

13. Collecting documents responsive to Honda's requests would involve undue expense and time, and would interfere with the proper conduct of business within Kohler.

14. On or about February 2, 2010, Honda sent a cease and design letter to Kohler, requesting that it stop selling its SH265 engines. A true and correct copy of the letter is attached hereto as Exhibit A. Since sending the letter, Honda has not taken any action against Kohler regarding the design of its SH265, or other horizontal shaft, engines.

Dated this 10th day of September, 2012.

s/ 

EXHIBIT A

February 2, 2010

By Federal Express

Herbert V. Kohler, Jr.
Chairman, CEO, and President
Kohler Co.
444 Highland Drive
Kohler, WI 53044



Mark G. Matuschak

+1 617 526 6559 (t)

+1 617 526 5000 (f)

mark.matuschak@wilmerhale.com

Re: Infringement of American Honda's Trade Dress

Dear Mr. Kohler:

This firm represents American Honda Motor Co., Inc. ("American Honda"). American Honda has enforceable rights to the unique, distinctive and immediately recognizable trade dress of Honda GX engines, generators and power equipment incorporating GX engines (the "GX Trade Dress"). I am writing about the illegal copying and unauthorized use by your company, Kohler Co., ("Kohler") of the GX Trade Dress. Specifically, we have learned that your company is offering for sale and/or selling an infringing product, Model No. SH265, at trade shows and on its website <www.kohlerengines.com>.

As you may know, American Honda has been selling GX engines, including model numbers GX120, GX160, GX200, GX240, GX270, GX340, and GX390, and generators and power equipment incorporating GX Engines in the United States since at least 1983. Standing alone or in certain power equipment like pumps, pressure washers and air compressors, GX engines have a unique, distinctive, and immediately recognizable design, characterized by numerous non-functional design elements and markings, including, in particular, the valve cover shape and design; the fan cover shape, including a unique combination of angular and rounded edges and the shape of the air guide portion of the fan cover; the air cleaner housing, including the wing-nut design; the carburetor housing, including the shape, plastic ribs, label and control placement and bolt locations and orientation; the combined and complementary shape of the fuel tank, air cleaner housing and heat shield each with a unique beveled edge angled to the outside of the engine and straight on the inside; the fuel tank size and shape; the engine oil cover color; the heat shield design; the oil alert system placement; the design and orientation of the fuel tank mount; the shape and design of the oil cover; the number, location and size of the air cooling fins; the trapezoidal shape and size of the pad; and the relative position and orientation of each of the major engine components.

When incorporated into generators, GX engines also have a unique, distinctive and immediately recognizable design, likewise characterized by numerous non-functional design elements and markings, including, in particular, the valve cover shape and design; the fan cover shape, including a unique combination of angular and rounded edges and the shape of the air guide portion of the fan cover; the air cleaner housing; the fuel tank size and shape; the engine oil fill

Mr. Kohler
Kohler Co.
Page 2

cap color; the muffler heat shield design; the oil alert system placement; the shape, design and orientation of the unattached fuel tank mounts; 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 size and shape of the base pad; and the relative position and orientation of each of the major engine components.

Products incorporating the GX Trade Dress are sold by stores and distributors throughout the United States. American Honda GX Engines are well-known for their performance benefits, such as quiet operation, reduced fuel and maintenance costs, low environmental impact, versatility, easy start-up, compact and lightweight design, usability in any position, high power, and wide, flat torque. Because of American Honda's exclusive use of the GX Trade Dress for more than 20 years, engines, generators and power equipment exhibiting the GX Trade Dress are associated with American Honda and with these sought-after performance characteristics.

As you may also know, the GX Trade Dress has been explicitly recognized as valid, enforceable, and infringed following a jury trial involving similar infringing products. *Powertrain, Inc. v. American Honda Motor Co., Inc.*, Civil Action No. 1:03CV668 (N.D. Miss. Aug. 13, 2007). I am attaching (as Exhibit A) a copy of the permanent injunction entered by the court in the *Powertrain* case, which explicitly recognizes the GX Trade Dress as valid and infringed.

The *Powertrain* Court also entered final monetary judgment against the defendants in connection with their manufacture, sale, offer for sale and/or distribution of infringing products. Among others, the Court entered judgment against Shaoxing Tongyong Engine Mading Company, Inc. for more than \$12 million in damages (attached as Exhibit B), Best Machinery, Inc. for more than \$13 million in damages (attached as Exhibit C), and the *Powertrain* defendants for more than \$29 million in damages (attached as Exhibit D).

In addition to the defendants involved in the *Powertrain* case, many manufacturers, distributors and retailers, including the Jiangdong companies ("Jiangdong"), the Lifan companies ("Lifan"), Liquid Combustion Technologies, Worldwide Electric, Optigenerators International, Great Lakes d/b/a Wen Power Products, Homier Distributing, YAT Electrical Appliance Co., Whally Min Co., Chongqing Shineray, Huasheng Zhongtian, Empire Liquidators, American Fab d/b/a Titan Industrial, Tadd Wholesale Supply and Champion Power Equipment, Inc. have either recognized in writing the validity of the GX Trade Dress and/or have agreed to cease selling products that Honda believes infringe the GX Trade Dress. Indeed, Jiangdong and Lifan, two of the largest engine manufacturers in China, have recognized the GX Trade Dress and agreed to redesign their engines so as to not infringe the GX Trade Dress, and Pep Boys, a large U.S. retailer, has agreed that it will no longer sell infringing Jiangdong and Lifan products.

American Honda has recently learned that Kohler is offering for sale and/or selling Model No. SH265, a product that Honda believes infringes the GX Trade Dress. Such conduct is likely to cause consumers to be confused or misled into believing that there is an affiliation, connection, and/or association between your company or the infringing product and American Honda, or that

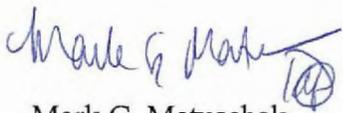
Mr. Kohler
Kohler Co.
Page 3

American Honda manufactured, sponsored or approved of such infringing products. Indeed, in Honda's view, the appearance of your product shows that it was intentionally designed to mimic the unique, distinctive and recognizable GX Trade Dress, and thereby to profit from, and trade on, the goodwill in the GX Trade Dress that has been established by American Honda. Manufacture, importation, use, offering for sale, or sale of such product, therefore, infringes the GX Trade Dress.

As you may expect, the GX Trade Dress is extremely valuable, making this an issue of grave concern to American Honda. In view of these circumstances, I must insist that your company immediately cease importing, using, offering for sale, and/or selling engines (either alone or incorporated in another product) bearing the GX Trade Dress. If I do not receive a prompt response to this letter, I will be forced to explore with our client additional means of legal redress available to protect these valuable intellectual property rights.

Please note that a number of companies have worked with Honda to redesign their products so as not to infringe the GX Trade Dress. Honda would be willing to consider a reasonable proposal from Kohler to achieve a businesslike solution to this issue.

Very truly yours,

A handwritten signature in blue ink, appearing to read "Mark G. Matuschak", with a circled "M" or similar mark at the end of the signature.

Mark G. Matuschak

MGM:dfd
Enclosures