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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	/Robert N. Phillips/
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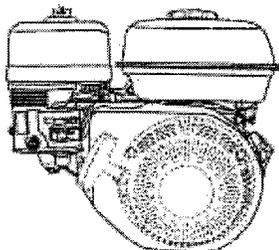


**TABLE OF CONTENTS**

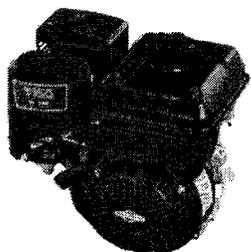
	<b>Page</b>
I. INTRODUCTION .....	1
II. SUMMARY OF RELEVANT FACTS .....	5
A. The Issues in the Opposition are Whether Honda’s Claimed Product Configuration Lacks Secondary Meaning and is Functional .....	5
B. Honda’s Document Requests Covered Virtually Every Document Pertaining to 42 Engines Manufactured and Sold by Opposers .....	5
C. Honda Has Accused the Briggs 550 and Kohler SH265 of Infringement of Honda’s Alleged Trade Dress Rights .....	7
D. Opposers Are Large Companies with Thousands of Employees Worldwide and Enormous Quantities of Electronic Information .....	7
III. ARGUMENT .....	8
A. Honda Failed to Make a Good Faith Effort to Resolve The Issues Raised In Its Motion .....	9
B. Even Given Honda’s Proposed Limitations, Honda’s Requests Remain Overbroad and Unduly Burdensome .....	10
C. Honda’s Request For All Documents Regarding Opposers’ Purchase of Honda GX Engines is Overbroad, Irrelevant and Unduly Burdensome .....	13
D. Honda’s Request for All Documents Concerning Differences or Similarities Between Opposers’ Products and the Honda GX Engine is Overbroad, Irrelevant, Vague and Ambiguous, and Unduly Burdensome .....	14
E. Honda’s Request for All Documents Concerning The Design and Manufacture of Opposers’ Products is Overbroad, Irrelevant, and Unduly Burdensome .....	15
F. This is the First Time Honda Has Limited Its Requests Regarding Marketing Materials .....	17
G. Honda’s Request for All “Business Plans” is Vague and Ambiguous, Unduly Burdensome, and Overbroad .....	18
H. Honda’s Request for All of Briggs’ Correspondence With Advertising Agencies Regarding the GX Engine Trademark is Overbroad .....	20
I. Opposers’ Actions Have Not Prejudiced Honda .....	20
IV. CONCLUSION .....	21

## I. INTRODUCTION

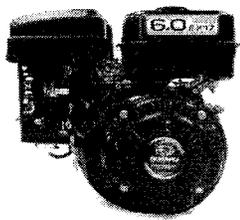
Applicant Honda Giken Kogyo Kabushiki Kaisha (“Honda”) seeks to trademark a product configuration that is a commercial utility engine with the following appearance:



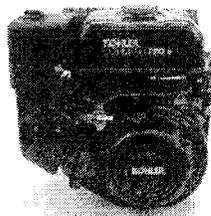
The claimed mark is described, in part, as an engine with (1) an overall cubic design, (2) a slanted fan cover, (3) a fuel tank located on top of the fan cover, (4) an air cleaner cover located to the left of the fuel tank, and (5) a carburetor cover (shown below the air cleaner cover) with a recessed area for control levers. Commercial utility engines with these same component parts, configuration, and overall cubic design have long been used in the engine industry. Honda’s competitors, including Opposers Briggs & Stratton Corporation (“Briggs”) and Kohler Company (“Kohler”), all offer these types of engines with the same or substantially similar component parts, placement, and overall configuration and commercial impression:



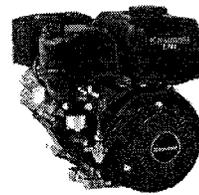
Briggs 750



Robin Subaru EX



Kohler Command Pro

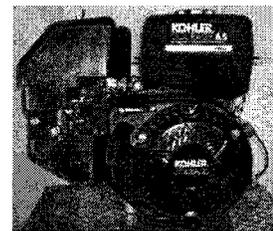
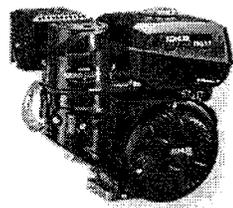
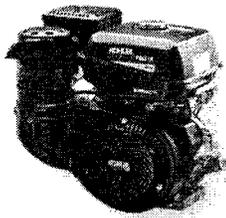


Kawasaki FJ180

Thus, Honda does not have substantially exclusive use of the claimed design, and none of these

third party engines were disclosed by Honda to the Trademark Examiner in Honda's Section 2(f) declaration of acquired distinctiveness. In addition, the claimed engine design has functional purposes, which are described in expired utility patents issued to Honda. It is designed to be cubic shaped and compact, so that original equipment manufacturers ("OEMs") can fit the engine easily, efficiently, and safely in construction equipment, such as pressure washers, tillers, and compactors. Indeed, engine manufacturers such as Briggs and Kohler must use this cubic design in order to compete against Honda for OEMs' business because OEMs design their power equipment to incorporate engines of this same standard cubic shape, layout, and compactness.

Accordingly, Briggs and Kohler have opposed Honda's application on the grounds that the claimed product configuration lacks secondary meaning as a trademark and is functional under well settled law.<sup>1</sup> In support of their opposition, Opposers disclosed to Honda numerous commercial engines with the same component parts, placement, and overall configuration and commercial impression. In addition to engines from Robin Subaru, Champion, Kawasaki, Lifan and others, this list included the following Kohler and Briggs engines:



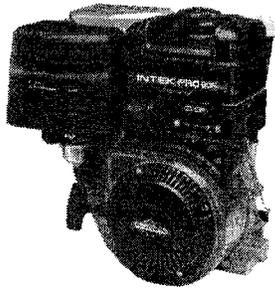
Kohler Command Pro CH440

Kohler Command Pro CH395

Kohler SH265

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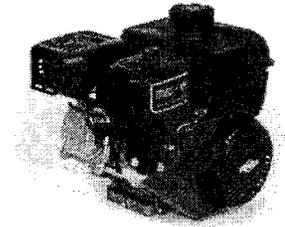
<sup>1</sup>Pursuant to the Board's order dated September 4, 2012 granting Opposers leave to file a second amended notice of opposition (Docket No. 22), Opposers plan to add genericness and abandonment as additional grounds for their opposition.



Briggs IntekPro206



Briggs Vanguard 6.5 HP



Briggs 550

In response, Honda served broad, trademark infringement-style document requests seeking virtually every document in Opposers' possession relating to the design, development, manufacturing, advertising and sale of the above referenced Briggs and Kohler engines. Opposers objected to the grossly overbroad and burdensome nature of these requests, and repeatedly urged Honda to narrow the requests so that Honda would focus on the sole issue before the Board: does the claimed product configuration serve as a trademark exclusively for Honda and is it functional? Honda resisted Opposers' pleas, and instead insisted that it is entitled to all of Opposers' design, development, manufacturing, advertising and sales documents. Opposers justifiably refused, and proceeded with a production that was narrowly tailored to the relevant issues before the Board (e.g. documents showing substantial third party use of engines having the same overall design, Briggs and Kohler's annual sales figures for its competing engines, sample advertising by Briggs and Kohler and other engine manufacturers, and Honda advertisements telling consumers to look for the HONDA trademark and not the claimed product configuration).

Unsatisfied, and without good cause, Honda has proceeded with this motion.

Recognizing that its requests go far beyond the bounds of reasonableness, Honda for the first time in its motion now says it is only interested in documents pertaining to two of Opposer's engines: the Briggs 550 and Kohler SH265. This, however, does not make the requests any less burdensome or irrelevant. Briggs and Kohler are very large companies with enormous quantities of electronic files and emails, and it would be incredibly difficult and expensive to search for and produce all documents regarding the design, development, manufacture, sales, and advertising of even just one engine.

Tellingly, there is a back story here that Honda has conveniently omitted from its motion. During the pendency of Honda's application, Honda sent Opposers cease and desist letters on the Briggs 550 and Kohler SH265, claiming that these specific engines infringed Honda's alleged trade dress rights. Honda threatened to file suit for infringement in federal court, but has not taken such action in the United States as of this date. Honda, however, recently filed suit against Briggs in Italy claiming that the Briggs 550 infringes Honda's trade dress rights. Opposers deny there is any infringement and intend to vigorously defend against Honda's claims. Honda's document requests are clearly a fishing expedition to try to support Honda's threatened trade dress infringement claims in the U.S., and the actual suit Honda filed in Italy (where discovery is not available).

Finally, Honda's argument -- that the issues of secondary meaning and functionality make its requests relevant and proper in scope -- is totally without merit. The requests clearly go well beyond the limited scope of facts relevant to those two issues, and would place an unwarranted burden on Opposers. When this burden is balanced with the limited relevancy of

Honda's requests, the impropriety is clear. Thus, Honda's motion should be denied.

## **II. SUMMARY OF RELEVANT FACTS**

### **A. The Issues in the Opposition are Whether Honda's Claimed Product Configuration Lacks Secondary Meaning and is Functional**

Honda has applied for registration of a product configuration consisting of a commercial utility engine with certain described component parts and a cubic shaped configuration ("applied-for mark"). Opposers both oppose registration of the applied-for mark on the grounds that it is functional and lacks secondary meaning. Dkt. No. 1. The Board has recently allowed Opposers to file amended Notices of Opposition which will add genericness and abandonment as additional grounds. Dkt. No. 22. Whether Opposers' engines infringe Honda's trade dress is not at issue.

### **B. Honda's Document Requests Covered Virtually Every Document Pertaining to 42 Engines Manufactured and Sold by Opposers**

On October 28 and December 13, 2011, Honda served its first sets of requests for production of documents to Briggs and Kohler, respectively. Despite the fact that Opposers' engines have limited relevance to the issues in this case (i.e., third party use of the claimed design), Honda's requests sought the production of essentially every document, file, or email ever generated that relates in any way to Opposers' similarly-configured engines. See Dkt. No 19, Exhs. E.1 and F.1. Specifically, Honda's requests sought "all documents" related to the design, development, manufacture, marketing, promotion, sale, and use of "Opposer's Products," which it defined as the Briggs 550, Kohler SH265, and any other engine Opposers contended were substantially similar to the applied-for mark. In addition, most of Honda's requests were not limited to the United States. In separate interrogatory responses, Opposers each listed 21 of their own engines that have the same or substantially similar component parts, placement, and overall configuration as Honda's applied-

for mark. Declaration of Seth B. Herring (“Herring Decl.”), Exhs. A, B. As a result, Honda’s requests for production necessarily covered a total of 42 different engines manufactured and sold by Opposers.

Opposers objected to Honda’s requests as overbroad and unduly burdensome, and in response Honda sent Opposers separate letters seeking full production of all responsive documents. Dkt. No. 19, Exhs. K, L. Honda’s letters made no mention of limiting the requests to the two specific engines Honda now focuses on its motion to compel (Briggs 550 and Kohler SH265). Opposers each sent a response letter to Honda, noting the extreme overbreadth of Honda’s requests and reminding Honda of the narrow nature of the oppositions. *Id.*, Exhs. Q, R. The parties then held a lengthy telephone conference regarding Honda’s requests and interrogatories, during which Opposers repeatedly explained why Honda’s requests were overbroad and unduly burdensome given the limited scope of the proceedings. Herring Decl., ¶ 4. In many instances, Honda admitted its requests were overbroad and agreed to narrow them considerably. However, in other instances, Honda refused to narrow its requests, often justifying a broad request by identifying a small subset of allegedly relevant documents within that request (much as it has done here). *Id.* During this call, which lasted almost three hours, Opposers repeatedly noted that Honda’s requests covered over 20 engines for each Opposer. *Id.* Not once did Honda tell Opposers that it was limiting its requests to the two engines listed in its motion to compel. *Id.*

The parties exchanged letters following the meet and confer, in which Opposers offered to produce narrower categories of documents relevant to the issues at hand: lack of secondary meaning and functionality of the applied-for mark. Dkt. No. 19, Exhs. Z, CC. Again Opposers in their letter noted that Honda’s requests covered over 20 engines for each Opposer. *Id.*, Exh. CC.

Honda did not accept Opposers' offers, and its letter again failed to notify Opposers that Honda intended to limit its requests to the Briggs 550 and Kohler SH265. *Id.*, Exh. Z. Moreover, Honda's requests remained drastically overbroad, as discussed further below.

**C. Honda Has Accused the Briggs 550 and Kohler SH265 of Infringement of Honda's Alleged Trade Dress Rights**

On February 2, 2010, Honda sent a cease and desist letter to Briggs, claiming that it infringed Honda's alleged trade dress rights in the engine which is the subject of the applied-for mark, and demanded that Briggs stop selling its 550 series engines. Herring Decl., Exh. C. On the same day, Honda sent a similar cease and desist letter to Kohler, making the same allegations of infringement and requesting that Kohler stop selling its SH265 series engines. Herring Decl., Exh. D. Both Briggs and Kohler denied any infringement. As of this date, Honda has not yet filed suit in the United States against either company regarding those engine designs. However, on July 12, 2012, Honda sued Briggs in Italy over the design of the 550 series engine. Herring Decl., ¶ 5. Document discovery is not available in Italian courts absent a court order. *Id.*

**D. Opposers Are Large Companies with Thousands of Employees Worldwide and Enormous Quantities of Electronic Information**

Briggs has 16 different offices in the U.S., located in nine different states. Declaration of Norm Mackensen ("Mackensen Decl."), ¶ 2. Briggs has another seven offices abroad (including in Canada, Europe, Asia, and Australia), for a total of 23 offices worldwide. *Id.* Of these 23 offices, 11 handle Briggs' business related to engines. *Id.* Briggs has over 6,000 employees, with over 4,900 working in its engines division. *Id.* at ¶ 3. Development of the 550 engine began in early 2008, and the product went to market in 2009. *Id.* at ¶ 4.

Briggs' data file servers contain over 125 terabytes of information. These servers are located in Wisconsin, Australia, Europe, and China. Mackensen Decl., ¶ 5. Briggs also maintains

email accounts for more than 2,000 employees. *Id.* Briggs does not own any e-discovery software, and therefore lacks the capability to electronically search its data files for relevant documents in a targeted, cost-effective manner. *Id.*

Kohler has over 30,000 employees in almost 50 countries. Declaration of Cameron Litt (“Litt Decl.”), ¶ 4. Kohler’s Engine Division is composed of approximately 1,100 employees located in Wisconsin, Mississippi and China. *Id.* at ¶ 5. 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. *Id.* The development team for the design of Kohler’s horizontal gas shaft engines is composed of approximately 65 employees, and the Engine Division’s marketing department consists of more than 15 individuals. *Id.* at ¶¶ 6,7. 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. *Id.* at ¶ 6.

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. Litt Decl, ¶ 7.

### **III. ARGUMENT**

Honda failed to meet and confer in good faith by failing to advise Opposers that it would ultimately drop its document requests to the extent they covered all of Opposers’ similar engine

designs, and that Honda would only move to compel production of documents related to the Briggs 550 and Kohler SH265 engines. Honda disingenuously forced Opposers to engage in several lengthy, expensive meet and confer communications with Honda covering the entire Briggs and Kohler 42 engine product line. This misuse of the meet and confer process, at substantial wasted time and legal expense to Opposers, alone warrants denial of Honda's motion.

Even with Honda's surprise limitation of its requests to the Briggs 550 and Kohler SH265 engines, Honda's requests remain overbroad, irrelevant, and unduly burdensome. The most relevant engine design in this case is the one that Honda is trying to trademark: the Honda GX series. Opposers' engines are only tangentially relevant to the extent they show that the applied-for product configuration is not substantially exclusive to Honda, and has functional purposes. Opposers' have produced the documents they intend to rely on, including documents showing the appearance of these engines, annual sales figures, and sample advertisements. Honda has refused to accept Opposers' production, despite the fact that they adequately address the issues in this case. Instead, Honda asks the Board to order Opposers to search the files of thousands of employees for virtually every document relating to two engines that Honda has accused of infringement. Opposers' alleged infringement is obviously not at issue in this case, yet Honda is trying to use these proceedings to get broad discovery on a potential United States infringement claim, as well as its ongoing infringement claim against Briggs in Italy. Honda's motion should therefore be denied.

**A. Honda Failed to Make a Good Faith Effort to Resolve The Issues Raised In Its Motion**

Recognizing the overbreadth of its requests, Honda now offers that its requests are limited to documents related to Opposers' "Knock-Off Products," the Briggs 550 and Kohler

SH265. Mot. at pp. 9, 13. Honda's motion is the **first time** Honda has limited its requests to just these two engines. Thus, Honda has failed to make a good faith effort to resolve the issues raised in its motion, and its motion should therefore be denied on this basis alone. TBMP § 523.02.

As discussed, Opposers have consistently pointed to the large number of engines included in Honda's definition of "Opposer's Products" as one of the reasons why Honda's requests were overbroad and unduly burdensome. Opposers listed each of these products in their responses because Opposers contend they are substantially similar to Honda's applied-for mark. Indeed, most or all of these 42 engines has a cubic design, slanted fan cover, fuel tank located over the fan cover on the right, and an air cleaner located to the left of the fuel tank, just like the applied-for mark. In addition to the numerous correspondence regarding these discovery requests in which Honda failed to raise this issue, Honda even asked Briggs to supplement its response to Honda's interrogatory asking Opposers to list all "Opposer's Products" ever sold in the U.S., or to confirm that Briggs had listed all such products. Dkt. No. 19, Exh. K. Not at that point, nor any of the other correspondence that followed, did Honda take the position that it only sought information regarding the Briggs 550 and Kohler SH265. Honda's motion therefore violates TBMP § 523.02, and should be denied as procedurally deficient.

**B. Even Given Honda's Proposed Limitations, Honda's Requests Remain Overbroad and Unduly Burdensome**

Honda's surprise limitation of its requests to the two products specified in its motion does not save all of Honda's requests from being overbroad and unduly burdensome. Throughout its motion, Honda attempts to distract the Board from the only relevant question here: whether Honda's document requests are narrowly tailored to the issue of lack of secondary meaning and functionality. Opposers' alleged infringement is not an issue in this proceeding. As such, characterizing

Opposers' products as "knock-offs" is misleading, and Honda's requests seeking broad discovery on these products are improper. Opposers attempted to remedy this overbreadth by proposing limitations aimed at getting at the specific documents that could potentially be relevant to the lack of secondary meaning and functionality, but Honda insisted on the production of all documents instead.<sup>2</sup>

Honda's applied-for mark, not Opposers' products, is what is most relevant here. Simply because Honda contends that the Briggs 550 and Kohler SH265 are "knock-offs" and too similar to the applied-for mark does not open the door to such broad discovery. Indeed, these are just two of several third party engines with the same overall configuration as Honda's applied-for mark. In short, Honda should not be permitted to discover broad sensitive competitive information which has nothing to do with whether the applied-for mark is registrable.

Honda's requests are also overbroad in that they are not limited to Opposers' activities in the United States. Honda has likely declined to limit its requests to the United States because it wishes to use these documents to support its case against Briggs in Italy, where discovery is not available. Honda should not be permitted to take discovery in this opposition for the benefit of its case in Italy, or for the benefit of a potential future U.S. infringement action.

Honda's requests would require interviewing and searching the files of literally thousands of employees for both Briggs and Kohler. As discussed, 11 Briggs offices handle business related to

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<sup>2</sup> Honda also attempts to distract the Board with accusations regarding Opposers' conduct and the parties' comparative productions to date. This is a red herring. The "nearly 100,000 pages" of Honda's production almost exclusively consists of documents produced and pleadings filed in prior federal court cases filed by Honda for alleged infringement of the GX engine trade dress. Herring Decl., ¶ 7. As to new issues that have arisen since those cases, Honda has produced essentially nothing. For example, Honda has produced only a few pages regarding the redesign of the GX engine in which a number of the claimed elements of the mark were removed from the engine design, including the beveled edges of the air cleaner cover and fuel tank, and the four ribs on the carburetor cover. *Id.* Thus, it does not appear as though Honda has engaged in a company-wide search for its own responsive documents, and has instead identified and produced specific documents it considers to be relevant – precisely the same conduct of Opposers that Honda complains about in its motion.

engines, including offices in several U.S. states, China, Europe, and Australia, and over 4,900 employees work in those offices. Mackensen Decl., ¶¶ 2, 3. Kohler's engine division comprises about 1,100 employees, located in Wisconsin, Mississippi, and China. Litt Decl., ¶ 4. Kohler's relevant data storage – comprising roughly 60 terabytes of information – is globally dispersed and resides on servers located in Wisconsin, China, and England. *Id.* at ¶ 6. Briggs' servers reside in Wisconsin, Australia, Europe, and China, and contain roughly 125 terabytes of information. Mackensen Decl., ¶ 5.

Responding to Honda's requests would be extremely time consuming and labor intensive for both companies. Collecting relevant documents would require coordination of different globally dispersed groups for identification and discovery efforts.<sup>3</sup> Litt Decl., ¶ 9; Mackensen Decl., ¶ 7. And without a more defined set of criteria in which to search, the amount of time it would take to complete Opposers' search and production would be immense. Litt Decl., ¶ 10; Mackensen Decl., ¶ 7. Such an endeavor would involve undue expense and time, and would interfere with the proper conduct of business within both Opposers. Litt Decl., ¶ 11; Mackensen Decl., ¶ 7. For Briggs, fully responding to Honda's requests would require the full attention of its six-person server IT team for a number of months, in addition to the hiring of outside contractors. Mackensen Decl., ¶ 7. A project of this size and scope would likely cost Briggs at least \$1,000,000 in vendor costs and attorney fees. *Id.*

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<sup>3</sup> 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. Litt Decl., ¶ 12.

The Board recently held that “the burden and expense of e-discovery will weigh heavily against requiring production in most cases.” *Frito Lay N. Am. v. Princeton Vanguard LLC*, 100 U.S.P.Q.2d 1904, \*6 (T.T.A.B. 2011). This is precisely one such case.

**C. Honda’s Request For All Documents Regarding Opposers’ Purchase of Honda GX Engines is Overbroad, Irrelevant and Unduly Burdensome**

Honda is moving to compel production of documents responsive to the following request: “All documents concerning the purchase by Opposer or anyone acting on behalf of Opposer, of a Honda engine embodying Appplicant’s Mark.” Dkt. No. 19, Exh. E.1, Request No. 28; Exh. F.1, Request No. 43. Because Briggs is a customer of Honda, and regularly purchases Honda engines for power equipment manufactured Briggs, Honda has now attempted to narrow this request to exclude documents concerning engines purchased for use in Opposers’ products.

This request remains overbroad, burdensome, and irrelevant for several reasons. Honda has failed to articulate why documents concerning the purchase of Honda engines – such as invoices or purchase orders – are relevant to this opposition. Purchase orders and receipts do not indicate whether the purchased engine was incorporated in Opposers’ products, was tested for competitive reasons, or put to some other use. Further, Honda and its dealers undoubtedly have their own records of engine sales to Opposers, begging the question of what more Opposers can provide that Honda does not already possess. Also, as noted, Briggs regularly purchases Honda engines for use in Briggs power equipment, and it would be very difficult and time consuming, if not impossible, to separate these purchases by their purpose. *See* TBMP § 402.01; Fed. R. Civ. P. 26(b)(2)(C)(iii) (“the court must limit the frequency or extent of discovery . . . if it determines that the burden or expense of the proposed discovery outweighs its likely benefit . . .”). The fact that Opposers, who are competitors of Honda, are in possession of, or familiar with, Honda

engines is not a fact seriously in dispute, just as Honda is admittedly in possession of Opposers' engines. There is no good reason to require Opposers to produce records regarding their purchases of Honda engines.

Honda will undoubtedly argue that documents regarding purchases of Honda's engines is relevant to show copying, a factor in determining whether the applied for engine configuration has acquired secondary meaning as a trademark for Honda. This document request, however, goes far beyond the question of copying, as it covers the purchase of any Honda GX engine without regard to any relevant purpose. If the request is properly limited to "documents evidencing Opposers' purchase of Honda engines purchased for the purpose of copying the external appearance of the Honda GX series," Opposers hereby respond that there are no responsive documents.

**D. Honda's Request for All Documents Concerning Differences or Similarities Between Opposers' Products and the Honda GX Engine is Overbroad, Irrelevant, Vague and Ambiguous, and Unduly Burdensome**

Next, Honda is moving to compel production of documents responsive to the following request: "All documents concerning any differences or similarities between Opposer's Products and any Honda engine embodying Applicant's Mark." Dkt., No. 19, Exh. E.1, Request No. 31; Exh. F.1, Request No. 46.

This request is objectionable for several reasons. First, it is vague and ambiguous because it fails to specify what "differences" or "similarities" it is after. It is also overbroad to the extent it covers "all documents" concerning "any differences or similarities." There are innumerable similarities and differences that have nothing to do with this proceeding: materials, colors, weight, cost, power, noise, vibrations, emissions, price, internal components, and the list

goes on and on. The only relevant differences and similarities – i.e. the external appearance of the engines – is shown by the engine photographs that Opposers have already produced.

Opposers and Honda are competitors, and the Briggs 550 and Kohler SH265 engines compete with the Honda GX series, the configuration in the applied for mark. The parties' respective engines are the same type, and are sold for the same purpose to the same customers. Thus, as would be expected, they would be compared and contrasted for competitive reasons regularly in the ordinary course of business. Accordingly, in order to comply with this request, Opposers would be forced to scour their entire companies for responsive documents. This would involve interviewing and/or searching the electronic files of not just every U.S. employee, but every employee worldwide. This burden far outweighs the relevancy, if any, of this request, and the request is therefore improper.

Honda's reliance on *Frito Lay N. Am. v. Princeton Vanguard LLC*, 100 U.S.P.Q.2d 1904 (T.T.A.B. 2011) is off base. That case did not involve a request for all documents regarding the similarities or differences between the parties' products. Indeed, the Board there warned against the same type of overbroad discovery that Honda now seeks:

In view of our limited jurisdiction, the narrowness of the issues to be decided by the Board, and the concerns expressed by the Federal Circuit, the burden and expense of e-discovery will weigh heavily against requiring production in most cases. Parties are advised to be precise in their requests and to have as their first consideration how to significantly limit the expense of such production. Absent such a showing, the likelihood of success of any motion to compel will be in question.

*Id.* at \*6.

**E. Honda's Request for All Documents Concerning The Design and Manufacture of Opposers' Products is Overbroad, Irrelevant, and Unduly Burdensome**

Honda next is moving to compel production of documents responsive to the following requests: “All documents concerning the selection, adoption, and use of any aspect of Applicant’s Mark by Opposer, including but not limited to the decision by Opposer to use, manufacture, sell, or offer for sale Opposer’s Products in the United States.”; “All documents related to the selection, adoption, use, registration, or defense of any aspect of the design of Opposer’s Products.”; “To the extent not included in previous requests, all contracts between Opposer and third parties which refer or relate to the design or manufacture of Opposer’s Products.” Dkt. No. 19, Exh. E.1, Request Nos. 9, 18, and 21; Exh. F.1, Request Nos. 24, 33, 36. In seeking all documents regarding the “use . . . of any aspect of the design of Opposer’s Products,” this set of requests calls for essentially every single document in Opposers’ possession regarding the relevant products. Even if these requests are “limited” to design and manufacture, they remain overbroad. For instance, the third request, seeking contracts between Opposers and third parties regarding the design or manufacture of the Briggs 550 and Kohler SH265, is simply irrelevant to these proceedings, and Honda has failed to argue otherwise. Honda’s other requests also seek vast quantities of irrelevant information, such as information regarding aspects of Opposers’ engines which have nothing to do with the claimed elements of the applied-for mark. Again, this opposition only deals with the registrability of Honda’s applied-for mark. Thus, it’s Honda’s applied-for mark and any Honda product embodying that mark that is at issue here, not Opposers’ products. Indeed, the 550 and SH265 are just two of many engines which incorporate the elements of the applied-for trade dress. Opposers have already agreed to produce any evidence of copying of the external appearance of the Honda’s GX engine (of which there is none), and documents supporting Opposers’ claims of lack of

secondary meaning and functionality. Requiring Opposers to produce all documents regarding the design, development, and manufacture of their engines is overbroad and burdensome. To find all responsive documents, each member of Opposers' design and development teams, as well as everyone who is involved with manufacturing, would need to be interviewed, and each of their files would need to be searched. The burden of such an endeavor far outweighs any limited benefit these documents may provide, thus Honda's requests are improper.

**F. This is the First Time Honda Has Limited Its Requests Regarding Marketing Materials**

Next, Honda is moving to compel production of documents responsive to the following requests, served on both Opposers: "All documents which relate or pertain in any manner to any advertisements or promotions of Opposer's Products and Opposer's business related to Opposer's Products, including but not limited to specimens of each and every advertisement or promotion used by oppose in connection with Opposer's Products."; "All documents related to Opposer's merchandising and promotional strategy for Opposer's Products." Dkt. No. 19, Exh. E.1, Request Nos. 13 and 20; Exh. F.1, Request Nos. 28 and 35. Honda has failed to properly meet and confer on these requests. As the Board can see, Honda initially requested **all documents** concerning advertisements and marketing materials (as opposed to just the materials themselves), including documents regarding Opposers' marketing strategy, and any other documents that "relate or pertain in any manner to" their marketing and advertising of the Briggs 550 and Kohler SH265. Opposers initially objected to these requests as overbroad and unduly burdensome, and Honda included these requests in its initial meet and confer letter to Opposers. Dkt. No, 19, Exhs. K, L. During the parties' meet and confer call, Kohler specifically asked whether Honda wanted the advertisements and marketing materials themselves, or if it was

instead requesting all documents concerning advertisements (such as related emails, presentations, etc.). Honda replied that it was seeking **all documents concerning advertisements and marketing materials**. Herring Decl., ¶ 4. Now, for the first time in this motion, Honda has narrowed its requests to only seek the advertisements and marketing materials themselves.<sup>4</sup>

Honda also takes issue with Opposers' use of the term "representative documents" when describing their production. Opposers were simply stating that they intended to produce a single copy of each of their marketing materials, as opposed to every copy in their possession. If Honda had met and conferred on this issue, this would have been clear.

As agreed, Opposers have produced at least one copy of all marketing materials and advertisements on the Briggs 550 and Kohler SH265. To the extent additional responsive documents exist, Opposers will produce them.

**G. Honda's Request for All "Business Plans" is Vague and Ambiguous, Unduly Burdensome, and Overbroad**

Honda is next moving to compel production of documents responsive to the following requests: "All documents concerning any plans or proposals Opposer has, ever had or considered for the expansion or contactation of its use of Opposer's Products (including new versions of Opposer's Products), including, but not limited to, any plans, proposals, or considerations for offering new Opposer's Products or discontinuing the sale of Opposer's Products (including new versions of Opposer's Products)."; "All documents concerning the business plans or strategies for use of the Opposer's Products in the United States, including but not limited to any business

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<sup>4</sup> Honda takes issue with Opposers' request that Honda reproduce its advertisements in color. Opposers asked for color advertisements to show that the secondary meaning of the applied for product configuration, if any, necessarily includes the signature red, white and black color scheme Honda uses on the for the GX engine. Indeed, not a single Honda advertisement shows the GX engine in any color other than red, white and black. Herring Decl., ¶ 7.

plans or strategies concerning the use, manufacture, sale, or offering for sale of the Opposer's Products." Dkt. No. 19, Exh. E.1, Request Nos. 12 and 22; Exh. F.1, Request Nos. 27 and 37.

These requests as written are clearly infringement-type requests, and therefore irrelevant to these proceedings. Honda's recent limitation to just the "business plans" concerning the use, sale, or offer for sale of the Briggs 550 and Kohler SH265 engines remains vague and ambiguous, unduly burdensome, and overbroad. First, Honda has never articulated what it means by "business plan." If Honda means any document where the future sale/marketing/use of the two products is discussed, it is asking for practically every document ever generated related to those products, including emails, power points, memos, or any other forward-looking document. And the "limitation" that the document must discuss the GX engine trademark or **any element of the mark** is no limitation at all, as the Briggs 550 and Kohler SH265, like many other engines, incorporate virtually every element of the applied-for mark. Clearly such a request would be overbroad and burdensome, for the reasons already discussed.

Even if Honda's request instead means documents identified as "Business Plans," it remains overbroad and burdensome. Honda's first justification for this request is that it could capture evidence of copying the GX engine's look. However, Opposers have already agreed to produce all such documents, if any. Honda then reaches for the rationale that Opposers should produce all business plans because it's possible one could show a "technical justification for changing a claimed feature of the GX Engine mark." This request is nothing more than a fishing expedition, which would require interviewing and searching the files of hundreds of employees over multiple offices for each Opposer. Honda's request should therefore be denied.

**H. Honda's Request for All of Briggs' Correspondence With Advertising Agencies Regarding the GX Engine Trademark is Overbroad**

Finally, Honda is moving to compel production of documents responsive to the following request, served on Briggs only: "All correspondence or other communication between Opposer and its advertising agencies referring or relating to Applicant's Mark." Dkt. No. 19, Exh. E.1, Request No. 26. As Honda acknowledges, Briggs has already agreed to produce any correspondence between Briggs and its advertising agencies regarding Honda's claim that its alleged mark has acquired distinctiveness and is not functional, which is the only relevant issue in this opposition. Honda failed to take issue with this limitation until bringing this motion, and Honda now fails to explain why the limitation is insufficient. Honda claims these communications may evidence Briggs' desire to trade off Honda's "goodwill" by emphasizing certain design elements in its own advertising. Yet, Honda points to no Briggs advertisement or marketing material where Briggs emphasizes any design element, let alone a design element of the applied-for mark. This is an unsubstantiated fishing expedition, and is therefore improper.

**I. Opposers' Actions Have Not Prejudiced Honda**

It is unclear why Honda argues that Opposers' actions have prejudiced it, and why that should have any bearing on its motion to compel. Regardless, it's simply not true. The documents regarding whether Honda's applied-for mark is functional is in Honda's control, not Opposers'. And Opposers have in fact produced many documents demonstrating the lack of secondary meaning, including many photographs of third party engines that are substantially similar to the applied-for mark. Further, discovery has been extended in this case, and Honda has yet to take any depositions. And perhaps most notably, Honda could have brought this

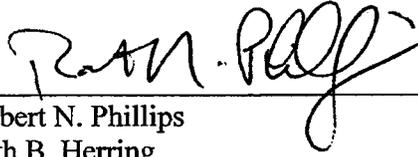
motion nearly two months ago, after Opposers sent their letter following the meet and confer. Dkt. No. 19, Exh. CC. Thus, any prejudice is Honda's own doing.

#### IV. CONCLUSION

In its motion, Honda seeks company-wide discovery regarding just two of many engine designs that incorporate the same shape and overall configuration of the applied-for mark. Responding to Honda's requests would require a lengthy search by Opposers, through documents located on multiple continents, at an extremely high expense. The only difference between these two engines and all of the others is that these are the two that Honda has accused of infringement. Honda should not be allowed to use the discovery process in this opposition to discover information regarding its potential infringement suits, especially given the fact that infringement is not an issue in the opposition. Honda's request are overbroad and unduly burdensome, and its motion should therefore be denied.

Dated: September 10, 2012

By: \_\_\_\_\_

  
Robert N. Phillips  
Seth B. Herring  
Nina Habib Borders  
Reed Smith LLP  
101 Second Street  
San Francisco, CA 94105

Attorneys for Opposer Briggs & Stratton Corporation

Dated: September 10, 2012

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

Donald A. Daugherty, Jr.  
Elisabeth Townsend Bridge  
Christopher R. Walker  
Whyte Hirschboeck Dudek S.C.  
555 East Wells Street, Suite 1900  
Milwaukee, WI 53202

Attorneys for Opposer Kohler Co.

**CERTIFICATE OF SERVICE**

In accordance with Rule 2.105(a) of the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing DECLARATION OF SETH B. HERRING IN SUPPORT OF OPPOSERS' OPPOSITION TO HONDA'S MOTION TO COMPEL was served on the following counsel of record for Applicant, by depositing same in the U.S. mail, first class postage prepaid, this 10th day of September, 2012:

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

/s/ Deborah L. Kalahale  
Deborah L. Kalahale