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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 ST SAN FRANCISCO, CA 94105 UNITED STATES ipdocket-chi@reedsmith.com
Submission	Motion to Consolidate
Filer's Name	Robert N. Phillips
Filer's e-mail	robphillips@reedsmith.com, dkalahale@reedsmith.com
Signature	/s/ Robert N. Phillips
Date	01/31/2012
Attachments	Briggs & Stratton - Opposers' Motion to Consolidate and Reset Dates.pdf ( 10 pages )(115879 bytes ) Briggs & Stratton - Decl of Robert Phillips iso Opposer's Motion to Consolidate and Reset Dates.pdf ( 22 pages )(844994 bytes )

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

BRIGGS & STRATTON CORPORATION,

Opposer,

vs.

HONDA GIKEN KOGYO KABUSHIKI  
KAISHA,

Applicant.

Opposition No. 91200832

Application Serial No. 78924545

**OPPOSER BRIGGS & STRATTON CORPORATION'S MOTION FOR  
CONSOLIDATION AND TO RESET DATES**

Pursuant to Rule 42(a) of the Federal Rules of Civil Procedure and TBMP Section 511, Opposer Briggs & Stratton Corporation (“Briggs”), with the consent of Kohler Company (“Kohler”) (collectively “Opposers”), hereby moves the Board to consolidate Opposition Nos. 91200832 and 91200146 (collectively “Oppositions”) and to reset the dates therein.

## **I. INTRODUCTION**

Briggs and Kohler have both opposed Honda Giken Kogyo Kabushiki Kaisha’s (“Honda”) Application Serial No. 78924545 (“Application”), which seeks to register the configuration of an industrial engine as a trademark. The Oppositions were filed less than two months apart, are in their early stages, and challenge the Application on the same following grounds: (1) the engine configuration claimed in Honda’s Application is functional and therefore cannot be a trademark, and (2) the Application is for a product configuration that is not inherently distinctive as a matter of law, and lacks secondary meaning as a trademark as a matter of fact. Thus, the Oppositions present identical questions of fact and law, and there would obviously be a substantial savings of time, effort, and expense to the Board and the parties from consolidation. Moreover, Honda cannot point to any prejudice or inconvenience from consolidation. Indeed, Honda previously represented to Briggs’ counsel that it intended to seek consolidation, but never followed through in making this simple request of the Board.

Briggs also requests that the dates in the consolidated action be reset for five months beyond the dates currently set in Kohler’s opposition proceeding. The parties in both oppositions are just beginning to engage in fact discovery. Honda has yet to make its agreed-upon document production to Briggs, despite being due for almost a month.

Honda claims it intends to produce a staggering number of documents, over 1 million pages in total. This will require a substantial amount of time to review and digest. Depositions cannot even get started until this is done. Also, given the complex questions regarding functionality and secondary meaning, there will be a need for expert opinion testimony. Obviously, the experts will require sufficient time, after the exchange of documents and the taking of depositions, to complete their analysis and prepare their reports. Consequently, the current schedules are far too condensed for the amount of work required to be performed, and resetting the dates is warranted. Again, Honda previously represented to Briggs' counsel that it would include with its motion for consolidation a request that the Board extend all dates by six months. Thus, Briggs' motion is consistent with the relief Honda previously agreed to seek, and should therefore be granted.

## **II. PROCEDURAL BACKGROUND**

Honda filed its Application claiming trademark rights in an engine design on July 7, 2006. After a lengthy series of office actions, the Application was published for opposition on January 25, 2011.

### **A. Briggs' Opposition**

Briggs filed its opposition to the Application on July 22, 2011. Briggs opposes the Application on two grounds: 1) the engine design lacks inherent distinctiveness and has not acquired secondary meaning, and 2) the engine design is functional. Dkt No. 1, ¶¶ 3-5. Honda answered Briggs' opposition on August 30, 2011. Dkt. No. 4. Expert disclosures are currently due on February 27, 2012, and fact discovery closes on March 28, 2012. Dkt. No. 2.

On October 25, 2011, Briggs served its first set of requests for production on Honda. Declaration of Robert N. Phillips (“Phillips Decl.”), ¶ 2. On November 29, 2011, Honda requested a 30 day extension to respond to Briggs’ requests for production, on the grounds that it needed more time to gather and produce its “over one millions [sic] documents” responsive to Briggs’ requests. *Id.* at exh. A. Briggs granted Honda’s request, and Honda served its responses to Briggs’ document requests on December 29, 2011. *Id.* at ¶ 4. However, Honda has only produced a handful of pleadings from a prior district court case, and has informed Briggs that it is withholding the vast majority of its production until a suitable protective order is in place.<sup>1</sup> *Id.* at ¶ 5.

### **B. Kohler’s Opposition<sup>2</sup>**

Koler filed its opposition on May 25, 2011. Kohler opposes the Application based on the same grounds as Briggs: lack of inherent/acquired distinctiveness and functionality.<sup>3</sup> Dkt No. 1, ¶¶ 4-7. On September 13, 2011, the Board ordered the proceedings suspended while Kohler and Honda discussed settlement. Dkt. No. 6. On December 9, 2011, Kohler moved to resume the opposition proceeding, and on December 27, 2011, the Board reset all dates. Dkt. Nos. 7, 8. Expert disclosures are currently due

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<sup>1</sup> Briggs and Honda have exchanged drafts of a modified version of the Board’s form protective order, but disagree on two issues: 1) whether Briggs’ in-house litigation counsel, who is uninvolved in Briggs’ competitive decision making, should be denied access to any of Honda’s confidential information; and 2) the conditions for disclosing experts and consultants. If this dispute cannot be resolved informally, Briggs and Honda intend to submit it to the Board for resolution.

<sup>2</sup> Counsel for Kohler has informed counsel for Briggs that Kohler consents to consolidation of the Oppositions. Phillips Decl., ¶ 10.

<sup>3</sup> A third opposition to the Application, also based on these grounds, was filed by Cummins, Inc. on September 22, 2008 (Opposition No. 91187217). This opposition is currently suspended. If this opposition resumes, it may be appropriate to consolidate it with the Briggs and Kohler oppositions.

on May 1, 2012, and fact discovery closes May 31, 2012. No depositions are currently scheduled, and the parties have not yet exchanged any documents. Phillips Decl., ¶ 11.

**C. Prior Discussions Between Honda and Briggs Regarding Consolidation of Proceedings and Resetting Dates**

Honda's counsel first proposed consolidating the Oppositions during a phone call with counsel for Briggs on December 13, 2011. Phillips Decl., ¶ 6. Two days later, on December 15, 2011, Honda agreed that it would also request the Board to extend all dates by six months as part of the consolidation order. *Id.* at exh. A. Honda also agreed that, until the proceedings were consolidated, it would consent to a three month extension of the Briggs schedule. *Id.* On December 30, 2011, in response to an email from counsel for Briggs, counsel for Honda indicated its client would not be filing a motion to consolidate "in the foreseeable future." *Id.* On January 9, 2012, Briggs asked Honda whether it would object to a motion to consolidate from Opposers. *Id.* at exh. B. Honda's counsel replied that Honda had not provided him an answer regarding consolidation, so Briggs could not represent to the Board that Honda did not object. *Id.* In an effort to gain Honda's consent, counsel for Briggs again raised the issue of consolidation in a phone call with Honda's counsel on January 20, 2012. *Id.* at ¶ 8. Again, Honda's counsel could not provide a response. *Id.* In a follow-up email, Briggs gave Honda until January 25, 2012 to consent to consolidation. *Id.* at ¶ exh. C. Counsel for Honda replied on January 27, 2012, saying his client "has still not made a decision" regarding consolidation, and on that basis would not consent to Briggs' motion. *Id.*

### III. ARGUMENT

#### A. Consolidation is Warranted Because The Issues of Law and Fact are Identical

Under TBMP § 511 and Federal Rule of Civil Procedure 42(a), the Board has the discretion to consolidate oppositions where there is a “common question of law or fact.” Here, the issues of law are identical: Briggs and Kohler have opposed the Application on the same two grounds, that: 1) the claimed design lacks inherent/acquired distinctiveness, and 2) the claimed design is functional. See Briggs Notice of Opposition, ¶¶ 3-5; Kohler Notice of Opposition ¶¶ 4-7. The issues of fact are also identical in each opposition, as all pertain solely to Honda’s claimed engine configuration. Issues which would involve different factual analyses for each Opposer, such as likelihood of confusion with Opposers’ marks, are not present in either opposition. Thus, the analyses in the Oppositions will be exactly the same. The Board routinely consolidates proceedings when they present identical issues. *See, e.g., Stuart Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 U.S.P.Q.2d 1549, 1554 (TTAB 2009) (17 consolidated oppositions opposing the same application on the grounds that the claimed trade dress lacks secondary meaning or is generic); *DataNational Corp. v. BellSouth Corp.*, 18 U.S.P.Q.2d 1862, 1863 (TTAB 1991) (describing consolidation of 24 opposers and 12 oppositions due to “general uniformity in the allegations”).

Additionally, consolidation here will cause no prejudice to Honda. As discussed, Honda previously indicated it was in favor of consolidation, but failed to follow through in making this request of the Board. Clearly, due to the identity of issues described

above, consolidation will save Board resources and promote efficiency. Consolidation is therefore warranted.<sup>4</sup>

**B. Dates Should Be Extended Five Months From The Dates Currently Set in the Kohler Proceeding**

Briggs requests that the dates be extended five months from the dates currently set for Kohler. Despite the fact that it is the first-filed case, the Kohler opposition has the later schedule by about three months due to the suspension and resumption. Thus, the schedule set in the Kohler opposition is more appropriately used as a starting point than the schedule set in the Briggs opposition.

At least a five month extension of those dates is also appropriate. Kohler has yet to serve any written discovery, due in large part to the parties' settlement discussions. Kohler and Honda have also yet to schedule any depositions. In the Briggs opposition, Honda is currently withholding over 1 million pages of documents until an agreed-upon protective order is in place. If Honda and Briggs are unable to resolve their differences, Briggs will move for entry of its desired form of protective order, which will likely further prolong Honda's delay in producing its documents. Even after Honda makes its production, Briggs will have a staggering number of documents to review. Once that is completed, depositions can then be scheduled. Opposers' experts will also need additional time, once the document exchange and depositions are conducted, to analyze and prepare their reports.<sup>5</sup>

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<sup>4</sup> In the event the Board orders consolidation, Opposers appoint Robert N. Phillips of Reed Smith LLP, attorney of record for Briggs, as lead counsel.

<sup>5</sup> Indeed, Honda relied on two technical experts reports and numerous distributor affidavits during the prosecution of the Application. Opposers expect Honda will do the same in this proceeding, and Opposers

Continued on following page

Honda previously indicated it would consent to a six month extension as part of a consolidation order. Since the Kohler schedule is later in time, the Board should consolidate and reset the remaining dates in both proceedings as follows:

Expert Disclosures Due:	<b>10/1/2012</b>
Discovery Closes:	<b>10/31/2012</b>
Plaintiff's Pretrial Disclosures:	<b>12/15/2012</b>
Plaintiff's 30-day Trial Period Ends:	<b>1/29/2012</b>
Defendant's Pretrial Disclosures:	<b>2/13/2012</b>
Defendant's 30-day Trial Period Ends:	<b>3/28/2013</b>
Plaintiff's Rebuttal Disclosures:	<b>4/12/2013</b>
Plaintiff's 15-day Rebuttal Period Ends:	<b>5/12/2013</b>

#### **IV. CONCLUSION**

Briggs' and Kohler's oppositions involve identical questions of law and fact, and their consolidation will save Board resources and promote efficiency. Moreover, it is essential to reset the dates as set forth above to allow the proceedings to be conducted in an orderly fashion, given the substantial amount of outstanding discovery and expert work that needs to be accomplished.

DATED: January 31, 2012

By:

/s/ Robert N. Phillips

Robert N. Phillips  
Reed Smith LLP

Nina Habib Borders  
Reed Smith LLP

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Continued from previous page

will need to counter with their own technical experts. In addition, Honda may try to rely on a secondary meaning expert report, which will require further response from Opposers.

Seth B. Herring  
Reed Smith LLP

Attorneys for Opposer  
BRIGGS & STRATTON  
CORPORATION

**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 OPPOSER BRIGGS & STRATTON CORPORATION'S MOTION FOR CONSOLIDATION AND TO RESET DATES was served on the following counsel of record for Applicant, by depositing same in the U.S. mail, first class postage prepaid, this 31st day of January, 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 Kalahale*  
\_\_\_\_\_  
Deborah L. Kalahale

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

BRIGGS & STRATTON CORPORATION,

Opposer,

vs.

HONDA GIKEN KOGYO KABUSHIKI  
KAISHA,

Applicant.

Opposition No. 91200832

Application Serial No. 78924545

**DECLARATION OF ROBERT N. PHILLIPS IN SUPPORT OF OPPOSER  
BRIGGS & STRATTON CORPORATION'S MOTION FOR CONSOLIDATION  
AND TO RESET DATES**

I, Robert N. Phillips, declare as follows:

1. I am a partner in the law firm of Reed Smith LLP, counsel of record for Briggs & Stratton Corporation ("Briggs"). The matters set forth herein are based upon my personal knowledge, except where otherwise indicated, and if called as a witness I could and would testify competently thereto.

2. On October 25, 2011, Briggs served its first set of requests for production on Applicant Honda Giken Kogyo Kabushiki Kaisha ("Honda").

3. Attached hereto as **Exhibit A** is a true and correct email string between me and Honda's counsel, dated between November 29, 2011 and December 30, 2011.

4. Honda served its responses to Briggs' document requests on December 29, 2011.

5. To date, Honda has only produced a handful of pleadings from a prior district court case, and counsel for Honda Mr. Michael Bevilaqua informed my colleague Seth Herring that Honda is withholding the remainder of its production until a suitable protective order is in place. Mr. Bevilaqua and Ms. Barakat advised me that they had over one million pages of Honda documents to review for production.

6. During our Rule 26 conference of telephone conference of counsel on December 13, 2011, Honda's counsel Ms. Barbara Barakat advised me that Honda intended to file a motion to consolidate the Briggs, Kohler and Cummins oppositions.

7. Attached hereto as **Exhibit B** is a true and correct email string between me and Mr. Bevilaqua, dated between January 9, 2012 and January 10, 2012.

8. I am informed that my colleague Mr. Herring asked Mr. Bevilaqua if Honda would consent to consolidation during a phone call on January 20, 2012. Mr. Bevilaqua indicate that he has had several calls with Honda regarding consolidation, but could not yet provide a definitive response.

9. Attached hereto as **Exhibit C** is a true and correct copy of an email exchange between Mr. Herring and Mr. Bevilaqua, dated January 20, 2012 and January 27, 2012.

10. Mr. Donald Daugherty, counsel for Kohler Company ("Kohler"), has informed me that Kohler consents to consolidation.

11. I am informed that no depositions have been scheduled yet in Kohler's opposition proceeding against Honda, and that Honda and Kohler have not yet exchanged any documents.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on the 31st day of January, 2012 at San Francisco, California.

By */s/ Robert N. Phillips*

\_\_\_\_\_  
Robert N. Phillips

**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 ROBERT N. PHILLIPS IN SUPPORT OF OPPOSER BRIGGS & STRATTON CORPORATION'S MOTION FOR CONSOLIDATION AND TO RESET DATES was served on the following counsel of record for Applicant, by depositing same in the U.S. mail, first class postage prepaid, this 31st day of January, 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. Kalahela*  
\_\_\_\_\_  
Deborah L. Kalahela

# **EXHIBIT A**

**Kalahele, Deborah L.**

---

**From:** Bevilacqua, Michael [Michael.Bevilacqua@wilmerhale.com]  
**Sent:** Friday, December 30, 2011 2:31 PM  
**To:** Phillips, Robert N. (Rob); Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Kalahele, Deborah L.; Davidson, Janey  
**Subject:** RE: Briggs & Stratton v. Honda

Rob

My secretary is out today and I cannot find a copy of the responses that were mailed out yesterday. I will have them emailed to you on Tuesday.

At this point it does not appear that we will be filing the Motion to Consolidate in the foreseeable future.

I will look into the protective order and get back to you early next week on that as well.

Mike

**Michael J. Bevilacqua | WilmerHale**  
60 State Street  
Boston, MA 02109 USA  
+1 617 526 6448 (t)  
+1 617 526 5000 (f)  
michael.bevilacqua@wilmerhale.com

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**From:** Phillips, Robert N. (Rob) [mailto:RobPhillips@ReedSmith.com]  
**Sent:** Friday, December 30, 2011 12:20 PM  
**To:** Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Kalahele, Deborah L.; Bevilacqua, Michael  
**Subject:** RE: Briggs & Stratton v. Honda

Barbara:

Can you please email us Honda's responses that were served yesterday.

1/31/2012

Also, what is the status of your motion to consolidate? And we are still waiting to receive your proposed stipulated protective order.

Thanks,

Rob

**Robert N. Phillips | Reed Smith LLP**

101 Second Street - Suite 1800 San Francisco, CA 94105

Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269

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---

**From:** Barakat, Barbara [<mailto:Barbara.Barakat@wilmerhale.com>]  
**Sent:** Thursday, December 22, 2011 11:33 AM  
**To:** Phillips, Robert N. (Rob)  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Kalahale, Deborah L.; Bevilacqua, Michael  
**Subject:** RE: Briggs & Stratton v. Honda

Rob:

Our client will not agree to a 6 month extension, but will consent to a 3 month extension to all the trial dates in this proceeding. We will serve our response to the Requests for Production of Documents by December 29th and we expect to receive Briggs & Stratton's responses when due.

If you have any questions, don't hesitate to contact us.

Barbara

Barbara A. Barakat  
WilmerHale  
60 State Street  
Boston, MA 02109 USA  
617-526-6154 (t)  
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[barbara.barakat@wilmerhale.com](mailto:barbara.barakat@wilmerhale.com)

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**From:** Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]  
**Sent:** Friday, December 16, 2011 2:12 PM  
**To:** Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Kalahale, Deborah L.; Bevilacqua, Michael  
**Subject:** RE: Briggs & Stratton v. Honda

Barbara:

Given the uncertainty as to when Honda will be filing a consolidation motion, if at all, we would like to

1/31/2012

go ahead and file a joint motion to extend the trial dates in our case by six months. Please let us know if this is acceptable, and we will prepare. Thank you.

Rob

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---

**From:** Barakat, Barbara [<mailto:Barbara.Barakat@wilmerhale.com>]  
**Sent:** Thursday, December 15, 2011 10:42 AM  
**To:** Phillips, Robert N. (Rob)  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Kalahelle, Deborah L.; Bevilacqua, Michael  
**Subject:** RE: Briggs & Stratton v. Honda

Rob:

We understand that Honda's discovery requests will be due January 3rd due to the holiday.

We are not sure when we will be filing the motion as we are waiting for final approval from our client. If the motion is granted, we would certainly consent to a 6 month extension of the dates in the proceeding.

We have taken note of the specific documents you are requesting.

Once we have more specifics for you, either Mike or I will contact you.

Barbara

Barbara A. Barakat  
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617-526-5000 (f)  
[barbara.barakat@wilmerhale.com](mailto:barbara.barakat@wilmerhale.com)

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**From:** Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]  
**Sent:** Tuesday, December 13, 2011 2:19 PM  
**To:** Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Bevilacqua, Michael; Kalahelle, Deborah L.  
**Subject:** RE: Briggs & Stratton v. Honda

Barbara:

1/31/2012

Just to confirm, Briggs' responses to Honda's discovery requests will now be due on January 3rd (since the 2nd is a holiday).

Also, you indicated that Honda intends to file a motion to consolidate this TTAB proceeding with two other oppositions. I assume you will be requesting a new, extended schedule to apply to the consolidated proceedings as part of the motion. When do you expect to file the motion, and what new schedule do you have in mind? Clearly, given the volume of documents you indicated will be produced by Honda, and the complications of coordinating depositions among several parties, we think the dates should be extended by at least six months. Let us know if you agree.

Finally, as I mentioned in our call, we would like to get copies of certain of the pleadings from the Honda/Pep Boys case as soon as possible in advance of Honda's full production to Briggs. Attached is the docket from that case, and below is a list of the documents by docket number that we would like you to forward at your soonest opportunity:

215, 288, 297, 299, 330 (re MSJ on functionality issue)

219, 293, 294, 318 (re MSJ on secondary meaning issue)

270, 274, 289, 324 (re Daubert motion on Mantis survey)

271, 273, 290, 326 (re Daubert motion on Gelb survey)

401 (Court Order on motions)

Please let us know if you have any questions or concerns, and when we can expect to receive these documents. I look forward to hearing from you soon.

Thank you,

Rob

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---

**From:** Barakat, Barbara [<mailto:Barbara.Barakat@wilmerhale.com>]

**Sent:** Tuesday, November 29, 2011 2:05 PM

1/31/2012

**To:** Phillips, Robert N. (Rob)  
**Cc:** Borders, Nina Habib; Herring, Seth B.; Bevilacqua, Michael  
**Subject:** RE: Briggs & Stratton v. Honda

Rob:

Further to our telephone conference, thank you for consenting to the 30 day extension of time for Honda to respond to Briggs & Stratton's requests for production of documents. The new deadline will be December 29, 2011. We will, of course, agree to a similar extension of time for Briggs & Stratton's responses to Honda's discovery requests.

As you requested, we inquire as to the format of the production in the related litigation and we will send you a draft Protective Order for your review shortly.

Should you wish to extend all of the dates in this proceeding by the 30 days extended, we will consent to that extension.

Barbara

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**From:** Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]  
**Sent:** Tuesday, November 29, 2011 4:27 PM  
**To:** Bevilacqua, Michael; Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.  
**Subject:** RE: Briggs & Stratton v. Honda

Mike:

Today I am around. Tomorrow is bad. I am available Thursday and Friday pretty much any time. Let me know.

Rob

**Robert N. Phillips | Reed Smith LLP**  
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1/31/2012

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**From:** Bevilacqua, Michael [<mailto:Michael.Bevilacqua@wilmerhale.com>]  
**Sent:** Tuesday, November 29, 2011 1:01 PM  
**To:** Phillips, Robert N. (Rob); Barakat, Barbara  
**Cc:** Borders, Nina Habib; Herring, Seth B.  
**Subject:** RE: Briggs & Stratton v. Honda

Dear Mr Phillips

We are filing a motion today for a month extension since you are not willing to grant it to us. As Barbara Barakat mentioned in her email, there are over 1 million pages of documents that need to be reviewed and we cannot serve written responses until these documents are reviewed.

We also need to discuss how these documents will be produced. Are there any times this week that you would be available for a call?

Mike Bevilacqua

**Michael J. Bevilacqua | WilmerHale**  
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Boston, MA 02109 USA  
+1 617 526 6448 (t)  
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**From:** Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]  
**Sent:** Tuesday, November 29, 2011 3:17 PM  
**To:** Barakat, Barbara  
**Cc:** Borders, Nina Habib; Bevilacqua, Michael; Herring, Seth B.  
**Subject:** RE: Briggs & Stratton v. Honda

Let's go with two weeks for the written response, and 30 days for the production. We will want the same extension. And we'll need to extend the case schedule.

1/31/2012

**Robert N. Phillips | Reed Smith LLP**

101 Second Street - Suite 1800 San Francisco, CA 94105

Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269

[robphillips@reedsmith.com](mailto:robphillips@reedsmith.com) | [www.reedsmith.com](http://www.reedsmith.com)

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**From:** Barakat, Barbara [<mailto:Barbara.Barakat@wilmerhale.com>]

**Sent:** Tuesday, November 29, 2011 11:35 AM

**To:** Phillips, Robert N. (Rob)

**Cc:** Borders, Nina Habib; Bevilacqua, Michael; Herring, Seth B.

**Subject:** RE: Briggs & Stratton v. Honda

Rob:

Thanks for your reply. We do not feel that 30 days is an excessive extension. By our estimates, there may be over one millions documents that are responsive to your requests. Before we prepare the written requests, we need to review these documents. Accordingly, we ask that you agree to the full 30 day extension.

Barbara

Barbara A. Barakat

WilmerHale

60 State Street

Boston, MA 02109 USA

617-526-6154 (t)

617-526-5000 (f)

[barbara.barakat@wilmerhale.com](mailto:barbara.barakat@wilmerhale.com)

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**From:** Phillips, Robert N. (Rob) [<mailto:RobPhillips@ReedSmith.com>]

**Sent:** Tuesday, November 29, 2011 1:04 PM

**To:** Barakat, Barbara

**Cc:** Borders, Nina Habib; Bevilacqua, Michael; Herring, Seth B.

**Subject:** RE: Briggs & Stratton v. Honda

Barbara:

I received your telephone message today requesting a 30 day extension of time to respond to Briggs' document requests. You indicated that you tried to reach me previously, but I have no record of receiving a message. There are two Robert Phillips at Reed Smith, so perhaps that may have been the problem.

In any event, I am willing to provide a reasonable extension, but 30 days seems excessive, at least with respect to serving the written response. I understand you may need more time to gather and produce the

1/31/2012

documents, but when do you think you could have the written response ready to serve?

Also, with respect to your request to have a conference call to discuss discovery matters, I am generally available today after 11 PST.

Regards,

Rob

**Robert N. Phillips | Reed Smith LLP**

101 Second Street - Suite 1800 San Francisco, CA 94105

Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269

[robphillips@reedsmith.com](mailto:robphillips@reedsmith.com) | [www.reedsmith.com](http://www.reedsmith.com)

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**From:** Barakat, Barbara [<mailto:Barbara.Barakat@wilmerhale.com>]

**Sent:** Tuesday, November 29, 2011 9:59 AM

**To:** Phillips, Robert N. (Rob)

**Cc:** Borders, Nina Habib; Bevilacqua, Michael

**Subject:** Briggs & Stratton v. Honda

Trademark Opposition No. 91/200832

Rob:

We are writing to request your consent to a 30 day extension of time for Applicant Honda to respond to the Opposer's First Set of Request for Production of Documents. We would, of course, be willing to provide a similar extension to your client, if requested. We have attempted to contact you and/or Nina by telephone on Tuesday November 22, Monday November 28 and today, but have not reached either of you and have not received a telephone call back. If we do not hear from you by 3pm, EST, we will file a Motion to extend the time for response.

In addition, Mike and I would like to set up a conference call with you to discuss how the discovery disclosures should proceed. If you will suggest some times you are available in the next few days, we will set up the call.

We look forward to hearing from you.

Barbara

**Barbara A. Barakat | WilmerHale**

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Boston, MA 02109 USA

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[barbara.barakat@wilmerhale.com](mailto:barbara.barakat@wilmerhale.com)

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# **EXHIBIT B.**

**Kalahele, Deborah L.**

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**From:** Bevilacqua, Michael [Michael.Bevilacqua@wilmerhale.com]  
**Sent:** Tuesday, January 10, 2012 1:01 PM  
**To:** Phillips, Robert N. (Rob)  
**Cc:** Barakat, Barbara; Ferrera, Vinita  
**Subject:** RE: Pleadings

Rob

I do not have an answer from Honda on the consolidation issue so you cannot represent to the Board that Honda does not object to consolidation.

Mike

Michael J. Bevilacqua | WilmerHale  
60 State Street  
Boston, MA 02109 USA  
+1 617 526 6448 (t)  
+1 617 526 5000 (f)  
michael.bevilacqua@wilmerhale.com

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-----Original Message-----

**From:** Phillips, Robert N. (Rob) [mailto:RobPhillips@ReedSmith.com]  
**Sent:** Tuesday, January 10, 2012 2:38 PM  
**To:** Bevilacqua, Michael  
**Cc:** Barakat, Barbara; Ferrera, Vinita  
**Subject:** RE: Pleadings

Thanks. What is your client's position on consolidation? Can we represent to the Board that Honda does not object?

Robert N. Phillips | Reed Smith LLP  
101 Second Street - Suite 1800 San Francisco, CA 94105  
Direct: 415.659.5953 | Reception: 415.543.8700 | Fax: 415.391.8269  
robphillips@reedsmith.com | [www.reedsmith.com](http://www.reedsmith.com)

-----Original Message-----

**From:** Bevilacqua, Michael [mailto:Michael.Bevilacqua@wilmerhale.com]  
**Sent:** Monday, January 09, 2012 8:20 PM  
**To:** Phillips, Robert N. (Rob)

Cc: Barakat, Barbara; Ferrera, Vinita  
Subject: Pleadings

Rob

The attached documents are being provided to you under the condition that they will be viewed solely by outside counsel.

Mike Bevilacqua

Michael J. Bevilacqua | WilmerHale  
60 State Street  
Boston, MA 02109 USA  
+1 617 526 6448 (t)  
+1 617 526 5000 (f)  
michael.bevilacqua@wilmerhale.com

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# **EXHIBIT C**

**Kalahele, Deborah L.**

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**From:** Bevilacqua, Michael [Michael.Bevilacqua@wilmerhale.com]  
**Sent:** Friday, January 27, 2012 5:40 PM  
**To:** Herring, Seth B.  
**Cc:** Phillips, Robert N. (Rob); Borders, Nina Habib; Ferrera, Vinita; Barakat, Barbara  
**Subject:** RE: Today's call

Seth

I am writing in response to your email of January 20, 2012. As you know, you arranged a call to discuss the Protective Order last Friday, but most of the call was spent discussing the discovery requests which I did not have with me during the call which is why I could not address many of your questions.

I will address the issues raised in your email in the order in which they appeared in your email.

With respect to in-house counsel gaining access to "Trade Secret/Commercially Sensitive—Material", I find it ironic that you would rely on *Georgia Pacific Corp. v. Solo Cup Co*, which was a case in which the Board denied in-house counsel access to such materials. I would suggest that you either make a proposal (1) on how you would guarantee that the in-house counsel in question is not, and will not be, involved in competitive decision making and (2) describing the steps that will be taken to maintain the confidentiality of the material or file a motion with the Board. At this point it is not clear to us how you propose to provide the necessary assurances. TBMP 412.02(b) also seems to apply to situations where outside counsel is not retained and it would be a burden for the in-house counsel handling the opposition to engage outside counsel.

With respect to the disclosure of certain classes of confidential information to consultants and experts, we disagree that this is a work product issue. Disclosing the identities of experts or other consultants does not disclose any strategy decisions. We are entitled to know who is going to see the documents in order to determine whether we have any concern about that particular individual having access to Honda's confidential information. If the individual works for a competitor, we ought to be able to know that so that we can object to the sharing of confidential information with them. Whether Briggs ultimately uses them as a testifying expert or not is irrelevant to the issue.

I do not understand what you are trying to state in your third paragraph. Are you asking us to produce the materials now or after we finalize a Protective Order?

We will produce Honda documents which are not the subject of an objection.

We are seeking permission to share the settlement agreements. (RFP 4)

If we have consumer research or surveys relating to other design elements, we will produce them (RFP 8)

If Honda can identify any non-public documents relating to patents for products containing the ENGINE CONFIGURATION that are not subject to the attorney client privilege, we will produce them. (RFP 18)

If we have any documents relating to alternative designs considered in connection with the design and development of the ENGINE CONFIGURATION, we will produce them. (RFP 32)

If we can identify any Trademark Office communications or decisions anywhere in the world discussing functionality, we will produce them.

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With respect to your proposed Motion to Consolidate what I had said during the call was that Honda has not made a decision whether it would oppose the motion. That is not the same as not having a clear answer. Honda has still not made a decision, so we would not consent to such a motion at this time.

Mike Bevilacqua

**Michael J. Bevilacqua | WilmerHale**  
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michael.bevilacqua@wilmerhale.com

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**From:** Herring, Seth B. [mailto:SHerring@ReedSmith.com]  
**Sent:** Friday, January 20, 2012 4:31 PM  
**To:** Bevilacqua, Michael  
**Cc:** Phillips, Robert N. (Rob); Borders, Nina Habib; Ferrera, Vinita; Barakat, Barbara  
**Subject:** Today's call

Mike,

I write to confirm our discussion today. First we discussed the protective order. I explained that because Briggs' in-house counsel responsible for managing and directing outside counsel in this proceeding is not involved in any competitive decision making at Briggs, he should be granted access to all Honda confidential information, regardless of designation, so that he may properly fulfill his job duties. TBMP section 412.02(b) specifically contemplates this, and the "competitive decision making" standard is used by both the Federal Circuit in *U.S. Steel Corp. v. United States* and the TTAB in *Georgia Pacific Corp. v. Solo Cup Co.* You said you would raise this issue with Honda.

I then explained why we wanted to modify section five of the model TTAB order to require disclosure of an expert or consultant only if that person is or has been involved in the engine business. This caveat will alleviate any potential concern regarding disclosure of confidential information this provision was meant to prevent. On the other hand, forced disclosure of **any** expert or consultant as soon as that person is given access to confidential information would violate the work product doctrine, in that it would reveal the key strategy decisions involved with the timing and identification of experts (such as functionality or survey experts). This is particularly true if the

parties decline to ultimately submit reports from said experts or consultants, and would thus not be obligated to disclose them under the normal procedural rules. You said you would raise this issue with Honda.

You stated that Honda was withholding its document production until a suitable protective order is in place, and that if Honda produces documents now under the form TTAB protective order, it will cease negotiating a revised order. If Honda refuses to stipulate to a protective order reflecting both of the items discussed above, Briggs will demand that Honda immediately produce its documents under the form TTAB protective order, with the possibility of either re-designating the documents or treating them differently in the event an alternative order is entered.

Regarding Honda's responses to Briggs's first set of requests for production, you explained that the "otherwise non-objectionable" language simply meant that Honda would not produce objectionable documents. However, if a document is responsive and non-privileged and Honda has agreed to produce it, Honda must produce it. Please confirm that Honda will produce all non-privileged responsive documents for those requests for which it has agreed to make a production.

Regarding settlement agreements (RFP 4), you said there were third party confidentiality concerns with those documents, but you had not yet reached out to the third parties for waivers. We ask that you do so immediately. Regarding RFP 8, I explained that these documents were relevant to secondary meaning. You responded that you would take another look at Honda's response to this request and get back to me. Regarding RFP 18, you first said you'd only produce Honda's patents and applications. I then explained why other documents related to the patents and applications, such as communications regarding those applications, could be relevant to issues such as functionality. You said those documents were likely to be 20-30 years old and in Japanese, but you would talk about this with Honda.

Regarding alternative designs considered (RFP 32), I explained that these documents were clearly relevant to at least functionality. You said that these documents would be burdensome to produce, to which I responded you had presented evidence in other cases regarding the design process of the engines at issue, so you clearly have access to this information. You agreed to see what your client could find. Last, I explained that RFP 38 dealt with documents related to functionality, regardless of whether the law in the foreign jurisdiction was the same as U.S. law. You agreed to follow up with your client on this category.

You also said you have had several calls with Honda regarding whether it opposes consolidation with the other two ongoing oppositions, but you have not gotten a clear answer. You agreed to ask again. You also agreed to ask your client whether it would agree to a six month extension of all dates in this case, which we think is appropriate given the limited fact discovery that has taken place to date, the fast approaching expert report deadline, and the ongoing negotiations regarding the protective order.

We ask that Honda respond regarding whether it agrees to consolidation, and whether it agrees to the six month extension, by next Wednesday January 25. We ask that Honda respond to the issues regarding the protective order and document requests by next Friday January 27. If Honda fails to meet either of these deadlines, Briggs will be forced to seek relief from the Board.

Please let me know if anything I have stated above is incorrect.

Regards,

Seth

**Seth B. Herring | Reed Smith LLP**  
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