

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: August 5, 2013

Opposition No. 91200832

Briggs & Stratton Corporation

v.

Honda Giken Kogyo Kabushiki  
Kaisha (Honda Motor Co.,  
Ltd.)

Opposition No. 91200146

Kohler Co.

v.

Honda Giken Kogyo Kabushiki  
Kaisha (Honda Motor Co.,  
Ltd.)

**Cheryl S. Goodman, Interlocutory Attorney:**

As background, on March 6, 2013, the Board denied opposers' motion (filed February 2, 2013) to use testimony taken in other civil litigation under Trademark Rule 2.122(f), as the testimony appeared to be deposition testimony, not used as trial testimony, and there was a lack of privity between the parties in the civil action and the present litigation. The Board also considered applicant's motion (filed February 1, 2013) to extend,

finding, in part, that applicant's motion to extend was a premature motion for Rule 56(d) discovery, as at the time of filing the extension request, the motion for summary judgment had not been filed. The Board granted applicant's motion to extend in part, to the extent that, should proceedings resume, proceedings would be re-suspended for completion of expert discovery and all other dates would be extended. The Board then suspended proceedings in view of opposers' February 2, 2013 filing of their motion for summary judgment on the functionality ground.<sup>1</sup>

On March 8, 2013, opposers filed a request for reconsideration of the Board's order denying their Trademark Rule 2.122(f) motion, and on March 21, 2013, opposers filed a supplemental declaration in support of summary judgment and reconsideration.<sup>2</sup> On March 28, 2013, applicant filed its motion for Rule 56(d) discovery. Then, on April 1, 2013, opposers filed a reply to their motion for summary judgment to which applicant filed an objection,

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<sup>1</sup> On September 4, 2012, the Board had granted opposers leave to amend to file second amended notices of opposition. Opposers each filed on February 2, 2013 second amended notices of opposition.

<sup>2</sup> The declaration provides a better copy of the Hoag deposition excerpt.

on April 5, 2013, via letter.<sup>3</sup> Opposers then filed a response to applicant's letter on April 12, 2013.

Turning first to the request for reconsideration, opposers seek for the Board to consider the deposition testimony evidence "for a different, independent reason" which they admit was not addressed in their original motion, namely that Honda produced the testimony in response to opposers' requests for production. Opposers submit that "[h]ad Opposers discovered the applicable rule in time, their motion would not have been required in the first place."

In response, applicant argues that opposers' motion fails to meet the standard for relief for reconsideration and that opposers waived additional arguments now made on reconsideration that were not raised in their initial motion.

A request for reconsideration on motion under Trademark Rule 2.127(b) provides an opportunity for a party to point out any error the Board may have made in considering the matter initially. It is not to be a reargument of the points presented in the original motion or response thereto, nor is it to be used to raise new

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<sup>3</sup> It appears that this letter was not served on opposers. Any paper filed in a Board proceeding must be served on the adverse party. Trademark Rule 2.119.

arguments or introduce additional evidence. Rather, the motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. TBMP § 518 (3d ed. rev.2 2013).

The Board has carefully reviewed the matter, and finds no error in the March 6, 2013 decision. To the extent that opposers argue that deposition testimony may be admissible and considered on a basis other than Trademark Rule 2.122(f), that is not a basis for reconsideration, as the subject of the initial motion and denial thereof was based solely on Trademark Rule 2.122(f), to which decision opposers concede was correct.<sup>4</sup>

In view thereof, reconsideration with respect to opposers' Trademark Rule 2.122(f) motion is denied.

The Board turns next to applicant's letter and opposers' response with respect to opposers' filing of a reply to their motion for summary judgment.

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<sup>4</sup> If the discovery deposition testimony is admissible on another basis, whereby leave of the Board is not required, then presumably, opposers have met the necessary requirements on summary judgment. The Board notes that in their April 17, 2013 reply to the motion to reconsider they have included the supplemental declaration of Donald A. Daugherty Jr., and exhibit 1, their request for production of documents, pursuant to Trademark Rule 2.127(e)(2). However, this filing on reconsideration is not considered part of the papers that constitute opposers' motion for summary judgment.

Applicant has objected to the filing of a summary judgment reply brief by opposers and consideration thereof in view of its filing of a Rule 56(d) motion.

In response, opposers argue that "if Honda's Rule 56(d) motion is denied, Honda should not be given the opportunity to file an opposition, and the Board can move directly to the merits." Opposers submit that the reply is proper and "will assist the Board with its determination . . . ."

A motion to take Rule 56(d) discovery is filed in lieu of filing a responsive brief on the merits of the motion. See e.g., *Brouwer v. Wyndham Vacation Resorts, Inc.*, No. 7:11-cv-3959-LSC, 2012 WL 4335986 (N.D. Ala., September 18, 2012) at \*9 ("Rule 56(d) of the Federal Rules of Civil Procedure provides a mechanism for relief where a party faced with a summary judgment motion does not have the facts necessary to respond to it"); *Five Points Hotel Partnership v. Pinsonneault*, 835 F.Supp.2d 753, 757-58 (D. Ariz. 2011) ("Plaintiffs correctly point out that they can move for discovery pursuant to Rule 56(d) in lieu of responding to the merits of the motion"). Thus, even if the Board denies the motion for Rule 56(d) discovery, applicant is still entitled to file a responsive brief on the merits to the motion for summary judgment. See e.g.,

*Betances, v. Prestige Decorating & Wallcovering, Inc.*, No. 05 Civ. 4485 (NRB) 2006 WL 250486 at \*2 (S.D.N.Y. February 2, 2006) (in lieu of filing a response on the merits to the motion for summary judgment, plaintiff filed a motion for Rule 56(f) discovery, which the court denied; the court then directed plaintiff to submit his opposition on the merits). Therefore, opposers' reply to their motion for summary judgment is premature.

The Board notes that the purpose of a reply brief is not to reargue matters already addressed in opposers' summary judgment brief, but is for the purpose of addressing new matter raised in applicant's response. In this case, as no response by applicant has yet been filed, opposers' reply brief in effect acts as a supplemental brief on its motion for summary judgment, for which leave has not been granted.

Accordingly, the April 1, 2013 summary judgment reply brief will not be considered.

The Board now turns to applicant's motion for Rule 56(d) discovery.

Fed. R. Civ. P. 56(d) provides, in pertinent part, that a party which believes that it cannot effectively oppose a motion for summary judgment without first taking discovery, may file a request with the Board for time to

take the needed discovery. The request is to be supported by an affidavit or declaration showing that for specified reasons the nonmoving party "cannot present facts essential to justify its opposition." Fed. R. Civ. P. 56(d).

As the movant in the Rule 56(d) motion, applicant bears the burden of persuasion in establishing why the Board should grant it the opportunity to seek the information specifically identified in its declaration in order to respond to opposers' summary judgment motion. Rule 56(d) discovery is not a substitute for full-blown pre-trial discovery nor is it a substitute for a motion to compel. Rule 56(d) functions as a safe harbor offering relief "where the nonmovant has not had a full opportunity to conduct—not to complete—discovery." *Bramlett v. Med. Protective Co. of Fort Wayne, Ind.*, Civil Action No. 3:10-CV-2048-D, 2012 WL 3887059, at \*2 (N.D.Tex. Sept.7, 2012 (citations omitted)). Under Rule 56(d), applicant is limited to discovery it must have in order to respond to the motion for summary judgment. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990). Cf. *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *aff'd* 26 USPQ2d 1551 (S.D. Ohio 1992).

Applicant complains that summary judgment is premature and the record is incomplete, asserting that it "cannot respond to Opposers' Motion absent an opportunity to obtain and analyze essential discovery." Applicant complains that "Honda has been denied the opportunity to discover any facts in Opposers' possession relevant to the functionality of the GX Engine Trademark, including those pertinent to the issues raised in Opposers' Motion."

Opposers have argued that the Rule 56(d) motion should be denied because in 2007 civil litigation involving applicant's subsidiary and a third party, a motion for summary judgment on functionality was opposed by applicant's subsidiary without seeking discovery. However, the fact that applicant's subsidiary opposed a motion for summary judgment in civil litigation in 2007 on a functionality claim without seeking Rule 56(d) discovery is irrelevant as to whether applicant is entitled to seek Rule 56(d) discovery in this case.

Opposer has also argued that the Rule 56(d) motion should be denied because evidence regarding alternative designs is not within opposers' exclusive control. However, that factor does not dictate denial of the motion. While exclusive control of information by a party seeking summary judgment is a factor favoring relief under Rule

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56(d), it is not a controlling one in determining whether a party is entitled to relief under Rule 56(d). *Hackworth v. Progressive Casualty Ins. Co.*, 468 F.3d 722, 733 (10<sup>th</sup> Cir. 2006).

Opposer also contends that applicant's affidavits are insufficient under Rule 56(d) which requires a party to show "by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition." Fed. R. Civ. P. 56(d).

However, applicant's affidavits, while lacking the detail required by the Rule, may be read in conjunction with the supporting papers, so as to meet the requirements under Rule 56(d). *Bauer v. Shepard* Cause No. 3:08-CV-196-TLS, 2008 WL 4411658 at \*4 (N.D.Ind. September 25, 2008) ("the court views Defendants [Rule 56(d)] request in its entirety, and whatever specific information not in the affidavit is sufficiently explained in the accompanying motion and memorandum;" "putting the details of their request in their Motion and Memorandum in Support, instead of in Babcock's affidavit, is [not] grounds for denying the motion"); *Thiesen Vending Co. v. United States*, 58 Fed. Cl. 197, 197 (Fed. Cl. 2003) (considering the affidavit and supporting papers together when considering whether the

party has fulfilled the requirements under a Rule 56(f), now 56(d), motion).

Although opposers also contend that applicant has failed to be diligent seeking discovery, the Board finds that applicant has been diligent. Applicant served discovery in 2011 and 2012 and subsequently filed a motion to compel in August 2012 to obtain responsive documents to outstanding document requests. The Board granted the motion to compel in a January 23, 2013 order. Subsequent to the motion to compel, applicant "received the first substantive production responsive to these requests in February 2013," although production is still ongoing.<sup>5</sup> As to the taking of depositions, applicant states that it noticed depositions in July 2012 but that "Opposers refused to respond to Honda's repeated requests to schedule these depositions," and subsequently applicant agreed to opposers' proposal of postponement of the depositions of fact witnesses until after the resolution of the motion to compel. Applicant also states that for months it made requests to schedule the deposition of opposers' functionality expert but the parties were unable to agree on any dates.

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<sup>5</sup> Applicant indicates in its reply to its Rule 56(d) motion that "Opposers continue to produce documents, and on the day they filed their Opposition to Honda's Rule 56(d) motion produced more than 25,000 additional pages."

Although applicant claims that opposers' documents and testimony are necessary to challenge "unsupported conclusions" in the motion for summary judgment, this contention supports denial rather than granting Rule 56(d) discovery inasmuch as "unsupported statements of counsel in a summary judgment brief are not evidence and cannot be properly considered" in support of summary judgment.

*Schambeau Properties, LP v. Waffle House, Inc.* Civil Action 11-0029-WS-B, 2011 WL 6934817 at \*6 (S.D. Ala. December 30, 2011). See *Bowden ex rel. Bowden v. Wal-Mart Stores, Inc.*, 124 F.Supp.2d 1228, 1236 (M.D. Ala 2000) ("the opinions, allegations and conclusory statements of counsel do not substitute for evidence"); *Taylor v. Holiday Isle, LLC*, 561 F.Supp.2d 1269, 1275 n. 11 (S.D. Ala. 2008) ("Unadorned representations of counsel in a summary judgment brief are not a substitute for appropriate record evidence"); *Forsyth v. Barr*, 19 F.3d 1527, 1533 (5th Cir. 1994); ("Unsubstantiated assertions are not competent summary judgment evidence").

To the extent that applicant seeks discovery (documents or deposition testimony) regarding "third party use of the GX Engine Trade Dress, selection, adoption and use of elements of the GX Engine trademark by Opposers, and testing or research documents regarding the differences or

similarities between Opposers' Knock-off products and the Honda GX Engine Trademark, the Board finds that discovery regarding these topics will not raise a genuine dispute as to non-functionality at issue on summary judgment. See e.g., *Neutrik AG v. Switchcraft, Inc.*, 31 Fed.Appx. 718, 722 (Fed. Cir. 2002) (district court denied Rule 56(f), now 56(d), discovery, concluding with regard to discovery related to copying in a trade dress case that information related to secondary meaning would not overcome a failure of party meet its burden on summary judgment on the question of non-functionality of its trade dress).

Time to Receive and Review Production of Documents

Applicant's declaration indicates that it seeks completion of production of documents pursuant to the Board's January 23, 2013 order granting its motion to compel.

To the extent that applicant seeks production of documents with regard to *all document requests* granted in connection with the Board's order on the motion to compel, the motion for Rule 56(d) discovery is denied inasmuch as applicant has not demonstrated that production with regard to *all requests* subject to the motion to compel is essential to its opposition on summary judgment.

In its motion, applicant has pointed to document production regarding the existence of functionally-equivalent designs and has argued that "[i]nformation showing that other designs were feasible, cost effective, and performed well would be sufficient to raise a genuine issue of material fact. . . ." Applicant states that not all relevant documents have been produced as to the discovery requests which seek information related to alternative designs.

Although opposer has argued that the existence of alternative designs need not be considered as it will not rebut a prima facie showing of functionality, the Board agrees with applicant that the existence of alternative designs can raise a genuine dispute of material fact on summary judgment. As the Board's reviewing court noted in *Valu Engineering Inc. v. Rexnord Corp.*, 278 F3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002), under the *Morton-Norwich* factors, alternative designs aid in determination of whether a particular feature is functional. See e.g., *Sunbeam Products Inc. v. The West Bend Co.*, 39 USPQ2d 1545 (S.D. Miss. 1996) (finding overall configuration of mixer non-functional even though it is comprised of many functional components, since viable alternative designs are available).

Accordingly, to the extent documents have not been produced<sup>6</sup>, the Board grants the motion for Rule 56(d) discovery with regard to the "alternative external designs considered" in connection with the following document requests:

*Narrowed Request No. 18 (Briggs)*

*All documents relating to the selection, adoption, use registration or defense of any aspect of the design of Opposer's 550 Series engines in the United States including but not limited to all documents concerning alternative external designs considered . . .*

*Narrowed Request no. 33 (Kohler)*

*All documents relating to the selection, adoption, use, registration or defense of any aspect of the design of Opposer's SH265 engines in the United States, including but not limited to all documents concerning alternative external designs considered . . .*

To the extent they have not already done so, opposers are allowed until TWENTY DAYS from the mailing date of this order to produce responsive documents as to alternative designs under these narrowed document requests.

Deposition of Opposers' Representatives and Employees

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<sup>6</sup> As of April 1, 2013, opposer has produced over 25,999 pages of documents; it is unclear whether opposers have produced responsive documents with respect to Request nos. 18 (Briggs) as narrowed and Request no. 33 (Kohler) as narrowed. Opposers declarations of counsel, filed April 1, 2013, indicate that copies of third party use documents were provided to applicant in response to applicant's discovery requests. Applicant now has had four months to review the over 26,000 pages of produced documents from opposers which provides applicant a sufficient opportunity to review opposers' production to date.

Applicant submits that certain individuals have information "relevant to the functionality of the applied-for mark." Applicant argues that it needs to depose opposers' representatives and employees as these depositions are "likely to raise genuine issues of material fact regarding the assertions in Opposers' Motion" and asserts that "Opposers' own descriptions of these witnesses establish the relevance of these depositions to the issues presented in Opposers' Motion." Applicant further argues that the identified employees have information relating to "factual issues [that] are central to this proceeding" and that "Opposers' have deprived Honda of this essential discovery which is likely to reveal genuine issues of material fact germane to Opposers' Motion." Applicant seeks to depose Briggs & Stratton Corporation employees Pete Hotz, Ron Webber and Mike Miller and Kohler Co. employee Cameron Litt.

Applicant argues that it has not had an opportunity to question these witnesses regarding documents authored and received by these individuals and that applicant expects that these individuals will have relevant information regarding "functional aspects of Applicant's claimed engine configuration" and the "functionality of the GX Engine Trademark." Applicant also states that these individuals

will have "information regarding the relative ease and cost of manufacturing horizontal shaft utility engines that copy the GX Engine Trademark" and "third party use of similar designs." To the extent that these individuals have information regarding knock-off products, as stated supra, those issues relate to secondary meaning and therefore, deposing the witnesses on these issues would not raise a genuine dispute as to non-functionality. See *Neutrik AG v. Switchcraft, Inc.*, 31 Fed.Appx. at 722.

With regard to applicant seeking to depose these individuals generally with respect to their knowledge of the functionality of the GX engine trademark, the Board finds that applicant's motion and supporting declaration have not identified any specific facts it would elicit during depositions of these witnesses. While applicant's motion has indicated how the desired deposition testimony is in a quite general sense relevant to the proceeding and motion for summary judgment, applicant has failed to specifically explain how these depositions will allow it to raise a genuine dispute. *Getz v. Boeing Co.*, 690 F.Supp.2d 982, 1000 (N.D. Cal. 2010) (denying 56(d) continuance as supporting declaration did not identify specific facts that would be elicited and merely speculated that deposing these individuals would uncover facts to raise a dispute).

Applicant merely speculates that deposing these individuals would uncover more evidence in connection with the GX engine's functionality to raise a genuine dispute. *Id.*

Because applicant offers no specific reasons demonstrating the necessity and utility of these witness depositions to withstand summary judgment, applicant has not demonstrated that Rule 56(d) deposition testimony is necessary as to these individuals. Accordingly, the Board denies this request for the depositions of Briggs & Stratton Corporation employees Pete Hotz, Ron Webber and Mike Miller and Kohler Co. employee Cameron Litt.

Deposition of Opposers' Experts

While the declaration omits a specific request to depose opposers' expert Professor Reisel, applicant's motion submits that it needs to depose Professor Mr. Reisel. In particular, applicant argues that "[m]any of the 'factual' assertions and arguments . . . several of which are unsupported by any reference, appear to be derived from these [expert] opinions." In addition, applicant seeks to depose employees identified as Rebuttal Expert Witnesses: Briggs & Stratton Corporation employee Pete Hotz and Kohler Co. employee Dale D. Snyder relating to the functionality of the GX Engine Trademark.

The Board finds that applicant has not established that deposing opposers' expert or potential rebuttal experts are essential to its opposition. Opposers' expert reports were not provided in support of opposers' motion for summary judgment, and if any of opposers' factual assertions are unsupported, they cannot be relied on in deciding issues related to summary judgment. *See Johnston v. City of Houston*, 14 F.3d 1056, 1060 (5th Cir. 1994) (unsupported factual assertions in pleadings or memoranda are not summary judgment evidence, and cannot be relied on in deciding issues raised by a motion for summary judgment). While applicant "anticipates" that taking the testimony of Professor Reisel will raise genuine disputes, as will the taking of deposition testimony of opposers' rebuttal expert witnesses, this assertion is speculative, as applicant has not pointed to particular facts that are necessary for it to discover in order to oppose opposers' motion. Applicant has not indicated with any specificity how the expert deposition testimony will raise a genuine dispute.

In any event, applicant has in its possession reports from its own experts who can opine on issues raised in opposers' motion so as to raise a genuine dispute, e.g., scope of applicant's utility patents and the availability

of cost-effective and functionally equivalent designs, or the ease and cost of manufacturing horizontal shaft utility engines. As opposers have pointed out, applicant retained expert James Mieritz who provided an expert report on "(1) the process required to design a small gasoline engine such as the Honda GX series engines; (2) the non-functional features of the Honda GX series engine" as well as creating a "rebuttal report [that] addresses the opinion and underlying support in the Reisel Report" in this proceeding. Applicant's expert testimony is just as relevant as any testimony that it could adduce from opposers' experts to meaningfully respond to the motion for summary judgment so as to raise a genuine dispute.

*Fitzgerald v. Henderson*, 251 F.3d 345, 353 (2d Cir. 2001) (56(f), now 56(d), discovery not appropriate where plaintiff is "able to demonstrate, at the very least, a material issue of fact to defeat summary judgment through her own affidavit, and by relying on her own witnesses and documents").

In view thereof, applicant's Rule 56(d) motion to depose opposers' experts is denied.

In summary, applicant's motion for Rule 56(d) discovery is granted to the extent that opposers are allowed until TWENTY DAYS from the mailing date of this

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order to produce responsive documents that relate to "alternative external designs considered," to the extent these documents have not yet been produced. All other Rule 56(d) discovery is denied. Applicant is allowed until FIFTY DAYS from the mailing date of this order to respond to the motion for summary judgment.

Proceedings herein remain otherwise suspended pending disposition of the motion for summary judgment.