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

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| Proceeding | 91200832 |
| Party | Defendant<br>Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.) |
| Correspondence Address | MICHAEL J BEVILACQUA<br>WILMER CUTLER PICKERING HALE AND DORR LLP<br>60 STATE ST<br>BOSTON, MA 02109 1800<br>UNITED STATES<br>silena.paik@wilmerhale.com, michael.bevilacqua@wilmerhale.com, john.regan@wilmerhale.com, sarah.frazier@wilmerhale.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Sarah R. Frazier |
| Filer's e-mail | sarah.frazier@wilmerhale.com |
| Signature | /Sarah R. Frazier/ |
| Date | 09/24/2013 |
| Attachments | FINAL Mieritz Declaration with Exhibits.pdf(5688202 bytes ) |

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

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| BRIGGS & STRATTON CORPORATION and KOHLER CO., | |
| Opposers, | |
| v. | Opposition No. 91200832 (parent) |
| HONDA GIKEN KOGYO KABUSHIKI KAISHA, | Opposition No. 91200146 |
| Applicant. | Application Serial No. 78924545 |

**DECLARATION OF JAMES MIERITZ IN SUPPORT OF APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA'S OPPOSITION TO OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.'S MOTION FOR SUMMARY JUDGMENT**

I, James Mieritz, declare as follows:

## I. GENERAL BACKGROUND

1. I am the founder and president of James Mieritz Consulting LLC, a consulting firm located in Rockledge, Florida. A true and correct copy of my current resume is attached hereto as Exhibit 1.

2. I have been retained by Applicant Honda Giken Kogyo Kabushiki Kaisha ("Honda") to provide expert testimony regarding, among other things, the functional and non-functional features of the Honda GX Engine that is the subject of the trademark application at issue as shown in Exhibit 2 (referred to hereinafter as the "GX Engine").

3. This declaration is focused on the issues related to the functionality of the GX Engine raised in Opposers' Motion for Summary Judgment. True and correct copies of my complete expert reports in this proceeding are attached hereto as Exhibit 3 (Opening Report) and Exhibit 4 (Rebuttal Report). I have personally inspected the engines photographed in my reports (which are reproduced below) or engines of the same make and model. All of the photographs are accurate representations of actual engines.

## II. QUALIFICATIONS

4. I have approximately forty years of experience working in the gasoline engine industry. From 1970 to 2006, I worked for Briggs & Stratton. I began my career at Briggs & Stratton as an engineer and draftsman for gasoline engines. Over the years, I achieved increasing levels of responsibility, becoming an Assistant Chief Engineer and Engineering Manager for various classes of engines. In these roles, I designed, participated in, and supervised teams of engineers responsible for small gasoline engine design.
5. For example, I was the project engineer/design engineer for the first Briggs & Stratton twin-cylinder opposed engine from 1974-1977. During that project, my responsibilities included designing the entire engine layout. As project engineer, I had complete design responsibility for every component in the engine. I also put together the team that took the engine from concept to production.
6. During my career, I had experience with the GX Engine as well as other similar types of engines. In 1985-1986, Briggs & Stratton began looking at engines to compete with the GX Engine. I was leader of the design team for a 9 hp OHV single cylinder horizontal

shaft, inclined cylinder engine that was Briggs & Stratton's first attempt to compete with the GX Engine.

7. In addition, in 1986-1987, I began working on the Vanguard engine series, a line of engines from 5 hp up to 30 hp that was in direct competition with the Honda GX series and other industrial type engines. From approximately 1988 to 1998, I was the Engineering Manager-Vanguard Engines. I oversaw the engineering and design group that designed and developed the Vanguard engines.
8. As an engineer and manager, I was required to have an understanding of our competitors' products and the relative strength and weaknesses of those products as compared to those of Briggs & Stratton. At Briggs & Stratton, we brought in competitors' engines, tore them down and benchmark tested them. We tested the Honda GX Engine, Kohler engines, and Kawasaki engines, among others. In addition, as a manager, I became intimately familiar with the cost considerations of engine design.
9. Beginning in 1998, I moved into a business management role, becoming the Business Manager for Asian Operations. In this capacity, I was responsible for business management of a joint venture facility in Japan and contract engine purchases from a Japanese supplier, engine transfer pricing, production scheduling, inventory, program management, forecasting, budgeting, engineering, and department supervision.
10. I retired from Briggs & Stratton in 2006.
11. I obtained a Bachelor of Science in Mechanical Engineering from Marquette University, in Milwaukee, Wisconsin in 1970. I obtained a Masters of Business Administration from the Keller Graduate School, also in Milwaukee, Wisconsin, in 1996.

12. I am a retired member of the Society of Automotive Engineers (SAE). I am also a Past Chairman of the Small Engine Committee of the SAE.

13. I am being compensated in connection with this proceeding at a rate of $170 per hour for research and consultation time or $200 per hour for court, testimony and deposition time, plus expenses. I have received no additional compensation for my work in this proceeding. My compensation is in no way dependent upon the outcome of this proceeding.

14. I have testified as an expert in *American Honda Motor Co., v. The Pep Boys – Manny, Moe & Jack, et al., and Homier Distributing, Co. Inc.*, Case No. CV05-8879 SJO and Case No. CV06-0961 SJO.

15. I submitted a declaration on behalf of Honda in support of the above-referenced application which was filed on July 7, 2006.

## III. RELEVANT EXPERIENCE WITH THE HONDA GX ENGINE

16. I first became aware of and familiar with the Honda GX Engine approximately 30 years ago, while working at Briggs & Stratton.

17. As discussed above with respect to my qualifications, at Briggs & Stratton, I was engineering manager for the Vanguard line of engines that competed with Honda and Kohler in the high-quality, high-end portion of the small-utility engine market. The Honda GX Engines were considered industry-leading, and we were constantly trying to improve our engines to match the performance and durability of the Honda GX Engine.

18. As someone who has worked in the small gasoline engine industry for nearly 40 years, and specifically in the years since the Honda GX Engine reached the market, and based on my specific experience designing engines to compete with the Honda GX Engine, it is

my opinion that the Honda GX Engine is famous in the market for small gasoline engines, due to, among other things, its startability, dependability, reliability, and innovation.

19. In addition, the look of the GX Engine is well-known throughout the industry. Based on my experience dealing with original equipment manufacturers, distributors, dealers, and other potential customers for such engines, I believe that a large number of such individuals would immediately recognize the look of the GX Engine and associate it with Honda regardless of the color or finish of the engine.

## IV. SUMMARY OF OPINIONS

20. In my opinion, the design features of the GX Engine discussed in Opposers' Motion for Summary Judgment are matters of styling, not matters of functionality. The GX Engine does not work better or cost less because of those design elements, either when considered individually or as a whole.

21. My opinions are based on my skills, knowledge, experience, education, and training, as well as information gathered by and/or provided to me as of the date of this declaration.

22. In forming the opinions set forth herein, I have reviewed a variety of documents and small gasoline engines which are listed at Exhibit 5.

## V. LEGAL PRINCIPLES

23. I have been informed and understand that in order for the appearance of the GX Engine to be registered as a trademark, the configuration must be non-functional and must have acquired distinctiveness.

24. I have been informed that a trademark that consists of the configuration of a product is functional if that configuration is essential to the use or purpose of the product, or if it affects the product's cost or quality. I have been informed that to meet the test of legal

functionality it is not enough that the product serve a function; rather the product must be in a particular shape because it works better in that shape or costs less in that shape, such that precluding others from using the same configuration would prevent them from competing effectively.

25. I have been informed that when determining the functionality of a trademark that consists of a product design, one must focus on the overall configuration, not whether each design feature individually serves a utilitarian purpose. I have been informed that functional elements that are separately unprotectable can be protected together as part of a trademark that also includes non-functional elements.

26. I have been informed that some considerations used to determine functionality are (1) whether advertising touts the utilitarian advantages of the design, (2) whether the particular design results from a comparatively simple or inexpensive method of manufacture, (3) whether the design yields a utilitarian advantage, (4) whether alternative designs are available, and (5) the existence of utility patents disclosing the utilitarian advantages of the design sought to be registered. With respect to alternative designs, I have also been informed that the availability of alternative designs may indicate whether the design embodies functional or merely ornamental aspects of the product.

27. I have been informed that the existence of a design patent that covers features of a trademark is evidence of non-functionality.

## VI. THE PROCESS OF SMALL ENGINE DESIGN

28. In general, the first step is to establish the design of the "inside" of the engine and layout. Then, the "outside" components of the engine – such as the muffler, fan cover,

carburetor, air cleaner, fuel tank, and controls – can be added. Styling of the engine can usually begin after the engine layout is complete and prototype fabrication has started.

29. Often companies will employ or contract with an Industrial Designer to develop a packaged appearance that will be appealing, distinguish the finished engine from other competitive products, and associate it with other product offerings from the same manufacturer.

30. An Industrial Designer is asked to visualize concepts. The stylist will take into account requests from Sales, Marketing and other departments to provide various sketches. A variety of various concepts are reviewed. At such time, appearances such as beveled edges, radii edges, sharp corners or other shapes and contours are considered. Additional items such as covers, shrouds, control placement and customer convenience items can be styled-in at this time. The look of an engine takes into account features such as decorative covers and their shapes, colors, intake air openings (slots, holes, etc.) and the blending of all lines.

31. Industrial Designers have to work closely with the engineers to insure that the styling concepts do not affect the performance of the engine. The styling should be purely cosmetic. Materials might also play an important role in styling. The manufacturability and assembly ease must also be considered.

32. Many revisions of the styling concepts may be necessary before the final appearance is complete. After approval, an engine “mock-up” is fabricated which is used to show management and customers the prototype engine.

33. Finally, the entire engine appearance is stylized in order to achieve a brand identity.

## VII. THE GX ENGINE TRADEMARK IS NON-FUNCTIONAL

34. The Honda GX Engine has a distinctive overall look and configuration that comes from the combination of various design elements, which are the subject of the trademark application at issue in this proceeding. Based on my experience designing engines of this type, I expect that the Honda GX engine was consciously styled to have its distinct appearance.

35. In my opinion, the design features of the GX Engine as shown in Exhibit 2 are matters of styling, not matters of functionality. The GX Engine does not work better or cost less because of these design elements, either when considered individually or as whole.

36. Below, I discuss some of the notable design features found on the GX Engine. I do not attempt an exhaustive catalog of all the unique features of the GX Engine. Instead, I explain from the standpoint of a design engineer why and to what degree the particular design features of the Honda GX Engine are not functional. I also provide examples of alternative designs on competitor engines, further demonstrating that these features are non-functional.

### A. Fuel Tank

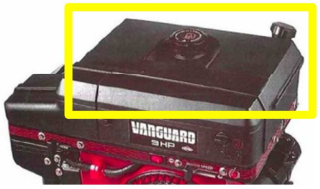
37. Honda has chosen a fuel tank located on the top right side of the engine with a roughly rectangular shape that mirrors the angles on the air cleaner cover and the radii on the upper left corner of its fan cover, beveled top outside edges, and a seam roughly in the middle of the fuel tank. The shape, location, beveling, and location of the seam of the fuel tank are purely cosmetic. These elements can be changed without affecting the cost or quality of the engine.

38. Honda has chosen a fuel tank located on the top right side of the engine. Although the fuel tank must be located above the carburetor to allow gravity flow of fuel to the engine, it can also be located in other areas such as along the entire top back side or across the front of the engine as shown below.

Honda Fuel Tank Location


Alternative Fuel Tank Locations


Kawaski




Vanguard 9 HP

39. The fuel tank can come in a number of shapes and sizes. While the fuel tank size in part determines capacity, the exact dimensions may vary and still provide the desired capacity. The fuel tank could also be square, oval, trapezoidal or other unique shapes. The best shape and dimensions for optimizing fuel tank volume while maintaining a compact engine design will depend on the relative size, shape and orientation of the other major engine components. Examples of alternative fuel tank designs are shown below.

Honda Fuel Tank Shape

Alternative Fuel Tank Shapes


Briggs INTEK


Subaru EX 17


Kohler Command Pro (Old Design)


Kawasaki

40. Honda has chosen to use a seam that is roughly in the middle of the fuel tank to align with the horizontal top line of the belt-like area on the air cleaner cover, creating a distinctive continuous horizontal line visible across the entire front portion of the engine. As shown below, the placement and orientation of the seam is arbitrary and could be, for example, diagonal (as Kohler has chosen to use).

Honda Fuel Tank

Kohler Command Pro Fuel Tank

41. The distinctive beveling on the GX Engine fuel tank is similar and complementary to the beveling on the air cleaner cover. Tank edges could be beveled with larger or smaller radii, sharp or a stepped contour. In addition to the beveling, the degree of the angle of the walls of the fuel tank offers a further opportunity for product differentiation.

**B. Air Cleaner Cover**

42. Honda has chosen an air cleaner cover located to the left of the fuel tank with a distinctive cube-shape that mirrors the squared corner of the upper left edge of its fan cover, beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference. These elements are purely cosmetic which is demonstrated by the examples of alternative designs below.

Honda Air Cleaner Cover Shape

Alternative Air Cleaner Cover Shapes


Kohler Command Pro (New Design)

Subaru EX 17

Kawasaki

Subaru EX 35


Briggs INTEK

43. The shape of the air cleaner cover is purely cosmetic. The air cleaner cover could be round, rectangular or some other shape to accommodate the inside shape of the air cleaner element without affecting the cost or quality of the engine. For example, the Subaru Robin EX 17 engine has a leftward sloping appearance that differs from the cubic shape of the GX Engine air cleaner cover.

44. The location of the air cleaner cover is also cosmetic. As shown below, unlike the GX Engine, the Briggs & Stratton INTEK, Kawasaki, and Subaru EX 35 engines have the air cleaners directly mounted to the carburetor and front-mounted rather than top-mounted like the GX Engine air cleaner. Also unlike the GX Engine, the Briggs & Stratton 9 HP Vanguard engine uses an air cleaner mounted on top of the engine but in front of the fuel tank that spans the entire front of the engine.

Honda Air Cleaner Location


Alternative Air Cleaner Locations


Briggs INTEK

Subaru EX 35


Kawaski


Vanguard 9 HP

45. Another distinctive feature is that the top outside edges of the Honda GX Engine air cleaner cover are beveled to complement the beveling on the outward-facing and inward-facing edges of the fuel tank. The edges could be beveled with larger or smaller radii, sharp or a stepped contour, or removed entirely.

46. The Honda GX Engine air cleaner cover also has a distinctive belt-like area on the lower portion of the cover encompassing the entire circumference where the top of this belt-like feature is aligned with the rib (seam) of the fuel tank to give a look of continuity. Neither the Briggs & Stratton nor the Kawasaki engines have this distinctive belt-like feature. While the Subaru Robin engine has a belt-like area, unlike the GX Engine air cleaner cover, it is not aligned with the fuel tank seam.

Honda

Subaru EX 17


**C. Carburetor Cover and Controls**

47. Honda has chosen a stylized carburetor cover that also houses various engine controls. The carburetor cover features four ribs along its outside edge and a receded area where controls levers are located. The appearance, size, and location of the carburetor cover are purely cosmetic which is demonstrated by the examples of the alternative designs below.

Honda Carburetor Cover Shape

Alternative Carburetor Cover Shapes

Subaru EX 17

Kohler Command Pro (Old Design)

Kohler Command Pro (New Design)

48. As depicted above, there are a variety of shapes and sizes for the carburetor cover.

49. The GX Engine carburetor cover features four ribs along the outside edge. The presence of the ribbing, including the number of ribs, is completely arbitrary.

50. The location of the carburetor cover is also purely cosmetic. The carburetor cover can be placed in a variety of locations. As described above with respect to the air cleaner cover, unlike the GX Engine, some engines including the Briggs & Stratton INTEK, Kawasaki, and Subaru EX 35 do not even have carburetor covers because the air cleaners are mounted directly to the carburetors.

51. The GX Engine carburetor cover also has a receded area where control levers are located. The engine controls can be placed within this cover, as Honda has chosen to do, or numerous other locations without affecting the cost or quality of the engine. Again, styling dictates control placement. As shown below, the Briggs & Stratton INTEK

engine controls are located in a different area, for example the fuel shut-off and speed controls are located on the right side of the engine.

Honda Control Location


Briggs INTEK Control Location


**D. Fan Cover**

52. Honda has chosen a distinctive fan cover rounded on the right side (as you look at the fan cover), with a square corner on the upper left side, and angled on the lower left side. The appearance of the fan cover is purely cosmetic.

53. These edges might be beveled, have a larger or smaller radius, stepped contour, or some other unique shape such as a squared design. The angular position could be steeper or shallower.

54. Although one of the functions of a fan cover is to direct the air from the fan to the cylinder, many different shapes can serve this function without affecting the cost or quality of the engine. Some examples are provided below.

55. As shown below, the existence and angle of the slant (on the left side) of the fan cover can vary. The fan cover can have various designs and geometries including those with a circular or angled left side.

Honda Fan Cover


Alternative Fan Cover Designs

Briggs INTEK

Kawasaki

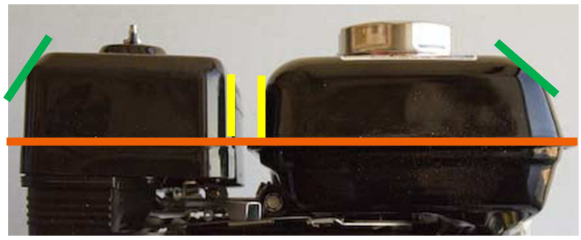

Kohler Command Pro
(Old Design)


Subaru EX 17

56. While the use of an inclined cylinder defines where the hottest part of the engine is, it does not dictate the slant in the fan cover. While cool air needs to be directed to the hottest parts of the engine, this can be achieved using a number of different external fan cover shapes and internal components (e.g., baffling, deflectors, etc.).

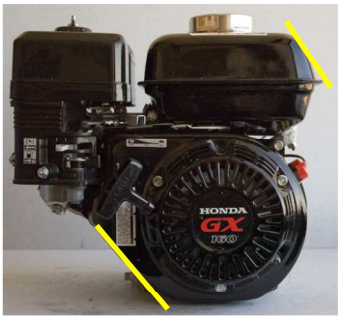
**E. Other Complementary Features**

57. The combined and complementary shape of the GX Engine fuel tank and air cleaner cover is distinctive and nonfunctional. The top left angle of the air cleaner cover was designed to mirror the angle of the right side of the fuel tank (shown below in green), the right vertical line of the air cleaner cover was designed to mirror the left vertical line of the fuel tank (shown below in yellow), and the air cleaner cover and the fuel tank were designed to have the same height and horizontal lines giving a look of continuity. Also the top portion of the belt-like area of the air cleaner cover is aligned with the seam of the fuel tank to once again achieve a continuous and complementary appearance (shown below in orange). This design choice is arbitrary.



58. Another distinctive feature is the complementary sloped shape of the top right side of the fuel tank and the lower left side of the fan cover that is absent from the designs below.

Honda Angles




Alternative Designs

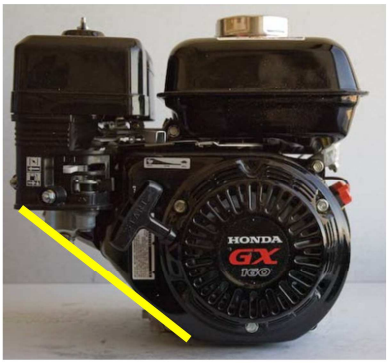

Briggs INTEK


Subaru EX 17


Kawasaki

59. In addition, another distinctive feature is how the angle of the lower left side of the fan cover is maintained up to the left edge of the carburetor cover, giving it a continuous look, unlike its various competitors' engines shown below.

Honda Fan Cover Line




Alternative Designs


Briggs INTEK


Subaru EX 17


Kawasaki

60. As illustrated below, there are a variety of design approaches for the combined appearance of the fuel tank and air cleaner cover. For example, the Subaru EX 17 fuel tank uses horizontal and vertical edges whereas the air cleaner cover has a more sloped and rounded appearance. The Kohler engine uses a fuel tank with angular edges whereas the air cleaner cover has a cylindrical shape with rounded edges. The Briggs INTEK 900 engine uses a fuel tank with rounded edges whereas the air cleaner cover has sharper edges and is mounted much lower than the fuel tank.

Honda Air Cleaner Cover & Fuel Tank Profile

Alternative Designs

Briggs INTEK

Subaru EX 17

Kohler Command Pro (New Design)

### F. The Relative Position and Orientation of Each of the Major Honda GX Engine Components and Overall Cubic Design

61. Honda has chosen components with particular dimensions that in turn affect the relative position and orientation of the components. The combination of spacing between the components, the shapes of the components, and the way the shapes of the components are oriented toward each other helps the styling avoid a cluttered or bulky look.

62. The overall square or cubic appearance of the GX Engine as well as the relative position, shape, size, and orientation of each of the major Honda GX Engine components and linear design elements are consistent with and creates the distinctive overall cubic design of the engine. As discussed above, there are alternative locations available for the major engine components. These alternative locations also allow for safe operation of the engine and enable easy access to the major engine components for inspection or maintenance. The fuel tank can run all the way across the top of the engine, the air cleaner can be located directly left of the fan cover instead of above it or can be located above the fan cover but run across the entire width of the engine, and the carburetor can

be behind the air cleaner rather than below it. These are just some of the alternatives that exist in the market. Other alternatives could exist that function equally as well as the GX Engine.

63. I understand that Opposers contend that the location of the muffler dictates the location of the major engine components. I disagree. As with the other major components discussed above, there are alternative locations and shapes available for the muffler. For example, the old design of the Kohler Command Pro engine uses a muffler that is located behind the air cleaner cover that spans the entire back of the engine (unlike the GX Engine). Similarly, as explained above, even with the muffler located where it is on the GX Engine, the location of the carburetor and air cleaner covers can vary.

64. While a cubic design is consistent with the goal of keeping the engine compact, other engine designs (for example, rectangular (taller or wider) or oblong) can serve this function equally well and compete effectively with the Honda GX Engine. The GX Engine's overall cubic design is just one example of a compact engine. Compactness can be achieved through a variety of engine designs.

65. I understand Opposers contend that the use of an inclined cylinder and the general placement and shape of the major engine components (fuel tank, air cleaner, carburetor, fan cover, and muffler) on the GX Engine reduces the engine's overall height, which creates a more compact engine and the "overall cubic design" of the GX Engine. I disagree. While inclining the cylinder decreases the engine's overall height, it also increases the width of the engine. Thus, an engine with an inclined cylinder can have multiple shapes and sizes including square, rectangular (taller or wider), or oblong. Moreover, the "overall cubic design" of the GX Engine is comprised of the overall square

appearance of the engine as well as the relative position, shape, size, and orientation of each of the major Honda GX Engine components, and linear design elements.

66. A cubic engine design is not necessary for incorporation into original equipment manufacturers products. Although there are SAE standards that manufacturers must conform to, various engine designs can be incorporated into original equipment manufactures' products.

67. Many products, for example pressure washers, pumps, and compressors, have open sides. As long as the engine fits within the frame of those products, there is room for variation in size and shape.

68. Furthermore, original equipment manufacturers frequently work with engine manufacturers in designing products that can incorporate engines with a particular design (including configurations that do not have a cubic design).

69. Therefore, it is my opinion that the overall cubic design of the GX Engine is a matter of styling, not functionality. The GX Engine does not work better or cost less because of the overall cubic design. Numerous alternative designs can effectively compete in the marketplace.

70. As set forth above, many of the individual features of the GX Engine complement each other and are purposefully done for styling. The details of each element, including, for instance, the complementary beveling of the air cleaner edges and fuel tank, the complementary sloped upper right corner of the fuel tank, bottom left side of the fan cover, and the upper left corner of the air cleaner cover, are indicative of a consciously stylized appearance. More importantly, the most noticeable components on the engine – air cleaner cover, fan cover, carburetor cover, and fuel tank – all have the stylized

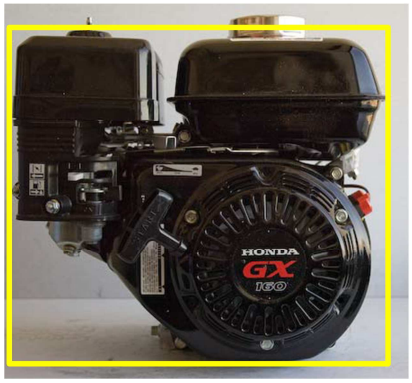
features that interrelate in appearance and that do not affect engine performance. Instead, these design details are merely cosmetic styling which creates the distinctive overall look of the Honda GX Engine. This styling does not necessarily increase or decrease the component cost. Furthermore, the quality of the engine is not affected by the styling features discussed above.

71. It is my understanding that Honda recently changed the beveling so that it is softer. The beveling on the air cleaner cover is still similar and complementary to the beveling on the fuel tank, and does not change the overall visual impression of the GX Engine. Moreover, this change does not affect the cost or quality of the engine.

72. Honda recently added a "skirt" on the lower left portion of the air cleaner cover. This change does not affect the cost or quality of the engine or change the overall visual impression of the GX Engine.

73. It is my understanding that Honda recently removed the four ribs on the carburetor cover and used a rounder bottom left edge. These changes do not affect the cost or quality of the engine and do not change the overall visual impression of the GX Engine.

74. As shown below, the minor changes made recently to the GX Engine (discussed above) do not change the overall visual impression of the GX Engine. The relative position, shape, size, and orientation of each of the major components remain the same and continues to create the same distinctive overall cubic design and configuration.





75. The below examples demonstrate the opportunity for each manufacturer to create a visually distinctive design and configuration without sacrificing cost or performance.

Honda GX Design


Alternative Engine Designs


Kohler Command Pro (New Design)


Kawasaki


Briggs INTEK


Kohler Command Pro (Old Design)


Subaru EX 35


Subaru EX 17

## G. Patents

76. It is my understanding that Opposers have asserted that various patents demonstrate the functionality of the design depicted in Exhibit 2. I have reviewed several patents

including, among others, U.S. Patent No. 4,813,385 (the "'385 patent"), U.S. Patent No. 6,941,919 (the "'919 patent), U.S. Patent No. 6,362,533 (the "'533 patent), U.S. Patent No. 6,489,690 (the "'690 patent), U.S. Patent No. 6,331,740 (the "'740 patent"), U.S. Patent No. 6,525,430 (the "'430 patent"), U.S. Patent 7,086,389 (the "'389 patent), Japanese Patent Application No. 57-170212 (the "'212 application"), and Japanese Patent No. 63-32344 (the "'344 patent"), and, in my opinion, none of these patents show that the design depicted in the application at issue is functional.

77. None of these patents describe or claim the details that comprise the appearance of the engine shown in Exhibit 2. While there is a description of the general shape of some of the components (e.g., "substantially rectangular when viewed in plan" ('385 patent); "fan cover has a generally cylindrical shape" ('430 patent); "fan cover [] bulges greatly along the engine cylinder" ('533 patent); "cylinder inclined" ('430 patent)) and the general location of some components (including the air cleaner, muffler, fuel tank, crankcase, cylinder, carburetor, fan cover, and controls), none of these patents describe the individual design elements of these components (e.g., beveled outside edges, belt-like area on the air cleaner cover where the top portion aligns with the seam of the fuel tank) that give the GX Engine its unique, distinctive appearance. Moreover, the inventions of these patents relate to other functional features that have nothing to do with the ornamental design of the GX Engine that can be used in numerous engine designs (including, but not limited to the GX Engine) such as a cyclone-type precleaner ('385 patent); a canister for absorbing fuel vapor ('389 patent); and an internal bearing support member (not an inclined cylinder) that aids in oil flow (the '919 patent). Also, many of

these patents concern generators in which the engine appearance and configuration is different from that depicted in Exhibit 2.

78. Unlike the general descriptions in the patents referenced above, the design patent, U.S. Patent Des. 282071, depicts many of the details that make up the appearance of the GX Engine shown in the application at issue and therefore confirms my opinion that this design is nonfunctional.

I declare under the penalty of perjury under the laws of the United States of America that the foregoing is true and correct, that all statements made of my own knowledge are true, and that all statements made on information and belief are believed to be true.

Executed this 24 day of September, 2013 at Rockledge, Florida.

James Mieritz

Exhibit 1

# JAMES T. MIERITZ

**4315 Collingtree Drive**
**Rockledge, Fl. 32955**
**262-227-6447**
**Jmieritz@cfl.rr.com**

## Summary of Experience

Senior level professional with over 25 years of diversified experience in worldwide engineering and business operations management. Extensive background in manufacturing and quality systems, pricing, negotiations, new product development, program management, strategic planning, and design.

July 2006 to December 2008

**Cequent Trailer Products / Division of Trimas Corporation**, Mosinee, Wisconsin

**Senior Global Sourcing Manager/Engineering:** Responsible for offshore component sourcing and engineering.

1970 to 2006

**Briggs & Stratton Corporation**, Milwaukee, Wisconsin
A $2.5 billion, Fortune 500 manufacturer of engines and powered systems with production facilities in the US, Japan, Europe, and China.

1998 to 2006

**Business Manager for Asian Operations:** Responsible to Divisional Vice President of Asian Operations for business management of joint venture facility in Japan (DBS Co LTD) and contract engine purchases from Mitsubishi Heavy Industries, engine transfer pricing, production scheduling, inventory, program management, forecasting, budgeting, engineering, and department supervision. Member Board of Directors of DBS Co LTD.

- Directed and managed DBS Co LTD. Member of the Board of Directors 1992-2004. **Result:** Achieved between $1,750,000 - $25,000,000 annual operating profits with an average annual dividend of $2,000,000.
- Recommended and proposed BIG BLOCK engine series concept. **Result:** Created new engine line with first year sales of 5,000 engines and a 5 year growth plan of 400% generating $2,500,000 operating profit.
- Negotiated engine transfer prices from Daihatsu/Briggs & Stratton (DBS) yearly. **Result:** Insured a 60-40% balance of operating profits for partners.
- Negotiated DBS engine discounts. **Result:** Established special customer prices for 30,000 consumer brand engines.
- Achieved an additional 7% DBS discount for Simplicity. **Result:** Maintained the business of 20,000 engines with sales of $8,000,000.
- Maintained minimum daily build rates. **Result:** Generated operating profits of $1,750,000 in 2005 and achieved positive operating profits for the past 15 years.
- Directed business with Mitsubishi Heavy Industries for engine orders, pricing, production schedules, and forecasting. **Result:** Negotiated 70,000 additional storm stock engines at up to $30 below standard cost. 2005 engine totals were

170,000 which generated $40,000,000 in sales.

- Structured engine discounts from Mitsubishi Heavy Industries. **Result:** Sold 90,000 engines that produced $24,500,000 in sales.
- Finalized contract to purchase engines from Mitsubishi Heavy Industries. **Result:** Renewed contract for an additional 5 years which produced $30,000,000 in annual sales and 100,000 engines per year.
- Launched a 5hp engine to China. **Result:** Completed a 2 year program to manufacture an engine with 80% of the components localized in China at the proposed target cost.
- Completed M12 marine engine. **Result:** Added $3,300,000 annual sales for the Chinese engine manufacturing plant.
- Developed a liquid-cooled V-twin engine. **Result:** Obtained 6 new commercial accounts with first year sales of $3,000,000.
- Obtained special prices for 5 customers SKU's. **Result:** Generated 30,000 new additional engines for $6,000,000 in sales.
- Eliminated premium freight of engines shipped from Japan. **Result:** Generated $750,000 annual savings.
- Transferred parts packaging from external to internal. **Result:** Achieved $500,000 annual savings.
- Developed executive personnel. **Result:** Promoted the following: program manager to product manager, program manager to manufacturing development manager, technician to program manager, technician to application engineer and engineer to engineer specialist.

1988 to 1998

**Engineering Manager Vanguard Engines:** Responsible to Vice President/General Manager Vanguard Division for engineering management of premium brand of engines from 4-25hp. Managed an engineering staff for design and development, budgets, cost, new products, program management, long range planning and engineering documentation.

- Designed and developed a new 9hp engine. **Result:** Expanded the engine series into the commercial market which provided 50,000 additional engines per year.
- Established a cost reduction program to maintain profitability @ 90 Yen/$. **Result:** Manufactured over 1,500,000 engines in 15 years which provided $40,000,000 annual sales.
- Increased engine hp for additional V-twin models. **Result:** Generated $20,000,000 in annual sales.
- Expanded single cylinder engine line. **Result:** Added 4 engines that increased annual sales by $10,000,000.
- Promoted to Business Manager for Asian Operations.

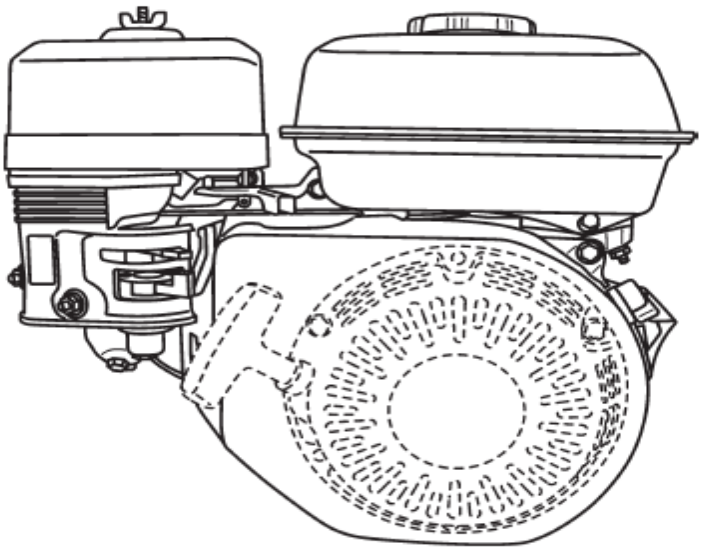
1964 to 1988

Held positions of increasing responsibility: **Manager of Engineering/Industrial-Commercial Engines, Assistant Chief Design Engineer/Large Engines, Assistant Chief Design Engineer, Project Engineer and Tool Design/Specifications Writer/Draftsman.**

- Promoted to Engineering Manager Vanguard Engines.

| | |
|---|---|
| **Education:** | MBA Degree, Keller Graduate School, Milwaukee, Wisconsin<br>BSME Degree, Marquette University, Milwaukee, Wisconsin |
| **Professional Affiliations:** | Society of Automotive Engineers (SAE)<br>Past Chairman Small Engine Committee |

Exhibit 2



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

| | | |
|---|---|---|
| BRIGGS & STRATTON CORPORATION and KOHLER CO., | ) | |
| Opposers, | ) | |
| | ) | Opposition No. 91200832 (parent) |
| v. | ) | |
| | ) | Opposition No. 91200146 |
| HONDA GIKEN KOGYO KABUSHIKI KAISHA, | ) | Application Serial No. 78924545 |
| Applicant. | ) | |

**EXPERT REPORT OF JAMES MIERITZ**

## I. INTRODUCTION

1. I have been retained by Honda Giken Kogyo Kabushiki Kaisha ("Honda") to provide expert testimony regarding among other things: (1) the process required to design a small gasoline engine such as the Honda GX series engines; and (2) the nonfunctional features that give the Honda GX series engine that is the subject of the trademark application at issue in the above-entitled proceedings its unique, distinctive appearance as shown in Exhibit A.

## II. QUALIFICATIONS

2. I have approximately forty years of experience working in the gasoline engine industry. From 1970 to 2006, I worked for Briggs & Stratton, one of the largest manufacturers of small gasoline engines in the world and a competitor of Honda in this market. I began my career at Briggs & Stratton as an engineer and draftsman for gasoline engines. Over the years, I achieved

increasing levels of responsibility, becoming an Assistant Chief Engineer and Engineering Manager for various classes of engines. In these roles, I designed, participated in, and supervised teams of engineers responsible for small gasoline engine design.

3. For example, I was the project engineer/design engineer for the first Briggs & Stratton twin-cylinder opposed engine from 1974-1977. During that project, my responsibilities included designing the entire engine layout. As project engineer, I had complete design responsibility for every component in the engine. I also put together the team that took the engine from concept to production.

4. During my career, I had experience with the engine that is the subject of the present application (referred to hereinafter as the "GX Engine") as well as other similar types of engines. In 1985-1986, Briggs & Stratton began looking at engines to compete with the GX Engine. I was leader of the design team for a 9 hp OHV single cylinder horizontal shaft, inclined cylinder engine that was Briggs & Stratton's first attempt to compete with the GX Engine.

5. In addition, in 1986-1987, I began working on the Vanguard engine series, a line of engines from 5 hp up to 30 hp that was in direct competition with the Honda GX series and other industrial type engines. From approximately 1988 to 1998, I was the Engineering Manager-Vanguard Engines. I oversaw the engineering and design group that designed and developed the Vanguard engines.

6. As an engineer and manager, I was required to have an understanding of our competitors' products and the relative strength and weaknesses of those products as compared to those of Briggs & Stratton. At Briggs & Stratton, we brought in competitors' engines, tore them down and benchmark tested them. We tested the Honda GX Engine, Kohler engines, and Kawasaki

engines, among others. In addition, as a manager, I became intimately familiar with the cost considerations of engine design.

7. Beginning in 1998, I moved into a business management role, becoming the Business Manager for Asian Operations. In this capacity, I was responsible for business management of a joint venture facility in Japan and contract engine purchases from a Japanese supplier, engine transfer pricing, production scheduling, inventory, program management, forecasting, budgeting, engineering, and department supervision.

8. I retired from Briggs & Stratton in 2006.

9. I obtained a Bachelor of Science in Mechanical Engineering from Marquette University, in Milwaukee, Wisconsin in 1970. I obtained a Masters of Business Administration from the Keller Graduate School, also in Milwaukee, Wisconsin, in 1996.

10. I am a retired member of the Society of Automotive Engineers (SAE). I am also a Past Chairman of the Small Engine Committee of the SAE.

11. My complete resume is attached to this report as Exhibit B.

## III. **COMPENSATION**

12. I am being compensated in connection with this proceeding at a rate of $170 per hour for research and consultation time or $200 per hour for court, testimony and deposition time, plus expenses. I have received no additional compensation for my work in this proceeding. My compensation is in no way dependent upon the outcome of this proceeding.

## IV. PREVIOUS TESTIMONY AND EXPERT OPINIONS

13. I have testified as an expert in *American Honda Motor Co., v. The Pep Boys – Manny, Moe & Jack, et al., and Homier Distributing, Co. Inc.*, Case No. CV05-8879 SJO and Case No. CV06-0961 SJO.

14. I submitted a declaration on behalf of Honda in support of the above-referenced application which was filed on July 7, 2006.

## V. SUMMARY OF OPINIONS

15. It is my opinion that the GX series engine that is the subject of the present application has a unique and distinctive overall appearance, which is comprised of several individual design features that are themselves unique and distinctive. It is my opinion that these individual design features, as set forth in detail below, do not contribute to the functionality of the GX Engine. Instead, these features are matters of styling and taste.

16. My opinions are based on my skills, knowledge, experience, education, and training, as well as information gathered by and/or provided to me as of the date of this report.

## VI. DATA AND MATERIALS CONSIDERED

17. In forming the opinions set forth herein, I have reviewed a variety of documents and small gasoline engines which are listed at Exhibit C.

## VII. LEGAL PRINCIPLES

18. I have been informed and understand that in order for the appearance of the GX Engine to be registered as a trademark, the configuration must be non-functional and must have acquired distinctiveness.

19. I have been informed that a trademark that consists of the configuration of a product is functional if that configuration is essential to the use or purpose of the product, or if it affects the product's cost or quality. I have been informed that to meet the test of legal functionality it is not enough that the product serve a function; rather the product must be in a particular shape because it works better in that shape or costs less in that shape, such that precluding others from using the same configuration would prevent them from competing effectively.

20. I have been informed that when determining the functionality of a trademark that consists of a product design, one must focus on the overall configuration, not whether each design feature individually serves a utilitarian purpose. I have been informed that functional elements that are separately unprotectable can be protected together as part of a trademark that also includes non-functional elements.

21. I have been informed that some considerations used to determine functionality are (1) whether advertising touts the utilitarian advantages of the design, (2) whether the particular design results from a comparatively simple or inexpensive method of manufacture, (3) whether the design yields a utilitarian advantage, (4) whether alternative designs are available, and (5) the existence of utility patents disclosing the utilitarian advantages of the design sought to be registered. With respect to alternative designs, I have also been informed that the availability of alternative designs may indicate whether the design embodies functional or merely ornamental aspects of the product.

22. I have been informed that the existence of a design patent that covers features of a trademark is evidence of non-functionality.

23. I have been informed that the term "acquired distinctiveness" (also called "secondary meaning") refers to the association of a product's configuration with the source of that product. I have been informed that it is this association of a product's configuration with the product's source that trademark law protects.

24. I have been informed that courts look at multiple factors to determine whether a trademark has acquired distinctiveness. I have been informed that copying of a design may be evidence of acquired distinctiveness.

## VIII. **THE PROCESS OF SMALL ENGINE DESIGN**

25. As background for my opinions, I set out below a brief summary of one approach to engine design. While this is not the only way to design an engine, it is illustrative of the types of decisions that need to be made to arrive at a working production grade engine.

### A. Initial Design and Layout

26. The first step is to determine the required displacement in cubic inches ("$in^3$") of the engine you want to design. The logical place to begin is with a target power output in horsepower ("hp") and an established horsepower per cubic inch ("$hp/in^3$").

27. The target power output will probably be dictated by customer demand or market convention. For instance, a 5.5 hp engine is a common power rating in the small utility-type engine market. The $hp/in^3$ may be based on what the company or an engineering team has achieved in the past, or it may be based on what a competitor has achieved, or it may simply be based on an engineering goal. For small utility-type engines, such as a GX Engine that is the subject of the present application, a good basis to start is 0.5 $hp/in^3$.

28. Given the target power rating of the engine and the horsepower per cubic inch decided upon, the displacement in cubic inches of the engine can be determined by simple calculation:

Target Horsepower ÷ Horsepower/Inch$^3$ = Inch$^3$

5.5 hp ÷ .5 hp/in$^3$ = 11 in$^3$ (displacement)

29. Displacement is the measure of volume that a piston moves through within the cylinder of an engine. As a practical matter, displacement is determined by the Bore area (the area of the piston head) x Stroke (the one-way distance traveled by the piston head within the cylinder). Having determined a desired displacement, we can readily calculate various combinations of Bore x Stroke to achieve the desired displacement.

| **Bore (in)** | **Bore area (in$^2$)** | **Stroke (in)** | **Displacement (in$^3$)** |
|---|---|---|---|
| 1.5 | 1.77 | 6.22 | **11** |
| 2.0 | 3.14 | 3.50 | |
| **3.0** | **7.07** | **1.56** | |

30. As shown in the table above, there can be many combinations, e.g., large bore x small stroke or small bore x large stroke. Each combination has its trade-offs with respect to emissions, overall engine size and combustion efficiency.

31. After the Bore x Stroke is selected, the position of the cylinder bore (vertical, inclined or horizontal) is determined. Again, there are many choices, but this is usually dictated by overall size requirement. All other things being equal, for a given Bore x Stroke measurement, a horizontal cylinder will result in a low, wide engine; a vertical cylinder will result in a tall,

narrow engine; and an inclined cylinder will result in something in between depending on the angle.

32. Once the Bore x Stroke and cylinder bore position is established, we can begin the process of determining the basic internal engine layout of the crankshaft, cam gear, piston and connecting rod, and cap. Beginning with the crankshaft and connecting rod, we generate a 360º degree path of the connecting rod and cap to determine inside cylinder clearance paths.

33. With these paths established, the gear centers—a critical design feature—can now be established for the timing gear (crankshaft) and the cam gear. The relative location of the gear centers is critical. When you are designing an engine, you want to keep it as small as possible. The tolerances between the gear centers (and by extension the moving parts turned by the crankshaft and cam shaft) is therefore very small.

34. The cam gear in turn operates through various other components – called the valve train – to allow the flow of air, fuel, and combustion gases into and out of the cylinder. These components include tappets, push rods, rocker arms, valves, etc. The valve train is designed together with the cylinder head, the portion of cylinder through which air, fuel, and combustion gases flow. Variations in the location of the gear centers change the design geometry of the entire valve train.

35. Next, additional gearing, such as governor gears, oil pumps, etc., is designed.

36. Only after these aspects of the internal design have been determined, it is possible to determine the shape of the crankcase cover, including required bolt spacing, gasket shape, and perimeter of the cover. Cylinder fins, walls, legs and other shapes are usually now determined.

Once these steps have been completed, a “Basic Engine Powerplant” has been established, which includes cylinder head, piston, connecting rod and cap, crankshaft, cam gear, valve train and miscellaneous gearing. This is an enclosed package with the cover mounting to the cylinder and the cylinder head attached to the cylinder.

37. At this point in the process, one can begin adding the “outside” components of the engine. It is typical to start with the flywheel, fan and ignition systems.

38. Fan size ultimately determines cooling rate of the engine. The larger the fan, the better; but noise must also be considered. Maximum fan diameter is established by the centerline of crankshaft to the mounting legs of the cylinder. This dimension is usually equal among competitors. The cooling air must be directed to the ‘hot spots’ of the cylinder and cylinder head. There needs to be some means of directing the air upward (either through an internal scroll or with the fan cover itself or with some combination), but many different fan cover configurations would accomplish this. The particular shape chosen is cosmetic.

39. A rewind or recoil starter, rotating screen, and fan cover are created. The amount of ‘open area’ in the recoil cover determines the amount of air drawn into the engine. Any number of variations in the shape of the recoil cover, such as holes, slots, squares, rectangles or other openings, can provide the open area required for effective cooling. Again, the appearance of these features is mostly cosmetic.

40. The next steps might be to add the carburetor and air cleaner. The carburetor can be directly mounted to the cylinder head or mounted with an elbow. The air cleaner may also be mounted in several locations. For example, it could be extended horizontally above the top of the fan cover in front of the fuel tank, or mounted in front of the carburetor extending down

below the carburetor. Again, the particular shape and appearance of the air cleaner cover and carburetor cover are usually determined by customer demand and styling, and are almost entirely cosmetic.

41. The remainder of the outside components can now be determined. These typically include a muffler, fuel tank, engine governing levers and other controls. The fuel tank may be mounted in several locations. For example, it could be on the top but in the back side or further to the left. Again, the particular shape and appearance of the fuel tank can be varied based on the desired look. Accessories, such as an off-on switch, choke and speed levers, and safety guards, plus customer add-ons, are the last items fitted.

B. Prototype Fabrication and Testing

42. Once the parts have been designed and detailed to ensure the tolerances are functional, the designs are transferred to a model shop where one or two engines are fabricated from scratch.

43. The model engine is then tested in a variety of ways. The engine is coupled to a dynamometer in a test cell. A variety of thermocouples are attached to the engine to determine the temperature at a number of critical positions on the model. Initially, basic mechanical functioning is tested at low speed to confirm, for example, that oiling within the crankcase is satisfactory. Eventually, the engine is brought up to rated full load at rated speed where all the thermal conditions are at their worst. The engine's power output, torque, and temperature are continuously monitored.

44. Many aspects of engine performance must be tested by trial and error. For example, if the horsepower falls short of expected, the design team might need to change valve size, valve lift, carburetor size, etc. The same sort of trial and error process applies to other aspects of

engine performance including, for example, oiling, cooling, and fuel flow. Testing of multiple prototypes may be required.

45. After achieving the rated speed and horsepower with acceptable temperatures and good oiling of the engine components, a life test is run at full load and maximum rated speed. Such a test enables you to determine the durability of crankshaft, connecting rods, cylinder, etc. At Briggs & Stratton, we ran life tests for 1000 to 1500 hours, depending on the type of engine tested. For the premium brand Vanguard line of engines that competed directly with the Honda GX Engine, we tested engines for 1500 hours.

C. Exterior Design Features

46. Styling of the engine can usually begin after the engine layout is complete and prototype fabrication has started.

47. Often companies will employ or contract with an Industrial Designer to develop a packaged appearance that will be appealing, distinguish the finished engine from other competitive products, and associate it with other product offerings from the same manufacturer.

48. An Industrial Designer is asked to visualize concepts. The stylist will take into account requests from Sales, Marketing and other departments to provide various sketches. A variety of various concepts are reviewed. At such time, appearances such as beveled edges, radii edges, sharp corners or other shapes and contours are considered. Additional items such as covers, shrouds, control placement and customer convenience items can be styled-in at this time. The look of an engine takes into account features such as decorative covers and their shapes, colors, intake air openings (slots, holes, etc.) and the blending of all lines.

49. Industrial Designers have to work closely with the engineers to insure that the styling concepts do not affect the performance of the engine. The styling should be purely cosmetic. Materials might also play an important role in styling. The manufacturability and assembly ease must also be considered.

50. Many revisions of the styling concepts may be necessary before the final appearance is complete. After approval, an engine "mock-up" is fabricated which is used to show management and customers the prototype engine.

D. Summary

51. To summarize, the steps generally required to design the "inside" of the engine are:

Establish cubic inch displacement

Establish Bore x Stroke

Determine gear centers

Determine valve train

Finish cylinder finning, cylinder head design and crankcase cover

52. Once these steps have been completed, one can add "outside" components, such as:

Flywheel and fan

Ignition system

Fan cover and rewind starter

Carburetor

Air cleaner

Fuel tank

Governing and controls

Muffler

Accessories

53. Finally, the entire engine appearance is stylized in order to achieve a brand identity.

## IX. THE GX ENGINE TRADEMARK IS NONFUNCTIONAL

54. The Honda GX Engine has a distinctive overall look and configuration that comes from the combination of various design elements, which are the subject of the trademark application at issue in this proceeding. Based on my experience designing engines of this type, I expect that the Honda GX engine was consciously styled to have its distinct appearance.

55. In my opinion, the design features of the GX Engine as shown in Exhibit A are matters of styling, not matters of functionality. The GX Engine does not work better or cost less because of these design elements, either when considered individually or as whole.

56. Below, I discuss some of the notable design features found on the GX Engine. I do not attempt an exhaustive catalog of all the unique features of the GX Engine. Instead, I explain from the standpoint of a design engineer why and to what degree the particular design features of the Honda GX Engine are not functional. I also provide examples of alternative designs on competitor engines, further demonstrating that these features are nonfunctional.

### A. The Fan Cover Shape

57. Honda has chosen a distinctive fan cover rounded on the right side (as you look at the fan cover), with a square corner on the upper left side, and angled on the lower left side. The appearance of the fan cover is purely cosmetic.

58. These edges might be beveled, have a larger or smaller radius, stepped contour, or some other unique shape such as a squared design. The angular position could be steeper or shallower.

59. Although one of the functions of the fan cover is to direct the air from the fan to the cylinder, many different shapes can serve this function without affecting cost or quality of the engine. Some examples are provided below.

60. As shown below, the existence and angle of the slant (on the left side) of the fan cover can vary. The fan cover can have various designs and geometries including those with a circular or angled left side.

Honda Fan Cover


Alternative Fan Cover Designs

Briggs INTEK

Kawasaki


Kohler Command Pro
(Old Design)


Subaru EX 17

61. In addition to the shape of the fan cover, another distinctive feature is how the angle of the lower left side is maintained up to the left edge of the carburetor cover, giving it a continuous look unlike its various competitors' engines shown below.

Honda Fan Cover Line


Alternative Designs


Briggs INTEK


Subaru EX 17


Kawasaki

B. The Air Cleaner Cover Including the Location, Shape, Size, Beveled Edges, and Belt-Like Area

62. Honda has chosen an air cleaner cover located to the left of the fuel tank with a distinctive cube-shape that mirrors the squared corner of the upper left edge of its fan cover, beveled top outsides edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference. The appearance, size, and location of the air cleaner cover are purely cosmetic which is demonstrated by the examples of alternative designs below.

## Honda Air Cleaner Cover Shape

## Alternative Air Cleaner Cover Shapes


Kohler Command Pro (New Design)

Subaru EX 17

Kawasaki

Subaru EX 35


Briggs INTEK

63. As shown above, the air cleaner cover could be round, rectangular, or some other shape to accommodate the inside shape of the air cleaner element without affecting the cost or quality of the engine. For example, the Subaru Robin engine has a leftward sloping appearance that differs from the cubic shape of the GX Engine air cleaner cover.

64. The air cleaner can be located in a variety of locations as well. As shown below, unlike the GX Engine, the Briggs & Stratton INTEK, Kawasaki, and Subaru EX 35 engines have the air cleaners directly mounted to the carburetor and front-mounted rather than top-mounted like the GX Engine air cleaner. Also unlike the GX Engine, the Briggs & Stratton 9 HP Vanguard

engine uses an air cleaner mounted on top of the engine but in front of the fuel tank that runs the entire front of the engine.

## Honda Air Cleaner Location


## Alternative Air Cleaner Locations

Briggs INTEK

Subaru EX 35

Kawaski


Vanguard 9 HP

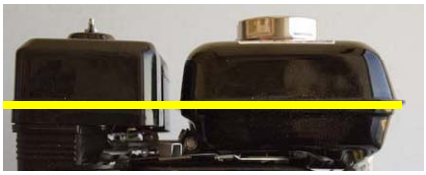
65. Another distinctive feature is that the top outside edges of the Honda GX Engine air cleaner cover are beveled to complement the beveling on the outward-facing and inward-facing edges of the fuel tank. The edges could be beveled with larger or smaller radii, sharp or a stepped contour.

66. It is my understanding that Honda recently changed the beveling so that it is softer. The beveling on the air cleaner cover is still similar and complementary to the beveling on the fuel tank, and does not change the overall impression of the GX Engine. Moreover, this change does not affect the cost or quality of the engine.

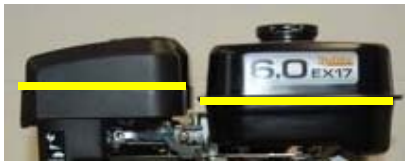
67. The Honda GX Engine air cleaner cover also has a distinctive belt-like area on the lower portion of the cover encompassing the entire circumference where the top of this belt-like feature

is aligned with the rib (seam) of the fuel tank to give a look of continuity. Neither the Briggs & Stratton nor the Kawasaki engines have this distinctive belt-like feature. While the Subaru Robin engine has a belt-like area, unlike the GX Engine cover, it is not aligned with the fuel tank seam.

Honda



Subaru EX 17




68. Honda recently added a "skirt" on the lower left portion of the air cleaner cover. This change does not affect the cost or quality of the engine or change the overall visual impression of the GX Engine.

69. Honda also uses a distinctive raised circular portion with a wing nut attachment that is absent from the designs above. This raised circular portion does not affect the cost or quality of engine, and could be a shape other than a circle.

C. The Carburetor Cover Including the Location, Shape, Size, Plastic Ribs, Control Placement, and Orientation

70. Honda has chosen a stylized carburetor cover that also houses various engine controls. The carburetor cover features four ribs along its outside edge and a receded area where controls levers are located. The appearance, size, and location of the carburetor cover are purely cosmetic which is demonstrated by the examples of the alternative designs below.

Honda Carburetor Cover Shape

Alternative Carburetor Cover Shapes

Subaru EX 17

Kohler Command Pro (Old Design)

Kohler Command Pro (New Design)

71. As depicted above, there are a variety of shapes and sizes for the carburetor cover.

72. The carburetor cover can be placed in a variety of locations. As described above with respect to the air cleaner cover, unlike the GX Engine, some engines including the Briggs & Stratton INTEK, Kawasaki, and Subaru EX 35 do not even have carburetor covers because the air cleaners are mounted directly to the carburetors.

73. The GX Engine carburetor cover features four ribs along the outside edge. The presence of the ribbing, including the number of ribs, is completely arbitrary.

74. The GX Engine carburetor cover also has a receded area where control levers are located. The engine controls can be placed within this cover, as Honda has chosen to do, or numerous

other locations without affecting the cost or quality of the engine. Again, styling dictates control placement. As shown below, the Briggs & Stratton INTEK engine controls are located in a different area, for example the fuel shut-off and speed controls are located on the right side of the engine.

Honda Control Location


Briggs INTEK Control Location


75. It is my understanding that Honda recently removed the four ribs on the carburetor cover and used a rounder bottom left edge. These changes do not affect the cost or quality of the engine and do not change the overall visual impression of the GX Engine.

D. The Fuel Tank Including the Location, Shape, Size, Orientation, Beveled Edges, Seam, and Mounts

76. Honda has chosen a fuel tank located on the top right side of the engine with a roughly rectangular shape that mirrors the angles on the air cleaner cover and the radii on the upper left corner of its fan cover, beveled top outside edges, and a seam roughly in the middle of the fuel tank. The shape, location, beveling, mounts, and location of the seam of the fuel tank are purely cosmetic which is demonstrated by the examples of the various designs below.

77. As shown below, the fuel tank can come in a number of shapes and sizes. While the fuel tank size in part determines capacity, the exact dimensions may vary and still provide the desired

capacity. The fuel tank could also be square, oval, trapezoidal, or other unique shapes. Honda has recently changed the fuel tank so that it is slightly taller around the outside edges. This change does not affect the cost or quality of the engine and does not change the overall visual impression of the GX Engine.

Honda Fuel Tank Shape

Alternative Fuel Tank Shapes


Briggs INTEK


Subaru EX 17


Kohler Command Pro (Old Design)


Kawasaki

78. The GX Engine fuel tank is located on the top right side of the engine. Although the fuel tank must be located above the carburetor to allow gravity flow of fuel to the engine, it can also be located in other areas such as along the entire top back side or across the front of the engine as shown below.

## Honda Fuel Tank Location


## Alternative Fuel Tank Locations


Kawaski


Vanguard 9 HP

79. Honda has chosen to use a seam that is roughly in the middle of the fuel tank to align with the horizontal top line of the belt-like area on the air cleaner cover, creating a distinctive continuous horizontal line visible across the entire front portion of the engine. As shown below, the placement and orientation of the seam is arbitrary and could be, for example, diagonal (as Kohler has chosen to use).

## Honda Fuel Tank

## Kohler Command Pro Fuel Tank


80. The distinctive beveling on the GX Engine fuel tank is similar and complementary to the beveling on the air cleaner cover. As shown below, tank edges could be beveled with larger or smaller radii, sharp or a stepped contour. It is my understanding that Honda recently changed

the beveling so that it is softer, while still similar and complementary to the beveling on the air cleaner cover. This change does not affect the cost or quality of the engine and does not change the overall visual impression of the GX Engine. In addition to the beveling, the degree of the angle of the walls of the fuel tank offers a further opportunity for product differentiation as shown in the variety of designs below.

81. Another distinctive feature is the complementary sloped shape of the top right side of the fuel tank and the lower left side of the fan cover on the GX Engine that is absent from the designs below.

Honda Angles

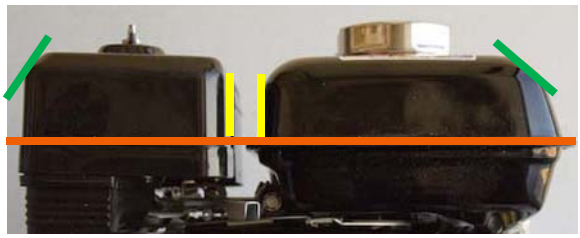

Alternative Designs

Briggs INTEK


Subaru EX 17


Kawasaki

82. The combined and complementary shape of the GX Engine fuel tank and air cleaner cover is distinctive and nonfunctional. The top left angle of the air cleaner cover was designed to mirror the angle of the right side of the fuel tank (shown below in green), the right vertical line of the air cleaner cover was designed to mirror the left vertical line of the fuel tank (shown below in yellow), and the air cleaner cover and the fuel tank were designed to have the same height and horizontal lines giving a look of continuity. Also the top portion of the belt-like area of the air cleaner cover is aligned with the seam of the fuel tank to once again achieve a continuous and complementary appearance (shown below in orange).



83. As illustrated below, there are a variety of design approaches for the combined appearance of the fuel tank and air cleaner cover. For example, the Subaru EX 17 fuel tank uses horizontal and vertical edges whereas the air cleaner cover has a more sloped and rounded appearance. The Kohler engine uses a fuel tank with angular edges whereas the air cleaner cover has a cylindrical shape with rounded edges. The Briggs INTEK 900 engine uses a fuel tank with rounded edges whereas the air cleaner cover has sharper edges and is mounted much lower than the fuel tank.

## Honda Air Cleaner Cover & Fuel Tank Profile

## Alternative Designs


Briggs INTEK


Subaru EX 17


Kohler Command Pro (New Design)

84. The design and orientation of the GX Engine fuel tank mounts are distinctive and nonfunctional. Honda has chosen to mount its fuel tank by attaching to legs that are an integral part of the crankcase. The Honda mounts are designed to mate securely with the shape of the Honda fuel tank and are thus part of the overall design strategy. In general, the mounting of the fuel tank could be with brackets attached to the tank or the tank directly mounted to the engine cylinder.

E. The Relative Position and Orientation of Each of the Major Honda GX Engine Components and Overall Cubic Design

85. Honda has chosen components with particular dimensions that in turn affect the relative position and orientation of the components. The combination of spacing between the components, the shapes of the components, and the way the shapes of the components are oriented toward each other helps the styling avoid a cluttered or bulky look.

86. The relative position, shape, size, and orientation of each of the major Honda GX Engine components is consistent with and creates the distinctive overall cubic design of the engine. As discussed above, there are alternative locations available for the major engine components. These alternative locations also allow for safe operation of the engine and enable easy access to the major engine components for inspection or maintenance. The fuel tank can run all the way across the top of the engine, the air cleaner can be located directly left of the fan cover instead of above it or can be located above the fan cover but run across the entire width of the engine, and the carburetor can be behind the air cleaner rather than below it. These are just some of the alternatives that exist in the market. Other alternatives could exist that function equally as well as the GX Engine.

87. I understand that Opposers contend that the location of the muffler dictates the location of the major engine components. I disagree. As with the other major components discussed above, there are alternative locations and shapes available for the muffler. For example, the old design of the Kohler Command Pro engine uses a muffler that is located behind the air cleaner cover that spans the entire back of the engine (unlike the GX Engine). Similarly, as explained above, even with the muffler located where it is on the GX Engine, the location of the carburetor and air cleaner covers can vary.

88. While a cubic design allows the engine to be compact, other engine designs (for example, rectangular (taller or wider) or oblong) can serve this function equally well and compete effectively with the Honda GX Engine.

89. A cubic engine design is not necessary for incorporation into original equipment manufacturers' products. Although there are SAE engine standards that manufacturers must conform to, various engine designs can be incorporated into original equipment manufacturers' products.

90. Many products, for example pressure washers, pumps, and compressors, have open sides. As long as the engine fits within the frame of those products, there is room for variation in size and shape.

91. Furthermore, original equipment manufacturers frequently work with engine manufacturers in designing products that can incorporate engines with a particular design (including configurations that do not have a cubic design).

92. As set forth above, many of the individual features of the GX Engine complement each other and are purposely done for styling. The details of each element, including, for instance, the complementary beveling of the air cleaner edges and fuel tank, the complementary sloped upper right corner of the fuel tank, bottom left side of the fan cover, and the upper left corner of the air cleaner cover, are indicative of a consciously stylized appearance. More importantly, the most noticeable components on the engine – air cleaner cover, fan cover, carburetor cover, and fuel tank – all have the stylized features that interrelate in appearance and that do not affect engine performance. Instead, these design details are merely cosmetic styling which creates the distinctive overall look of the Honda GX Engine. This styling does not necessarily increase or decrease the component cost. Furthermore, the quality of the engine is not affected by the styling features discussed above.

93. The below examples demonstrate the opportunity for each manufacturer to create a visually distinctive design and configuration without sacrificing cost or performance.

Honda GX Design


Alternative Engine Designs

Kohler Command Pro (New Design)

Kawasaki

Briggs INTEK

Kohler Command Pro (Old Design)

Subaru EX 35

Subaru EX 17

94. As shown below, the minor changes made recently to the GX Engine (discussed above) do not change the overall visual impression of the GX Engine. The relative position, shape, size, and orientation of each of the major components remain the same and continues to create the same distinctive overall cubic design and configuration.



X. **PATENTS**

95. It is my understanding that Opposers have asserted that various patents demonstrate the functionality of the design depicted in Exhibit A. I have reviewed several patents including U.S.

Patent No. 4,813,385 (the "'385 patent"), U.S. Patent No. 6,941,919 (the "'919 patent"), U.S. Patent No. 6,362,533 (the "'533 patent"), U.S. Patent No. 6,489,690 (the "'690 patent"), U.S. Patent No. 6,331,740 (the "'740 patent"), U.S. Patent No. 6,525,430 (the "'430 patent"), JP S57-30407, JP S63-35160, JP S62-33961, JP S59-40536, JP S63-32344, JP 59-62238, JP 62-31640, and JP 59-59577, and, in my opinion, none of these patents show that the design depicted in Exhibit A is functional.

96. None of these patents describe or claim the details that comprise the appearance of the engine shown in Exhibit A. While there is a description of the general shape of some of the components (e.g., "substantially rectangular when viewed in plan" ('385 patent); "fan cover has a generally cylindrical shape" ('430 patent); "fan cover [] bulges greatly along the engine cylinder" ('533 patent); "cylinder inclined" ('430 patent)) and the general location of some components (including the air cleaner, muffler, fuel tank, crankcase, cylinder, carburetor, fan cover, and controls), none of these patents describe the individual design elements of these components (e.g., beveled outside edges, belt-like area on the air cleaner cover where the top portion aligns with the seam of the fuel tank) that give the GX Engine its unique, distinctive appearance. Moreover, the invention of these patents focus on other features that can be used in numerous engine designs (including, but not limited to the GX Engine) such as a cyclone-type precleaner ('385 patent), and a cooling fan device (JP 63-35160). Also, many of these patents concerns generators in which the engine appearance and configuration is different from that depicted in Exhibit A.

97. Furthermore, the patents concerning the fuel tank (JP 59-62238 and JP 62-31640) do not cover the individual design elements of the fuel tank, for example the placement of the seam.

98. Unlike the general descriptions in the patents referenced above, the design patent, U.S. Patent DES. 282071, depicts many of the details that make up the appearance of the GX Engine shown in Exhibit A and therefore confirms my opinion that this design is nonfunctional.

## XI. **RELEVANT EXPERIENCE WITH THE HONDA GX ENGINE**

99. I first became aware of and familiar with the Honda GX Engine approximately 30 years ago, while working at Briggs & Stratton.

100. As discussed above with respect to my qualifications, at Briggs & Stratton, I was engineering manager for the Vanguard line of engines that competed with Honda and Kohler in the high-quality, high-end portion of the small-utility engine market. The Honda GX Engines were considered industry-leading, and we were constantly trying to improve our engines to match the performance and durability of the Honda GX Engine.

101. As someone who has worked in the small gasoline engine industry for nearly 40 years, and specifically in the years since the Honda GX Engine reached the market, and based on my specific experience designing engines to compete with the Honda GX Engine, it is my opinion that the Honda GX Engine is famous in the market for small gasoline engines, due to, among other things, its startability, dependability, reliability, and innovation.

102. In addition, the look of the GX Engine is well-known throughout the industry. Based on my experience dealing with original equipment manufacturers, distributors, dealers, and other potential customers for such engines, I believe that a large number of such individuals would immediately recognize the look of the GX Engine and associate it with Honda regardless of the color or finish of the engine.

103. It is my understanding that Honda recently made certain external changes to the GX Engine previously discussed. These changes do not affect the cost or quality of the engine. It is my opinion that these changes are minor and do not change the overall look of the GX Engine, and that those in the industry would continue to recognize the look of the GX Engine and associate it with Honda.

## XII. TRIAL EXHIBITS

104. I may rely on visual aids and demonstrative exhibits that demonstrate the bases of my opinions. Examples of these visual aids and demonstrative exhibits may include, for example, photographs of engines, actual engines, interrogatory responses, deposition testimony, and deposition exhibits, as well as physical exhibits, charts, photographs, diagrams, videos, and animated or computer-generated videos.

## XIII. SUPPLEMENTATION OF OPINIONS

105. I understand that discovery is ongoing in this case. I therefore reserve the right to adjust or supplement my opinions after I have had the opportunity to review deposition testimony or in light of additional documents or information that may be brought to my attention. I also reserve the right to amend or supplement my analysis in light of any critique of my report or alternative opinions advanced by or on behalf of the Opposers in this proceeding.

Dated: 9-28-12

By: James Mieritz

**EXHIBIT A**

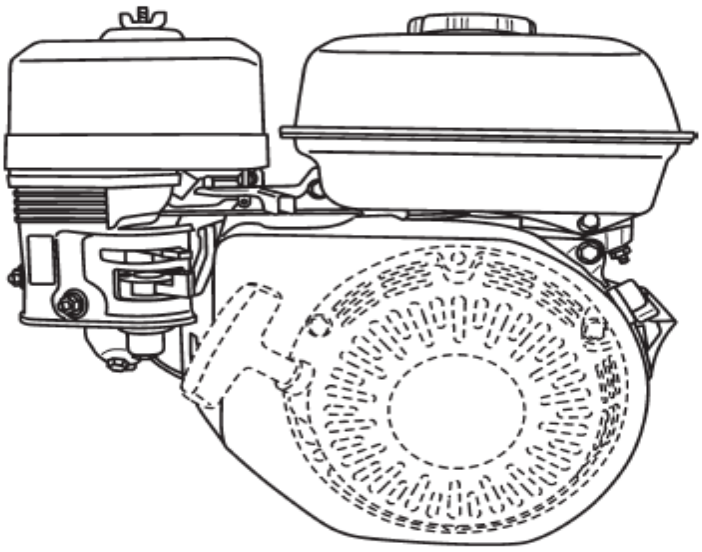


**EXHIBIT B**


# JAMES T. MIERITZ

**4315 Collingtree Drive**
**Rockledge, Fl. 32955**
**262-227-6447**
**Jmieritz@cfl.rr.com**


## Summary of Experience

Senior level professional with over 25 years of diversified experience in worldwide engineering and business operations management. Extensive background in manufacturing and quality systems, pricing, negotiations, new product development, program management, strategic planning, and design.

July 2006 to December 2008

**Cequent Trailer Products / Division of Trimas Corporation**, Mosinee, Wisconsin

**Senior Global Sourcing Manager/Engineering:** Responsible for offshore component sourcing and engineering.

1970 to 2006

**Briggs & Stratton Corporation**, Milwaukee, Wisconsin
A $2.5 billion, Fortune 500 manufacturer of engines and powered systems with production facilities in the US, Japan, Europe, and China.

1998 to 2006

**Business Manager for Asian Operations:** Responsible to Divisional Vice President of Asian Operations for business management of joint venture facility in Japan (DBS Co LTD) and contract engine purchases from Mitsubishi Heavy Industries, engine transfer pricing, production scheduling, inventory, program management, forecasting, budgeting, engineering, and department supervision. Member Board of Directors of DBS Co LTD.

- Directed and managed DBS Co LTD. Member of the Board of Directors 1992-2004. **Result:** Achieved between $1,750,000 - $25,000,000 annual operating profits with an average annual dividend of $2,000,000.
- Recommended and proposed BIG BLOCK engine series concept. **Result:** Created new engine line with first year sales of 5,000 engines and a 5 year growth plan of 400% generating $2,500,000 operating profit.
- Negotiated engine transfer prices from Daihatsu/Briggs & Stratton (DBS) yearly. **Result:** Insured a 60-40% balance of operating profits for partners.
- Negotiated DBS engine discounts. **Result:** Established special customer prices for 30,000 consumer brand engines.
- Achieved an additional 7% DBS discount for Simplicity. **Result:** Maintained the business of 20,000 engines with sales of $8,000,000.
- Maintained minimum daily build rates. **Result:** Generated operating profits of $1,750,000 in 2005 and achieved positive operating profits for the past 15 years.
- Directed business with Mitsubishi Heavy Industries for engine orders, pricing, production schedules, and forecasting. **Result:** Negotiated 70,000 additional storm stock engines at up to $30 below standard cost. 2005 engine totals were

170,000 which generated $40,000,000 in sales.

- Structured engine discounts from Mitsubishi Heavy Industries. **Result:** Sold 90,000 engines that produced $24,500,000 in sales.
- Finalized contract to purchase engines from Mitsubishi Heavy Industries. **Result:** Renewed contract for an additional 5 years which produced $30,000,000 in annual sales and 100,000 engines per year.
- Launched a 5hp engine to China. **Result:** Completed a 2 year program to manufacture an engine with 80% of the components localized in China at the proposed target cost.
- Completed M12 marine engine. **Result:** Added $3,300,000 annual sales for the Chinese engine manufacturing plant.
- Developed a liquid-cooled V-twin engine. **Result:** Obtained 6 new commercial accounts with first year sales of $3,000,000.
- Obtained special prices for 5 customers SKU's. **Result:** Generated 30,000 new additional engines for $6,000,000 in sales.
- Eliminated premium freight of engines shipped from Japan. **Result:** Generated $750,000 annual savings.
- Transferred parts packaging from external to internal. **Result:** Achieved $500,000 annual savings.
- Developed executive personnel. **Result:** Promoted the following: program manager to product manager, program manager to manufacturing development manager, technician to program manager, technician to application engineer and engineer to engineer specialist.

1988 to 1998

**Engineering Manager Vanguard Engines:** Responsible to Vice President/General Manager Vanguard Division for engineering management of premium brand of engines from 4-25hp. Managed an engineering staff for design and development, budgets, cost, new products, program management, long range planning and engineering documentation.

- Designed and developed a new 9hp engine. **Result:** Expanded the engine series into the commercial market which provided 50,000 additional engines per year.
- Established a cost reduction program to maintain profitability @ 90 Yen/$. **Result:** Manufactured over 1,500,000 engines in 15 years which provided $40,000,000 annual sales.
- Increased engine hp for additional V-twin models. **Result:** Generated $20,000,000 in annual sales.
- Expanded single cylinder engine line. **Result:** Added 4 engines that increased annual sales by $10,000,000.
- Promoted to Business Manager for Asian Operations.

1964 to 1988

Held positions of increasing responsibility: **Manager of Engineering/Industrial-Commercial Engines, Assistant Chief Design Engineer/Large Engines, Assistant Chief Design Engineer, Project Engineer and Tool Design/Specifications Writer/Draftsman.**

- Promoted to Engineering Manager Vanguard Engines.

| | |
|---|---|
| **Education:** | MBA Degree, Keller Graduate School, Milwaukee, Wisconsin<br>BSME Degree, Marquette University, Milwaukee, Wisconsin |
| **Professional Affiliations:** | Society of Automotive Engineers (SAE)<br>Past Chairman Small Engine Committee |

**EXHIBIT C**

Materials Considered

AHGX0006589-96
AHGX0006696-699
AHGX0033264-73
AHGX0033444-52
AHGX0057180-85
AHGX0057186-88
AHGX0057199-203
AHGX0061090-61123
AHGX0061124-131
AHGX0061132-139
AHGX0061140-145
AHGX0061169-353
AHGX0061583-649
AHGX0063148-218
AHGX0063244-248
AHGX0064689-820
AHGX0065560-65969
AHGX0066775-66940
AHGX0067421-67523
AHGX0079700-747
AHGX0080781-81129
AHGX0081698-82050
AHGX0082293-391
AHGX0096560-562
AHGX0097298-308
AHGX0097316-409
AHGXC000394-398
AHGXC000399
AHGXC000400-401
AHGXC000402-411
AHGXC000434
AHGXC000648-652
AHGXC000658-671
Engine: Honda GX 120
Engine: Honda GX 160
Engine: Honda GX 200
Engine: Honda GX 240
Engine: Honda GX 270
Engine: Honda GX 340
Engine: Honda GX 390
Engine: Kohler Command Pro 6
Engine: Kohler Command Pro 7
Engine: Kohler Courage (SH265)
Engine: Briggs & Stratton Intek Pro 206
Engine: Briggs & Strattong Intek Pro 305
Engine: Briggs & Stratton 550 Series
Engine: Briggs & Stratton 750 Series
Engine: Briggs & Stratton 900 Series
Engine: Briggs & Stratton 1150 Series
Engine: Briggs & Stratton 1450 Series
Engine: Briggs & Stratton 1450 Series low profile
Engine: Briggs & Stratton 1600 Series
Engine: Briggs & Stratton 2100 Series
Engine: Vanguard 13hp
Engine: Vanguard 9hp
Engine: Vanguard 7.5hp
Engine: Vanguard 6hp
Engine: Vanguard 2.4hp
Engine: Subaru Robin EX 17

Engine: Subaru Robin EX 21

Engine: Subaru Robin EX 35

Engine: Kawasaki FE170

Engine: Kawasaki FE250

Letter of Protest Concerning Application Serial No. 78/924545

September 2, 2008 Office Action Concerning Application Serial No. 78/924545

March 4, 2009 Response to September 2, 2008 Office Action Concerning Application Serial No. 78/924545

February 5, 2010 Office Action Concerning Application Serial No. 78/924545

August 4, 2010 Response to February 5, 2010 Office Action Application Serial No. 78/924545

August 26, 2010 Office Action Concerning Application Serial No. 78/924545

Declaration of James Mieritz in Support of Application Serial No. 78/924545

Declaration of Kevin Hoag in Support of Application Serial No. 78/924545

U.S. Patent and Trademark Office Official Gazette, January 25, 2011, TM381

Kohler Co.'s Notice of Opposition, No. 91200146, Filed May 25, 2011

Briggs and Stratton Corporation's Notice of Opposition, No. 91200832, Filed July 22, 2012

Opposers' Motion for Leave to File Amended Notices of Opposition, Opposition No. 91200832 (parent), Dkt. No. 11

Motion for Leave to File Summary Judgment Motion Regarding Functionality of Applicant's Claimed Engine Configuration, Opposition No. 91200832 (parent), Dkt. No. 21

Deposition of Scott Connor, Vol. I, August 9, 2012

Deposition of Scott Connor Vol. II, August 10, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Expert Report of James Mieritz was served by first class mail, postage prepaid, this 28th day of September, 2012 upon:

Donald Daugherty
Whyte Hirschboeck Dudek S.C.
555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202

And

Robert N. Phillips
Seth B. Herring
Reed Smith LLP
101 Second Street
Suite 1800
San Francisco, California 94105

Sarah R. Frazier

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

| | | |
|---|---|---|
| BRIGGS & STRATTON CORPORATION and KOHLER CO., | ) | |
| Opposers, | ) | Opposition No. 91200832 (parent) |
| v. | ) | Opposition No. 91200146 |
| HONDA GIKEN KOGYO KABUSHIKI KAISHA, | ) | Application Serial No. 78924545 |
| Applicant. | ) | |

**REBUTTAL EXPERT REPORT OF JAMES MIERITZ**

## I. INTRODUCTION

1. I previously submitted an expert report on behalf of Applicant Honda Giken Kogyo Kabushiki Kaisha ("Honda") on September 28, 2012.

2. I have reviewed the Report of Professor John R. Reisel submitted on behalf of Opposers Briggs and Stratton Corporation and Kohler Co. on September 28, 2012 (the "Reisel Report"). This rebuttal report addresses the opinions and underlying support included in the Reisel Report.

## II. QUALIFICATIONS

3. A summary of my qualifications and experiences is contained in my initial report of September 28, 2012.

## III. SUMMARY OF OPINIONS

4. As set forth in detail below, I disagree with Professor Reisel's opinions regarding the functionality of certain features of the Honda GX Engine that is the subject of the trademark application at issue in the above-entitled proceedings.

5. None of the opinions contained in the Reisel Report change the opinions expressed in my initial report, each of which I incorporate by reference into this report. It continues to be my opinion that the GX Engine that is the subject of the present application has a unique and distinctive overall appearance, which is comprised of several individual design features that are discussed in my initial report. It is further my opinion that these individual design features do not contribute to the functionality of the GX Engine and are instead cosmetic.

6. My opinions are based on my skills, knowledge, experience, education, and training, as well as information provided to me as of the date of this report.

## IV. MATERIALS CONSIDERED

7. In reaching the opinions expressed in this rebuttal report, I have reviewed additional documents and small gasoline engines which are listed at Exhibit A, as well as the documents and engines identified in my initial report.

## V. THE GX ENGINE FEATURES DISCUSSED IN THE REISEL REPORT ARE NONFUNCTIONAL

8. I disagree with Professor Reisel that the features of the GX Engine discussed in his report are functional. These features, as they are described and shown in the application at issue, do not cause the GX Engine to work better or cost less, either when considered individually or as a whole.

### A. Overall Cubic Design

9. As a preliminary matter, I disagree with Professor Reisel's definition of a "cubic" design as "one with approximately flat surfaces meeting at roughly 90º angles." Reisel Report, ¶ 11. In the context of the GX Engine trademark that is the subject of this proceeding, I understand that Honda maintains that cubic design refers to the approximately equal width and height of the GX Engine when viewed from the perspective shown in the application at issue, as well as the overall visual cubic impression of the engine created by the relative position, shape, size, and orientation of each of the major GX Engine components. As discussed in my initial report, this overall cubic design is not necessary for functionality or competitiveness.

10. Horizontal shaft gasoline-powered engines can be manufactured, operated, and compete effectively without having roughly equal height and width. For example, the Briggs and Stratton INTEK 900 Series engine competes effectively in the market with a design that is noticeably taller than it is wide.


Honda


Briggs INTEK

11. I disagree with Professor Reisel's opinion that the edge of the fuel tank should be roughly aligned with the right side of the engine block. *See, e.g.*, Reisel Report, ¶ 14. The fuel tank can be moved further right from the location on the GX Engine, such that it extends beyond the plane of the engine block on the right side, without additional cantilevered support.

12. I also disagree with Professor Reisel's opinion that the air cleaner and muffler cannot move very far to the left because it would impede access to the spark plug. *See, e.g.*, Reisel Report, ¶ 15. As long as there remains adequate space between the muffler and the air cleaner for a socket wrench, the spark plug can be accessed even if the air cleaner cover and muffler are located further left.

13. It is Professor Reisel's opinion that an engine design with approximately flat surfaces "allows for placement of the crankshaft where it is expected by equipment manufacturers." Reisel Report, ¶ 16. Based on my experience designing engines for use by OEMs, OEM expectations are simply that the crankshaft and cover mounting surfaces will conform to Society of Automotive Engineer's ("SAE") standards. This can be achieved with many different engine designs. Because the crankshaft is located in the back of the engine, protrusions from the front and sides do not interfere with mating the engine to other equipment.

14. While compactness may be desired by OEMs for some applications, the GX Engine's overall cubic design is just one example of a compact engine. Compactness can be achieved through a variety of engine designs.

15. In Mr. Fujita's August 15, 2007 deposition, referenced in the Reisel Report, Mr. Fujita makes clear that the benefits of having a compact engine are separate from having a cubic design. *See, e.g.*, Deposition of Motohiro Fujita, August 15, 2007 at 202:3-21.

16. Moreover, Professor Reisel's reliance on U.S. Patent No. 7,086,389 is misplaced. The invention of this patent concerns a canister for absorbing fuel vapor which does not concern the trade dress at issue.

17. Therefore, it remains my opinion that the overall cubic design of the GX Engine is a matter of styling, not functionality. The GX Engine does not work better or cost less because of the overall cubic design. As demonstrated in my initial report, numerous alternative designs can effectively compete in the marketplace.

**B. <u>The Fan Cover Shape</u>**

18. The unique shape of the GX Engine fan cover is nonfunctional. As shown in my initial report, numerous different shapes can serve equally well the functions of directing air from the fan to the cylinder and preventing debris from entering the cooling air passages.

19. Professor Reisel relies on Japanese Utility Model Application No. S57-30407 as support for his opinion that the GX Engine fan cover is functional. This application concerns an engine design different from the GX Engine overhead valve design. Specifically, this application concerns an L-Head valve engine design with an in-line cylinder which uses a

perforated rotating screen attached to the flywheel. Therefore, this application is irrelevant to the question of whether or not the GX Engine fan cover is functional.

20. I disagree with Professor Reisel's opinions that the use of an inclined cylinder dictates the slant in the fan cover, and that the slant defines the necessary direction of the air flow. The inclined cylinder defines where the hottest part of the engine is. While cool air needs to be directed to the hottest parts of the engine, this can be achieved using a number of different external fan cover shapes and internal components (*e.g.*, baffling, deflectors, etc.).

21. Similarly, I disagree with Professor Reisel's opinion that the GX Engine "fan cover is designed at the optimal angle for drawing air through the system." Reisel Report, ¶ 21. The drawing in of air is not determined by the external shape of the fan cover, but rather the slots on the fan cover.

22. Professor Reisel's reliance on Japanese Utility Model Application No. S63-35160 as support for his opinion that the external fan cover design of the GX Engine is "a necessary functional element of the engine operation" is also in error. Reisel Report, ¶ 26. The invention of this application concerns an *internal* cooling device, namely carving out a space in the crankcase under the fan cover and flywheel, for a general purpose engine with a fan cover that has a flattened bottom. It has no bearing on the shape of the external fan cover.

23. Contrary to Professor Reisel's opinion, neither an inclined cylinder nor a slanted fan cover aids in engine lubrication. Gasoline-powered horizontal shaft engines like the GX Engine utilize an internal splashing mechanism for lubrication.

24. Professor Reisel inaccurately characterizes U.S. Patent No. 6,941,919 as describing "[t]he benefits of the slanted cylinders with regards to engine lubrication." Reisel Report, ¶ 24. The invention of this patent concerns an *internal* bearing support member (and not an inclined cylinder) that aids in oil flow. This added internal bearing support member is more expensive to include and thus many engines do not have this component.

25. Moreover, emissions are not reduced through the use of an inclined cylinder but rather as a result of OHV technology.

26. As shown in my initial report, a variety of OHV inclined-cylinder engine designs exist that do not share the unique GX Engine fan cover shape. The shape of the GX Engine fan cover, including but not limited to the specific slant on the lower left side, does not perform better or cost less than other alternatives. Fan covers with rounded left sides or with slants different from the GX Engine compete effectively in the market.

### C. <u>The Fuel Tank and Air Cleaner Positions</u>

27. The top right position of the GX Engine fuel tank is not required for effective engine operation or for competitiveness. While the fuel tank needs to be above the carburetor in order to enable gravity flow of fuel, it does not need to be placed on the right side of the engine, nor does it need to be "away from the cylinder head" as Professor Reisel claims. Reisel Report, ¶ 33. Alternative designs shown in my initial report demonstrate that the fuel tank can be located near the cylinder head and does not necessarily need to be placed on the right side of the engine.

28. The top left position of the GX Engine air cleaner cover is not required for effective engine operation or for competitiveness. While the air cleaner should be placed near the carburetor, there are several alternative positions available, as shown in my initial report.

29. I also disagree with Professor Reisel's opinion that "placing the air cleaner on the top of the engine makes the maintenance of the engine easiest with regards to air cleaner replacement." Reisel Report, ¶ 35. The ease with which the air cleaner can be replaced depends on the application in which the engine is installed. In some applications, it is easier to maintain the air cleaner if it is mounted on the front of the engine rather than on top.

30. Similarly, I also disagree with Professor Reisel's opinion that "[a] location on top of the engine also reduces the amount of debris the air filter encounters." Reisel Report, ¶ 35. Placing the air cleaner on top of the engine does not necessarily reduce the amount of debris the air filter encounters. Moreover, for many of the standard applications in which these engines are used (*e.g.*, power washers, generators, compressors), the air cleaner will not encounter a substantial amount of debris. In circumstances where a substantial amount of debris is expected, a precleaner element is typically attached to the air cleaner.

31. The air cleaner does not necessarily need to be positioned close to the carburetor to minimize the risk of contaminating the air with particulates before it passes through the carburetor. Rather, to keep the passageway between the air cleaner and carburetor clean, air-tight connections must be used (*e.g.*, gaskets, seals, etc.).

32. Professor Reisel's reliance on U.S. Patent No. 4,813,385 (the "'385 patent") is also misplaced. The invention of this patent concerns a cyclone-type precleaner that can be used in numerous engine designs (including, but not limited to the GX Engine). The patent does not

state that the location and shape of the major engine components provide any functional benefit over alternative designs; rather the patent focuses on the advantages of the cyclone-type precleaner (which is not part of the trade dress at issue). Moreover, the '385 patent is not directed to and does not describe the individual design elements of the components that give the GX Engine its unique, distinctive appearance.

### D. The Carburetor Cover and Recessed Area for Controls

33. A carburetor cover with a recessed area for control levers is purely cosmetic. It does not improve performance or reduce cost to have the controls located in a recessed area that is molded out of the carburetor cover. As discussed in my initial report, many engines do not even have carburetor covers. The location of the controls on the GX Engine is a matter of styling and design, not function. The controls can be located in numerous different locations that are just as convenient.

34. Control levers (including those that open/close the fuel flow) can be placed adjacent to the carburetor or placed further away from the carburetor without affecting the cost or performance of the engine. *See, e.g.*, Briggs & Stratton INTEK engine in my initial report.

35. Professor Reisel's reliance on Japanese Utility Model Application Nos. S62-33961 and S59-40536 is misplaced. These applications do not describe any functional advantage of having the controls located in a recessed area on the carburetor cover. Furthermore, contrary to Professor Reisel's assertion, Japanese Utility Model Application No. S59-40536 does not describe placing the speed control on the outside of the engine to allow for ease of use by the operator.

36. I also disagree with Professor Reisel's opinion that "[i]f the control levers for the carburetor located near the front of the engine are not recessed, they will interfere with the movement of the rewind during the starting of the engine." Reisel Report, ¶ 43. The location of the rewind handle is not static. It varies by engine, application, and can be easily changed by simply unscrewing a few bolts and rotating the recoil cover. The examples in Professor Reisel's own report show engines with rewind handles at different locations. *See* Reisel Report, ¶ 54. Even when the recoil handle is located on the upper left side of the recoil cover, the controls can be located in a variety of locations that do not impact the starting of the engine.

**E. <u>The Fuel Tank Shape, Size and Seam</u>**

37. As discussed in my initial report, the shape of the GX Engine fuel tank, the placement and orientation of the seam, and the fuel tank dimensions relative to the other major engine components, are matters of styling rather than function.

38. Fuel tanks, both metal and plastic, can have a number of different shapes that can be manufactured in a cost-competitive manner without affecting the performance of the engine. For example, a fuel tank can be square, rectangular, oval, or round.

39. A roughly rectangular fuel tank is not necessary for producing a compact engine design. Depending on the relative size and orientation of the fuel tank in relation to the other major engine components, the fuel tank can take a number of different shapes, as demonstrated in my initial report.

40. The fuel tank must hold a volume of fuel acceptable to the market. This can be achieved with a number of different shapes. The best shape and dimensions for optimizing fuel

tank volume while maintaining a compact engine design will depend on the relative size, shape and orientation of the other major engine components.

### F. The Air Cleaner Cover Shape

41. I disagree with Professor Reisel's opinion that air cleaner covers must be rectangular or oval-shaped. *See e.g.*, Reisel Report, ¶ 50. As shown in my initial report, there are a variety of shapes, relative proportions, and orientations available for air cleaner covers that do not affect the cost or performance of the engine. These designs have very different appearances when viewed from any angle. Even among rectangles and ovals there are numerous opportunities for differentiation.

42. Furthermore, the ornamental beveling on the GX Engine air cleaner cover is nonfunctional. These edges do not "diminish[] the differences in appearance between a rectangular profile and an oval profile," but rather contribute to the unique air cleaner cover and overall appearance of the GX Engine. Reisel Report, ¶ 52.

### G. The GX Engine Trademark is Nonfunctional

43. I disagree with Professor Reisel's opinion that many companies produce engines similar in appearance to the GX Engines.

44. It is my understanding that some of the models shown in Professor Reisel's report have been accused of infringing the GX Engine trademark. These engines include the Kohler SH265 and Briggs and Stratton 550 Series engines. In my opinion, over time some of the Kohler and Briggs' engine designs have evolved to look more like the GX Engine, including these two

models and the Briggs and Stratton 750 Series engines, which has a similar design to the 550 Series engines.

45. However, most of the engines shown in the Reisel Report have overall appearances very distinct from the Honda GX Engine. For example, the Subaru SP 170 has a fan cover with a rounded left side, and the same sloping asymmetrical air cleaner cover as the Subaru EX engines shown in my initial report. The Lifan 420cc engine has a relatively large air cleaner cover with a distinct angle on the right side that accommodates the sharp, arrow-like shape of the left side of the fuel tank. The Champion model #61151 engine also has a relatively large air cleaner cover and a very wide, "top-heavy" appearance with a control panel mounted to the right side. The Predator 346cc engine has a sloped air cleaner cover similar to the Subaru engines, tiered belting across the bottom of the air cleaner cover, and a fan cover with very sharp edges. The Kawasaki FJ180 engine has a rounded fan cover and an air cleaner cover with a rounded top edge and a visible nut cover that is offset to the left. These are just some of the distinctive elements of some of the engines shown in the Reisel Report that contribute to overall appearances that are very different from the GX Engine.

46. The engine described in Japanese Utility Model Application No. JP S63-32344 is only one example of a lightweight compact design that is adaptable to a wide variety of applications and allows for convenient maintenance. A smaller package that allows for convenient maintenance can be created through a number of different designs and configurations. Thus, I disagree with Professor Reisel's opinion that this application demonstrates that the claimed mark is functional and must be available to third parties in order to remain competitive.

47. Furthermore, in my initial report, I demonstrated the opportunity for other manufacturers to create a visually distinctive design and configuration without sacrificing cost or performance. This supports my opinion that other manufacturers do not need to be able to use the design depicted in the application at issue in order to compete effectively in the market for overhead valve engines.

## VI. TRIAL EXHIBITS

48. I may rely on visual aids and demonstrative exhibits that demonstrate the bases of my opinions. Examples of these visual aids and demonstrative exhibits may include, for example, photographs of engines, actual engines, interrogatory responses, deposition testimony, and deposition exhibits, as well as physical exhibits, charts, photographs, diagrams, videos, and animated or computer-generated videos.

## VII. SUPPLEMENTATION OF OPINIONS

49. I understand that discovery is ongoing in this case. I therefore reserve the right to adjust or supplement my opinions after I have had the opportunity to review deposition testimony or in light of additional documents or information that may be brought to my attention. I also reserve the right to amend or supplement my analysis in light of any critique of my report or alternative opinions advanced by or on behalf of the Opposers in this proceeding.

Dated: 11-21-12

James Mieritz

By: James Mieritz

# **Exhibit A**

Materials Considered

U.S. Patent No. 7,086,389

AHGX0036198-0036202 (January 19, 2007 Letter from Stetina Law Firm to WilmerHale)

AHGX0051631-0051641 (April 6, 2007 Letter from Stetina Law Firm to WilmerHale)

Engine Photo (in Reisel Report): Subaru SP170

Engine Photo (in Reisel Report): Predator 346cc

Engine Photo (in Reisel Report): Lifan 420cc

Engine Photo (in Reisel Report): Champion Model No. 61151

Engine Photo (in Reisel Report): Kawasaki FJ180

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Rebuttal Expert Report of James Mieritz was served by first class mail, postage prepaid, this 21st day of November, 2012 upon:

Donald Daugherty
Whyte Hirschboeck Dudek S.C.
555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202

And

Robert N. Phillips
Seth B. Herring
Reed Smith LLP
101 Second Street
Suite 1800
San Francisco, California 94105

Silena Paik

Exhibit 5
Materials Considered

AHGX0006589-96
AHGX0006696-699
AHGX0033264-73
AHGX0033444-52
AHGX0057180-85
AHGX0057186-88
AHGX0057199-203
AHGX0061090-61123
AHGX0061124-131
AHGX0061132-139
AHGX0061140-145
AHGX0061169-353
AHGX0061583-649
AHGX0063148-218
AHGX0063244-248
AHGX0064689-820
AHGX0065560-65969
AHGX0066775-66940
AHGX0067421-67523
AHGX0079700-747
AHGX0080781-81129
AHGX0081698-82050
AHGX0082293-391
AHGX0096560-562
AHGX0097298-308
AHGX0097316-409
AHGXC000394-398
AHGXC000399
AHGXC000400-401
AHGXC000402-411
AHGXC000434
AHGXC000648-652
AHGXC000658-671

Engine: Honda GX 120
Engine: Honda GX 160
Engine: Honda GX 200
Engine: Honda GX 240
Engine: Honda GX 270
Engine: Honda GX 340
Engine: Honda GX 390
Engine: Kohler Command Pro 6
Engine: Kohler Command Pro 7
Engine: Kohler Courage (SH265)
Engine: Briggs & Stratton Intek Pro 206
Engine: Briggs & Strattong Intek Pro 305
Engine: Briggs & Stratton 550 Series
Engine: Briggs & Stratton 750 Series
Engine: Briggs & Stratton 900 Series
Engine: Briggs & Stratton 1150 Series
Engine: Briggs & Stratton 1450 Series
Engine: Briggs & Stratton 1450 Series low profile
Engine: Briggs & Stratton 1600 Series
Engine: Briggs & Stratton 2100 Series
Engine: Vanguard 13hp
Engine: Vanguard 9hp
Engine: Vanguard 7.5hp
Engine: Vanguard 6hp
Engine: Vanguard 2.4hp
Engine: Subaru Robin EX 17
Engine: Subaru Robin EX 21
Engine: Subaru Robin EX 35
Engine: Kawasaki FE170
Engine: Kawasaki FE250

Exhibit 5
Materials Considered

Letter of Protest Concerning Application Serial No. 78/924545

September 2, 2008 Office Action Concerning Application Serial No. 78/924545

March 4, 2009 Response to September 2, 2008 Office Action Concerning Application Serial No. 78/924545

February 5, 2010 Office Action Concerning Application Serial No. 78/924545

August 4, 2010 Response to February 5, 2010 Office Action Application Serial No. 78/924545

August 26, 2010 Office Action Concerning Application Serial No. 78/924545

Declaration of James Mieritz in Support of Application Serial No. 78/924545

Declaration of Kevin Hoag Submitted in Support of Application Serial No. 78/924545

U.S. Patent and Trademark Office Official Gazette, January 25, 2011, TM381

Kohler Co.'s Notice of Opposition, No. 91200146, Filed May 25, 2011

Briggs and Stratton Corporation's Notice of Opposition, No. 91200832, Filed July 22, 2012

Opposers' Motion for Leave to File Amended Notices of Opposition, Opposition No. 91200832 (parent), Dkt. No. 11

Motion for Leave to File Summary Judgment Motion Regarding Functionality of Applicant's Claimed Engine Configuration, Opposition No. 91200832 (parent), Dkt. No. 21

Deposition of Scott Connor, Vol. I, August 9, 2012

Deposition of Scott Connor Vol. II, August 10, 2012

U.S. Patent No. 7,086 389

AHGX0036198-0036202 (January 19, 2007 Letter from Stetina Law Firm to WilmerHale)

AHGX0051631-0051641 (April 6 2007 Letter from Stetina Law Firm to WilmerHale)

Engine Photo (in Reisel Report): Subaru SP170

Engine Photo (in Reisel Report): Predator 346cc

Engine Photo (in Reisel Report): Lifan 420cc

Engine Photo (in Reisel Report): Champion Model No. 61151

Engine Photo (in Reisel Report): Kawasaki FJ180

Opposers Briggs and Stratton Corporation and Kohler Co.'s Motion for Summary Judgment, Dkt. No. 48

Declaration of R. Massari and Exhibits thereto in support of Opposers Briggs and Stratton Corporation and Kohler Co.'s Motion for Summary Judgment, Dkt. No. 49

Declaration of D. Daugherty and Exhibits thereto in support of Opposers Briggs and Stratton Corporation and Kohler Co.'s Motion for Summary Judgment, Dkt. No. 50

Deposition of John Lally in *Am. Honda Motor co., v. The Pep Boys-Manny Moe & Jack*, cv05-08879 (C. D. Cal), June 8, 2007 (AHGX0061462-61540)

Deposition of Motohiro Fujita in *Am. Honda Motor co., v. The Pep Boys-Manny Moe & Jack*, cv05-08879 (C. D. Cal), Vol. 1, Aug. 14, 2007 (AHGX0064689-64820)

Exhibit 5
Materials Considered

Deposition of Motohiro Fujita in *Am. Honda Motor co., v. The Pep Boys-Manny Moe & Jack*, cv05-08879 (C. D. Cal), Vol. 2, Aug. 15, 2007 (AHGX0061169-61353)

Deposition of Kevin Hoag in *Am. Honda Motor co., v. The Pep Boys-Manny Moe & Jack*, cv05-08879 (C. D. Cal), Aug. 23, 2007 (AHGX0067421-67523)

Deposition of James Mieritz in *Am. Honda Motor co., v. The Pep Boys-Manny Moe & Jack*, cv05-08879 (C. D. Cal), Aug. 28, 2007 (AHGX0061583-61649)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Declaration of James Mieritz In Support of Applicant Honda Giken Kogyo Kabushiki Kaisha's Opposition to Opposers Briggs & Stratton Corporation and Kohler Co.'s Motion for Summary Judgment was served by Federal Express, this 24th day of September, 2013 upon:

Donald Daugherty
Whyte Hirschboeck Dudek S.C.
555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202

And

Robert N. Phillips
Seth B. Herring
Reed Smith LLP
101 Second Street
Suite 1800
San Francisco, California 94105

Sarah R. Frazier