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

Proceeding	91200832
Party	Defendant Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Correspondence Address	MICHAEL J BEVILACQUA WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE ST BOSTON, MA 02109 1800 UNITED STATES 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/
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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.)	
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**APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA’S OPPOSITION TO
OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.’S
MOTION FOR SUMMARY JUDGMENT
[REDACTED-PUBLIC VERSION]**

I. INTRODUCTION

Contrary to Opposers' contention, there are vigorous disputes about many material facts related to the non-functionality of the GX Engine Trademark. Honda expects to offer compelling evidence during trial, including testimony from a Japanese engineer who helped design the GX Engine, and expert testimony from a former engineer for Opposer Briggs and Stratton Corporation ("Briggs"), that the GX Engine Trademark is non-functional. As invited by the Board (*see* Dkt. 75 (August 5, 2013 Order) at 18-19), Honda has included the opinions of its expert below to highlight the genuine disputes that exist. Relying on similar evidence, Honda has already prevailed in a week-long trial where the jury found that the trade dress of the GX Engine is non-functional.¹ Honda also defeated summary judgment in another district court case concerning the trade dress of the GX Engine where the defendants presented much of same evidence Opposers now rely on.^{2,3}

Under the law of trade dress, products that perform a function may nevertheless have a particular style that can be protected. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34 (2001). The Board has recognized this distinction between "de facto" and "de jure" functionality.⁴ In addition, for registration to be denied, the mark "as a whole" must be functional. 15 U.S.C. § 1052(e)(5). "That is to say, the fact that separate elements are, by themselves, functional does not render the trade dress as a whole de jure functional and, thus, not registerable." *In re Hudson*, 39 U.S.P.Q.2d at 1919. Ignoring these precedents, Opposers' Brief reflects a concerted effort to view the GX Engine as a collection of

¹ *See* Declaration of Sarah R. Frazier in Support of Applicant Honda Giken Kogyo Kabushiki Kaisha's Opposition to Opposers' Motion for Summary Judgment ("Frazier Decl."), Exh. A (Order and Judgment in *PowerTrain v. Am. Honda Motor Co.*, Civ. No. 1:03-cv-668 (N.D. Miss. Aug. 28, 2007)).

² Frazier Decl., Exhs. B (Defendants' Motion for Summary Judgment in *Am. Honda Motor Co. v. The Pep Boys, et al.*, Civ. No. 05-8879, Dkt. 215 (C.D. Cal.) and C (Order in *Am. Honda Motor Co. v. The Pep Boys, et al.*, Civ. No. 05-8879, Dkt. 401 (C.D. Cal. Nov. 13, 2007)).

³ The trade dress at issue in both prior litigations was even broader than that which Honda currently seeks to register as it encompassed all three-dimensions of the GX Engine, not just the front view that is the subject of Honda's pending Application. Since the trademark at issue in those litigations encompasses the GX Engine Trademark, these decisions should be given substantial weight. *Daimler Chrysler Corp. v. Maydak*, 86 U.S.P.Q.2d 1945, 1950 (T.T.A.B. 2008) ("[T]o the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is typically binding.").

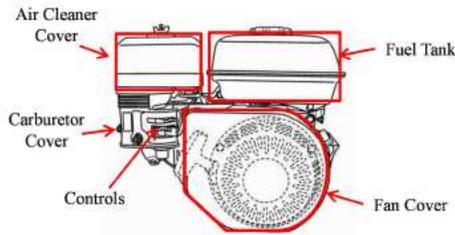
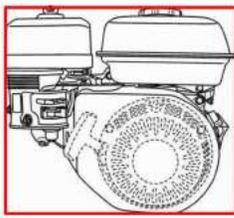
⁴ "In essence, de facto functionality means that the design of a product has a function, i.e., a bottle of any design holds fluid. De jure functionality on the other hand, means that the product is in its particular shape *because it works better in this shape.*" *In re Hudson News Co.*, 39 U.S.P.Q.2d 1915, 1918 (T.T.A.B. 1996) (quoting *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484 (Fed. Cir. 1984)) (emphasis added).

disjointed parts, rather than as a whole, and confuses de facto and de jure functionality. Opposers pretend that if a product or component works, nothing about the product or component can be protected trade dress. But that is not the law. What Opposers offer in support of this misguided theory is nothing more than unsubstantiated attorney argument, prior art previously considered (or cumulative with that which was previously considered) by the Patent and Trademark Office (“PTO”), and statements in documents that have nothing to do with the external design of the GX Engine, but rather the *internal* mechanics of the base engine. As explained more fully below, because there is ample evidence that the GX Engine Trademark is not de jure functional, Opposers’ motion for summary judgment should be denied.

II. FACTUAL BACKGROUND AND DISPUTED FACTS

Development of the Honda GX Engine began in 1981. Declaration of Motohiro Fujita in Support of Applicant Honda Giken Kogyo Kabushiki Kaisha’s Opposition to Opposers’ Motion for Summary Judgment (“Fujita Decl.”) ¶ 6. The effort took approximately two years, an investment of at least 1.2 to 1.3 billion yen (over \$5 million based on 1981 exchange rates), and involved approximately fifty employees in three groups: a performance design group, a styling design group, and an engine testing group. Fujita Decl. ¶¶ 6-7; Frazier Decl. ¶ 2. These groups collaborated almost daily to ensure that they were all working toward the same development objectives. Fujita Decl. ¶ 8. The styling design group, whose objective is to ensure that products are attractive to consumers, envisioned a “cubic” look for the GX Engine. Fujita Decl. ¶¶ 9-10.

The appearance of each element of the GX Engine Trademark was chosen by the styling designers to realize this overall “cubic” look. Fujita Decl. ¶¶ 11-15. For example, the engine has a square appearance when viewed from the front as well as a number of boxy components and straight lines that contribute to the overall cubic look. *Id.* These elements are depicted in Honda’s Application:



These features are prominently shown in nearly all print advertising for the GX Engine.

Frazier Decl., Exh. D (Conner Dep. Tr.) at 186:17-22, 330:7-13. And the

external appearance of the GX Engine is covered by an expired design patent owned by Honda, which confers a presumption of non-functionality. Frazier Decl., Exh. E (U.S. D282,017); *see supra* § IV. C. 1. In addition, as discussed above, a jury found that trade dress covering the GX Engine was non-functional, and numerous other companies have acknowledged that the GX Engine trade dress is protectable and non-functional. Frazier Decl., Exhs. F, G and H (settlement agreements).

Opposers purport to rely on various sources of evidence in support of their motion for summary judgment. However, numerous statements in the “Facts” section in Opposers’ Brief are nothing more than unsupported conclusions and unsubstantiated arguments of counsel, which the Board properly has recognized are not evidence and cannot be considered in support of Opposers’ summary judgment motion. *See* Dkt. 75 (August 5, 2013 Order) at 11 and 18; *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (“Arguments of counsel cannot take the place of evidence lacking in the record.”). Moreover, Opposers rely on prior testimony improperly before the Board. *See supra* n. 6. Given the fact-intensive nature of this case, these unsubstantiated statements, along with Opposers’ mischaracterizations of documents and testimony, and citations to immaterial evidence, necessitate a detailed catalog, corresponding to the sections of Opposers’ Brief, identifying all disputed material facts and the immaterial facts relied on by Opposers:

Opposers’ Asserted “Facts”	Dispute/Reason ⁵
Statements in Introduction to Opposers’ “Fact” Section	
“On July 7, 2006, just a few months after its nearly identical utility patent expired, Honda filed an application for registration (the “Application”) of the configuration of an engine for use ‘in construction,	Disputed. Honda does not own a utility patent, expired or otherwise, that is “nearly identical” to its Application in this proceeding. As shown by the patents themselves and supported by expert testimony, Honda’s utility patents

⁵ Each of these disputed issues of fact is discussed in more detail in Section IV below, with citation to support in the record.

Opposers' Asserted "Facts"	Dispute/Reason ⁵
maintenance and power equipment.'" Opposers' Brief ("Opp. Br.") at 2.	neither claim the specific design elements that comprise the GX Engine Trademark, nor do they attribute any functional advantages to those specific elements. Rather, those elements are the subject of an expired design patent.
"[T]he muffler's location is based on non-aesthetic reasons (e.g., user safety), and the practical advantages of locating the muffler on the back necessarily minimize the available locations for the engine's other major components, like the air cleaner and carburetor.'" Opp. Br. at 3.	Disputed and immaterial. The location of the muffler is not part of the applied-for mark. Further, according to expert testimony, the particular location of the muffler is not dictated by non-aesthetic reasons. The existence of alternative designs proves that there are alternative locations available for the muffler and that even with the muffler located where it is on the GX Engine, there are multiple locations available for the air cleaner cover and other major components.
"Between its filing in July 2006 and publication in January 2011, Honda's Application was rejected on functional grounds several times.'" Opp. Br. at 4.	Undisputed but immaterial. The PTO explicitly recognized that Honda "point[ed] out several nonfunctional features of its proposed mark: the overall 'cubic' look of the engine; the shape of the air cleaner housing; the design of the carburetor cover; the shape and size of the fuel tank; the combined and complementary shape of the fuel tank and air cleaner housing; and the position and orientation of the major engine components.'" Frazier Decl., Exh. I (Feb. 5, 2010 Office Action).
Statements Regarding Honda's 1981 GX Memorandum & Honda's Italian Complaint	
"Honda has designed the GX with the focus on function and performance, not aesthetic appearance or ornamentation.'" Opp. Br. at 4.	Disputed and unsupported attorney argument. The evidence, including testimony from an employee involved with the original design, shows that Honda did focus on the aesthetic appearance and ornamentation during its development of the GX Engine (as well as function and performance).
[REDACTED]	[REDACTED]
"[T]he performance benefits of using an overhead valve also created compatibility problems with OEM products, and this problem was solved by inclining the cylinder to reduce the engine's overall height, thus creating the 'overall cubic design' of the	Disputed and unsupported attorney argument. While it is the case that there are functional benefits to using an inclined cylinder, including reducing the engine's overall height, Opposers have not offered any evidence to support that an inclined cylinder necessitates the "overall cubic

Opposers' Asserted "Facts"	Dispute/Reason ⁵
Proposed Mark." Opp. Br. at 6.	design" of the GX Engine Trademark. Instead, expert testimony establishes that not to be the case, as evidenced by the existence of many alternative designs for compact engines having inclined cylinders.
<p>[REDACTED]</p> <p>[REDACTED]</p>	<p>[REDACTED]</p>
<p>"Honda recently eliminated the only features of the [GX Engine Trademark] that were arguably purely aesthetic." Opp. Br. at 7.</p>	<p>Disputed and immaterial. Expert testimony establishes that the changes to the ribbing on the carburetor cover, fuel tank, and air cleaner cover are minor and do not change the overall visual appearance of the GX Engine. Declaration of James Mieritz in Support of Applicant's Opposition to Opposers' Motion for Summary Judgment ("Mieritz Decl.") ¶¶ 71-74. Moreover, these changes are not relevant to determining whether the GX Engine Trademark is functional.</p>
<p>"Honda implicitly acknowledges that the overall configuration and shape of the Proposed Mark is necessary to the engine's compatibility with OEM products." Opp. Br. at 7.</p>	<p>Disputed and unsupported attorney argument. Opposers' evidence does not support this statement because the referenced promotional materials only discuss the <i>dimensions</i> of the GX engine, and not the overall configuration and design of the GX Engine Trademark. The availability of alternative designs in the market, as well as fact and expert testimony, establish that the specific shape and configuration Honda seeks to protect is not necessary for an engine to be compatible with OEM products.</p>
<p>Statements Regarding Honda's Utility Patents</p>	
<p>"After launching the GX in the early 1980's, Honda aggressively sought to protect its investment in the development and design of the engine by obtaining numerous utility patents in the United States and Japan covering nearly all major aspects of the Proposed Mark, including the overall cubic design and the placement and orientation of its main component parts." Opp. Br. at 7.</p>	<p>Disputed. Honda did not seek or obtain utility patents covering the specific design elements or the "overall cubic design" that comprise the GX Engine Trademark. As shown by the patents themselves and supported by expert testimony, Honda's utility patents neither claim the specific design elements or "overall cubic design" that comprise the GX Engine Trademark, nor do they attribute any functional advantages thereto. Rather, those elements are the subject of an expired design patent.</p>
<p>"These patents reinforce the functional advantages of compactness, ease of operator access and maintenance, and compatibility with OEM equipment that are described in the GX Design Memo and Italian Complaint, and many contain drawings of 'preferred embodiments' that look like the GX and the Proposed Mark." Opp. Br. at 7-8.</p>	<p>Disputed and immaterial. As expert testimony makes clear, the patents relied upon by Opposers neither claim the specific design elements or "overall cubic design" that comprise the GX Engine Trademark, nor do they attribute any functional advantages thereto.</p>
<p>"The '385 Patent covers many important features of</p>	<p>Disputed. As expert testimony makes clear, the '385 patent</p>

Opposers' Asserted "Facts"	Dispute/Reason ⁵
<p>the Proposed Mark, including the overall cubic design and the placement and orientation of its main component parts. The claims and disclosures, along with the prosecution history, make clear that the location, arrangement and shape of the fuel tank, air cleaner and muffler, along with the cylinder inclined at a slant, were intended for a compact, rectangular configuration, to allow improved safety and user access, and for the greatest engine efficiency." Opp. Br. at 8.</p> <p>"Apart from the addition of a precleaner on the left side of the air cleaner, the preferred embodiment shown in the '385 Patent is almost identical to the Proposed Mark." Opp. Br. at 8.</p>	<p>– which is directed to a precleaner element – neither claims the <i>specific</i> location, arrangement, shape, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. Further, contrary to Opposers' characterization, the engine shown in Fig. 1 of the '385 patent does not depict the GX Engine Trademark, but rather the claimed precleaner element that is not part of the GX Engine Trademark.</p>
<p>"The '740 Patent discloses many of the same functional benefits of the compact GX engine design." Opp. Br. at 9.</p> <p>"[I]nclining the engine's cylinder and placing the muffler above it, and placing the fuel tank by the muffler, lowers the overall height of the engine so the generator 'can be constructed compactly into a generally-cubic overall configuration, so that it can be appropriately installed even in a relatively small space with its center of gravity significantly lower.'" Opp. Br. at 10.</p> <p>"[A]lso, as with the Proposed Mark, Figures 5 and 10 of the '740 Patent depict a slanted fan cover, which is functionally designed to cool the engine." Opp. Br. at 10.</p>	<p>Disputed, unsupported attorney argument, and immaterial. As expert testimony makes clear, the '740 patent – which is directed to a generator configuration – neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages (e.g., lowered height and compactness) thereto. Further, Opposers have not provided any support tying the slanted fan cover in the '740 patent to the internal cooling mechanism described. To the contrary, expert testimony establishes that the specific slant of the GX Engine fan cover is not functional.</p>
<p>"The '430 Patent also discloses many of the same functional features as the . . . Proposed Mark. For example, the '430 Patent claims a 'fan cover for covering said cooling fan,' and as shown in Figure 3 of the patent, the angled or tapered portion of the left side of the fan cover is slanted to track the inclination of the cylinder. . . The description as to how the cooling fan and fan cover function explains the reason for the slanted fan cover in the Proposed Mark." Opp. Br. at 10.</p>	<p>Disputed, unsupported attorney argument, and immaterial. As expert testimony makes clear, the '430 patent – which is directed to a generator configuration – neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. Moreover, Opposers offer no support for the conclusion that the '430 patent "explains the reason for the [specific] slanted fan cover in the Proposed Mark." To the contrary, expert testimony establishes that the specific slant of the GX Engine fan cover is not functional.</p>
<p>"[T]he '630 [sic] Patent explains that the relation between the fuel tank, muffler and inclined cylinder is so that the 'overall height [is] significantly reduced,' which in turn allows the 'engine-operated generator unit [to] be constructed compactly into a</p>	<p>Disputed and immaterial. As expert testimony makes clear, the '690 patent—which is directed to a generator configuration—neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX</p>

Opposers' Asserted "Facts"	Dispute/Reason ⁵
generally-cubic overall configuration' for installation 'in a relatively small space with its center of gravity significantly lowered.'" Opp. Br. at 10.	Engine Trademark, nor does it attribute any functional advantages thereto. To the extent Opposers are suggesting the <i>specific</i> location, dimensions, or other design elements of the components parts, or "overall cubic design" are necessary to reduce height and create a compact engine, expert testimony and the availability of alternative designs demonstrate otherwise.
"The '690 Patent also discloses a slanted fan cover for the purpose of directing airflow into the engine shroud to cool the hottest parts of the engine." Opp. Br. at 10.	Disputed, unsupported attorney argument, and immaterial. The '690 patent neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. Opposers have not provided any support tying the slanted fan cover in the '690 patent with the internal cooling mechanism described. Expert testimony and the availability of alternative designs establish that the specific slant of the GX Engine fan cover is not functional.
<p>"[T]he '533 Patent discloses and claims the advantage of a compact engine." Opp. Br. at 11.</p> <p>"The '533 Patent also has many of the same disclosures regarding the function of the slanted fan cover as the '690 Patent." Opp. Br. at 11.</p>	Disputed, unsupported attorney argument, and immaterial. As expert testimony makes clear, the '533 patent—which claims a generator configuration—neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. Opposers have not provided any support tying the slanted fan cover in the '533 patent with the (unidentified) functions. To the extent Opposers are suggesting the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" are necessary to create a compact engine, expert testimony and the availability of alternative designs demonstrate otherwise. Further, Honda is not claiming all compact engine designs.
<p>"Honda's '919 Patent discloses the benefits of inclined cylinders with regard to engine lubrication." Opp. Br. at 11.</p> <p>"[T]he inclined cylinder lowers the engine's overall height, which benefits performance and facilitates mating with OEM products." Opp. Br. at 11.</p> <p>"[The] slanted cylinder configuration [in the '919] dictates the slant in the fan cover and defines the necessary direction of the air flow." Opp. Br. at 11.</p>	Disputed, unsupported attorney argument and immaterial. As expert testimony makes clear, the '919 patent – which is directed to an <i>internal</i> bearing support member that aids in oil flow, not the inclined cylinder – neither claims the specific design elements or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. Moreover, while there is no dispute that having an inclined cylinder provides functional benefits, Honda is not claiming all engines with an inclined cylinder. Further, Opposers fail to cite to any evidence to support their theory that the inclined cylinder dictates the slant in the fan cover. Expert testimony and availability of alternative designs establish that the use of an inclined cylinder does not dictate the slant of the fan cover.
"Consistent with the emphasis in the GX Design Memo and Italian Complaint on OEM compatibility,	Disputed and immaterial. As expert testimony makes clear, the '389 patent neither claims the <i>specific</i> location,

Opposers' Asserted "Facts"	Dispute/Reason ⁵
Honda's '389 Patent states 'A general-purpose engine usually needs to be compact so that a work machine that includes the general-purpose engine does not become large.'" Opp. Br. at 11.	dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages thereto. To the extent Opposers are suggesting the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" are necessary to create a compact engine, expert testimony and the availability of alternative designs demonstrate otherwise. Further, Honda is not claiming all compact engines.
"Honda's '212 Patent discusses the advantages of slanting the engine cylinder and placing the air cleaner and muffler above it, and the fuel tank over the engine crank case: 'This constitution eliminates wasteful space to form a compact device, permits reduction in the total height of a tilling machine, enables lowering of the center of gravity, and improves safety and tilling capacity'" Opp. Br. at 11-12.	Disputed and immaterial. As expert testimony makes clear, the '212 patent neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that the comprise GX Engine Trademark, nor does it attribute any functional advantages thereto.
"Honda's '344 Patent explains that the goals of adaptability to a variety of OEM products and ease of user access are achieved in large part by arranging the components in the same way as the Proposed Mark." Opp. Br. at 12.	Disputed. As expert testimony makes clear, the '344 patent neither claims the <i>specific</i> location, dimensions, or other design elements of the component parts, or "overall cubic design" that comprise the GX Engine Trademark, nor does it attribute any functional advantages (e.g., adaptability to a variety of OEM products and ease of user access) thereto.
Statements Regarding Prior Testimony from Honda's Experts⁶ and Corporate Representative	
"Testimony from Honda experts in prior litigation confirms that the design described in the Application is functional." Opp. Br. at 12.	Disputed and immaterial. The cited testimony from Honda's experts in a prior litigation discusses the <i>general</i> placement of the engine components. It confirms only that some components of the GX Engine serve a function, not that they serve that function better as a result of the numerous design elements or "overall cubic design" that comprise the GX Engine Trademark. Moreover, summary judgment was denied in a district court proceeding based on the same testimony on which Opposers currently rely.
[REDACTED]	[REDACTED]

⁶ Opposers make numerous statements for which the only cited support is deposition testimony from Messrs. Mieritz and Hoag from a prior litigation. This evidence was not properly filed with Opposers' Brief. *See* Dkt. Nos. 52-56. In fact, the Board found that Opposers failed to satisfy the requirements of 37 C.F.R. § 2.122(f), which explicitly governs the use of prior testimony. Dkt. No. 57. Opposers now attempt to back door this evidence pursuant to 37 C.F.R. § 2.127(e)(2) – which was not intended to cover use of prior testimony – with a supplemental declaration filed more than *six months* after submitting their brief. Dkt. No. 76. These transcripts of depositions taken by parties not in privity with Opposers (as required by 37 C.F.R. § 2.122(f)), were produced subject to numerous objections by Honda in response to overly broad requests from Opposers regarding multiple prior litigations involving the GX Engine's trade dress. Frazier Decl., Exh. J (Honda's Responses to Briggs' First Request for Production of Documents). The Board should exercise its discretion and exclude this evidence to prevent a circumvention of its Rules.

Opposers' Asserted "Facts"	Dispute/Reason ⁵
[REDACTED]	[REDACTED]

Opposers' Asserted "Facts"	Dispute/Reason ⁵
[Redacted]	[Redacted]

Opposers' Asserted "Facts"	Dispute/Reason ⁵
[REDACTED]	[REDACTED]

Statements Regarding Honda's Promotional Materials

<p>“Besides compatibility with OEM products... the aspects of the GX that Honda touts in its marketing materials are the engine’s dependability and reliability, which are the most important traits for customers that use engines like the GX... The importance of such utilitarian features is reflected in the text of Honda’s ads for the engine.” Opp. Br. at 15-16.</p>	<p>Disputed and immaterial. The utilitarian benefits of the GX Engine touted in its advertising do not result from the GX Engine Trademark, and Honda’s advertising makes no connection between the utilitarian benefits and the GX Engine Trademark. Further, testimony of a Honda employee and the advertisements themselves make clear the touted benefits of the GX Engine <i>do not</i> result from its external appearance.</p>
[REDACTED]	[REDACTED]
<p>“The only non-functional feature emphasized by Honda in its promotional materials is the color scheme of a red fan cover, white fuel tank, and black air cover and carburetor, which is featured in the</p>	<p>Disputed and immaterial. Testimony from a Honda employee as well as the advertisements themselves confirm that the “hero shot”—a near-straight-on view of the GX Engine – displays all elements of the mark Honda seeks to</p>

Opposers' Asserted "Facts"	Dispute/Reason ⁵
'hero shot' photograph of the GX that Honda uses in all advertisements for the engine." Opp. Br. at n. 7.	protect. Moreover, as recognized by Opposers, color is not part of the applied-for mark and therefore not relevant in assessing the functionality of the GX Engine Trademark.
Statements Regarding Mid-Size Utility Engines That Compete With The GX Engine	
"[N]early all manufacturers of mid-size, horizontal shaft utility engines like the GX use the same, basic configuration as the Proposed Mark. As shown in the images below, Briggs, Kohler, Subaru, Champion, Generac, and Blue Max all sell engines with an overall cubic design; the fuel tank located above and to the right of the slanted fan cover; the air cleaner located to the left of the fuel tank on the front of the engine; and the carburetor cover beneath the air cleaner with its controls in a recessed area on the front." Opp. Br. at 16-17 and n. 8.	Disputed and immaterial. Expert testimony and the availability of alternative designs (including Opposers' own engines) demonstrate that a variety of configurations exist in the marketplace. Further, Honda is not claiming trade dress rights to all engines with the "basic configuration" of the GX Engine but rather the <i>specific</i> design and ornamental features of the engine depicted in its Application.
"All manufacturers of engines like the GX use this configuration because... function and the market demand it." Opp. Br. at 17.	

III. LEGAL STANDARDS

Summary judgment is only appropriate if Opposers show that "there is no genuine dispute as to any material fact and [they are] entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). Opposers bear the burden of proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n. 10 (1986). In evaluating whether summary judgment is appropriate, the evidence is viewed in a light most favorable to Honda, with doubts as to issues of material fact resolved in Honda's favor. *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 202 (Fed. Cir. 1992). The Board must regard Honda's evidence as true, if supported by affidavits or other evidentiary material. *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205, n. 10 (T.T.A.B. 2003).

IV. ARGUMENT

A design is functional if it is "essential to the use or purpose of the [product] or if it affects the cost or quality of the [product], that is, if exclusive use of the [design] would put competitors at a significant non-reputation-related disadvantage." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995). The GX Engine was consciously developed to have numerous design elements and the overall

cubic appearance that comprise the GX Engine Trademark. As a result, the GX Engine Trademark has many arbitrary and ornamental features that do not affect the performance, cost, or quality of the engine.

In determining functionality, the Board considers the four “Morton-Norwich factors”: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) the availability to competitors of functionally-equivalent designs; (3) advertising materials in which the originator of the design promotes the design’s utilitarian advantages; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982). As shown below, there are disputed issues of material fact regarding each of these four factors that require denial of Opposers’ Motion.

A. The GX Engine Trademark Is The Product Of Conscious Styling Decisions

Consistent with industry practice, the GX Engine was jointly developed by three groups: a performance design group, a styling design group, and a testing group. Mieritz Decl. ¶¶ 29-31; Fujita Decl. ¶ 7. The evidence shows that the Honda styling team consciously designed the GX Engine with numerous unique, ornamental features that do not affect the function, performance, quality, or cost of the engine. The only evidence relied upon by Opposers—statements contained in the 1981 GX memo and an Italian complaint—are inapposite. [REDACTED]

Moreover, Opposers’ own documents [REDACTED]

[REDACTED]

[REDACTED] Opposers try

to bridge the gap between the *engineering* benefits of the GX Engine, which have nothing to do with the external appearance of the GX Engine, and the GX Engine Trademark by wrongfully equating the “overall cubic design” with compactness, and attributing the purported benefits of a slanted cylinder to that overall cubic design. [REDACTED]

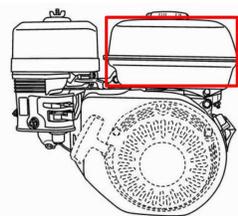
B. The GX Engine Trademark Has Many Arbitrary And Ornamental Features That Do Not Affect The Performance, Quality, Or Cost Of The Engine

Opposers repeatedly mischaracterize the mark that Honda seeks to protect as the “basic configuration” of an engine. That is not what the GX Engine Trademark covers. Instead, it encompasses the precise location, shape, size, and ornamental details of the GX Engine components that together have come to be associated by consumers with Honda. Mieritz Decl. ¶¶ 18-19. As explained in detail below, these arbitrary and ornamental features are not necessary in order to make a high quality, low-cost engine. Mieritz Decl. ¶¶ 20, 34-35, 69-70 and 75. There is room for variation even within the “basic configuration,” and many alternative designs compete effectively in the market. *Id.* at ¶¶ 69 and 75.

In addition, while a mark must be considered “as a whole” and not by its individual elements when assessing functionality (*see* 15 U.S.C. § 1052(e)(5); *In re Hudson*, 39 U.S.P.Q.2d at 1919), even when considered individually, there are disputed issues of material fact regarding the functionality of the component features that make up the GX Engine Trademark.

1. Fuel Tank

The GX Engine fuel tank is located on the top right side of the engine. Honda’s styling engineers designed the fuel tank to have a roughly rectangular shape, beveled top outside edges, and a horizontal seam roughly across the middle of the tank. Mieritz Decl. ¶ 37; Fujita Decl. ¶ 14. The location, shape,



beveling, and seam placement are purely cosmetic and could be altered without any impact on the cost or quality of the engine. Mieritz Decl. ¶ 37. Indeed, Opposers themselves

concede the ornamental nature of most of these elements. Opp. Br. at 7 and 20.

Opposers' main argument with respect to the GX Engine's fuel tank is that the location of the tank is functional because it enables the gravity-fed fuel system, and that without such a system the engine would require the added cost of a fuel pump. Opp. Br. at 13, 20, and 25. Honda does not dispute that the fuel tank needs to be located above the carburetor to allow for gravity flow of fuel to the engine. Mieritz Decl. ¶ 38; [REDACTED]

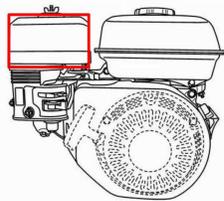
However, Opposers' argument ignores the fact that it is not necessary for the fuel tank to be on the right side of the engine in order to take advantage of gravity. The fuel tank could be located along the back of the engine, or across the entire front, and is thus not limited to the front right position. Mieritz Decl. ¶ 38; [REDACTED]

Opposers also contend that the rectangular shape chosen by Honda "maximize[s] the amount of available fuel." Opp. Br. at 20. In addition to being unsupported by any evidence, this statement is belied by the plethora of alternative fuel tank designs discussed below. The exact shape of the tank can vary and still provide the same capacity. Mieritz Decl. ¶ 39.

Lastly, Opposers argue that trade dress for the shape of the fuel tank is foreclosed by an expired utility patent that claims an engine with "substantially rectangular" components. Opp. Br. at 8-9 (citing to U.S. Patent No. 4,813,385). As discussed below, this argument misses its mark since Honda does not claim trade dress protection for every "substantially rectangular fuel tank."

2. Air Cleaner Cover

The GX Engine air cleaner cover is located to the left of the fuel tank. It has a distinctive cubic shape, beveled top outside edges, and a belt-like area along the bottom where the upper edge of that belt-like area aligns with the seam on the fuel tank. Mieritz Decl. ¶¶ 42 and 46; Fujita Decl. ¶ 14. It is



without question that design elements, such as the beveling and belt-like portion, are non-functional. Mieritz Decl. ¶¶ 42,

45-46. These design flourishes do not contribute to the performance of the air cleaner cover or the engine as a whole. For example, the beveling could be removed or changed. Mieritz Decl. ¶ 45. As with the fuel tank, Opposers concede that these elements of the GX Engine Trademark are non-functional. Opp. Br. at 7 and 20.

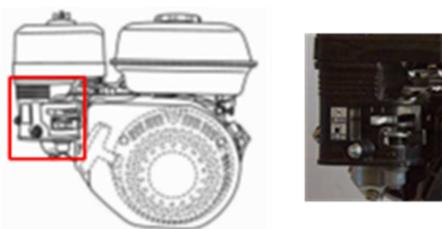
The shape, relative size, and location of the GX Engine’s air cleaner cover are also purely cosmetic and could be changed without affecting the cost or quality of the engine. Mieritz Decl. ¶¶ 42-44. Opposers claim the location of the air cleaner cover is functional “because it needs to be in the front of the engine for safety and accessibility, and in close proximity to the carburetor below it for optimal performance.” Opp. Br. at 20. This contention, for which Opposers cite no support whatsoever, is contradicted by a survey of the market. The Board need only look as far as some of the Opposers’ own engines (discussed below) to see that a number of alternative air cleaner locations are available. These alternative locations include in front of the carburetor, directly to the left of the fan cover instead of above it, or across the entire front of the engine. Mieritz Decl. ¶ 44.

As with the fuel tank, Opposers claim that the specific shape of the air cleaner cover is functional in light of an expired utility patent. Opp. Br. at 8-9. Again, Honda does not seek trade dress protection for every “substantially rectangular” air cleaner cover.

3. Carburetor Cover And Controls

The GX Engine carburetor cover is located below the air cleaner cover. The GX Engine has a stylized carburetor cover that features four ribs along the outside edge and a recessed area where the control levers are located. Mieritz Decl. ¶ 47; Fujita Decl. ¶ 18. The appearance, shape, ribbing,⁷ relative

size, and location of the carburetor cover on the GX Engine are purely cosmetic. Mieritz Decl. ¶¶ 47-50; Fujita Decl. ¶ 18. Indeed, even the existence of the carburetor cover is a matter of styling—some engines conceal the carburetor



⁷ Opposers apparently do not deny that the presence of the ribbing, including the number of ribs, is arbitrary. See Opp. Br. at 7.

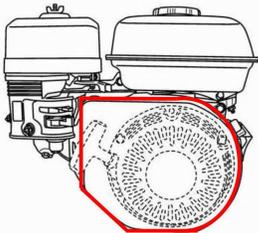
instead by mounting the air cleaner directly to it. Mieritz Decl. ¶ 50.

Opposers yet again fail to address the specific unique design of the GX Engine carburetor cover and instead focus only on the placement of the controls. Opposers contend that the controls need to be in front of the engine so they are easily accessible. Opp. Br. at 20. However, even limiting to the front of the engine, the controls can be placed in other locations with no impact on the cost or quality of the engine. Mieritz Decl. ¶ 51.

Opposers also argue, again without citing to any evidence in the record, that the recessed location of the controls is functional because it prevents inadvertent interference with the controls during engine operation. Opp. Br. at 20. However, there is contrary evidence in the record as to whether the recessed controls provide an advantage. [REDACTED]

4. Fan Cover

The GX Engine fan cover has a square upper left corner; an upper edge that flows straight into a semi-circular right side; an angled lower left corner; and a left edge that is roughly vertical. Mieritz Decl.



¶ 52. This specific shape is arbitrary and cosmetic. *Id.*;

Fujita Decl. ¶ 17. The shape could be modified in a number of ways without affecting function or cost.

Mieritz Decl. ¶¶ 53-55.

Opposers have not provided (nor could they) any evidence that the entire design of the GX Engine fan cover is functional. Rather, Opposers focus on *one* specific feature—the lower left slant of the fan cover—and argue that “[t]he Mark’s ‘slanted fan cover’ tracks the inclined cylinder and is designed to direct the flow of cool air towards the hottest parts of the engine, such as the cylinder head.” *See* Opp. Br at 20. This theory, in addition to being unsubstantiated, is directly contradicted by Honda’s expert. Although one of the functions of the fan cover is to direct the air from the fan to the cylinder, there is no evidence that the particular shape of the GX Engine fan cover performs this function any better than other designs. According to Honda’s expert, many different shapes serve this function equally well.

Mieritz Decl. ¶ 56. Though the incline of the cylinder determines where the hottest part of the engine will be (i.e., the cylinder head), because cool air is channeled by a combination of the fan cover and *internal* mechanisms (such as baffling, deflectors, etc.), it does not dictate the slant in the fan cover.⁸ *Id.*

Opposers also rely on certain utility patents (discussed in more depth below) to improperly equate any purported benefits of an inclined cylinder (e.g., compactness due to reducing the height of the engine) with a slanted fan cover. Opp. Br. at 8-12, 23. An engine with an inclined cylinder can have numerous different fan cover shapes. Mieritz Decl. ¶¶ 55-56, 65. The fan cover on Honda’s GX Engine is merely an example of one such shape.

5. Complementary Features

As demonstrated above, components of the GX Engine Trademark have numerous arbitrary and ornamental design features that do not affect the cost or quality of the engine. Honda chose to design each component with these specific aesthetic features to complement each other to create the *overall* distinctive look of the GX Engine. For example, the fuel tank and air cleaner cover were designed to have complementary beveling and shapes (see Fig. A below) —the top left angle of the air cleaner cover mirrors the angle of the right side of the fuel tank (shown in green); the right vertical line of the air cleaner cover mirrors the left vertical line of the fuel tank (shown in yellow); the air cleaner cover and fuel tank have the same height and horizontal lines giving it a look of continuity; 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 in orange). Mieritz Decl. ¶¶ 45, 57; Fujita Decl. ¶ 14.

Another complementary design feature is the slope on the top right side of the fuel tank which was designed to complement the lower left side of the fan cover (see Fig. B below). Mieritz Decl. ¶ 58; Fujita Decl. ¶ 15. In addition, the angle of the lower left side is undisturbed up to the left edge of the

⁸ [REDACTED]

carburetor cover, giving it a continuous look (see Fig. C below). Mieritz Decl. ¶ 59; Fujita Decl. ¶ 15.

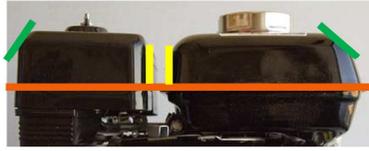


Figure A



Figure B



Figure C

6. Overall Cubic Design

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. Mieritz Decl. ¶¶ 61-62. Honda chose to use “boxy” components and numerous straight lines to contribute to the overall cubic impression of the GX Engine. Fujita Decl. ¶¶ 10-15. This overall cubic design is aesthetic and non-functional. Mieritz Decl. ¶ 69; *see also* Fujita Decl. ¶ 16.

Opposers, once again, fail to provide any evidence that the overall cubic design of the GX Engine—which includes the complementary and continuous design features discussed above—is functional. Instead, Opposers improperly attempt to equate the overall cubic design with compactness. Opp. Br. at 14 and 20. While a cubic design is consistent with the objective of a compact design, other non-cubic engine designs can also be compact and compete effectively with the Honda GX Engine. Mieritz Decl. ¶ 64. Moreover, contrary to Opposers’ assertion (Opp. Br. at 14), a cubic design is not necessary for incorporation into OEM products. Mieritz Decl. ¶¶ 66-67. In fact, often times manufacturers work with the OEMs to ensure compatibility between the engines the manufacturers are designing and the OEM’s products. Mieritz Decl. ¶ 68; [REDACTED]

[REDACTED]

C. The Morton-Norwich Factors Support a Finding of Non-Functionality

1. The Utility Patents And Applications Cited By Opposers Do Not Claim The Features Of The GX Engine Trademark

There are disputed issues of material fact regarding whether certain utility patents evidence the functionality of the GX Engine Trademark. Relying on the Supreme Court's decision in *TrafFix*, Opposers argue that because several utility patents and applications⁹ describe or claim the *general* shape and location of certain engine components, the GX Engine Trademark is functional. Opp. Br. at 7-12, 21-23. However, Opposers' reliance on *TrafFix* is misplaced. *TrafFix* held that "a utility patent is strong evidence that *the features therein claimed* are functional." *TrafFix Devices*, 532 U.S. at 29 (emphasis added). Here, Honda is not seeking trademark protection for the inventions *claimed* in these patents. Mieritz Decl. ¶¶ 76-77. Rather, Honda is seeking to protect *specific aesthetic* elements that comprise the GX Engine Trademark. As none of the patents to which Opposers cite claim the specific elements of the mark, these patents are irrelevant to the issue of whether or not the GX Engine Trademark is functional. In fact, these patents were previously considered (or are cumulative with those considered) by the PTO, which determined they did not render the GX Engine Trademark functional.¹⁰

Nowhere does the '385 patent¹¹ claim an "overall cubic design" as Opposers suggest. Opp. Br. at 22. What it does claim, namely "substantially rectangular" components, is not what Honda currently seeks to protect with its trade dress registration. Rather, among the infinite range of different "substantially rectangular" options available for components such as the fuel tank and air cleaner cover, Honda claims the *particular shape, relative dimensions, and aesthetic features* of the components as depicted in its Application. Nothing in the '385 patent dictates that a "substantially rectangular" air

⁹ U.S. Patent No. 4,813,385 (the "'385 patent"); U.S. Patent No. 6,331,740 (the "'740 patent"); U.S. Patent No. 6,525,430 (the "'430 patent"); U.S. Patent No. 6,489,690 (the "'690 patent"); U.S. Patent No. 6,362,533 (the "'533 patent"); U.S. Patent No. 6,941,919 (the "'919 patent"); U.S. Patent No. 7,086,389 (the "'389 patent"); Japanese Patent Application No. 57-170212 (the "'212 application"); and Japanese Patent No. S63-32344 (the "'344 patent").

¹⁰ The '385, '740, '690, and '533 patents were previously considered by the PTO. See Frazier Decl., Exhs. P (March 4, 2009 Response to Office Action) and I (Feb. 5, 2010 Office Action).

¹¹ Opposers rely mainly on the '385 patent. Opp. Br. at 8-9, 22-23. However, this patent was disclosed during the prosecution of the GX Engine Trademark and was relied upon by the defendants in the *Pep Boys* case in their motion for summary judgment on functionality, which was ultimately denied by the Court. Frazier Decl., Ex. C (Order at. 10 (holding with respect to the '385 patent that that the "features therein claimed are not entirely congruent" with the design features Honda claims are nonfunctional (quotation omitted))).

cleaner cover or fuel tank needs to have the specific dimensions or design of elements that these components have on the GX Engine. Moreover, even if the shape of these components alone were not protectable, the many other aesthetic features discussed above are neither functional nor even arguably covered by the expired patent.

Similarly, while some of these patents claim the *general* location and orientation of the engine components, Honda is not seeking trade dress rights in what these patents claim. Mieritz Decl. ¶¶ 76-77. Within those general parameters, there are numerous alternative designs. Mieritz Decl. ¶ 75. As discussed above, Opposers also rely on these utility patents to improperly equate the benefits of an inclined cylinder (e.g., compactness) with Honda's slanted fan cover and overall cubic design. *See* Opp. Br. at 8-12, 23.¹² But as shown by the numerous alternative designs in the marketplace, an engine with an inclined cylinder can have many different shapes, with different angles. Mieritz Decl. ¶ 55.

Also, none of the patents describe or claim the individual design elements (e.g., beveled outside edges, belt-like area on the air cleaner cover, etc.) that give the GX Engine its unique overall distinctive appearance. Mieritz Decl. ¶ 77. As the cases cited by Opposers make clear, the mere existence of a utility patent relating to the product for which trade dress protection is claimed "is not dispositive," and Opposers "must do more than show similarity" between what is claimed in the patent and what is covered by the trade dress. *See* Opp. Br. at 22 (citing to *Alphaville Design, Inc., v. Knoll, Inc.*, 627 F. Supp. 2d 1121, 1133 (N.D. Cal. 2009)). Opposers have made no such showing here. In fact, the inventions of the patents relied upon by Opposers are focused on specific engine features, *see, e.g.*, the '385 patent (cyclone-type precleaner element); the '919 patent (internal bearing support aiding in engine lubrication); and the '389 patent (canister for absorbing fuel vapor), that can be used in numerous engine designs. Mieritz Decl. ¶ 77. While some of these patents mention or show elements of the GX Engine Trademark, the fact that a design is merely described or depicted in a utility patent does not render it functional.

¹² Opposers also claim that the use of an inclined cylinder and "basic configuration" reduces the height of the engine which allows the engine to be "constructed compactly into a generally-cubic overall configuration." Opp. Br. at 10; *see also id.* at 6 and 11-12. Once again, Opposers are improperly conflating the "basic configuration" and benefits of using an inclined cylinder with the "overall cubic design" of the GX Engine Trademark. Mieritz Decl. ¶ 65.

Dogloo, Inc. v. Doskocil Mfg. Co., 893 F. Supp. 911, 919 (C.D. Cal. 1995).

While the utility patents cited by Opposers are not evidence that the GX Engine Trademark is functional, Honda's expired design patent on the GX Engine is *presumptive evidence of non-functionality*. One requirement for issuance of a design patent is that the design be ornamental. 35 U.S.C. § 171 (1952). The existence of a design patent therefore creates a presumption that the design is non-functional. *In re Morton-Norwich*, 671 F.2d at 1342 n. 3; *In re 3M Co.*, 2012 WL 1881484, at *4 (T.T.A.B. May 10, 2012). In 1986, Honda obtained a design patent for the external appearance of the GX Engine. *See* Frazier Decl., Exh. E (U.S. D282,017). Honda's design patent depicts nearly all the features of the GX Engine Trademark, including the aesthetic elements of the fuel tank, the air cleaner cover, carburetor cover, and fan cover discussed above. *Id.*; Mieritz Decl. ¶ 78. This presumptive evidence of non-functionality alone should preclude summary judgment on functionality.

Opposers' own intellectual property filings demonstrate that they indeed recognize the ornamental nature of the types of external design features that Honda seeks to protect with its Application. Both have design patents covering a variety of different engine designs— all of which depict the “basic configuration” (i.e., fuel tank on top right; air cleaner cover on top left; slanted fan cover; location of carburetor cover) they now insist is a functional bar to registering the GX Engine Trademark. *See, e.g.*, Frazier Decl., Exhs. P (US D634,333 (issued to Briggs on March 15, 2011)), Q (US D605,661 (issued to Kohler on December 8, 2009)), R (US D595,737 (issued to Briggs on July 7, 2009)). Opposers cannot have it both ways by alleging that the “basic configuration” of the GX Engine is functional in the context of Honda's Application, while at the same time claiming that the appearance of engines having that same “basic configuration” is ornamental when seeking to protect their own designs.

2. Available Alternative Designs Provide The Same Performance

The availability of alternative designs for a feature supports a finding that a particular design is non-functional. *Valu Eng'r Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002). Here, there is at least a disputed issue of material fact regarding the existence of alternative designs that can provide performance benefits comparable to the GX Engine. Honda's functionality expert, Mr. Mieritz, has

demonstrated that numerous alternative designs are available for every element and overall cubic design of the GX Engine Trademark, which are identified in his declaration and expert reports. *See* Mieritz Decl. ¶¶ 52-56 (fan covers), ¶¶ 42- 46 (air cleaner covers); ¶¶ 47-51 (carburetor covers and controls); ¶¶ 38-41 (fuel tank); and ¶¶ 57- 60, 75 (overall design).¹³ Thus, Opposers’ assertion (Opp. Br. at 16) that “nearly all manufacturers . . . use the same, basic configuration as the Proposed Mark,” is false and belied by the record.

In fact, Opposers themselves manufacture gasoline-powered horizontal shaft utility engines with alternative configurations. For example, unlike the GX Engine, the Briggs’ model M12 (also known as the 800 & 900 Series) has an overall shape that is noticeably taller than it is wide, a front-mounted air cleaner, and a panel for controls located between the fan cover and the fuel tank (see Fig. D below) which create an overall look distinct from the GX Engine Trademark. [REDACTED]



Figure D

Kohler too, acknowledges the availability of alternative designs. [REDACTED]

¹³ Opposers also contend that the muffler “location on the top of the [power take-off] side of the engine is for functional reasons” “which in turn, limits the options for positioning the engine components that can be seen in” the GX Engine Trademark. Opp. Br. at 20. The precise location of the muffler on the GX Engine is not dictated by function. Mieritz Decl. ¶ 63. Moreover, even with the muffler located where it is on the GX Engine there are numerous alternative locations available for the other major components. *Id.*

[REDACTED]

[REDACTED]

3. Honda's Advertisements Do Not Ascribe Utilitarian Benefits To The GX Engine Trademark

There are disputed issues of material fact regarding whether Honda's advertisements promote functional benefits of the GX Engine Trademark. Opposers argue that because Honda advertises functional characteristics of the GX Engine such as its durability, reliability, and fuel efficiency, the GX Engine Trademark is functional. However, this argument misapplies the applicable *Morton-Norwich* factor, which requires that in order to be evidence of functionality, the advertising must tout utilitarian advantages "*of the design*" for which trademark protection is sought. *In re Morton-Norwich Prods., Inc.*, 671 F.2d at 1341 (emphasis added).

Nothing in Honda's advertising connects the claimed advantages with the features that are the subject of the GX Engine Trademark. The advantages of the GX Engine touted in its advertising are a result of the *internal* mechanics of the GX Engine, not a benefit of its external appearance. *See, e.g.*, Frazier Decl., Exh. U (Honda website) (attributing functional benefits like fuel efficiency, proven reliability, and easy starting to elements unrelated to the GX Engine Trademark, such as the "OHV design," "cast iron cylinder sleeve," and "ergonomic, easy to grip recoil rope design"). Because Honda's advertisements focus on the "engineering advantages" of the GX Engine, they are consistent with a finding that the GX Engine Trademark is non-functional. *See Global Manufacture Grp. v. Gadget Universe.com*, 417 F. Supp. 2d 1161, 1169 (S.D. Cal. 2006) (finding non-functionality "supported because [the] advertisements do not tout the function of the design, but rather focus on the engineering advantages of the [product]").

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Thus, these advertisements help build brand identity for the GX Engines and their trade dress by consistently and prominently displaying the features

of the GX Engine Trademark, and do not promote any claimed utilitarian advantages of the GX Engine. *See, e.g.*, Frazier Decl., Exhs. V (AHGXC001548), W (AHGXC000400), and X (AHGXC000562). In fact, quite the opposite of suggesting that the design of the GX Engine contributes to its dependability and reliability, [REDACTED]

[REDACTED]

[REDACTED]

4. The GX Engine Design Is Not Dictated By A Comparatively Simple Or Inexpensive Method Of Manufacture

There are disputed issues of material fact regarding whether the GX Engine design is dictated by a comparatively simple or inexpensive method of manufacture. Opposers have failed to provide any evidence that engines embodying the GX Engine Trademark are relatively easy or cheap to manufacture.

Rather, [REDACTED]

[REDACTED], testimony focusing on *specific* elements of the mark (namely, the placement of the fuel tank), and a generic, *unsubstantiated* statement that “a smaller, more compact product uses less material to manufacture, which results in lower costs.” *See* Opp. Br. at 25.

With respect to the fuel tank, as discussed above, Honda is not claiming trademark protection for all engine designs with a fuel tank above the carburetor. As compared with other gravity-fed options, the precise placement, shape, size, and styling of Honda’s fuel tank is not cheaper or simpler to manufacture than the alternatives. Mieritz Decl. ¶¶ 37-41. Similarly, Honda is not claiming all compact engine designs. Thus, Opposers’ unsupported statement that a compact design saves money because it saves material—even if true—is not sufficient to establish that Honda’s design results from a relatively cheaper method of manufacturing. On the whole, the styling of the GX Engine does not decrease manufacturing costs and therefore is not evidence of functionality. Mieritz Decl. ¶¶ 20, 35, 69; Fujita Decl. ¶ 16.

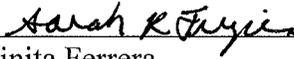
V. CONCLUSION

Given the numerous disputed material issues concerning the non-functionality of the GX Engine Trademark, Honda respectfully requests that the Board deny Opposers’ Motion for Summary Judgment.

HONDA GIKEN KOGYO KABUSHIKI KAISHA
(HONDA MOTOR CO., LTD.)

Date: September 24, 2013

By its attorneys,



Vinita Ferrera

John Regan

Silena Paik

Sarah Frazier

Wilmer Cutler Pickering Hale and Dorr LLP

60 State Street

Boston, Massachusetts 02109

(617) 526-6000

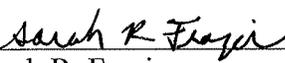
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Applicant Honda Giken Kogyo Kabushiki Kaisha's Opposition to Opposers Briggs & Stratton Corporation and Kohler Co.'s Motion for Summary Judgment [REDACTED – PUBLIC VERSION] 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