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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.) |
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| Date | 09/24/2013 |
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EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF MISSISSIPPI
EASTERN DIVISION

| | | |
|-----------------------------------|---|-------------------------------|
| POWERTRAIN, INC., <i>et al.</i> , |) | |
| |) | |
| Plaintiffs, |) | |
| |) | |
| v. |) | |
| |) | |
| AMERICAN HONDA MOTOR CO., INC., |) | |
| |) | |
| Defendant. |) | Civil Action No.: 1:03CV668MD |
| |) | |
| AMERICAN HONDA MOTOR CO., INC., |) | |
| |) | |
| Counterclaimant, |) | |
| |) | |
| v. |) | |
| |) | |
| POWERTRAIN, INC., <i>et al.</i> , |) | |
| |) | |
| Counterdefendants. |) | |

PERMANENT INJUNCTION

This case came on for trial before a jury and this Court, Michael P. Mills, Chief U.S. District Judge, presiding. Based on the jury verdict dated August 13, 2007, this Court has previously ordered, adjudged, and decreed, by Order and Judgment dated August 27, 2007, the following:

(a) that the trade dress of American Honda Motor Co., Inc.'s ("American Honda's") G (i.e., that the trade dress is n ed secondary meaning);

(b) that PowerTrain Tool Mart, Inc. and Best Machir have all directly infringed on nd

(c) that Joyce Ma on Honda's trade dress.

| | |
|---------------------|---|
| CASE NO. | CV05-8879 SJO (VBK) |
| | American Honda Motor Co. Inc. |
| VS. | The Pep Boys - Manny, Moe, & Jack, et al. |
| PLAINTIFF'S EXHIBIT | 2766 |
| DATE | IDEN. |
| DATE | EVID. |
| BY | |
| | Deputy Clerk |
| AO 286 | |

AHPB 326636

The Court further finds that there are certain parties against whom a default judgment has been entered, namely China National Electronics Import and Export Zhejiang Company, Shaoxing Tongyong Engine Mading Company, Inc., Xing Yue Group, and Zhejiang Ever Fine Electric Appliance Group, Ltd., as set forth in this Court's order of July 12, 2007 [1069]. Based on their default, and further based on the findings of the jury,

IT IS HEREBY ORDERED, ADJUDGED, AND DECREED that Defendants PowerTrain, Inc., Wood Sales Co., Inc., Tool Mart, Inc. Best Machinery and Electrical Co., Inc., Joyce Ma, China National Electronics Import and Export Zhejiang Company, Shaoxing Tongyong Engine Mading Company, Inc., Xing Yue Group, and Zhejiang Ever Fine Electric Appliance Group, Ltd., and their respective officers, directors, employees, agents, attorneys, and all persons acting for or on behalf of them, whether acting individually or in concert (collectively "Defendants") are hereby permanently enjoined from:

1. Using, designing, manufacturing, selling, offering for sale, or importing the engines, or any product incorporating such engines, as shown on the photographs attached as Exhibit A sheets 1-47 and 50-56, which utilize the fuel tank design, muffler design, valve cover design, fan cover design, cooling fins' design, air cleaner cover design, raised circle on air cleaner cover, wing nut on air cleaner cover, carburetor cover, plastic ribs on carburetor cover, bolt location on carburetor cover, oil fill cap style and color, fuel tank mounts, oil alert system, and/or engine base ribbing design of the trade dress of the Honda

GX series engines, including the overall appearance of Honda's GX series engines, as shown on the photographs attached as Exhibit B, or any such item or component substantially or confusingly similar thereto, including but not limited to all 4 to 13 HP PowerTrain engines (or products incorporating such engines) as in existence on the day on which judgment was entered in this case (August 27, 2007) ["Infringing Items"]; and

2. Without limiting the foregoing, using, manufacturing, selling, offering for sale, or importing any Infringing Items in the form in which such Infringing Items existed on or before August 27, 2007; and

3. Defendants shall file a report, within 30 days of the date of this Permanent Injunction, describing all its steps taken to ensure compliance with the provisions of paragraphs 1 and 2 above; and

4. This Court retains authority, under 15 U.S.C. § 1118, to ensure compliance with this order, and to grant any further and appropriate relief, including, but not limited to consideration of whether any alternative engine designs to be presented by PowerTrain or any other Defendant are permissible under the Order and Judgment dated August 27, 2007, as may be required on this record; and

5. The parties have agreed that any appeal times or deadlines that might otherwise apply to this Order are tolled, pending the trial of the damages portion of this matter. The parties further agree not to appeal this permanent injunction until after the trial of the damages portion of this matter.

ORDERED AND ADJUDGED this 23rd day of October, 2007.

/s/ Michael P. Mills
CHIEF JUDGE
UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF
MISSISSIPPI

EXHIBIT B
Filed Under Seal

EXHIBIT C

SEND - ENTER

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

AMERICAN HONDA MOTOR CO., INC.,)
)
) Plaintiff,)
)
) v.)
) THE PEP BOYS, et al.,)
)
) Defendants.)
 _____)

NO. CV 05-8879 SJO (VBKx)

ORDER GRANTING IN PART AND DENYING
IN PART JIANGDONG AND HOMIER'S
MOTION FOR SUMMARY JUDGMENT;
GRANTING IN PART AND DENYING IN
PART LIFAN'S MOTION FOR SUMMARY
JUDGMENT; GRANTING AMERICAN
HONDA'S MOTION FOR SUMMARY
JUDGMENT; AND GRANTING AMERICAN
HONDA'S MOTION FOR PARTIAL
SUMMARY JUDGMENT.

Defendants Jiangsu Jiangdong Group Co., Ltd. and American JD Group Co., Ltd. (collectively, "Jiangdong") and Homier Distributing Co., Inc. ("Homier") have moved for summary judgment against Plaintiff American Honda Motor Co., Inc. ("American Honda") on all counts. Defendants Lifan Industry (Group) Co., Ltd. f/k/a Chongqing Lifan Industry (Group) Co., Ltd.; Chongqing Lifan Industry Group Import & Export Co., Ltd.; Chongqing Lifan Power Co., Ltd.; and American Lifan Co., Inc. (collectively, "Lifan") have also moved for summary judgment against American Honda on all counts. Defendants The Pep Boys - Manny, Moe & Jack ("Pep Boys") and Great Lakes Tool Manufacturing, Inc. d/b/a Wen Products, Inc. ("Great Lakes") have joined in the two separate motions for summary judgment against American Honda. American Honda has moved for summary judgment on Jiangdong's counterclaims, and has moved for partial summary judgment on Lifan's counterclaims. Oppositions and replies have been filed in all instances.

1 Pursuant to Federal Rule of Civil Procedure 78 and Local Rule 7-15, the Court found this
2 matter suitable for disposition without oral argument and vacated the hearing set for
3 October 29, 2007. Having thoroughly considered the arguments made by the parties, the Court
4 GRANTS IN PART and DENIES IN PART Defendants' respective motions for summary judgment,
5 and GRANTS Plaintiff's motions for summary judgment and partial summary judgment.

6 I. BACKGROUND

7 American Honda is a wholly owned subsidiary of Honda Motor Co. ("Honda") and the
8 exclusive licensee of Honda's intellectual property in the United States (Second Am. Compl.
9 ("SAC") ¶ 8.) Honda manufactures small gasoline-powered engines known as GX engines, as well
10 as power generators incorporating GX engines. (SAC ¶ 2.) American Honda markets and sells
11 these products in the United States. (SAC ¶ 8.) According to American Honda, GX engines and
12 GX engine generators have a "unique and distinctive overall look" – the GX engine trade dress
13 and the GX engine generator trade dress, respectively – "which consumers immediately recognize
14 and associate with authentic, high quality Honda products."¹ (SAC ¶ 3.) The GX engine trade
15 dress and GX engine generator trade dress are described as being "characterized by numerous
16 non-functional design elements" (SAC ¶ 3.) Specifically, American Honda lists ten such
17 elements applicable to both the GX engine trade dress and the GX engine generator trade dress,²

18
19 ¹ American Honda specifically identifies the following GX engine model numbers: GX120,
20 GX160, GX200, GX240, GX270, GX340, and GX390. (SAC ¶ 2.) However, there are other models
21 within the GX engine family, including: GXH50, GX100, GXV50, GXV160, GXV340, and GXV390.
22 (Conner Decl. Supp. American Honda ("AH") Mots. Ex. 1.) These latter engines are notably
23 different in appearance from the former GX engines, which are referenced in text and image
24 throughout the pleadings and filings relating to the present motions for summary judgment.
25 Because of this obvious discrepancy in appearance, and because American Honda never explicitly
26 mentions these latter model numbers in the context of its trade dress claims, the Court defines the
27 GX engine family, for purposes of this lawsuit, to include only those models specifically mentioned
28 in the Second Amended Complaint. The GX engine generator family is similarly limited for
purposes of this lawsuit to only those generators incorporating the GX engines mentioned in the
Second Amended Complaint.

² These elements are: (1) the valve cover shape and design; (2) the fan cover shape,
including a unique combination of angular and rounded edges and the shape of the air guide
portion of the fan cover; (3) the fuel tank size and shape; (4) the engine oil fill cap color; (5) the
muffler heat shield design; (6) the oil alert system placement; (7) the location, shape, and design

1 as well as four additional such elements uniquely applicable to the GX engine trade dress³ and
2 two additional such elements uniquely applicable to the GX engine generator trade dress.⁴ (SAC
3 ¶¶ 24-25.) American Honda claims that the GX engine trade dress and the GX engine generator
4 trade dress are protectable trade dress. (SAC ¶ 3.)

5 Jiangdong and Lifan manufacture small gasoline-powered engines ("Jiangdong engines"
6 and "Lifan engines," respectively) and generators incorporating these engines ("Jiangdong
7 generators" and "Lifan generators," respectively) that are similar in appearance to American
8 Honda's GX engines and GX engine generators.⁵ (SAC ¶ 4.) Jiangdong and Lifan market and sell
9 these products in the United States. (SAC ¶¶ 9-15.) Homier is a United States retailer of
10 Jiangdong engines and generators. (Compl. ¶ 4.)⁶ Pep Boys is a United States retailer of
11 Jiangdong and Lifan engines and generators. (SAC ¶ 17.) Great Lakes sells Lifan engines and
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14 of the oil fill cap and drain cap; (8) the number, location, and size of the air cooling fins; (9) the
15 trapezoidal shape and size of the base pad; and (10) the relative position and orientation of each
16 of the major engine components. (SAC ¶¶ 24-25.)

17 ³ These elements are: (1) the air cleaner housing, including the wing-nut design; (2) the
18 carburetor cover, including the shape, plastic ribs, label placement, control placement, bolt
19 locations, and bolt orientation; and (3) the combined and complimentary shape of the fuel tank,
20 air cleaner housing, and muffler heat shield, each with a unique beveled edge angled to the
21 outside of the engine and straight edge facing inward; and (4) the design and orientation of the
22 fuel tank mount. (SAC ¶ 24.)

23 ⁴ These elements are: (1) the air cleaner housing; and (2) the shape, design, and
24 orientation of the unattached fuel tank mount. (SAC ¶ 25.)

25 ⁵ The Court recognizes that the named Jiangdong Defendants dispute that they
26 manufacture engines and generators. (Jiangdong Opp'n 1.) They claim that the manufacturer is
27 the Jiangdong Gasoline Engine Manufacturing Company, not a party to the lawsuit. (Jiangdong
28 Opp'n 8.) Other than conclusory deposition statements (Whitehart Decl. Ex. L, at 40:7-16;
Whitehart Decl. Ex. M, at 390:19-22), little evidence is offered to support this position. The same
can be said as to American Honda's position that the named Jiangdong Defendants do in fact
manufacture engines and generators. In sum, the record is unclear on this issue. However, the
motions now before the Court do not depend on resolution of this dispute as American Honda has
not moved for summary judgment on its claims. The issue will be addressed at a later time.

⁶ The Complaint cited is the Complaint filed in the separate, now consolidated case
American Honda Motor Co. v. Homier Distributing Co., Case No. CV 06-0961.

1 generators in the United States under the WEN brand name, including through retailers such as
2 Pep Boys. (SAC ¶¶ 16.)

3 Perceiving a threat to its asserted trade dress rights, American Honda brought suit against
4 Jiangdong, Lifan, Homier, Pep Boys, and Great Lakes, alleging (1) federal unfair competition
5 (trade dress infringement) under 15 U.S.C. § 1125(a); (2) federal unfair competition (trade dress
6 dilution) under 15 U.S.C. § 1125(c); (3) common law unfair competition under California law; (4)
7 unfair business practices pursuant to California Business and Professions Code section 17200;
8 and (5) injury to business reputation and dilution under California Business and Professions Code
9 section 14330.⁷ (See *generally* SAC.) American Honda claims that Defendants are deliberately
10 attempting to capitalize on American Honda's GX engine trade dress and GX engine generator
11 trade dress by selling "knock-off" engines and generators. (SAC ¶¶ 4-6.)

12 Concurrent with the institution of suit, American Honda sent a Bulletin to all U.S. Honda
13 Power Equipment Dealers entitled "Imitation Honda Generators and Engines." (Strauss Decl. Ex.
14 4.) The Bulletin states that Jiangdong and Lifan are selling engines and generators copying
15 American Honda's trade dress and that "[s]uch conduct violates federal and state trademark and
16 unfair competition laws." (Strauss Decl. Ex. 4.) On the basis of this Bulletin, Jiangdong and Lifan
17 assert counterclaims on numerous federal and state tort grounds.⁸

18
19 ⁷ On December 21, 2005, American Honda filed a Complaint against Pep Boys; Jiangsu
20 Jiangdong Group Co., Ltd.; American JD Group Co., Ltd.; Chongqing Lifan Industry (Group) Co.,
21 Ltd.; American Lifan Industry, Inc.; and Wen Products, Inc. After discovering that Wen Products,
22 Inc. is merely a trade name for Great Lakes, Tool Manufacturing, Inc., a First Amended Complaint
23 was filed on January 11, 2006, naming Great Lakes as a defendant. A Second Amended
24 Complaint was filed on June 29, 2006, adding Chongqing Lifan General Gasoline Engines Co.,
25 Ltd. and Chongqing Lifan Industry (Group) Import & Export Co., Ltd. as defendants, and
26 identifying Chongqing Lifan Industry Group Co., Ltd. by its new corporate name, Lifan Industry
27 (Group) Co., Ltd. In a separate action, commenced February 16, 2006, American Honda brought
28 suit against Homier, alleging the same five counts as alleged in the Second Amended Complaint.
By this Court's Order of August 31, 2006, the two cases were consolidated.

⁸ Jiangdong counterclaims on four counts: (1) defamation under Georgia and California
law; (2) federal unfair competition; (3) tortious interference with prospective business opportunities
and advantage under Georgia and California law; and (4) unfair business practices under
California Business and Professions Code section 17200. (See *generally* Jiangdong Answer and
Countercl. to SAC.) Each of the Lifan defendants counterclaimed separately. However, all Lifan

1 American Honda moves for summary judgment on Jiangdong's counterclaims and partial
2 summary judgment on Lifan's counterclaims,⁹ on the ground that the Bulletin is privileged as a
3 litigation-related communication. Jiangdong and Homier move for summary judgment on American
4 Honda's claims on the grounds that American Honda's trade dress is functional, American Honda
5 has no standing to pursue its trademark dilution claim, and American Honda's state claims fail
6 because its federal claims fail. Lifan moves for summary judgment on American Honda's claims
7 on the grounds that American Honda's trade dress has not acquired secondary meaning, there
8 is no likelihood of confusion between American Honda's trade dress and Lifan's trade dress, and
9 American Honda has failed to show actual dilution. Jiangdong and Homier adopt the arguments
10 made in Lifan's motion (Jiangdong and Homier ("J&H") Mot. 20), and Lifan adopts the arguments
11 made in Jiangdong and Homier's motion (Lifan Mot. 2-3).

12 II. DISCUSSION

13 Summary judgment is appropriate if no genuine issue of material fact exists and the moving
14 party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477
15 U.S. 317, 322-23 (1986). An issue is "genuine" if the evidence is such that a reasonable jury could
16 return a verdict for the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248
17 (1986). An issue is "material" if its resolution could affect the outcome of the action. *Id.*

18 The moving party bears the initial burden of informing the court of the basis for the motion
19 and identifying portions of the pleadings, depositions, answers to interrogatories, admissions, or
20 affidavits that demonstrate the absence of a triable issue of material fact. *Celotex*, 477 U.S. at 323.

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23 defendants counterclaim on the same fourteen counts, with the exception of one Lifan defendant,
24 who omits two such counts. The fourteen counts are: (1) federal unfair competition and false
25 representation; (2) misuse of trade dress; (3) misrepresentation; (4) tortious interference with
26 contractual relations; (5) declaratory relief; (6) unfair competition under California law; (7) unfair
27 competition under Connecticut law; (8) unfair competition under Florida law; (9) common law unfair
28 competition under California, Texas, Georgia, and Connecticut law; (10) defamation under Georgia
law; (11) defamation under Texas law; (12) defamation under Florida law; (13) defamation under
Connecticut law; and (14) common law defamation and libel. (See *generally* American Lifan
Industry, Inc. Answer and Countercl. to SAC.)

⁹ American Honda does not move for summary judgment on Lifan's fifth count.

1 If the moving party meets its initial burden, the burden shifts to the non-moving party to designate
2 specific and supported material facts showing a genuine issue for trial. *Id.* at 322. In determining
3 whether a genuine issue of material fact exists, the court views the evidence and draws inferences
4 in the light most favorable to the non-moving party. *Anderson*, 477 U.S. at 255.

5 A. American Honda's Federal Trade Dress Infringement Claim

6 Trade dress refers generally to the overall image, design, and appearance of a product.
7 *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992). To recover for infringement
8 of trade dress, a plaintiff must demonstrate that its trade dress is (1) non-functional; (2) serves a
9 source-identifying role because it is inherently distinctive or has acquired secondary meaning; and
10 (3) a likelihood of confusion exists. *Disc Golf Ass'n v. Champion Discs, Inc.*, 158 F.3d 1002, 1005
11 (9th Cir. 1998). With respect to the second element, if the trade dress claim involves the product's
12 design rather than its packaging, as is the case in the present action, then the party asserting
13 trade dress rights must establish that the trade dress has acquired secondary meaning. *Wal-Mart*
14 *Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 215 (2000).

15 1. A Genuine Issue of Material Fact Exists Regarding Functionality.

16 "In a civil action for trade dress infringement . . . the [party] who asserts trade dress
17 protection has the burden of proving that the matter sought to be protected is not functional." 15
18 U.S.C. § 1125(3). Where a party claims that the overall appearance of a product is protectable as
19 trade dress, the entire product design therefore must be nonfunctional. *Leatherman Tool Group,*
20 *Inc. v. Cooper Indus., Inc.*, 199 F.3d 1009,1012 (9th Cir. 1999).

21 Product design is functional if it is "essential to the use or purpose of the [product] or if it
22 affects the cost or quality of the [product], that is, if exclusive use of the [design] would put
23 competitors at a significant non-reputation-related disadvantage." *Qualitex Co. v. Jacobson Prods.*
24 *Co.*, 514 U.S. 159, 165 (1995). In determining whether a product design is or is not functional,
25 courts must be mindful of the important distinction between "de facto" and "de jure" functionality:

26 In essence, de facto functional means that the design of a product has a function,
27 i.e., a bottle of any design holds fluid. De jure functionality, on the other hand,
28 means that the product is in its particular shape *because it works better in this*

1 *shape* Before an overall product configuration can be recognized as a
2 trademark, the entire design must be arbitrary or non de jure functional.
3 *Leatherman*, 199 F.3d at 1012 (quoting *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019,
4 1025 (Fed. Cir. 1985)). Additional factors relevant to the functionality analysis include: whether
5 there exists an expired utility patent disclosing the utilitarian advantages of the design; whether
6 alternative designs are available showing that the plaintiff's choices were arbitrary or aesthetic;
7 whether the advertising touts the utilitarian advantages of the design; and whether the particular
8 design results from a comparatively simple or inexpensive method of manufacture. *Clamp Mfg.*
9 *Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516 (9th Cir. 1989).

10 Product design must be examined "as a whole, not by its individual constituent parts."
11 *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001). The fact that
12 individual design elements may be functional does not necessarily mean that the overall design
13 is functional. *Id.* However, where the whole is "nothing other than the assemblage of functional
14 parts . . . it is semantic trickery to say that there is still some sort of separate 'overall appearance'
15 which is non-functional." *Leatherman*, 199 F.3d at 1013. Accordingly, the Ninth Circuit has held
16 that, in a product configuration trade dress case, "there must be some aspect to the configuration
17 which is nonfunctional." *Id.* at 1013 n.6.

18 Jiangdong and Homier argue that all of the allegedly nonfunctional design elements of the
19 GX engine trade dress and the GX engine generator trade dress are functional, and that American
20 Honda's trade dress claims therefore fail as a matter of law. American Honda counters that each
21 and every design element is, as claimed, nonfunctional. Functionality is a question of fact. *Clicks*
22 *Billiards*, 251 F.3d at 1258. To avoid summary judgment, American Honda need only make "some
23 showing of nonfunctional features" of its trade dress, thereby creating a genuine issue of material
24 fact as to the functionality of its trade dress as a whole. *Interactive Network, Inc. v. NTN*
25 *Commc'ns, Inc.*, 875 F. Supp. 1398, 1406 (N.D. Cal. 1995). The Court finds that American Honda
26 has made such a showing.

27 Contrary to Jiangdong and Homier's contentions, American Honda has introduced evidence
28 to support its position that the design elements that comprise its trade dress are arbitrary and yield

1 no utilitarian advantage.¹⁰ Jiangdong and Homier are correct that many of these elements serve
2 a function; however, this observation is limited to the de facto function of these elements.¹¹
3 Motohiro Fujita, an engineer involved in the design of the GX engine, testified at his deposition that
4 the engine's design elements were selected by a styling design team solely for their ornamental
5 characteristics, not for any performance-enhancing or cost-reducing purposes (Strauss Decl. Ex.
6 8; Hannan Decl. Ex. 5), a point reinforced by the expert reports of engineers Kevin L. Hoag and
7 James T. Mieritz (Hoag Decl. Ex. 2 ¶ 15; Mieritz Decl. Ex. 2 ¶ 61). Photographs of the various
8 design elements confirm this assessment. For instance, the hexagonal valve cover design (AH
9 Opp'n to J&H 5), the angular and rounded shape of the fan cover (AH Opp'n to J&H 5-6), the
10 beveling and lack of beveling on the edges of the air cleaner housing (AH Opp'n to J&H 6), the
11 ribbing of the carburetor cover¹² (AH Opp'n to J&H 8), the style of the slots and louvers on the
12 muffler heat shield (AH Opp'n to J&H 9-10), and the number, width, and spacing of the air cooling
13 fins (AH Opp'n to J&H 13), among other design elements, all "appear to have been selected on
14 the whim of the designer." *Global Manufacture Group, LLC v. Gadget Universe.Com*, 417 F. Supp.
15 2d 1161, 1169 (S.D. Cal. 2006). The fact that competitor engines exhibit alternative designs, and
16 do not seem to be disadvantaged thereby, further supports this conclusion. (See generally Hoag
17 Decl. Ex. 2 (comparing various engines); Mieritz Decl. Ex. 2 (same).)

18
19 ¹⁰ Unless otherwise noted, these elements are shared by both the GX engine trade dress
20 and the GX engine generator trade dress.

21 ¹¹ For instance, the valve cover serves the de facto function of "provid[ing] a seal keeping
22 oil in and dirt out of the rocker lever and valve spring region of the engine" (Hoag Decl. Ex. 2 ¶ 32),
23 the fan cover serves the de facto function of "encas[ing] the spinning flywheel and fan blades for
24 safety" (Hoag Decl. Ex. 2 ¶ 45), and the air cleaner housing serves the de facto function of
25 "protecting the engine from ingesting dirt particles into the cylinder" (Hoag Decl. Ex. 2 ¶ 63).
26 Indeed, all of the design elements identified by American Honda serve one or more de facto
27 functions. (See generally Hoag Decl. Ex. 2.) The question, however, is not whether these engine
28 components serve a function, but whether they *work better* as a result of their particular designs.
See *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981) ("[De jure]
[f]unctional features of a product are features which constitute the actual benefit that the consumer
wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored,
or endorsed a product.").

¹² This element is only present in the GX engine trade dress.

1 American Honda's position is also strengthened because its advertising does not tout any
2 utilitarian advantages of the GX engine design or the GX engine generator design.¹³ (Conner Decl.
3 Supp. AH Mots. Ex. 2 (showing examples of advertisements).) Rather, the advertisements focus
4 on "the engineering advantages" of the engines and generators, such as fuel efficiency, quiet
5 operation, power capability, and emission compliance. *Global Manufacture Group*, 417 F. Supp.
6 2d at 1169 ("Plaintiff's argument [in favor of nonfunctionality] is also supported because its
7 advertisements do not tout the function of the design, but rather focus on the engineering
8 advantages of the scooter.").

9 Additionally, there is a presumption that the GX engine trade dress is nonfunctional
10 because American Honda previously held a design patent for the external appearance of the
11 engine (see Strauss Decl. Ex. 9.) and "a design patent . . . presumptively indicates that the design
12 at issue is not de jure functional," *Topps Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q.2d 1412, 1420
13 (S.D.N.Y. 1996). American Honda's design patent claimed "[t]he ornamental design for an internal
14 combustion engine" and it depicted many of the same design elements now being asserted by
15 American Honda as comprising the GX engine trade dress, and consequently, the GX engine
16 generator trade dress. (Strauss Decl. Ex. 9.)

17 Jiangdong and Homier point instead to the existence of a utility patent previously held by
18 American Honda for the GX engine as support for their position that the engine design is
19 functional. (See Hannan Decl. Ex. 6.) Specifically, they argue that claims 1 and 2 of the utility
20 patent require a finding of functionality as to three of the design elements identified by American
21 Honda as being nonfunctional.¹⁴ While "a utility patent is strong evidence that the features therein

22
23 ¹³ For instance, the advertisements do not state that GX engines perform better because
24 of the angular and rounded shape of the engine fan cover.

25 ¹⁴ Claim 1 of the patent claimed "a fuel tank disposed over [a] crank case [and] a main air
26 cleaner and a muffler disposed . . . laterally of [the] fuel tank in parallel relation to each other."
27 (Hannan Decl. Ex. 6.) Claim 2 of the patent claimed "[a] general-purpose internal combustion
28 engine according to claim 1, wherein each of said fuel tank, said muffler, and said main air cleaner
is substantially rectangularly shaped as viewed in plan." (Hannan Decl. Ex. 6.) According to
Jiangdong and Homier, these claims require a finding of functionality as to the following design
elements: (1) the shape of the air cleaner housing; (2) the shape and size of the fuel tank; and (3)

1 claimed are functional," *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 23 (2001), it
2 appears that the "features therein claimed" are not entirely congruent with the three respective
3 design features American Honda claims are nonfunctional. According to American Honda, within
4 the general parameters of the patent's claims, there is significant room for the making of arbitrary
5 stylistic choices, and it is the specific design flourishes that have resulted from these choices that
6 are nonfunctional. (AH Opp'n to J&H 14.) This position is supported by evidence of competitor
7 engines that visually fall within the same general parameters of these claims, yet are stylistically
8 distinct from the design of the GX engine.¹⁵ Nevertheless, even were the Court to find these three
9 features functional, American Honda, as noted above, has already made a sufficient showing of
10 nonfunctionality as to a number of other design elements not covered by the utility patent.

11 Because a genuine issue of material fact exists as to the functionality of the GX engine
12 trade dress and the GX engine generator trade dress, summary judgment on this element is
13 DENIED.

14 2. A Genuine Issue of Material Fact Exists Regarding Secondary Meaning of
15 the GX Engine Trade Dress, But Not the GX Engine Generator Trade Dress.

16 "A product's trade dress attains secondary meaning when the purchasing public associates
17 the dress with a single producer or source rather than just the product itself." *First Brands Corp.*
18 *v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987). Secondary meaning is a question of fact.
19 *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 873 (9th Cir. 2002). In determining
20 secondary meaning, courts will inquire into whether actual purchasers associate the dress with
21 the source, and will also evaluate the degree and manner of advertising by the party seeking
22 protection. *Clamp Mfg.*, 870 F.2d at 517.

23 _____
24 the position and orientation of the major engine components.

25 ¹⁵ For instance, with respect to claim 1, photographs of the top of a GX engine, a
26 Jiangdong engine, a Kawasaki engine, and a Tecumseh engine demonstrate that all engines fall
27 within the general parameters of the claim, yet the Kawasaki and Tecumseh engines are
28 stylistically distinct from the GX engine, whereas the Jiangdong engine is substantially similar in
design. (Separate Statement of Uncontroverted Facts & Conclusions of Law ("SUF") Supp. AH
Mot. Summ. J. on Jiangdong's Countercls. ¶¶ 46-49.)

1 Lifan first contends that American Honda has failed to introduce any evidence supporting
2 its claim that the GX engine generator trade dress has acquired secondary meaning. The Court
3 agrees. American Honda offers evidence of an empirical survey on the issue of secondary
4 meaning, but the survey only focuses on the GX engine trade dress, not the GX engine generator
5 trade dress. American Honda explains this shortcoming as follows: "Lifan notes that the Gelb
6 survey focuses on Honda's engines, and not specifically on generators. But an engine is a critically
7 important component of a generator, and recognition of that component is thus relevant with
8 respect to both engines *and* generators that include engines." (AH Opp'n to Lifan 8.) This
9 explanation is not persuasive. American Honda does not claim trade dress protection in the GX
10 engine component of GX engine generators, but rather, in the appearance of GX engine
11 generators as a *whole*. (AH Opp'n to Lifan 7.)

12 At best, the survey would only support a finding of secondary meaning as to the GX engine
13 component of GX engine generators; however, the Court finds that there is insufficient evidence
14 to reach even this limited conclusion. As American Honda notes, "[t]he entire point of a secondary
15 meaning survey is to determine whether, when faced with a product *as it appears in the*
16 *marketplace*, survey respondents recognize the source of that product." (AH Opp'n to Lifan 6.)
17 While GX engines and GX engines incorporated into generators share a number of common
18 design elements, the engines, *as they appear in the marketplace*, are visually distinguishable in
19 terms of their overall configuration and appearance. (*Compare* Gelb Decl. Ex. 1, at 12, *with* SUF
20 Supp. AH Mot. on Lifan's Countercls. ¶¶ 119-20.) American Honda notes as much. (SAC ¶¶ 24-25
21 (describing the similarities *and* differences between the GX engine trade dress and GX engine
22 generator trade dress).) Accordingly, a finding of secondary meaning as to GX engines does not
23 establish that GX engines incorporated into generators have attained secondary meaning.

24 In sum, American Honda's secondary meaning survey fails to show that, "in the minds of
25 the public," the GX engine generator as a whole or the GX engine component of the generator
26 "identif[ies] the source of the product rather than the product itself." *Inwood Labs., Inc. v. Ives*
27 *Labs.*, 456 U.S. 844, 851 (1982).

1 American Honda makes the additional argument that its "promotion of its generators is
2 alone sufficient to demonstrate secondary meaning for the generators, and to preclude summary
3 judgment." (AH Opp'n to Lifan 8.) This argument is also unpersuasive. For advertising to be
4 relevant in determining whether trade dress has acquired secondary meaning, the advertising
5 "must involve 'image advertising,' that is, the ads must feature in some way the trade dress itself."
6 *First Brands Corp.*, 809 F.2d at 1383. American Honda describes the appearance of the GX
7 engine as being the most "critically important component" of the GX engine generator trade dress.
8 However, in advertisements touting GX engine generators, the GX engine component is hardly
9 visible. (Conner Decl. Supp. AH Mots. Ex. 2.) As to those portions of the engine that are visible,
10 the ornamental design elements that American Honda claims serve to identify the source of the
11 product are not visible at all because the image is so small. Lastly, those features of the generator
12 that are visible are features that have never been mentioned by American Honda as being relevant
13 to the overall generator trade dress. These advertisements are therefore insufficient to
14 demonstrate secondary meaning as to either the GX engine generator trade dress as a whole, or
15 the GX engine component of the generator.

16 As to the GX engine trade dress, American Honda fares much better regarding its argument
17 in favor of secondary meaning. Unlike the GX engine generator advertisements, the GX engine
18 advertisements prominently feature the GX engine trade dress. (Conner Decl. Supp. AH Mots.
19 Exs. 1-2.) Where a product's trade dress is "prominently featured," the Ninth Circuit has held that
20 "[e]vidence of use and advertising over a substantial period of time is enough to establish
21 secondary meaning." *Clamp Mfg.*, 870 F.2d at 517. The Ninth Circuit has found that the
22 expenditure of three million dollars constitutes "fairly extensive evidence of advertising" and that
23 nine years of use of a particular trade dress constitutes "a fairly long time." *Cal. Scents v. Surco*
24 *Prods., Inc.*, 28 F. App'x 659, 662-63 (9th Cir. 2002). American Honda has been selling GX
25 engines in the United States since 1983, over twenty years. (Conner Decl. Supp. AH Mots. ¶ 2.)
26 In addition, American Honda has expended more than thirty million dollars on such advertising.
27 (Conner Decl. Supp. AH Mots. ¶ 3.) The evidence is sufficient to create a triable issue of fact
28 regarding secondary meaning.

1 This conclusion is further buttressed by the secondary meaning survey, alluded to above.
2 The survey found that 78% of the relevant customer population identifies the GX engine with
3 American Honda. (Strauss Decl. Ex. 6, at 54.) "Generally, figures over 50% are regarded as
4 *clearly sufficient*." 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §
5 32:190 (4th ed. 2007).

6 Lifan attacks the survey on two grounds, both unavailing. First, Lifan argues that the survey
7 failed to subtract for the reported 51% control. (Lifan Mot. 6.) However, as American Honda notes,
8 the control in this instance failed to detect any potential survey "noise," and so it was not
9 subtracted. (AH Opp'n to Lifan 5.) Lifan does not contest this argument in its Reply. Second, Lifan
10 argues that the survey failed to filter out the non-trade dress elements of the engine design. (Lifan
11 Mot. 7.) For instance, the survey showed respondents a color photograph of the engine that
12 included the recoil starter. According to Lifan, American Honda does not claim color or the recoil
13 starter as part of its trade dress. (Lifan Mot. 7.) Lifan is mistaken. American Honda claims trade
14 dress rights in the GX engine *as a whole*, not in any particular design element of the engine. It is
15 of no import that American Honda does not identify color and the recoil starter as nonfunctional
16 design elements of its trade dress, because the Ninth Circuit has made clear that trade dress can
17 include both functional and nonfunctional elements. *Clicks Billiards*, 251 F.3d at 1259
18 ("[F]unctional elements that are separately unprotectable can be protected together as part of a
19 trade dress.") (quotation omitted).

20 Because a genuine issue of material fact exists as to the secondary meaning of the GX
21 engine trade dress, but not as to the secondary meaning of the GX engine generator trade dress,
22 summary judgment on this element is GRANTED IN PART and DENIED IN PART.

23 3. A Genuine Issue of Material Fact Exists Regarding Likelihood of Confusion.

24 A likelihood of confusion exists "when consumers are likely to assume that a product or
25 service is associated with a source other than its actual source because of similarities between
26 the two sources' [trade dresses] or marketing techniques." *Nutri/System, Inc. v. Con-Stain Indus.,*
27 *Inc.*, 809 F.2d 601, 604 (9th Cir.1987). Eight factors are considered as part of the consumer
28 confusion inquiry: (1) the strength of the plaintiff's mark; (2) the relatedness or proximity of the

1 goods; (3) the similarity of the marks; (4) evidence of actual confusion; (5) the marketing channels
2 used by each party; (6) the type of goods and the degree of care likely to be exercised by the
3 purchaser; (7) the defendant's intent in selecting the mark; and (8) the likelihood of expansion of
4 the product lines. *First Brands*, 809 F.2d at 1384. "These elements are not applied mechanically;
5 courts may examine some or all of the factors, depending on their relevance and importance."
6 *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1076 (9th Cir. 2006). Because
7 likelihood of confusion is a fact-intensive inquiry, it is generally not amenable to resolution on
8 summary judgment. *Id.* at 1075. The instant case is no exception.¹⁶

9 With respect to the first and second factors, the evidence favors American Honda. The fact
10 that American Honda has been selling GX engines in the United States for over twenty years, with
11 few changes to the engine design, and has expended significant sums advertising these engines,
12 suggests a strong trade dress. (See Conner Decl. Supp. AH Mots. ¶¶ 2-3.) In addition, the
13 products at issue are clearly related, as both are compact internal combustion engines.

14 With respect to the third factor, there is substantial similarity between the GX engine trade
15 dress and Lifan's engine trade dress, as demonstrated by the many photographs showing their
16 nearly identical appearance. (See generally SUF Supp. AH Mot. on Lifan's Countercls.) Lifan does
17 not dispute the similarity of trade dress; rather, Lifan argues that there is no likelihood of confusion
18 because Lifan prominently displays on its engines the "LIFAN" trademark, or the trademark of its
19 customers, such as the "WEN" trademark. (Wang Decl. ¶ 3.) While use of a trademark may
20 prevent confusion even where product configurations are visually similar, see *Global Manufacture*
21 *Group*, 417 F. Supp. 2d at 1174, the Court finds that reasonable jurors could conclude that a
22 likelihood of confusion exists despite Lifan's use of its trademark.

24
25 ¹⁶ In their Motion, Jiangdong and Homier state that they adopt the arguments made by
26 Lifan in its Motion. While adoption of Lifan's secondary meaning argument, for instance, poses no
27 analytical problems because the inquiry focuses solely on the distinctiveness of American Honda's
28 trade dress, adoption of Lifan's likelihood of confusion argument is problematic because the
inquiry focuses on the similarity between two parties' respective trade dresses. As Jiangdong and
Homier have presented no evidence of their own trade dress to support summary judgment on the
issue of likelihood of confusion, the Court only considers the argument with respect to Lifan.

1 "A copier must not only attempt to avoid likelihood of confusion; it must succeed in doing
2 so. Thus when there is a source-indicating label, the label must be effective to make consumer
3 confusion unlikely, in light of all the circumstances." *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988
4 F.2d 1117, 1133 (Fed. Cir. 1993). The Ninth Circuit has stated that the "test for likelihood of
5 confusion embraces confusion between the goods or sponsorship of the allegedly infringing
6 goods." *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1987) (emphasis
7 added). Where consumers wrongly believe that a product "is associated with the source of a
8 different product," likelihood of confusion exists. *Id.*

9 American Honda has presented evidence suggesting that customers may be confused into
10 believing that American Honda and Lifan are affiliated. For instance, a survey of engine
11 purchasers found that, of 141 test group respondents shown the Lifan engine, with the "WEN"
12 trademark visible, 21.7% "mistakenly believe that Honda makes or puts out the Lifan engine or
13 that the company that makes the Lifan engine is connected to, authorized by, or affiliated with
14 Honda." (Mantis Decl. Ex. 2, at 19-20.)¹⁷ Such evidence suggests that summary judgment on the
15 issue of likelihood of confusion is not proper in this case. See *Cairns v. Franklin Mint Co.*, 24 F.
16 Supp. 2d 1013, 1041 (C.D. Cal. 1998) ("Survey evidence is not required to establish likelihood of
17 confusion, but it is often the most persuasive evidence.").

18 The remaining factors do not compel a contrary conclusion. As to the fourth factor,
19 American Honda has produced some evidence of actual confusion in the form of two customer
20 statements that the similarity of Lifan and GX engines is the result of a contractual or other
21

22
23 ¹⁷ Lifan does not dispute that this percentage figure is within the range that courts have
24 found probative of confusion. Instead, Lifan attempts to discredit this survey by arguing, as it did
25 with the secondary meaning survey, for the exclusion of any survey response citing a design
26 element that American Honda does not claim as nonfunctional. (Lifan Mot. 16.) This argument has
27 no merit; as noted above, functional elements may be part of a product's overall trade dress.
28 Furthermore, Lifan argues for the exclusion of any survey response citing only individual design
elements American Honda claims are nonfunctional. (Lifan Mot. 17.) According to Lifan, only
survey responses that cite the trade dress as a whole should be considered. Lifan is unable to
muster any authority for this illogical proposition. While trade dress is to be analyzed as a whole,
it is perfectly reasonable for respondents to cite similar parts that comprise a similar whole.

1 business relationship between the parties.¹⁸ As to the fifth factor, although no evidence is adduced
2 one way or the other, it would appear that the marketing channels used by American Honda and
3 Lifan converge due to the similarity of their products. The sixth factor is the factor that seems to
4 weigh most heavily in Lifan's favor. Because the parties' products are expensive,¹⁹ purchasers are
5 presumed to be more sophisticated, and thus take more care in their purchasing decisions. See
6 *Computer Access Tech. Corp. v. Catalyst Enters., Inc.*, No. C-00-4852, 2001 WL 34118030, at
7 *8 (N.D. Cal. June 13, 2001). However, the survey mentioned above targeted precisely these
8 types of purchasers, and concluded that a notable percentage indicated confusion. The seventh
9 factor favors American Honda, as the photographs of the parties' respective engines suggest an
10 intent on Lifan's part to copy the GX engine trade dress. "In the Ninth Circuit, a defendant's
11 knowing adoption of a mark similar to the plaintiff's raises a presumption of confusion." *Sega*
12 *Enters. Ltd. v. MAPHIA*, 948 F. Supp. 923, 937 (N.D. Cal. 1996). No evidence is introduced
13 regarding the eighth factor.

14 For the above reasons, the Court concludes that a genuine issue of material fact exists
15 regarding likelihood of confusion. Summary judgment on this element is therefore DENIED.

16 B. American Honda's State Trade Dress Infringement Claims

17
18
19 ¹⁸ On an Internet forum dedicated to small engines, one customer said: "[T]he Chinese
20 generator that I am considering buying from (Lifan) is licensed by Honda to produce the GX200
21 engine." (Strauss Decl. Ex. 13, at 251.) Also, a press release from a Lifan customer and engine
22 dealer said: "all of the Lifan engine parts are interchangeable with its Japanese cousin, Honda."
23 (Strauss Decl. Ex. 14, at 258.) It is not fatal that American Honda has only identified two instances
24 of actual confusion because "actual confusion is hard to prove; difficulties in gathering evidence
25 of actual confusion make its absence generally unnoteworthy." *Brookfield Commc'ns Inc. v. W.*
26 *Coast Entm't Corp.*, 174 F.3d 1036, 1050 (9th Cir.1999). Also, it bears mentioning, that the above
27 statements do not constitute hearsay. See *Blair Foods, Inc. v. Ranchers Cotton Oil*, 610 F.2d 665,
667 (9th Cir. 1980) (stating that hearsay evidence may not be considered on summary judgment).
While Lifan does not raise an evidentiary objection to this evidence, Jiangdong does with respect
to similar evidence presented in support of American Honda's summary judgment motion. This
evidence is not being offered for the truth of the matter asserted - i.e., that Lifan and American
Honda actually have a contractual relationship. Rather, it is being offered to show what the
customers mistakenly believed to be true.

28 ¹⁹ The retail price of Lifan's engines exceeds \$200, and the retail price of American
Honda's GX engines exceeds \$500. (Wang Decl. ¶ 10; Yuan Decl. ¶ 12.)

1 Jiangdong and Homier argue that American Honda's state trade dress infringement claims
2 fail to the extent that American Honda's federal claim fails. *Acad. of Motion Picture Arts & Scis.*
3 *v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1457 (9th Cir. 1991) (stating that an action
4 for unfair competition under California law is "substantially congruent to a trademark infringement
5 claim under the Lanham Act") (quotation omitted)). Because the Court has found that a genuine
6 issue of material fact exists regarding American Honda's trade dress infringement claim under
7 federal law, American Honda may also assert this claim under state law. However, consistent with
8 the Court's finding that the GX engine generator trade dress has not acquired secondary meaning,
9 American Honda may only pursue its state law claims with regard to the GX engine trade dress.

10 Summary judgment on American Honda's state trade dress infringement claims is therefore
11 GRANTED as to the GX engine generator trade dress, and DENIED as to the GX engine trade
12 dress.

13 C. American Honda's Federal Trade Dress Dilution Claim

14 American Honda's trade dress dilution claim is challenged on two separate grounds.
15 Jiangdong and Homier argue that the claim should be dismissed because American Honda lacks
16 standing to assert the claim. Lifan argues that the claim should be dismissed because American
17 Honda is required to present evidence of actual dilution, and American Honda has failed to do so.

18 1. American Honda Lacks Standing.

19 Different standing requirements apply under 15 U.S.C. § 1125(a), which creates a cause
20 of action for trade dress infringement, and 15 U.S.C. § 1125(c), which creates a cause of action
21 for trade dress dilution. The former confers standing on "any person who believes that he or she
22 is or is likely to be damaged" by the infringing act. The latter confers standing on the "owner" of
23 the trade dress in question. Jiangdong and Homier argue that American Honda lacks standing to
24 bring its trade dress dilution claim because, as an exclusive licensee of Honda's intellectual
25 property rights, it is not the owner of the GX engine trade dress.

26 In *STX, Inc. v. Bauer USA, Inc.*, No. C 96-1140, 1997 WL 337578, at *4 (N.D. Cal. June 5,
27 1997), the court was faced with the following question of first impression: "whether an exclusive
28 licensee, rather than an 'owner,' would have standing to pursue a claim under 15 U.S.C. §

1 1125(c)(1)." The court reasoned that if Congress had wanted to give non-owners the right to bring
2 trade dress dilution claims under § 1125(c), it would have said so. *Id.* Accordingly, the court held
3 that "plaintiff, as the exclusive licensee but not the owner of the marks at issue in this case, lacks
4 standing to pursue a claim under 15 U.S.C. § 1125(c)." *Id.*; see also *Love v. Mail on Sunday*, No.
5 CV 05-7798, 2006 WL 4046180, at *14 (C.D. Cal. Aug. 15, 2006) ("Plaintiff lacks standing to bring
6 a claim for trademark dilution because he is only an exclusive licensee of the mark, and not the
7 owner of the mark.").

8 American Honda argues that the holding in *STX* was dependent on a fact-specific review
9 of the licensing agreement in question. In *STX*, the licensing agreement provided that the licensor
10 retained the right to determine whether to take any action against infringement of its marks. *STX*,
11 1997 WL 337578, at *3. Accordingly, American Honda argues that, where an exclusive licensee's
12 ability to enforce the mark is not restricted by the licensor, the licensee should be deemed to have
13 an interest akin to an ownership interest, thereby conferring standing under § 1125(c). (AH Opp'n
14 to J&H 19.) There is some support for this position in the case law of other circuits. In *World*
15 *Championship Wrestling v. Titan Sports, Inc.*, 46 F. Supp. 2d 118, 122 (D. Conn. 1999), the court
16 held that the holding in *STX* "was based on a fact-specific review of the licensing agreement," and
17 that if a plaintiff "can show that its licensing agreement . . . provides greater ownership rights in
18 their marks than the one at issue in *STX*, plaintiff may have standing to assert [its] claim."
19 Similarly, in *Bliss Clearing Niagra, Inc. v. Midwest Brake Bond Co.*, 339 F. Supp. 2d 944, 960
20 (W.D. Mich. 2004), the court held that "a licensee will have standing where the agreement
21 transfers to the licensee all of the licensor's rights in the use of the trademark, or where the
22 agreement grants the licensee exclusive use of the mark without restricting the licensee's ability
23 to enforce the mark." (citations omitted).

24 Assuming, without deciding, that the holding in *STX* requires a fact-specific review of the
25 licensing agreement in question, the Court finds that the licensing agreement between American
26 Honda and Honda *does* restrict American Honda's ability to enforce Honda's trademark rights,
27 thereby defeating standing. Under the agreement, American Honda has "the right, *subject to the*
28 *prior approval of [Honda]*, to institute and maintain any legal action in any court in the United

1 States or the individual States thereof to prevent infringement of any Licensed Trademark or unfair
2 competition arising out of any improper use of same and to obtain damages on account of such
3 infringement or unfair competition." (Conner Decl. Supp. AH Opp'ns ¶ 4 (emphasis added).) This
4 provision is akin to the provision of the licensing agreement in *STX* that preserved in the owner
5 the right to determine whether to take action against infringement of its marks. Furthermore, it
6 should be noted that American Honda's licensing agreement restricts its use of Honda's marks to
7 within the United States, a factor that the *Bliss* court held weighs against a finding of standing. 339
8 F. Supp. 2d at 959-61 (finding standing where the licensing agreement gave plaintiff exclusive
9 right to use the mark "throughout the world" because there was no geographical restriction on the
10 licensee's use of the mark). For the above reasons, American Honda does not have standing to
11 bring its federal trade dress dilution claim. Summary judgment on this issue is GRANTED.

12 Because American Honda does not have standing, the Court need not address Lifan's
13 argument that American Honda has failed to show evidence of actual dilution.

14 D. American Honda's State Trade Dress Dilution Claims

15 The same two arguments are made regarding American Honda's state trade dress dilution
16 claims, namely that American Honda lacks standing, and that American Honda is required to prove
17 actual dilution and has failed to do so.

18 1. American Honda Has Standing.

19 Unlike 15 U.S.C. § 1125(c), California's anti-dilution statute contains no language restricting
20 standing to the "owner" of a mark. See Cal. Bus. & Prof. Code § 14330. The lone case cited by
21 Jiangdong and Homier does not support a contrary finding. In *Panavision Int'l, L.P. v. Toeppen*,
22 141 F.3d 1316, 1324 (9th Cir. 1998), the Ninth Circuit held that a California state law dilution claim
23 "is subject to the same analysis" as a federal dilution claim. That holding, however, was limited to
24 the substantive requirements of a dilution claim, not the standing requirements. Under the terms
25 of California's anti-dilution statute, standing in this case is proper. Common law standing
26 requirements also do not require proof of ownership. *Angelucci v. Century Supper Club*, 158 P.3d
27 718, 726-27 (Cal. 2007) ("In general terms, in order to have standing, the plaintiff must be able
28

1 to allege injury – that is, some 'invasion of the plaintiff's legally protected interests.')" (citation
2 omitted).

3 2. California Law Requires a Finding of Likelihood of Dilution.

4 Lifan argues that, under California law, American Honda is required to demonstrate actual
5 dilution. Lifan is incorrect. The language of the California statute is clear that "likelihood of . . .
6 dilution" is the standard. Cal. Bus. & Prof. Code § 14330. Lifan incorrectly cites *Jada Toys, Inc.*
7 *v. Mattel, Inc.*, 496 F.3d 974 (9th Cir. 2007), in support of its position. (Lifan Mot. 19.) *Jada Toys*
8 confirms that the correct standard under California law is likelihood of dilution. *Id.* at 982 n.6. In
9 its Reply, Lifan does not dispute that the likelihood of dilution standard is the correct standard.
10 Furthermore, in neither its Motion nor its Reply does Lifan argue that American Honda is unable
11 to meet this standard. Accordingly summary judgment on American Honda's state law claims for
12 trade dress dilution is DENIED.²⁰

13 E. Jiangdong and Lifan's Federal Counterclaims

14 1. American Honda Timely Raised the *Noerr-Pennington* Defense.

15 American Honda invokes the *Noerr-Pennington* doctrine, discussed below, as a defense
16 to Jiangdong and Lifan's counterclaims. Jiangdong and Lifan argue that American Honda failed
17 to plead *Noerr-Pennington* immunity as an affirmative defense and thus waived it. They are
18 mistaken. American Honda specifically asserts the following affirmative defense: "American
19 Honda's rights in the trade dress of its GX series engines, generators and products incorporating
20 GX series engines are protected by trademark law and *may be asserted by American Honda*
21 *judicially and otherwise.*" (See, e.g., AH Answer to Countercl. of Lifan Industry (Group) Co., Ltd.
22 ¶ 210 (emphasis added).) As defined in the following subsection, the *Noerr-Pennington* defense
23 is clearly contemplated by this language, thereby noticing Jiangdong and Lifan of American
24 Honda's intent to rely on the defense.

25
26 ²⁰ For the first time, in its Reply, Lifan argues that American Honda "cannot make the
27 required showing that its trade dress is famous to the general public." (Lifan Reply 4.) This
28 argument is not timely, and is therefore waived. *Bazuaye v. INS*, 79 F.3d 118, 120 (9th Cir. 1996)
("Issues raised for the first time in the reply brief are waived.").

1 Even were the Court to find that American Honda failed to "plead [its] affirmative defense
2 with enough specificity or factual particularity to give [Defendants] 'fair notice,'" *Smith v. Wal-Mart*
3 *Stores*, No. C 06-2069, 2006 WL 2711468, at *8 (N.D. Cal. Sept. 20, 2006), the defense is not
4 waived because neither Jiangdong nor Lifan have made any showing that they would suffer
5 prejudice. See *Ledo Fin. Corp. v. Summers*, 122 F.3d 825, 827 (9th Cir. 1997) ("[A]bsent prejudice
6 to the plaintiff an affirmative defense may be plead for the first time in a motion for summary
7 judgment.").

8 2. The Noerr Pennington Doctrine Covers American Honda's Bulletin.

9 Under the *Noerr-Pennington* doctrine, those who petition the courts for redress are
10 generally immune from liability for their petitioning conduct. See *Sosa v. DIRECTV, Inc.*, 437 F.3d
11 923, 929 (9th Cir. 2006). The doctrine encompasses "not only petitions sent directly to the court
12 in the course of litigation, but also 'conduct incidental to the prosecution of the suit,'" including
13 "communications between private parties." *Id.* at 934-35. Jiangdong and Lifan argue that the
14 Bulletin American Honda transmitted to all U.S. Honda power equipment dealers following the
15 commencement of suit does not fall within the ambit of the doctrine.²¹ This is incorrect.

16 *Noerr-Pennington* has been held to apply to a wide range of litigation-related
17 communications and enforcement efforts, including communications to customers of the parties.
18 See, e.g., *Sosa*, 437 F.3d at 925-26, 938 (extending immunity to sender of over 100,000 demand
19 letters threatening legal action); *Coastal Sales Mktg., Inc. v. Hunt*, 694 F.2d 1358, 1367-69 (5th
20 Cir. 1983) (extending immunity to press releases, publications of warning notices in newspapers,
21 and communications with potential customers); *Matsushita Elecs. Corp. v. Loral Corp.*, 974 F.
22 Supp. 345, 359 (S.D.N.Y. 1997) (extending immunity to infringement warning letters sent to
23 defendants' customers); *Aircapital Cablevision, Inc. v. Starlink Commc'ns Group*, 634 F. Supp.
24 316, 325-26 (D. Kan. 1986) (extending immunity to press releases publicizing the lawsuit and

25
26 ²¹ Lifan also argues that a single cease-and-desist letter sent by American Honda to one
27 of Lifan's customers § the Water Cannon letter § does not come under the *Noerr-Pennington*
28 doctrine. (Lifan Opp'n 3.) Because the analysis applicable to the Bulletin is substantially the same
in the case of the individual letter, the Court does not analyze the letter independently. To the
extent that the Bulletin is immunized, the letter is as well.

1 threatening further action). Furthermore, courts have applied the doctrine even when recipients
2 of such communications are potentially innocent, *Sosa*, 437 F.3d at 927, and even when the
3 communications contain allegedly "false and misleading statements about [a party's] claims."
4 *Avery Dennison Corp. v. Acco Brands, Inc.*, No. CV 99-1877, 2000 WL 986995, at *6, *23 (C.D.
5 Cal. Feb. 22, 2000). The American Honda Bulletin falls squarely within this well-settled precedent.

6 First, the Bulletin was transmitted in furtherance of the instant litigation, even though it was
7 not sent to a party to the lawsuit. The Bulletin states that a number of manufacturers "are copying
8 the distinctive trade dress of HONDA engines and generators," and that American Honda, in
9 response, has "initiated legal action against two of the biggest manufacturers of such knock-off
10 engines and generators, Lifan and Jiangdong, as well as a variety of their outlets" (Strauss
11 Decl. Ex. 4, at 18.) Additionally, the Bulletin specifically requests the assistance of the recipient
12 equipment dealers by asking them to gather and send to American Honda relevant information
13 about infringing engines and generators mistakenly brought in for Honda warranty service.
14 (Strauss Decl. Ex. 4, at 19-20.)

15 Second, the Bulletin served as an enforcement communication in its own right, despite the
16 fact that many of the recipients may be innocent and that American Honda's position may later be
17 discredited at trial. As the Bulletin states:

18 Please also be advised that, if American Honda becomes aware that you are
19 offering for sale or selling such products, we will have no choice but to refer the
20 matter to our outside legal counsel for appropriate follow up. While we have no
21 desire to engage our dealers in expensive and time-consuming legal action, the
22 seriousness of this matter does require our utmost vigilance.

23 (Strauss Decl. Ex. 4, at 19.) This language is akin to the language of a typical cease-and-desist
24 letter, which, as the above cited cases make clear, qualifies for *Noerr-Pennington* protection.

25 Jiangdong and Lifan have not cited any authority that would compel a contrary conclusion.
26 Subject to the "sham" litigation exception discussed below, the *Noerr-Pennington* doctrine is
27 applicable to the Bulletin sent by American Honda.

28 3. American Honda's Suit Does Not Fall Within the Sham Litigation Exception.

1 There is one key exception to the *Noerr-Pennington* doctrine – the so-called "sham
2 litigation" exception. See *Profl Real Estate Investors, Inc. v. Columbia Pictures Indus., Inc.*, 508
3 U.S. 49, 62 (1993). Where a lawsuit is "objectively baseless in the sense that no reasonable
4 litigant could realistically expect success on the merits," then the court may inquire into litigant's
5 subjective motivation to determine "whether the baseless lawsuit conceals 'an attempt to interfere
6 directly' with the business relationships of a competitor" *Id.* at 60-61 (citation omitted).

7 Jiangdong and Lifan argue that American Honda's lawsuit is objectively baseless. Because
8 the Court has ruled that genuine issues of material fact exist regarding American Honda's trade
9 dress infringement and trade dress dilution claims, American Honda has "some chance of
10 winning." *Id.* at 65;²² cf. *White v. Lee*, 227 F.3d 1214, 1232 (9th Cir. 2000) ("A winning lawsuit is
11 by definition a reasonable effort at petitioning for redress and therefore not a sham."). The sham
12 litigation exception therefore does not apply.

13 Summary judgment is GRANTED in favor of American Honda as to Jiangdong and Lifan's
14 federal counterclaims.

15 F. Jiangdong and Lifan's State Counterclaims

16 1. Noerr-Pennington Applies to Jiangdong and Lifan's State Law Tort Claims.

17 American Honda seeks extension of the *Noerr-Pennington* doctrine to the various state law
18 tort claims asserted by Jiangdong and Lifan. The Court finds that such extension is warranted.

19 "While the *Noerr-Pennington* doctrine originally arose in the antitrust context, it is based on
20 and implements the First Amendment right to petition and therefore . . . applies equally in all
21 contexts." *White*, 227 F.3d at 1231; see also *Sosa*, 437 F.3d at 931 ("[W]e conclude that the
22 *Noerr-Pennington* doctrine stands for a generic rule of statutory construction, applicable to any
23 statutory interpretation that could implicate the rights protected by the Petition Clause.") As the
24

25 ²² Even if the Court had ruled against American Honda on summary judgment, the Court
26 would still conclude that the lawsuit is not "objectively baseless" as there is no evidence to suggest
27 that American Honda brought the case other than as a good faith effort to enforce what it believes
28 to be its legally protectable trade dress rights. See *White v. Lee*, 227 F.3d 1214, 1232 (9th Cir.
2000) ("The fact that a litigant loses his case does not show that his lawsuit was objectively
baseless for purposes of *Noerr-Pennington* immunity.").

1 Ninth Circuit noted in *Sosa*, "[o]ther circuits have similarly used *Noerr-Pennington* principles to
2 guide their interpretation of statutes, . . . as well as their application of common law doctrines." 437
3 F.3d at 932 n.6. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 208 F.3d 885,
4 889 (10th Cir. 2000) ("[W]e do not question the application of the right to petition outside of
5 antitrust . . ."); *We, Inc. v. City of Philadelphia*, 174 F.3d 322, 326-27 (3d Cir.1999) ("This court,
6 along with other courts, has by analogy extended the *Noerr-Pennington* doctrine to offer protection
7 to citizens' petitioning activities in contexts outside the antitrust area . . ."); *Video Int'l Prod., Inc.*
8 *v. Warner-Amex Cable Commc'ns, Inc.*, 858 F.2d 1075, 1084 (5th Cir. 1988) ("There is simply no
9 reason that a common-law tort doctrine can any more permissibly abridge or chill the constitutional
10 right of petition than can a statutory claim such as antitrust.").

11 Based on the above precedent, and the record of the case now at bar, the Court sees "no
12 persuasive reason why [Jiangdong and Lifan's] state tort claims, based on the same petitioning
13 activity as [their] federal claims, would not be barred by the *Noerr-Pennington* doctrine." *Cheminor*
14 *Drugs, Ltd. v. Ethyl Corp.*, 168 F.3d 119, 128 (3d Cir.1999). Accordingly, American Honda's
15 motions for summary judgment as to Jiangdong and Lifan's state law tort claims are GRANTED.

16 III. RULING

17 For the foregoing reasons, the Court concludes: Defendants' respective motions for
18 summary judgment on American Honda's federal and state trade dress infringement claims are
19 GRANTED as to the GX engine generator trade dress and DENIED as to the GX engine trade
20 dress; Defendants' respective motions for summary judgment on American Honda's federal and
21 state trade dress dilution claims are GRANTED as to American Honda's federal claim and
22 DENIED as to American Honda's state claims; and American Honda's motions for summary
23 judgment and partial summary judgment are GRANTED in their entirety.

24 IT IS SO ORDERED.

25 November 13, 2007

27 /S/

28 S. JAMES OTERO
UNITED STATES DISTRICT JUDGE

EXHIBIT D
Filed Under Seal

EXHIBIT E

[54] INTERNAL COMBUSTION ENGINE

[75] Inventor: Tetsuo Nakamura, Saitama, Japan

[73] Assignee: Honda Giken Kogyo Kabushiki
Kaisha, Tokyo, Japan

[**] Term: 14 Years

[21] Appl. No.: 478,941

[22] Filed: Mar. 25, 1983

[30] Foreign Application Priority Data

Oct. 20, 1982 [JP] Japan 57-47691

[52] U.S. Cl. D15/1

[58] Field of Search D15/1; 123/56 B, 56 BC,
123/56 BA, 41.66, 41.67, 41.7, 195 G, 195 B,
195 R, 198 E

[56] References Cited

U.S. PATENT DOCUMENTS

D. 247,177 2/1978 Stevens D15/1
D. 257,844 1/1981 Stevens D15/1
D. 276,160 10/1984 Tuggle et al. D15/1

OTHER PUBLICATIONS

Implement & Tractor, 2-21-79, p. 37, Kawasaki En-
gine.

Implement & Tractor, 3-21-79, p. 11, Kawasaki En-
gine.

Primary Examiner—Wallace R. Burke

Assistant Examiner—Lynn Wilder

Attorney, Agent, or Firm—Sughrue, Mion, Zimm,

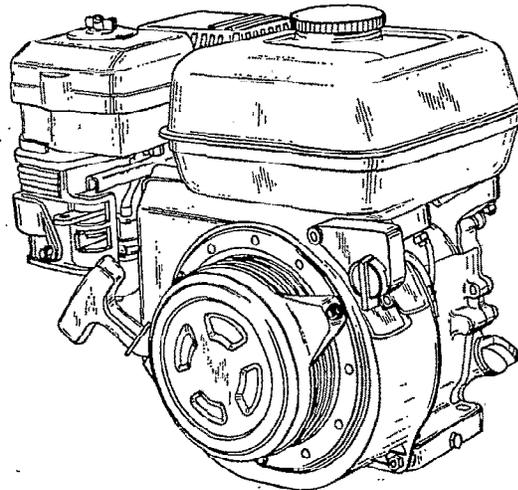
Macpeak & Seas

[57] CLAIM

The ornamental design for an internal combustion en-
gine, as shown.

DESCRIPTION

FIG. 1 is a front, top and left side perspective view of an
internal combustion engine showing my new design;
FIG. 2 is a left side elevational view thereof;
FIG. 3 is a front elevational view thereof;
FIG. 4 is a rear elevational view thereof;
FIG. 5 is a top plan view thereof;
FIG. 6 is a right side elevational view thereof; and
FIG. 7 is a bottom plan view thereof.



Hoag
EXHIBIT NO. 526
8-23-07
Karla Baez

FIG. 1

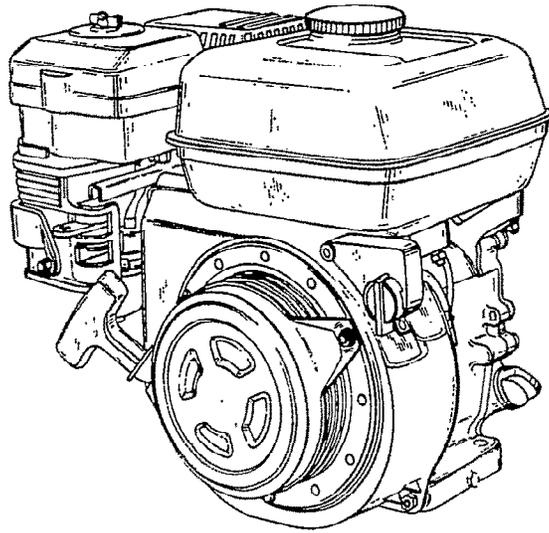


FIG. 2

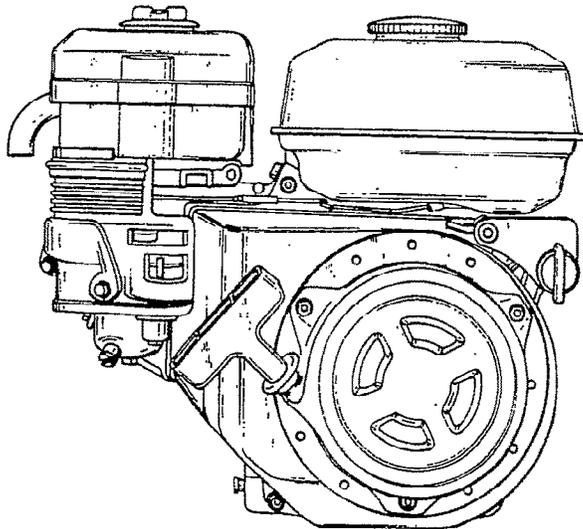


FIG. 3

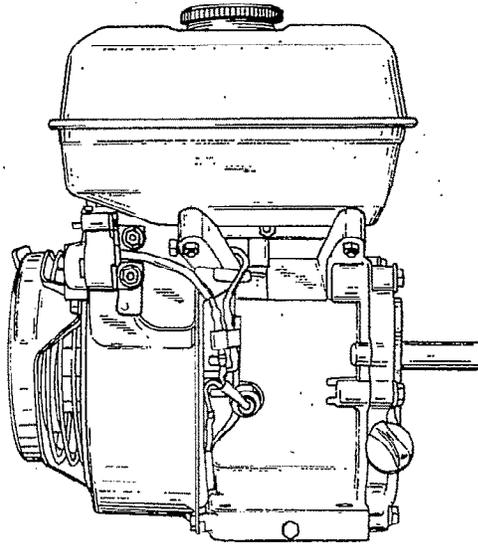


FIG. 4

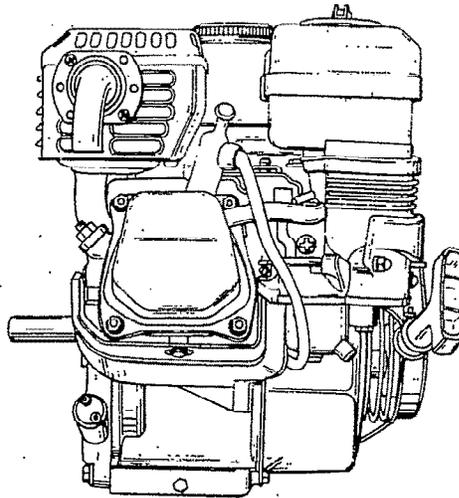


FIG. 5

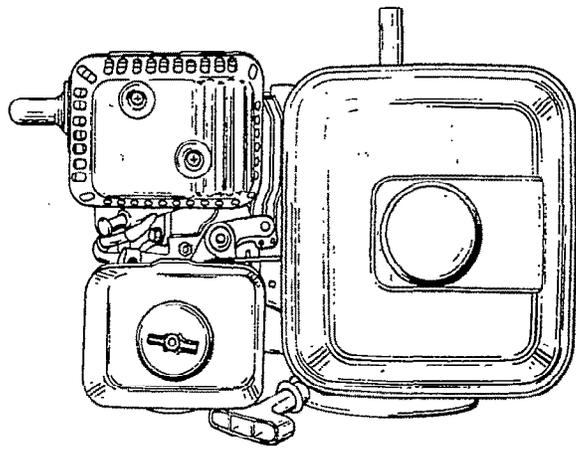


FIG. 6

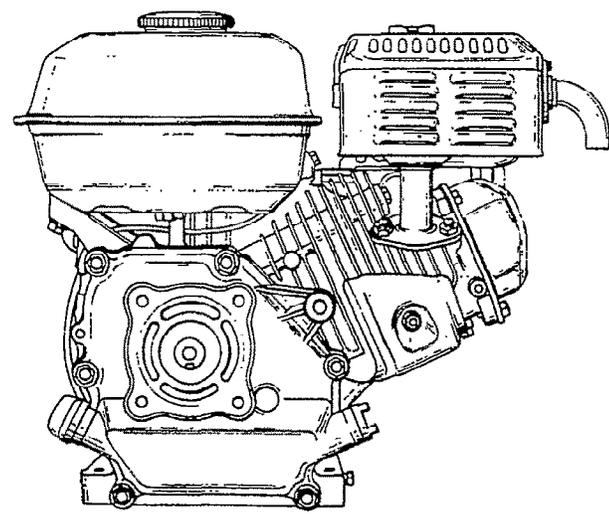


FIG. 7

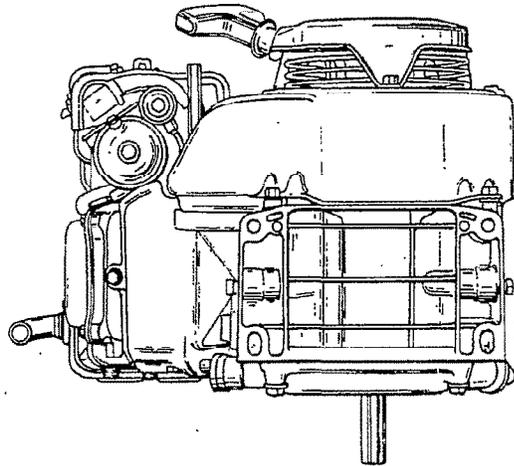


EXHIBIT F
Filed Under Seal

EXHIBIT G
Filed Under Seal

EXHIBIT H
Filed Under Seal

EXHIBIT I

To: Honda Giken Kogyo Kabushiki Kaisha (Hond ETC. (michael.bevilacqua@wilmerhale.com)
Subject: U.S. TRADEMARK APPLICATION NO. 78924545 - 103.443.241
Sent: 2/5/2010 1:40:03 PM
Sent As: ECOM109@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/924545

MARK:

78924545

CORRESPONDENT ADDRESS:

MICHAEL J. BEVILACQUA, ESQUIRE
WILMER CUTLER PICKERING HALE AND
DORR LL
60 STATE ST
BOSTON, MA 02109-1800

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Honda Giken Kogyo Kabushiki
Kaisha (Hond ETC.)

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

103.443.241

CORRESPONDENT E-MAIL ADDRESS:

michael.bevilacqua@wilmerhale.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 2/5/2010

The referenced application has been withdrawn from publication and remanded to the examining attorney because the Commissioner's Office has determined the following.

Registration was refused because the applied-for mark, which consists of a three-dimensional configuration of the goods, appears to be a functional design for such goods. Trademark Act Section 2(e)(5), 15 U.S.C. §1052(e)(5); *see* TMEP §1202.02(a)-(a)(ii). The Office has considered the applicant's arguments carefully but has found them unpersuasive. Accordingly, the refusal is hereby reinstated.

A feature is functional if it is “essential to the use or purpose of the [product]” or “it affects the cost or quality of the [product].” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); TMEP §1202.02(a)(iii)(A).

A mark that consists of a three-dimensional configuration of a product or its packaging is functional, and thus unregistrable, when the evidence shows that the design provides identifiable utilitarian advantages to the user; i.e., the product or container “has a particular shape because it works better in [that] shape.” *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002) (internal punctuation and citation omitted); see TMEP §1202.02(a)(iii)(A).

The Office must establish a prima facie case that the three-dimensional configuration mark sought to be registered is functional. The burden then shifts to the applicant to present sufficient evidence to rebut the prima facie case. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993); TMEP §1202.02(a)(iv).

A determination of functionality is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); TMEP §1202.02(a)(iv).

The evidence need not establish that the configuration at issue is the very best design for the particular product or product packaging. A configuration can be held functional when the evidence shows that it provides a specific utilitarian advantage that makes it one of a few superior designs available. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (holding shape of a loudspeaker system enclosure functional because it conforms to the shape of the sound matrix and is thereby an efficient and superior design); *In re Am. Nat’l Can Co.*, 41 USPQ2d 1841 (TTAB 1997) (holding metal beverage containers with vertical fluting functional because vertical fluting is one of a limited number of ways to strengthen can sidewalls and it allows for an easier way to grip and hold the can); TMEP §1202.02(a)(v), (a)(v)(C).

In this case, the evidence suggests that the configuration of engine components shown in the mark may enable the applicant’s engines to fit into a more compact space and to have a lower center of gravity. Further, the configurations enables the fuel tank and the muffler to have large capacities, and to be safely positioned very close to each other, such a large capacity muffler being better able to reduce engine exhaust noise. Because the muffler is not located under the fuel tank, that empty space can be easily accessed or used, and the lower portion of the fuel tank can be made larger, thereby allowing an increased overall capacity of the fuel tank. Moreover, the fuel tank and muffler can be simplified in their shapes, resulting in increased flexibility in designing these components.

The evidence consists of the applicant’s utility patents (Nos. 6331740, 6362533 and 6489690) for engines which are similar – although admittedly not identical – in configuration. The applicant is directed to the evidence located in the TDR database under the heading “Outgoing” dated 7/29/2008, at pages 116 to 177.

A utility patent claiming the design features at issue is strong evidence of functionality. The party seeking trademark protection for a three-dimensional configuration mark then bears the burden of establishing that the features are not functional, such as by providing evidence that they are merely ornamental, incidental, or arbitrary aspects of the product or packaging. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001); see TMEP §1202.02(a)(iv), (a)(v)(A).

In sum, the applicant may not register a trademark for the entire engine design in this particular configuration, which contains several functional elements.

In its response, the applicant has included a design patent for a similar engine design. A configuration of a product or product packaging that has been the subject of a design patent is evidence of nonfunctionality; but this can be outweighed by other evidence of functionality. TMEP §1202.02(a)(v)(A); *see In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841, 1843 (TTAB 1997).

However, where the evidence shows that the specific product or container configuration at issue provides no real utilitarian advantages to the user, but is one of many equally feasible, efficient and competitive designs, then it may be registrable. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982). But a product configuration cannot be registered on the Principal Register without a showing of acquired distinctiveness. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); TMEP §1202.02(b)-(b)(i).

The applicant has provided a showing of acquired distinctiveness, and portions of the mark appear to be capable of registration. However, the applicant needs to limit what it is claiming as its mark to those elements which are capable of acquired distinctiveness.

The evidence provided by the applicant points 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. If the applicant limits its claimed mark to these elements, the mark may be registrable.

Description and Drawing

The applicant must submit a new description of the mark. The following language is suggested:

“The mark consists of the configuration of an engine with an overall cubic design, with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located above the fan cover on the left. The air cleaner cover features a cube shape with beveled outside edges, non-beveled inside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and aligned with the extruded part of the fuel tank. The carburetor cover features four ribs along its outside edge and a receded area where control levers are located. The fuel tank is roughly square, with a shape that mirrors the angles on the air cleaner cover and the radii on the upper left corner of the fan cover. The engine features a beveling that runs throughout its entire circumference. The relative positioning and orientation of the air cleaner cover, muffler heat shield and fuel tank, are such that the straight edges face each other and the center of the engine, while the beveled edges are on the exterior. The broken lining in the drawing is not part of the mark and serves only to indicate position.”

The applicant is advised that it must also amend its drawing to show the purely functional portions of the design, such as levers, bolts, nuts and caps in broken lines, or if that is not practical, disclaim those items.

/James A. Rauen/

Trademark Examining Attorney
Law Office 109
571-272-9211

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

EXHIBIT J

shall not be construed as a waiver by Applicant of all, or any part, of any objection to the Request.

3. The following general objections are incorporated into each answer as though set forth in full regardless of whether Applicant also states a specific objection to an individual request. A specific answer may repeat a general objection for emphasis or for some other reason. Failure to include a general objection in any specific answer shall not be interpreted as a waiver of any general objection to that answer.

GENERAL OBJECTIONS

1. Applicant objects to the Requests for Production of Documents to the extent they seek documents that contain confidential or private business information, including information pertaining to trade secrets, business decisions, and/or other competitively sensitive information.

2. Applicant objects to the Requests for Production of Documents to the extent they seek documents and things that are not within its possession, custody or control and/or are a matter of public record, are within the files and/or particular knowledge of Opposer, its counsel, or agents, or are otherwise equally available to Opposer.

3. Applicant objects to the Requests for Production of Documents to the extent they seek documents protected by attorney/client privilege, the attorney work-product doctrine, or any other applicable privilege.

4. Applicant objects to the Requests for Production of Documents to the extent they are overly broad, unduly burdensome, oppressive, request irrelevant information, and/or are not reasonably calculated to lead to the discovery of admissible evidence.

5. Applicant objects to the Requests for Production of Documents to the extent they are unreasonably broad or burdensome by not providing a time limit as to the scope of the Request.

6. Applicant objects to the Requests for Production of Documents to the extent they are unreasonably broad or burdensome by not providing a geographic scope for the Request.

7. Applicant objects to the Requests for Production of Documents to the extent they contain words or phrases that lack an apparent meaning or have an uncertain meaning.

8. Applicant objects to the Request for Production of Documents to the extent they impose obligations beyond those set forth in the Federal Rules of Civil Procedure and/or the Trademark Trial and Appeal Board Manual of Procedure.

Subject to the forgoing qualifications, General Objections and the specific objections made below, Applicant answers Opposer's First Request for Production of Documents as follows:

DOCUMENT REQUESTS

REQUEST FOR PRODUCTION NO. 1.

All documents that support YOUR contention that the ENGINE CONFIGURATION is a distinctive, nonfunctional configuration associated with APPLICANT by consumers.

RESPONSE TO REQUEST FOR PRODUCTION NO. 1

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, 4, 5, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that

fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, as the Requests asks for “all” documents and does not limit the documents requested by providing a geographic or time scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 2.

All documents that discuss whether the ENGINE CONFIGURATION is associated with APPLICANT by consumers.

RESPONSE TO REQUEST FOR PRODUCTION NO. 2

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, 4, 5, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, as the Requests asks for “all” documents and does not limit the documents requested by providing a geographic or time scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 3.

All documents, including all communications between the signators and APPLICANT or its attorneys, regarding the Distributor Statements filed by APPLICANT in response to the Office Action mailed December 8, 2006.

RESPONSE TO REQUEST FOR PRODUCTION NO. 3

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 4.

All documents relating to any legal proceedings wherein APPLICANT attempted to enforce the ENGINE CONFIGURATION as a trademark or trade dress against third parties anywhere in the world, or where any third party challenged the validity of the ENGINE CONFIGURATION as a trademark or trade dress, including but not limited to all pleadings, depositions, expert reports, written discovery requests and responses, document productions and settlement agreements therein.

RESPONSE TO REQUEST FOR PRODUCTION NO. 4

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 3, 4, 5, and 6. In particular, Applicant objects to this Document Request to the extent that it

requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Applicant also objects to this Request because it seeks documents that are a matter of public record or are otherwise equally available to Opposer. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, as the Request asks for “all” documents and for those related to “proceedings anywhere in the world” and does not limit the documents requested by providing a time scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 5.

All trademark office communications and decisions from anywhere in the world discussing the alleged inherent distinctiveness or acquired distinctiveness of the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 5

Applicant incorporates all of its General Objections and specifically, General Objections 4 and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because it requests trademark office communications and decisions from “anywhere in the world.” Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 6.

All court opinions, decisions, orders, and judgments from anywhere in the world discussing the alleged inherent distinctiveness or acquired distinctiveness of the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 6

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4 and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because it requests court opinions, decisions, orders, and judgments from “anywhere in the world.” Applicant also objects to this Request because it seeks documents that are not within its custody or control and/or are a matter of public record or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 7.

All documents regarding any consumer research, surveys or focus groups relating to whether the ENGINE CONFIGURATION is associated with APPLICANT by consumers.

RESPONSE TO REQUEST FOR PRODUCTION NO. 7

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 4 and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant

objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because it is not limited by geographic scope. Applicant also objects to this Request because it seeks documents that are not within its custody or control or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 8.

All documents regarding any consumer research, surveys or focus groups relating to whether any design element of APPLICANT'S GX engines, other than the ENGINE CONFIGURATION, is associated with APPLICANT by consumers, such as any color used on the engine.

RESPONSE TO REQUEST FOR PRODUCTION NO. 8

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 4 and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information and because it does not limit the documents requested by providing a geographic scope. Applicant also objects to this Request because it seeks documents that are not within its custody or control or are otherwise equally available to Opposer. Applicant further objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, because it requests documents relating to whether any design

element of APPLICANT'S GX engines is associated with Applicant by consumers, and elements other than the ENGINE CONFIGURATION are irrelevant to this proceeding.

REQUEST FOR PRODUCTION NO. 9.

Copies of all "Look For" advertising materials YOU have used in connection with APPLICANT'S GX engines.

RESPONSE TO REQUEST FOR PRODUCTION NO. 9

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4 and 6. Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because it does not limit the documents requested by providing a geographic scope. Applicant also objects to this Request because it seeks documents that are not within its custody or control and/or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: There are no such documents.

REQUEST FOR PRODUCTION NO. 10.

Copies of all "Look For" advertising materials YOU have used in connection with any products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4 and 6. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and does not limit the documents requested by providing a geographic scope. Applicant also objects

to this Request because it seeks documents that are not within its custody or control and/or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: There are no such documents.

REQUEST FOR PRODUCTION NO. 11.

Copies of all advertising, marketing, and promotional materials related to the sale of any product containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 11

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4, 5, and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, as the Requests asks for “all” documents and does not limit the documents requested by providing a geographic or time scope. Applicant also objects to this Request because it seeks documents that are not within its custody or control and/or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide representative, non-privileged and otherwise non-objectionable documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 12.

Documents sufficient to show YOUR annual sales revenues for all products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 12

Applicant incorporates all of its General Objections and specifically, General Objections 1, 4, 5 and 6. In particular, Applicant objects to this Document Request to the extent that it

requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and does not limit the documents requested by providing a geographic or time scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 13.

Documents sufficient to show YOUR annual marketing and advertising expenditures for all products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 13

Applicant incorporates all of its General Objections and specifically, General Objections 1, 4, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, and requests documents sufficient to show marketing and advertising expenditures without providing a geographic scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 14.

Documents sufficient to describe the type and demographic of YOUR current and prospective customers for all products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 14

Applicant incorporates all of its General Objections and specifically, General Objections 1, 4, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, because the type and demographic of Applicant's customers for products containing the ENGINE CONFIGURATION is irrelevant to whether the mark should be registered. Applicant also objects to this Document Request because it is not limited by geographic scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 15.

Documents sufficient to show YOUR marketing channels for all products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 15

Applicant incorporates all of its General Objections and specifically, General Objections 1, 4, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the

discovery of admissible documents and/or information, because the marketing channels for all products containing the ENGINE CONFIGURATION is irrelevant to whether the mark should be registered. Applicant also objects to this Document Request because it is not limited by geographic scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 16.

All news articles, editorials, reviews, or other press referring or relating to products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 16

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4 and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, in that it seeks “all” news articles, editorials, reviews, or other press referring or relating to products containing the ENGINE CONFIGURATION and does not limit the documents requested by providing a geographic scope. Applicant also objects to this Request because it seeks documents that are not within its custody or control and/or are a matter of public record or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide representative, non-privileged and otherwise non-objectionable documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 17.

Documents sufficient to show the placement of the HONDA trademark on all products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 17

Applicant incorporates all of its General Objections and specifically, General Objections 4 and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome and/or oppressive, is requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information requests irrelevant documents or is not reasonably calculated to lead to the discovery of admissible documents and/or information and does not limit the documents requested by providing a geographic scope. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 18.

All documents regarding any design or utility patents sought or owned by YOU for products containing the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 18

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 3, 4, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, and does not limit the documents requested by providing a geographic scope. Applicant also objects to this Document Request

because it seeks documents that are not within its custody or control and/or are a matter of public record or are otherwise equally available to Opposer. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide representative, non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 19.

Documents sufficient to show the configuration of all products offered for sale by third parties with the same or similar configuration as the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 19

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 3, 4, and 6. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Applicant also objects to this Document Request because it seeks documents that are not within its custody or control and/or are a matter of public record or are otherwise equally available to Opposer. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, as the Request is not limited by providing a geographic scope or to those products of which Applicant is aware. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide documents responsive to this Request sufficient to show the configuration of products offered for sale by third parties with the same or similar configuration as the ENGINE CONFIGURATION of which Applicant is aware.

REQUEST FOR PRODUCTION NO. 20.

All documents that support YOUR contention that the ENGINE CONFIGURATION is arbitrary, ornamental, and does not affect the cost or quality of the engine.

RESPONSE TO REQUEST FOR PRODUCTION NO. 20

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 21.

All documents that support YOUR contention that the overall design of the ENGINE CONFIGURATION has nothing to do with engine performance and is a matter of styling and appearance.

RESPONSE TO REQUEST FOR PRODUCTION NO. 21

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome,

oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 22.

All documents regarding the design, development or advantages of the overall cubic design claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 22

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 23.

All documents regarding the design, development or advantages of the slanted fan cover claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 23

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 24.

All documents regarding the design, development or advantages of the air cleaner housing claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 24

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery

of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 25.

All documents regarding the design, development or advantages of the carburetor cover claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 25

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 26.

All documents regarding the design, development or advantages of the fuel tank claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 26

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests

documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 27.

All documents regarding the design, development or advantages of the beveled edges claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 27

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 28.

All documents regarding the design, development or advantages of the belt-like areas claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 28

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 29.

All documents regarding the design, development or advantages of the rib of the fuel tank claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 29

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections,

Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 30.

All documents regarding the design, development or advantages of the four ribs claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 30

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 31.

All documents regarding the design, development or advantages of the relative positioning and orientation of the air cleaner housing, muffler heat shield, and fuel claimed in the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 31

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests

documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 32.

All documents regarding alternative designs YOU considered in connection with the design and development of the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 32

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information.

REQUEST FOR PRODUCTION NO. 33.

All documents that support your contention that there are alternative horizontal engine designs that provide equal or better quality or performance as horizontal engines with the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 33

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Applicant also objects to this Document Request because it seeks documents that are not within its custody or control and/or are otherwise equally available to Opposer. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 34.

All documents that support your contention that there are alternative horizontal engine designs that can be made at an equal or lesser cost than horizontal engines with the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 34

Applicant incorporates all of its General Objections and specifically, General Objections 1, 2, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it

requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Applicant also objects to this Document Request because it seeks documents that are not within its custody or control and/or are otherwise equally available to Opposer. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 35.

Documents sufficient to show the manufacturing cost of the ENGINE.

RESPONSE TO REQUEST FOR PRODUCTION NO. 35

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 36.

All documents discussing any affect the claimed ENGINE CONFIGURATION has on cost, quality or performance of the engine.

RESPONSE TO REQUEST FOR PRODUCTION NO. 36

Applicant incorporates all of its General Objections and specifically, General Objections 1, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 37.

All documents discussing any stylistic or aesthetic aspects of the claimed ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 37

Applicant incorporates all of its General Objections and specifically, General Objections 1, 4 and 7. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information, in that the document requests “all”

documents discussing “any stylistic or aesthetic” aspects of the claimed ENGINE CONFIGURATION and that phrase “any stylistic or aesthetic” aspects lacks certain meaning. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

REQUEST FOR PRODUCTION NO. 38.

All trademark office communications and decisions from anywhere in the world discussing the functionality of the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 38

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4 and 6. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because the Request is not limited by geographic scope.

REQUEST FOR PRODUCTION NO. 39.

All court opinions, decisions, orders, and judgments from anywhere in the world discussing the functionality of the ENGINE CONFIGURATION.

RESPONSE TO REQUEST FOR PRODUCTION NO. 39

Applicant incorporates all of its General Objections and specifically, General Objections 2, 4, 6, and 7. In particular, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information and because the Request is not limited by geographic scope. Applicant further objects to this

Document Request because it seeks documents that are not within its custody or control and/or or are otherwise equally available to Opposer. Applicant also objects to this Document Request to the extent that it contains words or phrases that have an uncertain meaning, “discussing the functionality of the ENGINE CONFIGURATION.” Without waiving, and subject to, these objections, Applicant responds as follows: There are no such documents.

REQUEST FOR PRODUCTION NO. 40.

All documents, including all communications between the signators and APPLICANT or its attorneys, regarding the two Declarations filed by APPLICANT in response to the Office Action mailed September 2, 2008.

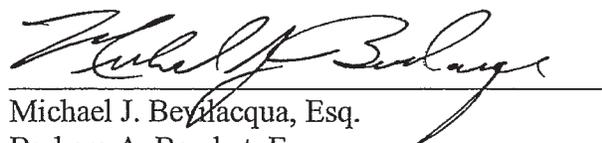
RESPONSE TO REQUEST FOR PRODUCTION NO. 40

Applicant incorporates all of its General Objections and specifically, General Objections 1, 3, and 4. In particular, Applicant objects to this Document Request to the extent that it requests documents that contain confidential or private business information, or documents that fall under the attorney/client privilege or the attorney work product doctrine. Further, Applicant objects to this Document Request to the extent that it is overly broad, unduly burdensome, oppressive, requesting irrelevant documents, and/or those not reasonably calculated to lead to the discovery of admissible documents and/or information. Without waiving, and subject to, these objections, Applicant responds as follows: Applicant will provide non-privileged and otherwise non-objectionable documents responsive to this Request, if any, upon entry of a suitable Protective Order.

HONDA GIKEN KOGYO KABUSHIKI KAISHA

By its attorneys,

December 29, 2011



Michael J. Beylacqua, Esq.

Barbara A. Barakat, Esq.

Wilmer Cutler Pickering Hale and Dorr LLP

60 State Street

Boston, MA 02109-1800

Attorneys for Applicant

HONDA GIKEN KOGYO KABUSHIKI

KAISHA

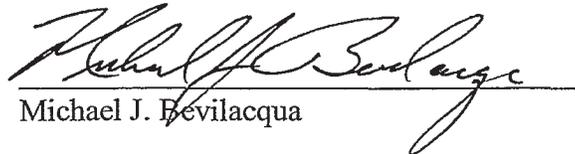
Certificate of Service

I hereby certify that the foregoing APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA'S RESPONSES TO OPPOSER BRIGGS & STRATTON CORPORATION'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS was served on the following counsel of record for Opposer, by depositing same in the U.S. mail, first class postage prepaid, this 29th day of December, 2011:

Robert N. Philips
Reed Smith LLP
101 Second Street
San Francisco, California 94105

And

Nina Habib Borders
Reed Smith LLP
10 S. Wacker Drive, 40th Floor
Chicago, Illinois 6060


Michael J. Bevilacqua

Copy

WILMERHALE

December 29, 2011

Michael J. Bevilacqua

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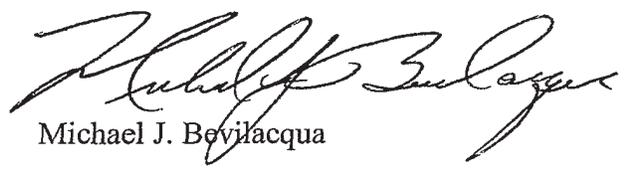
Nina Habib Borders, Esq.
Reed Smith LLP
10 S. Wacker Drive, 40th Floor
Chicago, Illinois 60606

Re: Briggs & Stratton Corporation v. Honda Giken Kogyo Kabushiki Kaisha
Trademark Opposition No. 91/200832

Dear Rob and Nina:

Enclosed are Applicant Honda's responses to Briggs & Stratton's First Set of Requests for Production of Documents for the above-identified proceeding. If there are any questions, do not hesitate to contact us.

Very truly yours,



Michael J. Bevilacqua

Enclosure
cc: Barbara A. Barakat, Esq. (w/o enclosure)

EXHIBIT K
Filed Under Seal

EXHIBIT L
Filed Under Seal

EXHIBIT M
Filed Under Seal

EXHIBIT N
Filed Under Seal

EXHIBIT O

Trademark Snap Shot Amendment & Mail Processing Stylesheet
(Table presents the data on Amendment & Mail Processing Complete)

OVERVIEW

| | | | |
|---------------|----------------|---------------|------------|
| SERIAL NUMBER | 78924545 | FILING DATE | 07/07/2006 |
| REG NUMBER | 0000000 | REG DATE | N/A |
| REGISTER | PRINCIPAL | MARK TYPE | TRADEMARK |
| INTL REG # | N/A | INTL REG DATE | N/A |
| TM ATTORNEY | RAUEN, JAMES A | L.O. ASSIGNED | 109 |

PUB INFORMATION

| | | | |
|----------------------|---|--------------------|-----|
| RUN DATE | 03/10/2009 | | |
| PUB DATE | 03/25/2008 | | |
| STATUS | 661-RESPONSE AFTER NON-FINAL-ACTION-ENTERED | | |
| STATUS DATE | 03/07/2009 | | |
| LITERAL MARK ELEMENT | | | |
| DATE ABANDONED | N/A | DATE CANCELLED | N/A |
| SECTION 2F | YES | SECTION 2F IN PART | NO |
| SECTION 8 | NO | SECTION 8 IN PART | NO |
| SECTION 15 | NO | REPUB 12C | N/A |
| RENEWAL FILED | NO | RENEWAL DATE | N/A |
| DATE AMEND REG | N/A | | |

FILING BASIS

| FILED BASIS | | CURRENT BASIS | | AMENDED BASIS | |
|-------------|-----|---------------|-----|---------------|----|
| 1 (a) | YES | 1 (a) | YES | 1 (a) | NO |
| 1 (b) | NO | 1 (b) | NO | 1 (b) | NO |
| 44D | NO | 44D | NO | 44D | NO |
| 44E | NO | 44E | NO | 44E | NO |
| 66A | NO | 66A | NO | | |
| NO BASIS | NO | NO BASIS | NO | | |

MARK DATA

| | |
|-------------------------|----|
| STANDARD CHARACTER MARK | NO |
| LITERAL MARK ELEMENT | |

| | |
|--------------------|---|
| MARK DRAWING CODE | 2-AN ILLUSTRATION DRAWING WITHOUT ANY WORD(S)/LETTER(S)/NUMBER(S) |
| COLOR DRAWING FLAG | NO |

CURRENT OWNER INFORMATION

| | |
|-------------|--|
| PARTY TYPE | 20-OWNER AT PUBLICATION |
| NAME | Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.) |
| ADDRESS | No. 1-1, 2-Chome, Minamiaoyama Minato-Ku, Tokyo, 107-8556 |
| ENTITY | 03-CORPORATION |
| CITIZENSHIP | Japan |

GOODS AND SERVICES

| | |
|---------------------|--|
| INTERNATIONAL CLASS | 007 |
| DESCRIPTION TEXT | engines for use in construction, maintenance and power equipment |

GOODS AND SERVICES CLASSIFICATION

| | | | | | | | |
|---------------------|-----|----------------|------------|----------------------------|------------|--------------|----------|
| INTERNATIONAL CLASS | 007 | FIRST USE DATE | 10/00/1983 | FIRST USE IN COMMERCE DATE | 12/00/1984 | CLASS STATUS | 6-ACTIVE |
|---------------------|-----|----------------|------------|----------------------------|------------|--------------|----------|

MISCELLANEOUS INFORMATION/STATEMENTS

| | |
|--------------------------|--|
| CHANGE IN REGISTRATION | NO |
| COLORS CLAIMED STATEMENT | Color is not claimed as a feature of the mark. |
| DESCRIPTION OF MARK | The mark consists of the configuration of an engine. The phantom lining shown in the drawing is not part of the mark and serves only to indicate position. |

PROSECUTION HISTORY

| DATE | ENT CD | ENT TYPE | DESCRIPTION | ENT NUM |
|------------|--------|----------|---|---------|
| 03/07/2009 | TEME | I | TEAS/EMAIL CORRESPONDENCE ENTERED | 035 |
| 03/07/2009 | CRFA | I | CORRESPONDENCE RECEIVED IN LAW OFFICE | 034 |
| 03/04/2009 | MAIL | I | PAPER RECEIVED | 033 |
| 10/29/2008 | OP.I | T | OPPOSITION INSTITUTED NO. 999999 | 032 |
| 09/02/2008 | GNRN | O | NOTIFICATION OF NON-FINAL ACTION E-MAILED | 031 |
| 09/02/2008 | GNRT | O | NON-FINAL ACTION E-MAILED | 030 |

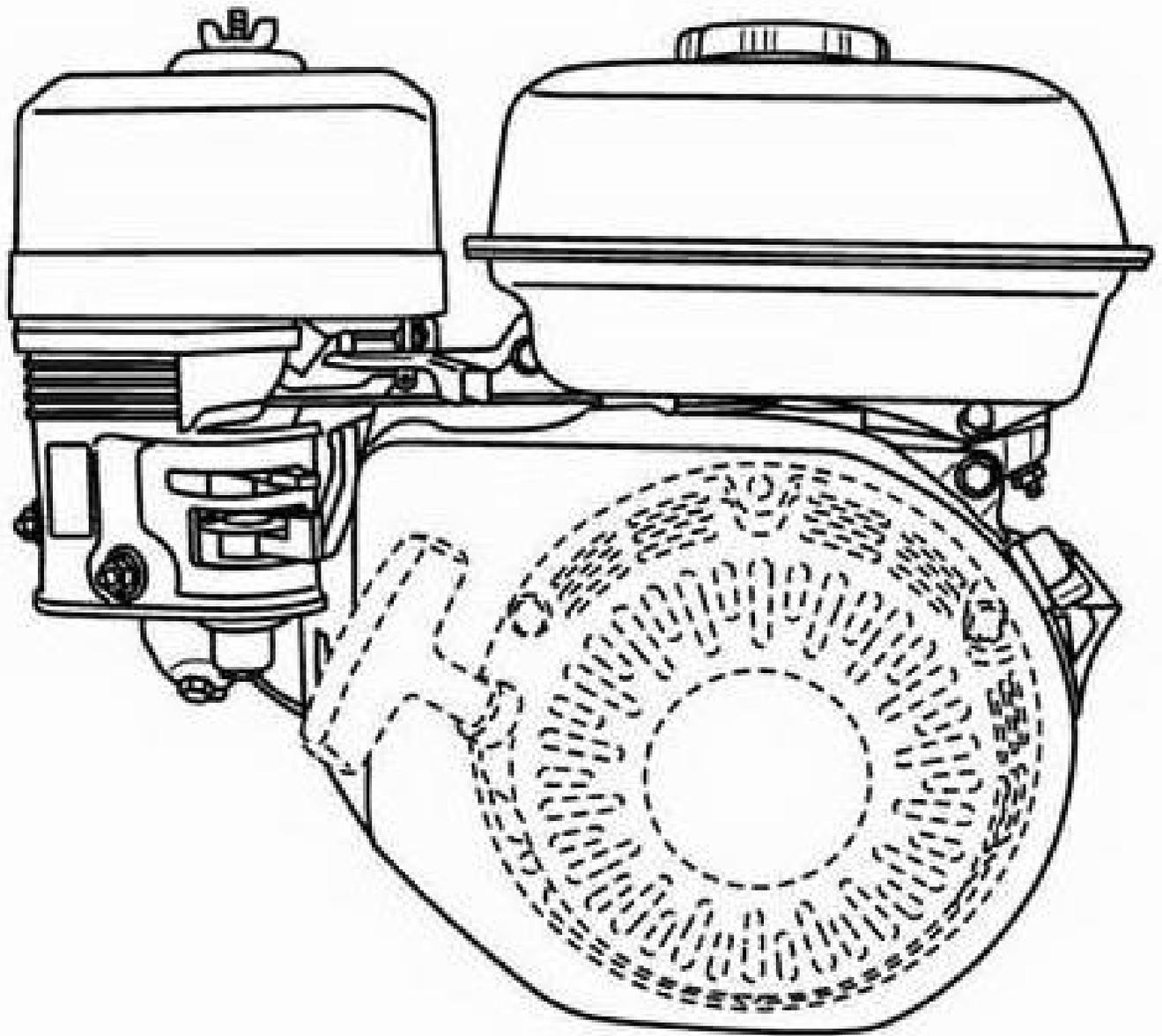
| | | | | |
|------------|------|---|---|-----|
| 09/02/2008 | CNRT | R | NON-FINAL ACTION WRITTEN | 029 |
| 08/18/2008 | ZZZX | Z | PREVIOUS ALLOWANCE COUNT WITHDRAWN | 028 |
| 07/30/2008 | LOPT | I | LETTER OF PROTEST ACCEPTED | 027 |
| 04/17/2008 | ETOF | T | EXTENSION OF TIME TO OPPOSE RECEIVED | 026 |
| 03/25/2008 | PUBO | A | PUBLISHED FOR OPPOSITION | 025 |
| 03/05/2008 | NPUB | O | NOTICE OF PUBLICATION | 024 |
| 02/19/2008 | PREV | O | LAW OFFICE PUBLICATION REVIEW COMPLETED | 023 |
| 02/13/2008 | CNSA | O | APPROVED FOR PUB - PRINCIPAL REGISTER | 022 |
| 02/11/2008 | TEME | I | TEAS/EMAIL CORRESPONDENCE ENTERED | 021 |
| 02/11/2008 | CRFA | I | CORRESPONDENCE RECEIVED IN LAW OFFICE | 020 |
| 02/11/2008 | TROA | I | TEAS RESPONSE TO OFFICE ACTION RECEIVED | 019 |
| 08/15/2007 | GNRN | O | NOTIFICATION OF NON-FINAL ACTION E-MAILED | 018 |
| 08/15/2007 | GNRT | O | NON-FINAL ACTION E-MAILED | 017 |
| 08/15/2007 | CNRT | R | NON-FINAL ACTION WRITTEN | 016 |
| 08/12/2007 | ZZZX | Z | PREVIOUS ALLOWANCE COUNT WITHDRAWN | 015 |
| 07/23/2007 | PBCR | Z | WITHDRAWN FROM PUB - OG REVIEW QUERY | 014 |
| 07/06/2007 | PREV | O | LAW OFFICE PUBLICATION REVIEW COMPLETED | 013 |
| 06/28/2007 | CNSA | O | APPROVED FOR PUB - PRINCIPAL REGISTER | 012 |
| 06/22/2007 | ACEC | I | AMENDMENT FROM APPLICANT ENTERED | 011 |
| 06/22/2007 | CRFA | I | CORRESPONDENCE RECEIVED IN LAW OFFICE | 010 |
| 06/22/2007 | ALIE | A | ASSIGNED TO LIE | 009 |
| 06/11/2007 | MAIL | I | PAPER RECEIVED | 008 |
| 02/21/2007 | CHAN | I | APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED | 007 |
| 02/21/2007 | COAR | I | TEAS CHANGE OF OWNER ADDRESS RECEIVED | 006 |
| 12/08/2006 | GNRT | F | NON-FINAL ACTION E-MAILED | 005 |
| 12/08/2006 | CNRT | R | NON-FINAL ACTION WRITTEN | 004 |
| 12/07/2006 | DOCK | D | ASSIGNED TO EXAMINER | 003 |
| 07/13/2006 | MDSC | O | NOTICE OF DESIGN SEARCH CODE MAILED | 002 |
| 07/12/2006 | NWAP | I | NEW APPLICATION ENTERED IN TRAM | 001 |

CURRENT CORRESPONDENCE INFORMATION

| | |
|-------------------------|--|
| ATTORNEY | Michael J. Bevilacqua, Esquire |
| CORRESPONDENCE ADDRESS | MICHAEL J. BEVILACQUA, ESQUIRE WILMER CUTLER PICKERING HALE AND DORR LL 60 STATE ST BOSTON, MA 02109-1800 |
| DOMESTIC REPRESENTATIVE | Michael J. Bevilacqua, Esquire |

PRIOR OWNER INFORMATION

| | |
|-------------|--|
| PARTY TYPE | 10-ORIGINAL APPLICANT |
| NAME | Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.) |
| ADDRESS | No. 1-1, 2-Chome, Minamiaoyama Minato-Ku, Tokyo, 107-8556 |
| ENTITY | 03-CORPORATION |
| CITIZENSHIP | Japan |



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
2-1-1 Minami-Aoyama
Minato-Ku
Tokyo 107 Japan

Serial No.: 78/924545

Examining Attorney: J. Rauen

Filed: July 7, 2006

Law Office: 109

For: **MISCELLANEOUS DESIGN**

Class: 7

Commissioner for Trademarks
BOX RESPONSE NO FEE
P.O. Box 1451
Alexandria, Virginia 22313-1451



03-04-2009

U.S. Patent & TMO/PTM Mail Rept. 01 #32

RESPONSE TO OFFICE ACTION

In response to the Office Action sent September 2, 2008, please consider the following remarks.

REMARKS

Jurisdiction in the above-referenced application has been restored to the Examining Attorney and registration has been refused because in the view of the Trademark Office the three dimensional configuration of an engine which is the subject of the above-identified application appears to be a functional design for such goods. In support of this rejection the Examining Attorney has stated that a feature is functional if it is essential to the use or purpose of the product or it effects the cost or quality of the product.

The subject matter of the present application is a configuration of an engine. The Examiner contends that "the evidence suggests that the configuration of engine components shown in the mark may enable the Applicants' engines to fit into a more compact space and to have a lower center of gravity." Applicants have carefully analyzed the evidence that has been submitted by the Examiner and that is available on the Trademark Office website as a result of the filing of a Protest, and there is absolutely nothing in the materials that have been made of record in this application that would even suggest that the configuration at issue makes it easier for such engine to fit into a compact space or that the engine has a lower center of gravity than

other comparable engines. Unless one knew the weight of the various components it is not possible to determine if a design has a lower center of gravity. If the Applicant has overlooked this evidence, Applicant would appreciate it if the Examining Attorney would identify it with greater specificity so that it can be addressed.

The engine that is the subject of the present application was first introduced in the United States by the applicant or one of its affiliates at least as early as 1983. This engine was consciously designed to have many features that are arbitrary or ornamental and that do not affect the cost or quality of the engine. In the following remarks this engine will be referred to as the "GX Engine". To facilitate the understanding of the following remarks, Applicant has attached as Exhibit A a copy of the GX Engine with hand written notations made by the party that filed the Letter of Protest as well as notations made by the undersigned to identify components of the GX Engine.

It is a fundamental principle of the trademark laws that even if an object has a functional purpose, such as a bottle or an engine, "the configuration of that object may still qualify for trademark protection if its *physical details* are non functional." *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 785 (9th Cir. 2002)(evaluating the grip on a bottle as to functionality)(emphasis added). Even if a product feature serves some function, the particular design for that feature is protectable if the design itself is "arbitrary, incidental, or ornamental." See *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34 (2001) (ornamental elements of functional product features, "such as arbitrary curves in the legs or an ornamental pattern painted on the springs," may be protectable trade dress); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979) ("Thus, the fact that an item serves or performs a function does not mean that it may not at the same time be capable of indicating sponsorship or origin, particularly where the decorative aspects of the item are nonfunctional."); 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:70 at 7-171 (4th ed. 2007) (same). For example, while an old-fashioned Coca-Cola bottle certainly performs a function (holding a liquid, standing upright on a flat surface, and so on), the particular design of the bottle (its specific shape and ribbing) are protected under the Lanham Act. As will be described below, the GX Engine includes many features and/or physical details that are non-functional.

In support of its application, Applicant is submitting two declarations with this Response from experts in the field of engine design. Exhibit B to this Response is the Declaration of Kevin Hoag who is the Associate Director of the Engine Research Center at the University of Wisconsin-Madison College of Engineering which is the largest academic research center in the United States devoted to research and design of gasoline engines. As is clear from the Declaration, Mr. Hoag is an expert in the field of engine design.

Attached as Exhibit C is a Declaration of James Meiritz who worked in the gasoline engine industry for over 35 years primarily for Briggs & Stratton, a principal competitor of Applicant in the gasoline engine market. For the reasons described in his Declaration, Mr. Meiritz is also an expert in the field of electric engine design and is very familiar with the GX Engine.

The specific design features that are distinctive and nonfunctional will now be described:

1. The GX Engine was intentionally styled to have a “cubic” look

Applicant had a styling design group that worked on the design of the GX Engine. This is not unusual. Often an engine manufacturer will use an industrial designer to help create a “look” for a product. See attached Declaration of James Mieritz (“Mieritz Declaration”) at ¶39. An industrial designer will conceptualize a packaged appearance that is appealing, distinguishes the product from those of its competitors, and associates the product with others from the same manufacturer. Mieritz Declaration at ¶39. In the case of the GX Engine design, the styling engineers wanted “cubic” to be the general styling idea or concept of the design.

Consistent with the practice in the industry, Honda styling engineers worked closely with the performance design team so that the thoughts of the styling engineers were reflected in the performance teams’ design. Styling elements that might be used in engine design include beveled edges, radii edges, sharp corners or other shapes and contours. Mieritz Declaration at ¶40. Developing a look for an engine also takes into account such features as decorative covers and their shapes, colors, intake air openings (slots, holes, etc.) and the blending of all lines. Mieritz Declaration at ¶40. As indicated in the attached Mieritz Declaration and Hoag Declaration, Applicant’s stylists used such “arbitrary embellishments” when developing the “cubic” look for the GX Engines. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 785 (9th Cir.

2002)(features incorporated into product's design by virtue of arbitrary embellishment has trademark significance).

Furthermore, the "look" or distinctive appearance of the GX Engine does not contribute to the functioning of the engine, does not decrease its cost, and does not increase its quality or performance. Hoag Declaration at ¶ 12; Mieritz Declaration at ¶51; ¶ 53.

2. The Honda GX Engine has many ornamental features

For a product configuration to be protectable, "there must be some aspect to the configuration which is nonfunctional." *Leatherman Tool Group, Inc. v. Cooper Industries, Inc.*, 199 F.3d 1009, at 1013 n.6. In *Leatherman*, "[n]o witness pointed to any feature of, or marking on, the [product] which was ornamental or intended to identify its source." The configuration of the present application is a very different case from *Leatherman*. The fact is that the overall "cubic" design of GX Engine has nothing to do with engine performance, it is a matter of styling design and appearance. Numerous individual design features on GX Engine components are ornamental or distinctive as described below.

a. The shape of the air cleaner housing (or cover)

Applicant has chosen a cube-shaped air cleaner (or air filter) housing that mirrors the squared corner of the upper left edge of its fan cover. Mieritz Declaration at ¶52. The beveling on the outside edge of the air cleaner cover and the lack of beveling on the inside edges are ornamental elements of the air cleaner cover design. The belt-like area on the lower portion of the air cleaner cover that encompasses the entire circumference and that is aligned with the extruded part of the fuel tank is another ornamental feature of the air cleaner cover design. The raised area where the wing nut is fastened onto the air cleaner cover is an ornamental element. Because the air cleaner housing is molded from plastic, complex shapes are easily achieved without added cost. Hoag Declaration at ¶24.

b. The design of the carburetor cover (or air cleaner case)

Honda has chosen a stylized carburetor cover that also houses various engine controls. Mieritz Declaration at ¶52. The carburetor cover ("air cleaner case") has ornamental elements, including the four ribs and their shapes, the locations of the bolts that secure the case, and the recessed area where control levers are provided. The existence, number, and placement of these

ribs is ornamental and arbitrary. Hoag Declaration at ¶35. Meiritz Declaration at ¶52. The shape and ribbing could be modified in any number of ways without losing function or increasing cost. Hoag Declaration at ¶36. For example, the ribs could be eliminated or their number and orientation could be changed. *Id.* The radius between the front and side surfaces could be changed. *Id.* Because it is molded from plastic, the carburetor cover easily could be molded in numerous complex shapes without added cost. *Id.*

c. The shape and size of the fuel tank

“Honda has chosen a roughly square fuel tank (viewed from above) with a shape that mirrors the angles on the air cleaner housing and the radii on the upper left corner of its fan cover. . . . [i]n particular, the angle of the upper left corner edge of the fuel tank (viewed from the configuration that is the subject of the present application) need not repeat the same corner of the air cleaner housing.” Mieritz Declaration at ¶52. The combination of beveled and less beveled features on the top part of the GX Engine fuel tank is ornamental. Changes to the styling of the fuel tank would not increase its cost. Hoag Declaration at ¶40.

d. The combined and complementary shape of the fuel tank and air cleaner housing

The combined and complementary shape of the fuel tank and air cleaner housing on the GX Engine show the interrelationship of ornamental design features among components. The beveling that runs throughout the entire circumference of the engine (the top portion of the fuel tank and air cleaner housing) is ornamental. According to Professor Hoag, “the upper profile of the engine assembly was beveled on the front and rear through the shaping of the fuel tank, air cleaner housing and muffler heat shield as diagrammed below. . . . [a]s is described in the component-level descriptions, none of this architecture is functional. The angles and positions of each of these lines have no impact on function, cost, or quality.” Hoag Declaration at ¶42-43 and ¶40.

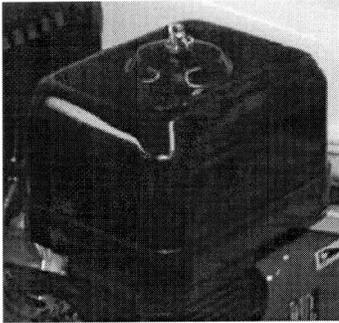
e. The position and orientation of the major engine components

As an example of the position and orientation of components that contribute to the trade dress, Prof. Hoag referred to “the relative positioning and orientation of the air cleaner housing, muffler heat shield and fuel tank of the Honda engine, such that the straight edges face each other and the center of the engine while the beveled edges are on the exterior is a detail of the

relative position and orientation that contributes to the overall and distinctive look of the Honda engine.” Hoag Declaration at ¶61. Mr. Mieritz additionally noted that the combination of spacing between 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.” Mieritz Declaration at ¶52. In light of the care taken in the design of the individual components of the GX Engine, it is not surprising that Applicant also configured the components in such a way to provide a pleasing appearance by avoiding clutter.

B. There are alternatives to GX Engine designs that provide the same functionality

It is settled law that “the existence of alternative designs cannot negate a trademark’s functionality,” but “may indicate whether the trademark itself embodies functional or merely ornamental aspects of the product.” *Automotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062, 1072 n.8 (9th Cir. 2006) (quoting *Talking Rain Beverage Co. V. South Beach Beverage Co.*, 349 F.3d 601, 603 (9th Cir. 2003)). For example, alternative designs help a court to determine what functionality *is* in the context of a particular product. Professor Hoag reviews the availability of different designs (including copied designs) and shapes for components that embody the elements of the GX Engine in his Declaration. For example, alternatives designs are available for the air cleaner housings (some also used as carburetor covers), Hoag Declaration at ¶26 (as pictured below).



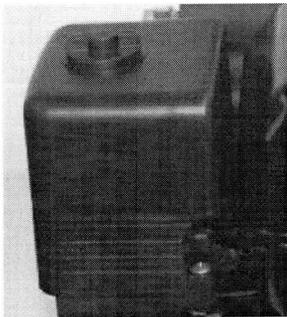
Honda



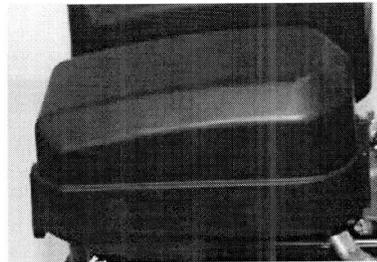
Briggs & Stratton



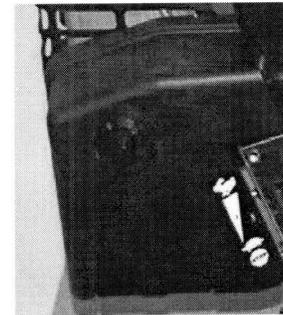
Kawasaki



Kohler



Robin



Tecumseh

Exhibit D includes photographs of six engines that compete in the marketplace with the GX Engine. Starting in the upper left hand corner and moving clockwise these engines are sold by Honda (the GX Engine), Briggs & Stratton, PowerTrain, Kohler, Kawasaki and Tecumseh. All of these companies except PowerTrain have been long time competitors of Honda and each has its own engine which competes with the GX Engine. All of these engines except the PowerTrain engine, have a completely different design. PowerTrain, which only entered the small gasoline engine market earlier this decade, copied Applicant's GX Engine when it introduced its engine.

C. GX Engine advertisements prominently display the GX Engine design features

Advertisements of Applicant's affiliates in the United States do display the features of the configuration of the present application, but those features are not touted for their utilitarian advantages.

Applicant has attached a number of advertisements as Exhibits E, F and G to this response. Exhibit E is a Honda brochure for the GX Engine and as indicated above, none of the ornamental features described above are touted for their utilitarian advantages. Applicant's online advertisements which include product specifications, an example which is attached as Exhibit F, also does not describe any of the ornamental features as providing any particular functional advantages. Exhibit G is a copy of pages from a website of an independent engine company (www.smallenginewarehouse.com) which also does not tout any of the design features of the GX Engine described above as being functional. This website also shows many other designs from competitors of Applicant which do not incorporate Applicant's configuration.

D. Patents

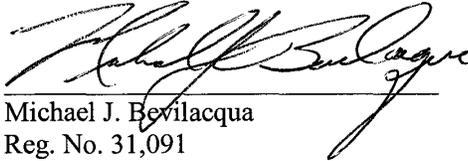
As part of the evidence to suggest that the engine configuration of components shown in the mark enable Applicant's engine to fit into a more complex space and have a lower center of gravity, three utility patents which have been issued to the Applicant are cited. None of these patents, however, even remotely show the configuration which is the subject of the present application. The gas tank in each of these patents is multiple times the relative size of the gas tank of the engine of the present application and the gas tank is not of the same shape as the gas tank shown in the mark. Moreover, an air cleaner cover is not shown in the same relative position to the gas tank in the patented engines. It should be noted that all of these patents were filed many years after Applicant first introduced the GX Engine and its components that are shown in the mark of the present application. Applicant does have a design patent which shows this engine (U.S. Design Patent No. 282,071 which issued January 7, 1986) and is attached as Exhibit H. A design patent on a configuration creates a presumption that the features depicted are not functional, even if the design patent later expires. See 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §6:11 (4th ed. 2005) ("McCarthy"); *Fuji Kogyo Co., Ltd. v. Pacific Bay Int'l, Inc.*, 461 F.3d 675, 683 (6th Cir. 2006); *Topps Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q.2d 1412, 1419-20 (S.D.N.Y. 1996).

Applicant has been granted a number of other utility patents that cover features embodied in the GX Engine but none of these utility patents cover the configuration which is the subject of the present application. For example, U.S. Patent No. 4,813,385 which is attached hereto as Exhibit I was filed more than 4 years after Applicant first sold the GX Engine. Obviously, if

Applicant was seeking protection for the configuration, such patent would have been barred as the invention was already on sale.

In view of the information described above and in the attached Exhibits, Applicant submits that it has satisfied the requests made by the Examiner and that the configuration of an engine that is the subject of the present application satisfies the criteria for registration. Applicant has substantial additional information which could be provided if a further showing is necessary.

Respectfully submitted,
WILMER CUTLER PICKERING
HALE AND DORR LLP



Michael J. Bevilacqua
Reg. No. 31,091
60 State Street
Boston, Massachusetts 02109
(617) 526-6448

Dated: March 2, 2009

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, BOX RESPONSE NO FEE, P.O. Box 1451, Alexandria, Virginia 22313-1451, on September 26, 2007.


Iris M. Dianna

Exhibit A

Engine

Honda - SN 78/924,545

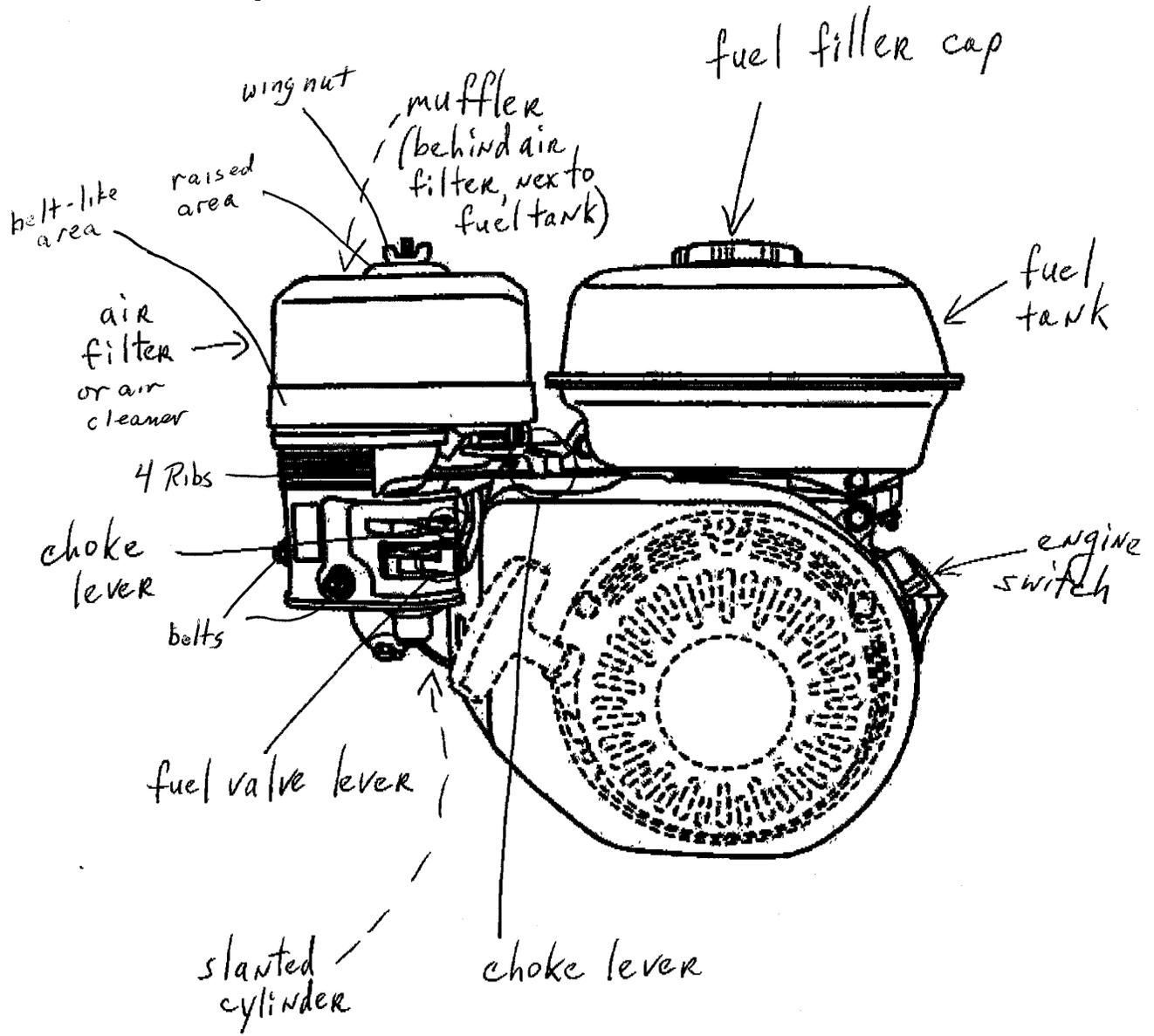


Exhibit H

U.S. Design Patent No. 282,071

[54] **INTERNAL COMBUSTION ENGINE**

[75] **Inventor: Tetsuo Nakamura, Saitama, Japan**

[73] **Assignee: Honda Giken Kogyo Kabushiki Kaisha, Tokyo, Japan**

[**] **Term: 14 Years**

[21] **Appl. No.: 478,941**

[22] **Filed: Mar. 25, 1983**

[30] **Foreign Application Priority Data**

Oct. 20, 1982 [JP] Japan 57-47691
[52] **U.S. Cl. D15/1**
[58] **Field of Search D15/1; 123/56 B, 56 BC, 123/56 BA, 41.66, 41.67, 41.7, 195 G, 195 B, 195 R, 198 E**

[56] **References Cited**

U.S. PATENT DOCUMENTS

D. 247,177 2/1978 Stevens D15/1
D. 257,844 1/1981 Stevens D15/1
D. 276,160 10/1984 Tuggle et al. D15/1

OTHER PUBLICATIONS

Implement & Tractor, 2-21-79, p. 37, Kawasaki Engine.

Implement & Tractor, 3-21-79, p. 11, Kawasaki Engine.

Primary Examiner—Wallace R. Burke
Assistant Examiner—Lynn Wilder
Attorney, Agent, or Firm—Sughrue, Mion, Zinn, Macpeak & Seas.

CLAIM

[57] The ornamental design for an internal combustion engine, as shown.

DESCRIPTION

FIG. 1 is a front, top and left side perspective view of an internal combustion engine showing my new design; FIG. 2 is a left side elevational view thereof; FIG. 3 is a front elevational view thereof; FIG. 4 is a rear elevational view thereof; FIG. 5 is a top plan view thereof; FIG. 6 is a right side elevational view thereof; and FIG. 7 is a bottom plan view thereof.

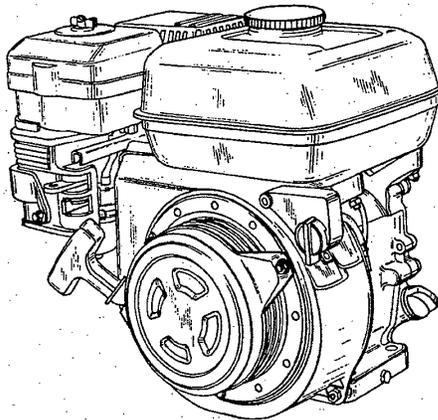


FIG. 1

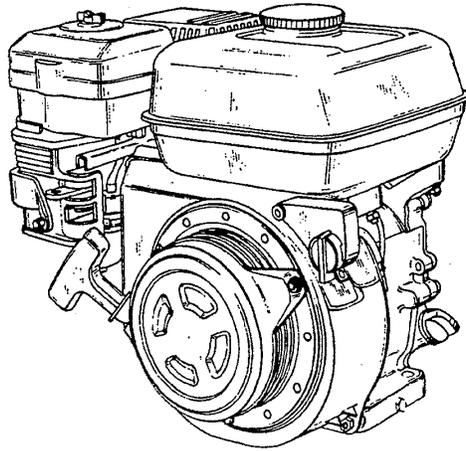


FIG. 2

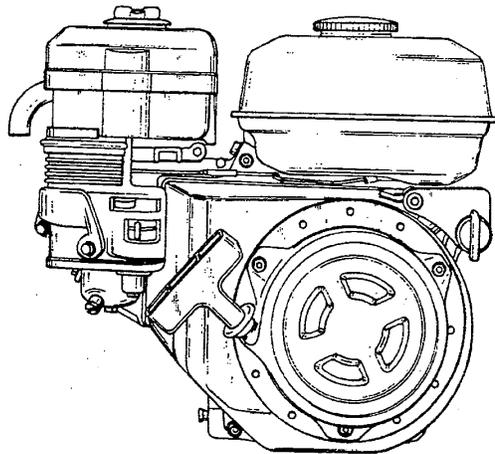


FIG. 3

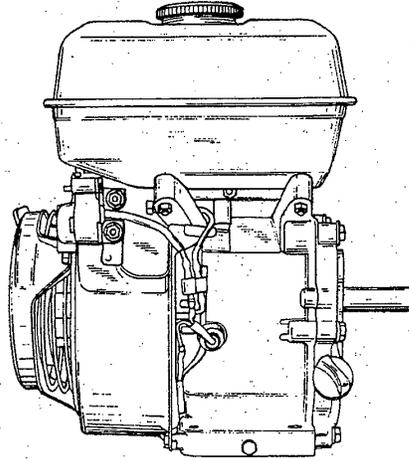


FIG. 4

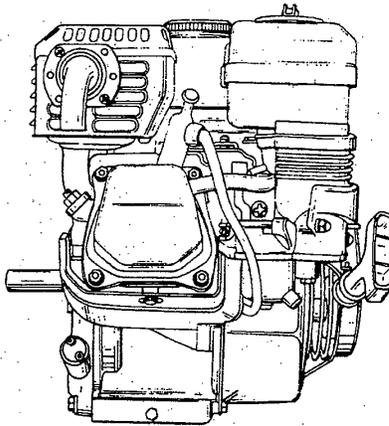


FIG. 5

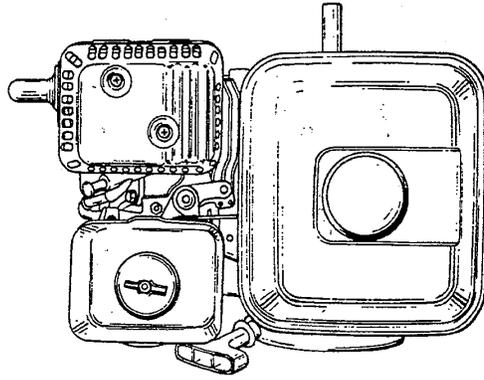


FIG. 6

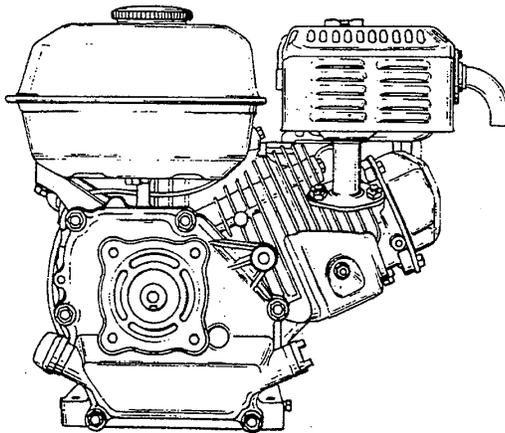


FIG. 7

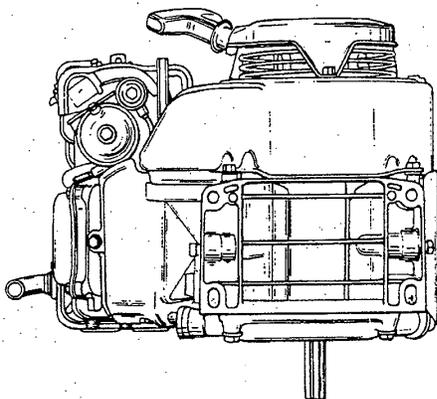


Exhibit I

U.S. Patent No. 4,813,385

- [54] **GENERAL-PURPOSE INTERNAL COMBUSTION ENGINE**
- [75] **Inventors:** Yoshinobu Yamaguchi; Mutsumi Terasawa, both of Saitama; Mitsuo Sasagase, Shizuoka, all of Japan
- [73] **Assignees:** Honda Giken Kogyo Kabushiki Kaisha, Tokyo; Toyoroki Seizo Co., Ltd., Shizuoka, both of Japan
- [21] **Appl. No.:** 143,299
- [22] **Filed:** Jan. 11, 1988

Related U.S. Application Data

- [63] Continuation of Ser. No. 793,410, Oct. 31, 1985, abandoned.

Foreign Application Priority Data

| | | | |
|--------------|------|-------|--------------|
| Nov. 1, 1984 | [JP] | Japan | 59-230915 |
| Nov. 1, 1984 | [JP] | Japan | 59-230916 |
| Nov. 1, 1984 | [JP] | Japan | 59-230917 |
| Nov. 1, 1984 | [JP] | Japan | 59-165832[U] |
| Nov. 1, 1984 | [JP] | Japan | 59-165833[U] |
| Nov. 1, 1984 | [JP] | Japan | 59-165834[U] |

- [51] **Int. Cl.⁴** F02B 65/00
- [52] **U.S. Cl.** 123/2; 55/320
- [58] **Field of Search** 123/2, 195 C, 193 C; 290/1 R, 1 A, 1 B; 55/317, 318, 320, 337

References Cited

U.S. PATENT DOCUMENTS

| | | | |
|-----------|--------|-----------------|-----------|
| 3,521,726 | 7/1970 | Frey | 123/198 E |
| 3,952,640 | 4/1976 | Knechler | 55/31 E |
| 4,013,105 | 3/1977 | Wuskallio | 123/198 E |
| 4,276,067 | 6/1981 | Lindman | 55/337 |
| 4,610,229 | 9/1986 | Wissmann et al. | 92/169 |

FOREIGN PATENT DOCUMENTS

| | | |
|----------|---------|----------|
| 2399200 | 3/1979 | France . |
| 2524551 | 10/1983 | France . |
| 2534626 | 4/1984 | France . |
| 27-5504 | 7/1952 | Japan . |
| 54-20689 | 7/1979 | Japan . |
| 56-50126 | 11/1981 | Japan . |
| 57-61155 | 4/1982 | Japan . |

Primary Examiner—Tony M. Argenbright
Assistant Examiner—Eric R. Cariberg
Attorney, Agent, or Firm—Armstrong, Nikaido, Marmelstein & Kubovcik

[57] **ABSTRACT**

A general-purpose internal combustion engine comprises an engine unit, a recoil starter, a fuel tank disposed on the engine unit, a main air cleaner disposed on the engine unit and coupled with a precleaner, and a muffler disposed on the engine unit. The main air cleaner and the muffler are disposed laterally of the fuel tank in parallel relation to each other, the main air cleaner being located closely to the recoil starter, and the muffler being disposed remotely from the recoil starter. The precleaner has an air inlet member disposed remotely from the muffler and positioned without projecting out of a plane containing a side of the main air cleaner which is remote from the muffler. The pre-cleaner has an air outlet and the main air cleaner has a case with an air inlet defined in a side thereof and a substantially cylindrical filter housed centrally in the case coaxially with the vertical axis thereof. The air inlet has a central axis sidewardly offset a distance from a horizontal axis of the case and connected to the air outlet.

6 Claims, 4 Drawing Sheets

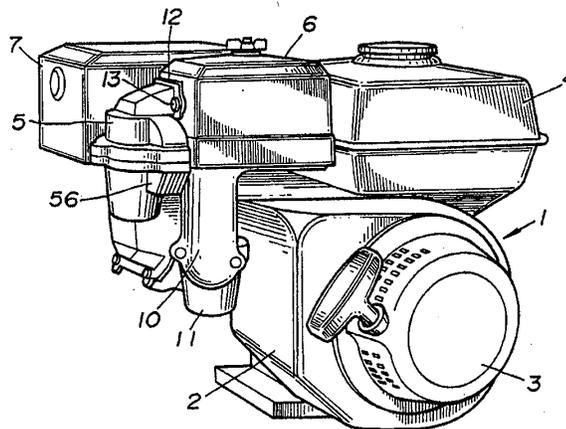


FIG. 1

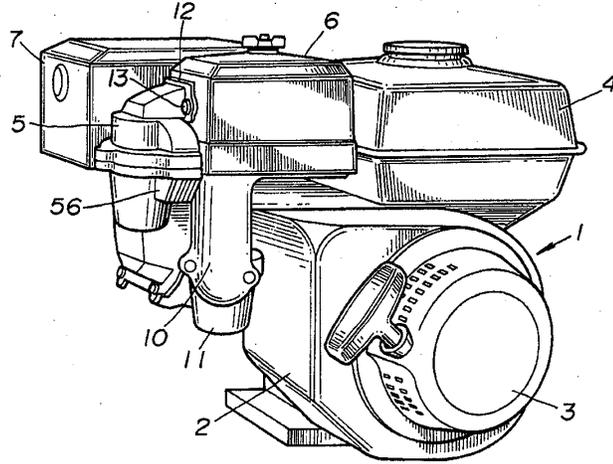


FIG. 2

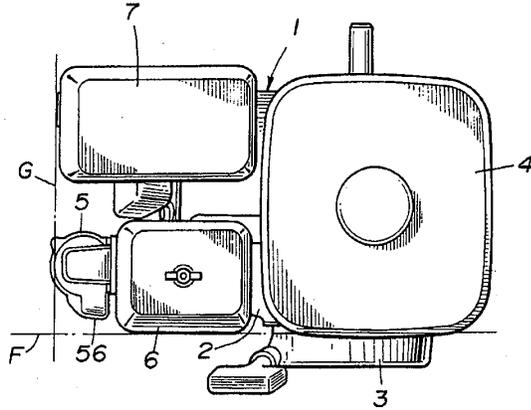


FIG. 3

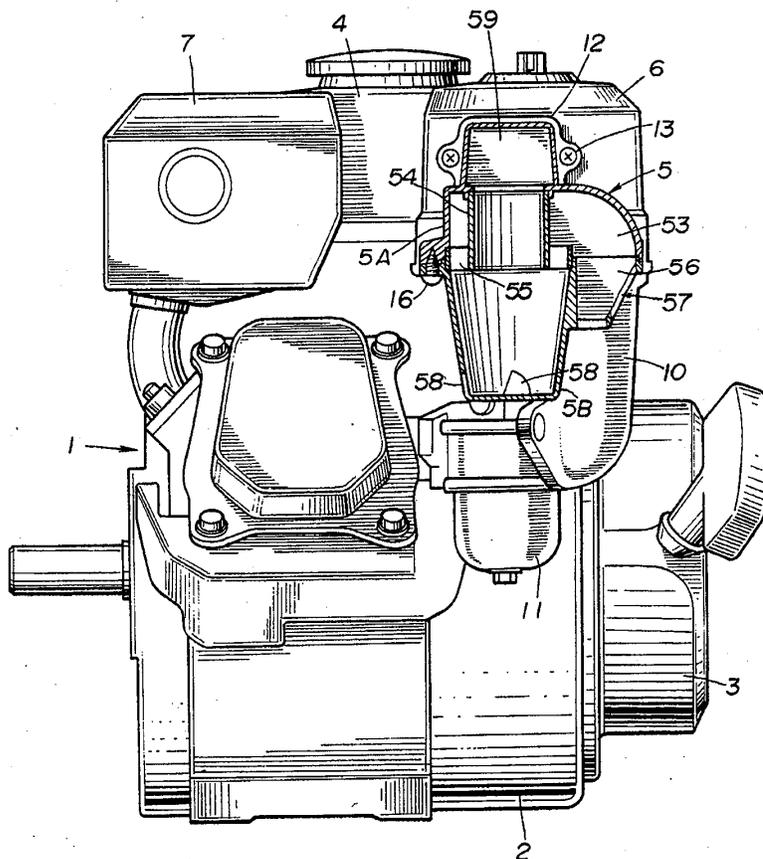


FIG. 4

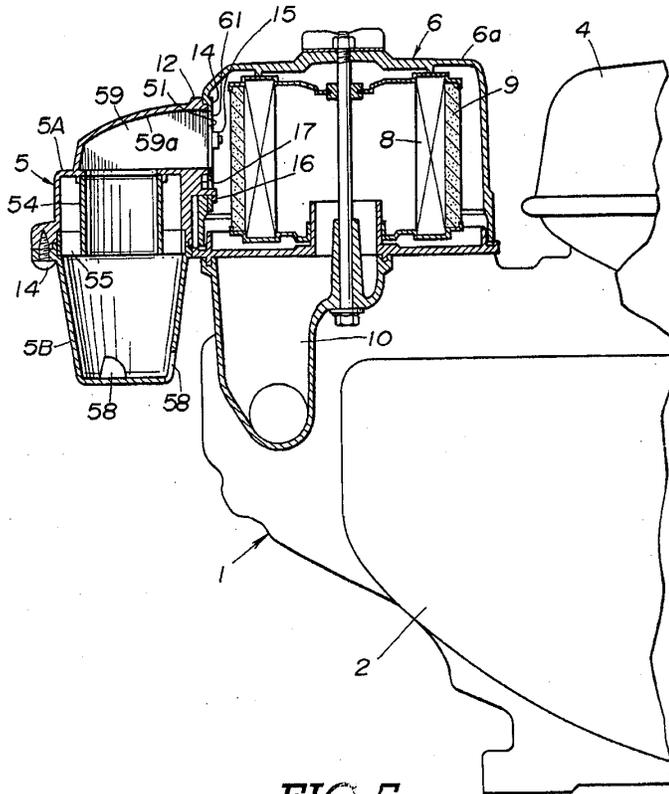


FIG. 5

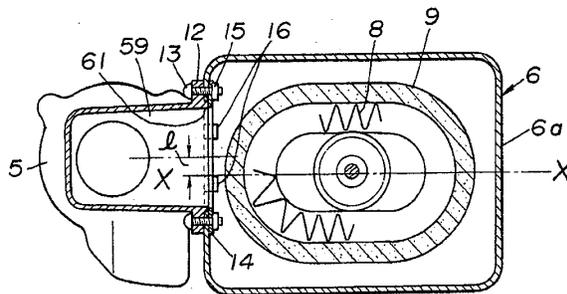


FIG. 6

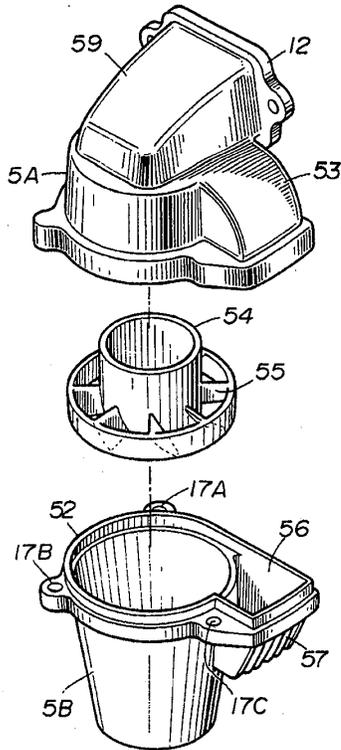


FIG. 7

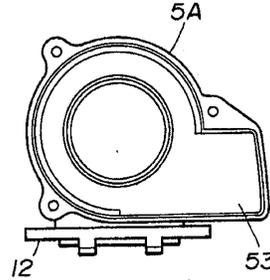


FIG. 8

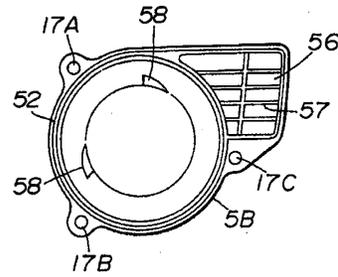
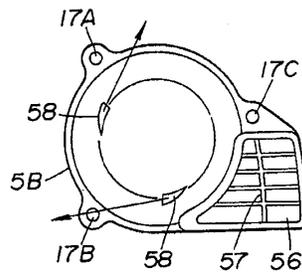


FIG. 9



**GENERAL-PURPOSE INTERNAL COMBUSTION
ENGINE**

This application is a continuation of application Ser. No. 793,410 filed Oct. 31, 1985, now abandoned.

BACKGROUND OF THE INVENTION

The present invention relates to a general-purpose internal combustion engine for use as a prime mover in various machines for agricultural, civil construction, and other uses and in various portable machines such as electric generators and pumps, and more particularly to such a general-purpose internal combustion engine having an air cleaner with a precleaner.

Internal combustion engines for use as prime movers in various machines for agricultural, civil construction, and other uses and in various portable machines such as electric generators and pumps, are often used in dusty places. Therefore, the filters in the air cleaners of such internal combustion engines are liable to get clogged soon, and have to be frequently cleaned or replaced. To avoid this shortcoming, there have been proposed general-purpose internal combustion engines as disclosed in Japanese Utility Model Publication Nos. 27-5504 and 54-20689, for example. The disclosed internal combustion engines have a main air cleaner employing a filter of paper and/or urethane foam and a cyclone-type pre-cleaner positioned laterally of the main air cleaner. Dust-laden air is first introduced into the pre-cleaner which removes most of the dust from the air. The air from the pre-cleaner is then introduced into the main air cleaner through a port defined in a side thereof.

With the conventional air cleaner arrangements, however, the pre-cleaner is simply connected to the air inlet port of the main air cleaner. The prior air cleaner structures have failed to meet the following requirements:

(a) The pre-cleaner should not project out of the assembly of an engine, a fuel tank, a muffler, and an air cleaner, so that the pre-cleaner would not impair the appearance of the engine assembly, would not obstruct the operation of a recoil starter, or would be damaged by being hit by an object;

(b) The pre-cleaner should be located so as not to draw air heated by a heating body such as a muffler;

(c) The main air cleaner and the pre-cleaner should be interconnected by a joint duct having a small resistance to the flow of air therethrough;

(d) The pre-cleaner should be structured so that it could easily be formed;

(e) The pre-cleaner should be arranged so that dust discharged therefrom would not be drawn through its own air inlet port into the pre-cleaner; and

(f) The joint between the pre-cleaner and the main air cleaner should be durable.

The filter of the main air cleaner is oval or generally cylindrical in shape and housed centrally coaxially in an air cleaner case having a complementary shape. The filtered air discharged from the pre-cleaner is introduced into the main air cleaner case toward the vertical axis thereof and impinges substantially perpendicularly upon the outer circumferential surface of the oval or cylindrical filter, with the result that the filter portion hit by the filtered air tends to get clogged soon. Therefore, the entire circumferential surface of the filter is not effectively utilized, and it is uneconomical to clean or

replace the entire filter when the other filter portion is not appreciably clogged.

The present invention has been made in an attempt to meet the aforesaid requirements of the general-purpose internal combustion engines and also to solve the above problem of the conventional air cleaner combined with the cyclone-type pre-cleaner.

SUMMARY OF THE INVENTION

It is an object of the present invention to provide a general-purpose internal combustion engine having a pre-cleaner attached to a main air cleaner so that the pre-cleaner will not impair the appearance of the engine assembly, will not obstruct the operation of a recoil starter, and will not be damaged by being hit by an object, the pre-cleaner being located so as not to introduce air heated by a heating body such as a muffler.

Another object of the present invention is to provide a general-purpose internal combustion engine having a main air cleaner and a pre-cleaner which are interconnected by a joint duct having a small resistance to the flow of air therethrough.

Still another object of the present invention is to provide a general-purpose internal combustion engine having a pre-cleaner structured so that it could easily be formed;

A still further object of the present invention is to provide a general-purpose internal combustion engine having a pre-cleaner arranged so that dust discharged therefrom will not be drawn through its own air inlet port into the pre-cleaner.

A yet still further object of the present invention is to provide a general-purpose internal combustion engine having a pre-cleaner and a main air cleaner which are interconnected by a durable joint.

Still another object of the present invention is to increase the cleaning or replacement interval and the air purifying efficiency of the filter in an air cleaner having a cyclone-type pre-cleaner.

According to the present invention, there is provided a general-purpose internal combustion engine comprising an engine unit, a recoil starter disposed parallel to the engine unit, a fuel tank disposed on the engine unit, a main air cleaner and a muffler disposed on the engine unit laterally of the fuel tank in parallel relation to each other, the main air cleaner being located closely to the recoil starter, the muffler being disposed remotely from the recoil starter, and a pre-cleaner connected to the main air cleaner and having an air inlet member disposed remotely from the muffler in a plane containing a side of the main air cleaner which is remote from the muffler.

The pre-cleaner comprises an upper cleaner case and a lower dust pan which are detachably coupled to each other, the upper cleaner case having an air inlet duct projecting laterally and having a lower open end, the dust pan having the air inlet member which projects laterally and opens upwardly, the air inlet member defining an air inlet port directed substantially downwardly, the cleaner case and the dust pan being coupled together with the air inlet duct and the air inlet member held in registry with each other. Each of the cleaner case and the dust pan is substantially cylindrical in shape, the air inlet duct and the air inlet member projecting tangentially from the cleaner case and the dust pan, respectively, the dust pan having a dust outlet hole defined in a bottom thereof and opening away from the air inlet port.

The precleaner has an integral air duct at its upper portion, the air duct having an air outlet at an outer end thereof, the main air cleaner having an air inlet defined in a side thereof and connected to the air outlet, the air duct having an upper surface curved progressively upwardly toward the air outlet.

The air duct of the precleaner has a flange surrounding the air outlet, the air outlet and the air inlet being coupled by the flange, the precleaner engaging the main air cleaner at a position below the air outlet and the air inlet which are coupled to each other.

According to the present invention, there is also provided an air cleaner comprising a cyclon-type pre-cleaner having an air outlet, and a main air cleaner including a case having an air inlet defined in a side thereof and a substantially cylindrical filter housed centrally in the case coaxially with the vertical axis thereof, the air inlet having a central axis sidewardly offset a distance from an axis of the case and connected to the air outlet of the precleaner.

The above and further objects, details and advantages of the present invention will become apparent from the following description of a preferred embodiment thereof, when read in conjunction with the accompanying drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a perspective view of a general-purpose internal combustion engine according to the present invention;

FIG. 2 is a plan view of the general-purpose internal combustion engine;

FIG. 3 is an enlarged front elevational view of the general-purpose internal combustion engine, with a precleaner shown in vertical cross section;

FIG. 4 is an enlarged fragmentary side elevational view of the general-purpose internal combustion engine, with the precleaner and a main air cleaner in vertical cross section;

FIG. 5 is a horizontal cross-sectional view of the main air cleaner and the precleaner;

FIG. 6 is an exploded perspective view of the pre-cleaner;

FIG. 7 is a bottom view of a precleaner case;

FIG. 8 is a plan view of a dust pan; and

FIG. 9 is a bottom view of the dust pan.

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

As shown in FIGS. 1 and 2, a general-purpose internal combustion engine includes an engine unit 1 having an air guide cover 2 disposed on one side thereof in covering relation to an engine cooling fan integral with a flywheel. A recoil starter 3 is attached to the outer surface of the air guide cover 2 in parallel relation to the engine unit 1.

A fuel tank 4 is disposed on the upper surface of the engine unit 1 at one side thereof. A main air cleaner 6 coupled with a cyclone-type precleaner 5 and a muffler 7 are disposed laterally of the fuel tank 4 parallel to each other, the main air cleaner 6 and the precleaner 5 being located closely to the recoil starter 3. Each of the fuel tank 4, the main air cleaner 6, and the muffler 7 is substantially rectangularly shaped when viewed in plan.

As illustrated in FIGS. 4 and 5, the main air cleaner 6 accommodates a substantially cylindrical or elliptical filter centrally in a cleaner case 6a coaxially with the vertical axis thereof, the cylindrical or oval filter com-

prising a paper filter member 8 and a urethane foam member 9 surrounding the paper filter member 8. The cylindrical or oval filter has an inner space communicating through an air duct 10 with a carburetor 11 (FIGS. 1 and 3).

As shown in FIG. 5, the main air cleaner 6 has an air inlet 61 defined in a side thereof and having a central axis sidewardly displaced or offset a distance *l* from a horizontal axis X—X of the cleaner case 6a, and the precleaner 5 has an air outlet 51 defined by the outer end of an air duct 59 thereof. The precleaner 5 is attached to the main air cleaner 6 by a flange 12 surrounding the air outlet 51 with the air inlet 61 and the air outlet 51 held in registry with each other. As shown in FIG. 4 and 5, bolts 13 extend through the flange 12 threadedly into nuts 15 on a patch plate 14 disposed in the main air cleaner 6 and held against the inner side thereof in surrounding relation to the air inlet port 61. The precleaner 5 has a pair of hooks 16 (FIGS. 4 and 5) projecting into the main air cleaner 6 below the air outlet 51 and the air inlet 61 and held in engagement with a case of the main air cleaner 6 and an edge of a hole 17 defined in the patch plate 14. The precleaner 5 may have a horizontally elongate single hook rather than the pair of hooks 16.

As illustrated in FIG. 6, the precleaner 6 comprises an upper cleaner case 5A substantially in the form of a hollow cylinder, and a lower dust pan 5B substantially in the form of a hollow cylinder. The upper cleaner case 5A and the lower dust pan 5B are fitted together through a socket and spigot joint 52 (FIG. 6) and fastened together by a plurality of screws 16. (FIGS. 3 and 4).

The air duct 59 is integral with the upper cleaner case 5A and has an upper surface 59a which is gradually curved progressively upwardly toward the main air cleaner 6.

The upper cleaner case 5A has an integral air inlet duct 53 projecting tangentially outwardly and opening downwardly. An air guide sleeve 54 with a plurality of revolving guide blades 55 integrally formed therearound is removably fitted centrally in the upper cleaner case 5A.

The lower dust pan 5B has an integral air inlet member projecting laterally outwardly tangentially therefrom and opening upwardly. The air inlet member defines an air inlet port 56 held in registry with the open end of the air inlet duct 53. The air inlet port 56 opens obliquely downwardly remotely from the muffler 7 through a grid 57.

The air inlet duct 53 and the air inlet port 56 are joined through a socket and spigot joint contiguous to the socket and spigot joint 52. The dust pan 5B has a plurality of dust outlet holes 58 defined in the bottom thereof along its peripheral edge. The dust outlet holes 58 are directed away from the air inlet hole 56 so that dust discharged from the dust outlet holes 58 will not be directed toward the air inlet hole 56 as indicated by the arrows in FIG. 9.

The dust pan 5B have screw holes 17A, 17B, 17C which are spaced at irregular intervals so that the air inlet port 56 and the dust outlet holes 58 will properly be positioned with respect to each other when the cleaner case 5A and the dust pan 5B are coupled by screws through the screw holes 17A, 17B, 17C.

With the cyclone-type precleaner 5 mounted on the main air cleaner 6, the air inlet port 56 of the precleaner 5 is positioned remotely from the muffler 7 as shown in

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FIG. 1 and 2, and does not project out of a plane F in which sides of the main air cleaner 6 and the fuel tank 4 lie. The precleaner 5 also does not project out of a plane G extending perpendicularly to the plane F and in which the end face of the muffler 7 lies. The fuel tank 4, the main air cleaner 6 with the precleaner 5 attached thereto, and the muffler 7 are positioned in a substantially rectangular space as seen in plan.

When the engine operates, dust-laden air is introduced through the air inlet port 56 into the precleaner 5 and caused to revolve by the tangential duct 53 and the revolving guide blades 55. Dust of a large specific gravity such as sand particles drops along the inner wall surface of the dust pan 5B and is discharged out of the dust pan 5B through the dust outlet holes 58. Air from which most dust has been removed is drawn upwardly through the central air guide sleeve 54 and then through the duct 59 and the ports 51, 61 into the main air cleaner 6, in which the air is purified by the filter members 8, 9. Since the air inlet 61 of the main air cleaner 6 having a central axis sidewardly offset the distance l of the horizontal axis X - X thereof, the air having entered the main air cleaner 6 is caused to flow along the inner peripheral surface of the cleaner case 6a. Therefore, dust can be removed from the air by the cyclonic action, and the air can be filtered through the entire circumference of the filter. Thus, the filter is prevented from being locally clogged with dust. The interval for cleaning or replacing the filter is increased, and the air purifying efficiency of the filter is also increased. The filter is accordingly economical in use.

Although there has been described what is at present considered to be the preferred embodiment of the present invention, it will be understood that the invention may be embodied in other specific forms without departing from the spirit or essential characteristics thereof. The present embodiment is therefore to be considered in all aspects as illustrative, and not restrictive. The scope of the invention is indicated by the appended claims rather than by the foregoing description.

We claim:

1. A general-purpose internal combustion engine comprising:
 - an engine unit having a crank case and a cylinder;
 - a recoil starter disposed adjacent and coaxially with respect to said engine unit;
 - a fuel tank disposed over said crank case;
 - a main air cleaner and a muffler disposed on said engine unit laterally of said fuel tank in parallel

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relation to each other, said main air cleaner being located closely to said recoil starter, said muffler being disposed remotely from said recoil starter and above said cylinder;

- a precleaner connected to said main air cleaner and having an air inlet member disposed remotely from said muffler, said precleaner comprising an upper cleaner case and a lower dust pan which are detachably coupled to each other, said upper cleaner case having an air inlet duct projecting laterally and having a lower open end, said dust pan having said air inlet member which projects laterally and opens upwardly, said air inlet member defining an air inlet port directed substantially downwardly, said cleaner case and said dust pan being coupled together, with said air inlet duct and said air inlet member held in registry with each other.
2. A general-purpose internal combustion engine according to claim 1, wherein each of said fuel tank, said muffler, and said main air cleaner is substantially rectangularly shaped as viewed in plan.
3. A general-purpose internal combustion engine according to claim 1, wherein said air inlet duct and said air inlet member project tangentially from said cleaner case and said dust pan, respectively, said dust pan having a dust outlet hole defined in a bottom thereof and opening away from said air inlet port.
4. A general-purpose internal combustion engine according to claim 1, wherein said precleaner has an integral air duct at its upper portion, said air duct having an air outlet at an outer end thereof, said main air cleaner having an air inlet defined in a side thereof and connected to said air outlet, said air duct having an upper surface curved progressively upwardly toward said air outlet.
5. A general-purpose internal combustion engine according to claim 1, wherein said air duct of said pre-cleaner has a flange surrounding said air outlet, said air outlet and said air inlet being coupled by said flange, said precleaner engaging said main air cleaner at a position below said air outlet and said air inlet which are coupled to each other.
6. A general-purpose internal combustion engine according to claim 1, wherein said main air cleaner has an oval filter disposed centrally therein in alignment with a vertical axis thereof, said air inlet having a central axis sidewardly offset a distance from a horizontal axis of said main air cleaner.

* * * * *

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EXHIBIT P



US00D634333S

(12) **United States Design Patent**
Johnson et al.

(10) **Patent No.:** **US D634,333 S**
(45) **Date of Patent:** **** Mar. 15, 2011**

(54) **ENGINE**

(75) **Inventors:** **Brian Johnson**, Kewaskum, WI (US);
Caleb J. Palmer, Wauwatosa, WI (US)

(73) **Assignee:** **Briggs & Stratton Corporation**,
Wauwatosa, WI (US)

(**) **Term:** **14 Years**

(21) **Appl. No.:** **29/368,485**

(22) **Filed:** **Aug. 24, 2010**

(51) **LOC (9) Cl.** **15-01**

(52) **U.S. Cl.** **D15/1**

(58) **Field of Classification Search** D15/1,
D15/2, 3, 5, 6, 14, 17, 149; 123/22, 41.34,
123/51 A, 606 R, 52.1, 50 A, 50 B, 54.1,
123/54.2, 54.4, 54.5, 65 R, 195 R, 195 HC,
123/657, 311
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

| | | | | |
|----------------|---------|---------------|-------|-----------|
| D282,071 S * | 1/1986 | Nakamura | | D15/1 |
| 6,520,141 B2 * | 2/2003 | Ryzek et al. | | 123/198 E |
| D515,589 S * | 2/2006 | Lin et al. | | D15/1 |
| D529,046 S * | 9/2006 | Maeda et al. | | D15/1 |
| D536,004 S * | 1/2007 | Ryzek et al. | | D15/1 |
| D584,745 S * | 1/2009 | Wei et al. | | D15/1 |
| D595,737 S * | 7/2009 | Neeley et al. | | D15/1 |
| D605,661 S * | 12/2009 | Koehl | | D15/1 |
| D609,720 S * | 2/2010 | Buck | | D15/1 |

OTHER PUBLICATIONS

Photographs of various engine designs compiled Jun. 24, 2010, 1 page.
Snow Series Engines, <http://www.briggsandstratton.com/engines/snow-blower>, believed to be available by Aug. 25, 2010, 3 pages.

* cited by examiner

Primary Examiner — T. Chase Nelson

Assistant Examiner — Ania K Dworzecka

(74) *Attorney, Agent, or Firm* — Foley & Lardner LLP

(57) **CLAIM**

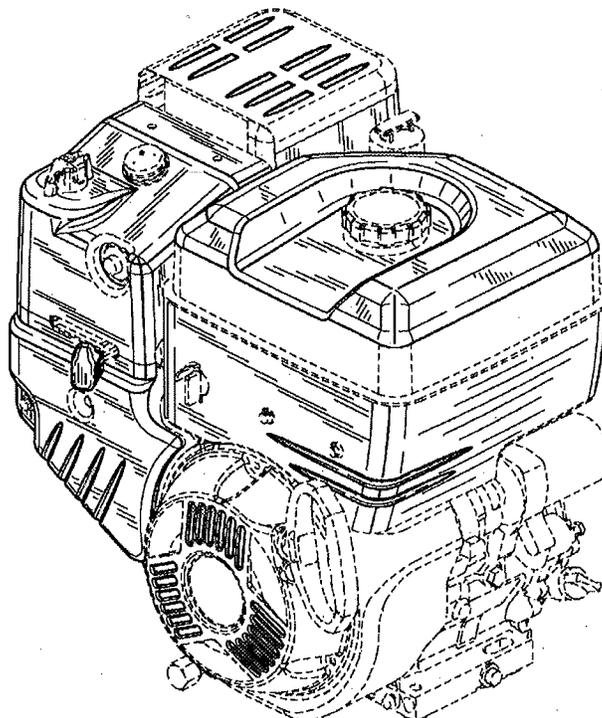
We claim the ornamental design for an engine, as shown and described.

DESCRIPTION

FIG. 1 is a top front perspective view of an engine showing our new design;
FIG. 2 is a top rear perspective view of the claimed design;
FIG. 3 is a front view of the claimed design;
FIG. 4 is a right side view of the claimed design;
FIG. 5 is a left side view of the claimed design;
FIG. 6 is a rear view of the claimed design;
FIG. 7 is a top view of the claimed design; and,
FIG. 8 is a bottom view of the claimed design.

The ornamental design that is claimed is shown in solid lines in the drawings. Any broken lines in the drawings are for illustrative purposes only and form no part of the claimed design.

1 Claim, 8 Drawing Sheets



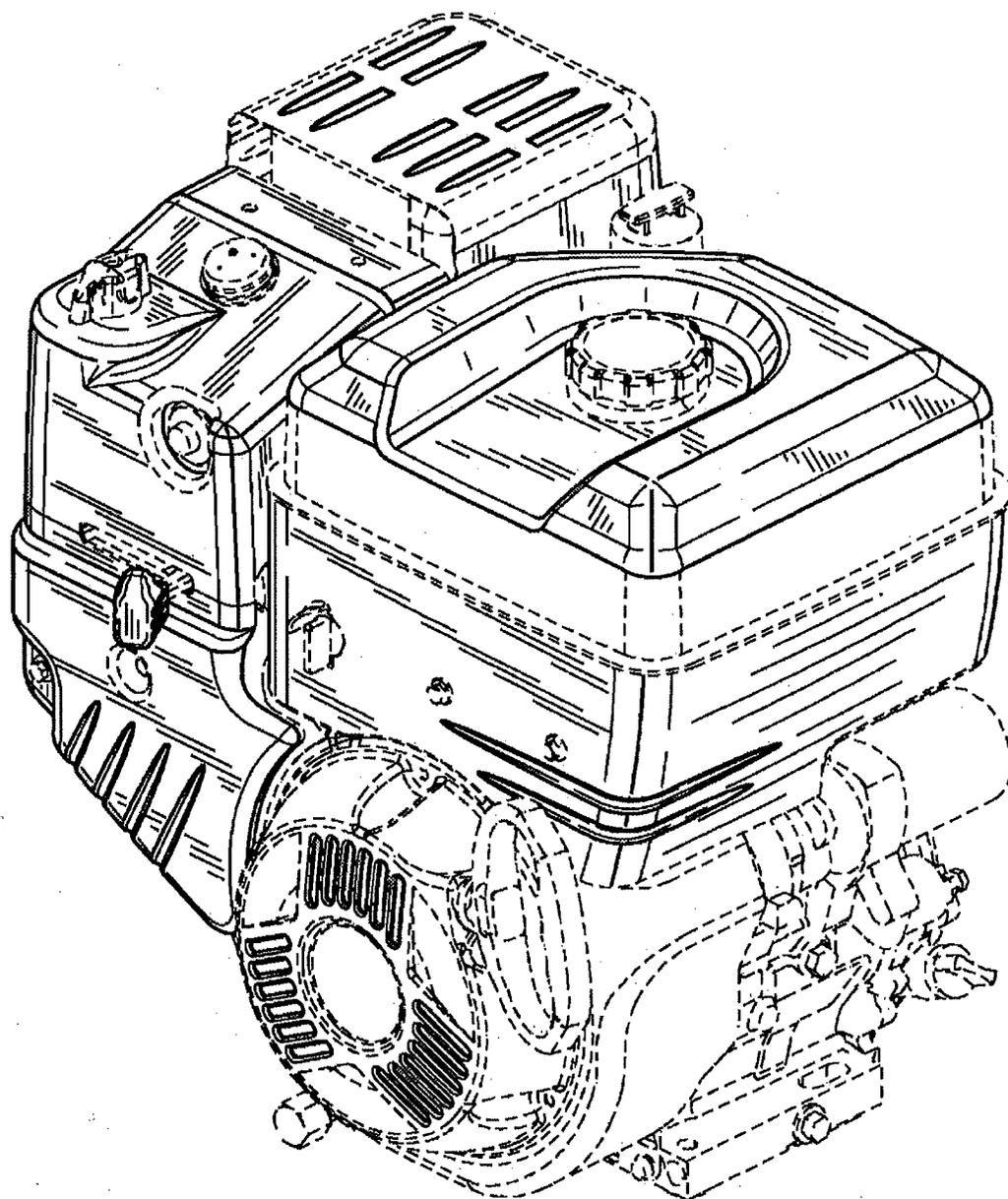


FIG. 1

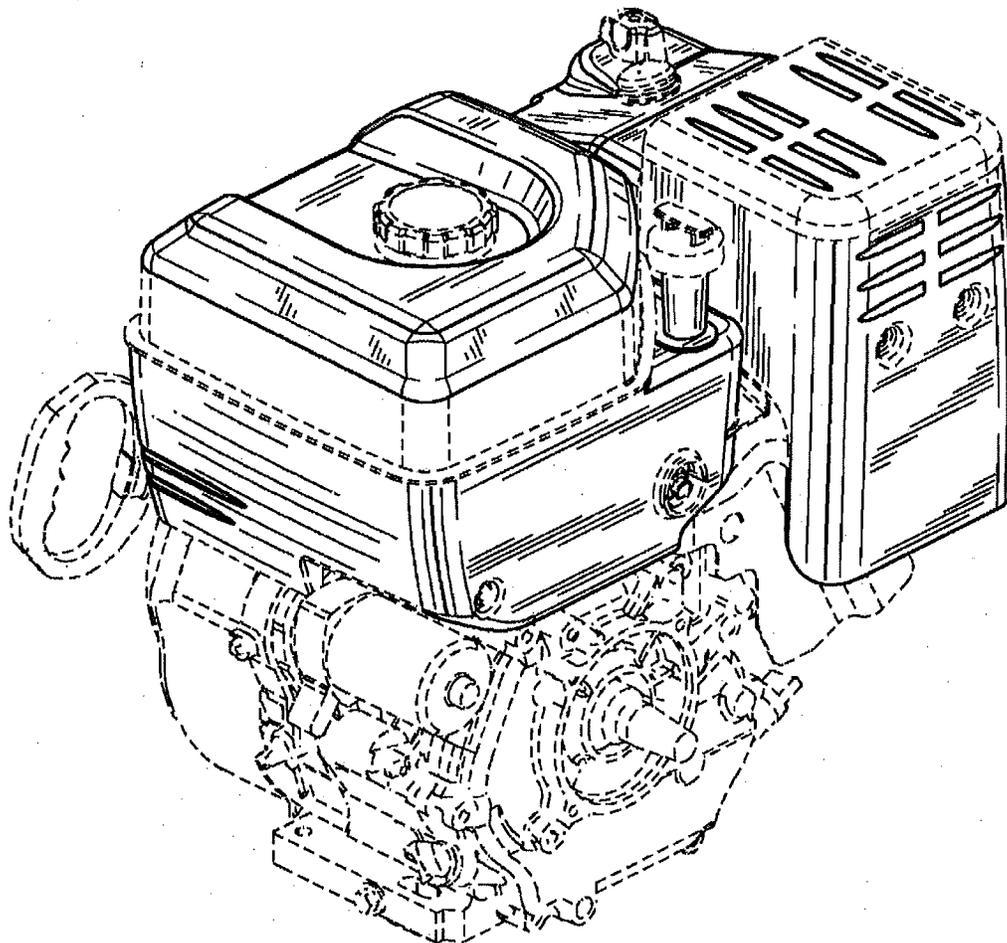


FIG. 2

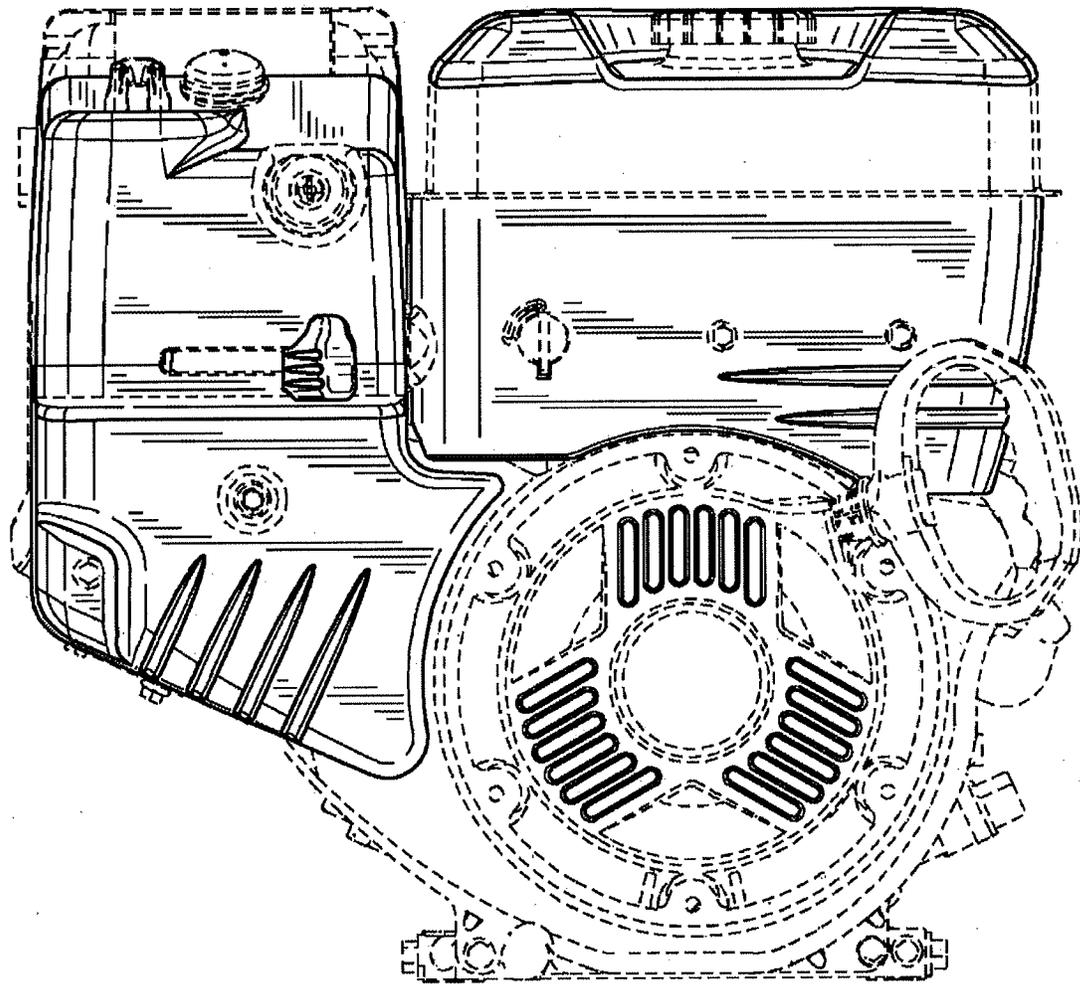


FIG. 3

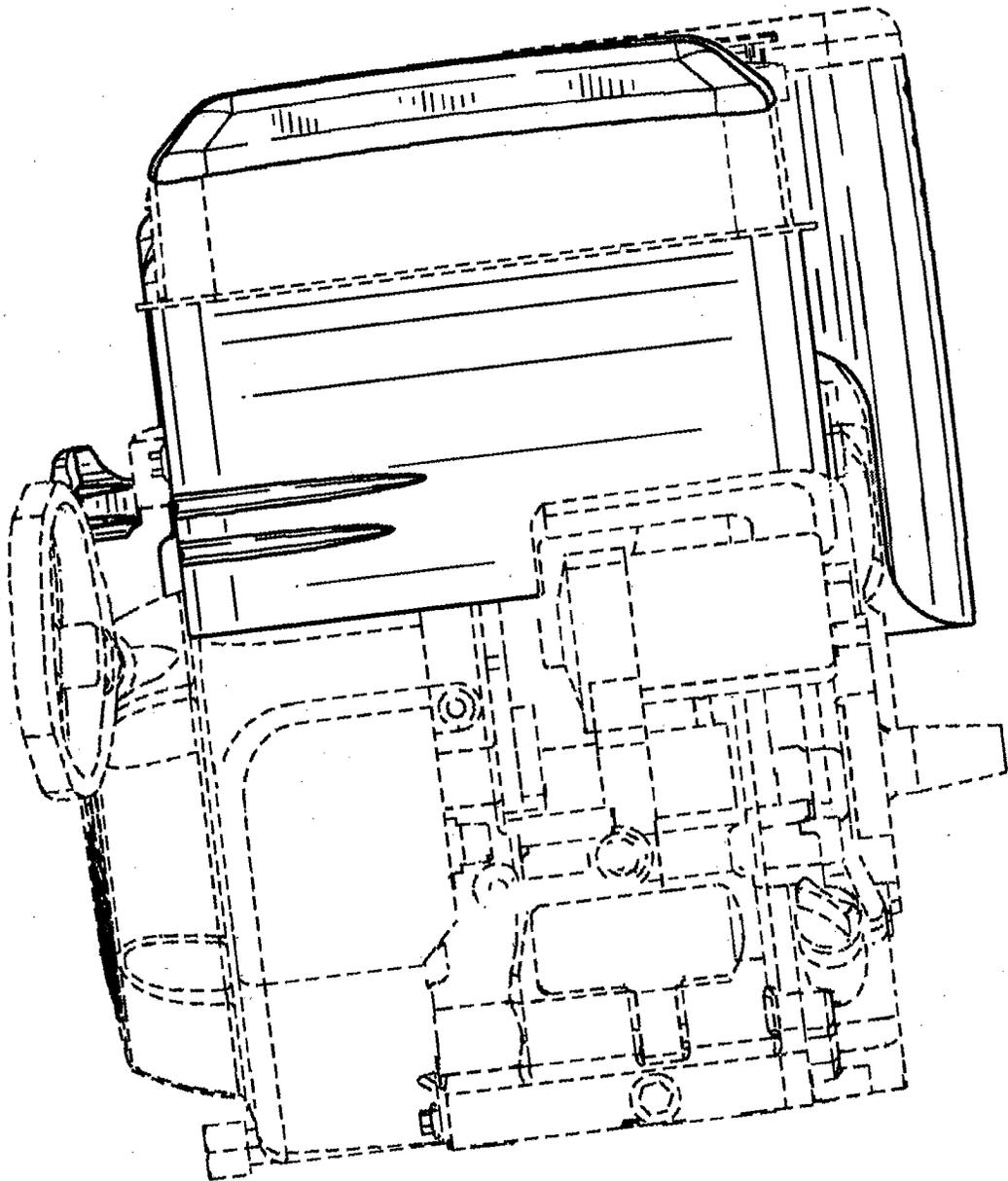


FIG. 4

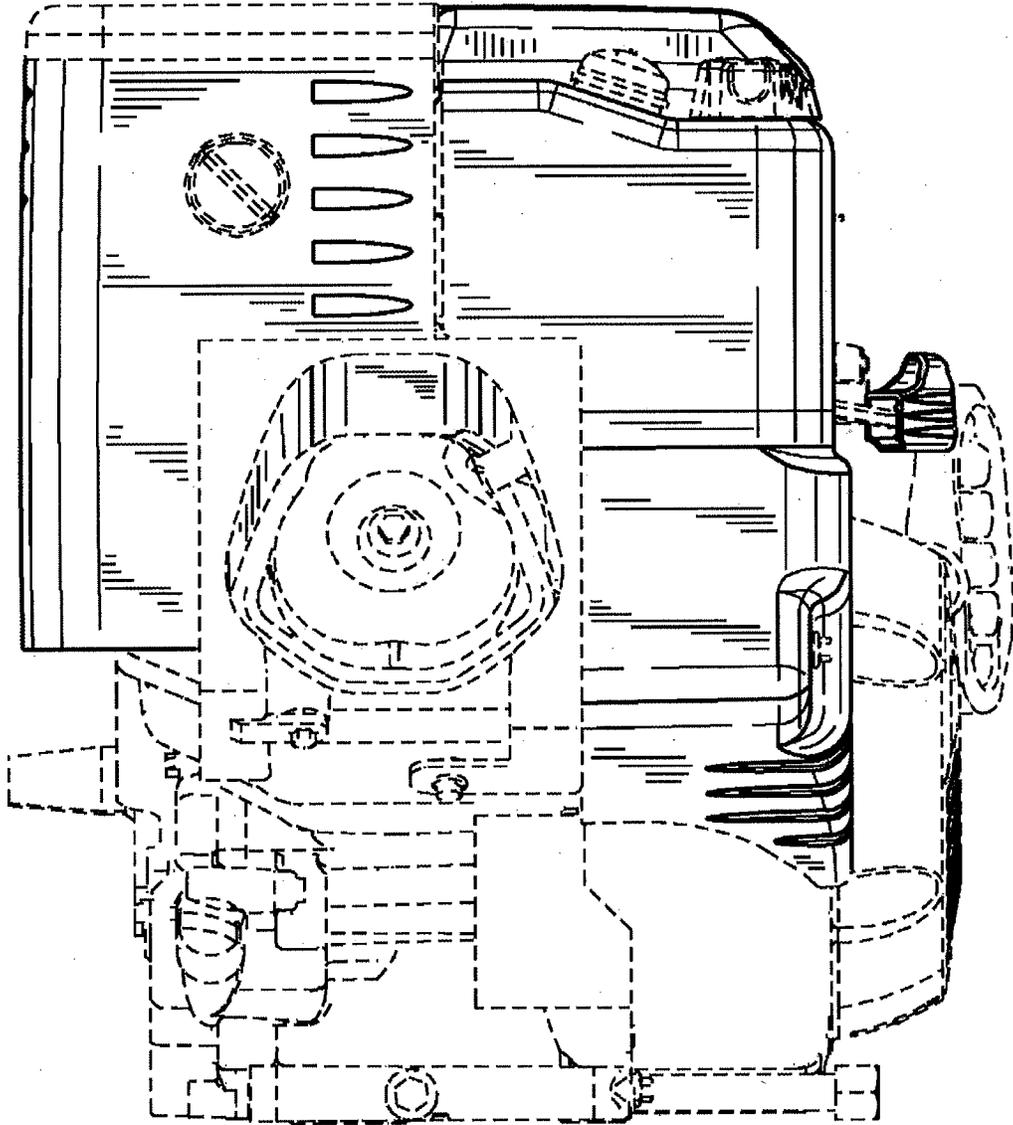


FIG. 5

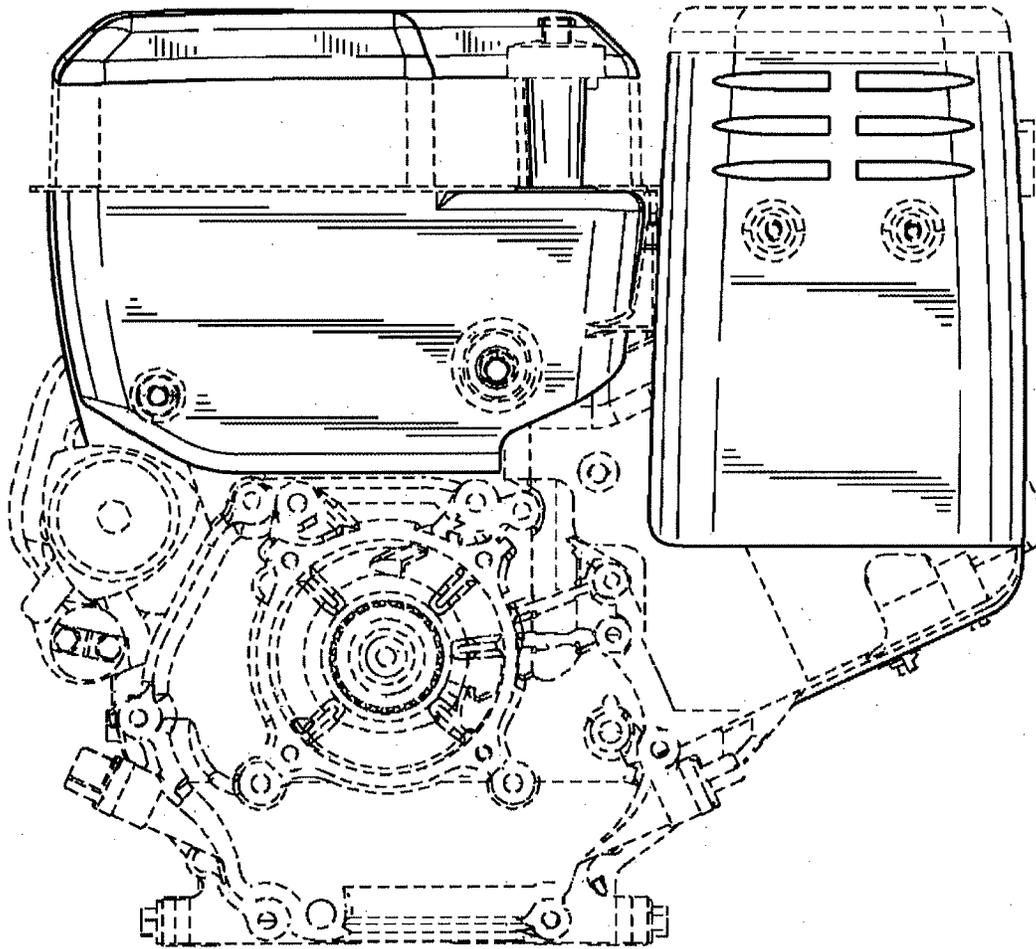


FIG. 6

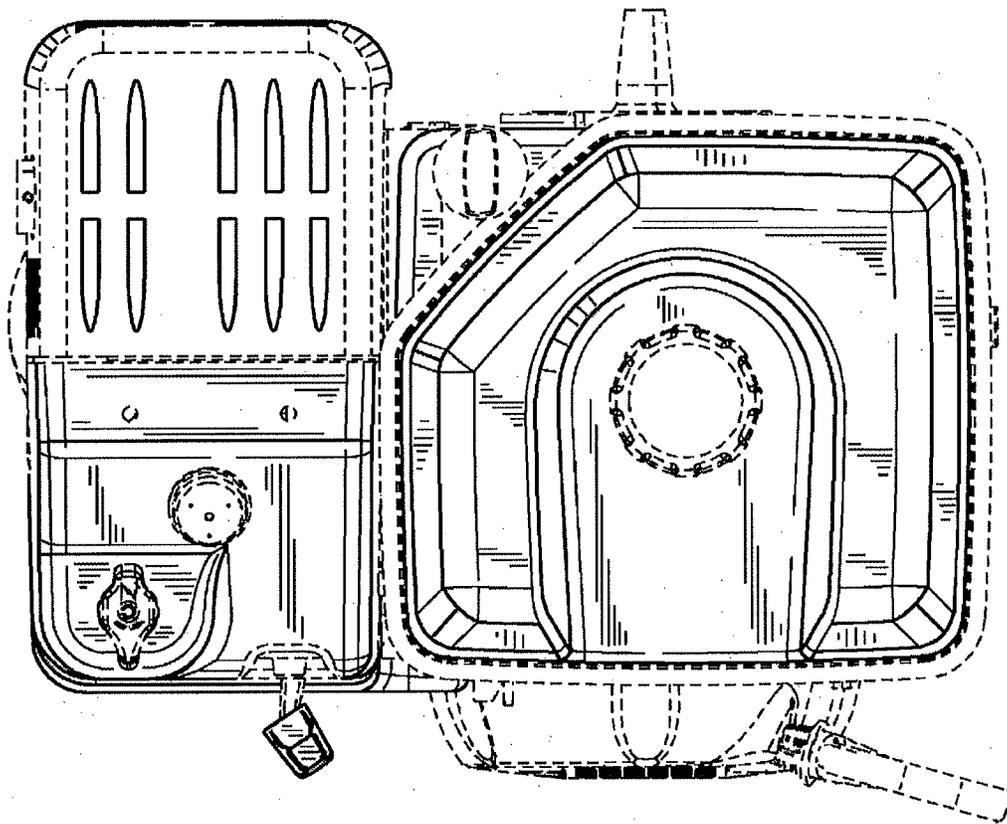


FIG. 7

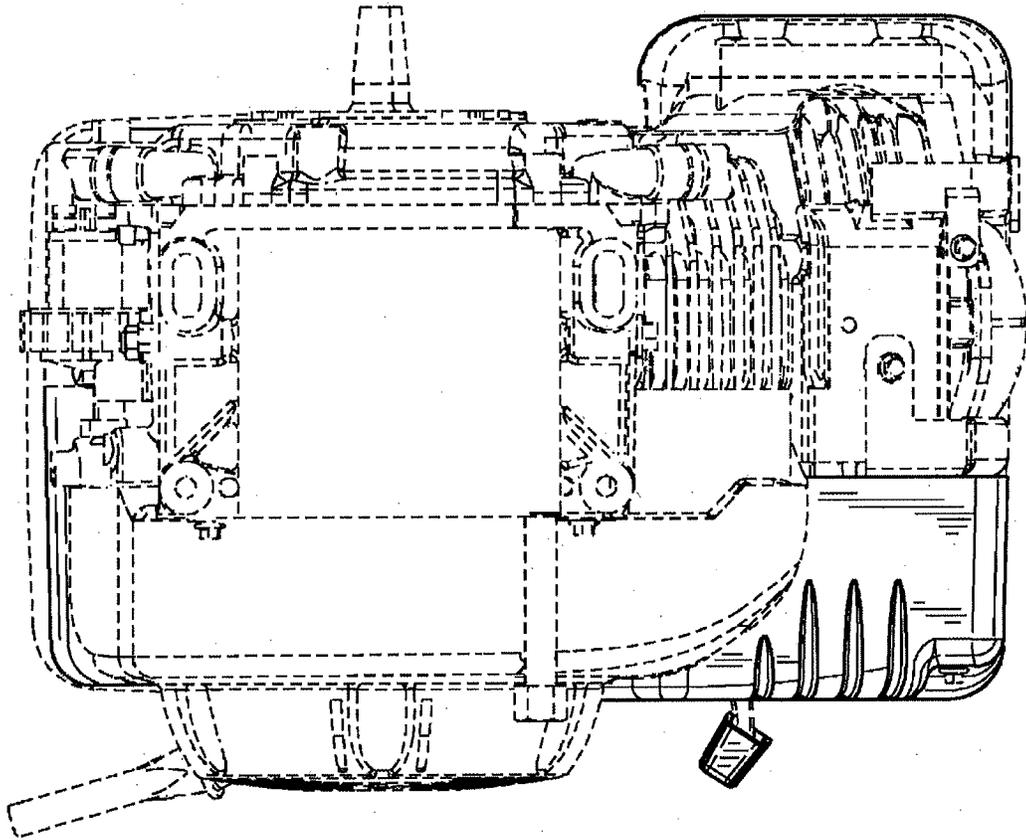


FIG. 8

EXHIBIT Q



US00D605661S

(12) **United States Design Patent**
Koehl

(10) **Patent No.:** **US D605,661 S**
(45) **Date of Patent:** **** Dec. 8, 2009**

- (54) **ENGINE**
 - (75) **Inventor:** **Richard R. Koehl**, Sheboygan Falls, WI (US)
 - (73) **Assignee:** **Kohler Co.**, Kohler, WI (US)
 - (**) **Term:** **14 Years**
 - (21) **Appl. No.:** **29/326,622**
 - (22) **Filed:** **Oct. 21, 2008**
 - (51) **LOC (9) Cl.** **15-01**
 - (52) **U.S. Cl.** **D15/1**
 - (58) **Field of Classification Search** **D15/1,**
D15/3, 5, 17; 123/50 A, 50 B, 50 R, 198 E,
123/70 R, 41.7, 306, 308, 667
- See application file for complete search history.

Consumer Engine Product Literature; Internet Screen Shots from consumer websites and Google; the screen shots are dated Mar. 03, 2009; 16 pages

Chart listing types and pictures of various commercial engines; 2 pages; Mar. 2, 2009* [Note: *This date is provided because it is believed that at least some of the pictures contained in this document were obtained from the Internet on or around Mar. 2, 2009].

* cited by examiner

Primary Examiner—Ian Simmons
Assistant Examiner—Wan Laymon
(74) *Attorney, Agent, or Firm*—Whyte Hirschboeck Dudek SC

(57) **CLAIM**

The ornamental design for an engine, as shown and described.

(56) **References Cited**

U.S. PATENT DOCUMENTS

| | | | | |
|--------------|---------|--------------|-------|-------|
| D282,071 S * | 1/1986 | Nakamura | | D15/1 |
| D309,612 S * | 7/1990 | Nakagawa | | D15/1 |
| D515,589 S * | 2/2006 | Lin et al. | | D15/1 |
| D516,580 S * | 3/2006 | Li | | D15/1 |
| D529,046 S * | 9/2006 | Maeda et al. | | D15/1 |
| D552,128 S * | 10/2007 | Li | | D15/1 |
| D561,784 S * | 2/2008 | Yin et al. | | D15/1 |
| D570,877 S * | 6/2008 | Glass et al. | | D15/1 |
| D579,026 S * | 10/2008 | Busschaert | | D15/1 |
| D583,829 S * | 12/2008 | Fan | | D15/1 |

OTHER PUBLICATIONS

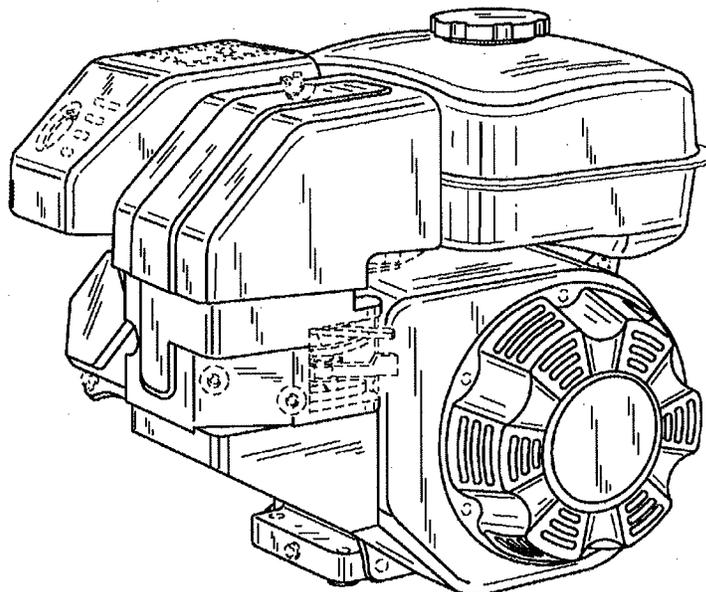
Commercial Engine Product Literature; Internet Screen Shots from commercial websites and Google; the screen shots are dated Mar. 3, 2009; 28 pages.

DESCRIPTION

- FIG. 1 is a front perspective view of an engine showing my new design;
- FIG. 2 is a front view thereof;
- FIG. 3 is a left side view thereof;
- FIG. 4 is a rear view thereof;
- FIG. 5 is a right side view thereof; and,
- FIG. 6 is a top view thereof.

The broken lines shown in the figures are for illustrative environmental purposes only and form no part of the claimed design.

1 Claim, 6 Drawing Sheets



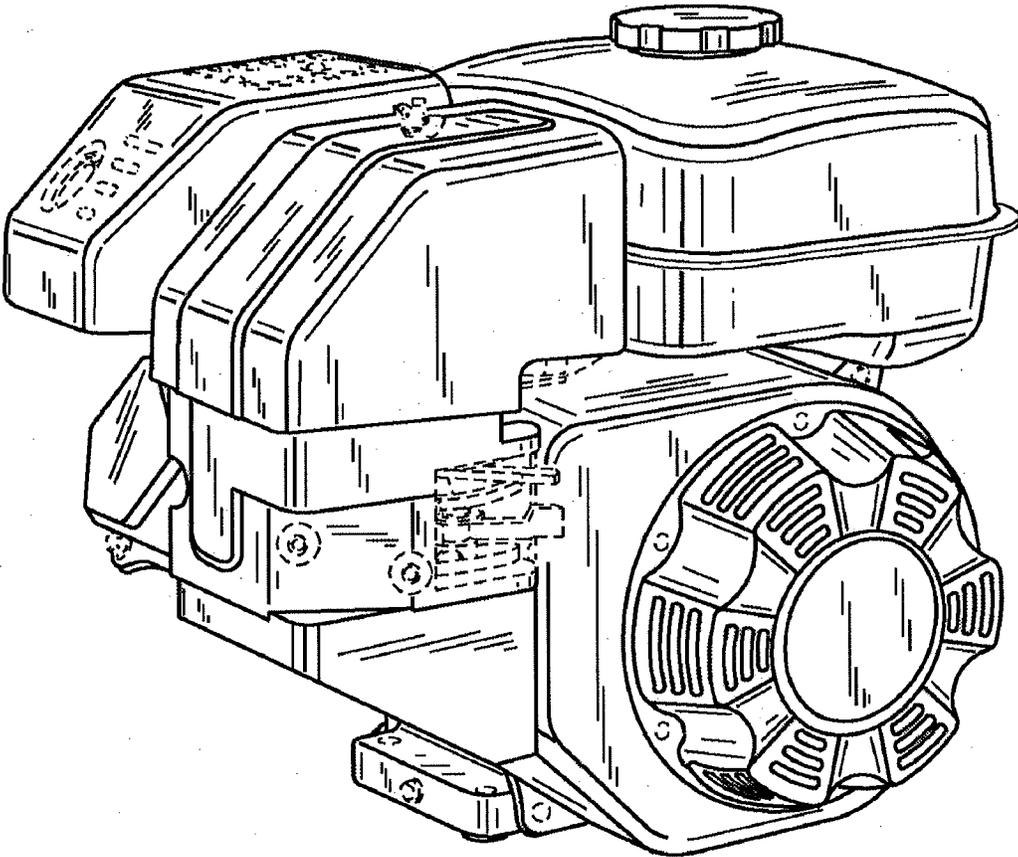


FIG. 1

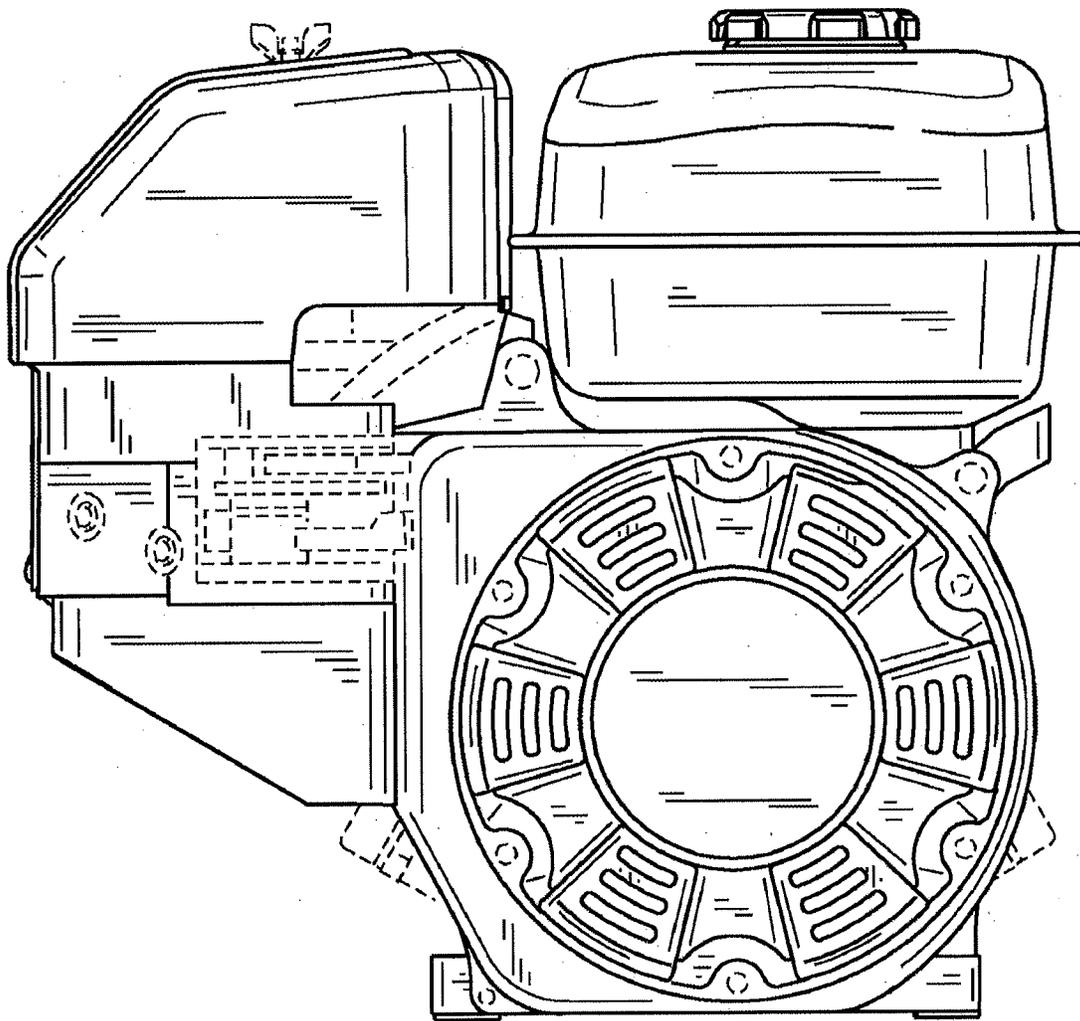


FIG. 2

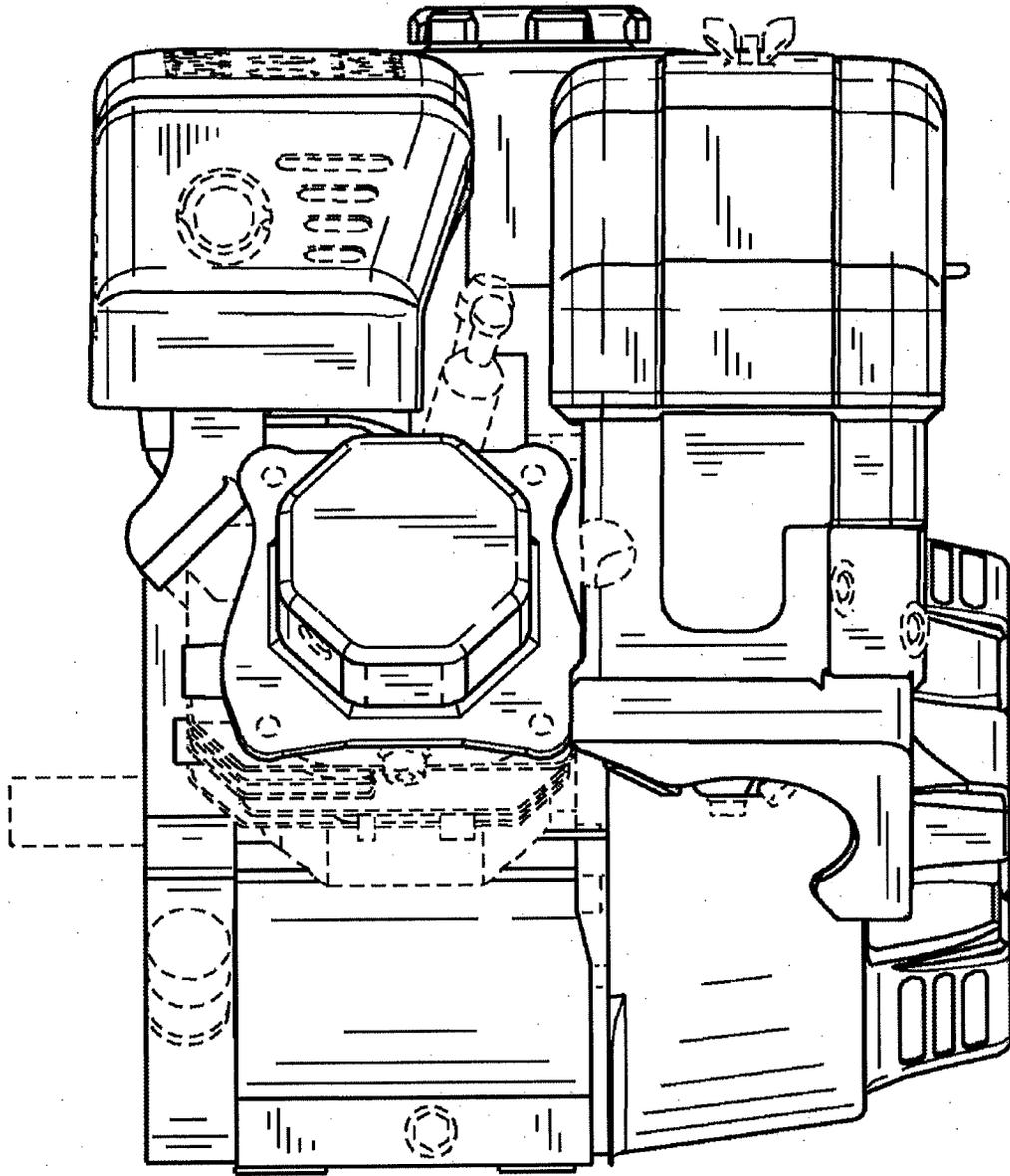


FIG. 3

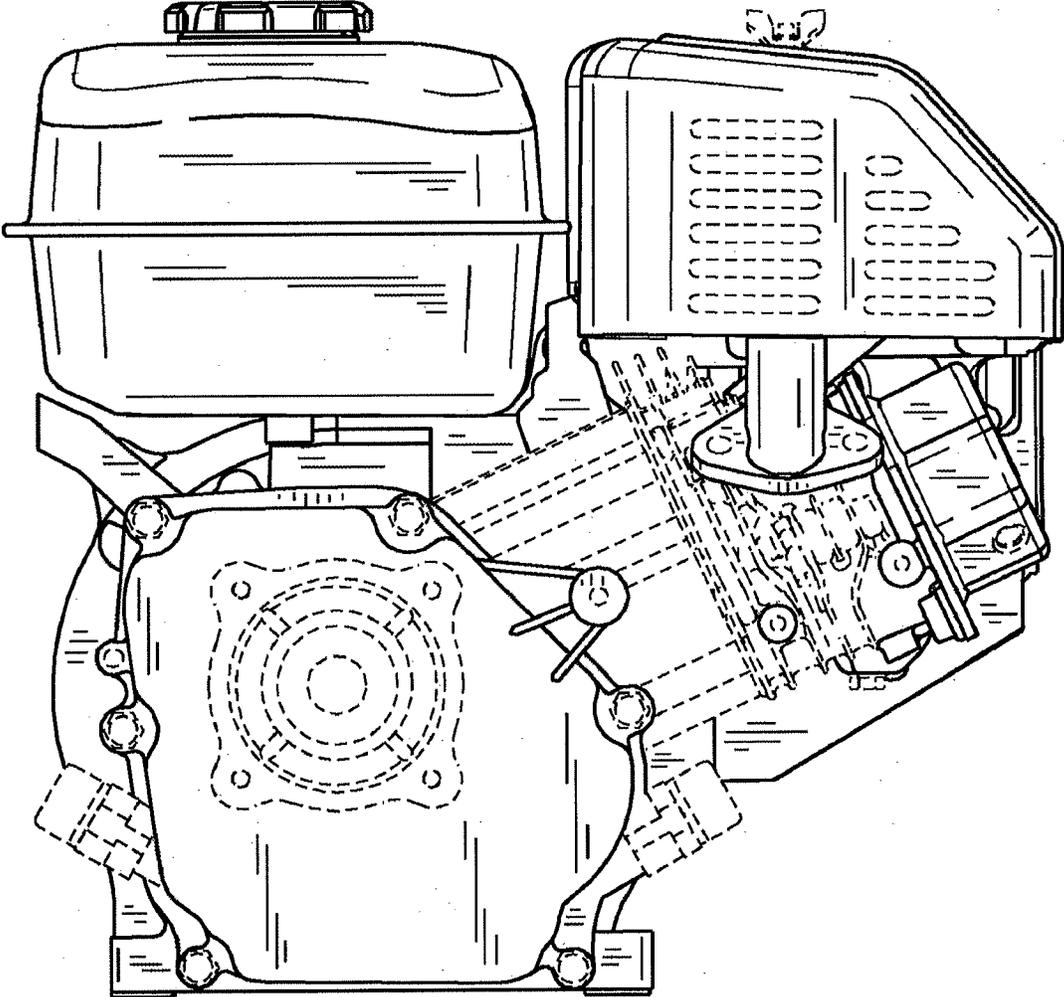


FIG. 4

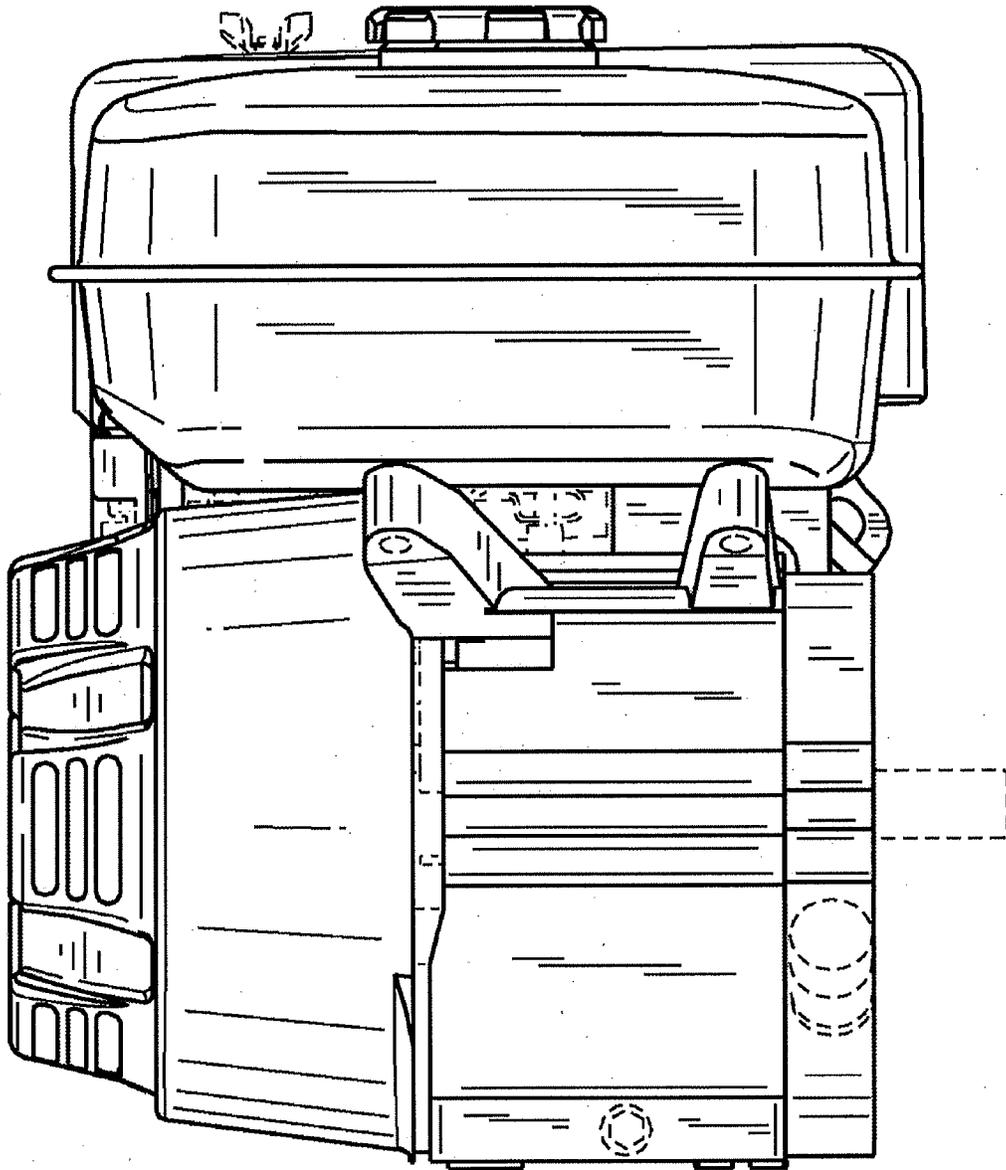


FIG. 5

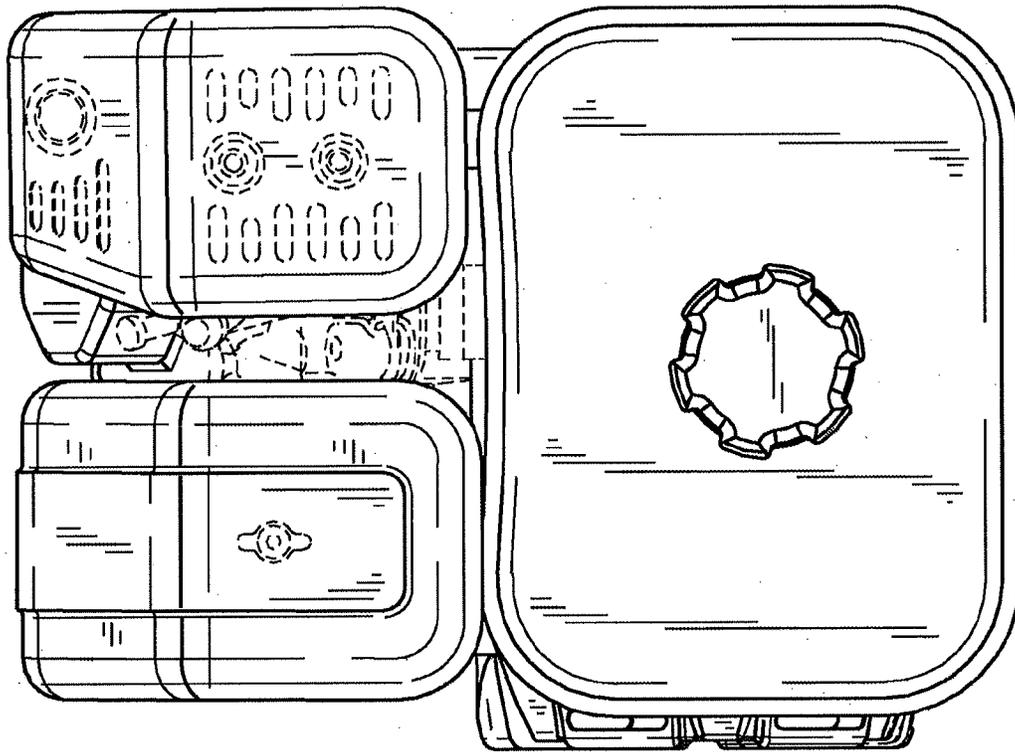


FIG. 6

EXHIBIT R



US00D595737S

(12) **United States Design Patent**
Neeley et al.

(10) **Patent No.:** **US D595,737 S**
(45) **Date of Patent:** **** Jul. 7, 2009**

- (54) **ENGINE**
- (75) Inventors: **Brian D. Neeley**, West Bend, WI (US);
Bart Mayer, Fond du Lac, WI (US)
- (73) Assignee: **Briggs & Stratton Corporation**,
Wauwatosa, WI (US)
- (**) Term: **14 Years**
- (21) Appl. No.: **29/306,238**
- (22) Filed: **Apr. 4, 2008**

- (51) **LOC (9) Cl.** **15-01**
 - (52) **U.S. Cl.** **D15/1**
 - (58) **Field of Classification Search** **D15/1,**
D15/3, 5, 17; 123/50 A, 50 B, 50 R, 198 E,
123/306, 308, 667, 41.7, 70 R
- See application file for complete search history.

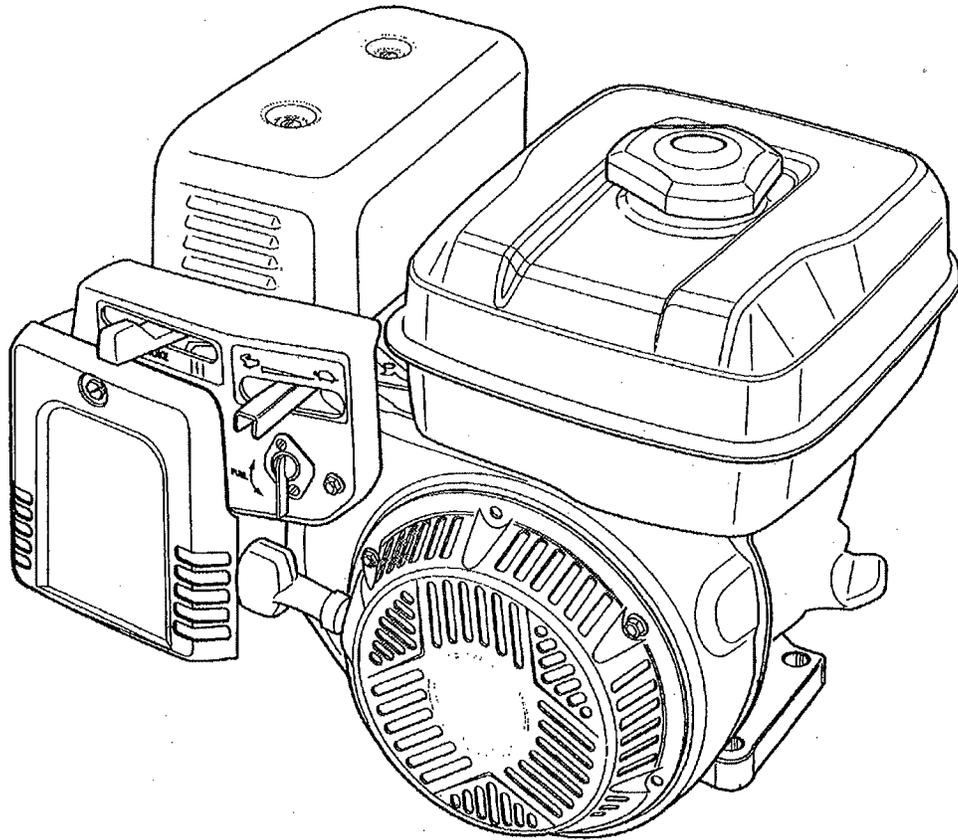
- (56) **References Cited**
U.S. PATENT DOCUMENTS
- | | | | | |
|--------------|--------|----------------|-------|-------|
| D324,221 S * | 2/1992 | Kiyooka et al. | | D15/1 |
| D398,010 S * | 9/1998 | Yoshida et al. | | D15/1 |
| D515,589 S * | 2/2006 | Lin et al. | | D15/1 |

D521,528 S * 5/2006 Kamijo et al. D15/1
* cited by examiner
Primary Examiner—Lisa P Lichtenstein
(74) *Attorney, Agent, or Firm*—Michael Best & Friedrich LLP

(57) **CLAIM**
We claim the ornamental design for an engine, as shown and described.

DESCRIPTION
FIG. 1 is a perspective view of an engine embodying the invention;
FIG. 2 is a front view of the engine of FIG. 1;
FIG. 3 is a first side view of the engine of FIG. 1;
FIG. 4 is a second side view opposite the first side view of the engine of FIG. 1;
FIG. 5 is a top view of the engine cover of FIG. 1;
FIG. 6 is a bottom view of the engine cover of FIG. 1; and,
FIG. 7 is a rear view of the engine cover of FIG. 1.

1 Claim, 7 Drawing Sheets



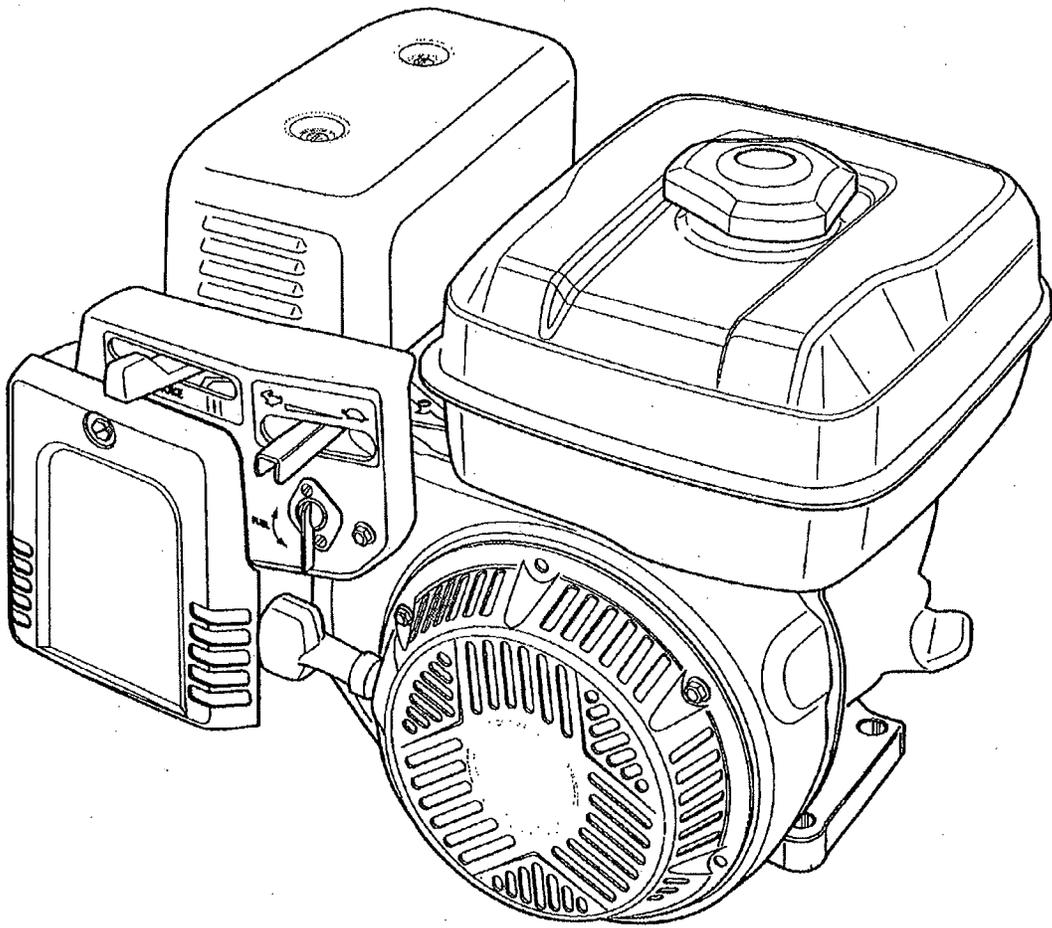


Fig. 1

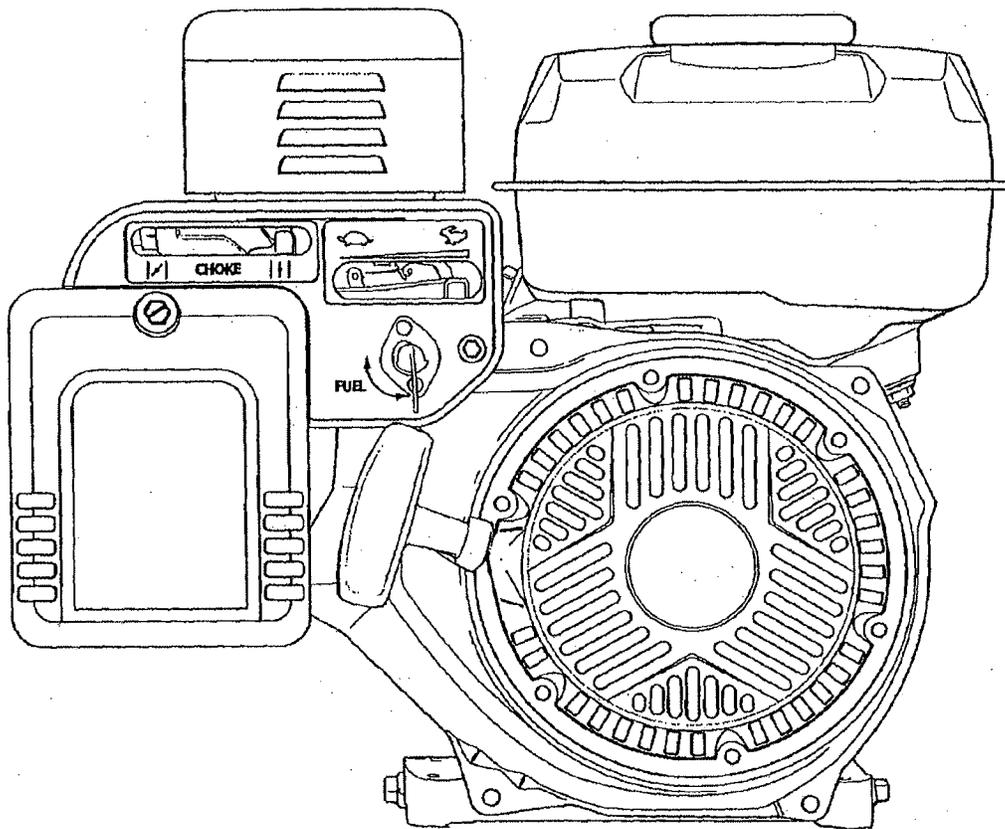


Fig. 2

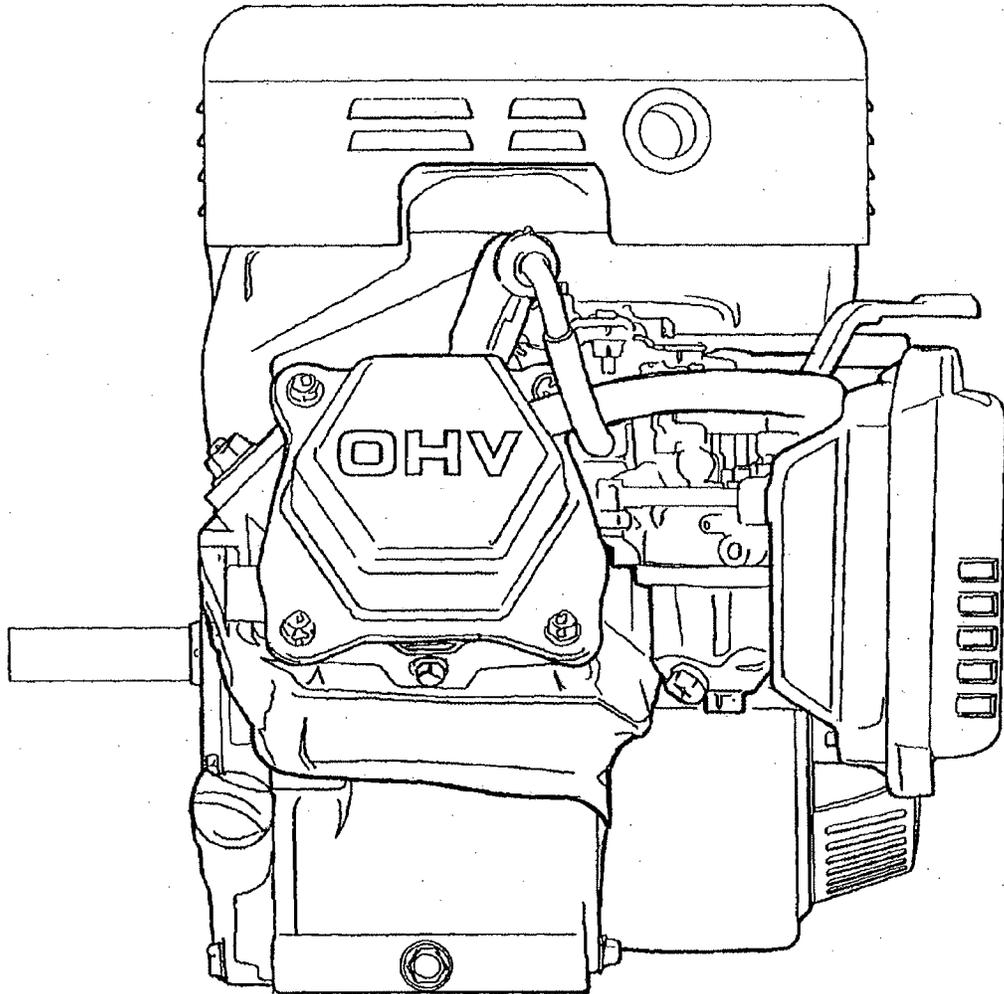


Fig. 3

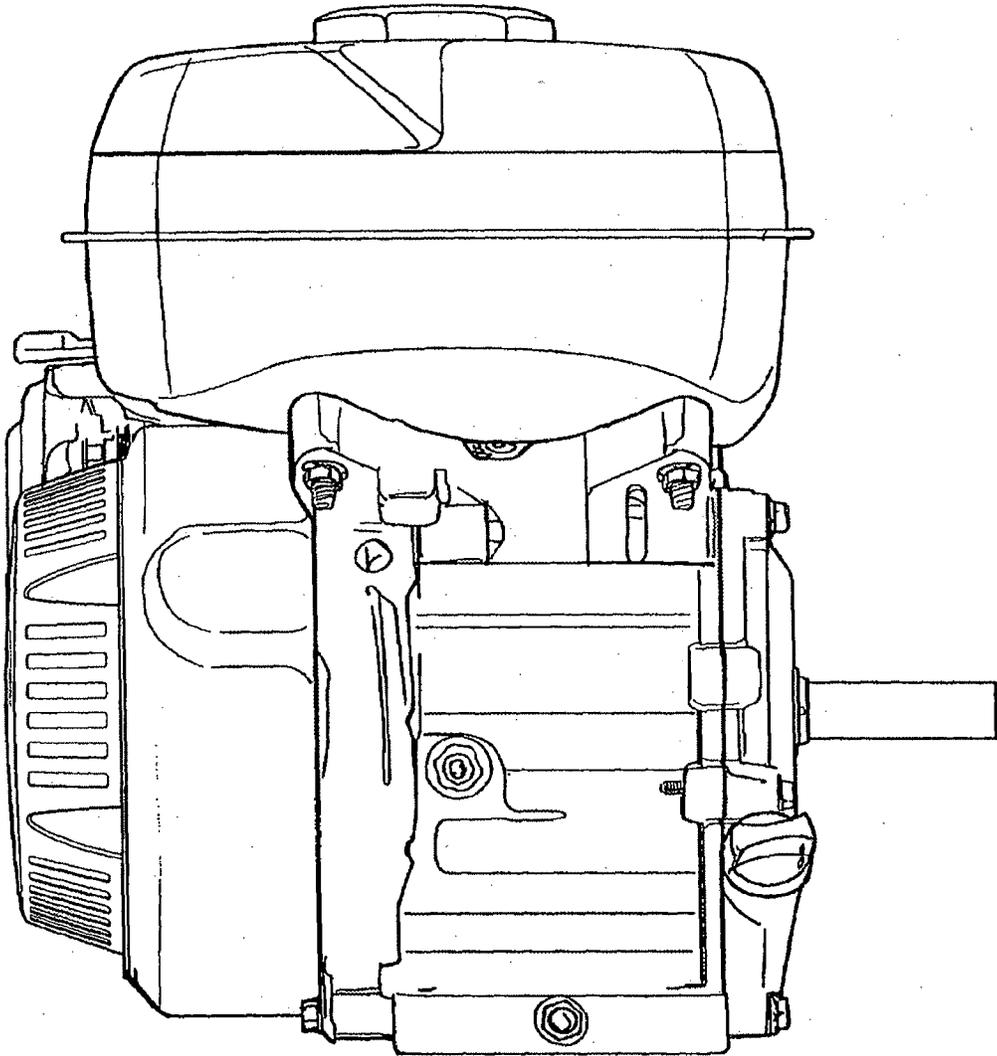


Fig. 4

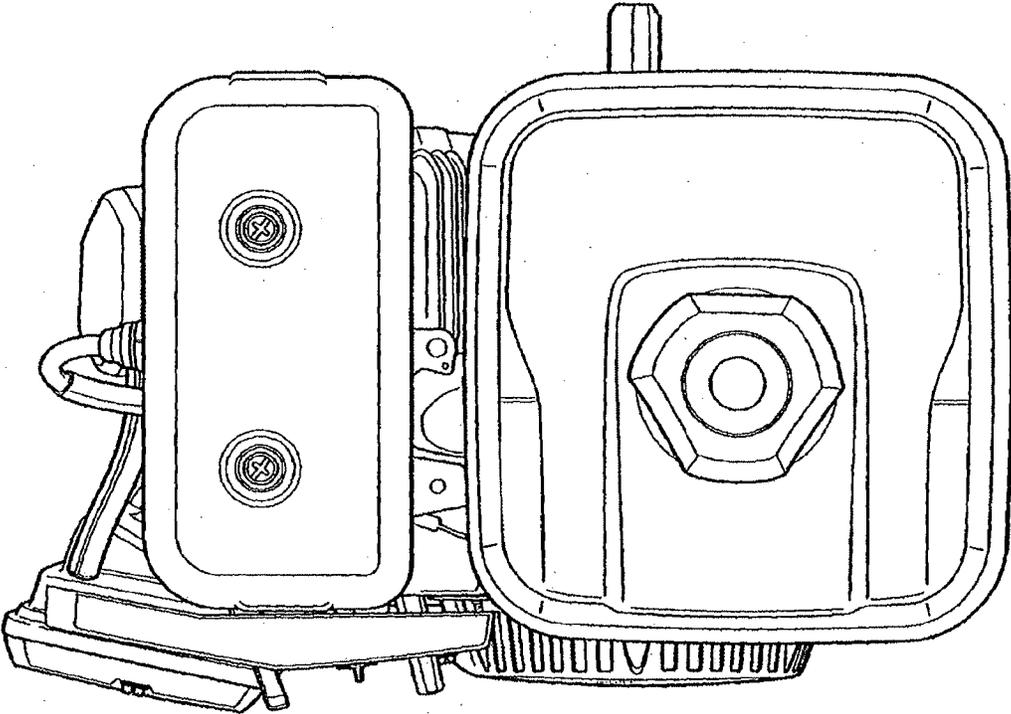


Fig. 5

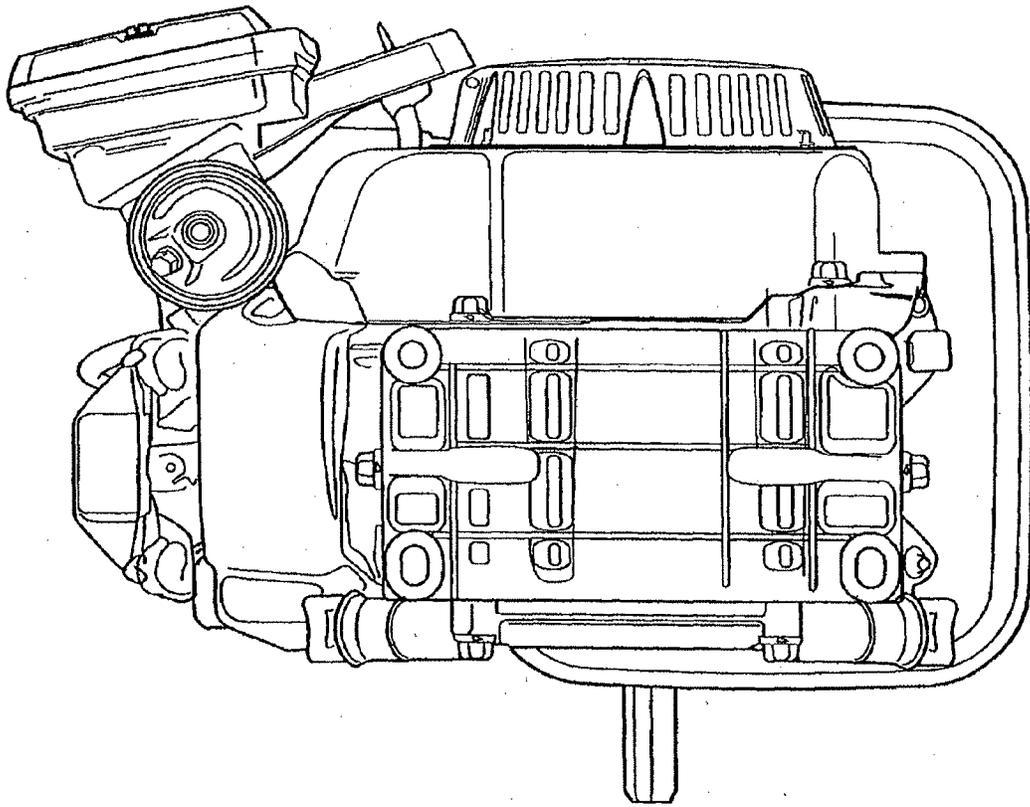


Fig. 6

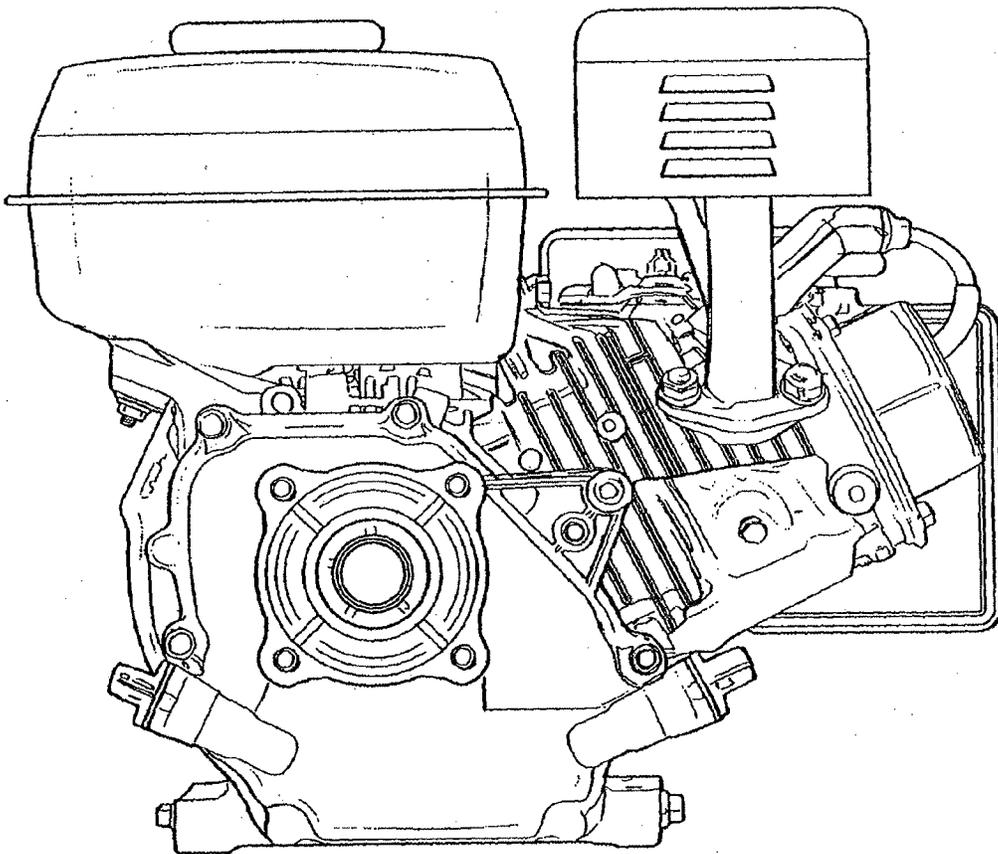


Fig. 7

EXHIBIT S
Filed Under Seal

EXHIBIT T
Filed Under Seal

EXHIBIT U



ENGINES | FIND A DEALER | PARTS & SUPPORT

OEM RESOURCES

Engine Quick Search

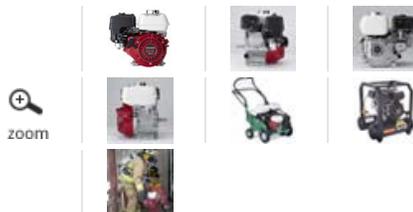
[View All](#)

- PRODUCT TYPE
All
- SERIES
All
- DISPLACEMENT
All
- CRANKSHAFT DIRECTION
All
- USE
All
- STARTING
All

Total Number of Results: 1

Reset Filters

- Engines
- Why choose Honda Engines
- Find brands powered by Honda
- Brochures



Quality and performance come standard.

GX120

Honda's GX series engines are legendary for superior reliability and performance. And there's no doubt about it: the GX120 lives up to the legend. Lower noise levels, lower vibration, and lower emissions – without sacrificing power output or performance.

COMMON APPLICATIONS

- Commercial lawn and garden equipment
- Tillers / cultivators
- Generators
- Construction / industrial equipment
- Agricultural equipment
- Water pumps

Owners Manual

Features

Specs

Performance Curve



FUEL EFFICIENT, HIGH OUTPUT OPERATION

- Precision camshaft design offers precise valve timing and optimal valve overlap for better fuel efficiency
- OHV design for increased efficiency and optimal power transfer
- High compression ratio for better fuel efficiency

SMOOTH PERFORMANCE

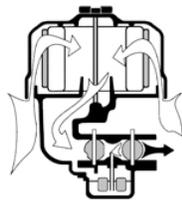
- Precision engineered components result in lower vibration
- Ball bearing supported crankshaft for greater stability

EXCEPTIONALLY QUIET

- Even quieter than previous model!
- Large capacity, multi-chamber exhaust system
- Reduced mechanical noise due to light weight, noise-reducing materials
- Forged steel crankshaft and rigid crankcase
- Helical cut gears
- Sophisticated air intake system

PROVEN RELIABILITY

- Oil Alert | [Learn More](#)
- New carburetor chamber coating and carburetor filter help to protect against fuel impurities
- Cast iron cylinder sleeve
- High quality materials, fit, and finish



Superior air filtration systems



- Dual element air cleaner
- Fuel Valve
- 3-Year Limited Warranty

EASY TO USE AND MAINTAIN

- Simple throttle control
- Large fuel tanks
- Large automotive type fuel cap
- Dual oil drains and fill
- Easy, convenient, heavy duty control box
- Easily accessible spark plug

EASY STARTING

- Heavy duty recoil starter
- Ergonomic, easy to grip recoil rope design
- Automatic mechanical de-compression system | [Learn More](#)

EMISSIONS COMPLIANT

- Lower emissions, same power output!
- CARB and EPA certified
- No catalyst necessary

AVAILABLE OPTIONS

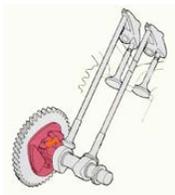
- Gear reduction options
- Spark arrester available



Ball bearing supported crankshaft



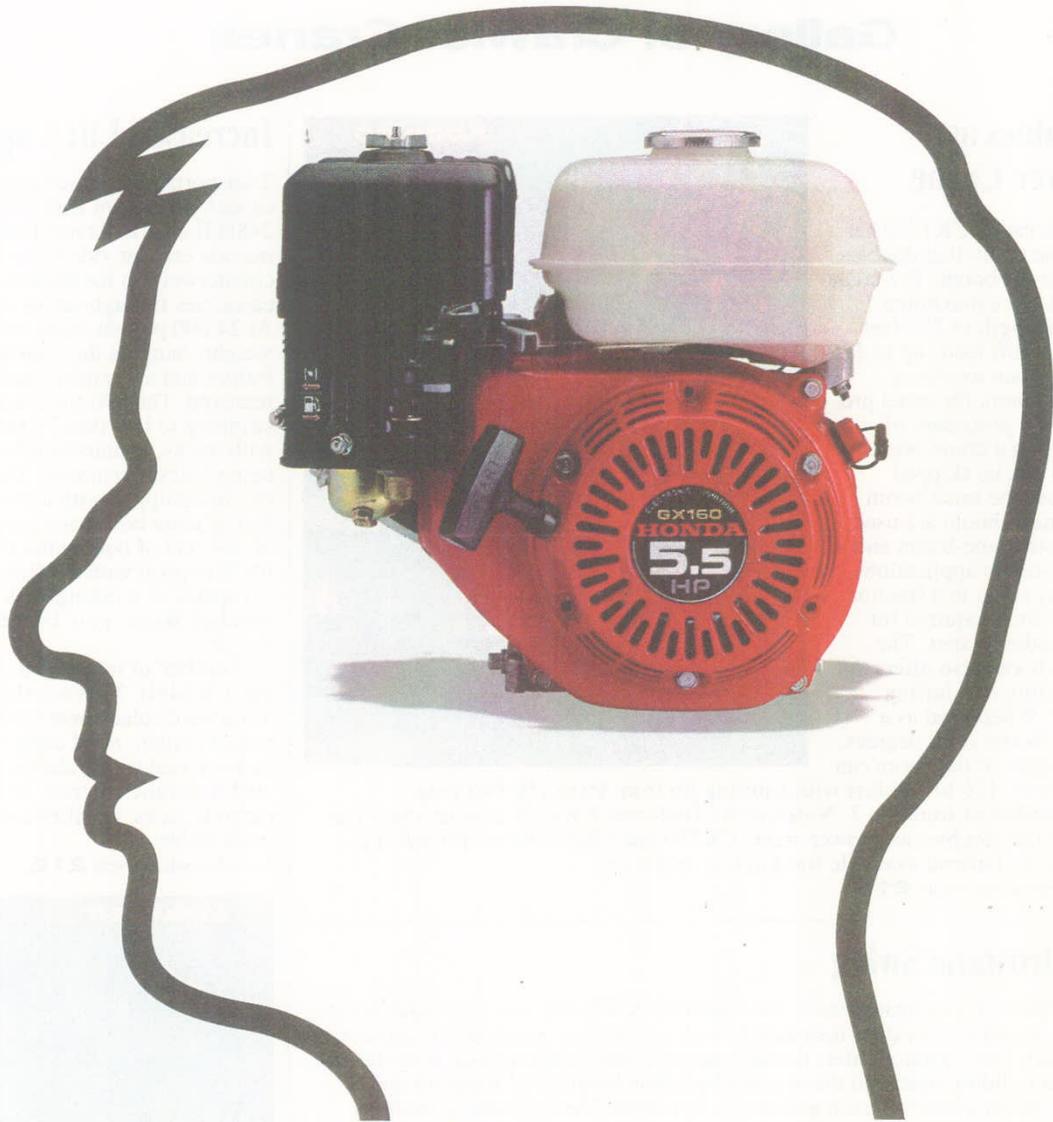
Dual oil drains and fill



Automatic mechanical decompression for easier starting



EXHIBIT V



It's the first thing a good foreman thinks of.

You've got more than enough to think about on the job without worrying about choosing an engine. You get to work quickly. They're also fuel efficient. In fact, our legendary OHV design is so efficient that we only

Luckily, there's Honda.

For years, the Honda Overhead Valve general purpose engine has been an industry standard for reliability and durability. To thousands of people, on thousands of construction sites.

Honda engines start easily, so you



HONDA
ENGINES
Power with a Clear Advantage.

had to make minor modifications to meet the current California and EPA emissions standards.

So if you're in the market for an engine that'll get the job done, there's really not much to think about.

Just make sure you get a Honda.

Call 1-800-426-7701 for more information.

©1996 American Honda Motor Co., Inc. For optimum performance and safety, please read the owner's manual before operating your Honda Power Equipment.

For information circle 42

AHPB 283922

AHGXC001548

EXHIBIT W



100% LEAN

We are the first to globally and universally adopt the SAE J1349 net horsepower standard for our entire line of engines.

By measuring horsepower with the manufacturer's production muffler and air cleaner in place, SAE J1349 provides our customers with lean and accurate representation of the operating power they will experience. Just another example of how the largest engine manufacturer is leading the way in the small engine world.

honda-engines.com



HONDA **ENGINES**

Built like no other.

©2007 American Honda Motor Co., Inc. For optimum performance and safety, please read the owner's manual before operating your Honda Power Equipment.

*Mass production engines may vary from this value. Actual power output for the engine installed in the final machine will vary depending on numerous factors, including the operation speed of the engine in application, environmental conditions, maintenance and other variables.

AHGXC000400

EXHIBIT X

Visit Us At
Booth 16607



Honda's Redesigned GX Engines. The Foundation Of Success.

With the newly-redesigned mid-range GX120, GX160, and GX200 to go along with the recently-introduced GX240, GX270, GX340 and GX390, the second generation of Honda GX Series Engines is now complete.

Featuring improved performance, lighter weight, great fuel economy and meeting EPA Phase 3 emission requirements without a performance-inhibiting catalyst, this is the winning lineup. Add to that Honda's 3-Year Warranty* and unsurpassed reputation for reliability and it's clear how Honda can help your business.

So come visit us at Booth 16607 and find out more concrete reasons to choose Honda.



engines.honda.com

*Warranty applies to all Honda GX Series Engines, 100cc or larger purchased at retail or put into rental service since January 1, 2009. Warranty excludes the Honda GXV160 model. See full warranty details at Honda.com. For optimum performance and safety, please read the owner's manual before operating your Honda Power Equipment.
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HONDA
ENGINES

Built like no other.

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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**DECLARATION OF SARAH FRAZIER IN SUPPORT OF
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, Sarah Frazier, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am an attorney duly licensed to practice law in the Commonwealth of Massachusetts. I am an Associate at the law firm of Wilmer Cutler Pickering Hale and Dorr LLP, counsel for Honda Giken Kogyo Kabushiki Kaisha (“Honda”), the Applicant in the above-entitled actions.

2. Honda employee Motohiro Fujita states that Honda invested between 1.2 and 1.3 billion yen into the development of the GX Engine. Declaration of Motohiro Fujita in Support of Applicant Honda Giken Kogyo Kabushiki Kaisha’s Opposition to Opposers’ Motion for

Summary Judgment ¶ 6. Based on 1981 exchange rates, this translates into over five million United States dollars.

3. Attached hereto as **Exhibit A** is a true and correct copy of the Order and Judgment in *PowerTrain v. Am. Honda Motor Co.*, Civ. No. 1:03-cv-668 (N.D. Miss. Aug. 28, 2007), produced by Honda in this opposition as AHGX0069675-AHGX0069677.

4. Attached hereto as **Exhibit B** is a true and correct copy of defendants Jiangdong and Homier's Motion for Summary Judgment in *Am. Honda Motor Co. v. The Pep Boys*, Civ. No. 05-8879 (C.D. Cal.), docket number 215, produced by Honda in this opposition as AHGX0066593- AHGX0066616.

5. Attached hereto as **Exhibit C** is a true and correct copy of the district court's November 13, 2007 Order, docket number 401, in *Am. Honda Motor Co. v. The Pep Boys*, Civ. No. 05-8879 (C.D. Cal.) produced by Honda in this opposition as AHGX0061776-AHGX0061799.

6. Attached hereto as **Exhibit D** is a true and correct copy of excerpts of the August 9 and 10, 2013 deposition of Honda Vice President Scott Conner in this opposition.

7. Attached hereto as **Exhibit E** is a true and correct copy of United States design patent D282,017, produced by Honda in this opposition as AHGX0067416-AHGX0067420.

8. Attached hereto as **Exhibit F** is a true and correct copy of the May 22, 2007 Settlement Agreement between American Honda Motor Co., Inc. and Liquid Combustion Technology LLC, produced by Honda in this opposition as AHGXC000080- AHGX000089.

9. Attached hereto as **Exhibit G** is a true and correct copy of the October 6, 2009 Settlement Agreement between American Honda Motor Co., Inc. and its affiliated companies and Champion Power Equipment, Inc. and its affiliated companies, produced by Honda in this opposition as AHGXC000009-AHGXC000024.
10. Attached hereto as **Exhibit H** is a true and correct copy of the April 6, 2010 Settlement Agreement between American Honda Motor Co., Inc. and Max Tool, produced by Honda in this opposition as AHGXC000090-AHGXC000097.
11. Attached hereto as **Exhibit I** is a true and correct copy of the February 5, 2010 Office Action regarding United States Trademark Application Number 78924545.
12. Attached hereto as **Exhibit J** is a true and correct copy of Honda's December 29, 2011 Objections and Responses to Opposer Briggs & Stratton Corporation's First Set of Requests for Production of Documents.
13. Attached hereto as **Exhibit K** is a true and correct copy of a 1981 Honda memorandum, produced by Honda in this opposition as AHGX0061354-AHGX0061380.
14. Attached hereto as **Exhibit L** is a true and correct copy of the document produced by Kohler Co. in this opposition as Kohler003571-Kohler003575.
15. Attached hereto as **Exhibit M** is a true and correct copy of excerpts of the August 15, 2007 deposition of Motohiro Fujita in the case *Am. Honda Motor Co. v. The Pep Boys*, Civ. No. 05-8879 (C.D. Cal.) produced by Honda in this opposition as AHGX0061169-AHGX0061282.

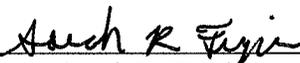
16. Attached hereto as **Exhibit N** is a true and correct copy of the document produced by Briggs and Stratton Corporation in this litigation as BASCO0000418-BASCO0000439.
17. Attached hereto as **Exhibit O** is a true and correct copy of excerpts from the March 4, 2009 Response to an Office Action regarding United States Trademark Application Number 78924545.
18. Attached hereto as **Exhibit P** is a true and correct copy of United States design patent D634,333.
19. Attached hereto as **Exhibit Q** is a true and correct copy of United States design patent D605,661.
20. Attached hereto as **Exhibit R** is a true and correct copy of United States design patent D595,737.
21. Attached hereto as **Exhibit S** is a true and correct copy of the document produced by Briggs and Stratton Corporation in this opposition as BASCO0000170-BASCO0000172.
22. Attached hereto as **Exhibit T** is a true and correct copy of the document produced by Kohler Co. in this opposition as Kohler005077-Kohler005080.
23. Attached hereto as **Exhibit U** is a true and correct copy of the website at <http://engines.honda.com/models/model-detail/gx120>, accessed on September 24, 2013.
24. Attached hereto as **Exhibit V** is a true and correct copy of the Honda advertisement produced by Honda in this opposition as AHGXC001548.

25. Attached hereto as **Exhibit W** is a true and correct copy of the Honda advertisement produced by Honda in this opposition as AHGXC000400.

26. Attached hereto as **Exhibit X** is a true and correct copy of the Honda advertisement produced by Honda in this opposition as AHGXC000562.

I declare under the penalty of perjury that the foregoing is true and correct.

Date: September 24, 2013



Sarah R. Frazier

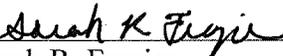
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Declaration of Sarah R. Frazier In Support of 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