

Goodman

**THIS OPINION IS NOT  
A PRECEDENT OF THE TTAB**

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

Mailed: December 16, 2013

Opposition No. **91200832**  
(parent)

Briggs & Stratton Corporation

v.

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

Opposition No. 91200146  
Kohler Co.

v.

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

**Before Taylor, Mermelstein and Bergsman, Administrative  
Trademark Judges.**

**By the Board:**

This case now comes up on opposers' motion, filed  
February 2, 2013, for summary judgment.<sup>1</sup> The motion is  
fully briefed.<sup>2</sup>

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<sup>1</sup> Opposer made a supplemental filing on August 23, 2013, with respect to deposition testimony given by representatives of applicant in a lawsuit filed by applicant's United States subsidiary, American Honda Motor Co., Inc. v. The Pep Boys-Manny, Moe & Jack, et al., U.S.D.C., Central District of California Case No. CV05-8879 SJO and CV06-0961 SJO. This testimony was previously submitted with opposers' motion for summary judgment under Trademark Rule 2.122(f). The August filing indicates that

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Upon careful consideration of the arguments and evidence presented, we find that disposition by summary judgment is not appropriate. At a minimum, there is a genuine dispute of material fact as to whether the utility patents submitted by opposers establish that the overall cubic design configuration is functional of the goods. The fact-intensive nature of whether the configuration as a

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this testimony was produced by applicant in connection with opposers' request for production and now is submitted under Trademark Rule 2.127(e)(2). A copy of the request for production has been provided. These exhibits have been considered.

<sup>2</sup> As noted in the Board's order issued August 5, 2013, opposers' premature reply, filed during the pendency of applicant's motion for Rule 56(d) discovery has not been considered.

whole is functional makes it particularly unsuited to summary judgment. *Confederated Tribes of Colville Reservation v. United States*, 964 F.2d 1102, 1109 (Fed. Cir. 1992) (noting that for fact-intensive issues, the trial court has the discretion to deny summary judgment).

In view thereof, the motion for summary judgment is denied.<sup>3</sup>

The parties are further informed that no further motions for summary judgment may be filed and the parties should expeditiously complete discovery and prepare for trial.

Proceedings are resumed. Opposers second amended notices of opposition (filed February 2, 2013) are accepted.<sup>4</sup>

Dates are reset as follows:

Answer to second amended complaints due: 1/26/2014

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<sup>3</sup> The fact that we have identified certain genuine disputes of material fact sufficient to deny opposers' motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the motion for summary judgment. Otherwise, to be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n. 2. (TTAB 1993).

<sup>4</sup> The Board previously granted opposers' leave to amend to file second amended notices of opposition on September 4, 2012.

Discovery Closes	2/10/2014 <sup>5</sup>
Plaintiffs' Pretrial Disclosures Due	3/27/2014
Plaintiffs' 30-day Trial Period Ends	5/11/2014
Defendant's Pretrial Disclosures Due	5/26/2014
Defendant's 30-day Trial Period Ends	7/10/2014
Plaintiffs' Rebuttal Disclosures Due	7/21/2014
Plaintiffs' 15-day Rebuttal Period Ends	8/20/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>5</sup> Expert disclosures and rebuttal expert disclosures have already been provided in this case so the expert disclosure date is not being reset. Previously, proceedings had been suspended to complete expert discovery. Should expert discovery remain outstanding, the parties may request further suspension of proceedings as appropriate.