

This Opinion is a
Precedent of the TTAB

Hearing: January 24, 2017

Mailed: December 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kohler Co.

v.

Honda Giken Kogyo K.K.

Opposition No. 91200146

Kenneth R. Nowakowski of Husch Blackwell LLP for Kohler Co.

Vinita Ferrera of Wilmer Cutler Pickering Hale and Dorr LLP for Honda Giken Kogyo K.K.

Before Adlin, Heasley, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

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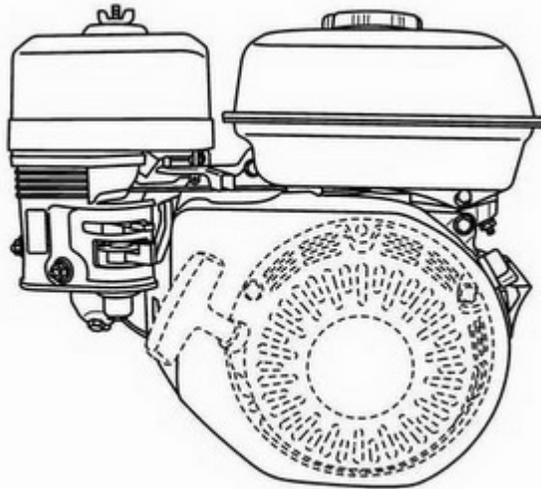
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Introduction

Honda Giken Kogyo K.K. (“Applicant” or “Honda”) seeks registration on the Principal Register under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the product configuration mark shown below for “engines for use in construction, maintenance and power equipment,” in International Class 7:¹



The mark is described in the application as follows:

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 to the left of the fuel tank. The air cleaner cover features a cube shape with beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and the top of the belt-like area is aligned with a rib of the fuel tank. The carburetor cover features four ribs along its outside edge and a recessed area where control levers are located. The

¹ Application Serial No. 78924545 was filed on July 7, 2006 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claim of first use in October 1983 and first use in commerce in December 1984.

fuel tank is roughly rectangular. The engine features a beveling that runs around its top circumference.

Color is not claimed as a feature of the mark. Applicant has disclaimed the exclusive right to use “the design mark’s purely functional components, namely levers, bolts, nuts and caps.”

Three companies, Cummins Inc. (“Cummins”), Briggs & Stratton Corporation (“Briggs & Stratton”), and Kohler Company (“Kohler” or “Opposer”), filed separate oppositions to registration of Applicant’s claimed mark.² The Cummins opposition was dismissed and the Briggs & Stratton and Kohler oppositions were consolidated on February 9, 2012, with the Briggs & Stratton opposition designated as the “parent” case. Following the parties’ submission of evidence and briefs, and shortly before the scheduled oral hearing, Briggs & Stratton and Applicant settled and stipulated to dismissal of Opposition No. 91200832 with prejudice. 226 TTABVUE 2.³ The Board dismissed that opposition. 228 TTABVUE.

Kohler’s Opposition No. 91200146 remains for decision. The case is fully briefed and the parties appeared at an oral hearing before the panel on January 24, 2017. We sustain the opposition on two of the four pleaded claims and do not reach the others.⁴

² Cummins filed Opposition No. 91187217, Kohler filed Opposition No. 91200146, and Briggs & Stratton filed Opposition No. 91200832.

³ Because the entire trial record is in the file of the now-dismissed Opposition No. 91200832, citations in this opinion are to the TTABVUE docket in that case. References in this opinion to “Opposer” may include Briggs & Stratton as well as Kohler, as the context requires.

⁴ “Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . [T]he Board’s determination

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