An Empirical Assessment of the Eveready Survey’s Ability to Detect Significant Confusion in Cases of Senior Marks That Are Not Top-of-Mind
Hal Poret

Commentary: The Science of Proving Trademark Dilution
Barton Beebe, Roy Germano, Christopher Jon Sprigman, and Joel H. Steckel

Reflection: Trademark Office: Year-End Wrap-Up
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AN EMPIRICAL ASSESSMENT OF THE EVEREADY SURVEY’S ABILITY TO DETECT SIGNIFICANT CONFUSION IN CASES OF SENIOR MARKS THAT ARE NOT TOP-OF-MIND

By Hal Poret∗

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I. INTRODUCTION

One of the most significant and frequently debated topics in connection with the use of surveys to assess likelihood of confusion in Trademark Trial and Appeal Board (TTAB) and district court trademark infringement cases involves the applicability and reliability of the well-established “Eveready survey” format. One proposition advanced at times by certain commentators and frequently cited by attorneys seeking to challenge survey evidence is that an Eveready survey is appropriate only to test for likelihood of confusion in cases where the senior mark1 is “top-of-mind.”2 This article presents survey research designed and conducted under this author’s direction to empirically test the ability of the Eveready survey to detect significant levels of confusion—that is, levels sufficient to support a finding that there is a likelihood of confusion—in certain scenarios involving senior marks that are not top-of-mind. The research described herein empirically demonstrates that Eveready surveys are capable of detecting significant levels of confusion in some cases of senior marks that are not top-of-mind. Accordingly, the proposition that an Eveready survey is appropriate3 only in the case of senior marks that are top-of-mind is not valid, and the fact that a senior mark is not top-of-mind should not, on its own, be grounds for rejection of an Eveready survey.

Part II of this article describes the Eveready survey format. Part III discusses the potential relevance of consumer awareness to the accuracy and reliability of the Eveready survey format’s findings regarding likelihood of confusion. Part IV summarizes prior discussion of the issue of “top-of-mind” awareness in the literature.

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1 Such a proposition regarding “top-of-mind” awareness applies to the senior mark in the traditional case of forward confusion, because the survey exposes respondents to the junior mark and determines whether respondents report a connection to the senior mark. In the case of reverse confusion, where respondents would instead be exposed to the senior mark, the corresponding proposition would concern whether there is top-of-mind awareness of the junior mark. Unless otherwise noted, the discussion herein assumes matters involving forward confusion, and all the surveys conducted for this article measure forward confusion.

2 See, e.g., Phyllis Welter, Trademark Surveys, § 24.03[1][c] (1999); Jerre B. Swann, Likelihood of Confusion Studies and the Straitened Scope of Squirt, 98 TMR 739, 740-43, 745-46 (2008) (hereafter “Straitened Scope”). As discussed in more detail below, “top-of-mind” is a common market research concept that measures or reflects the frequency with which a brand comes to a consumer’s mind on an unaided basis when prompted only with a generic product category.

3 The term “appropriate” is used herein to refer to situations where the Eveready format is capable of detecting significant levels of confusion (if confusion is indeed likely) and, therefore, should not be rejected as either inadmissible or deserving of no weight solely because the Eveready format was employed. “Appropriate” is not intended to mean that the survey format is the correct strategic choice for a particular party or that the survey format is the best or only option that could generate reliable data on the topic of likelihood of confusion. That question is beyond the scope of this paper.
regarding the Eveready survey and explores deficiencies in the theoretical basis for this purported requirement. Part V presents the design and methodology of surveys testing the extent to which the Eveready survey successfully detects confusion at levels meaningful enough to potentially support a finding of likelihood of confusion in certain cases involving the use of trademarks that are similar to senior marks that are not-top-of-mind. Part VI examines the data from these surveys and discusses the implications for the accuracy and reliability of Eveready surveys in cases involving senior marks that do not enjoy top-of-mind awareness.

II. THE EVEREADY FORMAT

The Eveready survey derives its name from a survey conducted to test whether use of the brand EVER-READY in connection with a lamp was likely to cause confusion with the EVEREADY mark for batteries.4 Respondents in the survey were shown a picture of the allegedly infringing EVER-READY lamp and were asked who had manufactured it. The survey then asked respondents to name any other products put out by the same concern. While relatively few respondents identified the plaintiff (Union Carbide) as the source of the lamp, a substantial percentage of respondents answered that the concern putting out the lamp also sold batteries. This was seen as establishing that respondents mistakenly connected the defendant’s EVER-READY lamp with the maker of EVEREADY batteries.

The term “Eveready” has since come to identify the category of confusion surveys in which respondents view only the allegedly infringing mark and are asked questions to determine whether, without additional stimulus, they report a mistaken connection to the senior mark, in contrast to a survey format (commonly referred to as “Squirt”) in which both parties’ marks are shown and respondents are directly asked about a potential connection between the parties.5

III. THE POTENTIAL RELEVANCE OF CONSUMER AWARENESS

Because the Eveready survey does not expose respondents to the senior mark, confusion can be evidenced only if respondents, on their own, name the senior user, identify its products or services, or give other answers sufficient to make reasonably certain that they are thinking of the senior user when exposed to the allegedly

4 Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366 (7th Cir. 1976).
infringing use. By definition, respondents can identify the senior user during an Eveready survey only if they are already aware of the senior mark prior to the survey, such that a memory of the senior mark can be accessed when triggered by the survey showing respondents a confusingly similar use. For this reason, some commentators have asserted that the Eveready format is appropriate only in cases where there is a certain degree of consumer awareness of the senior mark—that is, where the senior mark is accessible in the memories of the relevant consumer base.

The first questions this raises are why and when the level of consumer awareness is relevant to the question of whether an Eveready survey can reliably assess likelihood of confusion. The fundamental purpose of a likelihood-of-confusion survey is to test whether confusion will occur under realistic marketplace circumstances. The actual marketplace is full of senior marks lacking high levels of consumer awareness, and there are many instances in which consumers who encounter an allegedly similar junior mark will neither have previous awareness of the senior mark nor gain awareness of the senior mark in the course of encountering and considering a purchase of the product bearing the junior mark. For instance, consider a scenario in which: (1) the senior user’s mark is almost entirely unknown to the general public because the senior user exclusively sells advanced weaponry to the U.S. military as part of extremely sophisticated, specialized, and expensive government contracts; (2) the junior user sells an ordinary consumer product through common retail channels (stores and websites); and (3) as a result of (1) and (2), the marketplace reality is that prospective consumers of the junior user’s product will not be aware of the senior mark and will not experience confusion with respect to the senior user. Imagine that in such a case an

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7 Id.
8 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:163 (4th ed. 2009) (“the closer the survey methods mirror the situation in which the ordinary person would encounter the trademark, the greater the evidentiary weight of the survey results.”)
9 This scenario is not far afield from the facts of the case of Valador, Inc. v. HTC Corp., 241 F. Supp. 3d 650 (E.D. Va. 2017), in which plaintiff supplied modeling and simulation software to an extremely specialized niche market (primarily NASA and the Department of Veteran’s Affairs) and the alleged infringer used the same mark (VIVE) for a virtual reality/video game headset sold at retail to ordinary consumers through electronics stores and websites. The court granted summary judgment to defendant on the trademark infringement claim, relying heavily on the parties’ sale of “different things through different channels to different customers.” Id. at 671. Consistent with the court’s assessment of the likelihood of confusion under the true marketplace circumstances, the defendant’s Eveready survey confirmed that confusion is not likely under such circumstances. While lack of awareness of the plaintiff’s mark might be a chief reason for the lack of likelihood of confusion, this does not affect the accuracy or reliability of a
Eveready survey exposes prospective consumers to the junior user’s product and demonstrates prong (3) of the scenario—that is, it shows a zero percent (0%) rate of consumers mistakenly connecting the junior product to the senior user. In such a scenario, the fact that prospective consumers of the junior user may not be aware of the senior mark does not render the finding of the Eveready survey (0% confusion) inaccurate or unreliable. Rather, lack of awareness of the senior mark may serve to explain why confusion is not likely to occur—both in the survey and the real world—namely, because confusion simply will not occur when consumers are both unaware of the senior mark and unlikely to encounter the senior mark in reasonably close proximity to the junior mark in the marketplace.10 With this understood, the proposition that there must always be consumer awareness of a senior mark for an Eveready survey to accurately assess whether confusion is likely to occur in the actual marketplace is objectively unsupportable.11

The issue of consumer awareness of the senior mark becomes relevant to the accuracy and reliability of the Eveready format where the parties’ marks are used in close enough proximity that consumers will encounter both with appreciable frequency12—for instance, where the parties’ products/services are directly

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10 See Ever-Constant Eveready, 109 TMR 671, 672, 683 (2019) (confusion can only occur in the case of lesser-known senior marks where the junior use is proximate enough in the marketplace such that both parties’ marks could be encountered in connection with each other and, therefore, exist simultaneously in the consumer’s awareness.) The court in Hypnotic Hats, Ltd. v. Wintermantel Enterprises, 335 F. Supp. 3d 566, 597 n.10 (S.D.N.Y. 2018), held similarly that “if a senior mark is neither stored in memory nor proximate to a junior use, there is little possibility that it can be compared to the junior use sufficiently to generate a likelihood of consumer confusion.”

11 Indeed, many courts have accepted in evidence and/or relied on Eveready surveys in cases where the relevant mark did not have high consumer awareness, but where an Eveready survey was the appropriate replication of marketplace conditions. See, e.g., Valador, 241 F. Supp. 3d at 669 n.22 (Valador’s VIVE mark) (noting that defendant’s Eveready survey finding 0% confusion was conducted in accordance with “well settled and accepted methods” although unnecessary to support the court’s finding of no confusion); Joules v. Macy’s Merchandising Grp., Civil Action No.: 1:15-cv-03645-KMW (S.D.N.Y. 2016) (accepting Eveready survey where senior mark was JOULES); THOIP v. Walt Disney Co., 690 F. Supp. 2d 218, 2225-27 (S.D.N.Y. 2010) (declining to exclude results of Eveready survey commissioned by defendant); Fancaster, Inc. v. Comcast Corp., 832 F. Supp. 2d 380, 405-07 (D.N.J. 2011) (crediting results of Eveready survey commissioned by defendant). Kelly-Brown v. Winfrey, 95 F. Supp. 3d 350, 362 (S.D.N.Y. 2015) (accepting Eveready survey where senior mark was OWN YOUR POWER); GoSmile, Inc. v. Levine, 769 F. Supp. 2d 630, 643 (S.D.N.Y. 2011) (accepting Eveready survey where senior mark was GOSMILE mark); 3M Co. v. Mohan, No. 09-1413 ADM/FLN, 2010 U.S. Dist. LEXIS 81094, at *21 (D. Minn. Aug. 9, 2010) (accepting Eveready survey where senior mark was Littman stethoscope design mark).

12 Cognitively Updated, 106 TMR 727, 743 (2016).
competing or substantially overlapping\(^{13}\) in the marketplace.\(^{14}\) In such a scenario, lack of consumer awareness of the senior mark could cause an Eveready survey to fail to detect confusion, even though the actual marketplace conditions may render confusion likely. By presenting only the junior mark, the survey would fail to take account of the fact that consumers are reasonably likely to encounter the senior mark (and thus gain awareness of it) while shopping for and encountering the product bearing the junior mark.

For instance, consider a scenario in which the senior mark is not well-known but is used on products directly competing with the product sold under the allegedly infringing mark. In such a scenario, while survey respondents may not be aware of the senior mark, consumers shopping for the relevant type of product may encounter both the senior and junior marks in reasonably close proximity in the actual marketplace and may then be in position to experience confusion. In such a scenario, an Eveready survey may not fully reflect the likelihood of confusion, because the Eveready survey does not attempt to simulate marketplace exposure to both marks, that is, the fact that consumers may encounter the junior mark in close proximity to the senior mark.\(^{15}\) For this subset of cases in which consumer awareness of the senior mark is relevant to the accuracy and reliability of the Eveready survey format—that is, cases where consumers would be reasonably likely to gain exposure to the senior mark in the course of encountering the junior mark because of the proximity of the parties' goods/services—the question then becomes what constitutes “awareness” of a senior mark.

IV. THE ISSUE OF TOP-OF-MIND AWARENESS

In discussing the issue of consumer awareness of senior marks in the context of an Eveready survey, it has sometimes been stated that a senior mark must enjoy “top-of-mind” awareness. For

\(^{13}\) Cases of goods that are not directly competing but are substantially overlapping could include ones where one party offers a certain product and the other party offers accessories for that product, such as a mobile phone and a mobile phone case or charger. While a mobile phone case or charger is not a directly competing alternative to a mobile phone, such goods may be substantially overlapping in that they will generally be encountered and considered in proximity in the marketplace by the same consumer because of the goods having common channels, customers, and related uses.

\(^{14}\) *Straitened Scope*, 98 TMR at 740 (2008). Swann’s latest article (with Henn) discusses the evolving concept of marketplace proximity given the complexities brought about by the online/digital (website and mobile) searching, browsing, and shopping experience. See *Ever-Constant Eveready*, 109 TMR at 673.

\(^{15}\) A further complication due to the chaos and complexity of the marketplace is that there are also cases involving more than one common marketplace scenario, including scenarios both where the parties’ marks appear in close proximity and where they do not. In such cases, an Eveready survey may accurately and reliably assess confusion under the latter type of conditions but may potentially not apply well to the former type of conditions.
instance, commentator Phyllis Welter has suggested that the question of whether a senior mark is sufficiently accessible in consumer memory is equivalent to the question of whether the mark has unaided “top of mind” awareness.\(^{16}\) A Southern District of New York court also recently characterized “top of mind” awareness of the senior mark as a requirement of the Eveready format.\(^{17}\) In his earlier articles exploring the bounds of the Eveready and Squirt formats, Jerre B. Swann has also used the phrase “top-of-mind” in analyzing whether a mark is sufficiently accessible in consumer memory for an Eveready survey to trigger a connection to the senior mark when the respondent is exposed to the allegedly similar mark or use.\(^{18}\) (In a more recent article, Swann and his coauthor, R. Charles Henn Jr., clarify that a mark does not need to be “top-of-mind” for a consumer to recall and mention the mark when prompted with an allegedly confusingly similar mark in an Eveready survey or in the real world.\(^{19}\)) As a result of these various uses of the term “top-of-mind” in the literature, this author has frequently observed attorneys representing plaintiffs to challenge opposing Eveready surveys offered by defendants by arguing that a senior mark is not “top-of-mind.”

In considering whether there is any theoretical support for a top-of-mind requirement, it is critical to consider what “top-of-mind” awareness means. The most common definition for a mark to be considered “top-of-mind” in the field of market research is that the mark is the first to come to a consumer’s mind on an unaided basis when prompted only with the relevant generic product category.\(^{20}\) For instance, if a certain percentage of consumers identify Apple as

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\(^{16}\) Phyllis Welter, Trademark Surveys, § 24.03[1][c] (1999).

\(^{17}\) Hypnotic Hats, Ltd. v. Wintermantel Enters., 335 F. Supp. 3d 566, 597 n.10 (S.D.N.Y. 2018). The court in *Hypnotic Hats* gave minimal weight to a Squirt survey (but declined to exclude it) because of the court’s finding that the parties’ marks would not likely be encountered in close proximity under realistic marketplace conditions. The court, however, expressed the opinion that an Eveready survey would also not have been appropriate because the senior mark is not “top of mind” for consumers. While using the term “top of mind,” the court also referred to “the accessibility of the senior mark in memory,” apparently making the mistake of equating these two concepts. As discussed in detail herein, a mark does not have to be top-of-mind to be accessible in memory.

\(^{18}\) Straitened Scope, 98 TMR at 745; Cognitively Updated, 106 TMR at 727-28.

\(^{19}\) Ever-Constant Eveready, 109 TMR at 672, n.1.

the first company that comes to their mind when the category of smartphones is mentioned, Apple would be top-of-mind for that segment of consumers. A somewhat broader conception of “top-of-mind” would be to equate “top-of-mind” with overall “unaided awareness,” which would require not necessarily that a brand be the first to come to mind, but that it be at least one of any number of brands that come to mind on an unaided basis.\(^{21}\) For instance, if consumers identify various brands that come to mind when asked about athletic sneakers, the percentage of consumers who mention any particular brand (whether first or not) would constitute an unaided awareness level and reflect the extent to which any brand is top-of-mind in the sense that the brand came to mind unaided based only on mention of the generic product category.\(^{22}\) Whether “top-of-mind” means that a mark is the first brand to come to mind, or that it is one of various brands that come to mind, top-of-mind awareness is a reflection of the frequency with which a mark “comes to mind” on an unaided basis, as opposed to the extent to which a mark is recognized when the mark is supplied to the consumer on an aided basis.\(^{23}\) As such, the critical aspect of top-of-mind awareness is that the product category is the only cue given to respondents. Any definition of “top-of-mind” is based purely on a measurement of whether a mark comes to mind unaided—that is, with no prompting with any stimulus other than mention of a generic category.\(^{24}\)

The Eveready survey’s use of open-ended questions to test for confusion with respect to a senior mark has been analogized to measuring top-of-mind awareness because an Eveready survey is also “unaided” in a certain sense.\(^{25}\) Presumably it is the perception

\(^{21}\) Phyllis Welter, Trademark Surveys, § 24.03[1][c] (1999).

\(^{22}\) In a recent case, the author conducted a survey that asked respondents to name brands that come to mind in the category of vaginal care products. When prompted only with this category, 38.7% identified the senior mark VAGISIL as at least one of the brands that came to mind unaided, by far the highest of any brand in the relevant category. This finding reflected a relatively high unaided awareness level and the author argued that this result meant that VAGISIL was a top-of-mind brand for its category. This unaided finding, along with a net 85% aided awareness level, were relied on by the court in finding that VAGISIL is a famous mark. Combe Inc. v. Dr. August Wolff GMBH & Co., C.A. No. 1:17-cv-00935 (E.D. Va. May 23, 2019).

\(^{23}\) According to Ipsos, a global marketing and research firm, “top-of-mind” is a measurement of spontaneous or unaided awareness, as distinct from a measurement of prompted or “aided” awareness. See https://www.marketingstudyguide.com/brand-awareness-metrics/ (top-of-mind awareness is a measurement of brands consumers think of “off the top of their head” on an unaided basis https://www.ipsos.com/en/ipsos-encyclopedia-awareness).

\(^{24}\) There is no particular standard in the abstract for what percentage of consumers would need to think of a brand on an unaided basis for it to be considered “top-of-mind.” Indeed, any such standard would vary from category to category depending on numerous factors, including how crowded the field is and the presence or absence of other strong brands.

\(^{25}\) Jacob Jacoby, Are Closed-Ended Questions Leading Questions? in Trademark and Deceptive Advertising Surveys: Law, Science, and Design, at 270 (Shari Seidman
that an Eveready survey is unaided in the same sense that a measurement of top-of-mind awareness is unaided that has led some commentators erroneously to cite top-of-mind awareness as a prerequisite for an Eveready survey\(^\text{26}\) and has led attorneys for plaintiffs to regularly argue for the exclusion or accordance of little weight to Eveready surveys showing little or no confusion where the senior mark is not top-of-mind. This analogy between top-of-mind awareness as an “unaided” measurement and the Eveready survey as an “unaided” format, however, is fatally flawed because of one significant difference. As noted above, an unaided attention test to assess whether a brand is top-of-mind provides respondents with no cue that could cause them to access a memory of a brand other than the survey’s identification of a generic product category—for example, respondents are prompted with the term “athletic sneakers” to see which brands they name. A top-of-mind awareness measurement is, therefore, unaided in the purest of senses. The Eveready survey, on the other hand, supplies respondents with a far more specific cue—namely, the mark that is alleged to be confusingly similar. Accordingly, the Eveready survey is “unaided” only in the limited sense that it does not literally mention or show the senior mark. It is quite aided, however, in the sense that it cues respondents with a specific mark allegedly similar to the senior mark. This exposure to a mark similar to the senior mark (as opposed to exposure to only a generic product category) has a dramatically greater ability to trigger respondents’ memory of the senior mark.

Consider the mark FILA for sneakers. When asked on an unaided basis to name sneaker brands (prompted only with the identification of the category “sneakers”), FILA has a relatively low level of unaided awareness, as the sneaker brands at the “top” of most respondents’ minds are more likely to be NIKE, ADIDAS, and other more prominent brands.\(^\text{27}\) The fact that FILA might not be top-of-mind, however, does not rule out the possibility that the brand FILA is accessible in memory for consumers. If an Eveready survey showed respondents the term “PHEELA” for sneakers or the term “FILA” for a different type of product, such cues should be far more likely to trigger respondents to access the sneaker brand FILA from memory than would the mere mention of the category of athletic sneakers. Accordingly, there is a clear theoretical basis for

\(^{26}\) Id. at 271 (depicting open-ended questions such as "evoking what is top-of-mind for most respondents"). Swann cites this discussion from Jacoby in Cognitively Updated in discussing the parameters of the Eveready format. See Cognitively Updated, 106 TMR at 734-35.

\(^{27}\) See infra Part V.A (providing “top-of-mind” survey results).
how an Eveready survey can detect significant levels of confusion even where a senior mark is not top-of-mind and not called to mind on an unaided basis merely by mention of a generic product category. These observations triggered the idea for the research discussed in Part V.

V. THE RESEARCH DESIGN

The research was designed to test empirically whether an Eveready survey’s presentation of a mark can trigger respondents to access a similar senior mark from memory (and thus detect significant levels of confusion) even if the senior mark is not top-of-mind and, accordingly, would not come to mind unaided when prompting respondents solely with the relevant product category. The research design is straightforward, involving two sets of surveys, (1) an unaided awareness survey followed by (2) an Eveready survey using a mark similar to a non–top-of-mind mark identified by the first survey.

A. The Unaided Awareness Surveys

The first phase of research involved conducting online consumer brand awareness surveys to determine the extent to which various marks in various product categories are top-of-mind in the sense that they come to mind for consumers on an unaided basis when the consumers are prompted merely with the product category. Respondents were allowed to take the survey on either a computer (desktop, laptop/notebook, or tablet) or on a mobile phone. The awareness surveys focused on three product category examples:

- Soda/pop

28 For the purposes of this analysis, I adopted a broader conception of “top-of-mind” that equates with overall unaided awareness—that is, a measurement of the extent to which the mark comes to mind on an unaided basis, whether or not it is the first to come to mind. Were “top-of-mind” to be more strictly defined to include only the first brand to come to mind on an unaided basis, the resulting percentages for all of the brands discussed herein would be even lower, which would even more powerfully compel the conclusion that the marks analyzed herein are not top-of-mind. For instance, nineteen respondents (6.3%) named FANTA on an unaided basis. Only three respondents (1%), however, named FANTA as the first brand that came to mind. Accordingly, the FANTA percentage would decrease to 1% if the analysis of “top-of-mind” was limited to brands that come to mind first.

29 It is increasingly common practice in the field of market research to allow respondents to take surveys on mobile phones in scenarios where the survey is not showing content that would be overly difficult to display or view on the relatively smaller screen of a mobile phone. The surveys comprising the relevant research here were suitable for mobile phones, as there was no stimulus that would be difficult to view on a small screen. Allowing the survey to be taken on both computers and mobile devices also allowed the author to examine the data to determine whether there was any meaningful variation in the results by device type.
• Athletic sneakers
• Breakfast cereal

For each of these categories, three hundred recent and/or likely future purchasers of the relevant product type were tested as to their awareness of various company or brand names. The consumers for each category were initially instructed to take a few moments to think about any brands of the relevant type of product that they have ever seen or heard of. The “continue” button on the screen containing this instruction was disabled for fifteen seconds. This prevented respondents from advancing to the questions without spending some time thinking about brands in the relevant category. Respondents were then asked to list all brands that they have ever seen or heard of in the relevant category. They were instructed to be as complete as possible and were provided text boxes for up to twenty answers.

This procedure allowed the surveys to measure an unaided awareness level for various brands in each of the three categories, so that an empirical assessment could be made regarding which brands are or are not top-of-mind.

The following table shows the unaided awareness levels for soda/pop brands:

<table>
<thead>
<tr>
<th>Brand</th>
<th>#</th>
<th>%</th>
</tr>
</thead>
<tbody>
<tr>
<td>COKE/COCOA-COLA</td>
<td>269</td>
<td>89.7%</td>
</tr>
<tr>
<td>PEPSI</td>
<td>255</td>
<td>85.0%</td>
</tr>
<tr>
<td>SPRITE</td>
<td>143</td>
<td>47.7%</td>
</tr>
<tr>
<td>DR. PEPPER</td>
<td>129</td>
<td>43.0%</td>
</tr>
<tr>
<td>7-UP</td>
<td>98</td>
<td>32.7%</td>
</tr>
<tr>
<td>MOUNTAIN DEW</td>
<td>95</td>
<td>31.7%</td>
</tr>
<tr>
<td>A&amp;W</td>
<td>54</td>
<td>18.0%</td>
</tr>
<tr>
<td>RC</td>
<td>30</td>
<td>10.0%</td>
</tr>
<tr>
<td>CANADA DRY</td>
<td>28</td>
<td>9.3%</td>
</tr>
<tr>
<td>CRUSH</td>
<td>26</td>
<td>8.7%</td>
</tr>
<tr>
<td>BARQ'S</td>
<td>25</td>
<td>8.3%</td>
</tr>
<tr>
<td>SUNKIST</td>
<td>20</td>
<td>6.7%</td>
</tr>
<tr>
<td>FANTA</td>
<td>19</td>
<td>6.3%</td>
</tr>
<tr>
<td>SIERRA MIST</td>
<td>16</td>
<td>5.3%</td>
</tr>
</tbody>
</table>

30 The survey universe for each unaided awareness study was identical to the survey universe for each corresponding confusion survey. For instance, the unaided awareness survey regarding soda/pop brands and the confusion survey regarding soda/pop brands used identical survey universes, namely, recent and likely future purchasers of soda/pop.

31 Only results for brands named by more than 1% of respondents are shown.
<table>
<thead>
<tr>
<th>Brand</th>
<th>#</th>
<th>%</th>
</tr>
</thead>
<tbody>
<tr>
<td>SHASTA</td>
<td>15</td>
<td>5.0%</td>
</tr>
<tr>
<td>SQUIRT</td>
<td>12</td>
<td>4.0%</td>
</tr>
<tr>
<td>MELLO YELLOW</td>
<td>11</td>
<td>3.7%</td>
</tr>
<tr>
<td>MR. PIBB</td>
<td>11</td>
<td>3.7%</td>
</tr>
<tr>
<td>SCHWEPPES</td>
<td>11</td>
<td>3.7%</td>
</tr>
<tr>
<td>MUG</td>
<td>10</td>
<td>3.3%</td>
</tr>
<tr>
<td>SEAGRAMS</td>
<td>10</td>
<td>3.3%</td>
</tr>
<tr>
<td>FAYGO</td>
<td>8</td>
<td>2.7%</td>
</tr>
<tr>
<td>TAB</td>
<td>8</td>
<td>2.7%</td>
</tr>
<tr>
<td>CHEERWINE</td>
<td>7</td>
<td>2.3%</td>
</tr>
<tr>
<td>DAD’S</td>
<td>7</td>
<td>2.3%</td>
</tr>
<tr>
<td>FRESCA</td>
<td>6</td>
<td>2.0%</td>
</tr>
<tr>
<td>SUN DROP</td>
<td>6</td>
<td>2.0%</td>
</tr>
</tbody>
</table>

As this table shows, the mark FANTA is not top-of-mind, with only a 6.3% rate of unaided awareness, as opposed to the most top-of-mind marks such as COKE and PEPSI (which were named unaided by 80% to 90% of respondents) and marks such as SPRITE, DR. PEPPER, 7-UP, and MOUNTAIN DEW (which had strong unaided awareness levels in the 30% to 50% range).\(^{32}\) FANTA, on the other hand, is a brand that may be accessible in the memories of significant percentages of consumers, despite not being top-of-mind. Accordingly, I selected the brand FANTA as the senior mark for the purposes of studying a hypothetical scenario in which a defendant uses a mark that the senior mark’s owner alleges creates a likelihood of confusion with its FANTA mark for soda/pop.

The following table shows the unaided awareness levels for athletic sneakers:

<table>
<thead>
<tr>
<th>Brand</th>
<th>#</th>
<th>%</th>
</tr>
</thead>
<tbody>
<tr>
<td>NIKE</td>
<td>277</td>
<td>92.3%</td>
</tr>
<tr>
<td>ADIDAS</td>
<td>203</td>
<td>67.7%</td>
</tr>
<tr>
<td>REEBOK</td>
<td>109</td>
<td>36.3%</td>
</tr>
</tbody>
</table>

\(^{32}\) While there is no objective standard for what level of unaided awareness is required to meet a top-of-mind standard, it is clear that figures such as 6.3% for FANTA (and the even lower rates for the other marks discussed below) are sufficiently low so as to conclude that the mark is not top-of-mind. The conclusion that FANTA is not top-of-mind is also supported by the fact that FANTA (and the other marks discussed below) were not even in the top-ten most commonly cited brands. As already noted, if a stricter definition of “top-of-mind” (requiring that a brand be first to come to mind) were used, the top-of-mind awareness levels for FANTA would be even lower and would even more powerfully compel the conclusion that such marks are not top-of-mind.
As this table shows, the mark FILA is not top-of-mind, with only a 5.3% rate of unaided awareness, as opposed to the most top-of-mind marks, such as NIKE (92.3% unaided awareness) and ADIDAS (67.7% unaided awareness) or even marks such as REEBOK and NEW BALANCE (which have unaided awareness levels above 30%). Based on these results, I selected the brand FILA as the senior mark for the purposes of studying a hypothetical scenario in which a defendant uses a mark that the senior mark's owner alleges creates a likelihood of confusion with its FILA mark for athletic sneakers.

The following table shows the unaided awareness levels for breakfast cereals:

<table>
<thead>
<tr>
<th>Brand</th>
<th>#</th>
<th>%</th>
</tr>
</thead>
<tbody>
<tr>
<td>KELLOGG</td>
<td>139</td>
<td>46.3%</td>
</tr>
<tr>
<td>CHEERIOS</td>
<td>121</td>
<td>40.3%</td>
</tr>
<tr>
<td>POST</td>
<td>84</td>
<td>28.0%</td>
</tr>
<tr>
<td>GENERAL MILLS</td>
<td>66</td>
<td>22.0%</td>
</tr>
<tr>
<td>FROSTED FLAKES</td>
<td>56</td>
<td>18.7%</td>
</tr>
<tr>
<td>RAISIN BRAN</td>
<td>49</td>
<td>16.3%</td>
</tr>
<tr>
<td>FROOT LOOPS</td>
<td>41</td>
<td>13.7%</td>
</tr>
<tr>
<td>LUCKY CHARMS</td>
<td>40</td>
<td>13.3%</td>
</tr>
<tr>
<td>RICE KRISPIES</td>
<td>39</td>
<td>13.0%</td>
</tr>
<tr>
<td>CAP’N CRUNCH</td>
<td>38</td>
<td>12.7%</td>
</tr>
<tr>
<td>SPECIAL K</td>
<td>38</td>
<td>12.7%</td>
</tr>
<tr>
<td>Brand</td>
<td>#</td>
<td>%</td>
</tr>
<tr>
<td>------------------------------</td>
<td>----</td>
<td>-----</td>
</tr>
<tr>
<td>CORN FLAKES</td>
<td>36</td>
<td>12.0%</td>
</tr>
<tr>
<td>QUAKER</td>
<td>35</td>
<td>11.7%</td>
</tr>
<tr>
<td>CINNAMON TOAST CRUNCH</td>
<td>27</td>
<td>9.0%</td>
</tr>
<tr>
<td>WHEATIES</td>
<td>26</td>
<td>8.7%</td>
</tr>
<tr>
<td>CHEX</td>
<td>25</td>
<td>8.3%</td>
</tr>
<tr>
<td>KASHI</td>
<td>24</td>
<td>8.0%</td>
</tr>
<tr>
<td>HONEY BUNCHES OF OATS</td>
<td>19</td>
<td>6.3%</td>
</tr>
<tr>
<td>APPLE JACKS</td>
<td>17</td>
<td>5.7%</td>
</tr>
<tr>
<td>COCOA PUFFS</td>
<td>17</td>
<td>5.7%</td>
</tr>
<tr>
<td>LIFE</td>
<td>16</td>
<td>5.3%</td>
</tr>
<tr>
<td>SHREDDED WHEAT</td>
<td>16</td>
<td>5.3%</td>
</tr>
<tr>
<td>TRIX</td>
<td>16</td>
<td>5.3%</td>
</tr>
<tr>
<td>FRUITY PEBBLES</td>
<td>15</td>
<td>5.0%</td>
</tr>
<tr>
<td>REESE'S</td>
<td>10</td>
<td>3.3%</td>
</tr>
<tr>
<td>GRAPE-NUTS</td>
<td>9</td>
<td>3.0%</td>
</tr>
<tr>
<td>KIX</td>
<td>9</td>
<td>3.0%</td>
</tr>
<tr>
<td>CORN POPS</td>
<td>8</td>
<td>2.7%</td>
</tr>
<tr>
<td>HONEYCOMB</td>
<td>8</td>
<td>2.7%</td>
</tr>
<tr>
<td>MALT-O-MEAL</td>
<td>7</td>
<td>2.3%</td>
</tr>
<tr>
<td>POPS</td>
<td>7</td>
<td>2.3%</td>
</tr>
<tr>
<td>COOKIE CRISP</td>
<td>6</td>
<td>2.0%</td>
</tr>
<tr>
<td>GOLDEN GRAHAMS</td>
<td>6</td>
<td>2.0%</td>
</tr>
<tr>
<td>GREAT VALUE</td>
<td>6</td>
<td>2.0%</td>
</tr>
<tr>
<td>SMACKS</td>
<td>5</td>
<td>1.7%</td>
</tr>
<tr>
<td>TOTAL</td>
<td>5</td>
<td>1.7%</td>
</tr>
<tr>
<td>COUNT CHOCULA</td>
<td>4</td>
<td>1.3%</td>
</tr>
<tr>
<td>OREO</td>
<td>4</td>
<td>1.3%</td>
</tr>
</tbody>
</table>

As this table shows, the mark KIX is not top-of-mind, with only a 3.0% rate of unaided awareness, as opposed to the most top-of-mind brands such as KELLOGG’S (46.3%) and CHEERIOS (40.3%).\(^3\) Based on these results, I selected the brand KIX as the

---

\(^3\) Cereal is an example of a category containing so many brands that even relatively popular brands have lower levels of unaided awareness than top-of-mind brands in categories with fewer products. Cereal is also a category in which some of the most top-of-mind “brands” are company names or house marks (KELLOGG, POST, and GENERAL MILLS), rather than brands of specific cereal products. It is also noteworthy that “Raisin Bran” was named unaided by 16.3% of respondents, despite the fact that “Raisin Bran” has been judged to be a generic term and is used by multiple manufacturers of cereal products. “Shredded Wheat” (5.3%) was held by the U.S.
senior mark for the purposes of studying a hypothetical scenario in which a defendant uses a mark that the senior mark’s owner alleges creates a likelihood of confusion with its KIX mark for breakfast cereal.  

B. The Eveready Confusion Surveys

The next phase of the research involved designing and conducting Eveready-style surveys to test the extent to which the surveys detect confusion in the case of hypothetical trademarks that are confusingly similar to the three senior marks selected from the first phase, because they lack top-of-mind awareness. Surveys were constructed to test three hypothetical scenarios:

- Use of the mark FANTA for juice, which is alleged to create a likelihood of confusion with respect to the senior mark FANTA for soda/pop. This scenario tests the use of the identical mark in a different product category. A group of two hundred juice consumers (the relevant universe for a forward confusion survey where the accused product is a juice product, and the identical universe used to assess the level of unaided awareness of the senior FANTA mark) participated in this survey.

- Use of the mark KIXX for snack bars, which is alleged to create a likelihood of confusion with respect to the mark KIX for breakfast cereal. This scenario tests the use of a similar but non-identical mark in a different product category. A separate group of two hundred snack bar consumers (the relevant universe for a forward confusion survey where the accused product is a snack bar, and the identical universe used to assess the level of unaided awareness of the senior KIX mark) participated in this survey.

- Use of the mark PHEELA for athletic sneakers, which is alleged to create a likelihood of confusion with respect to the mark FILA for athletic sneakers. This scenario tests the use of a similar but non-identical mark in the same product category.

As noted in the Supreme Court in 1939 to be generic. Similarly, although the leading brand of corn flakes is KELLOGG’S Corn Flakes, the term “corn flakes” may be considered generic, as there are multiple registrations for CORN FLAKES–formative marks, and even Kellogg disclaims the term in its U.S. Trademark Registration (U.S. Reg No 1,411,563). Notably, the levels of unaided awareness did not differ meaningfully based on whether respondents took the survey on a computer or mobile phone. The following table shows the breakdown of results for each of the three key marks by device type:

<table>
<thead>
<tr>
<th>Brand</th>
<th>Total</th>
<th>Computer</th>
<th>Mobile</th>
</tr>
</thead>
<tbody>
<tr>
<td>FANTA</td>
<td>6.3%</td>
<td>6.0%</td>
<td>7.0%</td>
</tr>
<tr>
<td>FILA</td>
<td>5.3%</td>
<td>5.0%</td>
<td>6.0%</td>
</tr>
<tr>
<td>KIX</td>
<td>3.0%</td>
<td>3.5%</td>
<td>2.0%</td>
</tr>
</tbody>
</table>
category. A separate group of two hundred athletic sneaker consumers (the relevant universe for a forward confusion survey where the accused product is an athletic sneaker, and the identical universe used to assess the level of unaided awareness of the senior FILA mark) participated in this survey.

No respondents who participated in any of the awareness surveys were allowed to participate in any of the confusion surveys.

The confusion surveys generally followed the Eveready format in that they presented respondents with the accused use and asked open-ended questions to determine the extent to which, if at all, respondents on their own make a mental connection to and mention the senior mark or product. In the interest of simplicity and clarity, the surveys followed standard practice for TTAB surveys addressing registrability, which require presenting only the mark at issue along with an identification of the relevant product category.35 The following screenshots display the presentation of the allegedly confusing mark in each survey:

Respondents were then asked two question series to assess the following:

- Whether they think any other products are made or put out by the same brand as the product they were told about and, if so, what products.
- Whether they think the product they were told about is affiliated with, or sponsored or approved by, any other brand or company and, if so, what brand or company.36

This research design tests whether the Eveready format successfully detects significant levels of confusion in various scenarios in which a junior mark is very similar to a senior mark that is not top-of-mind, including:

- An identical junior mark used in a different product category.
- A similar but non-identical mark used in a different product category.
- A similar but non-identical mark used in the same product category.

In the interest of simplicity and brevity, the surveys purposefully omitted certain measures that are typical or standard in the case of surveys that are intended to serve as evidence in connection with legal proceedings. First, surveys often include open-ended follow-up questions asking respondents to explain why they named a certain brand, company, or product.37 Second, surveys purporting to find confusion typically require a control to assure that any tendency to name the senior mark is caused by the confusing similarity of the accused mark as opposed to other factors, such as unrelated textual or trade dress elements or guessing a

36 Eveready surveys often also include a question asking respondents what company or brand makes or puts out the product. See Cognitively Updated, 106 TMR at 729. This question was not included for the sake of brevity and simplicity and because the purpose of the research was to test whether the Eveready survey can detect confusion, without need to precisely quantify the full amount of such confusion.

37 Cognitively Updated, 106 TMR at 729.
brand simply because it is a popular brand in the relevant category. Here, considering that the senior marks at issue are not top-of-mind and that respondents were shown only the mark at issue with no extraneous content (no product image, packaging, webpages, etc.), it is clear enough for the purposes of this research that the similarity of the marks is the most likely cause of respondents naming the senior mark. Accordingly, while controls are very important in surveys purporting to find confusion and would be necessary to accurately quantify a precise level of confusion, they were not necessary here to reach the conclusion that the Eveready format was capable in these instances of detecting levels of confusion that are significant enough to potentially support a finding of likelihood of confusion.

There is also an even more important reason that the lack of controls poses no problem for the interpretation of the results in the context of this research and the proposition it is testing. The reason a control is typically necessary in an Eveready survey that purports to show confusion is to account for the concern that the senior mark comes to mind and is named at exaggeratedly high rates that might not be fully attributable to the alleged infringement. In other words, the concern is that the survey overstates confusion. The proposition that the Eveready format is appropriate only for top-of-mind marks, however, reflects the opposite concern—that a senior mark that is not top-of-mind will not come to mind and will, accordingly, be named in the survey at deflated or negligible rates. Accordingly, the possibility that the Eveready results discussed herein could be somewhat inflated as a result of lack of a control would not undermine the conclusion drawn from the research—namely, that an Eveready survey can show significant rates of confusion (naming the senior mark) even in the case of senior marks that are not top-of-mind. To the contrary, if the Eveready rates of naming the senior marks were inflated rates, this would only underscore and strengthen the conclusion that the Eveready format is capable of showing significant levels of confusion (naming the senior mark) even in certain cases of senior marks that are not top-of-mind.

VI. THE RESEARCH RESULTS

The following table demonstrates the rates of confusion detected by the Eveready surveys for each of the marks/scenarios tested:

---

In the case of the mark FANTA for juice, respondents were counted as confused if they mentioned the following or equivalent variations:

- FANTA orange soda
- FANTA grape soda
- FANTA flavored soda (other)
- FANTA soda
- Soda/pop

All of these answers clearly reflect that respondents made a mental connection to the FANTA mark for soda/pop.

In the case of the mark KIXX for snack bars, respondents were counted as confused if they mentioned the following or equivalent variations:

- KIX cereal
- Breakfast cereal
- Cereal

All of these answers clearly reflect that respondents made a mental connection to the KIX mark for breakfast cereal.

In the case of the mark PHEELA for athletic sneakers, respondents were counted as confused if they mentioned the following or equivalent variations:

- FILA
- FILA shoes or sneakers
- FILA sports wear
- FILA tennis sneakers/clothing

All of these answers clearly reflect that respondents made a mental connection to the FILA brand for athletic sneakers or related goods.

The following table shows the unaided awareness rates of each senior mark compared with the rates at which that senior mark was named or referenced in the Eveready confusion survey.

<table>
<thead>
<tr>
<th>Mark Tested</th>
<th>Confusion Rate</th>
</tr>
</thead>
<tbody>
<tr>
<td>FANTA for juice</td>
<td>56.0%</td>
</tr>
<tr>
<td>KIXX for snack bars</td>
<td>25.0%</td>
</tr>
<tr>
<td>PHEELA for athletic sneakers</td>
<td>30.5%</td>
</tr>
</tbody>
</table>
The respective confusion results of 25%, 30.5%, and 56% empirically demonstrate the capability of the Eveready survey format to detect significant confusion rates in at least some cases of senior marks that are not top-of-mind. Specifically, these results demonstrate the dramatic difference between the likelihood that a senior mark is called to mind merely based on mention of the relevant product category (unaided awareness) and the likelihood that a senior mark is called to mind by exposure to a similar junior mark. For instance, while the mark FANTA was called to mind unaided for only 6.3% of respondents who were asked to think of soda/pop brands, a significantly higher 56.0% of respondents made a mental connection to the FANTA mark for soda/pop when exposed to a highly similar use (FANTA for juice). The fact that FANTA is not a top-of-mind brand did not prevent the Eveready format from detecting a very high rate of confusion caused by a confusingly similar junior use.

<table>
<thead>
<tr>
<th>Brand</th>
<th>Named Unaided in Awareness Survey</th>
<th>Named in Confusion Survey</th>
</tr>
</thead>
<tbody>
<tr>
<td>FANTA</td>
<td>6.3%</td>
<td>56.0%</td>
</tr>
<tr>
<td>FILA</td>
<td>5.3%</td>
<td>30.5%</td>
</tr>
<tr>
<td>KIX</td>
<td>3.0%</td>
<td>25.0%</td>
</tr>
</tbody>
</table>

VII. CONCLUSION

In conclusion, the research described herein empirically demonstrates that Eveready surveys may be appropriate for senior marks that are not top-of-mind. Even in situations where awareness of the senior mark—or the lack thereof—is relevant to consideration of the confusion format, the research establishes that the Eveready format can detect substantial confusion levels in some cases of senior marks that are not top-of-mind. Accordingly, the issue of whether a senior mark is top-of-mind is not, on its own, a suitable metric for assessing whether an Eveready survey is appropriate.

39 As noted already, the possibility that these confusion rates could be somewhat inflated because of a lack of a control only underscores the fact that respondents in an Eveready survey can identify the senior mark at significant (perhaps even artificially high) rates even when the senior mark is not top-of-mind.

40 It is also worth noting that the levels of confusion did not differ meaningfully based on whether respondents took the survey on a computer or mobile phone. The following table shows the breakdown of results for each of the three key marks by device type:

<table>
<thead>
<tr>
<th>Brand</th>
<th>Total</th>
<th>Computer</th>
<th>Mobile</th>
</tr>
</thead>
<tbody>
<tr>
<td>FANTA</td>
<td>56.0%</td>
<td>54.0%</td>
<td>58.0%</td>
</tr>
<tr>
<td>FILA</td>
<td>30.5%</td>
<td>29.5%</td>
<td>31.5%</td>
</tr>
<tr>
<td>KIX</td>
<td>25.0%</td>
<td>26.0%</td>
<td>24.0%</td>
</tr>
</tbody>
</table>
COMMENTARY

THE SCIENCE OF PROVING TRADEMARK DILUTION*

By Barton Beebe,** Roy Germano,*** Christopher Jon Sprigman,**** and Joel H. Steckel*****

I. INTRODUCTION

In this short commentary, we discuss our recent empirical scholarship on the vexing question of how to prove claims that a trademark has been diluted by “blurring.”1 We first discuss the current confusion in the federal courts over what qualifies as proof of dilution. We then report the results of two experiments that test different ways that plaintiffs may seek to prove these claims.

Our bottom line is clear: the test that has been employed by most federal courts—what we refer to here as the “mere association test”—is an invalid measure of trademark dilution. The important question, which we take up later in this commentary, is how to improve upon that failed approach.

We offer a new “association strength test” that can be used to prove—or, to disprove—dilution by blurring. This test offers a valid construct for measuring trademark dilution. Those who are interested in the full details of our research should consult the longer article, Testing for Trademark Dilution in Court and the Lab, from which this commentary is drawn.2

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***** Professor of Marketing and Vice Dean for Doctoral Education, New York University Stern School of Business.


2 Id.
II. COURTS’ CONFUSION ABOUT TRADEMARK DILUTION

The difficulty in understanding how best to prove claims of trademark dilution is likely rooted in the difficulty of articulating what, precisely, the claim is. In theory, dilution occurs when two companies use very similar or even identical trademarks in a manner that does not confuse consumers as to source. The problem that trademark dilution hypothesizes is not confusion; instead, the problem is a form of cognitive obstruction—that is, that these consumers must “think for a moment” whenever they see one of the marks to determine to which company the mark refers. This delay in recognition is thought to represent a harm to the prior, “senior” user of the mark.

Here’s an example: Imagine that a Brooklynite opens a microbar called “Apple” in her neighborhood. Suppose further that there is no likelihood of consumer confusion about source—that it is highly unlikely that patrons will be confused into believing that the global high technology brand owns the bar and is leveraging its brand into the sale of artisanal cocktails. The concept of dilution asserts that the existence of the bar may nevertheless harm the famous global brand. When Brooklynites hear the term “Apple,” they will associate it with two different entities: Is it the high tech company (the senior user of the trademark) or the bar (the junior user)? As the legal theory goes, this dual association causes a “blurring” of the link between “Apple” and the Cupertino company. This “dilution by blurring” is alleged to damage the famous brand name by

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3 See J. Thomas McCarthy, Dilution of a Trademark: European and United States Law Compared, 94 TMR 1163, 1163 (2004) (“No part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of ‘dilution’ as a form of intrusion on a trademark.”).

4 Richard A. Posner, When Is Parody Fair Use?, 21 J. Legal Stud. 67, 75 (1992) (explaining antidilution law on the basis that “[a] trademark seeks to economize on information costs by providing a compact, memorable, and unambiguous identifier of a product or service. The economy is less when, because the trademark has other associations, a person seeing it must think for a moment before recognizing it as the mark of the product or service.”). On the bench, Judge Richard Posner reasoned similarly in explaining the rationale for protection specifically against dilution by blurring:

[T]here is concern that consumer search costs will rise if a trademark becomes associated with a variety of unrelated products. Suppose an upscale restaurant calls itself “Tiffany.” There is little danger that the consuming public will think it’s dealing with a branch of the Tiffany jewelry store if it patronizes this restaurant. But when consumers next see the name “Tiffany” they may think about both the restaurant and the jewelry store, and if so the efficacy of the name as an identifier of the store will be diminished. Consumers will have to think harder—incur as it were a higher imagination cost—to recognize the name as the name of the store. . . . So “blurring” is one form of dilution.

Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002).
diminishing the immediacy with which consumers identify the brand name with its source and other preexisting associations.

This framework for understanding trademark dilution is as controversial as it is vague. Trademark scholars are overwhelmingly critical of antidilution protection, not least because in real-world purchasing contexts, consumers are likely to use a variety of environmental cues to disambiguate the meaning of terms. For example, at an airport, when someone refers to “American” or “Delta,” no one must “think for a moment” to know that the references are to airlines and not to the broadcasting company or the faucet maker. Even in a setting such as online search, in which there is less context, consumers are often able to disambiguate various uses of a mark using the information that accompanies search results.

Pictured above, for example, are results from a Google search for “Delta.” Using the search test, one can clearly differentiate the airline from the faucet maker below.

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5 See, e.g., Christine Haight Farley, Why We Are Confused about the Trademark Dilution Law, 16 Fordham Intell. Prop. Media & Enter. L. J. 1175, 1184–85 (2006) (arguing that little harm results from most cases of dilution); David S. Welkowitz, Reexamining Trademark Dilution, 44 Vand. L. Rev. 531, 548–49, 557–58, (1991) (arguing that the tenuous benefits that antidilution doctrine may provide beyond those of other areas of trademark law are not enough to justify it).

Blurring, in other words, is plausible in theory but may actually be rare in practice because of the disambiguating effect of purchasing context.

In the shadow of this uncertainty over the *bona fides* of the dilution claim, federal courts are currently split on what the plaintiff must show to establish that the defendant’s conduct constitutes blurring. Even within particular districts, such as the Southern District of New York, courts have adopted different standards.\(^7\) Federal trademark law states that “‘dilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”\(^8\) In construing this language, a majority of courts have held that to establish blurring, a plaintiff need show only that consumers associate the defendant’s mark with the plaintiff’s famous mark.\(^9\) In other words, to win an injunction, Apple of Cupertino would need show only that patrons of the Brooklyn “Apple” bar associate its name with the Cupertino company (even if there is no source confusion). These courts appear to assume that to the extent there is association between the defendant’s and plaintiff’s marks, this association alone will impair the distinctiveness of the senior mark’s source and its other preexisting associations.\(^10\) We refer to this in what follows as the “mere

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\(^8\) 15 U.S.C. § 1125(c)(2)(B) (2018). An alternative form of dilution, which we do not discuss in this article, is “dilution by tarnishment.” Federal trademark law defines “dilution by tarnishment” as “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C) (2018). Tarnishment “generally arises when the plaintiff’s trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.” Tiffany (N.J) Inc. v. eBay Inc., 600 F.3d 93, 111 (2d Cir. 2010), quoting Deere & Co. v. MTD Prods., Inc., 41 F.3d 39, 43 (2d Cir. 1994).


\(^10\) See, e.g., Visa Int’l Serv. Ass’n v. JSL Corp., 610 F.3d 1088, 1090–91 (9th Cir. 2010) (affirming summary judgment for likely dilution of Visa’s trademark through a mere
association” standard. A minority of courts have held that the plaintiff must show both consumer association and that this consumer association impairs the distinctiveness of the senior mark’s preexisting associations. Here, Apple of Cupertino would need to show that the bar calls to mind the global brand and that this calling to mind somehow impairs the global brand’s distinctiveness. We refer to this as the “association plus impairment” standard.

The split among courts is surprising, and not just because the statutory language appears clearly to call for the association plus impairment approach. In the 2003 case Moseley v. V Secret Catalogue, Inc., the Supreme Court explicitly stated, albeit in dicta, that “[b]lurring is not a necessary consequence of mental association.” The Court could not have been clearer: the mere fact that consumers associate the defendant’s mark with the plaintiff’s cannot, without more, establish blurring. The Court recognized that there are two different associative links at issue: the link between the defendant’s mark and the plaintiff’s mark, and the link between the plaintiff’s mark and its source and other preexisting attributes. The emergence of the former link does not necessarily impact the strength of the latter. And yet a majority of courts continue to accept evidence establishing mere association as sufficient evidence of blurring.

In the remainder of this commentary, we summarize two of the primary contributions that our empirical research has made to the current debate over the nature of dilution by blurring and what must be shown to establish it in court.

First, we report findings from a new set of experiments that confirm that the majority mere association approach is fundamentally deficient. These experiments demonstrate that even when consumers associate a junior mark with a famous senior mark, this association does not necessarily result in any impairment of the ability of the senior mark to identify and distinguish its source and other associations. The practical significance of our experimental results is clear: courts should not base dilution liability on mere association. Rather, they should require the plaintiff to show that the association between the defendant’s and plaintiff’s mark impairs the latter’s distinctiveness of source and other attributes.

13 Id. at 434 (addressing a prior antidilution statute).
Second, we propose a new, more empirically grounded, “association strength test” for dilution. We suggest that courts should demand evidence that exposing consumers to the junior mark is likely to affect the strength of preexisting associations between the senior mark and the qualities or attributes to which it is linked. Those preexisting associations must first be identified. The plaintiff must then establish that exposure to the junior mark weakens the link between the senior mark and those preexisting associations. Our experiments model a methodology that can be used in litigation for assessing whether potentially diluting uses of marks actually reduce association strength and harm the distinctiveness of the senior mark.

III. MERE ASSOCIATION AND BLURRING

As we mention briefly above, a majority of courts that have considered an antidilution claim have adopted the mere association standard for establishing blurring. That is, they have accepted survey evidence that consumers merely associate the plaintiff’s and defendant’s marks as sufficient evidence to show that the defendant’s mark “impairs the distinctiveness” of the plaintiff’s mark. And in certain leading cases, courts have based their finding of blurring on survey evidence showing a likelihood of consumer confusion as to source.

Those courts that apply the mere association standard generally rely on two forms of survey evidence as proof of blurring. We review them in turn.

A. The Nikepal Survey Approach

The first and most prominent form of survey evidence that mere association courts have accepted consists of variations on the survey method used by the plaintiff in Nike Inc. v. Nikepal International Inc.14 In Nikepal, the defendant used the mark NIKEPAL as the name of its business, which distributes glass syringes and other laboratory products.15 Nike conducted a telephone survey of the defendant’s current and prospective customers in which it asked them about “their perception of a website called nikepal.com.”16 Specifically, the survey asked: “What, if anything, came to your mind when I first said the word ‘Nikepal’?” Unsurprisingly, 87 percent of respondents stated that they thought of the plaintiff or its products. The survey expert and the Nikepal court took this as

15 Id. at 1822.
16 Id. at 1824.
evidence of blurring.\textsuperscript{17} Other courts have accepted the results of similar surveys as evidence of blurring.\textsuperscript{18}

The Nikepal court did not explain how mere association translates into evidence that use of NIKEPAL impairs the distinctiveness of the NIKE mark. Numerous trademark commentators have criticized the Nikepal survey method as failing to present persuasive evidence of dilution,\textsuperscript{19} and we believe these criticisms are valid. NIKE is one of the world’s best-known brand names. The fact that a consumer thinks of a famous mark when she sees a word containing that mark may not mean that the distinctiveness of the famous mark is “blurred” or harmed in any way. Indeed, because the association calls the famous mark to mind, its strength and salience may conceivably be reinforced.\textsuperscript{20} The measure used in the Nikepal case cannot tell us which of the outcomes is more likely and, for that reason, lacks construct validity; that is, it cannot be taken as a valid measure of harm.

The marketing literature is very clear on how a brand suffers harm. Marketers would describe harm to a brand (or trademark) as a diminution of (customer-based) brand equity.\textsuperscript{21} Professor Kevin Lane Keller characterizes brand awareness and brand image as the components of customer-based brand equity.\textsuperscript{22} Brand image, in turn, is built from strong, favorable, and unique brand associations. Damage caused by blurring conceptually fits into this framework as

\textsuperscript{17} Id. at 1825, 1828.

\textsuperscript{18} See, e.g., Perfumebay.com Inc. v. eBay Inc., 506 F.3d 1165, 1172 (9th Cir. 2007) (discussing a similar telephone survey asking respondents what website or company they would think of if they encountered the term “bay” used by a website); Deere & Co. v. FIMCO Inc., 302 F. Supp. 3d 837, 873 (W.D. Ky. 2017) (discussing an online blurring survey asking respondents to identify which, if any, companies came to mind upon seeing photographs of certain agricultural equipment); id. at 900 (crediting the survey and finding blurring). See also Krista F. Holt and Scot A. Duvall, Chasing Moseley’s Ghost: Dilution Surveys Under the Trademark Dilution Revision Act, 98 TMR 1311, 1324–29 (2008) (reviewing survey evidence of dilution considered by the federal courts in Nikepal and Perfumebay.com). But see Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 736 F.3d 198, 210–11 (2d Cir. 2013) (finding a 3.1 percent response rate insufficient to prove actual association).

\textsuperscript{19} See, e.g., Matthew D. Bunker & Kim Bissell, Lost in the Semiotic Maze: Empirical Approaches to Proof of Blurring in Trademark Dilution Law, 18 Comm L. & Pol. 375, 384 (2013) (“Aside from the problem of conflating association with dilution, the [Nike] survey certainly provides no evidence of dilutive harm since there is no baseline measurement of the strength of Nike’s brand prior to Nikepal’s entry into the marketplace.”).

\textsuperscript{20} See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 267 (4th Cir. 2007) (“[B]y making the famous mark an object of the parody, a successful parody might actually enhance the famous mark’s distinctiveness by making it an icon. The brunt of the joke becomes yet more famous.”).

\textsuperscript{21} See, e.g., Kevin Lane Keller, Conceptualizing, Measuring, and Managing Customer-Based Brand Equity, 57 J. Marketing 1, 8 (1993).

\textsuperscript{22} Kevin Lane Keller, Strategic Brand Management: Building, Measuring, and Managing Brand Equity 45–51 (2013).
a weakening of brand associations, a compromise of the uniqueness of the associations, or a reduction in the favorability of the associations the trademark owner has worked hard to cultivate. The Nikepal approach cannot indicate that an association is tied to brand weakening and as such is not probative of blurring.

**B. Association and Confusion Survey Results**

Courts have also relied on likelihood of confusion surveys as evidence of dilution by blurring. For example, in *Jada Toys, Inc. v. Mattel, Inc.*, Mattel, which manufactured toy automobiles under the HOT WHEELS mark, argued that Jada Toys’s sale of toy automobiles under the HOT RIGZ mark would both confuse consumers and blur Mattel’s mark. Mattel proffered two confusion surveys. The first exposed respondents to the HOT RIGZ mark and then asked a series of questions designed to determine who the respondents believed “puts out or makes” toy vehicles with that name. The second survey exposed respondents to a HOT RIGZ package and asked similar questions. In reversing the district court’s partial grant of summary judgment to Jada Toys, the Ninth Circuit Court of Appeals pointed to both surveys as “significant evidence of actual association between the alleged diluting mark and the famous mark” and found that a “reasonable trier of fact could conclude that this evidence was sufficient to establish the existence of a likelihood of dilution.”

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23 This view follows the associative network theory of memory in psychology. See Allan M. Collins and Elizabeth F. Loftus, *A Spreading-Activation Theory of Semantic Processing*, 82 Psychol. Rev. 407, 411–15 (1975). That theory models information in (long-term) memory as networks of nodes connected by links. For an example of associative network theory applied in the trademark context, see Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution*, 91 TMR 1018–24, 1046–50 (2001). Here, the nodes consist of trademarks and concepts linked to or associated with those marks. These concepts include product categories and attributes possessed. When exposed to a trademark, the network containing that trademark is activated and the activation signal spreads outward to the concepts linked to that node. Blurring presumes that that signal activates the node of the desired association more slowly, if at all. See id. at 1046–50.

24 *518 F.3d 628 (9th Cir. 2008).*

25 *Id. at 631–32.*

26 *Id. at 636. See also Krista F. Holt and Scot A. Duvall, Chasing Moseley’s Ghost: Dilution Surveys Under the Trademark Dilution Revision Act, 98 TMR 1311, 1332–35 (2008) (discussing the Jada Toys surveys in detail).*

27 *Jada Toys, 518 F.3d at 636. The first survey took the form of an “Eveready” survey. See also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:174 at 468–71 (5th ed 2017) (describing the survey design used in *Union Carbide Corp v. Ever-Ready Inc.*, 531 F.2d 366 (7th Cir. 1976) as “a standard and widely accepted survey format for testing to see if confusion is likely or not”)).

28 *Jada Toys, 518 F.3d at 636.*

29 *Id.*

30 *Id.*
Appeals has more recently written approvingly of the *Jada Toys* court’s reasoning and reliance on confusion survey evidence as potential evidence of dilution, stating that “[s]ource confusion may be probative of association.”

As with the *Nikepal* survey format, consumer confusion surveys show consumer association, but they do not show blurring. Indeed, confusion surveys arguably show the opposite of blurring. Recall that blurring describes situations in which, because of the similarity of the plaintiff’s and the defendant’s marks, consumers see the plaintiff’s mark and must think for a moment to determine whether the mark is referring to the plaintiff or the defendant. In this scenario, consumers are not confused as to source. By contrast, consumer confusion surveys expose situations in which consumers believe that both marks, because of their close similarity, refer only to the plaintiff. In this sense, the defendant’s mark reminds consumers of and reinforces the link between the plaintiff’s mark and the plaintiff.

In other words, in the case of consumer confusion, on encountering the defendant’s mark, the confused consumer associates it with the plaintiff’s mark and believes that it originates in the plaintiff. By contrast, in the case of blurring, on encountering the defendant’s mark, the blurred consumer associates it with the plaintiff’s mark but knows that it originates in the defendant. Evidence of consumer association that leads to consumer confusion is evidence that consumers think there is only one company rather than two; those confused consumers cannot experience blurring because they associate both marks with the same company.

**C. Survey Evidence of Mere Association Is Not Evidence of Impairment**

We present experimental evidence confirming that even when consumers associate a junior mark with a senior famous mark, this does not necessarily result in weakening the association of the famous mark with its source or other associations. Furthermore, such consumer association does not necessarily result in any material change to consumers’ purchasing preferences. In sum, mere association on its own does not necessarily harm the senior mark.

1. **Brand Selection Pretest**

Because we intended in these experiments to study blurring in the form of changes in brand associations, we sought out brands with strong, relatively well-defined associations. We chose automobiles as a product category and collected data from five

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hundred people to identify brands and associations that could potentially be blurred. The research began by showing respondents the names of up to twenty popular car brands. The brand names were shown one by one in random order. For each brand name, respondents were asked whether they were familiar with the brand. For each brand they identified as familiar, respondents were asked to name the top five things that came to mind when they thought of that brand; that is, the top five associations for each brand. We hypothesized that very strong brands would bring to mind a relatively concentrated set of associations, most of which would be positive. Conversely, weaker brands would bring to mind a larger set of more diffuse, and sometimes negative, associations.

To determine how concentrated a brand’s associations were, we collected all of the associations that respondents provided for each brand. We then grouped equivalent associations and calculated the percentage of subjects identifying each group. We then added up the percentages for the five most common association groups mentioned for each brand. This gave us a concentration score. Based on this analysis, we identified MERCEDES, BMW, and INFINITI as our three strongest brands. In all three cases, the most common associations named were characteristics like “luxury,” “expensive,” as well as words that connote wealth and high socioeconomic status.

We selected MERCEDES and INFINITI as our test brands. We selected MERCEDES because it had the highest concentration score. We also selected INFINITI because, although it had a relatively high concentration of positive associations, it was among the least familiar brands in our sample. As such, although INFINITI has relatively clear associations among those who are familiar with it, it may be more easily diluted because its associations are not as widely held.

2. Study 1: Examining Brand Association Strength

Study 1 tested whether blurring advertisements affected the strength of the association between the MERCEDES and INFINITI brands and both their product category (cars) and the top associations (wealth, luxury) previously found for each brand in our initial brand selection pretest. A total of 2,012 subjects participated in the experiment. Each subject was randomly assigned to a brand (MERCEDES or INFINITI), then randomly assigned to a treatment or control group. Subjects in the INFINITI and MERCEDES control groups saw three “filler” text-only “tombstone” advertisements for well-known brands that contained true representations of each brand’s product category and attributes.\(^32\) Subjects in our two

\(^{32}\) A tombstone advertisement presents information via “black and white text only, with no use of human or animal images or cartoon characters.” Lawrence O. Gostin, *Corporate
treatment groups saw the three filler ads plus an ad for a fictitious diluting brand. Subjects assigned to the MERCEDES treatment group saw an ad for a diluting brand called “MERCEDES toothpaste” and subjects assigned to the INFINITI treatment group saw an ad for a diluting brand called “INFINITI toothpaste.”

All subjects were then shown twenty-three brand-word pairs. For each pair, subjects were asked to state the degree to which they associate the brand and the word using a five-point scale that ranged from “a great deal” to “not at all.” Eighteen of these pairs were filler pairs for brands unrelated to cars. Randomly mixed in with the eighteen filler pairs were five brand-word pairs for one of our target marks. The pairs for our target marks included the product category “cars” and two words that capture the high-status qualities that respondents in our brand selection survey tended to associate with both marks: “luxury” and “wealth.” Finally, we included two words that are not associated with the MERCEDES and INFINITI car brands—at least not uniquely so: the product category “toothpaste” and the attribute “cheap.”

If the MERCEDES and INFINITI toothpaste ads were causing dilution by blurring, we would expect that subjects in the treatment groups exposed to such ads would less strongly associate the car brands with the product category “cars.” They may also become less likely to associate these marks with words that our pretests indicated to be strongly associated with MERCEDES and INFINITI, such as “luxury” and “wealth,” and more likely to associate these brands with the word “cheap,” which better describes an ordinary, low-cost product like toothpaste than an expensive luxury automobile. Weakening associations between the brand and “luxury” or “wealth” would indicate that distinctiveness has been impaired. The possible addition of an association between the brand and the attribute “cheap” would be an example of tarnishment, not blurring, which is the subject of this paper. Nevertheless, we felt it interesting to study.

We did not find these effects. Our results show that for a significant number of subjects our blurring stimulus produced a new association—that is, an association between MERCEDES, or INFINITI, and toothpaste. We found little, if any, compelling evidence that the new association between the test brands and the toothpaste product category is accompanied by a weakening of the association between the test brands and their true product category or their principal product attributes.

First, it is clear from our data that the toothpaste ads created a new association between the car brands and the toothpaste product category. About 95 percent of subjects who did not see the toothpaste

ad said they do “not at all” associate the INFINITI or MERCEDES brand with the word “toothpaste.” The result was different for subjects in the treatment groups. In the INFINITI treatment group, 54.8 percent of subjects said they do “not at all” associate INFINITI with the word “toothpaste,” whereas 23.5 percent said they associate these words “a little,” 9.2 percent “a moderate amount,” 6.2 percent “a lot,” and 6.2 percent “a great deal” with the word “toothpaste.” In the MERCEDES treatment group, 73.3 percent of subjects said they do “not at all” associate MERCEDES with “toothpaste,” whereas 15.8 percent associate them “a little,” 5.0 percent “a moderate amount,” 2.8 percent “a lot,” and 3.2 percent “a great deal.” These results should surprise no one. Such differences should be expected after treatment group subjects saw, moments earlier, an ad establishing an association between these brands and the toothpaste product category.\textsuperscript{33}

To the question of whether the toothpaste ad weakened existing car-related associations, we find that subjects who saw the toothpaste ads were no less likely on average than those who did not see it to associate the MERCEDES or INFINITI marks with the product category “cars” or attributes like “luxury” and “wealth.” In short, a comparison of average responses reveals no evidence of distinctiveness having been impaired.\textsuperscript{34}

Of course, looking only at averages can obscure changes in the distribution of responses to each of the brand-word pairs. On occasion, these distributions may possibly tell a more nuanced story. Specifically, in the case of INFINITI, the lesser known of our two brands, we see some evidence that the toothpaste ad might possibly have caused a weakening of the association between the INFINITI brand and the product category “cars.”\textsuperscript{35}

However, in most cases, a weakening of a brand-product category association could not be considered impairing. Brand-product category associations generally do not differentiate the brand within a product category. On the other hand, if there was a weakening of the brand associations of “luxury” or “wealth,” that would be more serious, as those are properties with which not all cars are endowed. When comparing the distributions for product

\textsuperscript{33} A summary of the distribution of responses is set out in Figures 1 and 2 of our full article in the University of Chicago Law Review, supra note 1, at 630-31.

\textsuperscript{34} A summary of average distribution results is set out in Table 1 of our full article in the University of Chicago Law Review, supra note 1, at 628.

\textsuperscript{35} Among control group subjects, 58.65 percent said they associate INFINITI with the word “cars” “a great deal,” and 18.09 percent said they associate INFINITI with cars “a lot.” Among treatment group subjects, the percentage who said they associate INFINITI with cars “a great deal” was lower at 51.81 percent, while the percentage who said they associate INFINITI with cars “a lot” was higher at 25.1 percent. Both groups strongly associate INFINITI with the word “cars”; however, the group that saw the INFINITI toothpaste ad was somewhat less enthusiastic in making that connection. A chi-square test indicates that this difference is statistically significant ($p = 0.002$).
attributes like “luxury,” and “wealth,” however, we found no significant evidence of any meaningful impairment, either in averages or distributional shifts.

We also compared the distribution of responses for subjects in the MERCEDES groups. We found no evidence that the toothpaste ad caused a weakening of the association between MERCEDES and the product category “cars” or the attributes of “luxury” and “wealth.”

In sum, it is clear from our experiments that the MERCEDES and INFINITI toothpaste ads caused subjects to form a new association between toothpaste and our two car brands. Evidence of this was straightforward both when we compared group averages and when we compared how subjects’ responses were distributed. While we observed the formation of a new association among subjects in the treatment groups, we found no evidence that the creation of this new association was accompanied by the blurring or weakening of preexisting within-category differentiating associations. Comparing average responses, there were no statistically significant differences between the treatment and control groups. A closer look at the distribution of responses indicates that the diluting ad may have caused a slight weakening of the association between INFINITI and cars. The data here are far from definitive—especially given the results of Study 2, which we discuss directly below. But our results point toward a method, which we term the “association strength test,” that courts can use to determine whether association is likely to lead, in a particular case, to dilution.

3. Study 2: Dilution and Brand Ranking

Study 1 shows that new associations may or may not lead to the weakening of other associations, but the ultimate question as to whether distinctiveness is impaired is whether these new associations have some effect on the “selling power” of the famous brand. Study 2 engaged this issue. It tested whether ostensibly blurring advertisements and the new associations they produce affect consumer preferences and consumers’ intent to purchase the targeted brand.36

Study 2 consisted of a preference-ordering protocol in which 1,009 subjects were first shown up to twenty car brands in random order and asked to state whether the brand was familiar. When five familiar brands were selected, respondents moved to the next stage of the experiment. Half of the subjects who said they were familiar with either MERCEDES or INFINITI were shown a diluting MERCEDES toothpaste or INFINITI toothpaste ad in addition to

36 A summary of Study 2’s preference ranking results is set out in Table 2 of our full article in the University of Chicago Law Review, supra note 1, at 633.
three filler ads (treatment group). The other half were shown a 
NIKE toothpaste ad in addition to the three filler ads (control 
group).37

After viewing the ads, subjects were asked to rank the five 
brands they had identified as familiar in order of preference, from 1 
(favorite) to 5 (least favorite). Overall, the mean rank for 
MERCEDES was 2.32, and the mean rank for INFINITI was 2.84.

We calculated the differences between the mean preference 
ranking for treatment and control group subjects for each brand. In 
both cases, the differences are not statistically different from zero. 
We were unable to find any evidence from this protocol that the 
diluting ad caused subjects to rank MERCEDES or INFINITI lower.

IV. MOVING FORWARD: WHAT COURTS SHOULD 
REQUIRE DILUTION PLAINTIFFS TO PROVE

To recall, federal trademark law states that “‘dilution by 
blurring’ is association arising from the similarity between a mark 
or trade name and a famous mark that impairs the distinctiveness 
of the famous mark.”38 This statutory language implies that some 
associations do not impair the distinctiveness of the plaintiff’s mark. 
Otherwise, if all association resulted in impairment, there would be 
no need to add the limiting phrase “that impairs the distinctiveness 
of the famous mark.” The statutory scheme assumes an underlying 
fact: association does not necessarily lead to impairment.

Our experiments provide methodologically valid and judicially 
administrable techniques for assessing the likelihood of blurring.39 
Litigants can design studies to mimic our Studies 1 and 2. Taken 
together, these studies suggest that courts that equate mere 
association with impairment are proceeding in error. We exposed 
subjects to diluting stimuli that created new associations among the 
targeted brands and new products and brand characteristics in 
these subjects’ shared associative memory networks.40 But despite 
the new associations, we found no evidence of blurring measured

37 For reasons we explain more fully in the next Part, the control group was shown a 
toothpaste ad for a famous brand other than MERCEDES or INFINITI to ensure that 
control subjects were exposed to some ostensibly diluting advertisement, though one not 
directed at the targeted brands.


39 Note that our experiments do not measure actual dilution, but rather the likelihood of 
dilution occurring within the context of our experimental setting. Laboratory 
experiments inherently involve the simplification of reality. Our experiments, for 
example, do not contain any of the market context that may affect consumers’ perception 
and understanding of trademarks. Of course, this is equally true of virtually all dilution 
surveys employed in trademark litigation. Such studies—like this experiment—should 
be evaluated for their usefulness as evidence of the likelihood of dilution. They should 
not be taken as an indication of actual dilution of any particular mark in the real world.

40 See generally Allan M. Collins & Elizabeth F. Loftus, A Spreading-Activation Theory of 
either by average treatment effects or by effects on purchase intention.

On average, subjects showed no weakening of the association between the targeted brands and their traditional products and characteristics, nor did these subjects reveal any change in purchasing preferences. When we disaggregated average treatment effects and examined the distribution of responses on our five-point scale, we saw some results that suggest the potential for dilution with regard to the INFINITI brand with respect to its association with the automobile product category. But we did not see the same sort of significant shift in the distribution of responses for MERCEDES.

Our results suggest that courts should not treat mere association as tantamount to proof of trademark dilution through blurring. Plaintiffs must present something more than evidence of association between the defendant’s and plaintiff’s marks to establish the likelihood that the plaintiff’s mark will suffer dilution via blurring. Importantly, we believe that our results help to mark the correct path. Courts should require plaintiffs to produce evidence showing that a weakening of the associations between the plaintiff’s mark and its source or other preexisting attributes is likely. Plaintiffs may seek to do so by using our Study 1 and Study 2 methodologies. Study 1 is a direct measure of any such impairment. Data from this type of study should be analyzed to see both whether exposure creates weaker associations on average and also whether it changes the distribution of responses in a way that suggests impairment. As a supplement, Study 2 indirectly measures association strength. It does so by inquiring whether the association of a defendant’s junior mark with the plaintiff’s senior mark “cashes out” in the form of reduced consumer intention to purchase the plaintiff’s goods. In the end, this is the form of harm that brand owners typically care about most because it hits their bottom line. Though the results of one test may sometimes be sufficient to show impairment, courts would be best advised to rely on a combination of these tests and to be wary of enjoining defendants based on weak and conflicting evidence of dilution—such as when (as in our studies) the data reveal no impairment on average or diminution in purchase intention but rather only small shifts in the distribution of responses. Ultimately, the plaintiff should be required to demonstrate that any weakening of association between the plaintiff’s mark and its source or preexisting attributes (or any reduction in purchase intention) is not just statistically significant but also substantively significant.41 Evidence that the defendant’s

41 In our full article in the University of Chicago Law Review we also assess the construct validity of tests for blurring based on response time measurements. Response time tests purportedly show disassociation in that subjects exposed to ostensibly diluting stimuli appear to take longer than control subjects to link targeted marks with their traditional
mark only slightly impairs the distinctiveness of the plaintiff's mark cannot justify the kind of broad injunctive relief that antidilution protection entails.

In sum, we have identified empirical tests for dilution that have construct validity. And yet nothing we have done relieves courts of their central responsibility in assessing this sort of social scientific evidence—a court must always take care to assess the strength of the evidence produced by the tests and not simply rely blindly on a positive and statistically significant result.

All that said, we must confess that, though we have made a contribution by offering methods that both are administrable and possess construct validity, in a deeper sense we remain at sea. Our experiments do not settle the question of the existence of trademark blurring. It is, of course, possible that future surveys used in litigation or academic empirical studies may be able to reliably detect “association” between two similar marks that “impairs the distinctiveness” of one of them. But at present, we have only very weak evidence that this form of dilution ever actually occurs. We have little more than “just so” stories that attempt to explain how dilution by blurring might operate.

So where does that leave us? Given the absence of proof that dilution by blurring actually occurs, we are left to speculate that the problem may ultimately be not with our experiments or the surveys or experiments of others but with the concept of blurring itself. The notion of dilution originally emerged out of the 1924 German Odol case, which was essentially a case about misappropriation, one that happened to involve a trademark. But when Professor Frank Schechter introduced the concept of dilution to American law in his still widely cited 1927 article “The Rational Basis of Trademark Protection,” he downplayed the fact that dilution was a misappropriation doctrine and went so far as to expurgate from his translation of the Odol opinion the court’s core finding that the respondent had “appropriate[d] thus the fruit of another’s labor.” Heavily influenced by law and economics thinking on trademark product categories and product attributes and characteristics. In the article, however, we show that previous versions of these tests used an improper control and therefore lacked construct validity. When response time tests use the proper control, no evidence of dilution is found. See supra note 1, at 628.


The Odol court asserted that the damage to the mark was to its “selling power.” See Beebe, supra note 42, at 60.


Beebe, supra note 42 at 72.
law, with its focus on consumer search costs, the American concept of dilution evolved into the concept of “blurring” and the idea that, when two firms use the same mark, consumers must “think for a moment,” which increases their search costs.\textsuperscript{46} We have struggled ever since to develop empirical proof that any appreciable increase in search costs actually occurs.

Yet courts continue to rule in favor of plaintiffs on antidilution causes of action. We suggest, as others have,\textsuperscript{47} that they do so primarily for reasons sounding in misappropriation, but never articulated as such. The concept of “blurring” acts as an alibi for courts that want to reach what they deem to be the right result in cases like Nikepal, in which a defendant uses another’s famous mark on unrelated goods. The defendant is not causing consumer confusion, but it is reaping where it has not sown by appropriating some of the notoriety of the famous mark. Courts are motivated to accept mere association survey evidence as full-blown evidence of impairment to justify enjoining conduct they deem to be unfair misappropriation.\textsuperscript{48}

This is problematic for at least two reasons. First, we continue to twist ourselves into contortions to develop evidence of blurring when courts’ underlying focus is on fairness and misappropriation. The result is that the concept of dilution grows increasingly vague and outcomes grow increasingly unpredictable. Second, unlike its European counterparts,\textsuperscript{49} the American antidilution statute contains no misappropriation provision. Congress has twice had the opportunity to include such a provision, and twice it has declined to do so.\textsuperscript{50} To the extent that courts are ruling on unstated


\textsuperscript{48} See Nike Inc. v. Nikepal Int’l Inc., 84 U.S.P.Q.2d 1828 (E.D. Cal. 2007) (finding dilution based on a survey in which over 87 percent of participants responded that the word NIKEPAL brought to mind the NIKE brand).

\textsuperscript{49} See Articles 5(3)(a) and 10(2)(c) of Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to Approximate the Laws of the Member States Relating to Trade Marks, 2015 OJ L336 1, 9 (Dec. 23, 2015), Articles 8(5) and 9(2)(c) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (prohibiting the unauthorized registration or use of a qualifying mark that “without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark”).

misappropriation grounds, they are acting outside of the federal statutory framework.

In the end, we are left both better off and worse off than before. We believe that we have produced, at last, methodologically sound tests for measuring the likelihood of dilution. As applied to our test brands, however, none of the measures provided strong evidence that dilution actually occurs. This is not to deny the possibility that our methods might yield evidence of dilution if applied to other target brands with other ostensibly diluting stimuli. More significantly, our methods might show a likelihood of dilution if respondents were repeatedly exposed to the stimuli longitudinally over time. Indeed, Schechter himself spoke of the “gradual whittling away” of the distinctiveness of the brand through the long-term accumulation of otherwise de minimis harms—though the one empirical study that exists of long-term third-party uses of famous marks found no evidence of damage to the marks.

But even if we applied our methods to other brands over time and measured significant reductions in association strength or response delays indicating the possibility of dilution, additional questions would arise. We would need to test the possible mitigating effect of market context. And most importantly, we would still need to test whether laboratory protocols to measure dilution by blurring that showed small average association-strength treatment effects, or small shifts in the distribution of assessments of association strength, were likely to translate into real-world attribute association, preference, or purchase implications.

These are questions that remain open. But we have an intuition about where the evidence will lead. We suspect that the concept of dilution by blurring is a chimera—that is, an imaginary thing that

51 Though difficult to mount, particularly in the litigation context, a longitudinal study might show that repeated exposure to diluting stimuli would at some point generate evidence of blurring. We know of one cleverly designed small-scale pilot study that exposed thirteen undergraduate students weekly over the course of a month to a diluting stimulus in the form of a box of baked goods bearing the trademark CHEVROLET BAKERY. Results from a computer task showed no statistically significant treatment effect. See Dan Svirsky, Measuring Dilution: Is There an Effective Screening Device for Early Detection of Trademark Infections? *31–32 (working paper, 2012) (on file with authors). By contrast, our goal in this article has been to examine and rectify existing studies designed to detect dilution by blurring, all of which involve single-exposure protocols.

52 See Schechter, supra note 44, at 825. See also Hearings Before the House Comm. on Patents, 72d Cong. 15 (1932) (testimony of Frank I. Schechter) (“[I]f you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more.”).

53 See Paul J. Heald & Robert Brauneis, The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names, 32 Cardozo L. Rev. 2533, 2537 (2011) (finding that “[t]he vast number of unauthorized uses of some of the most iconic American trademarks suggests that consumers have a well-developed ability to cabin information in ways that maintain the associational values of even the most overused marks.”).
we insist upon only because it is valuable to us as a proxy for attacking unauthorized uses of senior marks that our intuition tells us are unfair. It is true that, in at least some dilution cases, defendants are engaged in some form of free riding on the fame and goodwill enjoyed by the plaintiff's mark. Free riding is, admittedly, not a simple thing to judge. Whether it is fair or unfair, productive or destructive, often depends on subtle differences in context. But courts are better at judging these sorts of contextual questions than they are at running a social science inquiry into the hypothesized, but unproven, cognitive concept of “blurring.” It is better, we think, to reframe the dilution cause of action away from cognitive science and toward the broader and more tractable questions of fairness and harm that the courts have become accustomed to dealing with in misappropriation cases.
Serving as Commissioner for Trademarks has been the best job I've had in my career. It has been an honor and a privilege to serve our customers and stakeholders, to lead an amazing Trademarks team, and to collaborate with colleagues in the United States Patent and Trademark Office (USPTO) and across the federal government and private sector as well as other trademark offices abroad. With my tenure coming to a close this year, I look back with satisfaction and pride for what the Trademarks organization has accomplished over the past five years, and I look forward with optimism for the future of the USPTO, trademarks, brand owners, and the IP community.

Combatting Improper Behavior Before the USPTO

The last couple of years have been particularly challenging as we experienced issues of a magnitude we had never seen. I'm talking specifically about the rise in questionable filings and bad-faith behavior before the office. For example:

- Submission of fake or altered specimens of use;
- Submission of inaccurate or knowingly false claims of use in U.S. commerce;
- Filings by practitioners who aren't authorized to appear before the USPTO;
- False claims of representation by U.S. counsel and attempts to circumvent the U.S. counsel requirement; and
- Unauthorized address changes and unauthorized assignments of ownership in the files of others.

In July 2019, I testified before the House Judiciary Committee's Subcommittee on Courts, Intellectual Property, and the Internet about the rise in improper trademark submissions and bad-faith behavior, as well as the proliferation of counterfeit goods in the marketplace. We discussed the actions the USPTO had taken, and plans to take, to combat the problem within the limits of our existing statutory authority. My testimony was the starting point in what has become an ongoing dialogue with Congress to address these issues.

issues. Through the hearing and our subsequent positive interactions with the Subcommittee, we have enhanced the opportunity for further collaboration to address real abuses of our trademark system.

We’ve had to come to terms with the reality that we cannot simply rely on the requirement under U.S. law that a mark be used in commerce, or on the good faith of all applicants and registrants to protect the U.S. trademark register. At the same time, we have embraced these developments as an opportunity to review our examination policies and our IT systems. We have developed and implemented new policies, procedures, and technology solutions and are continuing to work on others.

Of course, looking back, we had started gathering data on inaccurate filings when I was serving as Deputy Commissioner for Trademark Operations. In 2012, we launched a pilot program to audit registrations for current “proof of use” to assess the accuracy and integrity of the trademark register. In the pilot, 500 registrations were randomly selected where six-year Section 8 or 71 declarations of use were filed. We requested current proof that the mark was in use for the goods and services listed in the declaration. By the end of the two-year pilot, we were dismayed to find that 51 percent of the audited registrations were unable to verify the use that they had just claimed. We made the pilot a permanent program in 2017, and we currently audit about 5,000 registrations per year.

Trademarks has also implemented a number of other measures to curb or stop bad actors. We are committed to implementing measures that strike the right balance between deterring improper conduct and avoiding excessive new burdens on the majority of filers who do operate in good faith. Among them are:

- creation of the Special Task Force on Improper Behaviors to look for trends and to develop and coordinate our efforts to combat improper filing behaviors;
- development and implementation of the U.S. Counsel Rule effective August 3, 2019, requiring foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board (TTAB) proceedings to be represented before the USPTO by an attorney licensed to practice in the United States. The U.S. Counsel rule helps ensure effective use of available mechanisms to enforce foreign user compliance with our statutory and regulatory requirements. This rule was a major change in practice and required extensive coordination within the USPTO as well as other government agencies and bar groups;
- development and implementation of training for examining attorneys and paraprofessional staff on how to detect and refuse fake specimens;
• outreach and education to applicants, registrants, and their representatives on U.S. use requirements and U.S. rules that require they confirm the accuracy of their submissions to the USPTO. Our July 29, 2019, seminar held on the “proof of use program” covered these requirements. We are also adding educational materials to our website and information to our notices to ensure that our customers fully understand what “use in commerce” means and its importance to the trademark register;
• establishment of an electronic mailbox to which parties submit relevant evidence of improper behaviors to the USPTO; and
• development of new IT solutions to better identify doctored specimens, to flag improper filings at the time of filing, and to create a database of specimens so we will know when the same specimen is submitted by different applicants and registrants.

Improving IT Systems

While dealing with the significant problem of improper behaviors, we have also been diligently working to:
• stabilize and modernize our IT systems;
• use automation to promote accuracy and efficiency in our work;
• find technology solutions to combat the increase in improper third-party behavior such as unauthorized address changes and unauthorized assignments of ownership, and submission of digitally created and digitally altered specimens of use.

Stabilization and Modernization

Regarding stabilization and modernization, earlier this year, as the result of a strong collaborative effort between the USPTO’s Office of the Chief Information Officer and Trademarks, we made the decision to refocus the Trademarks Next Generation (TMNG) investment. While still in the nascent stages, Trademarks’ future IT system will establish an end-to-end electronic workflow incorporating artificial intelligence, machine learning, robotic process automation, cutting-edge security, block chain movement of applications, and data and disaster recovery capability in the cloud. It will take advantage of the latest technology to leapfrog the current generation of IT. The system we envision will seamlessly integrate the TTAB with Trademarks and will usher in automation of IT processes handled manually today such as petitions and other paper-based business practices. The system will connect with
partner intellectual property offices—specifically WIPO for Madrid Treaty applications—but will also integrate, as allowed, with international partners for operations like image searching and design coding. We have a long way to go, but our tireless team has laid the groundwork needed to take this system from concept to reality.

**Promoting Accuracy and Efficiency**

Our employees are always looking for ways to use technology and automation to promote efficiency and accuracy in our work. One of the major quality-and-efficiency initiatives is the move to mandatory electronic filing. Processing paper filings is more expensive for the office (in fact, paper filings cost more than we charge, so, in effect, e-filers have been subsidizing paper filers), and it creates an opportunity for errors because all paper must be scanned. Optical character recognition errors occur during scanning, which affects the quality of the office’s work and the accuracy of the trademark register.

Knowing that some of our customers might be reluctant to file electronically, we moved toward this goal incrementally. First, I met with multiple groups of users to socialize the concept, and to listen to and address any concerns. Then, in 2015, we reduced fees for those promising to be fully electronic throughout the trademark prosecution process. In 2017, we raised fees for those continuing to file paper documents. In 2018, after extensive discussions with bar associations, we published a Federal Register Notice proposing mandatory electronic filing, and on July 31, 2019, we published the final rule in the Federal Register. This incremental approach has worked well to ensure that bar associations and our customers are on board for this important change. On December 21, 2019, the office will begin requiring all trademark documents, except in very limited circumstances, to be filed electronically.

Our innovative team also leveraged technology to provide our users and stakeholders with an easy and efficient way to monitor their applications and registrations. In May 2019, Trademarks launched the agency’s first mobile device app. This groundbreaking app allows users to establish a direct account with the USPTO and quickly check the status of any pending or registered federal mark. The user can set up the app to send alerts when the status of applications or registrations changes. Additionally, by entering the registration number, the user can immediately link to the Trademark System of Data Retrieval (TSDR) and have access to all the features provided by that system.
Leveraging Technology to Combat Improper Behavior

Finally, we recognized the need to improve the security of our electronic filing systems to protect the integrity of data and to prevent bad actors from making unauthorized changes to the files of others.

Our open and easily accessible trademark system made the USPTO an easy target for bad actors. We had to take bold action to strengthen the accuracy and integrity of the trademark register and to safeguard customer records. On October 26, 2019, we implemented mandatory login to access the Trademark Electronic Application System (TEAS) and TEAS International (TEASi) forms. Users must now log in to a USPTO.gov account with a two-step authentication. This is the first step towards protecting filing records from unauthorized third-party interference. Future phases will further enhance the security process by verifying account holder information and allowing more control and delegation of access to forms. We are attacking the problem of bad-faith behavior on all fronts, and we have already seen a drop in these improper activities and expect that downward trend to continue.

In addition, we are evaluating and testing other tools that will help us combat the actions of bad-faith filers, including tools that will identify doctored specimens and flag other improper behaviors. We are also bringing our TEAS system in line with the Federal Information Security Management Act.

Operating Reserve and Fees

For thirty-five days in December 2018 and January 2019, the office was faced with a significant threat—having to shut down due to lack of access to funds collected during the government shutdown. As a result of careful planning, fiscal restraint, and advocacy for our operating reserve, Trademarks was in a position to stay open for an extended period, unlike much of the government.

It was important to all of us here to ensure the protection of Trademarks’ operating reserve for the future. At my request, the Financial Advisory Board raised the minimum operating reserve to $75 million and the “optimal” operating reserve to six months. This will enhance the likelihood that a healthy operating reserve will be maintained in the future.

We also changed the fee structure to better align with corresponding workloads. Trademarks is careful with its money and conducts periodic inquiries to determine whether fees are optimal. We lowered fees when we could (2015) and raised fees when necessary (2017). Trademarks’ financial team monitors budget and expenses carefully and sometimes uses fees to drive behavior (such as the shift from paper to electronic filings). Due primarily to the increased funding needed for IT projects and an anticipated shift in
filing patterns, Trademarks once again needs to increase fees. To protect the operating reserve further, I requested that the fee process be significantly shortened to enable Trademarks to implement its new fees in FY2020, rather than FY2021 as originally proposed. This swift action has ensured that the operating reserve will remain at a healthy level in the future and ensure Trademarks will remain operational even if the office faces a lengthy government shutdown.

As required by the America Invents Act (AIA), on September 23, 2019, the Trademark Public Advisory Committee (TPAC) held a hearing to gather stakeholder input on a proposed fee increase. TPAC's report on the fee hearing is available at https://www.uspto.gov/sites/default/files/documents/TPAC_Report-on-Trademark-Fee-Proposal_20191031.pdf. The office plans to issue a Notice of Proposed Rulemaking in spring 2020, with a final rule expected in summer 2020. This fee increase is crucial to securing the future of the operating reserve and Trademark operations.

The Customer Experience

One of my most satisfying achievements was bringing our customer service to a completely new level. I was a customer of the office for many years before I joined the office, so I understand the customers' perspective. I wanted to place the customer at the center of everything we do, including making every customer touchpoint consistent, clear, and intuitive. To ensure that this happened, we hired a customer experience administrator, plain language writers, and web strategists. We developed a strategic plan and started by improving our public-facing electronic systems by making them more user-friendly and adding features to make it easier for our customers to provide feedback, which we then use to make targeted improvements. We also overhauled the Trademarks home page so that we are now providing our customers, especially small business staff and entrepreneurs, with information that can be easily found, understood, and used. We want every interaction the public has with Trademarks to be positive. We energize our staff with employee-of-the-month awards, customer service awards, and now have a customer service hall of fame. With 35 to 40 percent of our filings coming from pro se applicants, we need those acting without lawyers to better understand our forms, systems, and communications. Our customer experience team is doing a great job tackling this challenge.

Anti-counterfeiting Campaign

One of our newer initiatives is our anti-counterfeiting public awareness campaign. The USPTO needs to protect not just intellectual property rights holders, but also consumers, the public,
and the U.S. economy from the very real dangers and negative effects of counterfeit goods. On April 3, the White House issued the Presidential “Memorandum on Trafficking in Counterfeit and Pirated Goods.” The memorandum required that the Secretary of Homeland Security, in coordination with the Secretary of Commerce, and in consultation with other agencies submit a report to the President. The report is required to evaluate policies and procedures of third-party intermediaries relating to trafficking in counterfeit and pirated goods and identify the practices of those entities that have been most effective in curbing the importation and sale of counterfeit and pirated goods, including those offered through online marketplaces. The USPTO’s Office of Policy and International Affairs played an active role in preparation of that report on behalf of the Department of Commerce. The report has been submitted to the White House for review, and a public version will be made available via the Federal Register as required under the memorandum. The report will include U.S. government recommendations on how platforms, other third-party intermediaries, and rights holders can help in the fight against counterfeit and pirated goods.

In the meantime, the USPTO is actively working with the Administration in developing anti-counterfeiting policies. We are raising public awareness through our video contest and we just launched a multi-year, nationwide public awareness campaign with the National Crime Prevention Council. The USPTO has also undertaken anti-counterfeiting efforts by helping government officials, both in the United States and abroad, to improve domestic and foreign laws and policies.

As Commissioner for the last five years, it’s been very important to me to build on the success that Trademarks has enjoyed for many years. Along the way, I’ve seen unprecedented challenges and exciting opportunities, and working hand in hand with my wonderful, talented team, we have attempted to rise to each occasion with the long-term best interests of the customers, the office, and the trademark system in mind. Throughout my tenure, I have endeavored to be a good steward for the trademark system. I have been honored to serve as Commissioner and believe my successor will find the office in excellent condition, with a talented and dedicated team of leaders and professionals poised to help conquer future challenges.
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