INTELLECTUAL PROPERTY SURVEYS:  2011 - 2012

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# TABLE OF CONTENTS

I. INTRODUCTION .................................................. 3

II. THE YEAR IN REVIEW: 2011 - 2012 ......................

   A. GENERICNESS SURVEYS ..................................... 4

   B. SECONDARY MEANING SURVEYS ....................... 10

   C. LIKELIHOOD OF CONFUSION SURVEYS .................. 12

   D. FALSE ADVERTISING SURVEYS ........................... 28

   E. FAME SURVEYS ............................................. 31

   F. DILUTION SURVEYS ......................................... 33

   G. DAUBERT/ADMISSIBILITY ISSUES ....................... 36

   H. PROCEDURAL ISSUES ....................................... 41

III. BIBLIOGRAPHY—INTELLECTUAL PROPERTY SURVEYS: 2011 - 2012—BY CIRCUIT ....... 44

IV. BIBLIOGRAPHY—INTELLECTUAL PROPERTY SURVEYS: 2011 - 2012—BY ISSUE ........... 52

V. BIOGRAPHICAL INFORMATION .............................. 63
I. INTRODUCTION


The following provides short excerpts of a number of selected opinions referencing survey evidence published in opinions from January 2011 through December 2012,2 which might be of interest to the Lanham Act litigator.3 The bibliographies to this paper provide citations, by circuit and by survey issue, for all identified opinions published during this time period in which survey evidence was referenced.

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1 Copies of the previous papers published by the Practising Law Institute (PLI) are available from the PLI or Westlaw. The previous paper published in the Proceedings of the American Intellectual Property Law Association (AIPLA) is available from the AIPLA. A compilation of all these papers is available at INTA.org. Copies of these papers and the compilation are also available from the author.

2 The primary focus of this paper and prior annual reviews of survey evidence is on surveys related to Lanham Act claims. Notwithstanding this focus, this paper, as well as previous papers, includes reference to surveys in other intellectual property matters as they are identified.

II. THE YEAR IN REVIEW: 2011 - 2012

A. GENERICNESS SURVEYS


[Defendant] does object to the survey on the grounds that consumer surveys are irrelevant if the term at issue was not coined by the party that is seeking trademark protection. [Defendant] relies on a Fourth Circuit case which rejected as “irrelevant” a registrant’s survey of local consumers because the registrant had not first coined the term “crab house.”...([and the 8th Circuit] holding that survey evidence concerning the term “Brick Oven” was irrelevant because the designation was “commonly used” before the use by either party). But the court agrees with authorities that challenge this position and finds that consumer surveys can play an important role in determining primary significance even if the term at issue was not first coined by the party seeking to protect its mark. See *McCarthy*...§ 12:17:50 (criticizing the holding in the cases cited above and noting that “[t]o state that consumer perception is irrelevant for a non-coined “generic” word . . . is to assume the result before making an analysis of that which is to be decided”). No matter how a term received its genesis, the “primary significance” test is still of paramount importance to determine if the term is generic, and a consumer survey is a useful indicator of what that significance is to the relevant public.


Applicant points to its survey conducted to show acquired distinctiveness. Overall, we find this survey to be lacking in probative value. The participants in the survey were limited to people already on applicant’s website which has the effect of skewing the results in applicant’s favor. After the participants have already come to applicant’s website they were asked the following questions:

- Do you associate RADIO-INFO.COM with the website of one, or more than one company?
- Do you believe RADIO-INFO.COM to be the brand name of the website located at the URL www.radio-info.com?

The survey did not follow the “Teflon” methodology discussed in *E.I. du Pont deNemours & Co. v. Yoshida Int’l, Inc*...For example, the survey does not adequately reflect the difference between a brand name and a domain name. Applicant argues that 80% of the participants of the survey “associated RADIO-INFO.COM as the website of one company (and) 481 of 515 people who participated in the survey answered that they believed RADIO-INFO to be the brand name of the website.”...Aside from the serious flaws in the survey, as noted
in Hotels.com “consumers may automatically equate a domain name with a brand name.”...


This opinion is a precedent of the T.T.A.B.

Applicant also submitted a “Teflon” type consumer survey...targeted to listeners of country music...The stated objective of the survey was to measure the relevant public’s understanding of the significance of the term COUNTRY MUSIC ASSOCIATION...The survey sample was based on a random digit probability sample of computer-generated phone numbers derived from all working telephones in the continental United States and based on a representative sample of the U.S. population. Using a double-blind protocol, the interviewers screened for qualified survey respondents who consisted of males and females at least 18 years of age who listened to country western music. The interviewer explained to the qualified survey respondents the conceptual distinction between a “brand or proprietary name” and “common name” using the following example: “By brand or proprietary name, I mean a name like ‘Bank of America’ which is used by one company or organization; by a ‘common name’ I mean a name like ‘safe deposit box’ which is used by a number of different companies or organizations...Respondents were then asked two questions to test their ability to distinguish brand or proprietary names from common names: (1) Do you understand the name “National Football League” to be a brand or proprietary name or common term? (2) Do you understand the name “high school football” to be a brand or proprietary name or common term? One hundred persons were deemed qualified and interviewed after completion of the screening process. These qualified respondents were then given a list of terms and asked whether they were brand or common names.

...respondents were asked whether the following ten terms were brand [or proprietary names] or common names. The results represented in percentages were as follows:

<table>
<thead>
<tr>
<th>Term</th>
<th>Brand Name</th>
<th>Common Name</th>
<th>Don’t Know</th>
<th>Both</th>
</tr>
</thead>
<tbody>
<tr>
<td>STP</td>
<td>74</td>
<td>6</td>
<td>19</td>
<td>1</td>
</tr>
<tr>
<td>Coke</td>
<td>92</td>
<td>7</td>
<td>--</td>
<td>1</td>
</tr>
<tr>
<td>Jello</td>
<td>66</td>
<td>30</td>
<td>1</td>
<td>3</td>
</tr>
<tr>
<td>Refrigerator</td>
<td>9</td>
<td>91</td>
<td>--</td>
<td>--</td>
</tr>
<tr>
<td>Margarine</td>
<td>12</td>
<td>86</td>
<td>2</td>
<td>--</td>
</tr>
<tr>
<td>American Airlines</td>
<td>94</td>
<td>5</td>
<td>1</td>
<td>--</td>
</tr>
<tr>
<td>Gas Station</td>
<td>6</td>
<td>94</td>
<td>--</td>
<td>--</td>
</tr>
<tr>
<td>National Rifle Association</td>
<td>93</td>
<td>4</td>
<td>2</td>
<td>1</td>
</tr>
<tr>
<td>Alumni Association</td>
<td>23</td>
<td>74</td>
<td>3</td>
<td>--</td>
</tr>
</tbody>
</table>

...respondents were [then] asked, with regard to music, whether the following were understood to be the name of a brand or proprietary name used by
one company or organization or a common name used by a number of different companies or organizations. The results represented in percentages were as follows:

<table>
<thead>
<tr>
<th>Brand Name</th>
<th>Common Name</th>
<th>Don’t Know</th>
<th>Both</th>
</tr>
</thead>
<tbody>
<tr>
<td>Country Music</td>
<td>85</td>
<td>10</td>
<td>5</td>
</tr>
<tr>
<td>Association</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>iTunes</td>
<td>86</td>
<td>3</td>
<td>11</td>
</tr>
<tr>
<td>Bluegrass</td>
<td>15</td>
<td>77</td>
<td>8</td>
</tr>
</tbody>
</table>

A significant number of surveyed respondents, 85%, answered that COUNTRY MUSIC ASSOCIATION is a brand name. Based on the survey results, [Applicant’s expert] concluded that the term “country music association” is perceived by listeners of country western music as a proprietary or brand name, and not a generic term.

The examining attorney questions [Applicant’s expert’s] interpretation of the survey results. First, he argues that the survey respondents’ recognition of the wording “country music association” as a brand name does not mean that the mark is not generic but rather is the result of applicant’s extensive promotion of its mark. (n.5 The examining attorney's assertion is incorrect. Extensive promotion of a mark that results in acquired distinctiveness is evidence that may be considered with regard to the genericness inquiry...) Second, the examining attorney maintains that it is impossible to distinguish whether the survey results reflect respondent’s recognition of applicant’s mark as a brand name for applicant’s association services or for applicant’s annual televised award program.

As a threshold matter, we find that the methodology used in [Applicant’s expert’s] survey to be sound. Similar to the Teflon survey, the respondents were capable of distinguishing between brand and common names. In addition, the interviewers presented to respondents brand and common names which are similar to the mark at issue here such as “National Rifle Association” and “Alumni Association” in testing the respondent’s ability to distinguish such names. According to the survey results, the majority of listeners of country western music, members of the relevant public in this case, identified COUNTRY MUSIC ASSOCIATION as a brand name as opposed to a common or generic designation. We therefore find that [Applicant’s expert’s] survey has probative value in applicant’s favor.

Finally, although the consumer survey conducted by [Applicant’s expert] was submitted in connection with the issue of genericness, the acquired distinctiveness of the term COUNTRY MUSIC ASSOCIATION among the relevant purchasing public can be inferred from the results. By categorizing the term COUNTRY MUSIC ASSOCIATION as a brand name, 85% of the respondents were saying, in effect, that they associated the term with the product or services of only one company.
Finally, we consider applicant’s consumer survey which purports to use both a “Thermos” and “Teflon” style methodology...to measure the relevant public’s understanding of the significance of the term THREE CARD POKER... Applicant asserts that the survey results demonstrate that THREE CARD POKER is not generic. We disagree, finding that the survey methodology is fundamentally flawed.

For the Thermos style question, respondents were asked: “If you walk into a brand new casino and want to find the area where the dealer games are located, how would you complete the following question: Excuse me where can I find the ?” The choices were BLACKJACK, CASINO WAR, CARD GAMES, FORTUNE PAI GOW, POKER, TABLE GAMES, TEXAS NO LIMIT, HOLD'EM POKER, or THREE CARD POKER. However, unlike the respondents in Thermos...the respondents in this case were not also asked to name any proprietary or brand name dealer games, or more specifically, whether any of the above terms referred to brand or proprietary names. As such, this portion of applicant’s survey is of little probative value.

Respondents were then asked another series of questions which purported to use the Teflon style methodology, asking respondents whether THREE CARD POKER was “primarily” a “common name” for the following choices – “live games of chance,” “casino services,” “casino games,” “table games,” “card games,” or “poker” or whether it identified a “the name for a specific type of poker.” Respondents were also asked whether they would use the term “three card poker” to refer to any of the same choices. The survey methodology, however, failed to follow the Teflon protocol because it did not ask any screening questions to ensure that respondents were capable of distinguishing between brand and common names. In applicant’s survey, the only guidance respondents were provided was the following narrative:

A common name is a name that is used to refer to an entire class of items. For example, the common name for NIKE brand products might be shoes.

Equally problematic, respondents were not eliminated if they failed to understand the distinction.

By contrast, in the Board’s recently decided case of In re Country Music Ass’n, Inc..., respondents were screened...to ensure their understanding of this conceptual distinction...

In addition, applicant’s potential survey choices were poorly worded. In lieu of directly asking respondents whether a term constituted a “brand” or “proprietary” name, respondents were instead asked whether a term referred to a “specific type of poker.” The survey did not state that “specific type of poker” meant brand or proprietary name, and in fact, no explanation of the meaning of the term was supplied. Applicant then argued that positive responses that “three card poker” referred primarily to a “specific type of poker” constituted evidence that respondents perceived the term as a brand or proprietary name. We disagree with this conclusion, and in fact find that such responses support the contrary
finding that the term “three card poker” constitutes a generic term for a type of poker game. As such, the survey results do not favor applicant.


n.20 ...we have given little weight to applicant’s survey which has major deficiencies and is not particularly useful to show that SOFTSPIKES is recognized as a mark by the relevant public as a whole. This was a telephone survey...The sample consisted of a total of 50 individuals from six states who were responsible for ordering the products for golf shops located at courses which require players to wear non-metal spikes. The 50 respondents were divided into two groups of 25 respondents. Each group was read a list of names for various golf products, some of which were brand names and others of which were common names. The list presented to one group included “Softspikes” and the other list included “plastic cleat.” After each name in the list was read, respondents were asked whether it is the name of a type of golf product, a brand name of a specific product, or both. They could also respond “no opinion.” The results show that 16% of respondents identified Softspikes as a type of product; 48% identified it exclusively as a brand; and 36% identified it as both a type of product and a brand. The fact that 48% identified “Softspikes” as a brand name would be sufficient to raise a doubt as to whether the mark is generic, but the sample size is so small and the universe is so narrowly defined that the results are not meaningful. In particular, even if we assume that the selected universe for the survey, i.e., golf shops, identifies a discrete subset of purchasers for applicant’s golf cleats, that subset is very small, representing only 17% (by applicant's own figures) of applicant's entire market. And with only 25 participants in the test group, the results cannot be generalized to even this limited subset of the relevant public as a whole...


Petitioner conducted a “homemade” survey of 18 of its customers (“a small cross-section of (petitioner’s) customer base”) that sell headache racks...Based on their answers to two questions, petitioner concludes that an overwhelming majority of these 18 survey respondents recognize that their customers (i.e., the end user), generally use the term “Backrack” as the name of any headache rack or cab guard as opposed to an identifier as the source of a product...

Respondent objects to petitioner’s survey evidence on the grounds that petitioner failed to disclose the survey during discovery, and that the survey constitutes inadmissible hearsay. Whether the survey is designated as a scientific survey (n.93 In fact the survey is not a scientific survey; the survey designer readily admitted that he is inexperienced and not an expert with respect to surveys...)...
Survey evidence is subject to review for its probative value, based on factors including the design of the survey, the questions asked, and the experience of the surveyor...While all surveys are necessarily based on some degree of hearsay, petitioner’s survey is replete with fatal defects, including a double layer of hearsay. That is, the survey does not solicit opinions directly from the true subjects of the survey. Rather, the survey respondents simply serve as conduits to relay feedback they supposedly received from their customers, i.e., the end users, who are the true subjects...

Putting aside the fatal defects pertaining to the small number of respondents surveyed and the fact that the survey was not administered to the end users who comprise a significant portion of the relevant public, the design of the survey did not test for genericness of the BACKRACK mark. Rather than ascertaining the term used by the relevant public to identify a headache rack, the survey asked what name was used by customers to identify a “BackRack truck rack.” (n.95 Survey question No. 1: When customers come into your store or call you on the phone looking to buy a BackRack truck rack, do they most often ask for a “BackRack” or do they most often ask for a “BackRack truck rack” or “BackRack cab guard?”...). The designer of the survey...testified that he was looking to establish whether consumers were improperly using the term “Backrack” as a noun...Whether customers refer to the rack as a “Backrack,” (i.e., use the term as a noun), “Backrack truck rack” or a “BackRack cab guard” sheds no light on the genericness issue. Customers looking for a BACKRACK brand product will undoubtedly use the term “Backrack” as a noun:

The fact that buyers or users often call for or order a product by a term does not necessarily prove that a term is a “generic name.” The person who orders for lunch a “BIG MAC and a COKE” undoubtedly has brand knowledge and brand loyalty. The generic names “hamburger” and “cola” are understood by all precisely because BIG MAC and COKE are such strong trademarks identifying source. Since everyone knows the generic names, they are dropped in ordinary usage.

The second survey question is so ambiguous and speculative that it precludes the possibility of drawing any conclusions. (n.97 Survey question No. 2: Has there ever been instances, even if only on occasion, that customers have come into your store or call you asking for a “BackRack” when they really don't actually want a “BackRack” at all; rather they want another type of truck rack? For instance, this could mean a different type of cab guard or a full truck rack?...) Neither survey question elicited responses that could provide insight into whether consumers understand the term BACKRACK to mean a product brand or source, or a product genus. Additionally, whether respondents are capable of distinguishing between brand and common names is an important feature of a genericness survey, and petitioner’s survey was not designed to detect this capability...In view of the foregoing, petitioner’s imprecise and non-scientific
survey is not probative of the significance of the term BACKRACK to the relevant public...

B. SECONDARY MEANING SURVEYS


n.15...[Plaintiff] submitted two consumer surveys in support of its argument that secondary meaning in the mark “black card” has accrued to [Plaintiff]...

The [Plaintiff’s first expert’s] Survey surveyed a sample of 200 individuals with a household income of $250,000 or more. 33.5% of respondents stated that they associated “Black Card” with only one company: [Plaintiff]. Surveying an ostensibly broader group, those who currently have or within the next year will consider getting a credit, charge, or debit card with an annual fee of $450 or more, the [Plaintiff’s second expert’s] Survey found that 19.4% of respondents indicated a unique association of the name “Black Card” with [Plaintiff].

[Plaintiff] has demonstrated that summary judgment is appropriate on its claim that the PTO registration of [Defendant’s] “BLACKCARD” mark should be cancelled because the mark is not inherently distinctive and [Defendant] has not demonstrated secondary meaning...


...the secondary meaning survey question, “If you have an opinion, what is the brand of motor oil product in the picture I showed you?” is somewhat leading. A better phrasing of the question would have been “what is the brand or brands . . .” or “what company or companies puts out this product?”...However, other courts have found such questions not to be leading...In the context of product packaging, which “almost automatically tell(s) customer that (it) refer(s) to a brand . . . and immediately signal(s) a brand or a product source”...the Court finds that this question phrasing is only slightly leading. The best remedy, the Court concludes, is to give slightly less weight to the survey as a result of this phrasing...

...The Court does find the control bottle used in the secondary meaning survey to be slightly problematic, but not enough so to warrant exclusion. As a control, the interviewers showed an “F-style bottle” with a single handle—the sort frequently used several years ago in the industry but less often today—that had been painted all brown, with the label fully blacked-out...
...we address the probative value of applicants consumer surveys and declarations. While survey evidence is relevant to establish acquired distinctiveness, the proponent of the survey must document the procedural and statistical accuracy of the evidence. In this case, applicant’s survey evidence consisted only of 23 survey questionnaires completed by the survey respondents themselves. Apparently, applicant and/or applicant’s counsel distributed the survey questionnaires to an unknown number of people at motorsports events who filled them out at their leisure and subsequently mailed them back to applicant's counsel. Suffice it to say that there is no basis on which to conclude that the survey is based on scientifically valid principles. While we will not consider the “consumer surveys” as survey evidence, we will consider them as declarations purportedly asserting recognition of the proposed mark as a source indicator.

...both parties submitted surveys. [Opposer] introduced the survey and testimony deposition of [Opposer’s expert] who sought to determine “the main function of the word “zero” . . . in the brand name Coca-Cola Zero.”...The concern with the [Opposer’s expert’s] survey is that it is a survey more of meaning than source identification. The source identifying function of a trademark and the “main function” - as [Opposer’s expert] put it - of a word in that mark are not necessarily the same things. If, as [Opposer] argues, the term ZERO is merely descriptive, it would not be inconsistent for consumers to view the term ZERO as both describing a characteristic of COCA-COLA ZERO while still perceiving the term to be a source indicator. The “main function” premise of the survey and source identification are not mutually exclusive. Put another way, it is possible that a “main function” of ZERO in [Applicant’s] marks is to identify a characteristic of applicant’s goods, but consumers nevertheless may have come to recognize that applicant is the only entity that identifies the characteristic of its goods in that manner. It is not enough that consumers merely know that ZERO means “something” is missing from COCA-COLA ZERO. The survey needs to test whether consumers view ZERO in the marks as indicating a source of the goods.

[Applicant’s] rebuttal survey was more on point. Rather than look for the “main function” of ZERO, the [Applicant’s expert’s] survey attempted to rebut the [Opposer’s expert’s] survey by determining whether ZERO in COCA-COLA ZERO served a trademark function. The [Applicant’s expert’s] survey examined acquired distinctiveness to see if ZERO was associated with one company or more than one company...[Applicant’s expert] found that 61% of respondents “perceive” that ZERO was associated with only one company as opposed to 6% for the term DIET...
We find that the [Applicant’s expert’s] survey validates the significant sales and advertising numbers discussed above. Consumers have been exposed to [Applicant’s] ZERO products and advertising on television, over the radio, via print media, and in every conceivable retail outlet. Billions of the products have been sold since 2004. [Opposer’s] attempt to show that the ZERO marks have not acquired distinctiveness simply fails in light of the scope of [Applicant’s] significant sales and marketing numbers.


Applicant’s direct evidence that the candy bar design has acquired distinctiveness comprises a consumer recognition survey...Applicant commissioned a blind internet survey of individuals (over 18 years old) who “have both purchased a chocolate bar in the past six months and also plan on purchasing a chocolate bar in the next six months.”...The survey respondents were shown the “four by three” panel candy bar configuration in the application. A control group also was used and was shown a “one by three panel” candy bar design. Respondents were first asked if they associated the “appearance or design of the product with one or more particular companies.”...If the respondents answered affirmatively, they next were asked which company or companies they associated with the design and appearance of the product...After adjusting for the control group, approximately 42% of the survey participants correctly identified applicant as the maker of the candy bar...These percentages are significant when compared to previous cases where secondary meaning or acquired distinctiveness in a mark has been established...We do not find these survey results, alone, to be conclusive in establishing that the candy bar design has acquired distinctiveness; however, the survey is one piece of persuasive evidence that is considered in conjunction with the entire record before us.

C. LIKELIHOOD OF CONFUSION SURVEYS

_Go SMiLE, Inc. v. Dr. Johnathan Levine, 769 F. Supp. 2d 630, 642-643 (S.D.N.Y. 2011)_

In an effort to establish a low likelihood of consumer confusion, defendants have proffered [an] expert report...five hundred “qualified prospective consumers of tooth whitening products” participated in one of two online surveys...The surveys were double blind: participants were not informed of the survey’s purpose or sponsorship, and the firm retained to administer the survey was not told of the study’s sponsor or purpose...

The first survey was a so-called “Eveready” survey...Fifty survey participants were shown an image of the Glo packaging, and a separate image of the Glo light-whitening products in their packaging...Another fifty were shown an image of the packaging on “GLO Brilliant” whitening gels...The survey asked participants to “look at this product” as if they were viewing it on a cable shopping channel such as QVC or HSN, in a store such as Sephora or on a
It then asked all participants: “Do you have an opinion about what company or brand puts out the product you were just shown, or do you not?” Respondents who answered “yes” were then asked to identify the brand or company responsible for the product. All participants were asked if they knew of any other products marketed by the same company, and if so, the brand and product marketed by that company.

All respondents were then asked if they believed that “the company that puts out the product you were shown is affiliated with or received approval from any other company or brand that you know of.” None of the 100 respondents in the Eveready survey named Go SMiLE as a potential source of the Glo product. The product was associated with 14 other brands, which were as varied as Sony and Crest. Four associated Glo with Sephora, but when asked to explain the basis for making the association, responses included that it looked like a product that Sephora would sell, that “it is nice,” and erroneously, that the product said Sephora on the box.

The second survey was a “sequential lineup survey” of 400 respondents, 200 of them assigned to a test cell and 200 to a control cell. Respondents were first shown an image of a Go SMiLE product package. Half saw the packaging of the “GO SMiLE SMILE WHITENING SYSTEM.” Half saw an image of the “GO SMiLE GO WHITER” product. “The purpose of including two products in the study was to cover two different manners in which consumers could encounter the GOSMILE mark on GOSMILE products.”

Respondents in the control cell were then shown Glo packaging, with the word “glo” removed, and the product renamed as “Brilliant G.” The control-cell alterations were intended to “measure noise — i.e., the extent to which survey respondents will make a connection between the two products even when the GLO marks have been removed.”

In the test cell, 37.5% of respondents concluded that the GLO Brilliant product “is put out by the same company as Gosmile” or is otherwise affiliated with Gosmile. In the control cell, which did not use “Glo,” 38.5% of respondents reached the same conclusions. The [Defendant’s expert’s] Report concludes, “Since the Test and Control Cell results were equivalent, the net confusion level is 0%. There was not confusion caused by the GLO or GLO Brilliant mark above the level of survey noise.”

I find his testimony to be credible and the surrounding results to be reliable and probative. They support my finding that there is little likelihood of consumer confusion as to the parties’ products.


[Plaintiff’s expert] conducted two surveys based on the “array or Squirt research model” — one for the Miss Disney shirts (“Miss Disney survey”) and another for the Little Miss Disney shirts (“Little Miss Disney survey”). In brief, respondents for each survey were asked a series of questions after being exposed to two portfolios of products: one containing either Miss Disney or Little Miss Disney shirts, and one containing Little Miss THOIP shirts.
In sum, because [Plaintiff’s expert’s] Survey failed to replicate actual marketplace conditions, lacked a proper control, improperly counted certain responses as indicating confusion, and suffered from demand effects, it is not a reliable indicator of consumer confusion, and is inadmissible.

_U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.,_ 800 F. Supp. 2d 515, 532-535 (S.D.N.Y. 2011)

The [DJ Plaintiff] presented a survey [which addressed the issue of likelihood of confusion]...

The...survey tested three fragrance packages, all set on beige packaging with gold lettering: (1) the Double Horsemen logo with “USPA” beneath, (2) the Double Horsemen logo with “U.S. POLO ASSN.” beneath, and (3) the Double Horsemen logo with “U.S. POLO ASSN.” arched above and “1890” below. [DJ Plaintiff’s expert] used two controls. One sported identical packaging and gold ink to the three tested fragrances, except instead of the Double Horsemen logo, the control featured USPA’s horsehead mark, which consists of a picture of a horse’s head in an oval shape formed by a stylized horseshoe, with “U.S. POLO” arched above. The second control is a fragrance which presents a gold embossed polo player astride a horse, facing directly to the viewer’s right, with “Beverly Hills” arched above and “Polo Club” below...

The [DJ Plaintiff’s expert’s] survey found 28% gross confusion with the Double Horsemen logo with “USPA” beneath; 27% gross confusion with the Double Horsemen logo with “U.S. POLO ASSN.” beneath; and 25.5% gross confusion with the Double Horsemen logo with “U.S. POLO ASSN.” arched above and “1890” below...The survey found 28.5% confusion with the USPA’s horsehead mark control and 32% confusion with the Beverly Hills Polo Club control...

The most significant error in the...study was its choice of control variables. Without a proper control, there is no benchmark for determining whether a likelihood of confusion estimate is significant or merely reflects flaws in the survey methodology. “In designing a control group study, the expert should select a stimulus for the control group that shares as many characteristics with the control group as possible, with the key exception of the characteristic whose influence is being assessed.”...Here...controls were improper in that they included the very elements being assessed,...namely, the word mark “POLO” and, in the case of the Beverly Hills Polo Club control, also a mounted polo player image.

...In sum, due to its significant drawbacks, the Court gives the [DJ Plaintiff’s expert’s] study no weight.
(S.D.N.Y. 2011)

...plaintiffs [also] presented the results of [a] survey that addressed the likelihood of consumer confusion.

The population for [Plaintiffs’ expert’s] survey consisted of men and women 18 years of age or older who lived in, worked in, shopped in or otherwise visited the area in which G.A.P Adventures’ New York City store is located and who were likely to shop for travel tour packages or travel tours in the next 12 months. This universe was designed to include both actual and prospective purchasers of G.A.P Adventures’ services.

Respondents in the test cell were shown the test stimulus: a photograph of the front of G.A.P Adventures’ New York City store.

Respondents in the control cell were shown a photograph identical to that used in the test cell, except the storefront sign that read “G.A.P Adventures” was replaced with a storefront sign that read “The Great Adventure People Adventures.” Otherwise, the stimuli used in the test cell and the control cell were the same.

In Question Set 1, respondents were asked what services or products they would expect to be able to get at the store in the photograph. The purpose of this question was to determine whether respondents believed the store to be a Gap store.

In Question Set 2, respondents were asked whether they thought the company that operates the store in the photograph also operates any other store or business...The purpose of these questions was to determine whether respondents believed the store in the photograph to be operated by the company that runs Gap stores.

In Question Set 3, respondents were asked, “Do you think the company that operates the store I showed you got authorization, that is, permission, from any other company to use their name, or not, or don't you know.”...The purpose of these questions was to determine whether respondents believed that the company that operates the store in the photograph obtained authorization or permission to use its name from Gap clothing.

Overall, the survey demonstrates that 40.9% of respondents in the test cell were confused into thinking either that (1) the G.A.P Adventures store was a Gap store, or (2) the G.A.P Adventures store was operated by the same company as Gap, or (3) the G.A.P Adventures store was authorized by Gap.

By comparing the results in the test cell and the control cell, [Plaintiffs’ expert] concluded that (1) there is a significant likelihood that consumers will confuse G.A.P Adventures with Gap; and (2) this likelihood of confusion is due solely to G.A.P Adventures’ use of the word “G.A.P”--when the word “G.A.P” was removed, no respondents were confused.
I credit [Plaintiff’s expert’s] survey as evidence of a likelihood of confusion.


The parties dispute the relevance and methodologies of one another’s [likelihood of confusion] consumer surveys. “To be probative and meaningful . . . surveys . . . must rely upon responses by potential consumers of the products in question.”...When a senior user asserts that its mark has been unlawfully used by a defendant, the relevant survey universe is the prospective purchasers of the defendant’s products...In this case, the relevant universe would consist of prospective [Defendant’s product] purchasers, and the relevant underlying issue is whether that population erroneously believed that [Plaintiff] sponsored, affiliated or associated with [Defendant]...

According to [Defendant’s] expert, a net eight percent of likely [Defendant’s product] consumers either believed that [Defendant] and [Plaintiff] were affiliated in the “Luxury” ad, or that [Plaintiff] granted permission to use its marks...Ten percent stated that they were more likely to purchase a [Defendant’s product] as a result of the basketball in “Luxury.”...[Defendant] asserts that these figures reflect an absence of actual confusion.

[Plaintiff] points out certain flaws in the [Defendant’s expert’s] survey. They note that the basketball showed to the control group was a chestnut-brown color. Indeed, by depicting the ball in an atypical color that mimics the [Plaintiff’s] marks, a reasonable trier of fact may question the control’s credibility. In addition, [Defendant’s expert] asked participants, “In creating the commercial, do you think the company that produces the advertised brand or product (X) got or was required to get permission from any other company or brand?” As [Plaintiff] notes, the question is not only compound, but requires participants to draw a legal conclusion as to [Defendant’s] obligations...Judge Scheindlin concluded that a consumer-confusion study premised on a similar question “carr(ied) little weight,” and cited other district courts that reached the same conclusion...

To the extent that [Plaintiff] cites its own expert’s opinions in opposition, that evidence is not directed to likely [Defendant’s product] purchasers and instead looks to the misapprehension among all participants who recognized the [Plaintiff’s] mark...While such views may be relevant in the dilution context — where the inquiry is directed toward perceptions of the senior mark and the whittling away of the senior mark’s power — they carry little or no weight under the relevant survey universe...and do not shed light on the ultimate issue of whether prospective [Defendant’s product] purchasers mistakenly believed that [Plaintiff] sponsored, approved or affiliated with the “Luxury” ad.
In addition to the flaws identified in the Daubert opinion [see Gucci v. Guess?, 2011 U.S. Dist. LEXIS 132706], testimony at trial revealed several other reasons to give reduced weight to the conclusions in the [Plaintiff’s expert’s] survey. First, he tested a cross-body bag, even though cross-body bags represented a maximum of three percent of bags sold during the period for which Gucci claims damages...Second, the results of his survey cannot be extrapolated to bags in other colorways...which account for more than seventy-five percent of Guess-branded bags bearing the Quattro G Pattern...Third, it is unreasonable to apply [Plaintiff’s expert’s] findings to those bags that feature the “slightly garish kind of hardware” and loud coloration that are key features of the [Defendant’s] brand

Based on the foregoing, I find that the [Plaintiff’s expert’s] Survey — when viewed in light of the [Defendant’s expert’s] observational study and the testimony of all the confusion experts at trial — is not entitled to significant weight, and therefore provides only weak evidence in support of [Plaintiff’s] trade dress claims...

...[Plaintiff’s] survey of consumers is also not evidence of actual confusion. Surveys are only evidence of actual confusion if they replicate the real world setting in which a consumer would encounter the mark...[Plaintiff’s] survey was conducted online and using only the names of each company. It did not incorporate either party’s logo or the packaging that accompanies the products. This is not how a consumer would encounter either party’s products in a real world setting and is not strong evidence of actual confusion.

n.5 In Question 1, respondents were asked “Do you believe that this restaurant (does serve or use the products you saw earlier) or do you believe this restaurant (does not serve or use the products you saw earlier)?...For respondents who answered “no” and “I don’t know” to Question 1, they were asked Question 4 which posed “Do you believe that this restaurant (is connected or affiliated with the company that put out the products you saw earlier)?”...

The [Plaintiff’s expert’s] survey mixed inquiries about [Defendant’s] use of Steak Umm products with inquiries about any “connection or affiliation” between Steak ‘Em-Up and Steak Umm....The [Plaintiff’s expert’s] survey focuses on an inquiry that has no relevance to this case and which has nothing to do with the likelihood of confusion between the brands. This point alone renders the survey unreliable as an indicator of the likelihood of confusion to the consumer. With regard to the connection or affiliation inquiry, I find that the
[Plaintiff’s expert’s] survey unduly suggests to the survey participants that there may be some affiliation or connection simply by the use of the word “steak” in each name without any explanation or any additional information about the two entities.


...the Court does not find the [likelihood of confusion] survey evidence inadmissible based on failure to replicate market conditions. Although the interviewees were shown photographs of the products, whereas in a store they would see three-dimensional bottles, that method is commonly used and accepted...


Plaintiff has also opposed defendants’ motion for judgment on plaintiff’s claims by producing a “consumer survey.” This survey consisted of plaintiff sending an e-mail question to 60,000 e-mail addresses that plaintiff acquired directly by consumers that “signed up” on plaintiff’s website or were provided to plaintiff by local vendors or local businesses. Plaintiff received 155 responses to the survey - or 0.25%...

...The question posed by plaintiff in this e-mail survey was: “Which one of these companies, if any, would confuse you into thinking that they were either part of iShopStark.com or actually iShopStark.com?”...The recipients of this e-mail question could select from the following from a drop-down menu: yellowpages.com;...HeyButler.com; ShopNStark.com;...BuyNDine.com; [and none]...

...the Court is doubtful of the methodological validity of the survey...on the question of consumer confusion. When methodological issues undermine the relevance and persuasiveness of a survey, it is appropriate for the Court to accord little weight to the results...


Finally, [Defendant] argues that the district court erred in crediting an expert survey...purporting to show that nineteen percent of consumers of retail banking services would be confused as to the source of [Defendant’s] marketing materials. [Defendant] first challenges the control mark used by the [Plaintiff’s expert’s] survey to filter out confusion caused by carelessness...[Defendant] asserts that the control mark “First Bank & Trust” used in the [Plaintiff’s expert’s] survey was improper because it does not include the phrase “First National.” To the contrary, “(t)o fulfill its function, a control should ‘share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.’”...Here, one
“characteristic whose influence is being assessed” is the phrase “First National,” so the use of that same phrase in the control mark would mask not just careless responses, but also legitimate confusion. We agree with the district court that the control used by the [Plaintiff’s expert’s] survey was proper.


n.5 We also find that Defendants’ behavior contributed to the low answer rate [in Plaintiff’s] survey. For example, we credit Karen Funk Seller’s testimony that a representative of [Defendants] called on the telephone and told her to ignore the survey. (…[Defendants] called me on the phone and told me to ignore this letter.”) In light of Defendants’ attempt to subvert the survey, their complaints about the purportedly low answer rate are unconvincing. Defendants should not benefit from their attempt to undermine the survey...


…Plaintiff’s expert…conducted a survey demonstrating that HSN infomercials created a fifteen-percent level of net confusion with the Borghese brand…The Second Circuit has indicated that this level of net confusion is probative of consumer confusion...


…The Gallo defendants submit the result of [a] survey. In that survey, less than 1%, or one person out of 216, was confused about the origin of the Camarena bottle based on its shape. As mentioned above, this Court finds [Gallos’] survey to be highly probative of the lack of likelihood of consumer confusion...

…The Proximo plaintiffs have submitted no evidence that raises a genuine issue of fact. Although they criticize the Gallo defendants’ expert survey, they present no counter-survey results or any other evidence to rebut the evidence presented by Gallo...


Defendant retained an expert…to conduct a consumer survey to determine whether distributors and architects who purchase commercial washroom products are likely to be confused as to the source of Defendant’s Roval products…[Defendant’s expert] found an extremely low likelihood of confusion: 7.4% for architects; 1.3% for distributors; and 4.7% for the combined sample…Plaintiff also retained an expert…who performed a “likelihood of confusion” survey of architects…[Plaintiff’s expert found a significantly higher “net confusion” of 38.46%...
The Court finds that [Plaintiff’s expert’s] survey is entitled to no probative weight and is, in fact, inadmissible under Federal Rule of Evidence 702. [Plaintiff’s expert] used the so-called Squirt methodology in conducting [the] survey. Participants were sent two envelopes. They were instructed to open the first envelope, which contained an advertisement for one of Plaintiff’s products. They were then instructed to put this advertisement back into the first envelope and to open the second envelope, which contained advertisements for four other products: one manufactured by Plaintiff, and three manufactured by other companies (i.e., the “control group”). Participants were then asked a series of questions regarding the relationship of the products in the second envelope to the company that manufactured the product in the first envelope.

The advertisements used in [Plaintiff’s expert’s] survey, however, were extremely leading. The advertisements for Plaintiff’s product and Defendant’s product were nearly identical: similar products, arranged in a similar fashion (i.e., a full-page photograph of the product arranged vertically on the page), with similar shading, style and other visual characteristics. The advertisements for the other three products - the purported “control group” - were substantially different. Instead of a full-page photograph of the relevant product, each of these advertisements contained a very small photograph. One advertisement (for Kimberly-Clark) showed a different product altogether. Another advertisement (for Bradley) was oriented horizontally, instead of vertically (as were all of the other advertisements). The “control group” advertisements also differed from Plaintiff’s and Defendant’s advertisements in terms of shading, style, and other visual characteristics.

In sum, [Plaintiff’s expert’s] survey format effectively predetermined its result - participants inevitably would conclude there was a relationship between the substantially-similar advertisements for Plaintiff’s and Defendant’s products, as opposed to the substantially-different advertisements for the remaining three manufacturers. Accordingly, the survey is neither admissible nor entitled to any probative weight...

In contrast, the Court finds [Defendant’s expert’s] survey both admissible and persuasive. [Defendant’s expert] utilized the so-called Eveready methodology in conducting his survey. Participants were instructed to look at an advertisement for one of Plaintiff’s products for the same amount of time that they would look at it if they saw it in a magazine. Participants were then asked a series of questions regarding the source of the product shown in the advertisement. The survey was not leading, and it consistently showed a very low likelihood of confusion.


...In order to determine the likelihood of confusion, [Plaintiff’s expert] performed a mall intercept survey in sixteen different malls around the country...The respondents were randomly assigned into two groups, with the first group exposed to the [Plaintiff’s] mark and the second (control) group exposed to
...After initial screening questions, consumers were asked the following four questions:

1. If you have an opinion, what company makes or puts out this product?
2. If you have an opinion, do you or do you not think that the company that makes or puts out this product makes any other brand or brands of neti pots?
3. If you have an opinion, do you or do you not think that the company that makes or puts out this product is connected or associated with any other company or companies?
4. If you have an opinion, do you or do you not think that the company that makes or puts out this product has authorization or permission from any other company or companies.

The results of the survey showed that only one of the 164 respondents in the first group (0.6%) believed that [Plaintiff’s product bearing its mark] had an association or connection with [Defendant’s product bearing its mark]...

[Defendant] challenges the admissibility of [Plaintiff’s expert’s] survey results and opinions. Specifically, [Defendant] asserts that [Plaintiff’s expert’s] survey is fundamentally flawed because: (1) it failed to test the universe...of consumers who are most likely to buy [Plaintiff’s] goods; (2) the chosen sample was not a fair sampling of the target universe; and (3) the questions posed could not adequately determine the likelihood of confusion between the two marks...According to [Defendant], these errors render [Plaintiff’s expert’s] survey and conclusions inadmissible...

In this case, [Defendant’s] counterclaim for trademark infringement is based on the theory of forward confusion. Forward confusion occurs when the junior user diverts a senior user’s customers and “attempts to capitalize on” the senior user’s existing reputation and goodwill...In cases of forward confusion, “the proper universe to survey is the potential buyers of the junior user’s goods or services.”...

...[Defendant] argues that, by focusing on this universe, the survey erroneously focused on respondents who are more likely to be familiar with [Defendant’s product] than [Plaintiff’s product]...[Plaintiff’s expert’s] survey focused on the wrong universe because the respondents represent likely purchasers of [Defendant’s] products and not [Plaintiff’s] goods.

[Defendant’s] argument is mistaken in that it confuses consumers who are likely to buy neti pots with those who are likely to be familiar with particular marks. Because the focus of surveys in forward confusion claims are consumers likely to buy the junior user’s goods, in cases such as this, where [Defendant] and [Plaintiff] market their products to similar groups, it is not uncommon for likely consumers of the junior user’s products to be familiar with both the junior and senior marks...

Second, [Defendant] alleges that the survey is flawed because it did not determine whether the respondents were familiar with the [Defendant’s] mark...However, as noted above, the focus of a consumer confusion survey should
be the junior user’s goods...Therefore, [Defendant’s] argument in this regard is meritless.

Finally, [Defendant] argues that [Plaintiff’s expert’s] survey design is systematically flawed because it: (1) fails to expose respondents to both the [Plaintiff’s] and the [Defendant’s] marks and trade dress; (2) allows respondents to view the stimulus during survey questioning; and (3) demands that customers identify the company name rather than the brand name...The Court finds all of these arguments unavailing.

First, [Defendant] argues that [Plaintiff’s expert’s] survey is flawed because it does not expose consumers to both the [Plaintiff’s] and [Defendant’s] marks. However, the Tenth Circuit has repeatedly explained that “(i)t is axiomatic in trademark law that ‘side-by-side’ comparison is not the test.”...

Here, [Defendant] does not provide evidence that the products are ever sold side-by-side...Thus, performing a survey with a side-by-side comparison would not accurately account for the marketplace conditions under which consumers encounter the two competing marks...

Second, [Defendant] argues that [Plaintiff’s expert’s] survey is flawed because the respondents were permitted to view the stimulus during questioning. However, surveys only provide useful evidence of confusion if the survey mirrors a real world setting...[Defendant’s] argument that [Plaintiff’s expert’s] survey was flawed because it permitted the respondents to handle the merchandise is unconvincing because the survey accurately accounted for marketplace conditions under which consumers encounter the neti pots.

Third, [Defendant] argues that [Plaintiff’s expert’s] survey is flawed because it requires that respondents identify the company name rather than the product’s brand name. However, the inquiry under both a trademark infringement and a trade dress claim is whether the marks are so similar that “there is a likelihood of confusion among consumers as to the source of the competing products.”...Thus, for a survey to test confusion it must determine whether the “ordinary prospective purchaser, exercising due care in the circumstances, is likely to regard (the junior mark) as coming from the same source as the trademarked article (the senior mark).”...Moreover, [Plaintiff’s expert’s] experiment was tailored to Professor McCarthy’s generally accepted “Standard Format” to test confusion in trademark cases...


[Defendant’s expert] designed a double-blind survey utilizing a questionnaire that respondents completed on the internet...[Defendant’s expert’s] sample size consisted of 401 respondents who had purchased a sinus remedy
product in the last six months or intended to purchase one in the next six months... Among other questions, respondents were asked the following:

3. Tell me what comes to mind when I say:
   a. SinuCleanse
   b. SinuSense
   c. Nielmed (sic)

...This question did not present the [Defendant’s] mark in its stylized format... The survey then presented respondents with photographs of the package design for either the Neti pots or the saline packets... Subsequently, the packaging for the... brands was presented side-by-side...

...[Plaintiff] argues that [Defendant’s expert’s] survey universe is overinclusive because it does not adequately limit survey respondents to prospective users of sinus wash products...

...Given that the relevant population targeted by [Plaintiff’s] allegedly infringing products is users of nasal wash products (i.e. neti pots, saline refills, and squeeze bottles), [Defendant’s expert’s] failure to differentiate between general sinus remedy product users and prospective sinus wash users renders his survey universe overinclusive...

...[Plaintiff] argues that [Defendant’s expert’s] survey does not replicate market conditions because question No. 3 of the survey does not present the stylized version of the [Defendant’s] mark, which is the only one consumers encounter... Additionally, [Plaintiff] argues that [Defendant’s expert] disassociates the [Plaintiff’s] mark from the [Plaintiff’s] company label, which does not replicate consumers’ exposure to its products... [Plaintiff] claims that, as a result of presenting the marks in this manner, [Defendant’s expert’s] survey “bias[es] the survey respondents with the intent to make them consider [Defendant’s product] and [Plaintiff’s product] as more ‘similar.’”...

For a survey to provide reliable information, the survey must resemble the manner in which consumers would view the products in the marketplace...

In typical marketplace conditions, [Plaintiff’s] products usually contain both the SinuSense™ mark and the “waterpik” label on the face of the packages... Additionally, consumers only encounter [Defendant’s] products with the SinuCleanse® mark in its stylized manner... Consequently, the Court finds that [Defendant’s expert’s] use of the unstylized SinuCleanse® mark and the separation of the SinuSense™ mark from the “Waterpik” label fails to adequately replicate market conditions.

...because the obvious result of [Defendant’s expert’s] survey is to exaggerate any confusion that might be detected by focusing respondents’ attention solely on the packaging of the three products, the probative value of the survey is decreased...

...
When evaluating the objectivity of a survey, a court must consider the degree of suggestiveness of every survey question...

...First, question No. 7(a) of the survey asks respondents: “Now, please tell me whether you think that . . . two or more of the products you see now are made by the same company.”...This question is suggestive because it introduces the possibility that one company made two or more of the products...Rather than measure any actual confusion, the question suggests, at least implicitly, that respondents should believe that there is some sort of relationship between the different items when the possibility might not even have occurred to the vast majority of consumers...In contrast, Professor McCarthy’s sample question asks respondents “What company do you think makes this product?”...In Professor McCarthy’s question, the respondent must provide the name of the company on his own accord, thereby showing the surveyor the extent to which the respondent was confused by the marks, if at all. In this regard, Professor McCarthy’s question is not suggestive.

Question No. 8(a) asks respondents: “Looking at these products, do you think that . . . One or more of the COMPANIES WHO’S (sic) products you see now have a business affiliation or connection with the other shown here?”...Also, question No. 9(a) asks respondents: “Looking at these products, do you think that . . . One or more of the products you see now received permission or approval from the others shown here.”...Both of these questions suggest to the respondent that there should be an association between the companies that produce the products in the survey...By limiting the respondents’ answers to “others shown here,” the question creates the impression of a relationship...In contrast, Professor McCarthy’s sample question asks respondents “Do you think this product was approved, licensed or sponsored by another company or not?”...Professor McCarthy’s question is open ended and allows respondents to determine what, if any, company approved or licensed a particular product. More importantly, Professor McCarthy’s question is not leading or suggestive because it does not limit respondents’ responses to the companies affiliated with the products in the survey.

In addition, none of the questions in [Defendant’s expert’s] survey require that a respondent identify the name of a company. However, it is axiomatic that a consumer cannot be confused as to the source of the marks if he had no previous knowledge of a particular source...Thus, [Defendant’s expert’s] failure to question respondents as to the source of the marks divests the survey questions of any probative value.

The Court retains the authority to determine what weight, if any, it should afford a consumer survey...Moreover, individual flaws in methodology typically only relate to the weight of the survey evidence...However, “when the deficiencies are so substantial as to render the survey’s conclusions untrustworthy, a court should exclude the survey.”...[Defendant’s expert’s] survey has an overinclusive survey universe, an unrepresentative sample, replicates unrepresentative market conditions, and contains suggestive questions. The Court finds that the substantial deficiencies in [Defendant’s expert’s] survey
cumulatively render all of his conclusions devoid of any probative value and therefore irrelevant as they do not make the existence of a likelihood of confusion more or less probable...


Finally, applicant relies on a survey to show that there is no likelihood of confusion. We begin by observing that typically surveys are used to prove likelihood of confusion rather than to prove no likelihood of confusion. While the survey follows the accepted format set out in _Union Carbide Corp. v. Ever-Ready, Inc._..., and followed by the Board...we find that it is compromised by the initial statement to the survey participants. In the preliminary statement of purpose, the participants are told “that the research [is] related to website names.” The reference to “website names” does not prepare the participant to perceive these examples as brands or trademarks but rather more as simply the virtual world’s version of an address...


...applicant has not disputed, the competence of opposer’s survey expert...In this case, [Opposer’s expert] designed a mall intercept survey involving interviews with four-hundred thirty-two respondents at shopping malls in eight geographically dispersed metropolitan areas. According to [Opposer’s expert], the survey indicates that “the net measured likelihood of confusion of approximately thirty-six percent (35.64%) is attributable solely to the presence of the CLINIQUE portion of Applicant’s proposed CLINIQUE DENTIQUE mark.”...

In understanding the relevance of a particular percentage, courts and the Board find likelihood of confusion when a “substantial” or “appreciable” number of consumers are likely to be confused. In analyzing percentage numbers then, courts will extrapolate a percentage to the actual number of potentially confused consumers. In any case, thirty-six percent represents a substantial number of potential consumers, based on the class of consumers being those members of the public interested in enhancing their personal appearance, or even, based on opposer’s annual sales...

[Opposer’s expert] explains the significance of the survey results when compared to the results of the control group:

Specifically, the survey results make clear that the causal nexus for likelihood of confusion is Applicant’s use of CLINIQUE in Applicant’s CLINIQUE DENTIQUE mark and is not due to any other alternative explanation. Because the control cell, using the BOUTIQUE DENTIQUE mark, also employed the same list of services (restorative, cosmetic and family dentistry services) and asked the same survey questions, and resulted in less than six percent (5.56%) likelihood of confusion with
opposer’s Clinique, it is certain that the measured likelihood of confusion is attributable solely to the presence of the CLINIQUE portion of Applicant’s proposed CLINIQUE DENTIQUE mark. Conversely, the survey results also make clear that the use of a dissimilar mark in conjunction with the list of Applicant’s specified services is not likely to cause confusion...

Applicant has retained its own survey expert to attack the probative value of opposer's made-for-litigation survey...

However, we find that opposer’s survey was carefully constructed to mirror the so-called Ever-Ready...survey format...This survey is consistent with those accepted in our established precedent on Ever-Ready type trademark surveys.

...we find that [Opposer’s expert’s] 6- and 7-series of questions [n.33 (Question 6.0) [On seeing the test cell card or control cell card]: “Who, or what company, do you believe owns or operates this business?” (Question 6.1) “Why do you say that?” (Question 6.2) “What, if anything, can you tell me about INSERT RESPONSE TO Q6.0?”] parallels the precise formats approved in Ever-Ready and Carl Karcher. The survey was conducted well within the parameters of the likelihood of confusion survey formats previously accepted by this Board...Thus, we find that it is reliable and has probative value on the issue of likelihood of confusion as to the CLINIQUE DENTIQUE mark used in connection with restorative, cosmetic and family dentistry services...

Although applicant criticizes [Opposer’s expert] for making the word “cosmetic” continuously visible on the stimulus card to the interviewee, we note that opposer’s survey expert merely adopted verbatim applicant’s recitation of services. This is entirely consistent with Board practice and the progeny of the Ever-Ready decision over more than three decades.

The parties are also at odds over the question of whether the fictitious mark used on the control cell card, BOUTIQUE DENTIQUE, was an appropriate choice. While applicant’s expert criticized [Opposer’s expert’s] choice, we find it an appropriate choice to eliminate any noise from the survey, and certainly find greater weaknesses in the alternatives thrown out by applicant’s expert and counsel.

Next, we note that consistent with Ever-Ready, opposer’s 8- and 9-series questions were designed to elicit responses concerning authorization/approval and affiliation/connection. While these types of questions were not expressly addressed in Ever-Ready, a leading commentator...suggests, and court opinions have found,...that authorization and affiliation queries are appropriate in light of the specific language of the Lanham Act.

Additionally, each series of the survey questions contain the follow-up question: “Why do you say that?”...The answers given to these follow-up questions persuade us that the respondents were not merely reading the stimulus card, guessing or trying to please the interviewer.
...given the way in which this survey format carefully follows the *Ever-Ready* survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein.


Finally, in connection with its argument that there is no evidence of actual confusion, applicant requests the Board to make an adverse inference based on opposers’ failure to conduct a likelihood of confusion survey. It is well-established that we do not make such adverse inferences...


[Opposer] further testified that “over the years we’ve done a number of studies and ... telephone surveys done by a third party market research firm.”...A summary of a July 2008 market research survey shows that over a four-year period, a range from 75% to 86% of purchasers who took the survey recognized BLACK CAT as a brand name for fireworks...Because the parameters of the survey have not been described, the record does not reflect the make-up of the chosen survey universe, and the questions that were asked of the respondents are missing from the record, we afford the survey little weight...


...With respect to the substance of the survey:

. it “covered consumers of fruit or fruit-flavored drinks and fruit-flavored carbonated drinks,” excluding those employed in fields which might give them “special knowledge or insight,” and those “who had an immediate household member so employed;”

. in total, 404 consumers participated in the survey, conducted via the “mall intercept” method, with 200 consumers participating in one of two “test cells” and 204 consumers participating in one of two “control cells;”

. one test cell was questioned about applicant’s involved mark “in the context of fruit or fruit-flavored drinks,” while the other was questioned about applicant’s involved mark “in the context of fruit flavored carbonated soft drinks;”

. the control cells were similarly divided between carbonated and non-carbonated beverages, and consumers in the control cells were
questioned not about applicant’s involved mark, but instead about the “control mark” CAN DO;

. respondents were shown a card bearing the mark applicable to their particular group, and asked a series of questions, starting with whether the respondent [*19] had “any opinion about what company or brand makes or distributes a drink with this name?”

. respondents answering yes were then asked which company or brand makes or distributes a drink under the applicable mark, followed by “what makes you think so?”;

. respondents were then asked if they had an opinion about “any other product or products” which are “made or distributed by the same company that makes or distributes this drink;”

. those answering “yes” were next asked “what other product or products do you think are made or distributed by the same company?,” followed by “what is your reason for thinking” so;

. finally, respondents were asked whether or not the drink is made “with the permission of, or in affiliation with any other company,” and, if the answer was yes, “what other company or brand?”

...After subtracting the 14.7% of control cell respondents who named MOUNTAIN DEW, i.e. the “noise level,” from the 62.5% of test cell respondents who were confused, [Opposer’s expert] found that “net confusion” was 47.8%...

We find that [Opposer’s expert’s] survey, which used the “mall intercept” method, surveyed approximately 400 respondents divided into control and test groups, displayed the test and control marks on cards, and asked a series of questions and follow-up questions in a well-accepted format, is admissible and credible. In fact, the survey is quite similar in design and execution to surveys we and federal courts have previously held to be persuasive...we find that the survey weighs in favor of a finding of likelihood of confusion.

D. FALSE ADVERTISING SURVEYS


“(T)he success of a plaintiff’s implied falsity claim usually turns on the persuasiveness of a consumer survey.”...
The plaintiff contends that “[Plaintiff’s expert’s] Report conclusively demonstrates that omission of the words ‘Made in China’ from [Defendants’] lithographs is materially misleading to consumers with a deception rate significantly higher than 20%...
The [Plaintiff’s expert’s] Report explains how the study was designed:

... The experiment was composed of two Cells. 200 respondents were assigned at random to Cell 1 and 200 to Cell 2.

Respondents in Cell 1 were shown a booklet containing three lithographs of Liberty caskets and a booklet containing three lithographs of Matthews caskets. The Liberty lithographs did not designate the caskets as being made in China. Respondents were then asked which casket (out of the six shown to them) would be their first, second, and third choices to buy (if they had a preference or preferences at all).

Respondents in Cell 2 were also shown a booklet containing three lithographs of Liberty caskets and a booklet containing three lithographs of Matthews caskets. The Matthews booklet was identical to the booklet shown to Cell 1. The Liberty booklet was the same as the one shown to Cell 1 except that the lithographs were changed to indicate that the Liberty caskets are “Made in China.” Respondents were then asked the identical question as in Cell 1 - which casket (out of the six shown to them) would be their first, second, and third choices to buy (if they had a preference or preferences at all).

...The “Summary of Key Findings and Opinions” includes five findings and opinions. The final finding and opinion is: “5) Based on the survey results, it is my opinion to a high degree of professional certainty that the information that a Liberty casket is made in China is material to consumers and that the omission of such information is misleading to consumers.”

Although [Plaintiff’s expert’s] survey would support a conclusion that information that a casket is made in China is material to consumers, it does not support a conclusion that the omission of such information from Liberty’s advertising and promotional materials renders them impliedly false. No part of [Plaintiff’s expert’s] survey focused on Liberty’s advertising and promotional materials and whether they suggest that Liberty’s caskets are manufactured domestically. Nor for that matter did any part of the study focus on advertising and promotional materials in general to determine what characteristics of such materials, if any, would suggest to consumers that a product is manufactured domestically. Rather, the [Plaintiff’s expert’s] Report draws an inference that because information that a casket is made in China is material to consumers, the omission of such information is misleading to consumers, which is a conclusion that would apply to the promotional materials of any company in the industry. However, [Plaintiff’s] claim here is not that omission from a casket manufacturer’s advertising and promotional materials of the fact that a casket is made in China renders them impliedly false, and for that reason Liberty’s advertising and promotional materials violate the Lanham Act, but rather that Liberty’s pervasive use of American iconography, including the name of the company and its logo, requires disclosure of the fact that its caskets are
manufactured in China in order for Liberty’s advertising and promotional materials not to be implicitly false.

In addition, the mere fact that information that was material to consumers was omitted in advertising and promotional materials is not enough to support a claim under the Lanham Act in light of the fact that “the Lanham Act ‘impos(es) no affirmative duty of disclosure.’”...

Therefore, the defendants’ motion for summary judgment on the plaintiff’s claim for impliedly false advertising in violation of the Lanham Act is being granted, and the plaintiff’s motion is being denied.


[Plaintiff] also has the report and testimony of its expert [who] conducted a consumer study, in which nearly half of the participants were shown the image and description of a [Defendant’s] product as it appears in advertisements and packaging. The remaining participants were shown an allegedly “accurate” image (along with the same description) of the [Defendant’s] product. Both groups were also shown images and descriptions of three other products, including [a Plaintiff’s] product. After reviewing all four products, participants indicated their first, second, third, and fourth choice and explained the reasons for their decisions. The results showed that in the group shown the advertised image, 69% would have selected the [Defendant’s] product as their first choice and 10% would have selected the [Plaintiff’s] product as their first choice. In the group shown the allegedly “accurate” image, 25% would have selected the [Defendant’s] product as their first choice and 28% would have selected the [Plaintiff’s] product as their first choice. [Plaintiff’s expert] concluded that the use of the allegedly “accurate” image had a material impact on consumers’ decisions to purchase the [Defendant’s] product. Further, more consumers would have chosen the [Plaintiff’s] product had it not been for [Defendant’s] allegedly false advertising. As discussed below, the Court finds [Plaintiff’s expert’s] testimony to be both relevant and reliable...The results of [Plaintiff’s expert’s] study can reasonably provide circumstantial evidence of materiality with respect to the other [Defendant’s] products that were not included in this study. Therefore, taking the evidence in the light most favorable to [Plaintiff], there is sufficient evidence of materiality so as to avoid summary judgment.


At the August 8, 2012 hearing, the Court granted [Plaintiff’s] motion to exclude evidence of a survey conducted by [Defendant’s expert] which was done to test...the use of Muscle Milk on a product that contains no milk causes consumers to mistakenly believe that the product contains milk...

The [Defendant’s expert’s] survey was a series of three questions where respondents were presented three brand names without accompanying trade dress or images of the products: Muscle Milk, ProMan-X, and Lean Body. They were
then asked if each product contained a lot, some, or no protein, creatine, and milk. Consumers did not have an “I don't know” option or another means to indicate lack of knowledge. Lean Body and Muscle Milk are protein drinks, ProMan-X is a herbal male enhancement supplement. The respondent’s answers indicate that a high level of guessing occurred. For instance, for ProMan-X, 98% said it contains protein, 92% creatine, and 68% milk. ProMan-X does not contain any of these ingredients. For Muscle Milk, 80% responded that it contained milk. [Defendant’s expert] admitted in his deposition that respondents were guessing...

[Plaintiff] cites two cases to support its contention that the [Defendant’s expert’s] survey was not conducted according to accepted principles...[Defendant] responds with general arguments about the adequacy of the survey, but cites no authority that shows that the methods used by [Defendant’s expert] are generally acceptable. [Defendant] bears the burden of showing the admissibility of its survey...and it has not met its burden. Accordingly, the [Defendant’s expert’s] survey is excluded.

E. FAME SURVEYS

Coach Services, Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1375 (Fed. Cir. 2012)

Next, the Board found that [Plaintiff’s] 2008 brand awareness study was “of dubious probative value” because it did not offer a witness with first-hand knowledge of the study to explain how it was conducted...The Board further noted that, although the study showed a high level of brand awareness among women ages 13-24, it provided no evidence of brand awareness among women generally, or among men...(noting that the TDRA eliminated the possibility of “niche fame” as a basis for finding a mark famous). And, the survey was conducted in 2007, several years after Triumph filed its applications. Given these circumstances, we find no error in the Board’s decision to give this survey limited weight.


As part of its regular course of business activity, in 2008, opposer commissioned [a] research firm to conduct a brand awareness survey relating to facial skin care and make-up products, including CLINIQUE. While the exact levels of unaided and aided awareness of the CLINIQUE brand on the part of relevant consumers were submitted under seal, both numbers are quite impressive. In its August 2009 publication, among a [Women’s Wear Daily] survey of buyers in this prestige market, Clinique placed first with 14.3% of respondents having purchased CLINIQUE products during the first six months of 2009...In fact, other than quibbling about whether opposer’s made for litigation survey shows fame among dental patients...we note that applicant does not dispute or rebut opposer’s evidence of fame as outlined above.
Finally, in addition to the overwhelming evidence of TOTAL’s brand awareness discussed in summary form above, opposers submitted a consumer awareness survey conducted by their testifying expert. The combined aided and unaided awareness number is very high and is in line with the numbers opposers have seen in their own regularly conducted consumer awareness surveys made during the ordinary course of business...Applicant argues that the unaided awareness numbers are low and that aided awareness is of no significance. While unaided awareness numbers are more significant, that does not mean that aided awareness numbers have no significance...Based on the record, opposers have shown that in the context of this industry and fragmented market, the unaided awareness numbers are high. Moreover, the very high aided awareness numbers have significance and have not been shown to be compromised...

Based on the totality of the evidence, we find that...TOTAL is a famous mark for ready-to-eat cereal...

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, “by the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services....Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary...

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it...

In 2007, opposer compiled a brand awareness study “based on our customer frequent shopper card data on the customer usage of various corporate brand products.”...

...According to the study, “71 percent of consumers that (opposer) surveyed were aware of the Nature’s Promise brand” suggesting a “very high awareness of the Nature’s Promise brand.”...

While opposer’s [brand] has achieved commercial success and brand awareness among opposer’s customers, the evidence of record is not sufficient to establish that opposer’s [brand] is famous for purposes of likelihood of confusion. For example, a study demonstrating that a significant percentage of opposer’s own customers recognize opposer’s corporate brand is derived from such a
narrow universe of consumers that it is not sufficient to establish the fame of the mark...Finally...opposer argues that “the consuming public consists of consumers exposed to (opposer’s) advertising. As a result of (opposer’s) advertising efforts and extensive use of its mark, (opposer’s) Nature’s Promise mark is its most recognized brand.”...The problem with this argument is that the consuming public is not limited to consumers exposed to opposer’s advertising...

F. DILUTION SURVEYS


...[Plaintiffs’ expert] presented the results of his two surveys addressing likelihood of dilution.

The population for both surveys consisted of men and women 18 years of age or older who reported that they were likely, within the next year, to use the Internet to search for information on travel tours outside the continental United States.

...In the test cell, respondents were exposed to an abbreviated version of G.A.P Adventures’ website that used the old logo on the home page and that linked to hundreds of other G.A.P Adventures web pages.

In the control cell, respondents were exposed to a website identical to that used in the test cell, except that “G.A.P” was replaced with the words “Great Adventure People”...Otherwise, the questions and procedures for the test cell and the control cell were identical.

Respondents in both cells were asked, “What company or brand, if any, comes to mind when you see the name on this website?”...Respondents were also asked what other companies or brands, if any, came to mind.

...[Plaintiffs’ expert’s] second survey addresses the likelihood of dilution using G.A.P Adventures’ new logo.

...[Defendant’s expert] gave the opinion that [Plaintiffs’ expert’s] control cells should have included uses of the word “gap” to which Gap had not objected, to provide a proper baseline for comparison, However, I find that it was proper for [Plaintiffs’ expert] to exclude the word “gap” from his control cells.

[Defendant’s expert] criticized [Plaintiffs’ expert’s] survey question, asking if any companies or brands came to mind after viewing the G.A.P Adventures’ website, as leading...

...I accept the appropriateness and relevance of [Plaintiffs’ expert’s] surveys. I find that they show a likelihood of association between G.A.P. Adventures and variants, with plaintiffs’ trademark “Gap.”
Plaintiff has proffered, as evidence of actual association, the results of a telephonic survey in which respondents were asked to react to the terms “Charbucks” and “Starbucks.” Of the 600 respondents surveyed, 30.5% said that they associated the term “Charbucks” with “Starbucks,” and 9% said they associated the term “Charbucks” with coffee.

The results of Plaintiff’s survey show some association between the terms Charbucks and Starbucks. However, the survey did not measure how consumers would react to the Charbucks marks as they are actually packaged and presented in commerce.

[Defendant’s] thirty-second commercial goes by the name “Luxury.”... The commercial’s “scene of an inner-city basketball game” features “a basketball bearing marks similar, but not identical,” to the [Plaintiff’s] marks...

To prove actual association, a plaintiff must establish that defendant’s mark “conjure[s] an association with the senior (mark),” thereby “lessen(ing) the distinctiveness of the senior mark.”...“(T)he absence of actual or even of a likelihood of confusion does not undermine evidence of trademark dilution.”...In Starbucks, the Second Circuit noted that the plaintiff submitted results of a telephone survey reflecting that 3.1% of respondents viewed Starbucks as the possible source of a coffee that called itself “Charbucks.”...Overall, 30.5% of consumers said that Starbucks was “the first thing that comes to mind” upon hearing the word “Charbucks.”...The Second Circuit concluded that the district court erred by concluding that no evidence supported a conclusion of “actual association,” noting that the statute does not equate association with confusion...On remand, the district court concluded that the survey results “constitute evidence of actual association,” but that because the survey did not present the marks in their full contexts and the surveys reflected relatively low levels of confusion, “the actual association factor weighs no more than minimally in Plaintiff’s favor.”...

In support of its assertion of actual association, [Plaintiff] cites the research of [Defendant’s] own expert...[Defendant’s expert] conducted a double-blind survey using a test group that was shown the “Luxury” ad and a control group that was shown the same ad without the stylized basketball...Participants were asked a series of questions about the ad...The study tested among the general population, and, separately, a subset of prospective [Defendant’s product] purchasers...

When asked to identify the brands shown in “Luxury,” 19% of [Defendant’s expert’s] test-group participants cited [Plaintiff]...

[Plaintiff’s] expert...conducted a double-blind internet survey...The survey used both a control group and a test group, with the control group shown a video...
that replaced the stylized “Luxury” basketball with a standard orange basketball...fifteen percent of the test-group recognized the design as belonging to [Plaintiff]...

[Plaintiff] also cites to messages that appeared on the social networking site Twitter, which purport to show public responses to [Plaintiff’s] role in the “Luxury” ad...

...[Defendant]...argues that the [Defendant’s expert’s] survey indicates that “only” nineteen percent of unguided test-group participants recognized [Plaintiff’s] appearance in the “Luxury” ad...However, in light of the Starbucks opinions in both the Second Circuit and this District, the survey results present evidence of association...As also emphasized by Starbucks, [Plaintiff] is not required to prove actual consumer confusion, as in a trademark-infringement case...

[Defendant’s] evidence...also relies on one aspect of the [Defendant’s expert’s] survey, which [Defendant] itself commissioned, in which 19% of respondents cited the presence of [Plaintiff’s] logo...a figure that [Defendant] contends is too low to constitute evidence of actual association. It is statistically significant that 19% of survey respondents, without prompting, identified [Plaintiff] as a brand shown in the ad, as is the 30% of participants who, when asked in [Defendant’s] survey to focus their attention on the basketball, said that it reminded them of [Plaintiff]...

...[Plaintiff] has come forward with significant, probative evidence reflecting actual association between its famous marks and the stylized basketball in the “Luxury” ad...Each party’s expert conducted surveys as to consumer perceptions of [Plaintiff’s] role in the “Luxury” advertisement. When asked an open-ended question as to the brands identified in the ad, [Defendant’s] study concluded that 19% of respondents identified [Plaintiff]; [Plaintiff’s] expert found a rate of 15%...The record as to actual association with [Plaintiff] is substantial and unrebutted.


In support of its dilution claim, [Plaintiff] submitted a survey...that claims to show a twelve percent level of a likelihood of association between [Defendant’s] Quattro G Pattern on a beige background and [Plaintiff]. At trial, [Defendant’s expert] criticized the [Plaintiff’s expert’s] Survey for asking what “products or brands” came to mind, instead of merely “what came to mind.” According to [Defendant’s expert], this led consumers to mention brands and products, instead of giving “top of mind” responses...

[Plaintiff’s expert] was also criticized for not using multiple controls to parse out the various elements of the trade dress...At trial, [Plaintiff’s expert] explained that he did not use multiple controls because he was testing the effect of a combination of elements, rather than each element discretely...While multiple controls may have been helpful in further parsing the results [Plaintiff’s expert] found, his failure to use them does not affect the validity of his results.
Based on the forgoing, I find that [Plaintiff’s expert’s] survey — while somewhat flawed because it used questions that primed respondents to answer with brands and products — provides valid, relevant evidence as to the likelihood that consumers will associate the Quattro G Pattern with [Plaintiff] when rendered in a brown/beige colorway.

G. DAUBERT/ADMISSIBILITY ISSUES


[Defendant] claims that [Plaintiff’s expert’s] Report should be excluded under Rules 702 and 403 because it is flawed in two major ways: (a) [Plaintiff’s expert] used an improper respondent universe, and (2) [Plaintiff’s expert] used an improper control product...

...[Plaintiff’s expert] used screening questions to ensure that survey respondents were likely to shop at stores that sold thermometers made by the parties. However, he did nothing to ensure that his respondents were likely to purchase those products. According to [Defendant], this failure means that [Plaintiff’s expert] surveyed the wrong universe of respondents, leading to results that are necessarily irrelevant to this case...

...[Defendant] raises two points in support of its argument that [Plaintiff’s expert] used an improper control: (1) the control product [Plaintiff”s expert] used “does not exist in the marketplace and shares few similarities with either the K-Jump-manufactured or the outdated [Plaintiff”s]-manufactured thermometers,”...and (2) that because [Plaintiff’s expert] did not specify which features of the [Plaintiff’s] product’s packaging he was testing, it is impossible to tell what generated the reported confusion, thereby “rendering [Plaintiff’s expert’s] analysis meaningless.”...

While both of the flaws noted above are quite serious, neither of them would justify excluding [Plaintiff’s expert’s] report if taken separately. Nonetheless, because each flaw goes to a fundamental element of the survey rather than an issue on the periphery, their combined impact is too significant to overlook under Daubert and Rule 702. Accordingly, the [Plaintiff’s expert’s] report is excluded in its entirety...


[Defendant] submits survey evidence to show that there is little risk of confusion between the FANCAST and fancaster marks. Specifically, [Defendant] submits two surveys...in March 2009 and March 2011, respectively...

...The March 2009 survey used a format known as a Sequential Lineup. That format involves “first exposing respondents to the defendant’s mark prior to
showing respondents the plaintiff’s mark (as well as other marks), thereby simulating a scenario in which a consumer comes to learn about defendant’s mark and then encounters plaintiff’s mark.”...Each respondent in the Test Group was shown a three-page printout of www.fancast.com. The printout was taken away and the “(r)espondents were then instructed that they were going to be shown some websites and asked some questions.”...“One at a time, respondents were then shown and asked about four websites: (a) Fancaster.com; (b) Veoh.com; (c) Musicvideocast.com; and (d) Tvfansonline.com.”...In contrast to the printout if [sic] the FANCAST website, these websites were shown to respondents as static screenshots on a computer screen.

In contrast to the March 2009 survey’s Sequential Lineup format, the March 2011 used an Eveready format, under which “respondents are exposed only to use of one party’s mark and are asked questions to see whether they confuse it with the other party’s mark.”...“In the context of reverse confusion, an Eveready survey involves exposing respondents to the senior user’s mark to determine whether it is mistakenly connected to the infringing junior user.”...

209 respondents participated in the March 2011 survey. Instead of a printout, they were first “shown the current, live (f)ancaster web site (starting on the home page) and asked to take as much time as they needed to review it.”...They were also given a mouse and allowed to click around any section of the website...

A survey must be “designed to examine the impression presented to the consumer by the accused product. Therefore, (it) must use the proper stimulus, one that tests for confusion by replicating marketplace conditions.”...Accordingly, the results of a survey that does not adequately simulate how a consumer would encounter a trademark are neither reliable nor probative.

[Plaintiff] advances several ways in which the March 2009 survey fails to reflect marketplace conditions, only one of which need be addressed by the Court: that [Defendant’s expert] used a printout and static screenshots of the fancast.com fancaster.com homepages instead of live versions of those websites. [Defendant’s expert’s] use of a printout and static screenshots, instead of live websites, provide ample grounds on which to exclude the March 2009 survey. For one, it is difficult to fathom how presenting a respondent with a paper printout of the FANCAST homepage in anyway replicates how an Internet user would encounter and perceive the FANCAST website in the marketplace...Websites, particularly those that offer video content, are meant to be viewed on a computer and allow consumers to browse and interact with them via hyperlinks. The FANCAST printout offered none of these aspects...

[Defendant] contends that the printout and static screenshots “provided a representative snapshot of the content available on the sites.”...This contention is unavailing. While an image of a website’s homepage may accurately summarize the nature of its content and services, it cannot meaningfully test for confusion if it is not presented in the way that an Internet user would actually encounter it...Notably, in his March 2011 survey, [Defendant’s expert] presented
respondents with a live version of the fancaster website and allowed them to browse it on a computer, and [Defendant] presents no reason why it would have been any less appropriate or practicable to do so in the context of the March 2009 survey. Accordingly, this methodology deprives the March 2009 of reliability and therefore merits its exclusion as well as exclusion of any testimony related thereto.


[Plaintiff] has moved to exclude the expert report and testimony of [Defendant’s expert]...[Plaintiff] contends that the...Report should be excluded (1) under Fed. R. Evid. 702 and Daubert v. Merrell Dow Pharmaceuticals...

... [Plaintiff] argues that [Defendant’s expert’s] Report is “methodologically flawed” and lacking “probative value” because it failed to approximate the actual marketplace conditions in which consumers view its mark...[Plaintiff] contends that [Defendant’s expert] improperly removed from its web page: (1) the website title bar with the text “Secrets Resorts & Spas,” and (2) copyright and contact information...

... Removal of the web address bar and copyright and contact information is not a basis for excluding the [Defendant’s expert’s] Report...

... Here, removal of the web address bar and copyright and contact information did not deprive survey participants of sufficient information to determine that the print-out was the [Defendant’s] web page. “Secrets Resorts & Spas” appears prominently in three locations on the page and is the only logo portrayed. Further, knowledge of the web address and other removed information was not necessary for survey participants to reliably answer [Defendant’s expert’s] questions about the relationship between the [Defendant’s] web page and the other visual and audio stimuli.


[Plaintiff’s expert’s] study consisted of a “shopping mall intercept” at eight locations throughout the United States targeting “buyers and potential buyers of 2-ounce energy drinks...”...The study participants were shown six television commercials, including one commercial for 5-Hour Energy. Afterward, the participants were shown two photographs, one of the front side of Defendants' 6 Hour Energy Shot bottle and one of the front side of a control product called ROCK ON, and then asked if either of the two energy drinks was advertised in the television ads the participant had just watched...

Defendants now seek to exclude [Plaintiff’s expert’s] report and expert testimony under FRE 702 and Daubert v. Merrell Dow Pharmaceuticals...
Defendants argue that [Plaintiff’s expert’s] study is fatally flawed because: (1) the study population was improper; (2) the study used leading and suggestive questions; (3) the study did not replicate market conditions; (4) the ROCK ON product was not a proper control, and (5) the study violated proper survey techniques...

...The Court finds that [Plaintiff’s expert’s] report is based on a flawed and unreliable foundation for the following reasons.

In the place of actual product bottles, study participants were asked to view two pictures of just the front of the products, one of Defendants’ product and one of a control product called “ROCK ON.” Participants were thus unable to pick up and look at the products, as would be the case under actual market conditions. “A survey that fails to adequately replicate market conditions is entitled to little weight, if any.”...

...“A survey is not reliable if it suggests to the respondents an answer that would not otherwise have occurred to them.”...After viewing six television commercials, one of which was for Plaintiff’s 5 Hour Energy product, participants were shown a picture of Defendants’ product and asked three questions. The first question was: “Was this energy drink advertised in any of the TV ads you saw, or not?”...Second, participants were asked, “Do you think the company who makes the energy drink you saw in the TV ad, also makes this one, or not?”...Finally, third, participants were asked, “Was the name 6 Hour ENERGY approved, licensed or sponsored by the company who makes the energy drink you saw in the TV ad, or not?”...This final question, combined with the first two questions, clearly evidences the suggestiveness of the question “trifecta,” and infected the objectivity of the study.

The Court finds that the above three compound questions were improperly designed to elicit a response in favor of Plaintiff.

[Plaintiff’s expert] testified at the Daubert hearing that it was not relevant whether study participants answered “don’t know” to any survey questions, or were informed that “don’t know” was an acceptable answer. The Court disagrees, and finds that the survey should have used a quasi-filter question to reduce guessing by providing “don’t know” or “no opinion” options as part of the question...

Although [Plaintiff’s expert’s] survey included a “No/Don’t know” option, there is no evidence that the individuals administering the survey informed the participants that “don’t know” was an acceptable answer. It is therefore likely that a significant segment of study participants felt pressured to guess in answering certain survey questions...


In light of [Plaintiff’s] dismissal of its claim that [Defendant’s] phones infringe [Plaintiff’s] iPhone trade dress, the Court agrees with [Plaintiff] that [Defendant’s expert’s] phone confusion survey is no longer legally relevant to any
issues in this case and is therefore excludable under *FRE 402*. To establish a trade dress infringement claim, a plaintiff must show likelihood of consumer confusion, whereas a trade dilution claim requires only that “the defendant’s use of the mark is likely to cause dilution by blurring or dilution by tarnishment.”...The latter can be established by showing that “the ‘association arising from the similarity between a mark or trade name and a famous mark . . . impairs the distinctiveness of the famous mark.’”...While a showing that confusion is likely may evidence an association between products, the absence of confusion is not probative of lack of dilution...Because [Defendant] presumably seeks to introduce phone confusion survey evidence in order to show the absence of confusion, such evidence would not be relevant to [Plaintiff’s] iPhone trade dress dilution claim and would be unduly prejudicial and confusing to the jury.


...The court must, therefore, determine whether a preponderance of the evidence establishes that the reasoning or methodology underlying expert testimony is scientifically valid...Unless survey evidence is conducted according to accepted principles, it is not admissible in the first instance...

Here, the preponderance of the evidence indicates that the [Plaintiff’s expert’s] survey was not conducted according to accepted scientific principles. [Plaintiff’s expert] did not identify any basis, save for his own undocumented research, for selecting the survey population that he used. There is no indication that the survey population had any relationship to the relevant population of [Defendants’] consumers...Furthermore, though the survey purported to examine the role that [Plaintiff’s] photos played in consumers’ association of certain ads with [Defendants’] brand, the survey did not include any controls or basis for comparison.

These inadequacies speak not merely to the weight that should be accorded to the survey, but rather to the fundamental reliability of [Plaintiff’s expert’s] approach. [Plaintiff] does not identify any scientific principles underlying the [Plaintiff’s expert’s] survey, which appears to violate numerous accepted practices in the field of survey research...

...The expert opinions of [Plaintiff’s experts] do not satisfy the requirements of *Federal Rule of Evidence 702*. Accordingly, [Defendants’] Motion in Limine to exclude those opinions are granted.


...For each product, the respondent was asked the question: “Do you believe this illustration suggests that the product shown is an authentic (Indian-made) Native American Indian product?” The respondent could answer “Yes,” “No,” or “Don’t Know.”
...the Court finds that the survey must be excluded for other reasons...

In order to be considered reliable, a survey must resemble the way consumers would view the products in the marketplace...

...The Court finds that [Plaintiff’s expert’s] failure to present the complete manner in which Defendant displays, offers to sell, or sells it goods render the survey unreliable under Rule 702 and misleading and confusing under Rule 403. The questions asked in the survey pose another problem...

The Court agrees with Defendant that the question regarding the products is leading and slanted. It implies the answer to the ultimate question the survey was designed to test, which is improper. The respondents should have been asked “Who makes this product?” or “Who do you believe makes this product based on the picture and text provided?”...

In addition to the leading nature of the questions, the Court believes the question regarding the products is ambiguous, requiring the exclusion of the survey...

H. PROCEDURAL ISSUES


...to create the targeted universe to be sampled, i.e. relying on the allegations of the plaintiff’s complaint and public representations, was likewise reliable and adequately met the goals sought to be achieved by the criteria for determining the universe in a genericness and secondary meaning survey.


On February 24, 2011, the Court granted the parties’ stipulation to amend the scheduling order...nothing in the order altered the parties’ obligation under the initial scheduling order to disclose all expert witnesses by March 23, 2011 and all supplemental experts by April 8, 2011 nor was any such alteration requested...

...Rather, on April 8, 2011, Defendant disclosed two “supplemental” expert witnesses...whose report are now at issue.

...the above discussion makes clear, the expert reports...are initial expert reports. Characterization of these reports a “supplemental” or “rebuttal” in nature would only serve to undermine the expert disclosure deadlines set by the Court...

Parties are required to make expert disclosures “at the times and in the sequence that the court orders.”...Here the Court issued a scheduling order instructing the parties to disclose all initial expert reports on or before March 23, 2011. Defendant, however, did not disclose the expert reports...until over two
weeks later, on April 8, 2011. Accordingly, the Court finds the reports to be untimely.

...In sum, the expert witness reports constitute initial expert disclosures. These disclosures were made by Defendant after the applicable March 23, 2011 deadline, making them untimely. Moreover, because Defendant has not demonstrated that the belated disclosures were substantially justified or harmless, the expert reports will be excluded. Federal Rules of Evidence 1006 provides no different result.


n.1 While it is true that claims need only be determined with regard to one of several items in a single international class, such that likelihood of confusion will be found as to the entire class if there is likely to be confusion with respect to any item that comes within the identification of goods in that class...this determination does not extend to other international classes...("If priority and likelihood of confusion are established as to any of the goods or services identified in an opposed class of goods or services, the opposition to registration of the mark as to all of the goods or services identified in that class will be sustained")...Each international class stands on its own, for all practical purposes like a separate application, and we must make determinations for each separate class...


...during its main testimony period, opposer introduced the testimony deposition of [its survey expert who] conducted a survey to determine “the main function of the word “zero” . . . in the brand name Coca-Cola Zero.”...

Applicant introduced the testimony deposition of...applicant’s expert witness regarding surveys. [Applicant’s expert] was identified by applicant in its expert disclosures as a rebuttal witness...[Applicant’s expert] critiqued the survey conducted by [Opposer’s expert] and opined as to how the survey should have been conducted. [Applicant’s expert] also conducted a “standard secondary meaning survey as to ZERO.”...

[Opposer] argues that the [Applicant’s expert’s] survey and testimony should be excluded because it constitutes improper rebuttal in that it did not “test the same question that was posed in the [Opposer’s] survey it purports to rebut.”...[Opposer] is correct that [Applicant] identified [their survey expert] as a rebuttal witness and therefore his survey and testimony should be limited to rebuttal. However, the rebuttal survey and testimony need not be limited to the same question that was posed in [Opposer’s] survey. The purpose of rebuttal is to “introduce facts and witnesses appropriate to deny, explain or discredit the facts and witnesses adduced by the opponent. . .”...
Because [Applicant’s expert’s] survey and testimony regarding that survey are proper rebuttal to the extent that they bear on the validity and probative value of the [Opposer’s expert’s] survey, [Opposer’s] objection is not well taken...


As to the survey information...applicant’s objection that the surveys lack foundation is overruled in part. [Opposer’s] declaration identified the surveys as annual tracking surveys conducted in the ordinary course of business and the 2009 US Boys and Girls Tracking Study...provides ample description of the survey methodology. Therefore, we note that the Total Unaided Awareness survey...lacks any discussion of methodology and we have not considered this survey.
III. BIBLIOGRAPHY

INTELLECTUAL PROPERTY SURVEYS: 2011 - 2012
BY CIRCUIT

This appendix contains citations, by circuit, for all identified opinions published from January 2011 through December 2012, in which survey evidence was referenced.

First Circuit

There were no citations from the First Circuit during the time period of this article.

Second Circuit


Go SMiLE, Inc. v. Dr. Johnathan Levine, 769 F. Supp. 2d 630 (S.D.N.Y. 2011) (Likelihood of Confusion)


U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc., 800 F. Supp. 2d 515 (S.D.N.Y. 2011) (Likelihood of Confusion)

Third Circuit


The Hershey Co. v. Promotion in Motion, Inc., 2011 U.S. Dist. LEXIS 129651 (D. N.J. 2011) (Genericness)


Profoot Inc. v. MSD Consumer Care, Inc., 2012 U.S. Dist. LEXIS 83427 (D. N.J. 2012) (Fame)


Fourth Circuit

Belk, Inc. v. Meyer Corp., 679 F.3d 146 (4th Cir. 2012) (Secondary Meaning) (Likelihood of Confusion)


PBM Products, LLC v. Mead Johnson Nutrition Co., 639 F.3d 111 (4th Cir. 2011) (False Advertising)


Rosetta Stone Ltd. v. Google Inc., 676 F.3d 144 (4th Cir. 2012) (Likelihood of Confusion)


Fifth Circuit


Honestech, Inc. v. Sonic Solutions, 2011 U.S. App. LEXIS 12816 (5th Cir. 2011) (Secondary Meaning) (Daubert/Admissibility Issues)

**Sixth Circuit**


*Innovation Ventures, LLC v. N.V.E., Inc.*, 694 F.3d 723 (6th Cir. 2012) (Likelihood of Confusion)


*T. Marzetti Co. v. Roskam Baking Co.*, 680 F.3d 629 (6th Cir. 2012) (Secondary Meaning)

**Seventh Circuit**


**Eighth Circuit**


**Ninth Circuit**


Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158 (9th Cir. 2011) (Fame) (Dilution)


Trafficschool.com, Inc. v. Edriver, Inc., 653 F.3d 820 (9th Cir. 2011) (False Advertising)


Tenth Circuit


Eleventh Circuit


Univ. of Alabama Bd. of Trustees v. New Life Art Inc., 683 F.3d 1266 (11th Cir. 2012) (Likelihood of Confusion)
District of Columbia Circuit

There were no citations from the District of Columbia Circuit during the time period of this article.

Federal Circuit


Bridgestone v. Federal Corp., 673 F.3d 1330 (Fed. Cir. 2012) (Likelihood of Confusion)

Coach Services, Inc. v. Triumph Learning LLC, 668 F.3d 1356 (Fed. Cir. 2012) (Fame)


Trademark Trial & Appeal Board


In re Country Music Ass’n, 2011 T.T.A.B. LEXIS 343 (T.T.A.B. 2011) This opinion is a precedent of the T.T.A.B. (Genericness)


The Univ. of Iowa v. The Univ. of S. Miss., 2011 T.T.A.B. LEXIS 224 (T.T.A.B. 2011) (Likelihood of Confusion)
IV. BIBLIOGRAPHY

INTELLECTUAL PROPERTY SURVEYS: 2011 - 2012

BY ISSUE

This appendix contains citations, by issue, for all identified opinions published from January 2011 through December 2012, in which survey evidence was referenced.

Genericness Surveys

The Hershey Co. v. Promotion in Motion, Inc., 2011 U.S. Dist. LEXIS 129651 (D. N.J. 2011) (Genericness)


In re Country Music Ass’n, 2011 T.T.A.B. LEXIS 343 (T.T.A.B. 2011) This opinion is a precedent of the T.T.A.B. (Genericness)


Secondary Meaning Surveys


Belk, Inc. v. Meyer Corp., 679 F.3d 146 (4th Cir. 2012) (Secondary Meaning) (Likelihood of Confusion)

Honestech, Inc. v. Sonic Solutions, 2011 U.S. App. LEXIS 12816 (5th Cir. 2011) (Secondary Meaning) (Daubert/Admissibility Issues)


T. Marzetti Co. v. Roskam Baking Co., 680 F.3d 629 (6th Cir. 2012) (Secondary Meaning)


Likelihood of Confusion Surveys

Go SMiLE, Inc. v. Dr. Johnathan Levine, 769 F. Supp. 2d 630 (S.D.N.Y. 2011) (Likelihood of Confusion)


U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc., 800 F. Supp. 2d 515 (S.D.N.Y. 2011) (Likelihood of Confusion)


Rosetta Stone Ltd. v. Google Inc., 676 F.3d 144 (4th Cir. 2012) (Likelihood of Confusion)

Belk, Inc. v. Meyer Corp., 679 F.3d 146 (4th Cir. 2012) (Secondary Meaning) (Likelihood of Confusion)


Innovation Ventures, LLC v. N.V.E., Inc., 694 F.3d 723 (6th Cir. 2012) (Likelihood of Confusion)


56


Univ. of Alabama Bd. of Trustees v. New Life Art Inc., 683 F.3d 1266 (11th Cir. 2012) (Likelihood of Confusion)

Bridgestone v. Federal Corp., 673 F.3d 1330 (Fed. Cir. 2012) (Likelihood of Confusion)


The Univ. of Iowa v. The Univ. of S. Miss., 2011 T.T.A.B. LEXIS 224 (T.T.A.B. 2011) (Likelihood of Confusion)


**False Advertising Surveys**


*Trafficschool.com, Inc. v. Edriver, Inc.*, 653 F.3d 820 (9th Cir. 2011) (False Advertising).


**Fame Surveys**

Profoot Inc. v. MSD Consumer Care, Inc., 2012 U.S. Dist. LEXIS 83427 (D. N.J. 2012) (Fame)

Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158 (9th Cir. 2011) (Fame) (Dilution)


Coach Services, Inc. v. Triumph Learning LLC, 668 F.3d 1356 (Fed. Cir. 2012) (Fame)


**Dilution Surveys**


Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158 (9th Cir. 2011) (Fame) (Dilution)


Copyright


Other


Daubert/Admissibility Issues


Honestech, Inc. v. Sonic Solutions, 2011 U.S. App. LEXIS 12816 (5th Cir. 2011) (Secondary Meaning) (Daubert/Admissibility Issues)


V. BIOGRAPHICAL INFORMATION

DR. GERALD L. FORD
Ford Bubala & Associates

Dr. Ford is a partner in the marketing research and consulting firm of Ford Bubala & Associates, located in Huntington Beach, California. As a partner in Ford Bubala & Associates, he has been engaged in commercial marketing research and consulting for the past thirty-eight years. He is also an emeritus faculty member of the School of Business Administration, California State University, Long Beach, where he held a full-time teaching position for twenty-five years.

He holds a Bachelor's Degree in Advertising (B.A.) from San Jose State University, a Master's Degree in Business Administration (M.B.A.) from the University of Southern California, and a Doctoral Degree in Business Administration (D.B.A.) from the University of Southern California.

He has spoken at meetings of the Marketing Research Association, the American Marketing Association, the American Intellectual Property Law Association, the American Bar Association, the Practising Law Institute, the Intellectual Property Institute of Canada, MARQUES, the NAD, the McCarthy Institute Symposium, and the International Trademark Association.


Dr. Ford is also a member of the Editorial Board of The Trademark Reporter®.

As a partner with Ford Bubala & Associates, Dr. Ford has been retained by a variety of firms engaged in the consumer product, industrial product, and service sectors of the economy to provide marketing consulting and research services. Approximately one-half of the consultancies in which Dr. Ford has participated have involved the design and execution of marketing research surveys.

During the past thirty-eight years, Dr. Ford has been retained in a number of litigation-related consultancies involving intellectual property matters, including matters before U.S. federal and state courts, the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office, and the International Trade Commission. Dr. Ford has also been retained in litigation-related consultancies in intellectual property matters before courts and administrative agencies in Canada, England, France, Germany, and Norway. Dr. Ford has designed and executed surveys.
relating to intellectual property matters, including trademark, false advertising, patent, copyright, and other related matters.