Use of Experts and Survey Evidence to Resolve Trademark Disputes

Surveys may be defined as “any data collection operation that gathers information from human respondents by means of a standardized questionnaire in which there is an interest in aggregates rather than particular individuals.”

Many disputes involving trademarks can be resolved by using surveys to measure the mental impressions or state of mind of prospective purchasers of particular goods or services. Trademark surveys are usually conducted in connection with litigation between different trademark owners or between trademark owners and a trademark registrar in connection with applications for trademark registration.

For example, to decide a claim for trademark infringement, the law requires a court or an administrator of trademark registrations to consider whether a particular mark so resembles another as to create a likelihood of confusion, mistake or deception among prospective purchasers of the goods or services at issue.

Similarly, to determine whether an alleged trademark is a source identifier or an unprotectable generic or merely descriptive term, surveys may be useful to measure the understanding of consumers.

I. Issues that May Be Resolved Through Use of Surveys

Surveys can be useful in forming an expert opinion as to the understanding or state of mind of prospective purchasers or consumers when any of following issues need to be decided.

___ **Genericness** – Does an alleged mark identify and distinguish the products or services of one party from those of another or is it merely the generic name for a product or service?

___ **Descriptiveness** – Does an alleged mark lack inherent distinctiveness because it is primarily merely a surname or because it merely describes a characteristic, ingredient, feature or geographical origin of a product or service with which it is used?

___ **Acquired Distinctiveness** – Has a non-distinctive mark been used so exclusively and continuously that it has acquired distinctiveness or secondary meaning?

___ **Fame of a Mark** – Has a mark become famous for likelihood of confusion or dilution purposes?
___ **Functionality** – Is an alleged mark so functional in a utilitarian or in an aesthetic sense that it fails to identify the source of a product?

___ **Likelihood of Confusion** – Is one mark so similar to another mark as to create a likelihood of confusion, mistake or deception among prospective purchasers?

___ **Likelihood of Dilution** – Is an alleged mark famous and, if so, will use of another mark dilute or blur the distinctiveness of the famous mark or tarnish it?

II. When Is a Survey Necessary?

A. Survey Probably Not Necessary

A survey **may not be necessary** to prove that a particular word or phrase is (a) generic, (b) merely descriptive, (c) capable of identifying and distinguishing goods or services through acquired distinctiveness, (d) functional or (e) likely to cause confusion if some or all of the following questions are answered yes.

1. **Genericness**

___ Has a court previously held that the alleged mark is the generic name for the goods or services at issue?

___ Is the alleged mark defined in dictionaries as a name for the goods or services at issue?

___ Is the alleged mark used as a noun in price lists or ads of competitors or third parties to denote the goods or services at issue?

___ Is the alleged mark found in the identification of goods or services contained in trademark registrations?

___ Is the alleged mark usually disclaimed in registrations for goods or services at issue?

2. **Descriptiveness**

___ Is there an incontestable registration for the alleged mark that covers the goods and services at issue?

___ Is the alleged mark defined in dictionaries as denoting a characteristic, quality, ingredient or feature of the goods and services at issue?

___ Is the alleged mark commonly used in price lists or ads as an adjective to denote a characteristic, quality, ingredient or feature of a product or service by third parties?
3. **Acquired Distinctiveness or Secondary Meaning**

___ Is the alleged mark defined in dictionaries as a trademark or service mark for goods or services at issue?

___ Has a court ever held that the alleged mark has acquired distinctiveness or secondary meaning when used for the goods or services at issue?

___ Is the alleged mark the subject of a principal registration that is more than five years old for the goods or services at issue?

___ Has the alleged mark been used substantially exclusively and continuously as a trademark or service mark for more than five years?

___ Can it be shown that third parties are not using the alleged mark?

___ Have publishers or third party businesses discontinued use of the alleged mark upon receipt of objections from the owner of mark?

___ Can it be shown that the alleged mark is not used in the identification of goods and services in third-party registrations?

4. **Functionality**

___ Has a court held that an alleged design or product configuration mark is functional?

___ Does an alleged design or product configuration mark have a utilitarian function?

___ Is an alleged design or product configuration mark identified in a utility patent?

___ Does use of an alleged design or product configuration mark reduce the cost of a product or service?

___ Does the alleged design or product configuration mark consist merely of attractive ornamentation that is incapable of ever functioning as a source indicator?

5. **Likelihood of Confusion**
___ Are the marks at issue identical or substantially indistinguishable and are they used on identical or closely related goods or services?

___ Has a court previously held that the marks at issue are so similar as to create a likelihood of confusion for goods or services of the type at issue?

___ Has contemporaneous use of the marks at issue resulted in numerous instances of actual confusion among purchasers?

B. Survey Probably Necessary or Helpful

A survey may be necessary or at least useful if some or all of the following questions are answered yes.

1. Genericness

___ Is the alleged mark used only occasionally or not at all as a generic term by publishers, competitors or broadcasters to denote the goods or services at issue?

___ Is the alleged mark absent from dictionaries as a common name for the goods or services at issue?

___ Is the alleged mark used only occasionally or not all as a noun in price lists or ads of competitors or third parties to denote the goods or services at issue?

___ Is the alleged mark absent from the identification of goods or services in trademark registrations for the goods or services at issue?

___ Is the alleged mark disclaimed only occasionally or not at all in registrations for the goods or services at issue?

2. Descriptiveness

___ Are there no principal registrations, or are there only supplemental registrations, for the alleged mark for goods and services of the type at issue?

___ Are there other words or phrases other than the alleged mark that are commonly used to denote a characteristic, quality, ingredient or feature of the goods and services at issue?

___ Is the alleged mark used only occasionally or not at all in price lists or ads as an adjective to denote a characteristic, quality, ingredient or feature of a product or service by third parties?

___ Is the alleged mark a rare surname or can it be potentially perceived as having a meaning other than as a surname?
3. **Acquired Distinctiveness**

___ Is the alleged mark absent from dictionary definitions for the goods or services at issue?
___ Is it a fact that neither the courts nor the TTAB has ever held that the alleged mark has acquired distinctiveness or secondary meaning when used on goods or services at issue?
___ Is it a fact that there are no trademark or service mark registrations that are more than five years old for the alleged mark at issue?
___ Has the alleged mark been used for less than five years?
___ Can it be shown that there is relatively little or no third-party use of the alleged mark?

4. **Functionality**

___ Is it a fact that neither the courts nor the TTAB have ever held that the mark is non-functional?
___ Is it true that the alleged design or product configuration mark has no utilitarian function?
___ Is it true that there are no utility patents containing an alleged design or product configuration mark?
___ Has the product design or product feature been advertised as an indicator of source?
___ Is there an issue of fact as to whether prospective purchasers find a design or product feature to be merely aesthetically pleasing as opposed to being a source indicator?

5. **Likelihood of Confusion**

___ Are the marks at issue similar in sound, appearance or meaning, but not identical?
___ Are the marks at issue used on non-identical or unrelated goods or services?
___ Is it true that neither the courts nor the TTAB has ever previously held the marks are so similar as to create a likelihood of confusion, mistake or deception for goods or services of the type at issue?
___ Has contemporaneous use of the marks at issue resulted in few or no instances of actual confusion among purchasers?

III. **Requirements for an Admissible Survey**
To insure reliability and admissibility in a court, a survey must be conducted in accordance with acceptable standards for statistical research. The following questions should be reviewed and answered affirmatively to enhance the likelihood that a survey will be found to have been designed and conducted properly and that an opinion based on the survey is admissible.

A. Selection of an Appropriate Universe of Respondents
   ___ Was the universe of survey respondents restricted to prospective purchasers of the goods or services at issue and otherwise appropriate?

B. Selection of a Random Sample from the Universe
   ___ Were acceptable random sampling techniques used to find an appropriate universe of respondents?

C. Creation of Appropriate Testing Stimuli
   ___ Were appropriate testing exhibits or stimuli used in connection with the survey?

D. Preparation of an Appropriate Questionnaire
   ___ Were questions phrased and asked in an unbiased manner?

E. Collection of Data Using Appropriate Interviewing Methods
   ___ Were appropriate data collection techniques used in gathering and recording data obtained in the survey?

F. Use of Qualified Persons to Collect Data
   ___ Were the persons who conducted the survey trained or experienced in survey taking?

G. Tabulation and Analysis of Data
   ___ Was the data tabulated and analyzed in accordance with acceptable standards of research?

H. Formulation of an Opinion Based on the Data
   ___ Was an opinion based on survey data formulated by a qualified expert?

I. Use of Appropriate Controls
   ___ Was it necessary to use a “control” to eliminate “noise,” such as responses dictated by an inability to understand a question or unjustified assumptions?
Was a duplicate survey conducted simultaneously using the same methodology and questions, except for a substitute control question or stimulus that would not generate a positive response from a reasonable respondent?

J. Other Actions to Ensure Objectivity and to Avoid Bias

Were any other actions considered or taken to ensure objectivity and to avoid bias in connection with the formulation of an opinion?

IV. Actions Required to Maintain Attorney Work Product Protection

Prior to conducting a full survey, it is sometimes helpful to conduct a pilot survey or pre-test using a small sample of respondents to obtain an idea as to the likely outcome of the survey. The results of such a small survey are usually not projectable and, therefore, not admissible. However, the sample may provide an idea as to whether it is worthwhile to conduct a full survey or not. And if the results appear unhelpful, one might decide not to go forward with the full survey. If this type of survey is conducted by a survey expert who ultimately will provide an opinion, the results of the pilot survey usually will be discoverable by the opposing party. To preserve confidentiality under the work product doctrine, a non-testifying expert might be used to conduct the pilot test. Alternatively, a survey expert could be asked to provide the results of the first 50 questionnaires before completing the survey to afford an opportunity to stop the procedure if the results appear likely to be unhelpful. In connection with these issues one might consider the following questions.

Is there enough uncertainty as to likely survey results to warrant use of a pilot survey?

Is it worthwhile to use a non-testifying expert to conduct the pilot survey?

Is a potential survey expert willing to provide the initial results of a survey in increments before completing it?