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GENERICNESS SURVEYS IN TRADEMARK DISPUTES: EVOLUTION OF SPECIES

By E. Deborah Jay

I. INTRODUCTION

In the seminal Bayer aspirin case in 1921, Judge Learned Hand applied the following test in deciding that ASPIRIN had become generic: “What do the buyers understand by the word for whose use the parties are contending?”¹ This test became codified in the Trademark Clarification Act of 1984, which stated, “The primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”²

Many types of evidence may be proffered in trademark disputes on the issue of whether a mark is or has become generic.³

¹. Bayer Co., Inc. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921) (“The single question, as I view it, in all cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, then, I take it, it makes no difference whatever what efforts the plaintiff has made to get them to understand more. He has failed, and he cannot say that, when the defendant uses the word, he is taking away customers who wanted to deal with him, however closely disguised he may be allowed to keep his identity.”).

². Pub. L. 98-620 § 102, 98 Stat. 3335 (1984) (codified at 15 U.S.C. § 1064(3)); see also Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938) (“But to establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”).

³. 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 12:13 (4th ed. 2009) [hereinafter McCarthy]. According to McCarthy, the following types of evidence may be used to prove genericness: generic use by the proponent of the trademark, uncontested generic use by competitors, dictionary definitions, media usage, testimony of persons in the trade, and consumer surveys; see also In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1570 (Fed. Cir. 1987) (“Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser...
However, surveys (opinion polls) that measure the “primary significance” of a mark to consumers are “almost de rigueur” in such inquiries. 4

Although any party may proffer survey evidence, for unregistered marks the owner of the asserted mark often will submit a survey to demonstrate trademark significance 5 (e.g., to show that the mark answers the question, “Who am I?,” rather than, “What am I?”). Conversely, in disputes over a registered mark the party alleging that a mark has become generic (also known as “genericide”) must overcome a “strong presumption” that the mark is not generic. 7 In such disputes the defendant will be

testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. 5.

4. 2 McCarthy, supra note 3, § 12:14 (“Consumer surveys have become almost de rigueur in litigation over genericness. Judges are now used to survey evidence and often expect to receive evidentiary assistance by surveys in resolving generic disputes.”); Schering Corp. v. Pfizer Inc., 189 F.3d 218, 225 (2d Cir. 1999) (“Surveys are, for example, routinely admitted in trademark and false advertising cases to show actual confusion, genericness of a name or secondary meaning, all of which depend on establishing that certain associations have been drawn in the public mind.”); Berner Int’l Corp. v. Mars Sales Co., 987 F.2d 975, 982 (3d Cir. 1993) (“However, direct consumer evidence, e.g., consumer surveys and testimony is preferable to indirect forms of evidence.”); Nestlé Co. v. Chester’s Market, Inc., 571 F. Supp. 763, 773 (D. Conn. 1983) (“The use of consumer perception or opinion surveys is . . . of undeniable importance in a case of this kind as it is the most practical and useful way of assessing public opinion.”), motion to vacate denied, 596 F. Supp. 1445 (D. Conn. 1985), rev’d, 756 F.2d 280 (2d Cir. 1985).

One author claims that surveys are more successful at proving secondary meaning and genericness than likelihood-of-confusion: Peter Weiss, The Use of Survey Evidence in Trademark Litigation: Science, Art, or Confidence Game? 80 TMR 71, 85 (1990) (“Use surveys more to prove secondary meaning or genericness (vel non) than likelihood of confusion. You are more likely to succeed in the former type of case.”). However, another author contends that, although direct testimony of consumers is potentially “the most weighty” evidence in a genericness dispute, other types of evidence (e.g., listings in dictionaries, various publications and databases) are just as important: Rita M. Irani, The Importance of Record Evidence to Categorize Marks as Generic, Descriptive, or Suggestive, 83 TMR 607 (1993).

5. McCarthy, supra note 3, § 12:12 (“If the term is not federally registered, once a defendant raises the defense, the burden is on plaintiff to prove trademark status: that is, lack of genericness.”). For a discussion of different types of generic terms, see Vincent N. Palladino, Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys, 92 TMR 857, 860 (2002) [hereinafter Palladino]. According to Palladino, “[S]ome generic terms have an initial non-trademark meaning, while other generic terms were initially trademarks. Still others were chosen as trademarks, but were challenged as generic before it was clear whether or not they were regarded by the public as trademarks.”

6. 2 McCarthy, supra note 3, § 12:01 (“A mark answers the buyer’s questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’”).

7. Id. § 12:12 (“If the plaintiff has a federal registration, it constitutes a strong presumption that the term is not generic and defendant bears the burden of overcoming the presumption.”)
more apt to tender a consumer survey than the trademark owner, provided the survey supports the argument that the mark has become a common name (e.g., to prove the mark does not distinguish the goods of one producer from the goods of other producers\(^8\)). In fact, the failure of a party who is alleging a mark has become generic to conduct a survey may result in a negative inference,\(^9\) although marks have been held generic despite the lack of survey evidence.\(^10\)

As with any survey, questions in genericness surveys should be reliable and valid.\(^11\) For questions in a genericness survey to be reliable respondents need to be able to understand them (e.g., the

8. Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 373-374 (1st Cir. 1980) (“A generic term is one that does not distinguish the goods of one producer from the goods of others. Instead, it is one that either by definition or through common use has come to be understood as referring to the genus of which the particular product is a species.”).

9. Creative Gifts, Inc. v. UFO, 235 F.3d 540, 546 at n.5 (10th Cir. 2000) (“It is worth remarking all of the customarily-offered types of evidence as to claimed genericness that Sherlocks did not produce. They elicited no consumer testimony or consumer surveys.”); March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 804 (N.D. Tex. 2003) (“Defendants have not offered any survey evidence.”), aff’d, 120 Fed. Appx. 540 (5th Cir. 2005). The failure of the owner of a claimed mark to conduct a survey to demonstrate the disputed name’s trademark significance also may result in a negative inference: Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 583 (D.N.J. 1985) (“Failure of a trademark owner to run a survey to support its claims of brand significance and/or likelihood of confusion, where it has the financial means of doing so, may give rise to the inference that the contents of the survey would be unfavorable, and may result in the court denying relief.”). For a discussion of the history and appropriateness of attaching significance to the absence of survey evidence (mostly in connection with trademark confusion), see Sandra Edelman, Failure to Conduct a Survey in Trademark Cases: A Critique of the Adverse Inference, 90 TMR 746 (2000).

10. Colt Defense LLC v. Bushmaster Firearms, Inc., 486 F.3d 701, 706 at n.4 (1st Cir. 2007) (“Bushmaster did not submit a consumer survey to support its claim but such evidence, while ‘desirable’ to establish genericness, is not required.”); Nartron Corp. v. STMicroelectronics, Inc., 305 F.3d 397, 407 (6th Cir. 2002) (“Thus, the overwhelming evidence in this case obviates the need for ST to have conducted a consumer survey”); Otokoyama Co. Ltd. v. Wine of Japan Import, Inc., 7 Fed. Appx. 112, 115 (2d Cir. 2001) (“Our previous decision in this matter did not require that the inquiry into genericness privilege certain categories of evidence, such as consumer-based surveys, dictionary definitions, or literature usage.”); Keebler, 624 F.2d at 375 (“While we agree that evidence such as a consumer survey would be desirable in a case such as this [citation omitted], indirect evidence can establish the genericness of a mark . . .”).

11. Floyd J. Fowler, Jr., Improving Survey Questions 4 (1995) (“A key difference between art and science is that in art, goodness is in the eye of the beholder. In science, there are consistent standards for ‘goodness.’ In this case, the ultimate standards for goodness are the validity and reliability with which a question produces answers that measure something.”); Gregory G. Holyk, Questionnaire Design in Encyclopedia of Survey Research Methods, 656, 657 (Paul J. Lavrakas ed., 2008) (“Unclear concepts, poorly worded questions, and difficult or unclear response choices may make the questionnaire difficult for both respondents and interviewers. Questionnaires should contain items that are both reliable and valid. Reliability is the consistency of the measurement; that is, the question is interpreted and responded to similarly over repeated trials. Construct validity is whether or not the measurement, as worded, properly reflects the underlying construct of interest.”).
questions may not be vague, unnecessarily complex, use double negatives, or be compound). To be valid these questions may not be suggestive or leading, and they ought to elicit relevant information unambiguously. Respondents’ answers should indicate clearly whether they understand a word to mean the source of a product or service versus the nature or class of goods.

Questions in a genericness survey may be open-ended, that is questions requiring respondents to answer in their own words; or closed-ended, that is questions for which response categories are provided. Unlike in trademark confusion surveys, in genericness surveys the courts have not expressed a preference for open-ended questions. However, questions in genericness surveys have been faulted for being ambiguous or self-serving. Flawed survey questions diminish the weight afforded a genericness survey, but may not control its admissibility.

12. Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 684 (S.D.N.Y. 1963) (“If questions are unfairly worded to suggest answers favorable to the party sponsoring the survey, the element of trustworthiness in the poll would be lacking.”); Shari S. Diamond, Reference Guide on Survey Research in Reference Manual on Scientific Evidence 229, 248 (2000) [hereinafter Diamond] (“When unclear questions are included in a survey, they may threaten the validity of the survey by systematically distorting responses if respondents are misled in a particular direction, or by inflating random error if respondents guess because they do not understand the question.”); Federal Judicial Center, Annotated Manual for Complex Litigation § 11.493 (4th ed. 2008) [hereinafter FJC, Manual for Complex Litigation] (“In addition, in assessing the validity of a survey, the judge should take into account the following factors: whether the questions asked were clear and not leading . . .”).

13. Diamond, supra note 12, at 251 (“The questions that make up a survey instrument may be open-ended, closed-ended or a combination of both.”); Howard Schuman and Stanley Presser, Questions & Answers in Attitude Surveys. Experiments on Question Form, Wording, and Context 7-8 (1996) [hereinafter Schuman & Presser] (“Perhaps the most basic decision an investigator must make is whether to leave a question open, or to close it by providing a set of fixed alternatives from which respondents can choose. On the one hand, the open form does not limit respondents to alternatives within the investigator’s frame of reference, and it also avoids suggesting or imposing answers the respondent may not have considered. On the other hand, the closed form restricts responses to those germane to the researcher’s aims and provides data in a form that is a great deal easier to code and analyze.”).

14. Diamond, supra note 12, at 253 (“Although many courts prefer open-ended questions on the grounds that they tend to be less leading, the value of any open-ended or closed-ended question depends on the information it is intended to elicit.”).

15. Am. Thermos Prods. Co. v. Aladdin Indus., Inc., 207 F. Supp. 9, 20 (D. Conn. 1962) (“The method of poll taking adopted by each of the parties reflects their respective views of the law and each method was designed to elicit the kind of evidence each wished to bring out.”), aff’d sub nom. King-Seeley Thermos Co. v. Alladin Indus., Inc., 321 F.2d 577 (2d Cir. 1963); G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436, 1484 (E.D. Wis. 1987) (“Well before the four primary meaning surveys were taken, each party had chosen to use the LA mark in a manner calculated to elicit ‘correct’ responses from possible interviewees.”), aff’d, 873 F.2d 985 (7th Cir. 1989).

Although the science of survey research continues to evolve, most genericness surveys trace their origins to those conducted more than thirty years ago in connection with disputes over the trademarks THERMOS (American Thermos\textsuperscript{17}) and TEFLON (E. I. Du Pont de Nemours\textsuperscript{18}). In trademark cases in which genericness is an issue, naturally it is generally preferable to use survey methods that have been previously accepted.\textsuperscript{19}

A “Thermos Survey” employs a series of open-ended questions, whereas a “Teflon Survey” consists largely of a series of closed-ended questions, to determine whether the challenged mark is a brand name or a common name. Whether survey experts elect to use the Thermos Survey format, the Teflon Survey format, or a more innovative approach in a genericness controversy depends on their views concerning the scientific validity or trustworthiness of these methods and the appropriateness of these methods given the specific facts of the case (i.e., the mark at issue and the context in which it is used). Often, and for a variety of reasons, Thermos Surveys and Teflon Surveys deviate in one or more ways from those approved in the American Thermos and E. I. Du Pont de Nemours cases.

or the questions themselves are flawed in this particular case goes to the weight afforded the survey, and not its admissibility.”).

17. 207 F. Supp. at 21-22.
19. Hans Zeisel & David Kaye, Prove It with Figures 156 (1997) (“Surveys that examine the issue of genericness do not have much leeway in their approach. The case law has designated a fairly narrow path. Surveys examining the likelihood of confusion, on the other hand, are more complex and less constrained. They are part of the larger category of ‘surveys cum experiment.’”), Twenty years ago, Lawrence E. Evans, Jr. and David M. Gunn described the trademark survey formats in use at the time as “horse-and-buggy questionnaires” and predicted these formats would “give way to better models” (Trademark Surveys, 79 TMR 1, 7 (1989)). Belying their prediction, the Thermos and Teflon formats remain the dominant methods for conducting surveys in trademark disputes in which genericness is an issue.

Using tested rather than innovative survey techniques has been encouraged in non-litigation contexts as well (Seymour Sudman and Norman M. Bradburn, Asking Questions. A Practical Guide to Questionnaire Design 119 (1982) (“While plagiarism is regarded as a vice in most matters, it is a virtue in questionnaire writing—assuming, of course, that you plagiarize good-quality questions.”)). However, a survey format approved in one matter may not be probative in another matter: Nestlé, 571 F. Supp. at 777 (“Merely duplicating a survey that was accepted in a previous trademark case is no assurance of relevance in another case.”); Allan W. Leiser & Carl R. Schwartz, Techniques for Ascertaining Whether a Term Is Generic, 73 TMR 376, 380 (1983) [hereinafter Leiser & Schwartz] (“[O]ne must remember that the reported decisions relate to specific situations involving a multitude of factors that led to the final outcome and that may well have affected the court’s acceptance or rejection of specific survey techniques. Caution must be exercised in applying the decisions to new situations where there may be just enough differences to destroy the fit.”).
In this article I first describe the surveys endorsed in *American Thermos* and *E. I. Du Pont de Nemours*, then the use and acceptance of these survey formats (and alternate formats) in subsequent trademark disputes involving genericness. While the principal focus of this article is on questionnaire formats, in the last section I briefly address other survey issues, including sampling, data collection, and reporting.

II. THE SURVEYS IN *AMERICAN THERMOS*

In *American Thermos*, the plaintiff claimed that THERMOS was a trademark that had been exclusively associated and inextricably linked with its products since 1907, the year they were first marketed and sold in the United States. The defendant, Aladdin Industries, alleged that the mark had become generic for any vacuum-insulated container used to keep beverages and food hot or cold. Both parties tendered surveys in support of their contentions.

The plaintiff’s survey asked respondents the following question, “Please name any trademark or brand names, with which you are familiar, for vacuum bottles, insulated bottles or other containers, which keep the contents hot or cold.” Approximately one-third of the survey’s respondents answered THERMOS, in one form or another. However, the U.S. District Court was critical of the plaintiff’s survey because the questions “left little or no opportunity for the revelation of a generic or descriptive use of ‘thermos’ in the answer.”

The defendant’s survey first asked respondents three qualifying questions to determine whether they were familiar with containers used to keep liquids hot and cold. Qualifying respondents then were asked the following nine questions that were used to determine whether THERMOS was or was not being used generically by the general public.


21. *Id.* at n.8. The plaintiff’s survey began with the following three questions: (1) “Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time?,” (2) “Have you yourself ever used (or filled) such a container-that is, the type to keep liquids cold or hot?,” and (3) “What was the occasion for using such a container?”

22. Almost three decades before *American Thermos*, some of the same questions were asked in a survey proffered by the defendant in *Du Pont Cellophane Co., Inc. v. Waxed Prods. Co., Inc.*, 6 F. Supp. 859, 885 (E.D.N.Y. 1934), modified, 85 F.2d 75, 80 (2d Cir. 1936). In *Du Pont Cellophane*, the defendant conducted a survey with the general public which asked the following questions: “What does the word ‘Cellophane’ mean to you?” and “Do you know of any other name than ‘Cellophane’ which you could use if you wanted to buy that kind of material?” However, the court found these questions to be leading (“This was in no sense a fair test, as it
If you were going to buy one of these containers tomorrow, that is, the type that keeps food and beverages hot or cold, what type of store would you select to make your purchase?

“What would you ask for, that is, what would you tell the clerk you wanted?”

“Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold?”

“If you were going to describe one of these containers to a friend of yours, what words would come to your mind first to describe a container that keeps liquids hot or cold?”

“Do you, or does anyone else within your household own a container such as we have been talking about?”

“How many are owned by all members of your household?”

“What do you call this (these) containers?”

“Do you know the names of any manufacturers who make these containers that keep liquids hot or cold?”

“Can you name any trademarks or brand names that are used on these containers?”

Approximately 75% of the survey respondents who were familiar with containers that keep contents hot or cold called them a “thermos,” and only 12% named THERMOS as a trademark or brand name for such containers. The U.S. District Court found the defendant’s survey to have been conducted according to “recognized scientific principles.” Although the court was critical of the plaintiff’s survey, it opined that both the plaintiff’s and the defendant’s surveys corroborated other evidence demonstrating that the majority of the consuming public uses THERMOS generically.

Since American Thermos, a survey inquiring how consumers would ask for or describe a product is known as a Thermos Survey. Parties seeking to establish trademark significance expect consumers to answer this question with generic names other than
the claimed mark. Conversely, those seeking to demonstrate that a mark is or has become generic expect that consumers will respond with the disputed mark.

III. THE SURVEYS IN E. I. DU PONT DE NEMOURS

In *E. I. Du Pont de Nemours*, plaintiff Du Pont alleged that defendant YKK, the manufacturer of EFLON zippers, infringed Du Pont’s TEFLON trademark, which had been in use and had been extensively advertised since the 1960’s on or in connection with pots and pans, cooking utensils, and other products. YKK replied that even though “teflon” was a word that had been invented or coined by Du Pont, “teflon” had become generic for non-stick coating. YKK submitted two consumer surveys in its defense, both modeled after the survey credited in *American Thermos*, and Du Pont countered with two surveys. Like YKK’s two surveys, the first Du Pont survey was a variant of the Thermos Survey. The U.S. District Court found the results from the Thermos Surveys to be

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23. *E. I. Du Pont de Nemours*, 393 F. Supp. at 525. YKK’s first Thermos Survey asked respondents whether they were aware of “kitchen pots and pans that have their inside surfaces coated by chemical substances to keep grease or food from sticking to them.” Aware respondents were asked the names of these pots and pans, how they would describe these pots and pans to a store clerk or friend, and who manufactured these pots and pans. Approximately 91% of YKK’s survey respondents were aware of pots and pans with a nonstick coating. Of these, most said that TEFLON alone was the name of these pots and pans (86%) or they would use this name alone to describe such pots and pans to a store clerk or friend (72%). Only 7% of aware respondents identified “Du Pont” as the manufacturer of TEFLON pots and pans. YKK’s second Thermos Survey asked similar questions about “substances that manufacturers sometimes apply to the surfaces of certain products in order to prevent things from sticking to them.” The findings were similar to YKK’s first survey. Approximately 89% of respondents were aware of nonstick coating for pots and pans. The majority of aware respondents said that TEFLON alone was the name of the nonstick coating (81%) or they would use this name alone to describe pots and pans with this nonstick coating to a store clerk or friend (60%). Only 9% identified du Pont as the manufacturer of such coatings.

24. *Id.* at 525-526. Du Pont’s Thermos Survey began by telling respondents that “[p]rotective coatings are sometimes applied by manufacturers to the inside of household utensils in order to prevent food and grease from sticking.” Survey respondents then were asked, “Do you know a brand name or trademark for one of these coatings?” Aware respondents were asked, “What is that brand name or trademark?” and “Can you think of any other words or terms to describe these coatings?” Almost half (48%) of all survey respondents named TEFLON as the brand name or trademark for these coatings. However, a majority of these survey respondents (68%) could not think of any other words or terms to describe the coatings.
ambiguous, even though the format for these surveys had met with approval in other cases.

Du Pont’s second survey employed a different approach. It began by explaining the difference between a “brand name” and a “common name,” and it then provided respondents with an example of each (e.g., Chevrolet and automobile). After confirming the survey respondents’ understanding of the difference between a brand name and a common name, interviewers read a list of eight words, including the word at issue, or the “test” word (TEFLON), and seven other words that served as “controls” (STP, COKE, JELLO, THERMOS, MARGARINE, REFRIGERATOR, and ASPIRIN). The control words were used to evaluate the meaningfulness of the responses with respect to TEFLON.

After each word was read, survey respondents were asked to classify the word as a brand name or a common name. Over two-thirds (68%) of Du Pont’s survey respondents identified TEFLON as a brand name, whereas only about one-third (31%) identified it as a common name. Majorities also correctly identified STP (90%), COKE (76%), and JELLO (75%) as brand names, and REFRIGERATOR (94%), MARGARINE (91%), and ASPIRIN (86%) as common names. Respondents were almost equally divided as to whether THERMOS was a brand name or a common name.

The U.S. District Court credited Du Pont’s second survey with showing that TEFLON is a “brand name,” finding that the responses of Du Pont’s second survey revealed that “the public is quite good at sorting out brand names from common names, and, for TEFLON, answers the critical question ... that of the principal significance of the TEFLON mark to the public.”

Since E. I. Du Pont de Nemours, surveys that define a trademark and a generic name in the introductory section and then ask respondents to classify a list of words (including the challenged mark) as one or the other have been dubbed Teflon

25. Id. at 527 (“[R]espondents were, by the design of the questions, more often than not focusing on supplying the inquirer a ‘name’, without regard to whether the principal significance of the name supplied was ‘its indication of the nature or class of an article, rather than an indication of its origin.’”).

26. In Stix Prods., Inc. v. United Merchants & Mfrs., Inc. (295 F. Supp. 479, 490-491 (S.D.N.Y. 1968)), a Thermos Survey was credited with showing that CONTACT (self-adhesive plastic products) was nongeneric (“As to the surveys, the Crossley, S-D survey, commissioned by Stix on the eve of trial, reflected that when 694 female heads of households were asked the question, ‘What do you call this type of product?’ 498 (72%) did not use the word ‘contact’ in any response; 196 (28%) used the word ‘contact’ in some form in answer to the question; and of those 196, at least 135 (69%) knew ‘contact’ was a brand. This survey reflects that the majority of consumers do not use ‘contact’ as a general designation for goods, and further supports this Court’s finding that the word ‘contact’ alone serves no descriptive purpose.”).

When a majority of relevant consumers identifies a challenged mark as a “brand name,” the survey will be proffered to show nongenericness; conversely, parties challenging a mark as being generic will tender a Teflon Survey if more than half of relevant consumers classifies the mark as a “common name.”

**IV. THERMOS SURVEYS AFTER AMERICAN THERMOS**

The U.S. District Court in *E. I. Du Pont de Nemours* found the Thermos Surveys unpersuasive because respondents may have supplied a word without regard to its principal significance as being the nature or class of an article versus an indication of origin. Some critics of the Thermos Survey format have echoed these concerns. Still others claim that the high usage of a word in a Thermos Survey may show genericness, but the lack of usage does not mean a word is *not* generic. For this reason, they contend

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28. The plaintiff’s survey in *Du Pont Cellophane* (6 F. Supp. at 885) may have been the inspiration for the survey credited four decades later in *E. I. Du Pont de Nemours* with showing that TEFLON was a brand name. In *Du Pont Cellophane*, the plaintiff’s mail survey instructed respondents, as follows: “I am trying to determine, for one of the leading advertisers of the country, how familiar our most intelligent magazine readers are with trademarked names. Will you help me by putting an ‘x’ after each name given below which you look upon as a trademark? You understand, of course, that a trademark is a name or mark which indicates that the goods bearing this name or mark are manufactured or sponsored by one concern only. * * * Will you put an ‘x’, please, after each name below, which you think is a trademark? Just give your immediate reaction, without investigation or study. Then fill in your name and address, and return it in the addressed envelope attached.” The list of names included the disputed name (CELLOPHANE), as well as brand name controls (VASELINE, CARBONA, COCOMALT, POSTUM, and KODAK) and common name controls (SILK, AMMONIA, IODINE, and COLOGNE). In *Du Pont Cellophane* the court found the questions in plaintiff’s survey to be “fairly presented,” but did not rely on the survey’s results due to hearsay concerns. However, on appeal, the Second Circuit disregarded plaintiff’s Teflon Survey for other reasons.

29. *E. I. Du Pont de Nemours*, 393 F. Supp. at 527. According to Leiser & Schwartz, supra note 19, at 382, “the most serious questioning of the Thermos technique is found in Teflon.”

30. Jerre B. Swann & Vincent N. Palladino, *Surveying “Genericness”: A Critique of Folsom and Teply*, 78 TMR 179, 180 (1988) [hereinafter Swann & Palladino] (“[I]n Thermos, ‘product category’ questions focusing on what words consumers use to describe or ask for a product were sanctioned by the court. Such questions have two deficiencies: they do not address the critical issue of consumer ‘understanding’ as to the disputed term, and interviewees may feel ‘compelled to supply a brand name as an answer without regard to its primary meaning.’”); Palladino, supra note 5, (“[T]hermos Question Three does not necessarily establish the extent of generic significance, because it asks respondents to ‘describe’ a product and asks ‘what words’ they would use to do so. This is not the same as asking them to provide the product’s generic name.”).
a Thermos Survey cannot be used to prove trademark significance.31

Despite criticism, the Thermos Survey format continues to be used for genericness surveys. For example, Thermos Surveys raised reasonable inferences that COCOA BUTTER FORMULA (skin care products)32 and VIRUS SCAN33 (anti-virus software) were not generic. In the COCOA BUTTER FORMULA survey, none of the respondents said they would identify or describe a skin product that contains cocoa butter as COCOA BUTTER FORMULA.34 In the VIRUS SCAN survey, less than 1% of the respondents said they would use VIRUS SCAN to describe the type or category of computer software that is designed to protect and

31. Nestlé Co. v. Chester’s Mkt., Inc., 571 F. Supp. 763, 776 (“All the Sorensen study could prove was that chocolate chip is a generic term just as a similar study in the Thermos case proved that thermos is a generic term.” Surely the study did not prove that vacuum bottle is not a generic term, as in this case it did not prove that Toll House is not a generic term for cookies.”). In Premier Nutrition, Inc. v. Organic Food Bar, Inc. (2008 WL 1913163, at *11 (C.D. Cal. Mar. 27, 2008) (unpublished)), the defendant introduced a Thermos Survey to prove that ORGANIC FOOD BAR was not a generic term. Interviewers showed respondents a variety of nutrition bars, and then inquired what respondents would ask for if they were looking for this product in a grocery store. In response to the question only three respondents out of 229 said ORGANIC FOOD BAR. Nevertheless, the court did not find defendant’s survey to be probative with respect to trademark significance (“And again, just because a term is not the most generic term for a product does not mean it is not generic. This Court does not see how the Poret Survey supports, in any meaningful way, Defendant’s argument that ‘organic food bar’ is not generic.”). On the other hand, in Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc. (2007 WL 4563873, at *6 (N.D. Ga. July 17, 2007) (unpublished)), the court rejected plaintiff’s argument that a Thermos Survey could not be used to support a nongenericness finding (“The court is not persuaded that the use by Hollander of a ‘Thermos Survey’ to conclude that a term is not generic is sufficiently beyond the standards practiced in the field of surveying so as to deem the survey unreliable.”).

32. E.T. Browne Drug Co. v. Cococare Prods., Inc., 538 F.3d 185, 197 (3d Cir. 2008) (“The survey raises a reasonable inference that ‘Cocoa Butter Formula’ does not describe the product genus in the opinion of the 46 respondents who described the product class.”). Nevertheless, the Third Circuit found that the appellant’s survey had “non-trivial flaws,” and criticized it for deviating from the standard “Thermos survey model” (“The survey likely would have been strongest if it had asked respondents, as the ‘Thermos survey’ also did, how they would ask at a store for the type of product at issue.”).

33. In re Network Assoc. Tech., Inc., 2005 WL 363395, at *4-*7 (T.T.A.B. Jan. 25, 2005) (unpublished). The applicant’s survey asked two basic questions: “What do you call the type or category of computer software that is designed to protect and secure computer data, software, and computer communications networks?” and “What other name or names, if any, do you use when referring to this type or category of software?” The Board found these questions to be vague (“While we have reason to question the persuasiveness of the survey, we must give it some weight. At this point, we note that at its bare minimum more than 100 people with some familiarity with business software were asked twice to provide the name of computer software that is designed to protect and secure computer data. Virtually no respondent identified ‘virus scan’ as the name of the software.”).

34. E.T. Browne, 538 F.3d at 195 (“Neither ‘Cocoa Butter Formula’ nor any form of the word ‘Formula’ appeared among the respondents’ answers.”).
secure computer data, software, and computer communications networks. Conversely, a Thermos Survey supported a finding that PILATES is generic for a type of exercise. None of the survey respondents familiar with that type of exercise was able to provide a substitute word for PILATES. Furthermore, in rejecting a motion to exclude a survey concerning NITE LITES (outdoor illumination), a U.S. District Court opined that the Thermos Survey format had achieved “general acceptance.”

The survey endorsed in American Thermos did not explain the difference between generic terms and trademarks or test respondents’ understanding of the difference between the two before asking the critical questions, and for this reason surveys that employ the Thermos Survey format have been faulted. A Thermos Survey may avert such criticism by incorporating brand name and common name definitions. Questions in a Thermos

35. In re Network Assoc., 2005 WL 363395, at *6 (“Of 110 respondents to survey questions six and seven, only one responded that the term ‘virus scan’ was a name for the software and another responded that ‘virus protection scan’ was the generic name of the goods.”).

36. Pilates, Inc. v. Current Concepts, Inc., 120 F. Supp. 2d 286, 305 (S.D.N.Y. 2000). The defendants’ survey asked the following questions: “Other than the word Pilates, is there some kind of word or short phrase that you use to refer to this type of exercise, or is Pilates the only word you use?”; “Is Pilates the only word you’ve heard other people use?”; and “Generally, in your own words how would you describe Pilates?” The court opined that even though the defendants’ survey was flawed, it “showed that consumers of exercise instruction services and equipment generally do not use any other term to describe the Pilates method,” and it credited the survey with showing that the word PILATES lacked trademark significance.

37. Nightlight Sys., 2007 WL 4563873, at *6. The defendant’s survey asked the following questions about a system of outside low-voltage home illumination: “What do you call such a system of outdoor illumination?”; “Do you know the names of manufacturers of such illuminating systems?” “Who are those manufacturers?” “Can you name any trademarks or brand names of such outside illumination systems?” and “What are those brand names?” Despite the plaintiff’s criticisms of these questions and other objections, the court denied the motion to exclude the defendant’s survey and found that “[t]he ‘Thermos Survey’ is a method that has achieved general acceptance for use in determining the genericness of a disputed term.”

38. In G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436, 1486 n.35 (E.D. Wis. 1987), Anheuser-Busch proffered a Thermos Survey in which respondents were shown a can of LA from Anheuser-Busch or LA advertising and then asked the following questions: “How do you describe the product?”; “What type of beer is it?”; “What is the brand name of the new product?”; and, “What company produces the brand?” The court commented negatively on the survey’s failure to test respondents’ understanding of the brand name/common name dichotomy (“The Wind survey respondents were not tested to determine what they understood by the concept ‘brand name.’”).

39. In re Minnetonka, Inc. (3 U.S.P.Q. 1714 (T.T.A.B. 1987)) involved an application to register the name SOFTSOAP in connection with liquid soap. Applicant’s survey included common name/brand name definitions tied to an automobile-Chevrolet example in the introductory section of the questionnaire. Respondents were shown photographs of unmarked containers with a pump-type dispenser, and then they were asked to provide the
Survey should relate to the product or service for which a party is claiming trademark identifying significance, and failure to do so may cause the survey to be disregarded. Whereas “control questions” (questions designed to measure guessing or “noise”) are an essential element of the Teflon Survey format, the absence of such questions in a Thermos Survey may not affect its admissibility.

In a Thermos Survey, respondents answer questions in their own words rather than selecting from a set of response categories as in a Teflon Survey. For this reason, after interviews are completed respondents’ answers need to be reviewed and then sorted into categories based on their content (a process known as “coding”). If respondents give multiple answers to questions in a Thermos Survey, the order in which responses were given may need to be analyzed and reported. Improper coding or grouping of respondents’ answers may undermine a Thermos Survey’s probative value.

“common name or names” and the “brand name or names” for the products shown in the photographs. Details of the survey are not included in the opinion, but are described in Phyllis J. Welter, Trademark Surveys § 22:02[1] (6th ed. 1999). Note, this was Minnetonka’s second attempt to register SOFTSOAP. The Board found the questions in the survey submitted in connection with Minnetonka’s initial application to be “flagrantly leading” (212 U.S.P.Q. 772, 780-81 (T.T.A.B. 1981)). The second SOFTSOAP survey apparently corrected the flaws identified by the Board in the first survey.

40. interState Net Bank v. Netb@nk, Inc. and Netb@nk, 221 F. Supp. 2d 513, 526 (D.N.J. 2002). Seeking to expand trademark protection for their name, defendants offered a survey that included the following items: “Are you aware of a banking service that allows you to pay some or all of your bills by using your computer to communicate with your bank?” and “If you were to describe this process to a friend, what words or phrases would come to mind first? That is, what would you call this process?” The court disregarded the survey because it confused the separate industries or services of online banking and online bill payment (“However, the issue is whether ‘net bank’ is generic for online banking services, for which defendants seek to expand their trademark protection, not online bill payment services using electronic coupons, for which the mark was registered. Defendants’ attempt to pose questions whether a banking service providing online bill payment services is considered a ‘net bank’ by the general public fails to reach the heart of the issue, which is whether the ‘net bank’ term has reached genericness in the field of banking services provided via the global computer network.”).

41. Nightlight Sys., 2007 WL 4563873, at *8 (“As the court has found the use of the ‘Thermos Survey’ reliable and relevant in the instant case, the court finds the lack of a control question in Hollander’s survey not sufficiently unreliable or irrelevant so as to prevent its admissibility. The extent to which the survey lacks a control question goes to the weight afforded the survey, and not its admissibility.”).

42. Heileman, 676 F. Supp. at 1486 (“Other disputes arose because the consumers surveyed gave multiple answers or answers which could arguably be classified in more than one category. Wind’s report gave no indication of the order in which the multiple responses came to mind.”).

43. Tea Bd. of India v. The Republic of Tea, Inc., 80 U.S.P.Q.2d 881 (T.T.A.B. 2006) (“Second, we have numerous problems with the way in which Dr. Block interpreted or ‘coded’ the responses as well as the manner in which he grouped the coded responses, and as
V. TEFLON SURVEYS AFTER E. I. DU PONT DE NEMOURS

Since E. I. Du Pont de Nemours, Teflon Surveys have been the preferred format for genericness surveys, as reflected by U.S. court opinions and U.S. Trademark Trial and Appeal Board decisions in which they have been approved. Teflon Surveys have helped establish trademark significance or helped create material issues of fact as to whether they were generic for the following marks: AUTO CLUB (roadside assistance); UGG (sheepskin boots); BEANIE(S) (plush toys); MARCH MADNESS (basketball tournaments); SWISS ARMY (pocketknives); STEELHEAD (golf clubs); and SPORTS CHANNEL (cable television).

a result, we have no confidence that the ‘32.4%’ figure, which represents the number of answers allegedly identifying Darjeeling as a ‘type’ of tea, is accurate.”).

44. Auto. Club of S. Cal. v. The Auto Club, Ltd., 2007 WL 704892, at *4 (C.D. Cal. Mar. 15, 2007) (unpublished) (“It is inappropriate for the Court to weigh this evidence, but the Court finds that Plaintiff has met the requirements for a non-movant to survive a motion for summary judgment.”).

45. UGG Holdings, Inc. v. Severn, 2005 WL 5887187, at *5 (C.D. Cal. Feb. 23, 2005) (unpublished) (“Moreover, Defendants have ignored the survey evidence, submitted by both Plaintiff and Defendants, clearly demonstrating that the term is non-generic.”).

46. Ty, Inc. v. Softbelly’s, Inc., 353 F.3d 528, 530-31 (7th Cir. 2003) (“If 60 percent of the relevant consuming public thinks ‘Beanies’ is a brand name, as many as 40 percent may think it generic-and in fact 36 percent of the respondents in Ostberg’s survey did. But the legal test of genericness is ‘primary significance’ [citations omitted]. Ostberg’s results are evidence that the primary significance of ‘Beanies’ is still as the name of Ty’s brand.”), aff’d in part, rev’d in part, 517 F.3d 494 (7th Cir 2008). In Ty, the District Court also credited Ostberg’s Teflon Survey in granting the plaintiff’s motion for a preliminary injunction (2001 WL 125321, at *3 (N.D. Ill. Feb. 9, 2001) (unpublished) (“Consumer surveys show that 60% of consumers tested believed ‘beanies’ to be a brand name . . .”)).

47. March Madness Athletic Ass’n, LLC v. Netfire, Inc., 310 F. Supp. 2d 786, 804-09 (N.D. Tex. 2003) (“In other words, within the relevant sample of persons who knew March madness was related to basketball, over 60% classified it as a trade name. Based on this evidence, the court finds that March madness has acquired secondary meaning as a trade name. * * * This court has examined the format, methodology, universe of respondents, and survey administration carried out by Mantis on behalf of Plaintiff, and concluded that the survey should be given substantial weight as indicative of the primary significance of March madness as a trade name within the context of basketball.”). Note, in March Madness, the court first concluded that MARCH MADNESS was nongeneric, and then credited the plaintiff’s Teflon Survey with showing that the name had acquired secondary meaning.

48. Arrow Trading Co., Inc. v. Victorinox A.G. and Wenger, S.A., 2003 WL 21509858, at *14 (T.T.A.B. June 27, 2003) (unpublished) (“Applicants, however, have submitted convincing evidence that SWISS ARMY is their trademark for multifunction pocketknives. * * * This survey utilized the generally approved Teflon Methodology.”).

49. In re Callaway Golf Co., 2001 WL 902004, at *7 (T.T.A.B. Aug. 9, 2001) (unpublished) (“Of considerable significance in the present case is the survey. As in the original Teflon Survey,’ the respondents in applicant’s survey were quite good at sorting out brand names from common names. Although the Examining Attorney is technically correct in viewing the survey results relating to STEELHEAD as a statistical tie (taking into account the precision variance), the simple fact is that a substantial part (over 48%) of the
They also have been credited with showing the lack of trademark significance or helped create material issues of fact as to whether they were nongeneric for the following marks: BROOKLYN STYLE (pizza),\(^{51}\) BEERMAN (beer vendor character);\(^{52}\) BREAK & BAKE (pre-sectioned cookie dough);\(^{53}\) 386 (microprocessors);\(^{54}\) and WINDSURFER (sailboards).\(^{55}\)

### A. The Brand Name/Common Name Dichotomy

The Teflon Survey credited in \textit{E. I. Du Pont de Nemours} began with the following brand name/common name definitions and examples: “I’d like to read 8 names to you and get you to tell me whether you think it is a brand name or a common name; by \textit{brand relevant purchasing public view the term STEELHEAD as a trademark, and not as a generic name. The survey by itself raises a doubt regarding genericness, and any doubt in determining registrability is resolved in favor of applicant.”\(^{50}\)."

\(^{50}\) \textit{SportsChannel Assocs. v. Comm’r of Patents and Trademarks}, 903 F. Supp. 418, 426-27 (E.D.N.Y. 1995) (“In an effort to satisfy this standard, the plaintiff has done a yeoman job of producing evidence that tends to establish that the public regards the term ‘SportsChannel’ as a trade name. While it is true, that the Government has offered its own countervailing evidence, this proof serves to demonstrate that an issue of material fact exists as to how the public truly perceives the term ‘SportsChannel’.”).

\(^{51}\) \textit{Great Am. Rest. Co. v. Domino’s Pizza, L.L.C.}, 2008 WL 1808532, at *3 (E.D. Tex. Apr. 21, 2008) (unpublished) (“Domino’s relies in part on the survey of Dr. Jay to demonstrate that the term is merely generic. In her Teflon survey, Dr. Jay notes that 77% of those surveyed had an opinion that Brooklyn style pizza was a common generic name [citation omitted]. Domino’s points out that even a surveyed showing of 60% is enough to hold that the name is merely generic.”), \textit{report and recommendation adopted}, 2008 U.S. Dist. WL 2277828 (E.D. Tex. May 29, 2008) (unpublished). The court found the name BROOKLYN STYLE to be either generic or merely descriptive without secondary meaning.

\(^{52}\) \textit{Donchez v. Coors Brewing Co.}, 392 F.3d 1211, 1218 (10th Cir. 2004) (“Again, however, we are not persuaded that a rational trier of fact could find, based on Donchez’s interpretation of the defendants’ survey results, that the term ‘beerman’ is descriptive rather than generic. In particular, the number of survey respondents classifying the term ‘beerman’ as generic was clearly substantial.”).

\(^{53}\) \textit{J & J Snack Foods Corp. v. Nestlé USA, Inc.}, 149 F. Supp. 2d 136, 153 (D.N.J. 2001) (“The McCullough report, dated May, 2001, concluded that a majority of the survey respondents felt that ‘Break & Bake’ was a common name.”). Although the court did not find BREAK & BAKE generic, it did find the name was merely descriptive (without secondary meaning).

\(^{54}\) \textit{Intel Corp. v. Advanced Micro Devices, Inc.}, 756 F. Supp. 1292, 1297 (N.D. Cal. 1991) (“If a properly conducted survey shows that 72% of the relevant public regards a combination as generic, then that is its principal significance, and a court is justified in according substantial weight to such a survey.”).

\(^{55}\) \textit{Windsurfing Int’l, Inc. v. Fred Ostermann GMBH}, 613 F. Supp. 933, 959 (S.D.N.Y. 1985) (“Having closely examined the survey report, we find that it represents an objective and logical procedure for gathering information on the question at hand. Although the limitations inherent in any statistical predictions must be recognized, we nonetheless conclude that the survey tends to establish that ‘windsurfer’ is generic.”), \textit{aff’d in part, rev’d in part}, 782 F.2d 995 (Fed. Cir. 1986).
name, I mean a word like *Chevrolet* which is made by one company; by *common name*, I mean a word like *automobile* which is made by a number of different companies.\(^{56}\)

Other Teflon Surveys have used variants of this introduction,\(^{57}\) sometimes tailoring the examples to the products at issue.\(^{58}\) Teflon Survey introductions have been criticized for supplying “circular” definitions\(^{59}\) and for illustrations at the beginning of the

\(^{56}\) As quoted in 2 *McCarthy*, supra note 3, § 12:16.

\(^{57}\) *Windsurfing*, 613 F. Supp. at 958 n.163 ("Interviewees were told: 'Most products on the market have two names. The one tells us what type of product it is. For instance, beer, or automobile or coffee. The other is its *brand name*, such as Budweiser, Chevrolet or Maxwell House.'). aff'd in part, rev'd in part, 782 F.2d 995 (Fed. Cir. 1986); In re Callaway Golf Co., 2001 WL 902004, at *4 (T.T.A.B. Aug. 9, 2001) ("The research we are conducting today is on common names and brand names. Most products or services have both common names and brand names. *Common names* tell what type of product it is; for example, beer, automobile, or instant coffee. *Brand names* tell what brand it is; for example, Budweiser, Chevrolet, or Maxwell House.").

\(^{58}\) This author used introductory examples concerning the products at issue (shoes) for a Teflon Survey endorsed by the court in *UGG Holdings, Inc. v. Severn*, 2005 WL 5887187, at *5 (C.D. Cal. Feb. 23, 2005). The survey (which was not described in detail in the opinion) began in the following manner: "Now, I'd like to ask you about your understanding of some names or terms involving shoes. For each one, I'd like you to tell me whether you think it is a common or generic name or whether it is a brand name. A common or generic name refers to a type of shoe whereas a brand name refers to shoes from one company or source. Here are two examples. SNEAKER is a common or generic name for a type of shoe whereas SKECHERS is a brand name. SANDAL is a common or generic name for a type of shoe whereas BIRKENSTOCK is a brand name.

This author introduced the Teflon Survey accepted in *Great Am. Rest. v. Domino's Pizza, L.L.C.* (2008 WL 1808532, at *3 (E.D. Tex. Apr. 21, 2008)) in the following manner: "Now, I would like to ask you about your understanding of some names or terms concerning pizza. For each one, I would like you to tell me whether you think it is a common or generic name or whether it is a brand name. A common or generic name refers to a type of product or service whereas a brand name refers to a product or service from one company or source. For example, PIZZA RESTAURANT is a common or generic name whereas PIZZA HUT is a brand name."

In *Auto. Club of S. Cal. v. The Auto Club, Ltd.* (2007 WL 704892, at *4 (C.D. Cal. Mar. 15, 2007)), this author's Teflon Survey employed the following introduction: "Now, I would like to ask about your understanding of some names or terms concerning cars and car-related services. For each one, I would like you to tell me whether you think it is a common or generic name or whether it is a brand name. A common or generic name refers to a type of product or service whereas a brand name refers to a product or service from one company or source. Here are some examples of names or terms concerning cars and car-related services. NAVIGATION SYSTEM is a common or generic name whereas ON STAR is a brand name. CAR RENTAL is a common or generic name whereas BUDGET and ENTERPRISE are brand names."

\(^{59}\) *Classic Foods Int'l Corp. v. Kettle Foods, Inc.*, 468 F. Supp. 2d 1181, 1193 (C.D. Cal. 2007) ("KFI's survey, however, has several flaws in its methodology. It uses a circular definition for what a brand name is . . .").
questionnaire that “precondition” respondents’ later answers regarding the disputed mark.60

B. Screening Respondents

Regardless of the questionnaire format selected, potential survey respondents often are asked questions about their purchase intentions when they are first contacted to be respondents (known as “screener questions”) to determine whether they qualify for a genericness survey (i.e., whether they are members of the relevant consuming public or target universe). A Teflon Survey includes additional qualifying questions at the beginning to ensure that respondents comprehend the common name/brand name dichotomy.61 After common name and brand name definitions are

60. Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 576 (D.N.J. 1985). Although the defendant’s Teflon Survey was criticized by the plaintiff for priming respondents, the court held this criticism lacked merit (“I also do not find plaintiff’s concern over the ‘preconditioning’ of respondents warranted. Plaintiff’s claim that respondents were told and thus preconditioned in the introductory or ‘screener’ portion of the survey that nuts were a product and were then asked, in effect, whether ‘honey roasted nuts’ was a product or a brand. Dr. Robert Sorensen, plaintiff’s expert witness in consumer surveys, testified, ‘[t]he presence of that word ‘nuts’ automatically, in my opinion, as a noun, as an object, causes any word coming prior to it, particularly a word ending in ‘-ed’ . . . , to be viewed by the average person as being descriptive.’ Such an approach does not, however, preclude a consumer from viewing the descriptive word as a brand name. The word ‘M & M’ in a question about ‘M & M candies’ could be perceived as descriptive and still be considered a brand name. A mark is to be viewed in relation to the product it identifies, so I find it only rational to conduct the survey in the manner defendants did.”).

Arthur J. Greenbaum, Jane C. Ginsburg & Steven M. Weinberg (A Proposal for Evaluating Genericism After “Anti-Monopoly,” 73 TMR 101, 119 (1983)) recommend providing respondents with examples of brand names and common names in the introduction to a Teflon Survey, but not definitions of these terms. However, their suggested modification to the Teflon format would expose it to the same criticism as the Thermos format; see Palladino, supra note 5, at 875 (“Finally, in contrast to the TEFLOON approach, THERMOS Questions Three and Five suffer from a lack of precision in that they do not explain what generic terms or trademarks are.”).

61. March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 803 (N.D. Tex. 2003) (“Qualified respondents were those who . . . were able to demonstrate, on the first part of the survey, that they understood the difference between trade names and common names.”); SportsChannel Assocs. v. Comm’r of Patents and Trademarks, 903 F. Supp. 418, 421 (E.D.N.Y. 1995) (“Each respondent to the Simonson Survey was first asked a series of qualifying questions to make sure that she or he met the parameters of the population of existing potential purchasers of cable television programming services. Those who met the criteria were then introduced to the concept of trade names and common names. If the respondent understood the difference, he or she was presented with nine names and asked if each was a trade name or a common name. One of the nine names was ‘SportsChannel.’”); Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292, 1296 (N.D. Cal. 1991) (“The sample was of representative persons in charge of purchasing microprocessor components for inclusion in equipment manufactured by their OEM companies who on the basis of exemplary questions demonstrated an ability to distinguish between a brand name and what the survey questionnaire refers to as a generic description.”).
supplied, potential respondents first are queried about one or more words. Only those respondents who correctly classify the first words are asked about the remaining ones (i.e., the disputed mark and the control words).

Eligible respondents for the survey ratified in *E. I. Du Pont de Nemours* correctly identified CHEVROLET as a “brand name” and WASHING MACHINE as a “common name” at the beginning of the survey. Teflon Surveys have used other words besides CHEVROLET and WASHING MACHINE to assess respondents’ understanding of the common name/brand name dichotomy (e.g., the words used to screen respondents sometimes concern the same product genus as the challenged mark). For the results of a Teflon Survey to be meaningful, respondents’ comprehensions of the common name/brand name dichotomy ought to be “tested.” If a Teflon Survey merely asks respondents at the beginning of the survey whether they understand the difference between common names and brand names, the survey may be entitled to little or no weight.

One Teflon Survey regarding a new product included a screening question at the end of the survey that asked respondents to describe a WINDSURFER after they had classified the word as a “type of product” or a “brand name.” The additional screening

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62. After explaining the difference between brand names and common names, the survey in *E. I. Du Pont de Nemours* (393 F. Supp. 502 (E.D.N.Y. 1975)) asked the following questions: “So if I were to ask you, ‘Is Chevrolet a brand name or a common name?’, what would you say?” and “Now, if I were to ask you, ‘Is washing machine a brand name or a common name?’, what would you say?” (*quoted in 2 McCarthy, supra note 3, § 12:16*). The Teflon Survey credited in *In re Callaway* (2001 WL 902004, at *4) also required its survey respondents to correctly identify WASHING MACHINE as a common name.

63. This author used “shoe” examples to test respondents’ understanding of the brand name/common name dichotomy for the Teflon Survey endorsed in *UGG Holdings* (2005 WL 5887187, at *5); eligible survey respondents correctly identified TIMBERLAND as a brand name and SLINGBACK as a common name. For this author’s Teflon Survey in *Great Am. Rest.* (2008 WL 1808532, at *3), eligible respondents understood SBARRO was a brand name and CALZONE was a common name; and in *Auto. Club of S. Cal.* (2007 WL 704892, at *4), eligible respondents correctly classified PEP BOYS as a brand name and CRUISE CONTROL as a common name.

64. *Classic Foods*, 468 F. Supp. 2d at 1193 (“KFI’s survey, however, has several flaws in its methodology . . . it fails to screen subjects to see if they understood what a brand is . . .”); Jacob Zimmerman v. Nat’l Assoc. of Realtors, 2004 WL 7639936, at *13 (T.T.A.B. Mar. 31, 2004) (“The gate-keeping queries deviated from the ‘Teflon’ format in ways that render the answers meaningless in ensuring understanding on the part of the survey subjects.”). Instead of testing respondents’ specific understanding, petitioner’s Teflon Survey in *Zimmerman* asked respondents “Do you understand the difference between brand names and common names?”

65. *Windsurfing*, 613 F. Supp. at 958-959 (“The next question was: ‘Now, please tell me what kind of products these are?’ In response to the latter question 58% of the 801 people surveyed gave answers indicating that they had no knowledge of what a ‘windsurfer’ was. Of the 320 people who did know, 61.4% said it was a type of product while 35.8% said it was a
question was used to qualify the respondents, and the results were reported only for those respondents who understood that the word referred to a sailboard. However, the WINDSURFER survey may not have required the additional qualifying question had it included a narrower universe than adults age 16 to 40 within the United States.

C. Question Wording

Respondents in the Teflon Survey approved in E. I. Du Pont de Nemours were read 8 words, and for each one they were asked, “Now, would you say (WORD) is a brand name or a common name?”66 Teflon Survey questions may also refer to “trade names” rather than “brand names.”67

While a trademark may be descriptive, one U.S. district court endorsed a Teflon Survey that asked respondents to distinguish between “a brand name” and a “generic description.”68 Other Teflon Survey formulations also have been endorsed, such as asking respondents whether a word tells the “type of product it is” or “what brand it is.”69

The proper wording of questions in a Teflon Survey may depend on the mark at issue and the context in which it is used. For example, the common name/brand name dichotomy was found to be “too narrow” when the purpose of the survey was to

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66. As quoted in 2 McCarthy, supra note 3, § 12:16.
67. March Madness, 310 F. Supp. 2d at 803 (“The survey, conducted in January 2001, asked its participants to give their opinion as to whether March madness was a ‘trade name’ or a ‘common name.’”; SportsChannel, 903 F. Supp. at 421.
68. Intel, 756 F. Supp. at 1297 (“The term ‘generic description’ may be ambiguous as Dr. Sorensen said, but Dr. Sorensen did not disagree with the manner in which respondents distinguished between brand names and generic descriptions.”). However, in Eagle Snacks (625 F. Supp. at 582) the court found the results of defendant’s Teflon Survey to be “confusing” in part because it asked respondents to classify names as a “brand name” or a “common or descriptive name” (“In addition, respondents were asked to choose between the terms ‘brand name’ or ‘common or descriptive name’ to describe each of the marks surveyed. As common names do not warrant the protection that descriptive names sometimes do, consumer response on this question could support a finding of ‘Honey Roast’ as a descriptive mark as well as a generic mark.”).
69. Windsurfing, 613 F. Supp. at 958 (“Here, as in the Teflon Survey, the interviewees were asked whether each of eight product names, one of which was ‘windsurfer,’ tells the type of product or a name that indicates the brand.”).
determine whether POSTAL SERVICE referred to an organization rather than to a type of organization.  

By design, Teflon Survey questions do not include an explicit “both” response that is read to respondents. However, because some respondents nevertheless may volunteer they believe a word to be “both” a brand name and a common name, the interviewer should be permitted to record this on the questionnaire. Although Teflon Survey questions have been faulted for failing to include an explicit “both” response, this criticism lacks merit. The purpose of a Teflon Survey is to determine the “primary significance” of a disputed mark, not whether it has “some significance” as a brand name or a common name.

70. Zipee Corp. and Zipee.com, Inc. v. U.S. Postal Serv., 140 F. Supp. 2d 1084, 1087 (D. Or. 2000) (“I find that plaintiff’s survey is of little use given the limitations posed by the questioning framework. Asking consumers to choose between a ‘common name’ or a ‘brand name’ when describing ‘postal service’ is simply too narrow since it fails to give the consumer the option of identifying the phrase as a reference to an organization.”).

71. Ralph H. Folsom and Larry L. Teply claim that trademarks serve a hybrid function: Trademarked Generic Words, 89 Yale L.J. 1323 (1980); Surveying “Genericness” in Trademark Litigation, 78 TMR 1 (1988); A Reply to Swann and Palladino’s Critique of Folsom and Teply’s Model Survey, 78 TMR 197 (1988). They contend it is inappropriate for a Teflon Survey to encourage respondents to choose between two response categories (between a brand name or a common name) for this reason, and they advocate the inclusion of an explicit “both” response in the survey questions. For example, Folsom and Teply propose asking the following question concerning BAND-AID: “Is the word BAND-AID, to you, a brand name, a generic name, or both a brand name and generic name for the type of product that sticks on your skin and is used to protect cuts, scrapes and other minor injuries?” However, Swann and Palladino (A Critique of Folsom and Teply, 78 TMR at 181 and 187) believe the Folsom and Teply question format will merely confirm that “many famous trademarks are the subject of some generic use among a majority of consumers.” According to them, Folsom and Teply’s concern that the Teflon approach forces an unrealistic binary choice is misguided (“The law requires that the trier of fact make such a choice, however, in seeking to determine the primary significance of a disputed term.”).

The opinion in Forschner Group, Inc. v. Arrow Trading Co., Inc., 833 F. Supp. 385, 393 at n.8 (S.D.N.Y. 1993) is sometimes cited in support of the proposition that Teflon Survey questions should include an explicit “both” response option. However, Forschner is inapproriate as it did not concern trademark rights in a name (“[T]his action is dissimilar because it does not deal with trademark rights in ‘Swiss Army knife.’”), vacated, 30 F.3d 348 (2d Cir. 1994), aff’d, 124 F.3d 402 (2d Cir. 1997).

72. Windsurfing, 613 F. Supp. at 959 n.168 ("WSI also argues that the use of the disjunctive in phrasing the question (whether ‘windsurfer’ is a type of product or a brand), incorrectly states the law because it does not account for the fact that a word can serve a dual purpose. This argument is unpersuasive. As the survey results indicate, individuals who believed ‘windsurfer’ serves a dual purpose were free to, and did, respond by answering that the term could be both a product and a brand.").

73. In E. I. Du Pont de Nemours & Co. v. Yoshida Intl’, Inc. (393 F. Supp. 502, 526 n.56 (E.D.N.Y. 1975)), the court did not wholly reject defendants’ contention that the surveys revealed some evidence and examples of generic use of TEFILON by the public. However, it opined that “some evidence” of generic usage was not sufficient to overcome trademark or brand name usage for a non-stick coated pot or pan. See also Feathercombs Inc. v. Solo Prods. Corp., 306 F.2d 251, 256 (2d Cir. 1962) (“In order to become generic the principal
The questions in the Teflon Survey approved in *E. I. Du Pont de Nemours* did not include an explicit “don’t know” option that was read to respondents. As with other types of trademark surveys, Teflon Surveys usually instruct respondents in the introductory section of the questionnaire to indicate if they do not have an opinion and provide a place for interviewers to record “no opinion” responses.

**D. Frame of Reference**

Whether a mark is generic may depend on the context in which it is used (e.g., Jaguar is a common name for a type of animal and a brand name for a car). In such circumstances, Teflon Survey questions may require a frame of reference. For example, a Teflon Survey concerning STEELHEAD for use in connection with golf clubs asked the question, “With respect to golf, for each of the following names, would you please tell me whether you understand the name to be a common name or a brand name?” The failure of a Teflon Survey to connect a word to a context may subject it to criticism and/or cause it to be disregarded. However, if a party significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.”); 2 *McCarthy*, supra note 3, § 12:06 (“The standard most often applied to determine whether a term is generic is not whether it has some significance to the public as the name of an article, but whether that is its principal significance.”).

74. Jean M. Converse & Stanley Presser, Survey Questions: Handcrafting the Standardized Questionnaire 36 (1986) (“Filtering is especially important toward the beginning of an interview to make clear to respondents that no opinion is a legitimate answer. Doing so at the outset, as well as training interviewers to accept ‘don’t knows,’ should also reduce the need—and monotony—of filtering routinely throughout an interview.”).

75. *In re Callaway Golf Co.*, 2001 WL 902004, at *4 n.6 (T.T.A.B. Aug. 9, 2001) (“This follow-up question presents a twist on a typical ‘Teflon Survey.’ In this connection, we take judicial notice of the dictionary definition of the term ‘steelhead’: ‘a large-sized silvery anadromous rainbow trout.’ *Webster’s New International Dictionary* (unabridged ed. 1993). Given the fact that ‘steelhead’ is a name of a fish, some respondents may well have classified the term as a common name if the term appeared in the first list of terms. By way of example, the same likely would be true of the term ‘Arrow.’ Although the term is a common name (as in ‘bow and arrow’), it is also a brand name as applied to shirts. Thus, inasmuch as ‘steelhead’ is a dictionary term, we see no problem with the follow-up question that directs the respondents’ attention to the significance of ‘Steelhead’ as it pertains to golf.”).

76. In *Donchez v. Coors Brewing Co.* (392 F.3d 1211, 1218 (10th Cir. 2004)), the defendant’s Teflon Survey asked survey respondents to classify BEERMAN as a common name or a brand name. In rejecting the plaintiff’s attempt to interpret the results in his favor, the Tenth Circuit commented on the failure of the Teflon Survey to provide a frame of reference (“Further, there is no indication that the survey respondents were asked to classify the term ‘beerman’ as applied to entertainment or promotional services.”).

77. *Nestlé Co. v. Chester’s Mkt.*, 571 F. Supp. 763, 777 (D. Conn. 1983) (“The key term on the list of names to be identified was simply Toll House. In order for the survey results to
does not demonstrate that the results of the survey would have differed had a frame of reference been provided, this criticism may be rejected\textsuperscript{78} or merely lessen the weight accorded a survey.\textsuperscript{79}

\textbf{E. Controls}

Unlike trademark confusion surveys, Teflon Surveys do not include “external controls,” such as a control group of respondents exposed to a different set of words. However, a Teflon Survey does include “internal controls” in the form of “control questions,” which are questions pertaining to words other than the contested mark. The control words in a Teflon Survey are used to evaluate respondents’ ability to distinguish brand names from common names, and they also provide a measure of the amount of guessing or “noise” in the survey. Although Teflon Surveys have not been faulted for the failure to include a control group, they have been criticized for their choice of control words (or control questions). However, such criticisms may not have a material impact on the evidentiary value of the survey’s results or affect its admissibility.\textsuperscript{80}

\textsuperscript{78}. \textit{E. I. Du Pont de Nemours}, 393 F. Supp. at 527 (“YKK criticizes the survey not for being unrepresentative, but for its failure to be tied to a particular product, and argues it is thus no evidence that TEFILON has trademark significance. That contention is without merit.”); Arrow Trading Co., Inc. v. Victorinox A.G. and Wenger, S.A., 2003 WL 21509858, at *15 (T.T.A.B. June 27, 2003) (“[Opposer argued in its brief that applicants’ survey is] fatally flawed because the survey failed to test the term at issue in this case—Swiss Army knife. Instead, consumers were asked whether they believed SWISS ARMY was a brand name or a generic term. * * * We have carefully considered the entire testimony of Dr. Ostberg, and we find no reason to discount his survey.”).

\textsuperscript{79}. Burger King Corp. v. Pilgrim’s Pride Corp., 705 F. Supp. 1522, 1525-1526 (S.D. Fla. 1988), aff’d, 894 F.2d 412 (11th Cir. 1990). In seeking to overturn a jury verdict in Burger King’s favor, the defendant criticized Burger King’s Teflon Survey because respondents were not told the product category when they were asked to classify CHICKEN TENDERS as a brand name or a common name. Burger King responded that the failure to identify the product category actually enhanced the credibility of the survey, arguing that if, in fact, the product had a generic meaning to consumers, then that generic term would be the first in mind and the most likely response from the consumer. The court found Burger King’s Teflon Survey comported with accepted survey standards (“This argument again goes to the weight of the survey and not to its validity.”).

\textsuperscript{80}. March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 803 n. 65 (N.D. Tex. 2003) (“In particular, the Court notes that one of the sample questions was whether ‘Double Header’ is a trade name or a common name. Mantis apparently believed it to be a common name. * * * This fact does not materially impact the value of the results of the survey.”). In \textit{Premier Nutrition, Inc. v. Organic Food Bar, Inc.} (2008 WL 1913163, at *11 (C.D. Cal. Mar. 27, 2008)), the plaintiff’s Teflon Survey pre-qualified respondents by asking them whether they had recently bought or intended to buy “nutrition bars, energy bars or \textit{food bars}.” Additionally, one of the names considered “common” in the survey was ORGANIC TORTILLA CHIPS. The defendant contended that the use of these terms in a
Even though the brand name controls in the Teflon Survey credited in *E. I. Du Pont de Nemours* were famous (e.g., COKE, JELLO),
81 parties have assailed other Teflon Surveys for including brand name controls that were too well-known. This objection did not disqualify a genericness survey in one matter because there was no reason to believe that the inclusion of intermediate examples would have produced a different result for the contested mark.82 The inclusion of well-advertised brand name controls did not “alter the fundamental reliability”83 or “fatally flaw”84 other Teflon Surveys, either. However, a Teflon Survey that did not use equal numbers of brands and kinds of motorcycles, and that included only widely-recognized motorcycle brands, had no probative value.85

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81. 393 F. Supp. 502, 527 n.54 (E.D.N.Y. 1975). Note, in *E. I. Du Pont de Nemours*, the primary significance of COKE was not disputed. However, because 76% of respondents recognized COKE as a brand name, the same survey was credited in another matter with showing that “COKE” had trademark significance: Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1254 at n.11 (9th Cir. 1982) (“Coca-Cola also relies on a trademark-recognition survey discussed in a case not involving Coca-Cola. In that survey, ‘Coke’ was the second-highest-ranking trademark with 76% of the public sampled recognizing ‘Coke’ as a trademark rather than a generic term.”).

82. Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 576 (D.N.J. 1985) (“The only criticism plaintiffs have of defendant's survey which I find material to the weight I accord the survey is that Professor Ross selected two very well known and coined trademarks (Pepsi and M & M's) and two very well known and common product names (aspirin and cellophane). No words in intermediate categories were included. Because of this, signals may have been given to respondents that in order to be a brand name, a name had to be of the strength of ‘Pepsi’ or ‘M & Ms.’ This factor, however, does not disqualify the Ross survey. It indicates only that I should give less weight to the survey than I otherwise would.”).

83. J & J Snack Foods Corp. v. Nestlé USA, Inc., 149 F. Supp. 2d 136, 153 n.12 (D.N.J. 2001) (“The Bunge report criticizes what he perceives to be survey errors (e.g., the rotation of the terms on the survey, the use of well known, clearly established marks, and the use of modifiers with names) and sampling errors (e.g., including only weekend shoppers) in Mr. McCullough’s report. This report was considered and Mr. Bunge’s opinions do not discredit the fundamental reliability of Mr. McCullough's survey evidence, in this Court’s view.”).

84. *Burger King*, 705 F. Supp. at 1526 (“This again goes to the weight of the evidence, and not its underlying validity. The survey simply asked if certain terms were brand names or common (generic) names. The fact that the persons surveyed recognized well-advertised items as brand names is almost inevitable but does not fatally flaw the survey.”).


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survey about ORGANIC FOOD BARS biased the survey. Although the court found that the defendant’s criticisms had merit, it did not disqualify the plaintiff’s survey (“Defendant also argues that the Cogan Survey includes terms that improperly influenced the respondents. ** ** Defendant's objections are well-taken, but they go to the weight of the survey evidence, not to the admissibility. ** ** Thus, Plaintiff has introduced survey evidence to support its claim that ‘organic food bar’ is a generic term.”).
F. Rotation of Items and Response Categories

In a Teflon Survey the words that respondents are asked to classify first may influence their subsequent answers, which is known as “question order effects” or “context effects.” For this reason the order in which words are read in a Teflon Survey often is randomized across respondents. Another concern relates to whether respondents’ answers are influenced by the order in which response categories are read. To minimize the potential for response-order effects in Teflon Surveys the order of the response categories may be randomized across respondents as well. For example, half the respondents will be asked to classify a name “as a brand name or a common name,” and the other half “as a common name or a brand name.”

G. Survey Analysis

In *E. I. Du Pont de Nemours*, 68% of the respondents recognized TEFLON as a brand name and not a common name.

of motorcycles in the survey. According to applicant, all but ‘Streetfighter’ are known brand/names of motorcycles. * * * Although Ms. Nielson is qualified as a survey expert, we believe that opposer's objections do indeed have merit, and thus we have accorded no probative value to the survey results in reaching our decision herein.

86. Schuman & Presser, Questions & Answers 12 (“Questions do not, of course, appear in isolated form in surveys, but are always part of a larger sequence of questions, a questionnaire. A worrisome problem is whether answers to a given item are influenced by the particular question or questions that precede it.”).

87. *March Madness*, 310 F. Supp. 2d at 803 (“The sequence of terms was rotated on different surveys in order to avoid term order bias.”); *Intel*, 756 F. Supp. at 1297 (“The order of the terms was rotated, so that no term kept its original position in the order of questioning at all times.”); *Eagle Snacks*, 625 F. Supp. at 575 (“The four test names were rotated to eliminate ‘order’ bias.”); Jacob Zimmerman v. Nat'l Assoc. of Realtors, 2004 WL 763936, at *13 (T.T.A.B. Mar. 31, 2004) (“After qualifying the survey subjects, two questions followed and were rotated.”). In *Classic Foods Int'l Corp. v. Kettle Foods, Inc.* (468 F. Supp. 2d 1181, 1193 (C.D. Cal 2007)), the court was critical of defendant’s survey because it failed “to identify or account for any order bias that might have been produced.” However, in *J & J Snack Foods* (149 F. Supp. 136), the court found that problems with the rotation of the terms on the survey did not discredit the fundamental reliability of the survey evidence.

88. Schuman & Presser, Questions & Answers 12 (“A problem somewhat analogous to that of question order occurs within any closed item: the order of alternatives offered to a respondent. The response-order problem, as we will term it, is usually whether there is a primacy or recency effect, that is, whether there is a systematic tendency for respondents to choose the first or last alternative in a set.”).

89. *Eagle Snacks*, 625 F. Supp. at 575 (“In addition, there was also a rotation as to whether the respondent was asked: ‘Would you say that is a common or descriptive or a brand name’, or ‘Would you say that is a brand name or a common or descriptive name.’ This rotation was employed to eliminate the possibility of systematic bias being introduced as a function of whether the respondent heard ‘brand’ or ‘common or descriptive’ first as applied to a particular name.”).

90. 393 F. Supp. at 526 n.54.
Since *E. I. Du Pont de Nemours*, a properly constructed and implemented Teflon Survey in which a majority classifies a mark as a brand name has supported a nongenericness finding, or helped create a material issue of fact as to whether the name was generic.\(^91\) Following are some examples, including the percentage of the respondents that classified the mark as a brand name: 58% for UGG (sheepskin boots);\(^92\) 60% for BEANIES (plush toys);\(^93\) 61% for MARCH MADNESS (basketball tournaments);\(^94\) 65% for SPORTS CHANNEL (cable television programming);\(^95\) 76% for AUTO CLUB (roadside service),\(^96\) and 81% for SWISS ARMY (pocketknives).\(^97\) When the results for a Teflon Survey are a "statistical tie," the survey may still be credited with showing that a "substantial part" of the relevant purchasing public views the word as a trademark.\(^98\)

Conversely, an appropriately designed and executed Teflon Survey in which a majority of the respondents identifies a mark as a common name may raise a reasonable inference that the mark

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\(^91\) McCarthy contends that, in a trademark dispute involving the issue of genericness, "majority usage of the word is controlling" (*McCarthy*, supra note 3, § 12:06). However, consistent with the test applied by Judge Learned Hand in *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921), a Teflon Survey measures consumer “understanding” (rather than usage). Generally speaking, assuming a Teflon Survey is not flawed “majority understanding” is controlling.

\(^92\) UGG Holdings, Inc. v. Severn, 2005 WL 5887187, at *5 (C.D. Cal. Feb. 23, 2005) (“The data collected by Jay demonstrate that that (sic) ‘58% of all survey respondents thought UGG was a brand name, whereas only 11% thought UGG was a common name . . .’.”).

\(^93\) *Ty, Inc. v. Softbelly’s, Inc.*, 353 F.3d 528, 530-31 (7th Cir. 2003).

\(^94\) *March Madness*, 310 F. Supp. 2d at 803-804 (“Of the 150 who associated March madness with basketball, 98 (61.3%) (sic) stated that it was a trade name . . .”). Following a bench trial, the court credited plaintiff's survey with showing that the primary significance of MARCH MADNESS was as a trade name. However, earlier the same court (in denying cross-motions for summary judgment) did not find the survey evidence dispositive (162 F. Supp. 2d 560, 572 (N.D. Tex. 2001)). Note, even though 98 out of 150 respondents is 65.3%, the 61% figure is mentioned in both court opinions.

\(^95\) *SportsChannel Assocs. v. Comm’r of Patents and Trademarks*, 903 F. Supp. 418, 426 (E.D.N.Y. 1995) (“As discussed above, this evidence consists of the Simonson Survey, which demonstrated that 65.3% of those polled considered ‘SportsChannel’ a trade name as opposed to 24.3% who perceived [it] as a common name, with 10.4% unsure . . .”).


\(^97\) *Arrow Trading Co., Inc. v. Victorinox A.G. and Wenger, S.A.*, 2003 WL 21509858, at *15 (T.T.A.B. June 27, 2003) (“The survey showing an 81% public recognition rate of SWISS ARMY (the mark applied for herein) as a brand designation is probative evidence that the term is not a generic name for pocketknives.”).

lacks trademark significance or be credited with showing that the mark is generic (or merely descriptive).\footnote{J & J Snack Foods Corp. v. Nestlé USA, Inc., 149 F. Supp. 2d 136, 153 (D.N.J. 2001).


The questions in a Teflon Survey are closed-ended and do not require coding of verbatim responses. Therefore, the analysis of a Teflon Survey would appear to be relatively straightforward. Nevertheless, the interpretation of a Teflon Survey may vary depending on whether the results are calculated based on all survey respondents or a subset of survey respondents, such as only those respondents who meet certain criteria or only those who express an opinion.\footnote{In March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc. (310 F. Supp. 2d 786, 803-04 (N.D. Tex. 2003)), the plaintiff submitted a Teflon Survey in support of its argument that MARCH MADNESS was not generic for basketball tournaments occurring in March. Of the 215 persons who initially qualified for the survey, 150 associated MARCH MADNESS with basketball. Of the 150 who associated MARCH MADNESS with basketball, 98 (over 60\%) stated it was a trade name. The 98 persons who stated MARCH MADNESS was a trade name represented only 46\% of the 215 persons who initially qualified for the survey. Nevertheless, the court found that only the responses of those persons who associated MARCH MADNESS with basketball were relevant.} A Teflon Survey may be accorded little weight when there is more than one colorable interpretation depending on how the data are analyzed. A survey that combined “both” responses with “generic name” responses was accorded little weight for this reason.\footnote{Transfer Print Foils, Inc. v. Transfer Print Am., Inc., 720 F. Supp. 425, 433 (D.N.J. 1989) (“Fourth, the interpretation Coopers & Lybrand has given to the statistical results is not the only viable one that exists. Specifically, rather than combining the responses of those who considered the phrase both generic and a trade name with those who view it only as generic, one could combine the responses of those in the former group with those who identified the phrase as only a trade name and conclude that more than half those surveyed identified the phrase at least as a trade name. * * * For all of these reasons, I find that the conclusions of the survey are not entitled to great weight.”.)}
VI. ALTERNATIVES TO THE THERMOS AND TEFLON FORMATS

Other survey formats besides those endorsed in American Thermos and E. I. Du Pont de Nemours have been tendered in genericness disputes, with mixed success. As discussed below, these include (a) surveys that measure whether respondents have heard of a mark in a particular context (“consumer recognition surveys”), (b) surveys that ask respondents whether permission or approval was or must be obtained to use a mark (“approval or permission surveys”), (c) surveys that gauge whether respondents associate a mark with products from a particular source (“brand or company association surveys”), and (d) surveys that inquire what consumers understand a mark to mean (“statement of meaning surveys”). Consumer motivation surveys, which ask consumers why they would purchase a particular product, are of historical interest only, as this test was discredited with the passage of the Trademark Clarification Act of 1984.106

A. Consumer Recognition Surveys

Surveys that merely quiz respondents about whether they have heard of a mark in connection with a particular product or service generally have failed to establish trademark significance. Although such surveys may demonstrate widespread consumer awareness of a mark, such as KISSES for chocolate candy,107 WINDOWS for computer operating systems108 and MEMORY for board games,109 they do not address the main issue in a genericness dispute: whether the relevant consuming public recognizes a mark as a brand name or a common name. As the

106. Supra note 2.

107. Hershey Foods Corp. v. Cerreta, 195 U.S.P.Q. 246, 255-256 (T.T.A.B. 1977) (“According to the analysis of the survey, 76% of the entire sample related the word ‘KISSES’ specifically to opposer or to a unique product of opposer . . .* * * The fact that a segment of the respondents associate the term ‘KISSES’ with opposer is understandable in that opposer is the largest distributor and seller of chocolate ‘KISSES’, but this alone cannot establish purchaser recognition thereof as a trademark . . .

108. Microsoft Corp. v. Lindows.com, Inc., 2002 WL 31499324, at *13 (W.D. Wash. Mar. 15, 2002) (unpublished) (“The final survey mentioned in the Oglesby Declaration was also conducted by Landor Associates in 2001 and showed that ‘in the United States, almost 80% of the general public is aware of the Window (sic) brand [citation omitted]. As discussed in Stuhlbarg, such ‘consumer awareness’ surveys merely “beg[ ] the question.”

109. Hasbro, Inc. v. MGA Entmt, Inc., 497 F. Supp. 2d 337, 345 at n.8 (D.R.I. 2007) (“For example, a recently completed study by Hasbro showed that 70% of target purchasers, comprised of mothers with children ages 3-5, were aware of Hasbro’s ‘Memory’ brand game and 34% owned it. * * * But, it has been made clear that such evidence is not dispositive on the question of genericness; rather, it is merely one of several factors that may be considered.”).
U.S. Court of Appeals for the Ninth Circuit put it, “Simply asserting consumer awareness of the term begs the question.”

### B. Source Identification and Brand Association Surveys

Brand association and source identification questions may help establish acquired distinctiveness or secondary meaning for a mark. However, according to Professor J. Thomas McCarthy, “Secondary meaning’ is out of place in a genericness enquiry,” and “Secondary meaning’ is not synonymous with ‘trademark significance,’ especially in cases where genericness is the issue.”

As one court opined, “[T]he type of survey used to test for genericness differs from the type of survey used to test for distinctiveness.”

110. Stuhlbarg Intern. Sales Co., Inc. v. John D. Brush and Co., Inc., 240 F.3d 832, 840 (9th Cir. 2001) (“Here, the district court noted that the survey excerpts do not indicate whether the consumers were asked to identify the term ‘firesafe’ as a brand name or a common name, a critical issue in a case involving genericness. Simply asserting consumer awareness of the term begs the question.”).

111. 2 McCarthy, supra note 3, § 12:46; see also Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111, 118 (1938) (“It is contended that plaintiff has the exclusive right to the name ‘Shredded Wheat’, because those words acquired the ‘secondary meaning’ of shredded wheat made at Niagara Falls by the plaintiff's predecessor. There is no basis for applying the doctrine of secondary meaning.”); America Online, Inc. v. AT&T Corp., 243 F.3d 812, 822 (4th Cir. 2001) (“At this summary judgment stage of the proceedings, we must accept AOL's assertion that a portion of the public associates ‘You Have Mail’ with AOL, the most widespread user of the phrase. But this fact does not reveal that the primary significance of the term ‘You Have Mail’ to announce the arrival of new e-mail is not the functional, heartland usage of the phrase. * * * AOL's evidence of association may establish what is called ’de facto secondary meaning,’ but such secondary meaning does not entitle AOL to exclude others from a functional use of the words.”). Palladino (supra note 5, at 858) suggests that secondary meaning surveys should be relevant in multiple product situations as opposed to unique product situations (“This notion that secondary meaning and genericness are opposite sides of the same coin finds support in the law. On the other hand, the de facto secondary meaning doctrine rejects this view. These conflicting views can be reconciled by applying the opposite sides of the same coin approach in multiple product situations and limiting the de facto secondary meaning doctrine to unique product situations.”).

112. Big Island Candies, Inc. v. The Cookie Corner, 269 F. Supp. 2d 1236, 1251 (D. Haw. 2003); see also Yoo-Hoo Chocolate Beverage Corp. v. A.J. Canfield Co., 229 U.S.P.Q. 653 (D.N.J. 1986) (unpublished) (“As such, that survey shows only that due to the long period in which Canfield was the only manufacturer, many people have come to associate the product, and as a consequence, the name by which the product is generally known with Canfield. If Canfield’s position were correct, the first manufacturer of any soda would obtain exclusive rights, no matter how commonplace the description.”). In Miller Brewing Co. v. G. Heileman Brewing Co., Inc. (561 F.2d 75, 77 (7th Cir. 1977)), the Seventh Circuit held that LIGHT including its phonetic equivalent LITE was a generic or common descriptive term as applied to beer. In so doing, it disregarded a survey that found a substantial percentage (55%) of beer drinkers perceived LITE, Miller LITE or LITE from or by Miller as a distinct brand name indicative of a low-calorie or less-filling beer due to Miller's advertising.
Surveys that ask consumers the following types of questions have been ineffective to prove trademark significance in some, but not all, genericness disputes: “Who makes this product?” and “What company or companies do you associate with this name?” This is because even if a large percentage of consumers identifies the source of a product, or associates a mark with a company (e.g., such as YO-YO with Duncan113), these consumers may not recognize the mark as a brand name.

Although secondary meaning surveys may not prove dispositive in a genericness controversy, the following “source identification” and “brand association” surveys supported nongenericness findings, or created a material issue of fact as to whether the challenged names were generic:

- A survey in which 57% of Atlantic City gamblers associated palace with Caesars casino,114
- A survey in which 60% of persons who listen to country music associated 1-800-THE-OPRY with the Grand Ole Opry in Nashville,115
- A survey in which 86% of real estate agents believed realtor referred only to real estate agents who were members of the

113. Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., Inc., 343 F.2d 655, 665-666 (7th Cir. 1965) (“Without analyzing the result of this survey in detail, we think it sufficient to note that the composite result indicates that a total of 630 out of 1,445 interviewed (43%) associated the trademark ‘Yo-Yo’ with plaintiff. * * * [I]n our judgment, the evidence was immaterial and irrelevant to the main issue, that is whether the generic and descriptive name of the toy was to the public ‘Yo-Yo’ (or ‘yo-yo’) or ‘return top.’”). The plaintiff’s survey read a list of names (including “Yo-Yo”), and then asked “What company do you think of as I mention each of these names?” After discrediting the plaintiff’s survey, the Seventh Circuit opined that different survey questions (similar to those in a Thermos Survey) may have been dispositive (“If plaintiff really desired to ascertain from a survey what the interviewees (members of the public) called or described the toy, we think questions could have been framed to obtain that result. For instance, the interviewees could have been shown an unmarked and unidentified toy and asked, ‘By what name do you call or know this toy?’ Or, ‘Do you know this toy as a Yo-Yo or a return top?’ Answers to these simple questions in all probability would have been decisive of the issue for decision.”).

114. Trump v. Caesars World, Inc., 645 F. Supp. 1015, 1021 (D.N.J. 1986) (“Although Trump attacked the methodology and conclusions of Caesars’ surveys, I find these attacks unpersuasive and find that the surveys are a good measure of the significance of the marks ‘Caesars Palace’ and ‘The Palace’ in the minds of the gambling consumer in Atlantic City and elsewhere.”), aff’d, 819 F.2d 1135 (3d Cir. 1987).

115. Gaylord Entm’t Co. v. Gilmore Entm’t Group, LLC, 187 F. Supp. 2d 926, 934-944 (M.D. Tenn. 2001) (“Within the population of respondents who listen to country music, the relevant market, 60% associated 1-800-THE OPry with a particular company, specifically the Grand Ole Opry in Nashville, TN. * * * Gaylord has produced a significant amount of evidence that tends to establish the primary meaning of ‘Opry’ to the relevant public (of individuals interested in country and western music) is as a trade name associated with the Grand Ole Opry and Gaylord.”).
national association of realtors or one of its affiliates (rather than all real estate agents).\textsuperscript{116}

- A survey in which 100\% of the persons who were aware of HONEY BAKED HAM also said they could purchase these hams from only one source.\textsuperscript{117}

On the other hand, the inability of beer consumers to identify the source of ICE BEER in a survey supported the U.S. Court of Appeals for the Eighth Circuit finding that it was reasonable for a jury to conclude that ICE was and always had been a beer category.\textsuperscript{118}

Other “source identification” and “brand association” surveys have been rejected (or disregarded) in cases where genericness was an issue because the questions were confusing or inappropriately worded. For example, a survey that sought to determine whether respondents identified WING DINGS (chicken wings) with a single source was accorded no weight in a genericness dispute because the critical question was worded in the following confusing and leading manner: “Are Wing-Dings like onion rings which are made by many different places or like Haagen-Dazs which is made by one particular manufacturer?”\textsuperscript{119} Two surveys that asked

\begin{itemize}
  \item Jacob Zimmerman v. Nat'l Ass'n of Realtors, 2004 WL 763936, at *13 (T.T.A.B. Mar. 31, 2004) (“For the question of primary interest, 86.3\% of the survey subjects believed that the term REALTOR refers only to real estate agents who are members of NAR or one of its local or state associations, while 6.4\% believed that the term REALTOR refers to all real estate agents. * * * We find that the results of this survey demonstrate rather convincingly that among real estate professionals, the ‘Realtor’ marks are perceived as strong source indicators.”).
  
  \item Schmidt v. Quigg, 609 F. Supp. 227, 230 (E.D. Mich. 1985) (“More important, all (100\%) those who were aware of ‘Honey Baked Ham’ were also aware that these hams could only be purchased at a Honey Baked Ham Company store. This statistic strongly supports the conclusion that ‘Honey Baked Ham’ is not a generic term. Not one person questioned responded that ‘Honey Baked Ham’ is available at any location other than a Honey Baked Ham Company store or that it could be prepared at home, which could be reasonably expected if the term were generic.”).
  
  \item Anheuser-Busch, Inc. v. John Labatt Ltd., 89 F.3d 1339, 1346 (8th Cir. 1996) (“Additionally, Labatt’s own June 1994 consumer survey ‘showed that consumers had no clear understanding of ICE BEER’S meaning or of its source [citation omitted]. In these circumstances, a reasonable jury easily could conclude that the ice terms were not suggestive and never served to identify a particular source or a product in the minds of consumers. Moreover, a jury could conclude that ice was and always had been the name of a beer category.”).
  
  \item Pierce Foods, Inc. v. Tyson Foods, Inc., 231 U.S.P.Q. 287 (D.N.J. 1986) (unpublished) (“Perhaps I am making a dangerous confession, but on first reading I find this question to be incomprehensible and I would be totally unprepared to check ‘onion rings’ or ‘Haagen-Dazs’ until I made a few diagrams so as to align the different places and manufacturers which are producing onion rings and ice cream and so as to align the many different restaurants with the particular ice cream or onion ring which is made by only one particular manufacturer and with the ice cream or onion ring which is made by different places or manufacturers using their own recipe. So when this question was read to an
respondents whether they “most often” identified STEAKBURGER as something that comes from more than one company, or something that comes from only one company, were disregarded in a genericness dispute; for the inclusion of “most often” in the questions rendered these surveys nothing more than measures of consumer familiarity.\textsuperscript{120}

\textbf{C. Permission or Approval Surveys}

Permission or approval questions, similar to those sometimes included in likelihood-of-confusion surveys, have not been used successfully to establish trademark significance (or the lack of it) in a genericness dispute. A survey asking whether a number of physical conditioning or fitness methods, including PILATES, “may be used and promoted by trainers without having to obtain any company’s authorization, permission or certification” was disregarded because it was based on a faulty premise that a method of exercise can be someone’s proprietary property.\textsuperscript{121} The same survey asked the following question, which was found to be leading, “May any company that makes the Reformer put the Pilates name on the equipment or promote the fact that the company makes the Pilates Reformer, or may only those companies that are authorized to do so put the Pilates name on the equipment and promote the fact that the company makes the Pilates Reformer?”\textsuperscript{122}

\textbf{D. Statement of Meaning Surveys}

Surveys that quiz respondents about what, if anything, a mark means to them have shed light on the principal issues in genericness disputes. Such surveys have helped establish some names as generic, such as GLOBALAW for a type of law\textsuperscript{123} and LA

\textsuperscript{120} Steak 'n Shake Co. v. Burger King Corp., 323 F. Supp. 2d 983, 993 (E.D. Mo. 2004) (“I do not agree with Steak n Shake's argument that the Jacoby and McCullough surveys show the non-genericness of the term 'steakburger.'

\textsuperscript{121} Pilates, Inc. v. Current Concepts, Inc., 120 F. Supp. 2d 286, 304 (S.D.N.Y. 2000) (“Since plaintiff concedes that a method of exercise cannot be trademarked, it is clear by Epstein's own admission that his survey is fundamentally flawed since it assumes that a method of exercise can be someone's exclusive property. This is confirmed by the fact that 29% of those surveyed responded that the generic term 'karate' could not be used without authorization and 25% said the same thing about the generic term 'yoga.'

\textsuperscript{122} Id. (“[S]o too is the value of Epstein's equipment question reduced because the question itself suggests the answer.”

for low alcohol beer;\textsuperscript{124} and others as nongeneric, such as BEANIES for a plush toy from Ty, Inc.\textsuperscript{125} However, a survey that asked, “What is Darjeeling Tea?” failed to establish that the public as a whole did not understand that DARJEELING TEA comes only from the Darjeeling region of India, and that there was no association in the public’s mind between DARJEELING as applied to tea and any specific geographic region.\textsuperscript{126}

\textbf{E. Consumer Motivation Surveys}

In \textit{Anti-Monopoly}, the U.S. Court of Appeals for the Ninth Circuit adopted the consumer motivation test in arriving at the conclusion that MONOPOLY was a generic name for Parker Brothers’ famous real estate board game.\textsuperscript{127} It credited a survey

\textsuperscript{124.} In \textit{G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.} (676 F. Supp. 1436, 1487-48 (E.D. Wis. 1987), Miller proffered a survey by Henry Ostberg in which respondents were shown photographs of cans and bottles for Budweiser, Schlitz, Miller High Life, and “LA from Anheuser-Bush.” Respondents familiar with LA beer were asked what LA on the Anheuser-Bush can and bottle meant. Over half (52%) said the meaning of LA was low or light alcohol. The court opined that the Ostberg survey “does not indicate whether consumers think of LA or low alcohol as a type of beer.” Nevertheless, it credited the Ostberg survey with showing “that a majority of consumers, who by June had been exposed to advertising and sales of LA, recognized that LA stands for low alcohol.”

\textsuperscript{125.} Ty, Inc. v. Softbelly’s, Inc., 353 F.3d 528, 530-31 (7th Cir. 2003) (“In a phone survey conducted in 1999, more than 60 percent of the respondents identified ‘Beanies’ as relating to Ty or Beanie Babies.”). In \textit{Ty}, the District Court also credited this author’s survey in granting plaintiff’s motion for a preliminary injunction (2001 WL 125321, at *3) (“Consumer surveys show . . . that 70% of consumers tested thought that the word ‘beanies’ and ‘beanie’ either meant BEANIE BABIES® or Ty, or referred to a toy made or put out by BEANIE BABIES® or Ty.”).

\textsuperscript{126.} Tea Bd. of India v. The Republic of Tea, Inc., 80 U.S.P.Q.2d 881 (T.T.A.B. July 30, 2006) (“Simply put, applicant’s survey fails to either show or support an inference that the primary significance of DARJEELING is generic.”).

\textsuperscript{127.} Anti-Monopoly, Inc. v. Gen’l Mills Fun Group, Inc., 684 F.2d 1316, 1325 (9th Cir. 1982) (“The district court’s major objection to the survey was that it sought an explanation of an actual purchaser’s motivation in purchasing the game rather than the primary significance of the word [citation omitted]. This objection cannot stand. In our earlier
that asked consumers why they would buy MONOPOLY. In response to this question, almost two-thirds of respondents said they were motivated to buy MONOPOLY because they were interested in playing the game; whereas only one-third said they would buy the game because they liked Parker Brothers’ products. Two years after the controversial decision in *Anti-Monopoly*, the U.S. Congress legislatively overruled the Ninth Circuit by amending the U.S. Trademark (Lanham) Act.\textsuperscript{128} The Trademark Clarification Act of 1984 explicitly stated that the primary significance of the registered mark \textit{rather than purchaser motivation} shall be the test for determining whether the registered mark has become generic.\textsuperscript{129}

\section*{VII. OTHER SURVEY DESIGN AND IMPLEMENTATION ISSUES}

Designing and implementing a genericness survey involves myriad considerations apart from selection of a questionnaire format and question wording, as discussed below.

\subsection*{A. The Role of Experts and Attorneys in Surveys}

For surveys to be admissible, the experts rather than the attorneys should be primarily responsible for formulating and implementing surveys proffered in trademark disputes over genericness.\textsuperscript{130} The survey expert should not abdicate opinion we made it clear that what was relevant was the sense in which a purchaser used the word ‘Monopoly’ when asking for the game by that name. The survey was a reasonable effort to find that out and was modeled closely on what we said in our opinion.”).

\textsuperscript{128} For a discussion of trademark surveys in light of the 1984 amendments, see Vincent N. Palladino, *Genericness and the Trademark Clarification Act of 1984: Five Years Later*, 79 TMR 657 (1989) [Palladino, Trademark Clarification Act]. Twenty years ago, Samuel Oddi \textit{(in Assessing “Genericness”: Another View}, 78 TMR 560, 561 and 571 (1988)) mistakenly suggested that the 1984 amendments rendered a Thermos Survey irrelevant in a genericness dispute. Based on his interpretation of the 1984 amendments, Oddi also proposed the following reformulation of the Teflon Survey question: “What is the primary significance of [trademarked name] to you? (a) The name of a product from a single source or (b) The name of a product.” In this author’s view, Oddi’s suggested Teflon question suffers from numerous defects (e.g., by asking about “primary significance,” the question appears to be seeking a legal conclusion; the response categories are not mutually exclusive and they do not properly distinguish between brand names and common names). Further, this author is unaware of any trademark dispute in which such a question has been used to test for genericness (either successfully or unsuccessfully).

\textsuperscript{129} \textit{Supra} note 2.

\textsuperscript{130} FJC, Manual for Complex Litigation § 11.493 (“Laying the foundation for such evidence will ordinarily involve expert testimony . . .”); Diamond, \textit{supra} note 12, at 237-38 (“[T]he attorney should have no part in carrying out the survey. However, some attorney involvement in the survey design is necessary to ensure that relevant questions are directed
responsibility for the design, conduct or analysis of such surveys.\textsuperscript{131} Nevertheless, attorneys may provide the survey expert with background information regarding the product context in which a disputed mark is used, and the relevant consuming public for those goods or services.\textsuperscript{132}

**B. Universe Selection and Sample Size**

A survey “universe” is the population from which a sample of respondents is drawn, and with whom interviews are conducted. For a genericness survey, the proper universe is the relevant consuming public or those persons likely to rely on the challenged mark in making purchase decisions.\textsuperscript{133} The universe for the survey endorsed in *American Thermos* and in *E. I. Du Pont de Nemours* was broadly defined. The favored survey in *American Thermos* was conducted with adults in the United States who were “familiar with containers that keep the contents hot or cold,”\textsuperscript{134} whereas the universe for the preferred survey in *E. I. Du Pont de Nemours* was the public at large (i.e., adults over age 18).\textsuperscript{135} However, unless a product or service is marketed to the general public, the appropriate universe for a genericness survey should be limited to to a relevant population.”). The Board disregarded a survey in *Buell Motorcycle Co. v. Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)* (2003 WL 21796056, at *9 (T.T.A.B. July 30, 2003)) in part because of the survey expert’s discussions with opposer’s attorneys and the marketing director of opposer’s parent corporation; in *Hershey Foods Corp. v. Cerreta* (195 U.S.P.Q 246, 256 (T.T.A.B. 1977)), the Board questioned the objectivity of a survey because it was designed by one of opposer’s officers.

131. In *Heileman* (676 F. Supp. at 1485), one of Anheuser-Busch’s surveys was accorded little weight for this reason, among others (“Wind’s own testimony established that he exercised little supervision over the collection or interpretation of data for either survey.”).

132. Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292, 1296-97 (N.D. Cal. 1991) (“I find it difficult to criticize survey managers on either side of this case who do not use independent judgment in defining the purpose and target group of a litigation survey. Unlike a marketing survey, usually in the hands of advertising agencies or marketing specialists, the context of litigation surveys to a large extent must necessarily be directed by lawyers who are familiar with the litigation at hand. There has been extensive lawyer participation on both sides in this case.”).

133. Bayer Co., Inc. v. United Drug Co., 272 F. 505, 510 (S.D.N.Y. 1921) (“The crux of the controversy, however, lies not in the use of the word to those buyers, but to the general consuming public composed of all sorts of buyers from those somewhat acquainted with pharmaceutical terms to those who knew nothing of them.”); Magic Wand, Inc. v. RDB Inc., 940 F.2d 638, 640 (Fed. Cir. 1991) (“The 1984 amendment makes the understanding of the ‘relevant public’ central to the genericness inquiry. By the words ‘relevant public’ for a product sold in the marketplace, the Clarification Act means the relevant public which does or may purchase the goods or services in the marketplace.”); Berner Int’l Corp. v. Mars Sales Co., 987 F.2d 975, 982 (3d Cir. 1993) (“It is the relevant consumers, not the courts, who determine whether the term signifies the genus of ‘air barriers.’”).


buyers and potential buyers of the goods and services for which the challenged mark is used. For example, the survey credited in *Intel* about the 386 mark (microprocessors) queried persons in charge of purchasing microprocessor components for inclusion in equipment manufactured by their OEM companies.136 The survey approved in *In re Callaway* about STEELHEAD (golf clubs) interviewed subscribers to *Golf Digest* magazine who had played one or more rounds of golf during the year prior to the survey,137 and the survey accepted in *Arrow Trading* about SWISS ARMY (pocketknives) was conducted with adults who intended to purchase a pocketknife in the next six months.138

Because opposing parties in genericness cases often use the disputed mark in connection with similar goods or services, the choice of the universe would appear to be relatively straightforward. However, as with other types of surveys in trademark disputes, the choice of the universe may become a bone of contention, especially if there is more than one consuming public (e.g., both professionals and the general public).139 The chosen universe for a genericness survey may be found to be irrelevant.140

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137. *In re Callaway Golf. Co.*, 2001 WL 902004, at *3 (T.T.A.B. Aug. 9, 2001) (“The survey was conducted among a random sample of individuals who subscribe to the publication *Golf Digest* and who had played one or more rounds of golf during the year prior to the survey.”).


139. 2 *McCarthy*, supra note 3, § 12:04 (“For ordinary consumer goods such as beer, it is a term’s meaning to consumers, not to professionals in the trade, that is the test of genericness and descriptiveness.** ** For goods and services rendered to both professionals and consumers, difficult issues arise . . .”). In *Globalaw Ltd. v. Carmon & Carmon Law Office* (452 F. Supp. 2d 1, 35 (D.D.C. 2006)), counterclaim defendants’ GLOBALAW Recognition Survey (conducted by Ridgway) randomly selected lawyers who practiced international law from the Martindale-Hubbell Law Directory. Carmon & Carmon (C&C) claimed the survey was “fatally defective” because it surveyed the wrong universe. C&C argued that the “purchasing public” (persons looking for legal counsel) should have been surveyed rather than international lawyers (a group with different sophistication, training and interests than clients looking for legal counsel). The court rejected this argument (“Upon an examination, it is clear that Ridgway’s universe was correct, even if slanted to search out those who might have heard of C&C and its ‘GLOBALAW’ imprimatur. Clients and lawyers often rely on referrals from other lawyers when selecting firms that will be employed to provide legal services. As such, the lawyer who is aware of international legal issues is one who is more likely to be consulted for a referral on the subject and will be the one who influences the purchase of legal services, which is the very point of Counterclaim Defendants’ ‘GLOBALAW Limited’ network.”).

140. *Intel* (756 F. Supp. at 1297) involved a dispute over whether the number “386” was generic for a family of microprocessors or was a brand name for a microprocessor from Intel. The court disregarded the surveys conducted by Intel because the samples consisted of “end
or merely underinclusive or overinclusive. A genericness survey that samples from an irrelevant universe, or that includes an “arbitrary subset of consumers,” will have no probative value. However, the universe for a genericness survey does not have to be “ideal” or “perfect.” If the universe for a genericness survey is underinclusive, the survey may still be probative if it includes “a significant subgroup of relevant consumers.” Likewise, an overly broad universe may not cause a survey to be disregarded if there is no evidence that a narrower universe would have yielded different results. Under other circumstances, however, genericness

users” (i.e., persons who were users of personal computers which contained as a component part a 386 microprocessor who worked in a business environment and/or MIS managers or data processing managers within businesses which utilized personal computers). The court reasoned that microprocessors were rarely or never sold to end users of personal computers. Rather, they were sold to OEMs who incorporate them into the construction of personal computers and other products which are in turn sold to end users. For this reason, the court found that the only relevant survey was the one commissioned by defendants (“The Walker Survey is an important piece of evidence because it was concerned with OEMs, the group that I have found to constitute the relevant market. It is the only survey evidence which is directed at that group. Plaintiff has not undertaken a survey of the OEM market. I find that the Walker Survey was competently conducted, taken of a sample of the relevant market, is projectable and is uncontradicted.”).

141. The source (or list) from which a sample is chosen to represent a particular population (known as a “sampling frame”) also may be criticized as underinclusive or overinclusive; see Diamond, supra note 12, at 241 ("More commonly, however, the sampling frame is either underinclusive or overinclusive relative to the target population.").

142. Ty, 353 F.3d at 531 ("[T]he survey was worthless- 13- to 18-year-old girls being an arbitrary subset of consumers of beanbag stuffed animals").

143. Pilates, 120 F. Supp. 2d at 303 ("Plaintiff’s objections to Rappeport’s survey universe reduce the survey’s usefulness to some extent. It is undisputed that Pilates exercise instruction and equipment are increasingly being marketed to the general public. An ideal survey universe would include all potential purchasers of Pilates equipment or exercise instruction services, not just professionals who are members of IDEA. However, the IDEA universe was adequate for the survey to have some weight in the genericness inquiry.").

144. In re Callaway, 2001 WL 902004, at *3 n.4 (T.T.A.B. Aug. 9, 2001) ("Having said this, we would add the often repeated observation that ‘no survey is perfect.’ Indeed, one might view the survey universe here to be inappropriately limited to individuals more likely to have been heavily exposed to applicant’s advertising.").


146. Windsurfing Int’l, Inc. v. Fred Ostermann GMBH, 613 F. Supp. 933, 959 (S.D.N.Y. 1985) ("Moreover, WSI offered no evidence to rebut Dr. Zeisel’s opinion that a survey limited to a coastal population would most likely not yield different results than those reached here."); Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 576 (D.N.J. 1985) ("Plaintiffs contend that the survey was based on both a too broad and a too narrow universe. * * * Consumers were still interviewed on enough of a random basis to be representative . . .").
surveys that sample from an underinclusive universe, or an overinclusive universe may be entitled to little or no weight. Flaws in the genericness survey universe are more apt to affect the probative value of the survey than its admissibility.

Other things being equal, surveys having larger sample sizes may prove more reliable. The genericness surveys endorsed in American Thermos and E. I. Du Pont de Nemours included relatively large samples (3,300 and 1,031 respondents, respectively). The number of qualified respondents ranged from 110 to 694 in surveys accepted in controversies concerning the following marks: 110 for VIRUS SCAN (anti-virus software); 150 for MARCH MADNESS (basketball tournaments); 200 for

147. BellSouth Corp. v. DataNational Corp., 60 F.3d 1565, 1571 (Fed. Cir. 1995) (“The survey evidence might raise a genuine fact issue were the surveys not limited to BellSouth’s claimed territory.”); Transfer Print Foils, Inc. v. Transfer Print Am., Inc., 720 F. Supp. 425, 432-33 (D.N.J. 1989) (“First, most of the 401 respondents polled were selected from defendant’s customer/mailing lists, which has 1,737 entries. Mr. Bier acknowledged on both days that he would have preferred a more representative sampling which included a list of plaintiff’s customers. * * * I find that the survey sample was not as representative as it could have been.”); Microsoft Corp. v. Lindows.com, Inc., 2002 WL 31499324, at *9 n.4 (W.D. Wash. Mar. 15, 2002) (“The Court’s selection of the relevant consuming public is broader than the sample population in the survey Microsoft submitted to the USPTO in 1993. There, the survey focused only on those individuals who had purchased computer software in the past twelve months or were likely to purchase software in the next three months.”).

148. G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436 (E.D. Wis. 1987), aff’d, 873 F.2d 985, 995 (7th Cir. 1989) (“We are persuaded by the view of the district court that Dr. Wind’s primary focus on a thoroughly uninformed consumer audience renders his conclusions highly suspect.”).

149. March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc., 162 F. Supp. 2d 560, 570 n.8 (N.D. Tex. 2003) (“Any other potential weaknesses with the composition of the survey group and the methodology employed, will go to the weight the trier of fact will give to his opinion and the survey at trial.”); Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc., 2007 WL 4563873, at *7 (N.D. Ga. July 17, 2007) (“The plaintiffs have provided little support indicating that a different ‘survey universe’ would have produced different results. The extent to which the ‘survey universe’ may be flawed in this particular case goes to the weight afforded the survey, and not its admissibility.”).

150. For probability samples, the maximum sampling error for an estimate (or margin of error) is inversely correlated with sample size. See, e.g., James W. Stoutenborough, Margin of Error in Encyclopedia of Survey Research Methods, 450-451 (Paul J. Lavrakas, ed., 2008) (“The margin of error (MOE) is a statistical concept that is most often associated with polls and pollsters. It serves to quantify the uncertainty associated with sampling in a poll or other survey. * * * As the equation indicates, the MOE is very much affected by the survey’s sample size.”).

151. 207 F. Supp. at 21 n.8 (“The key questions asked 3,300 interviewees . . .”).

152. As quoted in 2 McCarthy, supra note 3, § 12:16 (“[T]he [Teflon] survey was conducted of 514 men and 517 women on the evening of June 4, 1973, in 20 cities . . .”).


154. See March Madness, supra note 94.
PILATES (exercise);\textsuperscript{155} 200 for NITE LITES (outdoor illumination);\textsuperscript{156} 204 for REALTOR (real estate agents);\textsuperscript{157} 215 for SWISS ARMY KNIFE (pocketknives);\textsuperscript{158} 299 for PALACE (casinos);\textsuperscript{159} 313 for UGG (sheepskin boots);\textsuperscript{160} 320 for WINDSURFER (sailboards);\textsuperscript{161} 326 for STEELHEAD (golf clubs);\textsuperscript{162} 400 for 386 (microprocessors);\textsuperscript{163} 536 for LA (beer);\textsuperscript{164} and 694 for CONTACT (self-adhesive plastic products).\textsuperscript{165}

A sample of 96 individuals who had consulted a real estate agent or were likely to do so in the future was considered too small

\textsuperscript{155} Pilates, 120 F. Supp. 2d at 302 ("Of the 200 who were familiar with the word, no one provided a substitute word for Pilates. One-hundred-seventy-seven people responded that Pilates is the only word they use to describe the type of exercise. One-hundred sixty-seven people responded that Pilates is the only word they hear others use to describe the type of exercise.").

\textsuperscript{156} Nightlight Sys., 2007 WL 4563873, at *2 ("For example, only one in 200 interviewees (0.5\%) used the term 'nite lites' to describe a system of outside illumination in main question 1.").

\textsuperscript{157} Jacob Zimmerman v. Nat'l Assoc. of Realtors, 2004 WL 763936, at *12 (T.T.A.B. Mar. 31, 2004) ("Specifically, when asked whether 'Realtor' refers to all real estate agents or only those who are members of respondent or one of its local or state associations, 84.3\% of 204 individuals surveyed recognized this term as indicating members of respondent or one of its associations.").

\textsuperscript{158} Arrow Trading Co., Inc. v. Victorinox A.G. and Wenger, S.A., 2003 WL 21509858, at *14 (T.T.A.B. June 27, 2003) ("The findings were based on 215 respondent interviews which were completed and tabulated.").

\textsuperscript{159} Trump, 645 F. Supp. at 1020-21 ("The purpose of the first survey was to determine the meaning to consumers of the word 'palace.' 299 interviews were conducted with male and female heads of a household who were visiting Atlantic City and who made at least one other visit during the past year to any United States or foreign city that had legal gambling. * * * The second survey pointed to the same conclusions. Its objective was to determine the full name associated with 'Caesars' and three other casinos—Trump's, MGM and Bally's. 298 different persons of the same categories as those who participated in the first survey were interviewed.").

\textsuperscript{160} UGG Holdings, Inc. v. Severn, 2005 WL 5887187, at *5 (C.D. Cal. Feb. 23, 2005) ("Jay surveyed 313 women, ages 18 to 45, each of whom either had purchased a pair of boots or casual shoes (excluding athletic footwear) that cost $100 or more in the past 12 months or expected to do so in the next 12 months.").


\textsuperscript{162} In re Callaway Golf Co., 2001 WL 902004, at *3 (T.T.A.B. Aug. 9, 2001) ("The survey consisted of 326 telephone interviews.").

\textsuperscript{163} Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292, 1297 (N.D. Cal. 1991) ("The result of the survey was that of 400 total interviews 72\% of respondents stated that 386 is a generic description, 21\% of respondents stated that 386 is a brand name, and 7\% of respondents didn't know whether 386 is a generic description or a brand name.").

\textsuperscript{164} G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436, 1488 n.40 (E.D. Wis. 1987) ("When all 536 interviewees are considered, 50.2\% (269) stated that LA means low alcohol.").

\textsuperscript{165} Stix Products, supra note 26.
to be meaningful in a dispute over the mark REALTOR. However, a survey of 66 lawyers who specialize in international law was probative with respect to the primary significance of GLOBALAW, despite the small sample. 167 Although a smaller sample size may be viewed more favorably when the target population for the survey consists of relatively homogenous professionals, genericness surveys rarely survey fewer than 100 qualified respondents.

C. Data Collection Methods and Visual Stimuli

As with the survey favored in E. I. Du Pont de Nemours, genericness surveys often are conducted with probability samples over the telephone. 169 Genericness surveys also may be administered by professional interviewers in shopping malls to quota samples of relevant consumers. 170 However, a mail survey

166. Jacob Zimmerman, 2004 WL 763936, at *13 (“The final number of survey subjects (96) was too low to accord much weight to the study results.”).

167. Globalaw Ltd. v. Carmon & Carmon Law Office, 452 F. Supp. 2d 1, 33 (D.D.C. 2006) (“Of the sixty-six (66) lawyers that participated in the survey, only forty-seven (47) ascribed any meaning to the term ‘Globalaw.’”). In E.T. Browne (538 F.3d at 195-197) the survey asked 154 respondents the following questions: “What word or words would you use to identify or describe a skin care product which contains cocoa butter?” and “If you needed to identify or describe a skin care product containing cocoa butter, what word or words would you use instead of or in addition to just saying cocoa butter, if any?” However, only 46 of the 154 respondents answered this question with a “product class.” Nevertheless, the Third Circuit found the results for these 46 respondents to be probative.


170. Gaylord, 187 F. Supp. 2d at 934 (“Respondents were interviewed in three shopping malls in three states between the geographical sites of the litigants, with 210 total
was disregarded because respondents may have conducted research in their homes to determine whether the contested name was a trademark; and an Internet poll lacked “sufficient signs of reliability” because it did not prevent interested parties from voting multiple times to skew the results.\textsuperscript{171} Regardless of the data collection method, to ensure that respondents are neutral witnesses and minimize the potential for interviewer bias, properly conducted genericness surveys are double-blind (i.e., neither the interviewers nor the respondents are informed of the sponsor or the litigation purpose of the survey).\textsuperscript{172}

\textsuperscript{171} Du Pont Cellophane Co., Inc. v. Waxed Prods. Co., Inc., 6 F. Supp. 859 (E.D.N.Y. 1934), \textit{modified}, 85 F.2d 75, 80 (2d Cir. 1936) (“Moreover, as they were induced by flattering letters from the magazines and by offers of prizes in return for prompt replies, they might well have stimulated a search for a registered trademark that theretofore had been unknown. Such proofs have no great weight.”); \textit{In re Steelbuilding.com}, 415 F.3d 1293, 1300 (Fed. Cir. 2005) (“The poll did not prevent interested parties, such as friends or associates or even employees of the applicant, from voting multiple times to skew the results. In sum, this poll does not even remotely follow the precepts of standard trademark name-recognition polls.”).

\textsuperscript{172} Am. Thermos Prods. Co. v. Aladdin Indus., Inc., 207 F. Supp. 9, 21 (D. Conn. 1962) (“The court was particularly impressed with the high degree of credibility of the interviewers who testified, their conscientiousness in carrying out their duties and their complete lack of bias. They did not know the purpose of the survey as it related to the trial . . .”); March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 805 (N.D. Tex. 2003) (“The survey was a double-blind survey; neither the person administering the survey nor the person taking it knew what the survey was intended to demonstrate.”); \textit{Nightlight Sys.}, 2007 WL 4563873, at *1 (“Neither the interviewer nor the interviewees were told of the underlying purpose of the interview.”); \textit{Jacob Zimmerman}, 2004 WL 763936, at *13 (“Dr. Ross determined that the relevant universe for this ‘double-blind’ survey was . . .”).
The surveys advanced in *American Thermos*\textsuperscript{173} and *E. I. Du Pont de Nemours*\textsuperscript{174} did not show respondents anything. With a few notable exceptions, other surveys in genericness disputes have not used visual stimuli either. Nevertheless, visual stimuli may be appropriate in a genericness dispute. Respondents may be shown a card with the challenged mark\textsuperscript{175} or be shown products or photographs of products. For example, a Thermos Survey that supported a finding of nongenericness for the mark SOFTSOAP showed respondents a picture of unmarked containers with a pump-type dispenser. Survey respondents were told, “People primarily use this type of product to wash their hands,”\textsuperscript{176} and then respondents were asked to tell the interviewer the “common name or names” and the “brand name or names” for the type of product shown in the picture. Visual displays were used in surveys conducted in connection with a dispute over LA as applied to beer.\textsuperscript{177} In two of the LA surveys, respondents were shown photographs or displays of beer bottles and cans and then were asked what they understood LA on these items to mean. The surveys were credited with demonstrating that a majority of prospective consumers recognized that LA as applied to beer stands for and describes low alcohol.

Although visual stimuli may be used, the choice of stimuli may be improper and cause a genericness survey to be accorded little or no weight. For example, Yoo-Hoo introduced a survey to support

\textsuperscript{173} 207 F. Supp. at 20-22.
\textsuperscript{175} *Globalaw,* 452 F. Supp. 2d at 33 (“As part of the survey, the lawyers questioned were shown the term GLOBALAW, and then asked questions relating to what it meant to them.”); *Trump,* 645 F. Supp. at 1021 (“After being shown a card containing the word ‘Caesars’ and asked to complete the name of that casino hotel, 56.7 percent replied ‘Palace.’”).
\textsuperscript{177} G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436 (E.D. Wis. 1987).
its argument that CHOCOLATE FUDGE was generic for a soda flavor.\textsuperscript{178} Survey respondents were shown six soft drink cans, CANFIELD’S CHOCOLATE FUDGE SODA, YOO-HOO’S CHOCOLATE FUDGE SODA, PEPSI COLA, COCA COLA, CANADA DRY GINGER ALE, and SHASTA ORANGE. Interviewers then asked respondents how many different soda flavors were included in the display, and to name them. Survey respondents also were asked how many different producers or manufacturers were represented, and whether any of them were related. The U.S. District Court found the survey corroborated other evidence that demonstrated that CHOCOLATE FUDGE was descriptive of taste when used in connection with soda. However, it did not accord the survey much weight because it believed the cans “conveyed a differentiation which the test was designed to detect.”

In another case, Big Island Candies proffered a survey in support of its argument that the trade dress for its chocolate-dipped shortbread cookie was not generic.\textsuperscript{179} Oahu residents were shown a picture of the cookie. They then were asked if they had seen the cookie before, and if so, they were asked, “Who makes this product?” The U.S. District Court criticized the survey, not only because the questions were not relevant to a genericness determination, but also because the cookie in the photograph was wrapped in cellophane printed with “Big Island Candies.”

\section*{D. Survey Reporting}

The report concerning a genericness survey should provide information enabling replication of the study and its results.\textsuperscript{180} A genericness survey will be accorded little weight if the expert report inadequately describes the survey sample, questions, data collection methods, analyses, or findings.\textsuperscript{181} Although marketing

\begin{footnotes}
\textsuperscript{178} Yoo-Hoo Chocolate Beverage Corp. v. A.J. Canfield Co., 229 U.S.P.Q. 653, 659 (D.N.J. 1986) (“The Court does not give great weight to this survey because of the use of the cans. It clearly and immediately conveyed a differentiation which the test was designed to detect.”).

\textsuperscript{179} Big Island Candies, Inc. v. The Cookie Corner, 269 F. Supp. 2d 1236, 1250 (D. Haw. 2003) (“Survey respondents were never shown a plain BIC Cookie. Rather, the only way in which respondents saw the BIC cookie was when it was wrapped in cellophane printed with the words ‘Big Island Candies.’”).

\textsuperscript{180} Diamond, supra note 12, at 270 (“The completeness of the survey report is one indicator of the trustworthiness of the survey and the professionalism of the expert who is presenting the results of the survey.”).

\textsuperscript{181} In re Steelbuilding.com, 415 F.3d 1293, 1300 (Fed. Cir. 2005) (“This court agrees with the Board that this particular poll lacked sufficient signs of reliability. For instance, the poll results do not indicate the number of actual participants.”); Stuhlbarg, 240 F.3d at 840 (“Nor did the submission address the format of the survey or its methodology. Without any information regarding the survey design, questions, or methodology, the district court
surveys administered before a dispute arises may be relevant, often the methods used to conduct such surveys are not documented adequately for them to be probative.\textsuperscript{182}

**VIII. COUNTERING A GENERICNESS SURVEY**

If only one party proffers a survey in a genericness dispute that party will not necessarily prevail over one that did not.\textsuperscript{183} The best way to refute a genericness survey may be to conduct a rebuttal survey, assuming one has the resources to do so.\textsuperscript{184} Marketing surveys conducted by a party before litigation may be used by an opposing party to rebut the surveys conducted in connection with litigation, and such surveys may be deemed more trustworthy.\textsuperscript{185} As in *E. I. Du Pont de Nemours*,\textsuperscript{186} often one party’s survey is more persuasive than the other’s in a trademark dispute on the issue of genericness.\textsuperscript{187} However, countervailing surveys did not abuse its discretion by ascribing little weight to the survey excerpts submitted by Brush.

\textsuperscript{182.} Microsoft Corp. v. Lindows.com, Inc., 2002 WL 31499324, at *13 (W.D. Wash. Mar. 15, 2002) (“No exhibits are attached to demonstrate the methodology or explain the survey design, and without such a foundation, the Court has no alternative but to ascribe a bare minimum of weight to the result.”).

\textsuperscript{183.} *Big Island Candies*, 269 F. Supp. 2d at 1250 (“As BIC contends, ‘the most important type of evidence used in evaluating genericness is consumer surveys’ [citation omitted]. Unfortunately for BIC, the BIC Survey is of no help to it on the present motion.”).

\textsuperscript{184.} J & J Snack Foods Corp. v. Nestlé USA, Inc., 149 F. Supp. 2d 136, 153 (D.N.J. 2001) (“Plaintiff, not surprisingly, does not argue the customer survey, customer testimony, and trade journal factors in their moving papers, because there has been no suggestion that any such evidence exists.”); Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 577 (D.N.J. 1985) (“I find it significant that plaintiffs made no effort to conduct a survey of their own to support their contentions that the results of the Ross survey would have been different had plaintiff's proposed methodology been followed.”).

\textsuperscript{185.} *Nestlé*, 571 F. Supp. at 776 (“[T]he same standard should not apply when admitting survey evidence developed before litigation as is applied to surveys developed for the purposes of litigation. The former are inherently more trustworthy, especially when the results are against the developer’s interest, as is the case here.”).

\textsuperscript{186.} 393 F. Supp. at 525-527.

\textsuperscript{187.} *Zipee Corp. and Zipee.com, Inc. v. U.S. Postal Serv.*, 140 F. Supp. 2d 1084, 1087 (D. Or. 2000) (“While defendant’s survey is also too narrow, I find it more persuasive on the issue of establishing that more consumers than not associate the phrase ‘postal service’ with an organization.”); G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc., 676 F. Supp. 1436 (E.D. Wis. 1987), aff'd, 873 F.2d 985, 996 (7th Cir. 1989) (“For these reasons, we believe that the district court properly discounted the statistical evidence proffered by Busch and accorded greater weight to the survey results submitted by Heileman and Miller.”); Jacob Zimmerman v. Nat’l Assoc. of Realtors, 2004 WL 763936, at *12-14 (T.T.A.B. Mar. 31, 2004) (“In the most contentious area of evidence in this record, the parties to these
may merely preserve the equipoise between the parties or, alternatively, both parties’ surveys may be found to support the same conclusion.

If there are technical flaws in a survey, the party without a survey should consider retaining an expert to critique the opposing party’s survey. A party whose survey has been found to be flawed may conduct a second survey, but it may not prove more persuasive than the original. Further, a survey in a genericness dispute may not be accorded any weight for reasons other than technical flaws, such as because a mark has already been found to be not generic or the data collection for the survey was untimely. In such instances, it may not be necessary to conduct a rebuttal survey or to retain an expert to critique the survey.

The surveys in American Thermos and E. I. Du Pont de Nemours each concerned coined marks (THERMOS and TEFLON).

proceedings have each proffered a survey. * * * The results of petitioner’s flawed survey suggest that members of this portion of the relevant public may perceive the terms involved in these proceedings as generic terms in spite of respondent’s best efforts to create perceptions of these terms as source indicators among members of the general public. However, because of the flawed methodology, these results do not factor into our decision.”); Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292, 1297 (N.D. Cal. 1991).

188. Classic Foods Int’l Corp. v. Kettle Foods, Inc., 468 F. Supp. 2d 1181, 1193 (C.D. Cal 2007) (“In light of the foregoing, the survey evidence presented by KFI is essentially in equipoise with that offered by CFI, and is of only limited evidentiary value.”); Premier Nutrition, Inc. v. Organic Food Bar, Inc., 2008 WL 1913163, at *9 (C.D. Cal. Mar. 27, 2008) (“Both parties have introduced survey evidence supporting their position, and each party correctly argues that the other party’s survey is seriously flawed.”).


190. Arrow Trading Co., Inc. v. Victorinox A.G. and Wenger, S.A., 2003 WL 21509858, at *15 (T.T.A.B. June 27, 2003) (“Opposer thoroughly cross-examined applicants’ survey expert witness regarding the type of survey, the interviewing, the analysis, etc. However, it is noteworthy that opposer did not retain a survey expert to critique applicants’ survey, and did not conduct its own survey . . .”).

191. Pierce Foods Corp. v. Tyson Foods, Inc., 231 U.S.P.Q. 287 (D.N.J. 1986) (“It appears that Tyson itself developed questions about the survey, because after the hearing it directed Dr. Zeisel, to conduct a new one, the results of which were filed with the Court three and one-half weeks after the hearing. * * * However, I am not going to consider this survey on the present application. My experience with the first survey has given me a somewhat jaundiced view of surveys in general . . .”).

192. In re 1-800 Contacts, Inc., 2002 WL 481122, at *5 (T.T.A.B. Mar. 29, 2002) (unpublished) (“This survey is clearly directed to our initial question of whether 1800CONTACTS is generic in connection with the identified services. Because we have determined that 1800CONTACTS is not generic, it is not necessary for us to evaluate the effectiveness of this survey for its stated purpose.”).
The Court of Appeals for the Fourth Circuit disregarded a survey in a genericness dispute over the mark CRAB HOUSE because the mark was not coined. However, in other trademark disputes, genericness surveys have been probative with respect to descriptive, suggestive, and arbitrary marks such as VIRUS SCAN (antivirus software), BEANIES (plush toys), and STEELHEAD (golf clubs).

Survey evidence in a unique product context (i.e., a situation in which only one company makes the product) may not be dispositive with respect to trademark significance. One legal scholar has recommended modifications to the Thermos and Teflon Survey formats for such situations, although the suggested adaptations have yet to be tested or endorsed in a trademark dispute over genericness.

An opposing party may claim that the data collection for a genericness survey was untimely. According to Professor McCarthy there are “three possibilities for the critical date when genericness is to be tested: (1) the date when the proponent of the trademark rights first began the alleged trademark usage, (2) just before the date when the accused infringer entered the market, and (3) the current date of the litigation.” The timeliness of a

193. Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc., 240 F.3d 251, 255 (4th Cir. 2001) (“Hunt does not claim to have first coined the term ‘crab house.’ Therefore, it is not necessary to determine whether the term has become generic through common use, rendering Hunt’s customer survey irrelevant.”).
195. Ty, Inc. v. Softbelly’s, Inc., 353 F.3d 528, 530-31 (7th Cir. 2003).
197. A. J. Canfield Co. v. Honickman, 808 F.2d 291, 302 (3d Cir. 1986) (“[W]e do not believe that a direct survey of public views can truly measure consumer understanding if a term identifies a product that arguably constitutes its own genus.”). In Berner (987 F.2d at 983 n.7), the Third Circuit held: “The unique problem of consumer survey evidence with regard to a single-product market or genus does not apply to other contexts such as the present case.” See also Palladino, supra note 128, at 673-76, for a discussion of the decision in Canfield in light of the 1984 amendments to the U.S. Trademark (Lanham) Act.
198. Palladino, supra note 5, at 884, suggests that in a unique product situation secondary meaning are not necessarily opposites. For this reason, he contends that questions in a genericness survey may need to be modified when only one company makes a product. Palladino has proposed two alternative question wordings for a Teflon Survey: “If this type of product were made by more than one company, would you consider [the word at issue] a brand name or a common name?” or “If this type of product were made by more than one company, do you believe [the word at issue] would be used by more than one company making this type of product, or would it be used by one company for its version of this type of product?” He also has proposed other survey questions for a unique product situation. However, he admits that his suggested questions may be flawed because they seek to gauge public reaction to a hypothetical situation.
199. 2 McCarthy, supra note 3, § 12:17.50.
survey usually goes to the weight afforded a genericness survey. Like the survey credited in *E. I. Du Pont de Nemours*, most surveys that have been endorsed in genericness disputes have been conducted “virtually on the eve of trial.” Nevertheless, a survey conducted concurrent with the litigation may be disregarded, or have little probative value, if the mark at issue is alleged to have been commonly used well before the proponent of the trademark rights first began the asserted trademark use.

200. In *Burger King Corp. v. Pilgrim’s Pride Corp.* (705 F. Supp. 1522, 1525 (S.D. Fla. 1988), aff’d, 894 F.2d 412 (11th Cir. 1990), the defendants criticized the plaintiff’s survey because the survey was conducted in November 1987, after Burger King’s first use of the name CHICKEN TENDERS. However, the court held this did not control the survey’s admissibility (“[T]he defendant asserts that the Plaintiff cannot use the Chilton survey to show non-genericness of the term ‘Chicken Tenders’ alone, when a plurality of composite uses existed at the time the survey was taken. At trial, this Court specifically allowed the survey as evidence to prove non-genericness, and stated that the Defendant’s objections to the survey went to the weight to be given to the survey, and not its validity. This is still this Court’s position.”). In *Nightlight Sys., Inc. v. Nitelites Franchise Sys., Inc.* (2007 WL 4563873, at *9 (N.D. Ga. July 17, 2007)), plaintiffs argued unsuccessfully that defendant’s survey was “stale” because the meaning of the phrase NITE LITES may have changed since the time the survey was taken (“In the instant case, the litigation was filed in 2004. The survey was taken in January of 2006, during the active litigation. The court finds that, given the lack of evidence presented by the plaintiffs on this issue, the survey is not inadmissible due to untimeliness. Any deficiencies in the timeliness of the survey in the instant case goes to the weight afforded the survey, and not its admissibility.”). 201. 393 F. Supp. at 525 (“In response to these two surveys, Du Pont introduced a second Burke survey [citation omitted] conducted telephonically by Burke Marketing Research, Inc., virtually on the eve of trial.”).


203. Schwan’s IP, LLC v. Kraft Pizza Co., 460 F.3d 971, 976 (8th Cir. 2006) (“Similarly, Brick Oven was commonly used before either party began labeling their frozen pizzas with the term, and it was not error for the district court to omit the survey evidence from its genericness analysis.”); *Microsoft Corp. v. Lindows.com, Inc.* , 2002 WL 31499324, at *14 (W.D. Wash. Mar. 15, 2002) (“Nonetheless, the 1993 survey’s probative value is limited by the fact that it was taken approximately fourteen years after the introduction of Xerox’s Smalltalk software which pioneered the overlapping windows feature of user interfaces and ten years after Microsoft first announced its Windows product.”). For a discussion of the survey evidence in the Microsoft-Lindows dispute, see also Marc C. Levy, *From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine*, 95 TMR 1197, 1217-18 (2009). According to Levy, after the court’s ruling on the preliminary injunction motion in 2002, Microsoft commissioned a survey that employed the Teflon format. The survey found that 83% of business consumers and 73% of home consumers considered WINDOWS to be a trademark associated with a single source. Nevertheless, the court ruled that if the WINDOWS mark was generic in 1985, then it could not be valid now (2004 WL 329250, at *2 (W.D. Wash. Feb. 10, 2004) (unpublished)) (“Consistent with its findings thus far . . . the Court declares it will instruct the jury to consider whether the Windows mark was generic during the period before Microsoft Windows 1.0 entered the marketplace in November 1985. Furthermore, the Court will not instruct the jury that even if Windows were generic prior to November 1985, the trademark would nonetheless be valid today so long as the primary significance of the term today is not generic.”)).
IX. CONCLUSION

American Thermos and E. I. Du Pont de Nemours provide two distinct methods for conducting a survey to determine the primary significance of a mark in a trademark dispute involving genericness. Although less common, other questionnaire formats may also shed light on whether a mark is entitled to trademark protection.

While familiarity with accepted methods for conducting genericness surveys is helpful, proper construction of a genericness survey requires survey design expertise, as well as an understanding of the facts of the case (e.g., the context in which a party is seeking or claiming trademark protection). Furthermore, to be probative a genericness survey should be appropriately implemented, analyzed, and reported.

Genericness has been described as a fascinating and elusive concept in trademark law. For this reason, the resolution of a trademark dispute involving genericness may be difficult even when survey evidence is proffered, and particularly in a unique product context. A genericness survey may be flawed, or the results may be contradicted by another survey, or by non-survey evidence. Nevertheless, a review of U.S. court opinions and U.S. Trademark Trial and Appeal Board decisions suggests that surveys in trademark disputes in which genericness is an issue often prove dispositive.

204. Palladino, supra note 128, 79 TMR at 680 (“A fairer observation would be that, when all is said and done, genericness remains among the most fascinating and elusive concepts in the field of trademark law—one with which we no doubt will continue to wrestle as long as the issue is raised.”).