Practitioners' Checklists

Best Practices in Litigation Surveys

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This checklist provides trademark and IP practitioners, brand owners, and survey experts with a start-to-finish checklist pertaining to best practices in litigation surveys. This checklist spans key considerations of all aspects of litigation surveys, including designing, conducting, analyzing, reporting, and interpreting surveys, along with evidentiary issues and ramifications for trademark litigators. The checklist focuses on the use of surveys in U.S. trademark, unfair competition, and false advertising cases, although it may be helpful to practitioners in other jurisdictions descended from British common law.

1. **Determine appropriate survey format(s) based on the matter**
   Prior to initiating research design, experts should determine the appropriate survey based on the specifics of the matter at hand. Common survey formats include the following:
   a. Likelihood of confusion: Are consumers likely to be confused with regard to the source of, the connection or affiliation with, or the sponsorship or approval of, the at-issue product or mark?
      i. Eveready format: This format is appropriate when the trademark owner's product or mark can easily be recalled by most consumers in the target market. This format shows only the accused mark and asks questions to

determine whether consumers associate it with the trademark owner's mark.[1]

ii. Squirt format: This format is appropriate when the trademark owner's product or mark is sold near or at the same time as the accused product or mark. This format shows at least the two involved products or marks, and often also a lineup of marks or products in the same category, which serve as distractors to lessen the emphasis on the at-issue marks.[2]

b. Secondary meaning: Do consumers perceive a mark or product as being made or put out by just one company or organization?
    i. Does a significant portion of the relevant consuming public associate a mark or product as being from a single source?
    ii. To show secondary meaning, respondents do not need to be able to name the specific source; it is enough to show that they associate the mark or product with only one source.
c. False advertising: Is a message deceptive? If so, does that message have a material effect on a consumer's likelihood of purchasing?
    i. Surveys in false advertising matters generally ask questions in a "funnel" that starts with broad questions about the messages in the ad and narrows to the issues of interest. This permits the survey to gauge respondents' reactions to the ad without asking actual or perceived leading questions.
    ii. Materiality surveys ask, often indirectly, about the importance of advertising and promotional messages to consumers' decisions to purchase.
d. Genericism: Is a mark viewed as being a brand name that could apply to just one product, or as a generic name that could describe any product in a given category?
    i. Teflon surveys: After an explanation of what is generic and what is a brand, and a "mini-test" to ensure respondents understand, a Teflon survey asks whether each of a series of names is generic or branded.[3]

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[1] *See* Jerre B. Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirt*, 98 TMR 739–42 (2008). *See also Union-Carbide Corp. v. Ever-Ready Inc.*, 392 F. Supp. 280 (N.D. Ill. 1975).

[2] *See* Jerre B. Swann, *Likelihood of Confusion Studies and the Straitened Scope of Squirt*, 98 TMR 748–50 (2008). *See also* Squirtco v. Seven-up Company, 628 F.2d 1086 (8th Cir. 1980).

[3] *See* E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel*, in Trademark and Deceptive Advertising Surveys: Law, Science, and Design, edited by Shari Seidman Diamond and Jerre B Swann, ABA Publishing, 2022, pp. 113-116, 120-125. *See also E. I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 525-27 (E.D.N.Y. 1975).

ii. Thermos surveys: This format asks respondents what they call a product of the type that is at issue, and what they would request if speaking to a salesperson about the product or searching for it online.[4]

e. Others
    i. Fame: Is the at-issue mark well known or famous? This survey type asks the general public if they recognize the mark. Parties may conduct fame surveys as evidence when they need to show fame to prove dilution, or to justify the use of an Eveready likelihood of confusion survey.
    ii. Likelihood of dilution: Has a mark or brand been diluted by blurring the distinction between it and another mark or brand? Has the mark or brand been diluted by associating it with an unflattering mark or brand? Dilution surveys ask whether respondents associate the trademark owner's mark with another mark.
    iii. Purchasing importance: What is the overall importance of specific reasons for a consumer's purchase of a product or service? What is the relative importance of any particular reason?
    iv. Patent issues: While not as common, a survey might measure consumer usage of products that relate to an at-issue patent. Do consumers use products in certain ways that relate to the asserted functionalities of an at-issue patent? How much usage should be taken into account when calculating damages? Several types of surveys can be used in patent matters.

2. <u>Initial research design before developing survey</u>

Prior to creating a survey, experts should understand the marketplace in which the mark, brand, or product exists. This includes understanding how the product is used and sold, the competition, and what kind of people are in the target market.

a. Category and marketplace research
    i. Who are the competitors?
    ii. How do consumers use or purchase the at-issue product or service?
    iii. How do consumers talk about the products or services at issue?
    iv. How are the products or services promoted or sold in the real-world marketplace?
b. Relevant survey "universe" (the group of people interviewed in the survey)
    i. Demographic characteristics of relevant consumers

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[4] *See* E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel*, in Trademark and Deceptive Advertising Surveys: Law, Science, and Design, edited by Shari Seidman Diamond and Jerre B Swann, ABA Publishing, 2022, pp. 113-116, 120-125. *See also* Am. Thermos Prods. Co. v. Aladdin Indus., 207 F. Supp. 9, 20 (D. Conn. 1962).

1. Are relevant consumers more likely to fall within a specific age group, gender, or geography? For example, energy drinks are likely to be purchased by young males. Older adults are more likely to buy over-the-counter arthritis medications.
2. Or, are consumers more likely to reflect the makeup of the population at large? This might be true for a product or service that is widely used by a large number of consumers, such as home Internet service or air travel.

ii. Depending on the survey format, the group of relevant consumers may be comprised of past purchasers, future purchasers, both, or the general public.
1. Review survey treatises to determine appropriate types of consumers.
2. If interviewing purchasers, what is the normal purchase cycle of a product in the relevant category, e.g., is it one week, one month, one year, or more?

iii. Proactively address possible criticisms about the survey's universe
1. Does the survey interview a larger group of consumers than is relevant (overinclusive universe)?
2. Does the survey leave certain relevant consumers out of the demographics being interviewed (underinclusive universe)?
3. Does the survey's universe both leave out a set of relevant consumers and include a different set of irrelevant consumers?

iv. Assess the ability to reach the relevant audience via the survey
1. Is the product used or experienced by a broader universe of consumers (e.g., commonly consumed foods or beverages) or by a narrower group of consumers (e.g., less common surgical or medical procedures)?
2. How often would you expect to find relevant consumers in a randomly selected group?
3. Is the relevant group of potential survey respondents easily identifiable and accessible? For example, medical privacy laws may make it difficult to reach patients who underwent even common medical procedures.

3. <u>Survey Development</u>

After determining the survey format and conducting initial research on the matter, the expert should begin to develop the survey instrument. Key steps in developing the survey are as follows:

a. Develop the survey draft, including:

i. the questions used to qualify prospective respondents for the survey,
ii. the substantive questions measuring the at-issue elements,
iii. if the survey is performed online, all instructions that enable a programmer to create the online survey, and
iv. replicating market conditions as closely as possible to reality.

b. Where applicable, design and implement survey control(s)[5]
    i. Does your survey need a control? When investigating whether one factor causes another, such as whether the name of a junior mark causes confusion with a senior mark, a control helps eliminate other potential explanations for the confusion.
    ii. In accordance with best practices, does the control change only those elements of the mark, brand, or product that are under dispute? All factors that are not at issue should remain unchanged.
    iii. Does the control eliminate all of the elements of the mark, brand, or product that the survey is assessing?
    iv. Could the control itself plausibly be accused of the same trademark or false advertising violation as the test stimulus?
    v. Does the control avoid any cues that might artificially lead the respondent in another direction?
    vi. Is the control something that could plausibly appear in the marketplace?
c. Consider best practices for reducing the influence of biases and other elements that are not the elements of interest.
    i. Use survey controls whenever needed.
    ii. Ensure that questions on specific topics are later in the survey, so that they do not influence responses to more general questions.
    iii. Follow "double-blind" interviewing procedures, where neither the respondents nor the survey panel company are aware of key details, such as the sponsor or true purpose of the survey.
    iv. Disguise or hide responses that would qualify respondents for the survey among other non-qualifying survey responses.
    v. Use "filter questions" to remove respondents who don't have an opinion on a topic before asking about that topic.

[5] A control is like a placebo in medicine: it removes the factor of interest (the "active ingredient"). People who indicate that they are confused in response to the control are not responding to the factor of interest, so their responses can be attributed to extraneous influences like biases. See Sheri Seidman Diamond, *Reference Guide on Survey Research*," Reference Manual on Scientific Evidence, 3rd ed., National Academies Press, 2011, pp. 387-401.

vi. Instruct respondents not to guess and include an "I don't know" response option to discourage respondents from selecting any responses that may not accurately represent their opinions.
vii. Rotate or randomize certain question text and responses to reduce the possibility of order bias.
viii. Use a quality control or attentiveness question, sometimes referred to as a "speed bump" question; only respondents who select the proper response continue through the survey.
ix. Replicate market conditions as closely as possible.

d. Determine how the interviews will be conducted, i.e., should the survey be conducted in person, by mail, by phone, or online?
    i. Most modern survey research is conducted online because it is inexpensive and enables researchers to reach diverse or specialized respondents.
    ii. Researchers might opt against online surveys if asking about a product or service that must be experienced in person or about experiences over time.
e. Prepare final survey for interviews
    i. What demographic quotas will you set for respondents? Surveys typically set quotas for age, gender, and other demographic groups that match the demographics of the targeted population (including the general population).
    ii. What, if any, test and control stimuli should be shown in the survey?
    iii. Has the survey been checked carefully to ensure that it makes sense to the reader; asks the intended questions in the intended order; and has no errors in spelling, grammar, or usage?
    iv. If the survey is being conducted online (which is typical), has the survey program been proofread to ensure that the programming instructions are correct and complete and have been followed?

4. <u>Survey Implementation</u>

After the survey is developed, the survey must be implemented in accordance with best practices. In implementing the survey, the expert should address the following questions:

a. What method will be used to find prospective respondents and administer interviews?
    i. The most common approach is hiring an online panel company. These companies operate and maintain a large number of panelists and use quality control processes to ensure that the panelists and their responses are accurate and valid.
    ii. Less common approaches include mailing lists and in-person interviews

1. For some matters, a mailing list may be used. For example, if a survey must interview people who have purchased a product or service, a list of past customers may help to achieve this.
2. For circumstances where product interaction or usage is at issue, researchers may conduct in-person interviews.

iii. Attorneys should not be involved in conducting or carrying out the survey or tabulating the results.

b. Were results obtained by respondents over multiple days? A sample consisting of both weekday and weekend responses helps to minimize the risk of possible biases based on when the survey was offered.
c. Did the survey achieve a sufficient number of responses? While there is no consensus on the minimum number of survey respondents, a researcher should consider:
    i. whether the sample will be divided into groups, and
    ii. the margin of error, based on the measure and the sample size.
d. Double-blind requirement: Interviewers and respondents should be blind to the purpose and sponsorship of the survey.

5. <u>Conduct pilot survey</u>

Conduct a small number of interviews and assess pilot survey results to ensure that the survey is operating as designed, and that a full survey is desirable. This includes considerations for both the survey expert and the attorney.

a. Survey expert considerations include whether the survey expert ensured that:
    i. responses are recorded properly,
    ii. the survey skip patterns were followed accurately,
    iii. responses showed an understanding of the question, and
    iv. no other unexpected problems arise with the survey.
b. Attorney considerations:
    i. Consider discovery differences applicable to non-testifying consultants and designated expert witnesses.
    ii. Consider whether the pilot survey should be completed prior to expert witness designations.
    iii. Consider using a non-testifying consultant rather than the designated expert witness.

6. <u>Conduct remaining interviews and initiate data cleaning</u>

Assuming the survey continues after the pilot survey, continue with fielding the survey to achieve the desired sample size. This includes answering the following questions:

a. Does data from the survey continue to show that respondents understand and can follow through on questions?
b. Were the quotas for respondent demographics satisfied?
c. Did researchers check the data for common indications of poor survey validity? These include respondents who:
    i. completed the survey in a suspiciously short or long time
    ii. chose the same response item (e.g., the first or last item) for some or all questions in the survey
    iii. provided questionable open-ended responses
    iv. made multiple survey attempts or provided duplicate responses
d. Use survey validation to confirm that the survey questions were in fact presented and the responses were in fact provided by the survey participants.

7. <u>Prepare survey report</u>

Based on all materials relevant to the survey, the researcher (survey expert) prepares the expert report.

a. Export data from survey into a format useful to the report preparer.
b. Include an overview of the survey format, including any necessary justification for using it.
c. Include all information required by the venue or recipient of the survey. For U.S. federal courts, this would include a biography and C.V. of the survey expert, a list of the expert's prior cases, their financial compensation, and a list of materials reviewed in preparing the report.
d. Describe the survey's methodology, including details of each question in the survey.
e. Discuss survey findings for all substantive questions in the survey. Include data tables as needed.
f. Summarize opinions based on the survey's findings.

8. <u>Exhibits to accompany main report</u>

The survey expert includes all materials that substantiate expert's credentials and enable another researcher to replicate the survey. Relevant materials may include the following.

a. The survey expert's CV, including such information as:
    i. education,
    ii. academic and professional experiences,
    iii. honors and awards,
    iv. appointments and affiliations,
    v. publications and speaking engagements,

vi. survey areas of specialty, and
vii. cases in which the expert has testified as an expert, including written reports or testimony at deposition or trial. In U.S. federal court, this must include all cases from the prior four years.

b. The survey questionnaire, including:
    i. the questions used to qualify prospective respondents for the survey,
    ii. the substantive questions measuring the at-issue elements, and
    iii. all survey programming instructions
c. Examples of any images or other stimuli (such as videos or marks in plain text) used in the survey
d. A description of the recruiting methods for survey respondents.
e. A listing of quality control measures for the survey, including procedures used to validate respondents.
f. A summary of how many respondents were terminated from the survey before completing it or removed from the survey's database after completion, and the reasons for their termination or removal.
g. If applicable, a description of how any open-ended questions were categorized into relevant themes for analysis
h. Data tables, often called cross-tabulation tables, showing the data for responses to each question in the survey
i. A data table showing all responses to all questions from all respondents

9. <u>Post-report activities</u>

After the report is proffered, has the expert provided:

a. the survey database and variable information in native format, such as Excel or CSV?
b. a description and/or visuals of the survey as actually taken by respondents?
c. all information enabling any other researcher to replicate the survey format? This includes the survey instrument, any images or stimuli, and the exact demographics of the survey universe.

10. <u>Considerations of survey weight and exclusion factors and adverse inferences</u>

Trademark practitioners and brand owners may consider other post-report factors affecting survey weight and exclusion, as well as adverse inferences that may arise from failing to conduct a survey.

a. Survey weight and exclusion factors
    i. Is the expert qualified to offer opinions based on relevant credentials?
    ii. Did the survey interview the correct universe?

iii. Did the survey, to the fullest extent possible, replicate the conditions of the real-world marketplace?
iv. Did the survey appropriately utilize controls?
v. Did the survey include leading or suggestive questions?
vi. Did the survey interview a sufficient number of relevant respondents?
vii. Does the survey fail to account for relevant market conditions that may cut against the party proffering the survey?
viii. An unqualified expert witness and failing to survey the correct universe of consumers are the two factors most likely to result in exclusion from evidence of the survey.
ix. Generally speaking, courts typically rule that the other factors listed above affect the evidentiary weight to be accorded the survey evidence, not its admissibility.

b. Adverse inferences
    i. Was there a failure to conduct a survey where the party had the financial means to do so?
    ii. Does the relevant circuit or district court apply an adverse inference where a party with sufficient financial means to conduct a survey fails to proffer survey evidence?