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Jonathan E. Moskin and Roma Lopes

The Certification Mark Challenge: Successfully Navigating the Prosecution
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Evidence*, Fourth Edition
David T. Neal, PhD

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A PATENTLY OBVIOUS REMEDY FOR TRADEMARK INFRINGEMENT: CONVOYED SALES*

*By Jonathan E. Moskin** and Roma Lopes****

We are all familiar (colloquially, at least) with the concept of convoyed sales: that is, sales of two distinct goods that go hand-in-hand in a causal relationship. For instance, Gillette designs its razors so that users will buy Gillette replacement blades. And Hewlett Packard designs its printers so that users will buy HP replacement printer ink cartridges. These examples find support in patent law as illustrations of convoyed sales—that is, components whose sales are driven by a patented product.¹ And where there is proof of a sufficient causal relationship, patent law comfortably permits damages awards for non-patented products sold together with the infringing goods. But trademark law, while capacious enough to allow such recovery, reveals no relevant precedents allowing such a remedy. While this article does not mean to suggest that the Lanham Act and Patent Statute remedies should themselves be knotted together, the concept of convoyed sales could provide a basis for complete remedial relief in certain trademark cases.

In *Mishawaka Rubber & Woolen Manufacturing Co. v. S.S. Kresge Co.*,² the infringed trademark was simply a red dot on the heels of shoes, and the infringer sold detachable heels with a similar red plug. The infringer appealed the trial court's order directing it to account to the mark owner for "profits made from sales 'to purchasers who were induced to buy because they believed the heels

* This article should be cited as Jonathan E. Moskin & Roma Lopes, *A Patently Obvious Remedy for Trademark Infringement*, 116 Trademark Rep. 707 (2026).

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¹ Mobil Oil Corp. v. Amoco Chems. Corp., 915 F. Supp. 1333, 1358 (D. Del. 1994) ("‘Convoyed’ or ‘derivative’ sales occur where the sale of one thing is likely to cause the sale of another, such as selling a razor and then also being able to sell razor blades to go with it.”).

² *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 203 (1942).

to be those of plaintiff and which sales plaintiff would have otherwise made.”³ Justice Frankfurter’s decision is undoubtedly most famous for his observation that “[t]he protection of trademarks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.”⁴ It was this observation that arguably was the genesis of much modern trademark law. However, his discussion of damages is no less trenchant.

Justice Frankfurter explained: “Infringement and damage having been found, the Act requires the trade-mark owner to prove only the sales of articles bearing the infringing mark”—not that “but for” the defendant’s unlawful use of the mark, particular customers would have purchased the plaintiff’s goods.⁵ He further reasoned:

There may well be a windfall to the trade-mark owner where it is impossible to isolate the profits which are attributable to the use of the infringing mark. But to hold otherwise would give the windfall to the wrongdoer. In the absence of his proving the contrary, it promotes honesty and comports with experience to assume that the wrongdoer who makes profits from the sales of goods bearing a mark belonging to another was enabled to do so because he was drawing upon the good will generated by that mark.⁶

The Lanham Act of 1946, 15 U.S.C. § 1051 et seq., embraces Justice Frankfurter’s expansive view of the courts’ remedial powers, broadly permitting awards of compensatory damages upon a showing of infringement: the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant’s profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.... In assessing profits the plaintiff shall be required to prove defendant’s sales only; defendant must prove all elements of cost or deduction claimed.⁷

Under this broad language, there is good reason to believe that if a manufacturer of BRAND X razors fairly anticipated sales of its own razor blades or cartridges (even those sold without the BRAND X mark), but BRAND Y razor manufacturer diverts sales of blades or cartridges by trading on the good will in the branded razors, a damages award should encompass the blades or cartridges—and not

³ *Id.* at 204.

⁴ *Id.*

⁵ *Id.* at 206 (referring to the Trade-Mark Act of 1905).

⁶ *Id.* at 207.

⁷ 15 U.S.C. § 1117(a).

just the razors—so as to make the trademark owner whole and prevent an unearned windfall to the infringer.

Rite-Hite Corp. v. Kelley Co., a seminal en banc Federal Circuit decision on lost profits damages, allows incremental damages for portions of products sold with patented inventions but not covered by the patent.⁸ Under *Rite-Hite*, proving lost profits for convoyed sales requires a showing that the unpatented and patented products together form a “functional unit.”⁹ Stated differently, the patented and unpatented products must “be analogous to components of a single assembly or be parts of a complete machine”; the unpatented item “must function together with the patented [item] in some manner so as to produce a desired end product or result.”¹⁰ Damages for convoyed sales are not available where items are sold without any functional relationship to the patented invention—even if sold together for relevant business purposes. The Federal Circuit reinforced this limitation in *American Seating Co. v. USSC Group, Inc.*, involving wheelchair restraint systems for passenger buses, where it emphasized that “a functional relationship does not exist when independently operating patented and unpatented products are purchased as a package solely because of customer demand.”¹¹ More recently, the Federal Circuit’s decision in *Wash World, Inc. v. Belanger, Inc.* reaffirmed the requirement that convoyed goods must have a functional relationship to the patented technology, declining to extend lost-profits recovery to products that were merely sold contemporaneously with the patented item but served independent functions.¹²

The convoyed sales doctrine should be distinguished from the “entire market value rule” (“EMVR”). Although both doctrines permit damages to be measured on the basis of more than just the patented component itself, they serve different functions and impose different requirements. Under the EMVR, a patentee seeking a reasonable royalty may use the entire value of a multi-component product with a patented feature as the royalty base, but only if the patented feature is the basis for customer demand for the entire product.¹³ By contrast, the convoyed sales doctrine applies to lost-profits damages and permits recovery for sales of separate

⁸ *Rite-Hite Corp. v. Kelley Co., Inc.*, 56 F.3d 1538, 1546-47 (Fed. Cir. 1995).

⁹ *Id.* at 1550.

¹⁰ *Id.*

¹¹ *Am. Seating Co. v. USSC Grp., Inc.*, 514 F.3d 1262, 1268 (Fed. Cir. 2008).

¹² *Wash World, Inc. v. Belanger, Inc.*, 131 F.4th 1360, 1375 (Fed. Cir. 2025). To be sure, trying to base recovery of damages on non-patented items sold with patented items can give rise to an antitrust defense that such an award might be an illegal tying arrangement. However, the Supreme Court clarified in *Illinois Tool Works Inc. v. Independent Ink, Inc.* that a patent alone does not create a presumption of market power sufficient to establish an illegal tie. 547 U.S. 28, 43-46 (2006).

¹³ *See LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 67 (Fed. Cir. 2012).

unpatented items that are functionally related to the patented product and sold together with it as a unit.¹⁴ The functional-unit requirement thus operates as a limiting principle: unlike the EMVR, which focuses on consumer demand for the overall product, the convoyed sales doctrine requires proof that the items work together or are components of the same system. Where the products are merely complementary but functionally independent, neither doctrine permits expanded damages.

In a recent Lanham Act and unfair competition case handled by the authors, a theory of convoyed sales survived summary judgment.¹⁵ Although the case settled days before jury selection, the facts are instructive. The plaintiff sold certain agricultural valves, the handles of which were protected by a color trademark registration. The defendant was accused not only of copying the proprietary color of the handle but also of copying hundreds of (unpatented) parts designs—not only of the valves themselves but accompanying fittings and other parts used with the valves and typically sold together as a package. In deposition testimony, the defendant's witnesses admitted that the fittings and other parts were sold hand-in-glove with the valves and that the valves (the most expensive part of the whole set) drove sales of the accompanying parts, which functioned as a unit. At his deposition, the defendant's damages expert was unable to disagree with the fact witnesses about the causal connection between sales of the protected product (the valves) and the subsidiary products that did not bear the mark, nor with the factual summary and the analysis provided by the plaintiff's damages expert. The issue, of course, was not whether the subsidiary products were likely to be confused on account of the alleged trademark infringement, but rather whether there was a sufficient causal relationship by which sales of the one drove sales of the rest.

To borrow again from Justice Frankfurter, if “[a] trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants,”¹⁶ it stands to reason that if the consumer is motivated to purchase not only a product bearing a distinctive symbol, but also the associated component parts sold and marketed with that product (and its merchandising shortcut), then not only does the trademark owner lose those convoyed sales, but the infringer is unjustly enriched by the same causal mechanism. Consider: a consumer drawn to purchase a particular brand of power tool because of its trademark may also purchase that brand's proprietary batteries, chargers,

¹⁴ Wash World, 131 F.4th at 1375 (citing Rite-Hite, 56 F.3d at 1550).

¹⁵ Banjo Corp. v. Green Leaf, Inc., No. 1:23-CV-01770-SEB-MG, 2026 WL 75847 (S.D. Ind. Jan. 9, 2026).

¹⁶ Mishawaka Rubber & Woolen Mfg. Co., 316 U.S. at 205.

carrying case, and related accessories; these items function as a unit with the tool, and for this reason, their sale is driven by the same mark. Similarly, in the agricultural-valve scenario described above, the color (registered as a trademark) on the valve handle served as the “merchandising short-cut” that induced not only the valve purchase but also sales of the fittings and parts that operated together with the valve as a functional system.

The dissent in *Mishawaka* allowed that a broader damages rule might be permitted in cases of willful infringement.¹⁷ So too under the Lanham Act. If lines must be drawn regarding the scope of recoverable convoyed sales, willfulness is one tool available to courts: the statute expressly permits enhancement of profits awards up to three times in cases of willful infringement.¹⁸ But the logic of the Lanham Act compels no such requirement as a threshold matter. The statute conditions recovery on proof of infringement and sales, not on the infringer’s state of mind.¹⁹ Causation is the touchstone, and where convoyed sales are causally linked to the infringing mark, the plaintiff’s entitlement to damages need not depend on whether the defendant acted willfully or innocently.

Returning to the logic of *Mishawaka*: if trademark infringement entails harm to the trademark owner not only in the immediate sense of lost sales of the trademark-protected item itself, but also of associated component parts sold together with it as a functional unit, then the only way to make the trademark owner whole may be to include compensation for the lost sales of those components as well. The Lanham Act’s remedial scheme supports this conclusion. Section 1117(a) directs that damages be assessed “subject to the principles of equity” and that the plaintiff need prove only the defendant’s sales; the burden then shifts to the defendant to establish deductions.²⁰ This framework naturally accommodates convoyed sales: where the infringer’s use of a mark drives sales of an entire product system, equity permits (and perhaps demands) that the trademark owner recover for the full scope of its competitive injury.

Such a rule is also consistent with the long-recognized principle that in cases of direct competition, particularly where there is evidence of actual confusion or direct evidence of diversion, the Lanham Act authorizes damages based on treating the infringer’s profits as a rough proxy for the plaintiff’s own losses.²¹ Under this framework, convoyed sales represent the natural extension of the same compensatory logic: where the infringer’s wrongful

¹⁷ *Id.* at 208-209.

¹⁸ 15 U.S.C. § 1117(a).

¹⁹ *Id.*

²⁰ *Id.*

²¹ *See* *George Basch Co., Inc. v. Blue Coral, Inc.*, 968 F.2d 1532, 1539 (2d Cir. 1992).

appropriation of a mark drives not only primary sales but also sales of functionally related products, the trademark owner's injury—and the infringer's unjust enrichment—rightfully encompasses the entire stream of commerce set in motion by the same merchandising shortcut that induced the purchaser to select what he or she wants. Any windfall is, as Justice Frankfurter explained, the price to pay for infringement.

CONCLUSION

Patent law provides but one model of how damages awards can be shaped under the Lanham Act. But it is no more than that. A Lanham Act award of “(1) defendant's profits [and] (2) any damages sustained by the plaintiff,” as guided by principles of equity, can and should be allowed on their own separate footing. The basic economic concept may be the same, but its application need not be. In *Romag Fasteners, Inc v. Fossil, Inc.*,²² the Supreme Court recently had an opportunity to assess the appropriateness of importing into the Lanham Act *mens rea* limitations on the disgorgement remedy from broad “principles of equity” and pre-Lanham Act jurisprudence yet declined to do so where Congress imposed no such express conditions on the remedy. A similar logic suggests there is no inherent reason to limit recovery of damages or disgorgement of convoyed sales where the facts support such an award. One might say such a remedy is patently obvious.

²² *Romag Fasteners, Inc v. Fossil, Inc.*, 590 U.S. 212 (2020).

THE CERTIFICATION MARK CHALLENGE:
SUCCESSFULLY NAVIGATING THE PROSECUTION
OBSTACLE COURSE*

By B. Brett Heavner** and Caroline G. Segers***

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* This article should be cited as B. Brett Heavner & Caroline G. Segers, *The Certification Mark Challenge: Successfully Navigating the Prosecution Obstacle Course*, 116 Trademark Rep. 713 (2026).

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I. THE ARDUOUS PATH TO THE REGISTRATION OF CERTIFICATION MARKS

Certification marks are becoming almost ubiquitous in the marketplace. Consumers expect to see that the goods and services they purchase are guaranteed to possess every conceivable positive attribute, from organic ingredients and environmentally friendly production, to safety-tested and fireproof construction. To meet consumer expectations, testing laboratories and trade associations are establishing new and expanded certification programs that guarantee products meet the desired attributes. These independent certifying bodies have developed their own certification marks to communicate to consumers that they have tested or evaluated the subject goods and services. Thus, certification marks serve a “guaranty” function that is an entirely different purpose from that of traditional trademarks, whose role is merely to identify the source of the good or service for consumers.

However, certifying bodies should understand that prosecuting a certification mark application through to registration does not follow the familiar, relatively straightforward path of traditional trademark applications, but instead features unfamiliar, often challenging obstacles that must be successfully maneuvered in order to reach the finish line and receive the sought-after registration.

In the United States, the U.S. Patent and Trademark Office (“USPTO”) has imposed the following seven additional requirements on certification mark owners that are not imposed on regular trademark owners. Specifically, the certifying body must:

1. verify under oath that it is not engaged in the production or marketing of the goods and services that it is certifying;
2. adopt and submit to the USPTO the standards for the qualities and characteristics being certified;
3. apply the standards consistently to all those seeking certification;
4. verify under oath that it exercises legitimate control over the use of the mark by authorized users of the certification mark (i.e., those granted certification);
5. only use the certification mark to certify and not to identify their own goods and services;
6. submit specimens showing the certification mark as used by the authorized users (i.e., the certificants); and
7. list the goods and services being certified in the two specific classes of goods and services unique to certification marks.

Each of these USPTO requirements can present stumbling blocks in a certification mark owner’s path to the successful registration of its certification mark. In addition, certification mark

owners may also find that the registration process in other countries imposes additional burdens and restrictions, making it important for a certifier to consider the global strategy and development of its certification program. This article examines each of the seven requirements and provides practical approaches for certification mark owners to navigate this procedural obstacle course. This article also addresses some varying requirements for attaining registration of certification marks in some foreign jurisdictions.

II. NO FALSE STARTS: NEUTRALITY OF THE CERTIFIER

When a certification mark owner approaches the starting line, it must ensure that it meets the initial requirements from the beginning, or it will otherwise lose the race before it even begins. The most basic requirement in certification programs is the neutrality of the certifier. Thus, to qualify for registration, the certification mark owner must submit a sworn statement that it “is not engaged in the production or marketing of the goods and services to which the mark is applied.”¹ This rule is intended to ensure objectivity on the part of the certifying body. The certification mark owner can only oversee the certification of the parties who are applying to use the certification mark. If a certification mark owner is found to be engaged in the manufacture of the products or rendering of the services that it purports to certify, any resulting registration for the certification mark may be cancelled.² Any use of the certification mark for the certifier’s own products and services obviously undermines the objectivity and neutrality that is essential for certification programs.

One party who had such a false start is the University of Mississippi (“University”).³ In 1987, the University sought to register the mark shown below as a certification mark to “certif[y] that the person holding [the] certificate so marked has satisfactorily completed the course requirements for a degree as set by the faculty and Chancellor of The University of Mississippi.”⁴

¹ Trademark Manual of Examining Procedure (“TMEP”) § 1306.03(c) (May 2026 ed.) (based on 37 C.F.R.).

² United States Trademark Act of 1946, as amended (“Lanham Act”), § 14, 15 U.S.C. § 1064(5)(B) (2018); *see also* Restatement (Third) of Unfair Competition § 11, cmt. a (A.L.I. 1995) (“To ensure objectivity in the application of the criteria for certification, the owner of a certification mark registered under the Lanham Act is precluded from certifying its own goods and services.”).

³ *In re Univ. of Miss.*, 1 U.S.P.Q.2d 1909 (T.T.A.B. 1987).

⁴ *Id.* at 1910.



However, the Board noted that “[i]t is clear that applicant is not certifying the quality or characteristics of any goods or services of *others* as is required of a certifier.”⁵ Instead, “the function of the seal on the diplomas issued by the institution is to make that document official.”⁶ In that context, the seal serves as a trademark for the University’s own educational services rather than as a certification of the products or services of others. As a result, the Board denied the University’s certification mark application.⁷

III. CLEARING THE CERTIFICATION STANDARD HURDLE

A. Adopting Certification Standards

The key difference between certification marks and regular trademarks revolves around the certification standards. Because a certification mark tells the buyer that a product or service meets certain criteria, the first hurdle in the application process is establishing exactly what characteristic of the product or service is being evaluated. This requires the certifying body to adopt a specific written standard for that characteristic that the product or service must meet. Most standards fall into three categories: (1) verifying geographic origin; (2) testing a product’s quality, materials, or mode of manufacture; or (3) confirming that work or labor was performed by a member that meets certain standards.⁸ Certification marks that indicate geographic origin, such as FRESH FROM FLORIDA & Design⁹ or CERTIFIED GENUINE IDAHO POTATOES GROWN

⁵ *Id.* at 1911 (emphasis added).

⁶ *Id.*

⁷ *Id.* at 1912.

⁸ TMEP § 1306.01.

⁹ FRESH FROM FLORIDA & Design, U.S. Registration No. 3,641,699 for “[n]atural fresh agricultural food products from a Florida producer, processor, shipper, packer, wholesaler or retailer.”

IN IDAHO & Design,¹⁰ indicate to the consumer that the good is from a specific geographic region. Next, certification marks that indicate certain standards are met as to the quality, materials, or mode of manufacture, such as Energy Star,¹¹ show consumers that the goods have used specific materials, met a governmental or environmental standard, or met certain quality standards. Finally, certification marks may also indicate that the good or service was performed by someone who has been approved to become a member of a particular organization, such as Florida Registered Paralegal FRP & Design.¹²

When adopting the appropriate standards, the certification mark owner has a choice. It can either develop its own standards to be used in connection with the certification mark, or it can adopt a preexisting standard authored by another person or organization. The USPTO's Trademark Manual of Examining Procedure ("TMEP") indicates that the standards may be "established by another party, such as specifications promulgated by a government agency or standards developed through research of a private research organization."¹³ As such, a certifier may submit its own standards or standards developed by a third-party entity and be accepted by the USPTO.

B. Submitting the Certification Standards to the USPTO

To register the certification mark with the USPTO, the certifying body must make the applicable standards apparent to the public, so both those seeking to have their products and services certified and those consuming the products and services will know what the certification mark means. Consequently, the certification mark owner must submit the standards to the USPTO as part of the process to register the certification mark with the USPTO. The standards must discuss the requirements to qualify for certification under the mark.

Originally, the USPTO rules allowed the owner of a certification mark to simply list the title of the standard, and describe its general

¹⁰ CERTIFIED GENUINE IDAHO POTATOES GROWN IN IDAHO & Design, U.S. Registration No. 4,221,402 for "[p]otatoes and potato products, namely, fresh, frozen, refrigerated and dehydrated potatoes; potato salad, packaged potato based mixes."

¹¹ ENERGY ENERGY STAR, U.S. Registration. No. 6,406,229; *see also* U.S. Patent and Trademark Office, *Certification mark applications*, <https://www.uspto.gov/trademarks/apply/certification-mark-applications> (last visited Oct. 5, 2026) (noting that "[t]he ENERGY STAR certification mark is used by authorized users to show their products were certified as having met standards for energy efficiency set by the U.S. Environmental Protection Agency").

¹² FLORIDA REGISTERED PARALEGAL FRP & Design, U.S. Registration No. 3,958,260 for "[p]aralegal services."

¹³ TMEP § 1306.03(b).

subject matter, in the application. Now, under the most current iteration of 37 C.F.R. § 2.45, a certification mark owner must, during the application process, submit a full copy of the applicable standard for every good listed in the application.¹⁴

Accordingly, for a certification program that has already launched, Section 1(a) specifies that a certification mark owner must provide “[a] copy of the certification standards governing use of the certification mark on or in connection with the goods or services specified in the application.”¹⁵ For a certification program that is still in the planning phase, Section 1(b) requires that the standards be submitted with the statement of use.¹⁶ Further, when a certification mark registration is due for a maintenance filing or renewal, the certification mark owner must either (1) declare that the certification standard has not changed since the previous filing, or (2) include a copy of the updated standards along with its declaration of use.¹⁷ Finally, the standards submitted by the certifier must also cover the full scope of the goods or services in the application.¹⁸ For example, if the goods listed in the application are “olive oil,” but the standard submitted only references “extra virgin olive oil,” the application will not proceed until the applicant has either added additional standards to cover all types of oil or the application is amended so that it is limited to cover only extra virgin olive oil.¹⁹ Failure to submit the standards for every good or service listed can result in responses from the examining attorney requiring deletion of goods or services that are not covered by the standards.

1. The Cost Burden

Although submitting a copy of the certification standard to the USPTO does not seem as though it would be burdensome, this is highly dependent on the specific certification program. A certification body that certifies only one type of product or service or has only a small number of applicable standards will not find it onerous to submit that handful of documents to the USPTO. On the other hand, many certification bodies certify a large body of products and services and test for compliance with a large number of standards. Compare, for example, Idaho Potatoes and Underwriters Laboratories (“UL”). The CERTIFIED GENUINE IDAHO POTATOES GROWN IN IDAHO mark certifies that the potatoes or

¹⁴ This requirement is due to a 2015 amendment to 37 C.F.R. § 2.45. Prior to 2015, a certification mark owner was not required to submit the standards of the certification mark.

¹⁵ 37 C.F.R. § 2.45(a)(4)(i)(B) (2026).

¹⁶ TMEP § 1306.03(b).

¹⁷ 37 C.F.R. § 2.161(a)(9)(i)(B).

¹⁸ TMEP § 1306.03(b).

¹⁹ *Id.*

potato products were grown in Idaho and meet a certain quality standard.²⁰ Its certification standard consists of seven pages from the U.S. Department of Agriculture.²¹ UL, on the other hand, has twenty-six distinct goods in just one application, including products like consumer electronics and power tools.²² To obtain its registration for all of those goods, UL was required to submit over 3,000 pages of standards to cover all the goods and services included in the application.²³ Further, if the certifying body is using standards written by a different organization, in view of copyright interests, it will need to purchase those standards for submission to the USPTO. The purchase price for hundreds of standards can add up to many thousands of dollars, increasing the total cost of the certification mark application process manifold.

Recognizing the cost burden on certifying bodies imposed by the submission of a large number of standards, the USPTO did try to mitigate this burden by providing that “[i]n the rare circumstance when it is impracticable to provide a copy of the standards, the USPTO may accept a permanent link or permanent URL to the applicant’s standards with a synopsis of those standards.”²⁴ The TMEP continues by stating this is not a “general alternative,” but may apply in situations where “it may be impracticable to include a copy of the standards if the standards exceed 1,000 or more pages.”²⁵ Though the USPTO has indicated that this is an option, companies and agencies such as UL LLC and the U.S. Environmental Protection Agency²⁶ are still submitting many thousands of pages of standards to the USPTO.

Because of this significant burden, certifiers must now decide which products are worth including in their certification mark applications. This is especially true for smaller companies that may be certifying multiple, one-off products. In order to avoid this burden, parties may decide to stop certifying certain goods.

2. Navigating the Standards Copyright Maze

The submission of copies of the standards also creates copyright concerns whenever the certification mark owner does not own the copyright to those standards. Under 17 U.S.C. § 106, the copyright owner has the exclusive right to reproduce and publicly display the

²⁰ CERTIFIED GENUINE IDAHO POTATOES GROWN IN IDAHO & Design, U.S. Registration No. 4,221,402.

²¹ *Id.*

²² UL & Design, U.S. Registration No. 2,391,140.

²³ *Id.*

²⁴ TMEP § 1306.03(b).

²⁵ *Id.*

²⁶ ENERGY ENERGY STAR & Design, U.S. Registration No. 6,406,228, submitting over 1,200 pages of standards in its application.

copyrighted work. If another person copies or publicly displays the work without permission, it constitutes copyright infringement.

When submitting a standard with the USPTO electronically, the applicant would be creating a copy of the certification standards. While the applicant could avoid this copyright problem by purchasing paper versions of the standards and physically delivering those paper editions to the USPTO, USPTO rules now prohibit paper submissions unless they fall under a limited set of exceptions.²⁷

Further, copies of the standards become part of the application file and can be viewed and downloaded by the public through the USPTO's web site. Displaying and making the standards downloadable in the USPTO public record, without the authorization of the standard's copyright owner, could arguably fall squarely into the definition of copyright infringement. That said, these uses could also arguably constitute fair use. Fair use, as a defense to copyright infringement, analyzes the following four factors: (1) the purpose and character of the use, including whether such use is commercial or for educational purposes or transformative of the original work; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used; and (4) the effect of the use on the potential market for the copyrighted work.²⁸ Here, the certifier would be using the entirety of the copyrighted standard and not transforming the underlying purpose of the standard, which could weigh against the first and third fair use factors. On the other hand, a certifier can argue that the submission of the standards does not further its commercial purpose, as the certifier does not earn direct revenue from the copying and use, nor does it displace the copyright owner's potential market or value of the copyrighted works, both of which could weigh in favor of the first and fourth fair use factors.

Thus, to comply with the USPTO's rules, the certifying body that does not own the copyright in the standards it tests must risk a copyright infringement claim from the author of the standards, or find other ways to legally use the standard, including the possibility of a license. To date, there are no reported cases of a certification body being sued for copyright infringement based on the submission of standards to the USPTO. And, should this issue arise, the certification mark applicant can argue that the copying of the standards constitutes "fair use." However, there is no guarantee

²⁷ Changes to the Trademark Rules of Practice To Mandate Electronic Filing, 84 Fed. Reg. 37081, 37083-84 July 31, 2019) (to be codified at 37 C.F.R. pts. 2, 7); *see also* U.S. Patent and Trademark Office, *USPTO rule makes electronic filing mandatory for trademark submissions*, <https://www.uspto.gov/trademarks/laws/mandatory-electronic-filing> (last visited Oct. 5, 2026) (discussing that a document must be submitted online unless it falls under a limited number of exceptions).

²⁸ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1993).

that the “fair use” defense will be successful. In short, the liability risk that the USPTO rules have thrust upon certifying bodies cannot be entirely discounted, and applicants should consider it when deciding their strategy for registering their certification marks.

IV. WALKING THE TIGHTROPE: UNIFORM APPLICATION OF THE CERTIFICATION STANDARDS

The Lanham Act contains a strict uniformity requirement for certification mark owners.²⁹ To maintain the validity of their mark, owners are legally obligated to certify the goods or services of *any* person or business that meets the certification standards. This means that a certification owner cannot deny parties that would otherwise qualify for the certification for arbitrary reasons. For example, the certification mark owner cannot deny an applicant for certification because it does not like that applicant or agree with its ethos. Likewise, the certification body cannot show favoritism by granting certification to parties that fail to meet its standards but instead must refuse certification to anyone who cannot pass the applicable tests and evaluations. In short, the certifying body must scrupulously apply its standards in an objective, uniform manner.

As a practical matter, this uniformity requirement does not usually arise during the examination phase of the certification mark application. Rather, this factor is more typically litigated in the USPTO’s Trademark Trial and Appeal Board (“TTAB”) when an application is opposed or a registration is threatened with cancellation. One such example of a party navigating this tightrope is *Swiss Watch International, Inc. v. Federation of the Swiss Watch Industry*. In this case, Swiss Watch International, Inc. (“Swiss Watch”) petitioned to cancel the registrations for two certification marks owned by the Federation of the Swiss Watch Industry (“Federation”).³⁰ Swiss Watch argued, among other things, that the Federation “discriminates in the granting of use of its certification mark.”³¹ Specifically, Swiss Watch argued that the Federation’s requirements that the watch movement be cased up in Switzerland and that the final inspection of the watch take place in Switzerland discriminated against Swiss watchmakers that use facilities outside of Switzerland for these last steps.³² The Board was ultimately unpersuaded, finding that Swiss Watch’s argument was not about the Federation acting in a discriminating manner by refusing to

²⁹ Lanham Act § 14, 15 U.S.C. § 1064(5)(D).

³⁰ *Swiss Watch Int’l, Inc. v. Fed’n of the Swiss Watch Indus.*, 101 U.S.P.Q.2d 1731, 1733 (T.T.A.B. 2012).

³¹ *Id.* at 1734.

³² *Id.* at 1741.

certify the goods of those who maintain the Federation's standards that its marks certify.³³ Rather, Swiss Watch was actually arguing that the Federation's standards are wrong.³⁴ The Board noted that "the statute requires only that the owner of the certification mark allow any entity that meets the standards, whatever the owner determines those standards to be, to use the mark."³⁵ The anti-discrimination rule does not permit a rejected certificant to challenge the substance of the certification standard.

Another balancing act can be found in a challenge to the validity of the Idaho Potato Commission's ("IPC") certification mark on the ground that IPC operated its certification program in a discriminatory manner.³⁶ In this case, IPC terminated its certification of products made by M & M Produce Farms & Sales ("M & M") on the ground that M & M failed to submit sufficient records to establish that its products were Idaho-grown potatoes. When M & M continued to use IPC's certification mark after termination, IPC sued. In response, M & M counterclaimed to invalidate IPC's certification marks, alleging that IPC's quality control and audit requirements "improperly impose[] standards on license applicants that do not relate to whether the marked potatoes come from Idaho, including background and credit checks, quality controls, and onerous record requirements."³⁷ When analyzing M & M's claims, the Court went back to the language of 15 U.S.C. § 1064(5)(D), and determined that certification "[m]ark holders cannot discriminate in issuing licenses based upon grounds unrelated to the certification mark, but they can condition licenses upon factors directly related to the certification mark, here insuring that the marked potatoes were grown in Idaho."³⁸ The Court initially granted IPC's motion for summary judgment, dismissing M & M's discriminatory refusal to certify the claim, and held that IPC did not discriminate in refusing to certify, but was instead maintaining valid control of its certification program because the IPC's recordkeeping requirements directly related to its certification mandate.³⁹ However, on a motion for reconsideration, the Court reversed its opinion and held that there were genuine issues of material fact as to whether "any additional records requirements, such as the ones IPC s[ought] to impose [sic], [wa]s a discriminatory refusal to

³³ *Id.*

³⁴ *Id.*

³⁵ *Id.*

³⁶ Idaho Potato Comm'n v. M & M Produce Farms & Sales, No. 7:97-cv-8125, 2009 WL 10739846, *9 (S.D.N.Y. Nov. 3, 2009).

³⁷ *Id.*

³⁸ *Id.*

³⁹ *Id.*

certify.”⁴⁰ Thus, not only does a certification mark owner need to apply its certification standards uniformly across the board, but it also must take care not to refuse certification to parties based on factors that could be considered unrelated to the program itself.

For certification mark owners, enforcing the standards requires the owner to be perfectly balanced on the tightrope: the owner cannot be overinclusive and permit parties who do not meet the standards to be certified, nor can the owner be underinclusive and exclude parties for arbitrary reasons when their goods or services meet the defined certification standards. Should the owner fail to meet this requirement, it opens itself up to litigation or the possibility that its certification mark will be cancelled.

V. PRESSING THROUGH THE MUD: EXERCISING CONTROL OVER USE OF THE CERTIFICATION MARK

A certification mark owner must also declare in its application that it “exercise[s] legitimate control over the use of the [certification] mark in commerce” and “that to the best of the [owner’s] knowledge and belief, no other persons, *except authorized users*, have the right to use the mark in commerce.”⁴¹ Further, failure to exercise control over use of the mark by those that have been certified is grounds for cancellation of any certification mark registration.⁴²

As a practical matter, this requirement means that the certification mark owner must periodically monitor how the certification mark is used, whether there are any infringing uses, or whether parties that are certified continue to meet the applicable standards. This requirement was created “to protect the value of the mark and its significance as an indication of source, and to prevent the public from being misled or deceived as to the source of the product or its genuineness.”⁴³

Although the affirmation of control is a requirement during the application process, the sufficiency of a certifying body’s control over the certification mark typically arises when the validity of a certification mark registration is being challenged. For example, in *Tea Board of India v. Republic of Tea Inc.*, Republic of Tea (“Republic”) counterclaimed to cancel the certification mark of Tea Board of India (“Tea Board”) because Tea Board allegedly failed to

⁴⁰ Idaho Potato Comm’n v. M & M Produce Farms & Sales, No. 7:97-cv-8125, 2009 WL 10739844, *2 (S.D.N.Y. Dec. 2, 2009).

⁴¹ TMEP § 1306.02(b)(i) (emphasis added).

⁴² Lanham Act § 14, 15 U.S.C. 1064(5)(A).

⁴³ Tea Bd. of India v. Republic of Tea Inc., 80 U.S.P.Q.2d 1881, 1886 (T.T.A.B. 2006).

control third-party use of the mark DARJEELING.⁴⁴ Republic specifically argued that DARJEELING lost its significance as an indication of source, and that the general consuming public understands the term to mean a certain kind of tea.⁴⁵ Republic pointed to Tea Board's "failure to police the mark resulting in unlicensed and unregulated third-party usage, years of uncontrolled use prior to implementation of the formal certification program in 1987, and deficiencies in the regulations themselves."⁴⁶ In response to these arguments, the Board noted that "[t]he statute does not define 'control' or indicate the degree of control required, but it is clear that absolute control would be impracticable, if not impossible."⁴⁷ Here, Republic "introduced no evidence that the Tea Board did not in fact adequately control the use of the mark during the time prior to the implementation of the formal certification mark program in 1987," and "the mere fact of misuse, just like the mere absence of formal control, is not sufficient to raise an inference that the control was not adequate or that DARJEELING has lost all significance as a mark."⁴⁸ The Board further elaborated that "[e]ven if control is not maintained and misuse occurs, it must be shown that the misuse was of such significance to permit an inference that the mark is generic."⁴⁹ Moreover, Tea Board demonstrated that "control was in fact maintained, and that the misuse was not tolerated and did not go unaddressed."⁵⁰

The Federal Circuit has also provided guidance on the level of control a certifier is expected to exercise in *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.* In this case, Midwest Plastic Fabricators, Inc. ("Midwest") appealed the decision of the USPTO, denying Midwest's petition to cancel two certification marks owned by Underwriters Laboratories Inc. ("UL").⁵¹ Midwest argued that UL failed to control use of its certification mark because (1) Midwest's independent tests of UL certified products showed that some of the tested products failed to meet UL's standards, and (2) UL did not eliminate counterfeit UL marks on uncertified competitor's products.⁵² In analyzing Midwest's allegations, the Federal Circuit determined that the "control" requirement for certification marks "means the mark owner must take reasonable

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ *Id.* at 1886-87.

⁴⁷ *Id.* at 1888.

⁴⁸ *Id.*

⁴⁹ *Id.* at 1888.

⁵⁰ *Id.* at 1889.

⁵¹ *Midwest Plastic Fabricators, Inc. v. Underwriters Lab'ys Inc.*, 906 F.2d 1568, 1569 (Fed. Cir. 1990).

⁵² *Id.*, 906 F.2d at 1572-73.

steps, under all the circumstances of the case, to prevent the public from being misled.”⁵³ Specifically, the Board found that UL has “a vast network of inspectors making hundreds of thousands of inspections of thousands of different products across the country.”⁵⁴ With respect to the UL certified products that failed Midwest’s independent testing, the Board found that Midwest’s tests were unreliable and did not replicate test conditions used by UL in determining the certifiability of the products.⁵⁵ As to the counterfeiting allegation, the Board determined that the limited nature of the counterfeiting problem was not sufficient to cancel UL’s registrations and that UL exercised control over the unauthorized use of its certification marks “based on findings about UL’s responsiveness and the stringency of its corrective action.”⁵⁶ As neither of these Board findings were clearly erroneous, the Federal Circuit affirmed the Board’s decision.⁵⁷

As shown by the above examples, litigating these cases can be a slog. These claims require proof that the certification mark owner is taking steps to protect and control its certification mark. Thus, it is important for the certification body to maintain records showing that it has indeed exercised control over use of the mark. This can include not only keeping records of infringing uses and the steps taken to stop such use, but also records demonstrating that the certification body has withdrawn permission to use the mark when a previously certified party no longer meets the standards.⁵⁸

VI. STAYING ON THE LOG: USING CERTIFICATION MARKS SOLELY TO CERTIFY

The Lanham Act also requires that the certification mark be used solely to certify, meaning that the mark cannot be used as an identification of source.⁵⁹ The certifying body’s registration for the certification mark may be cancelled if the mark is found to have been used for any other purpose than to certify.⁶⁰ Due to these

⁵³ *Id.*

⁵⁴ *Midwest Plastic Fabricators Inc. v. Underwriters Lab’ys Inc.*, 12 U.S.P.Q.2d 1267, 1273 (T.T.A.B. 1989).

⁵⁵ *Id.* at 1273.

⁵⁶ *Id.* at 1274.

⁵⁷ *Midwest Plastic Fabricators, Inc.*, 906 F.2d at 1573.

⁵⁸ *See, e.g., Swiss Watch Int’l, Inc. v. Fed’n of the Swiss Watch Indus.*, 101 U.S.P.Q.2d 1731, 1739 (T.T.A.B. 2012) (discussing that the Federation was able to show control with evidence that it: (1) monitors trademark applications in Class 14 worldwide and files opposition proceedings; (2) monitors watch magazines for use of similar marks; and (3) inspects watches that have been seized by police forces or customs).

⁵⁹ TMEP § 1306.01(b).

⁶⁰ Lanham Act § 14, 15 U.S.C. § 1064(5)(C).

constraints, certification marks and standard trademarks are mutually exclusive.⁶¹ One example of a party rolling off the log occurs in *In re Monsanto Co.*, whereby the Board refused registration of the certification mark WEAR DATED, which purported to certify that manufacturers' products contain Monsanto's fibers and comply with quality standards imposed by Monsanto.⁶² However, despite having the right elements for its certification mark, Monsanto's application was denied because Monsanto also owned a trademark for WEAR DATED, covering suits, slacks, and sweaters.⁶³ The Board affirmed the denial and determined that there was no meaningful difference between the trademark and the certification mark application.⁶⁴

Because it is often necessary to include the name of the certifying body in both the certification mark and the mark used to identify the certifying service, this requirement can create some complications. The best way for a certification mark owner to address the requirement that its certification mark be used solely by others for certification purposes is to develop a distinct logo for the certification of the goods and services it tests, and a separate word mark or logo for its own branding. One example is UL. It has one house logo and word mark for its own branding and one mark for its certification program, both shown below:

UL⁶⁵



Both marks encompass the word “UL” and cover similar types of goods and services, but because the certification mark logo looks completely different from the organization’s corporate name and logo, consumers would not be confused as to which mark is used to identify products that have met UL’s quality and safety requirements and which mark identifies the organization’s own testing services and other programs.

⁶¹ *In re Celanese Corp. of Am.*, 136 U.S.P.Q. 86, 88 (T.T.A.B. 1962) (refusing registration for a trademark registration because the mark HONOR ROLL “serves merely as a guarantee that the product has been made of applicant’s plastic material rather than as a trademark to distinguish the toys produced therefrom from like toys of others.”).

⁶² *In re Monsanto Co.*, 201 U.S.P.Q. 864, 866 (T.T.A.B. 1978).

⁶³ *Id.*

⁶⁴ *Id.* at 870.

⁶⁵ UL, U.S. Registration No. 4,201,014 (registering various services including “providing electrical, flammability, mechanical, chemical, environmental, lighting protection and electromagnetic compatibility testing pursuant to national and international standards and other specimens” in Class 42).

⁶⁶ UL & Design, U.S. Registration No. 782,589 (certifying various types of goods including electrical equipment, building materials, and firefighting and fire prevention equipment).

VII. MAKING THE FINAL TURN TOWARD HOME: SUBMITTING SPECIMENS SHOWING USE

In the United States, all trademark applications and registrations will eventually require the submission of specimens to establish how the marks are being used in U.S. commerce.⁶⁷ The registration of certification marks puts a different spin on this requirement, however. Unlike regular trademark specimens that show how the *applicant* uses the mark, a certification mark specimen must show how those *who are certified* use the mark.⁶⁸ Thus, specimens submitted with a certification mark cannot be specimens that are circulated by the certification mark owner to promote its certification program. Rather, the certification mark owner must submit specimens showing that in the case of goods the certification mark appears on products themselves or their labels and packaging, and in the case of services, on promotional materials promoting the certified services. In order to demonstrate this, the certification mark owner must submit a declaration with an approximate date when the products and services were first certified. Though this seems like a fairly straightforward task, it may cause challenges, as it requires the certifying bodies to cooperate with their certificants to find appropriate specimens. In cases where the certifications are clearly labeled on products, such as food products certified to contain CERTIFIED GENUINE IDAHO POTATOES GROWN IN IDAHO potatoes, this requirement may be easier, as shown below:

⁶⁷ U.S. Patent and Trademark Office, *Drawings and specimens as application requirements*, <https://www.uspto.gov/trademarks/basics/drawings-and-specimens> (last visited Oct. 5, 2026).

⁶⁸ TMEP § 1306.02(a)(i)(B) (“A certification mark specimen must show how a person other than the owner uses the mark to reflect certification of regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of that person’s goods or services; or that members of a union or other organization performed the work or labor on the goods or services”), citing 37 C.F.R. § 2.56(b)(5).



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However, for certifications of services, it may be more difficult to find an acceptable specimen of the certification mark in use. Some acceptable uses can include displaying a certificate from the certifying body at the location where the services are rendered or on advertisements promoting the certification mark by a third party, as shown below by CP and CP CERTIFIED PARALEGAL & Design.



NALA CREDENTIAL GUIDELINES

Use this reference sheet as a guide to help you with the rules and regulations governing the use of the certification marks granted by NALA for use by paralegals. The rules are based on federal law, which dictates certain restrictions on the use of all registered trademarks, and are intended to protect the integrity of the marks. Please consult this guide when promotional literature, business cards, letterhead, and any other communication which features the certification marks are being prepared for you.

These marks were developed to provide you with a recognizable visual symbol with which to gain differentiation in the marketplace. If either mark is used in a way that denotes generic use (to describe a broad group of individuals or services) it could eventually lose its certification mark status. Your full support and cooperation are necessary for the certification marks' effective implementation and the public's ultimate recognition of the high professional qualities for which the marks stand.

ABOUT OUR CERTIFICATION MARKS

The certification marks are a distinctive visual symbol that indicates an individual is qualified to provide paralegal services by virtue of having 1) completed the education and examination requirements for certification by the National Association of Legal Assistants; 2) agreed to adhere to the Code of Ethics and Professional Responsibility of the National Association of Legal Assistants; 3) agreed to continuing education requirements to maintain the national certification; and 4) completed an ACP course*. The certification marks cannot be used by individuals who have not met these requirements and their use may be revoked for failure to comply with ethical standards and recertification requirements.

* Applies only for the ACP®

TYPES OF NALA CREDENTIALS

Certified Paralegal (CP®): Successful completion of both certification exam sections (*Knowledge and Skills*) is required to obtain the CP® credential.

	is a certification mark duly registered with the U.S. Patent and Trademark Office (Regis. No. 2864940).		is a certification mark duly registered with the U.S. Patent and Trademark Office (Regis. No. 3048617).
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Advanced Certified Paralegal (ACP®): The distinguished ACP® credential is **only** available to current Certified Paralegals (CP®); however, if the CP Exam is passed within one-year of completing an advanced course, the ACP® credential will be awarded.

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69 CERTIFIED GENUINE IDAHO POTATOES GROWN IN IDAHO & Design, U.S. Registration No. 4,221,402.

70 CP, Registration No. 2,864,940; CP CERTIFIED PARALEGAL, U.S. Registration No. 3,048,617.

The Board's analysis in *In re Council on Certification of Nurse Anesthetists* provides clear analysis of what specimens are acceptable or prohibited for service certification marks. In this case, the Council on Certification of Nurse Anesthetists ("CCNA") was registering the certification mark CRNA for nurse anesthetists.⁷¹ The application was initially refused on the ground that "use of the designation CRNA on the specimens of record conveys only the commercial impression of a title or degree," among other grounds.⁷² There, the CCNA submitted specimens including an examination for nurse anesthetists, a candidate handbook; guidelines; and a photograph of a person wearing a baseball hat and an apron, shoelaces, a badge, and a promotional sheet, all of which used variations of the CRNA mark and would be seen by the ultimate recipients of the services.⁷³ The Board determined that the sample certificate, brochure, and literature all showed the requirements needed to qualify to use the CRNA designation.⁷⁴ Thus, the Board determined that all such specimens clearly showed the CRNA mark as a certification mark, not just as a trademark.⁷⁵ Similarly, the case of *In re National Institute for Automotive Service Excellence* demonstrates a similar lesson in which the Board reversed the Examiner's refusal to register the below mark, and determined that the specimens indicated use of the mark as a certification mark.



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The certifying body in this case, the National Institute for Automotive Service Excellence, submitted specimens that included cloth insignia to be worn by individuals who were certified by the applicant.⁷⁷ The Board disagreed with the Examiner's argument that the specimens failed to prove the mark was being used to certify individuals. Instead, the Board determined that "applicant's design

⁷¹ *In re Council on Certification of Nurse Anesthetists*, 85 U.S.P.Q.2d 1403 (T.T.A.B. 2007).

⁷² *Id.* at 1405.

⁷³ *Id.* at 1406-07.

⁷⁴ *Id.* at 1410.

⁷⁵ *Id.*

⁷⁶ *In re Nat'l Inst. for Auto Serv. Excellence*, 218 U.S.P.Q. 744 (T.T.A.B. 1983).

⁷⁷ *Id.* at 745.

is used in applicant's specimens and literature in the manner of a certification mark for services."⁷⁸

At this point in the trademark prosecution, the certifier is almost at the finish line. It has met almost every other requirement and just needs to prove to the Examiner how its mark is used to certify goods or services. Thus, when a certifier is considering what specimens it should provide to the Examining Attorney, it should be cognizant of how the certification mark is displayed and whether it truly shows the goods or services being certified.

VIII. DIFFERENCES IN THE COURSE OF DOMESTIC AND FOREIGN CERTIFICATION REGISTRATION

A. The Simplified Classification System for U.S. Certification Marks: An American Shortcut

Standard trademark and service mark applications require that the applicant list the goods and services covered by the application and categorize those goods and services in forty-five separately numbered classes, known as the Nice Classification system, which has been adopted by most countries for use by their respective trademark offices.⁷⁹ For example, Nice Class 1 covers chemicals for use in industry, science, and photography, while Nice Class 2 covers paints, varnishes, and lacquers. In theory, every conceivable product or service falls within one of the Nice Classifications. Official trademark application filing fees are typically calculated by the number of Nice Classes covered by the application. The United States has also adopted the Nice Classification system for all standard trademark and service mark applications. However, the United States has created a sort of shortcut outside the Nice Classifications for certification marks, which may be submitted only under two classes that are NOT part of the Nice system: Class A and Class B. Class A relates to the certification of any physical product—for example, certifying electrical equipment.⁸⁰ Class B, on the other hand, is for the certification of services,—for example, paralegal services.⁸¹ The USPTO's simple, two-class system for certification

⁷⁸ *Id.* at 747.

⁷⁹ World Intell. Prop. Org., *Frequently Asked Questions: Nice Classification*, <https://www.wipo.int/en/web/classification-nice/faq> (last visited Oct. 5, 2026) (discussing that around 150 offices in the world apply the Nice Classification).

⁸⁰ UL UL & Design, U.S. Registration No. 3,934,920 (registering “Electrical equipment, usually not of a voltage exceeding 600 volts; lighting equipment; electrical appliance and utilization equipment; electrical construction equipment” in Class A).

⁸¹ CP CERTIFIED PARALEGAL, U.S. Registration No. 3,048,617 (registering “paralegal services in the nature of conducting legal research, composing and drafting legal documents and pleadings, conducting client and witness interviews, and trial and courtroom paralegal services” in Class B).

marks stands in stark contrast to most foreign governments, which require that certification mark owners list the certified goods and services separately in each of the applicable forty-five different Nice Classes and pay a separate filing fee for each class listed in the application. Because of the different classification systems, registration for certification marks in the United States is more affordable for large scale certification programs that certify products across a large number of Nice Classes. For example, a registrant like UL, whose applications often contain a wide array of goods, is required to pay for only one class (Class A) in the United States, while they may be required to pay across multiple Nice Classes for foreign registrations depending on the type of goods being certified. Although the U.S. system may be more expensive in some ways due to the additional requirements discussed above, the savings in filing fees provided by the U.S. certification mark system can be substantial in some cases.

***B. Different Countries, Different Hurdles:
The Varying Requirements for Certification Mark
Registration in Countries Across the Globe***

The path to registration of certification marks can be even more arduous outside the United States.

In several foreign jurisdictions, the applicant must submit proof of having the authority or expertise to certify goods and services in their field. For example, in New Zealand, the trademark office requires a certification owner to establish that it is “competent to certify the goods or services in respect of which the certification mark is to be registered.”⁸² Evidence can include the form of declarations or letters from reputable people in the relevant field that attest to the applicant’s reputation in the trade.⁸³ It may also include documentary evidence proving the applicant’s ability to certify particular goods or services.⁸⁴

In other countries, like Australia, the standard submitted with the certification mark is reviewed substantively and must be approved by an independent government agency.⁸⁵ For example, in

⁸² Trade Marks Act 2002, § 55(1)(c) (N.Z.); see also N.Z. Intell. Prop. Office, *Practice Guidelines*, <https://www.iponz.govt.nz/get-ip/trademarks/practiceguidelines/current/certification-marks/#fnref:26> (last visited July 6, 2026).

⁸³ N.Z. Intell. Prop. Office, *Practice Guidelines*, <https://www.iponz.govt.nz/get-ip/trademarks/practice-guidelines/current/certification-marks/#fnref:26> (last visited July 6, 2026).

⁸⁴ *Id.*

⁸⁵ Australian Competition & Consumer Comm’n, *Certification trade marks*, <https://www.accc.gov.au/business/competition-and-exemptions/exemptions-from-competition-law/certification-trade-marks> (last visited Oct. 5, 2026) (discussing that ACCC approval of the certification standards is required before a new certification mark can be registered by IP Australia).

Australia the applicant submits its certification mark application to the Registrar of Trademarks at IP Australia, who reviews the application for the general requirements. Then, if the application passes this stage, the Registrar sends the application to the Australian Competition & Consumer Commission (“ACCC”) to assess the standards and the certification mark rules.⁸⁶ At this point, the ACCC assesses that the applicant has the ability to successfully certify other entities and that the specimen and rules are not a detriment to the public by restricting market entry or misleading as to what is being certified.⁸⁷

Some countries do not permit certification mark programs for the same broad, open-ended range of qualities and characteristics that are allowed in the United States. For example, the European Union (“EU”) does not permit private bodies to certify the geographical origin of the product.⁸⁸ This was a point of contention in the EU’s acceptance of certification marks as a whole, as the various government entities controlled, and still control, the designation of products being from a certain region (such as Champagne or Gruyere). As a compromise with these governmental entities, the EU permitted certification marks to encompass “material mode of manufacture of goods or performance of services, quality, accuracy or other characteristics,” but expressly excluded the ability for certification marks to encompass the possibility of certifying geographic origin.⁸⁹

Finally, some countries, such as Saudi Arabia, Kuwait, and Qatar, do not provide a legal framework for certification mark registration at all. In such cases, the certification owner may need to register the certification mark as a regular trademark and argue that all those that it certifies in that country are merely trademark licensees. However, it is unclear how this might affect enforcement in these countries against infringers who falsely claim to be certified.

Thus, when considering the scope and nature of one’s certification program, a certification mark owner should be cognizant of the various routes and obstacles in foreign countries.

IX. THE FINISH LINE

The process of getting a certification mark registered is like navigating an obstacle course. There are multiple requirements that

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ EU Intell. Prop. Off., Guidelines for Examination of EU Trade Marks, pt. B, § 4, ch. 16, sec. 2.1 (2026) (discussing that certification marks excludes the possibility of certifying the geographical origin of goods or services).

⁸⁹ *Id.*

are special to certification marks and make the application process much more complex than the average trademark.

Though there are several steps a certification mark owner needs to be aware of prior to filing its certification mark application, the certification mark obstacle course is not nearly as daunting if the certifier is aware of what is to come and takes steps to organize its materials prior to filing. Having a plan to collect the standards and specimens, an effective way to control the program, and a system to audit and record compliance with standards will all help prepare the certifier to walk the tightrope that is certification mark registration. The certifier should further consider the scope of its certification mark program and whether it will need any additional evidence to support foreign filings, or even whether certification marks exist. The below checklist is a non-exhaustive list of questions to consider in order to best prepare for the application process.

- Is the certification mark program for goods or services?
- What is the scope of the certification mark program?
- How many goods or services are being certified, and does each one need its own standard?
- Is the standard specifically created or purchased from another source? If it is purchased, what steps need to be taken in order to limit the risk of copyright infringement?
- How is the certification mark going to be enforced against infringers? Demand letters? Monitoring trademark registrations and applications?
- How is the certification mark going to be enforced against certifiers who do not comply with the standards? Routine auditing? How long does a party have to fix their improper use?
- If needed in certain jurisdictions like the United States, what specimens are going to be used to support the application?

All these questions help avoid dead ends and get the certifier to the finish line. Thus, while the application and prosecution process relating to certification marks can feel like an obstacle course, understanding each step and the purpose behind every requirement can make this process more easily navigable.

**A PRACTITIONER’S PRÉCIS OF THE
2025 “REFERENCE GUIDE ON SURVEY RESEARCH”:
KEY REVISIONS IN THE FEDERAL JUDICIAL
CENTER’S *REFERENCE MANUAL ON SCIENTIFIC
EVIDENCE*, FOURTH EDITION***

*By David T. Neal, PhD***

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In 2025, the Federal Judicial Center and the National Academies of Sciences, Engineering, and Medicine published the Fourth Edition of their *Reference Manual on Scientific Evidence*¹—the first update since 2011. Among the revised chapters is the “Reference Guide on Survey Research,”² now authored by Shari Seidman Diamond, Matthew B. Kugler, and James N. Druckman (the first three editions were by Professor Diamond alone).³ The Guide has gained two co-authors and absorbed fifteen years of methodological evolution—most visibly the dominance of Internet surveys and nonprobability panels.

For attorneys and survey experts who develop and critique surveys in litigation, the question is what these revisions mean in practice: which aspects of the Guide’s framework have genuinely changed, and which have simply been restated in updated language?

This article summarizes the Fourth Edition (hereafter, “the Guide”), identifying what is new, what has been removed, what has shifted in emphasis, and what remains unchanged.

I. THE BIG PICTURE

The overall structure of the Fourth Edition generally mirrors its predecessor. The Guide still moves from purpose and design, through population definition and sampling, to survey questions, data collection, data entry, and disclosure requirements. But the Guide now reflects a world in which the overwhelming majority of litigation surveys are conducted online using managed nonprobability panels.

With the notable exceptions identified below, the Guide’s foundational principles, including elements such as probability sampling theory, question-design standards, order-effect controls, and the logic of control groups, remain substantively unchanged.

¹ Nat’l Acads. of Scis., Eng’g & Med. & Fed. Jud. Ctr., *Reference Manual on Scientific Evidence* (4th ed. 2025).

² Shari Seidman Diamond, Matthew B. Kugler & James N. Druckman, *Reference Guide on Survey Research*, in Nat’l Acads. of Scis., Eng’g & Med. & Fed. Jud. Ctr., *Reference Manual on Scientific Evidence* (4th ed. 2025) 681, 681 (hereinafter “the Guide” or “Fourth Ed.”).

³ See Shari Seidman Diamond, *Reference Guide on Survey Research*, in Fed. Jud. Ctr. & Nat’l Rsch. Council of the Nat’l Acads., *Reference Manual on Scientific Evidence* (3d ed. 2011) 359, 359 (hereinafter “Third Ed.”).

II. WHAT IS NEW IN THE FOURTH EDITION?

A. Updated MCL4 Factors⁴

The Fourth Edition closes with an updated set of factors for judges, drawn from—and explicitly building on—the *Manual for Complex Litigation*, Fourth (“MCL4”), published in 2004.⁵ The MCL4 listed seven factors organized into two groups. The first group contains four factors that relate generally to sampling and data analysis: (a) whether the population was properly chosen, (b) whether the sample was representative, (c) whether the data were accurately reported, and (d) whether the data were analyzed following accepted statistical principles. In the second group, three additional factors are identified for surveys seeking to measure people’s perceptions, attitudes, or behaviors: (e) whether the questions were clear and not leading, (f) whether the survey was conducted by qualified persons following proper interview procedures, and (g) whether the survey process was conducted so as to ensure objectivity. The Guide’s revised list consolidates these into a single eight-factor framework.⁶ The specific changes are:

- *Sampling frame added:* The MCL4’s “the sample chosen was representative of that population” becomes “the sampling frame and the sample itself were representative of that population.” This change adds sampling-frame adequacy as an explicit consideration.
- *Reporting expanded:* The MCL4’s “the data gathered were accurately reported” becomes “the data and details on data collection were fully and accurately reported.” This change stipulates disclosure of the underlying data, generally including any data that was excluded by the expert, along with disclosing the data-collection methodology and results.
- *“Interview procedures” broadened:* The MCL4’s “qualified persons following proper interview procedures” becomes “qualified persons following proper procedures”—dropping “interview.” This change reflects that most litigation surveys are now self-administered online rather than interviewer-administered.
- *Explicit linking of objectivity to litigation awareness removed:* The MCL4’s guidance to consider “whether the process was conducted so as to ensure objectivity” included as an indicator whether “the survey was conducted in anticipation of litigation and by persons connected with the parties or counsel or by persons aware of its purpose in the

⁴ Fourth Ed. at 743; no Third Ed. corresponding concluding checklist.

⁵ Manual for Complex Litigation, Fourth § 11.493 (Fed. Judicial Ctr. 2004).

⁶ Fourth Ed. at 743.

litigation.” The Fourth Edition’s revised list does not carry this language forward. This change recognizes that objectivity is properly assessed through the survey’s methodology (including design, implementation, analysis, and reporting), whether or not the survey was conducted in anticipation of litigation.

- *Two new factors added:* The Fourth Edition added the question whether “statements about causal relationships were supported by sufficient evidence about causality,” which reflects the increased emphasis on survey-experimental design for causal claims. The Fourth Edition also adds the question whether “the results were presented in accordance with statistical standards,”⁷ which reflects a general standard of statistical presentation.

Finally, I note that the revision moves away from the MCL4’s distinction between factors relevant to admissibility versus weight, arguing that all factors in the Fourth Edition’s revised set can, depending on quality, impact either admissibility or weight.⁸

B. A New Section on Conjoint Analysis⁹

Entirely absent from the Third Edition, conjoint analysis now has its own subsection—a reflection of the use of conjoint analysis in certain intellectual property cases (primarily where damages or materiality are at issue). The Guide describes the standard design—randomly assigned product profiles with regression-estimated part-worths—used to estimate the value consumers place on a single feature of a multi-feature product. It identifies several contested methodological issues, each of which can substantially affect the resulting damages estimate:

- Whether omitting important product features inflates the estimated value of the feature at issue.
- Whether feature descriptions draw more attention than consumers might naturally devote to them.
- How to account for supply-side factors, including whether market conditions have changed due to infringement.
- Whether a “none of the above” option should be included.
- How many features can be listed (e.g., debate exists about whether survey respondents can process more than seven features).

⁷ *Id.*

⁸ Fourth Ed. at 743 n.240.

⁹ Fourth Ed. at 722–25; no Third Ed. counterpart.

The Guide characterizes conjoint analysis as potentially useful but notes that “there are many decisions made in designing a conjoint analysis that can undermine reliability and bias the resulting estimates,”¹⁰ calling for “a detailed explanation of those decisions”¹¹ given the complexity involved.

*C. Expanded Guidance on Internet Survey Quality Control and Fraud Detection*¹²

The Third Edition’s Internet survey section focused primarily on the Internet access gap (Internet penetration had not yet reached telephone-level coverage) and the spectrum from “list-based” surveys to “self-selected pseudosurveys.” The Fourth Edition retains that spectrum but adds substantial new material on data-quality assurance for Internet panels:

- *Fraud and duplicate-response safeguards:* The Guide describes CAPTCHA questions, cookie-based duplicate-submission prevention, and platform-level fraud auditing.
- *Quality control checks:* The Guide describes quality control items (e.g., including nonexistent products on purchase-history lists) and consistency screens (e.g., excluding respondents who categorize all items identically in a genericness survey). These methods reflect a broader set of quality-assurance tools, including CAPTCHA items, gibberish analyses, and response-time screens.
- *Vendor accountability:* The Guide advocates that researchers “obtain the procedures used by the vendor to ensure the quality of the data,”¹³ including what steps the vendor took to minimize fraudulent and duplicate respondents and whether the vendor outsources sampling.

The Guide emphasizes that there is “constant evolution in the fraud-detection domain” and that a researcher should ensure that they and their panel provider are “using current best practices to detect fraudulent responses.”¹⁴ At the same time, it cautions that courts “should not treat the methods described here as a comprehensive checklist,” and that “no particular check is independently necessary or sufficient, but use of appropriate checks is required to ensure quality when the respondent is completing the survey online.”¹⁵

¹⁰ Fourth Ed. at 723.

¹¹ Fourth Ed. at 725.

¹² See especially Fourth Ed. at 730–33; cf. Third Ed. at 406–08.

¹³ Fourth Ed. at 732.

¹⁴ *Id.*

¹⁵ Fourth Ed. at 733.

*D. Professional Respondents*¹⁶

The Fourth Edition formally names the repeat-respondent issue mentioned in the Third Edition: some panel respondents participate in multiple surveys over time, creating a risk of “professional respondents” whose responses may differ from respondents who do not participate in multiple surveys. The Fourth Edition also offers concrete steps to address this issue, recommending that researchers ask about and disclose prior participation, consider excluding participants who have completed similar surveys, and evaluate whether prior participation had differential effects on outcomes.

*E. Expanded Disclosure: The AAPOR Framework*¹⁷

The Third Edition included a ten-item list of recommended disclosures that should generally be made in expert reports documenting a survey; the list was adapted from the Council of American Survey Research Organizations.¹⁸ The Fourth Edition replaces this with a twelve-item list explicitly tied to the American Association for Public Opinion Research (“AAPOR”) guidelines. Notable additions and expansions in the Fourth Edition are as follows.

- *Administrative and Recruitment*: Item 1 now explicitly recommends naming the research sponsor, and Item 3 has been expanded to include respondent compensation and the name of the panel vendor used.
- *Dates of Data Collection*: Explicitly recommended as a discrete item (Item 5).
- *Electronic questionnaire screenshots*: Item 6 notes that a report should include “screenshots of the questionnaire as viewed by respondents if administered electronically.”¹⁹ It also recommends documenting all randomization and experimental variations within the questionnaire.
- *Data-processing transparency*: Item 8 recommends reporting “validity checks such as measures of the time respondents took to complete the survey, any data-imputation procedures, criteria for removing any responses.”²⁰
- *Acknowledgment of any limitations*: Item 12 provides a new standalone recommendation to identify any limitations in the survey.

¹⁶ Fourth Ed. at 740; Third Ed. at 408.

¹⁷ See especially Third Ed. at 415–16; Fourth Ed. at 738–39.

¹⁸ Third Ed. at 416 n.240.

¹⁹ Fourth Ed. at 738–39.

²⁰ Fourth Ed. at 739.

Although not formally included in the new twelve-item list, the Guide elsewhere adds a further recommendation:

- *Respondent attentiveness*: A recommendation to include evidence that respondents were “attentive and honest,”²¹ which is linked, in turn, to various quality control methods mentioned throughout the Guide (e.g., CAPTCHA, bot detection, panel quality controls, gibberish analyses, and fictitious items serving as red herrings).

F. Digital-Era Confidentiality²²

The Third Edition’s confidentiality discussion specified removal of identifying information, including names, addresses, and telephone numbers. The Fourth Edition adds panel ID numbers, IP addresses, and precise geolocation data to the list of information that should generally be removed from data files shared beyond the survey expert. The Guide now also discusses heightened protections for small or easily identifiable populations, such as workplace surveys where demographic factors may narrow respondents to one or a few individuals.

III. WHAT WAS REMOVED FROM THE FOURTH EDITION?

The Guide removes very little substantive content present in the Third Edition. The primary exception is the Fourth Edition’s streamlined Introduction, which eliminates a historical discussion of surveys under *Daubert v. Merrell Dow Pharmaceuticals*, 509 U.S. 579 (1993), and a discussion of public-opinion surveys used to assess community standards, centering on *Atkins v. Virginia*, 536 U.S. 304 (2002). For most purposes, the removal of these sections is likely immaterial to the Guide’s concrete recommendations.

IV. WHAT SHIFTED IN EMPHASIS OR SUBSTANCE?

A. The Response-Rate Target Is Gone²³

The Third Edition suggested that “high response rates (i.e., 80% or higher) are desirable.”²⁴ The Fourth Edition drops the 80% figure, stating only that “Although high response rates are desirable because they reduce the potential impact of nonresponse bias, they are increasingly difficult to achieve.”²⁵ The Fourth Edition adds:

²¹ See, e.g., Fourth Ed. at 684, 732.

²² See especially Third Ed. at 417-418; Fourth Ed. at 741-42.

²³ See especially Third Ed. at 384-385; Fourth Ed. at 703-05.

²⁴ Third Ed. at 384.

²⁵ Fourth Ed. at 704.

“Generally, the representativeness of a sample (regardless of response rate) matters much more for accurate inference than the response rate,”²⁶ and echoes the Third Edition’s acknowledgement that “Surprisingly comparable results have been obtained in many surveys with varying response rates, suggesting that surveys may achieve reasonable estimates even with relatively low response rates.”²⁷

B. Weighting Procedures Get Expanded Treatment²⁸

The Third Edition discussed weighting (i.e., the statistical process of giving certain responses greater or lesser influence on sample results) more briefly and in limited contexts. The Fourth Edition provides a detailed treatment of weighting, acknowledging its potential value in some circumstances, but identifying three specific challenges: (1) the researcher must know true population proportions or the weights are “largely guesses”;²⁹ (2) weighting does not increase actual sample size and, in fact, “decreases the precision of estimates, leading to larger confidence intervals”;³⁰ and (3) weighting “cannot correct for unobserved factors”³¹—for example, if the surveyed members of a subpopulation are atypical, weighting cannot make them representative.

C. Internet Surveys: Expanding from Coverage Concerns to Data-Quality Concerns³²

The Third Edition’s Internet-survey discussion was dominated by the access gap (“Internet access has not approached the 95% penetration achieved by the telephone.”³³). The Fourth Edition treats Internet access as largely resolved (given that ~96% of U.S. adults and 99% of 18–49-year-olds have Internet access as of 2024)³⁴ and pivots to data quality as the central issue. The new focus areas—fraud detection, attention checks, vendor accountability, professional respondents—are detailed in Section II above.

²⁶ *Id.*

²⁷ *Id.*

²⁸ See especially Third Ed. at 382; Fourth Ed. at 705–06.

²⁹ Fourth Ed. at 706.

³⁰ *Id.*

³¹ *Id.*

³² See especially Third Ed. at 406–408; Fourth Ed. at 730–33.

³³ Third Ed. at 407.

³⁴ Fourth Ed. at 730 n.190.

***D. Survey-Experiments as the Recommended Norm
in Many Circumstances***³⁵

Both editions discuss control groups and survey-experimental design, but the Fourth Edition shifts the tone. The Third Edition explained that “courts have increasingly come to recognize the central role the control group can play.”³⁶ The Fourth reiterates this, but adds that “most experts recognize the need to submit a survey with a control group (i.e., a survey-experiment) if they wish to make a causal claim and rule out other explanations.”³⁷ The term “survey-experiment” is used more prominently throughout, reflecting the view that, without a properly designed control group, it is often difficult or impossible to determine whether survey responses reflect the causal influence of the stimulus at issue or are instead driven by preexisting beliefs, guessing, or other potential confounds.

***E. Population and Sample Descriptions:
Five Elements, Not Four***³⁸

The Third Edition’s introductory framework listed four elements a party should document when describing a survey’s sample and the underlying population it purports to represent. Those four elements were: (a) a description of the population, (b) a description of how the sample was drawn, (c) a report on response rate/representativeness, and (d) an evaluation of potential bias. The Fourth Edition retains those four elements and adds one more: (e) “evidence that respondents were attentive and honest in answering the questions on the survey.”³⁹

***F. Nonprobability Samples:
From Caution to Acceptance***⁴⁰

The Third Edition devoted roughly one paragraph to nonprobability samples. The Fourth Edition devotes approximately three pages to the topic and treats nonprobability sampling as an established, widely accepted practice rather than something to be cautiously accepted. The Guide notes that “an overwhelming majority of the consumer surveys conducted for Lanham Act litigation present results from nonprobability samples, and the standard modern practice is for these surveys to be conducted online

³⁵ See especially Third Ed. at 397–401; Fourth Ed. at 718–22.

³⁶ Third Ed. at 400.

³⁷ Fourth Ed. at 721–22.

³⁸ See especially Third Ed. at 362; Fourth Ed. at 684.

³⁹ Fourth Ed. at 684.

⁴⁰ See especially Third Ed. at 382–83; Fourth Ed. at 699–703.

using professionally managed nonprobability internet panels.”⁴¹ The Fourth Edition also acknowledges that inferential statistical tests may be appropriate for nonprobability samples, at least as an approximation when the sampling frame and sampling methods are clear.⁴² Finally, the revision discusses the advantages and limitations of three varieties of nonprobability samples: (a) the managed Internet panels typically used in litigation, (b) crowdsourcing platforms (e.g., Amazon Mechanical Turk), and (c) purposive samples for hard-to-reach populations.

G. Pretesting and Pilot Work: When Questions Are New⁴³

Both editions describe pretesting as “a standard and valuable way to improve the quality of a survey.”⁴⁴ The Fourth Edition, however, adds specificity about when pretesting is most important. It states that “[t]he value of pilot work is greatest when the issues and questions in the survey differ from the issues and questions addressed in previous surveys, or when the target population differs significantly from previously surveyed populations.”⁴⁵ As in the Third Edition, the Fourth Edition also identifies cognitive interviewing and focus groups as methods for pretesting.⁴⁶

H. Coding of Open-Ended Responses⁴⁷

The Third Edition’s treatment of coding consisted of a single paragraph, noting that coding requires detailed instructions, that two trained coders should generally independently score responses, and that verbatim responses should be available for recoding by an opposing expert. The Fourth Edition expands this substantially. It adds that the coding system should be exhaustive—covering all written answers, including responses that do not address the issue and nonresponses—and that the researcher “should be transparent on the construction of the coding system, which may be based on a priori categories or constructed based on the answers the respondents have given.”⁴⁸ It also states that the full open-ended answers should be made available to the opposing party, and discusses the practice in litigation of dispensing with multiple blind

⁴¹ Fourth Ed. at 700.

⁴² Fourth Ed. at 701 n.77.

⁴³ See especially Third Ed. at 388–389; Fourth Ed. at 708.

⁴⁴ Third Ed. at 389; Fourth Ed. at 708.

⁴⁵ Fourth Ed. at 708.

⁴⁶ *Id.*; see also Third Ed. at 388.

⁴⁷ See especially Third Ed. at 413; Fourth Ed. at 715–16.

⁴⁸ Fourth Ed. at 716.

coders for simple coding measures, while cautioning that “the resultant coding should be given close scrutiny.”⁴⁹

V. WHAT STAYED THE SAME?

A substantial portion of the Guide’s content has not changed in any substantive way. The following is a checklist of topics where the core guidance remains generally identical across editions:

- *Purpose and design of the survey.* The survey should address a relevant question; content and execution must be scrutinized, whether or not designed for litigation.
- *Attorney participation boundaries.* Attorneys should not participate in implementation or interact with respondents, but involvement in design is appropriate to ensure relevant questions.
- *Target population identification.* The first step remains to identify the target population and the same examples (trademark, discovery, change of venue) are provided. However, the Fourth Edition uses somewhat broader language when it explains that, in trademark litigation, the relevant universe may include prospective and past purchasers of the “pertinent party’s category of goods or services,”⁵⁰ shifting away from the Third Edition’s narrower reference to plaintiffs and defendants.⁵¹
- *Sampling frame and coverage error.* The sampling framework is unchanged, and both underinclusive and overinclusive sampling can be problematic; coverage error analysis unchanged.
- *Probability sampling techniques.* Simple random, stratified, cluster, and systematic sampling are described in substantively the same way across editions.
- *Confidence intervals and margin of error.* The 95% convention, the three factors (sample size, variability, confidence level), and the underlying mathematics are unchanged. However, the Fourth Edition discusses qualified support for using inferential statistics as approximations with nonprobability samples, subject to the limitations discussed in Section IV.F.⁵²
- *Screening and qualified respondents.* Same guidance on eligibility screening without revealing sponsorship.

⁴⁹ *Id.*

⁵⁰ Fourth Ed. at 692-93.

⁵¹ Third Ed. at 376.

⁵² Fourth Ed. at 701 n.77.

- *Question clarity, precision, and avoidance of bias.* Same guidance on ensuring questions are clear, sufficiently precise to avoid ambiguity, and free of bias.
- *Don't know/no opinion options.* The three-format framework (direct, quasi-filter, full-filter) and the competing concerns about guessing and discouraged responding remain.⁵³
- *Open-ended vs. closed-ended questions.* Same acknowledgement that both open-ended and closed-ended questions are used but may elicit different responses. The discussion of acquiescence is similar, with added guidance on counterbalancing multiple items. The recommendation that closed-ended response options generally be exhaustive remains unchanged. Same observation that open-ended questions are generally better for measuring "what comes first to a respondent's mind" and that closed-ended questions are generally better suited for "assessing choices between well-identified options."⁵⁴
- *Leading questions.* Same principle to avoid questions that direct respondents toward or away from a particular response. Same acknowledgement that both open-ended and closed-ended questions can be leading.
- *Probes.* Same guidance: standard probes are noncontroversial; persistent probing risks conveying the "right answer," so excessive probing should be avoided.
- *Order effects.* Same phenomena (primacy/recency); recommendation to rotate, randomize, or counterbalance where appropriate is substantively unchanged.
- *Control group design principles.* Same core rules. The classic formulation is unchanged: "In designing a survey-experiment, the expert should select a stimulus for the control group that shares as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed."⁵⁵
- *Net confusion/difference measurement.* Same typical focus on the difference between experimental and control responses rather than absolute levels.
- *In-person interviews and computer-assisted interviewing ("CAI")/computer-assisted telephone interviewing ("CATI")/computer-assisted personal interviewing ("CAPI").* Same strengths-and-weaknesses analysis; audio computer-

⁵³ Fourth Ed. at 713.

⁵⁴ Fourth Ed. at 715-16; Third Ed. at 394.

⁵⁵ Fourth Ed. at 720; Third Ed. at 399.

assisted self-interviewing (“ACASI”) is still recommended as one method for interviews involving sensitive topics.

- *Mixed-mode surveys* (i.e., using multiple methods to administer a survey). Same rationale (increasing contact likelihood, improving response rates) and same caution about mode effects.
- *Interviewer selection and training*. Same standards: detailed written instructions, verbatim recording, appropriate training in general interviewing skills and techniques.
- *Self-selected web pseudosurveys*. Same rejection: they resemble magazine reader polls and “do not meet standard criteria for legitimate surveys admissible in court.”⁵⁶
- *List-based web surveys*. Same identification as the Internet-survey type most amenable to probability sampling.
- *Use of surveys in court*. Continued broad use, illustrated with updated examples of common use-cases: trademark, false advertising, patent, employment, discrimination, copyright, change of venue.
- *Secondary expert testimony*. Same standards for experts testifying about surveys conducted by others.

VI. SUMMARY

Diamond, Kugler, and Druckman’s Fourth Edition of the “Reference Guide on Survey Research” is a comprehensive update, not a radical reconceptualization. The foundational principles—sound sampling, clear questions, appropriate controls, transparent reporting—are unchanged. The primary changes concern the infrastructure around those principles, reflecting the reality that litigation surveys are now overwhelmingly conducted online using nonprobability panels. The Guide now provides detailed frameworks for evaluating nonprobability samples, Internet-panel quality, conjoint analysis, weighting limitations, and professional respondents. It removes the 80% response-rate target, treats survey-experimental design as the expected norm for causal claims, and ties expanded reporting and data-production guidance to AAPOR. For practitioners, perhaps the most important takeaway is that the science of good survey methodology—as detailed in the Guide and in other authoritative sources—remains the essential foundation for designing surveys that can withstand scrutiny in litigation.

⁵⁶ Fourth Ed. at 731; Third Ed. at 407-08.

GUIDELINES FOR SUBMISSIONS TO *THE TRADEMARK REPORTER*

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