# Contents

**Author Biographies**

## Section I Introduction

1. **Editors' Introduction:**
   *Surveys in Modern Litigation Involving Trademarks and Deceptive Advertising*
   - The Chapters
   - Dedication

## Section II Preliminary Matters

2. **The Use of Pilot Tests and Pretests in Consumer Surveys**
   *By Ivan Ross*
   - Introduction: The Expert and the Attorney: Different Perspectives on the Value of Pilot Tests
   - An Example of the Value of Pilot Work
   - Typical Research Parameters Studied in Pilot Tests
   - The Questionnaire
   - Universe Specification, Sampling Issues, and Incentives
   - Mechanical, Administrative, and Logistical Considerations
   - How Likely Is It That Pilot Work Will Be Helpful?
   - Circumstances in Which Pilot Work Is More Likely to Be Helpful
   - Circumstances When a Pilot Test Is Less Likely to Be Helpful
   - Pilot Test Implementation Considerations
   - Pilot Survey Sample Size
   - How Many Parameters Can Be Evaluated at the Same Time?
   - Pilot Study Timing
   - How Many Pilot Tests?
   - Concluding Thoughts

3. **The Universe**
   *By William G. Barber*
   - Determining the Proper Universe
   - Forward Confusion
   - Reverse Confusion
   - Post-Sale Confusion
## CONTENTS

Distinctiveness/Strength of Senior User’s Mark 32
Dilution Issues 33
False Advertising 36
Special Rules 36

**ERRORS IN DEFINING THE UNIVERSE**
Overinclusiveness 39
Underinclusiveness 42
Overinclusive and Underinclusive 44
Judicial Nit-picking 44

**SAMPLING AND SCREENING THE UNIVERSE**
Sampling 47
Screening 48

CONCLUSION 49

## SECTION III  LEGAL QUESTIONS  51

### 4  LIKELIHOOD OF CONFUSION  53

*By Jerre B. Swann*

<table>
<thead>
<tr>
<th>EVEREADY</th>
<th>56</th>
</tr>
</thead>
<tbody>
<tr>
<td>The Questionnaire and Variants</td>
<td>56</td>
</tr>
<tr>
<td>Categorization and Pattern Matching in an Eveready Format</td>
<td>60</td>
</tr>
<tr>
<td>The Confusion Factors Tested by Eveready</td>
<td>61</td>
</tr>
<tr>
<td>The Need for a Control Cell</td>
<td>62</td>
</tr>
<tr>
<td>The Scope of Eveready</td>
<td>62</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>SQUIRT</th>
<th>64</th>
</tr>
</thead>
<tbody>
<tr>
<td>The Questionnaire and Variants</td>
<td>64</td>
</tr>
<tr>
<td>Categorization and the Representativeness Heuristic</td>
<td>66</td>
</tr>
<tr>
<td>The Confusion Factors Tested by Squirt</td>
<td>67</td>
</tr>
<tr>
<td>The Need for Control Cells</td>
<td>68</td>
</tr>
<tr>
<td>The Scope of Squirt</td>
<td>69</td>
</tr>
</tbody>
</table>

GOING BOTH WAYS 72
OTHER FORMATS 72
REJECTED APPROACHES 74

**PRINCIPAL REASONS FOR REDUCED WEIGHT/PRECLUSION OF CONFUSION STUDIES**
Lack of Relevance, Reliability, or Objectivity 75
Distortion of the Stimulus or Its Context 76

CONCLUSION 77

### 5  SECONDARY MEANING SURVEYS  79

*By Vincent N. Palladino*

<table>
<thead>
<tr>
<th>INTRODUCTION</th>
<th>79</th>
</tr>
</thead>
<tbody>
<tr>
<td>THE MEANING OF SECONDARY MEANING</td>
<td>81</td>
</tr>
<tr>
<td>ASSESSING ASSOCIATION DIRECTLY</td>
<td>83</td>
</tr>
<tr>
<td>Isolating the Trademark or Trade Dress</td>
<td>83</td>
</tr>
<tr>
<td>Questions</td>
<td>85</td>
</tr>
<tr>
<td>Level of Association</td>
<td>90</td>
</tr>
</tbody>
</table>
OTHER ATTEMPTS TO ASSESS SECONDARY MEANING DIRECTLY 91
“Who” Questions 91
“What-Word” Questions 92
“What-Name” Questions 93
Brand Awareness Questions 94
Applicability to Trade Dress 95
Reported Secondary Meaning Percentages 96
INFERRING SECONDARY MEANING FROM OTHER FINDINGS 97
Genericness 97
Likelihood of Confusion 98
A COMMENT ON COMMON SENSE 99

6 Genericness Surveys in Trademark Disputes:
UNDER THE GAVEL 101
By E. Deborah Jay

INTRODUCTION 101
THE SURVEYS IN AMERICAN THERMOS 105
THE SURVEYS IN E. I. DU PONT DE NEMOURS 107
THERMOS SURVEYS AFTER AMERICAN THERMOS 109
TEFLON SURVEYS AFTER E. I. DU PONT DE NEMOURS 112
The Brand-Name/Common-Name Dichotomy 114
Screening Respondents 115
Question Wording 117
Frame of Reference 119
Controls 120
Rotation of Items and Response Categories 121
Survey Analysis 122
ALTERNATIVES TO THE THERMOS AND TEFLON FORMATS 124
Consumer-Recognition Surveys 125
Source-Identification and Brand-Association Surveys 126
Permission or Approval Surveys 129
Statement-of-Meaning Surveys 129
Consumer Motivation Surveys 130
OTHER SURVEY DESIGN AND IMPLEMENTATION ISSUES 131
The Role of Experts and Attorneys in Surveys 131
Universe Selection and Sample Size 131
Data Collection Methods and Visual Stimuli 136
Survey Reporting 139
COUNTERING A GENERICNESS SURVEY 139
CONCLUSION 143

7A Dilution Surveys under the Trademark Dilution Revision Act 145
By Jerre B. Swann

INTRODUCTION 145
RECOGNITION/AWARENESS 147
ASSOCIATION 149
CONTENTS

IMPAIRED DISTINCTIVENESS AS A FUNCTION OF SIMILARITY, ELEVATED FAME, SUBSTANTIALLY EXCLUSIVE USE, ASSOCIATION, AND JUNIOR USER INTENT 151
CONCLUSION 154

7B SURVEYS IN DILUTION CASES II 155
By Shari Seidman Diamond

FAME SURVEYS 155
ASSOCIATION SURVEYS 157
AFTER FAME AND ASSOCIATION 159
CONCLUSION 161

7C SWANN’S REBUTTAL TO DIAMOND 163

8 SURVEY EVIDENCE IN FALSE ADVERTISING CASES 167
By Bruce P. Keller

WHEN SURVEYS ARE USED IN FALSE ADVERTISING 167
Advertisements That Are Literally False 168
Advertisements That Are False by Necessary Implication 172
Advertisements That Are Misleading 173
CONSTRUCTION OF SURVEYS 177
Survey Standards 178
WEIGHT AND ADMISSIBILITY OF SURVEY EVIDENCE 194
CONCLUSION 197

SECTION IV CONTROLS 199

9 CONTROL FOUNDATIONS:
RATIONALES AND APPROACHES 201
By Shari Seidman Diamond

INTRODUCTION 201
THREATS TO INTERNAL VALIDITY AND SOURCES OF MEASUREMENT ERROR 203
Preexisting Beliefs 204
Yea-Saying 204
Guessing That Produces Random Error 205
Guessing That Produces Systematic Error 205
A CLOSER LOOK AT SURVEY DESIGN WITHOUT AND WITH CONTROLS 206
Without Controls 206
With Controls 209
CHOOSING APPROPRIATE CONTROLS 210
Selecting a Control That Shares Features with the Test Stimulus That Are Not at Issue 212
Avoiding Cues in the Control That Artificially Depress “Confusion” Responses 213
## Contents

<table>
<thead>
<tr>
<th>Section</th>
<th>Title</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Selecting a Control That Is a Plausible Member of the Product Category</td>
<td>214</td>
</tr>
<tr>
<td></td>
<td>Avoiding a Control That Is Itself Infringing</td>
<td>214</td>
</tr>
<tr>
<td></td>
<td>THE ROLE OF MULTIPLE CONTROLS</td>
<td>215</td>
</tr>
<tr>
<td></td>
<td>CONCLUSION</td>
<td>216</td>
</tr>
<tr>
<td>10</td>
<td>DESIGN ISSUES FOR CONTROLS</td>
<td>217</td>
</tr>
<tr>
<td>By Mike Rappeport</td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td>INTRODUCTION</td>
<td>217</td>
</tr>
<tr>
<td></td>
<td>THE MYTH OF REPLICATION</td>
<td>218</td>
</tr>
<tr>
<td></td>
<td>THE PROBLEM—THE INHERENT “LEADINGNESS” OF SURVEYS</td>
<td>219</td>
</tr>
<tr>
<td></td>
<td>NOISE AND OTHER SURVEY ARTIFACTS</td>
<td>220</td>
</tr>
<tr>
<td></td>
<td>PRECONCEPTIONS</td>
<td>221</td>
</tr>
<tr>
<td></td>
<td>SUMMARY OF THE CHAPTER TO THIS POINT</td>
<td>222</td>
</tr>
<tr>
<td></td>
<td>GOOD DESIGN—THE CONCEPT OF CONTROLS</td>
<td>223</td>
</tr>
<tr>
<td></td>
<td>THE ENGINEERING NATURE OF SURVEY RESEARCH</td>
<td>224</td>
</tr>
<tr>
<td></td>
<td>CHOOSING A CONTROL—GENERAL PRINCIPLES</td>
<td>225</td>
</tr>
<tr>
<td></td>
<td>THE BASIC KINDS OF SURVEY CONTROL STRUCTURES</td>
<td>226</td>
</tr>
<tr>
<td></td>
<td>THE CONTROL CELL DESIGN</td>
<td>227</td>
</tr>
<tr>
<td></td>
<td>The Basic Design</td>
<td>227</td>
</tr>
<tr>
<td></td>
<td>Uses of a Control Cell Design—False Advertising</td>
<td>228</td>
</tr>
<tr>
<td></td>
<td>Other Uses of a Control Cell Design</td>
<td>228</td>
</tr>
<tr>
<td></td>
<td>Analysis of Control Cell Designs with Multiple Controls</td>
<td>232</td>
</tr>
<tr>
<td></td>
<td>THE SINGLE TEST STIMULUS ONE-ROOM ARRAY DESIGN</td>
<td>233</td>
</tr>
<tr>
<td></td>
<td>The Basic Design</td>
<td>233</td>
</tr>
<tr>
<td></td>
<td>Controls in Single Test Stimulus One-Room Array Designs</td>
<td>234</td>
</tr>
<tr>
<td></td>
<td>Use of Single Test Stimulus One-Room Array Designs</td>
<td>234</td>
</tr>
<tr>
<td></td>
<td>Additional Control Stimuli in Single Test Stimulus One-Room Array Designs</td>
<td>236</td>
</tr>
<tr>
<td></td>
<td>COMPARISON ARRAY DESIGNS</td>
<td>236</td>
</tr>
<tr>
<td></td>
<td>The Two Basic Designs</td>
<td>236</td>
</tr>
<tr>
<td></td>
<td>Deciding Between a One-Room and a Two-Room Comparison Array</td>
<td>237</td>
</tr>
<tr>
<td></td>
<td>Selecting the Controls</td>
<td>238</td>
</tr>
<tr>
<td></td>
<td>Analysis in a One-Room Array</td>
<td>238</td>
</tr>
<tr>
<td></td>
<td>Analysis in a Two-Room Array</td>
<td>239</td>
</tr>
<tr>
<td></td>
<td>CONCLUDING REMARKS</td>
<td>239</td>
</tr>
<tr>
<td>Section V</td>
<td>OTHER METHODOLOGICAL ISSUES</td>
<td>241</td>
</tr>
<tr>
<td>11</td>
<td>DEMAND EFFECTS IN LIKELIHOOD OF CONFUSION SURVEYS: THE IMPORTANCE OF MARKETPLACE CONDITIONS</td>
<td>243</td>
</tr>
<tr>
<td>By Itamar Simonson and Ran Kivetz</td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td>ACADEMIC RESEARCH REGARDING DEMAND EFFECTS IN SOCIAL-PSYCHOLOGICAL AND BUYER-BEHAVIOR EXPERIMENTS</td>
<td>244</td>
</tr>
<tr>
<td></td>
<td>LEADING SURVEY QUESTIONS AND DEMAND EFFECTS</td>
<td>246</td>
</tr>
<tr>
<td></td>
<td>DEMAND EFFECT BIASES IN LIKELIHOOD OF CONFUSION SURVEYS</td>
<td>248</td>
</tr>
<tr>
<td></td>
<td>Monadic versus Sequential Presentation</td>
<td>249</td>
</tr>
<tr>
<td></td>
<td>SIMON PROPERTY GROUP V. MYSIMON</td>
<td>252</td>
</tr>
</tbody>
</table>
12  ARE CLOSED-ENDED QUESTIONS LEADING QUESTIONS?  
By Jacob Jacoby  

INTRODUCTION 261  
OPEN-ENDED QUESTIONS 262  
CLOSED-ENDED QUESTIONS 262  
JUDICIAL VIEWS OF CLOSED-ENDED QUESTIONS 263  
   Reliability 263  
   Objectivity 264  
   Leadingness 265  
THE VIEWS OF AUTHORITIES, LEGAL AND OTHERWISE 266  
   Authorities Generally Recognized in Law 266  
   The Case Law 267  
   Other Authorities 268  
   The Psychology Underlying Open-Ended and Closed-Ended Questions 269  
WHAT MAKES A CLOSED-ENDED QUESTION A LEADING QUESTION? 272  
FACTORS THAT CONVERT CLOSED-ENDED QUESTIONS INTO LEADING QUESTIONS 273  
   Failure to Provide Explicit Instructions Not to Guess 273  
   Failure to Provide a “Don’t Know” (or Equivalent) Response Option 274  
   Asking Simple Yes/No Questions 274  
   Failure to Be Fair and Balanced 274  
REVISITING THE EARLIER CITED COURT CRITICISMS OF CLOSED-ENDED QUESTIONS 281  
   Universal City Studios, Inc. v. Nintendo Co. 281  
   Beneficial Corp. v. Beneficial Capital Corp. 282  
   Scott Fetzer Co. v. House of Vacuums Inc. 282  
   Marshall Field & Co. v. Mrs. Fields Cookies 283  
   Gillette v. Norelco 283  
CONCLUSION 283  

EDITORS’ NOTE ON CHAPTER 12 285  

13  INTERNET SURVEYS FOR EVALUATING TRADEMARK INFRINGEMENT AND DECEPTIVE ADVERTISING  
By Roger Tourangeau and Shari Seidman Diamond  

INTRODUCTION 287  
SURVEY RESEARCH FOR EVALUATING TRADEMARK INFRINGEMENT AND DECEPTIVE ADVERTISING 288  
POTENTIAL ADVANTAGES OF THE INTERNET FOR TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS 289
INTRODUCTION 363
HOW A CRITIQUE SHOULD NOT BE DONE 363
IPSE DIXIT CRITIQUES PURELY AS TO TECHNICAL MATTERS SHOULD BEAR LITTLE (IF AT ALL) ON THE WEIGHT GIVEN A SURVEY 367
CRITIQUES AS TO SUBSTANTIVE FLAWS SHOULD TURN ON THE IMPACT OF THE FLAW ON RELEVANCE OR RELIABILITY, NOT ON THE LABEL ATTACHED TO THE FLAW 371
The Truly Irrelevant 371
The Substantially Irrelevant 372
The Partially Relevant 372
The Substantially Relevant 372
TRUE CANDIDATES FOR FATAL FLAW TREATMENT, WITHOUT EXTENSIVE ANALYSIS OR SUPPORTING DATA 373
A Survey Without a Control Cell or with a Fundamentally Inadequate Control Stimulus 373
A Complete Divergence “from the Conditions That Potential Purchasers Encounter in the Parties’ Marketplace” Is Irrelevant 374
CONCLUSION 375

INDEX 377