Preface

U.S. Supreme Court Justice Stephen Breyer observed: “Scientific issues permeate the law. . . . In this age of science we must build legal foundations that are sound in science as well as law.”1 With science touching upon virtually every aspect of contemporary life and society, scientists (as well as nonscientists claiming scientific expertise) are increasingly being called upon to proffer expert testimony in litigated matters. Indeed, “Rarely does a case, criminal or civil, go to trial today without the presence of experts, most of whom lay claim to a scientific basis for their testimony.”2 This applies to trademark, false advertising, and patent law, where the proffering of survey evidence on critical issues such as secondary meaning, likely confusion, genericism, fame, blurring, tarnishment, and the implied meaning of advertising messages, to mention but a few, has become commonplace.3

Commonplace does not mean universal. Countless numbers of intellectual property (especially trademark) disputes had been successfully

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3. See, e.g., Schering Corp. v. Pfizer Inc., 189 F.3d 218, 226 (2d Cir. 1999) (“There is no doubt that beginning with Judge Wilfred Feinberg’s seminal decision in Zippo Manufacturing Co. v. Rogers Imports, Inc., 216 F. Supp. 670 (S.D.N.Y. 1963), the general trend has been toward the admission of surveys of various kinds. Surveys are, for example, routinely admitted in trademark and false advertising cases to show actual confusion, genericism of a name or secondary meaning, all of which depend on establishing that certain associations have been drawn in the public mind.”); A. Robin & H.B. Barnaby, Trademark Surveys—Heads You Lose, Tails They Win, 73 Trademark Rep. 436 (1983) (“It is a well-established rule of evidence that . . . the failure to produce a relevant document in its possession raises an inference that . . . the contents of that document would be unfavorable. There is no such rule involving the failure of a party to create evidence. Yet, there is a growing belief in the trademark bar that the failure of a trademark owner to run a survey to support its claim of likelihood of confusion gives rise to a similar adverse inference.”) (emphasis added)).
resolved prior to the proffering of the first survey (apparently in 1957)\(^4\) and many such disputes continue to be resolved without the introduction of surveys. Since the early 1980s, however, consumer surveys have increasingly been employed by one or more parties to such disputes, with disputants sometimes proffering more than one survey on more than one issue (e.g., on genericism, secondary meaning, and likelihood of confusion, not to mention countersurveys offered to challenge such evidence). That said, a substantial proportion of trademark and deceptive advertising surveys never find their way to court. Counsel for potential plaintiffs will commission pilot or full surveys as aids to deciding whether or how to proceed with a matter. Surveys that do not support their client’s views sometimes are used to dissuade the client from proceeding. Even when a survey supports a potential plaintiff’s point of view, counsel may avoid having to litigate by using the survey to negotiate a favorable settlement.

A variety of resources have emerged over the years to help courts and counsel better understand and employ the survey research process. One such resource has been the discussion of survey evidence in J. Thomas McCarthy’s treatise, *McCarthy on Trademarks and Unfair Competition*.\(^5\) Another has been articles on survey research that sporadically appear in the *Trademark Reporter* and other academic and professional journals.


> The bedrock of [the American justice] system is the adversary process. . . . But when the adversary process yields conflicting testimony on complicated and unfamiliar issues . . . , courts may not be competent to make reasoned and principled decisions. Concern of this problem led the Carnegie Commission on Science, Technology and Government to undertake a study of science and technology in judicial decision making. In the introduction to its final report, the Commission concluded:

> The courts’ ability to handle complex science-rich cases has recently been called into question with widespread allegations that the judicial system was increasingly unable to


\(^5\) See especially the sections on survey evidence, 32.158 through 32.196.

manage and adjudicate science and technology issues. Critics have objected that judges cannot make appropriate decisions because they lack technical training. . . . If these claims go unanswered, or are not dealt with, confidence in the judiciary will be undermined as the public becomes convinced that the courts as now constituted are incapable of correctly resolving some of the most pressing legal issues of our day.\(^7\)

One need not fully share the opinions of the critics to appreciate the existence of a problem that affects the administration of justice in the decision of particular cases and in the larger dimension of the public’s perception of the courts.

A recent resource is the 2012 volume edited by Shari S. Diamond and Jerre B. Swann titled *Trademark and Deceptive Advertising Surveys: Law, Science and Design*. Also commissioned by the American Bar Association’s Section of Intellectual Property Law, this work, as its subtitle indicates, addresses selected scientific and legal issues in the design of trademark surveys.

**The Objectives of This Work**

The objective of *Trademark Surveys*—a top-to-bottom revision of an out-of-print resource\(^8\)—is to provide a fuller, more cohesive treatment than is possible via single chapters, with the ultimate objective being to improve the quality of survey research proffered as evidence in litigated proceedings. To better achieve this objective, the chapters discussing the legal issues have been written by lawyers, while the chapters discussing the scientific issues have been written by a social scientist. The entire compilation will require at least two volumes, the first of which is the present work.

One objective of this first volume is to provide a cohesive, comprehensive, and integrated treatment of the scientific issues that need to be considered when designing, implementing, and evaluating trademark and related survey research. Notwithstanding our best efforts, it is likely that we have fallen short in this regard. As this work will be updated periodically, readers aware of cases that merit mention are invited to bring these to the attention of the author.

A second objective is to generate realistic expectations among counsel and courts. There is no such thing as a perfect survey—one that represents

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perfectly the real world and is without technical flaws. In part, this is because of the complexity involved in studying mental processes and the tradeoffs that need to be made when designing and implementing research. That said, errors fall along a continuum, from minor, through major, to fatal. Fatal errors are those that render the findings of a study worthless. Surveys whose errors truly are fatal (with what constitutes being fatal sometimes differing depending upon the eye of the beholder) merit either being rejected entirely or accepted and given no weight. Surveys with flaws but without fatal flaws merit being accepted and given their due weight. This is completely consistent with scientific practice. Scientific research is utilitarian and typically evaluated from a relativistic perspective. If it is determined that a study’s methods are not fatally flawed but reasonably acceptable, then the pertinent query becomes what information does it yield that adds to our understanding of the situation—an understanding that perhaps cannot be obtained in any other way?

Surveys should not be evaluated against unreachable ideals. As a concrete example, a number of tribunals have faulted surveys for using nonprobability rather than probability sampling designs. While according to many texts and in theory, probability sampling is the gold standard, in practice, researchers in both industry and academia who study psychological states of mind—and make no mistake about it, confusion, secondary meaning, dilution, blurring, being deceived or misled, and so on are all psychological states of mind—overwhelmingly rely on well conducted nonprobability samples. For reasons discussed in the chapter on sampling, unless one has extensive resources and substantial amounts of time for successive recontact waves, it is virtually impossible to conduct traditional in-person probability surveys.

The Audiences for This Work

This treatise has been written with three principal audiences in mind. The first consists of attorneys, particularly those in trademark, advertising, and patent law, who contemplate using or critiquing a survey. The second audience consists of courts, the designated gatekeepers of scientific testimony, and their clerks who may be seeking a more detailed treatment than is found in other resources. The third consists of survey researchers who provide services to those engaged in trademark and other intellectual property litigation.

While focusing on surveys in the trademark arena, much of what is described has relevance to the design and conduct of surveys in other
litigation arenas, especially in other areas of intellectual property law. Many factors a trademark attorney has to consider when engaging an expert to conduct a likely confusion survey are the same as those an attorney practicing advertising law has to consider when engaging an expert to conduct a survey of likely deception. The same applies to patent attorneys, an arena where consumer surveys are becoming more prevalent.

In writing this work, the objective has been to help counsel, courts, and experts alike understand and utilize the best available survey research practices—or at the very least, refrain from using or advocating practices generally recognized among the scientific community as being unacceptable. It is for this reason that this work devotes time to explaining the thinking that underlies scientific practice. We hope in this way to accomplish two things. First and foremost, we seek to assist attorneys preparing their cases who need to remain mindful of the position articulated by the Supreme Court in *Weisgram*: “Since Daubert, . . . parties relying on expert evidence have had notice of the exacting standards of reliability such evidence must meet. It is implausible to suggest, post-Daubert, that parties will initially present less than their best expert evidence in the expectation of a second chance should their first try fail.” 9 Second, by having counsel understand and use appropriate survey research practices, we hope to play a role in reducing the amount of junk science being proffered in courtrooms. That said, science evolves, so that some things described as good practice herein may, upon acquiring further knowledge, be changed in subsequent editions.

**The Organization of This Work**

It is anticipated that the chapters constituting the volumes of *Trademark Surveys* will, when completed, be organized into five parts. Volume 1 contains parts I and II.

**Part I:** Consisting of two chapters, part I focuses on presurvey considerations. Chapter 1 identifies legal issues that can be productively examined via survey research, while chapter 2 discusses a number of factors that should be considered when selecting or otherwise evaluating a survey expert.

**Part II:** Written by a social scientist with considerable experience in the realm of trademark surveys, part II discusses what goes into designing,

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conducting, and reporting surveys. A sometimes overlooked but important first step is for counsel and survey experts to understand the pertinent aspects of the marketplace; this is the focus of chapter 3. Chapter 4 is devoted to providing a rudimentary understanding of the scientific research process in general, and the approach social scientists use to assess causal propositions in particular, the latter being a fundamental requirement for testing issues described in section 43(a) of the Lanham Act.

After discussing what is meant by the term universe and how universes are defined, chapter 5 considers case law as it applies to defining the proper universe for different trademark issues. Once the universe has been defined, the question becomes how to select a sample of respondents for the survey who are representative of the defined universe so that one is able to extrapolate the survey’s findings to the relevant universe. Chapter 6 discusses sampling issues in general, as well as case law commentary bearing on sampling.

Having identified the proper universe and how to obtain respondents representative of that universe, other questions that need to be addressed concern where the testing takes place and how the test situation is structured, specifically, what products, marks, communications, and so on, if any, the respondents will be shown as part of the test. Chapter 7 covers both test settings and the stimuli shown to respondents as part of the test, as well as case law commentary bearing these issues.

Chapter 8 focuses on questionnaire construction issues—what respondents will be told and what they will be asked, arguably the soft underbelly of survey research. Again, pertinent case law commentary is woven into the discussion.

Chapter 9 focuses on considerations that go into implementing the survey and gathering the data, including whether the questions will be self-administered by the respondent or administered by an interviewer and whether it will be administered in-person, over the phone or via the Internet. The pros and cons of each form of administration are discussed, with case law commentary bearing these issues being integrated as well.

Once the data have been gathered, the remaining issues focus on aggregating, evaluating, and reporting the findings. Chapter 10 is devoted to these issues, again incorporating pertinent case law commentary.

**Part III:** Written by practicing intellectual property attorneys with considerable experience, part III is expected to consist of five chapters devoted to key issues in trademark and deceptive advertising law. The tentative chapter titles are as follows.

Chapter 11: Genericism Surveys
Chapter 12: Secondary Meaning Surveys
Chapter 13: Likelihood of Confusion Surveys
Chapter 14: Dilution Surveys
Chapter 15: Advertising Surveys

Part IV: Written by practicing IP attorneys with considerable experience, part IV is expected to consist of two chapters devoted to presenting, defending, and opposing surveys.

Chapter 16: Using a Survey
Chapter 17: Dealing with an Opposing Survey

Part V: Part V will consist of 13 chapters written by practicing IP attorneys with considerable experience in the case law of their venues. Eleven of these chapters focus on case law in the First through the Eleventh Circuit, respectively. A twelfth chapter is devoted to cases heard by the Federal Circuit, and the last chapter focuses on cases heard before the Trademark Trial and Appeal Board.

Chapter 18: First Circuit
Chapter 19: Second Circuit
Chapter 20: Third Circuit
Chapter 21: Fourth Circuit
Chapter 22: Fifth Circuit
Chapter 23: Sixth Circuit
Chapter 24: Seventh Circuit
Chapter 25: Eighth Circuit
Chapter 26: Ninth Circuit
Chapter 27: Tenth Circuit
Chapter 28: Eleventh Circuit
Chapter 29: Federal Circuit
Chapter 30: Trademark Trial and Appeal Board