

The Order denies Plaintiffs' motion to preclude Drs. Maronick and Berger, concluding that each is "qualified to offer opinions on the relevant issue" based on his respective education and experience. Judge Francis also found that the alleged flaws in methodology affecting the experts' surveys do not "destroy all of [the surveys'] relevance" and therefore bear only on the weight they are to be afforded at summary judgment or trial.

The Order also denied Defendants' motion to preclude Mr. Sowers. Judge Francis found that "defendants' complaints about Mr. Sowers' education and experience are overblown, undersupported, or both," and that his "reports adequately explain his analyses and conclusions, which is what the Federal Rules of Evidence contemplate." Judge Francis rejected Defendants' arguments that Mr. Sowers' methodology is unreliable because he lacks an understanding of the concept of primary significance, and that he misidentified the proper survey universe for a genericness survey, because Defendants did not "establish[] that these alleged defects relate to his 'methodology' or make his reports unreliable."

Plaintiffs and Defendants now object to the portions of the Order denying their respective motions to preclude.

II. LEGAL STANDARD

Under 28 U.S.C. § 636(b)(1)(A) and Federal Rule of Civil Procedure 72(a), a magistrate judge may adjudicate non-dispositive motions. *See also Arista Records, LLC v. Doe 3*, 604 F.3d 110, 116 (2d Cir. 2010). A magistrate judge's order as to a non-dispositive motion may be set aside only where it is "clearly erroneous or contrary to law." 28 U.S.C. § 636(b)(1)(A); Fed. R. Civ. P. 72(a); *see also Arista Records*, 604 F.3d at 116. "An order is clearly erroneous if the reviewing court is 'left with the definite and firm conviction that a mistake has been committed.'" *Frydman v. Verschleiser*, No. 14 Civ. 5903, 2017 WL 1155919, at *2 (S.D.N.Y.

Mar. 27, 2017) (quoting *Easley v. Cromartie*, 532 U.S. 234, 242 (2001)). “An order is contrary to law when it fails to apply or misapplies relevant statutes, case law or rules of procedure.” *Id.* (internal quotation marks omitted).

Federal Rule of Evidence 702 governs the admissibility of expert testimony. The Rule provides that:

[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if [] (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case.

Courts play a “gatekeeping” role within the Rule 702 framework and are “charged with ‘the task of ensuring that an expert’s testimony both rests on a reliable foundation and is relevant to the task at hand.’” *Amorgianos v. Nat’l R.R. Passenger Corp.*, 303 F.3d 256, 265 (2d Cir. 2002) (quoting *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 597 (1993)). Examination of an expert’s analysis should be “rigorous,” but “[a] minor flaw in an expert’s reasoning or a slight modification of an otherwise reliable method will not render an expert’s opinion *per se* inadmissible.” *Id.* at 267.

III. DISCUSSION

A. Plaintiffs’ Objections to the Order

With respect to Dr. Maronick, Plaintiffs argue that the Order is clearly erroneous for essentially two reasons: (1) “Dr. Maronick has a fundamental lack of understanding of the concept of genericness”; and (2) “the universe Dr. Maronick selected for his surveys” is over-inclusive. Plaintiffs further argue that the Order is contrary to law because it “misapplies the law with respect to the definition of genericness.” Regarding Dr. Berger, Plaintiffs argue that the

Order is clearly erroneous because (1) Dr. Berger’s Thermos survey has no probative value; and (2) Dr. Berger “incorrectly chose as [the relevant] universe, attendees of ‘public’ beaches and swimming pools.” None of these arguments is persuasive.

1. Dr. Thomas Maronick

Plaintiffs assert that Dr. Maronick’s survey lacks reliability or probative value because “Dr. Maronick was unable to decide whether the second survey he commissioned for his 2016 Report was a survey to examine the existence of customer confusion or whether it was a survey to examine whether the Mark is generic.” However, at his deposition, Dr. Maronick repeatedly testified that the “focus” of the 2016 study was genericness, and that to the extent he tested consumer confusion at all, it was to assess the conclusion that consumers do not associate Plaintiffs’ Mark with any particular brand or company. Dr. Maronick’s testimony is consistent with his expert report, in which he concluded that Plaintiffs’ Mark is generic, based, in part, on such consumer confusion data. Neither Dr. Maronick’s expert report nor his deposition testimony undermines Judge Francis’ conclusion that Dr. Maronick is qualified to opine on genericness.

Plaintiffs’ contention that the Order was clearly erroneous and contrary to law because Dr. Maronick tested the wrong population, or “universe,” also fails. As stated in the Order, “[t]he majority rule is that while technical deficiencies can reduce a survey’s weight, they will not prevent the survey from being admitted into evidence.” (quoting 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:170 (4th ed. rev. 2017); see also *Tiffany & Co. v. Costco Wholesale Corp.*, 127 F. Supp. 3d 241, 258–59 (S.D.N.Y. 2015) (finding that “[w]hile calling into question the soundness of the study by pointing out flaws in its construction [including that it was administered to the wrong subject population], Costco does not undermine

Dr. Jacoby’s ultimate methodology (*i.e.*, the use of a consumer survey)’); *Louis Vuitton Malletier S.A. v. Sunny Merch. Corp.*, 97 F. Supp. 3d 485, 510 (S.D.N.Y. 2015) (rejecting the argument that the survey universe was fatally flawed where “there was no guarantee that it included anyone who would purchase either [plaintiff’s or defendant’s] products” because such deficiencies bear on the survey’s weight as opposed to admissibility); *Rise-N-Shine, LLC v. Duner-Fenter*, No. 14 Civ. 1305, 2015 WL 876470, at *3 (S.D.N.Y. Feb. 28, 2015) (finding that “[t]o the extent that this universe of respondents is overbroad, it is not so overbroad as to destroy the relevance of the survey results” and collecting cases). “A survey is only inadmissible if its flaws destroy all of its relevance.” *Victoria’s Secret Stores Brand Mgmt., Inc. v. Sexy Hair Concepts, LLC*, No. 07 Civ. 5804, 2009 WL 959775, at *11 n.9 (S.D.N.Y. Apr. 8, 2009) (denying a motion to preclude based on alleged methodological flaws in an expert’s survey because the survey was relevant under Federal Rule of Evidence 401.). The Order’s finding, that any methodological flaws respecting Dr. Maronick’s survey did not destroy the survey’s relevance so as to render it without probative value, is not clearly erroneous or contrary to law.

Lastly, Plaintiffs assert that the Order misapplies the law respecting genericness insofar as it relies on *Anvil Brand, Inc. v. Consolidated Foods Corp.*, 464 F. Supp. 474 (S.D.N.Y. 1978) and *Polo Fashions, Inc. v. Extra Special Products, Inc.*, 451 F. Supp. 555 (S.D.N.Y. 1978). Plaintiffs argue that *Anvil Brand* and *Polo Fashions* are inapposite because, unlike here, there was evidence that the marks at issue -- “rugger” and “polo” -- referred to both the sports of rugby and polo and a type of apparel associated with those sports. Plaintiffs either misstate or misunderstand the relevance of these cases to Judge Francis’ conclusion that Plaintiffs’ view of genericness is unnecessarily “cramped.” Rather than implying that *Anvil Brand* and *Polo Fashions* dictate the outcome of the instant litigation, Judge Francis’ Order suggests only that the

concept of genericness is broad enough to encompass the Mark on certain items of apparel that are associated with the profession of lifeguarding (even if those items of apparel themselves are not described as “lifeguards”).

2. Dr. James Berger

Plaintiffs object to the Order as it pertains to Dr. Berger on two grounds: it was clearly erroneous (1) to find that his Thermos study had probative value, and (2) not to exclude his Teflon survey, which tested the wrong universe.

Dr. Berger’s Thermos survey asked respondents to look at a photograph of a lifeguard and state whether they were familiar with his function. The Order found that the study “is somewhat probative, as a failure of the public to recognize the occupation of a lifeguard would likely preclude a finding that the label ‘lifeguard’ was generic when applied to clothing a lifeguard wears.” Plaintiffs argue that this finding is clearly erroneous because, “[i]f Mr. Berger’s ‘Thermos’ survey is a valid survey, then a survey in which the majority of people who are shown a picture of an apple identify it as an apple, proves that the Apple trademark . . . is in fact generic.” This assertion does not follow from the Order’s finding, however, which is not that Dr. Berger’s Thermos study *proves* that the Mark is generic, but that the survey is relevant to and probative of whether the Mark is generic.

Similarly flawed is Plaintiffs’ argument that the Order improperly shifts Defendants’ burden to prove genericness to Plaintiffs. The Order did not relieve Defendants’ of the burden of persuasion to prove genericness, but instead held that Dr. Berger’s survey was admissible because its purported design flaws did not “destroy all of its relevance.” (quoting *Victoria’s Secret*, 2009 WL 959775, at *11 n.9.

Plaintiffs' argument that the Order was clearly erroneous insofar as Dr. Berger tested the wrong universe is rejected for the same reasons stated with respect to Dr. Maronick.

Because the Order is not clearly erroneous or contrary to law as to Defendants' experts Drs. Maronick and Berger, Plaintiffs' objection to the denial of their motion to preclude Defendants' experts is overruled.

B. Defendants' Objections to the Order

Defendants argue that the Order was clearly erroneous and contrary to law insofar as it failed to preclude the expert evidence of Brian M. Sowers, Plaintiffs' expert on genericness. Specifically, Defendants argue that Judge Francis failed to consider that Mr. Sowers lied about his education and experience and lacks an understanding of both the "Primary Significance Test" and basic statistical concepts. These arguments are unavailing, for the reasons below.

Defendants' assertion that Mr. Sowers' "deceit" with respect to his curriculum vitae necessitates preclusion is baseless. Mr. Sowers did not lie about his graduate education; he received his graduate education from the University of Colorado, as indicated in his curriculum vitae. Even if Mr. Sowers' failing to specify on his curriculum vitae that he attended an online program were to qualify as "deceit," Defendants have cited no authority to suggest that such behavior bears on whether Mr. Sowers is qualified to opine on genericness, or to evaluate the results of Plaintiffs' experts' studies. Likewise, Defendants assert that Mr. Sowers' claim that he has served as an expert previously is deceitful because Mr. Sowers has never been sworn in to give expert testimony. That Mr. Sowers has never been asked to testify is of no relevance as to whether he has served in an expert capacity and does not indicate any deception on his part.

Defendants also take issue with the Order's characterization of Mr. Sowers' experience, specifically, its statement that Mr. Sowers occupied research positions when his curriculum vitae

indicated that he occupied managerial positions. Even assuming that the Order misstated Mr. Sowers' job titles, it fairly characterized his work experience as Mr. Sowers described it in his expert report and at his deposition. For many years, during which he occupied both managerial and non-managerial roles at a variety of companies, Mr. Sowers designed and executed surveys, collected and analyzed survey data, and reported survey results. His relevant experience includes designing and executing surveys, including genericness surveys -- beginning in 2011 -- specifically for litigation purposes. That Mr. Sowers "worked under the direction of experts . . . in designing genericness surveys" from 2011 to 2014 does not diminish the relevance or value of this experience. Although Mr. Sowers did not design or execute a genericness survey prior to 2011, his experience conducting qualitative and quantitative market research (including survey-based research) is a relevant qualification. To the extent that Defendants believe Mr. Sowers' education and experience undermine his credibility or diminish his persuasiveness, they may make such arguments at summary judgment or trial.

Defendants argue that Mr. Sowers must be precluded for multiple other reasons, none of which is persuasive. Defendants argue that the Order is clearly erroneous because "it does not address the fact that Mr. Sowers said, in sworn testimony, that he could not *understand* the plain meaning of the words in the Primary Significance Test." (Emphasis in original.) Under the Primary Significance Test, "a plaintiff seeking to establish a valid trademark 'must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.'" *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997) (quoting *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938)). 15 U.S.C. § 1064(3), which codifies the Primary Significance Test further provides: "The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for

determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.” Although Mr. Sowers testified that “some language” in § 1064(3) is “unclear,” his testimony does not suggest a lack of understanding of the underlying concept of genericness. Defendants fail to explain how Mr. Sowers’ testimony about the Primary Significance Test compromised any of his analyses. Moreover, Mr. Sowers’ testimony that the relevant universe would include “at least” those who might rely on the Mark to make a purchasing decision is consistent with § 1064(3) insofar as Mr. Sowers did not suggest that a finding of genericness depends on purchaser motivation rather than the Mark’s primary significance to the relevant public.

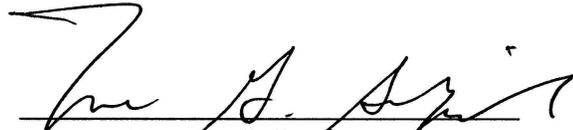
Defendants also assert that “the Berger Reply and the Maronick Reply are replete with instances of Sowers incorrectly using statistical terms or concepts”; however, Defendants identify only one instance of such an error, and offer no explanation as to why this or any other alleged error undermines the reliability of his reports. Similarly, Defendants argue that that the Order fails to consider that “Sowers cut-and-pasted approximately 40% of his material between the Berger Reply and the Maronick Reply.” But Defendants do not explain why Mr. Sowers’ analysis is wrong, or why his applying the same analysis in response to both expert reports renders that analysis unreliable. Also, Defendants’ 40% calculation is misleading: it includes Mr. Sowers’ introduction and a description of his qualifications, a description of this litigation and the scope of his assignment, and explanations of various survey design principles.

Because the Order is not clearly erroneous or contrary to law as to Plaintiffs’ expert Mr. Sowers, that portion of the Order is affirmed.

IV. CONCLUSION

For the reasons stated, the Order denying Plaintiffs' and Defendants' cross-motions to preclude expert evidence is AFFIRMED.

Dated: July 24, 2017
New York, New York



LORNA G. SCHOFIELD
UNITED STATES DISTRICT JUDGE