EXHIBIT 45

Exhibit A

NERA
Economic Consulting

Kent D. Van Liere
Vice President

National Economic Research Associates, Inc.
1 Front St., Suite 2600
San Francisco, California 94111
+1 415 291 1000 Fax +1 415 291 1020
Direct dial: +1 415 291 1010
kent.van.liere@nera.com
www.nera.com

KENT D. VAN LIERE, Ph.D.
VICE PRESIDENT

Dr. Van Liere is a Vice President at NERA with expertise in survey research, sampling, statistics, risk analysis and market research. He has testified at trial and in deposition on the application of statistical methods, sampling, questionnaire design, and the use of surveys.

Dr. Van Liere's litigation and project experience includes sampling, survey research, design of field protocols, and statistical analysis of large data files (i.e., sales data, products in the field, insurance claims, employee records, customer data, or transactions data) in a number of areas including:

Intellectual Property

- Trademark Infringement: Design, analysis, and critique of samples and surveys used to measure consumer confusion, secondary meaning, and dilution in trademark infringement cases.
- False and Misleading Advertising: Design, analysis, and critique of samples and surveys used to measure consumer understanding of and response to advertising claims.
- Copyright infringement: Sampling plans and analysis of the rates of infringing material in populations of shared information (such as through websites or other sharing medium).
- Patent Infringement: Sample designs and surveys to establish rates at which infringing material exist in populations of products or unique use of features in product user populations.

Mass Torts and Class Actions

- Product Liability and Construction Defects: Analysis of statistical samples of products and product use to determine product performance issues, statistical evaluation of causes of product failures, and damages in product liability and construction defect class action litigation. Analysis of sales records to forecast total sales. Products have included a wide range of consumer and building products.

- Representations and Omissions: Many class actions focus on misleading and deceptive information or omissions of information. Design and analysis of sampling plans and surveys to measure consumers' awareness of key documents or facts, reliance on representations, materiality of information for decisions, satisfaction with products, purchase processes, and analysis of choice behaviors in a range of consumer and business products areas.

- Labor: Analysis of employment records, methods for sampling records or employees, and use of surveys for purposes of estimating key facts in labor class actions including time to complete activities, exempt/nonexempt activities, and meal and rest break issues.

- Asbestos and Toxic Torts: Estimation of future claims and claim costs arising from exposures to various hazardous materials such as asbestos including modeling future liability for purposes of setting financial reserves, analysis of large claim files, insurance allocations, and insurance buybacks.

Energy/Environment/Water/Infrastructure

- Customer Demand: Design and analysis of customer samples and surveys to measure customer usage (demand) and customer preferences for a wide range of product and rate offerings including pricing or rate options, incentive programs, information programs, new service offerings.

- Value of Service/Outage Costs: Design and analysis of value of service and outage cost studies based on surveys using lost profits and willingness to pay methodologies.

- Evaluation of programs and services including customer satisfaction and program impacts.

Market Definition/Market Segmentation/New Products

- Analysis of consumer choice and business decision making for purposes of measuring and evaluating market potential, market segmentation, strategy formulation, new product offerings, positioning/branding, and customer retention/switching behavior in the areas of consumer household products, automobiles, lighting and building products, energy efficiency and solar products, telecommunications services, industrial products, and information and subscription services.

Prior to joining NERA, Dr. Van Liere served as a Principal of Freeman Sullivan where he directed survey research and sampling projects for litigation; President of Primen (a firm that conducted market research for the energy/infrastructure industry); Senior Vice President of Hagler Bailly where he directed the survey research and market analysis practice; the President/Principal of HBRS (a highly regarded survey research firm); and Associate Professor at the University of Tennessee where he taught statistics, sampling, and research methods at both the graduate and undergraduate levels.

Education

Washington State University
Ph.D. Sociology, specialization in research methods and statistics (1979).

Washington State University
M.A. Sociology, (1976).

Hamline University
B.A. Sociology, with Honors (1974).

Professional Experience

	NERA Economic Consulting
2006	Vice President
	Freeman, Sullivan & Co., San Francisco
2002-2005	Principal
	Primen (a joint venture of the Electric Power Research Institute and the Gas Research Institute)
2000-2002	President and Chief Executive Officer
	Hagler Bailly, Inc. (HBIX)
1995-2000	Senior Vice President (1997-2000), Director (1995-1997)
	HBRS, Inc., Madison, WI
1985-1995	President (1992-1995), Principal (1985-1992)
	University of Wisconsin-Madison
1985	Visiting Associate Professor, Department of Rural Sociology (summer)
	University of Tennessee
1978-1985	Associate Professor (with tenure), Department of Sociology (1984-1985), Assistant Professor, Department of Sociology (1978-1984)
	Tennessee Valley Authority
1983-1984	Visiting Analyst, Strategic Planning Staff, Office of Planning and Budget

Expert Analysis and Testimony

Intellectual Property Matters

Real Estate Disposition Corporation *v.* National Home Auction Corporation, United States District Court, Central District of California—Expert report on a survey to address issues of materiality, confusion, and misleading advertising in an unfair business practices and infringement case. (Expert Report: February, 2008; Surrebuttal report: March, 2008, Deposition: January, 2009).

Mary Kay, Inc. *v.* Amy Weber, Scott Weber, and Touch of Pink Cosmetics, United States District Court, Northern District of Texas, Dallas Division—Expert report on likelihood of confusion with regard to sale of branded products on a website. (Expert Report: December 2008; Deposition, December 2008)

American Airlines, Inc., *v.* Google, Inc., United States District Court, Northern District of Texas, Fort Worth Division—Expert report on likelihood of confusion with regard to trademark or branded keyword searches using the Google search engine. (Expert Report: May 2008; Deposition, May 2008, Surrebuttal Report, June 2008).

Rocky Brands, Inc., and Rocky Brands Wholesale, LLC, *v.* Glen Bratcher, Westwood Footwear and Accessories, LLC, and Nantong Hong Yi Wang Shoes Co., LTD, United States District Court, Southern District of Ohio, Eastern Division—Expert report on a likelihood of confusion with regard to trade dress of products in the footwear markets. (Expert Report: April 2008, Deposition: April 2008).

Faloney et al. *v.* Wachovia Bank, United States District Court, Eastern District of Pennsylvania—Expert analysis and rebuttal declaration on issues related to common representations to consumers in a precertification class action lawsuit related to telemarketing. (Expert Report: February, 2008).

Lulu Enterprises, Inc. *v.* N-F Newsite, LLC and Hulu Tech, Inc., United States District Court, Eastern District of North Carolina—Expert report on likelihood of confusion with regard to websites. (Expert Report: October 2007).

Confidential Client—Consulting rebuttal expert on survey design, sampling, survey implementation, and study design in trademark infringement and confusion analysis in the consumer beverages markets. (Expert Report: April 2007).

Anti-Trust, Labor and Commercial Disputes

Cencast Services, L.P., et al. *v.* The United States, United States Court of Federal Claims—Expert declarations regarding sampling and surveys of labor records and workers related to issues of FICA/FUTA taxes in the entertainment industry. (Expert Declaration: November, 2009)

IDT Telecom, Inc. and Union Telecard Alliance, LLC. *v.* CVT Prepaid Solutions, Inc. et al., United States District Court, District of New Jersey—Expert rebuttal report on survey and sampling issues related to consumer purchases of international pre-paid calling cards. (Expert Report: May, 2009)

Federal Trade Commission *v.* Whole Foods Market, Inc. and Wild Oats Markets, Inc., United States District Court, District of Columbia—Expert rebuttal report on sampling and survey design issues in an antitrust proceeding related to a preliminary injunction to block a proposed merger of Whole Foods Markets Inc. and Wild Oats. (Expert Report: July 2007; Deposition: July, 2007).

Javier Olguin *v.* Fed Ex Ground Package Systems, Superior Court of California, County of Orange—Expert rebuttal declaration on sampling and survey design issues in a pre-certification labor class action. (Expert Declaration: March 2007; Deposition: April, 2007).

Redwood Fire and Casualty Insurance Company *v.* Personnel Plus et al., Superior Court of California, County of Los Angeles—Expert analysis and sample design to estimate workman compensation premiums from employee payroll records. (Deposition: December, 2007).

Adelphia Communications Corp *v.* Deloitte and Touche, LLP, Court of Common Pleas, Philadelphia, Pennsylvania—Expert rebuttal report on use of surveys of employees to estimate business process inputs to calculation of capitalizable costs for accounting restatement. (Expert Report: December, 2006; Deposition: February 2007).

Laser Vision Eye Institute of California *v.* Nidek, Inc., Superior Court of California, County of Alameda—Expert declaration on estimation of economic damages from business interruption due to equipment availability issues. (Expert Declaration, March 2003).

Product Liability, Mass Torts and Construction Defects

Jovan Jones et al., *v.* Sears, Roebuck & Company, United States District Court, Northern District of Illinois, Eastern Division—Expert affidavit on issues related to using samples and surveys to estimate the rate of installation of nonconforming appliance venting. (Affidavit: November, 2009)

John Sutherland et al. *v.* Dan Gamel, Inc., Superior Court of California, County of Fresno—Expert rebuttal report on issues related to use of a survey to characterize a putative class in a pre-certification class action related to RV sales practices. (Expert Report: May, 2009).

Zill et al. *v.* Sprint Spectrum L.P. and Wireless Co. LP, Superior Court of California, County of Alameda—Expert rebuttal declarations on sampling, survey design, survey implementation, and the use of contingent valuation survey to estimate damages in a wireless communications class action. Expert report based on a survey of putative class members on consumer expectations and purchase behavior for wireless handsets. (Expert Declaration: December, 2006 and February, 2007; Deposition: April 2007; Expert Report: June 2007).

McAdams et al. *v.* Monier Lifetile et al., Superior Court of California, County of Placer—Deposition testimony and expert report on statistical and survey research, sample design, data analysis regarding issues related to representations and consumer expectations for construction product longevity in a pre-certification class action. (Expert Report and Declarations: October/November 2005; Deposition: November 2005).

Weiner, et al. *v.* Shake Company of California, Inc., et al., Superior Court of California, County of Contra Costa—Testifying expert on statistical analysis, sample design, causation issues, and damages regarding the prevalence of roofing failure in homes made with Cal Shake Roofing products. (For Liability Phase Trial: Multiple declarations and depositions in 2005, trial

testimony June 2005. For Damage Phase Trial: Expert declaration, September, 2006; Deposition: September 2006).

Kaiser Aluminum Chemical Corporation *v.* Certain Underwriters at Lloyd's London et al., Superior Court of California, County of San Francisco—Statistical analysis related to sampling of insurance claims and allocation of liability among excess insurers for asbestos liability.

Lotzer, et al. *v.* International Window Corporation, et al., Superior Court of California, County of Solano—Consulting expert on statistical analysis for purpose of estimating sales from invoice data and design of sampling strategies for product field tests in post-certification class action.

Confidential client—Analysis of asbestos claims, exposures by occupation, settlement costs, and future claims costs associated with a major boiler manufacturer.

Confidential Client, United States Bankruptcy Court, District of Delaware—Statistical surveying, analysis and consultation regarding the prevalence of failure in homes constructed with a specific building product.

McIlhargie, et al. *v.* Moulded Fiberglass Companies et al., Superior Court of California, County of San Joaquin—Consulting expert on statistical analysis, sampling design, and consultation on prevalence of construction building product defect in pre-certification class action.

Bowen-Fromm *v.* Terra Shake Products, et al., Superior Court of California, County of Alameda—Statistical analysis, sampling design, and consultation on prevalence of product defects in a class action lawsuit.

Bayview Hunters Point, All Hallows, Shoreview and LaSalle Apartments L.P. *v.* Colorworks Collegiate Painters; Simonton Building Products, United States District Court, Northern District of California—Statistical analysis and sampling design for estimation of the prevalence of construction defects in windows, doors, and siding.

Nature Guard Cement Roofing Shingles Cases in Davis *v.* Louisiana-Pacific Corporation, Superior Court of California, County of Stanislaus—Consulting expert on statistical analysis of evidence regarding prevalence of construction defects.

People of the State of California, *v.* Apartment Investment and Management Company, et al., Superior Court of California, County of San Francisco—Consulting expert on statistical analysis and sampling designs related to the prevalence of hazards and other construction and maintenance issues leading to notice of violations in buildings. (Expert report, October, 2003).

Naef, et al. *v.* Masonite, Superior Court, County of Mobile, Alabama—Consulting expert on statistical surveying and analysis of the prevalence of siding failure in homes made with Masonite siding. Identification of factors contributing to failure, projection of failure rates observed during the survey to the population of homes manufactured with subject siding, calculation of expected future costs of legal settlement under the various terms and conditions.

Summary of Consulting Experience in Market Analysis, Sampling, Survey Research and Policy Evaluation Experience

Over the past 20 years have served as a Practice Leader, Principal Investigator, and President/CEO for companies in market analysis and customer research. Principal investigator for over 300 market assessment, customer segmentation, customer choice, consumer opinion and public policy evaluation engagements in energy, telecom, environment, infrastructure, transportation, and consumer products and services industries. Key areas have included:

Measurement of Consumer Behavior and Customer Attitudes, Opinions, and Choice Studies—Directed more than 125 major projects measuring customer attitudes, customer intentions, and customer choices using broad range of survey techniques. Research projects addressed defining markets, customer segmentation, market potential, new product forecasting, satisfaction and company image tracking, and in support of litigation related to brand awareness/image, confusion, trademark issues, and use of products. Surveys included data collection from industrial companies, commercial companies, agricultural firms, and consumers. Areas included telecom, financial services, energy, environment, consumer products, industrial products, water, and business services.

Value of Service and Outage Cost Research—Led teams that designed and implemented new methods of measuring valuing service reliability by measuring outage costs for electricity and gas service using customer surveys. These surveys measured residential, commercial, industrial, and agricultural customers' outage costs and their preferences for different scenarios of service reliability. These projects included clients throughout the United States. The studies involved several thousand surveys with all customer segments including residential, commercial, industrial, and agricultural customers.

Design of Performance Measurement Systems—Led teams that designed and implemented performance measurement systems for companies focused on financial, process and customer goals. Projects included goal setting, identification of key performance indicators, setting performance standards, identifying data sources, and developing reporting systems. These engagements involved working with employees on surveys of staff time usage and allocation of time to activities as well as design of customer satisfaction/expectations surveys with customers.

Energy, Environment, and Transportation—Led teams conducting evaluations of major energy efficiency, demand management, environmental and transportation programs including rate programs, rebate programs, information programs and load control programs for major utilities, government agencies, and research institutes. Projects included sampling designs, survey designs, survey implementation using all modes of surveys (in-person, telephone, mail, internet), and statistical analysis of surveys of customers, and cost benefit evaluations. Over 150 program evaluations over past 20 years.

Environmental Attitudes and Behaviors—Early research focused on environmental attitudes and environmental behaviors in a wide range of settings. Co-developer of one of the most widely used environmental attitude scales (New Environmental Paradigm (NEP) scale.

Publications

Van Liere, Kent D., Butler, Sarah. 2007. "Emerging Issues in the Use of Surveys in Trademark Infringement on the Web." Paper published in the *Advanced Trademark & Advertising Law Conference* proceedings, Seattle, WA, September, 2007.

King, Mike, Kent Van Liere, Gene Meehan, Glenn R. George, Wayne P. Olson, Amparo D. Nieto. 2007. "Making a Business of Energy Efficiency: Sustainable Business Models for Utilities," Edison Electric Institute, Washington, D.C., August, 2007.

Van Liere, Kent. D. 2007. "Use of Sample Surveys in Product Liability Litigation," in *The International Comparative Legal Guide to: Product Liability 2007.* London: Global Legal Group LTD, pp. 38-43.

Lawton, Leora, Michael Sullivan, Kent D. Van Liere, Aaron Katz, and Joseph Eto "*A Framework and Review of Customer Outage Costs: Integration and Analysis of Electric Utility Outage Cost Surveys,*" Energy Storage Program, Office of Electric Transmission and Distribution, U.S. Department of Energy, LBNL-54365, 2004.

Dunlap, Riley E., Kent D. Van Liere, Angela G. Mertig, and Robert E. Jones. 2000. "Measuring Endorsement of the New Ecological Paradigm: A Revised NEP Scale." *Journal of Social Issues,* 56: 425-442.

Malloy, Ken, Jamie Wimberly, and Kent D. Van Liere. 1999. "The Customer Stewardship Program: Successfully Linking Consumer Education and Corporate Strategy," *The Electricity Journal*, August/September 1999.

The High Efficiency Laundry Metering and Marketing Analysis (THELMA) Project. EPRI, Palo Alto, CA: 1997. TR-109147-Volumes 1 to 9.

Market Tracking: Assessing Sources and Access to Appliance Sales Data, EPRI, Palo Alto, CA: 1997. TR-108928.

Performance Measurement in Utilities: A Framework for Creating Effective Management Systems. EPRI, Palo Alto, CA: 1996. TR-106860 3269-34.

Van Liere, Kent D., Rick Winch, Kathleen Standen, Shel Feldman, and Dale Brugger. 1994. "The Design and Structure of a Statewide Sales Tracking System for Residential Appliances." In *Energizing the Energy Policy Process,* edited by Roberta W. Walsh and John G. Heilman, Westport, Connecticut, Quorum Books, pp. 199-216.

Van Liere, Kent D. and William Lyons. 1986. "Measuring Perceived Program Quality." In *Performance Funding in Higher Education*, edited by Trudy W. Banta, Boulder, Colorado, National Center for Higher Education Management System, pp. 85-94.

Dunlap, Riley E. and Kent D. Van Liere. 1984. "The Dominant Social Paradigm and Concern for Environmental Quality: An Empirical Analysis." *Social Science Quarterly*, 65: 1013-1028.

Hand, Carl M. and Kent D. Van Liere. 1984. "Religion, Mastery Over Nature and Environmental Concerns." *Social Forces*, 63: 555-570.

Ladd, Anthony E., Thomas C. Hood, and Kent D. Van Liere. 1983. "Ideological Themes in the Antinuclear Movement: Consensus and Diversity." *Sociological Inquiry*, 53: 252-272.

Lounsbury, John W., Kent D. Van Liere, and Gregory J. Meissen. 1983. "PsychoSocial Assessment." In *Social Impact Assessment Methods*, edited by K. Kinsterbush, L. Llewellyn, and C.P. Wolff, Beverly Hills, California, Sage, pp. 215-240.

Van Liere, Kent D. and Riley E. Dunlap. 1983. "Cognitive Integration of Social and Environmental Beliefs." *Sociological Inquiry*, 53: 333-341.

Van Liere, Kent D. and Benson H. Bronfman. 1981. "Beliefs About Social Control and Participation in a Load Management Project." *Housing and Society*, 8: 124-135.

Van Liere, Kent D. and Riley E. Dunlap. 1981. "Environmental Concern: Does it Make a Difference How It's Measured?" *Environment and Behavior*, 13: 651-676.

Van Liere, Kent D. and Frank P. Noe. 1981. "Outdoor Recreation and Environmental Attitudes: Further Examination of the Dunlap-Hefferen Thesis." *Rural Sociology*, 46: 505-513.

Van Liere, Kent D. and Riley E. Dunlap. 1980. "The Social Bases of Environmental Concern: A Review of Hypotheses, Explanations, and Empirical Evidence." *Public Opinion Quarterly*, 44: 181-197.

Tremblay, Kenneth R., Jr., Don A. Dillman, and Kent D. Van Liere. 1980. "An Examination of the Relationship Between Housing Preferences and Community Size Preferences." *Rural Sociology*, 45: 509-519.

Dunlap, Riley E. and Kent D. Van Liere. 1978. "The New Environmental Paradigm: A Proposed Measuring Instrument and Preliminary Results." *Journal of Environmental Education*, 9: 10-19.

Van Liere, Kent D. and Riley E. Dunlap. 1978. "Moral Norms and Environmental Behavior: An Application of Schwartz's Norm-Activation Model to Yard Burning." *Journal of Applied Social Psychology*, 8: 174-188.

Dunlap, Riley E. and Kent D. Van Liere. 1977. "Further Evidence of Declining Public Concern with Environmental Problems: A Research Note." *Western Sociological Review*, 8: 110-112.

Dunlap, Riley E. and Kent D. Van Liere. 1977. "Land Ethic or Golden Rule." *Journal of Social Issues*, 33: 200-207.

Dunlap, Riley E. and Kent D. Van Liere. 1977. "Response to Heberlein." *Journal of Social Issues*, 33: 211-212.

Dunlap, Riley E. and Kent D. Van Liere. 1979. "Decline in Public Concern for Environmental Quality: A Reply." *Rural Sociology*, 44: 204-212.

Professional Associations

Member, American Association of Public Opinion Research

Member, American Statistical Association

October 2009

Exhibit B

Documents relied upon:

1) Rosetta Stone, Ltd. V. Google, Inc., Complaint

2) Diamond, S. (2000) "Reference Guide on Survey Research" in the *Reference Manual on Scientific Evidence Second Edition,* Federal Judicial Center

3) McCarthy, J. Thomas (2006) *McCarthy on Trademarks and Unfair Competition 4th Edition*, Chapter 32

FILED

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

2009 JUL 10 A 8:43

CLERK US DISTRICT COURT
ALEXANDRIA, VIRGINIA

ROSETTA STONE LTD.
1919 North Lynn Street
Arlington, Virginia 22209,

Plaintiff,

-v-

GOOGLE INC.
1600 Amphitheatre Parkway
Mountain View, California 94043,

Defendant.

Civil Action No. 1:09cv736 GBL/TJF

COMPLAINT

Plaintiff Rosetta Stone Ltd. ("Rosetta Stone"), through its counsel, for its Complaint against Google Inc. ("Google"), alleges as follows.

NATURE OF THE ACTION

1. This lawsuit relates to the use of trademarks on the Internet, particularly Defendant Google's unauthorized use of the famous trademarks and service marks that identify Rosetta Stone, the foremost language-education company in the United States, to Internet users (the "Rosetta Stone Marks"). The fundamental purpose of trademark law, in the bricks-and-mortar world and on the Internet, is to protect consumers from being confused as to the source or affiliation of the products or services that they seek to buy. In order to assist consumers in making informed purchasing decisions, trademark law encourages companies to develop brand

names to differentiate their products and services within the marketplace. This is accomplished by legally limiting a brand's commercial use to the brand's owner. This legal protection fully applies in the context of the Internet.

2. Unfortunately, some individuals and entities attempt to take advantage of consumers by marketing their products or services using the brands of others. In effect, they seek to free ride on the reputation and goodwill of another's brand. Because of the ease and low cost of setting up a website and the speed with which Internet transactions occur, this has become a particular and growing problem in connection with consumer purchases of goods and services on the Internet. This lawsuit involves exactly such a situation -- efforts by certain companies to free ride on Rosetta Stone's brand with the active participation and assistance of Google in such unauthorized and intentional use of Rosetta Stone's Marks through Google's technology.

3. Google owns and operates one of the world's most-utilized Internet "search engines." A search engine is a computer program that allows computer users to search the World Wide Web for websites containing particular content. Google's search engine is available not only on its own website (www.google.com), but also through other popular websites that use its search engine. On information and belief, approximately 80% of all searches conducted worldwide use Google's search engine.

4. To use Google's search engine, a World Wide Web user ("web user") need only type in a few words and hit the "enter" key (or click on the "Google Search" button) to receive a list of hyperlinks ("links") to web pages that Google identifies as relevant to the search requested. Web users may then visit these web pages by clicking on the links that Google provides. Google maintains and, on information and belief, many consumers believe, that the search results Google provides are the product of an objective formula or algorithm that produces "natural" or

"organic" results, *i.e.*, web listings the display and placement of which are not influenced by payments to Google from the website owners.

5. Google, however, does not only provide Internet users with such "organic search results." Without authorization or approval from Rosetta Stone, Google has sold to third parties the "right" to use the Rosetta Stone Marks or words, phrases, or terms confusingly similar to those marks, as "keyword" triggers that cause paid advertisements, which Google calls "Sponsored Links," to be displayed above or alongside the "organic search results." In many cases, the text and titles of these "Sponsored Links" include Rosetta Stone Marks or terms confusingly similar to those marks. Thus, when consumers enter one of the Rosetta Stone Marks into Google's search engine to search or navigate the World Wide Web, instead of being directed to Rosetta Stone's website, Google's "Sponsored Links" may instead misdirect them to: (i) websites of companies that compete with Rosetta Stone; (ii) websites that sell language education not only for Rosetta Stone, but also for a variety of competitors of Rosetta Stone; (iii) websites that sell counterfeit Rosetta Stone products; or (iv) websites that are entirely unrelated to language education.

6. Rosetta Stone does not bring this lawsuit lightly. Rosetta Stone has long been and remains a strong supporter of the Internet and the promise that it holds for consumers and society as a whole. Indeed, Rosetta Stone does not question that Google's search engine provides consumers with a powerful and highly-useful means to search the Internet for information. That said, Google's search engine is helping third parties to mislead consumers and misappropriate the Rosetta Stone Marks by using them as "keyword" triggers for paid advertisements and by using them within the text or title of paid advertisements. This lawsuit seeks to stop only this aspect of Google's search engine function and not its ability to provide "organic search results."

Indeed, Google has the ability to structure and configure its programming to stop this misuse of the Rosetta Stone Marks because it has already implemented procedures with respect to many non-U.S. Internet users that prevent the misuse of trademarks. Google, however, has chosen not to implement these procedures for Internet users in the United States to the detriment of U.S. consumers and Rosetta Stone.

THE PARTIES

7. Plaintiff Rosetta Stone is a corporation organized under the laws of the State of Delaware with its principal place of business at 1919 North Lynn Street, Arlington, Virginia, which is within the Alexandria Division of this District.

8. Upon information and belief, Defendant Google is a corporation organized under the laws of the State of Delaware with a principal place of business in Mountain View, California. In addition, on information and belief, Google advertises, solicits clients, leases office space, and conducts substantial amounts of business in the Commonwealth of Virginia and within the Alexandria Division of this District.

JURISDICTION AND VENUE

9. This action arises in part under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.* This Court has federal question jurisdiction over these claims pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 1338(b). This Court has supplemental jurisdiction over the Virginia state law claims pursuant to 28 U.S.C. § 1367(a) because those claims are so closely related to the federal claims brought herein as to form part of the same case or controversy.

10. Google is subject to personal jurisdiction in the Commonwealth of Virginia because Google practices the unlawful conduct complained of herein, in part, within this District; because the unlawful conduct complained of herein causes injury, in part, within this District;

because Google regularly conducts or solicits business, rents or leases office space within this District, engages in other persistent courses of conduct and/or derives substantial revenue from goods and/or services used or consumed within this District; and because Google regularly and systematically directs electronic activity into the Commonwealth of Virginia with the manifested intent of engaging in business within this District, including the creation, hosting, and offering of fully interactive websites, advertising, e-mail, and other Internet-related services to web users within this District, as well as entry into contracts with residents of this District.

11. Venue is proper in this District under 28 U.S.C. § 1391(b)(2) because a substantial part of the events or omissions giving rise to the claims herein occurred in this District.

12. Venue is also proper in this District under 28 U.S.C. §§ 1391(b)(1) and (c) because Google is a corporation whose contacts, as alleged in this Complaint, would be sufficient to subject it to personal jurisdiction if this District were a separate state.

FACTUAL BACKGROUND

The Internet and the World Wide Web

13. The Internet is a global network of millions of interconnected computers. The World Wide Web is a portion of the Internet especially well-suited to displaying images and sound as well as text. Much of the information on the World Wide Web is stored in the form of web pages, which can be accessed through a computer connected to the Internet (available through commercial Internet service providers or "ISPs"), and viewed using a computer program called a "browser," such as Microsoft Internet Explorer. "Websites" are locations on the World Wide Web containing a collection of web pages. A web page is identified by its own unique Uniform Resource Locator ("URL") or "web address" (*e.g.*, <http://www.rosettastone.com>),

which ordinarily incorporates the website's "domain name" (*e.g.*, "rosettastone.com"). Because URLs and domain names are not case-sensitive, URLs and domain names that contain capital letters are functionally the same as those that do not.

Rosetta Stone and the Rosetta Stone Marks

14. Rosetta Stone was founded in 1992. Since that time, Rosetta Stone has become a leader in providing technology-based language-learning products and services. Rosetta Stone's language-learning solutions are available in more than thirty languages and are used by schools, corporations, government entities and millions of individuals in more than 150 countries throughout the world. Rosetta Stone's website provides consumers with easy access to its language-education software and services.

15. To preserve and enhance its trademark rights, Rosetta Stone has obtained federal trademark registration for many of its Rosetta Stone Marks, some of which have been in continuous use for more than five years and are therefore considered "incontestable" pursuant to 15 U.S.C. §§ 1065 and 1115(b).

16. Among Rosetta Stone's federally registered marks are:

- ROSETTA STONE which was first used in commerce in 1993 and which has a registration date of September 9, 2003;
- GLOBAL TRAVELER which was first used in commerce in 2002 and which has a registration date of August 12, 2003;
- ROSETTA STONE LANGUAGE & LEARNING SUCCESS which was first used in commerce in 2001 and which has a registration date of November 11, 2003;

- LANGUAGE LIBRARY which was first used in commerce in 1993 and which has a registration date of July 27, 2004;
- DYNAMIC IMMERSION which was first used in commerce in 2001 and which has a registration date of November 20, 2007;
- THE FASTEST WAY TO LEARN A LANGUAGE. GUARANTEED which was first used in commerce in 2002 and which has a registration date of March 18, 2008;
- ROSETTASTONE.COM which was first used in commerce in 1999 and which has a registration date of June 24, 2008;
- ROSETTA WORLD which was first used in commerce in 2006 and which has a registration date of October 7, 2008;
- ADAPTIVE RECALL which was first used in commerce in 2007 and which has a registration date of December 30, 2008;
- CONTEXTURAL FORMATION which was first used in commerce in 2007 and which has a registration date of January 13, 2009;
- SHAREDTALK which was first used in commerce in 2006 and which has a registration date of February 3, 2009; and
- AUDIO COMPANION which was first used in commerce in 2008 and which has a registration date of February 3, 2009.

17. Rosetta Stone has registered the mark ROSETTA STONE in the Commonwealth of Virginia which has a registration date of April 13, 2009. Rosetta Stone also has common law rights to the Rosetta Stone Marks in the Commonwealth of Virginia by virtue of the marks' eligibility for protection and Rosetta Stone's status as the senior user of the marks.

18. The Rosetta Stone Marks are unique and famous distinctive designations of the source of Rosetta Stone's products and services.

19. Rosetta Stone has invested substantial amounts in worldwide advertising and marketing in order to build the fame, reputation, and goodwill of the Rosetta Stone Marks. Rosetta Stone advertises through a variety of media, including television, radio, newspapers, magazines, direct mail, and in telephone directories across the country.

20. Rosetta Stone also promotes its products and services on the Internet, via its own websites and through advertising on the websites of third parties.

21. Through Rosetta Stone's actions, and because of widespread and favorable public acceptance and recognition, the Rosetta Stone Marks have become distinctive designations of the source of origin of Rosetta Stone's products and services. The Rosetta Stone Marks have become uniquely associated with, and hence identify, Rosetta Stone. These marks are assets of incalculable value as symbols of Rosetta Stone, its quality products and services, and its goodwill.

22. Accordingly, the Rosetta Stone Marks have developed secondary meaning.

23. The Rosetta Stone Marks have become "famous" within the meaning of the dilution provisions of the Lanham Act, 15 U.S.C. § 1125(c). For example, as a result of Rosetta Stone's extensive advertising and promotional efforts, the mark "Rosetta Stone" has, on information and belief, attained some of the highest levels of brand recognition among consumers.

24. Rosetta Stone conducts a substantial amount of its business over the Internet and has made a sizeable investment in the development of its online business. It is generally more beneficial for Rosetta Stone when consumers purchase directly through Rosetta Stone. Among

other reasons, this is because when consumers buy through www.rosettastone.com, it assists Rosetta Stone in conveying important information to its customers, in developing a direct relationship and future business with its customers, and in minimizing costs associated with various transactions.

Google's Search Engine

25. Web users who are searching for a specific company product, service or information, but who do not know the exact domain name or website address at which it may be found, may use an internet "search engine" to locate it. In fact, many web users prefer to navigate the Internet by typing phrases and even URLs into search engines rather than type a URL into an Internet browser's address bar. A search engine, such as Google's, purportedly checks the terms entered into it against its databases and applies a formula or algorithm to produce a search results page that lists the websites that may relate to the customer's search terms and their corresponding links.

26. Google claims, and, upon information and belief, most web users who perform searches with Google's Internet search engine believe, that the results given by that search engine are determined by a "natural" or "organic" system that lists results in order of objective relevance to the search terms input into the search engine, with the most relevant websites appearing near the top of the web page. According to Google, the order in which "organic search results" are listed is automatically determined by a number of factors, including Google's patented PageRank algorithm.

27. By using Google's Internet search engine, web users are identifying to Google the subjects in which they are interested, the companies that they seek, or the products or services they wish to buy. This allows Google to obtain a significant percentage of its profits from

"contextual" or "search" advertising, which allows companies to place their advertising in front of consumers who have already identified themselves as interested in particular products or services.

28. When a web user carries out an Internet search using Google's search engine, Google not only provides the web user with the above-described "organic search results," but also displays a list of similarly formatted advertisements -- which Google refers to as "Sponsored Links" -- above and alongside the purportedly objective "organic search results."

29. On information and belief, the relevance of these "Sponsored Links" is determined not by an objective measure, but rather is substantially influenced by the amount of money Google stands to obtain from the "sponsors" of these links.

30. Google's use of the Rosetta Stone Marks and terms confusingly similar thereto in order to display "Sponsored Links" falsely communicates to consumers that Google's advertisers are official Rosetta Stone affiliates, or that Rosetta Stone sponsors or endorses Google's advertisers. In many cases, Google exacerbates this confusion by publishing text in its "Sponsored Links" that makes further confusing use of the Rosetta Stone Marks.

31. Further, when some web users click on the links that Google's advertisers pay to place above or alongside purportedly objective "organic search results" in order to seek information about Rosetta Stone's products or services, they are deceived into believing that they will be provided with official information about Rosetta Stone's products and other services directly from Rosetta Stone. On information and belief, however, some of these links and the websites to which they lead provide no such information. In fact, in some instances, these links lead to websites that offer the products and services of Rosetta Stone's competitors, whether or

not they also offer Rosetta Stone's own products and services. In other instances, these links lead to websites that offer pirated Rosetta Stone products.

32. On information and belief, Google also employs other advertising programs that utilize similar types of keywords, including but not limited to the Rosetta Stone Marks or terms confusingly similar thereto, to cause advertisements to appear on websites across the Internet that themselves display the Rosetta Stone Marks or terms confusingly similar thereto. On information and belief, many of these advertisements lead Internet users to websites that are not Rosetta Stone websites, some of which even compete with Rosetta Stone.

33. Google's unauthorized use in commerce of the Rosetta Stone Marks generates profits for Google and its advertisers that are directly attributable to their unauthorized exploitation of the value and name recognition associated with the Rosetta Stone Marks.

Google's Search Engine-Based Keyword Advertising Program

34. Google's search engine is available, among other places, through its website located at www.google.com. Google also licenses its search engine to other popular websites, such as America Online, Netscape, EarthLink, CompuServe, Shopping.com, AT&T Worldnet, and Ask.com.[1] In addition, Google invites consumers to affix a "Google Toolbar" at the top of Internet users' Internet browsers that allows these users to conduct Google searches even when they are not currently visiting www.google.com or a website that features Google's search engine.[2]

---

[1] *See* https://adwords.google.com/support/bin/answer.py?answer=6119&hl=en_US (visited June 19, 2009).

[2] *See* http://toolbar.google.com/T4/index_pack.html (visited June 19, 2009).

35. Google reports that its "content network reaches 80% of global internet users -- making it the world's #1 ad network."[3] And, it is estimated that more than 70% of U.S. Internet searches use Google's search engine.[4]

36. Google offers a program called "AdWords" that displays advertisements to users of Google's search engine in the form of "Sponsored Links." Under its AdWords Program, Google offers advertisers the ability to select certain "keywords" that will trigger a "Sponsored Link" to the advertiser's chosen website, which "Sponsored Link" Google will display above or alongside the purportedly "organic search results."

37. On information and belief, advertisers pay Google each time a web user clicks on keyword-targeted "Sponsored Links" that appear on Google's "results" page.

38. These targeted "Sponsored Link" results are not meaningfully or conspicuously identified to consumers as paid third-party advertisements. Google posts its "Sponsored Link" advertisements in a color, typeface, and font size that are not appreciably different than the "organic search results" that Google generates. On information and belief, even the designation of these keyword-triggered "results" as "Sponsored Links" is confusing to many consumers, because Google does not inform consumers who has done the "sponsoring."

39. On information and belief, in a substantial portion of searches, Google's AdWords program makes two distinct uses of a given keyword on behalf on an advertiser. First, Google uses the keyword to trigger the "Sponsored Link" advertisement. Second, Google sometimes publishes the keyword as part of the advertisement itself. Accordingly, when the

---

[3] *See* http://www.google.com/adwords/contentnetwork (visited June 19, 2009).

[4] *See* http://googlesystem.blogspot.com/2009/03/googles-market-share-in-your-country.html. (visited June 19, 2009).

keyword in question is a trademark or service mark, Google can make confusing use of that mark in two different ways: (1) as a keyword trigger and (2) as a part of the advertisement itself.

Google's Unwillingness to Refrain from Trademark Infringement

40. On information and belief, Google has the ability to refrain from making infringing use of proprietary marks as part of its keyword-triggered advertising program, such as AdWords.

41. Specifically, on information and belief, Google could reasonably prevent trademarks, service marks, and terms confusingly similar thereto from being used as keyword triggers or in the title or text of Sponsored Link advertisements.

42. Google has stated in its SEC filings that it formerly did not allow advertisers to use the trademarks of others as keyword triggers. (*See* Form S-1 Registration Statement, Google, Inc., April 29, 2004 ("Google S-1"), p. 10).

43. Consistent with that statement, in a Declaration filed in *American Blind and Wallpaper Factory, Inc. v. Google, Inc., et al.*, a trademark case filed in the United States District Court for the Southern District of New York, Google's Senior Trademark Counsel asserted on April 7, 2004, that Google had the capability to block its advertisers from using non-descriptive trademarks as keyword triggers. (Declaration of Rose A. Hagan in Support of Google Inc., Ask Jeeves, Inc., and Earthlink, Inc.'s Motion to Dismiss or, in the Alternative, to Transfer Venue, filed April 9, 2004, ¶ 4).

44. Google, however, now allows advertisers to purchase specific trademarks as keyword triggers for Sponsored Link advertisements. In its 2004 S-1, Google stated as follows:

> In order to provide users with more useful ads, we have recently revised our trademark policy in the U.S. and in Canada. Under our new policy, we no longer disable ads due to selection by our advertisers of trademarks as keyword triggers for the ads.

(Google S-1, p. 10).

45. Google has further stated that it anticipates additional trademark infringement lawsuits because of its decision to allow its advertising customers to use trademarks to trigger the delivery of "Sponsored Links":

> As a result of this change in policy, we may be subject to more trademark infringement lawsuits . . . . Adverse results in these lawsuits may result in, or even compel, a change in this practice which could result in a loss of revenue for us, which could harm our business.

(Google S-1, p. 10).

46. In contrast to its practices with respect to the use of trademarks in the United States, Google represents that it currently prevents advertisers from using trademarks as keywords in many countries *outside* the United States and Canada. According to Google's trademark policy for trademark rights in many countries outside the United States and Canada, Google will "ensur[e] that the advertisements at issue are not using a term corresponding to the trademarked term in the ad text *or as a keyword*."[5]

47. Additionally, Google maintains an extensive trademark policy regarding confusing uses of *its own* marks. A would-be user of a Google mark must, *inter alia*, "use the trademark only as an adjective, never as a noun or verb, and never in the plural or possessive form," and must put "a minimum spacing of 25 pixels between each side of the logo and other graphic or textual elements on [the user's] web page."[6] Google, in its own words, instructs the world not to "mess around with our marks. Only we get to do that. Don't remove, distort or alter any element of a Google Brand Feature ... for example, through hyphenation, combination

---

[5] http://www.google.com/tm_complaint_adwords.html (emphasis added) (visited June 19, 2009).

[6] "Google Permissions," http://www.google.com/permissions/guidelines.html (visited June 19, 2009).

or abbreviation."[7] Google, however, does not treat the marks of other companies with such respect.

Google's Unauthorized Use of the Rosetta Stone Marks

48. Rosetta Stone has not directly or indirectly given Google any permission, authority, or license to use or sell the right to use the Rosetta Stone Marks for the promotion of the goods and services of any third parties.

49. Nevertheless, on information and belief, Google has in fact sold to third-party advertisers the "right" to use the Rosetta Stone Marks or terms confusingly similar thereto as part of Google's search engine-based advertising program. As a result, Google's programming utilizes the expressed interest of web users in the Rosetta Stone Marks to trigger advertisements to websites that are not Rosetta Stone websites, some of which even compete with Rosetta Stone. In fact, many of Google's "Sponsored Links" are expressly designed to draw consumers *away* from Rosetta Stone websites.

50. Moreover, Google's use of Rosetta Stone Marks within the titles and text that Google posts as a part of some "Sponsored Links" further misleadingly communicates to consumers that such links are endorsed or sponsored by Rosetta Stone or its affiliates, or that such websites are official Rosetta Stone websites.

51. As a part of the process of triggering "Sponsored Links," Google offers its advertisers the ability to purchase as keyword triggers the trademarks and service marks of others, as well as words, phrases, and terms confusingly similar to those trademarks and service marks. Thus, a consumer searching for the Rosetta Stone website using Google's search engine

---

[7] *See id.*

might be shown a "Sponsored Link" unrelated to Rosetta Stone that was displayed because a third-party advertiser purchased a Rosetta Stone Mark or a term confusingly similar thereto as a keyword trigger. A significant number of consumers are likely to believe falsely that it was Rosetta Stone who "sponsored" the links that appears above or alongside the "organic search results."

52. On information and belief, a significant portion of the "Sponsored Links" for which Google uses the Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers link Internet users to: (i) websites of companies that compete with Rosetta Stone; (ii) websites that sell Rosetta Stone products, but also sell a variety of products that compete with Rosetta Stone; (iii) websites that sell counterfeit Rosetta Stone products; and/or (iv) websites that are entirely unrelated to language education. Rosetta Stone has not sponsored these "Sponsored Links" or otherwise authorized Google to sell the right to use the Rosetta Stone Marks in commerce to draw web users to these websites. Nevertheless, these unauthorized "Sponsored Links" appear in close and confusing proximity to both the listings generated by Google's purportedly "organic search results" system and the "Sponsored Links" that Google forces Rosetta Stone itself to purchase to reduce the likelihood that web users will be diverted to other websites. Many of these unauthorized "Sponsored Links" use Rosetta Stone Marks in whole or in part within the title and text of the "Sponsored Links" themselves.

53. On information and belief, the use of the mark "Rosetta Stone," such as shown above, is also confusing to consumers because, in many instances, consumers will enter the exact web address of Rosetta Stone's website, "www.rosettastone.com," or some variant of Rosetta Stone's web address into Google's search engine expecting to receive the link for Rosetta

Stone's website.[8] Due to Google's sale of the Rosetta Stone Marks to third parties as keywords, such consumers could be redirected to competitors of Rosetta Stone even though they originally intended to go to www.rosettastone.com. Accordingly, Google aids third parties in "hijacking" consumers who use their search engines to navigate the World Wide Web. This interferes with Rosetta Stone's sales and business.

54. On information and belief, a significant portion of the "Sponsored Links" for which Google uses the Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers do not even provide consumers with the opportunity to purchase products or services offered by Rosetta Stone.

55. On information and belief, Google also posts "Sponsored Links" to websites that similarly do not offer consumers the opportunity to purchase products or services from Rosetta Stone but nevertheless use Rosetta Stone Marks or phrases confusingly similar thereto in the text or title of the "Sponsored Links."

56. On information and belief, Google allows the use of Rosetta Stone Marks and terms confusingly similar thereto as keywords in its search engine-based advertising program, although that program is flexible enough to prevent many, if not all, such uses.

57. Google actively participates in the creation of "Sponsored Links" for its customers, including the information provided within such "Sponsored Links." Google actively solicits and encourages advertisers to use trademarks, service marks, and terms confusingly similar thereto as keyword triggers. For example, when a would-be advertiser selects a keyword

---

[8] Rosetta Stone's main website address is www.rosettastone.com. Many other addresses, however, such as www.rosettastoneclassroom.com, are also owned and used by Rosetta Stone to direct web users to the main page of the rosettastone.com website.

trigger for its advertising program, it may take advantage of a "keyword tool" which will find "related keywords" to whatever word or term the advertiser enters. Among the terms listed in the "keyword tool" directory are Rosetta Stone Marks. Thus, Google suggests to would-be users to select Rosetta Stone Marks as keywords. Google also creates the intentionally confusing titles and headings for "Sponsored Links," as well as the intentionally confusing visual appearance and positioning on the results page of the "Sponsored Links." Moreover, the very use of the confusing term "Sponsored Link" instead of "Paid Advertisement" is a Google contribution.

58. On information and belief, Google's specific use of the Rosetta Stone Marks as keyword triggers in its advertising program allows Google and its advertisers to benefit financially from and trade off the goodwill and reputation of Rosetta Stone without incurring the substantial expense that Rosetta Stone has incurred in building up its popularity, name recognition, and brand loyalty. Through these practices, Google intentionally traffics in the infringement and dilution of the Rosetta Stone Marks, falsely represents or confusingly suggests to consumers a connection to Rosetta Stone that does not exist, and unfairly competes with Rosetta Stone. These practices cause consumer confusion, erode the distinctiveness of the Rosetta Stone Marks, and cause Rosetta Stone to lose, in part, control over the commercial use of the Rosetta Stone Marks by placing such control in the hands of Google and its advertisers.

59. On information and belief, Google's advertising programs also allow confusing uses of Rosetta Stone Marks in the text of the "Sponsored Link" advertisements that Google publishes on its search results page and in other Google advertising on the Internet, although Google has the technical capability to prevent many, if not all, such uses if Google wanted to do so.

60. On information and belief, Google's advertisers have used loopholes in Google's programming to create "Sponsored Links" and other advertisements that either use terms that are confusingly similar to the Rosetta Stone Marks or are formatted in ways that are likely to cause confusion with Rosetta Stone and/or with the Rosetta Stone Marks.

61. On information and belief, Google may also have other advertising programs, including but not limited to Google's "AdWords" program, which similarly make commercial use of Rosetta Stone Marks or terms confusingly similar thereto in order to trigger advertisements on third parties' websites throughout the Internet. On information and belief, in at least some of these instances, the title and/or text of these advertisements also make use of Rosetta Stone Marks or terms confusingly similar thereto.

62. In sum, Google uses in commerce the registered and common law trademarks of other companies, including Rosetta Stone, with full knowledge that consumers are likely to be confused and lured away from the websites that they intended to visit, and with the goal of financially benefiting Google to the detriment of Rosetta Stone and other trademark and service mark owners.

Consumer Confusion and Harm to Rosetta Stone

63. On information and belief, Google charges advertisers a fee every time a web user clicks on a keyword-triggered "Sponsored Link."

64. On information and belief, many web users who enter one of the Rosetta Stone Marks into Google's search engine and who then view a "Sponsored Link" containing a third-party advertisement will follow the "Sponsored Link" to a third-party website in the belief that the website is owned by or affiliated with Rosetta Stone.

65. Upon information and belief, many web users who are presented with such "Sponsored Links" to third-party advertiser websites are not aware that the third-party advertiser may have no affiliation with Rosetta Stone and/or may not be an authorized provider of Rosetta Stone products and services. Google's misappropriation of the Rosetta Stone Marks as keyword triggers and its use of terms confusingly similar to Rosetta Stone Marks in the "Sponsored Link" text are therefore likely to cause confusion in the marketplace for language-education products and related services. This confusion is particularly likely because the "Sponsored Links" often appear in the same context as, and often above or immediately below, "Sponsored Links" to genuine Rosetta Stone websites.

66. Even if web users realize that a given website is not affiliated with Rosetta Stone, once they reach it, the damage to Rosetta Stone has already been done. Many such consumers are likely either to stay at the third-party advertiser's website or to discontinue their search for Rosetta Stone's website. Web users may also associate the quality of the products and services offered on the third-party advertiser's website with those offered by Rosetta Stone, and if dissatisfied with such goods and services, may decide to avoid Rosetta Stone's products and services in the future.

67. Moreover, because of the dominant role of Google's search engine in consumers' Internet usage and habits, Google effectively forces Rosetta Stone to purchase the "rights" to have official Rosetta Stone advertisements appear when Internet users search the web for the Rosetta Stone Marks. In other words, Google has set up a system wherein Rosetta Stone and others are, *de facto*, forced to pay Google to reduce the likelihood that consumers will be confused by Google's own practices. This need to reduce the extent of consumer confusion caused by Google's policies has cost and, unless enjoined, will continue to cost Rosetta Stone

millions of dollars. Even when Rosetta Stone purchases from Google these "rights," Google is still able to misappropriate Rosetta Stone's rights by selling these same "rights" to third parties at the same time.

68. Although the above examples are illustrative of the problems created by Google, they by no means describe all the ways in which Google's uses of the Rosetta Stone Marks are likely to confuse consumers. Because of the fluid nature of the way Google's programming uses the Rosetta Stone Marks and displays advertising based on those marks, Google either is misleading or will mislead consumers in innumerable different ways. Accordingly, it is impossible for Rosetta Stone to cure this problem merely by pursuing remedies against Google's advertisers alone.

69. Among other things, the following facts and circumstances support the conclusion that Google's use in commerce of the Rosetta Stone Marks is likely to cause consumer confusion:

A. The Rosetta Stone Marks are exceptionally strong.

B. Google uses the actual Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers and in advertisement text.

C. Third-party advertisers on whose behalf Google uses the Rosetta Stone Marks or terms confusingly similar thereto generally sell counterfeit Rosetta Stone products and/or products and services similar to the language-education products and services provided by Rosetta Stone, and in many cases are in direct competition with Rosetta Stone.

D. Google and its third-party advertisers use similar facilities and the exact same marketing channels or parallel marketing channels as Rosetta Stone -- namely, the World Wide Web, and in particular, the context of Internet searching.

E. On information and belief, purchasers are likely to exercise a minimal degree of care in the context of Internet searching generally and in purchasing goods and services online in particular.

F. On information and belief, consumers have actually been confused as a result of Google's conduct.

G. Google began using the Rosetta Stone Marks or terms very similar to the marks after they were registered and after they became famous and distinctive. On information and belief, Google did so with full knowledge of Rosetta Stone's rights in the Rosetta Stone Marks. In fact, on information and belief, it is Google's specific intent to use the Rosetta Stone Marks to profit from consumer's association of the Rosetta Stone Marks with Rosetta Stone.

I.

FIRST CLAIM FOR RELIEF
TRADEMARK/SERVICE MARK INFRINGEMENT
UNDER THE LANHAM ACT

70. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

71. Rosetta Stone possesses valid, federally registered trademarks and service marks entitled to protection under the Lanham Act.

72. Google has used the Rosetta Stone Marks in commerce in a number of ways as part of its search engine-based, keyword-triggered advertising programs, including (but not

limited to) the following: (i) by allowing and/or encouraging third-party advertisers to bid on the Rosetta Stone Marks, or terms confusingly similar thereto, and paying Google to use such marks or terms to trigger the display of "Sponsored Link" advertisements that link to third-party advertisers' websites, which are displayed above or alongside purportedly "organic search results;" (ii) by causing such "Sponsored Link" advertisements to appear when web users have specifically attempted to find or access Rosetta Stone's website, with the express purpose of causing web users to visit websites other than those affiliated with Rosetta Stone; (iii) by including Rosetta Stone Marks in Google's proprietary directories of terms that trigger "Sponsored Link" advertisements; (iv) by causing "Sponsored Link" advertisements to appear in close proximity to Rosetta Stone Marks and links to legitimate Rosetta Stone-related websites; and (v) by causing Rosetta Stone Marks or terms confusingly similar to Rosetta Stone Marks to appear in the text or title of advertisements which Google calls "Sponsored Links." In short, Google has used the Rosetta Stone Marks in commerce in connection with the sale, offering for sale, distribution, or advertising of goods and services.

73. Google's unauthorized and intentional use of the Rosetta Stone Marks or terms confusingly similar thereto in connection with its search engine-based advertising programs infringes on Rosetta Stone's exclusive rights in its federally registered marks and is likely to cause confusion, mistake or deception among consumers as to the source of the products and services offered by Google and its advertisers. Such use is also likely to cause confusion among consumers as to whether Rosetta Stone is sponsoring, has authorized or is somehow affiliated with Google's sale of the Rosetta Stone Marks or terms confusingly similar thereto, or with the products or services offered through the "Sponsored Links" that Google intentionally posts

above or alongside purportedly objective "organic search results" from Internet searches for Rosetta Stone Marks.

74. Even after accessing the websites associated with "Sponsored Links," consumers are likely to be confused into believing that those websites and the information they contain are associated with, sponsored by, operated by, or otherwise formally affiliated with or supported by Rosetta Stone when that is not the case.

75. Google's unauthorized and intentional use of the registered Rosetta Stone Marks and terms confusingly similar thereto in connection with its search engine-based advertising programs constitutes trademark infringement in violation of Section 32(1) of the Lanham Act, 15 U.S.C. §§ 1114(1).

76. Google's infringement of the Rosetta Stone Marks is willful and reflects Google's intent to exploit the goodwill and strong brand recognition associated with the Rosetta Stone Marks.

77. Google's infringement has damaged Rosetta Stone in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

78. Google's infringement has caused and, unless restrained by this Court, will continue to cause Rosetta Stone irreparable injury.

79. Rosetta Stone has no adequate remedy at law for Google's infringement.

II.

SECOND CLAIM FOR RELIEF
CONTRIBUTORY TRADEMARK/SERVICE MARK INFRINGEMENT UNDER THE LANHAM ACT

80. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

81. With full knowledge of Rosetta Stone's rights in the Rosetta Stone Marks, Google has knowingly sold to third-party advertisers the "rights" to use the Rosetta Stone Marks or terms confusingly similar thereto as a part of Google's search engine-based advertising programs. In this context, the third-party advertisers' use of the Rosetta Stone Marks or terms confusingly similar thereto is likely to cause confusion among consumers, and constitutes infringement of Rosetta Stone's rights in the Rosetta Stone Marks.

82. In particular, the use of the Rosetta Stone Marks or terms confusingly similar thereto in Google's search engine in order to trigger the display of "Sponsored Links" that link to the websites of third-party advertisers above or alongside purportedly "organic search results" is likely to deceive or cause confusion among web users as to whether Rosetta Stone is the source of (or is sponsoring or affiliated with) the products and services offered on the third-party advertisers' websites.

83. Alternatively, the use of Rosetta Stone Marks or terms confusingly similar thereto within the title and text of "Sponsored Link" advertisements by third-party advertisers is likely to deceive or cause confusion among web users as to whether Rosetta Stone is the source of (or is sponsoring or affiliated with) the products and services offered on the third-party advertisers' websites.

84. Through its sale of the Rosetta Stone Marks and terms confusingly similar thereto to third-party advertisers, Google provides such third-party advertisers with aid and material contribution to the third-party advertisers' violations of the Lanham Act.

85. Google is therefore contributorily liable for the infringing use of the Rosetta Stone Marks by the third-party advertisers who use the Rosetta Stone Marks to trigger the display of "Sponsored Links."

86. Google's contributory infringement is willful and reflects Google's intent to exploit the good will and strong brand recognition associated with the Rosetta Stone Marks.

87. Rosetta Stone has been damaged by Google's contributory infringement in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

88. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's actions.

89. Rosetta Stone has no adequate remedy at law for the foregoing wrongful conduct.

III.

THIRD CLAIM FOR RELIEF
VICARIOUS TRADEMARK/SERVICE MARK INFRINGEMENT UNDER THE LANHAM ACT

90. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

91. Google has the right and ability to control the use of the Rosetta Stone Marks or terms confusingly similar to the Rosetta Stone Marks in its search engine-based advertising programs.

92. Third-party advertisers' use of the Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers in Google's search engine-based advertising program is likely to cause confusion among consumers, and constitutes infringement of Rosetta Stone's rights in the Rosetta Stone Marks.

93. Third-party advertisers' use of the Rosetta Stone Marks or terms confusingly similar thereto in the title or text of "Sponsored Link" advertisements is likely to cause confusion among consumers, and constitutes infringement of Rosetta Stone's rights in the Rosetta Stone Marks.

94. Google receives a direct financial benefit from the third-party advertisers' unauthorized use of the Rosetta Stone Marks or terms confusingly similar thereto.

95. Google is therefore vicariously liable for the infringing use of the Rosetta Stone Marks by third-party advertisers who use the Rosetta Stone Marks to trigger the display of "Sponsored Links."

96. Google's vicarious infringement is willful and reflects Google's intent to exploit the goodwill and strong brand recognition associated with the Rosetta Stone Marks.

97. Rosetta Stone has been damaged by Google's vicarious infringement in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

98. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's actions.

99. Rosetta Stone has no adequate remedy at law for the foregoing wrongful conduct.

IV.

FOURTH CLAIM FOR RELIEF
FALSE REPRESENTATION UNDER THE LANHAM ACT

100. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

101. Google's use of the Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers in its search engine-based advertising programs conveys the false or misleading commercial impression to the public that the third-party advertisers listed as "Sponsored Links" above or alongside purportedly "organic search results," or their products or services, are approved, endorsed or sponsored by Rosetta Stone, or are otherwise affiliated with or supported by Rosetta Stone.

102. Google's use of the Rosetta Stone Marks or terms confusingly similar thereto in the title or text of "Sponsored Link" advertisements conveys the false or misleading commercial impression to the public that the third-party advertisers listed as "Sponsored Links" are approved, endorsed or sponsored by Rosetta Stone, or are otherwise affiliated with or supported by Rosetta Stone.

103. These misleading uses of the Rosetta Stone Marks constitute a false designation of origin and/or a false or misleading description of fact and/or a false or misleading representation of fact, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

104. Google's false representations are willful and reflect Google's intent to exploit the goodwill and strong brand recognition associated with the Rosetta Stone Marks.

105. Google's false representations have damaged Rosetta Stone in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

106. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's actions.

107. Rosetta Stone has no adequate remedy at law for Google's false representations.

V.

FIFTH CLAIM FOR RELIEF
TRADEMARK/SERVICE MARK DILUTION
UNDER THE LANHAM ACT

108. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

109. The Rosetta Stone Marks are famous within the meaning of the Trademark Dilution Revision Act of 2006. In particular, the following factors support the conclusion that the Rosetta Stone Marks are famous:

A. Rosetta Stone has expended substantial amounts in advertising the Rosetta Stone Marks on a nationwide basis in a broad cross-section of prominent media for many years;

B. The Rosetta Stone Marks have received massive publicity from third parties and products sold under the Rosetta Stone Marks have won numerous awards from third parties;

C. Rosetta Stone has earned hundreds of millions of dollars in revenue on a nationwide basis in connection with the products and services that it has offered under the Rosetta Stone Marks;

D. The Rosetta Stone Marks have achieved a high level of actual recognition among the consuming public; and

E. Rosetta Stone has obtained federal trademark registration for its Rosetta Stone Marks.

110. Google's use of the Rosetta Stone Marks or terms confusingly similar thereto as keyword triggers in its search engine-based advertising programs has lessened and will continue to lessen the capacity of Rosetta Stone's famous and distinctive Rosetta Stone Marks to distinguish Rosetta Stone's products and services from those of others, and has diluted the distinctive quality of the famous and nationally recognized Rosetta Stone Marks.

111. Google's use of the Rosetta Stone Marks or terms confusingly similar thereto in the title of text of "Sponsored Link" advertisements has lessened and will continue to lessen the capacity of Rosetta Stone's famous and distinctive Rosetta Stone Marks to distinguish Rosetta Stone's products and services from those of others, and has diluted the distinctive quality of Rosetta Stone's famous and nationally recognized Rosetta Stone Marks.

112. Google's conduct as alleged above is likely to cause blurring of the Rosetta Stone Marks and impair the distinctiveness of the Rosetta Stone Marks. Consumers are likely to associate Google's uses of the Rosetta Stone Marks or terms confusingly similar thereto with the Rosetta Stone Marks themselves because of the similarity between Google's uses of the Rosetta Stone Marks or terms confusingly similar thereto and the Rosetta Stone Marks themselves. In particular, on information and belief, the following factors make dilution by blurring likely:

A. Google is making use of the Rosetta Stone Marks themselves or words or phrases confusingly similar to the Rosetta Stone Marks;

B. The Rosetta Stone Marks have acquired tremendous distinctiveness through Rosetta Stone's promotion and use of the Rosetta Stone Marks in commerce since 1993;

C. The Rosetta Stone Marks have achieved high levels of recognition among the consuming public;

D. Rosetta Stone's commercial use of the Rosetta Stone Marks is substantially exclusive to Rosetta Stone and its agents and licensees;

E. On information and belief, Google's advertisers intend to create an association between Google's uses of the Rosetta Stone Marks or terms confusingly similar thereto and the Rosetta Stone Marks themselves; and

F. On information and belief, many consumers actually associate Google's uses of the Rosetta Stone Marks or terms confusingly similar thereto with the Rosetta Stone Marks.

113. Google's conduct as alleged above is also likely to cause tarnishment among the Rosetta Stone Marks that harms the reputation of the Rosetta Stone Marks because of the similarity between Google's uses of the Rosetta Stone Marks or terms confusingly similar thereto and the Rosetta Stone Marks themselves. In particular, many of the "Sponsored Links" lead consumers to websites that offer lower quality services than Rosetta Stone offers or post materials that are misleading or distasteful or offer counterfeit Rosetta Stone products.

114. On information and belief, Google has derived and continues to derive substantial revenue and profits from the past and ongoing dilution of the Rosetta Stone Marks as a result of its unauthorized uses of the Rosetta Stone Marks and terms confusingly similar thereto.

115. Google's use of the Rosetta Stone Marks constitutes dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

116. Google's dilution of the Rosetta Stone Marks has caused Rosetta Stone damage in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

117. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's actions.

118. Rosetta Stone has no adequate remedy at law for Google's dilution of the Rosetta Stone Marks.

VI.

SIXTH CLAIM FOR RELIEF FOR TRADEMARK INFRINGEMENT UNDER VIRGINIA LAW

119. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

120. Rosetta Stone has registered the trademark ROSETTA STONE in the Commonwealth of Virginia.

121. Google's acts, as described above, constitute trademark infringement of the ROSETTA STONE trademark under Virginia law, resulting in irreparable injury to Rosetta Stone. Google is also liable for contributory trademark infringement and vicarious trademark infringement of the ROSETTA STONE trademark under Virginia law.

122. Google's infringement has damaged Rosetta Stone in an amount to be determined at trial. For example and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

123. Google's infringement has caused and, unless restrained by this Court, will continue to cause Rosetta Stone irreparable injury.

124. Rosetta Stone has no adequate remedy at law for Google's infringement of its common law trademark rights.

VII.

SEVENTH CLAIM FOR RELIEF
UNFAIR COMPETITION UNDER VIRGINIA LAW

125. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

126. As discussed above, the Rosetta Stone Marks have acquired a secondary meaning associated with Rosetta Stone. And, Google has used the Rosetta Stone Marks unfairly to the detriment of Rosetta Stone. Indeed, Google's use of the Rosetta Stone Marks is likely to confuse prospective buyers of Rosetta Stone goods and services even if they exercise ordinary caution in their purchasing decisions. Thus, Google's acts as described above violate Virginia's unfair competition law.

127. As a result of Google's conduct, Rosetta Stone has suffered and will continue to suffer damage, including damage to its reputation because of consumer confusion as to the origin or sponsorship of the products and services advertised through Google's websites. For example, and without limitation, Google has been unjustly enriched through its unlawful and unauthorized sales of the Rosetta Stone Marks.

128. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's actions.

129. Rosetta Stone has no adequate remedy at law for Google's unfair competition.

VIII.

EIGHTH CLAIM FOR RELIEF
VIOLATION OF VA CODE § 18.2-499

130. Plaintiff repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

131. Google's acts as described above violate VA. Code § 18.2-499. Google has entered into agreements with and mutually undertaken with third parties for the purpose of willfully and maliciously injuring Rosetta Stone in its trade and/or business. Google and/or such third parties entered into such conspiracies intentionally, purposefully, and without lawful justification.

132. Specifically, and by way of example and not limitation, Google entered into agreements with Rocket Languages Ltd., a direct competitor of Rosetta Stone, and "affiliates" of Rocket Languages Ltd. (collectively "Rocket Languages") pursuant to which Google would display "Sponsored Links" for Rocket Languages in response to searches for the Rosetta Stone Marks and/or words, phrases, or terms confusingly similar to those marks. They did so knowing that the Rosetta Stone Marks were registered trademarks and that the use of these marks as keywords to trigger "Sponsored Links" would divert consumers from Rosetta Stone's website to Rocket Languages' websites with the intent to harm Rosetta Stone in its business. And, many consumers have been diverted in this manner. Google and Rocket Languages entered into these agreements knowing that their acts were unlawful and with the intent to injure maliciously Rosetta Stone.

133. Google's violation of Va. Code §18.2-499 has caused Rosetta Stone damage in an amount to be determined at trial.

134. Rosetta Stone has been, and absent injunctive relief will continue to be, irreparably harmed by Google's violations of Va. Code § 18.2-499.

135. Rosetta Stone has no adequate remedy at law for Google's violation of Va. Code § 18.2-499.

WHEREFORE, Rosetta Stone prays for judgment in its favor and against Google as follows:

A. Preliminarily and permanently enjoining Google and its officers, directors, partners, agents, subcontractors, servants, employees, representatives, franchisees, licensees, subsidiaries, parents, and related companies or entities, and all others acting in concert or participation with it from:

- directly or indirectly selling or offering for sale the Rosetta Stone Marks or other terms confusingly similar to the Rosetta Stone Marks for use in its search engine-based advertising programs to anyone other than Rosetta Stone or its authorized licensees;
- continuing to post advertisements for anyone other than Rosetta Stone and its authorized licensees because Internet users have run a search on Google's search engine using search terms that are identical or confusingly similar to the Rosetta Stone Marks;
- continuing to post titles or text of paid or keyword-triggered search engine results that falsely communicate to consumers that such links are endorsed, sponsored, or supported by Rosetta Stone or formally affiliated with Rosetta Stone;
- infringing, or causing any other entity to infringe the Rosetta Stone Marks;
- unfairly competing with Rosetta Stone in any manner whatsoever; and
- making any use of the Rosetta Stone Marks and/or terms confusingly similar thereto unless specifically authorized by Rosetta Stone.

B. Directing an accounting to determine all gains, profits, savings and advantages obtained by Google as a result of its wrongful actions;

C. Awarding restitution to Rosetta Stone of all gains, profits, savings and advantages obtained by Google as a result of its wrongful actions;

D. Awarding Rosetta Stone all damages caused by Google's wrongful actions;

E. Awarding Rosetta Stone treble the amount of its damages, together with the costs of this suit, including reasonable attorneys' fees and expenses and prejudgment interest, pursuant to 15 U.S.C. § 1117 and all other applicable provisions and principles of federal and Virginia law;

F. Awarding Rosetta Stone an amount sufficient to conduct a corrective advertising campaign to dispel the effects of Google's wrongful conduct and confusing and misleading advertising;

G. Directing Google to post on its website corrective advertising in a manner and form to be established by the Court;

H. Directing Google to file with this Court and serve on Rosetta Stone within thirty (30) days after the service of the injunction, a report in writing, under oath, that describes in detail the manner and form in which Google has complied with the orders of this Court;

I. Awarding Rosetta Stone punitive and/or exemplary damages in an amount sufficient to deter future similar conduct by Google and others; and

J. Granting Rosetta Stone such other and further relief as the Court may deem just.

DEMAND FOR JURY TRIAL

Plaintiff demands a trial by jury on all causes of action triable by jury.

Respectfully submitted,

Dated: July 10, 2009

Terence P. Ross
VA State Bar # 026408

Of Counsel:

Howard S. Hogan, Esq.
Kyle Amborn, Esq.
GIBSON, DUNN & CRUTCHER, LLP
1050 Connecticut Avenue, NW
Suite 300
Washington, DC 20036
Phone: 202-955-8500
Fax: 202-467-0539

GIBSON, DUNN & CRUTCHER, LLP
1050 Connecticut Avenue, NW
Suite 300
Washington, DC 20036
Phone: 202-955-8500
Fax: 202-467-0539

100580245_1.DOC

Reference Guide on Survey Research

SHARI SEIDMAN DIAMOND

Shari Seidman Diamond, J.D., Ph.D., is Professor of Law and Psychology, Northwestern University, Evanston, Illinois, and Senior Research Fellow, American Bar Foundation, Chicago, Illinois.

CONTENTS

I. Introduction

Surveys are used to describe or enumerate objects or the beliefs, attitudes, or behavior of persons or other social units.[1] Surveys typically are offered in legal proceedings to establish or refute claims about the characteristics of those objects, individuals, or social units. Although surveys may count or measure every member of the relevant population (e.g., all plaintiffs eligible to join in a suit, all employees currently working for a corporation, all trees in a forest), sample surveys count or measure only a portion of the objects, individuals, or social units that the survey is intended to describe.[2]

Some statistical and sampling experts apply the phrase "sample survey" only to a survey in which probability sampling techniques are used to select the sample.[3] Although probability sampling offers important advantages over nonprobability sampling,[4] experts in some fields (e.g., marketing) regularly rely on various forms of nonprobability sampling when conducting surveys. Consistent with Federal Rule of Evidence 703, courts generally have accepted such evidence.[5] Thus, in this reference guide, both the probability sample and the nonprobability sample are discussed. The strengths of probability sampling and the weaknesses of various types of nonprobability sampling are described so that the trier of fact can consider these features in deciding what weight to give to a particular sample survey.

As a method of data collection, surveys have several crucial potential advantages over less systematic approaches.[6] When properly designed, executed, and

1. Social scientists describe surveys as "conducted for the purpose of collecting data from individuals about themselves, about their households, or about other larger social units." Peter H. Rossi et al., *Sample Surveys: History, Current Practice, and Future Prospects*, *in* Handbook of Survey Research 1, 2 (Peter H. Rossi et al. eds., 1983). Used in its broader sense, however, the term *survey* applies to any description or enumeration, whether or not a person is the source of this information. Thus, a report on the number of trees destroyed in a forest fire might require a survey of the trees and stumps in the damaged area.

2. In *J.H. Miles & Co. v. Brown*, 910 F. Supp. 1138 (E.D. Va. 1995), clam processors and fishing vessel owners sued the Secretary of Commerce for failing to use the unexpectedly high results from 1994 survey data on the size of the clam population to determine clam fishing quotas for 1995. The estimate of clam abundance is obtained from surveys of the amount of fishing time the research survey vessels require to collect a specified yield of clams in major fishing areas over a period of several weeks. *Id.* at 1144–45.

3. *E.g.*, Leslie Kish, Survey Sampling 26 (1965).

4. *See infra* § III.C.

5. Fed. R. Evid. 703 recognizes facts or data "of a type reasonably relied upon by experts in the particular field . . . ."

6. This does not mean that surveys can be relied on to address all types of questions. For example, some respondents may not be able to predict accurately whether they would volunteer for military service if Washington, D.C., were to be bombed. Their inaccuracy may arise not because they are unwilling to answer the question or to say they don't know, but because they believe they can predict accurately, and they are simply wrong. Thus, the availability of a "don't know" option cannot cure the inaccuracy. Although such a survey is suitable for assessing their predictions, it may not provide a very accurate estimate of what their actual responses would be.

described, surveys (1) economically present the characteristics of a large group of objects or respondents and (2) permit an assessment of the extent to which the measured objects or respondents are likely to adequately represent a relevant group of objects, individuals, or social units.[7] All questions asked of respondents and all other measuring devices used can be examined by the court and the opposing party for objectivity, clarity, and relevance, and all answers or other measures obtained can be analyzed for completeness and consistency. To make it possible for the court and the opposing party to closely scrutinize the survey so that its relevance, objectivity, and representativeness can be evaluated, the party proposing to offer the survey as evidence should describe in detail the design and execution of the survey.

The questions listed in this reference guide are intended to assist judges in identifying, narrowing, and addressing issues bearing on the adequacy of surveys either offered as evidence or proposed as a method for developing information.[8] These questions can be (1) raised from the bench during a pretrial proceeding to determine the admissibility of the survey evidence; (2) presented to the contending experts before trial for their joint identification of disputed and undisputed issues; (3) presented to counsel with the expectation that the issues will be addressed during the examination of the experts at trial; or (4) raised in bench trials when a motion for a preliminary injunction is made to help the judge evaluate what weight, if any, the survey should be given.[9] These questions are intended to improve the utility of cross-examination by counsel, where appropriate, not to replace it.

All sample surveys, whether they measure objects, individuals, or other social units, should address the issues concerning purpose and design (section II), population definition and sampling (section III), accuracy of data entry (section VI), and disclosure and reporting (section VII). Questionnaire and interview surveys raise methodological issues involving survey questions and structure (section IV) and confidentiality (section VII.C), and interview surveys introduce additional issues (e.g., interviewer training and qualifications) (section V). The sections of this reference guide are labeled to direct the reader to those topics that are relevant to the type of survey being considered. The scope of this reference guide is necessarily limited, and additional issues might arise in particular cases.

7. The ability to quantitatively assess the limits of the likely margin of error is unique to probability sample surveys.

8. *See infra* text accompanying note 27.

9. Lanham Act cases involving trademark infringement or deceptive advertising frequently require expedited hearings that request injunctive relief, so judges may need to be more familiar with survey methodology when considering the weight to accord a survey in these cases than when presiding over cases being submitted to a jury. Even in a case being decided by a jury, however, the court must be prepared to evaluate the methodology of the survey evidence in order to rule on admissibility. *See* Daubert v. Merrell Dow Pharms., Inc., 509 U.S. 579, 589 (1993).

A. Use of Surveys in Court

Forty years ago the question whether surveys constituted acceptable evidence still was unsettled.[10] Early doubts about the admissibility of surveys centered on their use of sampling techniques[11] and their status as hearsay evidence.[12] Federal Rule of Evidence 703 settled both matters for surveys by redirecting attention to the "validity of the techniques employed."[13] The inquiry under Rule 703 focuses on whether facts or data are "of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject."[14] For a survey, the question becomes, "Was the poll or survey conducted in accordance with generally accepted survey principles, and were the results used in a

10. Hans Zeisel, *The Uniqueness of Survey Evidence*, 45 Cornell L.Q. 322, 345 (1960).

11. In an early use of sampling, Sears, Roebuck & Co. claimed a tax refund based on sales made to individuals living outside city limits. Sears randomly sampled 33 of the 826 working days in the relevant working period, computed the proportion of sales to out-of-city individuals during those days, and projected the sample result to the entire period. The court refused to accept the estimate based on the sample. When a complete audit was made, the result was almost identical to that obtained from the sample. *Sears, Roebuck & Co. v. City of Inglewood*, tried in Los Angeles Superior Court in 1955, is described in R. Clay Sprowls, *The Admissibility of Sample Data into a Court of Law: A Case History*, 4 UCLA L. Rev. 222, 226–29 (1956–1957).

12. Judge Wilfred Feinberg's thoughtful analysis in *Zippo Manufacturing Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 682–83 (S.D.N.Y. 1963), provides two alternative grounds for admitting opinion surveys: (1) surveys are not hearsay because they are not offered in evidence to prove the truth of the matter asserted; and (2) even if they are hearsay, they fall under one of the exceptions as a "present sense impression." In *Schering Corp. v. Pfizer Inc.*, 189 F.3d 218 (2d Cir. 1999), the Second Circuit distinguished between perception surveys designed to reflect the present sense impressions of respondents and "memory" surveys designed to collect information about a past occurrence based on the recollections of the survey respondents. The court in *Schering* suggested that if a survey is offered to prove the existence of a specific idea in the public mind, then the survey does constitute hearsay evidence. As the court observed, Federal Rule of Evidence 803(3), creating "an exception to the hearsay rule for such statements [i.e., state of mind expressions] rather than excluding the statements from the definition of hearsay, makes sense only in this light." *Id.* at 230 n.3.

Two additional exceptions to the hearsay exclusion can be applied to surveys. First, surveys may constitute a hearsay exception if the survey data were collected in the normal course of a regularly conducted business activity, unless "the source of information or the method or circumstances of preparation indicate lack of trustworthiness." Fed. R. Evid. 803(6); *see also* Ortho Pharm. Corp. v. Cosprophar, Inc., 828 F. Supp. 1114, 1119–20 (S.D.N.Y. 1993) (marketing surveys prepared in the course of business were properly excluded due to lack of foundation from a person who saw the original data or knew what steps were taken in preparing the report), *aff'd*, 32 F.3d 690 (2d Cir. 1994). In addition, if a survey shows guarantees of trustworthiness equivalent to those in other hearsay exceptions, it can be admitted if the court determines that the statement is offered as evidence of a material fact, it is more probative on the point for which it is offered than any other evidence which the proponent can procure through reasonable efforts, and admissibility serves the interests of justice. Fed. R. Evid. 807; *e.g.*, Keith v. Volpe, 618 F. Supp. 1132 (C.D. Cal. 1985); *Schering*, 189 F.3d at 232. Admissibility as an exception to the hearsay exclusion thus depends on the trustworthiness of the survey.

13. Fed. R. Evid. 703 advisory committee's note.

14. Fed. R. Evid. 703.

statistically correct way?"[15] This focus on the adequacy of the methodology used in conducting and analyzing results from a survey is also consistent with the Supreme Court's discussion of admissible scientific evidence in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*[16]

Because the survey method provides an economical and systematic way to gather information about a large number of individuals or social units, surveys are used widely in business, government, and, increasingly, administrative settings and judicial proceedings. Both federal and state courts have accepted survey evidence on a variety of issues. In a case involving allegations of discrimination in jury panel composition, the defense team surveyed prospective jurors to obtain age, race, education, ethnicity, and income distribution.[17] Surveys of employees or prospective employees are used to support or refute claims of employment discrimination.[18] In ruling on the admissibility of scientific claims, courts have examined surveys of scientific experts to assess the extent to which the theory or technique has received widespread acceptance.[19] Some courts have admitted surveys in obscenity cases to provide evidence about community standards.[20] Requests for a change of venue on grounds of jury pool bias often are backed by evidence from a survey of jury-eligible respondents in the area of the original venue.[21] The plaintiff in an antitrust suit conducted a survey to assess what characteristics, including price, affected consumers' preferences. The sur-

15. Manual for Complex Litigation § 2.712 (1982). Survey research also is addressed in the Manual for Complex Litigation, Second § 21.484 (1985) [hereinafter MCL 2d] and the Manual for Complex Litigation, Third § 21.493 (1995) [hereinafter MCL 3d]. Note, however, that experts who collect survey data, along with the professions that rely on those surveys, may differ in some of their methodological standards and principles. An assessment of the precision of sample estimates and an evaluation of the sources and magnitude of likely bias are required to distinguish methods that are acceptable from methods that are not.

16. 509 U.S. 579 (1993). *See also* General Elec. Co. v. Joiner, 522 U.S. 136, 147 (1997).

17. People v. Harris, 679 P.2d 433 (Cal.), *cert. denied*, 469 U.S. 965 (1984).

18. EEOC v. Sears, Roebuck & Co., 628 F. Supp. 1264, 1308 (N.D. Ill. 1986), *aff'd*, 839 F.2d 302 (7th Cir. 1988); Stender v. Lucky Stores, Inc., 803 F. Supp. 259, 326 (N.D. Cal. 1992); Richardson v. Quik Trip Corp., 591 F. Supp. 1151, 1153 (S.D. Iowa 1984).

19. United States v. Scheffer, 523 U.S. 303, 309 (1998); Meyers v. Arcudi, 947 F. Supp. 581, 588 (D. Conn. 1996); United States v. Varoudakis, No. 97-10158, 1998 WL 151238 (D. Mass. Mar. 27, 1998); United States v. Bishop, 64 F. Supp. 2d 1149 (D. Utah 1999); United States v. Orians, 9 F. Supp. 2d 1168, 1174 (D. Ariz. 1998) (all cases in which courts determined, based on the inconsistent reactions revealed in several surveys, that the polygraph test has failed to achieve general acceptance in the scientific community).

20. *E.g.*, People v. Page Books, Inc., 601 N.E.2d 273, 279–80 (Ill. App. Ct. 1992); People v. Nelson, 410 N.E.2d 476, 477–79 (Ill. App. Ct. 1980); State v. Williams, 598 N.E.2d 1250, 1256–58 (Ohio Ct. App. 1991).

21. *E.g.*, United States v. Eagle, 586 F.2d 1193, 1195 (8th Cir. 1978); United States v. Tokars, 839 F. Supp. 1578, 1583 (D. Ga. 1993), *aff'd*, 95 F.3d 1520 (11th Cir. 1996); Powell v. Superior Court, 283 Cal. Rptr. 777, 783 (Ct. App. 1991).

vey was offered as one way to estimate damages.[22] A routine use of surveys in federal courts occurs in Lanham Act[23] cases, where the plaintiff alleges trademark infringement[24] or claims that false advertising[25] has confused or deceived consumers. The pivotal legal question in such cases virtually demands survey research because it centers on consumer perception and memory (i.e., is the consumer likely to be confused about the source of a product, or does the advertisement imply an inaccurate message?).[26] In addition, survey methodology has been used creatively to assist federal courts in managing mass torts litigation. Faced with the prospect of conducting discovery concerning 10,000 plaintiffs, the plaintiffs and defendants in *Wilhoite v. Olin Corp.*[27] jointly drafted a discovery survey that was administered in person by neutral third parties, thus replacing interrogatories and depositions. It resulted in substantial savings in both time and cost.

B. A Comparison of Survey Evidence and Individual Testimony

To illustrate the value of a survey, it is useful to compare the information that can be obtained from a competently done survey with the information obtained

22. Dolphin Tours, Inc. v. Pacifico Creative Servs., Inc., 773 F.2d 1506, 1508 (9th Cir. 1985). *See also* SMS Sys. Maintenance Servs., Inc. v. Digital Equip. Corp., 188 F.3d 11 (1st Cir. 1999); Benjamin F. King, *Statistics in Antitrust Litigation*, *in* Statistics and the Law 49 (Morris H. DeGroot et al. eds., 1986). Surveys also are used in litigation to help define relevant markets. In *United States v. E.I. DuPont de Nemours & Co.*, 118 F. Supp. 41, 60 (D. Del. 1953), *aff'd*, 351 U.S. 377 (1956), a survey was used to develop the "market setting" for the sale of cellophane. In *Mukand, Ltd. v. United States*, 937 F. Supp. 910 (Ct. Int'l Trade 1996), a survey of purchasers of stainless steel wire rods was conducted to support a determination of competition and fungibility between domestic and Indian wire rod.

23. Lanham Act § 43(a), 15 U.S.C. § 1125(a) (1946) (amended 1992).

24. *E.g.*, Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976); Qualitex Co. v. Jacobson Prods. Co., No. CIV-90-1183HLH, 1991 U.S. Dist. LEXIS 21172 (C.D. Cal. Sept. 3, 1991), *aff'd in part & rev'd on other grounds*, 13 F.3d 1297 (9th. Cir. 1994), *rev'd on other grounds*, 514 U.S. 159 (1995). According to Neal Miller, *Facts, Expert Facts, and Statistics: Descriptive and Experimental Research Methods in Litigation*, 40 Rutgers L. Rev. 101, 137 (1987), trademark law has relied on the institutionalized use of statistical evidence more than any other area of the law.

25. *E.g.*, Southland Sod Farms v. Stover Seed Co., 108 F.3d 1134, 1142–43 (9th Cir. 1997); American Home Prods. Corp. v. Johnson & Johnson, 577 F.2d 160 (2d Cir. 1978).

26. Courts have observed that "the court's reaction is at best not determinative and at worst irrelevant. The question in such cases is, what does the person to whom the advertisement is addressed find to be the message?" American Brands, Inc. v. R.J. Reynolds Tobacco Co., 413 F. Supp. 1352, 1357 (S.D.N.Y. 1976). The wide use of surveys in recent years was foreshadowed in *Triangle Publications, Inc. v. Rohrlich*, 167 F.2d 969, 974 (2d Cir. 1948) (Frank, J., dissenting). Called on to determine whether a manufacturer of girdles labeled "Miss Seventeen" infringed the trademark of the magazine *Seventeen*, Judge Frank suggested that, in the absence of a test of the reactions of "numerous girls and women," the trial court judge's finding as to what was likely to confuse was "nothing but a surmise, a conjecture, a guess," noting that "neither the trial judge nor any member of this court is (or resembles) a teen-age girl or the mother or sister of such a girl." *Id.* at 976–77.

27. No. CV-83-C-5021-NE (N.D. Ala. filed Jan. 11, 1983). The case ultimately settled before trial. *See* Francis E. McGovern & E. Allan Lind, *The Discovery Survey*, Law & Contemp. Probs., Autumn 1988, at 41.

by other means. A survey is presented by a survey expert who testifies about the responses of a substantial number of individuals who have been selected according to an explicit sampling plan and asked the same set of questions by interviewers who were not told who sponsored the survey or what answers were predicted or preferred. Although parties presumably are not obliged to present a survey conducted in anticipation of litigation by a nontestifying expert if it produced unfavorable results,[28] the court can and should scrutinize the method of respondent selection for any survey that is presented.

A party using a nonsurvey method generally identifies several witnesses who testify about their own characteristics, experiences, or impressions. While the party has no obligation to select these witnesses in any particular way or to report on how they were chosen, the party is not likely to select witnesses whose attributes conflict with the party's interests. The witnesses who testify are aware of the parties involved in the case and have discussed the case before testifying.

Although surveys are not the only means of demonstrating particular facts, presenting the results of a well-done survey through the testimony of an expert is an efficient way to inform the trier of fact about a large and representative group of potential witnesses. In some cases, courts have described surveys as the most direct form of evidence that can be offered.[29] Indeed, several courts have drawn negative inferences from the absence of a survey, taking the position that failure to undertake a survey may strongly suggest that a properly done survey would not support the plaintiff's position.[30]

II. Purpose and Design of the Survey

A. Was the Survey Designed to Address Relevant Questions?

The report describing the results of a survey should include a statement describing the purpose or purposes of the survey. One indication that a survey offers probative evidence is that it was designed to collect information relevant to the legal controversy (e.g., to estimate damages in an antitrust suit or to assess con-

28. Loctite Corp. v. National Starch & Chem. Corp., 516 F. Supp. 190, 205 (S.D.N.Y. 1981) (distinguishing between surveys conducted in anticipation of litigation and surveys conducted for nonlitigation purposes which cannot be reproduced because of the passage of time, concluding that parties should not be compelled to introduce the former at trial, but may be required to provide the latter).

29. *E.g.*, Charles Jacquin et Cie, Inc. v. Destileria Serralles, Inc., 921 F.2d 467, 475 (3d Cir. 1990). *See also* Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 522 (10th Cir. 1987).

30. E.S. Originals, Inc. v. Stride Rite Corp., 656 F. Supp. 484, 490 (S.D.N.Y. 1987); *see also* Ortho Pharm. Corp. v. Cosprophar, Inc., 32 F.3d 690, 695 (2d Cir. 1994); Henri's Food Prods. Co. v. Kraft, Inc., 717 F.2d 352, 357 (7th Cir. 1983); Information Clearing House, Inc. v. Find Magazine, 492 F. Supp. 147, 160 (S.D.N.Y. 1980).

sumer confusion in a trademark case). Surveys not conducted specifically in preparation for, or in response to, litigation may provide important information,[31] but they frequently ask irrelevant questions[32] or select inappropriate samples of respondents for study.[33] Nonetheless, surveys do not always achieve their stated goals. Thus, the content and execution of a survey must be scrutinized even if the survey was designed to provide relevant data on the issue before the court. Moreover, if a survey was not designed for purposes of litigation, one source of bias is less likely: The party presenting the survey is less likely to have designed and constructed the survey to prove its side of the issue in controversy.

B. *Was Participation in the Design, Administration, and Interpretation of the Survey Appropriately Controlled to Ensure the Objectivity of the Survey?*

An early handbook for judges recommended that survey interviews be "conducted independently of the attorneys in the case."[34] Some courts have interpreted this to mean that any evidence of attorney participation is objectionable.[35] A better interpretation is that the attorney should have no part in carrying out the survey.[36] However, some attorney involvement in the survey design is

31. *See, e.g.,* Wright v. Jeep Corp., 547 F. Supp. 871, 874 (E.D. Mich. 1982). Indeed, as courts increasingly have been faced with scientific issues, parties have requested in a number of recent cases that the courts compel production of research data and testimony by unretained experts. The circumstances under which an unretained expert can be compelled to testify or to disclose research data and opinions, as well as the extent of disclosure that can be required when the research conducted by the expert has a bearing on the issues in the case, are the subject of considerable current debate. *See, e.g.,* Richard L. Marcus, *Discovery Along the Litigation/Science Interface,* 57 Brook. L. Rev. 381, 393–428 (1991); Joe S. Cecil, *Judicially Compelled Disclosure of Research Data,* 1 Cts. Health Sci. & L. 434 (1991); *see also* Symposium, *Court-Ordered Disclosure of Academic Research: A Clash of Values of Science and Law,* Law & Contemp. Probs., Summer 1996, at 1.

32. Loctite Corp. v. National Starch & Chem. Corp., 516 F. Supp. 190, 206 (S.D.N.Y. 1981) (marketing surveys conducted before litigation were designed to test for brand awareness, whereas the "single issue at hand . . . [was] whether consumers understood the term 'Super Glue' to designate glue from a single source").

33. In *Craig v. Boren,* 429 U.S. 190 (1976), the state unsuccessfully attempted to use its annual roadside survey of the blood alcohol level, drinking habits, and preferences of drivers to justify prohibiting the sale of 3.2% beer to males under the age of 21 and to females under the age of 18. The data were biased because it was likely that the male would be driving if both the male and female occupants of the car had been drinking. As pointed out in 2 Joseph L. Gastwirth, Statistical Reasoning in Law and Public Policy: Tort Law, Evidence, and Health 527 (1988), the roadside survey would have provided more relevant data if all occupants of the cars had been included in the survey (and if the type and amount of alcohol most recently consumed had been requested so that the consumption of 3.2% beer could have been isolated).

34. Judicial Conference of the U.S., Handbook of Recommended Procedures for the Trial of Protracted Cases 75 (1960).

35. *E.g.*, Boehringer Ingelheim G.m.b.H. v. Pharmadyne Lab., 532 F. Supp. 1040, 1058 (D.N.J. 1980).

36. Upjohn Co. v. American Home Prods. Corp., No. 1-95-CV-237, 1996 U.S. Dist. LEXIS 8049, at *42 (W.D. Mich. Apr. 5, 1996) (objection that "counsel reviewed the design of the survey

necessary to ensure that relevant questions are directed to a relevant population.[37] The trier of fact evaluates the objectivity and relevance of the questions on the survey and the appropriateness of the definition of the population used to guide sample selection. These aspects of the survey are visible to the trier of fact and can be judged on their quality, irrespective of who suggested them. In contrast, the interviews themselves are not directly visible, and any potential bias is minimized by having interviewers and respondents blind to the purpose and sponsorship of the survey and by excluding attorneys from any part in conducting interviews and tabulating results.

C. Are the Experts Who Designed, Conducted, or Analyzed the Survey Appropriately Skilled and Experienced?

Experts prepared to design, conduct, and analyze a survey generally should have graduate training in psychology (especially social, cognitive, or consumer psychology), sociology, marketing, communication sciences, statistics, or a related discipline; that training should include courses in survey research methods, sampling, measurement, interviewing, and statistics. In some cases, professional experience in conducting and publishing survey research may provide the requisite background. In all cases, the expert must demonstrate an understanding of survey methodology, including sampling,[38] instrument design (questionnaire and interview construction), and statistical analysis.[39] Publication in peer-reviewed journals, authored books, membership in professional organizations, faculty appointments, consulting experience, research grants, and membership on scientific advisory panels for government agencies or private foundations are indications of a professional's area and level of expertise. In addition, if the survey involves highly technical subject matter (e.g., the particular preferences of electrical engineers for various pieces of electrical equipment and the bases for those preferences) or involves a special population (e.g., developmentally disabled adults with limited cognitive skills), the survey expert also should be able to demonstrate sufficient familiarity with the topic or population (or assistance from an individual on the research team with suitable expertise) to design a survey instrument that will communicate clearly with relevant respondents.

carries little force with this Court because [opposing party] has not identified any flaw in the survey that might be attributed to counsel's assistance").

37. 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:166 (4th ed. 1996).

38. The one exception is that sampling expertise is unnecessary if the survey is administered to all members of the relevant population. *See, e.g.*, McGovern & Lind, *supra* note 27.

39. If survey expertise is being provided by several experts, a single expert may have general familiarity but not special expertise in all these areas.

D. Are the Experts Who Will Testify About Surveys Conducted by Others Appropriately Skilled and Experienced?

Parties often call on an expert to testify about a survey conducted by someone else. The secondary expert's role is to offer support for a survey commissioned by the party who calls the expert, to critique a survey presented by the opposing party, or to introduce findings or conclusions from a survey not conducted in preparation for litigation or by any of the parties to the litigation. The trial court should take into account the exact issue that the expert seeks to testify about and the nature of the expert's field of expertise.[40] The secondary expert who gives an opinion about the adequacy and interpretation of a survey not only should have general skills and experience with surveys and be familiar with all of the issues addressed in this reference guide, but also should demonstrate familiarity with the following properties of the survey being discussed:

1. the purpose of the survey;
2. the survey methodology, including
   a. the target population,
   b. the sampling design used in conducting the survey,
   c. the survey instrument (questionnaire or interview schedule), and
   d. (for interview surveys) interviewer training and instruction;
3. the results, including rates and patterns of missing data; and
4. the statistical analyses used to interpret the results.

III. Population Definition and Sampling

A. Was an Appropriate Universe or Population Identified?

One of the first steps in designing a survey or in deciding whether an existing survey is relevant is to identify the target population (or universe).[41] The target population consists of all elements (i.e., objects, individuals, or other social units) whose characteristics or perceptions the survey is intended to represent. Thus, in trademark litigation, the relevant population in some disputes may include all prospective and actual purchasers of the plaintiff's goods or services and all prospective and actual purchasers of the defendant's goods or services. Similarly, the population for a discovery survey may include all potential plaintiffs or all em-

40. Margaret A. Berger, The Supreme Court's Triology on the Admissibility of Expert Testimony § IV.C, in this manual.

41. Identification of the proper universe is recognized uniformly as a key element in the development of a survey. *See, e.g.*, Judicial Conference of the U.S., *supra* note 34; MCL 3d, *supra* note 15, § 21.493. *See also* 3 McCarthy, *supra* note 37, § 32:166; Council of Am. Survey Res. Orgs., Code of Standards and Ethics for Survey Research § III.B.4 (1997).

ployees who worked for Company A between two specific dates. In a community survey designed to provide evidence for a motion for a change of venue, the relevant population consists of all jury-eligible citizens in the community in which the trial is to take place.[42] The definition of the relevant population is crucial because there may be systematic differences in the responses of members of the population and nonmembers. (For example, consumers who are prospective purchasers may know more about the product category than consumers who are not considering making a purchase.)

The universe must be defined carefully. For example, a commercial for a toy or breakfast cereal may be aimed at children, who in turn influence their parents' purchases. If a survey assessing the commercial's tendency to mislead were conducted based on the universe of prospective and actual adult purchasers, it would exclude a crucial group of eligible respondents. Thus, the appropriate population in this instance would include children as well as parents.[43]

B. Did the Sampling Frame Approximate the Population?

The target population consists of all the individuals or units that the researcher would like to study. The sampling frame is the source (or sources) from which the sample actually is drawn. The surveyor's job generally is easier if a complete list of every eligible member of the population is available (e.g., all plaintiffs in a discovery survey), so that the sampling frame lists the identity of all members of the target population. Frequently, however, the target population includes members who are inaccessible or who cannot be identified in advance. As a result, compromises are sometimes required in developing the sampling frame. The survey report should contain a description of the target population, a description of the survey population actually sampled, a discussion of the difference between the two populations, and an evaluation of the likely consequences of that difference.

42. A second relevant population may consist of jury-eligible citizens in the community where the party would like to see the trial moved. By questioning citizens in both communities, the survey can test whether moving the trial is likely to reduce the level of animosity toward the party requesting the change of venue. *See* United States v. Haldeman, 559 F.2d 31, 140, 151, app. A at 176–79 (D.C. Cir. 1976) (court denied change of venue over the strong objection of Judge MacKinnon, who cited survey evidence that Washington, D.C., residents were substantially more likely to conclude, before trial, that the defendants were guilty), *cert. denied*, 431 U.S. 933 (1977); *see also* People v. Venegas, 31 Cal. Rptr. 2d 114, 117 (Ct. App. 1994) (change of venue denied because defendant failed to show that the defendant would face a less hostile jury in a different court).

43. Children and some other populations create special challenges for researchers. For example, very young children should not be asked about sponsorship or licensing, concepts that are foreign to them. Concepts, as well as wording, should be age-appropriate.

A survey that provides information about a wholly irrelevant universe of respondents is itself irrelevant.[44] Courts are likely to exclude the survey or accord it little weight. Thus, when the plaintiff submitted the results of a survey to prove that the green color of its fishing rod had acquired a secondary meaning, the court gave the survey little weight in part because the survey solicited the views of fishing rod dealers rather than consumers.[45] More commonly, however, the sampling frame is either underinclusive or overinclusive relative to the target population. If it is underinclusive, the survey's value depends on the extent to which the excluded population is likely to react differently from the included population. Thus, a survey of spectators and participants at running events would be sampling a sophisticated subset of those likely to purchase running shoes. Because this subset probably would consist of the consumers most knowledgeable about the trade dress used by companies that sell running shoes, a survey based on this population would be likely to substantially overrepresent the strength of a particular design as a trademark, and the extent of that overrepresentation would be unknown and not susceptible to any reasonable estimation.[46]

Similarly, in a survey designed to project demand for cellular phones, the assumption that businesses would be the primary users of cellular service led surveyors to exclude potential nonbusiness users from the survey. The Federal Communications Commission (FCC) found the assumption unwarranted and concluded that the research was flawed, in part because of this underinclusive universe.[47]

44. A survey aimed at assessing how persons in the trade respond to an advertisement should be conducted on a sample of persons in the trade and not on a sample of consumers. Home Box Office v. Showtime/The Movie Channel, 665 F. Supp. 1079, 1083 (S.D.N.Y.), *aff'd in part & vacated in part*, 832 F.2d 1311 (2d Cir. 1987). *But see* Lon Tai Shing Co. v. Koch + Lowy, No. 90-C4464, 1990 U.S. Dist. LEXIS 19123, at *50 (S.D.N.Y. Dec. 14, 1990), in which the judge was willing to find likelihood of consumer confusion from a survey of lighting store salespersons questioned by a survey researcher posing as a customer. The court was persuaded that the salespersons who were misstating the source of the lamp, whether consciously or not, must have believed reasonably that the consuming public would be misled by the salespersons' inaccurate statements about the name of the company that manufactured the lamp they were selling.

45. R.L. Winston Rod Co. v. Sage Mfg. Co., 838 F. Supp. 1396, 1401-02 (D. Mont. 1993).

46. Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 533 F. Supp. 75, 80 (S.D. Fla. 1981), *aff'd*, 716 F.2d 854 (11th Cir. 1983). *See also* Winning Ways, Inc. v. Holloway Sportswear, Inc., 913 F. Supp. 1454, 1467 (D. Kan. 1996) (survey flawed in failing to include sporting goods customers who constituted a major portion of customers). *But see* Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 294–95 (7th Cir. 1998) (survey of store personnel admissible because relevant market included both distributors and ultimate purchasers).

47. Gencom, Inc., 56 Rad. Reg. 2d (P&F) 1597, 1604 (1984). This position was affirmed on appeal. *See* Gencom, Inc. v. FCC, 832 F.2d 171, 186 (D.C. Cir. 1987).

In some cases, it is difficult to determine whether an underinclusive universe distorts the results of the survey and, if so, the extent and likely direction of the bias. For example, a trademark survey was designed to test the likelihood of confusing an analgesic currently on the market with a new product that was similar in appearance.[48] The plaintiff's survey included only respondents who had used the plaintiff's analgesic, and the court found that the universe should have included users of other analgesics, "so that the full range of potential customers for whom plaintiff and defendants would compete could be studied."[49] In this instance, it is unclear whether users of the plaintiff's product would be more or less likely to be confused than users of the defendant's product or users of a third analgesic.[50]

An overinclusive universe generally presents less of a problem in interpretation than does an underinclusive universe. If the survey expert can demonstrate that a sufficiently large (and representative) subset of respondents in the survey was drawn from the appropriate universe, the responses obtained from that subset can be examined, and inferences about the relevant universe can be drawn based on that subset.[51] If the relevant subset cannot be identified, however, an overbroad universe will reduce the value of the survey.[52] If the sample is drawn from an underinclusive universe, there is generally no way to know how the unrepresented members would have responded.[53]

C. How Was the Sample Selected to Approximate the Relevant Characteristics of the Population?

Identification of a survey population must be followed by selection of a sample that accurately represents that population.[54] The use of probability sampling techniques maximizes both the representativeness of the survey results and the ability to assess the accuracy of estimates obtained from the survey.

Probability samples range from simple random samples to complex multistage sampling designs that use stratification, clustering of population elements into various groupings, or both. In simple random sampling, the most basic type

48. American Home Prods. Corp. v. Barr Lab., Inc., 656 F. Supp. 1058 (D.N.J.), *aff'd*, 834 F.2d 368 (3d Cir. 1987).

49. *Id.* at 1070.

50. *See also* Craig v. Boren, 429 U.S. 190 (1976).

51. This occurred in *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.,* 532 F. Supp. 651, 657–58 (W.D. Wash. 1982).

52. Schieffelin & Co. v. Jack Co. of Boca, 850 F. Supp. 232, 246 (S.D.N.Y. 1994).

53. *See, e.g.*, Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263–64 (5th Cir.) (court found both plaintiff's and defendant's surveys substantially defective for a systematic failure to include parts of the relevant population), *cert. denied*, 449 U.S. 899 (1980).

54. MCL 3d, *supra* note 15, § 21.493. *See also* David H. Kaye & David A. Freedman, Reference Guide on Statistics § II.B, in this manual.

of probability sampling, every element in the population has a known, equal probability of being included in the sample, and all possible samples of a given size are equally likely to be selected.[55] In all forms of probability sampling, each element in the relevant population has a known, nonzero probability of being included in the sample.[56]

Probability sampling offers two important advantages over other types of sampling. First, the sample can provide an unbiased estimate of the responses of all persons in the population from which the sample was drawn; that is, the expected value of the sample estimate is the population value being estimated. Second, the researcher can calculate a confidence interval that describes explicitly how reliable the sample estimate of the population is likely to be. Thus, suppose a survey tested a sample of 400 dentists randomly selected from the population of all dentists licensed to practice in the United States and found that 80, or 20%, of them mistakenly believed that a new toothpaste, Goldgate, was manufactured by the makers of Colgate. A survey expert could properly compute a confidence interval around the 20% estimate obtained from this sample. If the survey was repeated a large number of times, and a 95% confidence interval was computed each time, 95% of the confidence intervals would include the actual percentage of dentists in the entire population who would believe that Goldgate was manufactured by the makers of Colgate.[57] In this example, the confidence interval, or margin of error, is the estimate (20%) plus or minus 4%, or the distance between 16% and 24%.

All sample surveys produce estimates of population values, not exact measures of those values. Strictly speaking, the margin of sampling error associated with the sample estimate assumes probability sampling. Assuming a probability sample, a confidence interval describes how stable the mean response in the sample is likely to be. The width of the confidence interval depends on three characteristics:

55. Systematic sampling, in which every *n*th unit in the population is sampled and the starting point is selected randomly, fulfills the first of these conditions. It does not fulfill the second, because no systematic sample can include elements adjacent to one another on the list of population members from which the sample is drawn. Except in very unusual situations when periodicities occur, systematic samples and simple random samples generally produce the same results. Seymour Sudman, *Applied Sampling*, *in* Handbook of Survey Research, *supra* note 1, at 145, 169.

56. Other probability sampling techniques include (1) stratified random sampling, in which the researcher subdivides the population into mutually exclusive and exhaustive subpopulations, or strata, and then randomly selects samples from within these strata; and (2) cluster sampling, in which elements are sampled in groups or clusters, rather than on an individual basis. Martin Frankel, *Sampling Theory*, *in* Handbook of Survey Research, *supra* note 1, at 21, 37, 47.

57. Actually, since survey interviewers would be unable to locate some dentists and some dentists would be unwilling to participate in the survey, technically the population to which this sample would be projectable would be all dentists with current addresses who would be willing to participate in the survey if they were asked.

1. the size of the sample (the larger the sample, the narrower the interval);
2. the variability of the response being measured; and
3. the confidence level the researcher wants to have.

Traditionally, scientists adopt the 95% level of confidence, which means that if 100 samples of the same size were drawn, the confidence interval expected for at least 95 of the samples would be expected to include the true population value.[58]

Although probability sample surveys often are conducted in organizational settings and are the recommended sampling approach in academic and government publications on surveys, probability sample surveys can be expensive when in-person interviews are required, the target population is dispersed widely, or qualified respondents are scarce. A majority of the consumer surveys conducted for Lanham Act litigation present results from nonprobability convenience samples.[59] They are admitted into evidence based on the argument that nonprobability sampling is used widely in marketing research and that "results of these studies are used by major American companies in making decisions of considerable consequence."[60] Nonetheless, when respondents are not selected randomly from the relevant population, the expert should be prepared to justify the method used to select respondents. Special precautions are required to reduce the likelihood of biased samples.[61] In addition, quantitative values computed from such samples (e.g., percentage of respondents indicating confusion) should be viewed as rough indicators rather than as precise quantitative estimates. Confidence intervals should not be computed.

58. To increase the likelihood that the confidence interval contains the actual population value (e.g., from 95% to 99%), the width of the confidence interval can be expanded. An increase in the confidence interval brings an increase in the confidence level. For further discussion of confidence intervals, see David H. Kaye & David A. Freedman, Reference Guide on Statistics § IV.A, in this manual.

59. Jacob Jacoby & Amy H. Handlin, *Non-Probability Sampling Designs for Litigation Surveys*, 81 Trademark Rep. 169, 173 (1991). For probability surveys conducted in trademark cases, see *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.,* 532 F. Supp. 651 (W.D. Wash. 1982); James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266 (7th Cir. 1976).

60. National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 515 (D.N.J. 1986). A survey of members of the Council of American Survey Research Organizations, the national trade association for commercial survey research firms in the United States, revealed that 95% of the in-person independent contacts in studies done in 1985 took place in malls or shopping centers. Jacoby & Handlin, *supra* note 59, at 172–73, 176.

D. Was the Level of Nonresponse Sufficient to Raise Questions About the Representativeness of the Sample? If So, What Is the Evidence That Nonresponse Did Not Bias the Results of the Survey?

Even when a sample is drawn randomly from a complete list of elements in the target population, responses or measures may be obtained on only part of the selected sample. If this lack of response were distributed randomly, valid inferences about the population could be drawn from the characteristics of the available elements in the sample. The difficulty is that nonresponse often is not random, so that, for example, persons who are single typically have three times the "not at home" rate in U.S. Census Bureau surveys as do family members.[62] Efforts to increase response rates include making several attempts to contact potential respondents and providing financial incentives for participating in the survey.

One suggested formula for quantifying a tolerable level of nonresponse in a probability sample is based on the guidelines for statistical surveys issued by the former U.S. Office of Statistical Standards.[63] According to these guidelines, response rates of 90% or more are reliable and generally can be treated as random samples of the overall population. Response rates between 75% and 90% usually yield reliable results, but the researcher should conduct some check on the representativeness of the sample. Potential bias should receive greater scrutiny when the response rate drops below 75%. If the response rate drops below 50%, the survey should be regarded with significant caution as a basis for precise quantitative statements about the population from which the sample was drawn.[64]

Determining whether the level of nonresponse in a survey is critical generally requires an analysis of the determinants of nonresponse. For example, even a survey with a high response rate may seriously underrepresent some portions of the population, such as the unemployed or the poor. If a general population sample was used to chart changes in the proportion of the population that knows someone with HIV, the survey would underestimate the population value if some groups more likely to know someone with HIV (e.g., intravenous drug users) were underrepresented in the sample. The survey expert should be prepared to provide evidence on the potential impact of nonresponse on the survey results.

61. *See infra* § III.E.

62. 2 Gastwirth, *supra* note 33, at 501. This volume contains a useful discussion of sampling, along with a set of examples. *Id.* at 467.

63. This standard is cited with approval by Gastwirth. *Id.* at 502.

64. For thoughtful examples of judges closely scrutinizing potential sample bias when response rates were below 75%, see *Vuyanich v. Republic National Bank,* 505 F. Supp. 224 (N.D. Tex. 1980); Rosado v. Wyman, 322 F. Supp. 1173 (E.D.N.Y.), *aff'd*, 437 F.2d 619 (2d Cir. 1970), *aff'd*, 402 U.S. 991 (1971).

In surveys that include sensitive or difficult questions, particularly surveys that are self-administered, some respondents may refuse to provide answers or may provide incomplete answers. To assess the impact of nonresponse to a particular question, the survey expert should analyze the differences between those who answered and those who did not answer. Procedures to address the problem of missing data include recontacting respondents to obtain the missing answers and using the respondent's other answers to predict the missing response.[65]

E. What Procedures Were Used to Reduce the Likelihood of a Biased Sample?

If it is impractical for a survey researcher to sample randomly from the entire target population, the researcher still can apply probability sampling to some aspects of respondent selection to reduce the likelihood of biased selection. For example, in many studies the target population consists of all consumers or purchasers of a product. Because it is impractical to randomly sample from that population, research is conducted in shopping malls where some members of the target population may not shop. Mall locations, however, can be sampled randomly from a list of possible mall sites. By administering the survey at several different malls, the expert can test for and report on any differences observed across sites. To the extent that similar results are obtained in different locations using different on-site interview operations, it is less likely that idiosyncrasies of sample selection or administration can account for the results.[66] Similarly, since the characteristics of persons visiting a shopping center vary by day of the week and time of day, bias in sampling can be reduced if the survey design calls for sampling time segments as well as mall locations.[67]

In mall intercept surveys, the organization that manages the on-site interview facility generally employs recruiters who approach potential survey respondents in the mall and ascertain if they are qualified and willing to participate in the survey. If a potential respondent agrees to answer the questions and meets the specified criteria, he or she is escorted to the facility where the survey interview takes place. If recruiters are free to approach potential respondents without controls on how an individual is to be selected for screening, shoppers who spend more time in the mall are more likely to be approached than shoppers who visit the mall only briefly. Moreover, recruiters naturally prefer to approach friendly-

65. Andy B. Anderson et al., *Missing Data: A Review of the Literature*, *in* Handbook of Survey Research, *supra* note 1, at 415.

66. Note, however, that differences in results across sites may be due to genuine differences in respondents across geographic locations or to a failure to administer the survey consistently across sites.

67. Seymour Sudman, *Improving the Quality of Shopping Center Sampling*, 17 J. Marketing Res. 423 (1980).

looking potential respondents, so that it is more likely that certain types of individuals will be selected. These potential biases in selection can be reduced by providing appropriate selection instructions and training recruiters effectively. Training that reduces the interviewer's discretion in selecting a potential respondent is likely to reduce bias in selection, as are instructions to approach every *n*th person entering the facility through a particular door.[68]

F. What Precautions Were Taken to Ensure That Only Qualified Respondents Were Included in the Survey?

In a carefully executed survey, each potential respondent is questioned or measured on the attributes that determine his or her eligibility to participate in the survey. Thus, the initial questions screen potential respondents to determine if they are within the target population of the survey (e.g., Is she at least fourteen years old? Does she own a dog? Does she live within ten miles?). The screening questions must be drafted so that they do not convey information that will influence the respondent's answers on the main survey. For example, if respondents must be prospective and recent purchasers of Sunshine orange juice in a trademark survey designed to assess consumer confusion with Sun Time orange juice, potential respondents might be asked to name the brands of orange juice they have purchased recently or expect to purchase in the next six months. They should not be asked specifically if they recently have purchased, or expect to purchase, Sunshine orange juice, because this may affect their responses on the survey either by implying who is conducting the survey or by supplying them with a brand name that otherwise would not occur to them.

The content of a screening questionnaire (or screener) can also set the context for the questions that follow. In *Pfizer, Inc. v. Astra Pharmaceutical Products, Inc.*,[69] physicians were asked a screening question to determine whether they prescribed particular drugs. The court found that the screener conditioned the physicians to respond with the name of a drug rather than a condition.[70]

The criteria for determining whether to include a potential respondent in the survey should be objective and clearly conveyed, preferably using written instructions addressed to those who administer the screening questions. These instructions and the completed screening questionnaire should be made avail-

68. In the end, even if malls are randomly sampled and shoppers are randomly selected within malls, results from mall surveys technically can be used to generalize only to the population of mall shoppers. The ability of the mall sample to describe the likely response pattern of the broader relevant population will depend on the extent to which a substantial segment of the relevant population (1) is not found in malls and (2) would respond differently to the interview.

69. 858 F. Supp. 1305, 1321 & n.13 (S.D.N.Y. 1994).

70. *Id.* at 1321.

able to the court and the opposing party along with the interview form for each respondent.

IV. Survey Questions and Structure

A. Were Questions on the Survey Framed to Be Clear, Precise, and Unbiased?

Although it seems obvious that questions on a survey should be clear and precise, phrasing questions to reach that goal is often difficult. Even questions that appear clear can convey unexpected meanings and ambiguities to potential respondents. For example, the question "What is the average number of days each week you have butter?" appears to be straightforward. Yet some respondents wondered whether margarine counted as butter, and when the question was revised to include the introductory phrase "not including margarine," the reported frequency of butter use dropped dramatically.[71]

When unclear questions are included in a survey, they may threaten the validity of the survey by systematically distorting responses if respondents are misled in a particular direction, or by inflating random error if respondents guess because they do not understand the question.[72] If the crucial question is sufficiently ambiguous or unclear, it may be the basis for rejecting the survey. For example, a survey was designed to assess community sentiment that would warrant a change of venue in trying a case for damages sustained when a hotel skywalk collapsed.[73] The court found that the question "Based on what you have heard, read or seen, do you believe that in the current compensatory damage trials, the defendants, such as the contractors, designers, owners, and operators of the Hyatt Hotel, should be punished?" could neither be correctly understood nor easily answered.[74] The court noted that the phrase "compensatory damages," although well-defined for attorneys, was unlikely to be meaningful for laypersons.[75]

Texts on survey research generally recommend pretests as a way to increase the likelihood that questions are clear and unambiguous,[76] and some courts have

71. Floyd J. Fowler, Jr., *How Unclear Terms Affect Survey Data*, 56 Pub. Opinion Q. 218, 225–26 (1992).

72. *Id.* at 219.

73. Firestone v. Crown Ctr. Redevelopment Corp., 693 S.W.2d 99 (Mo. 1985) (en banc).

74. *Id.* at 102, 103.

75. *Id.* at 103. When there is any question about whether some respondent will understand a particular term or phrase, the term or phrase should be defined explicitly.

76. For a thorough treatment of pretesting methods, see Jean M. Converse & Stanley Presser, Survey Questions: Handcrafting the Standardized Questionnaire 51 (1986). *See also* Fred W. Morgan, *Judicial Standards for Survey Research: An Update and Guidelines*, 54 J. Marketing 59, 64 (1990).

recognized the value of pretests.[77] In a pretest or pilot test,[78] the proposed survey is administered to a small sample (usually between twenty-five and seventy-five)[79] of the same type of respondents who would be eligible to participate in the full-scale survey. The interviewers observe the respondents for any difficulties they may have with the questions and probe for the source of any such difficulties so that the questions can be rephrased if confusion or other difficulties arise. Attorneys who commission surveys for litigation sometimes are reluctant to approve pilot work or to reveal that pilot work has taken place because they are concerned that if a pretest leads to revised wording of the questions, the trier of fact may believe that the survey has been manipulated and is biased or unfair. A more appropriate reaction is to recognize that pilot work can improve the quality of a survey and to anticipate that it often results in word changes that increase clarity and correct misunderstandings. Thus, changes may indicate informed survey construction rather than flawed survey design.[80]

B. Were Filter Questions Provided to Reduce Guessing?

Some survey respondents may have no opinion on an issue under investigation, either because they have never thought about it before or because the question mistakenly assumes a familiarity with the issue. For example, survey respondents may not have noticed that the commercial they are being questioned about guaranteed the quality of the product being advertised and thus they may have no opinion on the kind of guarantee it indicated. Likewise, in an employee survey, respondents may not be familiar with the parental leave policy at their company and thus may have no opinion on whether they would consider taking advantage of the parental leave policy if they became parents. The following three alternative question structures will affect how those respondents answer and how their responses are counted.

First, the survey can ask all respondents to answer the question (e.g., "Did you understand the guarantee offered by Clover to be a one-year guarantee, a sixty-day guarantee, or a thirty-day guarantee?"). Faced with a direct question, particularly one that provides response alternatives, the respondent obligingly may supply an answer even if (in this example) the respondent did not notice the guarantee (or is unfamiliar with the parental leave policy). Such answers will

77. *E.g.*, Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670 (S.D.N.Y. 1963).

78. The terms *pretest* and *pilot test* are sometimes used interchangeably to describe pilot work done in the planning stages of research. When they are distinguished, the difference is that a pretest tests the questionnaire, whereas a pilot test generally tests proposed collection procedures as well.

79. Converse & Presser, *supra* note 76, at 69. Converse and Presser suggest that a pretest with twenty-five respondents is appropriate when the survey uses professional interviewers.

80. *See infra* § VII.B for a discussion of obligations to disclose pilot work.

reflect only what the respondent can glean from the question, or they may reflect pure guessing. The imprecision introduced by this approach will increase with the proportion of respondents who are unfamiliar with the topic at issue.

Second, the survey can use a quasi-filter question to reduce guessing by providing "don't know" or "no opinion" options as part of the question (e.g., "Did you understand the guarantee offered by Clover to be for more than a year, a year, or less than a year, or don't you have an opinion?").[81] By signaling to the respondent that it is appropriate not to have an opinion, the question reduces the demand for an answer and, as a result, the inclination to hazard a guess just to comply. Respondents are more likely to choose a "no opinion" option if it is mentioned explicitly by the interviewer than if it is merely accepted when the respondent spontaneously offers it as a response. The consequence of this change in format is substantial. Studies indicate that, although the relative distribution of the respondents selecting the *listed* choices is unlikely to change dramatically, presentation of an explicit "don't know" or "no opinion" alternative commonly leads to a 20%–25% increase in the proportion of respondents selecting that response.[82]

Finally, the survey can include full-filter questions, that is, questions that lay the groundwork for the substantive question by first asking the respondent if he or she has an opinion about the issue or happened to notice the feature that the interviewer is preparing to ask about (e.g., "Based on the commercial you just saw, do you have an opinion about how long Clover stated or implied that its guarantee lasts?"). The interviewer then asks the substantive question only of those respondents who have indicated that they have an opinion on the issue.

Which of these three approaches is used and the way it is used can affect the rate of "no opinion" responses that the substantive question will evoke.[83] Respondents are more likely to say they do not have an opinion on an issue if a full filter is used than if a quasi-filter is used.[84] However, in maximizing respondent expressions of "no opinion," full filters may produce an underreporting of opinions. There is some evidence that full-filter questions discourage respondents who actually have opinions from offering them by conveying the implicit suggestion that respondents can avoid difficult follow-up questions by saying that they have no opinion.[85]

81. Norbert Schwarz & Hans-Jürgen Hippler, *Response Alternatives: The Impact of Their Choice and Presentation Order*, *in* Measurement Errors in Surveys 41, 45–46 (Paul P. Biemer et al. eds., 1991).

82. Howard Schuman & Stanley Presser, Questions and Answers in Attitude Surveys: Experiments on Question Form, Wording and Context 113–46 (1981).

83. Considerable research has been conducted on the effects of filters. For a review, see George F. Bishop et al., *Effects of Filter Questions in Public Opinion Surveys*, 47 Pub. Opinion Q. 528 (1983).

84. Schwarz & Hippler, *supra* note 81, at 45–46.

85. *Id.* at 46.

In general, then, a survey that uses full filters tends to provide a conservative estimate of the number of respondents holding an opinion, whereas a survey that uses neither full filters nor quasi-filters tends to overestimate the number of respondents with opinions, because some respondents offering opinions are guessing. The strategy of including a "no opinion" or "don't know" response as a quasi-filter avoids both of these extremes. Thus, rather than asking, "Based on the commercial, do you believe that the two products are made in the same way, or are they made differently?"[86] or prefacing the question with a preliminary, "Do you have an opinion, based on the commercial, concerning the way that the two products are made?" the question could be phrased, "Based on the commercial, do you believe that the two products are made in the same way, or that they are made differently, or don't you have an opinion about the way they are made?"

C. Did the Survey Use Open-Ended or Closed-Ended Questions? How Was the Choice in Each Instance Justified?

The questions that make up a survey instrument may be open-ended, closed-ended, or a combination of both. Open-ended questions require the respondent to formulate and express an answer in his or her own words (e.g., "What was the main point of the commercial?" "Where did you catch the fish you caught in these waters?"[87]). Closed-ended questions provide the respondent with an explicit set of responses from which to choose; the choices may be as simple as yes or no (e.g., "Is Colby College coeducational?"[88]) or as complex as a range of alternatives (e.g., "The two pain relievers have (1) the same likelihood of causing gastric ulcers; (2) about the same likelihood of causing gastric ulcers; (3) a somewhat different likelihood of causing gastric ulcers; (4) a very different likelihood of causing gastric ulcers; or (5) none of the above."[89]).

Open-ended and closed-ended questions may elicit very different responses.[90]

86. The question in the example without the "no opinion" alternative was based on a question rejected by the court in *Coors Brewing Co. v. Anheuser-Busch Cos.,* 802 F. Supp. 965, 972–73 (S.D.N.Y. 1992).

87. A relevant example from *Wilhoite v. Olin Corp.* is described in McGovern & Lind, *supra* note 27, at 76.

88. Presidents & Trustees of Colby College v. Colby College–N.H., 508 F.2d 804, 809 (1st Cir. 1975).

89. This question is based on one asked in *American Home Products Corp. v. Johnson & Johnson,* 654 F. Supp. 568, 581 (S.D.N.Y. 1987), that was found to be a leading question by the court, primarily because the choices suggested that the respondent had learned about aspirin's and ibuprofen's relative likelihood of causing gastric ulcers. In contrast, in *McNeilab, Inc. v. American Home Products Corp.,* 501 F. Supp. 517, 525 (S.D.N.Y. 1980), the court accepted as nonleading the question, "Based only on what the commercial said, would Maximum Strength Anacin contain more pain reliever, the same amount of pain reliever, or less pain reliever than the brand you, yourself, currently use most often?"

90. Howard Schuman & Stanley Presser, *Question Wording as an Independent Variable in Survey Analysis*,

Most responses are less likely to be volunteered by respondents who are asked an open-ended question than they are to be chosen by respondents who are presented with a closed-ended question. The response alternatives in a closed-ended question may remind respondents of options that they would not otherwise consider or which simply do not come to mind as easily.[91]

The advantage of open-ended questions is that they give the respondent fewer hints about the answer that is expected or preferred. Precoded responses on a closed-ended question, in addition to reminding respondents of options that they might not otherwise consider,[92] may direct the respondent away from or toward a particular response. For example, a commercial reported that in shampoo tests with more than 900 women, the sponsor's product received higher ratings than other brands.[93] According to a competitor, the commercial deceptively implied that each woman in the test rated more than one shampoo, when in fact each woman rated only one. To test consumer impressions, a survey might have shown the commercial and asked an open-ended question: "How many different brands mentioned in the commercial did each of the 900 women try?"[94] Instead, the survey asked a closed-ended question; respondents were given the choice of "one," "two," "three," "four," or "five or more." The fact that four of the five choices in the closed-ended question provided a response that was greater than one implied that the correct answer was probably more than one.[95] Note, however, that the open-ended question also may suggest that the answer is more than one. By asking "how many different brands," the question suggests (1) that the viewer should have received some message from the commercial about the number of brands each woman tried and (2) that different brands were tried. Thus, the wording of a question, open-ended or closed-ended, can be leading, and the degree of suggestiveness of each question must be considered in evaluating the objectivity of a survey.

6 Soc. Methods & Res. 151 (1977); Schuman & Presser, *supra* note 82, at 79–112; Converse & Presser, *supra* note 76, at 33.

91. For example, when respondents in one survey were asked, "What is the most important thing for children to learn to prepare them for life?", 62% picked "to think for themselves" from a list of five options, but only 5% spontaneously offered that answer when the question was open-ended. Schuman & Presser, *supra* note 82, at 104–07. An open-ended question presents the respondent with a free-recall task, whereas a closed-ended question is a recognition task. Recognition tasks in general reveal higher performance levels than recall tasks. Mary M. Smyth et al., Cognition in Action 25 (1987). In addition, there is evidence that respondents answering open-ended questions may be less likely to report some information that they would reveal in response to a closed-ended question when that information seems self-evident or irrelevant.

92. Schwarz & Hippler, *supra* note 81, at 43.

93. *See* Vidal Sassoon, Inc. v. Bristol-Myers Co., 661 F.2d 272, 273 (2d Cir. 1981).

94. This was the wording of the stem of the closed-ended question in the survey discussed in *Vidal Sassoon*, 661 F.2d at 275–76.

95. Ninety-five percent of the respondents who answered the closed-ended question in the plaintiff's survey said that each woman had tried two or more brands. The open-ended question was never asked.

Closed-ended questions have some additional potential weaknesses that arise if the choices are not constructed properly. If the respondent is asked to choose one response from among several choices, the response chosen will be meaningful only if the list of choices is exhaustive, that is, if the choices cover all possible answers a respondent might give to the question. If the list of possible choices is incomplete, a respondent may be forced to choose one that does not express his or her opinion.[96] Moreover, if respondents are told explicitly that they are not limited to the choices presented, most respondents nevertheless will select an answer from among the listed ones.[97]

Although many courts prefer open-ended questions on the grounds that they tend to be less leading, the value of any open-ended or closed-ended question depends on the information it is intended to elicit. Open-ended questions are more appropriate when the survey is attempting to gauge what comes first to a respondent's mind, but closed-ended questions are more suitable for assessing choices between well-identified options or obtaining ratings on a clear set of alternatives.

D. If Probes Were Used to Clarify Ambiguous or Incomplete Answers, What Steps Were Taken to Ensure That the Probes Were Not Leading and Were Administered in a Consistent Fashion?

When questions allow respondents to express their opinions in their own words, some of the respondents may give ambiguous or incomplete answers. In such instances, interviewers may be instructed to record any answer that the respondent gives and move on to the next question, or they may be instructed to probe to obtain a more complete response or clarify the meaning of the ambiguous response. In either situation, interviewers should record verbatim both what the respondent says and what the interviewer says in the attempt to get clarification. Failure to record every part of the exchange in the order in which it occurs raises questions about the reliability of the survey, because neither the court nor the opposing party can evaluate whether the probe affected the views expressed by the respondent.

Vidal Sassoon, 661 F.2d at 276. Norbert Schwarz, *Assessing Frequency Reports of Mundane Behaviors: Contributions of Cognitive Psychology to Questionnaire Construction*, *in* Research Methods in Personality and Social Psychology 98 (Clyde Hendrick & Margaret S. Clark eds., 1990), suggests that respondents often rely on the range of response alternatives as a frame of reference when they are asked for frequency judgments. *See, e.g.*, Roger Tourangeau & Tom W. Smith, *Asking Sensitive Questions: The Impact of Data Collection Mode, Question Format, and Question Context*, 60 Pub. Opinion Q. 275, 292 (1996).

96. *See, e.g.*, American Home Prods. Corp. v. Johnson & Johnson, 654 F. Supp. 568, 581 (S.D.N.Y. 1987).

97. *See* Howard Schuman, *Ordinary Questions, Survey Questions, and Policy Questions*, 50 Pub. Opinion Q. 432, 435–36 (1986).

If the survey is designed to allow for probes, interviewers must be given explicit instructions on when they should probe and what they should say in probing. Standard probes used to draw out all that the respondent has to say (e.g., "Any further thoughts?" "Anything else?" "Can you explain that a little more?") are relatively innocuous and noncontroversial in content, but persistent continued requests for further responses to the same or nearly identical questions may convey the idea to the respondent that he or she has not yet produced the "right" answer.[98] Interviewers should be trained in delivering probes to maintain a professional and neutral relationship with the respondent (as they should during the rest of the interview), which minimizes any sense of passing judgment on the content of the answers offered. Moreover, interviewers should be given explicit instructions on when to probe, so that probes are administered consistently.

A more difficult type of probe to construct and deliver reliably is one that requires a substantive question tailored to the answer given by the respondent. The survey designer must provide sufficient instruction to interviewers so that they avoid giving directive probes that suggest one answer over another. Those instructions, along with all other aspects of interviewer training, should be made available for evaluation by the court and the opposing party.

E. What Approach Was Used to Avoid or Measure Potential Order or Context Effects?

The order in which questions are asked on a survey and the order in which response alternatives are provided in a closed-ended question can influence the answers.[99] Thus, although asking a general question before a more specific question on the same topic is unlikely to affect the response to the specific question, reversing the order of the questions may influence responses to the general question. As a rule, then, surveys are less likely to be subject to order effects if

98. *See, e.g.*, Johnson & Johnson-Merck Consumer Pharms. Co. v. Rhone-Poulenc Rorer Pharms., Inc., 19 F.3d 125, 135 (3d Cir. 1994); American Home Prods. Corp. v. Procter & Gamble Co., 871 F. Supp. 739, 748 (D.N.J. 1994).

99. *See* Schuman & Presser, *supra* note 82, at 23, 56–74; Norman M. Bradburn, *Response Effects*, *in* Handbook of Survey Research, *supra* note 1, at 289, 302. In *R.J. Reynolds Tobacco Co. v. Loew's Theatres, Inc.*, 511 F. Supp. 867, 875 (S.D.N.Y. 1980), the court recognized the biased structure of a survey which disclosed the tar content of the cigarettes being compared before questioning respondents about their cigarette preferences. Not surprisingly, respondents expressed a preference for the lower tar product. *See also* E. & J. Gallo Winery v. Pasatiempos Gallo, S.A., 905 F. Supp. 1403, 1409–10 (E.D. Cal. 1994) (court recognized that earlier questions referring to playing cards, board or table games, or party supplies, such as confetti, increased the likelihood that respondents would include these items in answers to the questions that followed).

the questions go from the general (e.g., "What do you recall being discussed in the advertisement?") to the specific (e.g., "Based on your reading of the advertisement, what companies do you think the ad is referring to when it talks about rental trucks that average five miles per gallon?").[100]

The mode of questioning can influence the form that an order effect takes. In mail surveys, respondents are more likely to select the first choice offered (a primacy effect); in telephone surveys, respondents are more likely to choose the last choice offered (a recency effect). Although these effects are typically small, no general formula is available that can adjust values to correct for order effects, because the size and even the direction of the order effects may depend on the nature of the question being asked and the choices being offered. Moreover, it may be unclear which order is most appropriate. For example, if the respondent is asked to choose between two different products, and there is a tendency for respondents to choose the first product mentioned,[101] which order of presentation will produce the more accurate response?[102]

To control for order effects, the order of the questions and the order of the response choices in a survey should be rotated,[103] so that, for example, one-third of the respondents have Product A listed first, one-third of the respondents have Product B listed first, and one-third of the respondents have Product C listed first. If the three different orders[104] are distributed randomly among respondents, no response alternative will have an inflated chance of being selected because of its position, and the average of the three will provide a reasonable estimate of response level.[105]

100. This question was accepted by the court in *U-Haul International, Inc. v. Jartran, Inc.,* 522 F. Supp. 1238, 1249 (D. Ariz. 1981), *aff'd*, 681 F.2d 1159 (9th Cir. 1982).

101. Similarly, candidates in the first position on the ballot tend to attract extra votes when the candidates are not well known. Henry M. Bain & Donald S. Hecock, Ballot Position and Voter's Choice: The Arrangement of Names on the Ballot and Its Effect on the Voter (1973).

102. *See* Rust Env't & Infrastructure, Inc. v. Teunissen, 131 F.3d 1210, 1218 (7th Cir. 1997) (survey did not pass muster in part because of failure to incorporate random rotation of corporate names that were the subject of a trademark dispute).

103. *See, e.g.,* Stouffer Foods Corp., 118 F.T.C. 746, No. 9250, 1994 FTC LEXIS 196, at *24–25 (Sept. 26, 1994); *cf.* Winning Ways, Inc. v. Holloway Sportswear, Inc., 913 F. Supp. 1454, 1465–67 (D. Kan. 1996) (failure to rotate the order in which the jackets were shown to the consumers led to reduced weight for the survey).

104. Actually, there are six possible orders of the three alternatives: ABC, ACB, BAC, BCA, CAB, and CBA. Thus, the optimal survey design would allocate equal numbers of respondents to each of the six possible orders.

105. Although rotation is desirable, many surveys are conducted with no attention to this potential bias. Since it is impossible to know in the abstract whether a particular question suffers much, little, or not at all from an order bias, lack of rotation should not preclude reliance on the answer to the question, but it should reduce the weight given to that answer.

F. If the Survey Was Designed to Test a Causal Proposition, Did the Survey Include an Appropriate Control Group or Question?

Most surveys that are designed to provide evidence of trademark infringement or deceptive advertising are not conducted to describe consumer beliefs. Instead, they are intended to show how a trademark or the content of a commercial influences respondents' perceptions or understanding of a product or commercial. Thus, the question is whether the commercial misleads the consumer into thinking that Product A is a superior pain reliever, not whether consumers hold inaccurate beliefs about the product. Yet if consumers already believe, before viewing the commercial, that Product A is a superior pain reliever, a survey that records consumers' impressions after they view the commercial may reflect those preexisting beliefs rather than impressions produced by the commercial.

Surveys that record consumer impressions have a limited ability to answer questions about the origins of those impressions. The difficulty is that the consumer's response to any question on the survey may be the result of information or misinformation from sources other than the trademark the respondent is being shown or the commercial he or she has just watched. In a trademark survey attempting to show secondary meaning, for example, respondents were shown a picture of the stripes used on Mennen stick deodorant and asked, "[W]hich [brand] would you say uses these stripes on their package?"[106] The court recognized that the high percentage of respondents selecting "Mennen" from an array of brand names may have represented "merely a playback of brand share"[107]; that is, respondents asked to give a brand name may guess the one that is most familiar, generally the brand with the largest market share.[108]

Some surveys attempt to reduce the impact of preexisting impressions on respondents' answers by instructing respondents to focus solely on the stimulus as a basis for their answers. Thus, the survey includes a preface (e.g., "based on the commercial you just saw") or directs the respondent's attention to the mark at issue (e.g., "these stripes on the package"). Such efforts are likely to be only partially successful. It is often difficult for respondents to identify accurately the source of their impressions.[109] The more routine the idea being examined in the survey (e.g., that the advertised pain reliever is more effective than others on the

106. Mennen Co. v. Gillette Co., 565 F. Supp. 648, 652 (S.D.N.Y. 1983), *aff'd*, 742 F.2d 1437 (2d Cir. 1984). To demonstrate secondary meaning, "the [c]ourt must determine whether the mark has been so associated in the mind of consumers with the entity that it identifies that the goods sold by that entity are distinguished by the mark or symbol from goods sold by others." *Id*.

107. *Id*.

108. *See also* Upjohn Co. v. American Home Prods. Corp., No. 1-95-CV-237, 1996 U.S. Dist. LEXIS 8049, at *42-44 (W.D. Mich. Apr. 5, 1996).

109. *See* Richard E. Nisbett & Timothy D. Wilson, *Telling More Than We Can Know: Verbal Reports on Mental Processes*, 84 Psychol. Rev. 231 (1977).

market; that the mark belongs to the brand with the largest market share), the more likely it is that the respondent's answer is influenced by preexisting impressions, by expectations about what commercials generally say (e.g., the product being advertised is better than its competitors), or by guessing, rather than by the actual content of the commercial message or trademark being evaluated.

It is possible to adjust many survey designs so that causal inferences about the effect of a trademark or an allegedly deceptive commercial become clear and unambiguous. By adding an appropriate control group, the survey expert can test directly the influence of the stimulus.[110] In the simplest version of a survey experiment, respondents are assigned randomly to one of two conditions.[111] For example, respondents assigned to the experimental condition view an allegedly deceptive commercial, and respondents assigned to the control condition either view a commercial that does not contain the allegedly deceptive material or do not view any commercial.[112] Respondents in both the experimental and control groups answer the same set of questions. The effect of the allegedly deceptive message is evaluated by comparing the responses made by the experimental group members with those of the control group members. If 40% of the respondents in the experimental group responded with the deceptive message (e.g., the advertised product has fewer calories than its competitor), whereas only 8% of the respondents in the control group gave that response, the difference between 40% and 8% (within the limits of sampling error[113]) can be attributed only to the allegedly deceptive commercial. Without the control group, it is not possible to determine how much of the 40% is due to respondents' preexisting beliefs or other background noise (e.g., respondents who misunderstand the question or misstate their responses). Both preexisting beliefs and other background noise should have produced similar response levels in the experimental

110. *See* Shari S. Diamond, *Using Psychology to Control Law: From Deceptive Advertising to Criminal Sentencing*, 13 Law & Hum. Behav. 239, 244–46 (1989); Shari S. Diamond & Linda Dimitropoulos, Deception and Puffery in Advertising: Behavioral Science Implications for Regulation (American Bar Found. Working Paper Series No. 9105, 1994); Jacob Jacoby & Constance Small, *Applied Marketing: The FDA Approach to Defining Misleading Advertising*, 39 J. Marketing 65, 68 (1975). For a more general discussion of the role of control groups, see David H. Kaye & David A. Freedman, Reference Guide on Statistics, § II.A, in this manual.

111. Random assignment should not be confused with random selection. When respondents are assigned randomly to different treatment groups (e.g., respondents in each group watch a different commercial), the procedure ensures that within the limits of sampling error the two groups of respondents will be equivalent except for the different treatments they receive. Respondents selected for a mall intercept study, and not from a probability sample, may be assigned randomly to different treatment groups. Random selection, in contrast, describes the method of selecting a sample of respondents in a probability sample. *See supra* § III.C.

112. This alternative commercial could be a "tombstone" advertisement that includes only the name of the product or a more elaborate commercial that does not include the claim at issue.

113. For a discussion of sampling error, see David H. Kaye & David A. Freedman, Reference Guide on Statistics, § IV, in this manual.

and control groups. In addition, if respondents who viewed the allegedly deceptive commercial respond differently than respondents who viewed the control commercial, the difference cannot be the result of a leading question, because both groups answered the same question. The ability to evaluate the effect of the wording of a particular question makes the control group design particularly useful in assessing responses to closed-ended questions,[114] which may encourage guessing or particular responses. Thus, the focus on the response level in a control group design is not on the absolute response level, but on the difference between the response level of the experimental group and that of the control group.

In designing a control group study, 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. A survey with an imperfect control group generally provides better information than a survey with no control group at all, but the choice of the specific control group requires some care and should influence the weight that the survey receives. For example, a control stimulus should not be less attractive than the experimental stimulus if the survey is designed to measure how familiar the experimental stimulus is to respondents, since attractiveness may affect perceived familiarity.[115] Nor should the control stimulus share with the experimental stimulus the feature whose impact is being assessed. If, for example, the control stimulus in a case of alleged trademark infringement is itself a likely source of consumer confusion, reactions to the experimental and control stimuli may not differ because both cause respondents to express the same level of confusion.[116]

Explicit attention to the value of control groups in trademark and deceptive-advertising litigation is a recent phenomenon, but it is becoming more common.[117] A LEXIS search using *Lanham Act* and *control group* revealed fourteen

114. The Federal Trade Commission has long recognized the need for some kind of control for closed-ended questions, although it has not specified the type of control that is necessary. Stouffer Foods Corp., 118 F.T.C. 746, No. 9250, 1994 FTC LEXIS 196, at *31 (Sept. 26, 1994).

115. *See, e.g.*, Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership, 34 F.3d 410, 415–16 (7th Cir. 1994) (The court recognized that the name "Baltimore Horses" was less attractive for a sports team than the name "Baltimore Colts."). *See also* Reed-Union Corp. v. Turtle Wax, Inc., 77 F.3d 909, 912 (7th Cir. 1996) (court noted that one expert's choice of a control brand with a well-known corporate source was less appropriate than the opposing expert's choice of a control brand whose name did not indicate a specific corporate source).

116. *See, e.g.*, Western Publ'g Co. v. Publications Int'l, Ltd., No. 94-C-6803, 1995 U.S. Dist. LEXIS 5917, at *45 (N.D. Ill. May 2, 1995) (court noted that the control product was "arguably more infringing than" the defendant's product) (emphasis omitted).

117. *See, e.g.*, American Home Prods. Corp. v. Procter & Gamble Co., 871 F. Supp. 739, 749 (D.N.J. 1994) (discounting survey results based on failure to control for participants' preconceived notions); ConAgra, Inc. v. Geo. A. Hormel & Co., 784 F. Supp. 700, 728 (D. Neb. 1992) ("Since no control was used, the . . . study, standing alone, must be significantly discounted."), *aff'd*, 990 F.2d 368 (8th Cir. 1993).

district court cases in the six years since the first edition of this manual in 1994,[118] five district court cases in the seven years from 1987 to 1993,[119] and only one case before 1987[120] in which surveys with control groups were discussed. Other cases, however, have described or considered surveys using control group designs without labeling the comparison group a control group.[121] Indeed, one reason why cases involving surveys with control groups may be underrepresented in reported cases is that a survey with a control group produces less ambiguous findings, which may lead to a resolution before a preliminary injunction hearing or trial occurs.[122]

Another more common use of control methodology is a control question. Rather than administering a control stimulus to a separate group of respondents,

118. National Football League Properties, Inc. v. Prostyle, Inc., 57 F. Supp. 2d 665 (E.D. Wis. 1999); Nabisco, Inc. v. PF Brands, Inc., 50 F. Supp. 2d 188 (S.D.N.Y. 1999); Proctor & Gamble Co. v. Colgate-Palmolive Co., No. 96 Civ. 9123, 1998 U.S. Dist. LEXIS 17773 (S.D.N.Y. Nov. 5, 1998); Mattel, Inc. v. MCA Records, Inc., 28 F. Supp. 2d 1120 (C.D. Cal. 1998); Westchester Media Co. v. PRL USA Holdings, No. H-97-3278, 1998 U.S. Dist. LEXIS 11737 (S.D. Tex. July 2, 1998); Time Inc. v. Petersen Publ'g Co., 976 F. Supp. 263 (S.D.N.Y. 1997), *aff'd,* 173 F.3d 113 (2d Cir. 1999); Adjusters Int'l, Inc. v. Public Adjusters Int'l, Inc., No. 92-CV-1426, 1996 U.S. Dist. LEXIS 12604 (N.D.N.Y. Aug. 27, 1996); Upjohn Co. v. American Home Prods. Corp., No. 1-95-CV-237, 1996 U.S. Dist. LEXIS 8049 (W.D. Mich. Apr. 5, 1996); Copy Cop, Inc. v. Task Printing, Inc., 908 F. Supp. 37 (D. Mass. 1995); Volkswagen Aktiengesellschaft v. Uptown Motors, No. 91-CIV-3447, 1995 U.S. Dist. LEXIS 13869 (S.D.N.Y. July 13, 1995); Western Publ'g Co. v. Publications Int'l, Ltd., No. 94-C-6803, 1995 U.S. Dist. LEXIS 5917 (N.D. Ill. May 2, 1995); Dogloo, Inc. v. Doskocil Mfg. Co., 893 F. Supp. 911 (C.D. Cal. 1995); Reed-Union Corp. v. Turtle Wax, Inc., 869 F. Supp. 1304 (N.D. Ill. 1994), *aff'd*, 77 F.3d 909 (7th Cir. 1996); Pfizer, Inc. v. Miles, Inc., 868 F. Supp. 437 (D. Conn. 1994).

119. ConAgra, Inc. v. Geo. A. Hormel & Co., 784 F. Supp. 700 (D. Neb. 1992), *aff'd*, 990 F.2d 368 (8th Cir. 1993); Johnson & Johnson-Merck Consumer Pharms. Co. v. Smithkline Beecham Corp., No. 91 Civ. 0960, 1991 U.S. Dist. LEXIS 13689 (S.D.N.Y. Sept. 30, 1991), *aff'd*, 960 F.2d 294 (2d Cir. 1992); Goya Foods, Inc. v. Condal Distribs., Inc., 732 F. Supp. 453 (S.D.N.Y. 1990); Sturm, Ruger & Co. v. Arcadia Mach. & Tool, Inc., No. 85-8459, 1988 U.S. Dist. LEXIS 16451 (C.D. Cal. Nov. 7, 1988); Frisch's Restaurant, Inc. v. Elby's Big Boy, Inc., 661 F. Supp. 971 (S.D. Ohio 1987), *aff'd*, 849 F.2d 1012 (6th Cir. 1988).

120. American Basketball Ass'n v. AMF Voit, Inc., 358 F. Supp. 981 (S.D.N.Y.), *aff'd*, 487 F.2d 1393 (2d Cir. 1973).

121. Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership, No. 94-727-C, 1994 U.S. Dist. LEXIS 19277, at *10–11 (S.D. Ind. June 27, 1994), *aff'd*, 34 F.3d 410 (7th Cir. 1994). In *Indianapolis Colts*, the district court described a survey conducted by the plaintiff's expert in which half of the interviewees were shown a shirt with the name "Baltimore CFL Colts" on it and half were shown a shirt on which the word "Horses" had been substituted for the word "Colts." *Id*. The court noted that the comparison of reactions to the horse and colt versions of the shirt made it possible "to determine the impact from the use of the word 'Colts.'" *Id.* at *11. *See also* Quality Inns Int'l, Inc. v. McDonald's Corp., 695 F. Supp. 198, 218 (D. Md. 1988) (survey revealed confusion between McDonald's and McSleep, but control survey revealed no confusion between McDonald's and McTavish).

122. The relatively infrequent mention of control groups in surveys discussed in federal cases is not confined to Lanham Act litigation. A LEXIS search using *survey* and *control group* revealed thirty district court cases in the six years from 1994 in which *control group* was used to refer to a methodological feature: the fourteen Lanham Act cases cited *supra* note 118; nine that referred to medical, physiological, or pharmacological experiments; and seven others.

the survey asks all respondents one or more control questions along with the question about the product or service. In a trademark dispute, for example, a survey indicated that 7.2% of respondents believed that "The Mart" and "K-Mart" were owned by the same individuals. The court found no likelihood of confusion based on survey evidence that 5.7% of the respondents also thought that "The Mart" and "King's Department Store" were owned by the same source.[123]

Similarly, a standard technique used to evaluate whether a brand name is generic is to present survey respondents with a series of product or service names and ask them to indicate in each instance whether they believe the name is a brand name or a common name. By showing that 68% of respondents considered Teflon a brand name (a proportion similar to the 75% of respondents who recognized the acknowledged trademark Jell-O as a brand name, and markedly different from the 13% who thought aspirin was a brand name), the makers of Teflon retained their trademark.[124]

Every measure of opinion or belief in a survey reflects some degree of error. Control groups and control questions are the most reliable means for assessing response levels against the baseline level of error associated with a particular question.

G. What Limitations Are Associated with the Mode of Data Collection Used in the Survey?

Three primary methods are used to collect survey data: (1) in-person interviews, (2) telephone surveys, and (3) mail surveys.[125] The choice of a data collection method for a survey should be justified by its strengths and weaknesses.

1. In-person interviews

Although costly, in-person interviews generally are the preferred method of data collection, especially when visual materials must be shown to the respondent under controlled conditions.[126] When the questions are complex and the interviewers are skilled, in-person interviewing provides the maximum oppor-

123. S.S. Kresge Co. v. United Factory Outlet, Inc., 598 F.2d 694, 697 (1st Cir. 1979). Note that the aggregate percentages reported here do not reveal how many of the same respondents were confused by both names, an issue that may be relevant in some situations. *See* Joseph L. Gastwirth, *Reference Guide on Survey Research*, 36 Jurimetrics J. 181, 187–88 (1996) (review essay).

124. E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 526-27 & n.54 (E.D.N.Y. 1975).

125. Methods also may be combined, as when the telephone is used to "screen" for eligible respondents, who then are invited to participate in an in-person interview.

126. A mail survey also can include limited visual materials but cannot exercise control over when and how the respondent views them.

tunity to clarify or probe. Unlike a mail survey, both in-person and telephone interviews have the capability to implement complex skip sequences (in which the respondent's answer determines which question will be asked next) and the power to control the order in which the respondent answers the questions. As described in section V.A, appropriate interviewer training is necessary if these potential benefits are to be realized. Objections to the use of in-person interviews arise primarily from their high cost or, on occasion, from evidence of inept or biased interviewers.

2. Telephone surveys

Telephone surveys offer a comparatively fast and low-cost alternative to in-person surveys and are particularly useful when the population is large and geographically dispersed. Telephone interviews (unless supplemented with mailed materials) can be used only when it is unnecessary to show the respondent any visual materials. Thus, an attorney may present the results of a telephone survey of jury-eligible citizens in a motion for a change of venue in order to provide evidence that community prejudice raises a reasonable suspicion of potential jury bias.[127] Similarly, potential confusion between a restaurant called McBagel's and the McDonald's fast-food chain was established in a telephone survey. Over objections from defendant McBagel's that the survey did not show respondents the defendant's print advertisements, the court found likelihood of confusion based on the survey, noting that "by soliciting audio responses [, the telephone survey] was closely related to the radio advertising involved in the case."[128] In contrast, when words are not sufficient because, for example, the survey is assessing reactions to the trade dress or packaging of a product that is alleged to promote confusion, a telephone survey alone does not offer a suitable vehicle for questioning respondents.[129]

In evaluating the sampling used in a telephone survey, the trier of fact should consider

- (when prospective respondents are not business personnel) whether some form of random-digit dialing[130] was used instead of or to supplement tele-

127. United States v. Partin, 320 F. Supp. 275, 279-80 (E.D. La. 1970). For a discussion of surveys used in motions for change of venue, see Neal Miller, *Facts, Expert Facts, and Statistics: Descriptive and Experimental Research Methods in Litigation*, *Part II*, 40 Rutgers L. Rev. 467, 470–74 (1988); National Jury Project, Jurywork: Systematic Techniques (Elissa Krauss & Beth Bonora eds., 2d ed. 1983).

128. McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1278 (S.D.N.Y. 1986).

129. Thompson Med. Co. v. Pfizer Inc., 753 F.2d 208 (2d Cir. 1985); Incorporated Publ'g Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370 (S.D.N.Y. 1985), *aff'd without op.*, 788 F.2d 3 (2d Cir. 1986).

130. Random digit dialing provides coverage of households with both listed and unlisted telephone numbers by generating numbers at random from the frame of all possible telephone numbers. James M. Lepkowski, *Telephone Sampling Methods in the United States*, *in* Telephone Survey Methodology 81–91 (Robert M. Groves et al. eds., 1988).

phone numbers obtained from telephone directories, because up to 65% of all residential telephone numbers in some areas may be unlisted;[131]
- whether the sampling procedures required the interviewer to sample within the household or business, instead of allowing the interviewer to administer the survey to any qualified individual who answered the telephone;[132] and
- whether interviewers were required to call back at several different times of the day and on different days to increase the likelihood of contacting individuals or businesses with different schedules.

Telephone surveys that do not include these procedures may, like other nonprobability sampling approaches, be adequate for providing rough approximations. The vulnerability of the survey depends on the information being gathered. More elaborate procedures for achieving a representative sample of respondents are advisable if the survey instrument requests information that is likely to differ for individuals with listed telephone numbers and individuals with unlisted telephone numbers, or individuals rarely at home and those usually at home.

The report submitted by a survey expert who conducts a telephone survey should specify

1. the procedures that were used to identify potential respondents;
2. the number of telephone numbers for which no contact was made; and
3. the number of contacted potential respondents who refused to participate in the survey.

Computer-assisted telephone interviewing, or CATI, is increasingly used in the administration and data entry of large-scale surveys.[133] A computer protocol may be used to generate telephone numbers and dial them as well as to guide the interviewer. The interviewer conducting a computer-assisted interview (CAI), whether by telephone or in a face-to-face setting, follows the script for the interview generated by the computer program and types in the respondent's answers as the interview proceeds. A primary advantage of CATI and other CAI procedures is that skip patterns can be built into the program so that, for example, if the respondent is asked whether she has ever been the victim of a burglary and she says yes, the computer will generate further questions about

131. In 1992, the percentage of households with unlisted numbers reached 65% in Las Vegas and 62% in Los Angeles. Survey Sampling, Inc., The Frame 2 (March 1993). Studies comparing listed and unlisted household characteristics show some important differences. Lepkowski, *supra* note 130, at 76.

132. This is a consideration only if the survey is sampling individuals. If the survey is seeking information on the household, more than one individual may be able to answer questions on behalf of the household.

133. William L. Nicholls II & R.M. Groves, *The Status of Computer-Assisted Telephone Interviewing*, 2 J. Official Stat. 93 (1986); Mary A. Spaeth, *CATI Facilities at Academic Research Organizations*, 21 Surv. Res. 11 (1990); William E. Saris, Computer-Assisted Interviewing (1991).

the burglary, but if she says no, the program will automatically skip the follow-up burglary questions. Interviewer errors in following the skip patterns are therefore avoided, making CAI procedures particularly valuable when the survey involves complex branching and skip patterns.[134] CAI procedures can also be used to control for order effects by having the program rotate the order in which questions or choices are presented.[135] CAI procedures, however, require additional planning to take advantage of the potential for improvements in data quality. When a CAI protocol is used in a survey presented in litigation, the party offering the survey should supply for inspection the computer program that was used to generate the interviews. Moreover, CAI procedures do not eliminate the need for close monitoring of interviews to ensure that interviewers are accurately reading the questions in the interview protocol and accurately entering the answers that the respondent is giving to those questions.

3. Mail surveys

In general, mail surveys tend to be substantially less costly than both in-person and telephone surveys.[136] Although response rates for mail surveys are often low, researchers have obtained 70% response rates in some general public surveys and response rates of over 90% with certain specialized populations.[137] Procedures that encourage high response rates include multiple mailings, highly personalized communications, prepaid return envelopes and incentives or gratuities, assurances of confidentiality, and first-class outgoing postage.[138]

A mail survey will not produce a high rate of return unless it begins with an accurate and up-to-date list of names and addresses for the target population. Even if the sampling frame is adequate, the sample may be unrepresentative if some individuals are more likely to respond than others. For example, if a survey targets a population that includes individuals with literacy problems, these individuals will tend to be underrepresented. Open-ended questions are generally of limited value on a mail survey because they depend entirely on the respondent to answer fully and do not provide the opportunity to probe or clarify

134. Saris, *supra* note 133, at 20, 27.

135. *See, e.g.,* Intel Corp. v. Advanced Micro Devices, Inc., 756 F. Supp. 1292, 1296–97 (N.D. Cal. 1991) (survey designed to test whether the term *386* as applied to a microprocessor was generic used a CATI protocol that tested reactions to five terms presented in rotated order).

136. Don A. Dillman, *Mail and Other Self-Administered Questionnaires*, *in* Handbook of Survey Research, *supra* note 1, at 359, 373.

137. *Id.* at 360.

138. *See, e.g.*, Richard J. Fox et al., *Mail Survey Response Rate: A Meta-Analysis of Selected Techniques for Inducing Response*, 52 Pub. Opinion Q. 467, 482 (1988); Eleanor Singer et al., *Confidentiality Assurances and Response: A Quantitative Review of the Experimental Literature*, 59 Pub. Opinion Q. 66, 71 (1995); Kenneth D. Hopkins & Arlen R. Gullickson, *Response Rates in Survey Research: A Meta-Analysis of the Effects of Monetary Gratuities*, 61 J. Experimental Educ. 52, 54–57, 59 (1992).

unclear answers. Similarly, if eligibility to answer some questions depends on the respondent's answers to previous questions, such skip sequences may be difficult for some respondents to follow. Finally, because respondents complete mail surveys without supervision, survey personnel are unable to prevent respondents from discussing the questions and answers with others before completing the survey and to control the order in which respondents answer the questions. If it is crucial to have respondents answer questions in a particular order, a mail survey cannot be depended on to provide adequate data.[139]

4. Internet surveys

A more recent innovation in survey technology is the Internet survey in which potential respondents are contacted and their responses are collected over the Internet. Internet surveys can substantially reduce the cost of reaching potential respondents and offer some of the advantages of in-person interviews by allowing the computer to show the respondent pictures or lists of response choices in the course of asking the respondent questions. The key limitation is that the respondents accessible over the Internet must fairly represent the relevant population whose responses the survey was designed to measure. Thus, a litigant presenting the results of a web-based survey should be prepared to provide evidence on the potential bias in sampling that the web-based survey is likely to introduce. If the target population consists of computer users, the bias may be minimal. If the target population consists of owners of television sets, significant bias is likely.

V. Surveys Involving Interviewers

A. Were the Interviewers Appropriately Selected and Trained?

A properly defined population or universe, a representative sample, and clear and precise questions can be depended on to produce trustworthy survey results only if "sound interview procedures were followed by competent interviewers."[140] Properly trained interviewers receive detailed written instructions on everything they are to say to respondents, any stimulus materials they are to use in the survey, and how they are to complete the interview form. These instructions should be made available to the opposing party and to the trier of fact. Thus, interviewers should be told, and the interview form on which answers are recorded should indicate, which responses, if any, are to be read to the respondent. Interviewers also should be instructed to record verbatim the respondent's

139. Dillman, *supra* note 136, at 368–70.
140. Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc., 559 F. Supp. 1189, 1205 (E.D.N.Y. 1983).

answers, to indicate explicitly whenever they repeat a question to the respondent, and to record any statements they make to or supplementary questions they ask the respondent.

Interviewers require training to ensure that they are able to follow directions in administering the survey questions. Some training in general interviewing techniques is required for most interviews (e.g., practice in pausing to give the respondent enough time to answer and practice in resisting invitations to express the interviewer's beliefs or opinions). Although procedures vary, one treatise recommends at least five hours of training in general interviewing skills and techniques for new interviewers.[141]

The more complicated the survey instrument is, the more training and experience the interviewers require. Thus, if the interview includes a skip pattern (where, e.g., Questions 4–6 are asked only if the respondent says yes to Question 3, and Questions 8–10 are asked only if the respondent says no to Question 3), interviewers must be trained to follow the pattern. Similarly, if the questions require specific probes to clarify ambiguous responses, interviewers must receive instruction on when to use the probes and what to say. In some surveys, the interviewer is responsible for last-stage sampling (i.e., selecting the particular respondents to be interviewed), and training is especially crucial to avoid interviewer bias in selecting respondents who are easiest to approach or easiest to find.

Training and instruction of interviewers should include directions on the circumstances under which interviews are to take place (e.g., question only one respondent at a time out of the hearing of any other respondent). The trustworthiness of a survey is questionable if there is evidence that some interviews were conducted in a setting in which respondents were likely to have been distracted or in which others were present and could overhear. Such evidence of careless administration of the survey was one ground used by a court to reject as inadmissible a survey that purported to demonstrate consumer confusion.[142]

Some compromises may be accepted when surveys must be conducted swiftly. In trademark and deceptive advertising cases, the plaintiff's usual request is for a preliminary injunction, because a delay means irreparable harm. Nonetheless, careful instruction and training of interviewers who administer the survey and complete disclosure of the methods used for instruction and training are crucial elements that, if compromised, seriously undermine the trustworthiness of any survey.

141. Eve Weinberg, *Data Collection: Planning and Management*, *in* Handbook of Survey Research, *supra* note 1, at 329, 332.

142. *Toys "R" Us*, 559 F. Supp. at 1204 (some interviews apparently were conducted in a bowling alley; some interviewees waiting to be interviewed overheard the substance of the interview while they were waiting).

B. What Did the Interviewers Know About the Survey and Its Sponsorship?

One way to protect the objectivity of survey administration is to avoid telling interviewers who is sponsoring the survey. Interviewers who know the identity of the survey's sponsor may affect results inadvertently by communicating to respondents their expectations or what they believe are the preferred responses of the survey's sponsor. To ensure objectivity in the administration of the survey, it is standard interview practice to conduct double-blind research whenever possible: both the interviewer and the respondent are blind to the sponsor of the survey and its purpose. Thus, the survey instrument should provide no explicit clues (e.g., a sponsor's letterhead appearing on the survey) and no implicit clues (e.g., reversing the usual order of the yes and no response boxes on the interviewer's form next to a crucial question, thereby potentially increasing the likelihood that *no* will be checked[143]) about the sponsorship of the survey or the expected responses.

Nonetheless, in some surveys (e.g., some government surveys), disclosure of the survey's sponsor to respondents (and thus to interviewers) is required. Such surveys call for an evaluation of the likely biases introduced by interviewer or respondent awareness of the survey's sponsorship. In evaluating the consequences of sponsorship awareness, it is important to consider (1) whether the sponsor has views and expectations that are apparent and (2) whether awareness is confined to the interviewers or involves the respondents. For example, if a survey concerning attitudes toward gun control is sponsored by the National Rifle Association, it is clear that responses opposing gun control are likely to be preferred. In contrast, if the survey on gun control attitudes is sponsored by the Department of Justice, the identity of the sponsor may not suggest the kind of responses the sponsor expects or would find acceptable.[144] When interviewers are well trained, their awareness of sponsorship may be a less serious threat than respondents' awareness. The empirical evidence for the effects of interviewers' prior expectations on respondents' answers generally reveals modest effects when the interviewers are well trained.[145]

143. Centaur Communications, Ltd. v. A/S/M Communications, Inc., 652 F. Supp. 1105, 1111 n.3 (S.D.N.Y.) (pointing out that reversing the usual order of response choices, yes or no, to no or yes may confuse interviewers as well as introduce bias), *aff'd*, 830 F.2d 1217 (2d Cir. 1987).

144. *See, e.g.*, Stanley Presser et al., *Survey Sponsorship, Response Rates, and Response Effects*, 73 Soc. Sci. Q. 699, 701 (1992) (different responses to a university-sponsored telephone survey and a newspaper-sponsored survey for questions concerning attitudes toward the mayoral primary, an issue on which the newspaper had taken a position).

145. *See, e.g.*, Seymour Sudman et al., *Modest Expectations: The Effects of Interviewers' Prior Expectations on Responses*, 6 Soc. Methods & Res. 171, 181 (1977).

C. What Procedures Were Used to Ensure and Determine That the Survey Was Administered to Minimize Error and Bias?

Three methods are used to ensure that the survey instrument was implemented in an unbiased fashion and according to instructions. The first, monitoring the interviews as they occur, is done most easily when telephone surveys are used. A supervisor listens to a sample of interviews for each interviewer. Field settings make monitoring more difficult, but evidence that monitoring has occurred provides an additional indication that the survey has been reliably implemented.

Second, validation of interviews occurs when respondents in a sample are recontacted to ask whether the initial interviews took place and to determine whether the respondents were qualified to participate in the survey. The standard procedure for validation of in-person interviews is to telephone a random sample of about 10% to 15% of the respondents.[146] Some attempts to reach the respondent will be unsuccessful, and occasionally a respondent will deny that the interview took place even though it did. Because the information checked is limited to whether the interview took place and whether the respondent was qualified, this validation procedure does not determine whether the initial interview as a whole was conducted properly. Nonetheless, this standard validation technique warns interviewers that their work is being checked and can detect gross failures in the administration of the survey.

A third way to verify that the interviews were conducted properly is to compare the work done by each individual interviewer. By reviewing the interviews and individual responses recorded by each interviewer, researchers can identify any response patterns or inconsistencies for further investigation.

When a survey is conducted at the request of a party for litigation rather than in the normal course of business, a heightened standard for validation checks may be appropriate. Thus, independent validation of at least 50% of interviews by a third party rather than by the field service that conducted the interviews increases the trustworthiness of the survey results.[147]

146. *See, e.g.*, National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 515 (D.N.J. 1986); Davis v. Southern Bell Tel. & Tel. Co., No. 89-2839, 1994 U.S. Dist. LEXIS 13257, at *16 (S.D. Fla. Feb. 1, 1994).

147. In *Rust Environment & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210, 1218 (7th Cir. 1997), the court criticized a survey in part because it "did not comport with accepted practice for independent validation of the results."

VI. Data Entry and Grouping of Responses

A. What Was Done to Ensure That the Data Were Recorded Accurately?

Analyzing the results of a survey requires that the data obtained on each sampled element be recorded, edited, and often coded before the results can be tabulated and processed. Procedures for data entry should include checks for completeness, checks for reliability and accuracy, and rules for resolving inconsistencies. Accurate data entry is maximized when responses are verified by duplicate entry and comparison, and when data entry personnel are unaware of the purposes of the survey.

B. What Was Done to Ensure That the Grouped Data Were Classified Consistently and Accurately?

Coding of answers to open-ended questions requires a detailed set of instructions so that decision standards are clear and responses can be scored consistently and accurately. Two trained coders should independently score the same responses to check for the level of consistency in classifying responses. When the criteria used to categorize verbatim responses are controversial or allegedly inappropriate, those criteria should be sufficiently clear to reveal the source of disagreements. In all cases, the verbatim responses should be available so that they can be recoded using alternative criteria.[148]

148. *See, e.g.*, Coca-Cola Co. v. Tropicana Prods., Inc., 538 F. Supp. 1091, 1094–96 (S.D.N.Y.) (plaintiff's expert stated that respondents' answers to the several open-ended questions revealed that 43% of respondents thought Tropicana was portrayed as fresh squeezed; the court's own tabulation found no more than 15% believed this was true), *rev'd on other grounds*, 690 F.2d 312 (2d Cir. 1982). *See also* McNeilab, Inc. v. American Home Prods. Corp., 501 F. Supp. 517 (S.D.N.Y. 1980); Rock v. Zimmerman, 959 F.2d 1237, 1253 n.9 (3d Cir. 1992) (court found that responses on a change of venue survey incorrectly categorized respondents who believed the defendant was insane as believing he was guilty); Revlon Consumer Prods. Corp. v. Jennifer Leather Broadway, Inc., 858 F. Supp. 1268, 1276 (S.D.N.Y. 1994) (inconsistent scoring and subjective coding led court to find survey so unreliable that it was entitled to no weight), *aff'd*, 57 F.3d 1062 (2d Cir. 1995).

VII. Disclosure and Reporting

A. When Was Information About the Survey Methodology and Results Disclosed?

Objections to the definition of the relevant population, the method of selecting the sample, and the wording of questions generally are raised for the first time when the results of the survey are presented. By that time it is too late to correct methodological deficiencies that could have been addressed in the planning stages of the survey. The plaintiff in a trademark case[149] submitted a set of proposed survey questions to the trial judge, who ruled that the survey results would be admissible at trial while reserving the question of the weight the evidence would be given.[150] The court of appeals called this approach a commendable procedure and suggested that it would have been even more desirable if the parties had "attempt[ed] in good faith to agree upon the questions to be in such a survey."[151]

The *Manual for Complex Litigation, Second,* recommended that parties be required, "before conducting any poll, to provide other parties with an outline of the proposed form and methodology, including the particular questions that will be asked, the introductory statements or instructions that will be given, and other controls to be used in the interrogation process."[152] The parties then were encouraged to attempt to resolve any methodological disagreements before the survey was conducted.[153] Although this passage in the second edition of the manual has been cited with apparent approval,[154] the prior agreement the manual recommends has occurred rarely and the *Manual for Complex Litigation, Third*, recommends, but does not advocate requiring, prior disclosure and discussion of survey plans.[155]

Rule 26 of the Federal Rules of Civil Procedure requires extensive disclosure of the basis of opinions offered by testifying experts. However, these provisions may not produce disclosure of all survey materials, because parties are not obli-

149. Union Carbide Corp. v. Ever-Ready, Inc., 392 F. Supp. 280 (N.D. Ill. 1975), *rev'd*, 531 F.2d 366 (7th Cir.), *cert. denied*, 429 U.S. 830 (1976).

150. Before trial, the presiding judge was appointed to the court of appeals, so the case was tried by another district court judge.

151. *Union Carbide*, 531 F.2d at 386. More recently, the Seventh Circuit recommended the filing of a motion *in limine,* asking the district court to determine the admissibility of a survey based on an examination of the survey questions and the results of a preliminary survey before the party undertakes the expense of conducting the actual survey. Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 929 (7th Cir. 1984).

152. MCL 2d, *supra* note 15, § 21.484.

153. *Id*.

154. *E.g.*, National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 514 n.3 (D.N.J. 1986).

155. MCL 3d, *supra* note 15, § 21.493.

gated to disclose information about nontestifying experts. Parties considering whether to commission or use a survey for litigation are not obligated to present a survey that produces unfavorable results. Prior disclosure of a proposed survey instrument places the party that ultimately would prefer not to present the survey in the position of presenting damaging results or leaving the impression that the results are not being presented because they were unfavorable. Anticipating such a situation, parties do not decide whether an expert will testify until after the results of the survey are available.

Nonetheless, courts are in a position to encourage early disclosure and discussion even if they do not lead to agreement between the parties. In *McNeilab, Inc. v. American Home Products Corp.*,[156] Judge William C. Conner encouraged the parties to submit their survey plans for court approval to ensure their evidentiary value; the plaintiff did so and altered its research plan based on Judge Conner's recommendations. Parties can anticipate that changes consistent with a judicial suggestion are likely to increase the weight given to, or at least the prospects of admissibility of, the survey.[157]

B. Does the Survey Report Include Complete and Detailed Information on All Relevant Characteristics?

The completeness of the survey report is one indicator of the trustworthiness of the survey and the professionalism of the expert who is presenting the results of the survey. A survey report generally should provide in detail

1. the purpose of the survey;
2. a definition of the target population and a description of the population that was actually sampled;
3. a description of the sample design, including the method of selecting respondents, the method of interview, the number of callbacks, respondent eligibility or screening criteria, and other pertinent information;
4. a description of the results of sample implementation, including (a) the number of potential respondents contacted, (b) the number not reached, (c) the number of refusals, (d) the number of incomplete interviews or terminations, (e) the number of noneligibles, and (f) the number of completed interviews;
5. the exact wording of the questions used, including a copy of each version of the actual questionnaire, interviewer instructions, and visual exhibits;
6. a description of any special scoring (e.g., grouping of verbatim responses into broader categories);

156. 848 F.2d 34, 36 (2d Cir. 1988) (discussing with approval the actions of the district court).

157. Larry C. Jones, *Developing and Using Survey Evidence in Trademark Litigation*, 19 Memphis St. U. L. Rev. 471, 481 (1989).

7. estimates of the sampling error, where appropriate (i.e., in probability samples);
8. statistical tables clearly labeled and identified as to source of data, including the number of raw cases forming the base for each table, row, or column; and
9. copies of interviewer instructions, validation results, and code books.[158]

A description of the procedures and results of pilot testing is not included on this list. Survey professionals generally do not describe pilot testing in their reports. The Federal Rules of Civil Procedure, however, may require that a testifying expert disclose pilot work that serves as a basis for the expert's opinion. The situation is more complicated when a nontestifying expert conducts the pilot work and the testifying expert learns about the pilot testing only indirectly through the attorney's advice about the relevant issues in the case. Some commentators suggest that attorneys are obligated to disclose such pilot work.[159]

C. In Surveys of Individuals, What Measures Were Taken to Protect the Identities of Individual Respondents?

The respondents questioned in a survey generally do not testify in legal proceedings and are unavailable for cross-examination. Indeed, one of the advantages of a survey is that it avoids a repetitious and unrepresentative parade of witnesses. To verify that interviews occurred with qualified respondents, standard survey practice includes validation procedures,[160] the results of which should be included in the survey report.

Conflicts may arise when an opposing party asks for survey respondents' names and addresses in order to reinterview some respondents. The party introducing the survey or the survey organization that conducted the research generally resists supplying such information.[161] Professional surveyors as a rule guarantee

158. These criteria were adapted from the Council of Am. Survey Res. Orgs., *supra* note 41, § III. B. Failure to supply this information substantially impairs a court's ability to evaluate a survey. *In re* Prudential Ins. Co. of Am. Sales Practices Litig., 962 F. Supp. 450, 532 (D.N.J. 1997) (citing the first edition of this manual). *But see Florida Bar v. Went for It, Inc.*, 515 U.S. 618, 626–28 (1995), in which a majority of the Supreme Court relied on a summary of results prepared by the Florida Bar from a consumer survey purporting to show consumer objections to attorney solicitation by mail. In a strong dissent, Justice Kennedy, joined by three of his colleagues, found the survey inadequate based on the document available to the court, pointing out that the summary included "no actual surveys, few indications of sample size or selection procedures, no explanations of methodology, and no discussion of excluded results . . . no description of the statistical universe or scientific framework that permits any productive use of the information the so-called Summary of Record contains." *Id.* at 640.

159. Yvonne C. Schroeder, *Pretesting Survey Questions*, 11 Am. J. Trial Advoc. 195, 197–201 (1987).

160. *See supra* § V.C.

161. *See, e.g.*, Alpo Petfoods, Inc. v. Ralston Purina Co., 720 F. Supp. 194 (D.D.C. 1989), *aff'd in part & vacated in part*, 913 F.2d 958 (D.C. Cir. 1990).

confidentiality in an effort to increase participation rates and to encourage candid responses. Because failure to extend confidentiality may bias both the willingness of potential respondents to participate in a survey and their responses, the professional standards for survey researchers generally prohibit disclosure of respondents' identities. "The use of survey results in a legal proceeding does not relieve the Survey Research Organization of its ethical obligation to maintain in confidence all Respondent-identifiable information or lessen the importance of Respondent anonymity."[162] Although no surveyor–respondent privilege currently is recognized, the need for surveys and the availability of other means to examine and ensure their trustworthiness argue for deference to legitimate claims for confidentiality in order to avoid seriously compromising the ability of surveys to produce accurate information.[163]

Copies of all questionnaires should be made available upon request so that the opposing party has an opportunity to evaluate the raw data. All identifying information, such as the respondent's name, address, and telephone number, should be removed to ensure respondent confidentiality.

162. Council of Am. Survey Res. Orgs., *supra* note 41, § I.A.3.f. Similar provisions are contained in the By-Laws of the American Association for Public Opinion Research.

163. Litton Indus., Inc., No. 9123, 1979 FTC LEXIS 311, at *13 & n.12 (June 19, 1979) (Order Concerning the Identification of Individual Survey-Respondents with Their Questionnaires) (citing Frederick H. Boness & John F. Cordes, Note, *The Researcher–Subject Relationship: The Need for Protection and a Model Statute*, 62 Geo. L.J. 243, 253 (1973)). *See also* Lampshire v. Procter & Gamble Co., 94 F.R.D. 58, 60 (N.D. Ga. 1982) (defendant denied access to personal identifying information about women involved in studies by the Centers for Disease Control based on Fed. R. Civ. P. 26(c) giving court the authority to enter "any order which justice requires to protect a party or persons from annoyance, embarrassment, oppression, or undue burden or expense.") (citation omitted).

Glossary of Terms

The following terms and definitions were adapted from a variety of sources, including Handbook of Survey Research (Peter H. Rossi et al. eds., 1983); 1 Environmental Protection Agency, Survey Management Handbook (1983); Measurement Errors in Surveys (Paul P. Biemer et al. eds., 1991); William E. Saris, Computer-Assisted Interviewing (1991); Seymour Sudman, Applied Sampling (1976).

branching. A questionnaire structure that uses the answers to earlier questions to determine which set of additional questions should be asked (e.g., citizens who report having served as jurors on a criminal case are asked different questions about their experiences than citizens who report having served as jurors on a civil case).

CAI (computer-assisted interviewing). A method of conducting interviews in which an interviewer asks questions and records the respondent's answer by following a computer-generated protocol.

CATI (computer-assisted telephone interviewing). A method of conducting telephone interviews in which an interviewer asks questions and records the respondent's answer by following a computer-generated protocol.

closed-ended question. A question that provides the respondent with a list of choices and asks the respondent to choose from among them.

cluster sampling. A sampling technique allowing for the selection of sample elements in groups or clusters, rather than on an individual basis; it may significantly reduce field costs and may increase sampling error if elements in the same cluster are more similar to one another than are elements in different clusters.

confidence interval. An indication of the probable range of error associated with a sample value obtained from a probability sample. Also, margin of error.

convenience sample. A sample of elements selected because they were readily available.

double-blind research. Research in which the respondent and the interviewer are not given information that will alert them to the anticipated or preferred pattern of response.

error score. The degree of measurement error in an observed score (see true score).

full-filter question. A question asked of respondents to screen out those who do not have an opinion on the issue under investigation before asking them the question proper.

mall intercept survey. A survey conducted in a mall or shopping center in which potential respondents are approached by a recruiter (intercepted) and invited to participate in the survey.

multistage sampling design. A sampling design in which sampling takes place in several stages, beginning with larger units (e.g., cities) and then proceeding with smaller units (e.g., households or individuals within these units).

nonprobability sample. Any sample that does not qualify as a probability sample.

open-ended question. A question that requires the respondent to formulate his or her own response.

order effect. A tendency of respondents to choose an item based in part on the order in which it appears in the question, questionnaire, or interview (see primacy effect and recency effect); also referred to as a context effect because the context of the question influences the way the respondent perceives and answers it.

parameter. A summary measure of a characteristic of a population (e.g., average age, proportion of households in an area owning a computer). Statistics are estimates of parameters.

pilot test. A small field test replicating the field procedures planned for the full-scale survey; although the terms *pilot test* and *pretest* are sometimes used interchangeably, a pretest tests the questionnaire, whereas a pilot test generally tests proposed collection procedures as well.

population. The totality of elements (objects, individuals, or other social units) that have some common property of interest; the target population is the collection of elements that the researcher would like to study; the survey population is the population that is actually sampled and for which data may be obtained. Also, universe.

population value, population parameter. The actual value of some characteristic in the population (e.g., the average age); the population value is estimated by taking a random sample from the population and computing the corresponding sample value.

pretest. A small preliminary test of a survey questionnaire. See pilot test.

primacy effect. A tendency of respondents to choose early items from a list of choices; the opposite of a recency effect.

probability sample. A type of sample selected so that every element in the population has a known nonzero probability of being included in the sample; a simple random sample is a probability sample.

probe. A follow-up question that an interviewer asks to obtain a more complete answer from a respondent (e.g., "Anything else?" "What kind of medical problem do you mean?").

quasi-filter question. A question that offers a "don't know" or "no opinion" option to respondents as part of a set of response alternatives; used to screen out respondents who may not have an opinion on the issue under investigation.

random sample. See simple random sample.

recency effect. A tendency of respondents to choose later items from a list of choices; the opposite of a primacy effect.

sample. A subset of a population or universe selected so as to yield information about the population as a whole.

sampling error. The estimated size of the difference between the result obtained from a sample study and the result that would be obtained by attempting a complete study of all units in the sampling frame from which the sample was selected in the same manner and with the same care.

sampling frame. The source or sources from which the objects, individuals, or other social units in a sample are drawn.

secondary meaning. A descriptive term that becomes protectable as a trademark if it signifies to the purchasing public that the product comes from a single producer or source.

simple random sample. The most basic type of probability sample; each unit in the population has an equal probability of being in the sample, and all possible samples of a given size are equally likely to be selected.

skip pattern, skip sequence. A sequence of questions in which some should not be asked (should be skipped) based on the respondent's answer to a previous question (e.g., if the respondent indicates that he does not own a car, he should not be asked what brand of car he owns).

stratified sampling. A sampling technique that permits the researcher to subdivide the population into mutually exclusive and exhaustive subpopulations, or strata; within these strata, separate samples are selected; results can be combined to form overall population estimates or used to report separate within-stratum estimates.

survey population. See population.

systematic sampling. A sampling technique that consists of a random starting point and the selection of every *n*th member of the population; it generally produces the same results as simple random sampling.

target population. See population.

trade dress. A distinctive and nonfunctional design of a package or product protected under state unfair competition law and the federal Lanham Act §43(a), 15 U.S.C. §1125(a) (1946) (amended 1992).

true score. The underlying true value, which is unobservable because there is always some error in measurement; the observed score = true score + error score.

universe. See population.

References on Survey Research

William G. Cochran, Sampling Techniques (3d ed. 1977).

Jean M. Converse & Stanley Presser, Survey Questions: Handcrafting the Standardized Questionnaire (1986).

Thomas D. Cook & Donald T. Campbell, Quasi-Experimentation: Design and Analysis Issues for Field Settings (1979).

Shari S. Diamond, *Methods for the Empirical Study of Law*, *in* Law and the Social Sciences (Leon Lipson & Stanton Wheeler eds., 1986).

Floyd J. Fowler, Survey Research Methods (2d ed. 1984).

Robert M. Groves & Robert L. Kahn, Surveys by Telephone: A National Comparison with Personal Interviews (1979).

Handbook of Survey Research (Peter H. Rossi et al. eds., 1983).

Leslie Kish, Survey Sampling (1965).

Measurement Errors in Surveys (Paul P. Biemer et al. eds., 1991).

Questions About Questions: Inquiries into the Cognitive Bases of Surveys (Judith M. Tanur ed., 1992).

Howard Schuman & Stanley Presser, Questions and Answers in Attitude Surveys: Experiments on Question Form, Wording and Context (1981).

Seymour Sudman, Applied Sampling (1976).

Seymour Sudman & Norman M. Bradburn, Response Effects in Surveys: A Review and Synthesis (1974).

Telephone Survey Methodology (Robert M. Groves et al. eds., 1988).

McCarthy on Trademarks and Unfair Competition, Fourth Edition

Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:158. Introduction to survey evidence

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Surveying Customer Perception. In cases of trademark infringement, unfair competition and false advertising, the subjective mental associations and reactions of prospective purchasers are often an issue. Evidence of such mental associations may consist of evidence as to the quantity and quality of advertising coverage, testimony of dealers and consumers, testimony of experts in the field,[FN1] or merely an appeal to the subjective impressions of the trier of fact.[FN2] However, a more scientific means of evidencing mental associations is to introduce the actual responses of a group of people who are typical of the target group whose perceptions are at issue in a case. Survey evidence is often introduced for this purpose and a large body of legal literature has developed around the subject.[FN3]

Issues Provable by Survey Evidence. Surveys as to the state of mind of the relevant customer group or others have been offered as evidence of the existence of secondary meaning in a mark,[FN4] of the existence of a likelihood of confusion,[FN5] or of both elements in one case.[FN6] Surveys have been offered to prove that a famous mark has been diluted under an anti-dilution statute.[FN7] Surveys have also been offered to prove that prospective purchasers regard a given trade symbol as a trademark indicating origin, rather than a generic term and vice-versa.[FN8] In false advertising cases, proof of what an advertisement means to the general public is often made by way of a reliable consumer survey.[FN9] The Federal Judicial Center has noted that surveys and polls are admissible evidence in many types of cases.[FN10] As the Second Circuit observed: "Surveys are, for example, routinely admitted in trademark and false advertising cases to show actual confusion, genericness of a name or secondary meaning, all of which depend on establishing that certain associations have been drawn in the public mind."[FN11]

The* Daubert-Kumho *Test: The Court as Gatekeeper. The Supreme Court in the 1993 *Daubert* case held that a court analyzing the admissibility of scientific opinion testimony under Federal Rule of Evidence 702 must

ensure that the testimony is based on scientifically valid principles and is relevant to the facts of the case.[FN12] The Supreme Court in *Kumho Tire* later expanded the *Daubert* rule to all types of expert testimony and emphasized that a trial judge has a "basic gatekeeping obligation" to ensure that expert testimony is both relevant and reliable:

> [T]his is not to deny the importance of *Daubert's* gatekeeping requirement. The objective of that requirement is to ensure the reliability and relevancy of expert testimony. It is to make certain that an expert, whether basing testimony upon professional studies or personal experience, employs in the courtroom the same level of intellectual rigor that characterizes the practice of an expert in the relevant field.[FN13]

The Ninth Circuit has said that, ordinarily, survey evidence should be found sufficiently reliable and admissible under the test in *Daubert*.[FN14] However, there is no doubt that a trial court, in the exercise of its "gatekeeping function" may, in an appropriate case, exclude a survey report from being received into evidence.[FN15] Similarly, an appellate court can find that the district court abused its discretion by placing reliance on a deficient survey.[FN16] For example, if the person who designed the survey does not qualify as an expert, then the survey is properly not allowed into evidence.[FN 17]

In 2000, Federal Rule of Evidence 702 was amended to embody some of the principles of the *Daubert* and *Kumho* cases:

> F.R.E. 702: If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.[FN18]

Plevan has commented that "the *Daubert* era has given Lanham Act litigators a greater opportunity to challenge an opponent's survey evidence in the advance of a trial, particularly a jury trial."[FN19]

The Battle of the Experts. The usual procedure is for one of the parties to the litigation to hire a survey taker to run an appropriate survey. The survey expert for the opponent may then attack the substance and form of the other side's survey and/or counter it with a different survey producing different results. Then ensues the "battle of the experts," a process that takes place in many trials of all kinds. Judge Posner has suggested that each party's survey expert be asked by the court to designate a third, neutral expert who would be appointed by the court to conduct surveys.[FN20] In another case, a survey was jointly designed and executed by the experts for each side, with the experts taking different views as to the proper interpretation of the survey results.[FN21] If one side takes a survey, often the other side will do so too, hoping to present the court with offsetting data to nullify the impact of the first survey.[FN22]

As Weiss wryly remarked: "One might sum it all up by saying that the function of surveys in trademark litigation is to plumb the minds of the public in order to make up the minds of the judges."[FN23]

[FN1] *See, e.g.,* Yamaha International Corp. v. Hoshino Gakki Co., 231 U.S.P.Q. 926, 1986 WL 83747

(T.T.A.B. 1986), aff'd, 840 F.2d 1572, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988) (The Board held admissible, but gave only "modest weight," to the opinion testimony of experts in the making and playing of guitars. The testimony was that guitar buyers perceive the head shape as source identifying and not merely ornamental. The experts were qualified because of a "lifetime of observation and experience." The Federal Circuit held that a Board decision to admit expert testimony will not be basis for reversal unless "manifestly erroneous.").

[FN2] *See* § 23:90.

[FN3] *See, generally,* Note, "Consumer Polls as Evidence in Unfair Trade Cases," 20 Geo. Wash. L. Rev. 211 (1951); Note, "Public Opinion Surveys as Evidence: The Pollsters Go to Court," 66 Harv. L. Rev. 498 (1953); Sorensen & Sorensen, "The Admissibility and Use of Opinion Research Evidence," 28 N.Y.U. L.Q. 1213 (1953); Caughey, "The Use of Public Polls, Surveys and Sampling as Evidence in Litigation, and Particularly Trademark and Unfair Competition Cases," 44 Cal. L. Rev. 539 (1956); Barksdale, The Use of Survey Research Findings as Legal Evidence (1957); Shryock, "Survey Evidence in Contested Trademark Cases," 57 Trademark Rep. 377 (1967); Symposium, "The Structure and Uses of Survey Evidence in Trademark Cases," 67 Trademark Rep. 97 (1977); Sorensen, "The Use of Survey Evidence in Trademark Law & Unfair Competition," in PLI Current Developments in Trademark Law 71 (1978); Jacobs, "Survey Evidence in Trademark and Unfair Competition Litigation," 6 A.L.I.-A.B.A. Course Mat'ls 97 (1982); Symposium containing six articles on trademark surveys, 73 Trademark Rep. 4 (1983); Evans & Gunn, "Trademark Surveys," 79 Trademark Rep. 1 (1988); Weiss, "The Use of Survey Evidence in Trademark Litigation: Science, Art or Confidence Game?," 80 Trademark Rep. 71, 86 (1990); Jacoby & Handlin, "nonprobability Sampling Designs for Litigation Surveys," 81 Trademark Rep. 169 (1991); Bird, "Streamlining Consumer Survey Analysis: An Examination of the Concept of Universe in Consumer Surveys Offered in Intellectual Property Litigation," 88 Trademark Rep. 269 (1998); V.N. Palladino, Secondary Meaning Surveys in Light of Lund, 91 Trademark Rptr 573 (2001); W.W. Vodra & R.K. Miller, "Did He Really Say That?" Survey Evidence in Deceptive Advertising Litigation, 92 Trademark Rptr 794 (2002); V.N. Palladino, Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys, 92 Trademark Rptr 857 (2002); J. Jacoby, Experimental Design and Selection of Controls in Trademark and Deceptive Advertising Surveys, 92 Trademark Rptr 890 (2002); M. Rappeport, Litigation Surveys: Social Science as Evidence, 92 Trademark Rptr 957 (2002).

See Annotation, "Admissibility and Weight of Surveys or Polls of Public or Consumers' Opinion, Recognition, Preference or the Like," 76 A.L.R.2d 619; Annotation, "Admissibility and weight of consumer survey in litigation under trademark opposition, trademark infringement, and false designation of origin provisions of Lanham Act (15 U.S.C.A. §§ 1063, 1114, and 1125)," 98 A.L.R. Fed. 20.

[FN4] *See, e.g.,* Laskowitz v. Marie Designer, Inc., 119 F. Supp. 541, 100 U.S.P.Q. 367 (D. Cal. 1954) (secondary meaning in descriptive term proven by survey evidence); Marcalus Mfg. Co. v. Watson, 156 F. Supp. 161, 115 U.S.P.Q. 232 (D.D.C. 1957), aff'd, 258 F.2d 151, 118 U.S.P.Q. 7 (D.C. Cir. 1958) (secondary meaning in red oval used as background for word mark not proven by survey evidence); Anheuser-Busch, Inc. v. Bavarian Brewing Co., 264 F.2d 88, 84 Ohio L. Abs. 97, 120 U.S.P.Q. 420 (6th Cir. 1959) (survey relied upon to find secondary meaning); Roselux Chemical Co. v. Parsons Ammonia Co., 299 F.2d 855, 132 U.S.P.Q. 627 (C.C.P.A. 1962) (secondary meaning not proven by survey data); In re Riviana Foods, Inc., 160 U.S.P.Q. 757, 1969 WL 9021 (T.T.A.B. 1969) (secondary meaning not

proven by survey); Federal Glass Co. v. Corning Glass Works, 162 U.S.P.Q. 279, 1969 WL 9105 (T.T.A.B. 1969); In re Levi Strauss & Co., 165 U.S.P.Q. 348, (T.T.A.B. 1970) (secondary meaning proven in pocket tab as mark for LEVIS); Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976); Monsieur Henri Wines, Ltd. v. Duran, 204 U.S.P.Q. 601, 1979 WL 24898 (T.T.A.B. 1979); Harlequin Enterprises, Ltd. v. Gulf & Western Corp., 644 F.2d 946, 210 U.S.P.Q. 1 (2d Cir. 1981); Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989) (survey supported finding of secondary meaning in logo for sportswear).

See §§ 15:28 to 15:31, 32:190 to 32:191.

[FN5] *See, e.g.,* Standard Oil Co. v. Standard Oil Co., 252 F.2d 65, 116 U.S.P.Q. 176 (10th Cir. 1958); Jenkins Bros. v. Newman Hender & Co., 289 F.2d 675, 129 U.S.P.Q. 355 (C.C.P.A. 1961); James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555 (7th Cir. 1976); Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500, 208 U.S.P.Q. 384 (5th Cir. 1980); Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984) (45% confusion results are "high" and a factor "weighing strongly" in support of a likelihood of confusion); McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1 U.S.P.Q.2d 1761 (S.D.N.Y. 1986) (25% level supports finding of likely confusion); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 5 U.S.P.Q.2d 1314 (8th Cir. 1987), cert. denied, 488 U.S. 933, 102 L. Ed. 2d 344, 109 S. Ct. 326 (1988).

See §§ 32:184 to 32:189.

[FN6] *See, e.g.,* American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958) (neither proven by survey); Ronson Corp. v. Maruman of California, Inc., 224 F. Supp. 479, 139 U.S.P.Q. 436 (S.D. Cal. 1963) (survey evidence held to prove both); Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963); Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 167 U.S.P.Q. 713 (9th Cir. 1970); Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976) (both proven); National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175 (W.D. Wash. 1982) (both proven).

[FN7] *See* Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 50 U.S.P.Q.2d 1065 (4th Cir. 1999) (survey evidence did not support claim of dilution). *See* § 24:94.10.

[FN8] *See* §§ 12:14 to 12:17 for discussion of types of surveys used in generic vs. trademark disputes.

[FN9] *See, e.g.,* Rhodes Pharmacal Co. v. Federal Trade Comm'n, 208 F.2d 382 (7th Cir. 1953), rev'd, in part, 348 U.S. 940, 99 L. Ed. 736, 75 S. Ct. 361 (1955); American Brands, Inc. v. R. J. Reynolds Tobacco Co., 413 F. Supp. 1352 (S.D.N.Y. 1976) (no consumer surveys introduced: claims dismissed); American Home Products Corp. v. Johnson & Johnson, 436 F. Supp. 785, 196 U.S.P.Q. 484 (S.D.N.Y. 1977), aff'd, 577 F.2d 160, 198 U.S.P.Q. 132 (2d Cir. 1978); U-Haul International, Inc. v. Jartran, Inc., 522 F. Supp. 1238, 212 U.S.P.Q. 49 (D. Ariz. 1981), aff'd, 681 F.2d 1159, 216 U.S.P.Q. 1077 (9th Cir. 1982).

See discussion at §§ 27:24 to 27:39 for the need for surveys in false advertising cases. *See also* § 32:193.

[FN10] Federal Judicial Center, *Manual for Complex Litigation* 114-15 (5th ed. 1981) ("[P]olls have been held admissible to prove statements of interviewees as evidence of state of mind in unfair competition and antitrust cases."). The *Manual for Complex Litigation*, Third § 21.493, pp. 101-103 (1995), contains a highly truncated reference to survey evidence as compared to the 1981 edition. The Federal Judicial Center's 2000 Second Edition of the Reference Manual on Scientific Evidence, contains a useful article by Prof. S.E. Diamond describing survey evidence and its proper use. Reference Manual on Scientific Evidence, pp. 229–276 (Federal Judicial Center 2d ed. 2000). This manual can be found on Westlaw under the database identifier RMSCIEVID.

[FN11] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705 (2d Cir. 1999).

[FN12] Daubert v. Merrell Dow Pharmaceuticals, Inc., 509 U.S. 579, 113 S. Ct. 2786, 2796-99, 27 U.S.P.Q.2d 200 (1993).

[FN13] Kumho Tire Co. v. Carmichael, 526 U.S. 137, 119 S. Ct. 1167, 50 U.S.P.Q.2d 1177 (1999). *see* Weisgram v. Marley Co., 528 U.S. 440, 455, 120 S. Ct. 1011, 1021, 145 L. Ed. 2d 958, Prod. Liab. Rep. (CCH) P 15745, 53 Fed. R. Evid. Serv. 406, 45 Fed. R. Serv. 3d 735 (2000) ("Since *Daubert*, moreover, parties relying on expert evidence have had notice of the exacting standards of reliability such evidence must meet.").

[FN14] Southland Sod Farms v. Stover Seed Co., 108 F.3d 1134, n.8, 42 U.S.P.Q.2d 1097, n.8 (9th Cir. 1997) ("However, 'as long as they are conducted according to accepted principles,' … survey evidence should ordinarily be found sufficiently reliable under *Daubert*. Unlike novel scientific theories, a jury should be able to determine whether asserted technical deficiencies undermine a survey's probative value. Defendants have not demonstrated that the survey was not conducted according to accepted principles.").

[FN15] National Football League Properties, Inc. v. Prostyle, Inc., 57 F. Supp. 2d 665, 668-670 (E.D. Wisc. 1998) (a survey report was excluded from evidence because, among other reasons, survey failed to have a control); Mastercard Intern. Inc. v. First Nat. Bank of Omaha, Inc., 2004 WL 326708 (S.D. N.Y. 2004), related reference, 2004 WL 1575396 (S.D. N.Y. 2004) (survey was excluded from evidence in a jury trial because of small sample size and variance from actual purchasing conditions. "The flaws in the Survey diminish its relevance in predicting actual confusion among FNBO customers such that the potential for the Survey's results to prejudice unfairly, to confuse, and to mislead the jury substantially outweighs any limited relevance."). *See* K.A. Plevan, Daubert's Impact on Survey Experts in Lanham Act Litigation, 95 Trademark Rptr. 596 (2005) (Of the 44 cases over an eight year period (1997–2004) that were examined, in 14 cases surveys were excluded from evidence or accorded no weight at all. In all 14 cases a jury trial had been demanded, generally by the party offering the survey evidence.).

[FN16] Scotts Co. v. United Industries Corp., 315 F.3d 264, 65 U.S.P.Q.2d 1161, 2002-2 Trade Cas. (CCH) P 73911, 60 Fed. R. Evid. Serv. 330 (4th Cir. 2002) (The district court abused its discretion by placing reliance on a survey that suffered several deficiencies of form and substance.).

[FN 17] M2 Software, Inc., a Delaware corporation v. Madacy Entertainment, a corporation, 421 F.3d 1073, 76 U.S.P.Q.2d 1161, 1171 (9th Cir. 2005), cert. denied, 126 S. Ct. 1772, 164 L. Ed. 2d 516 (U.S. 2006).

[FN18] *See* Advisory Committee Notes on the Dec. 1, 2000 amendment to Rule 702.

[FN19] K.A. Plevan, Daubert's Impact on Survey Experts in Lanham Act Litigation, 95 Trademark Rptr. 596, 597 (2005).

[FN20] Indianapolis Colts v. Metropolitan Baltimore Football Club Ltd. Partnership, 34 F.3d 410, 414-15, 31 U.S.P.Q.2d 1811, 1815 (7th Cir. 1994). *See* Welter, "A Call to Improve Trademark Survey Evidence," 85 Trademark Rep. 205 (1995) (commenting on Posner's proposal and suggesting an alternative under which the court simply appoints one survey expert from a list submitted by the parties); Rappeport, "The Role of the Survey 'Expert': A Response to Judge Posner," 85 Trademark Rep. 211, 217 (1995) ("Because their job is to test hypotheses that grow out of specific theories of cases, and because opposing lawyers typically develop quite different theories of the same case, it is completely natural that there are often totally different surveys with totally different results.").

[FN21] SunAmerica Corp. v. Sun Life Assurance Co. of Can., 890 F. Supp. 1559, 33 U.S.P.Q.2d 1865, 1872 (N.D. Ga. 1994), aff'd on liability and remanded on remedy, 77 F.3d 1325, 38 U.S.P.Q.2d 1065 (11th Cir. 1996).

[FN22] *See, e.g.*, Classic Foods International Corp. v. Kettle Foods, Inc., 468 F. Supp. 2d 1181, 1193 (C.D. Cal. 2007) (Both sides took a survey in a genericness dispute. The court thought that they were offsetting. "[T]he survey evidence presented by KFI is essentially in equipoise with that offered by CFI, and is of only limited evidentiary value.").

[FN23] Weiss, "The Use of Survey Evidence in Trademark Litigation: Science, Art or Confidence Game?" 80 Trademark Rep. 71, 86 (1990).

MCCARTHY § 32:158

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:159. Relevant "universe" surveyed—Defining the universe

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The first step in designing a survey is to determine the "universe" to be studied. The universe is that segment of the population whose perceptions and state of mind are relevant to the issues in the case.[FN1] Selection of the proper universe is a crucial step, for even if the proper questions are asked in a proper manner, if the wrong persons are asked, the results are likely to be irrelevant.[FN2] Once the "universe" is selected, a sample to be surveyed is selected from that universe. A "census" involves questioning each and every member of the universe, but a "survey" involves taking a "sample" by selecting some subset of the universe, and questioning persons in that subset. The sample selected may be a probability sample or a nonprobability sample.[FN3] While each type of sample can reasonably be projected to the universe at large, only a prob ability sample can be projected to the entire universe by the use of definite mathematical and statistical probability models.

In a traditional case claiming "forward" confusion, not "reverse" confusion, the proper universe to survey is the potential buyers of the *junior user's* goods or services.[FN4] However, in a "reverse confusion" case, it is appropriate to survey the senior user's customer base.[FN5]

The universe may be narrowed from the population at large in various ways: geographically (people living in California); commercially (retail dealers or consumers); according to buying habits (prospective purchasers of pleasure boats); or by any other meaningful criteria which the law sets down as limiting or defining the class of persons whose state of mind is at issue.[FN6] A survey of the wrong "universe" will be of little probative value in litigation.[FN7]

A survey is really an attempt to derive from a part of the universe, facts which can be reasonably expected to apply to the entire universe. If a probability sample survey is fairly and scientifically conducted, its results are capable of being projected as evidence of the state of mind of the whole "universe" of prospective purchasers in issue. For example, if the "universe" constitutes some 200 million American potential consumers, if the survey

is accurate, it should produce data from which one can reasonably predict what the results would be if each member of the total "universe" were questioned in a census.[FN8]

The Federal Judicial Center Manual for Complex Litigation notes that the burden is on the proponent of the survey to show that the sampling of the universe conforms with recognized statistical standards:

> [T]he reliability and validity of estimates about the population derived from sampling are critical. The methods used must conform to generally recognized statistical standards. Relevant factors include whether:
> • The population was properly chosen and defined;
> • The sample chosen was representative of that population;
> • The data gathered were accurately reported;
> • The data were analyzed in accordance with accepted statical principles.
>
> Laying the foundation for such evidence will ordinarily involve expert testimony and, along with disclose of the underlying data and documentation, should be taken up by the court well in advance of trial.[FN9]

The Federal Judicial Center's 2000 Reference Manual on Scientific Evidence emphasizes that: "A survey that provides information about a wholly irrelevant universe of respondents is itself irrelevant … . More commonly, however, the sampling frame is either underinclusive or overinclusive relative to the target population."[FN10]

Bird has suggested that determination of the proper uni verse be treated as an issue of law to be settled by the judge before the litigants take their surveys.[FN11]

[FN1] *See* Note, "Public Opinion Surveys as Evidence: The Pollsters Go to Court," 66 Harv. L. Rev. 498 (1953); Reiner, "The Universe and Sample: How Good Is Good Enough?" 73 Trademark Rep. 366 (1983); Jacoby, "Survey & Field Experimental Evidence," at 179 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985); Jacoby & Handlin, "nonprobability Sampling Designs for Litigation Surveys," 81 Trademark Rep. 169, 170 (1991) ("In scientific parlance, a 'universe' (sometimes also called a 'population') is defined as the totality of all individuals (or elements) possessing a particular trait or feature in common.").

[FN2] *See* Bird, "Streamlining Consumer Survey Analysis: An Examination of the Concept of Universe in Consumer Surveys Offered in Intellectual Property Litigation," 88 Trademark Rep. 269, 276 (1998) ("Determination of the universe represents one of the most significant challenges a survey expert will face in drafting a consumer survey. A misaligned universe can doom otherwise competent research and trigger an adverse decision by the court."); Evans & Gunn, "Trademark Surveys," 79 Trademark Rep. 1, 31 (1988) ("Errors in this stage [of selecting the universe] are more likely to prove fatal than errors in the content of the questions, for there is some value in a slanted question asked of the right witness, but no value in asking the right question of the wrong witness.").

[FN3] *See* Jacoby, "Survey & Field Experimental Evidence," at 182 in Kassin & Wrightsman, *The Psy-*

chology of Evidence and Trial Procedure (1985) ("Probability sampling involves the random selection of elements (e.g. people) from the universe, where each element has a known probability of being selected."). *See* discussion at §§ 32:164 to 32:165.

[FN4] Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 559-60 (S.D.N.Y. 1991) ("It is well-settled in this circuit that the universe of the survey must include potential purchasers of the junior user's product." A survey of only potential users of the senior user's product was held improper.); Paco Sport, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305, 54 U.S.P.Q.2d 1205 (S.D. N.Y. 2000), aff'd without opinion, 234 F.3d 1262 (2d Cir. 2000) (in a case of "forward confusion," the proper universe to survey is composed of purchasers of the junior user's goods); Big Dog Motorcycles, L.L.C. v. Big Dog Holdings, Inc., 402 F. Supp. 2d 1312, 79 U.S.P.Q.2d 1187 (D. Kan. 2005) (survey of prospective buyers of all t-shirts and caps was too broad a universe because it was not limited to prospective buyers from the junior user: those who would be likely to buy t-shirts and caps at motorcycle dealerships. Survey results were disregarded.). Regarding the difference between "forward" and "reverse" confusion *see* §

[FN5] Sterling Drug, Inc. v. Bayer AG, 14 F.3d 733, 29 U.S.P.Q.2d 1321, 1326 (2d Cir. 1994) (the court, finding a likelihood of confusion, said that since the issue is whether the senior user's products, such as BAYER aspirin, are perceived to be made by the junior user, it is appropriate to survey customers of the senior user's BAYER aspirin product); Citizens Financial Group, Inc. v. Citizens Nat. Bank of Evans City, 383 F.3d 110, 121, 72 U.S.P.Q.2d 1389, 65 Fed. R. Evid. Serv. 350 (3d Cir. 2004), cert. denied, 544 U.S. 1018, 125 S. Ct. 1975, 161 L. Ed. 2d 857 (2005) ("The court should limit survey evidence in reverse confusion cases to the customers of the senior user.").

[FN6] *See, e.g.,* International Milling Co. v. Robin Hood Popcorn Co., 110 U.S.P.Q. 368, 1956 WL 8002 (Comm'r Pat. 1956) (survey of 513 householders in Minneapolis); Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963) (all American smokers over 18); In re Riviana Foods, Inc., 160 U.S.P.Q. 757, 1969 WL 9021 (T.T.A.B. 1969) (survey of veterinarians); In re Levi Strauss & Co., 165 U.S.P.Q. 348, (T.T.A.B. 1970) (survey of "young people" who are prospective buyers of LEVIS); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, n.6, 4 U.S.P.Q.2d 1497 (10th Cir. 1987) (proper universe for confusion survey relating to appearance of fishing reel was persons over 14 who had fished in fresh water in the last 12 months).

[FN7] National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175, 180 (W.D. Wash. 1982).

[FN8] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963); Astatic Corp. v. American Electronics, Inc., 201 U.S.P.Q. 411, 1978 WL 21384 (N.D. Ohio 1978).

[FN9] *The Manual for Complex Litigation*, Third § 21.493, p. 102 (1995).

[FN10] Reference Manual on Scientific Evidence, 241 (Federal Judicial Center 2d ed. 2000).

[FN11] Bird, "Streamlining Consumer Survey Analysis: An Examination of the Concept of Universe in Consumer Surveys Offered in Intellectual Property Litigation," 88 Trademark Rep. 269, 288 (1998) ("Predetermination of universe by the judge provides the parties with an equal playing field with which to conduct their surveys.").

MCCARTHY § 32:159

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:160. Relevant "universe" surveyed—Examples of appropriate universe

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Examples of the proper universe as defined by the courts include the following:

To prove secondary meaning and likely confusion among purchasers of bulbs, lamps, batteries and flashlights, the relevant universe is the general population since everyone buys such goods. The court noted that a survey is more helpful where low value items are involved, because purchasers of high priced items are likely to study the product more carefully.[FN1]

To prove likely confusion among purchasers of lemonade flavor drink mix, the survey universe was found appropriate where it consisted of female heads of households in Cook County, Illinois, aged 18-65 who had personally, or a member of whose household had, served or drunk lemonade during the year prior to the sur- vey.[FN2]

To prove that people would be confused as to an association between defendant's BEEFEATER restaurant and plaintiff's BEEFEATER gin, a survey conducted among 500 male and female heads-of-household of within a five-mile radius of defendant's proposed restaurant was found proper. The court noted that the results could be extrapolated to all potential customers of the restaurant.[FN3]

To prove likely confusion of defendant's TEXON auto repairs with plaintiff's EXXON gasoline, plaintiff conducted a survey during daytime hours in two high-traffic shopping centers on four different days, interviewing 515 licensed drivers. The court noted that, "while this universe is not perfect, it is close enough," such that the survey results were entitled to "great weight."[FN4]

To prove secondary meaning and likely confusion where defendant sold football jersey replicas imitating the design, names and colors of those licensed by the National Football League, the NFL took a survey whose universe was the entire population of the continental United States between the ages of 13 and 65. This universe

was broken down into sub-groups of prior purchasers of NFL football jersey replicas, "fans" of professional football and "fans plus." The court noted that taking a survey with sub-groups moots any challenge that the universe was too broad.[FN5]

Secondary meaning and confusion surveys of children ages 8-18 were held to be proper as to the significance of a trademark in the sole pattern of children's sneakers.[FN6] A survey of persons 14 years or older who either in the past year bought a slogan or picture T-shirt or were likely to do so in the next six months was held to be a sample of the proper universe of potential purchasers of defendant's "New Jersey Giants" wearing apparel.[FN7] The proper universe for a confusion survey relating to the appearance of a fishing reel was held to be persons over 14 who had fished in fresh water in the last 12 months.[FN8]

[FN1] Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976), superseded by statute as stated in Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 227 U.S.P.Q. 138 (7th Cir. 1985).

[FN2] General Foods Corp. v. Borden, Inc., 191 U.S.P.Q. 674 (N.D. Ill. 1976).

[FN3] James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555 (7th Cir. 1976), appeal after remand, 572 F.2d 574, 197 U.S.P.Q. 277 (7th Cir. 1978). *See* Scotch Whiskey Ass'n v. Consolidated Distilled Products, Inc., 210 U.S.P.Q. 639 (N.D. Ill. 1981) (universe is drinkers of after-dinner liqueur).

[FN4] Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500 (5th Cir. 1980) (survey questions reproduced in opinion).

[FN5] National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175 (W.D. Wash. 1982).

[FN6] In re Sneakers with Fabric Uppers & Rubber Soles, 223 U.S.P.Q. 536 (Int'l Trade Comm'n 1983).

[FN7] National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 229 U.S.P.Q. 785 (D.N.J. 1986).

[FN8] Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, n.6, 4 U.S.P.Q.2d 1497 (10th Cir. 1987).

MCCARTHY § 32:160

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:161. Relevant "universe" surveyed—Examples of inappropriate universe

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Over-Inclusive Universe. A universe may be improperly over-inclusive by encompassing such a large group of persons that it includes those whose perceptions are not relevant, thus skewing the results by introducing irrelevant data.[FN1] Some examples of use of an over-inclusive universe:

- A shopping mall survey of persons planning on buying gifts for girls under 12 years of age was said to cover too broad a universe. The court said that the survey should have focused only upon prospective purchasers of plaintiff's CABBAGE PATCH dolls.[FN2]
- Where WEIGHT WATCHERS sued for use of its mark on LEAN CUISINE frozen diet entrees, the court found over-inclusive a survey of women between the ages of 18 and 55 and who had purchased frozen food entrees in the past six months and who tried to lose weight through diet and/or exercise in the past year. The court said that the universe should have been limited to women who had purchased a diet frozen en- tree.[FN3]
- A survey of women who had purchased or intended to purchase a table or desk lamp was held over-inclusive where the proper universe was persons who buy expensive halogen lamps.[FN4]
- A secondary meaning survey at malls anchored by Sears or Kmart of persons "fairly likely" to buy a watch priced at at least $2500 was held to be over inclusive, the court opting for a survey of persons more resolute in their intentions of buying an expensive watch and conducted at retail outlets that sold expensive watches where the issue was consumer recognition of the design of expensive CARTIER watches.[FN5]
- A survey of the general public was too broad when testing the alleged false endorsement of plaintiff of Penthouse Magazine, an adult publication which was purchased by less than 10% of the sample population.[FN6]
- A survey of adults who had or were likely to buy a bottle of wine in the $5 to $14 price range was too broad when testing reaction to moderately priced wines from Michigan purchased in a wine tasting room.[FN7]

Under-Inclusive Universe. A universe may be improperly under-inclusive by defining a group narrower than the ideal universe, thus leaving out a group of persons whose perception is relevant. Some examples of use of an under-inclusive universe:

- To prove secondary meaning in its red, white and blue basketball, the American Basketball Association surveyed males between 12 and 23 years old who had played basketball within the last year. The court held that because no attempt was made to survey all persons who were in the market to buy a basketball, the universe selected was too narrow to allow the survey to be given any substantial weight.[FN8]
- A universe of spectators and participants at running events was held to be too narrow in a case involving a design mark on a running shoe.[FN9]
- An at-home survey of women during daylight hours was too narrow a universe to prove that there was a likelihood of confusion between defendant's DOMINO'S pizza parlors and plaintiff's DOMINO sugar. Defendant's pizza customers were mainly young, single, male college students, whereas the customers of plaintiff's sugar product were mainly middle-aged females. The persons surveyed, said the court, would have had little exposure to defendant's pizza parlor mark, and of the ten cities used in the survey, eight had no outlet of defendant.[FN10]
- A genericness survey concerning the mark BEANIES for beanbag stuffed animals was found to be too narrow a universe because it was limited to girls from 13 to 18 years old.[FN11]
- A survey to disprove secondary meaning in "king size" for large mens' clothing was held too narrow a universe because it was restricted to men 6' 2" in height or over and did not include other large men who were not so tall.[FN12]
- A likelihood of confusion survey was criticized for having a universe skewed towards a younger population where almost three-quarters of the market for the accused cosmetic product was composed of persons over 34 years old.[FN13]
- A survey of interior designers in a case involving alleged trade dress in ceramic decorative tiles was found to be under-inclusive for not including builders, architects, contractors, and home owners.[FN14]

Judicial Criticism of Universe. Occasionally, judicial criticism of the universe surveyed appears to be extraordinarily myopic. For example, in a dispute over conflicting trademarks used on men's jeans, Levi Strauss surveyed males who had purchased or worn jeans within the past six months. The court held that the survey was "defective" and the results "irrelevant" because the survey did not enquire as to "whether those participants intended to purchase jeans in the future." The court concluded that: "As a result the universe of respondents does not necessarily include potential purchasers of jeans."[FN15] The court apparently felt that some of those men who had purchased or worn jeans within the past six months would never buy jeans in the foreseeable future.

Forward Confusion. In a traditional case claiming "forward" confusion, not "reverse" confusion, the proper universe to survey is composed of the potential buyers of the *junior user's* goods or services, not the senior user's customers. Thus, where the senior user's product was a magazine targeted at younger black women and the junior user's service was rap music, a survey of only African-Americans was of too narrow a universe. The court held that because whites are a significant part of the consumer audience for rap music, the universe surveyed should have included both blacks and whites.[FN16]

Conversely, it was held that surveying only potential customers of the accused product, omitting potential customers of the plaintiff's product, may skew the results of a confusion survey upward so as to substantially detract from the weight of the survey.[FN17]

Survey of Dealers. If the issue involves the state of mind of consumers,[FN18] a survey of dealers or mem-

bers of the trade may or may not be probative, depending on the legal issue. If the issue is secondary meaning among consumers, members of the trade would be the wrong universe, since they generally would be more likely to recognize and associate a mark.[FN19] Where the issue was the possible descriptiveness of the designation used on product sold only to commercial food distributors, a survey of consumers at shopping malls was held to be of the wrong universe and inadmissible.[FN20]

If the issue is likelihood of confusion, the cases are split, some saying that confusion of dealers is not probative of consumer confusion,[FN21] and others saying that it is.[FN22] Since dealers are usually more difficult to confuse by similar marks, while evidence of confusion of dealers should tend to prove confusion of consumers, evidence of non-confusion among dealers would not necessarily prove consumer non-confusion.[FN23]

Geographical Location of Survey. In some cases, the propriety or impropriety of the survey was a function of the geographical area covered. It has been noted that the geographical area selected cannot be based on mere sampling convenience rather than upon scientific or sampling grounds.[FN24] The geographical area surveyed may be either too small to represent adequately a nationwide market,[FN25] or too large to represent consumer reaction in a limited territorial market.[FN26] It has been said that an informal rule of thumb is that four testing sites are a minimum number to ensure a reasonable degree of projection to the universe of a larger area.[FN27] However, when the appropriate universe is confined to a small area, such as a five-mile radius of a local restaurant, fewer testing sites will be appropriate.[FN28]

While in an infringement case, the usual target group to survey are those living in the territory served by both parties,[FN29] in an inter partes case concerning a national registration, there is no necessity to conduct a survey in the territory served by both. Rather, the issue is one of entitlement to a registration nationwide in scope, so that a survey in any significant market is probative. “An opposer need not show a likelihood of confusion in areas outside of its own market area.”[FN30]

[FN1] *See, e.g.,* WGBH Educational Foundation, Inc. v. Penthouse International, Ltd., 453 F. Supp. 1347, 203 U.S.P.Q. 432, 435 (S.D.N.Y. 1978), aff'd without op., 598 F.2d 610 (2d Cir. 1979) (Target audience for defendant's publication was persons in the 18- to 34-year-old range, and plaintiff's television program concerned serious science topics, but survey was not selective as to age or scientific interest. Disparity between the universe in the survey and “some optimal universe of people to whom such a survey should be directed reduces the evidentiary weight to be accorded its findings.”); Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202, 205-206 (7th Cir. 1984) (Survey of all owners of private planes as to source of defendant's parts. While the survey could have been restricted to only those plane owners who use parts to work on or build their own aircraft, any deviation from a perfect universe “goes to the weight to be given the survey results, not the admissibility of the sur- vey.”).

See Reference Manual on Scientific Evidence, 242 (Federal Judicial Center 2d ed 2000) (An overinclusive universe “generally presents less of a problem” than an underinclusive universe if responses from a relevant subset of respondents can be separated out and examined.).

[FN2] Original Appalachian Artworks, Inc. v. Blue Box Factory (USA), Ltd., 577 F. Supp. 625, 222 U.S.P.Q. 593 (S.D.N.Y. 1983) (the court observed that adult purchasers looking for a CABBAGE

PATCH doll might exercise special care in order not to disappoint the child by accepting an imitation). *See* General Motors Corp. v. Cadillac Marine & Boat Co., 226 F. Supp. 716, 140 U.S.P.Q. 447 (W.D. Mich. 1964) (in case involving possible confusion by use of CADILLAC on boats, survey of persons in general, including those with no interest in boats, and was over inclusive); Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 4 U.S.P.Q.2d 1541 (2d Cir. 1987) (survey of "people in executive positions in marketing in American business enterprises and institutions" was held too broad a universe in determining secondary meaning for a marketing trade magazine title where the relevant group is "executives in the international marketing and advertising community in the United States").

[FN3] Weight Watchers Int'l, Inc. v. Stouffer Corp., 744 F. Supp. 1259, 19 U.S.P.Q.2d 1321, 1331 (S.D.N.Y. 1990) ("[S]ome of the respondents may not have been in the market for diet food of any kind and the study universe therefore was too broad."). *See* Trouble v. Wet Seal, Inc., 179 F. Supp. 2d 291, 69 U.S.P.Q.2d 1603, 58 Fed. R. Evid. Serv. 509 (S.D. N.Y. 2001) (conducting survey in mall where defendant's stores were located surveys the wrong universe because while both parties are wearing apparel sellers, they cater to entirely different socioeconomic markets. Survey was excluded from evidence.)

[FN4] Lon Tai Shing Co. v. Koch + Lowy, 21 U.S.P.Q.2d 1858 (S.D.N.Y. 1992), recons. granted, in part, recons. denied, in part, 1992 U.S. Dist. LEXIS 20783 (S.D.N.Y. July 17, 1992), on recons., 25 U.S.P.Q.2d 1375 (S.D.N.Y. 1992) ("Since [alleged infringer's] survey failed to narrow the universe of customers in order to encompass only the potential buyers of the products at issue, it fails to refute [trademark owner's] survey and its probative value is minimal."). *See*: Big Dog Motorcycles, L.L.C. v. Big Dog Holdings, Inc., 402 F. Supp. 2d 1312, 79 U.S.P.Q.2d 1187 (D. Kan. 2005) (survey of prospective buyers of all t-shirts and caps was too broad a universe because it was not limited to prospective buyers from the junior user: those who would be likely to buy t-shirts and caps at motorcycle dealerships. Survey results were disregarded.).

[FN5] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 229–231 (S.D. N.Y. 2004).

[FN6] Kournikova v. General Media Communications Inc., 31 Media L. Rep. 1201, 64 U.S.P.Q.2d 1614, 2002 WL 31628027 (C.D. Cal. 2002).

[FN7] Leelanau Wine Cellars, Ltd. v. Black & Red, Inc., 502 F.3d 504, 84 U.S.P.Q.2d 1225 (6th Cir. 2007) ("These deficiencies undermine the persuasiveness of the Parikh survey." Defendant's accused wine was sold almost exclusively through the tasting room at its winery.).

[FN8] American Basketball Ass'n v. AMF Voit, Inc., 358 F. Supp. 981, 177 U.S.P.Q. 442 (S.D.N.Y. 1973), aff'd without op., 487 F.2d 1393, 180 U.S.P.Q. 290 (2d Cir. 1973), cert. denied, 416 U.S. 986, 40 L. Ed. 2d 763, 94 S. Ct. 2389, 181 U.S.P.Q. 685 (1974). *See* Universal City Studios, Inc. v. Nintendo Co., 746 F.2d 112, 223 U.S.P.Q. 1000 (2d Cir. 1984) (telephone survey of people who had purchased defendant's video game was held to be too narrow to cover the correct universe: it should also have covered those who were contemplating a purchase).

[FN9] Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 533 F. Supp. 75, 215 U.S.P.Q. 358 (S.D. Fla. 1981), aff'd, 716 F.2d 854, 221 U.S.P.Q. 536 (11th Cir. 1983). *See* Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989) (A survey universe was found to be under-inclusive in

that it focused only on youngsters who were skateboarding aficionados rather than on all young persons ages 15 to 25 who buy sports wear, but the survey result was so strong that it still supported a finding of secondary meaning.); Breuer Electric Mfg. Co. v. Hoover Co., 48 U.S.P.Q.2d 1705 (N.D. Ill. 1998) (while survey of three categories of buyers of commercial vacuum cleaners covered only about 15% of the total market for such commercial products, the results were helpful to show that confusion was unlikely); Scott Fetzer Co. v. House of Vacuums Inc., 381 F.3d 477, 72 U.S.P.Q.2d 1011 (5th Cir. 2004) (survey was under-inclusive because it was limited to a universe of persons who had purchased products from defendant and did not include those who were potential buyers from defendant); In re Spirits International N.V., 86 U.S.P.Q.2d 1078, 1088, 2008 WL 375723 (T.T.A.B. 2008) (Survey should have been limited to persons knowledgeable in Russian to determine if a Russian word used as a mark was geographically deceptively misdescriptive.).

[FN10] Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 205 U.S.P.Q. 969, 979, 29 Fed. R. Serv. 2d 1528 (5th Cir. 1980) (The court held that the survey results were not probative of the true degree of confusion because the universe was too narrow.) *See* Ideal Toy Corp. v. Kenner Products Division of General Mills Fun Group, Inc., 443 F. Supp. 291, 197 U.S.P.Q. 738 (S.D. N.Y. 1977) (to prove that purchasers associated toys with characters in Star Wars movie, children and parents were interviewed at shopping malls: survey did not attempt to reach persons in the market for space toys or those in the process of making a purchase).

[FN11] Ty Inc. v. Softbelly's Inc., 353 F.3d 528, 69 U.S.P.Q.2d 1213, 57 Fed. R. Serv. 3d 637 (7th Cir. 2003) ("[T]he survey was worthless—13 to 18 year old girls [are] an arbitrary subset of consumers of beanbag stuffed animals.")

[FN12] King-Size, Inc. v. Frank's King Size Clothes, Inc., 547 F. Supp. 1138, 1158, 216 U.S.P.Q. 426 (S.D. Tex. 1982) ("[T]he survey excluded other groups of consumers of wearing apparel for large size men, i.e., short, heavy men, men ranging in height from 6' to 6'2 with an unusual anatomical feature which requires them to purchase extra-large size clothes, and finally, women in families where such women are the principal purchasers of the product.").

[FN13] Juicy ZCouture, Inc. v. L'Oreal USA, Inc., 2006 WL 1012939 (S.D. N.Y. 2006) (The court said the skewed universe affected the results because the plaintiff's JUICY wearing apparel product was more familiar to a younger group, leading to a higher connection with defendant's JUICY WEAR line of cosmetics.).

[FN14] Walker & Zanger, Inc. v. Paragon Industries, Inc., 549 F. Supp. 2d 1168 (N.D. Cal. 2007) (survey was admissible but of reduced value and failed to prove secondary meaning).

[FN15] Jordache Enterprises Inc. v. Levi Strauss Co., 841 F. Supp. 506, 518, 30 U.S.P.Q.2d 1721 (S.D.N.Y. 1993).

[FN16] Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 559-64 (S.D.N.Y. 1991) ("A universe that excluded whites entirely is one which reflects neither the market for rap music generally nor for [the junior user's] music specifically"). Regarding the difference between "forward" and "reverse" confusion *see* § 23:10.

[FN17] IDV North America, Inc. v. S & M Brands, Inc., 26 F. Supp. 2d 815, 830 (E.D. Va. 1998)

(surveying only the potential customers of defendant's BAILEY's inexpensive cigarettes and not including potential purchasers of plaintiff's BAILEY's liqueurs "seriously undercuts the credibility of the survey because it excludes those most likely to be aware that BAILEY's liqueurs are not made by a tobacco manufacturer." No infringement was found.).

[FN18] Note that the issue may involve likely confusion of dealers. *See* Russ Berrie & Co. v. Jerry Elsner Co., 482 F. Supp. 980, 205 U.S.P.Q. 320 (S.D.N.Y. 1980).

[FN19] Astatic Corp. v. American Electronics, Inc., 201 U.S.P.Q. 411 (N.D. Ohio 1979). *But compare* In re Raytheon Co., 202 U.S.P.Q. 317 (T.T.A.B. 1979).

[FN20] J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 65 U.S.P.Q.2d 1897 (D.N.J. 2002), related reference, 2003 WL 21051711 (D.N.J. 2003).

[FN21] American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958); Wembley, Inc. v. Diplomat Tie Co., 216 F. Supp. 565, 137 U.S.P.Q. 107 (D. Md. 1963).

[FN22] Metropolitan Opera Ass'n v. Pilot Radio Corp., 189 Misc. 505, 68 N.Y.S.2d 789, 72 U.S.P.Q. 334 (1947); Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976), superseded by statute as stated in Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 227 U.S.P.Q. 138 (7th Cir. 1985).

[FN23] *See* §§ 23:100 to 23:103.

[FN24] Ralston Purina Co. v. Quaker Oats Co., 169 U.S.P.Q. 508 (T.T.A.B. 1971); Bank of Texas v. Commerce Southwest, Inc., 741 F.2d 785, 223 U.S.P.Q. 1174 (5th Cir. 1984) (survey to prove secondary meaning was taken in too small a geographic area to be probative of secondary meaning in larger area plaintiff claimed as its own).

[FN25] General Motors Corp. v. Cadillac Marine & Boat Co., 226 F. Supp. 716, 140 U.S.P.Q. 447 (W.D. Mich. 1964) (150 people in a single area not adequate to sample entire U.S. market); R. J. Reynolds Tobacco Co. v. Loew's Theatres, Inc., 511 F. Supp. 867, 210 U.S.P.Q. 291 (S.D.N.Y. 1980) (suburban shopping mall intercept survey fails to produce nationally projectable percentage); Exxon Corp. v. Xoil Energy Resources, Inc., 552 F. Supp. 1008, 216 U.S.P.Q. 634 (S.D.N.Y. 1981) (194 persons informally interviewed at New York City train stations is not projectable over national market).

[FN26] Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969) (survey of entire county too large to give indication of consumer confusion in area within ten-mile radius of defendant's small business).

[FN27] Jacoby, "Survey & Field Experimental Evidence," at 184 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985).

[FN28] *See, e.g.,* James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555 (7th Cir. 1976), appeal after remand, 572 F.2d 574, 197 U.S.P.Q. 277 (7th Cir. 1978) (universe of persons

within five-mile radius of defendant's proposed restaurant was proper).

[FN29] *See* §§ 26:33 to 26:36 (no infringement occurs unless party with superior rights enters the other party's trade territory). *See* Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 205 U.S.P.Q. 969, 979, 29 Fed. R. Serv. 2d 1528 (5th Cir. 1980) (The court held that the survey results were not probative of the true degree of confusion because, inter alia, the geographic universe was too narrow: of the ten cities used in the survey, eight had no outlet of defendant.).

[FN30] Carl Karcher Enters. v. Stars Restaurants Corp., 35 U.S.P.Q.2d 1125, 1133 (T.T.A.B. 1995) (opposer operated restaurants in California, Arizona, Oregon and Nevada and applicant operated restaurants only in Texas and Oklahoma; surveys taken in California support a finding of likelihood of confusion).

MCCARTHY § 32:161

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:162. Relevant "universe" surveyed—Effect of sampling inappropriate universe

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The selection of an inappropriate universe generally affects the weight of the resulting survey data, not its admissibility. For example, where plaintiff surveyed a slightly broader universe than would be the perfect target group, the Seventh Circuit said that this merely goes to the weight given the survey results, not to the very admissibility of the survey.[FN1] Even if a survey does not target what the court considers to be the optimal universe, the results may be so compelling that it still supports the factual finding for which it was intended. For example, a survey universe was found to be under-inclusive in that it focused only on youngsters who were skateboarding aficionados rather than on all young persons ages 15 to 25 who buy sports wear, but the Ninth Circuit held that the survey result was so strong that it still supported a finding of secondary meaning.[FN2]

If the reactions of the universe surveyed are irrelevant to the perceptions of the universe at issue, then the court has the power to declare the survey inadmissible as evidence.[FN3]

[FN1] Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984).

[FN2] Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989).

[FN3] J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 65 U.S.P.Q.2d 1897 (D.N.J. 2002), related reference, 2003 WL 21051711 (D.N.J. 2003) (Where the issue was the possible descriptiveness of the designation used on products advertised and sold only to commercial food distributors, a survey of consumers at shopping malls was held to be of the wrong universe and inadmissible at the summary judgment motion stage.); Trouble v. Wet Seal, Inc., 179 F. Supp. 2d 291, 69 U.S.P.Q.2d 1603, 58 Fed. R. Evid. Serv. 509 (S.D. N.Y. 2001) (Conducting survey in mall where defendant's stores were

> located surveys the wrong universe because while both parties are wearing apparel sellers, they cater to entirely different socioeconomic markets. Survey was excluded from evidence. "A survey, however, must be excluded from evidence under FRE 403 where it is so flawed in methodology that its probative value is substantially outweighed by its prejudicial effect.").

MCCARTHY § 32:162

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:163. Survey methodology—Approximating market conditions

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

While confusion of non-purchasers is relevant in many cases,[FN1] most often, a survey is designed to prove the state of mind of a prospective purchaser. Therefore, the closer the survey methods mirror the situation in which the ordinary person would encounter the trademark, the greater the evidentiary weight of the survey results. Speaking of surveys designed to elicit information relevant to the issue of a likelihood of confusion, Professor Perlman observed:

> Most surveys do not measure actual confusion. Surveys only give us information about a controlled and artificial world from which we are asked to draw inferences about the real world. One might be able to draw helpful inferences from a survey of randomly selected pedestrians in a shopping mall who are interrogated about pictures of two products, but to claim their responses are direct proof of the responses of actual consumers as they make their purchasing decisions is going too far.[FN2]

Some courts have discounted or rejected some surveys because the survey did not accurately reproduce the state of mind of customers "in a buying mood." Judge Wyzanski once commented that:

> If the interviewee is not in a buying mood but is just in a friendly mood answering a pollster, his degree of attention is quite different from what it would be had he his wallet in hand. Many men do not take the same trouble to avoid confusion when they are responding to sociological investigators as when they spend their cash.[FN3]

There are two problems with such a criticism of surveys: (1) The criticism essentially is a rejection of all surveys, since no survey can perfectly reproduce the actual purchasing decision in which the customer puts his or her money behind the decision. To require that a survey be taken "during the buying decision" is an im-

possible requirement tantamount to rejecting all survey evidence. (2) Likely confusion of purchasers does not define the only type of confusion that may be relevant. Confusion of non-purchasers may be just as important in some cases.[FN4]

The better view is that the closer the survey context comes to marketplace conditions, the greater the evidentiary weight it has. Survey interviews conducted in a store[FN5] or in a shopping center[FN6] should reach persons "in a buying mood," even assuming that this is a necessary ingredient. Thus, the best response to a comment like that of Judge Wyzanski was that given in the famous ZIPPO lighter case:

> While it may be that in general the store is the best place to measure the state of mind at the time of purchase, it would be virtually impossible to obtain a representative national sample if stores were used. An interview at a respondent's home is probative of his state of mind at the time of purchase, although the deviation from the actual purchase situation should be considered in weighing the force of this evidence.[FN7]

One reason why intercept surveys are usually performed in shopping malls is that the modern shopping mall is the quintessential place to find gathered those who are "in a buying mood."

Surveys taken at home in person or by telephone should not be discounted or denigrated, but accepted as probative evidence if properly conducted. Telephone surveys have been criticized by some courts,[FN8] but accepted by most.[FN9] The only inherent problem in a telephone interview is that the visual component is missing.[FN10]

The Federal Judicial Center 2000 Reference Manual on Scientific Evidence recognizes the usefulness of telephone surveys and recommends that the expert's report specify three elements: (1) the procedures that were used to identify potential respondents; (2) the number of telephone numbers where no contact was made; and (3) the number of contacted potential respondents who refused to participate.[FN11]

Courts (and attorneys) should recognize the cost trade-off: telephone surveys are often less expensive than elaborate in-person interviews. Courts that demand perfection in surveying must realize that they may be pricing the litigant of moderate means out of the courtroom in trademark litigation.

[FN1] *See* §§ 23:3 to 23:4.

[FN2] Perlman, "The Restatement of the Law of Unfair Competition: A Work in Progress," 80 Trademark Rep. 461, 472 (1990).

[FN3] American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958). *See* American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 204 U.S.P.Q. 609 (2d Cir. 1979), cert. denied, 445 U.S. 951, 63 L. Ed. 2d 787, 100 S. Ct. 1601, 205 U.S.P.Q. 680 (1980) (survey rejected for failure to conduct "under actual marketing conditions"); Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969) (telephone interviews not conducted "in the context of the marketplace"); Oneida, Ltd. v. National Silver Co., 25 N.Y.S.2d 271, 48 U.S.P.Q. 33 (Sup. Ct. 1940).

[FN4] *See* National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175 (W.D. Wash. 1982). *See* discussion at §§ 23:5 to 23:9.

[FN5] *See* Marcalus Mfg. Co. v. Watson, 156 F. Supp. 161, 115 U.S.P.Q. 232 (D.D.C. 1957), aff'd, 258 F.2d 151, 118 U.S.P.Q. 7 (D.C. Cir. 1958) (store survey rejected where interviewees could see the labels in question with both design and word marks on nearby shelves; issue was secondary meaning of background design alone); La Maur, Inc. v. Revlon, Inc., 245 F. Supp. 839, 146 U.S.P.Q. 654 (D. Minn. 1965) (accepted in-store survey not near counter where the goods were displayed).

[FN6] *See, e.g.,* Scotch Whiskey Ass'n v. Consolidated Distilled Products, Inc., 210 U.S.P.Q. 639 (N.D. Ill. 1981) (survey limited to persons who had bought or consumed after-dinner liqueur within past year and conducted in shopping centers where no alcoholic beverage was sold; that survey was not conducted in actual purchasing situation does not significantly undermine weight of the survey); Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500 (5th Cir. 1980); McDonough Power Equipment, Inc. v. Weed Eater, Inc., 208 U.S.P.Q. 676 (T.T.A.B. 1981).

[FN7] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 685, 137 U.S.P.Q. 413, 424 (S.D.N.Y. 1963). *See* Boal, "Techniques for Ascertaining Likelihood of Confusion and the Meaning of Advertising Communications," 73 Trademark Rep. 405, 406 (1983).

[FN8] Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969); Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982).

[FN9] *See, e.g.,* Western Bank v. Western Bancorporation, 212 U.S.P.Q. 973 (Or. Ct. App. 1980); E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc., 393 F. Supp. 502, 185 U.S.P.Q. 597 (E.D.N.Y. 1975); President & Trustees of Colby College v. Colby College--New Hampshire, 508 F.2d 804, 185 U.S.P.Q. 65 (1st Cir. 1975).

[FN10] *See* Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 227 U.S.P.Q. 257 (S.D.N.Y. 1985), aff'd without op., 788 F.2d 3 (2d Cir. 1986) (while telephone surveys are "not per se unreliable," they are confined to aural stimuli in which visual impressions are lost). *See* § 23:21.

[FN11] Reference Manual on Scientific Evidence, 262 (Federal Judicial Center 2d ed. 2000).

MCCARTHY § 32:163

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:163.50. Survey methodology—Survey pilot tests

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

It is standard practice for the survey expert to conduct a pre-test or a pilot test of a proposed survey in order to evaluate the clarity and usefulness of the survey method, structure and questions. A pilot test is a small field test replicating the procedures planned for the full-scale survey. While the terms pre-test and pilot test are sometimes used interchangeably, strictly speaking, a pretest tests the questionnaire, while a pilot test tests proposed collection procedures as well.[FN1] In such tests, a proposed survey is administered to a small sample of about 25 to 75 respondents and the procedures and responses are analyzed. The final survey is often changed and questions re-worded as a result of feedback from the pilot test.

There is nothing biased or unfair about changes in either survey methodology or questions which are made as a result of the experience gained by running a pilot test. As the Federal Judicial Center observes: "A more appropriate reaction is to recognize that pilot work can improve the quality of a survey and to anticipate that it often results in word changes that increase clarity and correct misunderstandings. Thus, changes may indicate informed survey construction rather than flawed survey design."[FN2]

It is not usual practice for survey experts to disclose or discuss in the expert report the existence or scope of pilot testing.[FN3]

[FN1] Reference Manual on Scientific Evidence, 249 (Federal Judicial Center 2d ed. 2000).

[FN2] Reference Manual on Scientific Evidence, 249 (Federal Judicial Center 2d ed. 2000).

[FN3] Reference Manual on Scientific Evidence, 271 (Federal Judicial Center 2d ed. 2000) (But the

manual notes that "The Federal Rules of Civil Procedure, however, may require that a testifying expert disclose pilot work that serves as a basis for the expert's opinion.").

MCCARTHY § 32:163.50

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:164. Survey methodology—Probability and nonprobability surveys—Probability sampling

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Random Selection from the Universe. A "survey" by definition involves taking a "sample" by selecting some subset of the defined universe and questioning persons in that subset. The sample selected may be a probability sample or a nonprobability sample. While each type of sample can reasonably be projected to the universe at large, only a probability sample can be projected to the entire universe by the use of definite mathematical and statistical probability models.

The familiar "sampling error" or "margin of error" computation is appropriate only for a probability sample. Assuming a probability sample, a margin of error describes how stable the mean response in the sample is likely to be.[FN1]

A probability survey involves the mathematically random selection of persons from the defined universe such that each person has a known mathematical probability of being selected for questioning.[FN2] The benefit of a probability sample is that the persons selected do a good job of reflecting the make-up of the universe. This permits a statistical projection of the results to the universe as a whole, with a known degree of error.[FN3]

Telephone Surveys. The most common use of probability sampling is in telephone surveys, in which telephone numbers in a given territory can be randomly selected.[FN4] However, with the use of cell and mobile phones and changing social habits, there have been substantially decreased response rates for telephone surveys. It was reported that between 2000 and 2006, there was a 50% decline in participation in telephone surveys.[FN5] There were several reasons for this. Firms that sell lists of available phone numbers to research organizations for random digit dialing exclude cell phone numbers. With greater use of cell phones, this removes a large number of people from the potential group. Also, caller ID and call blocking make it difficult to elicit a response from landline phone numbers. And even if a phone is answered, an increasing number of people are not willing to spend time responding to survey questions. All these factors skew the randomness of the survey.

Drawbacks of Probability Surveys. While the probability sample reflects the scientific ideal, it is often both difficult and costly to implement. For example, to conduct in-person interviews on a probability sample, some method of random choice must be used by which each household has a known chance of being selected. Then persons in each selected household must be contacted and an appointment made for an in-person visit. This can be a very time-consuming and expensive process. Randomness is compromised unless each individual within a household has a known chance of being questioned.[FN6] However, gender, age and income variations impact on the type of person in a household who is likely to be home, or willing to be home, for an in-person interview. And with the increasing frequency of two-couple earners in households, the number of persons who are willing to be at home for an interview is decreasing. Thus, the difficulties of taking a probability sample sometimes loom large.[FN7]

[FN1] Reference Manual on Scientific Evidence, 243 (Federal Judicial Center 2d ed. 2000).

[FN2] *See* Jacoby, "Survey & Field Experimental Evidence," at 182 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985) ("Probability sampling involves the random selection of elements (e.g., people) from the universe, where each element has a known probability of being selected."); M. Rappeport, Litigation Surveys: Social Science as Evidence, 92 Trademark Rptr 957, 971 (2002) ("[A] probability sample is defined as a sample in which each person in the universe has a *known, non-zero* probability of being included in the sample of actual respondents. … [But] in the real world, almost no survey sample ever actually comes anywhere near to meeting the definition of a probability sample."). *See, e.g.,* the "Haley Survey" in the DOMINO'S case, where a random sample of 525 persons was selected and interviews were conducted at home: Amstar Corp. v. Domino's Pizza, Inc., 205 U.S.P.Q. 128, 140 (N.D. Ga. 1979), rev'd, 615 F.2d 252, 205 U.S.P.Q. 969, 979 (5th Cir. 1980), reh'g denied, 617 F.2d 295 (5th Cir. 1980), cert. denied, 449 U.S. 899, 66 L. Ed. 2d 129, 101 S. Ct. 268, 208 U.S.P.Q. 464 (1980) (the Haley Survey was disregarded by the court of appeals for focusing on the wrong universe).

[FN3] *See* Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?" 73 Trademark Rep. 349, 355 (1983) (A probability sample meets three specifications: (1) It is selected such that every member of the universe has a known chance of being selected; (2) the members of the sample are a microcosm of the universe as qualified by a predictable sampling error; and (3) the results can be "statistically projected at a calculable confidence level to the population from which the sample is selected.").

[FN4] However, randomness ends with the phone call unless each individual within a household has a known chance of being questioned. If the caller says: "I'd like to speak to a person at this number who is 18 years or older," this is a non-random procedure that narrows the group from which the spokesperson for the household is chosen to those over 18 who happen to be home at the time of the call. This has been characterized as "a decidedly non-random procedure." Jacoby, "Survey & Field Experimental Evidence," at 184 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985).

[FN5] G. Gelb and B. Gelb, Internet Surveys for Trademark Litigation: Ready or Not, Here They Come, 97 Trademark Rptr 1073, 1076 (2007).

[FN6] *See* Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?" 73 Trademark Rep. 349, 356 (1983) ("[Q]uestions that involve individual attitudes and behavior must be answered by individuals—because the universe is composed of individuals who may vary in attitude or perception or behavior from others in the same household.").

[FN7] M. Rappeport, Litigation Surveys: Social Science as Evidence, 92 Trademark Rptr 957, 971-972 (2002). ("In a well-defined strict probability sense, probability samples are the gold standard in survey sampling … . [But] in the real world, almost no survey sample ever actually comes anywhere near to meeting the definition of a probability sample … . [U]nless one has the kind of resources available to the United States Census Bureau, few surveys ever actually come anywhere near to meeting the requirements for a probability sample.").

MCCARTHY § 32:164

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:165. Survey methodology—Probability and nonprobability surveys—nonprobability sampling

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Mall Intercept Surveys. A nonprobability sampling survey, sometimes called a "mall intercept" survey, does not require random selection of persons to question. Thus, it does not permit a mathematically precise projection to the universe at large.[FN1] Selection of respondents to question is usually done on the basis of availability at a designated location. The most popular method is interception of persons at a shopping mall. The characteristics of the persons intercepted are recorded, such as gender, age, income level, education and the like. The desired quota of persons with a specified characteristic is reached by questioning persons until the quota is filled. For example, if the surveyor wants an equal distribution of male and female respondents, persons are intercepted and questioned until the gender quotas are reached.[FN2]

A Common Survey Method. Nonprobability sampling is now the most commonly performed type of in-person survey done for trademark and unfair competition litigation. Such surveys are most often admitted into evidence under Federal Rule of Evidence 703, which permits an expert to base an opinion on evidence which is not admissible in evidence if that evidence is "of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject." In one study the authors found that about 97% of in-person commercial surveys are nonprobability samples and that about 95% of the empirical literature in the social and behavioral sciences also relies upon nonprobability surveys.[FN3] The logical conclusion is that nonprobability surveys are of a type often relied upon by marketing experts and social scientists in forming opinions on customer attitudes and perceptions. Thus, expert opinions based on such surveys are admissible in evidence.[FN4]

Admissible in Evidence. Almost all courts have found that nonprobability "mall intercept" surveys are sufficiently reliable to be admitted into evidence.[FN5] The Trademark Board has observed that: "The shopping mall intercept method has also been endorsed as adequate in numerous decisions." The Board noted that any effect on the sample resulting from the fact that the shopping malls selected skewed the sample upward in income level would probably underestimate the amount of likely confusion.[FN6] Some courts, recognizing that the results of

a nonprobability survey cannot be statistically extrapolated to the entire universe, admit the data but do not accord them as much evidentiary weight as those from a probability survey.[FN7]

Comparing the Two Survey Types. In comparing probability and nonprobability surveys, Jacoby has concluded that:

> [T]he objective of sampling is to ensure that the subgroup tested is representative of the universe of interest. In the abstract, probability sampling generally offers a better approach for achieving such representativeness. However, other facets of the research design or the exigencies of the court calendar may dictate that one use a nonprobability sampling plan, and the trier of fact should not be hasty in reducing weight on these grounds. It is clearly better to have a nonprobability study conducted with members who are from the appropriate universe than it is to have a precise probability study conducted with respondents who are not.[FN8]

[FN1] *See* Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, n.6, 4 U.S.P.Q.2d 1497, n.6 (10th Cir. 1987) (it was proper for district court to treat nonprobability survey results as evidence of actual confusion, making irrelevant the issue of whether district court erred by projecting the results of a nonprobability survey); Reference Manual on Scientific Evidence, 244 (Federal Judicial Center 2d ed. 2000) ("[Q]uantitative values computed from such [nonprobability] samples (e.g. percentage of respondents indicating confusion) should be viewed as rough indicators rather than as precise quantitative estimates. Confidence intervals should not be computed.").

[FN2] *See* Jacoby, "Survey & Field Experimental Evidence," at 183 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985) ("[N]onprobability sampling is more likely to provide accurate estimates of the universe when the members of that universe are relatively homogeneous with respect to the issue of interest.").

[FN3] Jacoby & Handlin, "nonprobability Sampling Designs for Litigation Surveys," 81 Trademark Rep. 169 (1991).

[FN4] Reference Manual on Scientific Evidence, 244 (Federal Judicial Center 2d ed. 2000) ("A majority of the consumer surveys conducted for Lanham Act litigation present results from nonprobability convenience samples. They are admitted into evidence based on the argument that nonprobability sampling is used widely in marketing research and that 'results of these studies are used by major American companies in making decisions of considerable consequence.").

[FN5] National Football League Properties, Inc. v. New Jersey Giants, Inc., 637 F. Supp. 507, 229 U.S.P.Q. 785, 792 (D.N.J. 1986) ("[A] nonprobability survey, such as the survey in this case, is sufficiently reliable to be admitted into evidence and accorded substantial weight."); Tyco Industries, Inc. v. Lego Systems, Inc., 5 U.S.P.Q.2d 1023 (D.N.J. 1987), aff'd, 853 F.2d 921 (3d Cir. 1988), cert. denied, 488 U.S. 955, 102 L. Ed. 2d 381, 109 S. Ct. 392 (1988) ("[C]ourts have repeatedly accepted mall intercept surveys in litigation," even if they are not projectable); E. & J. Gallo Winery v. Gallo Cattle Co., 12 U.S.P.Q.2d 1657 (E.D. Cal. 1989), modified, aff'd, 955 F.2d 1327, 21 U.S.P.Q.2d 1824 (9th Cir. 1992), amended, 967 F.2d 1280 (9th Cir. 1992) (while a mall-intercept survey does not have a statistical

probability of extrapolation, it is a reliable and popular method of surveying); Berkshire Fashions, Inc. v. Sara Lee Corp., 729 F. Supp. 21, 14 U.S.P.Q.2d 1124 (S.D.N.Y. 1990) (mall intercept survey responses support a finding of likely confusion).

[FN6] Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc., 1 U.S.P.Q.2d 1445, 1455 n.33 (T.T.A.B. 1986). *See* Reiner, "The Universe and Sample: How Good is Good Enough?" 73 Trademark Rep. 366, 373 (1983) ("[I]f the selected mall caters to people with an ascertainable socio-economic standard of living, the views of that group of shoppers (i.e., universe) may not reflect the views of different groups that shop at other locations.").

[FN7] Boehringer Ingelheim G.m.b.H. v. Pharmadyne Laboratories, 532 F. Supp. 1040, 1053, 211 U.S.P.Q. 1163, 1176 (D.N.J. 1980) ("Because the survey was not a probability sample, the results cannot be extrapolated to the universe. Therefore, I will not accord the survey as much weight as I would a probability survey. Nonetheless, the survey deserves some weight." The survey was one of physicians' prescriptions for a certain drug in order to find the incidence of disallowance of permitted substitution of a generic drug. The court accepted the survey and found that it proved the point for which it was introduced.); Calvin Klein Co. v. Farah Mfg. Co., 229 U.S.P.Q. 795 (S.D.N.Y. 1985), Finding of Fact No. 21 (a "random intercept" survey is less accurate than a probability survey because the results cannot be statistically projected to the entire population); American Home Products Corp. v. Barr Laboratories, Inc., 656 F. Supp. 1058, 3 U.S.P.Q.2d 1194 (D.N.J. 1987), aff'd, 834 F.2d 368, 5 U.S.P.Q.2d 1073 (3d Cir. 1987) ("While nonprobability survey results may be admissible, they are weak evidence of behavior patterns in the test universe."); Consumers Union of United States, Inc. v. New Regina Corp., 664 F. Supp. 753, 4 U.S.P.Q.2d 1257 (S.D.N.Y. 1987) (the failure to obtain a probability sample goes only to the weight and not to the admissibility of the survey); Frank Brunckhorst Co. v. G. Heileman Brewing Co., 875 F. Supp. 966, 35 U.S.P.Q.2d 1102 (E.D.N.Y. 1994) (a random or probability sampling telephone survey "is entitled to more weight" than a face-to-face mall intercept survey); In re Spirits International N.V., 86 U.S.P.Q.2d 1078, 1089, 2008 WL 375723 (T.T.A.B. 2008) (mall intercept survey is admissible but is not a random sample: "the results cannot be projected to the entire universe of relevant purchasers.").

[FN8] Jacoby, "Survey & Field Experimental Evidence," at 185-186 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985).

MCCARTHY § 32:165

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:165.25. Internet surveys

Gelb and Gelb report that with the declining usefulness of telephone surveys, there is an increasing use of surveys conducted over the Internet.[FN1] They list several strengths of Internet survey methods:

- Respondents can respond to the questions at their convenience, rather than have to respond at the time of a telephone call.
- Photos, sound and video clips can be included, obviating the need for a person-to-person survey in a mall intercept setting.
- An Internet survey can screen large populations quickly, enabling contact with small groups of people who comprise a universe for the survey. For example, one can reach only members of trade or professional associations.
- An Internet survey is faster and less expensive than mall intercept or telephone surveys.
- Internet data collection eliminates the potential of interviewer biasing of the responses, either consciously or inadvertently. Different live interviewers may read the questions differently, with different stress and intonation, creating the impression that there is a "correct" answer.

Internet survey disadvantages include population bias if the universe consists of low-income, rural, or elderly persons, for those groups have Internet usage in lower percentages than other groups. In addition, an Internet survey cannot respond to responses in the same way as a live interviewer. For example, a human interviewer is often instructed to "probe" yes-no responses with a question like "Why do you say that?" If the respondent says, "It makes me think of that brand." A live interviewer can probe with: "What is it about it that makes you think of that brand?" An Internet survey can be programmed to ask "Why do you say that?" but cannot usually follow up using the respondent's own language.

[FN1] G. Gelb and B. Gelb, Internet Surveys for Trademark Litigation: Ready or Not, Here They Come, 97 Trademark Rptr 1073, 1076 (2007).

MCCARTHY § 32:165.25

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

A. PROPER SURVEY METHODS

References

§ 32:166. Survey methodology—Attorney participation in survey design

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

While some authority indicates that a survey is flawed if an attorney is involved in designing the questions to be asked,[FN1] this cannot be a correct criticism and is based upon a misreading of precedent.[FN2] Of course, it may be improper for an attorney to single handedly design a survey without professional assistance. Thus, a court criticized a survey because it was designed solely by plaintiff's counsel, rather than with the assistance of a survey professional.[FN3]

Attorney cooperation with the survey professional in designing the survey is essential to produce relevant and usable data. If attorneys cannot tell the survey director what the legal issues are and assist the director in framing relevant questions to be directed at a relevant universe, then irrelevant survey data are bound to be the result.[FN4]

The only relevant limitation is that the attorneys do not *conduct* the survey. Once the relevant universe and relevant questions are defined between the attorneys and the survey director, the attorneys should then step aside and allow the expert survey director to carry out independently the survey in accordance with accepted survey methodology.

The Federal Judicial Center's 2000 Reference Manual on Scientific Evidence agrees with this treatise that attorney participation in survey design is needed but attorneys should not participate in the actual conduct of the survey:

> A better interpretation is that the attorney should have no part in carrying out the survey. However, some attorney involvement in the survey design is necessary to ensure that relevant questions are directed to a relevant population … . [T]he interviews themselves are not directly visible and any potential bias is minimized by having interviewers and respondents blind to the purpose and sponsorship of the survey and by excluding attorneys from any part in conducting interviews and tabulating results.[FN5]

[FN1] Boehringer Ingelheim G.m.b.H. v. Pharmadyne Laboratories, 532 F. Supp. 1040, 211 U.S.P.Q. 1163, 1179 (D.N.J. 1980); American Home Products Corp. v. Barr Laboratories, Inc., 656 F. Supp. 1058, 3 U.S.P.Q.2d 1194, 1204 (D.N.J. 1987), aff'd, 834 F.2d 368, 5 U.S.P.Q.2d 1073 (3d Cir. 1987) (court, relying upon *Boehringer,* said that because survey director consulted with attorneys in defining the issues on which to survey, this "further detracts from the weight which should be accorded the survey results").

[FN2] In the case relied upon, the court only said that "the survey must be conducted independently of the attorneys involved in the litigation." Pittsburgh Press Club v. United States, 579 F.2d 751 (3d Cir. 1978), on remand, 462 F. Supp. 322 (W.D. Pa. 1978), rev'd, 615 F.2d 600 (3d Cir. 1980). The language in the 1960 version of the Judicial Conference Handbook requiring that the interviews "were conducted independently of the attorneys in the case" was deleted by the 1981 version. *Compare* Judicial Conf. of the U.S., *Handbook of Recommended Procedures for the Trial of Protracted Cases* 75 (West ed. 1960) with Federal Judicial Center, *Manual for Complex Litigation* 116 (5th ed. 1981).

[FN3] American Greetings Corp. v. Dan-Dee Imports, Inc., 619 F. Supp. 1204, 227 U.S.P.Q. 750, 756 (D.N.J. 1985), aff'd in part on other grounds, 807 F.2d 1136, 1 U.S.P.Q.2d 1001 (3d Cir. 1986) ("Neither Wolf/Altschul/Callaghan, Stewart Surveys, nor any other outside professional having experience in the design of consumer surveys had any role whatsoever in the design of the survey, which was entirely done by plaintiff's counsel. While not dispositive, this fact renders plaintiff's survey somewhat less weighty than it might otherwise be.").

[FN4] *See* J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 65 U.S.P.Q.2d 1897 (D.N.J. 2002), related reference, 2003 WL 21051711 (D.N.J. 2003) ("Above all, the survey's design must fit the issue which is to be decided by the jury, and not some inaccurate statement of the case, lest the survey findings inject confusion or inappropriate definitions into evidence, confounding rather than assisting the jury.").

[FN5] Reference Manual on Scientific Evidence, pp. 237–239 (Federal Judicial Center 2d ed. 2000).

MCCARTHY § 32:166

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

B. HEARSAY OBJECTION

References

§ 32:167. Hearsay objection—Lack of ability to cross-examine respondents

West's Key Number Digest

West's Key Number Digest, Trade Regulation 581

Some courts have been troubled by the fact that the survey answers are given ex parte to the interviewer without any opportunity for cross-examination of those interviewed as to what exactly they meant to say.[FN1] However, if the survey is fairly and scientifically conducted, loss of the ability to cross-examine interviewees should not detract from the probative value of the survey. As Judge Wyzanski remarked:

> So long as the interviewees are not cross-examined, there is no testing of their sincerity, narrative ability, perception and memory. There is no showing whether they were influenced by leading questions, the environment in which questions were asked, or the personality of the investigator, but where a court is persuaded that in a particular case all these risks have been minimized, that the answers given by the interviewees are, on the whole, likely to be reliable indicia of their states of mind, then the absence of cross-examination is not prejudicial, and that other ways of getting evidence on the same point are either impractical or burdensome, the testimony should be admitted.[FN2]

When the survey director is put on the stand, he or she can be cross-examined to determine such things as instructions given to the actual survey takers, whether the questions asked of respondents were posed in a biased or leading manner, and what the environment of the questioning was like. Some courts have said that the lack of interviewee cross-examination is outweighed by the necessity for survey evidence, since it is the only practicable way to ascertain consumer reaction for the purpose of litigation. As one court stated:

> The alternatives of having a much smaller section of the public testify (such as 80 witnesses) or using expert witnesses to testify as to the state of the public mind are clearly not as valuable because the inferences which can be drawn from such testimony to the public state of mind are not as strong or direct as the justifiable inference from a scientific survey.[FN3]

[FN1] Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 114 U.S.P.Q. 19 (5th Cir. 1957), cert. denied, 355 U.S. 894, 2 L. Ed. 2d 192, 78 S. Ct. 268, 115 U.S.P.Q. 427 (1957).

[FN2] American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958).

[FN3] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963).

MCCARTHY § 32:167

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

B. HEARSAY OBJECTION

References

§ 32:168. Hearsay objection—Survey data are not inadmissible as hearsay

West's Key Number Digest

West's Key Number Digest, Trade Regulation 581

Although some early cases held that survey evidence was inadmissible as hearsay,[FN1] since at least 1951[FN2] the cases are now unanimous that evidence of the state of mind of persons surveyed is not inadmissible as hearsay.[FN3] In a case often cited as authority for the rule that survey evidence is not inadmissible as hearsay, the Third Circuit stated:

> The hearsay objection is unfounded. For the statements of the persons interviewed were not offered for the truthfulness of their assertions. … They were offered solely to show as a fact the reaction of ordinary householders and others of the public generally when shown a bottle of Bireley's Orange Beverage. Only the credibility of those who took the statements was involved, and they were before the court. The technical adequacy of the surveys was a matter of the weight to be attached to them.[FN4]

Thus, as the Third Circuit indicated, the reason survey evidence is not hearsay is that it is not offered to prove the truth of what the respondents said, but merely to prove their state of mind. Similarly, the Tenth Circuit stated in a trademark infringement case:

> The hearsay objection is not well taken. The persons who did the interviewing testified as to the results of their surveys. Their testimony was offered solely to show what they found. Only the credibility of the persons who took the statements was involved and they were before the court. The technical adequacy of the surveys was a matter of the weight to be attached to them.[FN5]

While most courts will admit survey evidence because it does not constitute "hearsay," other courts will admit survey evidence as being "hearsay" but fitting within a recognized exception to the hearsay bar. While the outcome is the same, the route taken is different. As Leighton observed:

Today, most courts that admit otherwise proper surveys into evidence are divided into two camps: those that consider the survey results to be non-hearsay and those that consider them to be admissible hearsay under on of the hearsay exceptions.[FN6]

[FN1] Elgin Nat'l Watch Co. v. Elgin Clock Co., 26 F.2d 376 (D. Del. 1928).

[FN2] *See* United States v. 88 Cases, Bireley's Orange Beverage, 187 F.2d 967 (3d Cir. 1951), cert. denied, 342 U.S. 861, 96 L. Ed. 648, 72 S. Ct. 88 (1951).

[FN3] International Milling Co. v. Robin Hood Popcorn Co., 110 U.S.P.Q. 368 (Comm'r Pat. 1956); Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 114 U.S.P.Q. 19 (5th Cir. 1957), cert. denied, 355 U.S. 894, 2 L. Ed. 2d 192, 78 S. Ct. 268, 115 U.S.P.Q. 427 (1957); American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958); Standard Oil Co. v. Standard Oil Co., 252 F.2d 65, 116 U.S.P.Q. 176, 76 A.L.R.2d 600 (10th Cir. 1958); Great Atlantic & Pacific Tea Co. v. A. & P. Trucking Corp., 51 N.J. Super. 412, 144 A.2d 172, 118 U.S.P.Q. 560 (1958), modified on other grounds, 29 N.J. 455, 149 A.2d 595, 121 U.S.P.Q. 55 (1959); Prudential Ins. Co. v. Prudential Life & Casualty Ins. Co., 377 P.2d 556, 134 U.S.P.Q. 417 (Okla. 1962); Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963); Wembley, Inc. v. Diplomat Tie Co., 216 F. Supp. 565, 137 U.S.P.Q. 107 (D. Md. 1963); Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968) (many cases cited); Shulton, Inc. v. Mennen Co., 170 U.S.P.Q. 54, 56 (T.T.A.B. 1971); Ralston Purina Co. v. Quaker Oats Co., 169 U.S.P.Q. 508 (T.T.A.B. 1971); Holiday Inns, Inc. v. Holiday Out in America, 481 F.2d 445, 178 U.S.P.Q. 257 (5th Cir. 1973) (survey held of "slight weight" because of defects); La Maur, Inc. v. Alberto-Culver Co., 179 U.S.P.Q. 607 (D. Minn. 1973), aff'd, 496 F.2d 618, 182 U.S.P.Q. 10 (8th Cir. 1974), cert. denied, 419 U.S. 902, 42 L. Ed. 2d 148, 95 S. Ct. 186, 183 U.S.P.Q. 386 (1974); Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 523 F.2d 1331, 186 U.S.P.Q. 436 (2d Cir. 1975).

[FN4] United States v. 88 Cases, Bireley's Orange Beverage, 187 F.2d 967 (3d Cir. 1951), cert. denied, 342 U.S. 861, 96 L. Ed. 648, 72 S. Ct. 88 (1951) (food misbranding case involving consumer reaction to meaning of label). *Accord* Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, n.5, 4 U.S.P.Q.2d 1497, 1504 n.5 (10th Cir. 1987) ("Survey evidence may be admitted as an exception to the hearsay rule if the survey is material, more probative on the issue than other evidence and if it has guarantees of trustworthiness. … In a case such as this in which confusion ast to product source is a material issue, a survey may be the only available method of showing the public state of mind.").

[FN5] Standard Oil Co. v. Standard Oil Co., 252 F.2d 65, 116 U.S.P.Q. 176 (10th Cir. 1958). *Accord* Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 4 U.S.P.Q.2d 1497 (10th Cir. 1987) ("Some survey evidence may be admissible because it is not hearsay; the statements are not offered as proof of the matter asserted but as inference of the individual's state of mind.").

[FN6] R.J. Leighton, Using (and Not Using) the Hearsay Rules to Admit and Exclude Surveys in Lan-

ham Act False Advertising and Trademark Cases, 92 Trademark Rptr. 1305, 1309 (2002).

MCCARTHY § 32:168

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

B. HEARSAY OBJECTION

References

§ 32:169. Hearsay objection—Federal Rules of Evidence

West's Key Number Digest

West's Key Number Digest, Trade Regulation 581

With the adoption in 1975 of the Federal Rules of Evidence, any lingering doubts have dissipated as to the hearsay nature of survey evidence. Fed. R. Evid. 703 permits an expert (such as a professional taker of opinion and consumer reaction surveys) to form an opinion based on facts or data which are not admissible in evidence if the facts or data are of a type reasonably relied upon by experts in the field in forming opinions.

The Advisory Committee's notes state that this rule offers a more satisfactory basis for ruling upon the admissibility of public opinion poll evidence: "Attention is directed to the validity of the techniques employed rather than to relatively fruitless inquiries whether hearsay is involved."[FN1]

The modern view is that the hearsay objection is without merit and that any technical deficiencies in survey methodology go to its weight as evidence, not to its admissibility.[FN2] The survey director's testimony is essentially that of a scientist who has designed and carried out a scientific experiment and reports the results in court. The *Manual for Complex Litigation* agrees, taking the position that survey data are not inadmissible as hearsay because they fall within the state of mind exception:

> Objection is sometimes raised that an opinion survey, although conducted according to generally accepted statistical methods, involves impermissible hearsay. When the purpose of a survey is to show what people believe—but not the truth of what they believe—the results are not hearsay. In the rare situation where an opinion survey involves inadmissible hearsay, experts may nevertheless be allowed to express opinions based on the results of the survey.[FN3]

The Second Circuit agrees that "the great majority of surveys" in trademark cases are admissible.[FN4] The court remarked that the typical trademark survey is not excluded by the hearsay rule because it probes for the presently existing state of mind of respondents and therefore falls into the Fed. R. Evid. 803(3) state of mind ex-

ception:

> It is important for district courts to recognize surveys of this type because their qualification for a traditional hearsay exception obviates the need to examine methodology before overruling a hearsay objection. Regardless of the basis cited for admitting these surveys, errors in methodology thus properly go only to the weight of the evidence—subject, of course, to Rule 403's more general prohibition against evidence that is less probative than prejudicial or confusing.[FN5]

The Second Circuit noted that in a false advertising case, a survey falls within the 803(3) state of mind exception to the hearsay rule only if the questions are directed at eliciting the "main message" or mental impression that a prospective buyer absorbed from an advertising pitch.[FN6] However, if a survey is introduced to prove that a literally false statement was in fact made to a potential purchaser (such as by a pharmaceutical salesman to a physician), then this is hearsay not admitted under the 803(3) state of mind exception. Such a survey is designed to elicit memory statements to establish the occurrence of the remembered event. However, such a survey could be admissible under the "residual hearsay rule" of Fed. R. Evid. 807 if it meets five criter- ia.[FN7]

An opponent's survey and an employee's analysis of it were held to be admissible over a hearsay objection because in tandem, they constitute an admission against interest admissible under the Fed. R. Evid. 801(d)(2) hearsay exception.[FN8]

[FN1] Notes of Advisory Committee on Proposed Rules. *See* McElhaney, "Expert Witnesses and the Federal Rules of Evidence," 28 Mercer L. Rev. 463, 481 (1977) (Rule 703 "is virtually a major new exception to the hearsay rule").

[FN2] Scott Paper Co. v. Scott's Liquid Gold, Inc., 439 F. Supp. 1022, 195 U.S.P.Q. 707, 723 n.51 (D. Del. 1977), rev'd and dismissed on other grounds, 589 F.2d 1225, 200 U.S.P.Q. 421 (3d Cir. 1978); Sheller-Globe Corp. v. Scott Paper Co., 204 U.S.P.Q. 329 (T.T.A.B. 1979) (survey published in trade magazine is admissible under Fed. R. Evid. 803(17)); SquirtCo v. Seven-Up Co., 628 F.2d 1086, 207 U.S.P.Q. 897 (8th Cir. 1980); Wuv's International, Inc. v. Love's Enterprises, Inc., 208 U.S.P.Q. 736 (D. Colo. 1980) (listing four theories under which surveys are admissible in evidence); McDonough Power Equipment, Inc. v. Weed Eater, Inc., 208 U.S.P.Q. 676 (T.T.A.B. 1981); Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, n.7, 217 U.S.P.Q. 988 (5th Cir. 1983); Prudential Ins. Co. v. Gibraltar Financial Corp., 694 F.2d 1150, 217 U.S.P.Q. 1097 (9th Cir. 1982), cert. denied, 463 U.S. 1208, 77 L. Ed. 2d 1389, 103 S. Ct. 3538 (1983); Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984) (survey results are not inadmissible into evidence as "hearsay": the results are reports of state of mind of the interviewees and form the basis of the expert opinion of the survey director, citing Fed. R. Evid. 703, 803(3)); Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 227 U.S.P.Q. 257 (S.D.N.Y. 1985), aff'd without op., 788 F.2d 3 (2d Cir. 1986) (in a non-jury trial, the better course is to receive the survey into evidence and to ignore it or give it such weight as the court thinks appropriate); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 4 U.S.P.Q.2d 1497 (10th Cir. 1987) (survey evidence is admissible as an exception to the hearsay rule and "a survey may be the only available method of showing the public state of mind").

[FN3] *Manual for Complex Litigation*, Third § 21.493, p. 103 (1995). Fed. R. Evid. 803(3) codifies the classic rule of evidence that a statement of the declarant's state of mind is an exception to the hearsay rule.

[FN4] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1716, 52 Fed. R. Evid. Serv. 1, 173 A.L.R. Fed. 685 (2d Cir. 1999). Followed in: Bacardi & Co. Ltd. v. New York Lighter Co., Inc., 54 U.S.P.Q.2d 1335, 54 Fed. R. Evid. Serv. 380 (E.D. N.Y. 2000) (traditional likelihood of confusion survey results are admissible under the state of mind exception of Fed. R. Evid. 803(3), following *Schering*.).

[FN5] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1712 (2d Cir. 1999) ("[S]tatements falling under Rule 803(3)'s exception for presently-existing states of mind rarely suffer from the risks of faulty memory because they are made when the declarant is in the relevant state and they bear minimal risk of faulty perception because speakers generally know their own states of mind."). *But see* Ortho Pharmaceutical Corp. v. Cosprophar, Inc., 828 F. Supp. 1114, 29 U.S.P.Q.2d 1103 (S.D.N.Y. 1993), aff'd, 32 F.3d 690, 695-96 (2d Cir. 1994) (lack of adequate foundation prevented in-house corporate survey from being introduced under the Rule 803(5) business records exception to the hearsay rule).

[FN6] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1713 (2d Cir. 1999) ("[T]he mental impressions with which an audience is left can be relevant, and sometimes even necessary, to establish what a defendant is implying in a challenged representation.").

[FN7] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1715-1720 (2d Cir. 1999) (remanding case for consideration under the five criteria of trustworthiness, materiality, probative importance, the interests of justice and notice. *See* W.W. Vodra & R.K. Miller, "Did He Really Say That?" Survey Evidence in Deceptive Advertising Litigation, 92 Trademark Rptr 794 (2002).

[FN8] Schering Corp. v. Pfizer Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1720 (2d Cir. 1999) (Because the analysis drew inferences from the survey it constituted an admission against interest and validated the survey and thus the opponent could introduce both into evidence, but the court cautioned: "A party admission may, however, be inadmissible when it merely repeats hearsay and thus fails to concede its underlying truthfulness.").

MCCARTHY § 32:169

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:170. Tests of properly conducted survey—Effect of deficiencies in survey methodology

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Survey evidence has sometimes been received grudgingly by the courts, and given little weight because of deficiencies in the manner of conducting the survey. Certainly, if the survey questions are not congruent with the issues in the case, the results will not only be irrelevant, but may also be prejudicially misleading to a jury:

> Above all, the survey's design must fit the issue which is to be decided by the jury, and not some inaccurate statement of the case, lest the survey findings inject confusion or inappropriate definitions into evidence, confounding rather than assisting the jury.[FN1]

In an extreme case, an improperly conducted survey with slanted questions or serious methodological defects may be excludable as "irrelevant" of the true state of mind of potential purchasers.[FN2] The Fifth Circuit has said that if the flaws in survey structure or methodology are serious enough, then the survey should be given no weight as evidence and the survey cannot prevent summary judgment against the party introducing the sur- vey:

> In some cases, however, serious flaws in a survey will make any reliance on that survey unreasonable … Otherwise, any survey, no matter how tendentious, would force the parties to trial. … No reasonable jury could view the proffered survey as evidence of confusion among relevant consumers.[FN3]

The majority rule is that while technical deficiencies can reduce a survey's weight, they will not prevent the survey from being admitted into evidence.[FN4] This is especially true in a non-jury case.[FN5] As one court correctly observed, "No survey is perfect" and flaws in questions and methodology should only affect the weight accorded survey results.[FN6]

The Ninth Circuit has observed that once a survey has passed the threshold criteria of having a proper foundation, being relevant and having been conducted according to accepted principles, it can be admitted into evidence. Thereafter, flaws in the survey go to the weight, not admissibility, of the evidence: "Once the survey is admitted, however, follow-on issues of methodology, survey design, reliability, critique of conclusions and the like go to the weight of the survey rather than its admissibility."[FN7]

In a survey where the methodology of sampling, questioning and reporting is casual and informal, the probative worth of the survey may be "minuscule"[FN8] or of "little weight."[FN9]

Standard procedures are used to ensure that the survey was administered in such a manner as to minimize error and bias.[FN10] Monitoring some interviews while in progress is a method commonly used for telephone interviews. Any doubts as to whether the recorded responses accurately reflect actual interviews can be dissipated by validation checks, which are common survey procedure. A validation check determines whether interviews were conducted, whether respondents qualified for the interview and, in some instances, whether the interviews were conducted in the proper manner. Validation is usually accomplished by contacting a sample of respondents (e.g. 15%) to quiz them as to their survey experience.[FN11] Another validation method is to compare the work done by individual interviewers for unexplained variations.

[FN1] J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 65 U.S.P.Q.2d 1897, 1905 (D.N.J. 2002), related reference, 2003 WL 21051711 (D.N.J. 2003) (Where the issue was the possible descriptiveness of a designation used on products advertised and sold only to commercial food distributors, a survey using inaccurate terminology and asked of consumers at shopping malls was held to be of the wrong universe and inadmissible at the summary judgment motion stage.); Trouble v. Wet Seal, Inc., 179 F. Supp. 2d 291, 69 U.S.P.Q.2d 1603, 58 Fed. R. Evid. Serv. 509 (S.D. N.Y. 2001) (conducting survey in mall where defendant's stores were located surveys the wrong universe because while both parties are wearing apparel sellers, they cater to entirely different socioeconomic markets. Survey was excluded from evidence. "A survey, however, must be excluded from evidence under FRE 403 where it is so flawed in methodology that its probative value is substantially outweighed by its prejudicial effect.").

see K.A. Plevan, Daubert's Impact on Survey Experts in Lanham Act Litigation, 95 Trademark Rptr. 596 (2005) (Of the 44 cases over an eight year period (1997–2004) that were examined, in 14 cases surveys were excluded from evidence or accorded no weight at all. In all 14 cases a jury trial had been demanded, generally by the party offering the survey evidence.).

[FN2] Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 114 U.S.P.Q. 19 (5th Cir. 1957), cert. denied, 355 U.S. 894, 2 L. Ed. 2d 192, 78 S. Ct. 268, 115 U.S.P.Q. 427 (1957) (2-1 decision on admissibility); Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc., 559 F. Supp. 1189, 217 U.S.P.Q. 1137 (E.D.N.Y. 1983) (while holding for plaintiff, court excluded plaintiff's survey from evidence, finding several deficiencies in methodology); Starter Corp. v. Converse, Inc., 170 F.3d 286, 50 U.S.P.Q.2d 1012 (2d Cir. 1999) (it was proper for district court to exclude a survey from evidence before the jury because the survey questions were irrelevant: "[A]ny probative value of the survey was outweighed by its potential to confuse the issues in the case.").

[FN3] Scott Fetzer Co. v. House of Vacuums Inc., 381 F.3d 477, 72 U.S.P.Q.2d 1011 (5th Cir. 2004) (affirming summary dismissal of trademark infringement claim). *Accord*: Citizens Financial Group, Inc. v. Citizens Nat. Bank of Evans City, 383 F.3d 110, 72 U.S.P.Q.2d 1389, 65 Fed. R. Evid. Serv. 350 (3d Cir. 2004), cert. denied, 544 U.S. 1018, 125 S. Ct. 1975, 161 L. Ed. 2d 857 (2005) (Survey was properly excluded because of flaws in structure. "The court in this case concluded that Reitter's survey did not suffer from mere technical flaws, but from fatal flaws. Thus, the court appropriately fulfilled its duty as a gatekeeper in excluding this evidence.").

[FN4] Jellibeans, Inc. v. Skating Clubs of Georgia, Inc., 716 F.2d 833, 222 U.S.P.Q. 10, 20 (11th Cir. 1983) ("These alleged technical deficiencies affect the survey's weight, however, and not is admissibility. … Therefore, the district court properly admitted the survey evidence, however flawed. … Notwithstanding its technical deficiencies, the survey evidence is … probative."); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254, 2 U.S.P.Q.2d 1677 (2d Cir. 1987) (criticisms of statistical deficiencies in a survey only affect the weight to be accorded the survey evidence, not its admissibility); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 4 U.S.P.Q.2d 1497 (10th Cir. 1987) (technical and methodological deficiencies "relate not [to] the survey's admissibility but to the weight to be given such evidence"); E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280 (9th Cir. 1992) ("[I]t is routine to admit a relevant survey; and technical unreliability goes to weight, not admissibility."); AHP Subsidiary Holding Co. v. Stuart Hale Co., 1 F.3d 611, 27 U.S.P.Q.2d 1758, 1764 (7th Cir. 1993) ("[A]ny shortcomings in the survey results go to the proper weight of the survey and should be evaluated by the trier of fact."); Southland Sod Farms v. Stover Seed Co., 108 F.3d 1134, 42 U.S.P.Q.2d 1097 (9th Cir. 1997) (objections that survey in false advertising case was only conducted in one location and asked leading questions "go only to the weight and not the admissibility of the survey").

[FN5] Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 557 (S.D.N.Y. 1991) (in a non-jury case it is appropriate to admit the survey data into evidence but determine how much weight to accord them; court concluded that data were "not entitled to significant weight" because of defects in survey).

[FN6] Selchow & Righter Co. v. Decipher, Inc., 598 F. Supp. 1489, 225 U.S.P.Q. 77 (E.D. Va. 1984) (survey relied upon to find likely confusion).

[FN7] Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 58 U.S.P.Q.2d 1881 (9th Cir. 2001).

[FN8] King Research, Inc. v. Shulton, Inc., 324 F. Supp. 631, 169 U.S.P.Q. 396 (S.D.N.Y. 1971), aff'd, 454 F.2d 66, 172 U.S.P.Q. 321 (2d Cir. 1972).

[FN9] Exxon Corp. v. Xoil Energy Resources, Inc., 552 F. Supp. 1008, 216 U.S.P.Q. 634, n.16 (S.D.N.Y. 1981) (an informal survey taken by associates in plaintiff's law firm was accorded "no weight" because of survey deficiencies); Amstar Corp. v. Domino's Pizza, Inc., 205 U.S.P.Q. 128, 142, 1979 WL 25080 (N.D. Ga. 1979), rev'd, 615 F.2d 252, 205 U.S.P.Q. 969, 979 (5th Cir. 1980), cert. denied, 449 U.S. 899, 66 L. Ed. 2d 129, 101 S. Ct. 268, 208 U.S.P.Q. 464 (1980) ("This unfair and biased survey is not entitled to any weight or credibility as evidence of confusion."); American Greetings Corp. v. Dan-Dee Imports, Inc., 619 F. Supp. 1204, 227 U.S.P.Q. 750, 756 (D.N.J. 1985), aff'd in part on other grounds, 807 F.2d 1136, 1 U.S.P.Q.2d 1001 (3d Cir. 1986) ("[T]he questions asked were biased and … the survey itself was performed in a haphazard and unprofessional manner. Accordingly,

the court gives little weight to plaintiff's survey."); Hilson Research, Inc. v. Society for Human Resources Management, 27 U.S.P.Q.2d 1423, 1437, 1993 WL 290669 (T.T.A.B. 1993) (questionnaire passed out by client to persons attending trade shows is not a proper "survey" and "is not entitled to any weight"); Missiontrek Ltd. Co. v. Onfolio, Inc., 80 U.S.P.Q.2d 1381, 2005 WL 3395187 (T.T.A.B. 2005), aff'd, 208 Fed. Appx. 858 (Fed. Cir. 2006) (nonprecedential) (e-mail survey sent to 42 customers by the senior user was not accorded any weight because it was not based on established survey techniques, was administered by a party to the case and was not analyzed in any statistically significant way).

[FN10] Reference Manual on Scientific Evidence, 267 (Federal Judicial Center 2d ed. 2000).

[FN11] *See* Paco Sport, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305, 54 U.S.P.Q.2d 1205 (S.D. N.Y. 2000), judgment aff'd, 234 F.3d 1262 (2d Cir. 2000) ("The purpose of validation is to identify the interviewers who had probably fabricated the answers instead of completing interviews in accordance with instructions." Validation of only 17% of interviews conducted was criticized as inadequate and "cast further doubt on the reliability" of the survey.).

MCCARTHY § 32:170

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:171. Tests of properly conducted survey—Examples of methodological deficiencies

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Various deficiencies in the mechanics of surveys have been criticized by the courts, leading them to give a survey little weight as evidence. Such deficiencies include the following:

Location Problems. Questioning consumers in a supermarket where the interviewee could see, or had just seen, the goods and labels in question;[FN1] questioning interviewees who had just purchased plaintiff's product.[FN2]

Irrelevant Questions or Exhibits. Examples of the use of irrelevant questions or exhibits in surveys include:
• Asking a question that is not relevant to the issue to be resolved[FN3] or asking an ambiguous question.[FN4]
• Showing interviewees photographs which are not true representations of the product as actually sold.[FN5] Similar is questioning interviewees about a web page image that differs from the actual web page in issue.[FN 6]
• Questioning interviewees as to their reaction to the source of goods without showing them the point-of-purchase display cards which are always present in stores.[FN7]
• Asking questions about a logo without showing the logo as it appeared on the product.[FN8]
• Asking questions about the conflicting marks as they appeared printed on index cards, divorced from packaging and house marks.[FN9]
• Asking questions about an unpackaged product which is always seen in actual purchasing conditions in its distinctive packaging.[FN10]
• Giving respondents less information than they would actually receive in a real purchasing situation.[FN11]
• Trying to prove secondary meaning for trade dress in a particular product feature by showing interviewees the whole product, which included nonprotectable, functional features.[FN12]
• Directing survey questions at consumer response to labels not bearing the trademark in issue.[FN13]

• Showing respondents the conflicting branded products side-by-side and asking if they were made by the same company where that is not how the products appeared in the marketplace.[FN14]
• Asking persons if they found a term in the abstract to be offensive, when the statutory bar was whether the term when used as a trademark was disparaging.[FN15]

Personnel and Tabulation Problems. Treating inconclusive responses as definite, unqualified responses in final survey tabulations.[FN16] Using low paid, part-time, nonprofessional investigators who may have exercised poor judgment in interpreting ambiguous interviewee responses,[FN17] failing to verify the validity of responses,[FN18] or changing recorded responses and failing to record unfavorable responses.[FN19]

Bias Problems. The fact that a survey is conducted specifically for the purpose of creating evidence for this litigation does not lessen its weight in any way.[FN20] Some courts have found a problem with inducing survey responses by flattering letters and by offers of prizes in return for prompt replies,[FN21] or by discounts on products.[FN22] The courts fail to explain how such modest and minimal inducements could skew results.

Timing Problems. Conducting a survey to prove plaintiff's secondary meaning at the time of defendant's entry into the market, where the survey was taken some years later.[FN23] The Sixth Circuit held that where the critical date to determine secondary meaning was some years in the past, a survey taken today should not be ignored, but should be given whatever weight the decision-maker thinks is appropriate. As the court remarked, this is "the appropriate choice, given the relatively unlikely scenario that a company has conducted a pre-infringement survey and this court's strong support for survey evidence in evaluating secondary mean- ing."[FN24]

Copyright Problems. In some survey formats, to replicate actual materials as used in the marketplace, a party will reproduce and use in the survey an advertisement or promotional piece of its adversary. It has been held that such a use constitutes an exempt "fair use" that is not an infringement of the adversary's copyright in the advertisement or promotional materials.[FN25]

Memory Tests. A survey which does little more than test respondents' memory of a controlled exposure to a trademark stimulus has been held to prove "something, but not very much."[FN26] In that case, in Phase One, respondents were shown advertisements of four companies, including the plaintiff. Then in Phase Two, respondents were shown advertising promotions of three companies, including defendant and asked, "Was there a product or service in the booklet I showed you [in Phase One] that is from the same source or company as [shown in this exhibit in Phase Two]?" Positive answers linking plaintiff and defendant were counted by the survey taker as evidence of likely confusion. A "noise" or "error" rate was developed which was then deducted.[FN27] The court found that the results were only of "slightly probative value."[FN28]

Insufficient Number of Respondents. Conducting a survey with a number of respondents too small to justify a reasonable extrapolation to the target group at large will lessen the weight of the survey.[FN29]

[FN1] Marcalus Mfg. Co. v. Watson, 156 F. Supp. 161, 115 U.S.P.Q. 232 (D.D.C. 1957), aff'd, 258 F.2d 151, 118 U.S.P.Q. 7 (D.C. Cir. 1958) (questions related to the secondary meaning of a background symbol, and interviewees were in a supermarket where they could see that symbol with a word mark imposed on it). *Compare* La Maur, Inc. v. Revlon, Inc., 245 F. Supp. 839, 146 U.S.P.Q. 654 (D. Minn.

1965) (survey questions asked in store, but not near counter carrying products in issue); Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharmaceuticals Co., 129 F. Supp. 2d 351, 57 U.S.P.Q.2d 1522 (D.N.J. 2000), judgment aff'd, 290 F.3d 578, 62 U.S.P.Q.2d 1757 (3d Cir. 2002) (In a false advertising survey "the Court finds that leaving the products for the respondents to examine rather than taking the products away replicates market conditions.").

[FN2] Aerojet-General Corp. v. Cincinnati Screen Process Supplies, Inc., 172 U.S.P.Q. 114, 1971 WL 16663 (S.D. Ohio 1971) (the court saying that the issue is confusion before purchase, not after pur- chase).

[FN3] National Football League v. Governor of Delaware, 435 F. Supp. 1372, 195 U.S.P.Q. 803, 807 (D. Del. 1977) (Asking persons if they thought the reputation of the NFL would suffer if legalized betting on NFL games was run by a state agency in each state. The issue in the case was whether one state's lottery games will injure the NFL reputation. "The question asked in the 'national' survey addressed a far broader subject which the plaintiffs have not shown to be relevant."); Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 227 U.S.P.Q. 257 (S.D.N.Y. 1985), aff'd without op., 788 F.2d 3 (2d Cir. 1986) (Asking respondents whether defendant's magazine might be a regional version of plaintiff's magazine is irrelevant to the issue of a likelihood, or probability, of confusion: "Might," on the scale of probabilities, occupies a low station. "Might," suggests what is possible, not what is probable or likely."); J & J Snack Foods, Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 65 U.S.P.Q.2d 1897 (D.N.J. 2002), related reference, 2003 WL 21051711 (D.N.J. 2003) (survey questions using inaccurate definition of a "descriptive" mark: survey held inadmissible); Tea Board of India v. The Republic of Tea, Inc., 80 U.S.P.Q.2d 1881, 2006 WL 2460188 (T.T.A.B. 2006) (Asking respondents "What is Darjeeling tea?" to determine if it is a generic name did not elicit relevant responses.).

[FN4] Scotts Co. v. United Industries Corp., 315 F.3d 264, 65 U.S.P.Q.2d 1161, 2002-2 Trade Cas. (CCH) P 73911, 60 Fed. R. Evid. Serv. 330 (4th Cir. 2002) (Ambiguous question did not go the issue of alleged falsity of the challenged advertisement: "[T]hose responses shed no light on the question that is key to [plaintiff's] false advertising claims … .").

[FN5] American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supplemental op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958); Scotts Co. v. United Industries Corp., 315 F.3d 264, 65 U.S.P.Q.2d 1161, 2002-2 Trade Cas. (CCH) P 73911, 60 Fed. R. Evid. Serv. 330 (4th Cir. 2002) (It is improper to show interviewees only part of a package in a false advertising case where the issue is consumer reaction to the advertisement as a whole and in context.). *Compare* Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947, 24 U.S.P.Q.2d 1001, 1012 (7th Cir. 1992), cert. denied, 507 U.S. 1042, 123 L. Ed. 2d 497, 113 S. Ct. 1879 (1993) (not error to use a stimulus in survey which is not found in the marketplace where defendant's conduct preventing plaintiff from marketing a product in the national market).

[FN 6] Government Employees Ins. Co. v. Google, Inc., 77 U.S.P.Q.2d 1841, 2005 WL 1903128 (E.D. Va. 2005) (This, along with "other weaknesses" in the survey gave the court "serious doubts about the accuracy of the survey results' reflection of actual user's experiences with and reactions to the Sponsored Links.").

[FN7] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963).

[FN8] Pilot Corp. of America v. Fisher-Price, Inc., 344 F. Supp. 2d 349, 73 U.S.P.Q.2d 1030 (D. Conn. 2004) ("That two logos may be confusing when viewed in isolation does not show that their use on two separate products is also confusing." Also, the logo shown in the interviews left out possibly distinguishing wording that always appeared with the logo in the marketplace.).

[FN9] Playtex Products, Inc. v. Georgia-Pacific Corp., 390 F.3d 158, 73 U.S.P.Q.2d 1127 (2d Cir. 2004) (Because the stimulus shown to interviewees did not replicate the marks in context as "presented and packaged" in the marketplace, the survey results were not relevant.); Juicy ZCouture, Inc. v. L'Oreal USA, Inc., 2006 WL 1012939 (S.D. N.Y. 2006) (respondents were shown 8 1/2 by 11 inch cards bearing only the accused word marks. Court said this was a "fundamental flaw" in the survey design because it did not "replicate the market conditions" in which the accused marks were encountered where the defendant's house mark LANCOME was prominently displayed.).

[FN10] Original Appalachian Artworks, Inc. v. Blue Box Factory (USA), Ltd., 577 F. Supp. 625, 222 U.S.P.Q. 593 (S.D.N.Y. 1983) (survey question about the source of defendant's unpackaged doll was not relevant because in actual purchasing conditions, customers see the doll in distinctive packaging).

[FN11] Mastercard Intern. Inc. v. First Nat. Bank of Omaha, Inc., 2004 WL 326708 (S.D. N.Y. 2004), related reference, 2004 WL 1575396 (S.D. N.Y. 2004) (bank employees were told it would take 10-15 minutes to complete an online survey about choosing a smart card program for the bank. "This exercise bears little resemblance to the lengthy and thoughtful decision-making process that occurs in the real world when large financial institutions make determinations about the services they provide to customers.").

[FN12] Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 36 U.S.P.Q.2d 1065, 1072 (7th Cir. 1995), ("A survey which asks consumers to identify the source of a product based on its overall configuration when most of the product's configuration is functional is worthless in determining whether a particular product feature has acquired a secondary meaning."), later proceedings, 138 F.3d 277, 46 U.S.P.Q.2d 1026 (7th Cir. 1998) (plaintiff took a later survey to change the stimulus shown respondents); OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 43 U.S.P.Q.2d 1641 (Fed. Cir. 1997) (likelihood of confusion survey that focused on both functional and ornamental aspects was not probative of trade dress infringement; results showing confusion due to functional similarities in the products are not probative of trade dress infringement).

[FN13] In re Riviana Foods, Inc., 160 U.S.P.Q. 757, 1969 WL 9021 (T.T.A.B. 1969) (survey evidence rejected as not probative); Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 167 U.S.P.Q. 713 (9th Cir. 1970); Jenkins Bros. v. Newman Hender & Co., 289 F.2d 675, 129 U.S.P.Q. 355 (C.C.P.A. 1961) (when interviewee shown whole product or label, it is uncertain which part motivates responses).

[FN14] Jordache Enters. v. Hogg Wyld, Ltd., 828 F.2d 1482, 4 U.S.P.Q.2d 1216 (10th Cir. 1987) (giving survey respondents the products side-by-side and asking if they thought the products were produced by the same manufacturer "bears little resemblance to the actual workings of the marketplace," making the survey results entitled to only "little weight" as evidence). *Compare* Gucci v. Gucci Shops, 688 F. Supp. 916, 7 U.S.P.Q.2d 1833 (S.D.N.Y. 1988) (Showing interviewees several cards with fam-

ous designer trademarks on them and asking questions about the products sold under those marks is an appropriate survey method. The survey results are entitled to "significant weight.").

[FN15] Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 132, 68 U.S.P.Q.2d 1225, 1253 (D.D.C. 2003), remanded on the laches alternative ground, 415 F.3d 44, 75 U.S.P.Q. 2d 1525 (D.C. Cir. 2005).

[FN16] General Motors Corp. v. Cadillac Marine & Boat Co., 226 F. Supp. 716, 140 U.S.P.Q. 447 (W.D. Mich. 1964); National Biscuit Co. v. Princeton Mining Co., 137 U.S.P.Q. 250 (T.T.A.B. 1963), aff'd, 338 F.2d 1022, 143 U.S.P.Q. 422 (C.C.P.A. 1964). *See* Hershey Foods Corp. v. Cerreta, 195 U.S.P.Q. 246, 1977 WL 22535 (T.T.A.B. 1977) (survey was designed by party to suit; it had ambiguous questions and answers; and interviewers referred to party's name); Waples-Platter Cos. v. General Foods Corp., 439 F. Supp. 551, 196 U.S.P.Q. 50 (N.D. Tex. 1977) (ambiguous questions); Revlon Consumer Prods. Corp. v. Jennifer Leather Broadway, Inc., 858 F. Supp. 1268, 32 U.S.P.Q.2d 1659 (S.D.N.Y. 1994), aff'd without op., 57 F.3d 1062 (2d Cir. 1995) (methodological and coding defects; survey held entitled to no weight).

[FN17] Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969).

[FN18] Sheller-Globe Corp. v. Scott Paper Co., 204 U.S.P.Q. 329, 1979 WL 24890 (T.T.A.B. 1979) (several defects of methodology in conduct of mail survey found to result in no weight accorded survey; defects included failure to check on accuracy and validity of responses, no check on who completed mail questionnaire, and insufficient explanation of selection of sample).

[FN19] Amstar Corp. v. Domino's Pizza, Inc., 205 U.S.P.Q. 128, 142, 1979 WL 25080 (N.D. Ga. 1979), rev'd, 615 F.2d 252, 205 U.S.P.Q. 969, 979 (5th Cir. 1980), cert. denied, 449 U.S. 899, 66 L. Ed. 2d 129, 101 S. Ct. 268, 208 U.S.P.Q. 464 (1980) ("In the Darden study, there were a substantial number of erasures and changes in the recorded answers. There was a deliberate failure to record the answers of persons who obviously were confused. Interviewees were counted who should have been disqualified as a result of young age, relationship with defendants, or knowledge of this litigation. This unfair and biased survey is not entitled to any weight or credibility as evidence of confusion.").

[FN20] United States Surgical Corp. v. Orris, Inc., 983 F. Supp. 963, 45 U.S.P.Q.2d 1125 (D. Kan. 1997) ("It is axiomtic that a court may admit such a survey despite its being conducted for the purpose of litigation.").

[FN21] Dupont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2d Cir. 1936), cert. denied, 299 U.S. 601, 81 L. Ed. 443, 57 S. Ct. 194 (1936) (the court stated that responses in such a survey "might well have been stimulated by such inducements").

[FN22] Kroger Co. v. Johnson & Johnson, 570 F. Supp. 1055, 223 U.S.P.Q. 29 (S.D. Ohio 1983) (Junior user's 152 affidavits from customers that they were not confused were not given much weight because of possible bias: those persons received a double rebate on price paid for the product as an inducement to be interviewed. However, senior user's five-second viewing survey of a shelf of junior user's products was given weight as evidence of likely confusion: substantial percentage of persons said they saw senior user's TYLENOL on the shelf when in fact it was not there.).

[FN23] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963). *Contra* Faberge, Inc. v. Saxony Products, Inc., 605 F.2d 426, 204 U.S.P.Q. 359 (9th Cir. 1979) (held that trial court's reliance on 1974 consumer survey, along with other evidence, to prove secondary meaning in 1970 was not error and finding of 1970 secondary meaning was not clearly erroneous).

[FN24] General Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405, 80 U.S.P.Q.2d 1608, 2006 FED App. 0393P (6th Cir. 2006), cert. denied, 2007 WL 2819747 (U.S. 2007) (The critical date for secondary meaning was 1992 and surveys were conducted in 1999 and 2002, yielding recognition rates of 96% and 77%. Given those high rates, the court held that the surveys were sufficient to support a finding of secondary meaning in trade dress in the grille and overall design of General Motor's HUMMER and HUMVEE vehicles. Infringement was found.).

[FN25] Lucent Information Management, Inc. v. Lucent Technologies, Inc., 5 F. Supp. 2d 238, 48 U.S.P.Q.2d 1041 (D. Del. 1998) (defendent in a trademark infringement suit ran a survey using a reproduction of an actual promotional letter sent out by plaintiff; plaintiff supplemented the complaint to add a claim for infringement of copyright in the letter; the claim was dismissed on the ground that the reproduction was a fair use).

[FN26] Franklin Resources, Inc. v. Franklin Credit Management Corp., 988 F. Supp. 322, 45 U.S.P.Q.2d 1872, 1884 (S.D.N.Y. 1997) ("I think that [the survey] evidence is of slight probative value." No likelihood of confusion was found and the court held for defendant.). *See* Starter Corp. v. Converse, Inc., 170 F.3d 286, 50 U.S.P.Q.2d 1012 (2d Cir. 1999) (it was proper for district court to exclude survey from evidence before the jury because the survey questions were irrelevant. Survey question was characterized as "little more than a memory test" which was not probative of the likelihood of confusion issue).

[FN27] An "error rate" was developed by treating as "errors" those respondents who "incorrectly" failed to link two ads from the same company and who "incorrectly" linked a mark in Phase Two with Phase One even though that mark did not appear in Phase One.

[FN28] The survey "proves that most of the respondents could read the name "Franklin" in the booklet and remember it long enought to recognize the name when shown one of the three letters immediately thereafter. … Surveys which do nothing more than demonstrate the respondents' ability to read are not probative on the issue of likelihood of confusion." 45 U.S.P.Q.2d at 1883.

[FN29] Lisa Frank, Inc. v. Impact Int'l, Inc., 799 F. Supp. 980, 994 (D. Ariz. 1992) (sample of only 32 persons reduced evidentiary weight accorded the survey, but was "some probative evidence" of a likelihood of confusion in support of a preliminary injunction. "Due to the small sample size, the survey results cannot be accorded great weight."); Schieffelin & Co. v. Jack Co. of Boca, Inc., 850 F. Supp. 232, 31 U.S.P.Q.2d 1865 (S.D. N.Y. 1994)(survey of 200 was pared down to 176 after verification of responses: survey was relied upon because results were not compromised by the reduction in size); In Re Kimpton Hotel and Restaurant Group, Inc., 55 U.S.P.Q.2d 1154, 2000 WL 562603 (Trademark Trial & App. Bd. 2000) (survey of 100 respondents was an "insufficient number of survey respondents."); Mastercard Intern. Inc. v. First Nat. Bank of Omaha, Inc., 2004 WL 326708 (S.D. N.Y. 2004), related reference, 2004 WL 1575396 (S.D. N.Y. 2004) (survey excluded in jury trial because of, among other issues, small number of respondents: "[T]he number of respondents surveyed is too small to provide

meaningful results … . Only 52 respondents completed the survey, resulting in just 27 individuals reviewing the test cell materials and 25 individuals commenting on the control group materials."); Jacob Zimmerman v. National Association of Realtors, 70 U.S.P.Q.2d 1425, 2004 WL 763936 (T.T.A.B. 2004) (96 survey subjects are too few, and along with other criticism and defects, led to survey being accorded "very little weight."); AutoZone, Inc. v. Tandy Corp., 373 F.3d 786, 71 U.S.P.Q.2d 1385, 2004 FED App. 0200P (6th Cir. 2004) (Survey of 110 respondents: "[I]t is questionable whether the results are statistically significant given the small number of respondents."); In re Spirits International N.V., 86 U.S.P.Q.2d 1078, 1089, 2008 WL 375723 (T.T.A.B. 2008) (mall intercept survey of 231 persons is "rather small" and "provides limited information about consumer views").

MCCARTHY § 32:171

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:172. Tests of properly conducted survey—Slanted or leading questions—Avoiding leading questions

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Implying a Connection. Survey questions should not be slanted or leading.[FN1] Some commentators[FN2] and courts have indicated that it is improperly leading to imply that there could be a business relationship where the respondent may previously have not thought of any such connection. For example, the question: "Do you think that there may or may not be a business connection between Beneficial Capital Corp. and the Beneficial Finance System Companies?" was rejected as a leading question, "not well suited to eliciting an uninfluenced reaction."[FN3] Similarly, in a secondary meaning survey, it is leading to phrase the question in a way that presumes that the designation identifies some single source.[FN4]

However, other courts have found nothing improperly leading in a question asking if the respondent thinks there is or is not a connection between the owners of the contesting marks.[FN5]

It may be improperly leading to expose the surveyed person to a desired response before asking the critical question about a connection between the owners of the contesting marks. Responses were given little weight by the court in a survey where questions twice exposed respondent to both parties' marks before asking the question: "Do you feel that there is some connection between Penta Hotels and Penta Tours or do you feel that there is no connection between these companies?" The Court said that the questions were "designed and placed in such a sequence so as to elicit the intended response."[FN6] Similarly, in a secondary meaning survey, it was held to be improperly leading to phrase the question in a way that presumes that the designation identifies some single source.[FN7]

A critical survey question may be slanted if it has been preceded by questions which lead the interviewee "along the garden path" to the desired response. For example, a question "What brand do you think of when you hear this slogan?" was held slanted where previous questions had already mentioned the critical brand name.[FN8] Similar examples include: preceding the critical question by questions which, if correctly answered,

elicited the trademark which was a favorable response to the critical question;[FN9] and presenting respondents with particular similarities between the marks rather than letting persons questioned respond to the marks as a whole.[FN10] In the same vein is directing a questionnaire to sympathetic retailers, telling them about the pending litigation, and asking them to respond to a question like: "Would it be in your opinion that (sic) the use of the name SLEEX upon girdles for women would import a derogatory effect to slacks sold under the identical trademark for men so that men would not buy the slacks merchandised under that name?" This is obviously a leading question, with a favorable response prompted by the retailers' self-interest. It also asks for a retailer's opinion about the mental reactions of consumers.[FN11]

Open-Ended Questions About Brands. Caution must be exercised in evaluating the results of some open-ended survey questions about brands because respondents who merely guess will likely just play back the names of the best-known and dominant brands.[FN12]

The Importance of Phrasing of Questions. As every trial lawyer knows, the phrasing of the question will determine the content of the answer by the witness. So also with survey questions. For example, Prof. Presser at the University of Maryland tested responses to a subtle difference in question phraseology. Presser asked half his sample the question: "Do you think the United States should *allow* public speeches against democracy?" and the other half, "Do you think the United States should forbid public speeches against democracy?" In the first sample, 56% said no, the U.S. should not "allow" public speeches against democracy, but in the second sample, only 39% said yes, the U.S. should "forbid" public speeches against democracy. While to not "allow" and to "forbid" literally carry the same meaning, the difference in connotation was significant enough to result in a 17% difference in Presser's study.[FN13] The drastic, legalistic connotations of the word "forbid," compared with the softer import of "not allow," resulted in a significant difference in responses.

[FN1] Philip Morris, Inc. v. R.J. Reynolds Tobacco Co., 188 U.S.P.Q. 289, 1975 WL 21170 (S.D.N.Y. 1975) (survey held tailored to elicit some brand identification through use of slanted questions in attempt to prove secondary meaning); In re Jockey International, Inc., 192 U.S.P.Q. 579, 1976 WL 21154 (T.T.A.B. 1976) (answers given to choose from held to elicit the desired choice, resulting in "loaded" survey: held probative anyway); WGBH Educational Foundation, Inc. v. Penthouse International, Ltd., 453 F. Supp. 1347, 203 U.S.P.Q. 432 (S.D.N.Y. 1978), aff'd without op., 598 F.2d 610 (2d Cir. 1979) (Defendant's survey question asking what the "word" Nova means rather than what the "name" Nova means held to "seriously undercut whatever validity the survey might otherwise have." "Name" would have focused attention on plaintiff's product, whereas "using the term 'word' diffuses that focus."); American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 204 U.S.P.Q. 609 (2d Cir. 1979), cert. denied, 445 U.S. 951, 63 L. Ed. 2d 787, 100 S. Ct. 1601, 205 U.S.P.Q. 680 (1980) (Phone survey question, "With whom or what do you associate a product labelled Bionic?," held improper as "self-serving." Court said question should have been, "With whom or what do you associate a 'Bionic' boot?"); Johnson & Johnson * Merck Consumer Pharmaceuticals Co. v. Smithkline Beecham Corp., 960 F.2d 294, 22 U.S.P.Q.2d 1362, 1367-68 (2d Cir. 1992) (several questions held misleading in false advertising cases, such as: "Based on the commercial you just saw, how do you feel about taking a product for heartburn that contains aluminum and magnesium?").

[FN2] *See* Boal, "Techniques for Ascertaining Likelihood of Confusion and the Meaning of Advertising

Communications," 73 Trademark Rep. 405, 422 (1983) (A question to the effect of "Do you think these two products are made by the same or different producers?" is not neutral. "[T]he question does strongly suggest a possibility that might not have occurred to the interviewees—that the products are made by the same company.").

[FN3] Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 213 U.S.P.Q. 1091 (S.D. N.Y. 1982). *See* Universal City Studios, Inc. v. Nintendo Co., Ltd., 746 F.2d 112, 223 U.S.P.Q. 1000 (2d Cir. 1984), judgment aff'd, 797 F.2d 70, 230 U.S.P.Q. 409 (2d Cir. 1986) (The following survey question was held improperly leading in that it presented respondents with the connection rather than permitting them to make their own association: "To the best of your knowledge, was the Donkey Kong game made with the approval or under the authority of the people who produce the King Kong movies?") Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 564 (S.D. N.Y. 1991) (a question that asks persons to assume that some entity sponsors or promotes or is associated with the junior user and then asks who that entity would most likely be was held to be improperly leading in the context of the facts) Marshall Field & Co. v. Mrs. Fields Cookies, 25 U.S.P.Q.2d 1321, 1334, 1992 WL 421449 (T.T.A.B. 1992) (Asking if the two stores "have a business connection or a business association with one another, or not?" is an improperly leading question that "tends to deliberately plant in the respondent's mind the idea that there is a connection between the stores. … Such a question is certainly highly prejudicial to the results." Survey found to be "seriously flawed and the results to be of little probative value.") Riviana Foods Inc. v. Societe Des Produits Nestle S.A., 33 U.S.P.Q.2d 1669, 1994 WL 761242 (S.D. Tex. 1994) (survey question held leading: "Do you think the weight loss product "Sweet Success" and "Success Rice" are more likely made by the same company or more likely made by different companies?"); Scott Fetzer Co. v. House of Vacuums Inc., 381 F.3d 477, 72 U.S.P.Q.2d 1011 (5th Cir. 2004) (held improper was question: "Looking at this ad, would you say that this company is in any way affiliated with, connected with, sponsored by, associated with or authorized by the Kirby Company?" Court said: "A survey question that begs its answer by suggesting a link between plaintiff and defendant cannot be a true indicator of consumer confusion.").

[FN4] Straumann Co. v. Lifecore Biomedical Inc., 278 F. Supp. 2d 130 (D. Mass. 2003) (the question "What company do you think puts out these products?" is leading because it "presume[s] the existence of the key element in a secondary meaning enquiry, namely the association of the design with a single source.").

[FN5] McGraw-Edison Co. v. Walt Disney Productions, 225 U.S.P.Q. 512, 1984 WL 1394 (N.D. Ill. 1984), judgment rev'd, 787 F.2d 1163, 229 U.S.P.Q. 355, 362 (7th Cir. 1986) (The district court said that presenting respondents with pictures of the two products and asking them if the products were put out by the same or different companies is leading and will always produce high results connecting the two products. The court of appeals disagreed, saying that the district court improperly rejected the 35% response that the products were put out by the same company.) Clicks Billiards, Inc. v. Sixshooters, Inc., 251 F.3d 1252, 58 U.S.P.Q.2d 1881 (9th Cir. 2001) (responses to question: "Do you think that the billiard parlor in these photos [of defendant's operation] is owned or operated by [plaintiff] or do you think that the billiard parlor in the photos is owned and operated by a different company?" were held to be sufficient proof of infringement to avoid dismissal on summary judgment).

See discussion of "product line-up" surveys at § 32:177.

[FN6] Penta Hotels Ltd. v. Penta Tours, 9 U.S.P.Q.2d 1081, 1988 WL 384940 (D. Conn. 1988).

[FN7] Straumann Co. v. Lifecore Biomedical Inc., 278 F. Supp. 2d 130 (D. Mass. 2003) (the question "What company do you think puts out these products?" is leading because it "presume[s] the existence of the key element in a secondary meaning enquiry, namely the association of the design with a single source." In the Author's Opinion, this is an overly rigid and strict criticism of a relatively neutral ques- tion.).

[FN8] Ralston Purina Co. v. Quaker Oats Co., 169 U.S.P.Q. 508, 1971 WL 16472 (T.T.A.B. 1971).

[FN9] Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969); Frisch's Restaurants v. Shoney's, Inc., 759 F.2d 1261, 225 U.S.P.Q. 1169 (6th Cir. 1985) (presenting respondents with the desired response six times before asking the critical question gives the results "diminished probative value": survey was discounted as evidence).

[FN10] Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 227 U.S.P.Q. 257 (S.D.N.Y. 1985), aff'd without op., 788 F.2d 3 (2d Cir. 1986) (questions were held leading where they presented respondents with particular similarities or associations rather than permitting respondents to arrive at the association themselves, unaided by prompting; proper questions would be: "Do you think there is any relationship between any of these magazines? Which ones? What is the relationship?").

[FN11] Esquire Sportswear Mfg. Co. v. Genesco, Inc., 141 U.S.P.Q. 400, 1964 WL 7842 (T.T.A.B. 1964) (likely confusion found, notwithstanding deficient "survey" evidence).

[FN12] Mennen Co. v. Gillette Co., 565 F. Supp. 648, 220 U.S.P.Q. 354 (S.D.N.Y. 1983), aff'd without op., 742 F.2d 1437 (2d Cir. 1984) (Following survey question held leading and survey found "fatally defective": "Please look at this picture and this list of stick deodorant brand names. Among the leading brands of stick deodorant now on the market, which of the brands listed here would you say uses these stripes on their package?" 63% response naming plaintiff Mennen found to be only a "playback of brand share," as Mennen was the major producer of such deodorants.).

[FN13] L. MacFarquhar, The Pollster, *The New Yorker*, October 18, 2004, pp. 85, 92. (Presser concluded that polls that ask people whether they are for or against things are not to be trusted, but polls that compare the responses to the same questions from different survey universes can result in meaningful data.).

MCCARTHY § 32:172

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:173. Tests of properly conducted survey—Slanted or leading questions—Aided awareness question- ing

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

As with direct examination of a witness at trial, in framing survey questions one must resist the temptation to lead responses to a desired end or to "help" the witness to reach the "correct" answer. Trial judges have considerable experience in spotting this kind of defect. For example, in one survey, after asking a neutral question about the interviewee's opinion as to products put out under defendant's mark, a further "aided awareness" question asked the interviewee to choose from among various named products, with the desired response featured prominently in the choices. The percentage naming products made by plaintiff jumped from only 7% on the neutral question to over 50% on the "aided awareness" question. Judge Stapleton found that while the responses to the neutral question were supportive of plaintiff's position, the responses to the "aided awareness" question were "of little probative value," as they led the interviewee to the desired response.[FN1]

[FN1] Scott Paper Co. v. Scott's Liquid Gold, Inc., 439 F. Supp. 1022, 195 U.S.P.Q. 707 (D. Del. 1977), rev'd, dismissed on other grounds, 589 F.2d 1225, 200 U.S.P.Q. 421 (3d Cir. 1978). *See* Johnson & Johnson-Merck Consumer Pharmaceuticals Co. v. Rhone-Poulenc Rorer Pharmaceuticals, 19 F.3d 125, 30 U.S.P.Q.2d 1112, 1119-20 (3d Cir. 1994) (accepting expert witness's view that only open-ended questions were valid, and criticizing follow up with repeated probing questions: "A survey is not credible if it relies on leading questions which are 'inherently suggestive and invite guessing by those who did not get any clear message at all.' "); Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc., 77 U.S.P.Q.2d 1492, 1507, 2005 WL 2451671 (T.T.A.B. 2005), appeal dismissed, 171 Fed. Appx. 838 (Fed. Cir. 2006) (Aided awareness questions (e.g. "Have you ever heard of _____?") did not support claim that mark was well-known and famous. "One should not be permitted to so heavily rely

on aided awareness. … ").

MCCARTHY § 32:173

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:174. Tests of properly conducted survey—Survey formats—*Eveready* confusion format

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

A now-standard survey format used to prove likely confusion in cases where plaintiff makes some products which defendant does not is the *Eveready* format.[FN1] To prove that consumers were likely to confuse the source of defendant' s EVER-READY lamps with plaintiff Union Carbide's EVEREADY batteries, flashlights and bulbs, Union Carbide introduced the results of a survey with the following questions:

1. [Screening question to eliminate persons in the bulb or lamp industries.]
2. Who do you think puts out the lamp shown here? (A picture of defendant's EVER-READY lamp with its mark is shown).
3. What makes you think so?
4. Please name any other products put out by the same concern which puts out the lamp shown here.

The results were that the number who associated the products displayed with Union Carbide were:

By answering “Union Carbide”: 6 (0.6%)

By indicating Union Carbide products such as batteries as being put out by the same concern: 551 (54.6%)

TOTAL 557 (55.2%)

While the district court said that the survey was entitled to “little, if any, weight,” the Seventh Circuit held that the trial court was clearly erroneous in not crediting the survey: “Those who indicated that they believed other Carbide products were manufactured by the same company that produced the bulbs or lamps shown must be considered cases of confusion.” The questions were held not to be leading, for “this is not a case where the interviewer stated the similar parts of the plaintiff's name several times in questions and then asked about the de-

fendant company."[FN2]

Further, although the survey was not designed to prove secondary meaning, the court of appeals held that it tdid prove secondary meaning because the results support the conclusion that "an extremely significant portion of the population associates Carbide's products with a single anonymous source." Thus, if the survey results are so strong and conclusive as to establish actual confusion, then some courts view the results as also being evidence of secondary meaning.[FN3]

In a reverse confusion case, an *Eveready*-type question should be asked of potential customers of the *plaintiff's* products, not of the defendant's products.[FN4]

An *Ever-Ready* format of survey can easily be combined with additional questions probing whether there is a likelihood of confusion as to sponsorship, affiliation or approval. As the Trademark Board observed: "While these types of [survey] questions were not expressly addressed in *Ever-Ready*, a leading commentator [McCarthy] suggests and court opinions have found, that affiliation and connection queries are appropriate in light of the specific language of the Lanham Act."[FN5]

[FN1] Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976). Cases explicitly approving *Eveready*-type surveys include: James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555, 564 (7th Cir. 1976); E. & J. Gallo Winery v. Gallo Cattle Co., 12 U.S.P.Q.2d 1657, 1674, 1989 WL 159628 (E.D. Cal. 1989), modified, aff'd, 955 F.2d 1327, 21 U.S.P.Q.2d 1824 (9th Cir. 1992), amended, 967 F.2d 1280 (9th Cir. 1992); Starbucks U.S. Brands, LLC and Starbucks Corporation d.b.a. Starbucks Coffee Company v. Marshall S. Ruben, 78 U.S.P.Q.2d 1741, 2006 WL 402564 (T.T.A.B. 2006) ("[G]iven the way in which this survey format carefully follows the *Ever-Ready* likelihood of confusion survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein." A likelihood of confusion was found.).

See Simonson, "The Effect of Survey Method on Likelihood of Confusion Estimates: Conceptual Analysis and Empirical Test," 83 Trademark L. Rptr. 364 (1993) (comparing the inherent bias of an *Eveready* format with a "line-up" survey—dubbed a *Squirt* format).

[FN2] *See* Sterling Drug, Inc. v. Bayer AG, 14 F.3d 733, 29 U.S.P.Q.2d 1321, 1326 (2d Cir. 1994) (The following question was found "not suggestive of any particular response": "What type of product or products, if any, are made by the company or companies mentioned in the sign?").

[FN3] *See* § 15:11.

[FN4] Sterling Drug, Inc. v. Bayer AG, 14 F.3d 733, 29 U.S.P.Q.2d 1321, 1326 (2d Cir. 1994) (since the issue is whether the senior user's products, such as BAYER aspirin, are made by the junior user, it is appropriate to survey customers of the senior user's BAYER aspirin product).

[FN5] Starbucks U.S. Brands, LLC and Starbucks Corporation d.b.a. Starbucks Coffee Company v. Marshall S. Ruben, 78 U.S.P.Q.2d 1741, 2006 WL 402564 (T.T.A.B. 2006) ("[G]iven the way in which this survey format carefully follows the *Ever-Ready* likelihood of confusion survey format, we find that

it is reliable and therefore of probative value on the issue of likelihood of confusion herein." A likelihood of confusion was found.). *See* § 32:175.

MCCARTHY § 32:174

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:175. Tests of properly conducted survey—Survey formats—Formats eliciting responses as to confusion of sponsorship, affiliation, or connection

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The Standard Format. One often-used two-part format for eliciting responses as to both source confusion and confusion as to sponsorship, affiliation and connection is the following. The respondent is shown the accused product or advertisement and is asked: "What company do you think makes this product?" Responses naming the senior user evidence actual confusion as to source. Respondents who did not name the senior user are then asked a second question: "Do you think this product was approved, licensed or sponsored by another company or not?" If the answer is yes, respondent is asked: "What company do you think this product is approved, licensed or sponsored by?" Responses naming the senior user evidence actual confusion as to sponsorship, affiliation or connection, which is actionable.[FN1] Both questions should be followed up by the important question: "Why do you say that?" Often, an examination of the respondents' verbatim responses to the "why" question are the most illuminating and probative part of a survey, for they provide a window into consumer thought processes in a way that mere statistical data cannot.

In one case, asking respondents if they thought that the accused product was made or sold by a company that makes another line of product yielded a majority of "no" responses, but the court said that did not prove a lack of confusion of affiliation when the respondents encountered both marks.[FN2]

Leading or Non-Leading Questions? It is not leading to posit the possibility to respondents that there may be some form of affiliation or licensing behind a junior user's operation. In one survey, to determine likely confusion, consumers were asked, "Though you may or may not have seen or heard of this restaurant, who do you believe sponsors or promotes MCBAGELS?" This was held not to be a leading question: "It was not unfair to hypothesize a larger entity's sponsorship of defendant's restaurant to determine whether an association with McDonald's was triggered by the name "McBagel's."[FN3]

In the author's view, it is not improperly leading to present the respondent with a fair and accurate representation of the contesting marks and ask in a neutral manner if the respondent thinks there is or is not some connection, affiliation or sponsorship relation between the owners of the marks—or that the respondent doesn't know.[FN4]

However, it will probably be improperly leading to suggest the desired response in the form of a yes or no question. The following survey question was held improperly leading in that it presented respondents with the connection rather than permitting them to make their own association: "To the best of your knowledge, was the Donkey Kong game made with the approval or under the authority of the people who produce the King Kong movies?"[FN5]

"Need to Get Permission?" Questions. In the *NFL* case, defendant sold without authority football jersey replicas imitating the design, names and colors of those licensed by the National Football League. The NFL's survey asked several questions probing for consumer beliefs as to the sponsorship or affiliation by the NFL of these jerseys. The survey then asked what, in many of these cases, is the critical enquiry: "Did the company that made this jersey have to get authorization or sponsorship, that is permission, to make it?" The court viewed the high percentage of affirmative responses as persuasive evidence of confusion as to sponsorship, affiliation or connection.[FN6] Jacoby, who designed the question, says it was worded in this way because "it was believed that the younger and lesser educated members of the relevant universe would not understand the legal connotation of the terms sponsored and authorized."[FN7]

Jacoby asked a similar survey question in the imitation golf course case.[FN8] The Fifth Circuit held that the survey question "Did defendant get permission?" was a proper inquiry and was probative of confusion.[FN9] The court noted that another court had accepted a variation of the question which asks: "Did defendant *need* to get permission?"[FN10] The Fifth Circuit felt that the latter "need to get" question was "problematic" because it "allows for the consumer's misunderstanding of the law."[FN11] However, as the author has pointed out, it is consumer perception that creates "the law" of whether permission is needed.[FN12] Dogan and Lemley have criticized the author's view, arguing that it confuses a survey respondent's belief about what the law is with a belief as to what the relationship between the two parties is.[FN13] A closely related criticism of the "need to get permission" survey question is that some consumers may think that there is a need to get permission in situations where there is no likelihood of confusion. That is, this question only indirectly measures a level of confusion. However, in the author's opinion, this should go only to the weight accorded to the results of such a survey question and should not be a ground for rejecting it altogether.

Some courts have criticized the "need to get permission" question as asking for "the law," arguing that what is asked should be the "factual" question: "was permission obtained?" Jacoby responded, arguing that asking if permission was obtained is an unreasonable inquiry because consumers have no way of knowing whether or not permission had been obtained and could only truthfully reply: "I don't know. I have no way of knowing that."[FN14]

The "Mystery Shopper" Method. A survey dubbed the "mystery shopper" method was judicially approved as a method of proving confusion over similar trade dress. In a case in which plaintiff alleged that defendant's table lamp design was an infringement of plaintiff's expensive high-style halogen lamp, interviewers masqueraded as shoppers and asked in lamp stores for the identification of a lamp shown in a photograph, under the pretext of wanting to buy such a lamp for a friend. The interviewer showed the sales clerk a photograph of plaintiff's table lamp and asked the clerk to identify it.[FN15]

Viewing the Stimulus While Questioning. Swann has investigated whether and in what circumstances the interviewer should remove the stimulus ("memory test") or keep it in the respondent's view while questioning ("reading test"). Swann suggested that keeping the stimulus in view while questioning is usually only appropriate to assess point-of-sale confusion under circumstances where consumers make involved, deliberate, thoughtful decisions.[FN16] Ostberg has responded that a "memory test" comes closer to real life buying conditions for all types of products. Ostberg argued that consumers in the real world obtain information on their own prior to purchase without being led by interviewer questions. This can be replicated by the interviewer, prior to removing the stimulus, instructing the respondent to look at the products, advertisements or marks at issue as they would normally when considering a purchase.[FN17]

[FN1] *See* §§ 24:5 to 24:12.

[FN2] Trouble v. Wet Seal, Inc., 179 F. Supp. 2d 291, 69 U.S.P.Q.2d 1603, 58 Fed. R. Evid. Serv. 509 (S.D. N.Y. 2001) (Questions were: "Do you think that [ACCUSED BRAND] clothing is made and sold by a company that makes or sells any other line of clothing?" and "Do you think the company that makes and sells [ACCUSED BRAND] clothing is affiliated, associated or connected with any other women's clothing company?" The court said that if the response was the plaintiff's brand, it would be evidence of confusion of affiliation, but "no" responses were said by the court not to evidence a lack of confusion of affiliation.).

[FN3] McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1 U.S.P.Q.2d 1761 (S.D.N.Y. 1986). *Compare* Wuv's International, Inc. v. Love's Enterprises, Inc., 208 U.S.P.Q. 736, 755, 1980 WL 30296 (D. Colo. 1980) (The following question was held to be "suggestive," such that the court would not consider the results as a "reliable figure": "Do you believe that this restaurant is connected with or related to any other restaurants?"); Wendy's International, Inc. v. Big Bite, Inc., 576 F. Supp. 816, 223 U.S.P.Q. 35 (S.D. Ohio 1983) (The following question asked in a survey by party trying to prove no likely confusion of sponsorship or endorsement was said to be "unnecessarily suggestive" of a favorable response: "Does the commercial give you the impression that any other restaurant chains actually endorses the Big Bite sandwich?" Plaintiff's survey was criticized as "probing" respondents until no further responses were given, thereby prodding respondents to identify more sources than they really had in mind. "At best these surveys are inconclusive."); Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 564 (S.D.N.Y. 1991) (a question that asks persons to assume that some entity sponsors or promotes or is associated with the junior user (a rap music performer) and then asks who that entity would most likely be was held to be improperly leading under *Universal City Studios*; the *McDonald's* question was distinguished because "restaurants are often franchises; singers rarely are"); Starbucks U.S. Brands, LLC and Starbucks Corporation d.b.a. Starbucks Coffee Company v. Marshall S. Ruben, 78 U.S.P.Q.2d 1741, 2006 WL 402564 (T.T.A.B. 2006) (Found proper and not leading was an *Ever-Ready* format survey augmented with these questions: "Do you think that the company that owns this retail establishment is connected or affiliated with any other company?" and "Do you think that the company that owns this retail establishment has authorization, permission or approval from another company to use this name?").

[FN4] *See* § 32:172.

[FN5] Universal City Studios, Inc. v. Nintendo Co., 746 F.2d 112, 223 U.S.P.Q. 1000 (2d Cir. 1984). *See* IDV North America, Inc. v. S & M Brands, Inc., 26 F. Supp. 2d 815, 830-831 (E.D. Va. 1998) (Held leading because it suggested an association between the products was the question: "Do you think there is any connection between (BAILEY's Irish Cream/BAILEY's liqueur/BAILEY's alcohol, if mentioned by a respondent in the previous question) and Bailey's cigarettes?"). For other examples, *see* §§ 32:172 to 32:173.

[FN6] National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175, 181-83 (W.D. Wash. 1982). *But compare* Major League Baseball Properties v. Sed Non Olet Denarius, Ltd., 817 F. Supp. 1103, 26 U.S.P.Q.2d 1731, 1744 (S.D.N.Y. 1993), vacated pursuant to settlement, 859 F. Supp. 80 (S.D.N.Y. 1994) (The following survey question was found to be impermissibly "leading": "Do you believe that the restaurant had to get authorization, that is, permission to use the name, 'The Brooklyn Dodger?' "); Sports Authority, Inc. v. Abercrombie & Fitch, Inc., 965 F. Supp. 925, 42 U.S.P.Q.2d 1662 (E.D. Mich. 1997) (Survey question "Do you believe [junior user] needed permission from [senior user] to use [contested mark]?" was found "leading" because interviewees were shown two marks not usually seen side-by-side and "were implicitly directed to find a relationship between them." Court entered a summary judgment of no infringement.). *See* Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 5 U.S.P.Q.2d 1314 (8th Cir. 1987), cert. denied, 488 U.S. 933, 102 L. Ed. 2d 344, 109 S. Ct. 326 (1988) (results of between 10% and 12% of affirmative responses to the survey question whether the senior user "goes along with" defendant's parody t-shirts supports finding of infringement, even though there is "some ambiguity" in this question).

[FN7] Jacoby, "Survey & Field Experimental Evidence" 187 in Kassin & Wrightsman, *The Psychology of Evidence and Trial Procedure* (1985).

[FN8] Pebble Beach Co. v. Tour 18 I, Ltd., 942 F. Supp. 1513 (S.D. Tex. 1996), aff'd, 155 F.3d 526, 48 U.S.P.Q.2d 1065 (5th Cir. 1998). Defendant's golf course consisted of imitations of golf holes at famous golf courses. On behalf of plaintiffs, Jacoby surveyed defendant's customers, asking in one ques- tion:

7 c. Tour 18 also uses the names of these other golf courses to advertise its holes and course to the public. Do you think the owner of Tour 18: (1) did get permission from the owners of these other courses to use their names at Tour 18 and to advertise Tour 18 to the public; (2) did not get permission from the owners of these other courses to use their names at Tour 18 and to advertise Tour 18 to the public; (3) or you don't have any idea about this?; (4) Don't know.

942 F. Supp. at 1549. The court found that survey results showing that 29% of those unaware of the dispute were confused into believing that plaintiffs gave defendant Tour 18 permission to use their marks in advertising and to name its golf holes supported a finding of a likelihood of confusion.

[FN9] Pebble Beach Co. v. Tour 18 I, Ltd., 155 F.3d 526, 48 U.S.P.Q.2d 1065 (5th Cir. 1998) (however, the court said that it preferred the word "approval" to the word "permission," because the court believed that it was more easily understood. 48 U.S.P.Q.2d at 1077, n.10).

[FN10] Indianapolis Colts v. Metropolitan Baltimore Football Club Ltd. Partnership, 34 F.3d 410, 415, 31 U.S.P.Q.2d 1811, 1816 (7th Cir. 1994) (Jacoby asked potential buyers of decedent's football merchandise whether the seller needed someone's permission to use the name in dispute). *See* Schieffelin &

Co. v. Jack Co. of Boca, Inc., 850 F. Supp. 232, 247, 31 U.S.P.Q.2d 1865, 1876 (S.D. N.Y. 1994) (a need to get permission question in a survey is "certainly a relevant inquiry … .").

[FN11] 48 U.S.P.Q.2d at 1077. *See* National Football League Properties, Inc. v. Prostyle, Inc., 16 F. Supp. 2d 1012, 1018 (E.D. Wisc. 1998) (criticizing the question "Do you think that, in order to put out this shirt, the company that put it out did need to get permission, did not need to get permission, or you have no thoughts about this?" as improperly asking for a legal conclusion); Malletier v. Dooney & Bourke, Inc., 340 F. Supp. 2d 415, 445 (S.D. N.Y. 2004), rev'd on other grounds, 454 F.3d 108, 79 U.S.P.Q. 2d 1481 (2d Cir. 2006). (Jacoby survey question about obtaining permission was given little weight because it called for a "legal conclusion.").

[FN12] *See* § 24:9.

[FN13] S.L. Dogan & M.A. Lemley, The Merchandising Right: Fragile Theory or Fait Accompli?, 54 Emory L.J. 461, 486, n.101 (2005).

[FN14] J. Jacoby, Sense and Nonsense in Measuring Sponsorship Confusion, 24 Cardozo Arts & Enter. L. Jour. 63 (2006) (also discussing a re-formulated question designed to meet the objection: "Do you think that in order to put out this item, the company that put it out either did get or did need to get permission [pause], did not get or need to get permission [pause], or have you no thoughts on this?" 24 Cardozo Arts & Enter. L. Jour. at 88.).

[FN15] Lon Tai Shing Co. v. Koch + Lowy, 19 U.S.P.Q.2d 1081, 1093-97, 1991 WL 170734 (S.D.N.Y. 1990) (the survey method was approved as one that "closely approximates real market conditions" and the result supported a finding of infringement). *See* I.P. Lund Trading ApS v. Kohler Co., 118 F. Supp. 2d 92, 56 U.S.P.Q.2d 1776 (D. Mass. 2000) (mystery shopper survey failed to prove secondary meaning in a faucet product design trade dress).

[FN16] J.B. Swann, A "Reading" Test or a "Memory" Test: Which Survey Methodology is Correct?, 95 Trademark Rptr. 876 (2005).

[FN17] H.D. Ostberg, Response to the Article Entitled A "Reading" Test or a "Memory" Test: Which Survey Methodology is Correct?, 95 Trademark Rptr. 1446 (2005).

MCCARTHY § 32:175

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:176. Tests of properly conducted survey—Survey formats—Word association questions

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The courts have used the term "word association survey" in different senses, leading to confusion as to what is intended. The most obvious meaning is a survey question which merely asks, "What is the first thing that comes to mind when looking at this word?" Without further probing, such a question may well be meaningless and irrelevant.[FN1] It is irrelevant because "calling to mind" is far removed from "likelihood of confu-

Another meaning of "word association survey" is a survey question which shows respondents a stimulus that does not accurately represent the mark in issue in the case. Responses may be so ambiguous and off-the-point as to be of little aid in resolving the issue in the case.[FN3] However, using a card with a mark shown in block letters as the survey stimulus is appropriate in Trademark Board inter partes proceeding where only registered or applied-for marks in block-letter format are in issue, without regard to special type or background.[FN4]

Another possible meaning of a "word association" survey is one in which the respondent is presented with the marks alone, out of context, and asked if there is a connection. This type of survey question can be criticized as deviating too far from actual market conditions to be helpful.[FN5]

[FN1] *See* Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500, 208 U.S.P.Q. 384, 389 (5th Cir. 1980) ("Surveys that involve nothing more than showing an individual a trademark and asking if it brings anything else to mind are given little weight in this circuit. … These surveys are seen as little more than word-association tests."); Charles Schwab & Co. v. Hibernia Bank, 665 F. Supp. 800, 3 U.S.P.Q.2d 1561 (N.D. Cal. 1987) (a survey asking "what comes to your mind?" is a

"word-association" test of little weight in proving that a mark is weak); Major League Baseball Properties v. Sed Non Olet Denarius, Ltd., 817 F. Supp. 1103, 26 U.S.P.Q.2d 1731, 1744 (S.D.N.Y. 1993), vacated pursuant to settlement, 859 F. Supp. 80 (S.D.N.Y. 1994) (Criticized this survey question: "Do you associate this name with anyone or anything or do you think that it's just the name of the restaurant without any other association, or don't you know?" Court: "[T]he issue here is not whether defendants' name brings to mind any other name. … Rather, the issue here is one of actual confusion. Plaintiff's survey questions regarding association are irrelevant to the issue of actual confusion.").

[FN2] *See* §§ 23:5 to 23:9.

[FN3] *See* discussion in Jellibeans, Inc. v. Skating Clubs of Georgia, Inc., 716 F.2d 833, n.24, 222 U.S.P.Q. 10, n.24 (11th Cir. 1983); Boal, "Techniques for Ascertaining Likelihood of Confusion and the Meaning of Advertising Communications," 73 Trademark Rep. 405, 413-16 (1983) ("Because a showing of association leaves a thoughtful court pondering where to go from there (and how), it appears to have utility only when a better technique for some reason is not available."); WE Media, Inc. v. General Elec. Co., 218 F. Supp. 2d 463, 68 U.S.P.Q.2d 1108 (S.D. N.Y. 2002), judgment aff'd, 94 Fed. Appx. 29 (2d Cir. 2004) (survey responses prompted by word lists were rejected for measuring "word associations devoid of context" and for not using pictures or advertisements that approximated what a potential customer would encounter.); Juicy ZCouture, Inc. v. L'Oreal USA, Inc., 2006 WL 1012939 (S.D. N.Y. 2006) (respondents were shown 8 1/2 by 11 inch cards bearing only the accused word marks. Court said this was a "word association test" and represented a "fundamental flaw" in the survey design because it did not "replicate the market conditions" in which the accused marks were encountered where the defendant's house mark LANCOME was prominently displayed.).

[FN4] Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc., 1 U.S.P.Q.2d 1445, 1986 WL 83319 (T.T.A.B. 1986). *See* §§ 20:14 to 20:18.

[FN5] Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 451, 213 U.S.P.Q. 1091, 1096 (S.D.N.Y. 1982) (Respondents were asked: "Do you think that there may or may not be a business connection between Beneficial Capital Corp. and the Beneficial Finance System Companies?" The question was criticized "because when faced with the prospect of borrowing money from either plaintiffs or defendant, a consumer or business would necessarily know more about the company than the minimal information provided to the survey respondents: the names of the companies. … However, this proposition provides no indication of public reaction under actual market conditions, and we conclude that there is no meaningful evidence of actual confusion."). *See* Franklin Resources, Inc. v. Franklin Credit Management Corp., 988 F. Supp. 322, 45 U.S.P.Q.2d 1872 (S.D.N.Y. 1997) (applying the *Beneficial* critique to a different type of survey format to discount its probative value).

MCCARTHY § 32:176

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:177. Tests of properly conducted survey—Survey formats—Product "line-up" survey methods

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

A survey method sometimes used to test for likelihood of confusion, especially in trade dress cases, involves some variation of a method in which respondents are shown a "line-up" of products or containers and asked which, if any, of them are made by the same company.[FN1]

In one variation, respondents are shown the plaintiff's trade dress, and then, after a short delay, shown a line-up of other brands, including the accused product. Respondents are asked if any of them are made by the same company as makes the product initially seen. This is an attempt to replicate the marketplace process of advertising exposure to a brand or trade dress, followed by being confronted in the market with both similar and differing brands or trade dresses. For example, in one case, respondents were first shown plaintiff's candy wrapper claimed as trade dress, then in a second room were shown a line-up of several other brands, including the accused package. Respondents were then asked if any were the one they saw previously: "Do you think candy number ——— is made by the same company as the candy I showed you a minute or two ago in the other room, or do you think it is made by a different company?"[FN2] If a brand was named, a follow-up question probed for reason: "What is it that makes you think candy number ——— is made by the same company as the candy I showed you in the other room?" The court found that results of 48% and 34% linkage of plaintiff's and defendant's trade dress were probative of likely confusion and supportive of the finding that a preliminary injunction should issue against the infringing trade dress.[FN3]

In another variation, respondents are shown a line-up of products or brands which includes the accused mark or trade dress, but not the plaintiff's mark. After seeing the line-up, respondents are asked to recall the brand names they had seen. Those who name plaintiff's mark as one of the brands are counted as evidence of confusion.[FN4]

An adaptation of this approach is to show respondents in Phase One advertisements of four companies, in-

cluding the plaintiff. Then in Phase Two, respondents are shown advertising promotions of three companies, including defendant and asked, “Was there a product or service in the booklet I showed you [in Phase One] that is from the same source or company as [shown in this exhibit in Phase Two]?” Positive answers linking plaintiff and defendant will be counted by the survey taker as evidence of likely confusion and a “noise” or “error” rate deducted.[FN5]

This type of survey has been used with just two stimuli. In Phase One, respondents are shown the senior user's mark and it is removed from view. In Phase Two, respondents are shown the junior user's mark and it is removed from view. For half the group, the order of showing is reversed. Respondents are then questioned: "Do you think that the brand name you saw first and the brand name you saw second come from the same company, different companies, or are you not sure?" Those who answered "different companies" or "not sure" are probed with further questions. All respondents are asked "Why do you feel that way?" A control group is shown a stimulus different from that of the junior user.[FN6]

[FN1] *See* Simonson, “The Effect of Survey Method on Likelihood of Confusion Estimates: Conceptual Analysis and Empirical Test,” 83 Trademark Rep. 364 (1993) (comparing the inherent bias of a “line-up” survey (dubbed a *Squirt* format) with other methods, such as an *Eveready* method); 24 Hour Fitness USA, Inc. v. 24/7 Tribeca Fitness, LLC., 447 F. Supp. 2d 266, 279 (S.D. N.Y. 2006), judgment aff'd, 247 Fed. Appx. 232 (2d Cir. 2007) (Line-up or “Squirt” survey was found not persuasive to prove likely confusion concerning word marks because of criticisms of the method and control question.).

[FN2] Storck USA, L.P. v. Farley Candy Co., 797 F. Supp. 1399, 25 U.S.P.Q.2d 1927, 1932 (N.D. Ill. 1992) (In a four-package line-up, the accused package was selected by more respondents than the packages of the three other brands in total; the court also noted that such a survey format is probative of likelihood of confusion, but not of secondary meaning, for it does not attempt to measure existing consumer awareness of plaintiff's alleged trademark or trade dress. 25 U.S.P.Q.2d at 1935.).

[FN3] After 48% linkage was found in the format where respondents were shown four nonplaintiff's packages at once, defendant criticized the format as suggesting to respondents that there is a “right” answer, encouraging guessing. Another version was run producing 34% linkage where respondents were shown each of three brands separately, which the court said eliminated the “right answer” bias, apparently because respondents would feel no pressure to say “yes” to any of the brands when presented singly. 25 U.S.P.Q.2d at 1933.

[FN4] *See* AHP Subsidiary Holding Co. v. Stuart Hale Co., 1 F.3d 611, 27 U.S.P.Q.2d 1758 (7th Cir. 1993) (summary judgment for defendant reversed, court saying that “[w]e believe that the district court was premature in rejecting the survey evidence”); Juicy ZCouture, Inc. v. L'Oreal USA, Inc., 2006 WL 1012939, *27 (S.D. N.Y. 2006) (approving survey by defendant in which persons were shown the accused cosmetics and allowed to handle them, as if they were shopping. The products were then covered and questions were asked about the trademarks. No infringement was found.).

[FN5] Franklin Resources, Inc. v. Franklin Credit Management Corp., 988 F. Supp. 322, 45 U.S.P.Q.2d 1872, 1884 (S.D.N.Y. 1997) (The court found that the results were only of “slightly probative value.” No likelihood of confusion was found and the court held for defendant).

[FN6] Ava Enterprises, Inc. v. Audio Boss USA, Inc., 77 U.S.P.Q.2d 1783, 2006 WL 173465 (T.T.A.B. 2006) (The Trademark Board found that a 45% "same company" response to the first question and 57% positive response to all questions which linked the parties was "strongly probative of a likelihood of confusion." Control group response was 5%. Opposition sustained.).

MCCARTHY § 32:177

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

C. PROPER FORMATS AND METHODS

References

§ 32:178. Tests of properly conducted survey—Author's comment: being realistic about surveys

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

As Professor Perlman has noted, any survey is of necessity an imperfect mirror of actual customer behavior under real life conditions:

> The treatment of survey evidence is simplified once it is recognized that such evidence is circumstantial rather than direct evidence of confusion. The issue becomes how strong an inference of confusion can be drawn from the particular survey.[FN1]

It is notoriously easy for one survey expert to appear to tear apart the methodology of a survey taken by another.[FN2] Similarly, cross-examination of a survey expert sometimes focuses strongly on the "road not taken": Why did you not ask a different question? Why did you not include more people in your sample? Why did you not sample in different locations? The experienced survey expert Robert Sorensen stated that:

> It has sometimes been my experience that the more scrupulous the survey methodology and the more attention paid to survey detail, the more harassing the cross examination, and, sometimes, the more dubious the judge.[FN3]

One must keep in mind that there is no such thing as a "perfect" survey.[FN4] The nature of the beast is that it is a sample, albeit a scientifically constructed one. As Rappeport observed, there are three unavoidable constraints that render all surveys less than perfect reflections of actual human behavior and perception: (1) Persons never behave exactly the same in a survey setting as in real life. The mere fact of being observed and questioned itself compromises "normal" behavior; (2) There are never infinite resources of time and money with which to conduct a survey and explore all of the permutations and combinations; (3) Sometimes, respondents simply do not know the answer to the question that the law seeks to resolve. Rappeport concludes: "[E]ven imperfect sur-

veys, generally speaking, can and do clarify the issues in a case. In other words, surveys are clarifying evidence, not proof."[FN4.50]

One must remain cognizant of the fact that, as Judge Anderson said of the survey evidence in the famous "Thermos" case, "any conclusion in this area cannot be reduced to a figure of unimpeachable accuracy but must, at best, be an approximation."[FN5] Like any scientific method related to statistics in the social sciences, every survey, no matter how carefully constructed and conducted, has some potential flaws somewhere.[FN6]

The proper approach is to view such evidence with some understanding of the difficulty of devising and running a survey and to use any technical defects only to lessen evidentiary weight, not to reject the results out-of-hand.[FN7]

Author's Opinion: Sometimes, the most illuminating and probative parts of a survey are not the numbers and percentages generated by the responses, but the verbatim accounts of the responses. The respondents' verbatim responses to "why" question may provide a window into consumer thought processes in a way that mere statistical data cannot.

[FN1] Perlman, "The Restatement of the Law of Unfair Competition: A Work in Progress," 80 Trademark Rep. 461, 473 (1990).

[FN2] *See, e.g.,* President & Trustees of Colby College v. Colby College-New Hampshire, 508 F.2d 804, 185 U.S.P.Q. 65 (1st Cir. 1975); U-Haul International, Inc. v. Jartran, Inc., 522 F. Supp. 1238, 212 U.S.P.Q. 49 (D. Ariz. 1981), aff'd, 681 F.2d 1159, 216 U.S.P.Q. 1077 (9th Cir. 1982).

[FN3] Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?," 73 Trademark Rep. 349, 352 (1983) (Sorensen explains that this occurs because a requirement of the survey model that is explicitly stated in the report draws the cross-examiner like a magnet to find shortcomings between execution and goal. On the other hand: "A requirement unstated is a requirement ignored by the interviewer, which sometimes (but only sometimes) goes unmonitored by cross examination and court alike.").

[FN4] Selchow & Righter Co. v. Decipher, Inc., 598 F. Supp. 1489, 225 U.S.P.Q. 77, 86 (E.D. Va. 1984) ("It must be recognized that no survey is perfect. … The Court is of the opinion that the flaws exposed by the defendant should be taken into consideration in determining the weight that the Court attributes to the survey. … The Court, therefore, diminishes the weight it affords to the survey, but still relies upon it as evidence of the likelihood of confusion between the two products.").

[FN4.50] M. Rappeport, Litigation Surveys: Social Science as Evidence, 92 Trademark Rptr 957, 961 (2002).

[FN5] American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9, 134 U.S.P.Q. 98 (D. Conn. 1962), aff'd, 321 F.2d 577, 138 U.S.P.Q. 349 (2d Cir. 1963).

[FN6] Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?," 73 Trademark Rep. 349, 351 (1983) ("I know of no survey, in trademark litigation or elsewhere,

which fulfills one hundred percent the requirements of its model.").

[FN7] *See* SquirtCo v. Seven-Up Co., 628 F.2d 1086, 207 U.S.P.Q. 897, 900 (8th Cir. 1980) ("In evaluating survey evidence, technical deficiencies go to the weight to be accorded them, rather than to their admissibility."); similar cases cited *supra* at § 32:170.

MCCARTHY § 32:178

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:179. Handling objections to survey procedures

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

An obvious, but impractical suggestion for handling objections to survey accuracy was made by Judge Wyzanski:

> It may be helpful for this Court to make certain additional observations for guidance in future cases. In every case where the results of a poll or similar survey are offered, there arises as preliminary problems the propriety of the universe, the choice of the sample, the qualifications of the experts and investigators, the manner of interviewing, the questions asked by the investigators, and the scope of freedom of the interviewee to frame an answer in his own terms. Ordinarily if the parties have not agreed between themselves as to these matters, it would be desirable to have them discussed at a pre-trial hearing at which the Court can enter appropriate orders. An adversary party, of course, has the right to object to the form, manner and content of questions put by interrogators to interviewees; and it would usually be more convenient and economical to have the Court rule on such objections before the poll is taken rather than at the full trial. Had this procedure been followed in the case at bar there would have been a considerable saving of money and time, and perhaps plaintiff could have filled gaps in its proof.[FN1]

However, such a procedure is only rarely followed.[FN2] Similar to Judge Wyzanski's suggestion, the *Manual for Complex Litigation* recommends that:

> When sampling or survey evidence is proposed to be offered, parties may want to consider whether details of the proposed sampling or survey methods should not be disclosed to the opposing parties before the work is done (including the specific questions that will be asked, the introductory statements or instructions that will be given and other controls to be used in the interrogation process). Objections can then be raised promptly and corrective measures taken before the survey is completed. A meeting of the parties' experts can expedite the resolution of problems affecting admissibility.[FN3]

In the 1960 Handbook, the Judicial Conference declined to recommend compulsory pre-trial discussion or investigation of a proposed survey because of the problems of the "work-product" privilege and the problems created if the survey results are not offered into evi dence.[FN4] The last element is, of course, the main reason why many survey proponents in a case do not want to submit the proposed survey to the scrutiny of their opponent. The party ordering the survey would rather wait and see what results the survey produces. If the results are favorable, the survey will be used as evidence. If the results are unfavorable, the survey will be ignored and not introduced. If the survey proponent offered the proposed survey to his opponent at pre-trial proceedings for objections, and the survey turned out to be unfavorable to the proponent, the opposing party might well be able to draw unfavorable inferences from a failure to introduce the survey, or might even try to obtain the "disappearing survey" for his own use.

In one case, the court implied, but did not directly state, that an unfavorable survey which will not be introduced into evidence cannot be discovered by the opponent.[FN5] An opponent's survey which is found in discovery may be admissible in evidence against that party.[FN6] The Second Circuit held that an opponent's survey and an employee's analysis of it were admissible over a hearsay objection because in tandem, they constitute an admission against interest admissible under the Fed. R. Evid. 801(d)(2) hearsay exception.[FN7]

[FN1] American Luggage Works, Inc. v. United States Trunk Co., 158 F. Supp. 50, 116 U.S.P.Q. 188 (D. Mass. 1957), supp. op., 161 F. Supp. 893, 117 U.S.P.Q. 83 (D. Mass. 1957), aff'd, 259 F.2d 69, 118 U.S.P.Q. 424 (1st Cir. 1958).

[FN2] *See* Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984) (Following the suggestion, plaintiff made a motion in limine to determine the admissibility of its survey format (along with the results of a preliminary survey) before incurring the expense of taking a full-scale survey. In response to defendant's objections, some parts were altered and the court granted the motion and admitted the survey into evidence at trial. The court of appeals affirmed this procedure, rejected defendant's objections and found the survey results strongly supportive of a likelihood of confusion.).

[FN3] Manual for Complex Litigation, Third § 21.493, p. 102-103 (1995).

[FN4] Judicial Conference of the U.S., Handbook of Recommended Procedures for the Trial of Protracted Cases 76 (1960).

For a discussion of the right to depose investigators before trial, *see* Wembley, Inc. v. Diplomat Tie Co., 216 F. Supp. 565, 137 U.S.P.Q. 107 (D. Md. 1963); Jewel Cos. v. GranJewel Jewelers & Distributors, Inc., 185 U.S.P.Q. 504, 1975 WL 21140 (M.D. Fla. 1975) (identities of all interviewees in survey taken by plaintiff's attorney and description of circumstances surrounding the interviews held protected by the work product rule; however, if plaintiff intends to produce any interviewees as witnesses at trial, their names and addresses must be made available to defendant at least 20 days prior to pre-trial conference).

[FN5] Loctite Corp. v. National Starch & Chemical Corp., 516 F. Supp. 190, 211 U.S.P.Q. 237 (S.D.N.Y. 1981) (relying on Procter & Gamble Co. v. Johnson & Johnson, Inc., 485 F. Supp. 1185, 205

U.S.P.Q. 697 (S.D.N.Y. 1979), aff'd without op., 636 F.2d 1203 (2d Cir. 1980), court said that a court should not "compel a party who has commissioned such a survey to introduce it at trial if it does not advance his case").

[FN6] Nestle Co. v. Chester's Market, Inc., 571 F. Supp. 763, 219 U.S.P.Q. 298 (D. Conn. 1983), vacated, 756 F.2d 280, 225 U.S.P.Q. 537 (2d Cir. 1985) (Defendant challenging plaintiff's mark as generic found through discovery and introduced into evidence two surveys taken by plaintiff not for the purpose of the litigation. The surveys were held admissible into evidence, the court remarking that these two surveys were "fatal" to the trademark status of plaintiff's "toll house" mark.).

[FN7] Schering Corp. v. Pfizer, Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1720 (2d Cir. 1999) (Because the analysis drew inferences from the survey it constituted an admission against interest and validated the survey and thus the opponent could introduce both into evidence, but the court cautioned: "A party admission may, however, be inadmissible when it merely repeats hearsay and thus fails to concede its underlying truthfulness.").

MCCARTHY § 32:179

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:180. Survey evidence in the Patent and Trademark Office

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

No separate discussion of decisions relating to survey evidence in ex parte or inter partes proceedings in the Patent and Trademark Office is needed, for the same legal criteria as previously discussed are applied in administrative proceedings involving the registration of marks.[FN1]

While the Trademark Board at one time indicated resistance to survey evidence,[FN2] it has since changed its position and is now as receptive to survey evidence as the courts.[FN3] For example, the Trademark Board has approved of the "*Ever-Ready*" survey format for testing for a likelihood of confusion as to sponsorship, affiliation or approval.[FN4]

However, the Trademark Board has stressed that while it is receptive to survey evidence, such evidence is not mandatory to establish a likelihood of confusion where other evidence exists.[FN5] The Board will not draw a negative inference from a party's failure to offer survey evidence.[FN6]

[FN1] *See, e.g.,* Marcalus Mfg. Co. v. Watson, 156 F. Supp. 161, 115 U.S.P.Q. 232 (D.D.C. 1957), aff'd, 258 F.2d 151, 118 U.S.P.Q. 7 (D.C. Cir. 1958) (survey evidence in application for registration given little weight because of deficiencies in conduct of survey); In re Hehr Mfg. Co., 279 F.2d 526, 126 U.S.P.Q. 381 (C.C.P.A. 1960) (survey accepted to prove secondary meaning); Jenkins Bros. v. Newman Hender & Co., 289 F.2d 675, 129 U.S.P.Q. 355 (C.C.P.A. 1961) (survey results measured against very critical standard and rejected as proof of likelihood of confusion); Federal Glass Co. v. Corning Glass Works, 162 U.S.P.Q. 279, 1969 WL 9105 (T.T.A.B. 1969) (survey evidence of various types accepted as proof of secondary meaning in mark); In re Levi Strauss & Co., 165 U.S.P.Q. 348 (T.T.A.B. 1970) (survey proper evidence to prove secondary meaning in mark); Ralston Purina Co. v.

Quaker Oats Co., 169 U.S.P.Q. 508, 1971 WL 16472 (T.T.A.B. 1971) (survey given no probative value because of deficiencies in conduct of survey); Monsieur Henri Wines, Ltd. v. Duran, 204 U.S.P.Q. 601, 1979 WL 24898 (T.T.A.B. 1979) (survey relied upon); Missiontrek Ltd. Co. v. Onfolio, Inc., 80 U.S.P.Q.2d 1381, 2005 WL 3395187 (T.T.A.B. 2005), aff'd, 208 Fed. Appx. 858 (Fed. Cir. 2006) (nonprecedential) (e-mail survey sent to 42 customers by the senior user was not accorded any weight because it was not based on established survey techniques, was administered by a party to the case and was not analyzed in any statistically significant way).

Regarding form statements and questionnaires to prove secondary meaning in ex parte applications, *see* §§ 15:74 to 15:78.

[FN2] National Biscuit Co. v. Princeton Mining Co., 137 U.S.P.Q. 250 (T.T.A.B. 1963), aff'd, 338 F.2d 1022, 143 U.S.P.Q. 422 (C.C.P.A. 1964). *Compare* International Milling Co. v. Robin Hood Popcorn Co., 110 U.S.P.Q. 368, 1956 WL 8002 (Comm'r Pat. 1956) (receptive to surveys).

[FN3] *See, e.g.,* Georgia-Pacific Corp. v. Great Plains Bag Co., 200 U.S.P.Q. 601, 1978 WL 21566 (T.T.A.B. 1978), aff'd, 614 F.2d 757, 204 U.S.P.Q. 697 (C.C.P.A. 1980) (following Fed. R. Evid.); McDonough Power Equipment, Inc. v. Weed Eater, Inc., 208 U.S.P.Q. 676, 1981 WL 40435 (T.T.A.B. 1981) (surveys are admissible as an exception to the hearsay rule and the only issue is how much weight should a survey be given); Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc., 1 U.S.P.Q.2d 1445, 1986 WL 83319 (T.T.A.B. 1986) (the Trademark Board extensively discussed the evidentiary weight of surveys and relied upon survey results to corroborate a finding of a likelihood of confusion); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889 (Fed. Cir. 1991) (in an opposition, the Federal Circuit found that a consumer survey, while "not perfect in its content and execution," is "admissible and given appropriate weight" to support a finding of a likelihood of confusion); Carl Karcher Enters. v. Stars Restaurants Corp., 35 U.S.P.Q.2d 1125, 1133 (T.T.A.B. 1995) ("Courts and the Board long have recognized that there is no such thing as a perfect survey." Since an opposition involves entitlement to rights on a national scale, there is no requirement that opposer take a survey in its own, rather than in applicant's trade area. Survey supported a finding of likely confusion.).

[FN4] Starbucks U.S. Brands, LLC and Starbucks Corporation d.b.a. Starbucks Coffee Company v. Marshall S. Ruben, 78 U.S.P.Q.2d 1741, 2006 WL 402564 (T.T.A.B. 2006) ("[G]iven the way in which this survey format carefully follows the *Ever-Ready* likelihood of confusion survey format, we find that it is reliable and there of probative value on the issue of likelihood of confusion herein." A likelihood of confusion was found.).

[FN5] Schering-Plough Healthcare Products, Inc. v. Ing-Jing Huang, 84 U.S.P.Q.2d 1323, 2007 WL 1751193 (T.T.A.B. 2007) ("Contrary to applicant's position, the Board does not require surveys in Board proceedings.").

[FN6] Hilson Research, Inc. v. Society for Human Resources Management, 27 U.S.P.Q.2d 1423, 1435-36, 1993 WL 290669 (T.T.A.B. 1993); McDonald's Corp. v. McClain, 37 U.S.P.Q.2d 1274, 1995 WL 785743 (T.T.A.B. 1995) ("Neither party is obligated, in a proceeding before the Board, to spend the effort and expense to obtain such evidence.").

MCCARTHY § 32:180

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:181. Introducing a survey into evidence—Laying a foundation

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The *Manual for Complex Litigation* recommends that the party offering a survey have the burden of laying a foundation that the survey was conducted in accordance with accepted principles of survey research.[FN1] The 1981 version of the Manual recommended[FN2] that this be proven by evidence that:

1. The proper universe was selected and examined;
2. A representative sample was drawn from that universe;
3. A correct method of questioning the interviewees was used;
4. The persons conducting the survey were recognized experts;
5. The data gathered were accurately reported;
6. The sample, the questionnaire and the interviewing were in accordance with generally accepted standards of objective procedure and statistics in the field of such surveys.

The 1995 version of the Manual contained a different list of seven factors to be considered:

1. The population was properly chosen and defined;
2. The sample chosen was representative of that population;
3. The data gathered were accurately reported;
4. The data were analyzed in accordance with accepted statistical principles;
5. The questions asked were clear and not leading;
6. The survey was conducted by qualified persons following proper interview procedures; and
7. The process was conducted so as to ensure objectivity (e.g. was the survey conducted in anticipation of litigation and by persons connected with the parties or counsel or aware of its purpose in the litiga- tion?).[FN3]

[FN1] Federal Judicial Center, Manual for Complex Litigation 116 (5th ed. 1981). The Manual's list of factors was paraphrased and applied in: Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc., 559 F. Supp. 1189, 1205, 217 U.S.P.Q. 1137, 1149 (E.D.N.Y. 1983); Weight Watchers Int'l, Inc. v. Stouffer Corp., 744 F. Supp. 1259, 19 U.S.P.Q.2d 1321, 1331 (S.D.N.Y. 1990); Hutchinson v. Essence Communications, Inc., 769 F. Supp. 541, 557 (S.D.N.Y. 1991) (using the seven foundations of survey evidence listed in *Toys R Us*).

[FN2] This list of six elements is found in the 1981 version of the Manual.

[FN3] The Manual for Complex Litigation, Third § 21.493, p. 102 (1995).

MCCARTHY § 32:181

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:181.50. Introducing a survey into evidence—The survey report

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The Federal Judicial Center Reference Manual on Scientific Evidence recommends that a complete survey report should demonstrate the trustworthiness of the survey and the professionalism of the testifying survey expert. The Manual recommends that the report should describe in detail the following nine points:[FN1]

1. the purpose of the survey;
2. a definition of the target population and a description of the population that was actually sampled;
3. a description of the sample design, including the method of selecting respondents, the method of interview, the number of call backs, respondent eligibility or screening criteria, and other pertinent information;
4. a description of the results of sample implementation, including (a) the number of potential respondents contacted, (b) the number not reached, (c) the number of refusals, (d) the number of incomplete interviews or terminations, (e) the number of noneligibles and (f) the number of completed interviews;
5. the exact wording of the questions used, including a copy of each version of the actual questionnaire, interviewer instructions, and visual exhibits;
6. a description of any special scoring (e.g. grouping of verbatim responses into broader categories);
7. estimates of the sampling error where appropriate (i.e. in probability samples);
8. statistical tables clearly labeled and identified as to source of data, including the number of raw cases forming the base for each table, row or column;
9. copies of interviewer instructions, validation results and codebooks.

[FN1] Reference Manual on Scientific Evidence, pp. 270–271 (Federal Judicial Center 2d ed. 2000).

MCCARTHY § 32:181.50

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:182. Introducing a survey into evidence—Testimony of the survey director

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

The above foundation testimony can normally be offered by the person or persons responsible for directing the survey.[FN1] A sample direct examination of the survey director is set forth in Am. Jur. Trials.[FN2] In one case, the authenticity of interviewees' responses was proven by showing the court sound movies of some actual interviews.[FN3] Obviously, this is a very expensive (and unnecessary) way to authenticate survey evidence.

Under modern state rules of evidence and the Federal Rules of Evidence, there should be no need to have anyone other than the survey director testify at trial to substantiate the survey results.[FN4] The survey director testifies as an expert who has devised and conducted a scientific poll or survey. There should be no need for testimony from the actual interviewers. The Seventh Circuit has adopted the suggestion of this treatise that the testimony of the survey director alone is sufficient to establish the foundation for the admission into evidence of survey results.[FN5]

Under Fed. R. Evid. 702, the expert survey director is permitted not only an opinion, but can give a dissertation or lecture as to the scientific principles of statistical sampling and opinion polls. While hypothetical questions of an expert are traditional, Fed. R. Evid. 705 abolishes the need for them.[FN6]

The survey expert does not have to disclose in discovery all of his or her expert reports prepared in cases in which the expert testified in the past five years. "The plain language of Rule 26 directs parties to provide a list of cases, not the expert reports relied on in those cases."[FN7]

Of course, the person who designed the survey must qualify as an expert in the field of designing, conducting and analyzing surveys. If he or she does not qualify, then the survey is properly not allowed into evidence.[FN8]

[FN1] *See* People v. Franklin Nat'l Bank, 200 Misc. 557, 105 N.Y.S.2d 81 (1951), rev'd, 281 A.D. 757, 118 N.Y.S.2d 210 (1953), modified, 305 N.Y. 453, 113 N.E.2d 796 (1953), remittitur amended, 307 N.Y. 678, 120 N.E.2d 852 (1954), rev'd, 347 U.S. 373, 98 L. Ed. 767, 74 S. Ct. 550 (1954) (The evidence offered should include calling the planners, supervisors and workers (or some of them) as witnesses so that the court may see and hear them. The work sheets, reports, surveys and all documents used should be offered in evidence.); Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969) (two interviewers and one supervisor testified; all but three of 24 interviewers were available to testify; parties stipulated that these would give same answers as to those who did testify).

[FN2] 8 Am. Jur. Trials, §§ 59-60 Trademark Infringement (1965).

[FN3] Seven-Up Co. v. Green Mill Beverage Co., 191 F. Supp. 32, 128 U.S.P.Q. 284 (N.D. Ill. 1961).

[FN4] *See* La Maur, Inc. v. Alberto-Culver Co., 179 U.S.P.Q. 607, 1973 WL 917 (D. Minn. 1973), aff'd, 496 F.2d 618, 182 U.S.P.Q. 10 (8th Cir. 1974), cert. denied, 419 U.S. 902, 42 L. Ed. 2d 148, 95 S. Ct. 186, 183 U.S.P.Q. 386 (1974); Georgia-Pacific Corp. v. Great Plains Bag Co., 200 U.S.P.Q. 601, 605, 1978 WL 21566 (T.T.A.B. 1978), aff'd, 614 F.2d 757, 204 U.S.P.Q. 697 (C.C.P.A. 1980); Fed. Rules of Evid. 705.

[FN5] Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202, 206 (7th Cir. 1984) ("We agree with the suggestion in McCarthy's treatise that the testimony of a survey director alone can establish the foundation for the admission of survey results." The court also noted that the ability to cross-examine the actual interviewers is not essential.).

[FN6] McElhaney, "Expert Witnesses and the Federal Rules of Evidence," 28 Mercer L. Rev. 463, 487 (1977).

[FN7] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 68 U.S.P.Q.2d 1695, 2003 WL 22227959 (S.D. N.Y. 2003), related reference, 2003 WL 22471909 (S.D. N.Y. 2003), related reference, 2004 WL 169746 (S.D. N.Y. 2004), related reference, 2004 WL 574732 (S.D. N.Y. 2004), related reference, 348 F. Supp. 2d 217 (S.D. N.Y. 2004) ("As long as the defendants provide plaintiffs with the name of the case, the court in which it was tried, the case number, the nature of [the expert's] testimony and the names of the parties, defendants satisfy Rule 26. With this information, plaintiffs Cartier can easily obtain prior testimony given by [the expert].").

[FN8] M2 Software, Inc., a Delaware corporation v. Madacy Entertainment, a corporation, 421 F.3d 1073, 76 U.S.P.Q.2d 1161, 1171 (9th Cir. 2005), cert. denied, 126 S. Ct. 1772, 164 L. Ed. 2d 516 (U.S. 2006).

MCCARTHY § 32:182

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

D. USE OF SURVEYS IN THE PTO AND COURTS

References

§ 32:183. Introducing a survey into evidence—Privacy of survey respondents

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Certainly those respondents who were interviewed should not be forced to testify. The privacy of ordinary persons interviewed should be preserved. However, Judge Van Bebber in Kansas held that a survey taker can be compelled by the court to reveal to the opponent the identities of the persons who were surveyed.[FN1] In the author's view this is a seriously erroneous view and invades the expectation of privacy of the survey respond- ents.

The Federal Judicial Center Reference Manual on Scientific Evidence agrees with the author's view that a survey respondent's privacy should be acknowledged and notes: "Although no surveyor-respondent privilege currently is recognized, the need for surveys and the availability of other means to examine and insured their trustworthiness argues for deference to legitimate claims for confidentiality in order to avoid seriously compromising the ability of surveys to produce accurate information."[FN2]

The anonymity of respondents is important because survey takers find that more and more persons will refuse to participate in a survey unless they are guaranteed anonymity.[FN3]

The Codes of Ethics of organizations in the survey research profession require survey takers to respect the anonymity of respondents. For example, Rule 3 of the Code of Ethics of the Marketing Research Association requires that a member agree: "To protect the anonymity of respondents and hold all information concerning an individual respondent privileged, such that this information is used only within the context of the particular study." Other associations have similar standards.[FN4]

Deprivation of the ability to cross-examine some, or all, of the often hundreds of respondents in a survey is not a significant loss of evidentiary verification. A person called to the stand years after he or she briefly responded to survey questions will probably recall little of what happened:

An interview is ordinarily at best a minor incident in the average person's life, a brief interruption in the flow of events which we learn people often forget after a few days. The authenticity of what a person thinks he remembers telling another one day months or years ago, and the extent this recollection is flawed by intervening variables in life that might have affected what one remembers saying—all strained through the tensions of appearing in an unwanted role as affiant or witness—is highly questionable.[FN5]

[FN1] United States Surgical Corp. v. Orris, Inc., 983 F. Supp. 963, 45 U.S.P.Q.2d 1125 (D. Kan. 1997) (the court concluded that defendant's need to "properly evaluate and rebut the reliability of the survey outweighed plaintiff's interest in shielding the survey participants").

[FN2] Reference Manual on Scientific Evidence, pp. 270–271 (Federal Judicial Center 2d ed. 2000).

[FN3] Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?," 73 Trademark Rep. 349, 361 (1983) (Also noting that: "Respondents cannot be told prior to an interview that their answers are to be used in litigation; nor, can they be told after an interview, because we do not want the interviewers to know the survey may be used in litigation.").

[FN4] Council of American Survey Research Organization, Code of Standards for Survey Research, Part I.A. 1 (Feb. 1984): "Survey research organizations have the responsibility to protect the identities of respondents and to insure that individuals and their responses cannot be related." Part I.A.3.e. states that: "The use of survey results in a legal proceeding does not relieve the survey research firm of its ethical obligation t o maintain in confidence all respondent-identifiable information or lessen the importance of respondent anonymity."; American Marketing Association, New York Chapter, Code of Ethics: "I will protect the right to privacy by guarding the identity of individual respondents. I will not release the names of respondents to anyone for any purpose other than legitimate validation, because the guarantee of anonymity is the respondent's only insurance against the disclosure of personal matters."; American Association for Public Opinion Research, By-Laws: Code of Professional Ethics and Practices, Part II.D.2. (March, 1986): "Unless the respondent waives confidentiality for specified uses, we shall hold as privileged and confidential all information that might identify a respondent with his or her responses."

[FN5] Sorensen, "Survey Research Execution in Trademark Litigation: Does Practice Make Perfection?," 73 Trademark Rep. 349, 363 (1983).

MCCARTHY § 32:183

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:184. Likelihood of confusion—Is survey data evidence of actual confusion?

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

As discussed previously, survey evidence is circumstantial, not direct, evidence of the likelihood of confusion. Surveys do not measure the degree of actual confusion by real consumers making mistaken purchases. Rather, surveys create an experimental environment from which we can get useful data from which to make informed inferences about the likelihood that actual confusion will take place.[FN1] Direct evidence of actual confusion can come only from such sources as misdirected phone calls or letters or even from that rarest of evidence, the testimony of someone willing to testify that they were once a confused customer.[FN2]

Sometimes, direct evidence of actual confusion can be "created" though the method of experimentation by creating conditions in which ordinary people have the opportunity to shop and become the victim of real confusion or mistake over brands. The 1978 "Maritz Study" is a well-known example. There, shoppers entering a supermarket were given a discount coupon good for non-cola beverages. Upon leaving, shoppers were intercepted and asked to verbally identify the brand they purchased, then asked to physically produce that brand from their shopping bag. Those who erroneously said that they had purchased SQUIRT but in fact had bought QUIRST were said by plaintiff to constitute evidence of instances of actual confusion. The courts were not so sure what to make of it, because the confused buyers were not offered for cross-examination.[FN3]

Several courts, when assembling the evidence within a likelihood of confusion framework of factors such as the *Polaroid* Eight,[FN4] have put survey evidence under the heading of "actual confusion."[FN5]

[FN1] Perlman, "The Restatement of the Law of Unfair Competition: A Work in Progress," 80 Trademark Rep. 461, 472-73 (1990) ("[T]o claim [survey] responses are direct proof of the responses of actual consumers as they make their purchasing decisions is going too far.").

Compare Blue Cross & Blue Shield Ass'n v. Harvard Community Health Plan, Inc., 17 U.S.P.Q.2d 1075, 1078 n.7, 1990 WL 354563 (T.T.A.B. 1990) (even if a survey has defects that preclude admission as a formal survey, it still constitutes evidence of specific instances of actual confusion).

[FN2] *See* § 23:2.

[FN3] *See* SquirtCo v. Seven-Up Co., 480 F. Supp. 789, (E.D. Mo. 1979), aff'd in relevant part, 628 F.2d 1086, 207 U.S.P.Q. 897, 898 n.3 (8th Cir. 1980) (The district court said the three instances of mistake out of 70 did not necessarily demonstrate actual confusion between SQUIRT and QUIRST because the mistake might have been due to "carelessness or inadvertence" rather than "confusing similarity between the names" and the unavailability of the witnesses for cross-examination made their motivation indeterminate, but the court nevertheless said that the results of the demonstration "are strong evidence of a likelihood of confusion between SQUIRT and QUIRST." The court of appeals, affirming the finding of a likelihood of confusion, was perplexed as to how to treat the evidence, saying that it was "novel" and "without legal precedent." The court of appeals was content to observe that: "In short, the [district] court gave the investigation the same weight as an opinion survey."). *See* Boal, "Techniques for Ascertaining Likelihood of Confusion and the Meaning of Advertising Communications," 73 Trademark Rep. 405, 409 (1983) ("Neither court appeared to appreciate the genius of the new (at least to it) methodology. Plainly it attempted to address actual, not likely confusion.").

[FN4] *See* § 24:28.

[FN5] *See, e.g.,* National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175, 183 (W.D. Wash. 1982) ("The evidence of actual confusion concerns the testimony of retail purchasers of defendant's products and the survey itself."); A.T. Cross Co. v. TPM Distributing, Inc., 226 U.S.P.Q. 521, 524, 1985 WL 72660 (D. Minn. 1985) (" [T]he plaintiff's survey demonstrates the existence of actual confusion in the marketplace, and, by implication, that there was a strong likelihood of confusion."); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 5 U.S.P.Q.2d 1314, 1317, 98 A.L.R. Fed. 1 (8th Cir. 1987), cert. denied, 488 U.S. 933, 102 L. Ed. 2d 344, 109 S. Ct. 326 (1988) ("As to instances of actual confusion, Mutual produced evidence of actual confusion in the form of a survey. … We consider this appropriate, for surveys are often used to demonstrate actual consumer confusion."); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254, 2 U.S.P.Q.2d 1677, 1681 (2d Cir. 1987) (survey evidence discussed under the heading of "actual confusion," the fifth Polaroid factor); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, n.6, 4 U.S.P.Q.2d 1497, n.6 (10th Cir. 1987) (it was proper for district court to treat survey results as evidence of actual confusion, making irrelevant the issue of projecting the results of a nonprobability survey); Sterling Drug, Inc. v. Bayer AG, 14 F.3d 733, 29 U.S.P.Q.2d 1321, 1326 (2d Cir. 1994) ("Judge Ward began his consideration of likelihood of confusion with an analysis of actual confusion. In concluding that [plaintiff] had demonstrated such confusion, Judge Ward relied on a survey conducted by Sterling's expert."); Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 38 U.S.P.Q.2d 1449 (4th Cir. 1996), cert. denied, 136 L. Ed. 2d 325, 117 S. Ct. 412 (1996) (survey evidence discussed under the heading of "actual confusion"); Thane Intern., Inc. v. Trek Bicycle Corp., 305 F.3d 894, 64 U.S.P.Q.2d 1564 (9th Cir. 2002) (persistently referring to survey results as evidence of "actual confusion.").

See Weiss, "The Use of Survey Evidence in Trademark Litigation: Science, Art of Confidence Game?," 80 Trademark Rep. 71, 80-81 (1990) (criticizing the judicial view that a survey is evidence of actual

confusion).

MCCARTHY § 32:184

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:185. Likelihood of confusion—Evaluating the significance of survey results—An "appreciable" num- ber

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Likelihood of confusion is found by such a likelihood among a "substantial" or "appreciable" number of reasonably prudent customers.[FN1] An "appreciable" number is not necessarily a majority,[FN2] and in fact can be much less than a majority.

The courts have been unwilling to be pinned down as to whether an "appreciable" number of customers is to be measured qualitatively (in percentage figures) or quantitatively (by the actual number of persons). This distinction may be crucial where a survey shows a low percentage number but can be extrapolated over a large relevant "universe" of potential customers. For example, one court indicated that even 11% of a national market of millions of consumers constitutes a very large number of confused consumers.[FN3] As one court observed in evaluating a survey result that 16% of respondents thought that defendant's McSLEEP motel was owned or operated by plaintiff McDonald's: "Projected across the 144 million people who are considered to be the potential audience for [defendant's] McSleep Inn, well over 20 million would be likely to be confused. This is not an insubstantial number."[FN4]

There is some dispute as to the proper base against which to compare the number of confused respondents to compute a percentage figure. For example, if survey responses reveal that only a subset of the total respondents know of the accused mark or have a belief as to who makes the accused product, should those smaller figures be used as the base against which to evaluate the number of confused persons? In one case, of 600 telephone survey respondents only 38 (6 percent) had a belief as to who made the accused product. Of that subset of 38 persons, 13 believed that plaintiff made the accused product. Is the percentage of confused persons best characterized as 34% (13 of 38) or 2% (13 of 600)? The court characterized the survey as proving confusion among "34% of all respondents who consciously formed a belief as to the identity of the manufacturer," which the court said was "a significant number of confused consumers" and supported a finding of a likelihood of confusion.[FN5]

It has been held that when testing for confusion in a traditional "forward" confusion case, it is improper to exclude from the universe and the computation of a relevant "confused" percentage those persons who were not aware of the senior user's mark. Excluding such persons would skew the percentage results upwards and fail to accurately represent the state of mind of all persons who are likely to buy or see the junior user's product.[FN6] Similarly, it was held that in surveying for secondary meaning of trade dress, it was improper to discard the views of those who were not "familiar" with the trade dress.[FN7]

[FN1] *See* §§ 23:2, 23:12 to 23:18.

[FN2] American Ass'n for Advancement of Science v. Hearst Corp., 498 F. Supp. 244, 206 U.S.P.Q. 605 (D.D.C. 1980).

[FN3] Humble Oil & Refining Co. v. American Oil Co., 405 F.2d 803, 160 U.S.P.Q. 289 (8th Cir. 1969), cert. denied, 395 U.S. 905, 23 L. Ed. 2d 218, 89 S. Ct. 1745, 161 U.S.P.Q. 832 (1969) (sufficient to keep an injunction in force). *See* James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555, 565 (7th Cir. 1976) ("We cannot agree that 15% is 'small.' Though the percentage of likely confusion required may vary from case to case, we cannot consider 15 percent, in the context of this case, involving the entire restaurant-going community, to be de minimis."). *compare* Mastercard Intern. Inc. v. First Nat. Bank of Omaha, Inc., 2004 WL 326708 (S.D. N.Y. 2004), related reference, 2004 WL 1575396 (S.D. N.Y. 2004) (survey result is unreliable for a small sample where 15.3% confusion represented only five respondents.).

[FN4] Quality Inns Int'l v. McDonald's Corp., 695 F. Supp. 198, 8 U.S.P.Q.2d 1633, 1649 (D. Md. 1988) (Survey result of 16.3% confused is an "appreciable number" supportive of a finding of a likelihood of confusion. Court also applied this percentage to the total potential market for the junior user's motels to find a substantial absolute number of people likely to be confused.). *See* Wendy's International, Inc. v. Big Bite, Inc., 576 F. Supp. 816, 223 U.S.P.Q. 35 (S.D. Ohio 1983) (Where defendant's survey question was found slanted in favor of finding no likely confusion but 7% of all age groups and 21% of ages 18 and 24 still responded in a way indicative of likely confusion of endorsement, court found likely confusion. Court noted that these percentages "translate into large numbers of confused consumers" and that it was "quite reluctant" to say that these percentages "were insubstantial as a matter of law.").

[FN5] Frank Brunckhorst Co. v. G. Heileman Brewing Co., 875 F. Supp. 966, 35 U.S.P.Q.2d 1102 (E.D.N.Y. 1994) (survey was conducted by defendant to disprove that any significant confusion would occur. A preliminary injunction was granted requiring a change of trademark.) *See* Johnson & Johnson-Merck Consumer Pharmaceuticals Co. v. Rhone-Poulenc Rorer Pharmaceuticals, 19 F.3d 125, 30 U.S.P.Q.2d 1112, 1115 (3d Cir. 1994) (Finding that consumer surveys did not prove that a substantial number of consumers were misled. Alito, J., dissented, taking the view that the required "substantial proportion" of deceived viewers should be based on those "who do pay attention to the [advertisement] and attach some meaning to it" rather than to all those who saw the advertisement "including those who do not pay attention" to it.).

[FN6] Paco Sport, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305 n. 17, 54 U.S.P.Q.2d 1205, 1221

(S.D. N.Y. 2000), judgment aff'd, 234 F.3d 1262 (2d Cir. 2000).

[FN7] I.P. Lund Trading ApS v. Kohler Co., 118 F. Supp. 2d 92, 56 U.S.P.Q.2d 1776 (D. Mass. 2000) (The court remarked that this "stacks the deck" in plaintiff's favor.).

MCCARTHY § 32:185

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:186. Likelihood of confusion—Evaluating the significance of survey results—Survey data are circumstantial evidence of confusion

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Survey results cannot be reduced to a figure of "unimpeachable accuracy," but at best are "an approximation."[FN1] Surveys are statistical evidence and are an aid to, not a substitute for, independent evaluation by a judge or jury. In many cases finding likely confusion, the court's opinion carefully recites that the survey evidence is merely supportive of the court's independent conclusion reached on the foundation of all the evidence introduced.[FN2]

In comparing the percentage figures mentioned in various cases, one must keep in mind that while survey results are important and valuable evidence, they are only one part of the overall legal and factual matrix used by the decision-maker. Technical deficiencies in a survey will result in an unmeasurable evidentiary discounting of the survey figures.[FN3]

[FN1] American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9, 134 U.S.P.Q. 98 (D. Conn. 1962), aff'd, 321 F.2d 577, 138 U.S.P.Q. 349 (2d Cir. 1963).

[FN2] *See* §§ 32:194 to 32:196.

[FN3] *See* §§ 32:167 to 32:169.

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:187. Using a control to filter out background noise

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Another factor to consider in evaluating survey results is that there is often "general background noise" in survey figures. For example, in one case, the survey showed that 5.7% of consumers were generally confused as to a connection between stores with distinctly different names. The court noted that the 7.2% who were confused because of conflicting marks must be placed against this background of general confusion and was thus insufficient to prove likelihood of confusion because of the marks.[FN1] Similarly, the Seventh Circuit affirmed a finding of no infringement where a survey found a 25% rate of confusion between the contesting products but the control survey using a radically differently named and dressed product found "noise" of 20%.[FN2] In any survey, there will always be some interviewees who are bored, hurried or just plain contrary and whose responses must be filtered out though control questions. These responses also contribute to background noise and static in the numerical results.

The amount of background noise can usually only be determined by asking control questions which form a basis for comparison to the key questions.[FN3] Thus, the Federal Judicial Center notes: "It is possible to adjust many survey designs so that causal inferences about the effect of a trademark or an allegedly deceptive commercial become clear and unambiguous. By adding an appropriate control group, the survey expert can test directly the influence of the stimulus."[FN4] As Rappeport remarked, the use of a "control" serves much the same purpose in surveying as use of a placebo does in drug testing and putting the suspect in a lineup of others does in criminal detection.[FN5]

The control question or questions should use a mark similar enough to the actual mark that it provides an accurate measure of the confusion created by the accused mark, not by some other similarity. For example, where 24 HOUR FITNESS fitness facility sued 24/7 FITNESS fitness facility, the control question concerned confusion between the accused mark 24/7 FITNESS and the control mark LIFETIME FITNESS. The court criticized this control, saying that the control should have been another fitness facility that advertised that it was

open 24 hours a day. For example, use of a control such as THE 24 HOUR GYM would have detected those who thought there was a connection based solely on the fact that two different facilities were both open 24 hours a day, not on the similarity of the conflicting marks.[FN6]

As Jacoby observed, the key figure is "net confusion:" the difference between the raw confusion percent and the control confusion percent:

> The most important percentage is not the percent confusion found with the allegedly confusing test item, nor the percent confusion found with the control item. Rather, it is the difference between the two or, in the parlance of the field, the "net confusion" that remains after subtracting the percent of confusion obtained with the Control stimulus (which is assumed to represent an amalgam of different forms of "noise") from the percent of confusion found with the Experimental stimulus.[FN7]

In some cases, background noise does not rise above a few percentage points.[FN8] However, when a control question is used in a survey, sometimes the noise rises to a surprisingly high level. For example, a survey result of 58.5% for those who mistakenly thought that the NOTORIOUS clothing of plaintiff and the NOTORIOUS perfume of defendant were put out by the same company had to be discounted by the 24.5% in a control group who thought that SAND & SABLE perfume was put out by the same company that sold NOTORIOUS clothing. Thus, an accurate figure after deducting background noise was 34%, which was found not determinative because of other defects in the survey structure.[FN9]

[FN1] S. S. Kresge Co. v. United Factory Outlet, Inc., 598 F.2d 694, 202 U.S.P.Q. 545, 548 (1st Cir. 1979) (Survey found that 7.2% of persons surveyed believed that plaintiff's local THE MART stores and defendant's K-MART national stores were owned by the same people, but the result means little because 5.7% of the same respondents reached the same conclusion as to THE MART and KING'S DEPARTMENT STORE. The court found the survey was no evidence of likely confusion.).

[FN2] Reed-Union Corp. v. Turtle Wax, 77 F.3d 909, 37 U.S.P.Q.2d 1718 (7th Cir. 1996).

[FN3] *See* Major League Baseball Properties v. Sed Non Olet Denarius, Ltd., 817 F. Supp. 1103, 26 U.S.P.Q.2d 1731, 1745 n.13 (S.D.N.Y. 1993), vacated pursuant to settlement, 859 F. Supp. 80 (S.D.N.Y. 1994) (court concluded that surveys were “flawed” because they did not have control questions); National Football League Properties, Inc. v. Prostyle, Inc., 57 F. Supp. 2d 665, 668-670 (E.D. Wisc. 1998) (survey excluded from evidence because, among other reasons, survey failed to have a control); Wells Fargo & Co. v. WhenU.com, Inc., 293 F. Supp. 2d 734, 768, 69 U.S.P.Q.2d 1171, 1199-1200 (E.D. Mich. 2003) (court criticized a survey for not including control questions); Pilot Corp. of America v. Fisher-Price, Inc., 344 F. Supp. 2d 349, 73 U.S.P.Q.2d 1030 (D. Conn. 2004) (It is preferable to use a control question relating to the same type product as the challenged product. Defendant's survey was preferred because it used a control of a drawing toy (the same as the accused product) rather than of some other toy.); American Flange & Manufacturing Co., Inc. v. Rieke Corporation, 80 U.S.P.Q.2d 1397, 1414, 2006 WL 1706438 (T.T.A.B. 2006) (Survey was flawed for, among other reasons, the failure to include a control for noise.).

[FN4] Reference Manual on Scientific Evidence, 257 (Federal Judicial Center 2d ed. 2000) (Also noting that: "Without the control group, it is not possible to determine how much of the 40% [deceptive response rate] is due to respondents' preexisting beliefs or other background noise (e.g., respondents who misunderstand the question or misstate their responses.").

[FN5] M. Rappeport, Litigation Surveys: Social Science as Evidence, 92 Trademark Rptr 957, 986 (2002) ("Just as in most circumstances, no one would trust the results of a 'lineup' in which witnesses were shown only the suspect, the results in a litigation survey, without any controls, are strongly suspect."); Government Employees Ins. Co. v. Google, Inc., 77 U.S.P.Q.2d 1841, 2005 WL 1903128 (E.D. Va. 2005) (control was criticized for not removing the allegedly infringing elements that were tested in the main survey. The control "did not function as an accurate measure of the confusion caused by the noninfringing elements … ." The court remarked that a proper control is "similar to the manner in which medical researchers subtract out the 'placebo effect' of a drug or procedure under examination.").

[FN6] 24 Hour Fitness USA, Inc. v. 24/7 Tribeca Fitness, LLC., 447 F. Supp. 2d 266, 280–281 (S.D. N.Y. 2006), judgment aff'd, 247 Fed. Appx. 232 (2d Cir. 2007) ("As conducted, the survey does not measure the amount of confusion between '24 Hour Fitness' and names such as 'All Day Gym,' … , compared to the amount of confusion claimed with '24/7 Fitness.' … [T]he survey does not adequately distinguish between [survey] respondents confused because of the name and those confused because the two facilitates appear to offer a similar service, that is, 24-hour access."). *See* Urban Outfitters, Inc. v. BCBG Max Azria Group, Inc., 511 F. Supp. 2d 482, 499–500 (E.D. Pa. 2007) (criticizing the use of "Classic" as a control mark because it was not "neutral": it was associated with other clothing brands).

[FN7] J. Jacoby, Experimental Design and Selection of Controls in Trademark and Deceptive Advertising Surveys, 92 Trademark Rptr 890, 905 (2002).

[FN8] *See* Quality Inns Int'l v. McDonald's Corp., 695 F. Supp. 198, 8 U.S.P.Q.2d 1633, 1649 (D. Md. 1988) (Two leading survey experts, Hans Zeisel and Jacob Jacoby, were on opposite sides of the case and the judge remarked that "none estimated that the extent of this noise would ever rise above a few percentage points." However, Jacob Jacoby has advised the author that Jacoby is of the view that the judge misinterpreted the record and that the trial transcript reveals that this was not Jacoby's testimony.); AHP Subsidiary Holding Co. v. Stuart Hale Co., 1 F.3d 611, 27 U.S.P.Q.2d 1758 (7th Cir. 1993) (survey directed by Hans Zeisel contained a control revealing 7% background noise, which was deducted from the raw survey result of 45% to result in 38% misidentification due to similarities in the marks); Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharmaceuticals Co., 129 F. Supp. 2d 351, 57 U.S.P.Q.2d 1522 (D.N.J. 2000), judgment aff'd, 290 F.3d 578, 62 U.S.P.Q.2d 1757 (3d Cir. 2002) (false advertising survey control group generated 5% noise, which was deducted from 30% gross results to arrive at a 25% of respondents who received the false message from the challenged ad.); Thane Intern., Inc. v. Trek Bicycle Corp., 305 F.3d 894, n. 6, 64 U.S.P.Q.2d 1564 (9th Cir. 2002) (4% background noise from control questions).

[FN9] Edison Bros. Stores, Inc. v. Cosmair, Inc., 651 F. Supp. 1547, 2 U.S.P.Q.2d 1013, 1022 (S.D.N.Y. 1987) (defects were: the unrealistic side-by-side presentation to respondents of NOTORIOUS wearing apparel and NOTORIOUS perfume and asking if they were put out by the same or a different company, and not screening to reach only those who were potential buyers of either product).

MCCARTHY § 32:187

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:188. Likelihood of confusion—Percentage figures in the cases—Evidence of a likelihood of confusion

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Percentages over 50% are usually viewed as persuasive evidence of likely confusion,[FN1] with the Seventh Circuit remarking that a result of over 50% is strongly probative of a likelihood of confusion as "far in excess" of the needed figure.[FN2] As noted, an "appreciable" number does not require a majority.[FN3] Generally, figures in the range of 25% to 50% have been viewed as solid support for a finding of a likelihood of confusion.[FN4] The Ninth Circuit has said that survey showing a 27.7% level of confusion is alone sufficient evidence to prevent a summary judgment that there is no likelihood of confusion.[FN5]

Figures below 20% become problematic because they can only be viewed against the background of other evidence weighing for and against a conclusion of likely confusion. The Fifth Circuit observed that where in a properly conducted survey, 15% of respondents associated defendant's TEXON auto repair service mark with plaintiff's EXXON gasoline mark and 23% associated TEXON with gasoline, the survey "constitutes strong evidence indicating a likelihood of confusion."[FN6]

In one case, while the district court dismissed a 15% figure as "small," the Seventh Circuit reversed, saying that 15% is neither "small" nor "de minimis" and is probative of likely confusion.[FN7] Similarly, the Second Circuit found that a 15-20% rate corroborates a finding of likely confusion.[FN8] Even results as low as 11% have been relied upon to support a finding of likely confusion.[FN9] The lowest reported figure is 8.5%, which the court found to be "strong evidence" of a likelihood of confusion where other evidence was also strongly supportive.[FN10]

[FN1] Sears, Roebuck & Co. v. Johnson, 219 F.2d 590, 104 U.S.P.Q. 280 (3d Cir. 1955) (74 percent); International Milling Co. v. Robin Hood Popcorn Co., 110 U.S.P.Q. 368, 1956 WL 8002 (Comm'r Pat.

1956) (61.5 percent).

[FN2] Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976).

[FN3] *See* § 23:2.

[FN4] *See* Standard Oil Co. v. Standard Oil Co., 252 F.2d 65, 116 U.S.P.Q. 176 (10th Cir. 1958) (40 percent); Seven-Up Co. v. Green Mill Beverage Co., 191 F. Supp. 32, 128 U.S.P.Q. 284 (N.D. Ill. 1961) (25% is credible evidence); John Walker & Sons, Ltd. v. Bethea, 305 F. Supp. 1302, n.3, 163 U.S.P.Q. 365, 367 n.3 (D.S.C. 1969) (22-60% confused respondents); Helene Curtis Industries, Inc. v. Church & Dwight Co., 560 F.2d 1325, 195 U.S.P.Q. 218 (7th Cir. 1977), cert. denied, 434 U.S. 1070, 55 L. Ed. 2d 772, 98 S. Ct. 1252, 197 U.S.P.Q. 592 (1978) (29% (290 of 998) relied upon to affirm preliminary injunction); Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984) (45% results are "high" and a factor "weighing strongly" in support of a likelihood of confusion); A.T. Cross Co. v. TPM Distributing, Inc., 226 U.S.P.Q. 521, 1985 WL 72660 (D. Minn. 1985) (43% and 34% results are entitled to "great weight" and prove "actual confusion" as well as "strong likelihood of confusion"); McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1 U.S.P.Q.2d 1761 (S.D.N.Y. 1986) (25% supports finding of likely confusion); Berkshire Fashions, Inc. v. Sara Lee Corp., 729 F. Supp. 21, 14 U.S.P.Q.2d 1124 (S.D.N.Y. 1990) (a result of 28% level of confusion supports a finding of a likelihood of confusion); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889 (Fed. Cir. 1991) (a result of 30% confused respondents supports a finding of likely confusion); Gateway, Inc. v. Companion Products, Inc., 384 F.3d 503, 72 U.S.P.Q.2d 1591 (8th Cir. 2004) (39% confusion rate on survey exceeds the rate the court had previously found sufficient.); Bell v. Starbucks U.S. Brands Corp., 389 F. Supp. 2d 766, 76 U.S.P.Q.2d 1254 (S.D. Tex. 2005), judgment aff'd, 205 Fed. Appx. 289 (5th Cir. 2006), cert denied 2007 WL 435912 (2007) (25% is sufficient to show a "significant" level of "actual confusion" and to support a finding of infringement).

[FN5] Thane Intern., Inc. v. Trek Bicycle Corp., 305 F.3d 894, 64 U.S.P.Q.2d 1564 (9th Cir. 2002) (reversing a summary judgment that there was no likelihood of confusion).

[FN6] Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500 (5th Cir. 1980). *See* National Football League v. Governor of Delaware, 435 F. Supp. 1372, 195 U.S.P.Q. 803 (D. Del. 1977) (19% of Delaware residents and 21% of "fans" thought that state lottery was autho rized by NFL. This was sufficient to prove substantial confusion as to sponsorship of state lottery.); McNeil-PPC v. Granutec, Inc., 919 F. Supp. 198, 37 U.S.P.Q.2d 1713 (E.D.N.C. 1995) (net confusion level of between 21% and 28% caused by defendant's red and yellow look-alike to TYLENOL red and yellow pills is sufficient for a preliminary injunction); Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 38 U.S.P.Q.2d 1449 (4th Cir. 1996), cert. denied, 519 U.S. 976, 136 L. Ed. 2d 325,117 S. Ct. 412 (1996) (Confusion level of 30% to 40% confusing source of LEG LOOKS hosiery with L'EGGS hosiery supports finding of likelihood of confusion. "[B]ut even if the true figure were only half of the survey estimate, actual confusion would, in our view, nevertheless exist to a significant degree.").

[FN7] James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 192 U.S.P.Q. 555, 565 (7th Cir. 1976) ("We cannot agree that 15% is 'small.' Though the percentage of likely confusion required may vary from case to case, we cannot consider 15 percent, in the context of this case, involving the entire

restaurant-going community, to be de minimis.").

[FN8] RJR Foods, Inc. v. White Rock Corp., 603 F.2d 1058, 203 U.S.P.Q. 401 (2d Cir. 1979). *See* Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc., 1 U.S.P.Q.2d 1445, 1986 WL 83319 (T.T.A.B. 1986) (18% corroborates finding of likely confusion); Lon Tai Shing Co. v. Koch + Lowy, 19 U.S.P.Q.2d 1081, 1097, 1991 WL 170734 (S.D.N.Y. 1991) (18% "is within the range of cognizable confusion recognized in this circuit" and supports a finding of likely confusion); Copy Cop v. Task Printing, 908 F. Supp. 37, 38 U.S.P.Q.2d 1171 (D. Mass. 1995) (16.5% was sufficient, along with other evidence, to support summary judgment of a likelihood of confusion).

[FN9] Jockey International, Inc. v. Burkard, 185 U.S.P.Q. 201, 1975 WL 21128 (S.D. Cal. 1975) (11.4 percent); McDonough Power Equipment, Inc. v. Weed Eater, Inc., 208 U.S.P.Q. 676, 1981 WL 40435 (T.T.A.B. 1981) (11 percent); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 5 U.S.P.Q.2d 1314 (8th Cir. 1987), cert. denied, 488 U.S. 933, 102 L. Ed. 2d 344, 109 S. Ct. 326 (1988) (results of between 10% and 12% of affirmative responses to question whether senior user "goes along with" defendant's parody T-shirts supports finding of infringement, even though there is "some ambiguity" in this ques- tion).

[FN10] Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 365 F. Supp. 707, 716, 180 U.S.P.Q. 506, 513 (S.D.N.Y. 1973), modified, 523 F.2d 1331, 186 U.S.P.Q. 436 (2d Cir. 1975) (8.5% of persons interviewed confused the names STEINWAY and STEINWEG for pianos and 7.7% perceived a business connection between the two companies). *Compare* Weight Watchers Int'l, Inc. v. Stouffer Corp., 744 F. Supp. 1259, 19 U.S.P.Q.2d 1321, 1332 (S.D.N.Y. 1990) (9.2% of survey re- spondents were confused as to source or sponsorship; flaws in survey methodology led the court to "accord very little weight to the results"; court found that there was no likelihood of confusion); V & S Vin & Sprit Aktiebolag v. Cracovia Brands, Inc., 69 U.S.P.Q.2d 1701, 2004 WL 42375 (N.D. Ill. 2004) (8% rate of survey confusion does not compel a summary judgment for plaintiff).

MCCARTHY § 32:188

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:189. Likelihood of confusion—Percentage figures in the cases—Evidence of no likelihood of confu- sion

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

When the percentage results of a confusion survey dip below 10%, they can become evidence which will indicate that confusion is not likely. The Seventh Circuit, reviewing prior cases involving low percentage results, found that 7.6% is "a factor weighing against infringement."[FN1] Similar low percentage figures have been relied upon to support a finding of no likelihood of confusion and no infringement.[FN2]

[FN1] Henri's Food Products Co. v. Kraft, Inc., 717 F.2d 352, 220 U.S.P.Q. 386, 391 (7th Cir. 1983).

[FN2] Wuv's International, Inc. v. Love's Enterprises, Inc., 208 U.S.P.Q. 736, 756, 1980 WL 30296 (D. Colo. 1980) (9% results; no likelihood of confusion proven); Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 228 U.S.P.Q. 346 (9th Cir. 1985) (results of less than 2% held to support the conclusion of no likelihood of confusion); G. Heileman Brewing Co. v. Anheuser-Busch, Inc., 676 F. Supp. 1436, 6 U.S.P.Q.2d 1481 (E.D. Wis. 1987), aff'd, 873 F.2d 985, 10 U.S.P.Q.2d 1801 (7th Cir. 1989) (survey result of 4.5% of confusion "falls well within the range which other courts have determined weighs against a finding of infringement"); IDV North America Inc. v. S & M Brands, Inc., 26 F. Supp. 2d 815, 831 (E.D. Va. 1998) (Survey result of 2.4% proves "the absence, rather than the presence, of likely confusion of source or sponsorship between Bailey's cigarettes and BAILEY's liqueurs); Paco Sport, Ltd. v. Paco Rabanne Parfums, 86 F. Supp. 2d 305, 54 U.S.P.Q.2d 1205 (S.D. N.Y. 2000), judgment aff'd, 234 F.3d 1262 (2d Cir. 2000) (confusion level of 5% held "virtually indistinguishable" from the control group. No likelihood of confusion found.); Brockmeyer v. Hearst Corp., 248 F. Supp. 2d 281, 298 (S.D. N.Y. 2003) (3% confusion results is proof that there will be no likelihood of confusion); CareFirst of Maryland, Inc. v. First Care, P.C., 434 F.3d 263, 77 U.S.P.Q.2d 1577 (4th Cir. 2006) (No confusion

likely between senior CAREFIRST and junior FIRST CARE for physicians group medical office. Survey showing only 2% level of confusion among 130 persons surveyed is *de minimis* and is "hardly a sufficient showing of actual confusion."); Newport Pacific Corp. v. Moe's Southwest Grill, LLC, 2006 WL 2811905 (D. Or. 2006) (14% confusion result is "barely above McCarthy's threshold that confusion results below 10% are evidence that confusion is *not* likely." Infringement case dismissed on summary judgment.).

MCCARTHY § 32:189

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:190. Secondary meaning—Significant level of identification

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

Designations which are not inherently distinctive require proof of acquired distinctiveness—secondary meaning—for protection in court and for registration.[FN1] For example, descriptive words are not inherently distinctive and require secondary meaning. Sometimes, survey evidence is used to prove that a given word in a given context is either descriptive or not.[FN2] More often, survey evidence is used to help prove the existence of secondary meaning.[FN3]

As the Ninth Circuit remarked, "[a]n expert survey of purchasers can provide the most persuasive evidence of secondary meaning."[FN4] Some courts have given broad hints that when the plaintiff has a less than clear case, a survey is necessary to prove secondary meaning.[FN5] However, survey data is not a requirement, and secondary meaning can be, and most often is, proven by circumstantial evidence.[FN6]

Many cases recite that proof of secondary meaning is sufficient if it shows that a "significant" or "substantial part" of the buying class use the designation to identify a single source.[FN7] One federal court stated of survey evidence to prove secondary meaning: "Proof of secondary meaning requires more than proof of the existence of one person or of even a relatively small number of people who associate the term with a single source."[FN8]

A survey which merely shows that a product is popular is not probative of the existence of secondary meaning in the trademark for that product.[FN9] Product popularity is not the same thing as secondary mean- ing.[FN10]

The courts have been confused and inconsistent as to the percentage of persons who use the designation to identify a source which is sufficient to constitute a "significant" amount. One court held that survey evidence that 25% of respondents associated plaintiff's designation with a single source was insufficient proof of secondary meaning.[FN11] Similarly, a survey which showed that only 10% of the sample gave trademark significance

to a descriptive term, was held insufficient proof of secondary meaning in the term.[FN12]

Higher percentages have been held to prove or support proof of secondary meaning in a designation. Where 41% associated red and yellow capsules with a single brand and 38% identified that brand as TYLENOL, the court found sufficient proof of secondary meaning in the red and yellow capsule colors.[FN13] A mail survey of 2000 households which revealed that 52% of the responding householders associated a blue cornflower design with CORNING WARE products, was held sufficient, along with other evidence, to prove secondary meaning in the design.[FN14] Generally, figures over 50% are regarded as clearly sufficient.[FN15] However, figures of 46%[FN16] and 37 percent[FN17] have also been found sufficient.

There would seem to be no logical reason to require any higher percentage to prove secondary meaning than to prove a likelihood of confusion. There is a close relationship between the two doctrines.[FN18] If the survey results are so strong and conclusive as to establish actual confusion, then some courts view the results as also being evidence of secondary meaning.[FN19] However, the rebuttal to this argument is that secondary meaning is an issue of validity, more akin to the majority usage test of genericness than to the significant number test of infringement.[FN20]

It can be argued that if, as is the case, a result of 20% confused survey respondents is regarded as supportive of a finding of a likelihood of confusion among an "appreciable" number, then 20% should be sufficient to support a finding of brand recognition (secondary meaning) among a "significant" number.[FN21] If there is evidence to support a finding that all of those in the 20% segment of respondents who recognize plaintiff's designation as a trademark are also confused by defendant's mark, then there is probative evidence of infringement. The rebuttal to this argument is that if 20% of the relevant customer group regards the designation as designating one source and each of the 20% is confused, protection of the designation as a mark would be contrary to the primary significance rule: 80% of the relevant population does not regard the designation as a trademark.[FN22]

[FN1] *See* §§ 15:1 to 15:4; Palladino, "Surveying Secondary Meaning," 84 Trademark Rep. 155 (1994).

[FN2] Aetna Health Care Systems, Inc. v. Health Care Choice, Inc., 231 U.S.P.Q. 614, 1986 WL 84362 (N.D. Okla. 1986) (In finding that the word CHOICE is not descriptive as applied to a pre-paid health care plan, court relied on a survey which asked: "Does the term or name 'choice' immediately describe to you a feature of prepaid health care plans?" The results were that to 75% of persons asked, the term was not descriptive.).

[FN3] In re Certain Vacuum Bottles & Components Thereof, 219 U.S.P.Q. 637, 1982 WL 54201 (Int'l Trade Comm'n 1982) (International Trade Commission said that to prove secondary meaning in a weak mark, "strong evidence" is needed. A consumer survey was necessary to prove that the appearance of a vacuum bottle had achieved secondary meaning. No survey was introduced and no secondary meaning proven.); Brown v. Quiniou, 744 F. Supp. 463, 16 U.S.P.Q.2d 1161 (S.D.N.Y. 1990) (Where other evidence of secondary meaning and strength is "hardly overwhelming," the absence of a survey "weighs heavily against plaintiff's position." Plaintiff's motion for summary judgment denied.).

[FN4] Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989).

[FN5] *See* cases cited at § 32:195.

[FN6] *See* Committee for Idaho's High Desert v. Yost, 92 F.3d 814, 39 U.S.P.Q.2d 1705 (9th Cir. 1996) ("[S]urvey evidence is only one of the most persuasive ways to prove secondary meaning and not a requirement for such proof." Secondary meaning was proven by testimony from members of the target user group and evidence of extensive advertising.); Yamaha International Corp. v. Hoshino Gakki Co., 231 U.S.P.Q. 926, 1986 WL 83747 (T.T.A.B. 1986), aff'd, 840 F.2d 1572, 6 U.S.P.Q.2d 1001 (Fed Cir. 1988) (there is no obligation to introduce survey evidence to prove secondary meaning, the federal circuit remarking that "absence of consumer surveys need not preclude a finding of acquired distinctiveness").

[FN7] *See* §§ 15:45 to 15:46.

[FN8] Wembley, Inc. v. Diplomat Tie Co., 216 F. Supp. 565, 137 U.S.P.Q. 107 (D. Md. 1963). *See* In re Hehr Mfg. Co., 279 F.2d 526, 126 U.S.P.Q. 381 (C.C.P.A. 1960) (secondary meaning proven by survey showing association by "majority" of interviewees).

[FN9] Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569, 123 U.S.P.Q. 372 (2d Cir. 1959), cert. denied, 362 U.S. 919, 4 L. Ed. 2d 739, 80 S. Ct. 671, 124 U.S.P.Q. 535 (1960).

[FN10] *See* § 15:47.

[FN11] Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963).

[FN12] Roselux Chemical Co. v. Parsons Ammonia Co., 299 F.2d 855, 132 U.S.P.Q. 627 (C.C.P.A. 1962). *See* Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 533 F. Supp. 75, 215 U.S.P.Q. 358 (S.D. Fla. 1981), aff'd, 716 F.2d 854, 221 U.S.P.Q. 536 (11th Cir. 1983) (2.7% association is "de minimis" evidence of secondary meaning); Straumann Co. v. Lifecore Biomedical Inc., 278 F. Supp. 2d 130 (D. Mass. 2003) (Identification percentages as low as 0 to 2.7% are not sufficient to go to a jury on the issue of secondary meaning.).

[FN13] McNeil-PPC v. Granutec, Inc., 919 F. Supp. 198, 37 U.S.P.Q.2d 1713 (E.D.N.C. 1995) (In the same survey, for TYLENOL users, 52% associated a red and yellow capsule with a single brand and 50% identified TYLENOL as that brand. This survey, along with evidence of copying, supported a finding of secondary meaning sufficient for issuance of a preliminary injunction.).

[FN14] Federal Glass Co. v. Corning Glass Works, 162 U.S.P.Q. 279, 1969 WL 9105 (T.T.A.B. 1969). *See* Anheuser-Busch, Inc. v. Bavarian Brewing Co., 264 F.2d 88, 120 U.S.P.Q. 420 (6th Cir. 1959) (survey showing 784 of 1,164 interviewees (67 percent) attributed secondary meaning to mark relied upon to find secondary meaning); Wesley-Jessen Div. of Schering Corp. v. Bausch & Lomb, Inc., 698 F.2d 862, 217 U.S.P.Q. 153 (7th Cir. 1983) (96.7 percent); National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175 (W.D. Wash. 1982) (55–80%).

[FN15] President & Trustees of Colby College v. Colby College--New Hampshire, 508 F.2d 804, 185 U.S.P.Q. 65 (1st Cir. 1975) (50 percent); RJR Foods, Inc. v. White Rock Corp., 201 U.S.P.Q. 578, 1978 WL 21389 (S.D.N.Y. 1978), aff'd, 603 F.2d 1058, 203 U.S.P.Q. 401 (2d Cir. 1979) (66% association probative of secondary meaning in trade dress design); In re Raytheon Co., 202 U.S.P.Q. 317, 1979 WL

24840 (T.T.A.B. 1979) (79% of mail questionnaires returned identified plaintiff by name as source of background design); Harlequin Enterprises, Ltd. v. Gulf & Western Corp., 644 F.2d 946, 210 U.S.P.Q. 1 (2d Cir. 1981) (50% association probative of secondary meaning in book cover design); Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 12 U.S.P.Q.2d 1740 (9th Cir. 1989) (A survey supported a finding of secondary meaning in a logo for sports wear for younger teenagers. The survey showed that 81% of persons 10 to 18 years old who participated in or viewed skateboarding or BMX bicycling exhibitions could identify the logo.); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 230 (S.D. N.Y. 2004) (consumer recognition of a CARTIER watch design as identifying a single source was in the range of 50% to 60% and sufficed to prove secondary meaning).

[FN16] North Carolina Dairy Foundation, Inc. v. Foremost-McKesson, Inc., 92 Cal. App. 3d 98, 154 Cal. Rptr. 794, 203 U.S.P.Q. 1012 (1st Dist. 1979) (46% of 800 women shoppers identified producer by name from the mark; held a substantial segment). *See* Tri-Star Pictures, Inc. v. Unger, 14 F. Supp. 2d 339, 349 (S.D. N.Y. 1998) (secondary meaning in the movie title BRIDGE ON THE RIVER KWAI was proven by a survey showing that of the 42% who had heard of or seen a movie with "River Kwai" in the title, 74% of them correctly identified BRIDGE ON THE RIVER KWAI as that movie).

[FN17] Monsieur Henri Wines, Ltd. v. Duran, 204 U.S.P.Q. 601, 1979 WL 24898 (T.T.A.B. 1979) (37% of interviewees associated opposer's brand with a background design; probative to corroborate finding of strong trademark in the design).

[FN18] *See* § 15:11.

[FN19] Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976), superseded by statute as stated in Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 227 U.S.P.Q. 138 (7th Cir. 1985).

[FN20] *See* Palladino, "Surveying Secondary Meaning," 84 Trademark Rep. 155, 178 n.94 (1994); V.N. Palladino, Secondary Meaning Surveys in Light of Lund, 91 Trademark Rptr 573, 589, n.39 (2001); V.N. Palladino, Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys, 92 Trademark Rptr 857, 864 (2002).

[FN21] *Compare* Spraying Systems Co. v. Delavan, Inc., 975 F.2d 387, 394, 24 U.S.P.Q.2d 1181, 1187 (7th Cir. 1992) (while a 50% figure would be sufficient, a 38% recognition figure is "marginal to prove secondary meaning even in a properly designed survey"), with Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 46 U.S.P.Q.2d 1026 (7th Cir. 1998) (*Spraying Systems* "did not establish that any recognition figure under 50% could not establish secondary meaning." A 30% recognition figure is "still probative" and should be weighed with other evidence.) *see* I.P. Lund Trading ApS v. Kohler Co., 118 F. Supp. 2d 92, 56 U.S.P.Q.2d 1776 (D. Mass. 2000) ("A fifty-percent figure (or higher) for consumer association of a product with one unique source is typically regarded as sufficient to establish secondary meaning." citing *Spraying Systems*.).

[FN22] Palladino, "Surveying Secondary Meaning," 84 Trademark Rep., at 183-84.

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:191. Secondary meaning—Secondary meaning survey formats

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

For several purposes, including definition of the universe and the design of questions in a secondary meaning consumer survey, it is important to know how much information about the product that the ordinary, reasonable consumer is assumed to already know prior to encountering the term whose descriptive status is in doubt.[FN1] The author feels that the better view is that of the "reasonably informed shopper." The hypothetical potential customer should be assumed to have that amount of basic knowledge about the product that most people would have from news and advertising.[FN2] However, such a person is not an expert and is not completely informed as to all the qualities and attributes of the product.

One difficulty in designing surveys to prove secondary meaning is in determining those customers who associate the term with a single, albeit *anonymous* source.[FN3] That is, how does a survey get interviewees to focus on the plaintiff as an unnamed source? This is not easy to accomplish, but not impossible. One method is to identify some aspect of plaintiff that is unique to it. For example, if interviewees name products made by plaintiff but not defendant, it is clear that they have plaintiff in mind as the source.[FN4] In another example, plaintiff Colby College was located in Maine and defendant Colby College was located in New Hampshire.[FN5] In the survey, interviewees were asked questions related to the differences between the parties. For example: "Where is Colby College located?" (37–79% answered "Maine"); "Is it a four year or two year institution?" (45–72% answered "four years," which was true of plaintiff and 4–15% answered "two years," which was true of defendant); "Is it coeducational?" (48-81% answered yes, whereas defendant was primarily a womens' college). Thus, where an overall average of 50% identified "Colby College" as a four-year, coeducational institution located in Maine, this correctly identified plaintiff according to three major characteristics by which the two parties could be distinguished.

A survey should reveal that survey respondents use the designation or trade dress to identify a single source, not that the party seeking trademark rights is listed as the first among several sources with which respondents as-

sociate the designation or trade dress.[FN6]

In the VOLA faucet case, plaintiff introduced three surveys using different methods to proven secondary meaning in the faucet product trade dress, but the court granted summary judgment, finding that there was insufficient evidence of secondary meaning.[FN7] In analyzing one of the surveys, the court said that it was improper to first ask if the surveyed person was "familiar" with the plaintiff's product shown in a photo and then remove those who were not: asking further ques tions only of those who were familiar. The court remarked that this "stacks the deck" in plaintiff's favor.[FN8]

One court found that because a majority of respondents answered in a "*Teflon* format" survey that they thought that MARCH MADNESS was a mark and not a generic name, that also proved the existence of secondary meaning.[FN9]

[FN1] *See* full discussion at § 11:21.

[FN2] *See, e.g.,* G. Heileman Brewing Co. v. Anheuser-Busch, Inc., 873 F.2d 985, 10 U.S.P.Q.2d 1801 (7th Cir. 1989) ("Typically, someone must first be informed of the existence and nature of a product before he chooses to purchase or consume it. It is the perception of this somewhat informed audience that massive advertising is intended to impact." This controls the weight of consumer survey evidence, such that a survey focusing on the state of mind of those totally uninformed about the product has little weight.).

[FN3] *See* discussion at § 15:8.

[FN4] *See, e.g.,* Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 U.S.P.Q. 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L. Ed. 2d 94, 97 S. Ct. 91, 191 U.S.P.Q. 416 (1976), superseded by statute as stated in Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 227 U.S.P.Q. 138 (7th Cir. 1985).

[FN5] President & Trustees of Colby College v. Colby College--New Hampshire, 508 F.2d 804, 185 U.S.P.Q. 65 (1st Cir. 1975).

[FN6] American Flange & Manufacturing Co., Inc. v. Rieke Corporation, 80 U.S.P.Q.2d 1397, 1415, 2006 WL 1706438 (T.T.A.B. 2006) (To prove secondary meaning, it is not sufficient to use survey results that show that applicant was the party "most commonly associated with" the product design.).

[FN7] I.P. Lund Trading ApS v. Kohler Co., 118 F. Supp. 2d 92, 56 U.S.P.Q.2d 1776 (D. Mass. 2000) ("Taken together, the court finds that a reasonable jury could not conclude that the three consumer surveys prove the VOLA faucet has acquired secondary meaning.").

[FN8] "Indeed, the numbers in this already limited constituency who could not identify the VOLA faucet speaks to the failure of [plaintiff's] promotional efforts.").

[FN9] March Madness Athletic Ass'n, L.L.C. v. Netfire, Inc., 310 F. Supp. 2d 786, 803–804 (N.D. Tex. 2003), judgment entered, 2003 WL 22173299 (N.D. Tex. 2003) and aff'd, 120 Fed. Appx. 540, 73

U.S.P.Q.2d 1599 (5th Cir. 2005) *See* § 12:16 for a description of the *Teflon* survey format.

MCCARTHY § 32:191

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:192. Generic name—Trademark significance

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580
West's Key Number Digest, Trade Regulation 583

In cases where an alleged trademark is challenged as being a public domain generic name, the understanding of a designation by the target group of persons as either a generic name or a trademark is the paramount issue, and surveys present a practicable way of introducing evidence on this issue. The formats commonly used for generic name surveys are discussed elsewhere in this treatise.[FN1]

Consumer surveys have become almost *de rigueur* in litigation over genericness. Judges are now used to survey evidence and often expect to receive evidentiary assistance by surveys in resolving generic disputes. A litigant who does not introduce a survey to support a generic challenge may be viewed as less than serious by many judges. As Judge Will stated in frustration, "Neither side in this case has produced any consumer surveys or other similar evidence. Both sides are at fault for such laxness."[FN2]

By way of example, in the THERMOS case, a consumer survey showed that about 75% used THERMOS as a generic name, about 12% thought the word had some trademark significance, and about 11% used the generic name "vacuum bottle." The court found that this meant that THERMOS was primarily generic, although injunctive relief could be drafted so as to protect residual trademark significance.[FN3] In the litigation over the alleged genericness of the mark CON-TACT for adhesive paper, survey evidence showed that from 69% to 84% of those questioned regarded CON-TACT as a trademark indicating source. The court held that the survey evidence went far to refute the contention that the term was generic.[FN4]

The majority view is that it is the principal or majority view which controls in a court determination of genericness.[FN5]

[FN1] *See* §§ 12:14 to 12:17.

[FN2] Gimix, Inc. v. JS&A Group, Inc., 213 U.S.P.Q. 1005, 1982 WL 52164 (N.D. Ill. 1982), aff'd on other grounds, 699 F.2d 901, 217 U.S.P.Q. 677 (7th Cir. 1983).

[FN3] American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9, 134 U.S.P.Q. 98 (D. Conn. 1962), aff'd, 321 F.2d 577, 138 U.S.P.Q. 349 (2d Cir. 1963), mot. denied, 289 F. Supp. 155, 159 U.S.P.Q. 604 (D. Conn. 1968), vacated, 418 F.2d 31, 163 U.S.P.Q. 65 (2d Cir. 1969), on remand, 320 F. Supp. 1156, 166 U.S.P.Q. 381, 169 U.S.P.Q. 85 (D. Conn. 1970). *See* § 12:51.

[FN4] Stix Products, Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968). *See* E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc., 393 F. Supp. 502, 185 U.S.P.Q. 597 (E.D.N.Y. 1975) (68% trademark significance).

[FN5] *See* §§ 12:6 to 12:8. *But see* discussion in Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp., 680 F.2d 755, 214 U.S.P.Q. 327 (C.C.P.A. 1982) (mark is abandoned for registration purposes only if all associative significance is lost).

MCCARTHY § 32:192

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

E. SIGNIFICANCE OF SURVEY RESULTS

References

§ 32:193. False advertising

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580
West's Key Number Digest, Trade Regulation 593
West's Key Number Digest, Trade Regulation 870(1)

If, in a false advertising case under Lanham Act § 43(a), a challenged advertisement does not convey a clear and unequivocal message, plaintiff must produce evidence, usually in the form of a consumer survey, showing what message the ad conveyed to the ordinary consumer.[FN1] Since the issue of likely customer deception from an allegedly false advertise ment is closely analogous to the issue of likely confusion from an allegedly infringing mark, it is proper to use the percentage figures accepted in likelihood of confusion surveys.[FN2] The hearsay exceptions that apply to different types of false advertising surveys are discussed elsewhere in this treatise.[FN3] In the determination of injunctive relief against false advertising under § 43(a), courts have used language very similar to the "appreciable" number of confused customers test used in trademark infringement cases. For example, one court, in evaluating the results of a consumer "message" survey, remarked that, "[A] qualitative rather than a quantitative determination is enough to support a conclusion that an advertisement 'tends' to mislead, if the qualitative showing establishes that a not insubstantial number of consumers receive a false or misleading impression from it."[FN4]

The Third Circuit held that a survey showing that 7.5% were deceived or misled by an advertisement was not sufficient to constitute the required "substantial portion of the intended audience."[FN5]

Courts have found survey figures to be sufficient when they revealed that 15%,[FN6] 20%,[FN7] 21% to 34%,[FN8] "over 25%,"[FN9] and 33%[FN10] of respondents received a misleading message from the ad. In one case, the court found that survey responses that showed over 50% of respondents perceived a message found to be misleading supports a finding of false advertising, but the court cautioned that: "[T]he survey is evidence of the tendency of the ad to deceive. The pertinent issue is not the specific percentage of deception revealed in the survey, but rather the tendency to deceive."[FN11]

[FN1] *E.g.,* U-Haul International, Inc. v. Jartran, Inc., 522 F. Supp. 1238, 212 U.S.P.Q. 49 (D. Ariz. 1981), aff'd, 681 F.2d 1159, 216 U.S.P.Q. 1077 (9th Cir. 1982), on remand, 601 F. Supp. 1140, 225 U.S.P.Q. 306 (D. Ariz. 1984), aff'd in part and rev'd in part, modified, in part, 793 F.2d 1034, 230 U.S.P.Q. 343 (9th Cir. 1986). *See* discussion at §§ 27:49 to 27:71. *See also* Comment, "The Use and Reliability of Survey Evidence in Deceptive Advertising Cases," 62 Oregon L. Rev. 561 (1983); Max Daetwyler Corp. v. Input Graphics, Inc., 608 F. Supp. 1549, 226 U.S.P.Q. 393 (E.D. Pa. 1985) (Held that while a consumer survey is useful to establish consumer deception in a false advertising claim under Lanham Act § 43(a), it is not essential. Summary judgment for defendant on this ground was denied.); Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharmaceuticals Co., 129 F. Supp. 2d 351, 57 U.S.P.Q.2d 1522, 1532 (D.N.J. 2000), judgment aff'd, 290 F.3d 578, 62 U.S.P.Q.2d 1757 (3d Cir. 2002) ("Questions that focus on whether a consumer received a particular message are appropriate when it can be shown, through 'filter' questions, that respondents are receiving some message from the stimulus.").

See Jacoby, Handlin & Simonson, "Survey Evidence in Deceptive Advertising Cases Under the Lanham Act," 84 Trademark Rep. 541 (1994).

[FN2] *See* Scotch Whiskey Ass'n v. Consolidated Distilled Products, Inc., 210 U.S.P.Q. 639, 1981 WL 40524 (N.D. Ill. 1981). *See* §§ 32:184 to 32:189.

[FN3] *See* § 32:169.

[FN4] McNeilab, Inc. v. American Home Products Corp., 501 F. Supp. 517, 207 U.S.P.Q. 573 (S.D.N.Y. 1980), modified, 501 F. Supp. 540, 212 U.S.P.Q. 593 (S.D.N.Y. 1980). *See* Johnson & Johnson * Merck Consumer Pharmaceuticals Co. v. Smithkline Beecham Corp., 960 F.2d 294, 22 U.S.P.Q.2d 1362, 1366 (2d Cir. 1992) (plaintiff must demonstrate that "a statistically significant part of the commercial audience holds the false belief allegedly communicated by the challenged advertise- ment").

[FN5] Johnson & Johnson-Merck Consumer Pharmaceuticals Co. v. Rhone-Poulenc Rorer Pharmaceuticals, 19 F.3d 125, 30 U.S.P.Q.2d 1112, 1119 (3d Cir. 1994), digest op. at 14 P. L. W. 57 (3d Cir. 1994) (court noted that some cases suggest that 20% would be sufficient). *Accord* William H. Morris Co. v. Group W, 66 F.3d 255, 36 U.S.P.Q.2d 1377 (9th Cir. 1995) (3% is such a "small percentage" that it is not proof that a "significant portion" were deceived).

[FN6] Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharmaceuticals Co., 290 F.3d 578, 62 U.S.P.Q.2d 1757 (3d Cir. 2002) (survey evidence showing that 15% of the respondents were misled is sufficient to prove a likelihood of deception among a "substantial portion" of the intended audience.).

[FN7] Telebrands Corp. v. Media Group, Inc., 45 U.S.P.Q.2d 1342, 1997 WL 790576 (S.D.N.Y. 1997) (because a survey showed that 20% of the persons that viewed defendant's can opener television ad took away the false message that you will not cut yourself on the opened can edge, this proves that an ad that is not literally false does contain an implicitly false representation; preliminary injunction granted).

[FN8] McNeilab, Inc. v. American Home Products Corp., 675 F. Supp. 819, 6 U.S.P.Q.2d 2001, 2004 (S.D.N.Y. 1987), aff'd, 848 F.2d 34, 6 U.S.P.Q.2d 2007 (2d Cir. 1988) (21% to 34% of respondents in surveys received a misleading message from the challenged advertisement. These surveys "establish, although not in precise or even approximate quantitative terms, that a substantial fraction of those who hear the ADVIL commercials in question [receive a misleading impression].").

[FN9] R. J. Reynolds Tobacco Co. v. Loew's Theatres, Inc., 511 F. Supp. 867, 210 U.S.P.Q. 291 (S.D.N.Y. 1980) (between 20% and 33 percent, with average over 25% and concluding that "over 25% is not an insubstantial number of consumers").

[FN10] Scotch Whiskey Ass'n v. Consolidated Distilled Products, Inc., 210 U.S.P.Q. 639, 1981 WL 40524 (N.D. Ill. 1981).

[FN11] Tyco Industries, Inc. v. Lego Systems, Inc., 5 U.S.P.Q.2d 1023, 1987 WL 44363 (D.N.J. 1987), aff'd, 853 F.2d 921 (3d Cir. 1988), cert. denied, 488 U.S. 955, 102 L. Ed. 2d 381, 109 S. Ct. 392 (1988).

MCCARTHY § 32:193

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

F. THE NEED FOR SURVEY EVIDENCE

References

§ 32:194. Comment: judicial receptiveness to survey evidence—History of survey evidence

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

In 1969, one court said that it had found no case in which a survey was used to support a finding of likelihood of confusion, that the survey was the *only* evidence on that issue.[FN1] However, such a sweeping generalization is hard to substantiate, for the opinions hardly ever pin down exactly the evidentiary basis upon which likelihood of confusion is decided.[FN2]

The need for a more certain test of probable consumer reaction than mere judicial hunches was noted as early as 1930 by legal scholars:

> The unscientific procedural methods employed in determining infringement are probably more responsible for the chaotic condition of the law than the substantive rules themselves. … The results of the courts would be more certain and predictable if the technique that has been developed in the conduct of market analyses was applied in determining whether two brands conflict. Whether the purchaser is likely to be misled is better ascertained in the marketplace than in the courtroom. There is need for a more objective determination.[FN3]

A conscientious judge is distrustful of his or her own subjective estimations of consumer reaction and welcomes some accurate factual information on this score. As Judge Frank stated:

> As neither the trial judge nor any member of this court is (or resembles) a teenage girl or the mother or sister of such a girl, our judicial notice apparatus will not work well unless we feed it with information directly obtained from "teenagers" or from their female relatives accustomed to shop for them. Competently to inform ourselves, we should have a staff of investigators like those supplied to administrative agencies … plaintiff, or the trial judge, might have utilized, but did not, "laboratory" tests, of a sort now familiar, to ascertain whether numerous girls and women, seeing both plaintiff's magazine and defendants' advertisements,

would believe them to be in some way associated.[FN4]

Thirty years later, the Second Circuit, after noting Judge Frank's lament, remarked that, "The law of unfair trade practices has come a long way" since then.[FN5] The court strongly endorsed the use of consumer surveys to determine the mental state of consumers.

By 1983, the Fifth Circuit could state that: "Survey evidence is often critically important in the field of trademark law. We heartily embrace its use, so long as the survey design is relevant to the legal issue, open-ended in its construction, and neutral in its administration."[FN6]

[FN1] Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969) (cases cited).

[FN2] *See* § 23:90.

[FN3] Handler & Pickett, "Trademarks and Trade Names," 30 Colum. L. Rev. 759 n.85 (1930).

[FN4] Triangle Publications, Inc. v. Rohrlich, 167 F.2d 969, 77 U.S.P.Q. 196, 77 U.S.P.Q. 294 (2d Cir. 1948) (Frank, J. dissenting).

[FN5] American Home Products Corp. v. Johnson & Johnson, 577 F.2d 160, 198 U.S.P.Q. 132 (2d Cir. 1978).

[FN6] Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, n.4, 217 U.S.P.Q. 988, 996 n.4 (5th Cir. 1983).

MCCARTHY § 32:194

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

F. THE NEED FOR SURVEY EVIDENCE

References

§ 32:195. Comment: judicial receptiveness to survey evidence—Rising judicial expectations

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

As the use of surveys has become more common, judges have come to expect that a survey will be introduced to aid the court in determining customers' state of mind. Some courts have remarked on the failure to introduce a survey as indicating that a litigant is less than deadly serious about its case. For example, Judge Weinfeld, in refusing to issue an injunction, noted that the party asserting confusion was "a substantial corporation with the means to have undertaken a survey or an investigation to establish instances of actual consumer confusion" and failed to do so, even though "such surveys are not uncommon in these types of cases."[FN1] Similarly, Judge Will, in a case of alleged genericness, complained that, "Neither side in this case has produced any consumer surveys or other similar evidence. Both sides are at fault for such laxness."[FN2] In the same mode, Judge Ackerman remarked that the failure of a plaintiff to conduct a survey to prove secondary meaning or likely confusion where it has the financial means to do so "may give rise to the inference that the contents of the survey would be unfavorable."[FN3]

Similarly, other courts have given broad hints that when plaintiff has less than a clear case, a survey is necessary to prove secondary meaning[FN4] or to prove a likelihood of confusion.[FN5] The Second Circuit said that when a trademark owner fails to respond with its own survey after an accused infringer produces a survey indicating a lack of confusion, then this "weighs against a finding of consumer confusion."[FN6]

These kind of judicial remarks have sometimes led trademark litigators to conclude that, unless the evidence is otherwise strong, a survey is needed to fill the gap.[FN7] Edelman has opined that the absence of a confusion survey should be treated as a negative in plaintiff's case only if the case is suitable for a survey, there has been time to conduct one and there is no evidence of actual confusion.[FN8]

However, the courts have been careful to state that a survey is not necessary in every case. That is, there is no flat rule that a survey must be introduced to obtain a preliminary injunction,[FN9] a permanent injunc-

tion,[FN10] or to recover damages.[FN11] The Third Circuit remarked that a survey is not essential to prove likely confusion in a container trade dress case: "While consumer surveys are useful, and indeed the most direct method of demonstrating secondary meaning and likelihood of confusion, they are not essential where, as here, other evidence exists." Thus the court said it was not error for the trial judge to refuse to give the jury an instruction to consider the significance of plaintiff's failure to conduct a survey.[FN12] The Sixth Circuit has said that while a consumer survey is "helpful" to proving secondary meaning in a trade dress case, it is not a "prerequisite."[FN13]

The Trademark Board has stressed that while it is receptive to survey evidence, such evidence is not mandatory to establish a likelihood of confusion where other evidence exists. The Board will not draw a negative inference from a party's failure to offer survey evidence.[FN14]

The Federal Circuit has held that gauging the "fame" or strength of a mark is a "dominant factor" in determining whether a likelihood of confusion exists.[FN15] However, direct evidence in the form of surveys of the "fame" or the strength of the mark is not necessary: circumstantial evidence will suffice.[FN16]

While the courts are careful in opinions not to place all their evidentiary eggs in the survey basket, an increasing number of opinions expressly rely upon survey evidence to substantiate the decision.[FN17]

[FN1] Mushroom Makers, Inc. v. R. G. Barry Corp., 441 F. Supp. 1220, 196 U.S.P.Q. 471 (S.D.N.Y. 1977), aff'd, 580 F.2d 44, 199 U.S.P.Q. 65 (2d Cir. 1978), cert. denied, 439 U.S. 1116, 59 L. Ed. 2d 75, 99 S. Ct. 1022, 200 U.S.P.Q. 832 (1979). *See* similar comments by Judge Weinfeld in Information Clearing House, Inc. v. Find Magazine, 492 F. Supp. 147, 209 U.S.P.Q. 936 (S.D.N.Y. 1980); Essence Communications, Inc. v. Singh Industries, Inc., 703 F. Supp. 261, 10 U.S.P.Q.2d 1036, 1042 (S.D.N.Y. 1988) (Judge Sweet said: "[Plaintiff's] failure to offer a survey showing the existence of confusion is evidence that the likelihood of confusion cannot be shown." Preliminary injunction denied.); Planet Hollywood, Inc. v. Hollywood Casino Corp., 80 F. Supp. 2d 815, 884 (N.D. Ill. 1999), clarified, 1999 WL 1186802 (N.D. Ill. 1999) ("[T]he Court finds that Planet Hollywood's failure to offer evidence of actual confusion—either directly or through a survey—demonstrates a failure of proof by Planet Hollywood on the important element of actual confusion." No likelihood of confusion was found.); Christian v. Alloy, Inc., 72 U.S.P.Q.2d 1697, 2004 WL 1375274 (S.D. N.Y. 2004) ("One method frequently resorted to in such a situation is to initiate a consumer survey, here, with plenty of time to do so, [plaintiff[did nothing of the kind.").

[FN2] Gimix, Inc. v. JS&A Group, Inc., 213 U.S.P.Q. 1005, 1982 WL 52164 (N.D. Ill. 1982), aff'd on other grounds, 699 F.2d 901, 217 U.S.P.Q. 677 (7th Cir. 1983).

[FN3] Eagle Snacks, Inc. v. Nabisco Brands, Inc., 625 F. Supp. 571, 228 U.S.P.Q. 625, 633 (D.N.J. 1985) (plaintiff's motion for preliminary injunction was denied). *See* Sports Traveler, Inc. v. Advance Magazine Publishers, Inc., 25 F. Supp. 2d 154, 164 (S.D.N.Y. 1998) (publisher of defunct magazine did not conduct a consumer survey to prove secondary meaning because it did not have the financial resources to do so. Held: "This factor favors [defendant]." Trade dress claim was dismissed on summary judgment.).

[FN4] In re Certain Vacuum Bottles & Components Thereof, 219 U.S.P.Q. 637, 1982 WL 54201 (Int'l Trade Comm'n 1982) (International Trade Commission said that to prove secondary meaning in a weak mark, "strong evidence" is needed. A consumer survey was necessary to prove that the appearance of a vacuum bottle had achieved secondary meaning. No survey was introduced and no secondary meaning proven.); Brown v. Quiniou, 744 F. Supp. 463, 16 U.S.P.Q.2d 1161 (S.D.N.Y. 1990) (where other evidence of secondary meaning and strength is "hardly overwhelming," the absence of a survey "weighs heavily against plaintiff's position"; plaintiff's motion for summary judgment denied); Merriam-Webster, Inc. v. Random House, 35 F.3d 65, 32 U.S.P.Q.2d 1010 (2d Cir. 1994), cert. denied, 513 U.S. 1190, 131 L. Ed. 2d 133, 115 S. Ct. 1252 (U.S. 1995) (failure to take a survey in a trade dress case "counts against finding actual confusion"); Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc., 149 F.3d 722, 47 U.S.P.Q.2d 1587 (7th Cir. 1998) (Plaintiff did not submit any consumer testimony or surveys: "While not fatal to its request [for a finding of secondary meaning], the absence of that evidence weighs against [plaintiff]." No secondary meaning was found.).

[FN5] Mattel, Inc. v. Azrak-Hamway International, Inc., 724 F.2d 357, 221 U.S.P.Q. 302 (2d Cir. 1983) (in affirming the denial of a preliminary injunction regarding the shape of dolls, Second Circuit remarked that while a consumer survey has become "a usual way" to prove secondary meaning and likelihood of confusion where those elements are "not otherwise obvious," plaintiff introduced no survey); Universal City Studios, Inc. v. Nintendo Co., 746 F.2d 112, 223 U.S.P.Q. 1000 (2d Cir. 1984) (where the products of the parties are very different, a claim of likely confusion must have some evidence of actual confusion or a survey); Braun, Inc. v. Dynamics Corp. of America, 975 F.2d 815, 24 U.S.P.Q.2d 1121, 1132 (Fed. Cir. 1992) (plaintiff's "failure to proffer survey evidence, empirical studies, or disinterested testimony from consumers or members of the trade as to this issue, suggests that the public is not likely to be confused"); Columbia University v. Columbia/HCA Healthcare Corp., 964 F. Supp. 733, 43 U.S.P.Q.2d 1083 (S.D.N.Y. 1997) ("The plaintiff's total failure to introduce any of its own survey evidence also weighs against finding actual confusion."); Atlantic Richfield Co., 43 U.S.P.Q.2d 1574, 1580, 1997 WL 607488 (S.D. N.Y. 1997), aff'd, 150 F.3d 189, 47 U.S.P.Q.2d 1529 (2d Cir. 1998), aff'd on other grounds, 150 F.3d 189, 47 U.S.P.Q.2d 1529 (2d Cir. 1998) ("[P]laintiff offered no survey evidence, empirical studies or expert testimony to suggest that the public is or is likely to be confused. Plaintiff's failure to introduce such evidence is significant.").

[FN6] Star Industries, Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 75 U.S.P.Q.2d 1098 (2d Cir. 2005), cert. denied, 126 S. Ct. 1570, 164 L. Ed. 2d 298 (U.S. 2006) (affirming a bench trial decision of no infringement).

[FN7] *See* Robin & Barnaby, "Trademark Surveys: Heads You Lose, Tails They Win," 73 Trademark Rep. 436, 440 (1983) ("As long as courts continue to criticize trademark owners for failure to take a survey, the attorney representing a trademark owner in a trademark infringement action may be reluctant to adopt a trial strategy which does not include a survey. At least if a survey is conducted, a court will not be able to suggest that such 'attorney failure' contributed to an unfavorable decision."); Reference Manual on Scientific Evidence, 236 (Federal Judicial Center 2d ed. 2000) ("Indeed, several courts have drawn negative inferences from the absence of a survey, taking the position that failure to undertake a survey may strongly suggest that a properly done survey would not support the plaintiff's posi- tion.").

[FN8] S. Edelman, Failure to Conduct a Survey in Trademark Infringement Cases: A Criticism of the

Adverse Inference, 90 Trademark Rptr 746, 769 (2000) ("This article concludes the absence of survey evidence of confusion should be deemed significant and treated as a negative in the multifactor analysis of likelihood of confusion, only when the trademark owner has had time to conduct a survey, where no logistical obstacles are present and there is no persuasive evidence of 'real' actual confusion.").

[FN9] Le Sportsac, Inc. v. K Mart Corp., 754 F.2d 71, 225 U.S.P.Q. 654 (2d Cir. 1985) (there is no flat rule that a survey must be introduced to obtain preliminary injunction); International Kennel Club, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 6 U.S.P.Q.2d 1977 (7th Cir. 1988) (under the Seventh Circuit standard for obtaining a preliminary injunction, the moving party is not required to introduce a survey to prove a "better than negligible chance" of proving secondary meaning); First Federal Sav. & Loan Ass'n v. First Federal Sav. & Loan Ass'n, 929 F.2d 382, 18 U.S.P.Q.2d 1394 (8th Cir. 1991) (while a survey is "undoubtedly helpful," it is not an essential ingredient of a successful claim for an injunction against infringement); Susan's, Inc. v. Thomas, 26 U.S.P.Q.2d 1804, 1993 WL 93333 (D. Kan. 1993) ("There is no authority, however, to support the argument that a scientific survey is required at any time during this litigation and certainly none is required for the issuance of a preliminary injunction." Preliminary injunction was granted.); Meridian Mutual Insurance Co. v. Meridian Insurance Group, Inc., 128 F.3d 1111, 44 U.S.P.Q.2d 1545 (7th Cir. 1997) (defendants emphasized plaintiff's failure to produce a consumer survey at the hearing for a preliminary injunction; the court of appeals reversed the denial of an injunction and remanded for immediate entry of a preliminary injunction).

[FN10] Badger Meter v. Grinnell Corp., 13 F.3d 1145, 29 U.S.P.Q.2d 1507, 1513 (7th Cir. 1994) ("[Defendant] argues strenuously that [plaintiff's] failure to introduce any market survey evidence of likely consumer confusion militates against finding such a likelihood; once again, however, this goes to the weight and not to the sufficiency of the evidence." Permanent injunction against infringement of trade dress in configuration of water meter was affirmed.).

[FN11] Getty Petroleum Corp. v. Island Transp. Corp., 878 F.2d 650, 11 U.S.P.Q.2d 1334 (2d Cir. 1989) (while a plaintiff seeking damages is normally required to prove some actual confusion, survey evidence of confusion is not essential where the jury can use its common sense to determine that consumers were deceived by the substitution of one brand of gasoline for another in trademarked pumps); Tools USA & Equip. Co. v. Champ Frame Straightening Equip., 87 F.3d 654, 39 U.S.P.Q.2d 1355 (4th Cir. 1996) (surveys are not required to prove a likelihood of confusion; award of actual damages was affirmed).

[FN12] Charles Jacquin Et Cie, Inc. v. Destileria Serralles, Inc., 921 F.2d 467, 17 U.S.P.Q.2d 1104 (3d Cir. 1990).

[FN13] Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc., 270 F.3d 298, 60 U.S.P.Q.2d 1633 (6th Cir. 2001) (summary dismissal for failure to show a triable issue on secondary meaning was re- versed).

[FN14] Hilson Research, Inc. v. Society for Human Resources Management, 27 U.S.P.Q.2d 1423, 1435-36 (T.T.A.B. 1993); McDonald's Corp. v. McClain, 37 U.S.P.Q.2d 1274 (T.T.A.B. 1995) ("Neither party is obligated, in a proceeding before the Board, to spend the effort and expense to obtain such evidence."). *See* § 32:77.

[FN15] *See* § 24:43.

[FN16] Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) ("[W]e have consistently accepted statistics of sales and advertising as indicia of fame … .").

[FN17] *See, e.g.,* Consolidated Freightways, Inc. v. Central Transport, Inc., 201 U.S.P.Q. 524 (E.D. Mich. 1978) (survey found "credible and entitled to substantial weight"); RJR Foods, Inc. v. White Rock Corp., 201 U.S.P.Q. 578 (S.D.N.Y. 1978), aff'd, 603 F.2d 1058, 203 U.S.P.Q. 401 (2d Cir. 1979) ("Survey evidence is particularly useful since evidence of actual confusion is quite difficult to find."); Scotch Whiskey Ass'n v. Consolidated Distilled Products, Inc., 210 U.S.P.Q. 639 (N.D. Ill. 1981) (survey found "particularly persuasive"); U-Haul International, Inc. v. Jartran, Inc., 522 F. Supp. 1238, 212 U.S.P.Q. 49 (D. Ariz. 1981), aff'd, 681 F.2d 1159, 216 U.S.P.Q. 1077 (9th Cir. 1982) (survey heavily relied upon); National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc., 532 F. Supp. 651, 215 U.S.P.Q. 175 (W.D. Wash. 1982) (survey "well-designed, meticulously exe cuted"); Piper Aircraft Corp. v. Wag-Aero, Inc., 741 F.2d 925, 223 U.S.P.Q. 202 (7th Cir. 1984) (45% results are "high" and a factor "weighing strongly" in support of a likelihood of confusion); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 U.S.P.Q.2d 1889 (Fed. Cir. 1991) (a survey result of 30% confused customers supports a finding of likely confusion).

See Jacobs, "Survey Evidence in Trademark and Unfair Competition Litigation," 6 ALI-ABA Course Materials 97, 98 (1982) (of 51 cases in which a survey was introduced on the issue of likelihood of confusion, the survey was received and given weight in 35 cases and in the other cases, the survey was either given little or no weight or rejected outright).

MCCARTHY § 32:195

END OF DOCUMENT

McCarthy on Trademarks and Unfair Competition, Fourth Edition
Database updated September 2009

J. Thomas McCarthy

Chapter
32. Procedure in Trademark Infringement and Unfair Competition Litigation

X. SURVEY EVIDENCE

F. THE NEED FOR SURVEY EVIDENCE

References

§ 32:196. Comment: judicial receptiveness to survey evidence—Realistic view of survey evidence

West's Key Number Digest

West's Key Number Digest, Trade Regulation 580

From the cases where survey evidence was introduced, one senses that the trier of fact (from Patent and Trademark Office Examiner to Court of Appeals Judge) sometimes views survey evidence of respondent's state of mind with something less than enthusiasm. Too often, the cases reveal an unwarranted hypercritical attitude towards surveys. The criteria set for a "proper" survey sometimes appear to be impossible to meet.[FN1]

A skeptic would classify the survey cases into two categories: a survey is accepted and relied upon when the judge already had his or her mind made up in favor of the survey results; and a survey is rejected and torn apart when the judge subjectively disagrees with the survey results.[FN2] Since an estimation of the probable mental reactions and associations of the buying public is not a science, there is always the temptation to decide on the basis of a "hunch."[FN3] That is, the trier of fact (or any human being) would rather extrapolate from his or her own subjective impressions than extrapolate from some hard evidence of other persons' subjective impressions—especially if the two do not agree.

Probably, a part of a lingering judicial skepticism about survey evidence can be laid at the feet of parties and their attorneys who, in a desperate search for *some kind* of evidence, offer, with a straight face, a haphazard, self-serving "survey." It may not be surprising that many judges view such purported "scientific evidence" with distaste. They know that the techniques of testing and sampling buyer reactions have been developed to a fairly high degree of accuracy. Thus, there is no real excuse for a biased survey which attempts to measure buyer reaction by means of leading or irrelevant questions asked in an environment far removed from the marketplace. The reason, of course, that accurate and scientifically precise surveys are not always offered is that they are costly. Perhaps the best that can be said is that no survey at all is better than a survey obtained "on the cheap." As weak arguments detract from even a strong case, a weak survey may detract from even the strongest case of trademark infringement or unfair competition.

[FN1] *See, e.g.,* Marcalus Mfg. Co. v. Watson, 156 F. Supp. 161, 115 U.S.P.Q. 232 (D.D.C. 1957), aff'd, 258 F.2d 151, 118 U.S.P.Q. 7 (D.C. Cir. 1958) (survey rejected because interviews conducted in supermarket where interviewees might have seen the label in question); Jenkins Bros. v. Newman Hender & Co., 289 F.2d 675, 129 U.S.P.Q. 355 (C.C.P.A. 1961) (survey evidence rejected, inter alia, on ground that when interviewee shown whole product or label, it is uncertain which part motivates the responses); American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 204 U.S.P.Q. 609 (2d Cir. 1979), cert. denied, 445 U.S. 951, 63 L. Ed. 2d 787, 100 S. Ct. 1601, 205 U.S.P.Q. 680 (1980) (taking a hyper-critical view of adequate survey methods and questions); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 205 U.S.P.Q. 969, 979-80 (5th Cir. 1980), cert. denied, 449 U.S. 899, 66 L. Ed. 2d 129, 101 S. Ct. 268, 208 U.S.P.Q. 464 (1980) (In the case of DOMINO sugar vs. DOMINO'S pizza, plaintiff's survey of housewives in their homes was rejected for surveying the wrong universe, because it "neglected completely defendant's primary customers—young, single, male college students." Defendant's survey was rejected, because, among other reasons, "it was conducted on the premises of "Domino's Pizza" outlets and therefore did not examine a proper survey universe."); Stuart Hall Co. v. Ampad Corp., 51 F.3d 780, 34 U.S.P.Q.2d 1428, 1436 (8th Cir. 1995) (chiding district court for too-critical view of survey: "The court is splitting hairs here: it would prefer a survey of people who are causal, but not *too* casual.").

[FN2] How can one distinguish two opinions, directly contradictory, as to whether a local ALLSTATE driving school infringes upon the Sears ALLSTATE insurance mark? In one case, a consumer survey was accepted and relied upon and infringement found: Sears, Roebuck & Co. v. Johnson, 219 F.2d 590, 104 U.S.P.Q. 280 (3d Cir. 1955). In the other, the survey was rejected and no infringement found: Sears, Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D.N.Y. 1969).

The Second Circuit quoted the sentence in the treatise and remarked that "This skepticism is unwarranted." However, the court cited many conflicting cases and attempted to clarify the law. Schering Corp. v. Pfizer, Inc., 189 F.3d 218, 51 U.S.P.Q.2d 1705, 1712 (2d Cir. 1999).

[FN3] *See* § 23:90.

MCCARTHY § 32:196

END OF DOCUMENT

Exhibit C

WEB SEARCH STUDY

TOP SHEET

(THIS IS A PERSONAL INTERVIEW)

– SCREENER –

RESPONDENT I.D. #: _____

(RECORD AT END OF INTERVIEW. PLEASE PRINT.)

RESPONDENT'S NAME:_____ TEL. # ( )_____

CITY:_____ STATE: _____ **ZIP:** _____

INTERVIEWER:_____ DATE: _____

RESPONDENT I.D. #: _____

Web Search Survey

– SCREENER –

INTRODUCTION:
Hello, I am _____ from _____. We are conducting a brief survey and would like to include your opinions. Please be assured that the questions are for research only and we are not selling anything.

NOTE: RECORD ALL TERMINATIONS WHICH OCCUR IN ANY QUESTION S0-S2 BY CIRCLING THE NEXT AVAILABLE NUMBER IN GRID AT BOTTOM OF THIS BOX. RECORD ONLY ONE TERMINATION PER CONTACT. RE-USE SCREENER UNTIL YOU REACH A QUALIFIED RESPONDENT.

S0. Are you a US citizen?

1 Yes
2 No ***[SCREEN OUT]***

S1. Do you or does anyone else in your household work for any of the following? **(READ ENTIRE LIST AND CIRCLE ALL THAT APPLY)**

1 A market research company ***[SCREEN OUT]***
2 A company that sells videos and DVDs
3 A company that sells travel packages
4 An internet search engine company ***[SCREEN OUT]***
5 A company that makes products for learning foreign languages ***[SCREEN OUT]***
6 A store or company located in this mall ***[SCREEN OUT]***
7 No, none of the above

S2. In the past three months, have you participated in a market research study, other than a political poll? **(RECORD SINGLE ANSWER)**

1 Yes ***[SCREEN OUT]***
2 No
3 Don't know ***[SCREEN OUT]***

RECORD TERMINATIONS WHICH OCCUR ON THIS PAGE BELOW:																								
1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20	21	22	23	24	25
26	27	28	29	30	31	32	33	34	35	36	37	38	39	40	41	42	43	44	45	46	47	48	49	50

S3. I am going to read you a list of topics. For each topic, please tell me if this is something you are interested in or are not interested in. Are you interested in… [READ LIST. CHECK ALL THAT APPLY]

	YES I am Interested	NO, NOT Interested	Don't Know
Learning how to play a musical instrument			
Learning new cooking techniques			
Learning a foreign language			
Learning simple car repair			
Learning how to better manage your finances			

[IF RESPONDENT SAYS HE/SHE IS NOT INTERESTED IN "LEARNING A FOREIGN LANGUAGE" OR DOES NOT KNOW WHETHER INTERESTED IN A FOREIGN LANGUAGE, THANK AND SCREEN OUT.]

S4. You mentioned learning a foreign language as one of your interests. In the next 12 months, do you think you will or will not search for information about learning a foreign language on the internet?

1 Yes, will use the internet to search for information about learning a foreign language
2 No, will not use the internet to search for information about learning a foreign language
3 Don't know
4 Refused

[IF RESPONDENT IN THE NEXT YEAR WOULD NOT USE THE INTERNET TO SEARCH FOR INFORMATION ABOUT LEARNING A FOREIGN LANGUAGE, DOES NOT KNOW OR REFUSED IN S4 THANK AND SCREEN OUT.]

S5. I am going to read a list of companies that have foreign language products. Please tell me, which, if any of these companies you have heard of? [READ ENTIRE LIST AND CIRCLE ALL THAT APPLY]

1 Berlitz

2 Pimsleur

3 Rosetta Stone

4 Fluenz

5 None of these

[IF RESPONDENT HAS NOT HEARD OF "ROSETTA STONE" THANK AND SCREEN OUT.]

RECORD TERMINATIONS FOR S3, S4 AND S5 BELOW:																							
1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20	21	22	23	24	25
26	27	28	29	30	31	32	33	34	35	36	37	38	39	40	41	42	43	44	45	46	47	48	49	50

S6. I'd like to read a list of internet search engines. Please tell me which of these search engines you have used in the past 12 months? [READ ENTIRE LIST AND CIRCLE ALL THAT APPLY]

1 AOL

2 Ask.com

3 Google

4 MSN Live Search

5 Yahoo

S7. And which of these search engines do you think you will use in the next 12 months? [READ ENTIRE LIST AND CIRCLE ALL THAT APPLY]

1 AOL

2 Ask.com

3 Google

4 MSN Live Search

5 Yahoo

IF RESPONDENT HAS NOT USED GOOGLE IN PAST 12 MONTHS (S6) AND WILL NOT USE GOOGLE IN THE NEXT 12 MONTHS THANK AND SCREEN OUT.

RECORD TERMINATIONS WHICH OCCUR IN S6 AND S7 (GOOGLE NOT MENTIONED) HERE:																							
1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20	21	22	23	24	25
26	27	28	29	30	31	32	33	34	35	36	37	38	39	40	41	42	43	44	45	46	47	48	49	50

S8. (RECORD GENDER BY OBSERVATION)

1 Male

2 Female

S9. And, into which of the following categories does your age fall?

1 18 – 24

2 25 – 34

3 35 – 44

4 45 – 54

5 55 or older

6 (VOL) Under 18 or Refused age ***[SCREEN-OUT]***

INTERVIEWER: CHECK AGE/GENDER QUOTAS AND TERMINATE IF FULL. RECORD IN THE APPROPRIATE BOX BELOW.

O/Q TERM– M18 - 24 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– M25 - 34-- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– M35 - 44 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– M45 - 54 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– M 55+ -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– F18 - 24 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– F25 - 34 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– F35 - 44 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– F45 - 54 -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
O/Q TERM– F 55+ -- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	

RECORD UNDER 18 / REFUSED AGE TERMINATIONS S18 HERE:																							
1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20	21	22	23	24	25
26	27	28	29	30	31	32	33	34	35	36	37	38	39	40	41	42	43	44	45	46	47	48	49	50

INTERVIEWER: IF RESPONDENT IS NOT WEARING GLASSES:

S10. Do you normally wear glasses or contact lenses when you read?

1 Yes

2 No ***[SKIP TO S12]***

3 Not sure / Refused ***[SCREEN-OUT]***

S11. Are you willing to bring them with you and wear them for the interview?

1 Yes

2 No/Refused ***[SCREEN-OUT]***

INTERVIEWER: IF RESPONDENT REFUSES TO ANSWER S10 OR REFUSES TO WEAR CONTACTS / GLASSES IN S11, TERMINATE AND RECORD IN THE APPROPRIATE BOX BELOW BASED ON RESPONDENT'S AGE & GENDER.

S10/S11 TERM–M18-24-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–M25-34-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–M35-44-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–M45-54-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–M55+- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–F18-24-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–F25-34-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–F35-44-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–F45-54-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
S10/S11 TERM–F 55+ - CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	

S12. We would like to invite you to participate in a short study that we think you will find interesting. Would you like to participate in this study? We will provide you a $5 incentive as a thank you for your time.

1 Yes, will participate ***[CONTINUE]***

2 No, will not participate ***[TERMINATE]***

INTERVIEWER: IF RESPONDENT REFUSES TO PARTICIPATE IN S12 TERMINATE AND RECORD IN THE APPROPRIATE BOX BELOW BASED ON RESPONENT'S AGE & GENDER.

REFUSAL TERM–M18-24-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–M25-34-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–M35-44-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–M45-54-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–M55+- CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–F18-24-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–F25-34-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–F35-44-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–F45-54-CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	
REFUSAL TERM–F 55+ - CIRCLE NEXT AVAILABLE NUMBER BELOW. ERASE AND RE-USE SCREENER.												
1	2	3	4	5	6	7	8	9	10	11	12	

BRING QUALIFIED RESPONDENT TO INTERVIEWING AREA.

Main Questionnaire

[SCREEN 1]

Thank you for participating in today's interview.

[INTERVIEWER: INSTRUCT RESPONDENT TO SIT IN FRONT OF THE LAPTOP COMPUTER. RESPONDENT SHOULD BE SEATED NEAR INTERVIEWER BUT NOT BE ABLE TO READ INTERVIEWER'S SCREEN]

To be sure that I have the correct information and that it is entered into the computer, I will need to ask you the questions that were just asked in the mall. This will only take a minute.

[RE-ASK ALL SCREENING QUESTIONS. IF RESPONDENT NO LONGER QUALIFIES, THANK RESPONDENT AND EXPLAIN THAT THEY ARE NOT ELIGIBLE TO COMPLETE THE STUDY].

[SCREEN 2]

Today we are conducting a study on how consumers use the internet. We are interested in your honest opinions. There are no right or wrong answers. If you don't know the answer to any of my questions, that's okay, just say you don't know or that you do not have an opinion. Please do not guess.

I am going to have you do a search on the internet. For this study, different survey participants are being asked to use different search engines to look for information about different brand name products. Today we are asking participants at this mall to use "Google" to search.

PROGRAMMING NOTE: RANDOMLY ASSIGN RESPONDENT TO CONDITION 1 or 2. QUOTA FOR EACH OF 8 SITES IS 50 OVERALL.

[SCREEN 3]

I am going to give you a brand name to enter in the search bar. First I need to open the web browser for you.

[INTERVIEWER: CLICK ON ICON (1 or 2) TO OPEN THE BROWSER ON THE LAPTOP FOR RESPONDENT]

[SCREEN 4]

Q1a. So that I can confirm that I opened the correct page for you, what number do you see on the screen?

1
2

[SCREEN 5]

I am now going to ask you to do a search on the internet using this computer. You can use the mouse to move the cursor and the roll button on the center of the mouse to scroll up and down as you normally would. One of the things you said you were interested in was learning a foreign language. Today I would like you to conduct a search for language learning software using the brand name on this card.
[INTERVIEWER, HAND RESPONDENT CARD].

[SCREEN 6]

Please go ahead click on the "Start" button on your screen to begin.
Please now go ahead and type this brand of language learning software [Rosetta Stone] into the search bar exactly as you see it printed on this card. When you have finished typing you can click on the "search" button.

[INTERVIEWER: CONFIRM RESPONDENT HAS TYPED THE SEARCH TERM CORRECTLY]

[SCREEN 7]

Q2. Do you see search results?
Yes [SKIP TO SCREEN 9]
No

[SCREEN 8 – IF Q2=NO]

Let me see if I can help you.

INTERVIEWER: RESET THE SEARCH PAGE AND ASK RESPONDENT TO TYPE THE SEARCH TERM AGAIN – MAKING SURE THEY TYPE THE WORDS EXACTLY. IF THE RESPONDENT STILL REPORTS THEY CANNOT SEE SEARCH RESULTS, TERMINATE INTERVIEW AND CONTACT SUPERVISOR IMMEDIATELY.

1 Respondent see results [GO BACK TO Q2 & UNSET]
2 Problems not resolved – terminate interview [TERMINATE]

[SCREEN 9]

Now, please look at this page as you would normally look at a search results page, but please do not click on any of the results at this time.
[CLICK 'NEXT' WHEN RESPONDENT IS READY TO PROCEED]

[SCREEN 10]

Q3. I would now like to ask you a few questions about these results. Which link or links if any do you think sells Rosetta Stone language software products?

PROGRAMMING NOTE: ALL POSSIBLE SITES THAT COULD BE SHOWN IN EACH OF THE CONDITIONS WILL BE LISTED FOR INTERVIEWERS TO RANK THE ORDER IN WHICH THEY WERE MENTIONED.

INTERVIEWER: RECORD CAREFULLY. IF NECESSARY, LOOK AT LINKS RESPONDENT IS POINTING TO. RECORD THE ORDER IN WHICH LINKS WERE MENTIONED BY USING NUMBERS; FOR EXAMPLE, TYPE A '1' IN THE BOX FOR THE LINK MENTIONED FIRST, TYPE A '2' IN THE BOX FOR THE LINK MENTIONED SECOND, ETC.

[SCREEN 11] [SHOW LINKS MENTIONED IN Q3]

Q4. Of the links you just mentioned, which link or links if any, are a Rosetta Stone company website?

INTERVIEWER: RECORD CAREFULLY. IF NECESSARY, LOOK AT LINKS RESPONDENT IS POINTING TO. RECORD THE ORDER IN WHICH LINKS WERE MENTIONED BY USING NUMBERS; FOR EXAMPLE, TYPE A '1' IN THE BOX FOR THE LINK MENTIONED FIRST, TYPE A '2' IN THE BOX FOR THE LINK MENTIONED SECOND, ETC.

[SCREEN 12 – SHOW LINKS NOT MENTIONED IN Q4 TO BE RANK ORDERED]

Q5. Of the links you mentioned, which link or links, if any, are endorsed by the Rosetta Stone company?

INTERVIEWER: RECORD CAREFULLY. IF NECESSARY, LOOK AT LINKS RESPONDENT IS POINTING TO. RECORD THE ORDER IN WHICH LINKS WERE MENTIONED BY USING NUMBERS; FOR EXAMPLE, TYPE A '1' IN THE BOX FOR THE LINK MENTIONED FIRST, TYPE A '2' IN THE BOX FOR THE LINK MENTIONED SECOND, ETC.

[SCREEN 13 ASK Q6 FOR EACH SITE MENTIONED IN Q.4. SHOW EACH ON SEPARATE SCREEN]

Q6. Now thinking about the links you mentioned, we would like to understand what it is about the link that makes you think it is a Rosetta Stone company website.

For example, why do you think the link that starts with the phrase – [SHOW FIRST ANSWER FROM Q3] – is a Rosetta Stone company website?

INTERVIEWER NOTE: IF RESPONDENT PROVIDES A GENERAL ANSWER FOR ALL LINK NAMES OR MENTIONS THAT THEY ALL HAVE THE SAME CHARACTERISTIC, SAY:
I need to confirm what you have said about all of the links for each of the individual links. Does what you said apply to [READ NAME OF LINK]?"

(INTERVIEWER: TYPE "SAME ANSWER" IF RESPONDENT CONFIRMS THEIR ANSWER FOR THIS LINK)

(OPEN-END; RECORD VERBATIM)

[SCREEN 14 – ASK Q7 FOR EACH SITE MENTIONED IN Q.5 SHOW EACH ON SEPARATE SCREEN]

Q7. Now I would like to ask you about the links that you indicated are endorsed by the Rosetta Stone company.

For example, why do you think the Rosetta Stone company endorses the link that starts with the phrase [SHOW LINK FROM Q5]?
(OPEN-END; RECORD VERBATIM)

[INTERVIEWER ENTER AND VERIFY INFORMATION COLLECTED ON SCREENER.]

Those are all the questions that I have for you today. I just need to confirm your name, phone number, and the zip code where you live to verify that you completed this interview. I need this information so that my supervisor can verify a portion of my work. If you are contacted, it will only be to confirm that I conducted this interview and for no other reason.

RESPONDENT STATEMENT

READ TO RESPONDENT:

By providing this information, you acknowledge that you were interviewed today, and that during this interview you conducted a web search and were asked some questions about what you saw.

(INTERVIEWER: CONFIRM ALL INFORMATION FROM SCREENER WITH RESPONDENT)

NAME: _____ DATE: _____

TELEPHONE #: _____

Is that a daytime or evening telephone number?

1. Daytime telephone number
2. Evening telephone number
3. Both daytime/evening number

ZIP: _____

INTERVIEWER STATEMENT

INTERVIEWER: THIS MUST BE COMPLETED BEFORE YOU CAN FINISH THE INTERVIEW.

I hereby certify that all of the above information was obtained by me from the respondent named above who is not personally known to me.

INTERVIEWER NAME: _____

WEB SEARCH SURVEY
INTERVIEWER INSTRUCTIONS

PROJECT OVERVIEW

This is a study of adults aged 18 and older who meet the survey screening criteria. In this survey, respondents are to be screened in the mall and then taken to your facility to complete the interview using a survey via computer.

QUALIFIED RESPONDENT

In order to qualify for this study, a respondent must not work for or have a household member that works for:

§ a market research company

§ an internet search company

§ a company that makes products for learning foreign languages, or

§ a store or company in the mall.

Qualified respondents must not have participated in a market research survey other than a political poll during the last three months. They must be interested in learning a foreign language and will, in the next 12 months, look for information about learning a foreign language on the internet. Additionally they must have heard of the Rosetta Stone company.

They must have used Google as a search engine in the past 12 months and would be wiling to use Google as a search engine in the next 12 months.

Respondents who wear contact lenses or glasses must have them with them and agree to wear them during the interview in order to qualify for the study.

SCREENER TERMINATION BOXES

All screeners have termination boxes to be used for tracking all respondent intercepts and terminations.

Once a screener has been used to screen an eligible respondent who completes the main interview, a new, clean, screening form should be obtained to continue respondent intercept and screening. If, in the process of screening, all numbers in a termination box have been circled before intercepting an eligible respondent, a new, clean screening form should be used to screen the next potential respondent.

QUOTA

Your facility's quota is 50. You should have approximately 25 males and 25 females. You will also need to track quotas by age group. Quotas for each age group are provided below.

Age Group	Number of Female Interviews	Number of Male Interviews
18 - 24	8	8
25 - 34	5	5
35 - 44	5	5
45 - 54	5	5
55 and over	2	2

INTERVIEWING SET UP

The private interviewing area is to contain a table, two chairs, a computer for the interviewer and the laptop computer provided by NERA for the respondent to use for the "web site" portion of the interview.

You, the **interviewer,** should be positioned to complete the survey questionnaire on the computer, so that the **respondent cannot see the questions** on your computer screen.

The laptop should be positioned so that you can access it and initiate the web site portion of the interview conveniently. The respondent must be seated in front of the laptop computer to complete the web site portion of the survey. The respondent should not touch or use the laptop other than when instructed by you for the web site portion of the interview.

LAPTOP COMPUTERS

Your facility will be receiving one laptop computer for respondents to use during the "web site" portion of the interview. The laptop should not be used by facility staff or respondents for any other purpose. When the laptop computer is not in use, it should be stored in a secure location. While interviewing is taking place, the laptop should:

§ be plugged into the wall using the provided power cord,

§ have the provided mouse attached.

You will need to initiate the web site for the respondent during the interview by clicking on one of two designated icons on the desktop. The icons are labeled with the numbers 1 and 2.

If, at any time during the interview, the program initiated by clicking on the icon does not work, call NERA.

MAIN QUESTIONNAIRE

The screening for qualified respondents should be done in the mall using the paper screeners. Screening should be done in pencil so that the answers of ineligible respondents can be erased.

Once a respondent has been qualified, and agrees to participate and comes back to your facility, you will begin the questionnaire using the computer version. The computer version will provide you with a respondent ID number. You will need to write the respondent ID on the first two pages of the paper screener.

As part of the computer version of the questionnaire, the screening questions asked in the mall will be re-asked. DO NOT just enter/copy the answers from the screener into the computer without re-asking the respondent the screener questions and waiting for them to provide their answers. Once the computer screening questions are completed and the respondent has qualified, the survey will continue automatically to the main questionnaire.

You will access the survey questionnaire as provided by Cunningham Research.

TEST INTERVIEWS AND INTERVIEWER TRAINING

Your facility will be provided with a test url to be used for training the interviewers. The test url will grant access to a practice questionnaire and allow you to become familiar and comfortable with the questionnaire prior to interviewing a qualified respondent. **Each interviewer who will be working on this project, either screening respondents or conducting interviews, must complete a test interview, prior to interviewing others.**

INTERCEPT PROCEDURES

> After positioning yourself at your assigned screening site, you should attempt to screen the first individual approaching your site who appears to be 18 years of age or older. If that individual does not qualify, does not meet any available age quota categories, or refuses to participate, you should approach the next individual, and the next, until you locate a qualified participant. Proceed from attempt (to screen/qualify) to attempt (to screen/qualify) utilizing the selection method described, approaching each prospective respondent, regardless of race, dress, appearance or any other consideration.

> It is important that you do not attempt to screen and/or interview more than one person from a collection or party of individuals.

> After qualifying a respondent, you are to take that individual to your facility to be interviewed in your interviewing area. The respondent will need to answer the screener questions again. If for any reason the respondent no longer qualifies once he/she has answered the screening questions in the facility, you should thank the person for his/her time and terminate the interview. No incentive should be given to unqualified individuals.

> Upon completion of the interview (including the collection of name and phone number and your confirmation), the respondent should be given the incentive payment.

> Once the respondent is finished gathering payment, you are to return to the mall and position yourself at your assigned screening site, and repeat the respondent selection process previously described.

OTHER REMINDERS

> Do not interview anyone you know.

> Terminate the attempt to interview if there is a language or hearing difficulty.

> Do not attempt to screen/qualify anyone who has, or might have, overheard the screening of a previous respondent.

> During the screening portion of the interview, if you approach a party of two or more, address your request to only one of the individuals and request that the other individual(s) not help or assist the participating individual with her answers. If this occurs, terminate the attempt to interview. Again, you are not to interview more than one person from such a party/collection of individuals.

> Do not stand or sit in a position where a respondent can read any of the words or screening questions.

> During the Questionnaire portion of the interview, the respondent should be alone, with the exception of a parent with a young child. It is essential that respondents waiting to be interviewed are not able to see or hear an interview being conducted.

QUESTIONNAIRE PROCEDURES

> It is important **that the questions are read verbatim,** exactly as written. Do not paraphrase a question or reword it. Do not add any words to the questions or attempt to explain the meaning of questions. Consistency between interviews is essential.

> It is also important that **the responses are accurately recorded**. Open-ended responses are to **be recorded verbatim**, exactly as the respondent says it. Do not paraphrase or edit. Any responses which appear to be inaccurately recorded will be reviewed and discussed with supervisors.

> Administer each questionnaire in a completely uniform manner, reading each question exactly as it is written and allow the respondent as much time as he/she needs to answer before proceeding to the next question. Do not change the wording of any question or rephrase a question, and ask only the questions included on the questionnaire. If a respondent indicates he/she does not understand a question or asks you to explain a question, simply repeat it exactly as worded. If necessary, repeat the question an additional two times. If the respondent still does not understand or asks that a question be explained, terminate the interview.

> Upon completing the interview, please provide the respondent with the incentive payment for participating. Have the respondent sign his/her name and date on the

respondent ID/signature form next to the ID used for the interview. The interviewer must also put his/her initials on the ID/signature form.

You are to take care in not misplacing any study materials. No survey materials are to be removed from your facility except to be used in recruiting respondents. All survey materials are confidential. No one, other than the interviewing staff and Supervisors, is to review any of the survey materials. All materials, used and unused, must be returned to NERA upon completion of the project.

NERA CONTACT INFORMATION – SAN FRANCISCO STUDY HEADQUARTERS LOCATION

NERA Economic Consulting
One Front Street
Suite 2600
San Francisco, CA 94111

There are two people that you can contact at NERA with questions about the study or to report any problems or concerns. Sarah Butler is the primary contact and you can also contact Arie Singer.

Primary Contact:
Sarah Butler –
Sarah.Butler@nera.com

Secondary Contacts:
Arie Singer –
Arie.Singer@nera.com

INTERVIEWER INSTRUCTIONS

SIGNATURE PAGE

Note: After reading and reviewing these instructions and procedures, along with the Screeners/Questionnaires, please print your name and then sign this set of instructions, acknowledging that you have read these materials.

_____
Name (Please Print)

_____
Signature

WEB SEARCH STUDY
SUPERVISOR INSTRUCTIONS

LIST OF MATERIALS

Screeners (80)
Supervisor Instructions (3)
Paper Copy Questionnaire (3)
Interviewer Instructions (10)
Laptop Computer (1)

Please read through the survey instructions and the paper copy questionnaire as soon as you receive this package. A conference call has been arranged to review all materials. Any questions you have regarding the survey or procedures can be addressed during this call.

If any materials are missing, or any instructions are unclear, please notify Sarah Butler or Arie Singer immediately. Contact information is at the end of this document.

PROJECT OVERVIEW

This is a study of adults aged 18 and older who meet the survey screening criteria. In this survey, respondents are to be screened in the mall and then taken to your facility to complete the interview using a survey via a computer.

QUALIFIED RESPONDENT

In order to qualify for this study, a respondent must not work for or have a household member that works for:

§ a market research company,

§ an internet search company,

§ a company that makes products for learning foreign languages, or

§ a store or company in the mall.

Qualified respondents must not have participated in a market research survey other than a political poll during the last three months. They must be interested in learning a foreign language and will, in the next 12 months, look for information about learning a foreign language on the internet. Additionally they must have heard of the Rosetta Stone company.

They must have used Google as a search engine in the past 12 months and would be wiling to use Google as a search engine in the next 12 months

Respondents who wear contact lenses or glasses must have them with them and agree to wear them during the interview in order to qualify for the study.

SCREENER TERMINATION BOXES

All screeners have termination boxes to be used for tracking all respondent intercepts and terminations.

Once a screener has been used to screen an eligible respondent who completes the main interview, a new, clean, screening form should be obtained to continue respondent intercept and screening. If, in the process of screening, all numbers in a termination box have been circled before intercepting an eligible respondent, a new, clean screening form should be used to screen the next potential respondent.

QUOTA

Your facility's quota is 50. You should have approximately 25 males and 25 females. You will also need to track quotas by age group. Quotas for each age group are provided below.

Age Group	Number of Female Interviews	Number of Male Interviews
18 – 24	8	8
25 – 34	5	5
35 – 44	5	5
45 – 54	5	5
55 and over	2	2

INTERVIEWING SCHEDULE/INTERVIEWING LOCATIONS

Interviewing is to commence as scheduled and is to be continued each day until your assigned quotas are completed. **Make sure that no more than 50% (25 interviews) of your facility's total quota is conducted EITHER during the week (Monday through Thursday) or on the weekend (Friday through Sunday).** Any interviews beyond this quota will not be accepted.

The private interviewing area is to contain a table, two chairs, a computer for the interviewer and the laptop computer provided by NERA for the respondent to use for the "web site" portion of the interview.

The **interviewer** should be positioned to complete the survey questionnaire on the computer so that the **respondent cannot see the questions** on the interviewer's computer screen.

The laptop should be positioned so that the interviewer can access it and initiate the web site portion of the interview conveniently. The respondent must be seated in front of the laptop computer to complete the web site portion of the survey. The respondent should not touch or use the laptop other than when instructed by the interviewer for the web site portion of the interview.

CREW ROTATION

No single interviewer should complete more than one-half (25) of your facility's total quota of interviews.

LAPTOP COMPUTERS

Your facility will be receiving one laptop computer for respondents to use during the "web site" portion of the interview. The laptop should not be used by your staff or respondents for any other purpose. When the laptop computer is not in use, it should be stored in a secure location. While interviewing is taking place, the laptop should:

§ be plugged into the wall using the provided power cord,

§ have the provided mouse attached.

Interviewers will need to initiate the web site for the respondent during the interview by clicking on one of two designated icons on the desktop. The icons are labeled with the numbers 1 and 2.

BE SURE TO TEST EACH ICON ON THE LAPTOP COMPUTER AS SOON AS YOU RECEIVE IT. If there are any problems with the icons or the programs initiated by clicking on them, notify Sarah Butler or Arie Singer immediately.

If, at any time during the interview, the program initiated by clicking on the icon does not work, call NERA.

MAIN QUESTIONNAIRE

The screening for qualified respondents should be done in the mall using the paper screeners. Screening should be done in pencil so that the answers of ineligible respondents can be erased.

Once a respondent has been qualified, and agrees to participate and comes back to your facility, the interviewer will begin the questionnaire using the computer version. The computer version will provide the interviewer with a respondent ID number. The interviewer will need to write the respondent ID on the first two pages of the paper screener.

As part of the computer version of the questionnaire, the screening questions asked in the mall will be re-asked. **DO NOT just enter/copy the answers from the screener into the computer without re-asking the respondent the screener questions and waiting for them to provide their answers.** Once the computer screening questions are completed and the respondent has qualified, the interviewer will continue automatically to the main questionnaire.

You will access the survey questionnaire as instructed by Cunningham Research.

TEST INTERVIEWS AND INTERVIEWER TRAINING

Your facility will be provided with a test url to be used for training the interviewers. The test url will grant access to a practice questionnaire and allow the interviewers to become familiar and comfortable with the questionnaire prior to interviewing a qualified respondent. **Each interviewer who will be working on this project, either screening respondents or conducting interviews, must complete a test interview online.**

INTERCEPT PROCEDURES

> After positioning yourself at your assigned screening site, you should attempt to screen the first individual approaching your site who appears to be 18 years of age or older. If that individual does not qualify, does not meet any available age quota categories, or refuses to participate, you should approach the next individual, and the next, until you locate a qualified participant. Proceed from attempt (to screen/qualify) to attempt (to screen/qualify) utilizing the selection method described, approaching each prospective respondent, regardless of race, dress, appearance or any other consideration.

> It is important that you do not attempt to screen and/or interview more than one person from a collection or party of individuals.

> After qualifying a respondent, you are to take that individual to your facility to be interviewed in your interviewing area. The respondent will need to answer the screener questions again. If for any reason the respondent no longer qualifies once he/she has answered the screening questions in the facility, you should thank the person for his/her time and terminate the interview. No incentive should be given to unqualified individuals.

> Upon completion of the interview (including the collection of name and phone number and interviewer confirmation), the respondent should be given the incentive payment.

> Once the respondent is finished gathering payment, you are to return to the mall and position yourself at your assigned screening site, and repeat the respondent selection process previously described.

OTHER REMINDERS

> Do not interview anyone you know.

> Terminate the attempt to interview if there is a language or hearing difficulty.

> Do not attempt to screen/qualify anyone who has, or might have, overheard the screening of a previous respondent.

> During the screening portion of the interview, if you approach a party of two or more, address your request to only one of the individuals and request that the other individual(s) not help or assist the participating individual with her answers. If this occurs, terminate the attempt to interview. Again, you are not to interview more than one person from such a party/collection of individuals.

> Do not stand or sit in a position where a respondent can read any of the words or screening questions.

> During the Questionnaire portion of the interview, the respondent should be alone, with the exception of a mother with a young child. It is essential that respondents waiting to be interviewed are not able to see or hear an interview being conducted.

QUESTIONNAIRE PROCEDURES

> It is important **that the questions are read verbatim,** exactly as written. Do not paraphrase a question or reword it. Do not add any words to the questions or attempt to explain the meaning of questions. Consistency between interviews is essential.

> It is also important that **the responses are accurately recorded**. Open-ended responses are to **be recorded verbatim**, exactly as the respondent says it. Do not paraphrase or edit. Any responses which appear to be inaccurately recorded will be reviewed and discussed with supervisors.

> Administer each questionnaire in a completely uniform manner, reading each question exactly as it is written and allow the respondent as much time as he/she needs to answer before proceeding to the next question. Do not change the wording of any question or rephrase a question, and ask only the questions included on the questionnaire. If a respondent indicates he/she does not understand a question or asks you to explain a question, simply repeat it exactly as worded. If necessary, repeat the question an additional two times. If the respondent still does not understand or asks that a question be explained, terminate the interview.

> Upon completing the interview, please provide the respondent with the incentive payment for participating. Have the respondent sign his/her name and date on the respondent ID/signature form next to the ID used for the interview. The interviewer must also put his/her initials on the ID/signature form.

You are to take care in not misplacing any study materials. No survey materials are to be removed from your facility except to be used in recruiting respondents. All survey materials are confidential. No one, other than the interviewing staff and Supervisors, is to review any of the survey materials. All materials, used and unused, must be returned to NERA upon completion of the project.

Final Shipment of All Survey Materials

When you are contacted by NERA to make your final shipment of remaining materials, you are to return all survey materials. UNUSED SCREENERS SHOULD BE RETURNED IN THIS FINAL SHIPMENT.

Shipping costs for the return of any materials not shipped in the final FedEx shipment, and/or charges for any materials that need to be returned to you for signature, etc., will be at your expense.

Ship final materials shipment to:

Sarah Butler
NERA Economic Consulting

One Front Street
Suite 2600
San Francisco, CA 94111
(415) 291-1022

Please use Federal Express for your daily shipments.

On the call you will be provided with a FedEx number to use for these shipments. You will be provided with a number for the internal billing reference.

NERA CONTACT INFORMATION – SAN FRANCISCO STUDY HEADQUARTERS LOCATION

NERA Economic Consulting
One Front Street
Suite 2600
San Francisco, CA 94111

There are two people that you can contact at NERA with questions about the study or to report any problems or concerns. Sarah Butler is the primary contact and you can also contact Arie Singer.

Primary Contact:
Sarah Butler –
Sarah.Butler@nera.com

Secondary Contact:
Arie Singer –
Arie.Singer@nera.com

SUPERVISOR INSTRUCTIONS

SIGNATURE PAGE

Note: After reading and reviewing these instructions and procedures, along with the Interviewer Instructions, and Screeners/Questionnaires, please print your name and then sign this set of instructions, acknowledging that you have read these materials.

_____
Name (Please Print)

_____
Signature