

# **TRADEMARK SURVEYS: TEN COMMON PITFALLS**

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## TRADEMARK SURVEYS: TEN COMMON PITFALLS

The issues in a trademark case are typically addressed by marketplace reaction, *i.e.*, what do consumers of the product or service at issue perceive? For example: is the mark distinctive and, if not inherently distinctive, has it acquired secondary meaning? If not distinctive, is it generic? Is there a likelihood of confusion? Etc.

Marketplace reaction is most efficiently addressed, in most cases, by one or more sample surveys of the relevant consumers. For this reason, surveys have become commonplace in trademark cases, and courts in recent years have frequently criticized the trademark litigant who comes to court without a survey.

While the issues that kept courts from admitting trademark surveys into evidence some years ago have been largely resolved, the weight given to survey evidence by judges and juries continues to vary widely. Survey experts are fond of saying an obvious truth--"There is no perfect survey." But how imperfect may a survey be and still be persuasive? Much depends on the skill of the expert and the cross-examining attorney, but it is instructive to learn from the mistakes of the past. By combing through expert reports submitted in litigation, and through questionnaires, instructions, responses to questionnaires, etc., and by reading the reported decisions, we can spot scores of pitfalls that have been experienced in designing, conducting and presenting surveys. In this paper we will focus on ten of the more common pitfalls.

### 1. Having the survey expert do one survey too many.

Perhaps the most common pitfall, and one that rarely comes to light, is giving in to the temptation to overuse the survey expert.

Few trademark cases involve only a single issue that is subject to survey evidence. For this reason, and since surveys and experts are so expensive, there is a strong temptation to use the survey expert for more than one issue. Suppose, for example, the plaintiff must prove both secondary meaning and likelihood of confusion to prevail at trial. Counsel for the plaintiff employs a survey expert and requests surveys on both issues, both at great cost to the plaintiff. The secondary meaning survey yields great results, but the results of the likelihood of confusion

survey are poor. If the plaintiff wants to use the secondary meaning survey the expert is almost certain to be asked whether other surveys were conducted, at which point the poor results of the confusion survey are discoverable. Given that risk, the expensive secondary meaning survey is usually discarded.

Only in exceptional circumstances should the survey expert be used for more than one survey. If circumstances are such that another survey from the expert is nevertheless prudent, the other survey should be undertaken with great care.

### 2. Addressing the wrong question in the survey.

Perhaps the most embarrassing thing that can happen to trademark counsel is learning that the expensive survey that has been done addressed the wrong question. Irrelevant surveys are of no value and should be excluded from evidence.

*Sears, Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161 (5<sup>th</sup> Cir. 1957): The Fifth Circuit affirmed the district court's exclusion of the plaintiff's study. Among other concerns about using survey evidence, the court noted regarding this survey that "it appears that it would be inadmissible on the ground of irrelevance, as not fairly presenting the name All States Life Insurance Company until after two questions had been asked which if correctly and properly answered called to mind Sears, Roebuck & Company." *Id.* at 172. Questions asked by the survey in question were:

- (1) What comes to your mind when I say the brand name "Westinghouse"?
- (2) What does the brand "Kodak" mean to you?
- (3) What does "Allstate" mean to you?
- (4) If you wanted Allstate insurance, where would you go?
- (5) Have you ever heard of All States Life Insurance Company?
- (6) Who would you say owns All States Life Insurance Company?

*Id.* at 171.

*National Football League Properties, Inc. v. Prostyle, Inc.*, 57 F. Supp. 2d 665 (E.D. Wis. 1999): The defendants were accused of selling unauthorized Green Bay Packers merchandise. As characterized by

the court, plaintiff's survey asked essentially one question: When respondents were shown several of defendants' products, they were asked, "What, if anything, do you think of when you see this shirt?" *Id.* at 668. The survey included no further probing, and no control. The court found it "utterly unremarkable that more than half of Wisconsinites polled shortly before the Packers' first Super Bowl appearance in nearly 30 years 'thought of' the Packers when shown green and gold shirts that said 'Green Bay Football' or 'Green Bay P.' . . . The court surmises that, in this state and at such a time of Packer-related frenzy, the questioners could have shown the survey respondents a green and gold Blarney stone (an example of a non-diluting use) and more than half of them would have thought of the Packers." *Id.* at 669. The survey was excluded.

***E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F. Supp. 457 (N.D. Cal. 1991):** The court did *not* strike defendant's survey because it consisted of a side-by-side comparison of the two parties' wine bottles. Numerous courts hold such side-by-side comparisons "to be legally irrelevant in determining whether defendant's use of a similar mark leads to a finding of a likelihood of confusion," the court wrote. *Id.* at 466. "The proper test for likelihood of confusion is not whether consumers would be confused in a side-by-side comparison of the products, but whether confusion is likely when a consumer, familiar with the one party's mark, is presented with the other party goods alone." *Id.* (quoting *Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L.*, 673 F. Supp. 1238, 1248 (S.D.N.Y. 1987)). On the other hand, for those who maintain that survey evidence should replicate actual marketing conditions as closely as possible, defendant's survey was relevant in gauging a likelihood of consumer confusion when confronted with the two wine bottles. *Id.* Nonetheless, in the end, the court granted summary judgment to plaintiffs on their trademark infringement claim.

Asking the wrong question in a survey probably results most often from insufficient attorney involvement. It is axiomatic that the attorneys in the case are the most knowledgeable about the issues to be addressed. So it is the attorneys that have to check the operative question(s) in the survey to be certain that the right issues are addressed. Some attorneys seem skittish about their involvement, probably stemming from some early authorities to the effect that attorney involvement could bias the survey and result in exclusion. Those authorities were wrongly interpreted in the first place, but in any event have now been completely superseded. This is not to say that once the questionnaire has been designed and the survey is

ready for the field the attorneys should get in the way of the process.

### 3. Sampling an under-inclusive population.

Ideally, the sample taken should represent all members of the relevant universe. This ideal is rarely achievable, but significant under-inclusion of members of the universe can raise serious problems about the credibility of the survey.

***Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 487-88 (5<sup>th</sup> Cir. 2004):** Infringement from yellow pages ad claimed by maker of Kirby vacuum cleaners. Survey universe was San Antonio residents who own a Kirby vacuum cleaner. This universe "severely limits the probative value of the survey's results. For a survey to be valid, 'the persons interviewed must adequately represent the opinions which are relevant to the litigation.' *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 264 (5<sup>th</sup> Cir. 1980). In an infringement action, 'the appropriate universe should include a fair sampling of those purchasers most likely to partake of the alleged infringer's goods or services.' *Id.* The universe in Scott Fetzer's survey consisted entirely of persons who purchased Kirby vacuum cleaners through Scott Fetzer. This group is uniquely familiar with Scott Fetzer's marketing and distribution techniques. Thus, the survey says nothing about the ad's effect on the class of potential consumers of new Kirby vacuum cleaners, a class that includes a large proportion of persons who have not yet purchased a Kirby."

***Pharmacia Corp. v. Alcon Labs., Inc.*, 201 F. Supp. 2d 335, 363 (D.N.J. 2002):** Infringement and dilution case involved medicines for treatment of glaucoma. Plaintiff's survey was flawed because it included only ophthalmologists, even though optometrists in 47 states also prescribe glaucoma medications. Furthermore, the survey expert took no steps to ensure that the sample drawn from his universe was representative of the marketplace of ophthalmologists, e.g., screening for respondents' years of experience or the size of their practices.

***Gillette Co. v. Norelco Consumer Prods. Co.*, 69 F. Supp. 2d 246, 261 (D. Mass. 1999):** Among other universe issues, a razor study that was limited to male shavers between the ages of 18 and 54 improperly excluded older and younger males, and all women. "[T]he uncontradicted evidence is that more than half of the electric razors that Norelco sells in the United States are sold as gifts and that women are often the purchasers of such gifts. Women too then are potential purchasers of the Reflect Action."

*Conopco, Inc. v. Cosmair, Inc.*, 49 F. Supp. 2d 242, 253 (S.D.N.Y. 1999): Infringement claim involving shape of perfume bottles. Survey universe including women age 18-45 was considered flawed because (1) it excluded all men and women over the age of 45, “who represent a substantial portion of the total universe of the products’ potential consumers”; (2) it included past purchasers who were not necessarily future potential purchasers; and (3) “it failed to properly discriminate between purchasers of ‘prestige fragrance’ brands as opposed to those who purchase just any fragrance.” The proper universe, the court concluded, would include men as well as women who are potential purchasers of prestige fragrance brands. “To be probative and meaningful, a survey must rely upon responses from all potential consumers of the product in question.”

*IDV North America, Inc. v. S&M Brands, Inc.*, 26 F. Supp. 2d 815, 830 (E.D. Va. 1998): Consumers leaving convenience stores were shown a package of defendant’s “Bailey’s” cigarettes and asked questions probing confusion with BAILEYS liqueur. Defendant faulted the survey methodology for failing to include consumers in the market for both products. The court concluded that the limited universe of survey participants did not render the plaintiff’s survey completely invalid. “However, the failure to include in the survey persons who are in the market for both products rather seriously undercuts the credibility of the survey because it excludes those most likely to be aware that BAILEYS liqueurs are not made by a tobacco manufacturer. By excluding persons in the market for both kinds of products (tobacco and liqueur cordials), the survey contained a built in bias. That alone leads the Court to conclude that the survey is of limited probative value in determining the likelihood of confusion issue.”

*Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1467-69 (D. Kan. 1996): This case involved an infringement claim between jacket makers. The court rejected two of the plaintiff’s surveys of consumers and professional buyers as fatally under-inclusive. One of the two surveys at issue, targeting consumers, was conducted solely in college bookstores, despite evidence that these stores compete with sporting goods stores for the same customer, and that there are nearly twice as many sporting goods stores as college bookstores in the United States. The court found that the survey expert’s “failure to survey consumers at sporting goods stores extinguishes the probative value of the survey in gauging the perceptions of consumers in this market. A survey should sample the full range of potential [consumers] for whom plaintiff and defendants

compete.” (citation omitted). Furthermore, the court faulted the buyer survey because it was conducted using a list of buyers with whom the plaintiff did business and none who purchased from the defendant or from neither party, among other flaws. “As a result, the survey pool was under-inclusive. Furthermore, this method of selection biases the professional buyer surveys in favor of [plaintiff] Winning Ways because it guarantees that every person surveyed has been exposed previously to the [plaintiff’s] trademark.” The survey also did not accurately portray the trade dress. “Combined, the flaws in the professional buyer surveys compel the conclusion that these surveys collected data on the wrong trade dress in an untrustworthy manner. The professional buyer survey evidence is, therefore, excluded for purposes of determining secondary meaning and defendants’ objection is sustained to that extent.”

*Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541 (S.D.N.Y. 1991): Declaratory judgment plaintiff, a rapper who performed under the stage name ESSENCE, sued the publisher of ESSENCE Magazine. Defendant conducted a survey of African-Americans aged 13-44, considered to be likely purchasers of rap music also familiar with ESSENCE Magazine. Interviews were conducted with 253 black men and 253 black women.

Discussing the validity of the universe at great length, the court concluded that it was improperly defined, and that the pool of interviewees did not adequately reflect the correctly defined universe of potential purchasers of the junior user’s product, i.e., rap music consumers. “The issue at bar is whether consumers of rap music will be confused as to the source of plaintiffs’ product. The proper universe thus is those people who listen to or buy rap music. It is not those people who read or know of ESSENCE Magazine. Defendant should have surveyed those people who buy or listen to rap music. The universe, as drawn by defendant, was not the correct universe.” *Id.* at 559-60. Furthermore, based on extensive evidence of “crossover” from the black to the white market, the court found that the total exclusion of whites from the survey failed to fully reflect the consumers of the plaintiffs’ product. Defendants introduced evidence that 77.2% of all those who buy rap music are white, while 20.5% of rap buyers are black. “To represent the universe of purchasers of rap music adequately, defendant’s survey should have included whites; arguably, close to 80% of all the people polled should have been white,” the court found. *Id.* at 562. The all-black survey reflected the buyers of the magazine, not rap music. “Given the extensive testimony about the powerful name recognition enjoyed by ESSENCE Magazine amongst

blacks, the exclusion of whites was likely to bias the results in favor of the magazine,” the court wrote. *Id.* at 564.

***King-Size, Inc. v. Frank’s King Size Clothes, Inc.*, 547 F. Supp. 1138, 1158 (S.D. Tex. 1982):** This trademark infringement suit involved manufacturers of men’s clothing. The court discounted the defendant’s survey in its entirety because its universe was under-inclusive. “Defendants’ universe which is composed of men who are 6’2” in height or over is far too narrow to give a fair indication of whether the consumers of wearing apparel for large size men do not associate the term ‘king size’ with plaintiffs. Aside from the fact that only approximately one-third of those men interviewed were consumers in the relevant market, the 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.” (internal citations omitted). The court also questioned the survey’s geography, finding that the sample of the Houston area included only men from the central and eastern parts of town, while excluding customers from the south and west. Plaintiff’s retail store was located in the southwestern area of Houston. “While the Court declines to fault the survey for not restricting the geographical area of the survey to a prescribed radius around plaintiffs’ store... the survey universe is nevertheless defective for failing to include the entire Houston area, or at the very least, to include the area around plaintiffs’ store,” the court wrote. *Id.*

***American Basketball Ass’n v. AMF Voit, Inc.*, 358 F. Supp. 981 (S.D.N.Y. 1973), *aff’d*, 487 F.2d 1393 (2d Cir. 1973):** Plaintiff sued a sports equipment manufacturer who made a red, white, and blue basketball. In a terse summary, the court gave the plaintiff’s pilot survey little weight. “This survey was further deficient in that: it was set up so that no logo showed on the red, white and blue basketball; ages of 12 and 23; and it was limited to those who had played basketball within the last year. No attempt was made to contact those who would actually purchase basketballs. For this reason alone, I find the ‘universe’ to be too narrow to allow the survey to be given any substantial weight.” *Id.* at 986.

#### 4. Sampling an over-inclusive population.

As we have seen above, an under-inclusive sample can destroy the credibility of a survey or limit its effectiveness. But so can a sample that includes persons who are not within the relevant population.

***Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 443-44 (S.D.N.Y. 2004):** The court found that plaintiff’s survey universe was over-inclusive and diminished its weight accordingly. The survey population was defined as females age 16 or older who were customers or potential customers of plaintiff and defendant purse makers. Potential Louis Vuitton customers had recently purchased a handbag costing more than \$350 or a purse or wallet costing more than \$100, or were likely to do so. Potential Dooney & Bourke customers shopped for handbags priced \$100-\$350 and purses or wallets costing \$50-\$100. The court found that “purse” and “handbag” were synonymous.

***Weight Watchers Int’l, Inc. v. Stouffer Corp.*, 744 F. Supp. 1259, 1272-73 (S.D.N.Y. 1990):** The court was critical of both parties’ surveys in this dispute between makers of frozen diet entrees. The plaintiff’s survey universe was defined as women between the ages of 18 and 55 who had purchased frozen food entrees in the past six months and who had tried to lose weight through diet and/or exercise in the past year. The court pointed out that these studies did not limit the universe to consumers who had purchased a *diet* frozen entree, or who had tried to lose weight through diet as opposed to exercise; “therefore, some of the respondents may not have been in the market for diet food of any kind, and the study universe therefore was too broad.” Furthermore, the court found that sloppy execution broadened the universe further when interviewers mistakenly included unqualified participants who did not qualify. “Flaws in a study’s universe quite seriously undermine the probative value of the study, because to be probative and meaningful . . . surveys . . . must rely upon responses by potential consumers of the products in question.” (citation and internal quotation marks omitted). “Respondents who are not potential consumers may well be less likely to be aware of and to make relevant distinctions when reading ads than those who are potential consumers. The ability to make relevant distinctions is crucial when what is being tested is likelihood of confusion.”

***Original Appalachian Artworks, Inc. v. Blue Box Factory (USA) Ltd.*, 577 F. Supp. 625, 632 (S.D.N.Y. 1983):** Maker of CABBAGE PATCH KIDS dolls sued maker of FLOWER KIDS dolls for copyright infringement and unfair competition. Survey universe targeted simply consumers at shopping malls who were planning on buying gifts for girls under age 12, rather than “prospective purchasers” of CABBAGE PATCH KIDS. The defendant’s expert “convincingly testified that parents contemplating the purchase of a relatively expensive, highly-promoted doll shop with care in the self-help toy shops where most sales now

occur. Knowing that the child will be bitterly disappointed by an imitation, the parent looks first for a label that clearly identifies the doll by name, and is unlikely to accept a substitute.” (internal citations omitted).

A frequent problem is failure to include prospective purchasers in the sample, sometime resulting in sampling a universe that is both under-inclusive and over-inclusive.

***Universal City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 118 (2d Cir. 1984):** The plaintiffs “utilized an improper universe in that it was conducted among individuals who had already purchased or leased Donkey Kong machines rather than those who were contemplating a purchase or lease.”

***J & J Snack Foods Corp. v. Earthgrains Co.*, 220 F. Supp. 2d 358, 372 (D.N.J. 2002):** Surveyed consumers instead of food distributors of frozen cookie dough product. “This universe renders the study unreliable as it ignores the fact that the ultimate consumer does not have any contact with the ‘BREAK & BAKE’ mark on [plaintiff] J & J’s product. In addition, it only concerns the views of ultimate consumers who purchase or may purchase refrigerated dough when J & J’s product is unquestionably frozen.”

##### 5. Sampling from the wrong geography.

In cases where the goods or services of the parties are not in nationwide distribution, trademark counsel may be presented with difficult issues on where to conduct the survey. In plaintiff’s territory? In defendant’s territory? In territory into which defendant may expand? Elsewhere? In some combination of the above? Unfortunately the courts are not always in agreement on these issues.

***Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 263-64 (5<sup>th</sup> Cir. 1980):** The maker of DOMINO’S sugar sued the maker of DOMINO’S PIZZA for trademark infringement. The district court ruled in favor of plaintiff Amstar, but the Fifth Circuit reversed, ruling that there was no likelihood of confusion. The appellate court found that the surveys conducted by both plaintiff and defendant were “substantially defective.” The plaintiff’s survey was conducted in ten cities among female heads of household primarily responsible for making food purchases. The court noted that “one of the most important factors in assessing the validity of an opinion poll is the adequacy of the ‘survey universe,’ that is, the persons interviewed must adequately represent the opinions which are relevant to the litigation. The

appropriate universe should include a fair sampling of those purchasers most likely to partake of the alleged infringer’s goods or services.” (citations omitted). *Id.* at 264. Of the ten cities in which the plaintiff’s survey was conducted, however, eight had no “Domino’s Pizza” outlets, and the outlets in the remaining two had been open for less than three months.

The court also criticized the study because interviewees were “women found at home during six daylight hours who identified themselves as the member of the household primarily responsible for grocery buying.” Because plaintiff’s sugar is sold primarily in grocery stores, participants in the survey would have been repeatedly exposed to plaintiff’s mark, but would have had little, if any, exposure to defendants’ mark, the court wrote. “Furthermore, the survey neglected completely defendants’ primary customers young, single, male college students.” *Id.* The defendant’s survey was conducted on the premises of “Domino’s Pizza” outlets, also an improper universe.

***Bank of Texas v. Commerce Southwest, Inc.*, 741 F.2d 785, 789 (5<sup>th</sup> Cir. 1984):** A survey that focused on the area immediately surrounding the plaintiff’s bank could not be used to establish secondary meaning in all of Dallas County. **Compare with:**

***Sears, Roebuck & Co. v. Allstate Driving School, Inc.*, 301 F. Supp. 4, 18-19 (E.D.N.Y. 1969):** In a case in which 80% of the defendant’s business comes from within the 8-10 mile radius of its school, a universe including all of Suffolk County, New York, arguably was too large. “[A] more accurate sampling of prospective purchasers would have confined itself to this geographic area.”

***Citizens Financial Group, Inc. v. Citizens Nat’l Bank of Evans City*, 2003 U.S. Dist. LEXIS 25977 (W.D. Pa. 2003):** The court pointed out that in a *reverse* confusion case, the correct survey universe is the senior user’s customer base. The court excluded the senior user’s survey evidence based on its failure to sample the appropriate geographic location.

***Exxon Corp. v. XOIL Energy Resources, Inc.*, 552 F. Supp. 1008, 1020 (S.D.N.Y. 1981):** District court accorded no weight to a survey that focused exclusively on 194 interviewees at commuter rail stations in the New York vicinity. The survey “was not conducted on a properly selected and representative sample of the population.” *Id.* at 1021. The court said it could not “seriously be contended that a survey predicated upon interviews with 194 persons chosen as

the interviewees here were chosen will support projection over a broad geographical base.” *Id.* Note that the survey was carried out by four associates from the law firm representing the plaintiff. *Id.* at 1020 n.16.

***General Motors Corp. v. Cadillac Marine & Boat Co.*, 226 F. Supp. 716, 737 (W.D. Mich. 1964):** Plaintiffs conducted a survey in which 150 people were shown advertisements for CADILLAC boats. The court found that the sample, taken in a single geographical area, was inadequate. Furthermore, the court wrote, the subjects were not likely purchasers. “The individuals among whom this poll was taken were not, in the vast majority of cases, ‘purchasers’ in any sense of the word. Indeed many indicated they had no interest in boats at all. Of necessity, it then follows that their inspection of the proffered advertisement was casual, cursory and careless.”

#### 6. Using the wrong method to gather the data

Many methods may be used to gather data, and sometimes counsel has the ability to choose from several methods. But in some cases only one method (or a limited number of methods) may be appropriate.

***1-800-Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467, 500 (S.D.N.Y. 2003):** *see also Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734 (E.D. Mich. 2003) (unsuccessful attempt to extrapolate from same survey): Although plaintiff’s survey supported the likelihood of initial interest confusion, it was not evidence of actual confusion. Plaintiff’s expert did not show respondents an example of the pop-up advertisement in question, or ask whether they had ever seen one. “To have substantial probative value, Plaintiff’s survey must examine the impression of a junior mark on a potential consumer,” the court wrote. The survey “failed to use any stimulus that would inform consumers as to the competing products or marks in question.”

***WE Media Inc. v. General Elec. Co.*, 218 F. Supp. 2d 463, 474 (S.D.N.Y. 2002), *aff’d*, *WE Media, Inc. v. Cablevision Sys. Corp.*, 94 Fed. Appx. 29, 2004 U.S. App. LEXIS 7379 (2d Cir. Apr. 13, 2004):** We Media Inc. (“WEM”), a provider of products and services using marks including WE and WE MEDIA for individuals with disabilities, sued for trademark infringement and dilution by use of the name “WE: Women’s Entertainment” (“WWE”) for a cable television channel. The plaintiffs submitted a national survey conducted by Dr. Robert Sorenson in which more than one-third of respondents believed WEM and WWE were sponsored by or affiliated with one

another. *Id.* at 474. The court, which granted summary judgment for defendants, concluded regarding this survey: “Due to flaws in its methodology, the Sorensen Report does not provide support for WEM’s case. Germaine survey evidence should make some effort to compare the impressions the marks have on potential customers under marketplace conditions. By contrast, Sorensen did not use pictures or advertisements that approximate what a potential customer would encounter in making her television-viewing choices. Thus, by presenting respondents with word lists, Sorensen essentially measured respondents’ word associations devoid of context. Accordingly, the information within Sorensen’s Report does not go to the issue at bar.” (internal citation omitted).

***Cumberland Packing Corp. v. Monsanto Co.*, 140 F. Supp. 2d 241 (E.D.N.Y. 2001):** Plaintiff, maker of NatraTaste brand sweetener, claimed trade dress infringement by the maker of NutraSweet sweetener. Both use aspartame and are sold in a blue box that also features one or more coffee cups and saucers. Plaintiff revised its survey after significant criticism by the court when it denied plaintiff’s motion for summary judgment in 1999, but the defendant nonetheless won its motion for summary judgment in 2001.

One of the court’s complaints about the revised survey was that it retained a “two-room array” in which each respondent first entered a room where they viewed a box of plaintiff’s NatraTaste, then entered a second room to view five additional boxes: defendant’s NutraSweet box as sold in stores, or a variation thereof, plus four controls. The court was puzzled by the continued use of the two-room array after the recommendation against it, and “remains unconvinced that a survey using this protocol can determine actual market confusion.” *Id.* at 248. While the expert defended the arrangement, “the court believes that the one-room array more accurately simulates the market conditions of these products and is a more appropriate gauge of whether there is a likelihood of confusion in the marketplace.” *Id.*

***Coherent, Inc. v. Coherent Techs., Inc.*, 736 F. Supp. 1055 (D. Colo. 1990), *aff’d*, 935 F. 2d 1122 (10<sup>th</sup> Cir. 1991):** Plaintiff’s telephone survey did not permit interviewees to compare Plaintiff’s graphic depiction of its mark and trade name and Defendant’s trade name. *Id.* at 1060. The court concluded that “the survey failed to describe Defendant as it is described in its advertising, namely, by its trade name, address and phone number. Had it done so, the survey would have simulated conditions in the marketplace more

accurately, and the level of confusion – if it existed at all – would have been lower. Therefore, I conclude that the survey does not establish actual confusion.” *Id.* at 1067.

### 7. Manipulating the mark

Counsel must resist the temptation to bias the results by manipulating the mark at issue, even if strictly for convenience’s sake.

***Hawley Products Co. v. U.S. Trunk Co.*, 259 F.2d 69, 77-78 (1<sup>st</sup> Cir. 1958):** The First Circuit affirmed the district court’s judgment for the defendant on an unfair competition claim one luggage manufacturer brought against another. The survey used photographs, rather than luggage samples, shown to retail luggage dealers, rather than ultimate luggage purchasers. The photos failed, either in whole or in part, to show manufacturer’s name tags “which prominently appeared in several places on the bags themselves.”

“The District Court found: ‘These distortions are fatal to the proffer of the evidence on the issue of confusion of retail dealers. For the fact that a retail dealer does not recognize an unlabeled bag is no indication that he would not recognize a labeled bag.’ Then the court continued: ‘Furthermore, another and most significant reason why the evidence of the poll is inadmissible on the issue of confusion is that under the substantive law the issue is not whether the goods would be confused by a casual observer (trained or untrained, professional or lay.) but the issue is whether the goods would be confused by a prospective purchaser at the time he considered making the purchase. 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 his 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.’”

***Sears, Roebuck & Co. v. Menard, Inc.*, 72 U.S.P.Q.2d 1221 (N.D. Ill. 2003):** The court granted defendant’s motion in limine to exclude plaintiff’s survey, which exposed respondents to 8-9 second excerpts of defendant’s 30-second TV commercials and 10-second radio ads, among other problems. The court found that the survey “improperly distorted marketplace conditions by lifting portions of the commercials out of context.” *Id.* at \*11.

***Trouble v. Wet Seal, Inc.*, 179 F. Supp. 2d 291, 308 & n.12 (S.D.N.Y. 2001):** A fashion designer using the mark AGNES b. sued Wet Seal, which

marketed a line of clothing under the ARDEN B. mark. Before trial on the trademark infringement claim, the court granted the plaintiff’s motion to exclude defendant Wet Seal’s surveys. In the first survey, women were interviewed in malls that contained an ARDEN B. store and screened by being asked whether they were familiar with ARDEN B. clothing. In the second survey, women were interviewed in markets that contained an ARDEN B. store and screened by being shown a card with the AGNES b. mark and asked whether they were familiar with that line of clothing. *Id.* at 308 n.10. “In addition to testing a proper universe, to have substantial probative value, a survey must be designed to examine an accused mark’s impression on a potential consumer. Although no survey can construct a perfect replica of ‘real world’ buying patterns, a survey must use a stimulus that, at a minimum, tests for confusion by roughly simulating marketplace conditions. Typically, trademark infringement surveys use stimuli, such as pictures, advertisements or clothing, that directly expose potential consumers to the products or the marks in question. The stimuli in Wet Seal’s survey were weak at best. They were comprised of the nearby ‘Arden B.’ store-fronts and the use of cards with ‘Agnes b.’ printed on them. Regardless of the value of the survey’s stimuli, Wet Seal’s survey never actually used the stimuli to test for confusion. Rather, they were used to screen the interviewees to determine if they were familiar with a line of clothing. Given the lack of a proper universe and sample, the poor choice of location, the lack of proper stimuli, and questions that have little or no relevance to issues in the case, the Court finds that the prejudicial effect of Wet Seal’s survey substantially outweighs its probative value. Accordingly, the survey results and any opinion evidence based on them are inadmissible.” (internal citations and footnote omitted).

***Conopco, Inc. v. Cosmair, Inc.*, 49 F. Supp. 2d 242, 254 (S.D.N.Y. 1999):** In an infringement claim involving the shape of a perfume bottle, the bottle shown to survey participants was not the one sold to consumers but a preliminary version. “Since the bottle shown to the participants was not the one they would encounter in the marketplace, the probative value of the survey must suffer accordingly.”

***Novo Nordisk of North America, Inc. v. Eli Lilly & Co.*, 1996 U.S. Dist. LEXIS 12807, \*27-28 (S.D.N.Y. Aug. 30, 1996), *aff’d*, *Novo Nordisk A/S, Inc. v. Eli Lilly & Co.*, 185 F.3d 884 (Fed. Cir. 1999):** Surveys failed to replicate actual marketing conditions in which diabetics purchase insulin.

*Original Appalachian Artworks, Inc. v. Blue Box Factory (USA) Ltd.*, 577 F. Supp. 625 (S.D.N.Y. 1983): (See also Section 4, *supra*.) In an infringement case pitting CABBAGE PATCH KID dolls against FLOWER KID dolls, a survey was conducted in which shoppers were interviewed in a room in which an unpackaged Flower Kid doll was placed on a table. Sixty-four percent of the interviewees who expressed an opinion on the name of the doll stated some variant of Cabbage Patch Kid. *Id.* at 630. Among other distinctions, the court contrasted the boxes in which the two types of dolls actually were sold, noting in part that defendant Blue Box “sells the Flower Kids simply as dolls, without the special accoutrements of adoption papers, birth certificates, and promises of birthday cards which have become so prominent a part of the Cabbage Patch Kids’ appeal.” *Id.* at 631-32.

#### 8. Asking leading questions

Trademark lawyers know better than to ask leading questions of their own witnesses at trial. So why do we ask them of respondents in a survey?

*Johnson & Johnson \* Merck Consumer Pharms. Co. v. Smithkline Beecham Corp.*, 960 F.2d 294, 299-300 (2d Cir. 1992): In this case, the makers of MYLANTA claimed that advertising for TUMS falsely represented that the magnesium and aluminum contained in MYLANTA are unsafe for human consumption. To succeed on its claims of implied falsehood, the plaintiff was required to show that the ads were likely to mislead or confuse consumers. The Second Circuit affirmed the court’s verdict for the defendant. The following questions from plaintiff’s consumer survey were found to be leading:

14a - What, if anything, does the commercial communicate to you about the aluminum and magnesium in Maalox and Mylanta?

14b - What else, if anything, does the commercial communicate to you about the aluminum and magnesium in Maalox and Mylanta?

14c - Based on the commercial you just saw, how do you feel about taking a product for heartburn that contains aluminum and magnesium?

*Sears, Roebuck & Co. v. Menard, Inc.*, 2003 U.S. Dist. LEXIS 951, 72 U.S.P.Q.2d 1221 (D. Ill. 2003): (See also Section 7, *supra*.) Plaintiff’s survey was excluded due to several flaws, including a “highly leading” question. The phrase at issue in the case was WHERE ELSE, and survey respondents were shown excerpts of the parties’ radio and TV ads. One of the

survey questions was: “Does it appear to you that one company borrowed the slogan ‘where else’ from the other?” *Id.* at \*8. Defendants contended that the question was inappropriate because it pointed out to respondents the fact that the phrase WHERE ELSE? appeared in both commercials. The court agreed that the question “suggested the similarity to respondents rather than testing whether respondents perceived it themselves. The question thus created an improper ‘demand effect.’” *Id.* (quoting *Simon Property Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1048 (S.D. Ind. 2000) (“‘demand effects’ bias a survey ‘by suggesting to respondents, at least implicitly, that they should believe there is at least some sort of relationship between the different items when the possibility might not even have occurred to the vast majority of consumers who see the items’”)).

*Sports Authority, Inc. v. Abercrombie & Fitch, Inc.*, 965 F. Supp. 925, 933 (E.D. Mich. 1997): A question was leading when it presented a side-by-side comparison of defendant’s clothing label and plaintiff’s newspaper advertisements, two items not typically analyzed side-by-side.

*Coors Brewing Co. v. Anheuser-Busch Cos.*, 802 F. Supp. 965 (S.D.N.Y. 1992): This unfair competition suit involved advertisements promoting the defendant’s Natural Light beer over Coors Light. Plaintiff Coors needed to show that the ads misled consumers into believing that the beers were brewed differently. The court determined that the following question was leading and therefore produced unreliable results: “Based on this commercial, do you believe that Coors Light and Natural Light are made the same way, or are they made differently?” *Id.* at 971. The court explained: “By asking whether, ‘[b]ased on the commercial,’ the respondent believes Coors Light and Natural Light are made the same way or different ways, Question 5 assumes that the commercial conveys some message comparing how the two beers are made.” *Id.* at 972. The court also found the question leading “in that it asks whether an obviously comparative advertisement, which disparages one product and promotes another, suggests or does not suggest a difference in the way the two products are made. This inquiry in itself implies, because the advertisement invidiously compares one product with another, that the advertisement does suggest a difference in the way the two products are made.” *Id.* Finally, the question failed to offer respondents the option of answering that they did not know if the commercial implied that the two beers were made by different processes. The court concluded that the plaintiff failed to substantiate its claims of implied falsehood with reliable extrinsic evidence.

### 9. Failing to use a proper control cell

Survey professionals have long known that in certain cases survey results can be misleading if interpreted literally. Results to be meaningful must be interpreted in light of causation. This is most conveniently accomplished using control questions or, usually, by use of a control cell.

***Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 912 (7<sup>th</sup> Cir. 1996):** This case included a trademark claim pitting two car waxes against each other: NU FINISH, made by plaintiff Reed-Union, and FINISH 2001, made by Turtle Wax. While each side's survey expert included a control cell, the Seventh Circuit affirmed the importance of selecting the correct control:

"To estimate the 'normal' rates of confusion, each expert used a different pair of products. Reed-Union's expert used ARMOR ALL car wax as the control product and found little natural confusion. Turtle Wax's expert selected PRISM wax as the control and found confusion exceeding 20 percent, implying that the name and packaging of FINISH 2001 could not be faulted. The district judge preferred the latter study, because ARMOR ALL bore the name of the manufacturer prominently on the front of the bottle, while both NU FINISH and FINISH 2001 carry the manufacturer's name inconspicuously on the back, as does PRISM. ARMOR ALL is a well known brand name, which reduces confusion. In other words, the court concluded that Reed-Union's expert introduced a bias into the study, producing an artificially low estimate of the normal degree of confusion affecting the purchase of products of this kind. Reed-Union argues that the district judge should have preferred its study, whose author, Reed-Union believes, had better credentials. But the reasons the judge gave are sound – the question is what the author did in this litigation, not where he got his degree or where he teaches – and it is impossible to describe his conclusion as a clear error."

***ConAgra, Inc. v. Geo. A. Hormel & Co.*, 784 F. Supp. 700 (D. Neb. 1992), *aff'd*, 990 F.2d 368 (8<sup>th</sup> Cir. 1993):** In a case involving the marks HEALTHY CHOICE and HEALTH SELECTIONS for shelf-stable microwaveable foods, the district court discounted one of plaintiff's surveys based on its failure to use a control cell. A second survey by the plaintiff added the control LIGHT BALANCE. *Id.* at 729. The defendant criticized this control as inadequate because it did not use either the words HEALTH/Y or the color green, used on both parties' products; rather, the defendant would have selected HEALTHY RECIPES. *Id.* at 730. The court agreed, stating that the latter product would have been a far better control. *Id.* at 731. "This of

course does not mean the [plaintiff's second] study is irrelevant, it only means that the control was not effective to screen for the color green and the word 'healthy' or 'health,' understanding that ConAgra has no proprietary rights to the color green or the word 'healthy' or its derivatives," the court wrote. *Id.*

***S. S. Kresge Co. v. United Factory Outlet, Inc.*, 598 F.2d 694, 697-98 (1<sup>st</sup> Cir. 1979):** This case involves use of a control cell by a declaratory judgment plaintiff which was helpful in seeking to refute allegation of likelihood of confusion. A declaratory judgment action was brought by K MART, which planned to open two stores in Worcester, Mass., after the owner of two nearby "The Mart" department stores threatened legal action. "In the instant case, the two marks are neither identical nor visually similar. United contends, however, that Kresge's own survey data showed that 7.2% of consumers surveyed in the area believed 'The Mart' and 'K mart' to be 'really owned by the same people.'" This, however, ignores the fact that 5.7% of the same people reached the same conclusion as to 'The Mart' and King's Department Store, which are clearly unrelated. This led the expert who conducted the poll to conclude that 'similar sounding names do not add to the confusion that is generally present for all stores.' We see no reason, therefore, to require the lower court to order appellee to further distinguish its trade name from that of appellants."

***Cumberland Packing Corp. v. Monsanto Co.*, 140 F. Supp. 2d 241 (E.D.N.Y. 2001):** (Case is described in Section 6, *supra*.) Among other problems, the court highlighted the design of the controls, all of which used blue as the primary color and displayed the NutraSweet name. *Id.* at 247. "In this they are not materially different from the original NutraSweet box in any legally relevant way," the court wrote. *Id.* at 248. The court explained that the controls "did not control for anything in a way that can assist in determining what actually caused confusion among the respondents." *Id.* "Appropriate controls would effectively eliminate the name as a factor causing confusion. Here the name cannot be eliminated as a factor causing confusion because the name was never eliminated from the allegedly infringing box. It would have been instructive to see how participants would have responded to a variation of the NutraSweet box that replaced the well-known brand name. Since this was not done we simply do not know. Likewise as to the survey's use of the color blue." *Id.* at 249. The court also found that the control boxes "look unauthentic and contrived." *Id.*

*Nabisco v. Warner-Lambert Co.*, 32 F. Supp. 2d 690, 700 (S.D.N.Y. 1999), *aff'd*, 220 F.3d 43 (2d Cir. 2000): The court held that plaintiffs' control product, Trident, was improper in a survey measuring confusion between "Ice Breakers" and "Dentyne Ice" because the control "fails to capture the essence of the allegedly confusing quality at issue, namely the 'Ice' term or some variation of that theme."

*National Football League Properties, Inc. v. Prostyle, Inc.*, 57 F. Supp. 2d 665 (E.D. Wisc. 1998): In a strongly worded opinion, the court granted defendant's motion in limine to exclude the plaintiff's survey evidence, partly because it failed to include a control group or question.

#### 10. Inappropriate use of the probability sample

True probability samples are ideal, but rarely truly achievable and in many situations, impossible. The old notion that the only admissible and credible surveys used probability samples (or something very close) went out the window in the mid 1970's with the advent of Rule 703, Fed. R. Evid.

According to a 1985 industry study by the Council of American Survey Research Organizations, the U.S. trade association for commercial survey research firms, the vast majority of commercial marketing and advertising research is conducted by telephone, allowing probability designs. See Jacoby & Handlin, *Non-Probability Sampling Designs for Litigation Surveys*, 81 Trademark Rep. 169, 172-73 (1991). However, when the interviews must be done "in person" because a tangible item needs to be shown to the respondent – as is most often true in trademark cases – 97% of surveys are conducted using a central location test site such as a shopping mall, school, social club, or church. *Id.* at 173. "By definition, such sites do not provide for the application of probability designs." *Id.* Thus, for in-person interviewing, "commercial advertising-marketing-consumer research overwhelmingly (in more than 97 percent of the cases) relies on non-probability designs." *Id.*

Now that nonprobability samples are readily accepted by the courts, it is better to use a nonprobability sample than to attempt a probability sample that falls short. Likewise, for those cases where it is important for the respondent to view the mark, the probability sample should not be a false god.

*E. & J. Gallo Winery v. Gallo Cattle Co.*, 12 U.S.P.Q.2d 1657, 1989 U.S. Dist. LEXIS 7950, \*66 (E.D. Cal. 1989), *aff'd*, 955 F.2d 1327 (9<sup>th</sup> Cir. 1992), *amended*, 967 F.2d 1280 (9<sup>th</sup> Cir. 1992): The court

noted that although the mall-intercept survey "does not have a statistical probability, it is a popular method for use in the marketing industry."

*National Football League Properties, Inc. v. New Jersey Giants, Inc.*, 637 F. Supp. 507, 518 (D.N.J. 1986): "[A] non-probability survey, such as the survey in this case, is sufficiently reliable to be admitted into evidence and accorded substantial weight . . . and non-probability survey evidence has been accepted by courts in many trademark and unfair competition cases." (citations omitted).

#### Conclusion

Almost every decision made in the survey process can be second-guessed. After a survey has been completed and the report and related documents are examined, many questions will come to the cross-examining attorney. Some of these will be (or at least will be perceived to be) nitpicking points. Others will be more serious questions and might detect major flaws in the survey that will reduce or destroy the credibility of the survey.

The ten pitfalls discussed above are not nearly exhaustive, but the chances of introducing a survey that will have credibility with the trier of fact will be greatly enhanced if at least these pitfalls are avoided.