

Trademark Surveys: An Undulating Path

Shari Seidman Diamond* & David J. Franklyn**

Introduction

When a plaintiff alleges trademark infringement or claims that false advertising is likely to confuse or deceive, the pivotal legal question is: how are consumers likely to perceive the mark or advertising?¹ In the early days of trademark litigation, a parade of consumer witnesses, carefully selected by one of the parties to support a trademark claim, would testify about their reactions to a mark.² That approach has given way to systematic survey evidence reflecting the responses of a substantial number of consumers selected according to an explicit sampling plan, asked the same questions, and unaware who sponsored the survey.³

A consumer survey that measures consumer confusion is an effective way to ensure that trademark infringement cases are decided based on empirical facts about likely consumer confusion instead of on judicial assumptions about how consumers are likely to respond. Assume, for example, that McDonald's Corporation sues a third party that expresses a plan to start a chain of motels called "McSleep Inns."⁴ The attempt to free ride on the good will of the "Mc" family of marks may be obvious, but are consumers really likely to think that the motel chain is associated with McDonald's? The answer may be yes; but it may be no, depending on the facts and circumstances of the planned third-party use. A well-crafted

* Howard J. Trienens Professor of Law and Professor of Psychology, Northwestern University; Research Professor, American Bar Foundation. We thank Barton Beebe, Jeremy Sheff, and Jerre B. Swann for helpful comments on the manuscript.

** Professor, Director of the LL.M. program in IP and Technology Law, and Director of the McCarthy Institute for IP and Technology Law, University of San Francisco School of Law.

1. 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:158 (4th ed. 2014) ("To an extent not true in other fields of law, in trademark and false advertising disputes the perceptions of large groups of ordinary people are key factual issues.").

2. *See Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970) (holding that eight consumer witnesses were not enough to establish secondary meaning); *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 760 (D. Conn. 1935) ("[I]ndividual members of the purchasing public are frequently called as witnesses and questioned as to their mental reactions [B]ut in view of the fact that modern advertising reaches millions, the chancellor, though he hear a hundred witnesses, can never know whether he has been shown a fairly representative picture.").

3. Shari Seidman Diamond, *Reference Guide on Survey Research*, in REFERENCE MANUAL ON SCIENTIFIC EVIDENCE 359, 372 (3d ed. 2011).

4. This hypothetical is based on an actual case. *See generally* *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198 (D. Md. 1988) (discussing the use of survey evidence to assess consumer confusion in a trademark dispute over a chain of motels called "McSleep Inns").

survey can help answer this question in a way that grounds trademark law in fact, rather than conjecture.

Some courts have described surveys as the most direct form of evidence that can be offered on the consumer perception questions at issue in trademark and deceptive advertising litigation,⁵ but several scholars have questioned the role that surveys actually play in trademark cases.⁶ These authors have based their conclusions on reviews of published court decisions in cases of alleged trademark infringement.⁷ Here, we take a larger view, examining not only varieties of trademark litigation beyond infringement (e.g., false advertising and dilution), but also investigating (via a survey!) how attorneys in the United States and internationally use surveys in trademark litigation. We also identify reasons why many reported cases do not contain survey evidence even when a survey would be valuable in supporting or refuting a claim.

The attorney survey we conducted for this Article enables us to examine how trademark surveys are used not only in cases that find their way to courtroom dispositions, but also in cases that are disposed of in the earlier nonpublic stages of litigation and thus do not result in a published court opinion. The International Trademark Association permitted us to invite its members to participate in a survey to assess when, if ever, and under what circumstances attorneys commission trademark surveys and what role the surveys play in the course of litigation.⁸ Our results indicate that trademark surveys often play multiple important roles in the life of a trademark case. Moreover, these attorney responses reveal the considerations that come into play in the decision to commission a survey. A closer look at the apparent inconsistency between our results and those of

5. *See, e.g.*, *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 1204 (Fed. Cir. 1994) (quoting *Co-Rect Prods., Inc. v. Marvy! Adver. Photography, Inc.*, 780 F.2d 1324, 1333 n.9 (8th Cir. 1985)) (“Consumer surveys are recognized by several circuits as the most direct and persuasive evidence of secondary meaning.”); *Malaco Leaf, A.B. v. Promotion in Motion, Inc.*, 287 F. Supp. 2d 355, 379 (S.D.N.Y. 2003) (“When an advertisement is not literally false, but rather is ambiguous or implicitly false, a plaintiff can only establish a claim of false advertising through a survey.”); *see also* *Schering Corp. v. Pfizer, Inc.*, 189 F.3d 218, 225 (2d Cir. 1999) (“Surveys are, for example, routinely admitted in trademark and false advertising cases to show actual confusion, genericness of a name or secondary meaning.”); *Kate Spade LLC v. Saturdays Surf LLC*, 950 F. Supp. 2d 639, 647 (S.D.N.Y. 2013) (noting that on the issue of consumer confusion “it has become routine in Lanham Act cases to submit such surveys”).

6. *E.g.*, Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1641 (2006); Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1017 (2012).

7. *E.g.*, Beebe, *supra* note 6, at 1641; Bird & Steckel, *supra* note 6, at 1029.

8. The International Trademark Association (INTA) is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property. *About INTA*, INT’L TRADEMARK ASS’N, <http://www.inta.org/About/Pages/Overview.aspx>. We are very grateful to Lisa Butkiewicz, Managing Editor at INTA, for arranging to send an email to INTA members inviting them to participate.

earlier research allows us to assess how pervasive and persuasive surveys are in trademark litigation and to evaluate how pervasive and persuasive they ought to be.

Part I provides a description of the primary legal topics that appear in trademark and deceptive advertising surveys. Part II reviews the recent studies that investigate the presence and influence of surveys in reported infringement decisions, identifying some of the limitations of these studies as a way to describe the role that surveys play in trademark litigation. Part III takes a close look at a sample of the reported cases that did not include survey evidence to begin our assessment of why surveys are or are not submitted in trademark cases. Part IV describes our survey, including a description of our methodology (the full survey instrument appears in an Appendix), questions, and results. Part V offers an explanation of why surveys may be underrepresented in reported cases, and when surveys succeed and fail as persuasive evidence. We analyze the limitations of survey methodology in current trademark litigation identified by our respondents, as well as judicial reactions to surveys that provide clues to the ambivalence of some judges to the surveys presented in court.

I. Trademark Law and Survey Overview

To provide a framework for the results of our empirical research, we begin with a description of trademark law. We describe the primary legal issues that surveys may be used to address in the course of litigation on trademarks and deceptive advertising.

A trademark is a “word, phrase, symbol or design, or a combination . . . [thereof] that identifies and distinguishes the source of the goods of one party from those of others.”⁹ Trademarks were traditionally limited to conventional word marks or image marks,¹⁰ but trademark application has been expanded to include colors,¹¹ sounds,¹² and even smells.¹³ The mark, coupled with its associated goodwill, constitutes a valuable form of intellectual property that may be listed as an asset, licensed, assigned, sold, and taxed.¹⁴

9. *Trademark, Copyright or Patent?*, U.S. PAT. & TRADEMARK OFF., http://www.uspto.gov/trademarks/basics/trade_defin.jsp; see also 15 U.S.C. § 1127 (2012) (stating a similar definition, but using the word “device” rather than the USPTO’s use of the word “design”).

10. See, e.g., Kenneth L. Port, *On Nontraditional Trademarks*, 38 N. KY. L. REV. 1, 17 (2011) (discussing the historical development of trademark law and noting that trademarks had “almost exclusively meant design marks” and did not include nontraditional trademarks such as colors).

11. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171–73 (1995).

12. 1 MCCARTHY, *supra* note 1, § 7:104.

13. *Id.* § 7:106.

14. *Id.* § 2:21.

It is useful to think of a trademark as requiring three elements, constituting what Barton Beebe has called “the triadic structure of the trademark”¹⁵: (1) the perceptible symbol; (2) the type of use: “the trademark must be used . . . [by the source] to refer to goods or services”; and (3) the function: the trademark must “‘identify and distinguish [the manufacturer’s] or seller’s goods from goods made or sold by others.’”¹⁶ If consumers do not see the connection between the mark and the source of the products or services, the third prong of this relational system is not met. Two central tasks for trademark surveys are to test whether consumers connect a mark with goods or services from a particular source and to test the extent to which that connection is distinctive.¹⁷

A. *Trademark Questions and Survey Evidence*

1. *Generic Marks.*—Unless a mark is viewed as distinctively signaling a particular source of goods or services, it cannot be protected as a trademark.¹⁸ Thus, a mark that identifies a category of product or service rather than a particular brand or source is not eligible as a trademark.¹⁹ These marks are characterized as generic. When a symbol refers to a product category, competitors may be disadvantaged if they cannot use the term to refer to their own goods or services, and consumers may be deprived of a useful way to reduce search costs. To avoid interfering with the efficient market operation, such a generic mark is not entitled to trademark protection.²⁰

It can be a major point of contention as to whether a mark is viewed as a brand name or the name of a product category (i.e., generic), particularly when some consumers use the name of a prominent brand to refer to the product or service. Not surprisingly, trademark owners engage in vigorous efforts to distinguish their brand name (e.g., KLEENEX) from the product category (facial tissues), but they are not always successful.²¹ If consumer use changes, a mark that began its life as a brand name may become generic

15. Barton Beebe, *The Semiotic Account of Trademark Doctrine and Trademark Culture*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 42, 45 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008).

16. *Id.* at 45–46.

17. *See infra* subpart I(B).

18. *See generally* Jerre B. Swann, *Genericism Rationalized*, 89 *TRADEMARK REP.* 639 (1999), for a discussion of genericism and trademark infringement.

19. 2 *MCCARTHY*, *supra* note 1, § 12:1 (“A mark answers the buyer’s questions ‘Who are you? Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’”).

20. *Id.* (“In short, a generic name of a product can never function as a trademark to indicate origin.”).

21. *See, e.g.,* *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 289 (S.D.N.Y. 2000) (holding that “pilates” is generic for a form of exercise).

over time (e.g., cellophane²² and aspirin²³). Surveys aimed at assessing consumer understanding and use of marks have provided relevant evidence in determining whether a mark is generic since surveys were introduced in a 1962 case to assess whether the mark THERMOS was generic.²⁴

2. *Secondary Meaning.*—The traditional “spectrum of distinctiveness” differentiates between marks that are deemed “inherently distinctive” and marks that are merely descriptive.²⁵ Inherently distinctive marks are “suggestive,” “arbitrary,” or “fanciful” in nature and generate trademark protection automatically upon their use.²⁶ Fanciful marks are generally made up words created for the sole purpose of trademark or brand identification.²⁷ Arbitrary marks are words that exist in language but are used in an unrelated context.²⁸ Finally, suggestive marks include words that exist in language and have a generally understood meaning that is somewhat related to the product²⁹ but still require some imagination, thought, or “mental leap.”³⁰

In contrast to inherently distinctive marks, descriptive marks “are merely descriptive of a product [and] are not inherently distinctive.”³¹ As their classification implies, merely descriptive marks describe the type of product or service and the Supreme Court has held that as such “they do not inherently identify a particular source, and hence cannot be protected.”³² While the general rule is that a “merely descriptive” mark cannot obtain trademark protection, it is possible for a descriptive trademark to acquire “secondary meaning” through use in commerce and thereby “acquire the distinctiveness which will allow them to be protected.”³³ In essence, the

22. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936) (holding that “cellophane” was generic for cellulose-based plastic film).

23. *Bayer Co. v. United Drug Co.*, 272 F. 505, 515 (S.D.N.Y. 1921) (holding that “aspirin” was generic for acetylsalicylic acid).

24. *Am. Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9, 20 (D. Conn. 1962). For a review of genericness surveys, see E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel*, in *TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN 101* (Shari Seidman Diamond & Jerre B. Swann eds., 2012).

25. 2 MCCARTHY, *supra* note 1, § 11:1.

26. *Id.*; *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

27. *E.g.*, KODAK, Registration No. 2,040,245 (cameras); XEROX, Registration No. 3,719,198 (photocopiers).

28. *E.g.*, APPLE, Registration No. 3,928,818 (computers); CAMEL, Registration No. 1,502,414 (cigarettes).

29. *E.g.*, IVORY SOAP, Registration No. 0054,415 (soap); TIDE, Registration No. 4,462,346 (detergent).

30. *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995) (holding that a mark is not suggestive where “[n]o mental leap is required”).

31. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

32. *Id.*

33. *Id.*

mark holder must show that consumers have come to recognize and accept the mark as denoting only one exclusive source.³⁴ Thus, if consumers come to associate a descriptive mark with a single source (e.g., WORLD BOOK for an encyclopedia), even if they cannot name the source (e.g., the source of WORLD BOOK is Scott Fetzer, a Berkshire Hathaway subsidiary), the mark can qualify as a source indicator that warrants trademark status.

The question of whether a descriptive mark has achieved secondary meaning is important both in the bulk of litigation that takes place before the Trademark Trial and Appeal Board (TTAB) in office actions to determine whether a descriptive mark qualifies for trademark protection through registration on the Principal Register³⁵ and in trademark infringement litigation in federal court. Although circumstantial measures are often used to support a claim of secondary meaning (e.g., “amount and manner of advertising” and “volume of sales”), surveys provide direct evidence on the relevant legal question: whether the relevant consuming public has come to identify the mark as denoting source.³⁶

3. *Likelihood of Confusion.*—Trademark law is commonly justified as serving two principal goals: (1) consumer protection and (2) mark owner protection.³⁷ There is an ongoing and lively debate over the foundations of trademark law,³⁸ but such matters are well beyond the scope of this Article. Suffice it to say that in terms of consumer protection, trademarks serve the obvious function of preventing consumer deception³⁹ and the less obvious, but widely accepted, function of reducing consumer search costs.⁴⁰ Trademarks come to function as representations of manufacturer quality assurance, and thus consumers use them as shortcuts to rapidly identify and

34. 2 MCCARTHY, *supra* note 1, § 11:25 (“Trademark protection for descriptive marks is extended only in recognition of consumer acceptance and recognition of such marks as denoting only one seller or source.”).

35. 3 *id.* § 19:10 (describing eligibility for the Principal Register).

36. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983).

37. 1 MCCARTHY, *supra* note 1, § 2:2 (“Trademark law serves to protect both consumers from deception and confusion over trade symbols *and* to protect the plaintiff’s infringed trademark as property.”).

38. *See, e.g.*, Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1840–41 (2007) (arguing that consumer protection is a secondary goal to mark owner protection). *Contra* Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2100 (2004) (arguing that the central function of protecting trademarks is to benefit consumers).

39. 1 MCCARTHY, *supra* note 1, § 2:4 (“Trademarks fix responsibility. Without marks, a seller’s mistakes or low quality products would be untraceable to their source.”).

40. *Kraft Foods Grp. Brands LLC v. Cracker Barrel Old Country Store, Inc.*, 735 F.3d 735, 739 (7th Cir. 2013) (“A trademark’s value is the saving in search costs made possible by the information that the trademark conveys about the quality of the trademark owner’s brand.”); *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) (“The fundamental purpose of a trademark is to reduce consumer search costs . . .”); 1 MCCARTHY, *supra* note 1, § 2:5 (“[T]rademarks reduce the customer’s cost of acquiring information about products and services.”).

purchase the types of goods they want without having to research them. In authorizing federal actions for trademark infringement,⁴¹ Congress enabled the federal courts to protect consumers from deception when the trademark holder proves that the use of a mark is likely to cause confusion.

Trademark law also offers the mark holder a potent sword against infringement. Trademarks can be the most valuable assets on a corporation's budget sheet,⁴² and courts regularly recognize that value.⁴³ Competitors are tempted to free ride by creating marks that mimic, imitate, or confuse.⁴⁴ Trademark law gives the mark holder a mechanism to stop competitors from using such infringing marks. The crux of the legal analysis revolves around whether the infringing mark is likely to cause confusion among consumers.⁴⁵ And therein lies the central value of consumer surveys in trademark infringement litigation: In the absence of difficult-to-obtain evidence of actual confusion, how can we know whether consumers are likely to be confused unless we examine consumer reaction?⁴⁶

The statutory test for consumer confusion is deceptively straightforward. A plaintiff needs to show that defendant is using a mark that is "likely to cause confusion, or to cause mistake, or to deceive."⁴⁷ In order to measure likelihood of confusion, each circuit has developed a multifactor test that measures up to twelve different factors. The Second Circuit's eight-factor *Polaroid* test⁴⁸ is often credited as the first and

41. 15 U.S.C. § 1125(a)(1) (2012).

42. Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301, 301–03 (1992).

43. See, e.g., *DHL Corp. v. Comm'r*, 285 F.3d 1210, 1219 (9th Cir. 2002) (upholding a Tax Court valuation of the "DHL" trademark at \$100 million); *Nestle Holdings, Inc. v. Comm'r*, 152 F.3d 83, 85, 88 (2d Cir. 1998) (vacating the Tax Court's \$150,300,000 valuation of Nestle's trademarks and trade names because the valuation methodology used did not encompass all relevant factors).

44. See generally David J. Franklyn, *Debunking Dilution Doctrine: Toward a Coherent Theory of the Anti-Free-Rider Principle in American Trademark Law*, 56 HASTINGS L.J. 117 (2004) [hereinafter Franklyn, *Debunking Dilution Doctrine*] (identifying the anti-free-riding impulse in trademark law as a "decisive, yet unstated, factor in many reported dilution cases"); David J. Franklyn, *The New Federal Anti-Dilution Act: Reinstating the Myth of "Likely" Dilutive Harm as a Mask for Anti-Free-Rider Liability*, 11 INTELL. PROP. L. BULL. 199 (2007) [hereinafter Franklyn, *The New Federal Anti-Dilution Act*] (arguing that dilution law is really about the prevention of problematic free riding, or "taking unfair advantage" of a famous brand).

45. 1 MCCARTHY, *supra* note 1, § 2:8 ("[T]he keystone . . . [of] trademarks is the avoidance of the likelihood of confusion in the minds of the buying public.").

46. Shari Seidman Diamond & Jerre B. Swann, *Editors' Introduction: Surveys in Modern Litigation Involving Trademarks and Deceptive Advertising*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 3, 3 ("Thus, it was natural that surveys would become a standard form of evidence—perhaps the standard form of evidence—on consumer perception in cases involving trademarks and deceptive advertising.").

47. 15 U.S.C. § 1114 (2012).

48. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). The *Polaroid* eight-factor test considers the following factors:

“immensely influential” multifactor test.⁴⁹ The Ninth Circuit uses a similar eight-factor *Sleekcraft* test, which shares the most common factors, including the core examination into the “strength of the mark,” “proximity of the goods,” and “similarity of the marks.”⁵⁰

Importantly, “[e]vidence of [a]ctual [c]onfusion” is a weighty factor in every single circuit.⁵¹ These four factors form the core inquiry into any trademark infringement action,⁵² even though most circuits augment the test with additional factors, such as marketing channels used, sophistication of customers, and likelihood of product expansion.⁵³ In any case, recent studies suggest that factors beyond the first four are virtually inconsequential.⁵⁴

Trademark law considers three main types of evidence for evaluating the likelihood of confusion: survey evidence, direct evidence, and argument by inference.⁵⁵ Direct evidence is often considered the strongest evidence and includes testimony by confused consumers or misdirected letters.⁵⁶ But substantial and reliable direct evidence of actual deception may be difficult to find. If the junior user has just begun to market his product, an infringement action may be brought to prevent consumer confusion that has not yet occurred in the marketplace from taking place, so no direct evidence of confusion will yet exist.⁵⁷ If the marks have coexisted for some time, some consumers who have been confused may not be aware of the

[T]he strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant’s good faith in adopting its own mark, the quality of defendant’s product, and the sophistication of the buyers.

Id.

49. See 4 MCCARTHY, *supra* note 1, § 24:32.

50. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir. 1979). The *Sleekcraft* eight-factor test considers the following factors:

1. [S]trength of the mark; 2. proximity of the goods; 3. similarity of the marks;
4. evidence of actual confusion; 5. marketing channels used; 6. type of goods and the degree of care likely to be exercised by the purchaser; 7. defendant’s intent in selecting the mark; and 8. likelihood of expansion of the product lines.

Id.

51. Bird & Steckel, *supra* note 6, at 1050 tbl.1.

52. See Beebe, *supra* note 6, at 1589 (“Common to all of the circuits’ tests are four factors: the similarity of the marks, the proximity of the goods, evidence of actual confusion, and the strength of the plaintiff’s mark.”).

53. Bird & Steckel, *supra* note 6, 1050 tbl.1.

54. See *infra* subparts II(A), (C).

55. 4 MCCARTHY, *supra* note 1, § 23:63. McCarthy refers to direct evidence as “[e]vidence of actual confusion.” *Id.*

56. *Id.* § 23:13.

57. *Id.* § 23:12; Mark D. Robins, *Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through a Factor-Based Approach to Valuing Evidence*, 2 N.W. J. TECH. & INTELL. PROP. 117, 129–30 (2004).

deception and others may not complain or be willing to step forward.⁵⁸ The motives of employees or friends who report evidence of deception may be suspect,⁵⁹ producing evidence that is susceptible to criticism.

The alternative to direct evidence is survey evidence, which can measure whether an appreciable number of relevant consumers are likely to be confused by a mark that may or may not already be in the marketplace, and offers “an economical and systematic way to gather information and draw inferences about a large number of individuals.”⁶⁰ Courts have long accepted survey evidence on a variety of issues; their validity and admissibility (assuming proper survey design⁶¹) is black letter law.⁶²

In a survey assessing likelihood of confusion, consumers are exposed to the allegedly infringing mark and their reactions are measured. The identity of the relevant consumer population, the nature of the mark, and the circumstances under which a consumer would encounter the mark determine the design of an appropriate survey. Over time, courts and researchers have come to recognize that the question in a likelihood-of-confusion survey is a causal one and that survey-experiments using control groups are appropriate for likelihood-of-confusion surveys in order to provide trustworthy evidence on whether or not the allegedly infringing mark is likely to cause confusion.⁶³ As a result, survey design has evolved so that surveys now typically include controls designed to rule out competing explanations for consumer responses other than confusion caused by the allegedly infringing mark. The quality of the survey depends on the appropriateness of the design choices, including the choice of the control stimulus.⁶⁴

58. 4 MCCARTHY, *supra* note 1, § 23:12.

59. Robins, *supra* note 57, at 215; Dan Sarel & Howard Marmorstein, *The Effect of Consumer Surveys and Actual Confusion Evidence in Trademark Litigation: An Empirical Assessment*, 99 TRADEMARK REP. 1416, 1432 (2009).

60. Diamond, *Reference Guide*, *supra* note 3, at 364.

61. *See generally id.* (discussing all of the issues that factor into the determination of whether a survey is properly designed).

62. MCCARTHY, *supra* note 1, § 32:158; Diamond, *supra* note 3, 365.

63. *See, e.g.*, Bracco Diagnostics, Inc. v. Amersham Health, Inc., 627 F. Supp. 2d 384, 448 (D.N.J. 2009) (criticizing a survey’s design for failure to use “an adequate control mechanism”); Procter & Gamble Co. v. Ultreo, Inc., 574 F. Supp. 2d 339, 351–52 (S.D.N.Y. 2008) (same); P&G Pharms., Inc. v. Hoffmann-La Roche, Inc., No. 06 Civ. 0034, 2006 U.S. Dist. LEXIS 64363, at *91 (S.D.N.Y. Sept. 6, 2006) (same); Simon Prop. Grp. L.P. v. mySimon, Inc., 104 F. Supp. 2d 1033, 1045–51 (S.D. Ind. 2000) (same); Nat’l Football League Props., Inc. v. ProStyle, Inc., 57 F. Supp. 2d 665, 668 (E.D. Wis. 1999) (same); *see also* Diamond, *supra* note 3, at 399–400, 421 (documenting a growth of surveys with control groups, that is, survey-experiments, in Lanham Act cases).

64. Diamond, *supra* note 3, at 399; *see also* Shari Seidman Diamond, *Control Foundations: Rationale and Approaches*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 201, 212 [hereinafter, Diamond, *Control Foundations*] (discussing features that characterize an appropriate control).

4. *Deceptive Advertising*.—If a party demonstrates that an advertisement is literally false, it is unnecessary to show evidence of consumer reaction to the advertisement to sustain a claim of deceptive advertising.⁶⁵ Courts, however, rarely find challenged claims to be literally false, so the parties may conduct surveys to assess what message consumers are taking from an advertisement in order to persuade the court that consumers are (or are not) being misled by an advertisement.⁶⁶ As with a likelihood-of-confusion survey, a series of methodological decisions will determine the quality of the survey, including the selection of an appropriate control.⁶⁷

5. *Dilution*.—When the owner of a trademark alleges likelihood of dilution, the owner of the mark must prove that the mark is famous, meaning that it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”⁶⁸ As with proof of secondary meaning, evidence may include indirect evidence from volume of advertising and sales; surveys of brand awareness provide direct evidence of fame.⁶⁹

One factor a court may consider in determining whether a mark or trade name is likely to cause dilution by blurring is “[a]ny actual association between the mark or trade name and the famous mark.”⁷⁰ Surveys measuring the associations that the allegedly diluting mark is likely to engender are a fairly recent development, reflecting the relative infancy of the Trademark Dilution Revision Act (TDRA), which was passed in October of 2006.⁷¹ Moreover, there is substantial controversy regarding the form that these surveys should take (i.e., what questions are appropriate to reflect spontaneous association) and what beyond association might be required to demonstrate likelihood of impaired distinctiveness.⁷²

65. 15 U.S.C. § 1125(a)(1) (2012); Bruce P. Keller, *Survey Evidence in False Advertising Cases*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 167, 160–69.

66. Keller, *supra* note 65, at 169.

67. See *supra* notes 63–64 and accompanying text.

68. 15 U.S.C. § 1125(c)(2)(A).

69. *Id.* § 1125(c)(2)(A)(i)–(iii); see *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1160–61 (9th Cir. 2011) (noting the use of surveys and volume of advertising as evidence that a mark was famous).

70. 15 U.S.C. § 1125(c)(2)(B)(vi).

71. See *id.* § 1125(c).

72. See Shari Seidman Diamond, *Surveys in Dilution Cases II*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 155, 157–62 (discussing the difficulties of producing surveys that measure spontaneous association and assess whether association is likely to impair distinctiveness of a mark); Jerre B. Swann, *Dilution Surveys Under the Trademark Dilution Revision Act*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 145, 154 (concluding that impaired distinctiveness is generally “cognitively inferred from fame, similarity, substantially

Nonetheless, association surveys are increasingly appearing as a component of proof in dilution cases.⁷³ As with other surveys, methodological decisions, including the choice of a control, affect the value of association surveys.

B. The Overall Role of Surveys in Trademark and Deceptive Advertising Law

A unique facet of trademark law is that the critical factual inquiry invariably revolves around consumer perception and reaction.⁷⁴ The bulk of trademark disputes require proving secondary meaning⁷⁵ or consumer confusion,⁷⁶ and establishing each relies on showing that the relevant consuming public holds certain perceptions about a mark.⁷⁷ In terms of proving secondary meaning, consumer surveys are virtually indispensable.⁷⁸ Similarly, when the generic nature of a mark is in question or when a competitor alleges that an advertisement is misleading, assessments of consumer perceptions are key. Finally, when likelihood of dilution is alleged, surveys are increasingly appearing in litigation to measure fame and association.⁷⁹ In the adversarial context of proving infringement or deceptive advertising, the use of consumer surveys has long been held an

exclusive use, and association”); Jerre B. Swann, *Swann’s Rebuttal to Diamond*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 163, 163–65 (proposing a five-factor test for impaired distinctiveness based on the text of the TDRA).

73. *E.g.*, Nike, Inc. v. Nikepal Int’l, Inc., 84 U.S.P.Q.2d (BNA) 1820 (E.D. Cal. 2007).

74. *Diamond & Swann*, *supra* note 46, at 3 (“[C]onsumer reaction is the gravamen of infringement.”); *accord* MCCARTHY, *supra* note 1, § 32:158 (“Both trademark validity and infringement turn largely on factual issues of customer perception.”); *see also* Jacob Jacoby & Lynda Zadra-Symes, *Legal Issues That Can Be Examined Via Survey*, in 1 TRADEMARK SURVEYS: DESIGNING, IMPLEMENTING, AND EVALUATION SURVEYS 3, at 5 (2013) (discussing the central role of the mental state of consumers in trademark litigation).

75. 2 MCCARTHY, *supra* note 1, § 15:30 (discussing how to prove secondary meaning).

76. 4 *id.* § 23:63 (discussing how to prove likelihood of confusion).

77. *Diamond*, *supra* note 3, at 366 (“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 a false or misleading message?).”).

78. *Co-Rect Prods., Inc. v. Marvy! Adver. Photography, Inc.*, 780 F.2d 1324, 1333 n.9 (8th Cir. 1985) (“Consumer surveys are recognized by several circuits as the most direct and persuasive evidence of secondary meaning.”); *accord* *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 312 (6th Cir. 2001); 2 MCCARTHY, *supra* note 1, § 15:42 (“One of the most scientific methods of determining the mental associations of the relevant purchaser class is to conduct a survey of the purchasers themselves.”).

79. For cases involving fame surveys, see, for example, *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011); *Visa Int’l Serv. Ass’n v. JSL Corp.*, 590 F. Supp. 2d 1306, 1315 (D. Nev. 2008). For cases involving association surveys, see, for example, *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Nike, Inc. v. Nikepal Int’l, Inc.*, 84 U.S.P.Q.2d (BNA) 1820 (E.D. Cal. 2007); *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.*, 2011 TTAB LEXIS 378 *26–28 (T.T.A.B. 2011).

appropriate,⁸⁰ if not a practically compulsory,⁸¹ method of proving several factors—particularly “actual consumer confusion.”⁸²

II. Studies of Presence and Influence of Surveys in Infringement Decisions

Over time, the use of surveys in trademark and deceptive advertising has grown. According to one account, only 18 surveys were offered in reported cases in the fifteen years between 1946 and 1960, growing to 86 surveys between 1961 and 1975 (approximately 6 per year).⁸³ Between 1976 to 1990, 442 surveys were presented in reported cases (29 per year); between 1991 and 2005, 742 surveys were offered (approximately 49 per year on average); and in the seven years between 2006 and 2012, about 315 surveys appeared in reported cases (approximately 45 per year).⁸⁴

Based on some claims about the crucial role of surveys, one would be forgiven for believing that every trademark case ended in a dramatic introduction of survey evidence serving as the smoking gun. But recent empirical studies published by accomplished scholars call that belief into question.⁸⁵ Several studies have been conducted in the last decade, with the most recent concluding: “survey evidence is used infrequently, treated subjectively, and has the potential to be either dispositive or useless

80. Diamond, *supra* note 3, at 363–66.

81. *Morrison Entm't Grp. Inc. v. Nintendo of Am., Inc.*, 56 F. App'x 782, 785 (9th Cir. 2003) (“Although Morrison is not required to conduct a survey in order to demonstrate actual confusion, such surveys are often used by plaintiffs to bolster their cases.”); *Charles Jacquin Et Cie, Inc. v. Destileria Serralles, Inc.*, 921 F.2d 467, 475 (3d Cir. 1990) (“Similarly, a plaintiff's failure to conduct such a survey where it has the financial resources to do so, could lead a jury to infer that the plaintiff believes the results of the survey will be unfavorable.”); *Gimix, Inc. v. JS&A Grp., Inc.*, 213 U.S.P.Q. (BNA) 1005, 1006 (N.D. Ill. 1982) (“Neither side in this case has produced any consumer surveys or other similar evidence. Both sides are at fault for such laxness.”); Sandra Edelman, *Failure to Conduct A Survey in Trademark Infringement Cases: A Critique of the Adverse Inference*, 90 TRADEMARK REP. 746, 747 (2000) (“[S]urvey evidence has become de rigueur in trademark infringement cases. Indeed, many courts will draw an adverse inference against a plaintiff on the issue of likely confusion if a survey is not introduced.”).

82. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400 (8th Cir. 1987). *But see* MCCARTHY, *supra* note 1 § 32:184 (arguing that surveys are circumstantial evidence of actual confusion and “do not measure the degree of actual confusion by real consumers making mistaken purchases”).

83. Gerald L. Ford, *Survey Percentages in Lanham Act Matters*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 311, 312 n.3.

84. *Id.* This count was updated through 2012 by Gerald L. Ford for a presentation at the McCarthy Law Symposium. Presentation by Shari Diamond, et al., *Survey Evidence: Crunching the Numbers* (Feb. 28, 2013), available at http://www.mccarthyinstitute.org/panel_pdfs/empirical-workmaurerdiamondford.pdf.

85. Beebe, *supra* note 6, at 1586; Bird & Steckel, *supra* note 6, at 1017–18. *But see* Sarel & Marmorstein, *supra* note 59, at 1419 (challenging Beebe's methodology in *An Empirical Study of the Multifactor Tests for Trademark Infringement*). *See also infra* subpart II(D) (pointing to other studies agreeing that survey use is not routine).

depending on the context of the underlying evidence.”⁸⁶ Our empirical research sheds light on why commentators can reach such different conclusions.

A. *Barton Beebe Breaks Ground, 2006*

When Beebe surveyed the state of American trademark law in 2005, he found it “in a severe state of disrepair. Its current condition is Babelian.”⁸⁷ He was referring to the multifactor likelihood-of-confusion test and all of its various manifestations, different in each of the thirteen circuits.⁸⁸ He identified 331 published federal trademark opinions from 2000–2004 that made substantial use of a multifactor-confusion test,⁸⁹ and his findings are dramatic.⁹⁰ He reviewed each opinion and coded whether the decision resulted in a finding of likelihood of confusion, whether the court considered each factor, and whether the court characterized the factor as favoring or not favoring a finding of likelihood of confusion.⁹¹ Based on his analysis, he characterized the Second Circuit as prodefendant⁹² and the Ninth Circuit as proplaintiff.⁹³

Beebe wanted to know which factors in the likelihood-of-confusion test were most important.⁹⁴ As in many other studies of decision making, he was able to predict decisions on likelihood of confusion based on judicial assessments of just a few factors,⁹⁵ most prominently the similarity of the marks and proximity of the goods.⁹⁶ Using simply the court’s assessment of similarity and proximity, Beebe was able to predict case

86. Bird & Steckel, *supra* note 6, at 1017–18.

87. Beebe, *supra* note 6, at 1582.

88. *Id.* at 1582–83.

89. *Id.* at 1649–50 app. A. Beebe excluded all cases involving counterfeit marks or “an alleged breach of a franchising, licensing, or distribution agreement.” *Id.* at 1650 app. A.

90. *See id.* at 1597. Beebe only studied “federal trademark infringement cases that produced written opinions available from the Westlaw and Lexis databases.” *Id.*

91. *Id.* at 1650–52 app. A.

92. *Id.* at 1597 (observing a 37% “plaintiff multifactor test win rate” in the circuit compared to 51% across all other circuits).

93. *Id.* (observing a 64% plaintiff multifactor test win rate in the circuit compared to 43% across all other circuits).

94. *Id.* at 1598 (“It is something of a pastime in trademark law to speculate on which factors, if any, drive the outcome of the multifactor test and how the factors interact.”).

95. *See, e.g.*, RICHARD NISBETT & LEE ROSS, HUMAN INFERENCE: STRATEGIES AND SHORTCOMINGS OF SOCIAL JUDGMENT 41 (1980) (discussing how judgment heuristics can cause people to attribute greater weight to certain types of information than others when making judgments); JOHN D. STEINBRUNER, THE CYBERNETIC THEORY OF DECISION: NEW DIMENSIONS OF POLITICAL ANALYSIS 67 (1974) (“The cybernetic decision maker is sensitive to information only if it enters through an established highly focused feedback channel, and hence many factors which do in fact affect the outcomes have no effect in his decision process.”). For a list of empirical studies of judicial decision making supporting this notion, see Beebe, *supra* note 6, at 1601 n.88.

96. Beebe, *supra* note 6, at 1603.

preliminary injunction decisions and bench trial outcomes with a high degree of accuracy.⁹⁷

His finding that similarity of marks is the single most important factor⁹⁸ makes intuitive sense. When marks are extremely similar, the situation borders the realm of counterfeiting and free riding, which usually tends to overpower other factors.⁹⁹ But Beebe also identified two other influential factors: the defendant's intent when it favored a likelihood of confusion,¹⁰⁰ and the proximity of the parties' goods when that factor disfavored a likelihood of confusion.¹⁰¹ He also concluded that the intent and actual confusion factors "exert an inordinate degree of influence" on the outcome of the rest of the factors.¹⁰² Moreover, the similarity of the marks and defendant intent were weighted so strongly by judges that they could trigger a finding of confusion despite the outcomes of any other factors.¹⁰³ In essence, Beebe described this as a "stampeding" effect and a by-product of "coherence-based reasoning."¹⁰⁴ He theorized that judges essentially looked at just a few factors to decide infringement and then rationalized the rest in order to obtain a coherent outcome.¹⁰⁵

According to the model of judicial decisionmaking that Beebe presents, "survey evidence, thought by many to be highly influential, is in practice of little importance."¹⁰⁶ He found that only sixty-five (20%) of the 331 opinions he studied discussed survey evidence¹⁰⁷ and thirty-four (10%) credited the survey evidence.¹⁰⁸ Although the rulings in 70% of those cases favored the credited survey, those twenty-four cases represented only 7% of the opinions he studied.¹⁰⁹ Beebe expressed surprise at the low overall proportion of reported cases that involved surveys, although he suggested

97. *Id.*

98. *Id.* at 1623 ("[T]he similarity of the marks factor is by far the most important factor in the multifactor test.").

99. See Franklyn, *Debunking Dilution Doctrine*, *supra* note 44, at 118 (describing how "judges and juries seek to . . . punish free-riding").

100. Beebe, *supra* note 6, at 1600, 1610.

101. *Id.* at 1608 ("As a practical matter, in order to win the multifactor test, the plaintiff must not lose . . . [the proximity of goods] factor—or alternatively, when the judge finds an overall likelihood of confusion, the judge almost invariably finds that the proximity factor favors this result.").

102. *Id.* at 1600.

103. *Id.* at 1607.

104. *Id.* at 1614–15. See generally Dan Simon, *A Third View of the Black Box: Cognitive Coherence in Legal Decision Making*, 71 U. CHI. L. REV. 511 (2004) (describing the use of "coherence-based reasoning" in legal decision making).

105. Beebe, *supra* note 6, at 1614–15.

106. *Id.* at 1622.

107. *Id.* at 1641.

108. *Id.*

109. *Id.*

that the time required to conduct a survey meant that most trademark litigation resolved before trial was unlikely to involve surveys.¹¹⁰

Beebe ultimately concluded that judges were indeed shortcircuiting the multifactor balancing test, relying on two or three of the factors (at least similarity of marks and proximity of goods in almost all cases) in a “take the best” strategy that seems to result in what Beebe characterized as an “altogether successful—and rational—approach to decision making.”¹¹¹ We suggest that an additional process may be occurring. In using coherence-based reasoning, judges may evaluate factors to be consistent with the outcome they favor on other grounds. For example, faced with a persuasive survey that shows evidence of likelihood of confusion, the marks may appear more similar than they might have appeared in the absence of the survey. In that case, it would not be the similarity of the marks, but rather the survey, that led to a finding of likelihood of confusion.

Beebe’s coding approach relied on the decisions that the judges made on each factor and he assumed that the judges evaluated each of the major factors independently. Yet, as he observed, the decisions on the less prominent factors tended to match the decisions on the two or three factors he identified as determinative.¹¹² Thus, his analysis of stampeding acknowledges the possibility that the judgments reached on each factor are not independent, and indeed his own analysis calls into question the causal ordering of these judicial decisions on likelihood of confusion.

We walk away from Beebe’s work agreeing that the courts do not practice what they preach in Beebe’s study; the multifactor tests are smokescreens for “fast and frugal” heuristics that create the appearance of consensus by producing coherence among three relatively subjective factors (similarity, intent, and proximity).¹¹³ What is less clear is just how that coherence is created.

B. *Sarel and Marmorstein Scrutinize Beebe’s Findings, 2009*

Professors Sarel and Marmorstein performed their own study in 2009 with the goal of determining the effect of survey evidence in trademark infringement cases in which likelihood of confusion was the central issue.¹¹⁴

110. *Id.* at 1642 (“It may be objected that trademark litigation is typically resolved at the preliminary injunction stage before either party has had the time or can be expected to conduct a creditable survey [I]t is still striking that survey evidence played a relatively minor role even in the bench trial context.”).

111. *Id.* at 1614.

112. *Id.*

113. *Id.* at 1586–87, 1600, 1617.

114. Sarel & Marmorstein, *supra* note 59, at 1430 (“The goal of this study is to help plaintiffs determine the importance and value of presenting actual confusion evidence and/or surveys in trademark infringement litigation.”).

Dissatisfied with Beebe's approach¹¹⁵ they analyzed 126 cases decided between 2001 and 2006 in which the plaintiff possessed an "undisputed, valid trademark."¹¹⁶ By focusing on these cases, questions about genericism or lack of secondary meaning that might make a survey about confusion legally irrelevant would not affect the outcome of the case. Using independent coders to assess whether the marks were similar or dissimilar and whether the goods were sold in high or low proximity, they also determined whether the plaintiff had presented a survey and, if so, whether the court had admitted or rejected it.¹¹⁷ Their results on the use and efficacy of surveys differed dramatically from those of Beebe. In approximately one-third of the cases studied (34.1%), plaintiffs offered likelihood-of-confusion surveys¹¹⁸ and the results suggest substantial impact in cases in which the parties' marks or goods or services are dissimilar.¹¹⁹

Sarel and Marmorstein's study showed that the admission of survey evidence increased the success rate on a likelihood-of-confusion issue by 24.2%.¹²⁰ When the plaintiff had survey evidence admitted and the trademarks or goods were dissimilar, use of survey evidence significantly increased plaintiff success in obtaining an injunction (by about 60%).¹²¹ Where the marks were dissimilar, it was almost impossible to obtain an injunction without a survey—only 4% of plaintiffs were able to obtain an injunction without the use of a survey in such instances, whereas 61.5% obtained an injunction with a survey.¹²² And if the survey was rejected, no plaintiff succeeded in obtaining an injunction.¹²³ Even where the goods and marks were similar, the admission of surveys increased win rates by approximately 17%–20%.¹²⁴

115. *Id.* at 1419 ("The methodology Beebe employed is unorthodox and the findings are open to different interpretations.").

116. *Id.* at 1422–23.

117. *Id.* at 1435. They also coded whether actual confusion evidence had been presented and, if so, whether it was weak or strong. *Id.*

118. *Id.* at 1431.

119. *Id.* at 1433.

120. *Id.* at 1426–27 ("In 76.0 percent of cases in which survey evidence was presented and admitted, injunctions were granted. These results are significantly higher than for the 'None' category, in which the plaintiffs prevailed in 51.8 percent of cases . . .").

121. *Id.* at 1433. Professors Sarel and Marmorstein found:

In cases involving parties with dissimilar trademarks, plaintiffs prevailed in only 4 percent of the cases in which a survey was not presented, 0 percent in which the plaintiff's survey was rejected, and 61.5 percent in which the plaintiff's survey was admitted. In cases involving dissimilar goods or services, the plaintiffs prevailed in only 27.3 percent of cases in which a survey was not presented, 0 percent in which the plaintiff's survey was rejected, and 85.7 percent in which plaintiff's survey was admitted.

Id.

122. *Id.* at 1428.

123. *Id.*

124. *Id.* at 1433 ("[When] the parties had similar trademarks, plaintiffs prevailed in 72.4

But how could Sarel and Marmorstein reach such dramatically different results from Beebe? It is difficult to tell, but Beebe relied on judicial conclusions about the similarity of the marks and the proximity of the goods. By using two independent coders to assess factors like the similarity of the marks,¹²⁵ Sarel and Marmorstein reduced the likelihood that the survey results would artificially influence the way the factors were categorized, avoiding a spurious match to the survey results that Beebe recognized might have occurred with the judges. Moreover, by focusing on cases in which the validity of the mark was undisputed, they studied precisely the cases in which likelihood of confusion would be the central issue. There is one important area in which the two studies converge: Beebe argued that the similarity of marks was nearly dispositive, so it makes sense that surveys would be more useful when marks are less similar. That, of course, is what Sarel and Marmorstein found.¹²⁶

C. *Bird and Steckel Renew the Inquiry, 2012*

The most recent empirical study of surveys returns to the theme of little impact for surveys involving likelihood of confusion.¹²⁷ Professors Bird and Steckel used Beebe's data set as a starting point and then expanded it with 202 additional cases from 2005–2006, for a total of 533 federal opinions from 2000–2006.¹²⁸ Again, they used only published opinions available on Westlaw and LexisNexis.¹²⁹ Their research goal was to evaluate “what impact surveys have on the outcome of court cases.”¹³⁰ Ultimately, they concluded that consumer surveys are neither “universally influential” nor “used as often as some would imply.”¹³¹

Bird and Steckel found that 16.6% of the 533 cases discussed survey evidence (representing a decline from Beebe's original 20%).¹³² From this, they concluded that “consumer surveys are not especially useful in likelihood of confusion cases.”¹³³ Many of their findings, however, actually corroborate Sarel and Marmorstein's. For instance, Bird and Steckel found that where the marks were similar but the products were dissimilar, the

percent of cases without surveys and in 91.7 percent of cases with admitted surveys. Likewise, in cases involving similar goods and services, plaintiffs prevailed in 55.6 percent [of cases] . . . without surveys and 72.2 percent of cases with admitted surveys.”)

125. *Id.* at 1423.

126. *Id.* at 1433.

127. Bird & Steckel, *supra* note 6, at 1035.

128. *Id.* at 1029–30.

129. *Id.* at 1031.

130. *Id.* at 1029.

131. *Id.* at 1048.

132. Compare *id.* at 1035, with Beebe, *supra* note 6, at 1641.

133. Bird & Steckel, *supra* note 6, at 1035.

introduction of survey evidence “represents an apparent 76.7% increase in the probability that a likelihood of confusion finding will occur.”¹³⁴

Overall, they found that surveys were not used in the majority of cases and that their actual effect varied greatly depending on the weight of other evidence and the factual circumstances.¹³⁵ To that end, their findings supported Beebe’s conclusion that three factors of the multifactor test were disproportionately influential.¹³⁶ The predicted outcomes on these core factors can serve as navigation points for survey usefulness.¹³⁷ They also found that it was in close cases that surveys were most useful,¹³⁸ in cases where the plaintiff’s key non-survey evidence was especially strong or weak, the survey was either redundant or insufficient.¹³⁹

Bird and Steckel recognized that their study of published cases did not permit them to measure the role that surveys played in cases that settled.¹⁴⁰ They theorized it was likely that “surveys play a very different role in cases that settle” and admitted that their “estimate of the degree to which they are used [in settlement] could be vastly understated.”¹⁴¹ To this end, they hypothesized a number of roles that surveys could play in the pretrial stage, such as determining the viability of a lawsuit or leveraging favorable settlements.¹⁴² Lacking any further data on pretrial usage, however, they could not assess whether survey usage in federal court misrepresented the role of surveys in trademark-related disputes.¹⁴³

D. *Other Studies Find Agreement that Survey Use Is Not Routine*

Empirical studies into survey use are by no means an untouched field of study. Dozens of scholars have examined court decisions to assess the role of surveys. Graeme W. Austin studied cases over a ten-year period (1993–2003) and found that surveys were introduced in 57.4% of trademark infringement cases that went to final judgment.¹⁴⁴ He concluded that the surveys influenced the result in 35.2% of cases.¹⁴⁵ Jacoby and Morrin studied cases from 1994 to 1997 and reported that courts were generally

134. *Id.* at 1041. Compare *id.*, with Sarel & Mormorstein, *supra* note 59, at 1433.

135. Bird & Steckel, *supra* note 6, at 1043–46.

136. *Id.* at 1045–46.

137. *Id.* at 1042–43 (describing a matrix of potential multifactor outcomes and the correlating benefit or “impact” of a survey in each measured against the cost of a survey).

138. *Id.* at 1041 (“Surveys seem to be most helpful to plaintiffs when non-survey proof is of middling strength.”).

139. *Id.* at 1041–42.

140. *Id.* at 1047.

141. *Id.*

142. *Id.* at 1036.

143. *Id.*

144. Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 867–69 (2004).

145. *Id.* at 867.

skeptical of survey evidence.¹⁴⁶ Kevin Blum, Ariel Fox, Christina Hayes, and James Xu studied 224 infringement cases in the Southern District of New York from 1994–2008 with “[t]he goal of testing Beebe’s results over a longer period of time.”¹⁴⁷ They too found results “consistent with Beebe’s national study.”¹⁴⁸ They concluded: “survey data is less frequently employed than one might expect given the conventional wisdom that survey evidence is routinely employed to prove a likelihood of confusion.”¹⁴⁹

The consensus in all of these studies is that survey data is neither omnipresent nor likely to be as important as some other factors when it appears in published opinions. But before we conclude that surveys play an unimportant role in trademark litigation it is worth considering the role it is reasonable to expect surveys to play. First, what roles do they—should they—play in the stages that precede court hearings? Second, how much survey activity is warranted where marks are highly similar, the proximity of the goods is high, or there is evidence of intent to free ride? The plaintiff may reasonably believe that further proof is unnecessary. Why then would we expect a survey? Third, how often are competent and defensible surveys offered as evidence? If a survey is not competently done, why should we expect it to be influential?

Thus, the real empirical questions worth asking are: how often and with what effect are surveys conducted when other evidence is ambiguous and survey evidence can be probative—of likelihood of confusion or of other trademark issues? We cannot answer all of these questions here, but we can provide evidence that suggests a larger role for surveys than is reflected in the previous studies of published opinions.

III. Reported Cases Without Survey Evidence

We begin by looking closely at a sample of reported cases in which surveys were not offered. The article by Graeme W. Austin, who studied cases over a ten-year period (1993–2003), provided the names of 23 federal cases in his sample in which no survey evidence was offered.¹⁵⁰ We looked closely at each of these cases for cues to the absence of survey evidence and the court’s perspective on it.

146. Jacob Jacoby & Maureen Morrin, “Not Manufactured or Authorized by . . .”: *Recent Federal Cases Involving Trademark Disclaimers*, 17 J. PUB. POL’Y & MARKETING 97, 100, 103 (1998).

147. Kevin Blum et al., *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. ¶ 3 (2010), <http://journals.law.stanford.edu/sites/default/files/stanford-technology-law-review/online/blum-consistency-of-confusion.pdf>.

148. *Id.* ¶ 88.

149. *Id.* ¶ 64.

150. Austin, *supra* note 144, at 868 n.175.

In seven cases, the plaintiff presented evidence of instances of actual confusion that the court found persuasive¹⁵¹ or stipulated to absence of actual confusion.¹⁵² In three cases, the defendant's mark was identical or nearly identical to that of the plaintiff¹⁵³ or the defendant was a licensee whose conduct went beyond the scope of the license agreement.¹⁵⁴ Assuming that these cases are representative of those in which scholars have not found surveys, these categories offer some explanation for why no survey was presented. With good evidence of actual confusion, no dispute about its absence, or nearly identical marks, a survey may be unnecessary or irrelevant, and these categories account for almost half (10/23 = 43%) of the no-survey cases.

In seven other cases, the court explicitly commented on the absence of a survey (e.g., "Planet Hollywood has offered no survey evidence on the question of whether there would likely be any confusion by consumers between Planet Hollywood restaurants and Hollywood Casino's operations" (denying injunction);¹⁵⁵ "[plaintiff has] yet to conduct any customer survey of their own to provide support of their claim that their mark has secondary meaning, despite ample time, resources and motivation to do so."¹⁵⁶ "[A]lthough AFLAC suggested it would submit survey evidence at the preliminary injunction hearing, it did not have time to complete the survey and presented no survey evidence." (denying preliminary injunction)¹⁵⁷).

151. *E.g.*, *Quantum Fitness Corp. v. Quantum Lifestyle Ctrs.*, 83 F. Supp. 2d 810, 830 (S.D. Tex. 1999) (granting preliminary injunction and holding that "Quantum Fitness has submitted competent evidence of actual confusion"). *See also* *Locomotor USA, Inc. v. Korus Co.*, No. 93-56032, 1995 U.S. App. LEXIS 401, at *22 (9th Cir. Jan. 6, 1995); *Pocono Int'l Raceway, Inc. v. Pocono Mountain Speedway, Inc.*, 171 F. Supp. 2d 427, 441 (M.D. Pa. 2001); *Patsy's Brand Inc. v. I.O.B. Realty Inc.*, 58 U.S.P.Q.2d (BNA) 1048, 1057 (S.D.N.Y. 2001); *Rainforest Cafe, Inc. v. Amazon, Inc.*, 86 F. Supp. 2d 886, 903 (D. Minn. 1999); *Porsche Cars N. Am., Inc. v. Manny's Porshop, Inc.*, 972 F. Supp. 1128, 1131 (N.D. Ill. 1997).

152. *Banfi Prods. Corp. v. Kendall-Jackson Winery, Ltd.*, 74 F. Supp. 2d 188, 198 (E.D.N.Y. 1999).

153. *E.g.*, *Apple Corps. v. Button Master*, 47 U.S.P.Q.2d (BNA) 1236 (E.D. Pa. 1998) (involving "pin-on buttons featuring the name and likeness of The Beatles"); *see also* *Calvin Klein Jeanswear Co. v. Tunnel Trading*, No. 98 Civ. 5408, 2001 U.S. Dist. LEXIS 18738, at *28 (S.D.N.Y. Nov. 16, 2001).

154. *Hard Rock Café Int'l (USA) Inc. v. Morton*, No. 97 Civ. 9483, 1999 U.S. Dist. LEXIS 8340, at *3 (S.D.N.Y. June 1, 1999).

155. *Planet Hollywood, Inc. v. Hollywood Casino Corp.*, 80 F. Supp. 2d 815, 866, 905 (N.D. Ill. 1999).

156. *J & J Snack Foods Corp. v. Nestle USA, Inc.*, 149 F. Supp. 2d 136, 153 (D.N.J. 2001).

157. *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 685, 690 (N.D. Ohio 2002); *see also* *Int'l Data Grp. v. Ziff Davis Media, Inc.*, 145 F. Supp. 2d 422, 438, 441 (D. Del. 2001) (denying preliminary injunction, finding that "[t]his does not preclude IDG from later introducing evidence, such as survey data, that demonstrates actual confusion of consumers or advertisers"); *Am. Auto. Ass'n v. AAA Auto. Club of Queens, Inc.*, No. 97 CV 1180, 1999 U.S. Dist. LEXIS 8892, at *22 n.11 (E.D.N.Y. Feb. 8, 1999) (granting preliminary injunction, finding "deliberative infringement in this case (in addition to some evidence of actual confusion)" and noting that "[n]either side has offered surveys or market research"); *Playboy Enter., Inc. v. Terri Welles, Inc.*,

Thus, the judge noted the absence of surveys in these cases and indicated that the evidence was weakened by its absence. Of course, neither we nor the judge could know whether a survey would have changed the outcome of the case or whether a survey was actually conducted and not presented, but the court found the absence of a survey to be an omission worth noting.

Among the six remaining cases, in one case, the plaintiff actually submitted a survey, but it was stricken as untimely.¹⁵⁸ In a second, the court denied summary judgment for the defendant who pointed to differences between the marks of plaintiff Sam's Wines & Liquors and defendant Walmart's Sam's Wholesale Club.¹⁵⁹ Although not explicitly referring to the absence of a survey, the court noted "[T]he defendant has failed to produce evidence showing that the consuming public would not be confused by the similarities between the marks."¹⁶⁰ Only four cases did not fall in any of these categories. This analysis of reported no-survey cases thus suggests that many of them lacked surveys for good reasons, or that the lack of a survey was potentially detrimental to the strength of the case.

We turn now to our survey of trademark attorneys for some further insights on the pretrial decisions that lead or do not lead to the presentation of a survey in court.

IV. The INTA Survey—Introduction

As far as we can tell, this is the first attempt to empirically measure the use of survey evidence in the prelitigation context. Almost all of the literature has complained of this missing gap in the empirical studies.¹⁶¹ We surveyed a large body of trademark attorneys and professionals with a brief questionnaire designed to elicit information about how, if at all, they have used surveys at any stage of litigation and what kinds of effects the surveys have had. We found ample evidence to suggest that surveys enjoy a substantial life before trial as critical evaluative and leveraging tools. In short, we found that survey use at trial is just the tip of the iceberg.¹⁶²

78 F. Supp. 2d 1066, 1083 (S.D. Cal. 1999) (granting summary judgment to defendant, finding that "[p]laintiff has presented no empirical evidence (either anecdotal or survey) to show that there is actual confusion among consumers"); *Sea-Roy Corp. v. Parts R Parts*, No. 1:94CV00059, 1997 U.S. Dist. LEXIS 21809, at *107 (M.D.N.C. Dec. 2, 1997) ("Plaintiffs in this case, like the competitor in *Glover*, could have offered evidence [on genericism] in the form of consumer surveys.").

158. *Golden W. Fin. v. WMA Mortg. Servs.*, No. C 02-05727, 2003 U.S. Dist. LEXIS 4100, at *13–14 (N.D. Cal. Mar. 12, 2003).

159. *Sam's Wines & Liquors, Inc. v. Wal-Mart Stores, Inc.*, No. 92 C 5170, 1993 U.S. Dist. LEXIS 12394, at *3, *16 (N.D. Ill. Sept. 2, 1993).

160. *Id.* at *8.

161. *See, e.g.*, Bird & Steckel, *supra* note 6, at 1047.

162. Thus, confirming Bird & Steckel's observation. *Id.* at 1036 ("Although we cannot say for certain, what we observe in the federal court system may merely be the 'tip of the iceberg' of survey usage in trademark-related disputes.").

A. *Eligible Survey Participants*

To uncover the role that surveys may play before a formal court action occurs, we could not use court files.¹⁶³ As the gatekeepers who decide whether or not to commission a survey, attorneys were the logical source of information on these preceding-decision stages, so a survey of practicing attorneys was a sensible methodological approach to take. The International Trademark Association (INTA) graciously agreed to send emails to its members inviting them to participate in the survey. As the leading global association of trademark owners and professionals in the world, INTA offered access to a large group of active trademark attorneys and professionals.¹⁶⁴

Using their membership list, INTA sent invitations to their members in November 2013, inviting them to participate in the survey.¹⁶⁵ Although the INTA membership does not include attorneys who only occasionally handle a case involving a trademark issue and does include many attorneys who specialize in nonlitigation trademark matters, the membership includes a substantial number of attorneys who are frequently involved in trademark litigation.¹⁶⁶

163. Even PACER files would not disclose these cases.

164. *About INTA*, *supra* note 8; *see also* Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 655 n.177 (noting that the INTA is the largest trademark organization).

165. The invitation was sent out on November 8 (with a follow-up sent on November 20) and read as follows:

Dear INTA Member,

INTA is pleased to facilitate an online survey being conducted by Dr. Shari Diamond and Professor David Franklyn, on behalf of the McCarthy Institute for Intellectual Property and Technology Law.

From the researchers:

The McCarthy Institute—Center for the Empirical Study of Trademark Law—is conducting a survey of INTA members worldwide to determine the ways in which consumer perception surveys are used (or not used) in trademark disputes. It is an anonymous survey. Please click on the link below to take the survey. It should take less than 10 minutes of your time. Kindly complete the survey no later than Monday, November 18. A summary of the survey results will be published in *The Trademark Reporter* as part of a study that is being undertaken by Dr. Shari Diamond of Northwestern University School of Law and David Franklyn of the McCarthy Institute.

Thank you very much,

Shari Seidman Diamond & David Franklyn (emphasis omitted).

166. *See* Grinvald, *supra* note 164 (explaining that, although “it is difficult to estimate the number of trademark attorneys in the United States,” in 2010 there were “approximately 2,218 U.S.-based attorneys who are members of the International Trademark Association”).

B. An Overview of the Survey

The survey included eighteen questions gauging the respondents' experience, if any, with surveys, as well as their occupational background and geographic location. The first question asked whether the respondent had ever commissioned or conducted a survey for a trademark or deceptive advertising matter. Respondents could answer: (1) no; (2) yes, as a lawyer; or (3) yes, as a consultant. Respondents were then asked what factors they considered in deciding whether or not to commission a survey. This was an open-ended question that called on respondents to describe the determinants of their decision without suggesting categories that they might have chosen if the choice was offered, but which did not spontaneously occur to them as a primary consideration.

The next set of questions asked respondents to think of the most recent case in which they had commissioned a survey. First, we asked which issues were involved: likelihood of confusion, secondary meaning, "genericness," deceptive advertising, dilution, and/or other. We then asked respondents to identify what happened with the survey (inviting them to check as many as were applicable):

- (1) the results helped to convince *my client* not to pursue a claim;
- (2) the results helped to convince *my client* to settle the case;
- (3) the results helped to convince *the opposing party* not to pursue a claim;
- (4) the results helped to convince *the opposing party* to settle;
- (5) the survey was presented in a preliminary injunction hearing;
- (6) the survey was presented at trial; and
- (7) other.

Following this question, we asked respondents to assess the effect of the survey on the outcome of the case. We then asked the respondent to indicate whether their client in this survey was a plaintiff or defendant.

Our next set of questions focused on the opposing party. We asked whether the opposing party had conducted a survey and repeated the same questions regarding the issues, outcome, and effect of the survey. We closed the survey with a set of more general questions asking how long the respondent had practiced law, how many surveys they had commissioned, how many had been presented at trial, where they practiced law, and what, if any, changes they would like to see in the use of surveys. The Appendix provides the exact wording of all of the survey questions.

C. Results of the Survey

We set out to explain the apparent inconsistency between conventional wisdom regarding the importance in trademark cases and the empirical findings provided by Beebe and by Bird and Steckel indicating low survey

use. We found that not only are surveys widely used in pretrial stages, but that the attorneys who commission them generally perceive their impact as quite influential on the outcome of the case.

1. The Respondents.—Of the 465 respondents, 335 identified as practicing attorneys (79 identified as “other” and 51 did not indicate their occupation).¹⁶⁷ Two of the practicing attorneys were survey consultants, so we did not include them in the sample of practicing attorneys.

Of the 333 practicing attorneys, 172 (52%) practiced law in the United States and the remaining attorneys practiced in 56 other countries. The U.S. practicing attorneys had practiced law for an average of 20.3 years (median = 20 years), and the non-U.S. practicing attorneys had practiced for an average of 17.3 years (median = 16 years).

An additional 13 respondents who completed the survey said they had commissioned or conducted a survey as a survey consultant.

2. Use of Surveys.—More than half of the 333 practicing attorneys indicated that they had commissioned at least one survey. Of the 172 who said they practiced law in the United States, 96 (55.8%) reported they had commissioned at least one survey. Of the 145 attorneys in the United States sample who reported they had been in practice at least eight years, 61.4% reported having commissioned at least one survey.¹⁶⁸ This group of 145 attorneys averaged 7.2 surveys per attorney; amongst the 96 who had commissioned at least one survey, the average was 11.8 per attorney. Thus, although a majority of attorneys reported that they used surveys on occasion, the numbers suggest that they do not use surveys in every case.

We do, however, have evidence that an exclusive focus on surveys presented at trial would substantially underestimate how often surveys are commissioned in trademark and deceptive advertising litigation. We asked respondents how many trademark or deceptive advertising surveys they had commissioned and how many of the commissioned surveys had been presented at trial. On average, 19.2% of surveys were presented at trial

167. INTA’s membership includes over 6,600 organizations from 190 countries. *About INTA*, *supra* note 8. Members include brand owners, law firms, nonprofits, government agency members, professors, and student members. *Id.* As a result, it is hard to assess the response rate of relevant respondents who received the email invitation, that is, attorneys who are engaged in trademark or deceptive advertising litigation. Although the survey yielded a substantial number of respondents, we assume that the response rate is quite low and we have no way to assess how representative it is of the population of attorneys who litigate trademark matters. Thus, although the practicing attorneys in the sample do reflect a range of seniority and experience, the numbers we report should be viewed with that caution in mind.

168. When a partner and an associate are working on the same case, the partner will typically be the one who commissions the survey. We did not ask whether the respondent was an associate or a partner, but only 25.9% of 27 attorneys who said they had less than eight years of practice reported having commissioned a survey.

(median = 11.2%). Some of the surveys may have been presented in a preliminary injunction hearing, but the rest would not be reflected in a formal proceeding other than a *Daubert* motion on admissibility.¹⁶⁹

Another indicator of the role surveys can play in pretrial stages of litigation comes from the thirteen survey experts in our sample. This was an experienced group who averaged 92 surveys per respondent (median = 50) and they reported that 18% (median = 10%) of their surveys had been presented at trial.

The United States was not alone in survey use. Of the 145 lawyers who said they practiced law outside the United States, 71 (49%) reported they had commissioned at least one survey. Because we are interested in comparing our results with the findings from the studies of federal court cases described above, we focus our analysis here primarily on surveys commissioned by U.S. practicing attorneys.

3. *When Attorneys Commission a Survey.*—Many factors influence whether an attorney will commission a survey in a trademark or deceptive advertising case. Table 1 shows what factors attorneys identified in response to an open-ended question that asked them to describe what factors they considered in deciding whether or not to commission a survey. Respondents were allowed to input multiple factors and describe them in their own words; we then analyzed each response and categorized it according to the most relevant factors.

Table 1: Factors Used in Deciding to Do a Survey—U.S. Practicing Attorneys

Factors in deciding to commission a survey	Attorneys who have commissioned a survey	Attorneys who have not commissioned a survey	All attorneys
Cost/client resources	51 (53.1%)	25 (32.9%)	76 (44.2%)
Closeness of case/other evidence	24 (25.0%)	1 (1.3%)	25 (14.5%)
Value of mark/stakes	18 (18.8%)	3 (3.9%)	21 (12.2%)
Likelihood result will favor client	17 (17.7%)	2 (2.6%)	19 (11.0%)

169. For a discussion of survey evidence and *Daubert* challenges, see generally G. Kip Edwards, *The Daubert Revolution and Lanham Act Surveys*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 329.

What other side does/is likely to do	16 (16.7%)	1 (1.3%)	16 (9.3%)
Sufficient time	5 (5.2%)	1 (1.3%)	6 (3.5%)
Jurisdiction/court expectation	10 (10.4%)	4 (5.3%)	14 (8.1%)
No factor mentioned	7	51	58
Total N	96	76	172

The most frequently mentioned consideration was cost or the client's budget. A majority (53.1%) of respondents who had commissioned a survey mentioned cost. While only a third of the respondents who had never commissioned a survey answered this open-ended question, each named cost as an explanation and few identified any other factors. The answers given by several of the "no survey" respondents are particularly telling: "I haven't had a client who was willing to undertake the expense" and "[u]sually cost and the analysis ends there."

The second most prominent factor respondents mentioned was the other evidence in the case. One in four respondents with survey experience said their decision on whether or not to commission a survey was the closeness of the case or what other evidence was available. Some of the respondents gave specific examples: "whether the alleged falsehood is express or implied"; "whether the confusion factor analysis is close enough to warrant a survey"; "closeness of the marks"; "whether I have good evidence of actual confusion." These responses help to clarify why a survey is not done in every case even when cost is not a key issue: the legal and factual nature of the case may or may not make a survey useful or even relevant.¹⁷⁰

A third factor mentioned by a substantial number of respondents was the value of the mark or the stakes at issue. This factor implicitly reflects an evaluation of whether it is worth bolstering the strength of the party's position irrespective of the nature of other available evidence: when the potential loss would be very harmful, the cost of obtaining additional evidence that may assist is worth assuming.

The fourth factor frequently mentioned was the likelihood that the survey results would favor the client. It is of course reasonable for an attorney to avoid spending client money collecting evidence that will not assist the client. However, using this criterion as a basis for determining

170. Note, however, that in a deceptive advertising case, the court may not see a claimed false statement as literally false so that a party who lacks a survey to assess the message conveyed by the advertisement may be taking a risk in relying on literal falsity.

whether a survey will be done reveals a potential weakness in cases that do not include a survey.

When courts draw a negative inference from the absence of a survey,¹⁷¹ they may in part be reflecting a suspicion that the party did not produce a survey for one of two reasons: either the party anticipated a negative result and did not do a survey or a survey was done but the results did not favor the party.¹⁷² Although it is standard practice in survey research to pretest questionnaires before fielding a survey in order to ensure that respondents will understand the questions,¹⁷³ conducting pilot work in the trademark context may also warn the party that conducted the pilot work that a survey will not produce favorable results. Thus, in some cases, courts may be correct in drawing a negative inference from the absence of a survey. That is, a party may not conduct, or at least may not produce, a probative survey precisely because the evidence would not favor that party. Four of the U.S. respondents (and two non-U.S. respondents) explicitly mentioned this role for pilot surveys.

Finally, the fifth factor that respondents mentioned with some frequency was what the other side does or is likely to do. Attorneys faced with an opposing survey see themselves at risk if they do not have empirical evidence to counter the opposing party's survey results. Our results from attorneys reporting on their most recent case provide some evidence that an unopposed survey may be more influential than one that is opposed.¹⁷⁴

4. *The Nature of Surveys in Litigation*—To obtain concrete information on a sample of recent surveys conducted in trademark and deceptive advertising litigation, we asked respondents to describe their most recent case involving a survey. The attorneys in the United States reported that a majority of the surveys were conducted on behalf of plaintiffs (75.9%), no doubt reflecting the fact that the plaintiff typically bears the burden of proof in trademark and deceptive advertising litigation. We expected that defendants would be more likely to feel the need to conduct a survey if they knew that the plaintiff had conducted one. And indeed, in cases in which the respondent reported commissioning the survey on behalf of the

171. *E.g.*, *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 72 (2d Cir. 1994).

172. Surveys are protected from discovery by attorney-client privilege. *See, e.g.*, MCCARTHY, *supra* note 1, § 32:179 (discussing the level of protection afforded surveys under work-product doctrine).

173. *See Standards and Guidelines for Statistical Surveys*, OFF. OF MGMT. & BUDGET § 1.4 (Sept. 2006), http://www.whitehouse.gov/sites/default/files/omb/inforeg/statpolicy/standards_stat_surveys.pdf (specifying that to ensure that all components of a survey function as intended, pretests of survey components should be conducted unless those components have previously been successfully fielded); *Best Practices*, AM. ASS'N FOR PUB. OP. RES. § 6, http://www.aapor.org/Best_Practices1.htm ("High quality surveys and polls always provide adequate budget and time for pretesting questionnaire(s) and field procedures.").

174. *See infra* section IV(C)(5).

defendant, the attorney was somewhat more likely to report that the opposing party had conducted a survey (50% versus 31%).¹⁷⁵

As the results in Table 2 indicate, the topic most commonly addressed in a survey was likelihood of confusion (81.25%).¹⁷⁶ A number of the cases involved surveys that addressed multiple issues, but nearly one in five cases involved surveys exclusively addressing an issue other than likelihood of confusion.

175. In 26% of the cases with plaintiff surveys and in 27% of the cases with defendant surveys, the attorney did not know whether or not the opposing party had conducted a survey.

176. Our survey experts reported an even higher rate of likelihood-of-confusion surveys in their most recent case. Twelve of the thirteen (92%) said that likelihood-of-confusion was at least one survey issue, although in only five of those cases was it the only survey issue (other issues were secondary meaning (6%); genericness (2%); deceptive advertising (2%); and dilution (2%)). The thirteenth expert reported that deceptive advertising was the only survey issue in the most recent case.

Table 2: Topic(s) Addressed in the Most Recent Case Involving a Survey

Topic of survey:	N	Percentage
Likelihood of confusion	78	81.25%
Secondary meaning	32	33.3%
Genericism	18	18.7%
Deceptive advertising	15	15.6%
Dilution, including fame and association	19	19.8%
Other	3	3.1%
Total N of cases	96	

The sole survey issue in six of the cases was genericism and in another six cases the sole survey issue was deceptive advertising. In contrast, dilution surveys in all but one case accompanied a survey assessing the issue of likelihood of confusion, reflecting the role of dilution claims as a backup for a claim of likelihood of confusion.¹⁷⁷ These results show only the nature of the most recent case in which surveys were conducted and cannot tell us how often surveys are commissioned when a case involves a question of genericism or deceptive advertising. The results do reveal that the role of surveys in trademark and deceptive advertising litigation will be underestimated if we focus exclusively on cases involving likelihood of confusion.

5. *Survey Effects in Litigation.*—To gauge the role played by surveys in the course of litigation, we asked respondents about the outcome of the survey in their most recent survey case: “What happened with your survey(s) in this case?” We presented them with six options, tracing the potential progress of a claim from its earliest stages through trial, and invited them to choose as many of them as applied. They could also select “other” and specify what that meant. Table 3 shows how and when the surveys were used.

177. See generally Franklyn, *Debunking Dilution Doctrine*, *supra* note 44 (noting that, even though dilutive harm is always speculative and very difficult to prove, plaintiffs may prevail on dilution when likelihood of confusion cannot be demonstrated).

Table 3: Survey Use in the Course of Litigation

**Question: What happened with your survey(s) in this case?
Please select as many as apply.**

What happened with the survey?	N	Total N	%
Survey convinced my client or opposing party not to pursue the claim or to settle the case:		47	54%
Convinced client only	26		
Convinced opposing party only	20		
Convinced both	1		
<hr/>			
Survey was presented at preliminary injunction or trial:		31	36%
Presented at preliminary injunction	13		
Presented at trial	16		
Presented at both	2		
<hr/>			
Survey was used for "other" purpose:		9	10%
Case settled before trial	1		
Unfavorable results	3		
Unspecified	1		
Excluded by court	2		
Results presented at arbitration	1		
None of the above	1		
<hr/>			
Total		87	100%

The results in Table 3 describe how surveys were used as the litigation unfolded, revealing substantial activity in the early stages of litigation. In 47 cases, the case ended when the survey convinced one or both parties not to pursue the claim or to settle the case. This group of cases constitutes more than half of the 87 cases (54%) in which the attorney provided outcome information.¹⁷⁸ In contrast, only 31 survey cases (36%) proceeded to a preliminary injunction hearing, a trial, or both.

We invited respondents to check as many responses as applied, so the figures in Table 3 provide a conservative estimate of the role of surveys. They do not completely reflect the supporting role played by surveys in leading to dropped claims and settlements because the cases in the table

178. We could not determine the role of the survey in the nine cases in which the matter was still pending (8) or the respondent did not remember (1).

show only the role of the survey at the point when the case ended.¹⁷⁹ For example, respondents in four of the thirteen cases (30%) that ended with a preliminary-injunction hearing also indicated that the survey convinced one or both parties to settle the case. We do not know whether this occurred before or after an opinion was written in the case, but if settlement occurred before an opinion was written, the case would not have appeared in a study of published cases.¹⁸⁰

The respondents did not report a direct role for the surveys in all of these cases, either in settlement or in a court hearing, but several responses reveal ways that published cases may miss survey activity behind the scenes apart from stimulating settlement. In three cases, the respondent reported that the survey was not used because it did not produce favorable results: “Not helpful but client pursued and prevailed”; “ended up not using at trial because of bad results”; and “results convinced client to pursue in venue that would not require a survey.” These results did not persuade the parties to settle, but they influenced the nature of the evidence that was produced in the course of the litigation.

We also asked each respondent to assess the overall effect of the survey(s) on the outcome of the case, using a 7-point scale ranging from 1 = not at all influential to 7 = extremely influential. Table 4 shows that on average the respondents rated the survey(s) in their most recent case as somewhat influential. A moderate rating would have been 4, the midpoint of the scale. The mean rating was 4.55 and the median 5. Less than one in four respondents (22.9%) rated the survey(s) at 3 or lower on the scale, and 61.5% rated them 5 or higher.

179. Across all cases, 17 respondents said the survey convinced the client not to pursue the claim; 20 said it convinced the client to settle; 5 said it convinced the opposing party not to pursue the claim; and 27 said it convinced the opposing party to settle.

180. We thank David Schwartz for pointing this out.

Table 4: Perceived Effect of Survey on the Outcome of the Case

Question: What would you say was the overall effect of your survey(s) on the outcome of the case?

(1 = Not at all influential; 7 = Extremely influential)

What happened with the survey?	Mean	N	Std. Deviation	Median
Led client to settle or not pursue the claim	4.81	26	1.52	5.00
Led opposing party to settle or not pursue the claim	5.20	20	1.10	5.00
Led both to settle	5.00	1	-	5.00
Preliminary injunction	5.15	13	1.14	5.00
Trial	4.56	18	2.12	5.00
Pending	3.88	8	1.64	4.00
Other	2.30	10	1.57	1.50
Total	4.55	96	1.74	5.00

To gauge whether surveys were evaluated as more influential at different stages of litigation (e.g., were they perceived as more influential when presented at trial?), we compared ratings for the cases disposed of at different stages of litigation. We found no evidence that surveys were perceived as more influential when they were presented in a preliminary injunction hearing (mean = 5.15) or at trial (mean = 4.56) than when they led to settlement or dropping of claims before trial (mean = 4.81 by client; mean = 5.20 by opposing party). In each instance, the survey on average received above-midpoint mean and median ratings. Not surprisingly, surveys in pending cases generated a more equivocal rating on influence (mean = 3.88; median = 4): their influence level was still uncertain when the outcome of the case was not yet determined. Similarly, when a survey was not used due to an unfavorable result or exclusion by a court, it was rated well below the midpoint of the scale in influence.

As we might expect, respondents rated an opposing survey as less influential than the survey they commissioned (4.06 versus 3.23, $t(34) = 2.30$, $p = .028$). This tendency to privilege our own work or possessions is a well-known human characteristic.¹⁸¹ Yet, in cases in which the

181. See generally Elizabeth Hoffman & Matthew L. Spitzer, *Willingness to Pay vs.*

respondent faced an opposing survey, respondents rated their own survey as less influential than when their survey was unopposed. Respondents rated the influence of an unopposed survey at 4.84 and the influence of an opposed survey at 4.06 ($t = 2.01, p < .05$). We would expect this difference if a well-conducted opposing survey raises doubts about a survey that provided conflicting results, but it is also possible that cases with and without opposing surveys differ on other dimensions as well.

Research on reported cases suggests that only a small percentage of survey cases in trademark litigation involve opposing surveys (8/89 cases = 9%).¹⁸² Our attorney survey finds that opposing surveys may be more common than the pattern in the published cases would suggest. We asked respondents whether the opposing party had conducted a survey in their most recent case. Although respondents did not know whether the opposing party had done a survey in 26% of the cases, they reported that an opposing survey had been done in 36.5% of the cases. Even if we look only at the cases involving likelihood of confusion, respondents reported an opposing survey in 32.1% of them. It is unclear why reported cases should be less likely to include dueling surveys, but this difference again suggests that the litigation landscape may not be fully captured in an analysis of reported cases.

V. Implications of the Attorney Survey Results

Our attorney survey helps to explain why contemporary scholarship reveals relatively low survey use in reported trademark decisions. Our results indicate that surveys are used heavily in pretrial assessments and strategic decision making.¹⁸³ They play key roles in claim evaluation and are understood by attorneys as an influential settlement tool for both sides.¹⁸⁴ Therefore, many surveys are never reported because they effectively contribute to pretrial resolution.

We also find that the primary driving force affecting survey use is cost. Clients who may benefit from surveys are potentially priced out of court. Furthermore, they may be unable to extract an advantageous settlement without the aid of a survey. The key issue going forward will be cost

Willingness to Accept: Legal and Economic Implications, 71 WASH. U. L.Q. 59 (1993) (reviewing research showing “people value commodities more when they own the commodities than when they do not”); Dale T. Miller & Michael Ross, *Self-Serving Biases in the Attribution of Causality: Fact or Fiction?*, 82 PSYCHOL. BULL. 213 (1975) (analyzing evidence of “self-serving biases in perception[s] of causality”); Richard Thaler, *Toward a Positive Theory of Consumer Choice*, 1 J. ECON. BEHAV. & ORG. 39, 44 (1980) (coining the term “endowment effect” for the principle that people tend to value goods more when they own them than when they do not).

182. Bird & Steckel, *supra* note 6, at 1035.

183. See *supra* Table 3 (54% of surveys used in settlement and claim evaluation).

184. See *supra* Tables 3 & 4 (lawyers rated surveys as highly effective during settlement phases).

management and hopefully new survey products and innovations that will give more litigants access to these critical tools when they are needed.

A. Why Reported Cases Underrepresent the Role of Surveys

Authors gauging the influence of surveys in trademark litigation by analyzing reported case outcomes have been correct to express unease about whether their results fully capture the role played by surveys in these cases. Fifty years ago, Karl Llewellyn warned against the “*threat of the available*”—his concern that researchers would “mistake the merely available, the easily seen, for all there is to see.”¹⁸⁵ Court decisions resulting in published opinions are the easily seen portion of litigation, but the majority of claims do not reach that stage.

Our survey of trademark attorneys helps assess the role played by surveys in publicly invisible stages of litigation. The results suggest that surveys often play an important role in the course of litigation that is not detectable in studies of reported cases that reach their final disposition in formal court actions. The attorneys reported not only that surveys are influential, but also that in a majority of cases involving surveys, the results of the surveys help to convince parties to drop claims or to settle. It is significant that surveys affect not only the opposing party’s willingness to drop a claim or settle, but are also used to convince a client not to pursue a claim or to settle.

Is there a selection bias in the cases that are not resolved until formal court action occurs? It is widely acknowledged that the process of winnowing disputes for litigation is not random,¹⁸⁶ and although the exact nature of the selection process is in dispute, most models assume that the fraction of cases going to trial declines as uncertainty about the trial outcome declines.¹⁸⁷ Thus, if a survey produces convincing evidence for or against either party, that evidence should reduce uncertainty and make trial less likely. We would expect then that some of the most convincing surveys never appear in reported cases because the claims that generated those surveys are dropped or settled before a preliminary injunction hearing or trial produces a court opinion.

B. A Survey for Every Case?

Several authors reporting on the frequency of surveys that appear in published cases have expressed surprise that survey evidence was not

185. Karl N. Llewellyn, *Legal Tradition and Social Science Method: A Realist’s Critique*, in *JURISPRUDENCE: REALISM IN THEORY AND PRACTICE* 77, 82 (1962).

186. *E.g.*, Peter Siegelman & Joel Waldfogel, *Toward a Taxonomy of Disputes: New Evidence Through the Prism of the Priest/Klein Model*, 28 *J. LEGAL STUD.* 101, 103 (1999).

187. *Id.* at 102 n.2.

offered in most cases.¹⁸⁸ Their surprise is in part understandable in light of court commentary identifying survey evidence as the most direct evidence that can be offered in trademark cases.¹⁸⁹ And indeed, a well-conducted survey can offer strong probative evidence on consumer perception that is hard to duplicate in other ways. Although part of the reason why surveys are not the norm in published cases may be a larger role for surveys in cases that are resolved before formal court dispositions, there are other explanations as well.

Both our attorney survey results and our close analysis of the Austin sample of no-survey cases¹⁹⁰ provide several reasons why litigants do not produce survey evidence in every trademark case. Some of these reasons reflect the nature of the other evidence in the case. If reliable evidence of actual confusion is available, a survey of consumer reaction is redundant. When marks are highly similar or nearly identical, likely confusion may be inferred without survey evidence in an appropriate situation. As Sarel and Marmorstein found, surveys are most influential when marks are dissimilar.¹⁹¹ Similarly, Bird and Steckel found that a credited plaintiff survey was most influential when other evidence was mixed.¹⁹² It is when courts are faced with equivocal evidence and there is no survey that they are likely to mention the absence of survey evidence.

Other reasons why surveys are not always conducted reflect the nature of trademark litigation. Surveys designed to assess likelihood of confusion, secondary meaning, or genericism are all special purpose surveys that must be generated for litigation to address the particular contested issue. There is no archive of surveys an expert can simply refer to in offering an opinion. Although some experts are willing to opine on how consumers are likely to respond to a mark, they cannot, without a survey of responses to that specific mark, offer more than a hunch about actual consumer response. Because a survey cannot be generated on the spot, identifying an appropriate and available expert and conducting a survey within the swift time frame available in litigation leading to a preliminary injunction hearing may present an insurmountable challenge.

Perhaps the most troubling aspect about the attorney survey responses reported here is the prominent role of cost in determining whether to commission a survey. As others have noted, surveys can be expensive¹⁹³

188. *See supra* Part II.

189. *See, e.g.*, *Morrison Entm't Grp., Inc. v. Nintendo of Am., Inc.*, 56 Fed. App'x 782, 785 (9th Cir. 2003).

190. *See supra* Part III.

191. Sarel & Marmorstein, *supra* note 59, at 1432.

192. Bird & Steckel, *supra* note 6, at 1041.

193. *E.g.*, Robert H. Thornburg, *Trademark Survey Evidence: Review of Current Trends in the Ninth Circuit*, 21 SANTA CLARA COMPUTER & HIGH TECH. L.J. 715, 717 (2005) (“[S]urvey experts in California charge between \$450 to \$600 per hour and require support staff billing at

and, as many of our attorney respondents indicated, the expense may deter a litigant from commissioning a survey that can provide relevant and probative evidence on consumer perceptions not easily obtained from other sources. The future of survey research in trademark litigation is likely to be affected by the ability to reduce costs while maintaining defensible quality.¹⁹⁴

Nonetheless, the choice not to conduct or present a potential probative survey may also stem simply from adversarial strategy. If predicted or obtained survey results would not support the claim of the party that commissioned the survey, the trial court is unlikely to see those findings, so they will not appear in any court opinion.

C. *Judicial Responses to Surveys*

As Barton Beebe's results revealed, just because a survey is presented in court does not mean that the court will find it persuasive.¹⁹⁵ If dueling surveys are presented, the court must decide if either one is persuasive. As with any expert testimony, the court's task can be difficult and judges sometimes complain about the quality of the survey evidence they receive.¹⁹⁶ Although we know of no systematic analysis of how often courts are misled by surveys (or any other expert testimony), there is no doubt that courts are sometimes leery of survey evidence and sometimes credit weak surveys and fault strong ones.

The most recent iteration of judicial complaints about surveys in trademark cases, and the most sweeping, comes from Judge Richard Posner.¹⁹⁷ Although he affirmed the district court's grant of a preliminary injunction based on the similarity of the logos and the products and channels of distribution, he called survey evidence "prone to bias."¹⁹⁸ He noted (correctly) the wide variety of survey designs, none foolproof, and worried that parties may suppress bad results and that experts can be biased.¹⁹⁹ He then offered a series of criticisms of the plaintiff's survey.

Kraft Foods, the source of Cracker Barrel brand cheese, sued Cracker Barrel Old Country Store when they began selling hams in the same

rates ranging between \$200–300 in orchestrating the actual surveys.”).

194. See MCCARTHY, *supra* note 1, § 32:196 (observing that “accurate and scientifically precise surveys” are not always introduced because they are costly and litigants are better off not using a survey than using a survey “obtained on the cheap.”).

195. Beebe, *supra* note 6, at 1641.

196. See, e.g., *J & J Snack Foods Corp. v. Earthgrains Co.*, 220 F. Supp. 2d 358, 370 (D.N.J. 2002); *Learning Network, Inc. v. Discovery Commc'ns, Inc.*, 153 F. Supp. 2d 785, 789 (D. Md. 2001); *Nat'l Football League Props., Inc. v. ProStyle, Inc.*, 57 F. Supp. 2d 665, 667–68 (E.D. Wis. 1999).

197. *Kraft Foods Grp. Brands LLC v. Cracker Barrel Old Country Store, Inc.*, 735 F.3d 735, 741–43 (7th Cir. 2013).

198. *Id.* at 741.

199. *Id.*

grocery stores that carried Kraft's Cracker Barrel cheese.²⁰⁰ Kraft argued that consumers were likely to confuse the similar logos and then blame Kraft for any dissatisfaction.²⁰¹ In the plaintiff's survey, respondents were shown the allegedly infringing ham and asked whether the company that makes it also makes other products—and if so what products.²⁰² Judge Posner properly observed that the respondents might be just guessing when they responded, “cheese” (presumably due to the notion that ham and cheese go together).²⁰³

But the survey did not stop there. Respondents in a control group were shown a ham without the allegedly infringing mark and they did not give a “cheese” response.²⁰⁴ The survey-experiment thus isolated the effect of the name Cracker Barrel in producing the cheese response in the test cell. In view of the identical use of Cracker Barrel on the two products, this evidence was highly relevant evidence of likelihood of confusion.

Judge Posner, however, would have preferred to have sales evidence that would reflect the extent of consumer confusion in the actual marketplace.²⁰⁵ His hypothetical study would require, among other things, control of sufficient purchasing settings to manipulate placement of products or a purchasing environment that happened naturally to provide at least quasi-random variation in whether the store carried the allegedly infringing product or, if it did, how closely the products were placed in the store. It is hard to imagine that this study could be carried out under appropriately controlled conditions and produce defensible conclusions about the cause of differences or lack of differences between conditions, let alone that it could be conducted in a reasonable period of time. More importantly, in view of the strength of Kraft's Cracker Barrel mark for cheese, there is no reason to think that proximity to Cracker Barrel cheese in the store would affect consumers' expectation that the ham was put out by the makers of Cracker Barrel cheese. Even Judge Posner acknowledged doubts about the reliability of such a study, and admitted that the design he proposed would have been impossible in the current case when few of the allegedly infringing products had yet appeared in stores.²⁰⁶

Reliable survey evidence provides precisely the evidence that is needed when actual confusion or sales diversion data are unavailable. If no such actual confusion or sales diversion evidence exists, judges are forced

200. *Id.* at 736–37.

201. *Id.* at 742.

202. *Id.*

203. *Id.* (“The respondents may have assumed that a company with a logo that does not specify a particular food product doesn't make *just* sliced spiral ham. So now they have to guess what else such a company would make. Well, maybe cheese.”).

204. *Id.*

205. *Id.*

206. *Id.*

to turn to their own reactions to the marks in assessing actual confusion. But as Judge Posner acknowledged, “judges and jurors have their own biases and blind spots.”²⁰⁷ Not only may a particular judge’s reaction be idiosyncratic, it may also be quite different from the reactions of members of the relevant consumer population for the products or services at issue. Judge Jerome Frank recognized the weakness of judicial perception in a 1948 trademark case that the publishers of *Seventeen* magazine brought against the makers of “Miss Seventeen” girdles.²⁰⁸ He observed that in the absence of a test of the reactions of “numerous girls and women,” the trial court’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.”²⁰⁹ It is an all-too-human response for a judge to presume that others will share the judge’s reactions.²¹⁰ A survey, if properly designed, can correct judicial misimpressions.

Judge Posner’s reaction to surveys reflects a judicial unease that is sometimes visible in other judges and displays the suspicion that Judge Posner expressed in an earlier case when he wrote after critiquing a survey: “[N]o doubt there are other tricks of the survey researcher’s black arts that we have missed.”²¹¹ Judges need to understand the principles of good survey design and be assured that justifiable methodological choices have been made in producing the survey evidence they are asked to consider.

D. Moving Forward: What Is/Should Be the Role of Surveys?

The value of surveys to litigants and courts, both now and in the future, depends on providing clearer standards for good survey design and educating judges to appreciate those standards and to evaluate the extent to which a survey measures up to those standards. Respondents to our attorney survey frequently mentioned both clearer standards and more educated judges in responding to our question about what, if any, changes they would like to see in the use of trademark and deceptive advertising surveys.

207. *Id.* at 741.

208. *Triangle Publ’ns, Inc. v. Rohrlich*, 167 F.2d 969, 974 (2d Cir. 1948) (Frank, J., dissenting).

209. *Id.* at 976–77.

210. The false consensus effect is a strong and well-established cognitive bias that leads a person to assume that their own opinions are shared by others. *E.g.*, Gary Marks & Norman Miller, *Ten Years of Research on the False-Consensus Effect: An Empirical and Theoretical Review*, 102 *PSYCHOL. BULL.* 72, 72–73 (1987); Lee Ross et al., *The “False Consensus Effect”: An Egocentric Bias in Social Perception and Attribution Processes*, 13 *J. EXPERIMENTAL SOC. PSYCHOL.* 279, 280–81 (1977).

211. *Indianapolis Colts, Inc. v. Metro. Balt. Football Club Ltd. P’ship*, 34 F.3d 410, 416 (7th Cir. 1994).

Some respondents suggested more radical changes. To reduce potential bias and thus defuse judicial objections to the methodological decisions made by adversarial experts in designing surveys, several respondents advocated greater use of court-appointed experts or party-agreed-upon survey designs (e.g., “the survey should be agreed upon by both parties to overcome bias”; “both parties pay a neutral party to conduct a non-biased survey”). These reforms have been suggested by others, but have not gained traction in the American adversarial system to this point.²¹²

The final frontier is cost. Online surveys offer a potential way to reduce costs. To the extent that the online survey can reduce costs while maintaining control, that format offers great promise.²¹³

Conclusion

Surveys may not be ubiquitous in reported cases involving allegations of likelihood of confusion, but they frequently play a central role in the progress of trademark and deceptive advertising litigation before cases appear in court opinions. They are most likely to be commissioned when other evidence in the case is equivocal, which is precisely when they are most likely to influence decisions.

Surveys are valuable tools in trademark litigation, even when they are not deployed in trial. They provide an important reality check on mark evaluation and effective leverage in settlement negotiations. Surveys help inform clients and shape strategy with insight into actual consumer perceptions and their legal significance.

The future of surveys in trademark litigation is likely to depend on the quality of survey design as well as better-educated trademark attorneys, experts, and judges. The tools of survey design have been improving over time (e.g., shifting from surveys to survey-experiments with control groups), producing better options than the designs that were common when surveys were first used in trademark cases. Ample business opportunity exists for survey firms that can reduce costs while maintaining defensible quality. There is still room for improvement, but as a window into the source of relevant consumer reactions to trademarks and allegedly

212. See, e.g., Justice Stephen Breyer, *Introduction* to REFERENCE MANUAL ON SCIENTIFIC EVIDENCE, *supra* note 3, at 1, 6–7 (advocating greater use of court-appointed experts); Christopher Robertson, *Blind Expertise*, 85 N.Y.U. L. REV. 174, 179 (2010) (advocating use of an intermediary to select qualified experts who will render litigation opinions without knowledge of which party is asking).

213. See Roger Tourangeau & Shari Seidman Diamond, *Internet Surveys for Evaluating Trademark Infringement and Deceptive Advertising*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS: LAW, SCIENCE, AND DESIGN, *supra* note 24, at 287, 305 (noting the reduced cost of web surveys and the probable development of new methods in the future that will increase control).

deceptive advertising, the potential evidentiary value of a well-designed survey-experiment is unique.

Appendix—Trademark Survey

(Note: respondents viewed the questions in a slightly different format)

Not all questions were asked of all respondents (e.g., if a respondent answered No to question 1, the respondent was not asked the questions about their most recent survey (questions 3–10)).

We are writing to you as a member of INTA to help us better understand the role that experts and surveys play in litigation. Specifically, we would like to know what, if any, experiences you have had with surveys in trademark and deceptive advertising litigation. We are interested both in cases that did and did not end up going to trial or appearing in judicial opinions. We would appreciate it if you would complete the following brief survey (18 questions). We are not asking you to identify any cases or parties (or experts). All responses will of course be confidential and we will use the responses only to describe aggregate results. We will be happy to share our findings with you when our results are compiled.

Thanks very much,

Shari Seidman Diamond & David Franklyn

Question 1: Have you ever commissioned or conducted a survey for a trademark or deceptive advertising matter?

- Yes, as a lawyer I have commissioned a survey
- Yes, as a survey consultant I have conducted a survey
- No

Question 2: What factors do you consider in deciding whether or not to commission a survey? (Please type your answer below.)

If respondent answered no to Question 1, survey skips to Question 11.

YOUR MOST RECENT SURVEY(S):

Question 3: Please think of the most recent case in which you commissioned or conducted a survey. What issues were involved? Please select as many as apply. (If “Other,” please specify.)

- Likelihood of Confusion
- Secondary Meaning
- Genericness
- Deceptive Advertising
- Dilution
- Other _____

Question 4: What happened with your survey(s) in this case? Please select as many as apply.

- The results helped to convince my client not to pursue a claim
- The results helped to convince my client to settle the case
- The results helped to convince the opposing party not to pursue a claim
- The results helped to convince the opposing party to settle the case
- The survey was presented in a preliminary injunction hearing
- The survey was presented at trial
- Other _____

Question 5: What would you say was the overall effect of your survey(s) on the outcome of the case?

	1	2	3	4	5	6	7	
Not at all influential	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	Extremely influential

Question 6: In this case, the client was the:

- Plaintiff
- Defendant

Question 7: Did the opposing party do a survey in this case?

- Yes
- No
- Don't Know

If respondents answered no to Question 7, survey skips to Question 11.

Question 8: What issue(s) did the opposing party's survey(s) address? Please select as many as apply. (If "Other," please specify.)

- Likelihood of Confusion
- Secondary Meaning
- Genericness
- Deceptive Advertising
- Dilution
- Other _____

Question 9: What happened with the opposing side's survey(s)? Please select as many as apply.

- The results helped to convince my client not to pursue a claim
- The results helped to convince my client to settle the case
- The results helped to convince the opposing party not to pursue a claim
- The results helped to convince the opposing party to settle the case
- The survey was presented in a preliminary injunction hearing
- The survey was presented at trial
- Other _____

Question 10: What would you say was the overall effect of the opposing side's survey(s) on the outcome of the case?

	1	2	3	4	5	6	7	
Not at all influential	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	<input type="radio"/>	Extremely influential

Asked of all respondents:

Question 11: Please respond as appropriate given the following choices:

- I have been practicing law for the number of years specified in the box below:

- I am not a practicing lawyer. My occupation is as follows:

Questions 12–14 asked only if respondent answered yes to Question 1 (had commissioned or conducted a survey for a trademark or deceptive advertising matter).

Question 12: In total, how many trademark or deceptive advertising surveys have you commissioned or conducted?

Question 13: Of those ___ total surveys you've commissioned or conducted, how many have been presented at trial?

Question 14: Are there any changes you would like to see in the use of surveys in trademark and deceptive advertising litigation? Please describe.

Question 15 asked only if respondent indicated practicing law in response to Question 11.

Question 15: Where do you practice law?

- United States
 Other _____

Question 16 asked only if respondent had indicated practicing law outside the United States in response to Question 15.

Question 16: In the country where you practice, are surveys ever used on trademark or deceptive advertising issues?

- Yes
 No
 Don't know

Questions 17–18 asked only if respondent answered yes in response to Question 16.

Question 17: What issues have these surveys been used to address? Please select as many as apply. (If “Other,” please specify.)

- Likelihood of Confusion
- Secondary Meaning
- Genericness
- Deceptive Advertising
- Dilution
- Other _____

Question 18: In your opinion, should the use of these surveys to address these issues?

- Increase
- Stay the same
- Decrease

Thank you for participating in this survey. If you are interested in the results, please send your email address to Shari Diamond at:

s-diamond@law.northwestern.edu.