

Surveying the Field: The Role of Surveys in Trademark Litigation

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Shari Seidman Diamond & David J. Franklyn, [Trademark Surveys: An Undulating Path](#), 92 **Tex. L. Rev.** 2029 (2014).

Trademark surveys have traditionally been seen as a core element of any trademark infringement or dilution dispute. How else would we discover, the theory goes, whether the typical consumer is confused about the source of a particular product, believes the prestige of a famous mark to have been diluted, or considers a once valid mark to have become generic?

Recent empirical work, focusing on published judicial opinions, has debated whether surveys have indeed played as significant a role as some have asserted or whether they are generally disregarded by courts, perhaps in favor of judges' own intuitions. In a recent symposium contribution published in the *Texas Law Review*, Shari Seidman Diamond and David J. Franklyn help to expand the field. Because published opinions tell only part of the story, Profs. Diamond and Franklyn surveyed trademark practitioners in an attempt to discover how surveys are used in early stages of legal disputes. The results provide some useful food for thought both for trademark practitioners and for empirical legal scholars.

Some background for readers who are unfamiliar with trademark doctrine: Trademarks function, in the now prevalent description, as source identifiers — they tell consumers who is responsible for (or, perhaps, who sponsors or authorizes) the good or service at hand. Unlawful uses of trademarks disrupt this function in impermissible ways, either by confusing consumers into thinking that two parties are related when they are not or by diluting the strength of a famous trademark by using it on unrelated goods or services. When a trademark no longer performs its source-identifying function — that is, when it becomes the common word for a good or service rather than identifying a particular producer of that good or service — the mark is said to have become generic and so can no longer be claimed by anyone as a mark for that good or service.

The conventional wisdom was that courts trying to determine how consumers interpreted a particular trademark would want to see evidence of that interpretation in the form of a survey. Consumers would be intercepted in a mall, or contacted via the telephone, and asked certain questions about the mark. There are, of course, limits to survey evidence, since any results must be assessed with the knowledge that the artificial nature of the survey environment is likely to encourage focus on small similarities or differences that might otherwise go unnoticed. (Likewise, there are equally troublesome instances of judges believing that their own views, arrived at in the quiet of chambers, are equivalent to those of the [reasonable consumer](#).)

In a careful and influential 2006 [study](#) of the multifactor tests for trademark infringement, Prof. Barton Beebe concluded that courts did not ultimately place as much weight on surveys as litigants might have assumed. Given that only 20 percent of the 331 opinions he studied discussed survey evidence, and only 10 percent credited the survey evidence, Prof. Beebe concluded that survey evidence was “in practice of little importance.”

Prof. Beebe's conclusions were challenged to some extent by Profs. Sarel and Marmorstein in their 2009 [study](#). Profs. Sarel and Marmorstein narrowed the field to 126 opinions in which the plaintiff's trademark rights were undisputed, in an attempt to focus their assessment on surveys regarding likelihood of confusion. They found that in about one-third of their cases, the plaintiff offered a likelihood-of-confusion survey, with a significant impact on the results of decided cases in which the survey was admitted.

A third [study](#) was published by Profs. Bird and Steckel in 2012. Like the previous two studies, the Bird/Steckel study focused on published opinions, expanding Prof. Beebe's data set with an additional 202 later cases. With this larger dataset, Profs. Bird and Steckel found that only 16.6 percent of their 533 cases discussed survey evidence, and so their results supported Prof. Beebe's finding that surveys were not as broadly influential as assumed. They also found, however, consistent with Profs. Sarel and Marmorstein, that surveys could be influential in particular kinds of cases (such as where the marks were similar but the products dissimilar).

In their contribution to this line of research, Profs. Diamond and Franklyn note — as the previous authors acknowledge — that all of these studies focus on published opinions, and so tend to show us what judges and juries think about trademark surveys. To learn more about how litigants assess the value of surveys, Profs. Diamond and Franklyn obtained the permission of INTA (the International Trademark Association) to survey its members to determine when and under what circumstances attorneys chose to commission a survey in a trademark case and what effect the survey had over the course of the litigation.

The survey included questions assessing the respondents' experience with surveys, the factors they considered in deciding whether to commission a survey, and the effect the survey had in the respondents' most recent case, such as leading one party to drop or settle a claim. The survey also asked respondents to assess the effect of any surveys conducted by the opposing party in the case. (It should be noted that, inevitably, the dataset for this study had its own limitations, in that it asked respondents about surveys in trademark and deceptive advertising litigation, which would not include the use of surveys in proceedings before the Trademark Trial and Appeal Board, where they may well play a different role.)

Although, as they acknowledge, the overall response rate to the survey was fairly low (333 practicing attorneys), Profs. Diamond and Franklyn conclude 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." (P. 2052.) Indeed, although only 19.2 percent of the surveys that respondents reported were eventually presented at trial, more than half of the 333 attorneys reported having commissioned at least one survey.

Profs. Diamond and Franklyn also asked about the factors used in deciding to commission a survey, and here, the results are not particularly surprising: the cost to the client; an assessment of how close the case was; how high-stakes the litigation was; and the likelihood that the survey would return a favorable result. Finally, the responses indicated that surveys played a substantial role in early stages of litigation: 54 percent reported that the survey persuaded one of the parties to drop the claim or settle, while 36 percent reported that the survey was presented at a preliminary injunction hearing and/or at trial (which, as Profs. Diamond and Franklyn note, could also have motivated settlement of the case).

The authors do not purport to offer a normative assessment on when and whether trademark surveys *should* be conducted or proffered, but their results can't be fully interpreted without taking such questions into account. The effect of a survey in a trademark case is as much about which party has the resources to fully commit to the survey process as it is about a search for the truth about consumer

perception. A party with the resources to commission a carefully designed survey, conduct pilots or pretests that yield useful information about predicted results (perhaps via a nontestifying expert in an attempt to shield the results of the pilot from discovery), and have an expert on hand to question the methodology of the opposing survey will be in a better position in settlement negotiations than the party without such resources. (When six percent of survey respondents believe that a parody advertisement featuring “[Michelob Oily](#)” was an actual Anheuser-Busch advertisement, one can appreciate the benefit of an expert survey team.) So, relatedly, a survey may well be a type of signaling device that communicates a belief in the strength of one’s case quite separate from the results of the survey itself. We should not, therefore, draw broad conclusions about the value of surveys in litigation without considering how the survey came to be in the first place.

All of this, however, is fodder for future inquiry. For now, this article provides a very helpful reminder to all scholars embarking on empirical projects that when we focus only on published opinions, we can only say so much about the world.

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