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# Survey Evidence in Trademark Actions

Ioana Vasiu and Lucian Vasiu

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*Ioana Vasiu* and Lucian Vasiu*



ABSTRACT

Properly formulated and executed surveys are widely accepted in trademark actions. This article aims to improve the empirical understanding of how courts consider surveys in trademark actions. The findings are based on the study of over 250 court cases brought from the United States, Canada, and Singapore which draws upon the content analysis method to identify the most important aspects and arguments. The article analyzes validation of experts' qualifications; universe selection; survey methodology; admissibility of survey evidence; and weight of survey evidence. The findings show both similarities and differences across the jurisdictions considered. The study offers important insights, which can strengthen courts' analysis, stimulate transnational judicial research and dialogue, and lead to improvements to the current approaches.

**Keywords:** Trademark; Survey; Probative Evidence.

## I. Introduction

Trademarks facilitate the identification of a product's source and characteristics, allowing consumers to identify and select the specific product they want, and enabling producers (and sellers) to reap the benefit of a product's reputation. As such, "trademarks protect the value of companies and can result in higher growth and marketing

* Corresponding author: Professor, Faculty of Law, Babeş-Bolyai University. *E-mail*: ioana.vasiu@law.ubbcluj.ro.

activity."[1] Consequently, trademarks play a significant role in national and international commerce and business. The considerable number of trademark registrations worldwide,[2] and the vast amounts invested by their owners in advertising and promotions,[3] strongly underscore that.

The basic rationale for trademark protections is that they incentivize investment in the development of high-quality products.[4] Trademark infringements, however, are encountered worldwide, on a large scale.[5] In trademark actions, the question is usually "whether the defendant's use of a mark is 'likely to cause confusion, or to cause mistake, or to deceive.'"[6]

Surveys are instruments used to gather data on the beliefs and attitudes of consumers. In trademark actions, surveys can provide "a snapshot of how consumers perceive the trademark at issue at the time the survey is conducted,"[7] and, as such, help ensure that the courts make decisions "based on empirical facts."[8]

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1. Emin Dinlersoz, et al., *On The Role of Trademarks: From Micro Evidence to Macro Outcomes*, Center for Economic Studies, U.S. Census Bureau, Working Papers 23-16 (2023).

2. *See* Einar H. Dyvik, *Number of trademark applications worldwide from* 1990 *to* 2022, Statista (Dec. 20, 2023), https://www.statista.com/statistics/257628/number-of-trademark-applications-worldwide/ (in 2022 15.5 million trademark applications were filed worldwide); United States Patent and Trademark Office (USPTO), *Trademarks Data Q*4 2023 at a glance (2023), https://www.uspto.gov/dashboard/trademarks/ (in 2023, over 737,000 trademark applications were registered); European Union Intellectual Property Office, *EUIPO Statistics for European Union Trade Marks:* 1996-01 *to* 2024-01 *Evolution* (2023), https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf (in 2022, 174,180 applications were filed); Canadian Intellectual Property Office, *IP Canada Report* 2021 (2023) at 16, https://ised-isde.canada.ca/site/canadian-intellectual-property-office/sites/default/files/attachments/2023/CIPOCS-2004-IP_Canada_report_2021-eng_0.pdf (in 2020, there were 69,793 trademark applications filed); *See also* Einar H. Dyvik, *Ranking of the* 20 *countries with the most trademark registrations class counts in* 2022, Statista Research (Dec. 11, 2023), https://www.statista.com/statistics/257389/ranking-of-the-20-countries-with-the-most-trademark-registrations/.

3. *E.g., FCOA LLC v. Foremost Title & Escrow Services LLC*, 57 F.4th 939, 943 (11th Cir., 2023); *Toyota Motor Sales, USA, Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010); *Volkswagen Grp. of Am., Inc. v. Varona*, No. 19-24838-CIV-GOODMAN, at *8 (S.D. Fla., 2021); 3*M Co. v. CovCare, Inc.*, 537 F. Supp. 3d 385, 402 (E.D.N.Y., 2021).

4. Davidson Heath & Christopher Mace, *The Strategic Effects of Trademark Protection*, 33 Rev. of Fin. Stud. 1848, 1848 (2020); Shayerah Ilias Akhtar & Ian F. Fergusson, Cong. Rsch. Serv., RL34292, Intellectual Property Rights and International Trade (2014).

5. Ioana Vasiu & Lucian Vasiu, *A Framework for Improved Protection of Trademarks*, 28 J. L. Bus. & Ethics 18, 25-41 (2022) (discussing categories of trademark infringements).

6. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 165 (2023).

7. Jake Linford & Kyra Nelson, *Trademark Fame and Corpus Linguistics*, 45 Colum. J.L. & Arts 171, 226 (2021).

8. Shari Seidman Diamond & David J. Franklyn, *Trademark Surveys: An Undulating Path*, 92 Tex. L. Rev. 2029, 2029 (2013).

Surveys employ probability to provide generalized results or predictions for the population of interest.[9] In trademark infringement claims, courts are required to determine whether the *typical consumers* are *likely* to be confused, not whether any or all consumers are likely to be confused.[10] While the absence of survey evidence does not necessarily weigh against parties, surveys can provide valuable evidence with respect to likelihood of confusion,[11] secondary meaning,[12] or genericness.[13] Moreover, survey evidence that is "exceptionally strong" can demonstrate trademark infringement even when other factors, usually considered by courts, are not present.[14] Nevertheless, surveys are susceptible to a variety of potential errors, such as design or sampling issues.[15]

Disputes over the use of surveys are often encountered in practice; for example, regarding the methodology used.[16] Survey evidence is often construed as "a controversial form of proof" in trademark actions, as it is prone to errors, vulnerable to manipulations,[17] and potentially a mere "transparent path[] to a desired but artificial result,"[18] designed to produce a predetermined outcome. Further, surveys have been viewed as tending to "elide complex normative and empirical questions that underlie trademark law and policy,"[19] and difficult to design, as

9. *See,* Remus Ilies, et al., *Reported Incidence Rates of Work-Related Sexual Harassment in the United States: Using Meta-Analysis to Explain Reported Rate Disparities*, 56 PERS. PSYCH. 607 (2003).

10. *E.g.,* Shashank Upadhye, *Trademark Surveys: Identifying the Relevant Universe of Confused Consumers*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 549, 567 (1997); LOIS SPORTSWEAR, USA, INC. V. LEVI STRAUSS & CO., 799 F.2D 867, 871 (2D CIR. 1986).

11. *See, e.g., Chanel, Inc. v. WGACA, LLC*, No. 18 Civ. 2253 (LLS), at *21 (S.D.N.Y. Mar. 28, 2022) (Chanel presented two surveys that assessed the level of confusion); *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 452 F. Supp. 2d 772, 778 (W.D. Mich. 2006) (surveys "may provide strong evidence on issues of secondary meaning and likelihood of consumer confusion."); *Simon Prop. Grp. L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1038 (S.D. Ind. 2000) ("Consumer surveys are generally accepted by courts as one means of showing the likelihood of consumer confusion.").

12. *See*, e.g., *LVL XIII Brands v. Louis Vuitton Malletier SA*, 209 F. Supp. 3d 612, 638 (S.D.N.Y. 2016) ("courts have long held that consumer surveys are the most persuasive evidence of secondary meaning").

13. *See Gruyere v. U.S. Dairy Export Council*, 61 F.4th 407, 425 (4th Cir. 2023) (surveys are "almost de rigueur" in litigations over genericness); *vonRosenberg v. Lawrence*, 413 F. Supp. 3d 437, 444-49 (D.S.C. 2019) (analysis of expert genericness report).

14. *GMC v. Lanard Toys, Inc.*, 468 F.3d 405, 420 (6th Cir. 2006).

15. Michael J. Stern, et al., *The State of Survey Methodology: Challenges, Dilemmas, and New Frontiers in the Era of the Tailored Design*, 26 FIELD METHODS 284, 285 (2014).

16. *See, e.g., Bush v. Rust-Oleum Corp.*, No. 20-cv-03268-LB (N.D. Cal. Feb. 8, 2024); *Pennsylvania State University v. Vintage Brand, LLC*, No. 4: 21-CV-01091 (M.D. Pa. Feb. 6, 2024); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025 (9th Cir. 2010); *Frehling Enter. v. Int'l Select Grp.*, 192 F.3d 1330 (11th Cir. 1999).

17. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 224 (2d Cir. 1999).

18. *Simon Prop. Grp. L.P.*, 104 F. Supp. 2d at 1052.

19. Barton Beebe, et al., *Consumer Uncertainty in Trademark Law: An Experimental Investigation*, 72 EMORY L. J. 489, 493 (2023).

"consumer beliefs are not binary but held at varying levels of strength and meaningfulness."[20]

Survey evidence presents numerous potential theoretical and practical problems. Moreover, survey's conclusion or results do not, by themselves, constitute legal conclusions with respect to the inquiry at hand. However, survey evidence derived through an adequate scientific methodology can constitute probative evidence in trademark actions.

Analysis of the use of survey evidence in trademark actions can be found in several academic articles, focused on various aspects.[21] This article aims to improve the empirical understanding of how courts consider surveys in trademark actions. The article aims to analyze the admissibility of expert evidence, universe selection, survey methodology, admissibility of survey evidence, and the weight given to survey evidence.

The findings are based on the study of over 250 cases brought to courts from the United States (U.S.), Canada, and Singapore. The study draws upon the content analysis method to identify important aspects and arguments. From these cases, 85 highly relevant are referenced in this study: 72 from the U.S., 7 from Canada, and 6 from Singapore.

## II. Survey Evidence

### A. *Legal Standard*

Initially, consumer surveys were regarded as untrustworthy, as they contained "hearsay, or out-of-court statements offered to prove the

20. *Id*. at 493.

21. *See* Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581, 1582 (2006) (discussing survey evidence in trademark trials); 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, 1015-16 (2012) (presenting an empirical study investigating the role of consumer surveys in federal courts by examining more than five hundred court opinions over a seven-year period); Katie Brown, Natasha T. Brison & Paul Batista, *An Empirical Examination of Consumer Survey Use in Trademark Litigation*, 39 Loy. L.A. Ent. L. Rev. 237 (2019) (provides a comprehensive examination of survey use in trademark actions); Robert H. Thornburg, *Trademark Survey Evidence: Review of Current Trends in the Ninth Circuit*, 21 Santa Clara High Tech. L.J. 715 (2004) (discussing aspects regarding the admission of surveys in the Ninth Circuit); Michael J. Borger, *Diamonds in the Rough: A Review of Tiffany v. Costco and a Call to Apply Daubert to the Admissibility of Consumer Survey Evidence in Trademark Infringement Litigation*, 34 Touro L. Rev. 431 (2018) (arguing the implementation and evaluation of the standards set forth in *Daubert*); Joseph L. Gastwirth, *Issues Arising in Using Samples as Evidence in Trademark Cases*, 113 J. Econometrics 69 (2003) (reviewing the use of survey evidence in cases involving alleged infringement of trademarks); Lawrence E. Evans, Jr. & David M. Gunn, *Trademark Survey Evidence*, 20 Tex. Tech L. Rev. 1, 2-3 (1989) (discussing important aspects regarding survey evidence), Shashank Upadhye, *Trademark Surveys: Identifying the Relevant Universe of Confused Consumers*, 8 Fordham Intell. Prop. Media & Ent. L.J. 549 (1997) (discussing aspects regarding the relevant universe in trademark surveys).

truth of the matters asserted."[22] Nowadays, however, surveys, when properly formulated and executed, are widely accepted in trademark actions,[23] and regarded as capable of providing compelling evidence. In fact, survey use is "more frequent[] in trademark law cases than in other areas of law."[24] Courts, however, usually consider this kind of evidence very carefully. To be admissible, expert reports must include clear details regarding: the surveyor's qualifications; survey purpose and universe definition; methodology details, such as questions asked, and instructions given to respondents; and the full results and statistical analysis.[25]

**U.S.**

In the U.S., survey evidence is considered relevant if it "has any tendency to make a fact more or less probable than it would be without the evidence" and "the fact is of consequence in determining the action."[26] According to the Manual for Complex Litigation, the relevant factors pertaining to survey admissibility are: the properly chosen and defined population; the drawing of a representative sample from that population; the accurate reporting of the data gathered; and the analysis of data in observance of the statistical principles.[27]

Surveys are generally accepted by the U.S. courts, nevertheless, the Eleventh Circuit Court is reluctant to use such evidence, and has held either that it "has moved away from relying on survey evidence,"[28] or gives survey evidence "slight weight," views it "unfavorably,"[29] or with "a skeptical eye."[30] According to the U.S Supreme Court, courts are required to "treat the results of surveys with particular caution. . . . Like any other evidence, surveys should be understood as merely one piece of the multifaceted likelihood of confusion analysis."[31]

Expert testimonies must comply with the U.S. Federal Rules of Evidence. For example, Rule 702 requires sufficient facts or data and the use of reliable principles and methods[32], and Rule 403 allows the

22. *Schering Corp. v. Pfizer, Inc.*, 189 F.3d 218, 224 (2d Cir. 1999) ("In the first half of this century, surveys were generally regarded as inherently untrustworthy because they contained hearsay, or out-of-court statements offered to prove the truth of the matters asserted.").

23. *See Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 919–20 (E.D. Va. 2017); *In-N-Out Burgers v. Doll N Burgers*, No. 20-11911 (E.D. Mich. Mar. 14, 2022); *Leelanau Wine Cellars, Ltd,* 452 F. Supp. 2d at 772.

24. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 525 F. Supp. 2d 558, 562 (2007).

25. *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd*. [2015] SGHC 39 at ¶ 30 (Sing.).

26. Fed. R. Evid. 401 (a) and (b).

27. Manual for Complex Litigation (Fourth) § 11.493 (2004).

28. *Frehling Enter.,* 192 F.3d 1330, 1341 1342 n.5 (11th Cir. 1999).

29. *FCOA LLC* 57 F.4th 939, 956.

30. *Wreal, LLC v. Amazon.com, Inc.*, 38 F.4th 114, 140 (11th Cir. 2022).

31. *Jack Daniel's Props., Inc.* 599 U.S. at 180 (Sotomayor, J., concurring).

32. Fed. R. Evid. 702.

exclusion of evidence "if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence."[33]

**Canada**

In Canada, surveys have "the potential to provide empirical evidence" in trademark actions, however, such evidence "should still be applied with caution."[34] Moreover, survey evidence can be excluded if the probative value presented is overborne by its prejudicial effect.[35]

Qualified expert-conducted surveys are admitted provided that their "findings are relevant to the issues and the survey was properly designed and conducted in an impartial manner."[36] Therefore, courts "must fulfil their gatekeeper role to ensure that unnecessary, irrelevant, and potentially distracting expert and survey evidence is not allowed to extend and complicate court proceedings."[37]

Survey evidence is rejected where it distorts the facts-finding process. Rule 279 of the Canadian Federal Court Rules govern the admissibility of expert evidence.[38] Expert evidence is admissible only if it meets the following criteria: relevance; necessity in assisting the trier of fact; absence of any exclusionary rule; and a properly qualified expert.[39] The Canadian Supreme Court divided the question of relevance into two sub-issues: survey must be found "both reliable (in the sense that if the survey were repeated it would likely produce the same results) and valid (in the sense that the right questions have been put to the right pool of respondents in the right way, in the right circumstances to provide the information sought)."[40] Rule 52.5(1) of the Canadian Federal Court Rules allows objections to an opposing party's proposed expert witness "that could disqualify the witness from testifying."[41]

**Singapore**

In Singapore, survey evidence is generally accepted,[42] however, the Singapore Court of Appeal held that survey evidence should not be

33. Fed. R. Evid. 403.

34. *Masterpiece, Inc. v Alavida Lifestyles, Inc. et al.*, (2011), 92 CPR (4th) 361 (SCC) at ¶ 93 (Can.).

35. *R. v. Mohan*, [1994] 2 S.C.R. 9 (Can.)

36. *Mattel, Inc. v.* 3894207 *Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772 at ¶ 43 (Can.).

37. *Masterpiece, Inc.*, 92 CPR (4th) 361 (SCC) at ¶ 76 (Can.).

38. *See RE/MAX, LLC v. Save Max Real Estate Inc.*, 2022 FC 1287 at ¶¶ 8-10 (Can.).

39. *R.,* [1994] 2 S.C.R. 9 (Can.).

40. *Mattel, Inc.*, 1 S.C.R. 772 at ¶ 45 (Can.).

41. Federal Court Rules, SOR/98-106, 52.5 (Can.).

42. *Han's (F & B) Pte, Ltd* [2015] SGHC 39 at ¶ 28 ("survey evidence. . . has become relatively commonplace. In trademark actions, this often takes the form of survey evidence.").

conclusive, rather just one factor in the global analysis.[43] The High Court of Singapore also held that surveys present problems regarding their "probative value."[44] "Expert" is defined as "a person with such scientific, technical or other specialized knowledge based on training, study or experience."[45] The expert testimony must comply with the Singaporean Rules of Court.[46]

Regarding the evaluation of survey evidence, the Intellectual Property Office of Singapore proposes several factors: the ways in which the respondents were selected; the number of surveyed respondents; the survey questions; the representation in survey of the trademark involved; the exact answers from respondents; the location, date, and exact instructions given to survey respondents; and aspects related to the "relevant public".[47]

### B. *Expert Validation*

In Canada, the criteria for expert validation is broad: the statement of expert witnesses must "set out the expert's qualifications and the areas in respect of which it is proposed that he or she be qualified as an expert."[48] Objections to opposing party's experts can be raised to disqualify them.[49] In *Remo Imports v. Jaguar Canada*, for example, the expert was considered qualified based on her experience in "marketing and consumer behaviour research and analysis, particularly surveys in issues relating to trademarks."[50]

In Singapore, "expert" is defined as "a person with scientific, technical or other specialised knowledge based on training, study or experience."[51] Courts can "disallow the use of or reject any expert evidence if it is of the opinion that the expert lacks the requisite specialised knowledge in the issues referred to him or her."[52] In *Han's v Gusttimo World*, for instance, the expert, "a director at the marketing branch of

43. *Sarika Connoisseur Cafe Pte, Ltd v. Ferrero SpA* [2012] SGCA 56 at ¶ 64.

44. *Doctor's Associates, Inc. v. Lim Eng Wah* (trading as SUBWAY NICHE) [2012] SGHC 84 at ¶ 50.

45. Evidence Act 1893 § 47 (2) (Sing.), https://sso.agc.gov.sg/Act/EA1893.

46. R. of Ct. [Supreme Court of Judicature Act] Ord. 12 (Sing.) (2021), https://sso.agc.gov.sg/SL-Supp/S914-2021/.

47. Intellectual Property Office of Singapore, *Evidence of distinctiveness acquired through use* (November 2022) at 14-8, https://www.ipos.gov.sg/docs/default-source/resources-library/trademarks/infopacks/6-evidence-of-use-(nov-2022).pdf.

48. Fed. Ct. Rules, SOR/98-106, § 52.2(1)(b) (Can.).

49. *Id.*

50. *Remo Imports Ltd. v. Jaguar Canada Ltd.*, 2006 FC 21 at ¶ 60 (Can.).

51. R. of Ct. (2021), Ord. 12, r. 1 (Sing.) https://sso.agc.gov.sg/SL-Supp/S914-2021/.

52. *Id.* at r. 2(4).

. . .a French advertising research firm," was accepted by the High Court of Singapore.[53]

In the U.S., the validation of experts is more complex matter, governed by Rule 702, which stipulates that:

> A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:
>
> (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;
> (b) the testimony is based on sufficient facts or data;
> (c) the testimony is the product of reliable principles and methods; and
> (d) the expert has reliably applied the principles and methods to the facts of the case.[54]

While the exclusion of survey evidence can be encountered in U.S. cases (for instance where the persons conducting the survey are deemed unqualified to testify, where the flaws are constructed as major, "serious and pervasive,"[55] or the cumulative nature of the deficiencies negatively assists the trier of fact) the exclusion of expert testimony is the exception, rather than the rule. Nonetheless, there are cases where exclusions were requested based on Rule 702.[56]

In *Valador v. HTC*, the U.S. District Court for the Eastern District of Virginia, Alexandria Division, granted the motion to exclude the expert testimony as the purported expert was "not qualified to present his proffered opinions."[57] The court concluded the expert had no prior experience with respect to conducting surveys concerning the determination of the likelihood of confusion in trademark claims; never previously testimony as an expert or work for anyone testifying as an expert in a trademark dispute; and no publications on trademark surveys or trademark confusion.[58] The plaintiff argued that the proposed expert had "consulted with trademark attorneys on trademark compliance issues," prepared surveys used in litigation, and served as consulting expert in litigation.[59] These arguments were rejected by the court as irrelevant and insufficient; the court determined that the proposed expert "lacks

53. *Han's (F & B) Pte, Ltd.* [2015] SGHC 39 at ¶ 25 (Sing.).
54. Fed. R. Evid. 702.
55. 1-800 *Contacts, Inc. v. Lens.com, Inc*., 722 F.3d 1229, 1246 (10th Cir. 2013).
56. Fed. R. Evid. 702.
57. *Valador, Inc. v. HTC Corp.,* 242 F. Supp. 3d 448, 457 (E.D. Va. 2017).
58. *Id*. at 458.
59. *Id*.

the necessary experience with trademark infringement claims to pass muster under Rule 702," and granted the exclusion.[60]

In *Hi-Tech Pharmaceuticals v. Dynamic Sports Nutrition*, the defendants asked for the exclusion of plaintiff's evidence, arguing the person that conducted the survey is not "qualified to testify as an expert" and the survey was "fatally and fundamentally flawed."[61] The U.S. District Court for Northern District of Georgia, Atlanta Division, agreed that the standard for qualification to testify as an expert witness in trademark-related genericness and consumer confusion related surveys was not met, as the expert had no experience or training in the area; never designed or executed trademark-related surveys; never written about consumer confusion, consumer surveys, or any other trademark-related topic; and never served as an expert or testified regarding these topics prior to this matter.[62] Therefore, the court ruled that the testimony is not admissible under Rule 702, and granted the exclusion of the survey.[63]

### C. *Survey Universe*

Various cases use expressions such as "typical consumer,"[64] "affluent consumer,"[65] "average consumer;"[66] "ordinary consumer or reasonably prudent buyer."[67] The determination of the relevant consumer, however, is highly dependent on the characteristics of each case. Therefore, the definition of the appropriate universe representing the likely purchasers, depends heavily on the category of goods or services involved and the specific circumstances of the case at hand. In *Cheung's Bakery Products Ltd. v. Easywin*, for example, a case involving trademarks containing Chinese characters, the Federal Court of Canada defined the profile of the average consumer as "casual Canadian consumer who can read and understand Chinese characters, albeit with varying degrees of fluency," as these would be "the persons who are more likely than not to buy the goods or services in the Chinese-Canadian market in which the parties offer their bakery goods and services."[68]

Surveys must assess the average consumer of the category of goods or services involved. There is the assumption that consumers are well informed, observant, and circumspect. The universe definition is especially

60. *Id*. at 459.
61. *Hi-Tech Pharms. Inc. v. Dynamic Sports Nutrition, LLC,* No. 1: 16-cv-949-MLB, at *42.
62. *Id*. at *49.
63. *Id*. at *62.
64. *E.g., A&H Sportswear v. Victoria's Secret Stores, Inc.,* 237 F.3d 198, 198 (3d Cir. 2000).
65. *E.g., Frehling Enter.* 192 F.3d at 1334.
66. *E.g., Coty, Inc. v. Excell Brands, LLC*, 277 F. Supp. 3d 425, 443 (S.D.N.Y. 2017).
67. *E.g.,* Ford Motor Co. v. Summit Motor Prod., Inc., 930 F. 2d 277, 293 (3rd Cir. 1991).
68. *Cheung's Bakery Products Ltd. v. Easywin Ltd*. 2023 FC 190 at ¶ [53] (Can.).

important because it bears heavy weight on the probative value of the survey results. As outlined in *Easy Spirit v. Skechers*, "proper survey practices require including customers and prospective customers, not artificially restricting the population from which the survey sampled."[69]

The analysis of the universe selection topic reveals interesting arguments and issues.[70] Often, how the universe should be defined is debatable. The burden of demonstrating that the selected universe is proper for the case at issue bears on the survey proponent. The appropriate survey universe must include purchasers most likely to partake of the alleged goods or services.[71] In other words, the universe is "that segment of the population whose perceptions and state of mind are relevant to the issues in the case."[72] However, it is often unclear how these "idealized" groups of individuals should be defined, making the determination of the "appropriate universe" of respondents difficult.

The sophistication of potential buyers, as it influences the exercised degree of care, can also be a factor in determining the adequate survey universe. U.S. Courts generally consider the nature and price of the product or service for consumer sophistication determination.[73]

In *Easy Spirit v. Skechers*, for example, the survey targeted "people who had purchased in the last year, or were planning to purchase in the next year, women's clogs or open-back shoes." The U.S. Court for the Southern District of New York ("S.D.N.Y.") remarked that additional restrictions based on based on gender or age, "would be empirically inappropriate."[74] In *Capri Sun v. American Beverage*, the plaintiff argued that the survey presented by the defendant is both over-inclusive by including past purchasers, and underinclusive, as it did not consider "future potential consumers who are indifferent to their packaging when they buy single-serve juice drinks and . . . children and retailers."[75] The S.D.N.Y. Court, however, rejected these arguments.[76] Courts frequently admit consumer confusion studies where the universe includes past purchasers, as well as potential future purchasers.[77] Nevertheless, the universe encompasses "only the potential buyers of the

69. *Easy Spirit, LLC v. Skechers USA, INC*., 571 F. Supp. 3d 185, 208 (S.D.N.Y. 2021).

70. *See*, e.g., *Adidas America, Inc. v. Skechers USA, Inc*., No. 3:15-cv-01741-HZ, (D. Or. Aug. 3, 2017); D.*H. Pace Co., Inc. v. Aaron Overhead Door Atlanta*, 526 F. Supp. 3d 1360, 1376 (N.D. Ga. 2021) (regarding over-inclusive universes); *Winning Ways, Inc. v. Holloway Sportswear, Inc*., 913 F. Supp. 1454, 1467(D. Kan. 1996) (regarding an under-inclusive universe).

71. *Amstar Corp. v. Domino's Pizza, Inc*., 615 F.2d 252, 264 (5th Cir. 1980); *Smith v. Wal-Mart Stores, Inc*., 537 F. Supp. 2d 1302, 1325 (N.D. Ga. 2008).

72. *D.H. Pace Co., Inc.*, 526 F. Supp. 3d at 1375.

73. *Gibson v. SCE Group, Inc*., 391 F. Supp. 3d 228, 249 (S.D.N.Y. 2019).

74. *Easy Spirit, LLC*., 571 F. Supp. 3d at 208.

75. *Capri Sun GMBH v. American Beverage Corp*., 595 F. Supp. 3d 83, 123 (S.D.N.Y. 2022).

76. *Id*. at 124-5.

77. *Id*.

products at issue," and, regarding retailers, "the Second Circuit has instructed that they 'are assumed to be more sophisticated buyers and thus less prone to confusion.'"[78] Therefore, the court concluded that the universe examined was adequate, with the representative sample adequately drawn.[79]

On the other hand, whether the case involves unusual or expensive products is unquestionably, significantly different, and requires discriminating purchasers; for example, computer software targets "large, sophisticated commercial enterprises,"[80] or "grab off the shelf" products.[81] The former involves sophisticated purchasers and "careful customer decision making,"[82] whereas, in a cases involving companies in the business of bottled pickles and related products, the "average customer" was construed by the U.S. District Court of the Northern District of Illinois as undergoing, "while in a supermarket, an experience not unlike that of hypnosis."[83]

Courts scrutinize proposed universes very carefully. In *Universal City Studios v. Nintendo*,[84] the U.S. Court of Appeals for the Second Circuit, in a likelihood of consumer confusion action, held that the survey was rejected as "badly flawed" because, *inter alia*, the survey universe was improperly defined, as it included individuals who had already purchased or leased the machines involved in the case, "rather than those who were contemplating a purchase or lease." In *Citizens Fin. v. Citizens Nat. Bank of Evans City*, for an example of reverse confusion action, the Third Circuit Court of Appeals disagreed with the arguments that "the universe at issue consisted of potential customers of both parties," and that the survey "universe" should include a certain county, as the "scope, media type, volume, and frequency" of the relevant marketing presence focused on a different county.[85]

Special products like premium or limited production wine, can require complex analysis on universe selection. In *Leelanau Wine Cellars v. Black & Red*, the survey universe was defined "as Michigan consumers over 21 years of age who had either purchased a bottle of wine in the $5 to $14 price range in the last three months or who expected to purchase a bottle of wine in that price range in the three months following the interview."[86] The U.S. District Court for the Western District of

78. *Id*.
79. *Id*. at 125.
80. *Ironhawk Technologies, Inc. v. Dropbox, Inc*., 994 F.3d 1107, 1126 (9th Cir. 2021).
81. *Bristol-Myers Squibb Co. v. McNeil-PPC, Inc.,* 786 F. Supp. 182, 211 (E.D.N.Y. 1992).
82. Ironhawk Technologies, Inc. 994 F.3d at 1127.
83. *Pikle-Rite Co. v. Chicago Pickle Co*., 171 F. Supp. 671, 676 (N.D. Ill. 1959).
84. *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F.2d 112, 118 (2d Cir. 1984).
85. *Citizens Fin. v. Citizens Nat. Bank of Evans City*, 383 F.3d 110, 119 (3d Cir. 2004).
86. *Leelanau Wine Cellars, Ltd*., 452 F. Supp. 2d at 782.

Michigan, Southern Division, held that the survey universe was substantially over-broad by including people "who are not potential consumers participants" as the consumers that purchase wine only at grocery or retail stores, with no intention to visit and/or is unaware of the defendants' tasting rooms, cannot be considered potential purchasers of the defendants' wine.[87]

In another case involving the likelihood of confusion, the distributor of the Dom Perignon champagne sued Dom Popingnon, maker of a popcorn product.[88] The plaintiffs identified the universe as "persons between the legal drinking age and the age of 64."[89] The S.D.N.Y., however, found that the universe was too broad, concluding that "the mere fact that interviewees had reached the drinking age rendered them the equivalent of potential customers for DOM PERIGNON . . . [a] better definition of the universe in this case would have been that group of consumers who were in the market for DOM PERIGNON, or at least for champagne."[90]

### D. *Survey Methodology*

Survey results are fundamentally contingent on the universe definition, methodology, and sample selection. Even though there are numerous cases where these were flagged, survey methodological errors are still often encountered. Depending on the methodology selected and implemented, surveys can produce significantly different results. For instance, there is an inherent weakness or deficiency of the surveys conducted over the telephone,[91] "as there is no empirical verification of the age, gender, or other characteristics of the respondents,"[92] and "allows [for] no visual inspection of the trademarks at issue, nor is it conducted in circumstances which replicate those of actual marketing conditions."[93]

Further, surveys designed to measure consumer's confusion with respect to source, affiliation, association, or permission, "may also inadvertently include the perceptions of respondents that are unrelated

87. *Id*. at 783.
88. *Schieffelin & Co. v. Jack Co. of Boca, Inc*., 850 F.Supp. 232 (S.D.N.Y. 1994).
89. *Id*. at 246.
90. *Id*.
91. *Han's (F & B) Pte, Ltd.* [2015] SGHC 39 at ¶ 165 (Sing.) (holding that it was a survey deficiency that the survey was conducted over the telephone, as "no visual or conceptual representation" were given to the respondents).
92. *Remo Imports Ltd.,*2006 FC 21 at ¶ 78 (Can.).
93. *Charles Schwab & Co., Inc. v. Hibernia Bank*, 665 F. Supp. 800, 807 (N.D. Cal. 1987).

to the specific stimuli being tested."[94] Therefore, the survey designs and methodology must be very carefully formulated to avoid unrealistic marketplace assumptions,[95] and include properly designed control groups.[96]

The selection and the number of survey respondents is also of utmost importance. The expert reports must include clear explanations of how the samples were designed and selected. The samples must be selected randomly and be indicative of the entire relevant cross-section of consumers.[97] Only if the sample is correctly selected and sufficiently large, can the results be considered representative of the survey universe and, therefore, capable of producing statistically valid results.[98] The importance of these aspects is further emphasized by the fact that the threshold for survey evidence, for instance, in demonstrating consumer confusion, can be as low as 10%.[99]

In the U.S. Fifth Circuit, it was held that "the first factor to be considered in evaluating the validity of a survey is the format of the questioning."[100] In the U.S., there are numerous survey formats that courts find acceptable in trademark actions, such as the Teflon, the Exxon, the Eveready, or the Squirt Format.[101] Nonetheless, no format or model can be regarded as without flaws, mandatory, "best suitable," or "beyond criticism" for a particular case.[102] Surveys, instead, must try to replicate the thought processes of consumers encountering the disputed mark or marks as they would in the marketplace.[103]

Survey questions "must not lead the interviewee into a field of speculation upon which he would not otherwise have embarked."[104] Questionnaires must be clearly formulated, avoiding vague or difficult words. Further, questions that are leading (suggesting their own answers, even

94. *Storage Cap Management LP v. Sparespace Storage, LLC*, No. 2: 19-cv-4328, at *18 (S.D. Ohio Oct. 7, 2022).

95. *Bluetooth Sig, Inc. v. FCA US LLC*, 468 F. Supp. 3d 1342, 1347 (W.D. Wash. 2020).

96. *See, e.g.*, *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.,* 618 F.3d 1025 (9th Cir. 2010); *see also Billfloat Inc. v. Collins Cash Inc.*, No. 20-cv-09325-EMC, at *6 (N.D. Cal. Mar. 1, 2023) (failure to use a control group).

97. *Avela, Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 326 (S.D.N.Y. 2019) (small survey sample size, which may render the survey unreliable).

98. *Aegis Software, Inc. v.* 22*nd Dist. Agricultural Assoc.*, 255 F. Supp. 3d 1005, 1010 (S.D. Cal. 2017) (small sample sizes are not very persuasive).

99. *RxD Media, LLC v. IP Application Dev. LLC*, 986 F.3d 361, 373 (4th Cir. 2021).

100. *Exxon Corp. v. Texas Motor Exchange of Houston, Inc.*, 628 F.2d 500, 506 (5th Cir. 1980).

101. Beebe, *supra* note 19; Brown, *supra* note 21 at 249; Evans & Gunn, *supra* note 21, at 18-36.

102. *Simon Prop. Grp. LP*, 104 F. Supp. 2d at 1038.

103. *Id*.

104. *Han's (F & B) Pte, Ltd.* [2015] SGHC 39 at ¶ 170.

in a subtle or inadvertent way),[105] close-ended (which can create bias),[106] double-barreled, word-association,[107] ambiguous or confusing[108] must also be avoided, as such occurrences will negatively affect the weight of the evidence.[109] For instance, ambiguous questions can lead respondents to interpret the questions at hand differently than designed and, consequently, answer a virtually different question than originally intended.

The importance placed by courts on the formulation of questions was made in several cases. In *Han's (F & B) Pte Ltd v Gusttimo World Pte*, the High Court of Singapore pointed out that the survey questions did not include an apostrophe in the spelling of the trademark (i.e., Han's), simply asking if "'H-A-N-S' sounded similar to 'H-A-N'").[110] The court stated that the "omission of the apostrophe is a crucial one, because . . . it changes the entire complexion of the word and the context in which it is used [and, as such,] may have altered the results of the survey."[111]

In certain cases, options such as "don't know" and instructions "not to guess" are considered as flaws by courts.[112] The U.S. Supreme Court concluded if the alleged infringement involves a parody, there is the "risk in giving uncritical or undue weight to surveys," as the survey answers "may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark."[113] Further, the U.S. Supreme Court observes that "cleverly designed surveys could also prompt such confusion by making consumers think about complex legal questions around permission that would not have arisen organically out in the world."[114]

As outlined by the Federal Court of Canada, to have probative value, surveys "cannot take place in a vacuum [and it] is not sufficient to ask abstract questions without revealing the concrete context underlying the issues."[115] Moreover, surveys are subject to sampling and other

105. *See*, *e.g.*, *Universal City Studios, Inc.*, 746 F.2d at 118.("survey question which begs its answer cannot be a true indicator of the likelihood of consumer confusion").

106. *See, e.g.*, *Simpson Strong-Tie Co. v. Mitek Inc.*, No. 20-VC-06957-VKD, at *5 (N.D. Cal. Jan. 9, 2023) (survey used close-ended questions, containing suggestions for the respondents).

107. *Holiday Inns, Inc. v. Holiday Out in America*, 481 F.2d 445, 448 (5th Cir. 1973) ("survey degenerated into a mere word-association test entitled to little weight because the format failed to account for the number of responses attributable to use of the word "Holiday").

108. *Mitcheson v. El Antro LLC*, No. CV-19-01598-PHX-GMS, at *5 (D. Ariz. Dec. 3, 2020) (the defendant challenged the survey questions as "confusing or misleading").

109. *Procter & Gamble Co. v. Ultreo, Inc.*, 574 F. Supp. 2d 339, 352 (S.D.N.Y. 2008) (surveys are not credible if they rely on "leading questions which are inherently suggestive and invite guessing by those who did not get any clear message at all.").

110. *Han's (F & B) Pte, Ltd.* [2015] SGHC 39 at ¶ 166.

111. *Id*.

112. *See, e.g.*, *Souza v. Exotic Island Enterprises, Inc.*, 68 F.4th 99, 114(2d Cir. 2023).

113. *Jack Daniel's Prop., Inc.,* v. VIP Products LLC, 599 U.S. at 181 (Sotomayor, J., concurring).

114. *Id*.

115. *Mattel Inc. v.* 3894207 *Canada Inc. et al,* 2004 FC 361 at ¶ 33 (Can.).

sources of errors. For instance, evidence that is construed as old, such as years-old surveys, are subject to reevaluation to determine whether they are still relevant.[116] Consequently, surveyors must consider "coverage errors, non-response errors; measurement errors (for instance, inaccurate or incomplete answers); and coding or processing errors.[117] Therefore, for trial admission, while there is no "perfect" methodology, the results must be reliable and fit well the case.

### E. *Admissibility Analysis*

To determine the admissibility of surveys, courts examine several aspects, including: the consideration of the proper universe; the drawing of a representative sample; the survey methodology and execution; the accuracy of the data reported; and the approximation of marketplace conditions.[118]

In the U.S., the party submitting the evidence must prove that it is relevant and dependable to the issue at hand. Courts review the admissibility of expert evidence under the U.S Supreme Court's *Daubert* framework.[119] Surveys can be excluded if they do not meet the *Daubert* relevancy and reliability standards.

In practice, surveys often present flaws or limitations, therefore raising issues and arguments over their admissibility. There is a notable dispute over the treatment of methodological errors or flaws in surveys.[120] Arguments over aspects regarding the methodology, the selection of relevant consumer, or the marketplace replication, however, do not necessarily render the results unreliable to the point of being inadmissible.

Some courts hold that methodological errors must be construed as grounds for exclusion, while other courts treat them as "affecting only the weight of the evidence."[121] Most courts, however, consider survey issues in connection with the weight, rather than admissibility;[122] methodology objections usually are considered "insufficient grounds" to find

116. *See Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1121 (Fed. Cir. 2018) ("survey results were probative, at best, of the public's perception five years after the survey was conducted.").

117. Michael J. Stern, et al., *The State of Survey Methodology: Challenges, Dilemmas, and New Frontiers in the Era of the Tailored Design*, 3 FIELD METHODS 284, 285 (2014).

118. *See Louis Vuitton Malletier*, 525 F. Supp. 2d at 580-81; *Leelanau Wine Cellars, Ltd*,452 F. Supp. 2d at 778; Thoip v. Walt Disney Co., 690 F. Supp. 2d 218, 230 (S.D.N.Y. 2010); Simon Prop. Grp. LP, 104 F. Supp. 2d at 1038.

119. *Daubert v. Merrell Dow Pharms., Inc*., 509 U.S. 579, 592-98 (1993).

120. *Schering Corp.,*189 F.3d at 225-6.

121. *Id*. at 226.

122. *See, e.g*., *E. & J. Gallo Winery v. Gallo Cattle Co*., 967 F.2d 1280, 1292 (9th Cir. 1992) ("any technical unreliability goes to weight, not admissibility."); *Leelanau Wine Cellars, Ltd.*,452 F. Supp. 2d at 778 ("almost all surveys are subject to some sort of criticism, courts generally hold that flaws in survey methodology go to the evidentiary weight of the survey rather than its admissibility.").

surveys inadmissible.[123] Consequently, it was held that disputes "over the parameters used in each survey are not an adequate basis to exclude the surveys and their results from the jury."[124]

Survey evidence is excluded where the proponents do not demonstrate proper conduct of the survey. According to the S.D.N.Y., while this would be the exception, there can be cases where "the proffered survey is so flawed as to be completely unhelpful to the trier of fact," with a probative value substantially "outweighed by its prejudicial effect."[125] Minor methodological flaws, on the other hand, do not affect the admissibility of surveys. This approach was clearly stated in numerous cases, holding that such surveys may still be construed as entitled to evidentiary weight. The review of cases in the U.S., shows that exclusions are encountered just in cases where errors are construed as serious to the point to render the survey unreliable or without probative value.[126]

A relevant analysis, in this regard, can be found in *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Management, Inc.*:[127] the district court excluded a survey on technical deficiencies, such as comparison of products side-by-side and failure to replicate "real world conditions." The U.S. Court of Appeals for the Ninth Circuit, acknowledged the shortcomings in the survey, but held that aspects regarding "issues of methodology, survey design, reliability, . . . [and] critique of conclusions," concern the survey weight, not its admissibility.[128]

Another relevant analysis was provided in *Tiffany and Co. v. Costco Wholesale Corp.*, where the defendant argued that survey evidence must be excluded as "it utilized false, built-in assumptions; . . . oversimplified, misleading and erroneous instructions; . . . contrived and artificial stimuli that either omitted context necessary for disambiguation or provided false and misleading 'context;' [and] was administered to the wrong subject population."[129] The S.D.N.Y., however, considered that "the flaws contained within the report went to the "weight, rather than the admissibility," of the survey.[130]

Similar to the objection that the surveys do not accord with accepted survey principles, in *Simpson Strong-Tie v. MiTek Inc.*, the U.S. District Court for the Northern District California, San Jose Division, held that the objections go to the weight, not admissibility of the survey

123. *Turf v. US Turf LLC*, No. 2: 21-CV-1749, at *3 JCM (DJA) (D. Nev. Sept. 29, 2023).

124. *Therapeutics MD, Inc. v. Evofem Biosciences, Inc.*, No. 20-CV-82296-RUIZREINHART (S.D. Fla. Mar. 30, 2022).

125. *Louis Vuitton Malletier*, 525 F. Supp. 2d at 563.

126. *See*, *e.g.*, *Thoip* 690 F. Supp. 2d at 218-19.

127. *Fortune Dynamic, Inc.*, 618 F.3d at 1037.

128. *Id*. at 1038.

129. *Tiffany and Co. v. Costco Wholesale Corp*., 127 F. Supp. 3d 241, 258 (S.D.N.Y. 2015).

130. *Id*. at 250-51.

evidence.[131] The court further found that, even where the survey universe was not well selected, the results can be probative of the intended proposition. For this reason, the courts "within the Ninth Circuit are largely unwilling to exclude survey evidence on the basis of an over-inclusive or under-inclusive target population."[132]

*Louis Vuitton Malletier SA v. Sunny Merchandise* provides another example where the defendants raised several objections to the survey introduced by the opponents, such as improper universe, too small sample sizes, non-replication of real-world conditions, and inadequate controls.[133] The S.D.N.Y., however, held that the wrong universe and small sample size limited the probative value - affecting the weight, not the admissibility.[134]

In *Firebirds International v. Firebird Restaurant Group*, the defendants also raised numerous objections to the survey presented, such as improper questions asked, affiliation suggestion, failure to accurately replicate market conditions and assumptions of consumer's knowledge.[135] After examining the objections, the U.S. District Court for the Northern District of Texas, Dallas Division, held that the survey is not "so badly flawed that it cannot be used to demonstrate the existence of a question of fact on the likelihood of consumer confusion," instead the methodological shortcomings "bear on its evidentiary weight, not its admissibility."[136]

In *Golo v. Goli Nutrition*, the plaintiff attacked the surveys presented, arguing that they considered an under-inclusive universe; inappropriately used an Eveready survey; presented the stimuli to the respondents in a manner biased in opponent's favor; used inadequate or no controls; used unambiguous and imprecise questions; and did not pretest either of the surveys.[137] The U.S. District Court for the District of Delaware "do not dismiss these surveys at this stage, but the criticisms by Plaintiff's expert give me enough pause that I do not rely upon them."[138]

Even when significant survey flaws or errors exist, and parties raise admissibility objections under Rule 403, courts tend to admit the flawed surveys. As a result, the weight of the survey is impaired and the court's analysis shifts from in-depth analysis to one based on cross-examination and survey weight consideration. In *Avela v. Estate of Marilyn Monroe*,

131. *Simpson Strong-Tie Co. v. MiTek Inc*., No. 20-cv-06957-VKD, at *9 (N.D. Cal. Jan. 9, 2023).
132. *Id*. at *10.
133. *Louis Vuitton Malletier SA v. Sunny Merchandise*, 97 F. Supp. 3d 485, 508 (S.D.N.Y. 2015).
134. *Id*. at 505.
135. *Firebirds Int'l, LLC v. Firebird Rest. Grp., LLC*, Civil Action No. 3: 17-CV-2719-B, at *7 (N.D. Tex. Aug. 21, 2019).
136. *Id*. at *6-7.
137. *Golo, LLC v. Goli Nutrition Inc.*, Civil Action No. 20-667-RGA, at *28 (D. Del. Sept. 1, 2020).
138. *Id*.

for instance, the plaintiffs challenging the survey presented on several aspects: the questions asked, the sample sizes, and the categorization of the respondents.[139] Even though the plaintiff held that such methodological errors make the report "more prejudicial than probative," and thus "inadmissible under Rule 403,"[140] the S.D.N.Y. disagreed reasoning that the exclusion arguments focus on disputes that are better addressed through cross-examination.[141]

Similarly in *Maui Jim v. SmartBuy Guru Enterprises*, the defendant attacked the survey on three aspects: the ambiguous use of the term "authorized retailer," the survey control method used, and the lack of realistic shopping conditions employed or the use a proper sample.[142] The defendant argued that these shortcomings could confuse the jury and therefore, must be construed as prejudicial under Rule 403.[143] However, the U.S. District Court for the Northern District of Illinois, Eastern Division held that the survey is not so unreliable as to be excluded, thus, the objections raised should be considered in relation with its weight, not admissibility.[144]

In *Fortune Dynamic v. Victoria's Secret Stores Brand Management*, the district court refused to admit a survey conducted by Howard Marylander, which showed that consumers were actually confused by Victoria's Secret's use of the word "Delicious" on its promotional tank top.[145] The court excluded the survey based on its side-by-side comparison of the products, failure to replicate real world conditions, improper screening of participants, and high suggestiveness.[146] The U.S. Court of Appeals for the Ninth Circuit, however, held that the district court abused its discretion in excluding the survey, as it was conducted in accordance with accepted principles, and offers relevant results for the examination.[147]

There are numerous instances where courts have found that surveys were faulty, and therefore excluded as prejudicial or non-probative (that is, unhelpful to the trier of fact). In *Thoip v. Walt Disney Co.*, the S.D.N.Y. held that because the Ford survey "failed to replicate actual marketplace conditions in which consumers encountered the products

139. *Avela, Inc. v. Estate of Marilyn Monroe, LLC*, 364 F. Supp. 3d 291, 326 (S.D.N.Y. 2019).
140. *Id*.
141. *Id*.
142. *Maui Jim, Inc. v. SmartBUY Guru Enterprises*, No. 1: 16 CV 9788, at *2 (N.D. Ill. Oct. 29, 2019).
143. *Id*. at 3.
144. *Id*. at 12.
145. *Fortune Dynamic, Inc.*., 618 F.3d at 1035.
146. *Id*. at 1037.
147. *Id*.

at issue here and failed to use an adequate control, it is not a reliable indicator of consumer confusion," and did not admit the survey.[148]

In another exemplary case, *Louis Vuitton Malletier v. Dooney & Bourke*, the S.D.N.Y. excluded two surveys.[149] One survey was excluded entirely under Federal Rules of Evidence 403 and 702, due to the cumulative effect of several flaws, such as improper stimulus, failure to instruct respondents against guessing, improper classification of respondents, and other significant methodological errors. The cumulative effect of these flaws "render the report and testimony unreliable, and any probative value is substantially outweighed by the danger of unfair prejudice and misleading the jury."[150] Another survey was excluded under Rule 702 on the basis of improper definition of its universe, inadequate coding and classification of several responses, inaccurate reporting, and "use of a survey question that asked respondents for a legal conclusion." [151] Consequently, the court excluded, in its entirety, the survey under Rules 702 and 403.[152]

Another illustrative analysis was provided by the U.S. District Court for the Western District of New York in *Saxon Glass Technologies, Inc. v. Apple Inc.*[153] Concerning one of the surveys presented by the plaintiff, the court held that it "failed to replicate marketplace conditions, asked leading questions, did not survey the relevant universe, failed to use an appropriate sample size, and failed to use a control."[154] The plaintiff argued that the survey was "qualitative," not "quantitative," however, the court rejected plaintiff's argument that a "qualitative" survey excuses methodological flaws.[155] The court stated that methodology is "meant to ensure that a survey's ultimate conclusions are reliable and therefore helpful to the trier of fact."[156] The court, citing admissibility rules, stressed that surveys not using an appropriate methodology are "essentially nothing more than a collection of hearsay, with no indicia of reliability."[157] The court further held that the survey flaws are so significant the survey must be construed as "unreliable and inadmissible."[158] Therefore, the court found that the survey presented in the case was

148. *Thoip,* 690 F. Supp. 2d at 241.
149. *Louis Vuitton Malletier*., 525 F. Supp. 2d at 22, 27.
150. *Id*. at 568-9.
151. *Id*. at 569-70.
152. *Id*. at 570.
153. *Saxon Glass Technologies, Inc. v. Apple Inc*., 393 F. Supp. 3d 270 (W.D.N.Y. 2019).
154. *Id*. at 286.
155. *Id*.
156. *Id*.
157. *Id*.
158. *Id*. at 287.

inadmissible under Rules 403 and 702.[159] In conclusion, survey problems may affect the weight of the evidence and it is up to the jury to ultimately judge a survey's merits; however, survey's presenting major issues cannot be admissible as trial evidence.

### F. *Survey Weight*

In Singapore, in determining the weight of the survey evidence, courts consider a complex framework, involving the following factors:

> (a) the interviewees in the survey must be selected so as to represent the relevant cross-section of the public;
> (b) the size of the survey must be statistically significant;
> (c) the survey must be conducted fairly;
> (d) all the surveys carried out must be disclosed, including the number of surveys carried out, how they were conducted and the totality of the persons involved;
> (e) the totality of the answers given must be disclosed and made available to the defendant;
> (f) the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put;
> (g) the exact answers and not some abbreviated form should be recorded;
> (h) the instructions to the interviewers as to how to carry out the survey must be disclosed; and
> (i) where the answers are coded for computer input, the coding instructions must be disclosed. [160]

Numerous cases illustrate how these factors are considered in practice when assessing the weight attributed to survey evidence. In *Ferrero v. Sarika Connoisseur Cafe*, the High Court of Singapore found that significant deficiencies in the framing of the survey question ("survey was plagued by the problem of leading questions"), created doubt in "the accuracy of the results obtained in that survey."[161] In *Han's (F & B) Pte Ltd v Gusttimo World*, the High Court of Singapore found four deficiencies in the survey methodology, regarding the survey methodology, held that these "limit the usefulness of the data collected," and placed "no weight on the survey findings in so far as they are said to show actual or the likelihood of confusion."[162]

In *Societe Des Produits Nestlé v. Petra Foods*, the High Court of Singapore found numerous problems with the survey submitted which, when construed together, "seriously offends guideline (f) : improper

159. *Id*. at 289.
160. *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 at ¶ 134 (Sing.).
161. *Id.* at ¶ 135.
162. Han's (F & B) Pte Ltd [2015] SGHC 39 at ¶¶ 165, 172 (Sing.).

definition of the survey sample, the "flawed screening process" impacting the results, and the way the surveys were structured.[163] Moreover, the High Court of Singapore found that the survey evidence did "not comply with guidelines (d), (e) and (g) as the underlying documents and responses of the survey respondents were not disclosed," Thus placing "little weight on the plaintiffs' surveys."[164]

*TMRG v. Caerus Holding* provides another example of the High Court of Singapore's analysis of survey weight, finding that the survey had numerous significant deficiencies: the survey used plaintiff's logo (not a registered trademark), rather than the registered trademark;[165] the interviewees did not represent the relevant cross-section of the public – "the relevant cross-section of the public comprises the plaintiffs' actual and potential customers," however, the survey "included no potential customers – all of them were actual customers;"[166] the interviewees were not asked any question to ascertain the cause of any confusion;[167] the survey was considered unfair, "leading, or otherwise problematic in various ways;"[168] and there was "late disclosure of the whole of the [s]urvey".[169] Taking these shortcomings and weaknesses into account, the court placed "no weight" on the survey evidence.[170]

In the U.S. the weight of the surveys is not determined uniformly, usually courts considered whether some or all the following factors are satisfied:

> (1) the "universe" was properly defined; (2) a representative sample of that universe was selected; (3) the questions to be asked of interviewees were framed in a clear, precise and non-leading manner; (4) sound interview procedures were followed by competent interviewers who had no knowledge of the litigation or the purpose for which the survey was conducted; (5) the data gathered was accurately reported; (6) the data was analyzed in accordance with accepted statistical principles; and (7) the objectivity of the entire process was ensured.[171]

There are many cases where the survey's conclusion was not considered probative. In *Storage Cap Management LP v. SpareSpace Storage*, for instance, the U.S. District Court for the Southern District of Ohio, Eastern Division found that the survey methodology was severely

163. Societe Des Produits Nestlé SA and another v Petra Foods Ltd and another [2014] SGHC 252 at ¶¶ 198, 202.
164. *Id*. at ¶¶ 207, 210.
165. *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2021] SGHC 163 at ¶ 192.
166. *Id*. at ¶¶ 197-99.
167. *Id*. at ¶ 202.
168. *Id*. at ¶ 204.
169. *Id*. at ¶ 238.
170. *Id*. at ¶ 241.
171. *Schering Corp.,* 189 F.3d at 225.

flawed: the control group testing was considered "imperfect," the marks at issue were not assessed separately, and "the survey was an unrealistic side-by-side study."[172] Consequently, the court found the survey is "not probative of the likelihood of confusion" as it is "replete with methodological errors." [173]

In *Charles Schwab v. Hibernia Bank*, the U.S. District Court for the Northern District of California highlighted several significant issues regarding the survey at hand: the universe was "skewed," as it included "those who earn more than $50,000 per year and are between the ages of 24 and 54;" the objectionable questions asked; and the conducting of the survey over the telephone, without the possibility to allow visual inspection of the trademarks at issue and without emulating actual marketing conditions. [174] The court found that the survey was "not substantiating evidence."[175]

In *Hi-Tech Pharmaceuticals v. Dynamic Sports Nutrition*, the U.S. District Court for the Northern District of Georgia, Atlanta Division, held that the survey presented "missed the mark," as it was both over-inclusive "in that 40% of the respondents were women, when the universe of purchasers for the products at issue in this case, which are characterized as 'anabolic,' are predominately, if not all, male;" and under-inclusive, as it excluded "otherwise qualified consumers, arguably some of the most likely consumers to have knowledge of the products at issue."[176] The court held that the "failure to survey a sufficiently close approximation of the correct universe is a fundamental flaw that contributes to the its finding that the survey is not reliable."[177]

Another interesting analysis can be found in *Scott Fetzer Co. v. House of Vacuums*, where the U.S. Court of Appeals for the Fifth Circuit found that the universe selected for the survey at hand, consisted "entirely of persons who purchased" products through the appellee, making it a group "uniquely familiar" with the appellee's marketing and distribution techniques.[178] The "survey says nothing about the ad's effect on the class of potential consumers . . . which includes a large proportion of persons."[179] Consequently, the survey universe was considered

172. Storage Cap Mgmt., LP v. Sparespace Storage, LLC, No. 2: 19-cv-4328 (S.D. Ohio Oct. 7, 2022)

173. *Storage Cap. Mgmt., LP,* No. 2: 19-cv-4328, at *21.

174. *Charles Schwab & Co., Inc. v. Hibernia Bank*, 665 F. Supp. 800, 807 (N.D. Cal. 1987).

175. *Id.*

176. *Hi-Tech Pharmaceuticals Inc.,* No. 1: 16-cv-949-MLB, at *56.

177. *Id*. at *57.

178. *Scott Fetzer Co. v. House of Vacuums Inc*., 381 F. 3d 477, 488 (5th Cir. 2004).

179. *Id.*

"suspiciously underinclusive," thus severely limiting the probative value of the results.[180]

In *Amstar Corp. v. Domino's Pizza*, the U.S. Court of Appeals for the Fifth Circuit found major survey problems: the universe did not include a "fair sampling" of consumers "most likely to partake of the alleged infringer's goods or services;" and the interviewees were women "found at home during six daylight hours who identified themselves as the member of the household primarily responsible for grocery buying," thus ignoring completely the primary customers – young, single, male college students.[181]The court held that the survey results must be discounted.[182]

In *Avery Dennison v. Sumpton*, the surveys focused on respondents from client lists, and users and purchasers of office supplies or products.[183] As the selected universe was construed as improper, the U.S. Court of Appeals for the Ninth Circuit rejected "any reliance on the flawed reports."[184] In *Kudos v. Kudoboard*, the U.S. District Court for the Northern District of California excluded the survey as the universe considered was "under-inclusive in that it excluded otherwise qualified consumers" and "presented respondents with leading stimuli, rendering the results unreliable."[185] Insufficient reliability is grounds for not crediting surveys in numerous cases.[186]

In Canada, the weight of the surveys depends on the analysis of several factors. Analysis can be very complex, concerning, for instance, "the logic of the answers of experts or the consistency of definitions or explanations which forms the basis of the experts".[187] Courts consider aspects such as the sample selection; the formulation of the survey questions; and the timeliness of the survey execution (i.e., refusal to admit evidence obtained well after the period relevant for determining the issue at hand).[188] In *Mattel v.* 3894207, the Federal Court of Canada found that the survey had "some blatant and determinative shortcomings that undermine its relevance considerably.[189] Consequently, the survey was

180. *Id*.
181. *Amstar Corp.,* 615 F.2d at264.
182. *Id*.
183. *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 879 (9th Cir. 1999).
184. *Id.*
185. *Kudos Inc. v. Kudoboard, LLC*, No. 20-cv-01876-SI, at *38 (N.D. Cal. Nov. 20, 2021).
186. *See*, *e.g.*, *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed. Cir. 2005) (survey did not show sufficient reliability to constitute sufficient evidence).
187. *Remo Imports Ltd.*,2006 FC 21 at ¶ 4 (Can.).
188. *Id*. at ¶ 130.
189. *Mattel Inc.* 2004 FC 361 at ¶ 27 (Can.).

construed as "not conclusive and cannot be used to establish the existence of a real likelihood of confusion."[190]

## III. Conclusion

Surveys are used to reveal certain aspects of a given consumer universe. Reliable surveys can provide empirical evidence showcasing consumers' reactions in the marketplace. However, survey evidence presents numerous challenging aspects and complex issues. Consequently, surveys require great care, primarily in their design and sample selection and size, to allow for an acceptable precision level and interpretation.

The main objective of this research was to provide an analysis of the most important aspects and arguments encountered in connection with survey evidence in trademark actions from the U.S., Canada, and Singapore. The article covers comprehensively fundamental aspects, regarding expert validation, survey universe and methodology, and admissibility and weight analysis.

This study found both similarities and certain differences across the jurisdictions considered. The findings offer important insights, which can strengthen courts' analysis, promote transnational judicial dialogue and research, and lead to improvements to the current approaches.

The findings highlight the importance of the proper validation of expert qualifications, the survey universe definition, the correct sample selection and adequate size, and the major significance of the questions asked. The proposed evidence must reflect scientific knowledge, derived through an appropriate scientific methodology, supported by adequate validation, avoiding uncritical survey weight. This article's findings suggest the need for the development of guidelines on how to properly define the survey universe, how to represent the inferred population, and the types of questions that are not admissible. Such guidelines can lead to more consistent approaches and accurate decisions.

Further, most courts consider survey problems in connection with the weight, rather than admissibility. However, the level of survey scrutiny varies, and there is a noted imprecision as what is considered a minor shortcoming, a weakness, or a major flow issue, as well as what such findings should entail. Consequently, there is a clear need to develop guidelines on how to treat survey deficiencies or inadequacies, such as improper universe selection, survey biases, survey non-response or response errors, or the treatment and interpretation of leading questions, with a view to improve predictability and weighting process.

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190. *Id*. at ¶ 36.