



# Ten Best

By James T. Berger

## Practices for Trademark Surveys

For years, intellectual property attorneys have used surveys to prove or disprove trademark infringement or likelihood of confusion. In my experience, many attorneys avoid surveys because they don't understand the proper way to develop and use them.

Here are my 10 best practices for intellectual property attorneys who need more familiarity with the use of surveys to create or refute evidence. (In the discussion of costs, I can only use my own frame of reference based on the costs that I commonly charge.)

### 1. Focus on the right target market.

As a first step, it's crucial that the survey focuses on the proper target market, and there are several obvious ways to locate the relevant market. If accurate and appropriate sales data is available, this is a good starting point. Find out who is buying and who is using the product or service; the buyer and user may not be the same. The client's marketing manager should be able to provide this information and the market segments being targeted.

### 2. Manage the costs.

There is a commonly held belief that trademark surveys are expensive, with the combined costs of those activities typically falling in the \$50,000–\$100,000 range. This is simply not true. Thanks to modern internet technology, I have developed surveys focusing on a consumer product or service for as little as \$20,000 to \$25,000, which includes:

- hiring the survey expert to develop and manage the entire process;
- developing the methodology;
- performing a pilot survey;
- hiring an independent research company to implement the questionnaire;
- hiring a company to tabulate the survey;
- hiring an independent company to validate the survey; and
- developing a final report that is submitted to the court.

Many attorneys think surveys take too long to develop, execute, and produce results and avoid them for these reasons, but there is a happy medium.

Surveys start getting costlier when specific target markets or audiences need to be identified and reached. Non-consumer surveys include specific users of industrial, commercial, or medical products. Depending on how difficult it is to reach these target markets, costs may increase. However, in most cases, association directories or other list sources can be used. For the most part, if we are dealing with consumer products such as packaged goods or commonly used services, doing a survey with 200–250 respondents is inexpensive.

### 3. Provide enough time for the survey.

Many attorneys think surveys take too long to develop, execute, and produce results and avoid them for these reasons, but there is a happy medium. Generally, a survey can comfortably be started and completed within a two-month timeframe. In emergencies, surveys can be developed faster. As with costs, internet panels greatly reduce the time needed to complete surveys. In some cases, a consumer product or service survey can move from inception to final report in less than three weeks.

### 4. Make use of internet surveys whenever possible.

In “A Comparative Empirical Analysis of Online Versus Mall and Phone Methodologies for Trademark Surveys,” Hal Poret writes:

Despite these many theoretical and practical concerns, the number of actual judicial criticisms of online surveys is quite small....

Courts considering online surveys conducted in 2009 and 2010 seem not to question the use of online methodologies at all, finding them admissible without raising any concerns regarding the use of the Internet....

Most importantly, perhaps, the Internet is now the single most common means of collecting consumer opinion and behavior data in the market research industry.<sup>1</sup>

The internet has become the leading way to develop the kind of survey that courts accept in trademark matters. Telephone surveys have become far more difficult because of cell phones and caller ID. Mall intercept surveys also have become passé since malls mostly attract younger or older people—not the cross section one typically seeks in developing surveys.

### 5. Be careful when using mall intercept research and telephone surveys.

While mall intercept research may have been the best way to research general consumers in the past, it's not the case anymore. More and more shopping malls are giving up their research centers, which are costly to maintain. And the rise in internet shopping has turned certain types of people away from malls. As stated earlier, many malls no longer attract a cross section of shoppers but are limited to specific population segments—like teenagers, discount shoppers, or seniors who walk the malls for exercise. If you're looking for a cross section of the population, the internet has transcended the shopping mall.

Like mall intercept research, telephone surveys are pretty much a thing of the past. As mentioned earlier, the rise of cell phones and caller ID has doomed telephone surveys as a cost-effective trademark survey research tool. The very nature of a telephone survey is intrusive, and people avoid them if they can. Also, given the number of surveys, people are turned off by them and would rather spend their time doing something else. Caller ID weeds out many of these calls. As the incidence for telephone surveys (the number of useable surveys divided by the number of calls) decreases, surveys take longer to complete and cost more.

Telephone surveys are still used for political polling, but even political pollsters are turning to the internet.<sup>2</sup>

## 6. Be especially careful when using multiple survey experts.

A common misconception is that two experts are better than one and their testimony will build a stronger case. This is a myth, because no two experts are going to agree on everything, and by the time the deposition process has been completed, there is a good chance the adversarial attorney will play one expert against another and weaken the testimony of both.

If the case requires more than one expert—for example, one expert to perform a secondary meaning survey and another to perform a likelihood of confusion survey—make sure each expert reviews the other's report before drafting the final report to avoid contradictions.

## 7. Live with the realization that there is no such thing as the perfect survey.

There is no such thing as the perfect survey. In every case, another expert will critique a survey and explain what he or she believes are its flaws. Surveys are not cookie-cutter processes. Every case is different in some way. A rebuttal expert generally will present alternative methodologies and second-guess the expert's report. If you're searching for perfection in a trademark survey, you'll never find it.

## 8. Be careful when communicating with a survey expert.

Some attorneys avoid surveys and survey experts because they believe if the findings weaken the case, the survey expert will be forced to reveal the flaws through the discovery process. While this might be true if the expert is designated as a testifying expert, it's not necessarily true if the expert is designated as a consulting expert. A consulting expert can be hired to do a pilot survey. If the pilot survey results weaken

the case, that work remains privileged and not discoverable. Only when an expert is designated as a testifying expert is his or her work product discoverable.

## 9. Beware of onsite surveys.

In fact, doing a survey in a store or at a trade show is about the most difficult survey to perform. Surveys, by their nature, are intrusive. People attending trade shows or shopping in stores aren't interested in doing surveys; they are there for another purpose. Most retail establishments have policies against in-store surveys, so getting permission to go into a store to do a survey is difficult. Another problem with the in-store survey: if a product or brand is on display, it might introduce bias.

## 10. If possible, conduct a pilot survey.

While intense time constraints make it impossible to conduct a pilot survey in some instances, in virtually every other case a pilot survey should be performed. If the results of the pilot survey are poor and the expert is retained as a consulting expert, the results are usually not discoverable. If the pilot survey results strengthen the case, that survey can easily be rolled out and form the basis of a full survey. If there are no changes between the pilot and the survey that follows, the results from both can be bundled into the final report. The pilot survey creates a level of comfort; chances are, the pilot results will be replicated in the primary survey. ■

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## ENDNOTES

1. Poret, *A Comparative Empirical Analysis of Online Versus Mall and Phone Methodologies for Trademark Surveys*, 100 *Trademark Reporter* 756 (2010), 764, 767-768, available at <[https://cdn2.hubspot.net/hubfs/454850/Poret%20vol100\\_no3\\_a3.pdf](https://cdn2.hubspot.net/hubfs/454850/Poret%20vol100_no3_a3.pdf)> [<https://perma.cc/RH4R-AJ5J>] (accessed February 1, 2020).
2. E.g., Cohn, *No One Picks Up the Phone, but Which Online Polls Are the Answer?*, *The New York Times* (July 2, 2019) <<https://www.nytimes.com/2019/07/02/upshot/online-polls-analyzing-reliability.html>> [<https://perma.cc/8Z2S-KPD3>] (accessed February 1, 2020).