

**Survey Says . . . Yes!  
Challenges Confronted, Lessons Learned, and Practice Pointers for Product Design Trade  
Dress Surveys in Litigation**

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**I. Introduction**

Consumer surveys in trademark cases are governed by a generally accepted set of rules or practices. For typical trademarks, such as word marks, there is a wealth of case law addressing survey design and methodology, providing guidance on how to design and evaluate surveys. In contrast, there is not nearly as much case law addressing consumer surveys for product design trade dress. As a result, courts and litigants in product design trade dress cases sometimes rely on case law related to consumer surveys for word marks. While that may be appropriate in some cases, in other cases the product design trade dress at issue may present unique issues making it difficult to rely on case law directed to word marks.

Indeed, the case law addressing consumer surveys for product design trade dress reflects an awareness of unique potential issues surrounding surveys for product design trade dress that may not exist for word marks, such as issues related to choice of control, testing for post-sale confusion, survey bias, and reliance on verbatim responses. But the cases are fact specific and it can be difficult to extrapolate general guidelines to apply in future cases.

Section II of this paper briefly summarizes some of the unique issues that may arise in product design trade dress cases. Section III contains a survey of select cases from the last decade that assess consumer surveys involving product design trade dress. Finally, Section IV provides general guidelines to consider when designing and evaluating consumer surveys in product design trade dress cases.

**II. Challenges Confronted in Some Product Design Trade Dress Cases**

Product design trade dress cases frequently involve multi-element trade dress. This can present certain challenges in some cases. The multi-element trade dress may include individual elements that, standing alone, constitute a separate, non-asserted trademark. At the same time, certain elements of the multi-element trade dress may be combined with other, non-asserted elements that likewise constitute a distinct trade dress from the one being litigated.

Because of the way consumers may, in some cases, use a number of cues in combination to identify objects,<sup>2</sup> a product design trade dress is not necessarily the sum of its parts. For example, during the holiday season, a consumer may associate a soda can with Coca-Cola if it includes (1) the “Coca-Cola” script, (2) a white ribbon, (3) a red background, and (4) polar bears.

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<sup>1</sup> The opinions expressed in this article are for the purpose of fostering productive discussions of legal issues and do not constitute the rendering of legal counseling or other professional services. The opinions expressed are subject to change as trademark law develops. Furthermore, this article does not reflect the views of the author’s law firm, its partners, or its clients.

<sup>2</sup> See generally, e.g., J. David Smith and June H. Shapiro, *The Occurrence of Holistic Categorization*, 28 J. OF MEMORY & LANGUAGE 386 (1989).

That same consumer may likewise associate a soda can with Coca-Cola if it only includes elements (2), (3), and (4) *i.e.*, a white ribbon, a red background, and a polar bear, or another variation of two or three elements. Still, that same consumer may also associate a soda can with Coca-Cola if it only includes element (4), *i.e.*, polar bears.

This can create challenges when selecting test and control stimuli for secondary meaning or likelihood of confusion surveys if the “rules” applied in typical trademark cases are followed. With respect to the Coca-Cola example, if an accused infringer sells a soda can with a red background and a polar bear, and the asserted mark is the red background, some may argue a proper control stimulus for a likelihood of confusion survey should include everything but the red background.<sup>3</sup> In other words, the control stimulus still includes a polar bear. But a control using a polar bear may measure more than “noise,” it may measure actual associations with Coca-Cola. Thus, others may argue a can featuring a polar bear is an improper control because it may artificially depress the net confusion results.<sup>4</sup> While this example is intentionally simplistic, it highlights the issues that can arise in more complex, multi-element product design trade dress cases.

Another issue that may arise in some product design trade dress cases is the treatment of verbatim responses to secondary meaning and likelihood of confusion surveys. One leading trademark treatise observes that “[o]ften, an examination of the respondents’ verbatim responses to the ‘why’ question are the most illuminating and probative part of a survey.”<sup>5</sup> While the responses may be “illuminating,” in some multi-element product design trade dress cases, consumers may not be able to specifically articulate each element that caused them to respond the way they did. Indeed, some consumer psychologists have observed that “[s]ubjects are sometimes (a) unaware of the existence of a stimulus that importantly influenced a response, (b) unaware of the existence of the response, and (c) unaware that the stimulus has affected the response.”<sup>6</sup> To that end, they argue “[p]eople often cannot report accurately on the effects of a particular stimuli on higher order, inference-based responses. . . . The accuracy of subjective reports is so poor as to suggest that any introspective access that may exist is not sufficient to produce generally correct or reliable reports.”<sup>7</sup>

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<sup>3</sup> See, e.g., Shari Seidman Diamond, *Reference Guide on Survey Research*, in REFERENCE MANUAL ON SCIENTIFIC EVIDENCE 229, 258 (Federal Judicial Center ed., 2d ed. 2000) (“In designing a control group study, the expert should select a stimulus for the control group that shares as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”).

<sup>4</sup> See, e.g., *id.* (recognizing the impact of a control stimulus that is itself a likely source of consumer confusion).

<sup>5</sup> 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:175 (4th ed.). The treatise also observes that “Jacoby disagrees with the view that verbatim responses to the ‘why’ question are reliable indicators of consumer perception.” *Id.* (citing Jacoby, *Trademark Surveys*, §§ 8:05.2–8.05.3 (ABA 2014)).

<sup>6</sup> Richard E. Nisbett and Timothy DeCamp Wilson, *Telling More Than We Can Know: Verbal Reports on Mental Processes*, 84 PSYCHOLOGICAL REVIEW 231, 231 (1977).

<sup>7</sup> *Id.* at 233.

### III. Lessons Learned from Cases Analyzing Product Design Consumer Surveys Over the Past Decade

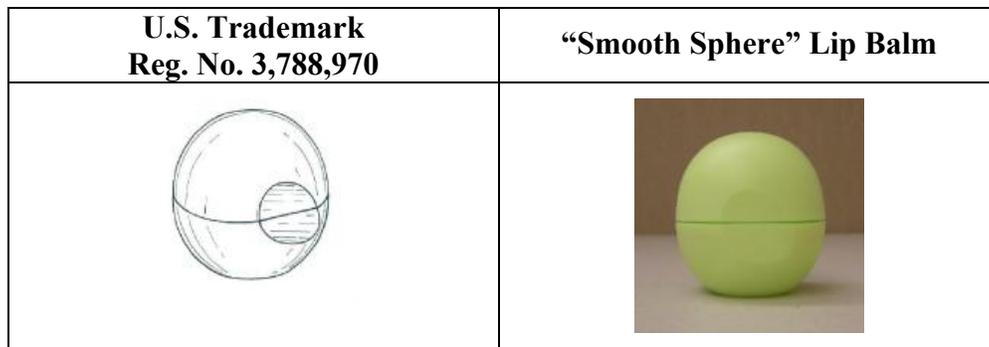
Courts addressing objections to likelihood of confusion surveys in product design trade dress cases often face similar objections as in typical trademark cases. For example, litigants may object to a product design trade dress survey for failing to survey the appropriate universe, failing to replicate market conditions, using improper stimuli, introducing survey bias, etc. However, resolution of these issues by reference to typical trademark cases may not always be appropriate.

This section surveys select cases from the last decade that address objections to likelihood of confusion surveys in product design and product packaging cases. When viewed as a whole, they provide some guidance on ways to defend, or critique, a likelihood of confusion survey in the product design context.

#### A. Post-Sale Confusion: *OraLabs, Inc. v. The Kind Group LLC*, 13-cv-170 (D. Col.)

In *OraLabs, Inc. v. The Kind Group LLC*, the defendants asserted trade dress infringement counterclaims in the design of the eos “Smooth Sphere” lip balm container, shown in the figure below.<sup>8</sup>

**Figure 1: Asserted Lip Balm Trade Dress**



The defendants relied on a consumer survey to test likely confusion from the plaintiff’s accused “Lip Revo” lip balm.<sup>9</sup> In particular, the survey employed a mall-intercept methodology to test post-sale confusion using an “Eveready” survey design.<sup>10</sup> The survey respondents were shown a physical sample of a test lip balm or control lip balm, and allowed to handle and view

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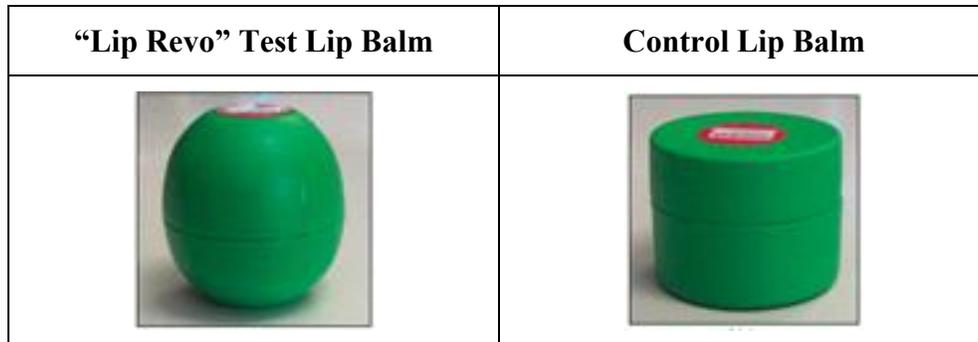
<sup>8</sup> See Answer to Complaint and Counterclaim, No. 13-cv-00170 (D. Col. Mar. 26, 2013), ECF No. 25.

<sup>9</sup> Expert Report Submitted by Dr. Bruce Isaacson Measuring the Likelihood of Confusion Between Lip Balms Produced by OraLabs and The Kind Group, *OraLabs*, No. 13-cv-00170 (Oct. 6, 2014), ECF No. 142-1.

<sup>10</sup> *Id.* at 1.

the lip balm as long as needed.<sup>11</sup> Exemplary images of the test and control lip balms used in the survey are shown in the figure below.

**Figure 2: Exemplary Test Lip Balm and Control Lip Balm**



The plaintiff filed a motion to exclude the defendants’ survey because the results were based on post-sale confusion as opposed to point-of-sale confusion.<sup>12</sup> The plaintiff acknowledged that post-sale confusion is actionable, but argued it should be limited to situations when a product is “consistently visible to the purchasing public,”<sup>13</sup> and that post-sale confusion may be “avoided when a junior user uses ‘an adequately distinguishing mark.’”<sup>14</sup> As a result, the plaintiff sought to impose a threshold requirement on the survey expert to demonstrate that “the products are first encountered in the marketplace in a post-sale context, without any identifying elements.”<sup>15</sup>

In denying the motion to exclude, the court found that post-sale confusion is “relevant to the trade dress infringement inquiry,”<sup>16</sup> and rejected the plaintiff’s request to “impose[] a threshold evidentiary burden on experts to support their decision of whether to conduct a post-sale or point-of-sale survey with research on how the public comes into contact with the product.”<sup>17</sup> The court further found that none of the authority cited in the plaintiff’s motion to exclude imposed a requirement on the survey expert to show the test product “lacks any identifying elements” as a prerequisite to conducting a post-sale confusion survey.<sup>18</sup>

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<sup>11</sup> *Id.* at 10.

<sup>12</sup> Motion in Limine to Exclude Testimony of Dr. Bruce Isaacson at 10–12, *OraLabs*, No. 13-cv-00170, 2015 WL 4538442 (July 28, 2015), ECF No. 140. The plaintiff also sought to exclude the survey on the basis of alleged flaws in the survey universe. *Id.* at 5–10.

<sup>13</sup> *Id.* at 10.

<sup>14</sup> *Id.* at 11 (citing 4 Rudolf Callman, *Callman on Unfair Competition, Trademarks & Monopolies*, § 22:16 (4<sup>th</sup> ed. 2014)).

<sup>15</sup> *Id.*

<sup>16</sup> *OraLabs*, 2015 WL 4538442, at \*6.

<sup>17</sup> *Id.* at \*7. The court accepted the surveyor’s justification for conducting a post-sale survey because (1) “it replicates the real-world scenario where someone sees the lip balm, perhaps taken out from a pocket or purse, with the top on the lip balm,” and (2) the lip products, by their nature, are not likely to be purchased frequently. *Id.* at \*6.

<sup>18</sup> *Id.* at \*7.

Accordingly, the court found that the expert’s “motivation” for conducting a post-sale confusion survey “at best goes to the weight to be afforded to his conclusions.”<sup>19</sup>

**B. Post-Sale Confusion and Choice of Controls: *Audemars Piguet Holding S.A. v. Swiss Watch International, Inc.*, No. 12-5423 (S.D.N.Y.)**

In *Audemars Piguet Holding S.A. v. Swiss Watch International, Inc.*, the plaintiff asserted trade dress infringement claims in the design of the Audemars “Royal Oak” watch, shown in the figure below.<sup>20</sup>

**Figure 3: Asserted Lip Balm Trade Dress**

U.S. Trademark Reg. No. 2,866,069	U.S. Trademark Reg. No. 3,480,826	U.S. Trademark Reg. No. 4,232,239	U.S. Trademark Reg. No. 4,232,240
			
			

To support its claims, the plaintiff introduced a consumer survey to test likely confusion from the defendant’s accused Swiss Legend “Trimix Diver” watch.<sup>21</sup> In particular, the plaintiff conducted the survey at jewelry and watch stores to test post-sale confusion using an “Eveready” survey design.<sup>22</sup> The survey respondents were shown a color, true-to-size photograph for ten seconds of a test watch or a control watch on a person’s wrist and with all indicia of source fully visible.<sup>23</sup> Two controls were used in the survey: an inexpensive round faced Timex watch and a Movado Museum watch. Exemplary images of the test and control watches are shown in the figure below.<sup>24</sup>

<sup>19</sup> *Id.* at \*6.

<sup>20</sup> Complaint, No. 12-5423 (S.D.N.Y. July 13, 2012), ECF No. 1.

<sup>21</sup> Report of Consumer Research Findings, *Audemars*, No. 12-5423 (Apr. 25, 2013), ECF No. 67-2.

<sup>22</sup> *Id.* at 3.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at 2.

**Figure 4: Test and Control Photographs**



The defendant challenged the survey on the grounds that it did not properly test post-sale confusion and used improper controls. Specifically, the defendant argued the survey failed to “replicate real-world conditions” where people would notice a watch post-sale, such as at a restaurant, and challenged the ten second time period that survey respondents were permitted to view the photographs.<sup>25</sup> Additionally, citing to *THOIP v. Walt Disney Co.*, which states that a control “should share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed,” the defendant argued that the control watches were improper because they “share[d] no essential features” with the trade dress or accused watches, “except for being watches.”<sup>26</sup>

The court did not find the defendant’s arguments persuasive. While the court acknowledged that the survey conditions did not “*exactly* replicate real life conditions,” it explained that “surveys ‘cannot be conducted in a vacuum.’”<sup>27</sup> To that end, the court found the survey’s presentation of the photographs “created satisfactory conditions” for a survey that “sought to shed light” on the post-sale confusion issue.<sup>28</sup> The court found this conclusion was further supported by consumers’ ability to correctly identify the Movado and Timex controls.<sup>29</sup>

As to the survey’s controls, the court accepted the plaintiff’s explanation that the control watches confirmed that the ten-second viewing of the photograph permitted sufficient time for survey respondents to view and assess the watch.<sup>30</sup> In other words, “by using both the Timex watch, with its brand name prominently displayed on the face, in addition to the Movado watch, with a well-known design and a barely visible brand name, the controls demonstrate that survey participants could see and assess both brand name and design.”<sup>31</sup> Thus, the court found the

<sup>25</sup> Memorandum in Support of Motion in Limine at 7–8, *Audemars*, 46 F. Supp. 3d 255, *rev’d in part on reconsideration on other grounds*, 2015 WL 150756 (2014) (No. 12-5423), ECF No. 90.

<sup>26</sup> *Id.* at 9.

<sup>27</sup> *Audemars*, 46 F. Supp. 3d at 273 (citing *Cartier, Inc. v. Four Star Jewelry Creations*, 348 F. Supp. 2d 217, 231 (S.D.N.Y. 2004)) (emphasis in original).

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

control watches “appropriate” and the survey expert’s “testimony credible with respect to the likelihood of post-sale confusion.”<sup>32</sup>

**C. Post-Sale Confusion and Choice of Control: *adidas-America, Inc. v. Payless Shoesource, Inc.*, No. 01-1655 (D. Ore.)**

In *adidas-America, Inc. v. Payless Shoesource, Inc.*, the plaintiff asserted infringement claims in the design of its “Superstar” shoe, as well as its “Three Stripe” mark, as shown in the figure below.<sup>33</sup>

**Figure 5: adidas “Superstar” shoe**



The plaintiff submitted a consumer survey to test likely confusion from the defendant’s accused shoes.<sup>34</sup> The survey employed a mall-intercept methodology to test post-sale confusion using an “Eveready” survey design.<sup>35</sup> The survey respondents were shown a photograph of a shoe on a person’s foot, and were allowed to view the photographs as long as needed.<sup>36</sup> Exemplary images of the test and control shoes used in the confusion survey are shown in the figure below.<sup>37</sup>

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<sup>32</sup> *Id.*

<sup>33</sup> Complaint, No. 01-1655 (D. Ore. Nov. 8, 2001), ECF No. 1. The plaintiff defined the Superstar trade dress as the combination of three stripes on the side of the shoe parallel to equidistant small holes, a rubber “shell toe,” a particularly flat sole and a colored portion on the outer back heel section, that identifies to consumers that the origin of the product lies with adidas. *Id.* at ¶ 17.

<sup>34</sup> Rule 26 Report of Dr. Gerald L. Ford Re: Payless Shoesource, Inc., *adidas*, No. 01-1655 (July 20, 2004), ECF No. 348-1.

<sup>35</sup> *Id.* at 6–11.

<sup>36</sup> *Id.* at 10.

<sup>37</sup> *Id.* at Vol. I, Survey Synopsis at 6, 13, 20.

**Figure 6: Test and Control Photographs**

Test: Accused Shoe	Control 1: Elements Redacted from Test Shoe	Control 2: Control 1 Shoe with Stripes Added
		

The defendant moved to exclude the survey on the grounds that it did not test all of the accused products, did not replicate a post-sale environment, and did not isolate the claimed trade dress.<sup>38</sup> As to the post-sale environment, the defendant challenged the use of still photographs that only showed one angle of one shoe.<sup>39</sup> The defendant also argued the survey was flawed because it allowed the interviewees to keep the stimuli in front of them throughout the interview process, stating that does not accurately reflect market conditions.<sup>40</sup> The defendant also challenged both controls used in the survey, arguing the claimed trade dress was not isolated.<sup>41</sup>

The court was not persuaded by defendant’s arguments, It found that, “[w]here actually surveyed products and subsequently accused products share common and prominent features, a trademark infringement plaintiff need not create new likelihood of confusion surveys for each newly accused product.”<sup>42</sup> As to the remainder of the defendant’s objections, the court found that they “go to the weight of [the] surveys, rather than their admissibility.”<sup>43</sup> Thereafter, the court considered the plaintiff’s likelihood of confusion survey results in denying the defendant’s motion for summary judgment on the issue of infringement.<sup>44</sup>

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<sup>38</sup> Memorandum in Support of Motion to Strike the Rule 26 Report of Dr. Gerald Ford, *adidas*, 546 F. Supp. 2d 1029 (2008) (No. 01-1655), ECF No. 652. The defendant challenged the survey on other grounds, including that the survey’s principal question was leading. *Id.* at 15.

<sup>39</sup> *Id.* at 12.

<sup>40</sup> *Id.*

<sup>41</sup> *Id.* at 14–15. The defendant argued the survey “failed to control the ‘background noise,’” pointing to the results of a replication survey it conducted using the same methodology, but with a K-Swiss shoe (which has five stripes) for the control. *Id.* at 15. The defendant explained that “40% more survey respondents identified Adidas as the source of [defendant’s K-Swiss control shoe] than the actual shoe’s maker, K-Swiss.” *Id.* The defendant concluded that, “[s]imply put, although Adidas may have rights in three stripes, if shoes with two, four, or five stripes are put in front of consumers, many will believe that shoe is from Adidas solely because it has stripes, regardless of the number.” *Id.* Some may argue the defendant’s control was improper as also being a source of confusion.

<sup>42</sup> *adidas*, 546 F. Supp. 2d at 1045.

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at 1059.

**D. Choice of Control: *KIND LLC v. Clif Bar & Company*, No. 14-770 (S.D.N.Y.)**

In *KIND LLC v. Clif Bar & Company*, the plaintiff asserted trade dress infringement claims in the overall design of its fruit and nut bar, certain elements of which are also subject to two federal trademark registrations,<sup>45</sup> as shown in the figure below.

**Figure 7: Asserted Trade Dress**



The plaintiff conducted a consumer survey to test the likelihood of confusion from the defendant’s accused fruit and nut bar packaging.<sup>46</sup> The online survey employed a line-up methodology whereby respondents were shown three photographs, one at a time, of (1) KIND fruit and nut bars, (2) gum, and (3) mints.<sup>47</sup> Respondents were then shown a second set of three photographs of (1) either the defendant’s accused bar or a control bar, (2) gum, and (3) mints.<sup>48</sup> Images of the photograph of the KIND bar, as well as of the test and control bars, are shown in the figure below. For each product shown in the second set of photographs, the respondents were asked whether the “brand of [product] is or is not made with the approval of the same company that makes the [corresponding product category] you saw in the earlier photo?”<sup>49</sup>

<sup>45</sup> Complaint, No. 14-00770 (S.D.N.Y. Feb. 6, 2014), ECF No. 2.

<sup>46</sup> Declaration of George Mantis, *KIND*, No. 14-00770 (Feb. 12, 2014), ECF No. 10. The surveyor explained that the survey design was modeled on the survey accepted in *Kraft General Foods, Inc. v. Allied Old English, Inc.*, 831 F. Supp. 123 (S.D.N.Y. 1993). Declaration of George Mantis at 2–3, *KIND*, No. 14-00770.

<sup>47</sup> *Id.* at 3–6.

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 6.

**Figure 8: Test and Control Photographs**

First Line-Up: KIND Bar	Second Line-Up: Test and Control Bars	
	 <p data-bbox="868 661 933 693" style="text-align: center;">Test</p>	 <p data-bbox="1185 661 1291 693" style="text-align: center;">Control</p>

The defendant’s rebuttal survey expert agreed that the plaintiff’s survey design “is one appropriate general approach to this issue,” but criticized the control used.<sup>50</sup> In particular, the defendant argued the control should have incorporated a transparent wrapper (which was an element of the asserted trade dress) because, according to the defendant, it constitutes a “non-protectable” element.<sup>51</sup> The defendant’s survey expert also testified that, as a result of the control used in the plaintiff’s survey, there was “no way of measuring or seeing whether one or two elements of the trade dress are the ones causing confusion and the others are simply superfluous.”<sup>52</sup> The plaintiff disagreed, arguing that the defendant’s suggested control would itself be a source of confusion because it shares elements with the test stimuli.<sup>53</sup>

The court credited the defendant’s survey expert, agreeing that the plaintiff’s survey “was flawed because it measured whether there was confusion, but not what *caused* the confusion.”<sup>54</sup> As a result, the court found that the plaintiff’s survey “may have underestimated the level of noise and thus overestimated the level of actual confusion.”<sup>55</sup> Because the plaintiff’s survey showed a 15% net confusion level, and in view of the defendant’s criticisms and other survey factors, the court gave “little weight to the survey.”<sup>56</sup>

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<sup>50</sup> Commentary on a Study Conducted by George Mantis at 4, *KIND*, No. 14-cv-00770 (Mar. 31, 2014), ECF No. 35.

<sup>51</sup> *Id.* at 4–5; see also Defendant’s Memorandum in Opposition to Plaintiff’s Motion for Preliminary Injunction at 18, *KIND*, 14-00770, 2014 WL 2619817 (June 12, 2014), ECF No. 31.

<sup>52</sup> *KIND*, 2014 WL 2619817, at \*9.

<sup>53</sup> Plaintiff’s Reply Memorandum to Motion for Preliminary Injunction at 7, *KIND*, 14-00770, 2014 WL 2619817 (Apr. 14, 2014), ECF No. 40.

<sup>54</sup> *KIND*, 2014 WL 2619817, at \*9 (emphasis in original).

<sup>55</sup> *Id.* at \*10.

<sup>56</sup> *Id.* The plaintiff appealed the district court’s denial of its motion for a preliminary injunction. See Brief & Appendix on Appeal, *KIND*, 14-2481 (2d Cir. Aug. 28, 2014), ECF No. 45. Among other things, the plaintiff argued the court legally erred in its analysis of the survey evidence. *Id.* at 36–43. After briefing on appeal, the parties entered into a Stipulation and Order of Dismissal wherein they agreed the district court’s order on the plaintiff’s motion for a preliminary injunction “focus[e]d upon the protectability as a trade dress of six elements of the KIND packaging and not the protectability of the KIND packaging as a whole.” Stipulation, *KIND*, No. 14-770 (Dec. 17, 2014), ECF No. 98.

**E. Choice of Control and Bias: *Brighton Collectibles, Inc. v. RK Texas Leather Mfg.*, No. 10-419 (S.D. Cal.)**

In *Brighton Collectibles, Inc. v. RK Texas Leather Mfg.*, the plaintiff asserted trade dress infringement claims in the design of its handbags,<sup>57</sup> shown in the figure below.

**Figure 9: Brighton Handbag Trade Dress**



To support its claims, the plaintiff conducted a consumer survey to test the likelihood of confusion from the defendant's accused handbags.<sup>58</sup> The survey respondents were first shown a table with four of the plaintiff's handbags (shown in the figure above), then shown another table with four different handbags, one of which was the accused handbag as shown in the figure below.<sup>59</sup> The survey asked respondents, "Which handbag or handbags, if any, [from the second table] do you think are made, sponsored, or endorsed by the same company as the first set of handbags?"<sup>60</sup>

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<sup>57</sup> Complaint, No. 10-419 (S.D. Cal. Feb. 24, 2010), ECF No. 1. The plaintiff defined the claimed trade dress as a sculpted, silver heart, used in conjunction with any two or more of the following: (i) leather embossed to resemble exotic materials such as crocodile, alligator, snake and lizard; (ii) filigreed, silver ornamentation; (iii) a silver heart dangling from a leather strap; (iv) cowhide or brocaded fabrics; and/or (v) additional sculpted silver hearts. *Id.* at 11.

<sup>58</sup> Expert Report of Professor Gary L. Frazier, *Brighton*, No. 10-419 (July 6, 2012), ECF No. 164-2.

<sup>59</sup> *Id.* at 6-9.

<sup>60</sup> *Id.* at 7.

**Figure 10: Second Line-up of Handbags, Including the Defendant’s Accused Handbag**



The defendant moved to exclude the plaintiff’s survey, arguing it lacked a control and was “overtly suggestive” because the accused bag was the only one of the four bags in the second line-up that looked similar to the plaintiff’s bag, including having the same colors.<sup>61</sup>

The court agreed with the defendant that the plaintiff’s survey design “was so blatantly biased that the results are unreliable,” explaining that a “line-up in which only one bag shares the most prominent and eye-catching features—two colors and silver hearts—improperly suggested . . . that Defendants’ bag was the ‘correct’ answer.”<sup>62</sup> Thus, rather than test confusion, the court found the survey “tested the ability of participants to pick the most obvious match.”<sup>63</sup> The court also found the “problem was exacerbated” because the survey did not use a control.<sup>64</sup>

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<sup>61</sup> Memorandum in Support of Motion to Exclude the Surveys and Testimony of Gary Frazier, *Brighton*, 923 F. Supp. 2d 1245 (2013) (No. 10-419), ECF No. 164. The defendant moved to exclude the survey on additional grounds, including that it failed to replicate market conditions. *Id.*

<sup>62</sup> *Brighton*, 923 F. Supp. 2d at 1257.

<sup>63</sup> *Id.* The court further observed that “color is not an element of [the asserted trade dress],” making the survey’s flaw “readily apparent.” *Id.*

<sup>64</sup> *Id.* at 1257–58. The plaintiff’s opposition to the defendant’s motion to exclude argued the other three, non-accused handbags in the second line-up served as a control. Opposition to Motion to Exclude the Surveys and Testimony of Gary Frazier, Ph.D. at 5–6, *Brighton*, 923 F. Supp. 2d 1245 (No. 10-419), ECF No. 196.

**F. Choice of Control and Bias: *Maker’s Mark Distillery, Inc. v. Diago North America, Inc.*, No. 03-93 (W.D. Ky.)**

In *Maker’s Mark Distillery, Inc. v. Diago North America, Inc.*, the plaintiff asserted trade dress infringement claims in the design of the red dripping wax seal that partially covers the neck of its bourbon bottles,<sup>65</sup> as shown in the figure below.

**Figure 11: Maker’s Mark “Dripping Wax” Trade Dress**



In response to the plaintiff’s claims, the defendant conducted a consumer survey to test the likelihood of confusion, if any, caused by the tendrils on the wax seal of its accused Jose Cuervo Reserva bottle.<sup>66</sup> Specifically, the defendant conducted an online survey using a line-up design whereby respondents were first shown three photographs of products, which included the plaintiff’s product embodying the asserted trade dress, as well as a bottle of Bloody Mary mix and a bottle of tonic water.<sup>67</sup> The respondents were then shown a second set of photographs of products, which included either a test bottle (*i.e.*, the defendant’s accused product) or a control bottle, as well as a bottle of Johnnie Walker scotch and a bottle of Crown Royal whisky.<sup>68</sup> The brand name of each product was displayed below the image shown to the respondents. Images of the test and control products are shown below.<sup>69</sup> For each product shown in the second line-up, the respondents were asked, “Do you believe that the product shown...is made by any of the companies that make a product you saw in the first set of pictures?”<sup>70</sup>

<sup>65</sup> First Amended Complaint, No. 03-93 (W.D. Ky. Mar. 28, 2007), ECF No. 60. While the plaintiff’s trademark registration is not specific to the color red, the plaintiff later narrowed its arguments to assert protection only for a red dripping wax seal. *Maker’s Mark*, 703 F. Supp. 2d 671, 682–83 (W.D. Ky. 2010).

<sup>66</sup> Likelihood of Confusion Survey Methodology and Results, *Maker’s Mark*, No. 03-93 (Sept. 1, 2009), ECF No. 219-2.

<sup>67</sup> *Id.* at 3–9.

<sup>68</sup> *Id.*

<sup>69</sup> *See id.* at D-7–D-33.

<sup>70</sup> *Id.* at 8.

**Figure 12: Test and Control Bottles Used in Defendant’s Survey**



The plaintiff objected to the defendant’s survey on the grounds that it used an improper experimental design and control, an improper definition of the relevant universe, and incorrect sampling to secure representative members.<sup>71</sup>

The court agreed with the plaintiff’s objections, finding the defendant’s study “neither useful nor persuasive.”<sup>72</sup> The court criticized the defendant’s use of an online survey because it “created an environment that was dissimilar to that in which a typical consumer would encounter” the products.<sup>73</sup> The court also criticized the defendant’s survey for displaying the brand name below each product, “which would tend to suggest that the products were not affiliated.”<sup>74</sup> Last, the court criticized the control because it “could have been confusing also,” which would have artificially depressed the confusion levels.<sup>75</sup>

**G. Verbatim Responses: 3M Company v. Mohan, No. 09-1413 (D. Minn.)**

In *3M Company v. Mohan*, the plaintiff asserted trade dress infringement claims in the design of its “Master Cardiology” stethoscope, which is subject to a federal trademark registration, as shown in the figure below.<sup>76</sup>

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<sup>71</sup> Opposition to Defendant’s Motion for Partial Summary Judgment at 32, *Maker’s Mark*, 703 F. Supp. 2d 671, *aff’d*, 679 F.3d 410 (6th Cir. 2012) (No. 03-93), ECF No. 229.

<sup>72</sup> *Maker’s Mark*, 703 F. Supp. 2d at 694.

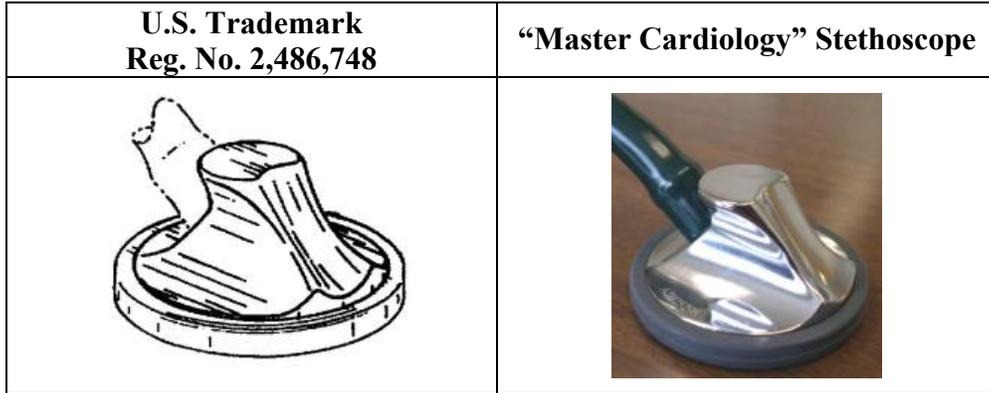
<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* n. 29.

<sup>76</sup> Complaint, No. 09-1413, (D. Minn. June 16, 2009), ECF No. 1. The plaintiff also asserted trademark infringement claims relating to various word marks and logos. *Id.*

**Figure 13: Asserted Stethoscope Trade Dress**



The plaintiff submitted a consumer survey to test the likelihood of confusion from the defendant’s accused stethoscopes.<sup>77</sup> Specifically, the plaintiff conducted an online survey testing point-of-sale confusion using an “Eveready” survey design.<sup>78</sup> The survey respondents were shown one of the defendant’s eBay listings for the accused products or a control eBay listing. The control eBay listing was the same as the defendant’s eBay listing, but was altered to replace the infringing stethoscope with a non-infringing one.<sup>79</sup> Exemplary images of the test and control eBay listings used in the survey are shown in the figure below.<sup>80</sup>

**Figure 14: Test and Control eBay Listings**



<sup>77</sup> Expert Report of Hal Poret on Likelihood of Confusion Survey Concerning Pradeep Mohan’s Marketing of Stethoscopes on eBay, 3M, No. 09-1413 (Aug. 27, 2010), ECF No. 193-1.

<sup>78</sup> *Id.* at 9.

<sup>79</sup> *Id.* at 4–11. The control also removed infringing word marks and logos. *Id.* at 9–10.

<sup>80</sup> *Id.* at 5, 10.

The defendant, a *pro se* litigant, sought to exclude the plaintiff's survey for a variety of reasons,<sup>81</sup> none of which were accepted by the court.<sup>82</sup> Instead, the court "accorded substantial weight" to the survey, and further found the survey's verbatim responses "illuminating."<sup>83</sup> In particular, the court observed that the "verbatim responses made obvious the inclusion of 3M's trademarks within Defendant's advertisements caused customers to believe that Defendant's stethoscopes were at the very least associated with" the plaintiff's brand.<sup>84</sup>

#### IV. Practice Pointers

Many of the issues that arise in trademark cases discussing product design consumer surveys relate to the choice of control, testing for post-sale confusion, survey bias, and reliance on verbatim responses. Below are general practice pointers to consider with respect to those potential issues. But, it is important to note that survey design and methodology in trademark cases are not one size fits all. The proper survey design and methodology will depend on the particular facts and circumstances of the case.

- **Choice of Control:** In some cases, the choice of control may be one of the more difficult tasks in designing a consumer survey involving a multi-element trade dress, particularly when other non-asserted elements of the product may likewise create associations in the minds of consumers. To that end, it is important to articulate credible reasons for the selection of the control along with record evidence to support that reason. In some instances, it may be appropriate to use more than one control. For example, in *Audemars*, the plaintiff used two control watches, which the defendant challenged because they shared nothing in common with the test stimuli "except for being watches." Nevertheless, the court accepted the plaintiff's reasoning that the control watches were proper because they also validated other aspects of the survey, such as the amount of time consumers were allowed to view the stimuli.

- **Post-Sale Confusion:** While the majority of courts have accepted a post-sale confusion theory, litigants continue to challenge surveys that test post-sale confusion. The court in *OraLabs* agreed that a survey expert testing the post-sale environment does not have a "threshold evidentiary burden" to support their decision "with research on how the public comes into contact with the product." Nevertheless, if a party pursues a post-sale confusion theory, it may want to make that clear to the court and other parties early in the case, and plan to introduce evidence showing that consumers learn about the products in the post-sale environment, including how the products appear in the post-sale environment, to further support the survey design.

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<sup>81</sup> *3M*, 2010 WL 5095676, at \*21 (D. Minn. Nov. 24, 2010). Among other things, the defendant objected to the survey because it "could have been completed by computerized robots in Moscow" instead of doctors and nurses in the United States. *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at \*22.

<sup>84</sup> *Id.*

- Survey Bias: While the “Eveready” method continues to be an acceptable method for conducting a likelihood of confusion survey, many product design surveys use a line-up method that initially exposes consumers to the asserted trade dress. This creates a heightened risk of survey bias, thus, it is important to use a control to mitigate that risk. For example, in *Brighton*, the court rejected a survey using the line-up method because there was no control.

- Verbatim Responses: Consumer psychology demonstrates that consumers are often not conscious of what particular elements caused them to be confused or why they associate a design with a source. Nevertheless, courts continue to reference verbatim responses when crediting, or criticizing, likelihood of confusion surveys. As a result, it is important to understand how the verbatim responses may be perceived, and conduct any necessary follow-up as part of the survey design.