10 Common Myths About Trademark Surveys

By James T. Berger

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Surveys to prove or disprove trademark infringement or likelihood of confusion have been used by attorneys for many years. Unfortunately, many attorneys who should be using surveys shy away from them because they don’t understand the process and are deluded by MYTHS that surround the use of I.P. survey research.

Here are 10 of the most common myths that I encounter from attorneys who have little experience with surveys or have never used surveys to create or destroy evidence. (In my discussion of costs, I can only use my own frame of reference based on the costs that I commonly charge.)

Myth #1 – Trademark Surveys Are Very Costly

There is a commonly held false belief that trademark surveys are dreadfully expensive. This is simply not true. Thanks to modern Internet technology, one can develop a survey focusing on a consumer product or service for as little as $20,000 to $25,000 and this includes: 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 to develop a final report. Many attorneys live with the belief that the combined costs of all these activities fall in the $50,000 to $100,000 range. This simply is a MYTH. Rarely do my consumer Internet surveys go above $25,000.

Surveys start getting more costly when specific target markets or audiences need to be identified and reached. Depending on how difficult it is to reach these target markets, costs can then accelerate. But, for the most part, if we are dealing with consumer products such as packaged goods and/or commonly used services, the costs of doing a survey with 200 to 250 respondents is quite inexpensive.

Myth #2 – Long Lead Times Are Needed to Implement a Survey Project

Along with misconceptions about costs, many attorneys shy away from surveys because they believe it may take a long time to develop and execute a survey and produce results. Just like with costs, the use of Internet panels greatly accelerates the time frame to complete a survey. In most cases, a consumer product or service survey can move from inception to final report in LESS THAN TWO AND A HALF WEEKS.

Myth #3 – Internet Surveys Are Not Accepted by the Courts

In “A Comparative Empirical Analysis of Online Versus Mall and-
and their testimony will build a stronger case. It 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. What is best is to retain one expert and let the other side find a rebuttal expert.

**MYTH #7 – IF YOU ARE CAREFUL YOU CAN PERFORM THE “PERFECT SURVEY”**

A complete MYTH. There is no such thing as the “perfect survey.” In virtually every case, another survey expert can critique your survey. Surveys are not cookie-cutter processes. A rebuttal expert generally will present alternative methodologies. Any expert can be second-guessed by another expert. If you are searching for perfection in a trademark survey, you’ll never find it.

**MYTH #8 – ALL COMMUNICATIONS WITH A SURVEY EXPERT IS DISCOVERABLE**

Some attorneys will shy away from surveys and survey experts because they believe if the findings from the survey weaken the case, the survey expert will be forced to reveal the flaws because of the “discovery” process. While this might be true if the expert is designated a “testifying expert,” it is not necessarily true if the expert is designated a “consulting expert.” An expert can be brought in as a “consulting expert” and be hired to do a pilot survey. If the pilot survey results weaken the case, the expert’s work remains “privileged” and not discoverable. Only when that expert is designated a “testifying expert” is his/her work product discoverable.

**MYTH #9 – ON-SITE SURVEYS ARE EASY TO DO**

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 at trade shows or shopping in stores are not interested in doing surveys. They are there for another purpose. Most retail establishments have policies that do not permit surveys to be done within the store. Getting permission to go into a store to do a survey is difficult. And, there is another problem with the in-store survey – if a product or brands that is sold in that store is on display, it might bias the survey.

**MYTH #10 – IT IS NOT MANDATORY TO DO A PILOT SURVEY**

While intense time constraints sometimes make it impossible to do a pilot survey, 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 of the pilot survey are usually not discoverable. If the results of the pilot survey strengthen the case, the pilot survey can easily be rolled out and form the basis of the full survey. If there are no changes between the pilot and the rolled-out survey, the results from the pilot can be bundled into the total results. The pilot survey provides a good comfort level. The chances are the results from the pilot will be replicated in the rolled-out survey.