The late Beverly Pattishall, our firm’s namesake former partner, presented a pioneering paper at a 1957 John Marshall Law School Symposium in Chicago, entitled “Reaction Test Evidence in Trade Identity Cases.” So great was the demand for copies, that it was republished in 1959 in the Trademark Reporter, the law review of the United States Trademark Association (now known as the International Trademark Association). The paper and the ensuing article were two of the earliest studies advocating the important role that survey evidence could play in trademark cases to assess the consumer’s state of mind and measure the likelihood of confusion as to the source of branded products or services.

Mr. Pattishall reportedly used the term “reaction test” rather than “survey” because of the widespread distrust of public opinion polls and surveys at the time. Indeed, he quoted the *Robin Hood Popcorn* case in the article, which emphasized: “The evidence here is not a survey of public opinion. Rather, it is a test of consumer reaction conducted for the purpose of determining whether or not applicant’s package bearing the mark sought to be registered is likely to cause purchasers and potential purchasers to associate the product packaged therein with opposer or its product.”

Modern terminology, of course, commonly uses the term “survey” to mean a methodically designed, executed, tabulated and reported study, within the relevant consuming public, to determine the likelihood of confusion described in *Robin Hood Popcorn*.

The Pattishall article identified an array of basic principles for assessing a survey’s persuasiveness, many of which are still valid today: “Trustworthiness, reliability, accuracy, complete disclosure, availability for cross-examination, authentication, foundation, interpretation and verification are all concepts that must be accorded a full measure of attention.”

In the intervening half-century (plus) since these early cases and articles, surveys have become quite common in trademark infringement and dilution cases, and in false advertising cases as well. By their sheer number, the “survey cases” are daunting to read, as is the voluminous literature about trademark surveys, how to conduct them and how to attack them. The trend is not limited to the United States. In a panel
discussion of survey evidence moderated by the author at the 2006 AIPPI Congress in Gothenburg, Sweden, lawyers from Argentina, England, France, Japan and the United States agreed that courts in the U.S., U.K., France and many commonwealth and civil code countries will admit survey evidence if the survey has been designed, conducted and interpreted in a scientific, objective, and unbiased manner.5

Many basic principles of trademark survey law that have evolved through the years are embraced by Mr. Pattishall’s summary. For readers wanting a more detailed review, with case citations and judicial guidelines, a more comprehensive article by the author was recently published in the World Trademark Review.6

The hearsay rule was initially an obstacle to admitting surveys into evidence. The testimony in court incorporated questions and answers out of court, by participants unavailable for cross-examination. However, the main arguments to overcome the hearsay obstacle were: (a) the survey results are not hearsay (i.e., not statements submitted to prove the truth of the matter asserted, that products sold under the marks in question do or do not come from the same source; and (b) the survey results show the respondents’ state of mind. One or both of these arguments increasingly prevailed, and today’s Federal Rule of Evidence 803(3) broadly restates the state-of-mind exception.

Modern guidelines for running a survey that will be admissible and persuasive:
- Respondents should be selected from the proper universe.
- They should constitute a representative sample of that universe.
- The resulting data should be accurately reported.
- The data should be analyzed in accordance with accepted principles.
- The survey questions should be clear and not leading.
- Qualified persons should conduct the survey using proper interviewing procedures.7

In addition, certain elements are recommended to be included in a survey report:
- the survey’s purpose;
- a description of the universe and the sample taken from it;
- a description of how respondents in the sample were selected, the interviewing method, validation (post-interview confirmation callbacks), screening criteria used and other pertinent information;
- a description of how many potential respondents were contacted to obtain the final sample and how many interviews were conducted to obtain the final, completed interviews;
- the questions that respondents were asked, including a copy of the questionnaire, interview instructions and exhibits shown;
- a description of how the expert categorised responses;
- an estimate of any sampling error in probability samples; and
- clearly labeled statistical data tables.8

These factors, along with the survey expert’s qualifications and the survey’s control (if any) for “noise,” are the most common battlegrounds for attacking and defending a survey. It is sometimes said that “technical deficiencies” will reduce a survey’s weight, but fundamental flaws will render it inadmissible. In any event, as foreseen by Mr. Pattishall, surveys in trademark cases can serve as powerful evidence, but only if they are designed, executed, interpreted and presented methodically and objectively.

3. Id., at 369.
Thad Chaloemtiarana and Jessica Ekhoff

Thad and Jessica conducted a workshop on “How to Conduct a Trademark Search” as part of Northwestern University School of Law’s 8th Annual Entrepreneurship Law Center Conference, on April 12. Jessica taught the INTA Unreal Campaign class on counterfeiting issues to a group of high school students at Legal Prep Charter Academies, on April 16.

Jonathan S. Jennings and Phil Barengolts

Jonathan spoke on intellectual property issues that are important to entrepreneurs at Northwestern University School of Law’s 8th Annual Entrepreneurship Law Center Conference on March 9. Jonathan also moderated on “Right of Publicity and Social Media” at the INTA Annual Meeting in Dallas on May 7. Jonathan and Phil spoke on “Emerging Trends in Social Media and Mobile Advertising” to the Intellectual Property Law Association of Chicago (“IPLAC”) Corporate Committee on April 10.

Robert W. Sacoff

Bob gave a presentation to the IPLAC Paralegal Committee on “The Ethics of Deception” on April 23.

Belinda J. Scrimenti

Belinda participated in debate panels on “The Blonde, the Red Shoe, the Round-Cornered Rectangles: Debating the Frontiers of Trade Dress Law” at the ABA Intellectual Property Law Conference, in Arlington, Virginia, on April 4. Belinda was also interviewed in a podcast arranged by Bereskin & Parr on the subject (http://iplawpodcast.com/2013/03/02/january-2013-episode-27/).

Joseph N. Welch II

Joe spoke at the Practising Law Institute in New York City on April 18 on “Fame, Functionality, Fraud and Unforeseen Consequences: The Year in Review.”

Jonathan S. Jennings and J. Michael Monahan


Janet A. Marvel

Janet’s article, “Value gained from nontraditional trademarks worth the effort,” was published on January 14, on sportsbusinessdaily.com. Janet also authored “How to Find and Develop Your Company’s Non-Traditional Trademarks,” which was published in the February issue of TD Monthly.

Robert W. Sacoff


Uli Widmaier and Thad Chaloemtiarana

Uli and Thad were quoted by the Chicago Daily Law Bulletin for an article entitled “‘Naked license’ questions develop after justices’ decision on Nike”, on January 14.

PUBLICATIONS

Seth I. Appel

Seth’s article, “U.S. Supreme Court Holds Covenant Not to Sue Can Moot Trademark Invalidity Claim,” was published in the March edition of AIPPI e-News. His article “U.S. Supreme Court Holds ‘First Sale’ Doctrine Applies to Copies of a Copyrighted Work Lawfully Made Abroad” was also published in the May edition of AIPPI e-News.

Phillip Barengolts

Phil was quoted in the Chicago Daily Law Bulletin article, “College athletes may have path to make money,” on March 5.

Ashly Iacullo Boesche


Jessica A. Ekhoff

Pattishall McAuliffe Selected for Gold Band in Prestigious WTR 1000 World Rankings

Pattishall McAuliffe garnered the top gold band ranking among Illinois law firms by the *World Trademark Review 1000*, which ranks trademark firms from 61 nations. The Pattishall McAuliffe team “has remarkable capabilities in both prosecution and enforcement,” said the *World Trademark Review*. The publication recognized “stand-out managing partner Joseph Welch,” saying he is “incredibly well versed in all aspects of trademark law and has a string of successes to his name.” The publication also cited partner Janet Marvel, saying she “crafts finely tuned development strategies” and has “a highly active enforcement practice, which encompasses briefs in the ever-evolving anti-counterfeiting field.” “Jonathan Jennings is also singled out,” the award said, “for his comprehensive trademark nous [mind].” “He is also an acknowledged leader in the closely related arena of publicity rights.”

*World Trademark Review 1000* awards Gold, Silver and Bronze Bands to law firms and individual attorneys after interviews, feedback from peers, and research into the reputations and capabilities of the firms and its attorneys.