Survey evidence in trademark cases throughout Europe: Where do we stand?

AIPPI World Intellectual Property Congress:
"Market surveys in legal proceedings"
Workshop IV: Use of survey evidence in trademark cases
Toronto, September 16, 2014
Europe: Trade mark offices that issued guidelines on survey evidence

Finnland (NBPR 2007)
United Kingdom (IPO 2012)
Germany (DPMA 2009)
OHIM (2014)
Switzerland (IGE 2011)
ECJ: Surveys are "guidance for judgments" on distinctiveness

ECJ, C-217/13 and C-218/13 – Colour Red/Oberbank

43 "It should also be stated that Union law does not preclude the competent authority, where it has particular difficulty in assessing the distinctive character acquired though use of the mark in respect of which registration or a declaration of invalidity is sought, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Windsurfing Chiemsee EU:C:1999:230, paragraph 53 and the case-law cited). If the competent authority finds it necessary to resort to such a survey, it must determine the percentage of consumers that would be sufficiently significant (see, by analogy, Case C-487/07 Budejovický Budvar EU:C:2009:521, paragraph 89)."
OHIM: More than 1,800 decisions with survey evidence

Total = 1,825 cases

Number of OHIM decisions

<table>
<thead>
<tr>
<th>Year</th>
<th>Cases</th>
</tr>
</thead>
<tbody>
<tr>
<td>1996-1998</td>
<td>3</td>
</tr>
<tr>
<td>1999-2000</td>
<td>71</td>
</tr>
<tr>
<td>2001-2002</td>
<td>111</td>
</tr>
<tr>
<td>2003-2004</td>
<td>203</td>
</tr>
<tr>
<td>2005-2006</td>
<td>310</td>
</tr>
<tr>
<td>2007-2008</td>
<td>400</td>
</tr>
<tr>
<td>2009-2010</td>
<td>395</td>
</tr>
<tr>
<td>2011-2012</td>
<td>226</td>
</tr>
<tr>
<td>2013-2014</td>
<td>106</td>
</tr>
</tbody>
</table>

Basis: Content analysis of OHIM decisions 1996 - 2014, figures for 2013 - 2014 preliminary
Source: Allensbach Archives 2014
"Opinion polls and surveys

Opinion polls concerning the level of recognition of the trade mark by the relevant public on the market in question can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to be truly neutral and representative. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys."
OHIM: Examination guidelines, part B (2014, Section 4) at 2.12.8.4:

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Opinion polls concerning the level of recognition of the trade mark by the relevant public on the market in question can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to be truly neutral and representative. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys."

In practice
Examiners will check three core aspects:
- neutral sample
- neutral questionnaire
- analysis
ECJ: In invalidity proceedings burden of prove concerning distinctive character is on the proprietor

ECJ, C-217/13 and C-218/13 – Colour Red/Oberbank

68 "In view of that objective and the structure and purpose of Article 3(3) of Directive 2008/95, the Court finds that, in the context of invalidity proceedings, the burden of proof concerning distinctive character acquired following the use which has been made of the mark at issue must be borne by the proprietor of that mark which invokes that distinctive character."
Europe: 3-step-test for measuring acquired distinctiveness

Survey needs to address relevant public (= actual and prospective purchasers of the goods/services applied for)

Question wording

**STEP 1** Awareness in relation to the specific good or service being applied for

"Are you familiar with abc in relation to xyz-products?"
Europe: 3-step-test for measuring acquired distinctiveness
Survey needs to address relevant public (= actual and prospective purchasers of the goods/services applied for)

**Question wording**

**STEP 1**  Awareness in relation to the specific good or service being applied for

"Are you familiar with abc in relation to xyz-products?"

**STEP 2**  Exclusive attribution to only one single source

"Is abc made by only one single company or is it not made by any specific company?"
Europe: 3-step-test for measuring acquired distinctiveness

Survey needs to address relevant public (= actual and prospective purchasers of the goods/services applied for)

**Question wording**

<table>
<thead>
<tr>
<th>STEP 1</th>
<th>Awareness in relation to the specific good or service being applied for</th>
<th>&quot;Are you familiar with abc in relation to xyz-products?&quot;</th>
</tr>
</thead>
<tbody>
<tr>
<td>STEP 2</td>
<td>Exclusive attribution to only one single source</td>
<td>&quot;Is abc made by only one single company or is it not made by any specific company?&quot;</td>
</tr>
<tr>
<td>STEP 3</td>
<td>Identification of that source</td>
<td>&quot;What is the name of the company?&quot;</td>
</tr>
</tbody>
</table>
Europe: 3-step-test for measuring acquired distinctiveness

Example: 3d-shape of an unwrapped chocolate candy
Determination of end result: Interrelated analysis of the three steps

Base: Total population, Germany

95% - Awareness

68% - Exclusive attribution to only one source

66% - End result = Share of relevant public that is aware of the sign and at the same time attribute it to only one source and at the same time do not name wrong brand/company

Basis: Federal Republic of Germany, Population 16 and over
Source: Allensbach Archives, IfD Survey 7069, April 2005
Europe: Test approaches for measuring 'mark with reputation' suggested by GCEU

<table>
<thead>
<tr>
<th>Type of mark:</th>
<th>Required active knowledge:</th>
</tr>
</thead>
<tbody>
<tr>
<td>Word mark</td>
<td>&quot;What marks do you know in relation to xyz-goods/services?&quot;</td>
</tr>
<tr>
<td></td>
<td>(&quot;brand recall&quot;)</td>
</tr>
<tr>
<td>Non-traditional marks (3d-marks, colour marks etc.)</td>
<td>Presentation of marks</td>
</tr>
<tr>
<td></td>
<td>- not mentioning any category of goods/services</td>
</tr>
<tr>
<td></td>
<td>- in context with other marks of the same type</td>
</tr>
<tr>
<td></td>
<td>&quot;Which of these do you know?&quot;</td>
</tr>
<tr>
<td></td>
<td>&quot;Which goods/services are available under this trademark?&quot;</td>
</tr>
</tbody>
</table>

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