



2019 Study Question

Submission date: May 24, 2019

Jonathan P. OSHA, Reporter General
Ari LAAKKONEN and Anne Marie VERSCHUUR, Deputy Reporters General
Guillaume HENRY, Ralph NACK and Lena SHEN, Assistants to the Reporter General

Consumer survey evidence

Responsible Reporter(s): Lena SHEN and Anne Marie VERSCHUUR

National/Regional Group	Norway
Contributors name(s)	Amund Brede SVENDSEN
e-Mail contact	abs@gjessingreimers.no

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

1.a Is consumer survey evidence in principle admissible in trademark proceedings? Please answer YES or NO.

Yes

Please Explain

1.b Are there specific statutory provisions in your law governing consumer survey evidence?

If YES, what do they state and do they specifically concern trademark matters or do they have a more general nature?

No

Please Explain

If you have answered NO to Q1)a), please skip Q2)-Q5) and proceed to Q6); If you have answered YES to Q1)a), please proceed to Q2).

2.a Is consumer survey evidence admitted in all types of trademark proceedings (see also para. 13 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Yes

Please Explain

2.b If consumer survey evidence is not admitted in all types of trademark proceedings, in which types is it admitted and in which types is it not (e.g. opposition proceedings, revocation, proceedings, infringement proceedings)?

N/A

3.a What can consumer survey evidence prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Consumer survey evidence can be used to prove or help prove: the right to an unregistered mark based on use; acquired distinctivity; reputation; confusion / perception of connection.

3.b What is consumer survey evidence most used for in practice to prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Consumer survey evidence is most used to prove or help prove acquired distinctivity and whether trademark rights are established through use.

4.a Are there specific requirements for surveys, e.g. as to the way of conducting the survey (e.g. internet or email survey, telephone survey, shopping mall interrupt surveys), the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls? If so, which?

No

Please Explain

No specific requirements for consumer surveys have been set out in Norwegian statutes. As regards case law, the Supreme Court included some interesting statements in the so-called "Colour purple" judgement in 2017 (HR-2017-2356-A, GlaxoSmithKline Norway AS vs. Sandoz A/S and Novartis Norge AS).

In its opinion, the S.C. noted that *"to establish how widespread the knowledge of a sign, or, as in the present case, a colour, is, as a specific mark for something, it may be obvious to conduct various market surveys, and depending on the circumstances great importance may have to be attached to them. This is not controversial. How much weight one should put on a survey, will have to be assessed in the specific case."*

The S.C. also referred to the appellant having *"strongly emphasized that in international practice it has been established that the methodology used in the survey [note: the surveys conducted by the appellant party] is the right one. In particular, the so-called "three step method has been referred to, which has been said to be generally used in Germany, and it was argued [note: by the appellant party] that it would be unfortunate if in Norwegian law different rules were to apply for such surveys, than in the rest of Europe. In that regard, reference has been made, in particular, to the German Supreme Court's judgement in the Sparkassen case, BGH, 21 July 2016, in case no I ZB 52/15."*

The justice that wrote the unanimous opinion of the S.C. also noted that *"I find no reason to go into details with regard to what requirements should apply to such market surveys; it is abundantly clear that there is no method that can be relied upon as satisfactory without assessing if the method answers the particular questions which the case raises. [...] The market surveys will be a part of the overall assessment of evidence."*

4.b If your answer to Q4a) is NO, what characteristics do surveys generally have, e.g. as to the way of conducting the survey, the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls?

It is difficult to point out characteristics that consumer surveys generally have in Norway. There is a variety of ways in which surveys are conducted. Very often the methodologies applied are challenged in litigation, especially on account of the selection of respondents or the relevance of the group of respondents, the formulation of questions, and the lack of controls.

5.a Are specific percentages of respondents answering certain questions required or sufficient to prove certain items? If so, which?

No

Please Explain

No specific percentages of respondents answering certain questions are required or sufficient to prove any items.

5.b What percentages of respondents answering certain questions are typically deemed insufficient?

There are no specific percentages that are deemed insufficient as such. Each case should be assessed individually taking into account the specific circumstances of the case.

6 Is the court or IP office involved in the set-up of the survey, or can it be, and, if so, to what extent?

No

Please Explain

No, the court or IP office will not be involved in the set-up of the survey, but the court could be, e.g. if the court itself appoints an expert.

7 What weight or value is generally given by the court or IP office to consumer survey evidence, if such is admitted, and which factors are relevant in considering the extent of such weight or value?

The Court (and the IP office) applies a free assessment of all the evidence offered by the parties. For the determination of acquired distinctiveness, establishment of a TM by use, and reputation, survey evidence will be considered relevant, but seldom as the sole evidence relied upon. The courts can be quite critical in their evaluation of survey evidence.

II. Policy considerations and proposals for improvements of your Group's current law

8 Could any of the following aspects of your Group's current law or practice relating to consumer survey evidence be improved? If YES, please explain.

8.a Types of trademark proceedings in which survey evidence is admissible;

No

Please Explain

8.b What survey evidence can prove or help prove;

No

Please Explain

8.c Requirements of surveys;

No

Please Explain

8.d The application, or lack thereof, of bench-mark percentages;

No

Please Explain

8.e The weight or value given to consumer survey evidence.

No

Please Explain

9 Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

Please Explain

The Norwegian group considers that the present system, in which the use and assessment of consumer survey evidence is governed by the general principles and rules on evidence and expert evidence that apply in civil disputes, works satisfactorily, and does not need to be changed.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

10 Do you believe that there should be harmonisation in relation to consumer survey evidence?

No

Please Explain

The Norwegian group believes that consumer survey evidence is often relevant and useful in trademark cases, and that it is generally desirable that this type of evidence should be admissible in some form in all jurisdictions. However, the use and evaluation of consumer survey evidence is, in many jurisdictions, governed by the general provisions applying to the submission and use of evidence in litigation, and should therefore not be the object of efforts to harmonise. The efforts required to achieve harmonisation in this area would likely be disproportionate.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

11 Should consumer survey evidence in principle be admissible in trademark proceedings? Please answer YES or NO.

Yes

Please Explain

Consumer Survey evidence should be admissible in trademark proceedings.

2.a Should consumer survey evidence be admitted in all types of trademark proceedings (see also para. 13 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Yes

Please Explain

2.b If consumer survey evidence should not be admitted in all types of trademark proceedings, in which types should it be admitted and in which types should it not be admitted (e.g. opposition proceedings, revocation, proceedings, infringement proceedings)?

N/A

13 What should consumer survey evidence be allowed to prove or help prove (e.g. confusion, acquired distinctiveness; see also para. 14 in the full text of the Study Guidelines which can be found at the top of this webpage)?

Consumer survey evidence should be allowed to prove or help prove any matter in trademark proceedings.

14 Should there be specific requirements for surveys, e.g. as to the way of conducting the survey (e.g. internet or email survey, telephone survey, shopping mall interrupt surveys), the number and selection of respondents, the appropriate form and order of survey questions and the use or nature of controls? If so, which?

No

Please Explain

The Norwegian group believes that there should be no specific requirements for consumer surveys. What can be considered as reasonable

and adequate requirements will often be case-specific, and there is no reason to try to legislate on what requirements should apply. The group believes that it is better to leave it to the courts to decide, i.a. on the basis of expert evidence, if a survey submitted in evidence was conducted in an adequate way, applying a reliable methodology.

5.a Should specific percentages of respondents answering certain questions be required or deemed sufficient to prove certain items? If so, which?

No

Please Explain

Specific percentages of respondents answering certain questions should not be required to prove certain items.

5.b What percentages of respondents answering certain questions should be deemed insufficient?

N/A

16 Should the court or IP office be involved in the set-up of the survey and, if so, to what extent?

Yes

Please Explain

Only if the court decides to appoint an expert to investigate a question, it may be necessary for the court to become involved with the set-up of a survey. That would be in the context of determining the mandate of the expert.

17 What weight or value should be given by the court or IP office to consumer survey evidence, if such is admitted, and which factors should be relevant in considering the extent of such weight or value?

Survey evidence should be assessed in the same way as other evidence: freely. The judge must ask herself if in the light of the survey, and any other evidence submitted, the fact which the survey purports to prove, is proven, i.e. has a higher probability of being true than of being false (preponderance of probability).

The factors to take into account when assessing the survey include everything relevant to the reliability of the survey, e.g. was it conducted in a scientifically correct way.

18 Please comment on any additional issues concerning any aspect of consumer survey evidence you consider relevant to this Study Question.

Image not readable or empty

file:///C:/Users/AmundBredtSvendsen/AppData/Local/Packages/oice_116_974fa576_32c1d314_31ff/AC/Temp/msohtmlclip1/01/clip_image002.gif

s.

19

Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

The Norwegian group had input of views from the consumer goods industry.