



2019 Study Question

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Consumer survey evidence

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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

It is indeed admissible, but the person that conducted the survey will be subject to examination and cross examination. Also, the court is entitled to order its own survey evidence (the court may decide to order it or not), and the court's expert's fees would have to be paid by the party that announce the conduction of the survey.

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?

Yes

Please Explain

The rules that apply are the ones contemplated by our Civil Procedure Code for expert testimonies. Therefore, the person conducting the survey must be a marketing expert and must prove his/her qualifications before the court.

The procedural provisions also state that the survey report must be ratified by the person that carried it out and that individual will be subject to examination and cross examination.

In addition, the court is entitled to order its own survey evidence (the court may decide to order it or not), and the court's expert's fees would

have to be paid by the party that announce the conduction of the survey.

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

It can be filed in trademark registration proceedings, opposition, nullity, and cancellation proceedings as well as in trademark infringement actions.

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)?

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)?

It can help prove confusion, acquired distinctiveness, recognition, reputation, dilution.

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)?

Confusion, recognition, and reputation.

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, the method to be followed in conducting a consumer survey depends completely on the expert's decision, but it must be duly documented.

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?

Shopping mall surveys.

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

No

Please Explain

No, the law does not set forth any specific percentage requirements.

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

There is no case law on this issue, but considering our courts' trends, we believe less than 60% would be deemed insufficient.

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, it is not. However, the court may decide to conduct its own survey and appoint an expert to that effect. In that case, the court's expert's fees are to be paid by the party that announced the conduction of a survey.

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?

If it is shown that the survey was well conducted and is reliable, and the position intended to be proven is supported by a significant percentage (more than 60%), it will have great value.

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

It is already admissible in all type of trademark proceedings.

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

No

Please Explain

Because the law does not limit the type of survey evidence that can be used.

8.c Requirements of surveys;

Yes

Please Explain

The court's right to appoint its own expert to carry out a survey should be abolished or if maintained, then, the court's expert's fees should be paid half and half by each party, respectively.

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

No

Please Explain

Because right now there are no specific requirements in the law and that gives more discretion to the courts to admit and value survey evidence.

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

No

Please Explain

Because it would not be possible under our procedure rules as they leave all valuation of evidence to the sound and reasonable criteria of the judges.

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

We believe broad and general rules are better for this type of evidence than specific and limiting rules.

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

It seems to us that it would be very difficult to harmonize legal provisions on consumer survey evidence globally because each jurisdiction has its own rules of procedure.

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

Because it could be an important tool in showing confusion, acquired distinctiveness, recognition, and reputation.

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

Our law already allows consumer survey evidence in all types of trademark proceedings.

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)?

Confusion, acquired distinctiveness, recognition, reputation, and dilution.

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 expert should have ample discretion to define the way of conducting the survey.

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

This should rest on the judges' sound and reasonable criteria.

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

None. This should rest on the judges' sound and reasonable criteria.

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

No

Please Explain

Because the expert conducting the survey should have ample discretion to do so.

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?

This should be left to the judges' sound and reasonable criteria.

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

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

None. We could not contact any industry sector.