

MRIA CODE OF CONDUCT FOR MARKET AND SOCIAL MEDIA RESEARCH

Appendix “N”

SOCIAL SCIENCE AS EXPERT EVIDENCE

Appendix N – Social Science as Expert Evidence

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Executive Summary

This Appendix to the Standards of the Market Research and Intelligence Association was originally adapted by Ruth Corbin, PhD., LL.D from a chapter prepared for the electronic Benchbook of the Federal Court of Canada, and subsequently modified for publication by Carswell in its 2014 *Canadian Trademark Law Benchbook*. As an Appendix to MRIA standards, it conveys to members the understanding and expectations held by the law profession in Canada, with respect to the value that can be provided, through market research products, for the administration of justice.

Market research is of interest as expert evidence when it adheres to scientific principles. Survey research has been the branch of social science most frequently relied upon as expert evidence in Canadian courts of law and regulatory forums. This Appendix reviews not only the standards and status of survey research in Canadian law, but also the emerging alternatives to survey evidence that have been increasing in frequency in recent years.

Surveys and others forms of social science evidence may be of evidentiary assistance to a court, whenever a factual issue can be translated into an unambiguous description of what a segment of the public experiences, infers, believes, or intends to do.

In trademark disputes, surveys have been offered into evidence with respect to a number of legal issues, including the following:

- Likelihood of confusion
- Trademark reputation or fame
- Trademark distinctiveness
- Genericism/descriptiveness
- Input to valuation or damage calculations

Surveys also have application in copyright matters, such as in establishing licensing fees and tariffs under the jurisdiction of the Copyright Board of Canada. Surveys continue to be used in misleading advertising disputes, including those heard in trade dispute cases before the regulatory body, Advertising Standards Canada. Finally, survey evidence has played a selective role in addressing patent disputes regarding what would be obvious or non-obvious to a person trained in the relevant art.

Reliability, validity, and relevance are the three criteria by which the probative value of surveys may be weighed. These criteria have been endorsed by the Supreme Court of Canada as the primary framework for evaluation, and they intuitively make sense because a sample survey is a measuring instrument, and reliability, validity, and relevance are germane to the evaluation of a measuring instrument. Consider values generated from repeated use of a bathroom scale by the same individual. Values from a reliable scale would be tightly bunched together; but there could still be a calibration error—say, a consistent overestimation of weights by five kilos. Therefore, a reliable scale is not necessarily valid. If the scale is both reliable and valid, values generated under repeated use would be closely bunched around the individual's correct weight.

Of course, if the objective is to measure one's blood pressure, the values produced by a reliable and valid scale would not be relevant.

Reliability, as a statistical concept, relates to the precision of a survey as a measurement instrument; the ability of a given sampling methodology, in repeated application to a given population, to generate tightly bunched estimates for a population parameter. Validity addresses the extent to which a survey measures exactly what it sets out to measure in its stated objectives. Written decisions have not always distinguished reliability and validity in a manner consistent with scientific practice. Relevance addresses the extent to which the survey offers probative evidence on an issue to a party's claim. A survey may measure what it sets out to measure, but the survey objective may not be in sync with or relevant to the legal issue.

There can never be a perfect survey. Privacy and security concerns continue to strain response rates, making perfect random samples impossible. Different methodology options for litigants (including those that employ emerging technologies) oblige trade-off decisions among cost, speed, rigour, reliability, feasibility, and practicality. A court's confidence in the value of any given survey evidence should be greater in instances where survey witnesses are able to support their choices with reference to scientific authorities, precedents, or "best practices". To that end, the Marketing Research and Intelligence Association of Canada established an expert committee (the "Dispute Resolution Committee") to act as a resource to the legal profession and judiciary on published authorities and best practices, and to advise litigants and case managers on what enlightenment survey research could or could not provide for resolving a dispute.

Opponents to surveys will always find something to criticize. Some criticisms may be material to the evidentiary issues, while others may be of little consequence. Opponents should be expected to demonstrate, with credible support, that the flaws they bring to the attention of the court are ones that could have materially altered the results.

1. SURVEYS AND RELATED EVIDENCE—THE SCOPE OF APPLICATION

Survey research is a tool of social science. Surveys are used to collect information from large groups of people, in order to enumerate their characteristics, or to describe people's beliefs, attitudes, behaviour, or intentions. Surveys may also assemble information about objects, sales records, households, or any set of units to which objective, quantitative measurement is applied. When conducted to a scientific standard, surveys have been routinely admitted as evidence in litigation and in other procedures for dispute resolution. Canadian courts have explicitly recognized the pertinence and potential value of survey evidence.² Litigants have been criticized for deficiencies in evidence, when a survey could have provided assistance to their case.³

Surveys are useful, and sometimes necessary, whenever a statement of fact or law depends on what a segment of the public experiences, infers, believes, or intends to do.⁴ In trademark disputes, surveys have been offered into evidence with respect to a number of legal issues, including the following:

- Likelihood of confusion⁵
- Trademark reputation or fame⁶
- Trademark distinctiveness⁷
- Genericism/descriptiveness⁸
- Input to valuation or damage calculations⁹

Surveys have broad application in other intellectual property matters as well, such as establishing fair copyright tariffs based on use of copyrighted works, assessing whether an advertisement misleads or not, and addressing patent disputes regarding what would be obvious or non-obvious to a person trained in the relevant art. More generally, because intellectual property consists of "products of the mind," surveys and related methods of social science are frequently necessary to revealing what goes on in the minds of consumers, for purposes of applying the law.

² In Canada, frequent reference has been made to the analysis of Justice Macfarland in *Sun Life Assurance Co. of Canada v. Sunlife Juice Ltd.* (1988), 65 O.R. (2d) 496, 22 C.P.R. (3d) 244, 20 C.I.P.R. 87 (Ont. H.C.) at p. 249 [C.P.R.] as a watershed in Canadian jurisprudence concerning survey evidence, an excerpt being provided in section 2 of this Appendix. The text *Survey Evidence and the Law Worldwide* (Corbin, R. M. and Gill, A. K., Butterworth, 2006) provides a comprehensive compilation of case law and standards.

³ *Insurance Corp. of British Columbia v. Stainton Ventures Ltd.*, 2012 BCSC 608 (B.C. S.C.) at para. 24, quoting Gibson J., "It was open to the plaintiffs to bring direct evidence from those alleged to have been led into mistake or confusion, but such evidence was not forthcoming. Equally, it was open to the plaintiffs to bring their own independent survey evidence and they chose not to do so."

⁴ The term of art is "operationalizing" a factual aspect of law into measurable survey objectives. Success in operationalizing requires design of specific and plausible surrogate measurements of the underlying belief, attitude, inference or intention stated or implied in the relevant statute.

⁵ *McDonald's Corp. v. Cheah*, 2012 TMOB 138 (T.M. Opp. Bd.).

⁶ *Coca-Cola Ltd. v. Industries Lassonde Inc.*, 2012 TMOB 84 (T.M. Opp. Bd.).

⁷ *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada*, 2007 FC 580 (F.C.), affirmed 2008 CarswellNat 688 (F.C.A.), leave to appeal refused 2008 CarswellNat 3236 (S.C.C.); *Bayer AG v. Marcon*, 2011 TMOB 9 (T.M. Opp. Bd.).

⁸ *Bodum USA Inc. v. Meyer Housewares Canada Inc.*, 2012 FC 1450 (F.C.), affirmed 2013 CarswellNat 3642 (F.C.A.).

⁹ *Lucent Technologies, Inc. v. Microsoft Corp.*, No. 07-CV-2000, ECF No. 1478 (S.D. Cal. Nov. 10, 2011) at pp. 14–19, a U.S. patent case providing illustration of how surveys of consumers potentially affected by infringements can provide input to damages calculations.

This Appendix also addresses other tools for collecting market information from large populations, that is, variations of the question-and-answer model traditionally associated with survey methodology. One such variation is "mystery shopping,"¹⁰ in which encounters with sales staff are undertaken by research personnel posing as shoppers, in order to determine what actual shoppers would likely experience. Another variation is structured searches of Internet communications, using objective search rules and scientific research design¹¹—and these structured searches usually do not produce 'probability' samples ('probability' samples are generated by using scientifically designed probabilistic processes to select a sample from a well-defined population). What all such variations have in common is the collection of information from a large number of sources, governed by the scientific method and statistical inference. With the increasing array of emerging research technologies, and inconsistency in how scientific standards are interpreted by different courts, the Marketing Research and Intelligence Association of Canada (the governance body for Canada's survey industry) established, in 2010, a Dispute Resolution Committee¹² to advise the legal profession on Canadian industry standards and best practices.

2. ACCEPTABILITY AND NECESSITY

The initial barrier to admissibility of survey evidence was the perception that surveys offended the rule against hearsay. This view was based upon the mistaken assumption that respondents' answers were being offered for the truth of the contents. It has since become understood that the evidence associated with the survey is the *expert opinion*, based upon conclusions reasonably drawn or inferred from the whole of the survey. As the Supreme Court of Canada has stated:

The more recent practice is to admit evidence of a survey of public opinion, presented through a qualified expert, provided its findings are relevant to the issues and the survey was properly designed and conducted in an impartial manner.¹³

Once accepted as not offending the hearsay rule, surveys were initially greeted with a certain judicial exuberance:

To attempt to make such a determination [of confusion] without regard to evidence of what others may think or have said would to my mind be nothing more than an exercise in pure judicial fantasy and of not much assistance at all.¹⁴

That generalized exuberance has since been tempered with a healthy judicial concern for the scientific integrity of the evidence. Courts:

... [H]ave indicated a willingness to accept expert evidence of surveys...as long as it can be demonstrated that approved statistical methods and social science research techniques have been employed. With respect to this kind of evidence, the

¹⁰ E.g. as accepted in *Bodum USA, Inc. v. Meyer Housewares Canada Inc.*, 2012 FC 1450, used in evidence cited in *Imperial Tobacco Canada Limited/Marlboro Canada Limited v Philip Morris Brands Sàrl*, 2014 TMOB 219 and as accepted in *Victoria's Secret Stores Brand Management Inc. v. La Senza Inc.*, 2006 CarswellOnt 2540 (Ont. S.C.J.). For a 2009 state-of-the-discipline review, see Corbin, R. M. and Carnegie, S. "Mystery shopping raised to scientific evidence," in *Vue*, Sept. 2009, pp. 26-29.

¹¹ As relied upon by the court in *Bodum USA Inc. v. Meyer Housewares Canada Inc.*, 2012 FC 1450. The Trademarks Opposition Board finds them frequently useful for factual evidence when governed by objective rules, as in *Forest Stewardship Council v GH Imported Merchandise & Sales Limited*, 2014 TMOB 99.

¹² formerly named the Litigation and Regulatory Resource Committee, <http://mria-arim.ca/contact-us/committees/litigation-and-regulatoryresources-committee>.

¹³ *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772 (S.C.C.) at para. 43.

¹⁴ *Sun Life Assurance Co. of Canada v. Sunlife Juice Ltd.* (1988), 65 O.R. (2d) 496, 22 C.P.R. (3d) 244, 20 C.I.P.R. 87 (Ont. H.C.).

courts have been more concerned about the procedures and techniques utilized by the experts than they have been about the hearsay aspect of such evidence.¹⁵

Adherence to the scientific method where surveys are concerned involves (a) setting a hypothesis for what is to be investigated, (b) predicting what results would prove or disprove that hypothesis, (c) designing a data-collection instrument that puts the prediction to a test, (d) controlling for alternate explanations that might produce the same results, (e) collecting and tabulating data in an objective fashion, and (f) drawing a statistical inference about the overall population of interest.

The Supreme Court of Canada, writing in its 2011 *Masterpiece* decision,¹⁶ urged a closer scrutiny of the *necessity* of survey evidence, particularly if it risked distracting from, rather than assisting with, the court's analysis, and if consumer confusion could be reasonably anticipated based on a judge's common sense. The Market Research and Intelligence Association of Canada reviewed the *Masterpiece* analysis in detail and issued an industry opinion that:

... [D]irect interviews with consumers or observation of consumer behaviour remain the most statistically reliable source of conclusions about what the relevant consumer population is likely to perceive when it comes to brands and trademarks. Surveys of sufficient size and properly-selected sample are able to provide a reasonably accurate report of the perceptions of the average consumer.¹⁷

3. CRITERIA FOR EVALUATION – OVERVIEW OF RELIABILITY, VALIDITY, AND RELEVANCE

There is no perfect survey.

Reliability, validity, and relevance are the three criteria by which the probative value of survey evidence may be weighed. These criteria have been endorsed by the Supreme Court of Canada as the primary framework for evaluation: The paragraph below captures in simple terms the statistical principles underlying the provision of survey evidence.

“As to the usefulness of the results, assuming they are elicited by a relevant question, courts have more recently been receptive to such evidence, provided the survey is both reliable (in the sense that if the survey were repeated it would likely produce the same results) and valid (in the sense that the right questions have been put to the right pool of respondents in the right way, in the right circumstances to provide the information sought).”¹⁸

The comment “the right questions have been put to the right pool of respondents in the right way, in the right circumstances” speaks in simple terms to four types of potential errors associated with sample surveys—sampling, coverage, measurement, and non-response. ‘Sampling’ error measures the reliability of a scientifically designed probabilistic sampling method. ‘The right pool of respondents’ refers to both ‘coverage’ and ‘non-response’ errors. ‘Coverage’ error addresses the need for a sample to be representative of the pertinent population—to reflect its characteristics. For example, the use of landlines for a survey on a general population will exclude respondents who have only cell phones (a distinct subgroup of the general population and hence compromise the ability of the sample to reflect population characteristics. ‘Coverage’

¹⁵ Sopinka, J. and Lederman, S. N., *The Law of Evidence in Civil Cases* (Toronto: Butterworth, 1974) at 321-322.

¹⁶ *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 (S.C.C.).

¹⁷ <http://www.mria-arim.ca/NEWS/AdvisorySupremeCourt.asp> as at March 15, 2013.

¹⁸ *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772 (S.C.C.) at para. 45.

errors resulting from non-response can occur in a survey measuring tax payment compliance. Citizens who do not properly follow tax laws will be the most uncomfortable filling this survey and will be more likely to refuse—likely resulting in a more law-abiding sample compared to the overall population. ‘The right question’ refers to ‘measurement’ errors. Survey questions must be aligned with survey objectives—the right wording, scales, and metrics must be used. Measurement errors can also result from questions not executed ‘in the right way’ or under ‘the right circumstance’, and this would include position bias, bias introduced by preceding questions, or even interaction between the respondent and interviewer in the case of sensitive questions.

The measurement and control of reliability is possible only for a survey involving a scientifically-designed probability sample. The reliability of a statistical estimate is often specified by stating a sampling error and associating this error with a specified level of confidence. One will often hear that the results of a national election are predicted within three percentage points, with 95 percent confidence. This means that if the survey were to be repeated, the results would be within three percent of the true population value for the percentage, 95 percent of the time. Standards of reliability have been well-documented.¹⁹ Reliability is directly related to the amount of information in a sample—and this is a function of sample size and variation intrinsic to the data collected (assessed typically by estimates of data variation from similar surveys). The statistical equivalent of a valid estimate is the idea of an unbiased estimate—in repetitions of a survey, unbiased estimates will cluster around the true population parameter. Examples of unbiased estimates are the mean and proportion from a representative sample, and unbiased estimates can be generalized to the wider target population’s value. When estimation of a population parameter is unbiased, the sampling error refers directly to the ‘error in estimation’—the deviation of the sample estimate from the true value for the population parameter.

Often because of considerations related to cost speed or convenience, a scientifically-designed probability sample may be impractical; instead a ‘non-probability’ sample is generated. ‘Non-probability’ samples are often structured searches of Internet communications, using objective search rules and scientific research design. The statistical challenge is then the determination of appropriate weighting variables to ensure that results reflect those from a representative sample. Primary candidates are key characteristics of the pertinent population or variables correlated to population parameters of interest.

Validity refers to the extent to which a survey measures what it sets out to measure in its stated mandate or objectives.²⁰ Validity is tied directly to the matters under study, and requires customized attention on each survey occasion.

Further information on reliability and validity are covered in Appendix D – Guidelines on scientific integrity and completeness of reporting.

Relevance concerns the extent to which the survey offers probative evidence on an issue to a party's claim. Relevance should be distinguished from validity. Validity is to be assessed against the survey's objectives, while relevance refers to the connection between the objectives and the legal issues that must be decided by the court. A survey's objectives may be relevant to an issue under consideration by the court, but the

¹⁹ The Market Research and Intelligence Association, the Canadian society for market research professionals, has published recommended best practices at <http://mria-arim.ca/about-mria/standards/code-of-conduct-for-members>; the American Association for Public Opinion Research has published recommended best practices at http://www.aapor.org/For_Researchers/4228.htm; and a publication of best practices prepared jointly by the International Chamber of Commerce and ESOMAR, the latter originally representing Europe, contains an “International Code of Marketing and Social Research Practice” at <http://www.esomar.org/index.php/codes-guidelines.html>. All website information was current as of August 2013. Elaboration on how such standards have been applied to litigation evidence is contained in Corbin, Ruth M. and Gill, A. K., *Survey Evidence and the Law Worldwide* (Toronto: Butterworth, 2006).

²⁰ See e.g. Kaplan, Robert M. & Saccuzzo, Dennis P., *Psychological Testing: Principles, Applications and Issues* (Monterey: Brooks/Cole Publishing, 1982) at 115-135.

survey questions may be inadequate to address the objectives; this is a problem with validity. In contrast, a survey's questions may properly and reasonably address an objective, but the objective may be irrelevant to the issue before the court - this is a relevance problem. In the latter situation, otherwise valid and reliable surveys are to be excluded where the surveys have not addressed a legal issue in dispute.²¹

Relevance of survey evidence is a matter of law for the court to determine and for counsel to address. Relevance is not usually a matter for the survey expert to opine on. Survey experts have been criticized for taking the liberty of commenting on relevance, especially where it crosses the line of advocacy.²² Triers of fact have not hesitated to discount a survey entirely if it is deemed to be irrelevant to the issue at hand, for example, if the survey examines a mark in the wrong context or in association with the wrong wares,²³ or in respect to an issue not directly before the trier of fact.²⁴

4. ASSESSING "RELEVANCE" IN TRADEMARK PROCEEDINGS

Relevance of specific survey designs for particular trademark issues is determinable on an issue-by-issue basis. However, certain survey design templates have gained wide use and approval for addressing specific issues of trademark law. Canadian law will be the primary source of authority for triers of fact, but reference to foreign decisions should be made where helpful. That is because certain basic principles of social and cognitive science, measurable by surveys and other methods, hold true no matter what the legal jurisdiction.

4.1 Likelihood of Confusion

Likelihood of confusion is the primary issue to be determined in the clear majority of trademark cases. In particular, the issue of confusion comes squarely into play in three instances: 1) the registrability and validity of trademarks;²⁵ 2) deemed infringement pursuant to section 20 of the *Trademarks Act*; and 3) passing off at common law and under section 7 of the *Trademarks Act*. In all these instances, the Court or the Registrar must determine whether one trademark is confusing with another trademark or trade-name.

With one exception, applicable only to passing off actions,²⁶ the issue of confusion is determined in exactly the same manner in all such proceedings.

Section 6 sets out the circumstances under which confusion is said to occur in law. The words "would be likely to lead to the inference" in section 6(2) of the *Act* make it clear that the plaintiff is not required to show that the defendant's mark is the same or even nearly the same as the registered trademark. It is

²¹ As the Supreme Court of Canada stated in *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772 (S.C.C.) at para. 44: "If the survey is not responsive to the point at issue, it is irrelevant and should (as the Federal Court of Appeal held) be excluded on that ground alone." See also *Canada Post Corp. v. Mail Boxes Etc. USA Inc.* (1996), 77 C.P.R. (3d) 93 (T.M. Opp. Bd.); *Coca-Cola Ltd. v. Southland Corp.* (2001), 20 C.P.R. (4th) 537 (T.M. Opp. Bd.).

²² See e.g. *Eli Lilly & Co. v. Novopharm Ltd.* (1997), 73 C.P.R. (3d) 371 (Fed. T.D.), affirmed (2000), 10 C.P.R. (4th) 10 (Fed. C.A.), leave to appeal refused 2001 CarswellNat 1295 (S.C.C.).

²³ *Imperial Tobacco Canada Ltd. v. Philip Morris Products S.A.*, 2012 TMOB 225 (T.M. Opp. Bd.).

²⁴ *The Canada (Commissioner of Competition) v. Yellow Page Marketing B.V.*, 2012 ONSC 927 (Ont. S.C.J.), affirmed 2013 CarswellOnt 1183 (Ont. C.A.), additional reasons 2013 CarswellOnt 2633 (Ont. S.C.J.).

²⁵ Primarily *Trademarks Act*, R.S.C. 1985, c. T-13, s. 12(1)(d).

²⁶ One point of difference exists between the test for a likelihood of confusion in infringement actions and passing off actions which may have an impact when preparing survey evidence. The addition of extraneous matter to the impugned trademark intended to identify the true origin, such as the use of the defendant's business name, will not assist a defendant in an infringement action. In a passing off action, a defendant may successfully defend the action on the basis that the added matter is sufficient to distinguish the defendant's goods, services, or business from those of the plaintiff. In designing a survey for use in a passing off action where such added matter is in issue, it is prudent for the design to either take such into account or for the survey expert to be prepared to explain why such added matter would not have affected the survey results. See e.g. *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3, 16 C.I.P.R. 282, 81 N.R. 257 (Fed. C.A.).

sufficient to demonstrate that the use of this mark would likely lead to the inference that the wares or services associated with it and those associated with the registered mark were produced by the same person.²⁷ Survey evidence can directly address whether members of the pertinent population are likely to draw such an inference. Survey evidence can also be helpful with respect to addressing the surrounding circumstances noted in section 6(5), specifically, the pre-requisite distinctiveness of a trademark, the extent to which a trademark has become known, and the degree of resemblance between two trademarks or trade-names in appearance or sound, or in the ideas suggested by them.

The next three sections discuss formats for relevant survey evidence under section 6.5 (distinctiveness, becoming known, degree of resemblance), followed by formats for survey evidence based on the language of section 6.2 (a direct test of confusion). The requirements for reliability and validity, already covered in this Appendix, are common to all of the formats.

4.2 Relevant Formats for Establishing Distinctiveness and Becoming Known

One of the first circumstances a court must consider in determining whether trademarks or trade-names are confusing, as per section 6(5), is their inherent distinctiveness, and the extent to which they have become known,²⁸ that is, the extent of their reputation. Trademarks are either inherently distinctive or have acquired distinctiveness through use in the marketplace.²⁹ In essence, distinctiveness refers to the ability of particular trade indicia, such as a mark, symbol, or logo, to act as a trademark, by communicating to the consumer a single business origin.

Surveys are well suited to determining the distinctiveness of a trademark.^{30 31} The issue to be addressed is whether the consumer believes, in a given context, that the mark denotes a single source for the product, i.e. that one person or entity ultimately controls the character or quality of the wares or services.

Scientifically-defensible formats are shown in the chart below, together with case sources where they have been evaluated for relevance.

²⁷ *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* (1968), [1969] S.C.R. 192, 57 C.P.R. 1, 1 D.L.R. (3d) 462, 39 Fox Pat. C. 207 (S.C.C.).

²⁸ *Trademarks Act*, R.S.C. 1985, c. T-13 s. 6(5)(a).

²⁹ Generally referred to as “secondary meaning”.

³⁰ See e.g. *Kirkbi AG v. Ritvik Holdings Inc. / Gestions Ritvik Inc.*, 2002 CarswellNat 1191, [2002] F.C.J. No. 793 (Fed. T.D.) at paras. 87-118, additional reasons 2002 CarswellNat 2898 (Fed. T.D.), affirmed (2003), [2004] 2 F.C.R. 241, 26 C.P.R. (4th) 1 (F.C.A.), affirmed 2005 SCC 65, 43 C.P.R. (4th) 385 (S.C.C.). See also *Harlequin Enterprises Ltd. v. Harlequin Imports Ltd.* (1989), 27 C.P.R. (3d) 564 (T.M. Opp. Bd.) at p.

³¹ : “The opponent also submitted survey evidence for the years 1981, 1982 and 1985 establishing that among women in Canada over the age of 15 over 90% are familiar with the opponent’s trade mark HARLEQUIN for books and over 50% had read at least one of the opponent’s books. Thus, it is apparent that the opponent’s trademark is extremely well known by adult women throughout Canada, the very group that the applicant’s wares are directed to.” See also: *Imperial Tobacco Ltd. v. Miller Brewing Co.* (1985), 5 C.P.R. (3d) 10 (T.M. Opp. Bd.).

Format	Case reference	Outcome
<p>Reputation of a word mark, through funnel questioning (increasingly specific):</p> <p>"What comes to mind when you hear the word Sunkist? Anything else or not? For how many years have you connected the word Sunkist with [oranges or fruit market, depending on previous answers]? Have you ever seen or heard of Sunkist oranges or not?"</p>	<p><i>Sunkist Growers Inc. v. Sunkist Fruit Market Toronto Ltd.</i>, 1995, F.C.T.D., Court File No.T-1/89</p>	<p>Reputation of Sunkist oranges established, with 90% awareness</p>
<p>Distinctiveness of a design mark, through open-ended questioning re: source identification:</p> <p>"Who do you think puts out this silverware?"</p> <p>"If you wanted to buy a set of this silverware how would you ask for it?"</p>	<p><i>Oneida, Limited, v. National Silver Co.</i>, 25 N.Y.S.2d 271 (N.Y. S.C., 1940).</p>	<p>Evidence of both distinctiveness and confusion established, because plaintiff (Oneida) was frequently named as source of the defendant's design.</p>
<p>"Teflon Test" of distinctiveness: The mark of interest is one of several words used in the following question, with results compared among all words tested: "Is [word at issue] a brand name or a descriptive name, or can you not say?"</p> <p>The Teflon format is described in detail in the section on Genericism below.</p>	<p>Originally endorsed in <i>E.I. DuPont de Nemours & Co. v. Yoshida, Int'l, Inc.</i>, 393 F.Supp. 502 (E.D.N.Y., 1975) at pp. 526-27, with subsequent wide application as an established format. Found favour as a precedential decision in <i>In re Country Music Association, Inc.</i>, 100 USPQ2d 1824 (TTAB 2011)</p>	<p>The term "Country Music Association" was considered by a majority of relevant consumers to be a brand name; Trademark Trial and Appeal Board found the survey to "have probative value in the applicant's favour"</p>

4.3 Relevant Formats for Establishing Resemblance (or absence thereof)

Survey evidence is well suited to shedding light on the resemblance between two marks, or lack thereof, if this is not already evident on the face of the marks. In such situations, a word association test may be helpful, but requires proper context and controls in the design of the questionnaire. For example, the applicant for the trademark NORDIC in association with tires presented a survey on the issue of resemblance in an appeal of a decision rendered by the Trademarks Opposition Board, in *Canadian Tire Corp. v. Accessoires d'autos Nordiques Inc.*³² The latter Quebec-based retailer had opposed the registration of NORDIC in association with tires, on the grounds that it was too similar to the sound and idea suggested by its own mark, NORDIQUES, used in association with auto parts in Quebec.

The survey presented a simple open-ended design. The senior mark NORDIQUES was printed on a card and shown to a respondent by the interviewer for six seconds. The respondent was then asked the following series of questions:

- (i) Please tell me what, if anything, first comes to mind when you see what appears on this card?
- (ii) When would you have first made that association with what appeared on the card? Would it have been [If Respondent said don't know, he or she was asked whether it was within the last year, within the last one to five years, or more than five years ago].

³² 2006 CarswellNat 4185, [2006] F.C.J. No. 1801 (F.C.), additional reasons 2007 CarswellNat 42 (F.C.), affirmed 2007 CarswellNat 3988 (F.C.A.).

(iii) Did anything else come to mind when you saw what appeared on that card or not?

(iv) What else?

The first question was designed to see what the stimulus, i.e. the mark NORDIQUES, would evoke in the mind of the person to whom it was exposed. In this case, the question at issue was whether the idea suggested by NORDIQUES was indeed that of auto parts, among a population of Quebec auto-parts purchasers. The second question addressed whether any association with auto parts would have been made at or before the relevant date in law. The third and fourth questions gave extra opportunities to an association with an auto-parts store to emerge, if it had just missed being mentioned as respondents' first top-of-mind association. The survey showed that the associations with NORDIQUES were almost unanimously with the former Quebec hockey team, and that there was negligible association with the auto-parts store. Thus, any apparent resemblance in sound and idea between the marks NORDIQUES and NORDIC was countered by evidence that consumer perception of NORDIQUES had nothing to do with auto parts.

The survey design was consistent with guidelines offered by Mr. Martin of the Trademarks Opposition Board in a different context more than ten years earlier:

[A] survey should be designed to elicit a consumer's first impression using open-ended questions such as "What do you think of when you see (or hear) this mark?" or "What word comes to mind when you see this mark?" This allows a respondent to reply in any number of ways. He might state that the mark reminds him of another mark, that it reminds him of a company, that he associates it with particular wares or services, that he associates it with a particular emotion or feeling, etc. Such a question should be followed up by one or more prompts in which the respondent is asked if there is anything else he thinks of when he sees the mark or what does he think of when the mark is associated with particular wares or services. This allows for a more complete assessment of the respondent's first impression.³³

The survey and other tendered evidence resulted in the opposition's rejection and the approval of the registration for the mark NORDIC in association with tires. It is worth noting that a survey conducted only in the province of Quebec was accepted to support a national registration, because it was only in the province of Quebec that the opponent claimed to have a reputation. This example recalls an earlier point in the section on reliability, regarding the value that could be provided by surveys drawn from only a key portion of the pertinent population.

While surveys are well-suited to establishing resemblance, resemblance—and the likelihood of its causing confusion—is sometimes obvious, per the Supreme Court of Canada, and need not be the subject of expensive survey evidence. In its decision on the validity of the trademark, "Masterpiece Living",³⁴ the court declared it a matter of common sense that the mark was likely to be confused with "Masterpiece the Art of Living," used earlier by a competitor.

Given these striking similarities, it is, in my respectful view, very difficult not to find a strong resemblance between the two... In cases of wares or services being marketed to the general public, such as retirement residences, judges should consider the marks at issue, each as a whole, but having regard to the dominant or most striking or unique feature of the trademark. They should use their own common sense, excluding influences of their "own idiosyncratic knowledge or temperament" to determine whether the casual consumer would be likely to be confused.

³³ *Canada Post Corp. v. Mail Boxes Etc. USA Inc.* (1996), 77 C.P.R. (3d) 93 (T.M. Opp. Bd.) at p. 103. See also *Canadian Tire Corp. v. Cooper Tire & Rubber Co.* (1994), 59 C.P.R. (3d) 402 (T.M. Opp. Bd.) at pp. 407-408.

³⁴ *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 (S.C.C.) at par. 65 and 92.

Which of the opposing litigants has "common sense" on its side will inevitably be its own topic of debate.

4.4 Directly Establishing a Likelihood of Confusion - the Eveready and Squirt Formats

Surveys designed to test a likelihood of confusion as to source are sometimes premised on a literal interpretation of section 6(2) of the *Trademarks Act*. Consumers are directly questioned on their beliefs about the company that manufactures or sells a given product or service. This type of survey design has been referred to as the "named-source test" or the Eveready format, owing to its endorsement in *Union Carbide Corp. v. Ever-Ready Inc.*³⁵ In that format, survey participants are shown the junior mark and asked questions along the following lines: "Who do you think makes this brand? What makes you think so? What other products, if any, are made by the company that makes this brand?" The extent to which the owner of the senior mark is named as the source of the junior mark constitutes evidence of likelihood of confusion. A clear endorsement for a named-source/Eveready test was given by the Ontario Superior Court in *Kraft Jacobs Suchard (Schweiz) AG v. Hagemeyer Canada Inc.*,³⁶ described earlier. In that survey, chocolate purchasers were shown the offending product, named ALPENHORN, and asked the following questions:

- (i) If you have an opinion, which company puts out the brand of chocolate product you just saw?
- (ii) Why do you say that? [PROBE] Any other reasons? Anything else?

The survey found that a sizable percentage of chocolate consumers (net of those inferred to be guessing) believed that the ALPENHORN bar had been made or licensed by the manufacturers of TOBLERONE. In endorsing the survey format, the Court allowed the injunction against Hagemeyer.

Notably, the defendant submitted a survey that was alleged to demonstrate an absence of product confusion. That survey attempted to demonstrate that few people would think an ALPENHORN bar and a TOBLERONE bar were one and the same. The Court properly held that such a survey test was insufficient for a finding of non-confusion, because it could not rule out the possibility that people would infer the two bars had come from the same source. Evidence of source confusion is sufficient for a finding of confusion, even if there is no product confusion; product confusion may be considered a particular case of the more general source confusion.

In taking action against marks or trademark applications for restaurant sector marks beginning with Mc or Mac, McDonald's Corp. has largely found success with survey evidence in the Eveready format,³⁷ the latest being the decision of the Federal Court in *Cheah v. McDonald's Corp.*,³⁸ upholding the Trademark Registrar's refusal to register MacDimsum.

A likelihood-of-confusion survey, based on the Eveready format, is only effective if the manufacturer/owner source is a recognized name. The Eveready format would not be effective in a situation where the consumer is still likely to be confused as to the source, but where the name of the source is unknown. Survey design becomes more difficult when the manufacturing source is unknown to the consumer because it is no longer an option to simply ask "which company do you think puts out this product?", as the consumer is unlikely to actually know the name of the manufacturer/trademark owner. Similar design problems arise where the mark at issue is also the name of the trademark owner. One possible survey design solution has been to show the plaintiff's and defendant's product in sequence, and ask consumers directly whether they believe

³⁵ *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366 (7th Cir., 1976) at p. 381.

³⁶ *Kraft Jacobs Suchard (Schweiz) AG v. Hagemeyer Canada Inc.*, 1998 CarswellOnt 405, [1998] O.J. No. 415 (Ont. Gen. Div.).

³⁷ McDonald's was similarly successful in the earlier decision of *McDonald's Corp. v. Silverwood Industries Ltd.* (1984), 4 C.P.R. (3d) 68 (T.M. Opp. Bd.) in opposing registration of the mark MACFREEZE for soft ice-cream. The MACSTEAK survey was virtually identical to the survey utilized to successfully oppose MACFREEZE.

³⁸ 2013 FC 774 (F.C.).

the products are put out by the same company or by different companies, or whether they are unable to say one way or another.

The survey design entailed in asking the question in that way has been referred to as the Squirt format, owing to its endorsement in *Squirt Co. v. Seven Up Co.* The original Squirt Format asked respondents "Do you think SQUIRT and QUIRST are put out by the same company or different companies?" Based on published authorities about the potentially leading nature of such a question (the risk of "creating" an opinion where none may exist), the more correct version of such a question is "Do you think X and Y are put out by the same company or by different companies, or can you not say?" Further, the phrases "same company" and "different companies" should have their order alternated, to avoid order bias. Finally, a control condition would normally be included in the survey to discount for guessing.

The Canadian Supreme Court in *Masterpiece*³⁹ appeared to find the Squirt format inappropriate, because the senior mark was named within the survey, rather than having survey participants recall it from their own memories. However, certain published research and legal analysis has been at odds with that view. As one author writing in the *Trademark Reporter*⁴⁰ observes, the Squirt format addresses the very issue of testing confusion with a senior mark that may not be famous enough or registered long enough to jump to mind. When a survey study exposes participants to one product after another, observes McCarthy,⁴¹ it serves to simulate the real-life situation of consumers being exposed to advertising of one product followed by encountering one or more other products in the marketplace where confusion may occur. The survey format has proven more likely to be accepted in cases where the trademarks in questions were applied to similar goods or services, rendering Squirt's "market simulation" more plausible.⁸³ Using a control group in the survey, and other quality controls mentioned earlier, should eliminate concern about the risk that closed-ended questions can be "leading."

4.5 Relevant Formats for Genericism – Thermos and Teflon Formats

Exclusive trademark rights cannot be obtained for words that are or have become the name of the product, product category, or service. These are sometimes referred to as "generic" terms. Valid trademarks may have their registration canceled if they become generic. Generic terms cannot generally be exclusively appropriated. Surveys can be very persuasive evidence of whether a trademark still functions as a trademark, or whether it has become generic among the relevant population.

The first Canadian case to establish the relevance of survey evidence on the issue of distinctiveness/genericism was *Aluminum Goods Ltd. v. Canada (Registrar of Trade Marks)*.⁴² Aluminum Goods sought to register "Wear-Ever" as a trademark used in association with cooking utensils. A survey was conducted to ascertain consumer and dealer knowledge of the word "Wear-Ever":

[The survey house] conducted the survey throughout Canada by its own employees who, in personal interviews, submitted a series of non-leading questions to 3,007 housewives and 505 dealers in cooking utensils in 64 cities, towns, and rural communities. The questions submitted to housewives differed somewhat from those submitted to dealers, but in each case I am satisfied that no objection could be taken to the form of the questions or to the manner in which the survey was conducted. I am satisfied that the report indicates a fair sampling of both consumer and dealer knowledge throughout Canada.

³⁹ *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 (S.C.C.).

⁴⁰ Swann, J. "Likelihood of Confusion Studies and the Straited Scope of Squirt," *Trademark Reporter*, 2008, 98(3), 739-758, at p. 748.

⁴¹ J. Thomas McCarthy, *Trademarks and Unfair Competition* (4th ed. 2007) at 32:177. ⁸³

Swann, *supra*, at p. 755-756.

⁴² [1954] Ex. C.R. 79, 19 C.P.R. 93, 14 Fox Pat. C. 41 (Can. Ex. Ct.).

...As a result of the questioning, 91% of 3,007 housewives and 96.5% of 505 dealers identified "Wear-Ever" as a brand. It is a significant fact that while 44% of the dealers questioned did not deal in "Wear-Ever" utensils, 96.5% of all identified "Wear-Ever" as a brand, thus indicating the widespread knowledge among dealers of the manner in which the word was used.⁴³

Two basic survey design approaches have evolved to assess genericism. One is the so-called "Thermos format," which asks open-ended questions about what words consumers use to describe or ask for a certain type of product. The format originated with the U.S. case of *American Thermos Products Co. v. Aladdin Industries Inc.*⁴⁴ The questions asked of the 3,300 interviewees included the following, among others:

- (i) Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea, and lemonade, hot or cold for a period of time?
- (ii) If you were going to buy one of these containers tomorrow – that is, the type that keeps food and beverages hot or cold – what type of store would you select to make your purchase?
- (iii) What would you ask for – that is, what would you tell the clerk you wanted?
- (iv) Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold?
- (v) If you were going to describe one of these containers to a friend of yours - what words would come to your mind first to describe a container that keeps liquids hot or cold?
- (vi) Do you, or does anyone else within your household, own a container such as we have been talking about?
- (vii) How many are owned by all members of your household? What do you call this (these) containers?
- (viii) Do you know the name of any manufacturers who make these containers that keep liquids hot or cold?
- (ix) Can you name any trademarks or brand names that are used on these containers?

75 percent of those familiar with these types of containers called them a "thermos," 11 percent called them "vacuum bottles," and 12 percent named THERMOS as a trademark for these containers.

1. An adaptation of this open-ended approach to surveying the issue of genericism can be seen in *Institut national des appellations d'origine des vins & eaux-de-vie v. Andres Wines Ltd.*⁴⁵ At issue was the meaning the Canadian public attributed to the term "champagne". The telephone survey conducted by the plaintiff posed the following questions to interviewees who were all at least 19 years old:
 - (i) What, if anything, does the word Champagne mean to you?
 - (ii) When you think of Champagne do you think of any particular country or countries, or not?
 - (iii) What country or countries do you think of?

Interestingly, the Court found the survey of little assistance for the purpose to which the plaintiff had introduced it, namely to illustrate the association between the term "champagne" and a particular country. Instead, the court found the survey to be of assistance to the defendant's allegation that "champagne" was generic:

⁴³ *Aluminum Goods Ltd. v. Canada (Registrar of Trade Marks)*, [1954] Ex. C.R. 79, 19 C.P.R. 93, 14 Fox Pat. C. 41 (Can. Ex. Ct.) at p. 97

Indirectly, the plaintiffs' survey sheds light on the defendants' allegation that the term has become generic because of its use in describing high-quality commercial products, or simply sparkling wines, from anywhere in the world.⁴⁶

[C.P.R.].

⁴⁴134 U.S.P.Q. 98, 207 F.Supp. 9 (D.C. Conn., 1962).

⁴⁵(1987), 60 O.R. (2d) 316, 41 C.C.L.T. 94, 16 C.P.R. (3d) 385, 40 D.L.R. (4th) 239, 14 C.I.P.R. 138 (Ont. H.C.), affirmed (1990), 30 C.P.R. (3d) 279, 71 D.L.R. (4th) 575, 74 O.R. (2d) 203, 6 C.C.L.T. (2d) 117 (Ont. C.A.), leave to appeal refused (1991), 33 C.P.R. (3d) v (note), 1 O.R. (3d) xi, 74 D.L.R. (4th) viii (note) (S.C.C.).

⁴⁶(1987), 60 O.R. (2d) 316, 41 C.C.L.T. 94, 16 C.P.R. (3d) 385, 40 D.L.R. (4th) 239, 14 C.I.P.R. 138 (Ont. H.C.) at p. 432 [C.P.R.], affirmed

A second survey design approach taken to assess genericism has been the Teflon format, summarized earlier in connection with establishing distinctiveness. In a Teflon test, survey respondents are told that there are two ways to name products—the common name, which refers to all products of a given class, and the brand name, which refers to a specific product within that class. The respondents are then given a list of terms, including the term in question, and asked whether each term on the list is a common name or a brand name. The original Teflon test in *E.I. DuPont* proceeded as follows:

I'd like to read eight names to you and get you to tell me whether you think it is a brand name or a common name; by brand name, I mean a word like Chevrolet which is made by one company; by common name, I mean automobile which is made by several different companies. So, if I were to ask you, 'Is Chevrolet a brand name or a common name?' what would you say?

Now, if I were to ask you, 'Is washing machine a brand name or a common name?' what would you say?

If the respondent indicated an understanding of the distinction, the survey would continue. If the respondent did not understand, the explanation would be given again. If the respondent still did not understand the distinction, the interview would be concluded.

Thereafter, the eight names were administered in the context of the question: "Now, would you say _____ is a brand name or a common name?" The eight words used in the original Teflon survey were STP, Thermos, Margarine, Teflon, Jell-O, Refrigerator, Aspirin, and Coke. The results of the "Teflon survey" were as follows:

Name	Brand %	Common %	Don't Know %
STP	90	5	5
THERMOS	51	46	3
MARGARINE	9	91	1
TEFLON	68	31	2
JELL-O	75	25	1
REFRIGERATOR	6	94	0
ASPIRIN	13	86	0
COKE	76	24	0

Certain American authors⁴⁷ have found both the Teflon and the Thermos designs wanting. They observed that consumer thinking may not be restricted to an either/or view of trademarks and generic names. For example, some consumers may think of JEEP only as a brand, some may think of it as a generic word or product category, and some may view it as both a brand name of a vehicle as well as the name of a product

category. Survey evidence about whether a term is a trademark or a generic name should invite consumers to specify that it could be both, the authors argued. This line of argument has been referred to as the duality option. While duality may be part of consumer thinking, there is currently no basis for it in Canadian law.⁴⁸ In appropriate cases, survey designs should permit consumers to respond "both" (if that is their opinion, the survey design should not constrain it), but the questionnaire need not encourage or endorse this possibility by allowing for it explicitly in the questionnaire.

4.6 Summary

This section has reviewed the most common templates or formats developed by social scientists to deal with recurring evidentiary issues in trademark disputes. They are formats which have been found relevant by triers of fact in resolving many legal disputes. They are not universally applicable. All survey designs

(1990), 30 C.P.R. (3d) 279, 71 D.L.R. (4th) 575, 74 O.R. (2d) 203, 6 C.C.L.T. (2d) 117 (Ont. C.A.), leave to appeal refused (1991), 33 C.P.R. (3d) v (note), 1 O.R. (3d) xi, 74 D.L.R. (4th) viii (note) (S.C.C.).

⁴⁷Folsom, Ralph H. & Teply, Larry L., "Trademarked Generic Words" (1979) 70 Yale L.J. 1323.

⁴⁸The duality theory was argued by the defendant in the Canadian case of *Unitel Communications Inc. v. Bell Canada* (1995), 92 F.T.R. 161, 61 C.P.R. (3d) 12 (Fed. T.D.), but was ultimately rejected by the Court.

require customization to the facts and issues of the case at hand. Any valid and reliable survey design so customized is potentially relevant. "Relevance" is a matter of law and would normally be outside the scope of expertise of a survey witness.

5. THE ROLE AND QUALIFICATIONS OF THE SURVEY EXPERT

5.1 Expert Essential to the Tendering Of Surveys

Survey evidence can generally only be admitted as evidence in a court proceeding through a qualified expert witness. This requirement is based on two distinct yet related principles: first, the parties must be able to test the evidence with respect to design and execution, to ensure that it meets accepted principles; second, without expert interpretation of the survey results, the court and the parties have no informed means for drawing any conclusions from the survey evidence. The former principle requires the person who designed and executed the survey to be present for the proceeding. The latter requires someone with the proper qualifications to interpret the data. While it is often the same person in both instances, that does not have to be the case.

Requiring the presence of the person who designed, executed, and subsequently interpreted the survey allows the court and the opposing party to test the evidence directly, ensuring that accepted principles were employed in the design and execution of the survey.⁴⁸ The party tendering such evidence would necessarily

⁴⁸ If the person who designed the survey were no longer available for trial, through death or otherwise, the principles of necessity or exceptions to inadmissible hearsay may result in the survey being admitted into evidence through another professional, provided certain requirements of disclosure are met by the tendering party. ⁹² 2003 U.S. Dist. LEXIS 25977 at pp. 34-35.

wish an expert's comment upon the result, to avoid the evidence being perceived as nothing more than a jumble of individual hearsay statements.

The presentation of the survey data as expert evidence must incorporate both firsthand assurance of the scientific integrity with which the study was earned out, as well as correct interpretation of the data. Unless both aspects are covered, the court may lack sufficient confidence to deem the evidence acceptable. An example of a survey expert's opinion being rejected as unreliable due to its lack of scientific basis is found in *Citizens Financial Group Inc. v. The Citizens National Bank of Evans City and Citizens Inc.*,⁴⁹ where one of the survey experts testified at the hearing that in relation to her opinion on consumer confusion, she did not take any steps herself upon which she could rely to give the conclusion she did. In a more recent Federal Court decision involving the Marlboro trademarks, a survey witness was found to have had insufficient direct knowledge of the interviewing process, and was unable to explain troublesome anomalies in the data; his survey evidence was discounted.^{44 50}

Expert evidence has been found inadmissible where the expert was not qualified as an expert or exceeded his or her qualifications. For example, in *Noxzema Inc. v. Novana Manufacturing Ltd.*,⁴⁵ the Hearing Officer rejected the survey evidence as inadmissible, because the person presenting the reports was not qualified as an expert and had no first-hand knowledge of the surveys. Similarly, in *R. v. Prairie Schooner News Ltd.*,⁴⁶ opinion poll evidence was rejected by the trial judge and later by the Court of Appeal because, among other criticisms, the person conducting the poll was not acceptable as an expert in the science of opinion research.⁴⁷ In that case, Dickson J.A. stated, "Essential to admissibility is that the witness testifying be possessed of expert knowledge."⁴⁸ A similar rejection of evidence occurred in *ITV Technologies Inc. v. WIC Television Ltd.*,⁴⁹ because the opinion was outside the bounds of the expert's qualifications.

5.2 Qualifications of the Expert

The courts have defined a qualified expert as a witness who has demonstrably acquired special and particular knowledge through study or experience, with respect to matters on which he or she is brought to testify.⁵⁰ Without such previous experience relevant to the matters at hand, there is no point in having a witness offer opinions. While the qualification of an expert should always relate to his or her background, education, and experience, rather than to a label that may be applied to the profession, there is no precise requirement as to the mode in which the skill or experience must have been acquired.⁵¹ Knowledge of a particular subject acquired through actual experience is no less valuable than knowledge acquired by education, training, or

⁴⁹ *Philip Morris Products S.A. v. Marlboro Canada Ltd.*, 2010 FC 1099 (F.C.), reversed in part 2012 CarswellNat 6010 (F.C.A.), leave to appeal refused 2013 CarswellNat 659 (S.C.C.).

⁵⁰ McKeown, William J. "Expert and Survey Evidence in Patent and Trademark Cases; Proposed Federal Court Case Management Procedures" (1997) 14 C.I.P.R. 1; presented in an address to the Third Annual Continuing Education Symposium on Intellectual Property Law of the Patent and Trademark Institute of Canada, March 15, 1997.

⁴⁵ (1985), 5 C.P.R. (3d) 509, 5 C.I.P.R. 185 (T.M. Opp. Bd.).

⁴⁶ (1970), 12 Crim. L.Q. 462, 1 C.C.C. (2d) 251, 75 W.W.R. 585 (Man. C.A.), leave to appeal refused [1970] S.C.R. x (S.C.C.).

⁴⁷ Nor, in the alternative, as an expert on the subject of obscenity.

⁴⁸ *R. v. Prairie Schooner News Ltd.* (1970), 1 C.C.C. (2d) 251, 75 W.W.R. 585, 12 Crim. L.Q. 462 (Man. C.A.) at para. 10, leave to appeal refused [1970] S.C.R. x (S.C.C.). For similar rejections of evidence due to the absence of an expert to defend them, see also *Irwin Toy Ltd. v. Marie-Anne Novelties Inc.* (1986), 12 C.P.R. (3d) 145 (Ont. H.C.); *McDonald's Corp. v. McTaco Enterprises Ltd.* (1984), 3 C.P.R. (3d) 130 (T.M. Opp. Bd.); and *Seligco Food Corp. v. Becker Milk Co.* (1984), 3 C.P.R. (3d) 506 (T.M. Opp. Bd.).

⁴⁹ (2005), 38 C.P.R. (4th) 481 (F.C.A.), affirming (2003), 29 C.P.R. (4th) 182 (F.C.).

⁵⁰ See *R. v. Mohan*, [1994] 2 S.C.R. 9, 89 C.C.C. (3d) 402, 29 C.R. (4th) 243, 166 N.R. 245, 71 O.A.C. 241 (S.C.C.), reversing (1992), 147 N.R. 392 (note) (S.C.C.); *Rice v. Sockett* (1912), 8 D.L.R. 84, 27 O.L.R. 410 (Ont. Div. Ct.), affirmed 1913 CarswellOnt 425 (Ont. C.A.); *R. v. Terceira* (1998), 123 C.C.C. (3d) 1 (Ont. C.A.), affirmed 1999 CarswellOnt 4027 (S.C.C.).

⁵¹ See *Bratt v. Western Air Lines*, 155 F.2d 850, 166 A.L.R. 1061 (10th Cir., 1946); *People v. Smith*, 142 Cal.App.2d 287, 298 P.2d 540 (Cal.App. 2d Dist. Div. 2, 1956).

research.⁵² Furthermore, the rules of evidence do not rank academic training over demonstrated practical experience.

The courts have had occasion to discuss the qualifications necessary or desirable for a person to be qualified as an expert for purposes of survey evidence. While each situation will be different, it is nevertheless helpful to review the various experiences the courts have looked to in accepting such professionals as experts:

- *Education in survey technology*: Adequate academic training would include university-level social science courses in experimental design, measurement, statistical analysis, and marketing research, and ideally university-teaching experience.
- *Survey experience*: No matter how much academic training one has had in the technology of conducting surveys, new problems constantly arise as times change, as the computerization of surveys introduces new experiences, and as respondents' attitudes evolve about what topics they are willing to discuss with an interviewer.
- *Subject matter experience*: The credibility of the witness would be enhanced if he or she had survey experience in the area or sector which is under examination—for example, experience conducting surveys in the pertinent business setting, or for criminal litigation, experience in jury surveys.
- *Content knowledge*: Training, research background, or career experience in some aspect of the subject area under consideration adds depth to the expert's survey design decisions, and would no doubt extend the accepted scope of opinion he or she could tender. For example, training in human perception has been found to be critical in some advertising cases. Inadequate appreciation of the limitations of people's aural and visual comprehension weakened survey evidence in both *Purolator Courier Ltd.—Courrier Purolator Ltée v. United Parcel Service Canada Ltd.*⁵³ and in *National Hockey League v. Pepsi-Cola Canada Ltd.*⁵⁴ Similarly, if the survey is about marketing a product or negotiating contracts, experience in the relevant area adds significant credibility to the expert's ability to design the right questions, questions which respondents would find relevant to their day-to-day experiences. In other words, a survey expert should be chosen not just for his or her technical expertise, but also for the customized content expertise that he or she can bring to the research problem at-hand.
- *Publications in learned, refereed journals*: Experts who have published peer-reviewed scientific papers will have had the depth of their knowledge and quality of their work previously screened through a process of typically tough scientific scrutiny. Peer-reviewed publication of original work is inevitably built on accurate use of established knowledge.

Additional desirable skills and experience for expert witnesses, noted in publications by intellectual property counsel,⁵⁵ include the following:

- working knowledge of trademark issues in legal disputes;
- reputation for integrity, quality, and thoroughness;
- an ability to get to the root of the issue and formulate the research problem;

⁵² See *State v. Baity*, 140 Wash.2d 1, 991 P.2d 1151 (Wash., 2000).

⁵³ (1995), 60 C.P.R. (3d) 473, 20 B.L.R. (2d) 270 (Ont. Gen. Div.), additional reasons 1995 CarswellOnt 4743 (Ont. Gen. Div.).

⁵⁴ (1992), 70 B.C.L.R. (2d) 27, 5 B.L.R. (2d) 121, 42 C.P.R. (3d) 390, 92 D.L.R. (4th) 349, [1992] 6 W.W.R. 216 (B.C. S.C.), additional reasons (1993), 48 C.P.R. (3d) 149, 15 C.P.C. (3d) 73, 102 D.L.R. (4th) 80 (B.C.S.C.), affirmed (1995), 59 C.P.R. (3d) 225, 2 B.C.L.R. (3d) 13, 56 B.C.A.C. 8, 92 W.A.C. 8, 122 D.L.R. (4th) 421, 37 C.P.C. (3d) 358 (B.C.C.A.), affirmed (1995), 59 C.P.R. (3d) 216, 2 B.C.L.R. (3d) 3, 56 B.C.A.C. 1, 92 W.A.C. 1, 122 D.L.R. (4th) 412, [1995] 5 W.W.R. 403 (B.C. C.A.).

⁵⁵ e.g. Wilson, J.D., "Survey Evidence in Trademark Proceedings" (1994) 13 Can. J. of Marketing Res. 55.

- experience with problems of proof;
- skills in oral presentation under pressure in a court setting, as an educator rather than an advocate, with good articulation and memory;
- membership in relevant professional organizations;
- a doctorate in cognitive science, marketing, or behavioral research;

While expert knowledge of law should not be expected, McKeown J. observed "it is important that the expert performing the survey and preparing an opinion based on that survey should be properly instructed on the applicable trademark law. A basic understanding of the law will ensure that the expert asks the right questions to the proper survey group."⁵⁶ That having been said, it is generally counsel who must have final accountability for translating a burden of legal proof into a survey mandate.

5.3 The Survey Expert's Report

Before experts are qualified in the trial of an action, they must submit a written statement. Generally, a survey expert's report should include the following information:

- The expert's qualifications and any academic and/or practical experience on which his or her expertise is based;
- The mandate conveyed by counsel;
- The objectives used to operationalize the mandate;
- The questionnaire used in the survey;
- The rationale for the choice of a particular type of survey;
- An explanation of the selection of the survey universe;
- A description of how respondents were sampled;
- The instructions given to the interviewers;
- The response rate to the survey;
- The process for coding and validating open-ended responses;
- A recounting of quality controls consistent with, or exceeding industry standard;
- Whether the technique used is an accepted one within the marketing scientific community;
- An analysis of the results along with a specific explanation of the statistical significance of the main results, including the margin of error;
- Any detailed data tables on which the data analysis was based, included in an appendix.

5.4 Weighing the Expert's Evidence

Survey experts perform at least four roles in the courtroom. The first is the relatively mechanical role of reporting in an objective manner on the accumulated responses to survey questions. The expert must also explain what can reasonably be inferred about the population from which the sample was drawn, using his

⁵⁶ McKeown, William J. "Expert and Survey Evidence in Patent and Trademark Cases; Proposed Federal Court Case Management Procedures" (1997) 14 C.I.P.R. 1; presented in an address to the Third Annual Continuing Education Symposium on Intellectual Property Law of the Patent and Trademark Institute of Canada, March 15, 1997.

or her knowledge of inferential statistics. Deviating from this objective role will elicit disapproval from the court. As observed by McKeown J. of the Federal Court of Canada:

Problems arise ... when experts take the role of partisan advocates instead of neutral fact-finders and opinion givers. An expert's role should be that of an independent advisor to the court. The responsibility of the expert should be to help the court impartially on matters within his or her expertise. This responsibility must override any duty to the client or counsel. Counsel should ensure that experts understand this role and that there is to be no conflict between their professional responsibilities and the demands of the client who is paying their fee.⁵⁷

Survey experts must verify that the survey procedures meet scientific and industry standards, and can be accepted as objective and unbiased. It is desirable that experts take a hands-on role at different stages of the project, in order to report first-hand that certain quality control procedures were met. For example, they should have designed the questionnaire, approved the interviewer training instructions, and monitored at least a portion of the interviews. Their supporting affidavit or report should outline all procedures followed in the conduct of the survey.¹⁰⁷ Survey experts should also be prepared to comment on content matters measured in the survey, such as relevant industry background, and relevant consumer behaviour.

Finally, survey experts should be available to analyze and provide an informed analysis of the opponent's survey.⁵⁸ Warring surveys are not necessarily a sign of bias or suspect science. While some surveys clearly do contain flaws and incorrect conclusions, they can be readily detected by the opposing party and revealed for what they are.⁵⁹ However, there may be other reasons that the Court should hear about why two different approaches to a problem may yield different results—the most common of these reasons is the differing burden of proof on both parties, which in turn calls for different scientific designs. Through all stages of their role, it is crucial for survey experts to remain impartial and unbiased, regardless of the assistance being offered and the fee being paid. An expert who will admit the weaknesses in her own evidence as readily as she will observe the weaknesses in the other party's evidence is more valuable on every level than an expert biased towards the party paying the bills.

Ultimately, when a trial judge rules that an expert witness has the requisite qualifications and expertise to give opinion evidence, the extent of the expert's accomplishments, experience, and recognition in the community, the reliability and validity of the study, and the manner of presenting the evidence are all matters of weight for the trier of fact to assess.⁶⁰

⁵⁷ McKeown, William J. "Expert and Survey Evidence in Patent and Trademark Cases; Proposed Federal Court Case Management Procedures" (1997) 14 C.I.P.R. 1 at p. 2-3. ¹⁰⁷
Ibid.

⁵⁸ See *e.g. A & W Food Services of Canada Inc. v. McDonald's Restaurants of Canada Ltd.* (2005), 40 C.P.R. (4th) 126 (F.C.).

⁵⁹ See Ruth M. Corbin & Arthur Renaud, "What's Good for the Goose is Bad for the Gander: Why Confusion Surveys for Plaintiff and Defendant should be Different" (2003) 16 I.P.J. 177.

⁶⁰ See Sopinka, J., Lederman, S.N. & Bryant, A.W. *The Law of Evidence in Canada*, 2nd ed. Suppl. (Toronto: Butterworths, 2004) at 114.