



Secondary Meaning Surveys: A Guide for Trademark Disputes

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When a word, symbol, or aspect of trade dress has no inherent distinctiveness but, over time, has come to be associated with only one provider in a marketplace, it is said to have [secondary meaning](#). Examples of this are easy to come by. American consumers are likely to recognize that a swoosh shape on the side of an athletic shoe means it was made by Nike, even if the brand name is not visible. Jewelry consumers who see robin's-egg blue jewelry packaging know that an item from Tiffany & Co. is inside. These items do not need the symbol or the color to serve their intended functions. The color and the symbol communicate that the goods come from a single source, so they have secondary meaning.

How Does Secondary Meaning Apply to Trademarks?

Secondary meaning can apply to a variety of elements of a trademark. In addition to symbols and colors, certain words and designs can come to have acquired distinctiveness.¹ An important consideration is that secondary meaning can only be achieved through elements of a mark that are nonfunctional.² For example, the two-pronged plug of an electric cord cannot have secondary meaning, because it serves a functional purpose. However, if the cord had a unique color or design that did not impact the function of the cord, it is possible that those elements could achieve secondary meaning.

When to Use a Secondary Meaning Survey

Secondary meaning disputes may arise when the user of a word or symbol applies to register that word or symbol as a trademark before the US Patent and Trademark Office (USPTO). In this situation, the proposed mark lacks inherent distinctiveness, but the applicant is arguing that the

proposed mark has acquired distinctiveness over time. A secondary meaning survey can help applicants support their applications or can be used by parties opposing the registration.

[Secondary meaning surveys](#) can also be used when a dispute arises. A plaintiff might claim secondary meaning as part of their case for asserting trademark rights in a trademark infringement dispute, or when opposing or petitioning to cancel another party's trademark. Alternatively, a defendant might measure secondary meaning to defend their mark against trademark infringement claims by demonstrating that the plaintiff's mark lacks enough distinctiveness to be a trademark. Consider how Nike might respond if another shoe company used the "swoosh" symbol on its own shoes. This could confuse consumers, and Nike might be concerned about lost sales or being associated with the other company, whose quality and behavior it cannot control.



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This is similar to [likelihood of confusion](#), but there is an important difference. Secondary meaning can apply to words or symbols that cannot be registered as trademarks from the beginning of their use, such as colors, because they are not inherently distinctive.³ This type of word or symbol may achieve acquired distinctiveness, the term used in the Lanham Act, after being used as a mark.⁴ As a result, parties claiming secondary meaning in a word or symbol must show that this word or symbol is functioning as a trademark. This is one job of secondary meaning surveys. Similarly, surveys can also be used as evidence that an asserted mark does not have any secondary meaning.

How Surveys Test for Secondary Meaning

To test for secondary meaning, a survey measures associations with the mark as it is registered (if a registered trademark), applied for (if a trademark application is pending), or asserted (if common-law rights are claimed). That means that a word mark is typically tested in plain font (unless stylization is part of the asserted mark), a symbol is typically tested by itself, and trade dress is typically tested in the absence of other potentially source-identifying information (such as a brand name or model number).

A secondary meaning survey typically does not test the word or symbol as it is used in the real marketplace because, in that context, it may be surrounded by other indications of origin, such as the brand name or registered trademarks. Those indications of origin can spoil the survey by telling respondents what they are looking at, so surveys should remove them, leaving only the word or symbol at issue.⁵

The Anonymous Source Rule

Courts have found that a mark has secondary meaning if consumers associate it with a single source,⁶ even if they cannot name the source.⁷ This is called the anonymous source rule.⁸ As a result, after secondary meaning surveys show the isolated word or symbol, they ask whether respondents associate it with one source or more than one source. The question of whether consumers associate an asserted mark with products or services from one source or multiple sources is typically the central question in a secondary meaning survey. This question is typically asked in a closed-ended format, with respondents choosing a response from a list including options such as “one company,” “more than one company,” “no company,” and “I don’t know.”⁹

Other Common Questions

To discourage guessing by people who are unfamiliar with the word or symbol, a secondary meaning survey might include a “filter question” before the primary question, e.g., asking “Have you ever seen or heard of this word or symbol before?” If respondents say no, they are not asked the substantive question or questions that measure acquired distinctiveness. This is called a “filter question” because it is used to screen respondents who lack relevant opinions and therefore cannot provide reliable information. An alternative is to include a “quasi-filter” by providing a “don’t know or no opinion” response option to the survey’s main question.¹⁰

Two other common questions in secondary meaning surveys come after the main question. One asks a question such as “Why do you think that?” The other question asks what company respondents associate with products or services that use the word or symbol. (This may be asked only of those who had already responded that they associate it with only one company.) Both of these questions are typically asked in an open-ended format, allowing respondents to answer in their own words.

These questions are typically unnecessary from an evidentiary standpoint because the legal standard for finding secondary meaning follows the anonymous source rule and does not require that respondents name the source.¹¹ One authority has argued that a well-designed likelihood of confusion survey that includes an experimental control group (discussed below) does not require asking the “Why do you think that?” question.¹² However, courts have historically expected questions like this, which may help them understand how respondents arrived at their responses.

Survey Considerations for Measuring Secondary Meaning

Like all surveys, even well-designed secondary meaning surveys are subject to respondents’ biases, lack of attention, and other problems that can cause responses that do not reflect

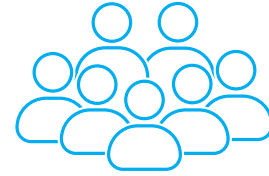
respondents' real opinions. To remove the potential bias caused by these problems, secondary meaning surveys should use controls.¹³

Finding the Right Survey "Universe"

A full discussion of why and how to design survey controls is available in our team's [white paper on controls](#).

However, a control should remove the at-issue aspect of the claimed trademark. In a secondary meaning survey, this should be whatever aspect of the mark the trademark holder claims has secondary meaning—for example, swapping the Tiffany & Co. robin's-egg blue for a non-distinctive color on packaging that is otherwise identical.

Another consideration for secondary meaning surveys is who to interview. The survey's "universe" is very important because only respondents who are relevant to the matter can provide relevant data. An incorrect universe can result in a survey being discounted or excluded.¹⁴ In secondary meaning surveys, the relevant universe is current or likely consumers in the market for the plaintiff's category of goods or services, though not exclusive to purchasers of the plaintiff's brand.¹⁵ For example, in a survey measuring the secondary meaning of Sargento's cheese packaging, it would be inappropriate to only interview purchasers of Sargento cheese. Instead, such a survey should interview current or likely purchasers of packaged cheese.



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Choosing the Right Survey Expert

An additional important consideration is which expert you choose to work with. Finding the right universe and asking those respondents the right questions can be complicated, but an experienced survey expert should be able to guide you through it.

The right survey expert can also guide you through how your survey results may be interpreted. Courts typically look for results showing that a "significant" or "substantial" number of relevant consumers associates the word or symbol with just one company.¹⁶

Reliable Expert Witness Testimony in Trademark Cases

The [Litigation Surveys and Consumer Science](#) team at IMS Legal Strategies has extensive experience designing, conducting, analyzing, and testifying in litigation surveys, including secondary meaning surveys. [Contact us](#) to discuss how we can help with your matter.¹⁶

References

- ¹ Palladino, Vincent N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, pp. 81-82.
- ² "Unless it is shown that the nonfunctional features primarily serve to identify the source of the product in the minds of consumers, the product cannot be protected as one that has acquired secondary meaning." Vincent, Palladino N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, p. 84.
- ³ McDonald, Susan Schwartz. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 2nd ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2022, p. 81.
- ⁴ McCarthy, J. Thomas. § 15:1 "Introduction to secondary meaning." *McCarthy on Trademarks and Unfair Competition*, 5th ed., Thomson Reuters, 2021, pp. 15-5 through 15-6.
- ⁵ Palladino, Vincent N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, pp. 85-86.
- ⁶ Palladino, Vincent N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, pp. 81-82.
- ⁷ McCarthy, J. Thomas. § 15:1 "Introduction to secondary meaning." *McCarthy on Trademarks and Unfair Competition*, 5th ed., Thomson Reuters, 2021, p. 15-7.)
- ⁸ McCarthy, J. Thomas. § 15:8 "Association with a single, though anonymous, source." *McCarthy on Trademarks and Unfair Competition*, 5th ed., Thomson Reuters, 2021, pp. 15-21 through 15-22.)
- ⁹ Vincent, Palladino N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, p. 88.
- ¹⁰ Diamond, Shari Seidman. "Reference Guide on Survey Research." *Reference Manual on Scientific Evidence*, 3rd ed., National Academies Press, 2011, pp. 389-391.
- ¹¹ Palladino, Vincent N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, p. 82. See also McCarthy, J. Thomas. § 32:191 "Secondary meaning—Secondary meaning survey formats." *McCarthy on Trademarks and Unfair Competition*, 5th ed., Thomson Reuters, 2021, pp. 32-569 through 32-571
- ¹² Henn, Jr., R. Charles. "Why Ask Why? A Critical Assessment of an Historical Survey Artifact." *The Trademark Reporter*, vol. 113, no. 5, 2023, pp. 786-787.
- ¹³ Palladino, Vincent N. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 1st ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2012, pp. 88-89.
- ¹⁴ Diamond, Shari Seidman. "Reference Guide on Survey Research." *Reference Manual on Scientific Evidence*, 3rd ed., National Academies Press, 2011, p. 377. See also McDonald, Susan Schwartz. "Secondary Meaning Surveys." *Trademark and False Advertising Surveys: Law, Science, and Design*, 2nd ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2022, p. 87. ("Universe definition represents the 'headwaters' of all survey research design because the population to which we want to generalize must (a) align with the legal and commercial issues propelling the case and (b) dictate the sampling criteria to operationalize that definition.")

¹⁵ McDonald, Susan Schwartz. "Secondary Meaning Surveys." Trademark and False Advertising Surveys: Law, Science, and Design, 2nd ed., edited by Shari Seidman Diamond and Jerre B. Swann, ABA Publishing, 2022, pp. 87-88.

¹⁶ Secondary meaning--significant level of identification." McCarthy on Trademarks and Unfair Competition, 5th ed., Thomson Reuters, 2021, p. 32-565.

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