

# Disarray Among the Circuits: When Are Consumer Surveys Persuasive?

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*ABSTRACT: Trademarks have been an integral part of our economic system for generations. As our needs and abilities have advanced, so too have trademark regulations advanced to meet these new challenges. This Note examines the requirements for federal trademark protection under the Lanham Act. Protection normally only extends to marks that are determined to be inherently distinct; however, in certain circumstances, marks that are not inherently distinct may be eligible for protection, if it can be sufficiently proven that a descriptive mark acquired distinctiveness. The best tool for showing that descriptive marks have become distinct are consumer surveys, which allow parties to look directly into the minds of consumers. However, there is no established standard for what level of positive response is needed on a consumer survey for the survey to be persuasive. Without an identifiable standard, the federal circuits have been thrown into disarray, each developing its own standard to address this void. This Note proposes that a “soft threshold” should be set by the Supreme Court for these surveys, creating a guidepost to help determine whether the mark has made a sufficient showing of distinctiveness.*

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## I. INTRODUCTION

As our nation's economy and culture push forward through the 21st century, so too do the legal needs and questions that surround those areas that progress with them. The law of intellectual property encompasses our attempts to address some of the most vital questions within our economic system. The law, however, does not always develop as quickly or as efficiently as needed, and light must be thrown on specific issues, if they are to be rectified.

Trademark law revolves around granting a party the right to exclude others from using a specific mark to distinguish the origin of goods or services.<sup>1</sup> To that end, trademark law serves two major purposes: (1) to protect consumers from counterfeit goods and (2) “to protect the goodwill . . . merchants have developed in their []marks.”<sup>2</sup> Trademark protection began under the umbrella of state law, allowing each jurisdiction to pass its own requirements and regulations in order to run its system of protection as it saw fit.<sup>3</sup> However, as the intricacies of state law frameworks became increasingly complex and differentiated, Congress recognized a need to unite trademark law under a federal framework, bringing it in line with other forms of intellectual property, such as patents and copyrights.<sup>4</sup> However, because Congress's initial attempts at federal trademark statutes underwent continuous revision,<sup>5</sup> Congress eventually opted for a total overhaul of federal protection. To this end, Congress passed the Lanham Act in 1946,<sup>6</sup> and has since amended it several times.<sup>7</sup> As now defined by the Lanham Act, a “trademark” is “any word, name, symbol, or device, or any combination thereof” that is used “to identify and distinguish [a person's] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.”<sup>8</sup>

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1. DONALD S. CHISUM ET AL., UNDERSTANDING INTELLECTUAL PROPERTY LAW 495 (3d ed. 2015).

2. *Id.*

3. *See id.* at 495–99.

4. *Id.* at 498.

5. *Id.* at 499.

6. Lanham Act, 15 U.S.C. §§ 1051–141 (2012); CHISUM ET AL., *supra* note 1, at 499.

7. CHISUM ET AL., *supra* note 1, at 500.

8. 15 U.S.C. § 1127.

Unfortunately, there is some uncertainty regarding the requirements that must be met for a certain subcategory of marks, known as descriptive marks, to be protected under the Lanham Act. This Note argues that the uncertainty regarding the use of consumer surveys to establish the secondary meaning of descriptive marks should be eliminated. Part II examines the legal framework behind trademark protection under the Lanham Act and details the requirements and structure of this protection.<sup>9</sup> Part III examines the controversy and confusion surrounding the use of consumer surveys, particularly focusing on the inability of the federal circuits to adopt a uniform analysis of survey results.<sup>10</sup> Finally, Part IV argues in favor of the Supreme Court implementing a soft threshold, creating a guidepost to help courts determine if the descriptive mark has acquired secondary meaning, without removing the court's ability to use its discretion in complicated or unique scenarios. Part IV also addresses less favorable secondary solutions, such as a discretion-removing judicially-created hard threshold and intervention by Congress through revision of the Lanham Act, as well as various counterarguments, such as whether this is a problem that is worthy of being addressed at all.<sup>11</sup>

## II. DISTINCTIVENESS: THE BAR TO ENTRY

In order to register a mark for protection under the Lanham Act, the mark must be distinct.<sup>12</sup> Registering for federal protection is critical to the long-term outlook of the owner of the mark, as federal registration is “admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark.”<sup>13</sup> Furthermore, registration provides the registrant with specific remedies to infringement, including monetary damages,<sup>14</sup> injunctive

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9. See *infra* Part II.

10. See *infra* Part III.

11. See *infra* Part IV.

12. 15 U.S.C. § 1052.

13. *Id.* § 1115(a).

14. *Id.* § 1117. Section 1117 allows successful plaintiffs to recover from the defendant the defendant’s own profits, damages sustained by the plaintiff, as well as attorney’s fees. *Id.* § 1117(a). Furthermore, the statute provides for treble damages in situations where the defendant has willfully infringed as well as statutory damages for counterfeit marks, which can be quite high for smaller businesses:

(1) not less than \$1,000 or more than \$200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than \$2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

*Id.* § 1117(b)–(c).

relief,<sup>15</sup> and destruction of the infringing marks.<sup>16</sup> Though this is a strong grant of protection to the registrant, it is subject to a list of statutory defenses.<sup>17</sup>

Because of these protections, alleged infringers often attempt to sue or counterclaim before a competing mark becomes incontestable under the Lanham Act. Once a mark becomes incontestable, it cannot be challenged on the basis of descriptiveness,<sup>18</sup> a classification that will be addressed in this Note.<sup>19</sup> However, before a descriptive mark becomes incontestable, the owner must prove the mark is distinct through a showing of secondary meaning,<sup>20</sup> a term that will be discussed at length in this Note.<sup>21</sup> Additionally, once a mark is federally registered, it can still be challenged for five years before it gains incontestable status.<sup>22</sup> Distinctiveness, therefore, is at the very heart of both trademark protection and infringement actions. This Part traces the requirements of distinctiveness, examining the current analysis employed to determine whether a mark is distinctive. Section II.A examines the initial determination of whether a mark is inherently distinctive, while Section II.B examines marks that are able to acquire distinctiveness after creation.

#### A. DETERMINING DISTINCTIVENESS

Even before codification of federal trademark statutes, common law jurisdictions were employing a test for distinctiveness to determine whether a mark was eligible for protection.<sup>23</sup> In short, the mark must distinctively identify the origin or ownership of the good to which it is attached.<sup>24</sup> In modern trademark law, distinctiveness is now evaluated using the categorical test laid out in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>25</sup> Section II.A.1 of this subsection details the four-category *Abercrombie* framework and

15. *Id.* § 1116.

16. *Id.* § 1118.

17. *Id.* § 1115(b). These defenses include that incontestable marks were obtained fraudulently, the abandonment of the mark, the mark has been used to violate antitrust law, the mark is functional, and others. *Id.*

18. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 205 (1985) (“We conclude that the holder of a registered mark may rely on incontestability to enjoin infringement and that such an action may not be defended on the grounds that the mark is merely descriptive.”).

19. *See infra* Section II.A.1.

20. *Park 'N Fly, Inc.*, 469 U.S. at 200.

21. *See infra* Section II.B.

22. *Park 'N Fly, Inc.*, 469 U.S. at 200–01.

23. *Canal Co. v. Clark*, 80 U.S. 311, 322–23 (1871) (stating that it is the “doctrine of all the authorities” that “the trade-mark must either by itself, or by association, point distinctively to the origin or ownership of the article to which it is applied”).

24. *Id.* at 323.

25. *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 451 (5th Cir. 2017) (“To assess the distinctiveness of a word mark . . . we rel[y] on the spectrum set forth by Judge Friendly in *Abercrombie* . . .” (internal quotations omitted) (alteration in original)); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976).

classification. Section II.A.2 of this subsection explains the difference between the inherently distinct and non-inherently distinct classifications within the *Abercrombie* framework.

### 1. The *Abercrombie* Framework

The *Abercrombie* framework lays out four different classifications under which prospective trademarks may fall: generic, descriptive, suggestive, and arbitrary or fanciful.<sup>26</sup> The list is arranged in ascending order from least eligible for protection to most eligible for protection.<sup>27</sup> The classifications, however, are not airtight. Sometimes marks do not fit neatly into any one category and may blur the lines between them.<sup>28</sup> Because of this, the *Abercrombie* framework has been described as a “spectrum” rather than neat, tightly defined boxes.<sup>29</sup> To further complicate this test, the same term may be classified under different categories if used in combination with different products,<sup>30</sup> the term may shift from one classification to another based on usage over time,<sup>31</sup> and the term may have different meanings to different groups of people.<sup>32</sup> To begin categorizing a term, it must be evaluated in “[t]he context in which [it] is used[,] . . . how it is used with other words or the products or services to which it is applied,” and in regard “to the *audience* to which the relevant product or service is directed.”<sup>33</sup>

Generic terms, thankfully, are fairly straightforward to identify. A term is considered generic if it “refers . . . to the genus of which the particular product is a species.”<sup>34</sup> In plain English, examples of generic terms would be “Computer” brand computers and “Apple” brand apples. Generic terms do more than describe the product to which they are attached—they fundamentally represent the product itself. Another consideration for the seller of the product is the potential for a term to become generic over time,

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26. *Abercrombie*, 537 F.2d at 9.

27. *Id.*

28. *Id.* (“The lines of demarcation, however, are not always bright.”).

29. *Streamline Prod. Sys.*, 851 F.3d at 451 (labeling the *Abercrombie* framework as a spectrum: “To assess the distinctiveness of a word mark, as opposed to a design mark, we rel[y] on the spectrum set forth by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). This spectrum divides the distinctiveness of marks into five categories: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful.” (citation omitted) (internal quotations omitted)).

30. *Abercrombie*, 537 F.2d at 9 n.6 (“To take a familiar example ‘Ivory’ would be generic when used to describe a product made from the tusks of elephants but arbitrary as applied to soap.”).

31. See *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BNA) 80, 81 (Dec. Comm’r Pat. 1950) (holding the term “escalator,” which had originally been either fanciful or suggestive, had become generic over time).

32. See *Bayer Co. v. United Drug Co.*, 272 F. 505, 509–10 (S.D.N.Y. 1921) (discussing how some customers believed “Aspirin” referred to the name of the drug and some believed it referred to the Plaintiff).

33. *Union Nat’l. Bank of Tex. v. Union Nat’l. Bank of Tex.*, 909 F.2d 839, 847 (5th Cir. 1990).

34. *Abercrombie*, 537 F.2d at 9.

even if the term was not generic originally. Perhaps the best example of this phenomenon, known as genericide, is a certain brand of moving staircase: Escalator. Originally the brand name of a specific manufacturer of moving staircases, Escalator was a trademarked and protected term.<sup>35</sup> However, it was eventually ruled that Escalator was “recognized by the general public as the name for a moving stairway and not the source thereof.”<sup>36</sup> This generic usage of the term was so prevalent that even the manufacturer itself had used it as a generic descriptive term rather than an indication of the source of the product in their own patents.<sup>37</sup> As a result, it was ruled that Escalator had become a generic term.<sup>38</sup> Other trademarks that have gone generic or are struggling against genericide include Hoover, Jacuzzi, Frisbee, Tiffany, Aspirin, and Xerox.<sup>39</sup>

One step up from generic terms, descriptive terms describe some aspect of the product. More specifically, “[a] descriptive term identifies a characteristic or quality of an article or service, such as its color, odor, function, dimensions, or ingredients.”<sup>40</sup> “All Bran,” the bran flake cereal produced by Kellogg, and “Holiday Inn”, the hotel chain, are examples of descriptive terms.<sup>41</sup> “All Bran” explicitly tells the consumer the product is a bran cereal, while “Holiday Inn” includes the word “inn,” used synonymously with hotel. These terms, therefore, describe the product to which they are attached, while still being more distinct than a hypothetical “Cereal” brand cereal or “Hotel” chain of hotels, which would be generic. Other examples of descriptive terms include “Alo” brand skin care products made from the aloe

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35. See *Haughton Elevator Co.*, 85 U.S.P.Q. (BNA) at 81 (“This is an appeal from the decision of the Examiner of Trade Mark Interferences sustaining the petition of the Haughton Elevator Company to cancel the trade mark ‘ESCALATOR’ . . . and recommending its cancellation.”).

36. *Id.*

37. *Id.*

38. *Id.*

39. Simon Tulett, ‘Genericide’: Brands Destroyed by Their Own Success, BBC (May 28, 2014), <http://www.bbc.com/news/business-27026704>. This article describes the struggle strong brands face when the general public begins to associate the brand name with the product itself, rather than with the producer. *Id.* Known as “genericide,” it is possible for a trademark to become so strong—so well known—that it becomes ubiquitous with the product or action itself. *See id.* When this happens, the product “goes generic” and is no longer used by the public as a source identifier. *See id.* Since trademarks are, at their core, source identifiers, this is catastrophic for producers. Once the product suffers genericide, it is susceptible to losing trademark protection altogether. *Id.* Some producers, such as the one who makes Xerox, have actually used marketing advertisements directly aimed at informing consumers that Xerox is a brand name rather than a generic term. *Id.*

40. *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 241 (5th Cir. 2010) (emphasis omitted).

41. See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 189 (2003); *Our Products: Three Fiber-Filled Varieties*, KELLOGG’S ALL-BRAN, [http://www.all-bran.com/en\\_US/home.html](http://www.all-bran.com/en_US/home.html) (last visited Aug. 24, 2018).

vera plant<sup>42</sup> and a “Vision Center” chain “offering optical goods and services.”<sup>43</sup>

The next classification, suggestive terms, can be hard to differentiate from descriptive terms. This classification “suggests, rather than describes, some particular characteristic of the goods or services to which it applies.”<sup>44</sup> Rather than simply telling the consumer what the product is, or describing an aspect of the product, a suggestive term “requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services.”<sup>45</sup> A commonly cited example of a suggestive mark is “Coppertone,” a sun tanning product.<sup>46</sup> Coppertone is not the generic name of the product, nor is it necessarily descriptive of the product itself. Rather, it is descriptive of the effect the product has when used, giving the user a copper skin tone. In other words, Coppertone is considered a suggestive mark because it requires an element of imagination to connect the name to the product.

The final classification in the *Abercrombie* spectrum is arbitrary and fanciful terms. These terms are the polar opposite of the generic classification. “Arbitrary [and] fanciful terms bear no relationship to the products or services to which they are applied . . . .”<sup>47</sup> A term such as “Kodak” is classified as fanciful<sup>48</sup> because it is completely unrelated to cameras and photography. Though arbitrary and fanciful terms are grouped together in the same *Abercrombie* classification, there still remains a difference between the two. Arbitrary terms are words that have definitions and other meanings, unrelated to the product to which they are attached.<sup>49</sup> In more plain terms, arbitrary marks are words used totally out of context when compared to the product to which they are attached. Fanciful terms, however, are “words invented solely for their use as trademarks.”<sup>50</sup> Using this distinction, Kodak is properly classified as a fanciful term, since it has no meaning outside of its use as a trademark.<sup>51</sup> Apple, the term used by the computer manufacturer, is considered arbitrary because the word “apple” has an actual definition, though it is totally unrelated to the technology sold by the company Apple.<sup>52</sup>

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42. *Amazing Spaces, Inc.*, 608 F.3d at 241.

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.*

47. *Id.* (emphasis omitted).

48. *Id.*

49. *Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, 11 n.12 (2d Cir. 1976) (“When the same legal consequences attach to a common word, i.e., when it is applied in an unfamiliar way, the use is called ‘arbitrary.’”).

50. *Id.*

51. *Amazing Spaces, Inc.*, 608 F.3d at 241.

52. See Arbitrary Marks, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/strength-of-marks/arbitrary-marks> (last visited Aug. 9, 2018).

Though the distinction between arbitrary and fanciful marks is rarely important, fanciful marks are considered the stronger of the two, because “an arbitrary mark is distinctive only within its product market and entitled to little or no protection outside of that area.”<sup>53</sup> In contrast, fanciful marks are always distinctive.

## 2. Inherently Distinct vs. Non-Inherently Distinct

How a term is categorized using the *Abercrombie* framework is critically important to the legal rights that are afforded to its owner. Specifically, “[a] mark’s placement on this spectrum determines whether and how it is entitled to legal protection.”<sup>54</sup> The spectrum is essentially divided in half, with arbitrary, fanciful, and suggestive marks in one group and descriptive and generic marks in another. Arbitrary, fanciful, and suggestive terms are qualified as “inherently distinctive” for the purposes of Lanham Act protection.<sup>55</sup> Thus, by their very nature, these terms are eligible for federal trademark protection. On the other end of the spectrum, descriptive and generic marks are not inherently distinctive, and therefore not readily eligible for protection under the Lanham Act.<sup>56</sup>

Within this category of non-inherently distinctive terms, generic marks are uniquely unqualified. Because generic marks are so fundamental to describing the very product to which they are attached, generic marks are never distinctive, and therefore are never eligible for protection under the Lanham Act.<sup>57</sup> It would be ludicrous to allow a fruit-selling company named “Pear” to trademark such a name for the purpose of selling pears, for example. This categorical bar highlights how dangerous the prospect of becoming generic is to product manufacturers. To return to the example of Escalators, when the term “Escalator” became generic, the product not only lost its distinctiveness, but had its federal trademark registration and protection cancelled.<sup>58</sup> The threat of going generic is a very real concern for trademark owners, and even mega-corporations such as Google are not immune; though argued unsuccessfully, a suit was brought in 2017 alleging the trademark on Google had become generic.<sup>59</sup>

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53. *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 626 (6th Cir. 2003).

54. *Amazing Spaces, Inc.*, 608 F.3d at 241.

55. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

56. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.01 (Catherine P. Cain ed., 2017), <https://tmep.uspto.gov/RDMS/TMEP/Oct2012#/Oct2012/TMEP-1200d1e6993.html>.

57. *Amazing Spaces, Inc.*, 608 F.3d at 241–42.

58. *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BNA) 80, 81 (Dec. Comm’r Pat. 1950).

59. *See generally Elliott v. Google, Inc.*, 860 F.3d 1151 (9th Cir. 2017) (stating that despite the fact “google” can be used as a verb to refer to using an internet search engine, “Google” had not become generic).



Finally, descriptive terms are left in somewhat of a gray area between the inherently distinctive terms and the never-distinct generic terms. While not inherently distinctive, descriptive marks may become distinctive.<sup>60</sup> If an owner can show a descriptive mark has acquired distinctiveness, the term will be eligible for protection under the Lanham Act.<sup>61</sup>

### B. ACQUIRING DISTINCTIVENESS

Though the exact wording and tests differ due to slight variations among the federal circuits, the circuits all agree that descriptive marks can acquire distinctiveness. Marks become distinctive by acquiring a secondary meaning beyond merely describing the product; this is when the consumers recognize the mark as an identifier of the producer or manufacturer rather than as an identifier of the product itself.<sup>62</sup> More specifically, the public must be aware that the product comes from a single source, even if the public cannot identify the source itself.<sup>63</sup> The inquiry into whether a descriptive mark has become distinct is generally phrased as whether the mark has acquired secondary meaning. The question of whether or not a mark has acquired secondary meaning is a question of fact.<sup>64</sup> However, secondary meaning can also be

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60. *Amazing Spaces, Inc.*, 608 F.3d at 241.

61. 15 U.S.C. § 1052(f) (2012) (“Except as expressly excluded . . . nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”).

62. *Parks LLC v. Tyson Foods, Inc.*, 863 F.3d 220, 231 (3d Cir. 2017) (“Secondary meaning is generally ‘established through extensive advertising which creates in the minds of consumers an association between the mark and the provider of the [products or] services advertised under the mark.’” (alteration in original) (quoting *Commerce Nat’l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000))); *Tartell v. S. Fla. Sinus & Allergy Ctr., Inc.*, 790 F.3d 1253, 1257 (11th Cir. 2015) (“A name has acquired secondary meaning when the primary significance of the term in the minds of the consuming public is not the product but the producer.” (quoting *Tana v. Dantanna’s* 611 F.3d 767, 774 (11th Cir. 2010))); *Test Masters Educ. Servs., Inc. v. Robin Singh Educ. Servs., Inc.*, 799 F.3d 437, 445 (5th Cir. 2015) (“Secondary meaning occurs when, in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.” (alteration in original) (quoting *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 476 (5th Cir. 2008))); *Co-Rect Prods., Inc. v. Marvy! Advert. Photography, Inc.*, 780 F.2d 1324, 1332 (8th Cir. 1985) (“S & R was required to show that the expression, through long and exclusive use and advertising had become so associated in the public mind with its control pourer that the expression served to identify and distinguish the pourer from those manufactured by others.” (internal quotations omitted)).

63. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 380 (7th Cir. 1976) (“It is sufficient if the public is aware that the product comes from a single, though anonymous, source.” (citing *Spangler Candy Co. v. Crystal Pure Candy Co.*, 353 F.2d 641, 647 (7th Cir. 1965))), *superseded on other grounds by statute* FED R. CIV. P. 52(a), *as recognized in* *Scandia Down Corp. v. Euroquilt, Inc.* 772 F.2d 1423, 1429 (7th Cir. 1985).

64. *Speed Prods., Co. v. Tinnerman Prods., Inc.*, 222 F.2d 61, 66 (2d Cir. 1955); *Little Tavern Shops, Inc. v. Davis*, 116 F.2d 903, 906 (4th Cir. 1941).

established as a matter of law,<sup>65</sup> making this question an interesting law/fact hybrid. Though different circuits prefer to put their own judicial gloss on these tests, ultimately all circuits place a substantial amount of weight on the use of consumer surveys.<sup>66</sup> Section II.B.1 details the different tests used by the circuits to determine whether a descriptive mark has acquired secondary meaning. Section II.B.2 highlights the importance of consumer surveys within these analyses.

### 1. Methods and Variations

In order to determine whether a mark has acquired secondary meaning, courts do not use a simple “yes or no” test. Rather, each circuit uses a balancing test, taking into account multiple different factors. For example, the Eleventh Circuit uses a four-factor balancing test, weighing:

(1) the length and manner of its use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the public’s mind between the name and the plaintiff’s product or business; and (4) the extent to which the public actually identifies the name with the plaintiff’s product or venture.<sup>67</sup>

Contrastingly, the Fifth Circuit uses a seven-factor balancing test, weighing:

(1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant’s intent in copying the [mark].<sup>68</sup>

Most other circuits fall somewhere in the middle, utilizing hybrid systems of their own design.<sup>69</sup> The Third Circuit truly goes a step farther, recently crafting an eleven-factor test that even accounts for the size of the company

65. See *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 295 (7th Cir. 1998) (“We noted that figures in the 30% range were marginal and did not establish secondary meaning as a matter of law.”).

66. See *infra* Section II.B.2 (discussing the importance of consumer surveys).

67. *FN Herstal SA v. Clyde Armory Inc.*, 838 F.3d 1071, 1083–84 (11th Cir. 2016); *Tartell*, 790 F.3d at 1257; *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984).

68. *Test Masters Educ. Servs., Inc. v. Robin Singh Educ. Servs., Inc.*, 799 F.3d 437, 445 (5th Cir. 2015).

69. See *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 18 (1st Cir. 2008) (“[T]he law instructs courts to consider several factors when undertaking this analysis: (1) consumer surveys; (2) the use of the term in media publications, (3) use of the term by competitors in the industry, (4) purchaser testimony concerning the term; and (5) the plaintiff’s use of the term.”); *Minn. Mining & Mfg. Co. v. Beautone Specialties Co., Ltd.*, 82 F. Supp. 2d 997, 1003 (D. Minn. 2000) (“The types of evidence relevant to the question of secondary meaning include: (1) customer surveys; (2) exclusivity, length, and manner of use; (3) amount and type of advertising; (4) media coverage; (5) sales volume and market share.”).

in question.<sup>70</sup> Ultimately, the purpose of these tests is to determine if the mark's primary function is the identification of the source of the product rather than the product itself.<sup>71</sup> In order to do this, the court must "look[] into the minds of potential customers,"<sup>72</sup> which can lead to a subjective analysis.<sup>73</sup> The tests developed by the circuits, however, have a built-in defense mechanism to avoid a purely subjective analysis—the use of consumer surveys. By using a more scientific method, courts can attempt to avoid a subjective determination.

## 2. The Importance of Consumer Surveys

It is important to first acknowledge that although surveys are a critical piece of every circuit's analysis, parties are not required to submit consumer surveys in order to prove or disprove secondary meaning.<sup>74</sup> Additionally, even when parties choose to submit surveys, these surveys are a probative, rather than a conclusive, factor in the analysis.<sup>75</sup> With these caveats, surveys can be an incredibly powerful tool in establishing secondary meaning. Surveys can provide concrete, statistical evidence to connect the mark to the source of the product, rather than the product itself. Allowing parties to actually reach out to the consumers in question and ask them if they associate the mark with the product rather than the producer provides a far more objective analysis than having the court attempt to emulate these consumers through the other factors in the secondary meaning balancing tests. The use of surveys removes the subjective element of the analysis entirely. Furthermore, the surveys are allowed to narrow the scope of inquiry to just the relevant consumer base, rather than being forced to address all consumers as a monolith.<sup>76</sup> This key detail allows parties to really focus in on the consumers who would be

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70. *Parks LLC v. Tyson Foods, Inc.*, 863 F.3d 220, 231 (3d Cir. 2017) ("In assessing secondary meaning, we have relied on the following factors, to the extent relevant: (1) the extent of sales and advertising leading to buyer association; (2) length of use; (3) exclusivity of use; (4) the fact of copying; (5) customer surveys; (6) customer testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and, (11) actual confusion." (citing *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000))).

71. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42 (1st Cir. 1998).

72. *I.P. Lund Trading ApS*, 163 F.3d at 42.

73. *See id.*

74. *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 201 (3d Cir. 2008).

75. *See Imig, Inc. v. Electrolux Home Care Prods., Ltd.*, No. CV 05-0529(JO), 2008 WL 905898, at \*10 (E.D.N.Y. Mar. 31, 2008).

76. *Cartier v. Samo's Sons, Inc.*, No. 04Civ.2268RMBDFE, 2005 WL 2560382, at \*4 (S.D.N.Y. Oct. 11, 2005) ("The plaintiff is not required to establish that *all* consumers relate the product to its producer; it need only show that a substantial segment of the relevant consumer group makes this connection." (quoting *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir. 1991))).

purchasing the products in question, maximizing the accuracy of the surveys.<sup>77</sup>

Courts have been very receptive to this shift toward a more objective method of determining whether a mark has acquired secondary meaning.<sup>78</sup> Though every circuit is free to weigh the factors of its unique secondary meaning test as it wishes, the circuits generally agree that consumer surveys are the most persuasive of the factors.<sup>79</sup> The Fifth Circuit has even gone as far as to say that in certain types of borderline cases, survey evidence may be required to prove secondary meaning.<sup>80</sup> With this in mind, it is clear that the use of consumer surveys has become an integral part of proving a mark has acquired distinctiveness through secondary meaning.

### III. FAILURE TO CREATE A UNIFORM STANDARD

Once a secondary meaning survey is commissioned and completed, the next step is to evaluate the results. The percent of participating consumers who were able to provide a “positive” response—identifying that the mark in question is a source identifier rather than a product identifier—will determine how persuasive the court finds the survey. Thus, the level of positive response needed to be probative of secondary meaning is a very important threshold to establish. If the bar is set too high, courts would require an overwhelming amount of the consumer base to recognize a mark in order to give it protection; if the bar is set too low, marks that are not actually distinct could become eligible for protection. Unfortunately, there is no uniformity<sup>81</sup> among the circuits as to the level at which the threshold for positive responses should be set. This lack of uniformity is a grave issue that must be rectified. Litigation of this issue will largely turn on the jurisdiction in which the suit is brought, something particularly unbecoming of a regulatory scheme that is meant to be national in its scope. Section III.A of

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77. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:46 (5th ed. 2018) (discussing that it does not need to be proven, using the general public, that the mark has acquired secondary meaning if the mark is directed toward a specific consumer base).

78. See *id.* § 32:195 (discussing the increasing importance and expectations of survey evidence).

79. *Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 430 (6th Cir. 2017) (“Survey evidence is the most persuasive evidence of commercial recognition.”); *Nola Spice Designs, L.L.C. v. Haydel Enters., Inc.*, 783 F.3d 527, 546 (5th Cir. 2015) (“While survey evidence is not required to establish secondary meaning, it is ‘the most direct and persuasive way of establishing secondary meaning.’” (quoting *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 248 (5th Cir. 2010))); *I.P. Lund Trading ApS v. Kohler, Co.*, 163 F.3d 27, 42 (1st Cir. 1998) (“Customer survey evidence, while not required, is a valuable method of showing secondary meaning.”); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985) (“An expert survey of purchasers can provide the most persuasive evidence on secondary meaning.”); *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970) (stating that “[s]hort of a survey” it is “difficult” to prove secondary meaning).

80. See *Nola Spice Designs*, 783 F.3d at 547.

81. See *infra* Section III.A (discussing the different levels of positive responses each circuit finds persuasive or determinative).

this Section discusses and highlights the different methods utilized by the different circuits. Section III.B of this Section illustrates why these differences are so harmful to both litigants and the federal trademark regulatory scheme as a whole.

#### A. FRACTURED CIRCUITS

Across the circuits, courts agree that surveys indicating extremely low levels of positive responses are not persuasive or indicative that the mark has acquired secondary meaning. There is near unanimity that surveys showing less than 25% of respondents associated the mark in question with the producer, rather than the product itself, are insufficient to suggest the survey is probative of secondary meaning.<sup>82</sup> Likewise, there is no debate that very high levels of positive responses are probative of secondary meaning. Positive responses of over 60% are consistently held to be more than sufficient to show that the survey is probative of secondary meaning.<sup>83</sup> To put this level of positive response into perspective, the association between “golden arches” and the McDonald’s franchise is about 85%.<sup>84</sup>

Unfortunately, this is where the uniformity ends. Courts have not been particularly successful at determining where the lower threshold for positive responses should be set, and the scholarship has noted this confusion.<sup>85</sup> Because of this, very slight differences in the percentages of positive responses can produce contradictory results depending on the jurisdiction. For example, a court in the Ninth Circuit’s jurisdiction held that positive

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82. See, e.g., *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 862 (C.C.P.A. 1962) (holding a positive response of 10% was insufficient to show secondary meaning); *Citizens Banking Corp. v. Citizens Fin. Grp., Inc.*, No. 07-11514, 2008 WL 1995104, at \*4-5 (E.D. Mich. May 6, 2008) (holding that a positive response of 8% was insufficient to show secondary meaning); *Walker & Zanger, Inc. v. Paragon Indus., Inc.*, 465 F. Supp. 2d 956, 966-67 (N.D. Cal. 2006) (holding a positive response of 25% was insufficient to show secondary meaning); *Zippo Mfg. Co. v. Rogers Imps., Inc.*, 216 F. Supp. 670, 689-90 (S.D.N.Y. 1963) (holding that a positive response of 25% was insufficient to show secondary meaning); *American Flange & Mfg. Co. v. Rieke Corp.*, 2006 WL 1706438, at \*23-24 (T.T.A.B. June 5, 2006) (holding a positive response of 19% was insufficient to show secondary meaning).

83. See, e.g., *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App’x 615, 618-19 (2d Cir. 2008) (holding that a positive response of 60% was sufficient to show secondary meaning); *General Motors Corp. v. Lanard Toys, Inc.* 468 F.3d 405, 418-19 (6th Cir. 2006) (holding a positive response of 77% was sufficient to show secondary meaning); *March Madness Athletic Ass’n L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 804 (N.D. Tex. 2003) (holding a positive response of 60% was sufficient to show secondary meaning); *Binney & Smith v. Rose Art Indus.*, No. CIV. A. 00-2939, 2001 WL 910943, at \*3, \*6 (E.D. Pa. Aug. 9, 2001) (holding that positive responses of 80%, 84%, and 92% were sufficient to show secondary meaning); *Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc.*, 26 F. Supp. 2d 834, 851 (E.D. Va. 1998) (holding that a positive response of 85% was sufficient to show secondary meaning).

84. *Black & Decker (U.S.) Inc.*, 26 F. Supp. 2d at 851.

85. MCCARTHY, *supra* note 77, § 32:190.

responses of about 30% mean the survey is probative of secondary meaning.<sup>86</sup> This is supported by the Trademark Trial and Appeal Board,<sup>87</sup> which held that a response of 33% is enough to make the survey probative of secondary meaning.<sup>88</sup> However, this is contradicted by a ruling out of the Second Circuit's jurisdiction, holding that a positive response of 32%, accompanied by some negative secondary factors, was insufficient to show the survey was probative of secondary meaning.<sup>89</sup> In other words, if the mark had been questioned in the Ninth Circuit rather than the Second Circuit, without actually changing anything about the survey evidence used to support it, the mark may have been found to have acquired secondary meaning.

Positive response rates between 30% and 40% seem to be an area of uncertainty for many jurisdictions. Courts within the Seventh Circuit, for example, have differing opinions on where the lower threshold should be set. In one case, a district court within the Circuit held that a mark with "close to" a 30% positive response in "weak[] markets"<sup>90</sup> was sufficient to show that the survey was evidence of secondary meaning.<sup>91</sup> However, that same year, the Seventh Circuit held in an entirely different case that a positive response of 30% was insufficient to show the survey in question was probative of secondary meaning, without explicitly determining where the necessary threshold to show secondary meaning should be set.<sup>92</sup>

The Seventh Circuit is not alone in this confusion, as the First Circuit has also had a string of contradictory rulings. To begin this strange line of cases, in *Boston Beer Co. Partnership v. Slesar Bros. Brewing Co.*, the First Circuit determined that a survey showing a positive response rate of 36% was not

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86. *Shuffle Master Inc. v. Awada*, No. 2:05-CV-01112-RCJ-(RJJ), 2006 WL 2547091, at \*3 n.1 (D. Nev. Aug. 31, 2006).

87. The Trademark Trial and Appeal Board is an administrative appeals board within the United States Patent and Trademark Office ("USPTO"). See *Trademark Trial and Appeal Board*, USPTO, <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board> (last visited Aug. 10, 2018). The Board handles various adversarial proceedings related to determinations made by the USPTO related to trademarks. *Id.*

88. *In re Carl Walther GmbH*, 2010 TTAB LEXIS 410 (T.T.A.B. Oct. 26, 2010).

89. *Johnson & Johnson v. Actavis Grp. HF*, No. 06 Civ. 8209, 2008 WL 228061, at \*2 (S.D.N.Y. Jan. 25, 2008) ("This percentage fell to 32% when the results from the control group were considered. Actavis further contends that the 32% figure is itself inflated because of flaws in the design of the survey. Actavis also points to studies conducted by Pfizer, a prior owner of NEOSPORIN®, in connection with advertising recalls of their products which could be read to show low consumer recognition of the Gold Mark. Taken as a whole, while J & J's evidence of secondary meaning is sufficient for a jury to conclude that the Gold Mark has acquired distinctiveness in the marketplace, it is insufficient to establish secondary meaning as a matter of law.")

90. *Sara Lee Corp. v. Am. Leather Prods., Inc.*, No. 97 C 4158, 1998 WL 433764, at \*8 (N.D. Ill. July 29, 1998). The court defined a weak market as one in which the producer did not have a freestanding store and a strong market as one in which the producer did have a freestanding store. *Id.* at \*8-9.

91. *Id.*

92. *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 295 (7th Cir. 1998).

probative of secondary meaning and was ineligible for protection.<sup>93</sup> The court described the 36% response as “hardly overwhelming,”<sup>94</sup> but did not expressly hold that responses of 36% were always insufficient to make a survey probative of secondary meaning.<sup>95</sup> Unfortunately, declining to determine where the positive response threshold lies appears to have been a mistake, as the district courts within the First Circuit struggle to apply this doctrine uniformly. For example, a district court within the First Circuit later held that a mark showing just a 29% positive response acquired secondary meaning.<sup>96</sup> But, just five years later, a different district court within the First Circuit found that a positive response of 36% was insufficient to show secondary meaning,<sup>97</sup> while reiterating that a positive response of 36% is not always insufficient to show the mark acquired secondary meaning.<sup>98</sup>

This analysis is further complicated by a more recent case arising in the First Circuit. In *Baystate Savings Bank v. Baystate Financial Services, LLC*, a district court within the First Circuit held that positive responses in the thirty percent range are only “marginal” in supporting the assertion that a mark acquired secondary meaning, while positive responses above 50% are typically sufficient.<sup>99</sup> Interestingly, the court cited a case from the Seventh Circuit in order to support the assertion that positive responses in the thirty percent range were only marginal.<sup>100</sup> This type of analysis is, in effect, creating a soft threshold.<sup>101</sup> Positive responses over the threshold of 50% are then presumed

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93. *Boston Beer Co. P’ship v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 183 (1st Cir. 1993).

94. *Id.* at 183 n.5.

95. *See id.* at 182–83 (“Just because one-third of those surveyed, when presented with a list of beers and a brewer whose name contained the words ‘Boston Beer,’ matched that brewer with Samuel Adams beer, does not mean that the words ‘Boston Beer,’ used in connection with appellant’s name, have necessarily assumed a secondary meaning. It is just as probable, as the district court lucidly explained, that appellant’s marks are still primarily perceived by consumers as geographically descriptive terms, and that consumers are simply aware of the fact that Samuel Adams is a Boston beer. Moreover, the district court observed that the survey was somewhat suggestive in that it gave the impression that Boston Beer Works was a ‘company,’ like Anheuser–Busch and Latrobe, as opposed to a restaurant/brew pub.” (footnote omitted)).

96. *Yankee Spirits, Inc. v. Gasbarro*, No. Civ. 96-10967PBS, 1998 WL 428092, at \*9–10 (D. Mass. May 26, 1998).

97. *Mark Bric Display Corp. v. Joseph Struhl Co.*, No. C.A. 98-532ML, 2003 WL 21696318, at \*9 (D.R.I. July 9, 2003).

98. *Id.* (“While the First Circuit in *Boston Beer* did state that ‘a positive response rate of 36% is hardly overwhelming,’ it did not hold that a positive response rate of approximately 36% is always insufficient to show secondary meaning as a matter of law.” (quoting *Boston Beer Co. P’ship*, 9 F.3d at 183 n.5)).

99. *Bay State Sav. Bank v. Baystate Fin. Servs., LLC*, 484 F. Supp. 2d 205, 217 (D. Mass. 2007).

100. *Id.* (citing *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 394 (7th Cir. 1992)).

101. A soft threshold is a benchmark for judges to utilize when determining if a survey is probative of secondary meaning. If the consumer survey shows a positive response rate above the soft threshold, the survey is likely probative of secondary meaning. However, in rare cases, the judge may decide that the survey is not probative after considering other factors, such as the quality of the survey, the target consumer base, or the type of product. If the consumer survey

to be sufficient, whereas the “marginal” status of positive responses below that line allow courts to make a judgment call on how persuasive the survey is in determining whether the mark had acquired secondary meaning. Though this does not create a hard line at 50% that surveys must reach, it does aid courts by giving them a mark to look for in their analysis.

While this holding is not inconsistent with the First Circuit’s decision in *Boston Beer*, it is noteworthy that the court in *Baystate Savings Bank* could not cite a First Circuit case establishing this soft threshold of 50%. Instead, the court could only cite a First Circuit case that held a positive response of “well over 50%” was sufficient to show secondary meaning.<sup>102</sup> However, there is a distinct difference between the First Circuit finding that a positive response of 50% was sufficient in a particular instance and the First Circuit creating a soft threshold by holding positive responses over 50% are “typically sufficient,” while response rates below this threshold are only “marginal.” Whether this was a mistake by the district court or a willful misinterpretation is irrelevant to the final conclusion: The district courts are evaluating positive responses of less than 50% in different ways.

This soft threshold has been shown to be a point of issue for other circuits as well. The Sixth Circuit noted in *Ashland Oil, Inc. v. Olymco, Inc.* that there was no consensus on what minimum level of positive response was needed on a consumer survey to be probative of secondary meaning.<sup>103</sup> This statement was immediately followed by the Court’s recognition that other jurisdictions held positive responses of over 50% to be sufficient, citing the Eastern District of Missouri<sup>104</sup> and the Seventh Circuit,<sup>105</sup> which has also shown a history of confusion on the topic.<sup>106</sup> The confusion the Sixth Circuit expressed in this case unfortunately trickled down into other jurisdictions as well. In *1-800 Contacts, Inc. v. Lens.com, Inc.*, a district court in the Tenth Circuit cited the *Ashland* case from the Sixth Circuit to establish precedent for a soft threshold of 50%, with positive responses in the 30% range only constituting marginal support for a finding of secondary meaning.<sup>107</sup> However, the Sixth Circuit did

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shows a positive response rate below the soft threshold, the judge may still determine the survey is probative of secondary meaning after considering the other factors. This is in contrast to a hard threshold, in which the survey only supports a finding of secondary meaning if the survey shows a positive response rate above the threshold level.

102. *Bay State Sav. Bank*, 484 F. Supp. 2d at 217 (citing *President & Trs. of Colby Coll. v. Colby Coll.-N.H.*, 508 F.2d 804, 809 (1st Cir. 1975)).

103. *Ashland Oil, Inc. v. Olymco, Inc.*, No. 94-5520, 1995 WL 499466, at \*3 (6th Cir. Aug. 21, 1995) (“[T]here is no general agreement as to what minimal level of consumer association with a single source is required to establish secondary meaning . . .”).

104. *Id.* (citing *Conopco, Inc. v. May Dep’t Stores Co.*, 784 F. Supp. 648, 677 (E.D. Mo. 1992), *rev’d*, 46 F.3d 1556 (Fed. Cir. 1994)).

105. *Id.* (citing *Spraying Sys. Co.*, 975 F.2d at 394).

106. *See supra* notes 90–92 and accompanying text.

107. *1-800 Contacts, Inc. v. Lens.com, Inc.*, 755 F. Supp. 2d 1151, 1180 (D. Utah 2010), *abrogated on other grounds by* 722 F.3d 1229 (10th Cir. 2013). *1-800 Contacts, Inc.* was affirmed in



not establish a soft threshold of 50% in *Ashland*.<sup>108</sup> In fact, the Court was not even required to reach this question, as the survey in this case only had a positive response rate of 26% when adjusted “for guessing by the respondents.”<sup>109</sup> The very low positive response of 26% was held to be insufficient to establish secondary meaning, without further analysis.<sup>110</sup> These facts, however, did not stop the court in *1-800 Contacts* from authoritatively citing *Ashland* to support a soft threshold of 50%.<sup>111</sup> The question remains: How can the court in *1-800 Contacts* authoritatively cite *Ashland*, when *Ashland* admitted there was no consensus on the minimum level of positive response necessary to show secondary meaning?

### B. THE HARMFUL IMPACT OF THE SPLIT

The confusion and contradictions in the analysis done by the courts when attempting to decide whether a consumer survey is probative of secondary meaning has two major faults. First, this lack of established doctrine prevents courts from fairly ruling on a critical part of the secondary meaning analysis. Second, the disarray of the circuits and the different methods used to analyze survey results is in direct contradiction with the intended purpose of federal trademark law.

In *Ashland*, the Sixth Circuit stated, “there is no general agreement as to what minimal level of consumer association with a single source is required to establish secondary meaning.”<sup>112</sup> Scholarship on the subject report similar confusion.<sup>113</sup> This is incredibly problematic. As mentioned previously, consumer surveys, though not dispositive<sup>114</sup> or required,<sup>115</sup> are the single most effective way to establish that a descriptive mark acquired secondary meaning.<sup>116</sup> Because of this, consumer surveys are a highly useful tool for

part and reversed in parts on grounds unrelated to the level of sufficiency provided by a response rate. See *1-800 Contacts, Inc.*, 722 F.3d at 1256–57.

108. See *Ashland Oil, Inc.*, 1995 WL 499466, at \*3.

109. *Id.* (“After adjusting this figure to compensate for guessing by the respondents, *Ashland*’s survey expert indicated that twenty-six percent of the Louisville respondents identified the mark with a single source. One-fifth of those respondents who said that ‘Instant Oil Change’ was a single company were able to recall, unaided, that the specific oil used was Valvoline.”).

110. See *id.* at \*4.

111. See *1-800 Contacts, Inc.*, 755 F. Supp. 2d at 1180.

112. *Ashland Oil, Inc.*, 1995 WL 499466, at \*3.

113. See MCCARTHY, *supra* note 77, § 15:45 (“Courts have been vague and uncertain in defining what is the minimum acceptable percentage of persons who have a secondary meaning in their minds.”).

114. *Imig, Inc. v. Electrolux Home Care Prods., Ltd.*, No. CV 05-0529(JO), 2008 WL 905898, at \*10 (E.D.N.Y. Mar. 31, 2008).

115. *E.T. Browne Drug Co. v. Cococare Prods., Inc.*, 538 F.3d 185, 201 (3d Cir. 2008).

116. *Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 430 (6th Cir. 2017) (“Survey evidence is the most persuasive evidence of commercial recognition.”); *Nola Spice Designs, L.L.C. v. Haydel Enters., Inc.*, 783 F.3d 527, 546 (5th Cir. 2015) (“While survey evidence is not required to establish secondary meaning, it is ‘the most direct and

producers to use in order to prove their marks acquired secondary meaning and are eligible for protection. The level of positive response needed on these surveys to indicate the mark acquired secondary meaning, therefore, may have a substantial impact on whether the court decides the mark in question is eligible for protection. It is absolutely counterintuitive for the level of positive response necessary to be probative of secondary meaning, an integral piece of the court's secondary meaning analysis, to remain a mystery to the courts applying multi-part secondary meaning tests. A court cannot be an arbiter of justice if there is no established doctrine from which to work. A single survey, particularly one in the high thirty percent range, may be seen to be sufficient in one jurisdiction while insufficient in another, purely based on the subjective leanings of the judge or judges determining the outcome of the case.

Congress has attempted to federally regulate trademarks since at least 1870.<sup>117</sup> With the passage of the Lanham Trademark Act in 1946, Congress took an unequivocal step toward a homogenous, federally regulated system.<sup>118</sup> Despite the source of the law coming from a single, unified entity—in this case, the Lanham Act—the circuits are clearly applying different doctrines to the analysis of consumer surveys for the purposes of determining whether a descriptive mark acquired secondary meaning.<sup>119</sup> This goes beyond a mere circuit split, since there are not two or even three established doctrines competing for viability between the circuits. Instead, the circuits seem to simply be in disarray on the issue.

Researchers note that circuit splits create “unique problems.”<sup>120</sup> These splits can create confusion and uncertainty for potential litigants.<sup>121</sup> If a litigant is not sure what level of positive response is needed on a consumer

persuasive way of establishing secondary meaning.” (quoting *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 248 (5th Cir. 2010)); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42 (1st Cir. 1998) (“Customer survey evidence, while not required, is a valuable method of showing secondary meaning.”); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985) (“An expert survey of purchasers can provide the most persuasive evidence on secondary meaning.”); *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970) (stating that “short of a survey” it is “difficult” to prove secondary meaning).

117. CHISUM ET AL., *supra* note 1, at 498 (“Congress enacted the first federal trademark statute in 1870 . . .”).

118. *See id.* at 499 (“In enacting the Lanham Act, Congress recognized that commercial activities were increasingly taking place on a national scale, so that state-by-state remedial schemes were not necessarily adequate to protect consumers and merchants from injury due to unfair competition.” (citing H.R. REP. NO. 79-219, at 4 (1945); S. REP. NO. 779-1333, at 5-6 (1946))).

119. *See supra* Section III.A.

120. Wayne A. Logan, *Constitutional Cacophony: Federal Circuit Splits and the Fourth Amendment*, 65 VAND. L. REV. 1137, 1147-48 (2012) (discussing the prevalence and harmful impact of circuit splits in the context of Fourth Amendment violations).

121. Jesse M. Boodoo, *Compounding Problems and Compounding Confusion: Federal Regulation of Compounded Drug Products and the FDAMA Circuit Split*, 36 AM. J.L. & MED. 220, 243 (2010) (discussing the confusion caused by the circuit split regarding the Food and Drug Administration Modernization Act (“FDAMA”)).

survey to be probative of secondary meaning, the litigant may refrain from bringing the suit at all. On the other hand, litigants may continuously bring lawsuits with positive responses lower than what is considered probative of secondary meaning, exasperating the already problematic judicial backlog with cases that courts could swiftly deal with if a clear soft or hard threshold was in place. Circuit splits also undermine judicial legitimacy, causing disillusionment with the judicial branch as a whole.<sup>122</sup>

These divisions between the circuits can also result in forum shopping,<sup>123</sup> which produces economic inefficiency.<sup>124</sup> Forum shopping and economic efficiency, particularly, are major concerns in trademark law. Trademark law inherently has a commercial aspect, considering trademark law exists to protect consumers and merchants engaged in commercial activities.<sup>125</sup> In such areas of the law, uniformity is needed to ensure the system does not become inefficient. It was this same concern for uniformity that led Congress to create the Court of Appeals for the Federal Circuit,<sup>126</sup> ensuring areas such as patent law would no longer have to deal with the uncertainty of circuit splits. Other highly commercial areas of the law, like trademarks, could similarly benefit from judicial uniformity. As highlighted in this piece,<sup>127</sup> the same level of positive response on a survey could be found to be probative of secondary meaning in some circuits while simultaneously found to be insufficient in others. A positive response of 33%, for example, may be probative of secondary meaning in the Ninth Circuit, while the Tenth Circuit would, at best, consider this level of response only marginal.<sup>128</sup> This is a textbook forum-shopping situation. If possible to bring the suit in another jurisdiction, plaintiffs have absolutely no reason to sue in jurisdictions that

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122. Logan, *supra* note 120, at 1173 (arguing that “[a]llowing such variation is a recipe for public disillusionment over the authoritativeness of national institutions” and stating “such a legitimacy deficit risks corrosion of respect for the Supreme Court itself”).

123. Matthew Lund, Comment, *Rockwell International, Pondcrete, and an A La Carte Three-Step Test for Determining an “Original Source” in Qui Tam Lawsuits*, 2008 BYU L. REV. 1243, 1244 (discussing how circuit splits regarding the interpretation of the statutory language of the False Claims Act has resulted in forum shopping by whistleblowers).

124. See generally Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 83 N.C. L. Rev. 889 (2001) (describing how circuit splits make case outcomes unpredictable, causing litigants to settle less often).

125. CHISUM ET AL., *supra* note 1, at 495 (“Trademark law serves two purposes—to protect consumers from being confused or deceived about the source of goods or services in the marketplace, and to protect the goodwill that merchants have developed in their trademarks.” (citation omitted)).

126. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (“It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases observing that increased uniformity would ‘strengthen the United States patent system in such a way as to foster technological growth and industrial innovation.’” (citation omitted) (quoting H.R. REP. NO. 97-312, at 20–23 (1981))).

127. See *supra* Section III.A.

128. See *supra* Section III.A.

they already know will be disadvantageous to them. In the interest of fairness, judicial legitimacy, forum shopping, and economic concerns, this circuit disarray should be rectified.

#### IV. CREATING A COMMON DOCTRINE TO UNITE THE CIRCUITS

Though the issue is clear, creating a solution is not necessarily a straightforward endeavor. There are many factors that must be considered when evaluating the potential effectiveness of any proposed solution, such as the ability for the solution to be tweaked or corrected at a later date, whether judges will still be afforded any discretion, how long such a solution would take to implement, and whether the solution would create any secondary issues when implemented. There are several ways to address the circuit disarray; this Note argues that the most compelling solution is the creation of a soft threshold by the Supreme Court. Secondary solutions, those that are plausible but not ideal, include the institution of a hard threshold by the Supreme Court, as well as Congressional intervention through amending the Lanham Act. Section IV.A discusses the merits, feasibility, and implementation of a judicially created soft threshold. Section IV.B details, alternatively, the implementation of a judicially created hard threshold and the possibility of Congressional intervention, explaining the merits of these solutions while also acknowledging their shortcomings.

##### A. THE IDEAL SOLUTION: A JUDICIALLY CREATED SOFT THRESHOLD

The ideal way to solve the confusion among the circuits is the implementation of a soft threshold by the Supreme Court. A soft threshold,<sup>129</sup> as discussed by the Seventh Circuit,<sup>130</sup> and district courts within the First<sup>131</sup> and Tenth<sup>132</sup> Circuits, provides a solution that addresses the major cause for the current uncertainty while simultaneously allowing courts to apply a holistic view rather than a rigidly formalistic test.

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129. See *supra* note 101.

130. See *Spraying Sys. Co. v. Delevan, Inc.*, 975 F.2d 387, 394 (7th Cir. 1992) (establishing that “a 50-percent figure is regarded as clearly sufficient to establish secondary meaning, [while] a figure in the thirties can only be considered marginal”).

131. See *Bay State Sav. Bank v. Baystate Fin. Servs., LLC*, 484 F. Supp. 2d 205, 217 (D. Mass. 2007) (stating “[c]ourts typically view survey evidence indicating that 50% or more of the consuming public associate a mark with the company’s products as sufficient to demonstrate secondary meaning” and “[a]lthough percentages below 50% can be a factor to consider in establishing secondary meaning, ‘a figure in the thirties can only be considered marginal’” (quoting *Spraying Sys. Co.*, 975 F.2d at 394)).

132. See *1-800 Contacts, Inc. v. Lens.com, Inc.*, 755 F. Supp. 2d 1151, 1180 (D. Utah 2010) (“Courts have found that consumer awareness exceeding fifty percent provides good evidence while ‘a recognition figure of thirty-eight percent’ provides only marginal evidence.” (quoting *Ashland Oil, Inc. v. Olymco, Inc.*, No. 94-5520, 1995 WL 499466, at \*3 (6th Cir. Aug. 21, 1995))). *1-800 Contacts, Inc.* was abrogated on other grounds. See *supra* note 107.

The core issue in the current state of affairs is the lack of an intelligible standard by which courts can evaluate the persuasiveness of a consumer survey.<sup>133</sup> If the circuits do not know what to look for or what standard to apply, they are free to create their own doctrine and standards, leading to the splintered and fractured application of federal protection. The first step to rectifying this issue is to set a threshold for courts to identify and apply when evaluating these surveys. In order to determine where this threshold should be set, the Court should look back to the roots of distinctiveness and secondary meaning; for a descriptive mark to have acquired secondary meaning, consumers must associate the mark with the producer or manufacturer rather than the product,<sup>134</sup> and consumers must also recognize that the product comes from a single source.<sup>135</sup> With these requirements in mind, the most logical place to set a threshold is at a 50% positive response rate. In the abstract, over 50% of a given population recognizing a mark as a source identifier seems to be a sufficient starting point for showing that the population, as a whole, is associating the mark in question with the producer of the product rather than the product itself. It is somewhat counterintuitive to argue that a population, as a whole, recognizes a mark as a source identifier if consumer surveys show that not even half of that population can recognize the mark in question as a source identifier on a survey. To further bolster the placement of the threshold at 50%, it is worth noting that current proponents of the soft threshold—the Seventh Circuit and district courts within the First and Tenth Circuits—have all placed their thresholds at 50%.<sup>136</sup>

The second step is to set up the threshold as a soft threshold rather than a hard threshold, the differences of which have been addressed in this Note.<sup>137</sup> Critically, a soft threshold provides the judge or judges presiding over the case the discretion needed to make the most accurate determination possible. Just because a consumer survey shows a positive response of over 50% does not automatically mean it is probative of secondary meaning; likewise, just because a consumer survey shows a positive response of under 50% does not automatically mean it is not probative of secondary meaning. This allows judges to tailor their determinations to the specific circumstances of each case, preserving the current practices of judges making this determination. In evaluating the persuasiveness of consumer surveys, judges have considered factors beyond merely the positive response rate, including the strength of

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133. *Ashland Oil, Inc.*, 1995 WL 499466, at \*3 (“[T]here is no general agreement as to what minimal level of consumer association with a single source is required to establish secondary meaning . . .”).

134. See *supra* note 64 and accompanying text.

135. See *supra* note 65 and accompanying text.

136. *Spraying Sys. Co.*, 975 F.2d at 394; *1-800 Contacts, Inc.*, 755 F. Supp. 2d at 1180; *Bay State Sav. Bank*, 484 F. Supp. 2d at 217.

137. See *supra* note 101 and accompanying text.

the market in which the trademark is used,<sup>138</sup> whether the survey was “opened in its construction,”<sup>139</sup> and whether the survey was “neutral in its administration,”<sup>140</sup> among others. The use of a soft threshold would allow judges to consider these factors while still providing a guidepost from which to base their determinations.

The final step in this solution is to ensure the Supreme Court sets the soft threshold rather than it being set through Congressional action. Issues such as this circuit disarray are exactly the type of problems the Supreme Court looks to rectify. Justice Van Devanter<sup>141</sup> once testified before Congress to express the opinion that the most important consideration when exercising the Court’s discretionary jurisdiction was promoting uniformity between the Circuits.<sup>142</sup> This statement is supported by Supreme Court Rule 10(a), which states that circuit splits are one of the reasons for which the Court would consider granting certiorari.<sup>143</sup> Empirical results show this assertion is supported by actual practice, with one study finding that it is not atypical for 70% of the cases the Supreme Court grants certiorari on to be borne from conflicting decisions in different jurisdictions.<sup>144</sup> The Court has explicitly stated that it will grant certiorari to resolve even particularly narrow issues if there exists a circuit split.<sup>145</sup> Therefore, the question of what level of positive response is needed on consumer surveys to be probative of secondary meaning is precisely the type of issue the Supreme Court should address, and historically has addressed.

Additionally, using the Supreme Court to create this change allows unparalleled flexibility when compared to other potential solutions. While attempting to correct a circuit split through the Supreme Court can often result in years of litigation, nothing precludes the Supreme Court from

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138. *Sara Lee Corp. v. Am. Leather Prods., Inc.*, No. 97 C 4158, 1998 WL 433764, at \*8–9 (N.D. Ill. July 29, 1998).

139. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 793 n.4 (5th Cir. 1983), *abrogated on other grounds by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

140. *Id.*

141. Justice Van Devanter had a long and illustrious legal career. He was appointed Chief Justice of the Wyoming Territory Supreme Court at the age of 30, served as an assistant U.S. Attorney General, was later appointed to the U.S. Court of Appeals for the Eighth Circuit, and was eventually appointed to the U.S. Supreme Court. *Willis Van Devanter*, OYEZ, [https://www.oyez.org/justices/willis\\_van\\_devanter](https://www.oyez.org/justices/willis_van_devanter) (last visited Aug. 12, 2018).

142. *Procedure in Federal Courts: Hearing on S. 2060 and S. 2061 Before a Subcomm. of the S. Comm. on the Judiciary*, 68th Cong. 29–30 (1924). Justice Van Devanter testified that when exercising discretionary jurisdiction, the Supreme Court should determine “whether the case is of such a character that the last word, the ultimate guiding rule, should be announced by the Supreme Court, so that there may be uniformity of decision in the several circuits courts of appeal, and also uniformity of decision in the State courts in so far as Federal matters are concerned.” *Id.*

143. SUP. CT. R. 10(a).

144. Ryan Stephenson, Note, *Federal Circuit Cases Selection at the Supreme Court: An Empirical Analysis*, 102 Geo. L.J. 271, 274 (2013).

145. See *Moskal v. United States*, 498 U.S. 103, 106 (1990).

continually addressing the issue if the need arises. If the soft threshold was set too high or too low, the Supreme Court could simply take another secondary meaning case and correct the mistake. Having its fingers on the pulse of the circuits, the Supreme Court would be in the perfect position to know when or if the soft threshold should be tweaked.

In practice, a soft threshold set to 50% would be quite simple to apply. If a survey shows a positive response rate of over 50%, it is presumptively probative of secondary meaning; if the survey results show a positive response rate of under 50%, it is not presumptively probative of secondary meaning. However, this presumption—or lack thereof—may be overcome by secondary factors that courts are already known to consider in their analyses.<sup>146</sup> In essence, this creates a “zone” of plausibility marginally above and below the 50% threshold. Surveys with positive responses below the 50% threshold may be found probative of secondary meaning if they are accompanied by strong secondary factors. Likewise, surveys with positive responses just above the 50% threshold may be found to be not probative of secondary meaning if accompanied by particularly weak secondary factors. This system creates an important guidepost, at the level of a 50% response rate, for judges to utilize while still allowing judges to consider the totality of the circumstances that produced the survey. After the survey is determined to be probative or not probative of secondary meaning, the court would then proceed to apply its multi-factor secondary meaning balancing test.<sup>147</sup>

Currently, judges have no guidepost from which to start their analyses, allowing judges across circuits to arbitrarily decide for themselves what level of positive response should be probative of secondary meaning. As shown throughout this Note,<sup>148</sup> this has created a situation where circuits are allowed to come to wildly different conclusions regarding what level of positive response is probative of secondary meaning. This solution corrects this issue by implementing a threshold from which to work, while still encouraging a holistic view of the evidence surrounding the survey, allowing judges to tailor their determinations to each case. For these reasons, a soft threshold created by the Supreme Court is the ideal solution to solve the circuit disarray.

#### B. SECONDARY SOLUTIONS

In addition to the Supreme Court implementing a soft threshold, there are other possible solutions available as well. Alternatively, the Supreme Court could implement a hard threshold, or Congress could intervene to establish a hard or soft threshold through legislative action.

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146. See *supra* notes 138–40 and accompanying text.

147. See *supra* Section II.B.1.

148. See *supra* Section III.A.

A hard threshold<sup>149</sup> is the counter to the soft threshold. While the soft threshold allows some wiggle room above and below the 50% threshold, a hard threshold does not. Surveys with a positive response of over 50% would be probative of secondary meaning while surveys below the 50% threshold would not be found probative of secondary meaning. The hard threshold is admittedly easier to apply to surveys, as it is a rigid, formalistic test. It creates a strong guidepost with which courts can work. If the survey's positive response crosses the threshold, it is probative of secondary meaning. However, such a rigid approach neglects to take into account secondary factors that allow courts a more holistic view of the surveying process. Restricting the survey analysis to simply the positive response rate, ignoring factors such as the intended consumer base, the neutrality of the survey, and the survey's open-endedness, lowers the survey's accuracy at measuring whether the mark has acquired secondary meaning in the marketplace. Because of this, a soft threshold is a superior solution to a hard threshold.

A far less likely and effective, though still plausible, method for correcting the circuit disarray is through legislative action. Distinctiveness is currently analyzed under the *Abercrombie* framework,<sup>150</sup> which makes legislative intervention difficult to accomplish. Though trademark law is ultimately governed by the Lanham Act,<sup>151</sup> the Act itself does not establish the tiers of distinctiveness set up in *Abercrombie*. However, the Act does specify that marks are not eligible for protection if they are "merely descriptive."<sup>152</sup> Since the marks attempting to acquire secondary meaning are descriptive,<sup>153</sup> Congress could address the circuit split by amending this provision in the Lanham Act to include the *Abercrombie* framework and to give further guidance regarding how these descriptive marks are to acquire secondary meaning—and through this method, establish a hard or soft threshold on the issue of using consumer surveys to show a descriptive mark acquired secondary meaning.

However, there are some clear deficiencies in this method. Though Congress has amended the Lanham Act since it was originally passed in 1946, the amendments have essentially all been passed in order to make substantial changes to trademark law. For example, in 1995 Congress passed the Federal Trademark Dilution Act<sup>154</sup> and revised it in 2006 with the Trademark Dilution Revision Act.<sup>155</sup> These amendments greatly increased the level of protection

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149. See *supra* note 101 and accompanying text.

150. See *supra* Section II.A.

151. See *supra* Part II (discussing the historical development of trademark law and factors which led Congress to pass the Lanham Act).

152. 15 U.S.C. § 1052(e) (2012).

153. See *supra* Section II.B.

154. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996).

155. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (2006).



federal trademark law gives against the dilution of marks.<sup>156</sup> Similarly, in 1999, Congress passed the Anticybersquatting Consumer Protection Act,<sup>157</sup> overhauling trademark protection in the realm of domain names.<sup>158</sup> Setting the working threshold needed to indicate secondary meaning is an important and meaningful endeavor, but it cannot be said that it will fundamentally change trademark law in the same way that these amendments have. Dealing with a more niche issue, such as the level of positive response on consumer surveys needed to indicate secondary meaning, may be below the concerns of an already busy Congress that is tasked with solving issues beyond only the ineffective application of existing law.

Furthermore, there are logistical issues with a Congressional solution. Bills will have to be written, revised, and passed in both houses; this process, certainly not a speedy one, could take years. Additionally, any resolution passed would be quite final. For example, though parts of the Trademark Dilution Revision Act were identified as in need of revision, Congress did not pass the Trademark Dilution Revision Act for another 11 years. Though solving the issue through the Congressional method would allow subcommittees to examine the problem through extensive research and recommend a highly-sourced solution, the solution would then only be able to be changed through an additional act of Congress, which may be placed on the “back-burner” for an extended period of time, or never touched again. This is a substantial risk. As previously addressed, if a solution is implemented by the Supreme Court, the Supreme Court would then be free to tweak the threshold as it sees fit while still leaving the door open for Congressional intervention. If Congress implements a solution, only Congress will have the power to amend that solution, which may become incredibly problematic if the threshold is later found to be in need of tweaking or if the courts come to a consensus on one type of threshold being superior to the other. With Congressional gridlock always a concern, delegating the power to amend this

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156. CHISUM ET AL., *supra* note 1, at 500 (“In 1995, Congress followed the lead of states that had enacted dilution laws to protect trademark owners against certain unauthorized uses of their marks that could undermine the selling power, or tarnish the reputation, of their marks even in the absence of competition or likelihood of confusion. In the Federal Trademark Dilution Act (FTDA), Congress added section 43(c) to the Lanham Act, creating a cause of action for dilution of the selling power of ‘famous’ marks. In 2006, Congress enacted the Trademark Dilution Revision Act (TDRA), amending section 43(c) in response to ten years of judicial interpretations.” (citations omitted)).

157. Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, § 3001, 113 Stat. 1501 (1999).

158. CHISUM ET AL., *supra* note 1, at 500 (“Congress sought to remedy these problems in 1999 with the Anticybersquatting Consumer Protection Act (ACPA), which added section 43(d) to the Lanham Act. In this provision, Congress sought to define with greater certainty the circumstances in which registration, use, or trafficking in a domain name that resembles a valid trademark violates the rights of a trademark owner, and to establish procedures for enforcing such rights even when the infringer is beyond the personal jurisdiction of the federal courts.” (citations omitted)).

solution to a body that is notorious for ignoring critical issues is less than ideal. For these reasons, a soft threshold established by the Supreme Court is the superior solution.

#### V. CONCLUSION

Uniformity and certainty are advantageous, in the context of our federal legal system. Contradictory decisions and confusion among the circuits is not good policy, nor is it good practice. In situations such as this, where district courts within the same circuit are applying different analyses on the same issue and the Circuits themselves do not believe there is any consensus on how the issue should be addressed, a solution must be implemented. If there is a need for a remedy, a remedy should be given. Without a doubt, there is a very clear need for some kind of intervention. Either Congress or the Supreme Court should establish a soft or hard threshold for the level of positive response needed on a consumer survey to be probative of secondary meaning, finally giving this area the clarity it so desperately deserves. Ideally, the Supreme Court will swiftly and conclusively solve this problem by clarifying the existing case law and implementing a soft threshold to guide the courts.