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APRIL 7,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Warner-Lambert Company
v.
Nabisco, Inc.

Opposition Nos. 92,062 and 92,162
to application Serial Nos. 74/307,317 and 74/348,595
filed on August 21, 1992 and January 14, 1993

Dolores A. Moro, Anthony F. LoCicero and Laurie J. Gentile of Amster Rothstein & Ebenstein for Warner-Lambert Company.

Steven H. Hartman for Nabisco, Inc.

Before Cissel, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Nabisco, Inc., filed intent-to-use applications to register the marks BURSTING FLAVOR[1] for chewing gum ("Flavor" is disclaimed) and BURSTING WITH FLAVOR[2] (no disclaimer) for bubble gum and chewing gum. Both applications for registration have been opposed by

[1] Application Serial No. 74/307,317 filed August 21, 1992.
[2] Application Serial No. 74/348,595 filed January 14, 1993.

Warner-Lambert Company on the ground that the marks are merely descriptive of the goods, in that they each describe qualities, ingredients or characteristics of applicant's bubble gum and/or chewing gum.

On April 17, 1996, in ruling on opposer's motion for summary judgment, this Board concluded that summary judgment was inappropriate in this case. After reviewing carefully the standards for summary judgment, the Board held that the evidence of record was insufficient to warrant a finding that these terms are merely descriptive as a matter of law, citing, *inter alia, Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board concluded that there was a genuine issue of material fact in this case as to whether BURSTING FLAVOR and BURSTING WITH FLAVOR, as applied to bubble gum or chewing gum, would immediately convey to ordinary purchasers a characteristic of applicant's gum. In response to the Board's focus on the "perceptions of the average prospective purchasers for the goods," the parties have made customer surveys a major focus of this trial.

In its notice of opposition to BURSTING FLAVOR, filed on July 15, 1993, Warner-Lambert Company noted its ownership of a federal trademark registration for CINN-A-BURST for

chewing gum[3] as well as an alleged family of other marks having *BURST formatives. At the beginning of this opposition proceeding, Opposer had seven pending, intent-to-use applications to register marks having *BURST formatives.[4] Only two of these seven applications, for the marks MINT*A*BURST for chewing gum,[5] and FRUIT*A*BURST, also for chewing gum,[6] have since matured into federal registrations. However, the ground for opposition is not likelihood of confusion, but rather that BURSTING FLAVOR is descriptive of a quality, attribute or characteristic of these goods. Then several days after filing the above opposition to the application to register the mark, BURSTING FLAVOR, Warner-Lambert Company, on July 19, 1993, filed a notice of opposition to the application to register the mark, BURSTING WITH FLAVOR, on the same ground. After applicant filed its answers denying the allegations in the notices of opposition, the two proceedings were consolidated with the mutual consent of the parties.

Opposer relied upon the above-enumerated registrations, of which title and status copies were submitted for the

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[3] Reg. No. 1,652,772, issued July 30, 1991, §8 affidavit accepted & §15 affidavit received.

[4] In addition to Registration No. 1,652,772 for CINN-A-BURST, Warner-Lambert (opposer) listed a “family” of “BURST” marks [74/143,729 -- BUBB*A*BURST; 74/347,929 -- BUBB*L*BURST; 74/277,080 (and then later, 74/653,678 -- FRUIT*A*BURST; 74/183,780 -- MINT*A*BURST; 74/277,321 -- PEPP*A*BURST; and 74/277,317 -- SPEAR*A*BURST].

[5] Reg. No. 1,865,359, issued November 29, 1994.

record. The parties jointly stipulated to the admissibility of the February 1995 declaration of Jill Rand, opposer's business manager, as well as the declaration of Hunter McFarland, applicant's senior product manager at the time of opposer's motion for summary judgment. Furthermore, the parties stipulated that:

> [a]ll deposition testimony and documentary and/or physical exhibits submitted by the parties in support of, or in opposition to, as the case may be, Opposer Warner-Lambert Company's Motion for Summary Judgment filed on February 13, 1995, in these opposition proceedings, shall be deemed admitted in evidence for all purposes in these opposition proceedings.[7]

Pursuant to this stipulation, we have, *inter alia*, evidence of Applicant's actual usage of these phrases on the trade dress of its gum packaging.

Opposer filed a notice of reliance on: the discovery depositions of a number of applicant's employees -- Ginger Carol Gay,[8] Brad Zabel,[9] Kevin Bokeno[10] and Robert J Gfeller,

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[6] Reg. No. 2,011,108, issued October 22, 1996.

[7] This joint stipulation was signed by both parties on October 10, 1996

[8] Associate Product Manager, Gummy/Chewy Products, Planters LifeSavers Division, Nabisco Foods Group, RJR Nabisco.

[9] Associate Product Manager, Care*Free Gum, Planters LifeSavers Division, Nabisco Foods Group, RJR Nabisco (1991-1992), who during this period reported to Bob Gfeller.

[10] Applicant's employee primarily responsible for consumer research for Care*Free gum. He had extensive interaction with Kristine A. Woodworth of Directions Research, Inc., during relevant periods, and produced for his bosses the "topline reports" made of record in this proceeding.

Jr.[11]; the discovery deposition of Applicant's outside market research consulting firm, Directions Research, Inc., through its designated witness, Kristine A. Woodworth[12]; dictionary definitions of the terms "burst" and "flavor"; and selected responses from applicant to opposer's first set of interrogatories.

The record now also contains a consumer survey with extensive back-up documentation submitted during deposition testimony on October 8, 1996 by Dr. Donald E. Payne, who conducted the survey on behalf of opposer (with exhibits) and the deposition testimony of Dr. Payne again on July 1, 1997, during rebuttal. In turn, applicant submitted the deposition testimony and "Expert Report" of George Mathis, its own survey expert.

Following the Board's denial of its motion for summary judgment, opposer decided to conduct a survey of consumer perceptions. Accordingly, in mid-July 1996, opposer's counsel, Ms. Gentile and Mr. LoCicero, asked Dr. Donald E. Payne for his recommendations for consumer research to determine the consumer perception of the phrases BURSTING FLAVOR and BURSTING WITH FLAVOR. After conducting the research agreed to by opposer's counsel, on August 20, 1996, Dr. Payne issued his report entitled "Consumer Perception

[11] Senior Marketing Manager, Care*Free Gum, Planters LifeSavers Division, Nabisco Foods Group, RJR Nabisco (1990 – 1992).

Study." The Board has reviewed the actual completed survey instruments, the computer compilations, as well as the Final Report.

Then, in January 1997, at the request of applicant, George Mantis issued his own report. Presented as an expert in consumer surveys, Mr. Mantis was critical of the reliability and methodologies of the Payne study as well as what conclusions could fairly be drawn therefrom. In addition to continuing to emphasize their respective contentions made at the time of the motion for summary judgment, much of counsels' arguments in the trial briefs are centered on the significance, if any, of the Payne survey.

Testimony and other non-survey evidence

Before tackling the intricacies of the survey design and results, we feel compelled to review in some detail the other evidentiary materials contained within this voluminous record.

Applicant argues that there is no reason this Board should make a determination under §2(e)(1) of the Trademark Act based upon its own employees' testimony using words like "describe," "mean," or "connote." On the other hand, opposer points to multiple examples from applicant's

[12] This deposition was also included in the parties' joint stipulation of October 10, 1996.

(Nabisco / Planters-LifeSavers) employees' deposition testimony where these deponents seem to agree with opposer that these terms constitute descriptive attributes of the gum:

> Brad Zabel's testimony:
> A: "… [BURSTING FLAVOR means] that the product had a lot of flavor…that there was some duration component to the BURSTING FLAVOR…EXTRA seemed to … perform better on the attributes of long-lasting flavor, bursting and juicy flavor." [p.12].
>
> Brad Zabel's testimony:
> Q: "…And bursting with flavor is a product attribute, is that correct?"
> A: "I think so. It's an attribute of – that can be used in talking about gum." [p.13].
>
> Brad Zabel's testimony on the choice of word BURSTING over the word BURST:
> Q: "… 'phrasing such as bursting flavor seemed to describe a gum with a consistent strong flavor, whereas a burst of flavor suggested a weaker gum in the middle and later stages of the chew.' Does that correspond to your understanding of the way those two phrases were perceived by consumers?"
> A: "Yes. That's the source of this comment." [p. 16]
>
> Ginger Carol Gay deposition:
> Q: "Do you think that when people chew Care*Free gum, the perception of its flavor – that is, what you described as an immediate hit of flavor and one that continues – is accurately described as 'Bursting with flavor.'?"
> **A:** "Yes." [p.79]
>
> Kevin Bokeno's "TopLine Report" dated Sept 26, 1991: "BURSTING FLAVOR" listed in table under "product attribute."
>
> Kevin Bokeno's testimony:

> Q: "OK, what did 'has BURSTING FLAVOR' mean?"
> A: "A strong flavor that lasted throughout the duration of the chew. It's used to connote a strong flavor." [p.13]
>
> Kevin Bokeno's testimony on the choice of word BURSTING over the word BURST: 'consumers understood it to describe a gum with a consistently strong flavor throughout duration of chew better than BURST, seen as weaker flavor in middle and end of chew.' [pp. 19-20]

In making the point that these terms do not immediately and directly refer to a feature of the gum, applicant argues from Mr. Gfeller's testimony that the term "Bursting flavor" means something more, if not different, than simply a strong, continuous flavor. Mr. Gfeller testified that "Bursting flavor" was chosen to impart the image of a flavor that "tends to grow and grow and evolve and fill or consume the consumer's mouth, and therefore gives them a feeling of bursting, long-lasting flavor."

Opposer responds by pointing out arguably damaging language elicited from Mr. Gfeller on cross-examination:

> Gfeller testimony:
> Q: "Would you agree that the list of factors [in table, including 'has bursting flavor'] on the vertical axis of the chart are product attributes?"
> A: "Yeah, they are." [p.19]
>
> Gfeller testimony:
> Q: "..does that portion of the sentence indicate a characteristic of the Care*Free Sugarless Bubble Gum?"
> A: "Yeah, that it's bursting with juicy bubble gum flavor."

Applicant points out that the imaging and positioning studies were tools of market research, done exclusively for marketing purposes. Applicant argues that there is no basis for going from these studies (and related testimony) containing words like “describe,” “mean,” or “connote” to a legal determination under Sec. 2(e)(1). Yet opposer points out rather explicit testimony undermining applicant’s position:

> Kristine Woodworth on imaging study (existing market image in 1991): “… ‘initial *burst of flavor’* was one of ‘the product attributes’ talked about with Kevin Bokeno.” [pp. 20-21]

Applicant also points to the findings of the Positioning Study, and observes that respondents generated a diverse set of words having the same connotation as “bursting” (e.g., “zing,” “flavor surge,” “blast,” “shock to your mouth,” “ice in your mouth,” “juicy cool,” “minty,” “minty soft,” “slap in your face,” “cool water on the face,” etc.). Applicant rightly questions whether such a wide spectrum of expressions –- some of which are synonymous with neither the relevant “Bursting” phrase nor each other -- can provide evidence of descriptiveness under §2(e)(1) of the Lanham Act. In fact, applicant argues that the cited marketing studies undertaken by applicant in years past actually support the opposite conclusion -- that these terms do not immediately and directly describe one, specific characteristic of gum. Applicant points out that Ms.

Woodworth specifically says during her testimony that she does not really know what these terms are supposed to mean.

Again, however, opposer points to her testimony on cross-examination that supports its position. Opposer's counsel points to the following interview question in the positioning study: "I'm going to read you several phrases which could be used to describe bubble gum…" In her deposition, Kristine Woodworth is asked:

> Q: " What was meant by the phrase '… phrases which could be used to describe bubble gum'?"
> A: "We're just trying to describe to the respondents what we meant by the product attributes. Just, 'here are some words that could be used to describe gum'."
> Q: "Like 'having Bursting Flavor'?"
> A: "Eh-huh."

On the question of what the advertising copy reflected in the record communicates, applicant argues that this advertising supports a finding of suggestive meaning and not mere descriptiveness. Opposer points out specific language from the advertising copy used in the positioning study to make the opposite point:

> CARE*FREE sugarless bubble gum is bursting with juicy bubble gum flavor. Enjoy the *bursting flavor* of CARE*FREE sugarless bubble gum. When you chew a piece, the juicy bubble gum flavor fills your mouth and lets you break away within the world around you. CARE*FREE sugarless bubble gum's bursting juicy flavor lets you break away.

Opposer goes on to point out that based upon data collected from the respondents, applicant decided that

"Bursting Flavor" represented a more viable positioning than "Long-Lasting Flavor" –- yet another alternative, descriptive phrase.

Applicant stresses that its gum has no crystals. Applicant has argued throughout this case that nothing in its gum actually "bursts" in the dictionary sense of this one word because no "exploding" or "abrupt" action is characteristic of this gum. In fact, applicant argues that its marks, "Bursting with flavor" and "Bursting flavor," are actually incongruous phrases that by definition require some mental effort to understand.

On the other hand, opposer argues that "Bursting with flavor" is an entire expression merely descriptive of an attribute or characteristic of applicant's goods. Opposer counters that these terms must be looked at in their entireties. The alleged marks are not just "Bursting" in the abstract, but rather the word "Bursting" within a phrase where it modifies, or is combined with, the word "flavor." Opposer argues that every competitor in this field needs to be able to use non-proprietary terms like "bursting," bursting flavor," "bursting with flavor," etc.

On this important point, we agree with opposer. "Bursting with flavor" and "Bursting flavor," are not arbitrary, coined or fanciful terms. Rather, these are combinations of common English words. Applicant is not

using them in a novel combination. Consistent with the dictionary entries made of record by opposer, we find that these expressions would be readily understood as describing food items, such as fruits, meats and spices.

The Payne Survey

We now turn to a detailed examination of the Payne survey, which since 1996 has occupied much of the attention of the parties to this dispute.

In a nutshell, the Payne survey concluded that three out of five respondents (60%) thought the term “Bursting flavor” conveyed to them an attribute of taste or flavor. Similarly, about four out of five respondents (78%) thought the term “Bursting with flavor” conveyed to them an attribute of taste or flavor. Opposer argues that inasmuch as its survey was properly designed and conducted according to fair and scientific methodologies, it proves that consumers perceive applicant’s alleged marks as merely descriptive.

Applicant contends that the Payne study is “fatally flawed” and cannot possibly demonstrate in a legal sense the mere descriptiveness of the terms “BURSTING FLAVOR” or “BURSTING WITH FLAVOR.” Applicant’s counsel and expert argue that: these marks mean many different things to different consumers; Dr. Payne’s own testimony on cross-examination shows that the word “conveys” could well be used

to generate free associations from respondents; these two marks have no readily understood meaning, and they describe nothing specific about the taste or flavor of the gum; the ambiguity of the word “convey” in questioning does not elicit immediate and direct meaning (i.e., vagueness of word “convey” does not distinguish between suggestive and descriptive matter); the biased structure of descriptive terms immediately preceding the test phrases in three of the four different rotations, the repeated use of probe questions, along with large but meaningless net percentages are fatally flawed; and that absent any degree of “particularity” in alleged descriptiveness, the survey actually makes the case for suggestiveness.

Opposer’s rebuttal is that the Payne survey was properly designed; the survey was conducted in accordance with proper methodologies; applicant has submitted criticisms of opposer’s survey without proffering a survey of its own; if the Board finds any weaknesses in the Payne survey, it merely affects the weight of the survey results, but does not destroy its probative value; the Board’s criticisms (in the decision denying summary judgment for opposer) of attaching legal significance to the words “connotes” or “describes” in applicant’s earlier market research is not relevant to the use of the word “conveys” in a survey specifically designed to test descriptiveness at

some later date; the accumulated taste/flavor responses are *not* distinct, vastly different, remote or tangential, but *rather* comprise minor variations on a common theme, logically and properly combined together into a single set of like responses; and, that a review of the data demonstrates a high degree of similarity of meaning among the combined "taste/flavor" categories.

Opposer and its expert defend the survey's failure to permit expressly an answer from respondents of "don't know," arguing the presence of this option would have reduced the accuracy of this survey. Applicant argues that without the "don't know" possibility, Payne was forcing answers. According to applicant, because this is an opinion survey rather than testing knowledge of facts, not everyone will have an opinion, but respondents will still feel compelled to come up with an answer –- any answer. In rebuttal, Opposer argues that employing open-ended, unbiased questions is a much better method for getting consumers' real perceptions than are more leading questions. Opposer argues these were not heavy or intellectual questions -- the interviewers merely presented a series of everyday words to young gum-chewers in a shopping mall, and recorded their reactions.

The Payne survey introduced two "control" terms in the hope of anchoring points on the generic end of the spectrum

–- “Sugarless gum” and “Artificially flavored.” Applicant argues that since the survey screener in each case had earlier questioned possible respondents about what type of gum they had bought recently or used regularly (i.e., sugarless gum, sugared gum, or sugarless bubble gum, sugared bubble gum), this was a form of conditioning for descriptiveness responses that inevitably distorted later answers as to what was conveyed to the respondent by the term “sugarless gum.”

The Payne survey also introduced two “control” terms in the hope of anchoring points on the source-indicating end of the spectrum – “Double your pleasure” and “The candy coated gum.”[13] However, more respondents put this into the “taste-flavor category than recognized it as a source indicator. In fact, the taste/flavor scores for “Double your pleasure” rivaled those of the two test phrases herein. Applicant contends that the survey clearly has a high percentage of “false positives” for taste/flavor, invalidating it as an instrument to test descriptiveness. In its rebuttal, opposer argues that while the survey used a phrase it

[13] Neither of the parties dwelt on the seemingly flawed choice of this term as a source indicating control in the Payne survey, so we will not pursue it at length either. However, this seems to be a reference to opposer’s 1993 registration on the Supplemental Register for “THE ORIGINAL CANDY COATED GUM” for chewing gum [Reg.No. 1,802,989] -- where the generic term “candy coated gum” is disclaimed. To the extent applicant argues conditioning for descriptiveness, this is arguably yet another reason to find bias in the Payne survey’s results.

thought to be a strong, well-known trademark, perhaps it proved at present not to be nearly as strong a trademark in this industry as opposer had assumed.

Dr. Payne testified about the manner in which data processing persons read verbatim responses and then placed them in like categories for coding. After several trials, it became necessary to add new categories for like kinds of responses not listed in the initial tables. Clearly, prior to his testimony in this case, Dr. Payne found it necessary to made some hand-written corrections to the summary tables.

Applicant focuses on several specific examples of hand-written corrections to fix earlier cases of miscoding. In short, applicant raises suspicions about the reliability of the numbers, and argues that any quick synopsis of the Payne findings that stresses the 60% and 78% numbers would be most misleading.

Opposer argues in rebuttal that any miscoding resulted in very small discrepancies that are irrelevant given the overwhelming thrust of the survey data demonstrating descriptiveness.

Opposer defends the use of “probe questions” in the data-gathering phase of the study. Following the initial question about what each one of the rotating, five phrases “conveyed” to the respondent, the interviewer would ask two

more probe questions – i.e., “What else?” and “Anything else.” Opposer argues that this format is consistent with standard survey procedure, especially if one is to get further elaboration on open-ended questions. Opposer noted that the interviewers used the same five cards (containing the four “control” phrases discussed above, plus either “Bursting Flavor” or “Bursting with Flavor”), but rotated their order to deal with the possibility of “order bias.”

Applicant counters that the responses were clearly the result of a survey design that fostered extrapolation, thought, creativity and imaginative thinking. Applicant contends that the very first probe question encouraged guessing. Then, according to applicant, the repetition of probe questions later in the rotations taught the respondents to employ multi-stage reasoning. Applicant contends that the nature of the verbatim responses shows huge mental leaps and lots of free associations by the survey respondents. Applicant claims that this tended to increase the chances of “taste/flavor” answers to the probe questions.

In response, opposer points out that a high percentage of respondents had no answer to the probes, and therefore their first answer was direct and immediate. Furthermore, opposer points out that a careful review of the data shows that the nature of responses remained the same throughout

the progression of these fifteen questions (i.e., three queries -- the initial question and two follow-up probe questions -- for each of five terms) asked of each survey subject, i.e., later questions did not result in a higher percentage of answers to probe questions.

Opposer notes that given the nature of the mall intercepts, the explicit instructions and the straightforward nature of the queries, the respondents' answers were immediate and direct.

By contrast, applicant notes that there is no indication anywhere of the amount of time respondents took to answer questions.

However, opposer points out that even applicant's own expert agrees that the time it took a respondent to answer a question is probably irrelevant.

Dr. Payne indicated that if the verbatim answers revealed no indication of a respondent's ruminations (e.g., 'I believe…,' 'I guess I would have to say…'), one has to assume the answers were direct and immediate. Applicant, however, contends there is no question but that some complex thought processes led to these answers. Applicant argues that even Dr. Payne's own testimony on cross-examination shows that the term "conveys" is a term that can be used to evoke free associations. According to applicant, associations or perceptions, if not made with sufficient

immediacy or directness, are useless in making our §2(e)(1) determination.

Applicant charges that given the expanded scope of the study's "taste/flavor" category, the net and total numbers are meaningless. It contends that if one combines the vagueness of "conveys" with two follow-up, probe questions to each phrase's initial query, and then finally throws almost anything into the "taste/flavor" category, the study results are not compelling at all. In reflecting on all the testimony, including that of Applicant's employees and contractors (made part of the record pursuant to the terms of the parties' October 10, 1996 joint stipulation), applicant argues that, like the study, all the answers are different, vague, and subjective.

Yet viewing the same evidence, opposer reaches the opposite conclusion -- arguing that the survey results had a particularity of meaning, not unlike that shown by the testimony taken of applicant's employees and outside marketing specialists.

Opposer notes that three out of ten (29%) respondents mentioned a specific brand of gum in answering the "conveys" query. In fact, opposer's Cinn-a-Burst, Mint*a*Burst, and/or Fruit*a*Burst were mentioned by 22% of the respondents while no respondent mentioned applicant's Care*Free gum. Applicant argues that in reality, the

opposer is simply concerned about not being able to use applicant's suggestive marks with opposer's own branded ____*A*BURST products.[14] Opposer argues that in spite of applicant's usage of this term, consumers are making no brand association with applicant's CARE*FREE gum precisely because the term is merely descriptive. (The survey results and the parties' respective arguments are almost identical throughout as to the term "Bursting flavor" and "Bursting with flavor.")

Board's Analysis of Survey

Surveys and survey results make appearances in reported trademark cases in a number of different contexts: to show acquired distinctiveness, to demonstrate likelihood of confusion, to prove implied false advertising claim during litigation under Section 43(a) of the Lanham Act, and to determine genericness.

On the issue of genericness, various courts have applauded the methodology of the survey conducted in the case of *E.I. DuPont de Nemours & Company v. Yoshida International, Inc*., 393 F.Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975) in which the term "TEFLON" was at issue. That survey offered the examples of "CHEVROLET" to illustrate what it

[14] According to applicant, opposer is really afraid these registrations will "…stymie opposer's nascent, yet audacious goal of obtaining a family of BURST gum marks…"

meant by a brand name and "automobile" to illustrate what it meant by a product type. Then, respondents were asked to classify other brand names and product names among which was "Teflon." Similarly, the "Thermos" survey asked participants how they would identify a particular product given that it performs certain functions. This was also an effort to determine if the claimed trademark for the product was generic. *See American Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F.Supp. 9, 134 USPQ 98 (D. Conn. 1962), aff'd, 321 F.2d 577, 138 USPQ 349 (2nd Cir. 1963).

In making a genericness determination, a consumer survey has value to the extent it provides the tribunal with insights into what consumers understand a specific term to be. *WSM, Incorporated v. Hilton et al.*, *supra* at 1328, n.3. The critical question, in many cases, is whether or not the alleged source-identifier is inherently distinctive to the prospective purchasers of the article. However, some courts have cautioned that a Teflon or Thermos survey is helpful only when the distinction between the brand name and the product genus is obvious. *See A.J. Canfield Company v. Honickman*, 808 F.2d 291, 303, 1 USPQ2d 1364, 1374 (3d Cir. 1986). These courts have expressed doubts that any consumer survey can be helpful when an arguably descriptive term is used as a brand name. *A.J. Canfield Company* at 1373-1374.

Applicant has raised just such an issue about the Payne survey herein. Applicant argues that it is incredibly difficult, if not impossible, to design a survey testing for descriptiveness because of the critical need to measure immediacy. In spite of the widespread use of surveys by parties involved in trademark litigation, there is a real dearth of reported decisions having surveys providing good benchmarks against which to measure the Payne survey's attempt to determine mere descriptiveness. We do agree with applicant that it is indeed difficult to calibrate a survey that reliably determines the descriptiveness of a multi-word phrase like "Bursting flavor" or "Bursting with flavor."

Opposer counters that inasmuch as it has done a valid survey and applicant has not done a survey, the Board should make inferences adverse to applicant based on that fact. Opposer argues that most of applicant's criticisms are not well taken, and certainly that none are fatal.

To understand the difficult assignment undertaken by Dr. Payne, it behooves us to look at the spectrum of increasing distinctiveness of trademarks under the classic formulation set out by the late Judge Friendly. Terms purporting to be source-identifiers are often classified in categories of generally increasing distinctiveness as follows: (1) generic, (2) descriptive, (3) suggestive, to (4) arbitrary or fanciful. *See* *Abercrombie & Fitch Co. v.*

Hunting World, Inc., 537 F.2d 4, 9, 189 USPQ 759, 769 (2nd Cir. 1976). How applicant's alleged marks have been used, and how the public understands them, is a question of fact. However, lest that sounds too easy, these categories, like colors in a spectrum, tend to blur at the edges and merge together, making it difficult to apply the appropriate label. Nonetheless, the correct categorization by any tribunal of a given term is a factual issue.

This Board is often called upon to make these difficult determinations when deciding whether a word is, or is not, merely descriptive. *In re Abcor Development Corp*., 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). In short, terms that are suggestive as applied to a given product are naturally understood by the consuming public as designations of origin. On the other hand, descriptive terms are ill suited to serve as designations of origin. This is because such terms are naturally understood by the consuming public in their ordinary descriptive sense.

We saw above that a *Teflon* survey is designed to test terms on opposite ends of the trademark spectrum of degrees of distinctiveness. However, Dr. Payne's task of definitively locating the correct classification of these terms on the trademark spectrum is much more complicated in the instant case. Without doubt, "Bursting with flavor" and "Bursting flavor," are not arbitrary, coined or fanciful

terms. On the other hand, no one has argued that they are incapable of serving a source-indicating function. Hence, the argument herein is descriptive versus suggestive. These phrases seem to be located on a continuum where determining the exact classification is made more challenging by the blurred edges separating them. However, in a reported decision from the Eighth Circuit, a somewhat similar survey was used to make a determination of descriptiveness versus suggestiveness. *See* *Anheuser-Busch, Incorporated v. The Stroh Brewery Company*, 750 F.2d 631, 224 USPQ 657, 662 (8th Cir 1984)[" L A " for light alcohol beer]. For example, in comparing the scope of Dr. Payne's survey with the " L A " case, we note that both surveys were conducted in twelve to fifteen shopping malls in geographically diverse parts of the country. In the Payne study, respondents were screened and gum-chewers were queried further provided they fit into preset quotas for age and type of gum chewed most often.[15] In *Anheuser-Busch* (the " **L A** "case), respondents were screened for the proper characteristics and were subsequently divided into two test cells: those who have not ever seen, heard of, or tried plaintiff's product, and those who have seen, heard of, or tried the product.

[15] As a matter of fact, the data show that differences among age groups, between gender groups and by which type of gum the respondent chewed were generally not significant in the instant case.

The parties in the instant case have argued extensively the design of the Payne survey. They disagree, for example, over the basic format and wording of the questions. It goes without saying that in developing a survey questionnaire, the survey's designer must pay close attention to question order, context and wording. For example, in the Payne study, respondents were told that they would be shown "… some phrases that are used in connection with chewing gum and bubble gum, and I'd like you to tell me what they *convey* to you." Respondents were then shown five phrases, one after the other, and their answers were recorded verbatim. The order of the presentation of the phrases was systematically rotated.[16] With the main part of the questionnaire behind them, the respondents were then given a card listing brands of chewing gum and bubble gum and asked which one they chewed most often and which others they chewed occasionally.

The members of this Board panel do not purport to be experts in survey design and methodology. However, we do agree with several of applicant's most damaging criticisms of the Payne survey. In short, both suggestive terms and descriptive terms are able to "convey" something, and so the

[16] While George Mantis' criticisms of having the "Burst…" test phrase immediately following descriptive phrases three of four rotations may be one more indication of introducing bias into the results, it does not seem to us to be as critical as other criticisms to which we have devoted more time.

form of the “conveys” question is a major weakness of this survey. We do wonder in this context whether a *Teflon*-type survey that first tried to educate respondents to the differences between a suggestive term serving as a source-indicators, on the one hand, and descriptive matter, which does not initially function as a source-indicators, on the other hand, would have been possible.

In the “ **L A** ” case, responses were gathered from the following statements and questions: “Please describe the product.” “What type of beer is it?” “What is the brand name of this new product?” “What company produces this brand?” Query whether opposer could more easily defend the survey results if it had adopted a similar approach using applicant’s Care*Free trade dress having thereon the “Bursting with flavor” phrase? Perhaps including some closed questions having a quantifiable scale would also have helped this tribunal determine fine shades of differences required in making a decision between suggestiveness and descriptiveness.

We also share applicant’s perception that the survey design encouraged flavor/taste responses. For example, among the phrases chosen by Dr. Payne, survey respondents were asked what the phrase “Double your pleasure” conveyed to them. Curiously, this registered trademark of the Wm. Wrigley Jr. Company produced taste/flavor scores similar to

those for the terms “Bursting flavor” or “Bursting with flavor.” In spite of opposer’s arguments to the contrary, we agree with applicant that this alone demonstrates that the Payne survey is unreliable in that it produces a notable percentage of “false positives.” Apart from any other alleged flaws, this result alone indicates that the survey's basic mechanics and resulting data are subject to question.[17] Yet while finding that the Payne survey has serious weaknesses, we are not prepared to discard it entirely as being “fatally flawed.”

Given the cumulative nature of the flaws of this survey, we definitely agree with applicant that the 60% and 78% numbers are misleading. Results from a reliable trademark survey having percentages this high would likely ensure a clear-cut victory for the litigant/survey proponent. However, it would be most misleading in the instant case to take these unusually large, bottom-line percentages as conclusive on the issue of descriptiveness.

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[17] We conclude that the structure and type of questions employed by opposer in the Payne survey avoided a bias in one direction (e.g., by not encouraging false negatives), but this certainly does not preclude the possibility that the survey design created a bias in another direction (e.g., false positives).

As applicant points out, an article placed into the record by opposer deals with the problem of “false negatives” (where the respondent has an underlying attitude but expresses no opinion), while applicant is rightly concerned about the instant study’s tendency to produce “false positives.” We agree with applicant that the survey design gave plenty of opportunities for the respondent who does not have an attitude to express an opinion in answering these interview questions.

These numbers exaggerate the sense of particularity and uniformity of the respondent's actual answers.

Mr. George Mantis, on behalf of applicant, has identified a number of other possible flaws in the survey. For example, he decries the failure explicitly to give respondents a "don't know" option in answering the questions.[18] Applicant has also raised concerns about the reliability of Dr. Payne's setting up broad categories, in coding and in tabulating the results.[19] However, the record before us contains the total responses, which can then be reviewed to ensure the responses were correctly coded according to the system Dr. Payne designed. In reviewing boxes of responses and comparing them with computer summaries, we did not find any major discrepancies with this part of the process.

We agree with applicant that a number of aspects of opposer's survey are rightly criticized. In spite of the tendency of the Payne survey to generate false positives,

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[18] One of the articles made part of the record deals with the availability of explicit "Don't Know" options. (See also opinion text, p. 13). It is clear from the literature on this subject made a part of this record, that in selecting the specific response options, the survey designer may choose to either include or exclude a "Don't Know" box, and should then be able to defend that choice in the context of the entire survey methodology and results.

[19] Mr. Mantis has criticized Dr. Payne's arbitrariness in selecting specific categories, his need to add new categories part way through the survey (e.g., to count for like-kinds of responses not listed in the initial tables), in the coding of

the ambiguity inherent in the word “conveys,” and other less glaring flaws, on balance, its results still deserve some weight. The survey results -- even after being accorded minimal weight -- when coupled with the testimony of applicant’s employees and outside marketing consultants, *supra*, demonstrate that these phrases communicate to potential customers rather directly a flavor or taste attribute of these goods.

Even though we are compelled to discount sharply the results of the Payne survey, one could still fairly conclude that a plurality of the survey respondents offered a “taste/flavor” response sometime in their answers to what the affected terms meant to them. This conclusion is entirely consistent with other parts of the instant record.[20] Given the overall weaknesses of this survey, the most we feel comfortable concluding from the Payne survey is that its results tend to corroborate a finding of descriptiveness based upon the balance of the record.

Of course, if a term is found to be descriptive without a showing of acquired distinctiveness, we assume in such a case that it does not have a distinctive quality. Both of these applications are intent-to-use applications in which

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specific responses, and questions Dr. Payne’s hand-written corrections to the tables, etc.

[20] Discussed above in pp. 6 – 12, *supra*.

no Statements of Use have been filed. Applicant was never asked to prove acquired distinctiveness during the *ex parte* prosecution of these two applications. This is a question on which no evidence was submitted, either before the Trademark Examining Attorney or before this Board. The issue was neither tried nor briefed by the parties in these opposition proceedings.

Decision

BURSTING FLAVOR for chewing gum and BURSTING WITH FLAVOR for bubble gum and chewing gum are merely descriptive of applicant's gum within the meaning of Section 2(e)(1) of the Lanham Act. Accordingly, the oppositions are sustained and both applications for registration are hereby refused.

R. F. Cissel

T. J. Quinn

D. E. Bucher

Administrative Trademark Judges, Trademark Trial and Appeal Board