

Practice Update

Descriptive or Suggestive Marks: An Issue for “Experts”?

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On February 28, 2015, the Southern District of New York denied a motion to exclude the testimony and survey of an expert witness regarding whether a trademark was descriptive or suggestive. In *Rise-N-Shine, LLC v. Robin Duner-Fenter*, the court held that such a survey could be helpful to a jury evaluating how the public views a mark.

Plaintiff, Rise-N-Shine LLC, markets and sells a dietary supplement to prevent the growth of grey hair under the mark “GO AWAY GREY.” In February 2014, Plaintiff filed a lawsuit alleging that Defendants’ use of the mark “GET AWAY GREY” to sell and market a competing product constituted trademark infringement. One of Defendants’ defenses is that “GO AWAY GREY” is descriptive, rather than suggestive and is not entitled to trademark protection.

Plaintiff retained Dr. Sara Parikh (“Parikh”) to conduct a survey regarding whether the purchasing public views “GO AWAY GREY” as descriptive or suggestive. The survey universe was limited to adults between the ages of 35 and 55, who had purchased vitamins or supplements in the previous six months and reported that they would “definitely” or “probably” consider buying vitamins or

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supplements to promote healthy hair in the next six months.

Parikh's survey informed respondents of the difference between a brand name and a product description and gave respondents two test phrases ("ONE A DAY" and "IMMUNITY BOOSTER") to evaluate whether they understood that distinction. Respondents were then asked whether they believed "GO AWAY GREY" – as well as two other marks – "SLIM-FAST" and "MUSCLE BUILDER" – referred to a product's brand name or described a product's function or purpose. Finally, respondents were asked whether they had grey hair.

49% of survey respondents (and 51% of respondents with grey hair) answered that they believed "GO AWAY GREY" to be a brand name. Parikh then excluded all respondents who incorrectly identified "SLIM-FAST" as a product description or incorrectly identified "MUSCLE BUILDER" as a brand name. Of the remaining universe, 56% of respondents (and 59% of respondents with grey hair) believed that "GO AWAY GREY" was a brand name.

Defendants' moved to exclude Parikh's testimony and survey on three grounds: (1) that the survey would not be helpful to the jury since it was an issue the jury could determine on its own; (2) the survey population was improper; and (3) Parikh's exclusion of respondents who responded incorrectly to the test phrases was inappropriate.

The court denied the motion to exclude. Although the court acknowledged that there was no authority in the Southern District evaluating whether survey evidence is relevant to determining whether a mark is suggestive or descriptive, the court concluded that the rationale applying to the admissibility of survey evidence in other trademark disputes applied in the instant case. Using the example of surveys to determine whether a mark is generic, the court reasoned that Parikh's survey could be useful in helping the jury understand how the purchasing

public views the “GO AWAY GREY” mark and thus should not be excluded on that basis.

The court also declined to exclude based on the other grounds raised by the Defendants because assertions of methodological errors in a survey go to the weight that they survey should be given and not its admissibility. Defendants’ argument that the survey universe should have been limited to individuals who want to reverse or prevent grey hair was rejected because Plaintiff’s supplement is advertised as also promoting healthier hair.

Finally, the fact that Parikh had other means of excluding respondents who did not understand the product/description distinction did not mean that adjusting the data to remove respondents who later failed the test was improper.

The court’s analysis with respect to the relevance of such a survey is correct in our view. However, the survey conducted by Parikh does not appear to address whether “GO AWAY GREY” is descriptive or suggestive.

As an initial matter, Parikh’s survey may fail to provide proper definitions of what constitutes a “descriptive” or “suggestive” trademark. Under Second Circuit case law, trademark law, descriptive marks describe the purpose, function or use of the product, a desirable characteristic of the product or the nature of the product. Suggestive marks suggest a quality or characteristic of the goods and services, but requires imagination, thought and perception to reach a conclusion as to the nature of goods. *See, e.g., Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976).

Parikh’s survey does not provide a description of either, instead asking respondents whether a term refers to a “brand name” or “describes a product’s purpose or function.” Whether “GO AWAY GREY” is a brand name does not answer the question of whether the mark is suggestive. It is also equally

possible that respondents may have described “GO AWAY GREY” as describing a desirable characteristic of the product if they were given the choice. The failure to provide proper definitions is a basis for exclusion. *See J&J Snack Foods Corp. v. Earthgrains Co.*, 220 F.Supp.2d 358, 370 (D.N.J. 2002)(excluding trademark survey for failure to provide a proper definition of a “descriptive” mark).

Therefore, while survey evidence may be helpful in determining the line between suggestive and descriptive marks, experts and counsel should ensure that the survey is actually probative of the underlying issue.

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