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Survey evidence: a gold mine or a minefield?

Giovanni Visintini, Counsel at Troutman Pepper Locke, reviews the critical role and complexities of survey evidence highlighted by the recent *Abbott Diabetes Care Inc v. Sinocare Inc & Ors* case, showcasing how improper methodology can turn a potentially valuable asset into a significant liability.

Since the first guidelines were set by M. Justice Whitford *(Imperial Group plc v. Philip Morris Ltd [1984] RPC293)*, the English courts have always been quite strict in allowing survey evidence to be admitted. Particularly in cases where acquired distinctiveness of a trademark is at stake, survey evidence could hold the key to unlock the treasures of acquired distinctiveness. However, such evidence could become a minefield if the method in which a survey has been conducted does not entirely comply with the guidelines.

The case discussed below *(Abbott Diabetes Care Inc v. Sinocare Inc & Ors [2025] EWHC 206 (Ch))* is an example of how things could go wrong.

Giovanni Visintini

Background

This judgment is a trademark dispute between Abbott Diabetes Care Inc. ("Abbott"), a market leader in the sale of continuous glucose monitoring (CGM) systems used by diabetes patients, and Sinocare ("Sinocare"), part of a group of companies specializing in rapid diagnostic test products including CGM systems.

Abbott obtained registration for a UK three-dimensional trademark (the "Mark") for an "on-body unit" (OBU) which houses the sensor used in Abbott's CGM systems, see Figure 1:

Figure 1

Abbott claimed that Sinocare's own CGM infringed its mark and was trying to pass itself off by using a product very similar to Abbott's own CGM.

Sinocare counterclaimed that the Mark was devoid of any distinctive character and consisted exclusively of the shape or another characteristic, which is necessary to obtain a technical result.

The Court found in favor of Sinocare on all points. Therefore, there was no infringement or passing off, and the Mark was invalid for both lack of distinctive character and because it consisted of features with a technical function.

Abbott's claim that the Mark acquired distinctiveness was also dismissed. In this context, the survey evidence filed by Abbott was openly criticized by the Court.

Legal issues relating to survey evidence

The Court very conveniently summarized the legal principles relating to the use of survey evidence in trademark cases:

1. "A survey as to confusion is unlikely to be of real value where the goods or services in question are ordinary consumer goods or services and the Court feels that there will be no real difficulty in determining the issue of confusion without one;

2. A survey as to acquired distinctiveness may have more utility since the Court may feel that it is not able to determine such a dispute based on its own

experience, and/ or the Court may feel the need to guard against an idiosyncratic decision;

3. Cases likely to be of real difficulty include those where the mark in question is not a traditional one or where a traditional mark has been used in conjunction with another trademark and the survey is designed to assist with the question whether the former, by itself, has acquired distinctiveness;

4. Reliance on evidence of use alone to show distinctiveness for a non-traditional mark without survey evidence is extremely difficult;

5. Likewise, a survey alone may be insufficient to show acquired distinctiveness but it may provide valuable confirmatory support where the relevant mark has been used extensively;

6. The Court will be circumspect when considering whether a survey is able to show distinctiveness of a trademark as a badge of origin as opposed to its recognition and association with the products of the holder of the mark; and

7. Likewise, the Court will be concerned to ensure that the survey tests whether the mark holder is indicated exclusively as opposed to merely the first one that comes to mind; it may find useful further information ruling out third party association".

The Court also referred to the guidelines set by Whitford J. in *Imperial v. Philip Morris [1984] R.P.C. 293,* see below:

1. "If a survey is to have any validity at all, the way in which the interviewees are selected must be established as being done by a method such that a relevant cross-section of the public is interviewed;

2. Any survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;

3. The party relying on the survey must give the fullest possible disclosure of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because

"The participants had to establish whether Abbott's product was amongst them."

Résumé

Giovanni Visintini manages, protects, and enforces IP rights across various business sectors. His experience ranges from major energy companies to organizations involved in international sporting events and cultural sponsorships. Giovanni provides global strategic advice on complex IP asset management, protection, exploitation, and enforcement issues. He leads negotiations and provides counsel on IP assets in joint ventures, mergers and acquisitions, distribution, licensing, and procurement agreements across multiple jurisdictions. Giovanni also spearheaded cases to enforce color trademarks in the UK, Poland, and Russia. His role often involves managing worldwide trademark portfolios and advising on sponsorship agreements and marketing campaigns.

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otherwise it is impossible to draw any reliable inference from answers given by a few respondents;

4. The questions asked must not be leading; and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;

5. Exact answers and not some sort of abbreviation or digest of the exact answer must be recorded;

6. The totality of all answers given to all surveys should be disclosed; and

7. The instructions given to interviewers must also be disclosed."

Survey evidence filed by Abbott

Abbott filed two surveys, which were conducted in 2022. The surveys were completed by a company specializing in performing survey research under the direction of a survey expert.

The first survey was a traditional survey conducted on a total of 460 individuals (258 healthcare professionals and 202 patients) ("Traditional Survey"). Screening questions were asked to select the relevant audience (i.e., diabetes patients and healthcare professionals dealing with diabetes issues). After the screening questions, the Abbott's product was shown, followed by further questions asking for information about the product shown and whether such product was associated with any company.

> **"The Court particularly criticized Abbott for not calling its survey expert as a witness."**

The second survey, after asking similar screening questions, was performed by showing the participants an image of four different CGMs, each for one second, and the participants had to establish whether Abbott's product was amongst them. The survey included a sample of 343 healthcare professionals and 206 patients ("Tachistoscope Survey").

Both surveys showed a high level of recognition among the respondents. However, the results were strongly criticized by the survey expert for Sinocare, and the Court agreed with such criticisms.

The Court particularly criticized Abbott for not calling its survey expert as a witness. As a consequence, the concerns expressed by Sinocare's expert could not be fully addressed in cross-examination. The Court believed that the absence of Abbott's survey expert "was never satisfactorily explained" and that Abbott could have nominated an alternative expert.

During her testimony, the survey expert for Sinocare identified three potential breaches of the Whitford guidelines by Abbott's surveys, in particular guidelines 1 (i.e., representation of a cross section of the public), 3 (i.e., full disclosure), and 4 (i.e., leading questions).

Traditional survey

Firstly, Sinocare's survey expert complained that the questions in the Traditional Survey were leading and did not comply with Whitford Guideline 4.

The expert was particularly critical of the fact that the screening questions primed the respondents to think about diabetes and, when shown Abbott's products, they would have been more likely to provide certain answers, in particular:

> "Her view was that this would prompt the respondent to treat the image as having special significance requiring an answer. That was said to be particularly problematical here because of the series of preliminary screening questions priming respondents to think in terms of diabetes".

Secondly, Sinocare's survey expert complained that "the full basis on which the respondent sample was produced was unknown due to a lack of information as to sample source". More specifically, the expert referred to the healthcare professional sample. Given that this was a very specific part of the population, the expert complained that the survey company did not "disclose(d) the source of those survey participants" and, therefore, she was unable to determine whether the sample represented a cross-section of such population, ideally the source should have been a medical database.

The court agreed with these concerns and concluded that "it was not possible to verify whether the HCP (healthcare professional) respondents were a representative cross-section". Therefore, there was not full disclosure and "compliance with Whitford Guideline 3 and, potentially, 1 as well".

Tachistoscope survey

The purpose of the Tachistoscope Survey was to identify which element of the Mark was most prominent and explain why people recognize the Mark. The main criticism of this approach was that, although many responses referred to the shape and color of Abbott's product, such shape and color were the only way to describe Abbott's product.

In addition, the Sinocare survey expert identified the same problem with the healthcare professional sample in this survey. As discussed above, the Court agreed on this point and concluded that there was no full disclosure and the survey did not comply with Whitford Guideline 3.

Finally, the Court also concluded that the surveys did not contain a sample of all the categories of CGM users. The surveys were only concerned with healthcare professional and type 1 diabetes patients, not type 2 diabetes patients. Furthermore, they did not contain a sample of CGM users who do not have diabetes, but decide to monitor their glucose levels for health, wellness, or fitness reasons (this last category has the potential to represent an even larger market).

"The Court also concluded that the surveys did not contain a sample of all the categories of CGM users."

Although the evidence showed that consumers recognized the Mark and associated it with Abbott's products, ultimately, the evidence did not show that healthcare professionals and patients regarded the shape alone as a badge of origin.

Final comments and suggestions

Abbott was particularly criticized by the court for not calling as a witness the survey expert reporting on the survey's results. The court was not entirely convinced that the reasons provided by Abbott justified the survey expert's absence. In addition, Abbott decided not to call an alternative survey expert. This shows that having a survey expert witness able to discuss and potentially rebut claims made by the opposing expert witness is a must in these cases.

Additionally, any parties intending to use survey evidence must be prepared to fully disclose the sources from which respondents are selected. Failure to do so, even for only part of the respondents, as in this case, could have devastating consequences and hinder the probative value of the survey evidence.

Finally, particular attention needs to be taken when deciding the questions to ask the respondents. It was considered that, in this case, the screening questions would prompt respondents to treat the image of Abbott's CGM as having special significance requiring an answer.

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