

ESTTA Tracking number: **ESTTA770135**

Filing date: **09/12/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Boy Scouts of America
Granted to Date of previous extension	09/11/2016
Address	1325 West Walnut Hill Lane P.O. Box 152079 Irving, TX 75015-2079 UNITED STATES

Attorney information	Gary A. Hecht Fox Rothschild LLP P.O. Box 5231 Princeton, NJ 08543-5231 UNITED STATES ghecht@foxrothschild.com, ipdocket@foxrothschild.com, bstaufenberg@foxrothschild.com, rwoodbridge@foxrothschild.com, llane@foxrothschild.com
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Applicant Information

Application No	86729498	Publication date	03/15/2016
Opposition Filing Date	09/12/2016	Opposition Period Ends	09/11/2016
Applicant	Scout Boats, Inc. 2531 Hwy 78 West Summerville, SC 29483 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 1992/00/00 First Use In Commerce: 1992/00/00 All goods and services in the class are opposed, namely: Apparel, namely, jackets, caps, hats, T-shirts, shirts, polo shirts, tank tops, sweatshirts, hooded sweatshirts, and children's rompers
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Other	Exclusive Rights Under 35 USC 30905

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1215939	Application Date	02/17/1981
Registration Date	11/09/1982	Foreign Priority Date	NONE
Word Mark	BOY SCOUTS OF AMERICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1911/01/31 First Use In Commerce: 1911/01/31 Items of Clothing Forming Part of a Uniform Consisting of Shirts, Pants, Shorts, Skirts, [Dresses,] Belts, Socks, Hats, and Neckerchiefs		

U.S. Registration No.	1363872	Application Date	11/26/1984
Registration Date	10/01/1985	Foreign Priority Date	NONE
Word Mark	BOY SCOUTS OF AMERICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1910/00/00 First Use In Commerce: 1910/00/00 TO INDICATE MEMBERSHIP IN AN ORGANIZATION FOR YOUNG MEN		


U.S. Registration No.	1215938	Application Date	02/17/1981
Registration Date	11/09/1982	Foreign Priority Date	NONE
Word Mark	CUB SCOUTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1930/04/01 First Use In Commerce: 1930/04/01 Items of Clothing Forming Part of a Uniform Consisting of Dress Shirts, T-Shirts, Pants, Shorts, Belts, Socks, Hats, and Neckerchiefs		


U.S. Registration No.	1701404	Application Date	04/01/1991
Registration Date	07/21/1992	Foreign Priority Date	NONE
Word Mark	CUB SCOUTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 metal keyrings [and statuettes] Class 008. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 pocket knives		

	<p>Class 009. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 [binoculars]</p> <p>Class 014. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 jewelry and watches</p> <p>Class 016. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 publications; namely, manuals, activitybooks and guide books concerning sportsand scouting activities; stationery; paper weights; [pens,] pencils, [let-teropeners;] bookmarks; tableclothes [and placemats] of paper</p> <p>Class 018. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 backpacks, beltpacks, book bags and wallets</p> <p>Class 021. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 [canteens,] mugs, cups, plates, [bowls,] toothbrushes [; combs, comb and nail clipper sets, and soap caddy]</p> <p>Class 026. First use: First Use: 1950/00/00 First Use In Commerce: 1950/00/00 embroidered emblems and cloth patches for clothing</p>
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U.S. Registration No.	1702357	Application Date	03/28/1991
Registration Date	07/21/1992	Foreign Priority Date	NONE
Word Mark	CUB SCOUTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1945/00/00 First Use In Commerce: 1945/00/00 indicating membership in an organization for boys		

U.S. Registration No.	1213650	Application Date	04/27/1981
Registration Date	10/19/1982	Foreign Priority Date	NONE
Word Mark	EAGLE SCOUT		

Design Mark	
Description of Mark	The mark consists of the words "Eagle Scout" with Eagle design.
Goods/Services	Class 200. First use: First Use: 1911/03/31 First Use In Commerce: 1911/03/31 Indicating Membership in an Organization for Boys to Promote Moral, Physical and Spiritual Development

U.S. Registration No.	3877547	Application Date	02/24/2009
Registration Date	11/16/2010	Foreign Priority Date	NONE
Word Mark	EAGLE SCOUT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1912/08/12 First Use In Commerce: 1912/08/12 Indicating membership in a(n) ORGANIZATION FOR BOYS AND YOUNG MEN		

U.S. Registration No.	2578122	Application Date	04/10/2001
Registration Date	06/11/2002	Foreign Priority Date	NONE
Word Mark	SEA SCOUTS		

Design Mark	SEA SCOUTS		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1915/12/31 First Use In Commerce: 1915/12/31 EDUCATIONAL SERVICES, NAMELY, A CO-EDUCATIONAL PROGRAM FOR YOUNG ADULTS IN THE FIELD OF BOATING, SAILING, RAFTING AND SCUBA DIVING		

U.S. Registration No.	1370697	Application Date	04/09/1984
Registration Date	11/12/1985	Foreign Priority Date	NONE
Word Mark	VARSITY SCOUT		
Design Mark	VARSITY SCOUT		
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 INDICATION OF MEMBERSHIP IN A SCOUTING ORGANIZATION FOR YOUNG MEN		

U.S. Application No.	89000095	Application Date	10/23/1969
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BOY SCOUTS OF AMERICA		
Design Mark			
Description of Mark	TITLE OF ORGANISATION		
Goods/Services			

U.S. Application No.	89001573	Application Date	08/12/1998
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BOY SCOUTS OF AMERICA		
Design Mark	BOY SCOUTS OF AMERICA		
Description of Mark	NONE		
Goods/Services			

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	SCOUT
Goods/Services	as used to identify a member of Opposer's Organization and its goods and services

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SCOUTS		
Goods/Services	as used to identify a member of Opposer's Organization, troops and units of Opposer, and Opposer's goods and services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SCOUTING		
Goods/Services	as used in association with Opposer's organization, participation in Opposer's programs and activities, and goods and services of Opposer		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	VARSITY SCOUT		
Goods/Services	clothing		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BOY SCOUTS OF AMERICA		
Goods/Services	CLOTHING		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EAGLE SCOUTS		
Goods/Services	CLOTHING		

Attachments	73307667#TMSN.png(bytes) 77676931#TMSN.png(bytes) 76238519#TMSN.png(bytes) 73474350#TMSN.png(bytes) 89001573#TMSN.png(bytes) OPPOSITION.PDF(149335 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/gah/
Name	Gary A. Hecht
Date	09/12/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86729498
For the mark: "SCOUT BOATS"

Boy Scouts of America,	:	Opposition No. _____
	:	
Opposer,	:	
	:	
v.	:	<u>NOTICE OF OPPOSITION</u>
	:	
Scout Boats, Inc.,	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

Opposer, Boy Scouts of America, believes that it will be damaged by registration of the mark "SCOUT BOATS", which is the subject of U.S. Trademark Application Serial No. 86729498, and hereby opposes registration of said mark. In support of its Opposition, Opposer alleges the following:

1. Opposer, Boy Scouts of America (hereinafter, "Opposer"), is a federally chartered corporation organized under the laws of the United States of America with a business address of 1325 West Walnut Hill Lane, P.O. Box 152079, Irving, Texas 75015-2079.

2. Scout Boats, Inc. (hereinafter, "Applicant") is a corporation organized under the laws of South Carolina with a mailing address of 2531 Hwy 78 West, Summerville, SC 29483.

3. Applicant filed U.S. Trademark Application Serial No. 86729498 (the "Application") seeking to register the mark "SCOUT BOATS" (the "Applicant's Mark") for use on goods described as "apparel, namely, jackets, caps, hats, T-shirts, shirts, polo shirts, tank tops, sweatshirts, hooded sweatshirts, and children's rompers", in International Class 025.

4. The application was filed on August 19, 2015, based on a claimed date of first use in interstate commerce of 1992.

5. Applicant's earliest possible priority date is its claimed date of first use in interstate commerce of 1992.

6. Opposer is a well-known youth organization in the United States. Beginning around February 8, 1910, and continuing to the present, Opposer has been engaged in the organization and management of programs for young people.

7. Opposer operates various programs for boys and young men, which programs include CUB SCOUTS, BOY SCOUTS, SEA SCOUTS and EAGLE SCOUTS and which, in addition to the name Boys Scouts of America, SCOUTS, SCOUT, and SCOUTING, are well known and famous names and identities of Opposer (the names and identities identified in this paragraph are collectively referred to herein as Opposer's "SCOUT NAMES AND IDENTITIES"). Opposer has used and or been known by its SCOUT NAMES AND IDENTITIES prior to the filing date of the Application, and before any date of actual first use which may be claimed by the Applicant.

8. Opposer adopted and began using marks incorporating the term "SCOUT" since as early as 1910 (Opposer's marks and trade names incorporating "SCOUT",

registered and unregistered, are collectively referred to herein as “Opposer’s Scout Marks” or “Scout Marks”).

9. In addition to its various programs, Opposer operates retail stores, including an online retail store at scoutstuff.org, that sells various goods and services in connection with its various marks that contain the term “SCOUT”. These goods and services, including clothing items, are offered to the general public.

10. Opposer has used its Scout Marks in the United States long prior to the filing date of the Application, and long before the date of actual first use claimed by the Applicant.

11. Opposer is the owner of, and will rely on herein, the following valid and subsisting United States trademark registrations which include trademarks, service marks, and collective marks (collectively, “Opposer’s Registered Scout Marks”):

MARK/TYPE	U.S. REG. NO.	REG. DATE	REPRESENTATIVE GOODS/SERVICES
BOY SCOUTS OF AMERICA	1215939	November 9, 1982	Items of clothing forming part of a uniform consisting of shirts, pants, shorts, skirts, belts, socks, hats, and neckerchiefs
BOY SCOUTS OF AMERICA	1363872	October 1, 1985	To indicate membership in an organization for young men.
BOY SCOUTS OF AMERICA	1725084	October 20, 1992	Pocket knives, utility knives and lock back knives; jewelry; namely, rings and pins stationery, activity books and manuals, concerning outdoor activities, crafts, and requirement of applicant’s organization, decals, desk sets with pen and pen holder, pen and pencil sets, printed certificates; plaque;
CUB SCOUTS	1215938	November 9, 1982	Items of clothing forming part of a uniform consisting of dress shirts, t-shirts, pants, shorts, belts, socks, hats, and neckerchiefs

MARK/TYPE	U.S. REG. NO.	REG. DATE	REPRESENTATIVE GOODS/SERVICES
CUB SCOUTS	1701404	July 21, 1992	Embroidered emblems and cloth patches for clothing; metal keyrings; pocket knives; jewelry and watches; publications; namely, manuals, activity books and guide books concerning sports and scouting activities; stationery; paper weights; pencils, bookmarks; tableclothes of paper; backpacks, beltpacks, book bags and wallets; mugs, cups, plates, toothbrushes
CUB SCOUTS	1702357	July 21, 1992	Indicating membership in an organization for boys
EAGLE SCOUT [and Design]	1213650	October 19, 1982	Indicating membership in an organization for boys to promote moral, physical and spiritual development
EAGLE SCOUT	3877547	November 16, 2010	Indicating membership in a(n) organization for boys and young men
SCOUTING	1197851	June 15, 1982	Magazine for adult leaders and scouting for providing Scouting instruction to boys and young men
SCOUTMASTER	1695120	June 16, 1992	Indicating membership in a scouting organization for boys
SEA SCOUTS	2578122	March 19, 2002	Educational services, namely, a co-educational program for young adults in the field of boating, sailing, rafting and scuba diving
VARSITY SCOUT	1370697	November 12, 1985	Indication of membership in a scouting organization for young men

12. In view of Opposer's Registered Scout Marks, Opposer has priority in this Opposition.

13. Opposer also is the owner of and will rely on herein the following "89" series code applications on file with the USPTO (also referred to as non-registration records) resulting from its ownership and use of its Scout Marks.

MARK	Application No.	DATE	GOODS/SERVICES
BOY SCOUTS OF AMERICA	89000095	October 23, 1969	Special designation - all international classes
BOY SCOUTS OF AMERICA	89001573	August 12, 1998	Special designation - all international classes

The basis for these records is 36 U.S.C. § 30905, a federal statute providing Opposer with the exclusive right to use emblems, badges, descriptive or designating marks, and words or phrases that it adopts.

14. Opposer also has and will assert its common-law rights resulting from its ownership and use of its unregistered Scout Marks in connection with its various goods and services, and its common law rights in Scout Marks that the public has adopted and uses to refer to Opposer and its goods and services. Such marks include various trademarks, service marks, collective marks, and trade name uses, which uses have not been abandoned, are distinctive or have obtained secondary meaning, and which have been valid and continuous since a date prior to the filing date of the Application, prior to the claimed priority date, and prior to Applicant's first use of its mark. Such common law Scout Marks include the following: (a) SCOUT as used to identify a member of Opposer's organization and Opposer's goods and services; (b) SCOUTS as used to identify membership in Opposer's organization, troops and units of Opposer, and goods and services of Opposer; (c) SCOUTING as used in association with Opposer's organization, participation in Opposer's programs and activities, and goods and services of Opposer; (d) VARSITY SCOUT as used with clothing; (e) BOY SCOUTS OF AMERICA as used with clothing; (f) EAGLE SCOUTS as used with clothing; and (g) CUB SCOUTS as used with clothing.

15. Opposer's Scout Marks constitute a family of marks that include the term "SCOUT".

16. Opposer has established a valuable reputation and goodwill in its Scout Marks by reason of its long use, extensive promotion, and sale of goods and services utilized in association with its Scout Marks.

17. As a result of Opposer's long use and extensive marketing efforts, Opposer's Scout Marks are well known, and the public has come to associate Opposer with said Scout Marks.

18. Applicant's Mark as proposed for registration is substantially similar to Opposer's Scout Marks.

19. The goods for which Applicant seeks to register Applicant's Mark are similar or related to the goods and services for which Opposer uses and/or has registered its Scout Marks.

FIRST GROUND FOR RELIEF
EXCLUSIVE RIGHTS UNDER 36 U.S.C. §30905

20. Opposer repeats and re-alleges each and every allegation set forth in paragraphs 1 through 19 herein.

21. Congress, in 36 U.S.C. §30905, granted to Opposer "the exclusive right to use emblems, badges, descriptive or designating marks, and words or phrases" that it adopts.

22. The rights granted under 36 U.S.C. §30905 to Opposer include the exclusive right to Opposer's Scout Marks as used in the United States.

23. Applicant's use and/or registration of Applicant's Mark is in direct contravention and derogation of the rights granted to Opposer by Congress.

SECOND GROUND FOR RELIEF
LIKELIHOOD OF CONFUSION – 15 U.S.C. 1052(d)

24. Opposer repeats and re-alleges each and every allegation set forth in paragraphs 1 through 23 herein.

25. Applicant's Mark so resembles Opposer's Scout Marks, when used on or in connection with Applicant's goods, as to be likely to cause confusion, or to cause mistake, or to deceive.

THIRD GROUND FOR RELIEF
FALSE ASSOCIATION – 15 U.S.C. 1052(a)

26. Opposer repeats and re-alleges each and every allegation set forth in paragraphs 1 through 25 herein.

27. Applicant's Mark is the same as or a close approximation of Opposer's SCOUT NAMES AND IDENTITIES as identified above.

28. Applicant's Mark, when used on or in connection with Applicant's goods, would be viewed by consumers as pointing uniquely and unmistakably to Opposer.

29. Opposer is not connected with the goods sold or to be sold by Applicant under Applicant's Mark.

30. The fame or reputation of Opposer is of such a nature that a connection with Opposer would be presumed by consumers when Applicant's Mark is used on its goods.

FOURTH GROUND FOR RELIEF
DILUTION – 15 U.S.C. 1125(c)

31. Opposer repeats and re-alleges each and every allegation set forth in paragraphs 1 through 30 herein.

32. Opposer's Scout Marks are distinctive and famous.

33. Opposer's Scout Marks have been famous from a time prior to the filing date of the Application, from a time prior to the claimed priority date, and from a time prior to Applicant's first use of Applicant's Mark.

34. Applicant's Mark is likely to cause dilution by blurring the distinctive quality of Opposer's Scout Marks.

35. If Applicant were granted registration of the Application herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that its opposition to the registration of U.S. Trademark Application Serial No. 86729498 be sustained and that Applicant's Mark be refused registration.

Dated: September 12, 2016

Respectfully submitted,

/gah/

Gary A. Hecht, Esquire
Fox Rothschild LLP
2000 Market Street, 20th Floor
Philadelphia, PA 19103
(215) 299-2416

ATTORNEYS FOR OPPOSER

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86729498
For the mark: "SCOUT BOATS"

Boy Scouts of America,	:	Opposition No. _____
	:	
Opposer,	:	
	:	
v.	:	
	:	
Scout Boats, Inc.,	:	
	:	
Applicant.	:	

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above Notice of Opposition and any attachments were served on Applicant on the date listed below by first class mail, postage prepaid, addressed as follows:

SARAH ANNE KEEFE
Womble Carlyle Sandridge & Rice Llp
PO Box 13069
Durham, NC 27709-3069

 /gah/
Gary A. Hecht

Dated: September 12, 2016