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

Proceeding	91247071
Party	Plaintiff Girl Scouts of the United States of America
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Date	04/01/2019
Attachments	Joint Motion Suspend Civil Action 91247071.pdf(4017453 bytes)

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

-----X	
GIRL SCOUTS OF THE UNITED STATES	:
OF AMERICA,	:
	:
Opposer,	:
	:
v.	:
	:
BOY SCOUTS OF AMERICA,	:
	:
Applicant.	:
-----X	

Opposition No. 91247071

JOINT MOTION TO SUSPEND

Pursuant to Trademark Rule 2.117(a), Opposer Girl Scouts of the United States of America (“GSUSA” or “Opposer”) and Applicant Boy Scouts of America (“BSA” or “Applicant”) jointly request suspension of the above-captioned proceeding (the “Opposition”) pending disposition of the civil action captioned *Girl Scouts of the United States of America v. Boy Scouts of America*, Case No. 1:18-cv-10287 (S.D.N.Y. filed Nov. 6, 2018) (the “District Court Case”). A copy of the Complaint, Answer, and the docket sheet from the District Court Case are attached as Exhibits A, B and C, respectively.

Good cause exists for the requested suspension because the District Court Case involves the same parties, the same trademark, and similar claims and issues as those presented in this Opposition. As such, the District Court Case is likely to have a bearing on the issues currently before the Board in this Opposition.

CONCLUSION

For the foregoing reasons, the parties respectfully request that the Board grant the Joint Motion to Suspend.

Dated: April 1, 2019

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing JOINT MOTION TO SUSPEND is being served upon the counsel for Applicant by emailing a true copy thereof to:

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on April 1, 2019

By: /tek/
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EXHIBIT A

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IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

-----X		
GIRL SCOUTS OF THE UNITED STATES	:	
OF AMERICA,	:	
	:	18-CV-
Plaintiff,	:	
	:	
- against -	:	
	:	COMPLAINT WITH JURY
BOY SCOUTS OF AMERICA,	:	<u>DEMAND</u>
	:	
Defendant.	:	
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Plaintiff Girl Scouts of the United States of America, a congressionally chartered corporation (“GSUSA” or “Plaintiff”), complains and alleges against the Boy Scouts of America, a congressionally chartered corporation (“BSA” or “Defendant”), as follows.

INTRODUCTION

1. For over more than a century, GSUSA has established itself as the preeminent, best-known provider of leadership development services for American girls. Dedicated to the proposition that girls should be prepared for a lifetime of success, leadership and adventure, GSUSA has developed award-winning programs that empower girls to attain their full potential, develop a strong sense of self, and learn positive values that will aid them throughout their lives. Many millions of girls have participated in and benefited from GSUSA’s services, which are

founded on research showing that girls learn best in environments led by girls, through programs tailored specifically for girls. GSUSA's long track record of success is best symbolized by the extraordinary number of GIRL SCOUTS alumnae who are leaders across all segments of American society, in fields that include government, science, sports, industry, culture and many others.

2. The core elements of GSUSA's brand identity among the American public are its famous, registered GIRL SCOUTS trademarks, which are powerful symbols of a unique, extraordinarily valuable goodwill that has grown over decades and been carefully protected by GSUSA. To the vast majority of Americans, the GIRL SCOUTS trademarks embody the values of an organization whose unique and specific mission is to advance the cause of girls' leadership and empowerment through programs exclusively for girls, so that they will mature into the extraordinary women that every girl can and should become.

3. Throughout GSUSA's history, it has coexisted with defendant BSA, which has long offered programs aimed at boys under the BOY SCOUTS trademark. Like the GIRL SCOUTS trademark, the BOY SCOUTS trademark is a symbol of youth development programs that, for more than a century, have been aimed at, led by and developed primarily for boys. Thus, even though both GSUSA and BSA use the term SCOUTS as part of their core trademarks, the organizations are distinct, with one offering leadership programming developed for and aimed at girls, and the other offering programming developed for and aimed at boys.

4. However, that core gender distinction between the two organizations and their use of the term SCOUTS and variations thereof has been altered by BSA's recent decision to offer *all* of its services to *both* boys *and* girls of all ages for the first time in its long history. Indeed, even though GSUSA and BSA have Congressional charters and separate grants of intellectual

property rights that are specific to girls and boys, respectively, BSA is now using its trademarks in a manner that is both new and uniquely damaging to GSUSA, its trademarks and their underlying goodwill. In particular, given its significant programming shift, BSA is now trying to alter its core brand identity from BOY SCOUTS to SCOUTS, through the use of communicative elements like the slogan “Scout Me In” and the new name by which it will refer to its best known Boy Scout program – “Scouts BSA” with members being called “Scouts.”

5. BSA does not have the right under either federal or New York law to use terms like SCOUTS or SCOUTING by themselves in connection with services offered to girls, or to rebrand itself as “the Scouts” and thereby falsely communicate to the American public that it is now the organization exclusively associated with leadership development services offered under that mark to girls. Such misconduct will not only cause confusion among the public, damage the goodwill of GSUSA’s GIRL SCOUTS trademarks, and erode its core brand identity, but it will also marginalize the GIRL SCOUTS Movement by causing the public to believe that GSUSA’s extraordinarily successful services are not true or official “Scouting” programs, but niche services with limited utility and appeal.

6. Since BSA’s announcement that it would admit girls to its core programs, GSUSA’s fears about the damage that would be caused to its trademarks and the mission those trademarks symbolize have been realized. Throughout the country, families, schools and communities have been told that GSUSA and BSA have merged, or even that GSUSA no longer exists. Parents interested in signing up for GIRL SCOUTS programs have instead mistakenly signed up for the new girls’ programs offered by BSA. BSA regional councils and troops have used the GIRL SCOUTS trademarks in their advertising and marketing materials since BSA’s announcement occurred. BSA is even using quotations from GSUSA’s founder, Juliette Gordon

Low, about the value of GIRL SCOUTS programs to promote **BSA's** newly launched services. And even though GSUSA has repeatedly called to BSA's attention these ongoing instances of actual confusion, and the unauthorized uses of GSUSA's intellectual property, they keep recurring.

7. Only GSUSA has the right to use the GIRL SCOUTS and SCOUTS trademarks with leadership development services for girls. To the extent BSA wishes to open its programs to girls, it cannot do so using GSUSA's intellectual property without authorization, in a manner that causes confusion among the public and harms the goodwill of the GIRL SCOUTS trademarks. It is therefore imperative that this Court take action to prevent the ongoing acts of trademark infringement, unfair competition and dilution perpetrated by BSA, both directly and vicariously through its regional and local councils, in order to prevent further damage to GSUSA's trademarks and preserve their goodwill.

THE PARTIES

8. GSUSA is a congressionally chartered corporation organized under 36 U.S.C. § 80301. GSUSA's headquarters is located at 420 Fifth Avenue, New York, New York.

9. Defendant is a congressionally chartered corporation organized under 36 U.S.C. § 30901. Upon information and belief, Defendant's headquarters is located at 1325 West Walnut Hill Lane, Irving, Texas.

JURISDICTION AND VENUE

10. This is an action for direct and vicarious trademark infringement, trademark dilution and unfair competition in violation of the U.S. Trademark Act of 1946, 15 U.S.C. §1051, *et seq.* (the "Lanham Act"), and for trademark infringement, dilution, unfair competition, tortious

interference with prospective economic advantage, and deceptive business practices under New York law.

11. This Court has original jurisdiction over GSUSA's federal trademark infringement, trademark dilution and unfair competition claims pursuant to 15 U.S.C. §§ 1114, 1121, 1125 and 28 U.S.C. §§ 1331 and 1338.

12. This Court has supplemental jurisdiction over GSUSA's New York claims under 28 U.S.C. § 1367(a) because these claims are so related to the federal Lanham Act claims that they form part of the same case or controversy under Article III of the United States Constitution.

13. This Court has personal jurisdiction over Defendant under multiple prongs of the New York long-arm statute, CPLR 302, as well as under the Due Process Clause of the U.S. Constitution. Specifically, Defendant regularly transacts business within the State of New York, including by, upon information and belief, offering its services and programs within New York to its regional councils and local troops, and by raising funds for its services and programs within New York. Defendant has been registered since at least 1996 with the New York State Department of Law, Charities Bureau, as a charitable organization that operates and raises funds in the State of New York. Upon information and belief, Defendant hires lobbyists and conducts lobbying in New York. In addition, Defendant contracts to supply its leadership development programs within New York to regional councils and troops located here, making unauthorized use of GSUSA's trademarks in the process.

14. In addition, Defendant has engaged in tortious conduct within the State of New York by disseminating or causing to be disseminated within the State of New York advertising, promotional, marketing and programming materials that are violative of GSUSA's trademark

and other rights as set forth herein, and that are likely to cause and have caused confusion to occur within the State of New York, and caused damage to GSUSA within the State of New York.

15. Finally, Defendant has engaged in tortious conduct outside the State of New York that has caused injury to GSUSA within New York by disseminating or causing to be disseminated advertising, promotional, marketing and programming materials that are violative of GSUSA's trademark and other rights as set forth herein, and that are likely to cause and have caused confusion in New York and throughout the United States. Upon information and belief, and as set forth above, Defendant both regularly solicits business, engages in a persistent course of conduct, and derives substantial revenue from services rendered within the State of New York. Likewise, Defendant also should reasonably expect its misconduct as described herein to have consequences within the State of New York, given its awareness of GSUSA's location here. Upon information and belief, Defendant also derives substantial revenue from interstate commerce.

16. Venue is proper in the United States District Court for the Southern District of New York under 28 U.S.C. § 1391(b) because: (i) GSUSA maintains its headquarters in this judicial district; (ii) Defendant's tortious conduct has caused and will continue to cause injury in this judicial district; (iii) Defendant conducts regular and systematic business in this district; and/or (iv) a substantial part of the events or omissions giving rise to GSUSA's claims occurred in this judicial district.

FACTUAL BACKGROUND

GSUSA AND THE GIRL SCOUTS TRADEMARKS

17. GSUSA is a national, nonprofit organization that was incorporated in 1915 and thereafter congressionally chartered on March 16, 1950. It is currently the largest girl-led leadership development organization for girls in the world, and its iconic GIRL SCOUTS program is both well-known and highly regarded. Founded in 1912 by Juliette Gordon Low in Savannah, Georgia, GSUSA promotes, encourages and inspires girls to develop courage, confidence and character through a variety of activities and practical skills programs.

18. Over the past 106 years, many millions of American women have participated in the GIRL SCOUTS program coordinated by GSUSA, and GSUSA currently has about 2 million active members.

19. Over the years, Girl Scouts have been able to earn over 400 types of badges covering a broad range of skills and topics that include, among other things, camping, mechanical engineering, environmental stewardship, robotics, cyber security, financial literacy and athletics. Girl Scouts are able to participate in a variety of skill-based programs that include programs about the outdoors, STEM and life skills. The Girl Scout Cookie Program is also one of the most famous entrepreneurship and financial literacy programs in the United States, helping girls to develop essential life and business skills.

20. GSUSA recruits and offers programs for girls in grades K-12. The specific programs available to girls are determined by grade level: (i) grades K-1 are considered “Daisies;” (ii) grades 2-3 are considered “Brownies;” (iii) grades 4-5 are considered “Juniors;” (iv) grades 6-8 are considered “Cadettes;” (v) grades 9-10 are considered “Seniors;” and (vi) grades 11-12 are considered “Ambassadors.” All are considered Girl Scouts.

21. The Girl Scout Movement in the United States, its territories and possessions is directed and coordinated by GSUSA at the national level. GSUSA charters 112 local Girl Scout councils across the nation that deliver Girl Scout programming within their respective jurisdictions. GSUSA, among other things, licenses the GIRL SCOUTS and related trademarks, and other intellectual property, to each of the local councils. Individual girls may become Girl Scouts, and multiple Girl Scouts band together to form troops, which typically consist of 12-20 girls, led by a volunteer registered with a chartered Girl Scout council.

22. Girls in grades K-12 may sign up to join Girl Scouts by filling out a form online or signing up through local recruiting efforts. It is common for local Girl Scout troops to host tables at back-to-school events, churches and other community locations at the beginning of the school year for the purpose of renewing or enrolling new members.

23. GSUSA's brand and programs have received many prestigious awards, including being designated as a Top 10 brand for the last two years in the World Value Index compiled by the Enso branding agency, as well as numerous other accolades. GSUSA has been recognized and honored by Presidents throughout history, including by President George H.W. Bush on March 10, 1992. In 2012, President Barack Obama awarded the Presidential Medal of Freedom to Juliette Gordon Low posthumously for her work in founding the Girl Scouts.

24. GSUSA has long enjoyed an excellent reputation among the consuming public with respect to the positive and safe environment it creates for all girls who participate in its leadership programs. Among other things, the public perceives GSUSA programs as welcoming to all girls, regardless of race, ethnicity, background, disability, family structure, religious beliefs and socioeconomic status.

25. GSUSA is entitled to the exclusive use of the GIRL SCOUTS and related trademarks adopted by GSUSA pursuant to 36 U.S.C. § 80305, which in relevant part states that GSUSA “has the exclusive right to use all emblems and badges, descriptive or designating marks, and words or phrases the corporation adopts, including the badge of the Girl Scouts.”

26. The United States Patent and Trademark Office (the “PTO”) has recognized the congressional protections afforded to GSUSA that grant it the exclusive right to use and register the GIRL SCOUTS mark in every class of goods and services recognized by the PTO, under Serial No. 89/000,078.

27. To further protect its famous brand, and to place the public on notice of its trademark rights, GSUSA has secured and owns multiple trademark registrations for its GIRL SCOUTS and GIRL SCOUTS & Profile Design marks, including:



- **Girl Scouts**, incontestable U.S. Trademark Registration No. 1,318,643, issued February 5, 1985, in connection with “educational services-namely, conducting programs and activities for girls and young women to promote social, physical and intellectual growth and development” in International Class 41;





- **Girl Scouts**, incontestable U.S. Trademark Registration No. 1,142,655, issued December 9, 1980, in connection with “t-shirts” in International Class 25;





- **Girl Scouts**, incontestable U.S. Trademark Registration No. 1,142,666, issued December 9, 1980, in connection with “embroidered patch” in International Class 26;
- **CAMPUS GIRL SCOUTS**, incontestable U.S. Trademark Registration No. 0,905,264, issued March 25, 1968, in connection with “organizing and maintaining student groups in colleges and universities to develop leadership and fellowship through continued participation in such groups and through service within the college community” in Class 42;

- **DAISY GIRL SCOUT**, incontestable U.S. Trademark Registration No. 1,480,077, issued March 8, 1988, in connection with “educational services, namely, conducting programs and activities for girls and young women to promote social, physical and intellectual growth and development” in Class 41;
- **GIRL SCOUT COOKIE SALE**, incontestable U.S. Trademark Registration No. 1,816,138, issued January 11, 1994 in connection with “charitable fundraising services featuring the sale of cookies” in Class 36;
- **GIRL SCOUTS**, incontestable U.S. Trademark Registration No. 1,816,847, issued January 18, 1994, in connection with “stationery, note pads, book marks, stickers, pens, pencils and posters” in Class 16 and “sweaters, shirts, blouses, tee-shirts, ties, shorts, tights, socks, sweatshirts, sweatpants, scarves, hats, headbands, sweatbands and visors in Class 25;
- **GIRL SCOUT GOLD AWARD**, incontestable U.S. Trademark Registration No. 2,094,328, issued September 9, 1997, in connection with “jewelry” in Class 14, “paper goods in the nature of printed invitations, folders and certificate of merit and distinction” in Class 16, “picture frames and an award composed of a glass disc mounted on a wood base with an engraved brass plaque” in Class 20, “mugs” in Class 21, and “educational and entertainment services, namely, providing recognition to individuals for the purpose of outstanding service, achievement and quality in the field of scouting” in Class 41;

-  **girl scouts**, incontestable U.S. Trademark Registration No. 4,085,279, issued January 10, 2012, in connection with “tote bags” in Class 18, “clothing, namely, shirts, tee-shirts, and sweatshirts” in Class 25, and “educational services, namely, conducting programs and activities for girls to promote social, physical and intellectual growth and development” in Class 41;

-  **girl scouts**, U.S. Trademark Registration No. 4,276,193, issued January 15, 2013, in connection with “nut products, namely, candied nuts, flavored nuts and trail mixes consisting primarily of processed nuts” in Class 29 and “cookies, chocolate candies and chocolate covered nuts” in Class 30;

-  **gogold**, U.S. Trademark Registration No. 4,481,906, issued February 11, 2014, in connection with “providing recognition and incentives by way of awards to demonstrate outstanding service, achievement and quality in the field of scouting” in Class 41;

- **GIRL SCOUT COOKIE PROGRAM**, U.S. Trademark Registration No. 4,558,536, issued July 1, 2014, in connection with “educational services, namely, conducting cookie-related programs and activities for girls to promote entrepreneurial skills, business management, and intellectual growth and development” in Class 41;
- **girl scouts** , U.S. Trademark Registration No. 4,200,117, issued August 28, 2012, in connection with “stationery, namely, pens and pencils” in Class 16;
- **GIRL SCOUTS**, U.S. Trademark Registration No. 4,727,381, issued April 28, 2015, in connection with “lip balm; lip gloss” in Class 3; and
- **GIRL SCOUT S'MORES**, U.S. Trademark Registration No. 5,336,893, issued November 14, 2017, in connection with “cookies” in Class 30.

True and accurate copies of the aforementioned trademark registrations are attached collectively as Exhibit A.

28. In addition to these federally registered marks, GSUSA owns common law rights in each of the trademarks identified above, as well as in all variations of GIRL SCOUTS that GSUSA has used in connection with girls’ leadership development services and related products or services, as well as any related trade dress and other designations of source (collectively, hereinafter, the “GS Marks”). With respect to the term SCOUTS and SCOUTING in particular, by virtue of the long history of use of the GIRL SCOUTS trademark by GSUSA, the consuming public has come to recognize SCOUTS and SCOUTING as trademarks that, like the other GS Marks, belong exclusively to GSUSA when used in connection with leadership programs and related services for girls.

29. The GS Marks have been extensively advertised and promoted in various media in the United States, including online through the GIRL SCOUTS website (<https://www.girlscouts.org/>) and social media sites such as Facebook.

30. The GIRL SCOUTS mark is distinctive, famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and uniquely associated by consumers with GSUSA and its programs, services and products, both in the State of New York and the United States as a whole. The GIRL SCOUTS mark serves as a strong source identifier by virtue of its long use, extensive promotion and long history with American consumers, and it is entitled to the widest scope of protection under federal and state anti-dilution laws.

31. GSUSA has marketed and offered its youth development services and programs for girls featuring the GIRL SCOUTS mark in interstate commerce since at least as early as 1913.

32. By virtue of its use, federal trademark registrations, and congressional charter, GSUSA has the exclusive right to use the GS Marks, and to prevent the use of any marks or trade dress confusingly similar thereto, in commerce in connection with youth development services and programs for girls.

BSA AND ITS USE OF THE BOY SCOUTS TRADEMARK

33. BSA is a congressionally chartered corporation that provides youth development services and programs for boys. BSA is the national organization that directs and coordinates leadership services and programs under the BOY SCOUTS trademark. Upon information and belief, those services and programs are offered through regional councils and local troops that operate under various trademarks used under license or authorized for use by BSA.

34. According to BSA's congressional charter as set forth in 36 U.S.C. § 30902, its purpose is "to promote, through organization, and cooperation with other agencies, the ability of boys to do things for themselves and others, to train them in scoutcraft, and to teach them

patriotism, courage, self-reliance, and kindred virtues, using the methods that were in common use by boy scouts on June 15, 1916.”

35. While GSUSA and Defendant are both congressionally chartered corporations that offer services to American youth, the two organizations are not associated with one another, and never have been. Defendant is also not endorsed or sponsored by or affiliated with GSUSA.

36. Defendant and GSUSA have coexisted in the marketplace for many decades, with each offering youth development services and programs, under the “SCOUT,” “SCOUTS” and “SCOUTING” trademarks. Crucially, and until recently, these terms when used have either been preceded by words like BOY or GIRL that have highlighted the gender-specific nature of each organization’s programs, or appeared in a context making clear that the programs at issue were developed by one organization or the other.

37. GSUSA has always offered and rendered its services to girls. Defendant historically targeted its core programming to boys, has represented that its congressional charter restricted its BOY SCOUTS and CUB SCOUTS programs to boys,¹ and has used its marks in connection with such boy programming.

¹ See, e.g., Long Island Girl Crusades for Right to Join Boy Scouts, *Southampton Patch* (Aug. 10, 2016, 1:41 PM, updated Aug. 11, 2016, 8:03 AM), <https://patch.com/new-york/southampton/bridgehampton-girl-crusades-right-join-boy-scouts> (quoting BSA spokesperson providing reason for denying a girl admission to Boy Scouts: “[T]he Boy Scouts of America was chartered by Congress in 1916 to serve boys and young men across the nation through the Cub Scouts and Boy Scouts programs, which are year-round programs for boys in the first grade through age 18. We have since developed alternative programs that are co-ed, such as Venturing, but to change the Cub or Boy Scouting programs would go outside the bounds of our charter”; 15-Year-Old Girl Denied Permission To Join Boy Scouts Because Of Gender, CBS New York (Aug. 10, 2016, 5:46 PM), <http://newyork.cbslocal.com/2016/08/10/girl-wants-to-join-boy-scouts/> (same); Petition for Writ of Certiorari, *Boy Scouts of America v. Dale*, 530 U.S. 640 (2000) (No. 99-699), 1999 WL 35238158, at *18 (“Boy Scouting is an expressive organization with the purpose of instilling in boys and young men certain ideals of what it means to be a man. Youth membership is therefore confined to males....”).

38. BSA expressly acknowledged this important division in trademark rights before the Trademark Trial and Appeal Board (“TTAB”) of the PTO. Specifically, in 2004, BSA admitted in a filing made in a trademark opposition proceeding, No. 91157313, that GSUSA owned exclusive, congressionally granted rights to SCOUTS and SCOUTING with respect to youth development programs for girls. It further stated that, “the Boy Scouts controls use of the marks [SCOUT and SCOUTING] in connection with development programs for boys, while Girl Scouts controls use of the marks in connection with development programs for girls. Their joint use of the marks has been expressly recognized by Congress.” True and accurate copies of excerpts from this filing BSA made with the TTAB are attached as Exhibit B. *See* pp. 20-21.

39. When examining Defendant’s SCOUTING trademark, the PTO requested that BSA limit the scope of goods covered by that mark to magazines offering instructional advice specific to boys, “since a similar Federally distributed magazine sponsored for girls and young women also uses the term ‘Scout’ and ‘Scouting’ in referring to organizational activities and members of its organization.” *See* PTO Office Action issued on June 15, 1982, in connection with Application Serial No. 282546, a true and accurate copy of which is attached as Exhibit C. Plainly, the other “organization” in question is GSUSA.

40. Although Defendant has previously offered some limited programs in which girls could participate, it has not, until recently, offered any girls’ programming under the marks SCOUT or SCOUTING alone (without other source-identifying distinguishing leading words) in connection with those programs targeted to girls. For example, Defendant previously offered programs to young women under the EXPLORER and VENTURING marks.

41. Defendant has long acknowledged that use of the SCOUT or SCOUTING marks, unaccompanied by distinguishing terms or devoid of context, even in connection with its programs for boys, could result in confusion. For example, on January 23, 1979, Defendant conceded in a letter to GSUSA that its use of its SCOUTING/USA mark (which obviously combines SCOUTING with the merely descriptive and therefore non-distinctive term “USA”) could mislead the public into believing that GSUSA is affiliated with BSA, or could be confusing to donors who intended to donate to BSA or GSUSA. For this reason, BSA took care at that time to make sure that its councils and troops included BSA’s full name in marketing materials in which that mark was used. A true and accurate copy of this correspondence is attached as Exhibit D. Upon information and belief, this trademark is no longer used by BSA.

42. In another communication sent by BSA to GSUSA on April 26, 1978, Defendant stated that it had taken “several steps that should assist potential public confusion that the communicative term Scouting/USA also refers to [GSUSA]. For one thing, we have instructed our Scouters, including our Public Relations staff, to use the term sparingly, and when it is used to always also feature the words ‘Boy Scouts of America.’” A true and accurate copy of this correspondence is attached as Exhibit E. Significantly, these steps to prevent potential confusion caused by the use of the term SCOUTING/USA were taken, even though BSA only admitted boys to its central programs at that time.

43. Defendant has therefore long recognized both: (i) GSUSA’s trademark rights in the GS Marks, including SCOUTS and SCOUTING, when used in connection with leadership programs for girls and related services and products; and (ii) that Defendant’s use of the terms SCOUT or SCOUTING preceded by other distinguishing terms, or outside of a context making clear that the services in question are directed to boys, would be likely to cause confusion.

44. As the correspondence attached as Exhibits D and E demonstrates, all use of the terms BOY SCOUTS, SCOUTS, SCOUTING and related trademarks in connection with services and programs offered or promulgated by BSA is controlled and supervised by BSA through licensing agreements between BSA and its regional councils, local troops and individual leaders. Upon information and belief, BSA both has the right to supervise and control, and actually does supervise and control, the quality of goods and services offered by Defendant's various regional councils and local troops under BSA's various trademarks, as well as the use of such trademarks by BSA's regional councils, local troops and individual leaders.

45. Upon information and belief, Defendant has published a manual for its various local councils entitled, "THE COUNCIL: How the Council Functions to Carry Out the Purpose of the BSA," that articulates standards for BSA's programs and services to ensure their overall quality, with which each BSA council must comply. A true and accurate copy of this publication is attached as Exhibit F.

46. Upon information and belief, Defendant has also published an "Orientation Guide for Council Officers and Executive Board Members," a true and accurate copy of which is attached as Exhibit G, in order to ensure that its councils adhere to the quality standards set and promulgated by BSA.

47. Upon information and belief, Defendant also issues charters to each of its local BOY SCOUT councils, and each local council identified in this complaint is currently chartered with Defendant. Upon information and belief, as a condition of maintaining their charters, and the concomitant right to use the BOY SCOUTS trademarks and variations thereof, each regional BOY SCOUTS council is required to pay fees to BSA. Upon information and belief, all BOY SCOUTS troop members and leaders are likewise required to be members of BSA and pay

membership dues to BSA in order to remain in operation and retain the right to use the BOY SCOUTS trademarks.

48. Defendant has stated that “[i]t is the council’s responsibility to provide leadership and supervision for all program activities within the territory covered by its charter in such a manner as to ensure compliance with the provisions of the *Charter and Bylaws of the Boy Scouts of America* and the *Rules and Regulations of the Boy Scouts of America*. The local council is an administrative organization charged with fulfilling the purpose of the movement.” See Exh. G at pg. 7.

BSA’S ACTS OF TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND DILUTION

49. Despite a century of coexistence with GSUSA in their respective, exclusive and separate markets, and perhaps in an effort to address financial concerns or declining membership, BSA recently announced that it would expand its offerings under the SCOUTS and SCOUTING trademark to encompass programs for girls, beginning with the enrollment of girls into its CUB SCOUTS programs. A true and accurate copy of Defendant’s announcement, dated October 11, 2017, is attached as Exhibit H. It then announced that it would open its BOY SCOUTS program to girls beginning in February 2019.

50. In May 2018, BSA went one step further by unveiling a new *Scout Me In* advertising campaign. In announcing this campaign, BSA stated that “[t]he *Scout Me In* campaign celebrates [Defendant’s] expansion to serve families and welcome girls and boys into Scouting in communities across the country.” A true and accurate copy of Defendant’s press release dated May 2, 2018, is attached as Exhibit I. Defendant now uses the SCOUT, SCOUTING, FAMILY SCOUTING and SCOUT ME IN trademarks to recruit girls into its CUB SCOUTS and BOY SCOUTS programs and, upon information and belief, it has also directed or

instructed its regional councils and local troops to use these trademarks or variations thereof in connection with programs and services newly offered to girls.

51. As the May 2, 2018 press release also indicates, SCOUTS BSA has been introduced as the new name of Defendant's programs for youth who are ages 11 to 17, beginning in February 2019, and will replace the longstanding BOY SCOUTS trademark for programs offered to that age group. *Id.* Defendant intends to use the SCOUTS BSA mark in connection with youth development services and programs targeted to girls. In a June 12, 2018 publication entitled "Family Scouting Questions and Answers," a true and accurate copy of which is attached as Exhibit J, Defendant further made clear that participants in the SCOUTS BSA program – boys and girls alike – will be referred to as "Scouts." *Id.* at 10.

52. Consistent with this message, Defendant is also currently distributing marketing materials, including videos, in which it frequently refers to girls as "Scouts." For example, upon information and belief, Defendant published a video on June 13, 2018, entitled "SCOUT ME IN" that prominently featured girls and included statements by girls such as "the Scouting world starts with my very best, right now self, and will lead me to my very best future self. Scouting will show me a kid who is brave, trustworthy, loyal and kind. . ." Defendants have also published or disseminated numerous other advertisements that are directed to girls, show pictures of girls, and reference the advertised program as SCOUTING or SCOUTS.

53. Recent U.S. trademark filings made by BSA demonstrate that Defendant is seeking to obtain federal trademark registration rights for its rebranding effort. For example, Defendant filed a trademark application for the SCOUTS BSA mark (Serial No. 87/906,567) with the PTO based on its intent to use the mark in commerce in connection with "educational services, namely, providing programs and activities for youth" in International Class 41.

Defendant also filed a trademark application with the PTO for SCOUTS BSA as a collective membership mark (Serial No. 87/906,407) based on its intent to use the mark in commerce in connection with “indicating membership in an organization for youth.” Finally, Defendant has also filed a trademark application with the PTO for the SCOUT LIFE mark (Serial No. 87/882,226) based on its intent to use this mark in commerce in connection with “magazines directed to the interests of the members of a youth organization” in International Class 16, and “providing online magazines directed to the interests of the members of a youth organization” in International Class 41.

54. By way of assignment from a university, Defendant also owns a trademark registration for the SCOUT mark (Reg. No. 4,865,183), issued on December 8, 2015, in connection with “education services, namely, providing on-line classes in the fields of math, history, science, economics, social studies, psychology, computer science, and environmental science; education services, namely, providing online courses of instruction at the secondary level and distribution of course material in connection therewith” in International Class 41.

55. Defendant’s decision to expand its core leadership programs to encompass girls of all ages has dramatically changed the circumstances that previously allowed its use of trademarks like SCOUTS and SCOUTING to coexist with the GS Marks without causing confusion. As a result of this fundamental change in the nature of Defendant’s services and how its marks are used, numerous examples of the mis-use of GSUSA’s trademarks have come to GSUSA’s attention, and actual confusion among members of the public between the two organizations, their services and their trademarks has become rampant.

56. Indeed, acting at the direction of or instructed by BSA in connection with the implementation of its rebranding effort, Defendant’s regional councils, local troops and

individual leaders have used the SCOUTING and SCOUTS marks, and variations thereof, to promote, market, fundraise, deliver services, and advertise their activities targeted to girls in a manner violative of GSUSA's valuable trademark rights, as demonstrated in the examples below. Upon information and belief, in each and every one of these examples, the councils, troops or leaders in question acted at either the direction of Defendant, on Defendant's behalf, or for the purpose of assisting Defendant within the scope of their relationship with Defendant. Likewise, Defendant has a direct financial interest in all of the wrongful activity delineated in these examples by virtue of the membership fees and other revenues it receives from its councils and troops that are generated in part through such wrongful use of GSUSA's trademarks.

57. Upon information and belief, and as depicted in Example 1 below, Defendant's Orange County, California Council distributed fundraising materials in connection with an event held on November 30, 2017, stating that the proceeds from the event would help, among other things, "implementation of our New BSA Girl Scouting Program."

Example 1: BSA Fundraising Flyer for “New BSA Girl Scouting” Programs

“THE EL CAPITAN DISTRICT SERVES OVER 1,400 YOUTH IN ANAHEIM, GARDEN GROVE, STANTON, AND SURROUNDING CITIES. SCOUTING'S POSITIVE IMPACT HELPS OUR LOCAL FAMILIES AND YOUR COMMUNITY. PLEASE JOIN US AS WE CELEBRATE SCOUTING AND HELP ENSURE BSA'S SPECIAL SCOUTING PROGRAMS FOR TODAY'S YOUTH”

Troop 111 Scoutmaster Emeritus [REDACTED]

The proceeds from the luncheon will provide funding for our Cub Scouts, Boy Scouts, Adventure Scouts, Explorer Scouts, and in the development and implementation of our New BSA Girl Scouting Programs!

Suggested Levels of Support for El Capitan Scouts

★ Special Gift \$	_____
★ Tiger/Lion Sponsor	\$250.00
★ Cub Sponsor	\$500.00
★ Tenderfoot Sponsor	\$750.00
★ Star Sponsor	\$1,000.00
★ Life Sponsor	\$2,500.00
★ Eagle Sponsor	\$5,000.00

✂

Your Sponsorship Amount : \$ _____

Donation Information and ON-LINE Payment LINK:
[REDACTED]

Please make checks payable to Orange County Council Boy Scouts of America-501(C)3 TAX ID 95-1727660 Donor Cards will be available and collected at the Luncheon or Please send checks or credit card authorization with attached form to:
Orange County Council, Boy Scouts of America 1211 E. Dyer Road, Santa Ana, CA. 92705

Credit Card Account # _____ Type VISA MC Etc. _____

Expiration _____ Name on Card _____ Code _____

Address _____

City _____ ZIP _____ Phone _____

Email _____ Signature _____

Please RSVP by Friday Nov. 24th to Mayor Pro-Tem [REDACTED]
[REDACTED] or [REDACTED] at [REDACTED]

Questions: Mayor Pro-Tem [REDACTED] at above email address or phone number

58. Upon information and belief, and as depicted in Example 2 below, a flyer for a Boy Scout day camp program held between June 4, 2018 and June 7, 2018 in Texas featured the GIRL SCOUT trademark.

Example 2: “GIRL SCOUT Volunteer Opportunity” at Twilight Camp



59. Upon information and belief, and as depicted in Example 3 below, a Boy Scout leader located in Texas used the phrase “Boys/Girls Scouts of America Volunteer Form” to recruit members online.

Example 3: “Boys/Girls Scouts of America” Online Form

Boys/Girls Scouts of America Volunteer Form

By completing this form, you would instantly become a valuable asset to a child's future. Be Proud.

*Required:

Name *

Your answer

Campus

Your answer

Your Campus Position

Your answer

Volunteer experience with Boys or Girls Scouts of America

Submit

60. Upon information and belief, and as depicted in Example 4 below, the Defendant’s Great Southwest Council in New Mexico constructed a sign that featured the words

“Boy & Girl Scouts www.troop174NM.org.” Upon information and belief, the website www.troop174NM.org is owned and/or operated by Defendant or one of Defendant’s councils.

Example 4: “Boy & Girl Scouts” Public Sign



61. Upon information and belief, and as shown in Example 5 below, an organization located in Wantagh, New York that sponsors BSA services announced in October 2018 the planned formation of a “Girl Scouts BSA Troop” or a “Girl Scout troop” in February 2019.

Example 5: Announcements Concerning Formation of a “Girl Scouts BSA Troop”

**OUR COMMUNITY
PACK AND TROOP**

COME ON DOWN!
Pack [redacted] meets on Thursday nights
from 6:15 pm - 7:30pm
in the Youth Lounge and is looking
for boys and girls in grades K-4

Boy Troop [redacted] meets on Thursday nights
from 7:30 pm - 9:00pm
in the Youth Lounge
and is looking for boys from 5th grade up to 18 years old

We are in the process of forming a Girl Scouts BSA Troop
as well (meetings will start at the beginning of February),
which will meet Thursday nights from 7:30pm - 9:00pm
(location still TBD) and are looking for
interested girls from 5th grade up to 18 years old.
For more information, please email me
at [redacted]

All three units are always looking for adults to volunteer as
well. Come on down and see how much fun it is!"

by [redacted]

Summer fun at [redacted]


Religious Awards Breakfast Article

14 [redacted]

Visit [redacted] for the latest information.

OUR COMMUNITY

PACK AND TROOP



Hi everyone,
No new pictures yet, so I thought I would talk about Family Scouting, why it happened, and how it is being implemented.

The Boy Scouts of America's leadership has always operated on the premise that we are to ensure that the Scouting program and learning the values (as stated in the Scout Oath and Law) would be made available to as many youth as possible. BSA has had coed programs for decades and also recognized that because Cub Scouting was designed to be a family oriented program, girls had been attending meetings for years. They also did research and found that there were a significant number of families that wouldn't consider Scouting for their boys because they were looking for one organization that would accept the entire family.

So, they decided to make it available to girls as well. We implemented accepting girls into Cub Scouts (grades K-5) this past winter and will accept girls into the renamed Scouts BSA program (grades 6-12) starting February, 2019.


In Cub Scouts, packs can choose to be single gender or family packs. Family packs accept boys and girls, but they go into single gender dens. Most of the learning activities are done at the den level and most meetings are den meetings, so they spend most of the time in a single gender environment. Pack [redacted] is a family pack.

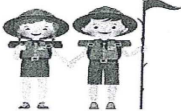
At the Scouts BSA program, boys and girls will be in separate troops. Each will have their own adult and youth leadership and, while they can do some activities together, the bulk of the meetings are separate. When all of the talk about accepting girls started, I thought we would be better off with coed troops (as is done in many other countries), but I have come around to thinking that single gender troops are better. From the boys' perspective, girls typically mature faster from ages 10-14, which would make them more likely to get selected for leadership roles, inhibiting the boys' leadership development. From the girls' perspective, while studies have had mixed results about whether single gender is

better for boys' learning, the studies are pretty convincing that girls learn better in single gender environments. So both genders benefit in different ways from being separate at the troop-level ages. We will be forming a Girl Scout troop in February.

That is the short version. Anyone who has more questions is welcome to reach out to me or any of the Scout leadership here at [redacted] including [redacted] (Scoutmaster of the boy Troop) and [redacted] (Cubmaster of the Pack). Come on down on a Thursday night and see what Scouting can do for your family!

(so many Scouting positions, so little space)





18 [redacted] Visit [redacted] for the latest information.

62. Upon information and belief, and as depicted in Example 6 below, a Boy Scout leader in Kirkland, Washington used the phrase, "Come talk to me about the Girl Scouts BSA Troops forming in Kirkland" in a Facebook post online.

Example 6: “Come talk to me about the Girl Scouts BSA Troops” Facebook Post



63. Upon information and belief, and as depicted in Example 7 below, a Boy Scout leader in St. Louis, Missouri misappropriated GSUSA’s slogan and mission statement of “Building girls of courage, confidence and character who make the world a better place” by marketing the CUB SCOUTS program to girls under the slogan, “Building kids of courage, confidence, character and to love the outdoors, and who make the world a better place!”

GSUSA's mission statement above is explicitly set forth in the Preamble of GSUSA's Constitution, which is published in GSUSA's Blue Book of Basic Documents, publicly available, including on GSUSA's website, www.girlscouts.org, and widely used in GSUSA's marketing materials.

Example 7: Use of Girl Scouts' Slogan/Mission Statement in Boy Scouts Marketing



64. Upon information and belief, a Boy Scout volunteer approached a former Gold Award Girl Scout and solicited her to join him and others to develop the "Girl Scout program" for Defendant's Northern Star Council (Twin Cities) located in Minneapolis, Minnesota.

65. Upon information and belief, GSUSA's Profile Design mark depicted in paragraph 27 above was used in Boy Scout New England Base Camp marketing materials, and also in a Boy Scouts council invitation to an event in Michigan.

66. Upon information and belief, Boy Scout councils have used pictures of Girl Scouts in Girl Scout uniforms to advertise BSA's programming in Massachusetts and Chicago.

67. Defendant's efforts to leverage the GIRL SCOUTS brand and confuse consumers has even gone so far as to prominently display a quote from GSUSA's founder on BSA's advertising for SCOUTS programs that has been disseminated to Defendant's councils through the BSA Brand Center. *See* Example 8, below.

Example 8: Use of Quote from Girl Scouts' Founder in Boy Scouts Marketing



68. GSUSA has sent numerous letters and warnings to Defendant and its regional councils regarding Defendant's serial infringing activity. In response, Defendant has acknowledged the "legally protected brand" that GSUSA owns in its GS Marks. A true and

accurate copy of correspondence from Defendant to GSUSA dated November 2, 2017 is attached as Exhibit K. This correspondence labeled the violation of GSUSA's trademark rights at issue therein as "inadvertent" and an "unfortunate error," but the ongoing violations of GSUSA's rights have mushroomed significantly since then, even though Defendant has been on notice of the infringing conduct of its councils, troops and volunteers throughout that time.

69. Indeed, to make matters worse, upon information and belief, Defendant and its councils have also engaged in a number of unfair business practices. For example, upon information and belief, in April and May 2018, one of Defendant's leaders approached a retailer in Red Bluff, California and attempted to dissuade the retailer from providing booth space to local Girl Scout members to sell their products, explaining that Defendant was now supposedly serving Girl Scouts and Boy Scouts. Upon information and belief, this Boy Scout leader acted at either the direction of Defendant or its local council, on behalf of Defendant or its local council, or for the purpose of helping Defendant or its local council within the scope of his relationship with those entities. True and accurate copies of correspondence dated April 17, 2018 and May 8, 2018 concerning this instance of unfair business practices are attached as Exhibit L.

70. Upon information and belief, Boy Scout council representatives in Illinois directed parents at a school open house to join the "Scouts," representing that the parties' separate organizations were now combined. In addition, upon information and belief, one of Defendant's leaders at a school recruitment event in Illinois stated that "there is no more Girl Scouts" or "there are no Girl Scouts" to a parent who was interested in signing their daughter up for GSUSA's programs. Upon information and belief, these Boy Scout council representatives acted at either the direction of Defendant, on Defendant's behalf, or for the purpose of helping Defendant within the scope of the representatives' relationship with Defendant.

71. Upon information and belief, Defendant's representatives in Texas have advised prospective parents interested in signing up for Girl Scouts that "it is all the same now" and that "Girl Scouts are in our pack." Parents are also being told that the Boy Scouts are the "official" Scouts, which has prompted some parents to ask GSUSA representatives if their longstanding Girl Scouts services are properly authorized. Upon information and belief, these Boy Scout council representatives acted at either the direction of Defendant, on Defendant's behalf, or for the purpose of helping Defendant within the scope of the representatives' relationship with Defendant.

72. Upon information and belief, a North Carolina Girl Scout recruitment staff member called to schedule visits with school principals in Henderson, Haywood and Jackson Counties, only to be told by these principals that they thought these visits had already been scheduled, because Defendant's representatives had told the schools that the Girl Scouts had been merged into the Boy Scouts.

73. In an effort to sow further confusion and interfere with GSUSA's leadership programming, upon information and belief, Defendant has used the GIRL SCOUTS trademark and variations thereof as Google Ad Words so that Defendant's advertisements would rank first in response to searches for "Girl Scouts" or "GSUSA Shop" on the Google search engine. A true and accurate copy with redactions of a screenshot from this search engine showing the effect of such wrongful use of GSUSA's GS Marks is attached as Exhibit M.

74. Upon information and belief, Defendant and its councils and volunteers have engaged in multiple other acts of misconduct that have violated GSUSA's trademark rights throughout the country that GSUSA can only fully discover through litigation. Despite

Defendant being on notice of such infringing conduct and the interference alleged herein, this conduct is continuous and ongoing.

75. As demonstrated by the examples above, there is a clear pattern of wrongful conduct by Defendant and its councils and leaders. Defendant has failed to take reasonable actions to prevent or correct the wrongful conduct of its councils and leaders.

ADDITIONAL EXAMPLES OF ACTUAL CONSUMER CONFUSION

76. Separate and apart from the unauthorized, wrongful acts of misconduct described above that have caused confusion among consumers, other use of the GS Marks, including SCOUTS and SCOUTING, as well as SCOUTS BSA, in advertising and promotional materials, has created confusion among consumers, and these are likely to continue to cause confusion unless enjoined by this Court.

77. Specifically, GSUSA has been made aware of several instances in which girls were mistakenly signed up for Boy Scouts programs when the intent was to sign them up for the GIRL SCOUTS. For example, upon information and belief, in Central Indiana, a parent contacted a Girl Scout council and reported that she had mistakenly enrolled her daughter in the Boy Scouts when she believed she was signing up for Girl Scouts. The parent asked whether the enrollment fees paid to Defendant could be transferred to GSUSA (they cannot). Upon information and belief, similar instances of parents mistakenly signing their girls up for BSA programs when they had intended to enroll them in GIRL SCOUTS programs have also occurred in Texas.

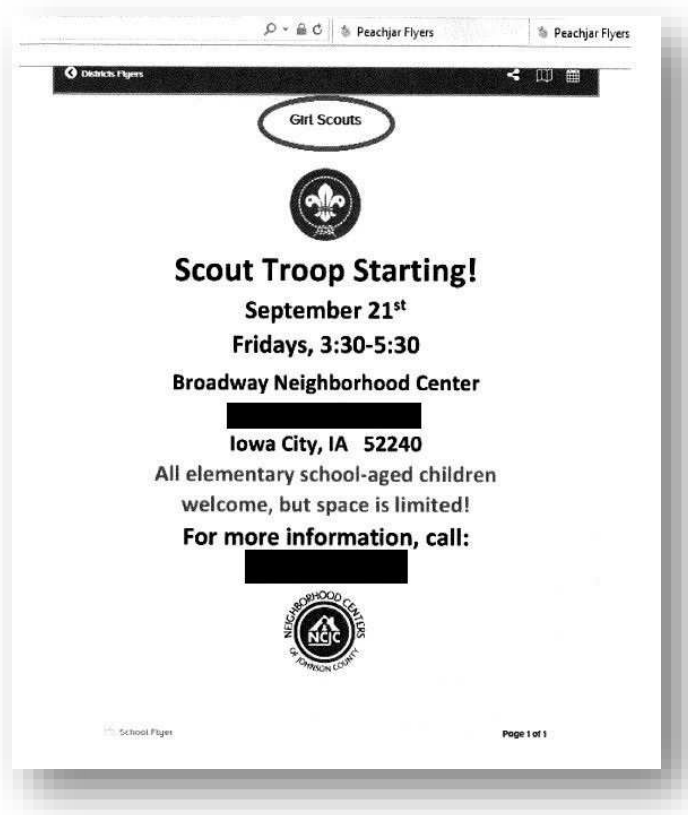
78. Upon information and belief, at a school recruitment event in South Dakota, a mother filled out membership paperwork provided by a Boy Scouts recruiter, believing that she was signing her five-year-old daughter up for GIRL SCOUTS programs.

79. Upon information and belief, at a school recruitment event in Goshen, Indiana, several parents reported to GSUSA volunteers that they had been confused by a presentation made by local BSA volunteers at a recruiting event as to whether they represented the Boy Scouts, the Girl Scouts, or both. One parent actually enrolled her daughter in the Boy Scouts thinking that she was signing her up for Girl Scouts and received a refund as a result.

80. Upon information and belief, a recruiter for Defendant repeatedly stated that “Boy Scouts is now accepting Girl Scouts” at an elementary school open house event in North Carolina, at which both Defendant and GSUSA councils had recruitment tables, prompting many attendees to express confusion to the recruiter at the GSUSA council table.

81. The confusion about the relationship between GSUSA and Defendant is spreading through third-party organizations and media channels as well. Upon information and belief, Neighborhood Centers of Johnson County, Iowa provided information on a recruitment flyer, depicted below, for Defendant that advertised “Scout Troop Starting! . . . all elementary school-aged children welcome” on September 18, 2018, which was billed as a “Girl Scouts” event and posted on the Grant Wood Elementary School’s website as such.

“Girl Scouts” Flyer Posted by Neighborhood Centers of Johnson County



82. In another example, a news article published in the *Brown County Press* located in Ohio concerned *solely* with Defendant’s events and recruiting was titled – “Boy and Girl Scouts looking for members.” A true and accurate copy of this article published in August 2018 is attached as Exhibit N. Another article published on September 10, 2018 in the *Barnesville Record* of Barnesville, Minnesota, entitled, “Scout Me In,” reported that “[a]fter a hundred years the girl scouts and boy scouts are merging into one group and will be known as Scouts BSA.” A local Boy Scout leader was quoted in the article as affirming the positive benefits that would flow from this purported merger. A true and accurate copy with redactions of this article published on September 10, 2018 is attached as Exhibit O.

83. Upon information and belief, Defendant’s use of SCOUT, SCOUTING and variations thereof like SCOUTS BSA in connection with all of its core programs offered to girls

of all ages nationwide has caused an extraordinary level of confusion among the public and violated GSUSA's valuable trademark rights.

84. This confusion will only be exacerbated when Defendant implements its recently announced SCOUTS BSA program in February 2019 that will see older girls admitted into BSA as "Scouts."

85. Defendant's use of the SCOUT mark and variations thereof in connection with all of BSA's core programs offered to girls of all ages on a nationwide basis has diluted and will continue to dilute GSUSA's famous GIRL SCOUTS trademark by blurring its distinctiveness and creating an improper and inaccurate association with BSA.

86. Such improper associations are of particular concern to GSUSA because Defendant has received significant negative publicity regarding its activities conducted under the BOY SCOUTS and SCOUTS marks, such that the goodwill associated with those terms when used in connection with boys' leadership development services has been damaged. In particular, there have been lawsuits and media articles alleging: a poor child safety record with respect to certain aspects of Defendant's programs; acts of misconduct perpetrated by some of its leaders over the years; and BSA's decision to lobby against child protection statutes in certain states.²

² Boy Scouts lobby in states to stem the flow of child abuse lawsuits, *The Washington Post*, (May 9, 2018), https://www.washingtonpost.com/powerpost/boy-scouts-lobby-in-states-to-stem-the-flow-of-child-abuse-lawsuits/2018/05/08/0eee0a44-47d8-11e8-827e-190efaf1flee_story.html?utm_term=.21c485b800f9; Boy Scouts' 'perversion files' released: 'The secrets are out', *Los Angeles Times*, (Oct. 18, 2012), <https://latimesblogs.latimes.com/lanow/2012/10/boy-scouts-perversion-files-released-the-secrets-are-out.html>; Three things to know about the Boy Scouts sex abuse cases, *The Atlanta Journal-Constitution*, (Aug. 20, 2018), <https://www.ajc.com/news/crime--law/three-things-know-about-the-boy-scouts-sex-abuse-cases/EalhiPsV8ipUyIQVcb8CmK/>; 4 men sue Boy Scouts of America over alleged sexual abuse, *New York Post*, (July 24, 2018), <https://nypost.com/2018/07/24/4-men-sue-boy-scouts-of-america-over-alleged-sexual-abuse/>; 'Pedophile Magnet' Boy Scouts of America Let 'Serial' Sex Abuser Prey on Four Boys: Lawsuit, *Daily Beast*, (July 24, 2018),

As a result, Defendant's misleading and confusing use of the SCOUTS mark and variations thereof in connection with youth development services and programs for girls has damaged and will continue to damage the goodwill associated with the GIRL SCOUTS mark.

87. GSUSA's GIRL SCOUTS mark will be both blurred and tarnished as a result of consumers mistakenly associating the two organizations. The incorrect and improper association is likely to be and has been harmful to GSUSA's GIRL SCOUTS marks and the organization as a whole, resulting in the impairment in the distinctiveness of the GIRL SCOUTS mark. Indeed, the consuming public formerly associated the GIRL SCOUTS mark, when used in connection with girls' leadership development programs offered to all girls of all ages, exclusively with GSUSA, but Defendant's actions have now begun to create an improper association between that mark and a second source – BSA. This is a classic type of dilution prohibited under 15 U.S.C. § 1125(c).

88. GSUSA has no adequate remedy at law.

FIRST CAUSE OF ACTION

FEDERAL TRADEMARK INFRINGEMENT UNDER 15 U.S.C. § 1114(1)

89. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

90. GSUSA owns the distinctive, valid and registered GS Marks.

<https://www.thedailybeast.com/pedophile-magnet-boy-scouts-of-america-let-serial-sex-abuser-prey-on-four-boys-lawsuit-claims>, *The Guam Daily Post*, (Jan. 8, 2018), https://www.postguam.com/news/local/former-boy-scouts-file-sex-abuse-lawsuits/article_85e60006-f40f-11e7-8361-7369b1ee1218.html; A list of Boy Scout outing deaths, *Los Angeles Times*, (Dec. 5, 2010), <http://articles.latimes.com/2010/dec/05/nation/la-na-scouts-list-online-20101205>; Sexual abuse of Explorer Scouts has gone on for decades across the nation, *Courier Journal*, (Published May 18, 2017, Updated June 27, 2018), <https://www.courier-journal.com/story/news/investigations/2017/05/18/sexual-abuse-explorer-scouts-has-gone-decades-across-nation/311510001/>.

91. Without GSUSA's consent, Defendant has used the SCOUTS and SCOUTING marks and marks similar thereto (and intends to use SCOUTS BSA), which are confusingly similar to the GS Marks, in commerce in connection with services targeted to girls and to advertise and promote such competing services.

92. In addition, Defendant's councils, troops and leaders, at the direction of Defendant, have also used the SCOUTS and SCOUTING marks and marks similar thereto (and will soon use SCOUTS BSA), which are confusingly similar to the GS Marks, in commerce in connection with services targeted to girls and to advertise and promote such competing services. Upon information and belief, Defendant has the authority to control the use of intellectual property related to Defendant's services by its councils, troops and leaders, and Defendant exercises control over the use of such intellectual property by its councils, troops and leaders. Upon information and belief, Defendant reaps a direct financial benefit from the infringing activities of its councils, troops and leaders by virtue of membership dues that flow back to Defendant.

93. Defendant's actions, as well as those of its councils, troops and leaders, as described herein, have caused and are likely to cause confusion, mistake, and deception among consumers as to the affiliation, connection, or association of Defendant with GSUSA, as to the true source of Defendant's services, and as to the sponsorship or approval of Defendant or Defendant's services by GSUSA.

94. Neither Defendant nor its councils, troops, and leaders are affiliated or associated with GSUSA or its services, and GSUSA does not approve or sponsor Defendant, Defendant's services, or the marketing in U.S. commerce of Defendant's services by Defendant's councils, troops and leaders.

95. Defendant is both directly and vicariously liable for the infringing use of the GS Marks, SCOUTS, SCOUTING and similar marks thereto, as well as that of Defendant's councils, troops and leaders, about which Defendant has received consistent notification from GSUSA.

96. The actions of Defendant described above constitute direct and vicarious trademark infringement in violation of 15 U.S.C. § 1114(1).

97. Defendant's actions are willful and reflect an intent to confuse consumers and profit from the goodwill and consumer recognition associated with GSUSA and the GS Marks.

98. GSUSA has been, and will continue to be, damaged and irreparably harmed by the actions of Defendant, which will continue unless Defendant is enjoined by this Court. GSUSA is therefore entitled to injunctive relief pursuant to 15 U.S.C. § 1116.

99. GSUSA is also entitled to actual monetary damages in an amount to be determined at trial, and to any profits made by Defendant in connection with its infringing activities.

100. Defendant's infringement of the registered GS Marks is deliberate, willful, and without extenuating circumstances, and constitutes a knowing use of GSUSA's trademarks. Defendant's infringement is thus an "exceptional case" within the meaning of section 35(a) of the Lanham Act, 15 U.S.C. § 1117(a). GSUSA is therefore entitled to recover three times the amount of its actual damages and the attorneys' fees and costs incurred in this action, as well as prejudgment interest.

SECOND CAUSE OF ACTION

**FEDERAL UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN
UNDER 15 U.S.C. § 1125(a)**

101. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

102. GSUSA owns the famous, distinctive, valid, and registered GS Marks, as well as common law rights in the GS Marks, including the marks SCOUTS and SCOUTING as used in connection with girls programs.

103. Without GSUSA's consent, Defendant has directly used the SCOUTS and SCOUTING marks and marks similar thereto (and intends to use SCOUTS BSA), which are confusingly similar to the GS Marks in commerce in connection with services targeted to girls and to advertise and promote such competing services.

104. In addition, Defendant's councils, troops and leaders, at the direction of Defendant, have also used the SCOUTS and SCOUTING marks and marks similar thereto (and will soon use SCOUTS BSA), which are confusingly similar to the GS Marks, in commerce in connection with services targeted to girls and to advertise and promote such competing services. Upon information and belief, Defendant has the authority to control the use of intellectual property related to Defendant's services by its councils, troops and leaders, and Defendant exercises control over the use of such intellectual property by its councils, troops, and leaders. Upon information and belief, Defendant reaps a direct financial benefit from the wrongful activities of its councils, troops, and leaders by virtue of membership dues that flow back to Defendant.

105. Defendant's actions, as well as those of its councils, troops, and leaders, as described herein have caused and are likely to cause confusion, mistake, and deception among

consumers as to the affiliation, connection, or association of Defendant with GSUSA, as to the true source of Defendant's services, and as to the sponsorship or approval of Defendant or Defendant's services by GSUSA.

106. Neither Defendant nor its councils, troops, and leaders are affiliated or associated with GSUSA or its services, and GSUSA does not approve or sponsor Defendant, Defendant's services, or the marketing in U.S. commerce of Defendant's services by Defendant's councils, troops, and leaders.

107. Defendant is both directly and vicariously liable for the use of the GS Marks, SCOUTS, SCOUTING and similar marks thereto, as well as that of Defendant's councils, troops, and leaders, about which Defendant has received consistent notification from GSUSA.

108. The actions of Defendant described above constitute unfair competition and false designation of origin in violation of 15 U.S.C. § 1125(a)(1).

109. Defendant's actions are willful and reflect an intent to confuse consumers and profit from the goodwill and consumer recognition associated with GSUSA and the GS Marks.

110. GSUSA has been, and will continue to be, damaged and irreparably harmed by the actions of Defendant, which will continue unless Defendant is enjoined by this Court. GSUSA is therefore entitled to injunctive relief pursuant to 15 U.S.C. § 1116.

111. GSUSA is also entitled to actual monetary damages in an amount to be determined at trial and to any profits made by Defendant in connection with its unfairly competitive activities.

112. Defendant's unfair competition and false designation of origin are deliberate, willful, and without extenuating circumstances. Defendant's conduct is thus an "exceptional case" within the meaning of Section 35(a) of the Lanham Act, 15 U.S.C. § 1117(a). GSUSA is

therefore entitled to recover three times the amount of its actual damages and the attorneys' fees and costs incurred in this action, as well as prejudgment interest.

THIRD CAUSE OF ACTION

FEDERAL TRADEMARK DILUTION UNDER 15 U.S.C. § 1125(C)

113. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

114. GSUSA's GIRL SCOUTS mark is famous and distinctive and has been for many years prior to the first offering of any services by Defendant to girls under the trademarks SCOUTS, SCOUTING and variations thereof.

115. Without authorization or license from GSUSA, Defendant is using and intends to use the SCOUTS and SCOUTING trademarks and marks similar thereto (and intends to use SCOUTS BSA) in commerce in a manner that impairs the distinctive quality, and harms the reputation, of GSUSA's famous GIRL SCOUTS mark.

116. In addition, Defendant's councils, troops, and leaders, at the direction of Defendant, have also used the SCOUTS and SCOUTING marks and marks similar thereto (and will soon use SCOUTS BSA) in commerce in a manner that impairs the distinctive quality, and harms the reputation, of GSUSA's famous GIRL SCOUTS mark. Upon information and belief, Defendant has the authority to control the use of intellectual property related to Defendant's services by its councils, troops, and leaders, and Defendant exercises control over the use of such intellectual property by its councils, troops, and leaders. Upon information and belief, Defendant reaps a direct financial benefit from the infringing activities of its councils, troops, and leaders by virtue of membership dues that flow back to Defendant.

117. The acts and conduct of Defendant alleged herein, as well as those of Defendant's councils, troops, and leaders occurring at Defendant's direction, occurred after

GSUSA's GIRL SCOUTS mark became famous and constitute dilution by blurring and dilution by tarnishment in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), both directly and vicariously.

118. Upon information and belief, Defendant's acts of dilution and tarnishment are willful, deliberate, and in bad faith.

119. GSUSA has no adequate remedy at law.

120. Defendant's acts and conduct will cause immediate and irreparable injury to GSUSA, to its goodwill and reputation, and to the public, and will continue to threaten such injury unless enjoined by this Court.

121. GSUSA is entitled to injunctive relief and to recover GSUSA's actual damages and an award of GSUSA's profits, as well as costs and GSUSA's reasonable attorney's fees, under 15 U.S.C. §§ 1025(c), 1116, and 1117.

FOURTH CAUSE OF ACTION

MODIFICATION OR PARTIAL CANCELLATION OF REGISTRATION

122. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

123. Defendant's U.S. trademark registration for the SCOUT mark (Reg. No. 4,865,183) obtained by assignment from a university does not limit the identified online secondary level educational services to programs for boys.

124. Defendant's use of the SCOUT mark in connection with educational services for girls is likely to cause, and has already caused, consumer confusion.

125. Pursuant to 15 U.S.C. § 1119, this Court has the authority to "determine the right to registration, order cancellation of registrations, in whole or in part . . . and otherwise

rectify the register with respect to the registrations of any party” in an action involving a registered mark.

126. Consistent with the authority conferred by 15 U.S.C. § 1119, Defendant’s registration for the SCOUT mark should be modified or partially cancelled through entry of a decree ordering the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to make an entry on the records of the PTO limiting the identified services in such registration to programs for boys.

FIFTH CAUSE OF ACTION
**COMMON LAW TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND PASSING OFF**

127. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

128. GSUSA owns common law trademark rights in the GS Marks and all such rights owned by GSUSA are superior to any rights that the Defendant may claim to have in the SCOUTS or SCOUTING marks with respect to any goods or services targeted to girls.

129. Defendant’s unauthorized use of trademarks confusingly similar to the GS Marks in connection with youth development services or programs for girls is likely to cause confusion as to the source or sponsorship of these services, and is likely to lead the public to believe that GSUSA is affiliated with or sponsors or endorses Defendant and/or Defendant’s services, and is likely to mislead persons in the ordinary course of purchasing Defendant’s services, thereby injuring the reputation and goodwill and unjustly diverting from GSUSA to Defendant the benefits arising therefrom.

130. In addition, Defendant’s councils, troops, and leaders, at the direction of Defendant, have also used the SCOUTS and SCOUTING marks and marks similar thereto (and

will soon use SCOUTS BSA), which are confusingly similar to the GS Marks, in commerce in connection with services targeted to girls and to advertise and promote such competing services. Upon information and belief, Defendant has the authority to control the use of intellectual property related to Defendant's services by its councils, troops, and leaders, and Defendant exercises control over the use of such intellectual property by its councils, troops, and leaders. Upon information and belief, Defendant reaps a direct financial benefit from the wrongful activities of its councils, troops, and leaders by virtue of membership dues that flow back to Defendant.

131. Defendant's unlawful activities, as alleged above, constitute trademark infringement, unfair competition, and passing off as proscribed by common law.

132. Defendant's acts of trademark infringement, unfair competition, and passing off were committed, or will imminently be committed, willfully, knowingly, intentionally, and in bad faith.

133. Defendant's acts or intended acts of trademark infringement, unfair competition, and passing off, unless enjoined by this Court, will threaten to cause GSUSA irreparable damage, loss, and injury for which GSUSA has no adequate remedy at law. GSUSA is therefore entitled to injunctive relief enjoining such wrongful conduct, and to an award of damages that provides GSUSA with adequate compensation for the harm it has suffered.

SIXTH CAUSE OF ACTION

TRADEMARK DILUTION UNDER NEW YORK GENERAL BUSINESS LAW § 360-I

134. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

135. GSUSA's GIRL SCOUTS mark is distinctive within the State of New York and has been for many years prior to the first offering of any services by Defendant to girls under the SCOUTS and SCOUTING trademarks and marks similar thereto.

136. Without authorization or license from GSUSA, Defendant is using and intends to use the SCOUTS and SCOUTING trademarks and marks similar thereto (and intends to use SCOUTS BSA) in the State of New York in a manner that impairs the distinctive quality, and harms the reputation, of GSUSA's famous GIRL SCOUTS mark.

137. In addition, Defendant's councils, troops, and leaders within the State of New York, at the direction of Defendant, have also used the SCOUTS and SCOUTING marks and marks similar thereto (and will soon use SCOUTS BSA) in New York in a manner that impairs the distinctive quality, and harms the reputation, of GSUSA's famous GIRL SCOUTS mark. Upon information and belief, Defendant has the authority to control the use of intellectual property related to Defendant's services by its councils, troops, and leaders within the State of New York, and Defendant exercises control over the use of such intellectual property by its councils, troops, and leaders. Upon information and belief, Defendant reaps a direct financial benefit from the activities of its councils, troops, and leaders within the State of New York by virtue of membership dues that flow back to Defendant.

138. The acts and conduct of Defendant alleged herein, as well as those of Defendant's councils, troops, and leaders occurring at Defendant's direction, occurred after GSUSA's GIRL SCOUTS mark became distinctive within the State of New York and constitute dilution by blurring and dilution by tarnishment in violation of New York General Business Law § 360-1.

139. Defendant's acts and conduct will cause immediate and irreparable injury to GSUSA, to its goodwill and reputation, and to the public, and will continue to threaten such injury unless enjoined by this Court. GSUSA is therefore entitled to injunctive relief in New York under General Business Law § 360-1.

SEVENTH CAUSE OF ACTION

TORTIOUS INTERFERENCE WITH PROSPECTIVE ECONOMIC ADVANTAGE

140. GSUSA realleges and incorporates by reference herein each and every allegation of the foregoing paragraphs of this Complaint as if fully set forth herein.

141. Defendant's councils and GSUSA's councils occasionally attend the same recruitment events.

142. Defendant is aware that GSUSA has a prospective business relationship with the parents and girls who attend these recruitment events.

143. Defendant, by the acts described herein that illustrate a widespread and systematic course of conduct, intentionally interfered with those relationships by dishonest, unfair, and improper means. For example, Defendant's recruiters have recently told parents and girls that there "are no more Girl Scouts" or that the organizations have combined. These statements are dishonest, unfair, and improper because GSUSA is still in existence and Defendant cannot register girls for the GIRL SCOUTS program. Upon information and belief, these recruiters acted on behalf of Defendant or for the purpose of serving the Defendant's interest. Upon information and belief, as a result of Defendant's interference and/or knowledge of and failure to halt such systematic tortious behavior, girls have signed up for Defendant's program instead of GSUSA's program, causing significant harm to GSUSA's prospective business relationships with these individuals.

144. Likewise, GSUSA had a prospective business relationship with a retailer in Red Bluff, California to provide space to a Girl Scout council for the purpose of conducting Girl Scout activities. Defendant, knowing of this relationship, intentionally interfered with that relationship when it attempted to dissuade the retailer from providing booth space to the council on the basis that Defendant now serves both Boy Scouts and Girl Scouts. Upon information and belief, such dishonest, unfair, and improper statements interfered with the reservation of such booth space.

145. Upon information and belief, Defendant and its councils or leaders have made numerous other dishonest, unfair and improper statements for the purpose of intentionally and knowingly inducing parents and girls across the country to register with Defendant's programs instead of GSUSA's programs. Upon information and belief, GSUSA can only obtain information about these additional instances of dishonest, unfair, and improper actions through discovery.

PRAYER FOR RELIEF

WHEREFORE, GSUSA respectfully requests the following relief:

(a) That GSUSA be granted preliminary and permanent injunctive relief under 15 U.S.C. § 1051 *et seq.* and New York law specifically requiring that Defendant and all of its councils, troops, officers, leaders, agents, servants, representatives, employees, attorneys, parent and subsidiary corporations, assigns and successors in interest, and all other persons acting in concert or participation with them, or any of them, be preliminarily and permanently enjoined from: (i) using the GS Marks, or any confusingly similar variations thereof, in connection with the marketing, promotion, advertising, sale or rendering of any of Defendant's services, (ii) using the marks SCOUT, SCOUTS, SCOUTING, SCOUTS BSA, or any variation thereof, alone without an inherently distinctive or distinguishing term appearing immediately before it, in

connection with the marketing, promotion, advertising, sale or rendering of any of Defendant's services directed to girls; (iii) using any false designation of origin or any false description that can, or is likely to, mislead the public, or individual members thereof, to believe that any service distributed, sold, offered for sale, or advertised by Defendant is in any manner associated with or approved or sponsored by GSUSA; (iv) representing in any manner that Defendant or its councils or troops are endorsed or sponsored by GSUSA, or represent or work on behalf of GSUSA, or are affiliated or associated with GSUSA; and (v) any other infringing or misleading conduct discovered during the course of this action;

(b) That Defendant be ordered to provide training to all of its councils, troops, officers, leaders, agents, servants, representatives, employees, and volunteers to prevent confusion between the parties and their respective trademarks, including with respect to:

(i) Defendant's use of the marks SCOUT, SCOUTS, SCOUTING, SCOUTS BSA or variations thereof in a manner compliant with the injunction issued by this Court; (ii) Defendant's relationship with GSUSA; (iii) the GS Marks, and (iv) affirmative steps that must be taken to avoid or remediate instances of actual consumer confusion; and to provide GSUSA with a written report detailing such training;

(c) That Defendant be ordered to file a withdrawal with prejudice of Trademark Application Serial Nos. 87/906,407, 87/906,567, 87/882,226 with the PTO;

(d) That Defendant file with the Court, within ten (10) days from entry of the aforementioned injunction, a declaration signed under penalty of perjury certifying the manner in which Defendant has complied with the terms of the injunction;

(e) That Defendant is adjudged to have violated 15 U.S.C. § 1114(1) by infringing the GS Marks;

(f) That Defendant is adjudged to have violated 15 U.S.C. § 1125(a)(1) for unfairly competing against GSUSA and by using a false designation of origin for Defendant's services;

(g) That Defendant is adjudged to have violated 15 U.S.C. § 1125(c) by diluting the GIRL SCOUTS trademark;

(h) That judgment be entered in favor of GSUSA against Defendant to the effect that U.S. Reg. No. 4,865,183 is to be modified or partially cancelled, and ordering the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to make an entry on the records of the PTO limiting the identified services in such registration to programs for boys;

(i) That Defendant is adjudged to have engaged in illegal acts of common law trademark infringement, unfair competition, and passing off;

(j) That Defendant is adjudged to have violated New York General Business Law § 360-1 by diluting the GIRL SCOUTS trademark;

(k) That Defendant is adjudged liable for tortious interference with prospective economic advantage;

(l) That GSUSA be awarded damages in an amount sufficient to compensate it for harm caused by Defendant's acts;

(m) That this Court order an accounting of Defendant's profits earned as a result of Defendant's unlawful activities and disgorge all of said profits to GSUSA;

(n) That GSUSA be awarded three times Defendant's profits and three times GSUSA's damages suffered as a result of Defendant's willful, intentional, and deliberate acts in violation of the Lanham Act and New York law;

- (o) That GSUSA be awarded its attorneys' fees and costs in this action under 15 U.S.C. § 1117 as a result of Defendant's Lanham Act violations;
- (p) That GSUSA be granted prejudgment and post judgment interest; and
- (q) That GSUSA be granted such further relief as the Court may deem just and equitable.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38, GSUSA hereby respectfully demands a trial by jury of all issues triable of right by a jury.

Dated: New York, New York
November 6, 2018

Respectfully Submitted,

DORSEY & WHITNEY LLP

By: /s/ Bruce R. Ewing
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*Attorneys for Plaintiff
Girl Scouts of the United States of America*

EXHIBIT B

**UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

GIRL SCOUTS OF THE UNITED STATES
OF AMERICA,

Plaintiff,

v.

BOY SCOUTS OF AMERICA,

Defendant.

Case No. 1:18-cv-10287 (AKH)

ANSWER

Defendant Boy Scouts of America (the “BSA”) is one of the most iconic non-profit organizations in the United States, with more than 100 years of history as the nation’s foremost program of character development and values-based leadership training. The BSA has been using its registered and common law trademarks in SCOUTS and SCOUTING (among other marks) in connection with services for boys *and* girls for nearly 50 years. Despite this longstanding, wide-spread use, Plaintiff Girl Scouts of the United States of America (“GSUSA”) now seeks to prohibit the BSA from calling its own members SCOUTS—simply because the BSA has begun welcoming girls into two more of its youth programs. Thus, the core of GSUSA’s case goes to the question of whether the BSA’s use of its SCOUTS and SCOUTING marks in connection with offering services to all young people (as it has done for decades) somehow now infringes or dilutes GSUSA’s rights in its GIRL SCOUTS-related marks. It does not.

Moreover, the BSA’s decision to expand all of its program offerings to girls came after years of requests from families who wanted the option of the BSA’s character and leadership development programs for all of their children, both boys and girls. The step of welcoming girls

into all of the BSA's programs aligns the organization's offerings with the needs of today's families, who are busier than ever and want their daughters and sons to be able to participate in activities together. The BSA applauds every organization that builds character and leadership in children, including GSUSA, and believes that there is an opportunity for both organizations to serve girls and boys in local communities.

The BSA, by and through its undersigned counsel, for its Answer to the Complaint filed against it by GSUSA, states as follows:

INTRODUCTION

1. The BSA admits that the GSUSA has for many years provided a leadership program for girls, that millions of girls have participated in those programs and that the program goals are generally as stated in the second sentence of Paragraph 1. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1 of the Complaint and therefore denies them.

2. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Complaint and therefore denies them.

3. The BSA avers that it has long offered programs aimed at boys under the BOY SCOUTS trademark, and that the BOY SCOUTS trademark is a symbol of youth development programs that has been used for more than century. The BSA admits that the BSA uses the term SCOUTS alone as a mark. The BSA denies that GSUSA uses the term SCOUTS alone as a mark, and in fact, GSUSA has specifically instructed its professionals and volunteers not to do so. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 3 of the Complaint and therefore denies them.

4. The BSA denies the allegations of Paragraph 4 of the Complaint.

5. The BSA denies the allegations of Paragraph 5 of the Complaint.

6. The BSA denies that GSUSA has been damaged by any of the BSA's uses of the BSA's own trademarks, or that the BSA has engaged in any alleged misconduct, and avers that the BSA has worked proactively to differentiate its unique program offerings, and that any time the BSA has been made aware of an alleged concern of potential confusion, the BSA has immediately taken appropriate action. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 6 of the Complaint and therefore denies them.

7. The BSA admits that GSUSA has the right to use the trademark "GIRL SCOUTS." The BSA denies that it lacks the right to use its own SCOUTS mark in connection with services for girls, which it has been doing for nearly 50 years, and further avers that GSUSA has specifically instructed that its members should not be called SCOUTS alone, but rather should only be called GIRL SCOUTS. The BSA denies that it is using GSUSA's intellectual property, and further denies the remaining allegations of Paragraph 7 of the Complaint.

THE PARTIES

8. The BSA admits the allegations of Paragraph 8 of the Complaint.

9. The BSA admits the allegations of Paragraph 9 of the Complaint.

JURISDICTION AND VENUE

10. The allegations of Paragraph 10 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 10 of the Complaint.

11. The allegations of Paragraph 11 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 11 of the Complaint.

12. The allegations of Paragraph 12 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 12 of the Complaint.

13. The allegations of Paragraph 13 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 13 of the Complaint.

14. The allegations of Paragraph 14 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 14 of the Complaint.

15. The allegations of Paragraph 15 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 15 of the Complaint.

16. The allegations of Paragraph 16 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 16 of the Complaint.

FACTUAL BACKGROUND

17. The BSA admits the first sentence of Paragraph 17 and that GSUSA's mission is as stated in the last sentence of Paragraph 17. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 17 of the Complaint and therefore denies them.

18. The BSA admits that many millions of American women have participated in the GIRL SCOUTS program. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 18 of the Complaint and therefore denies them.

19. The BSA admits that Girl Scouts have been able to earn various badges over a broad ranges of skills and topics, that Girl Scouts have been able to participate in a variety of skill-based programs, and that Girl Scouts have been able to participate in the Girl Scout Cookie Program. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 19 of the Complaint and therefore denies them.

20. The BSA admits the first and second sentences of Paragraph 20. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 20 of the Complaint and therefore denies them.

21. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 21 of the Complaint and therefore denies them.

22. The BSA admits that girls may sign up for GSUSA by filling out forms online or in person. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 22 of the Complaint and therefore denies them.

23. The BSA admits the last sentence of Paragraph 23. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 23 of the Complaint and therefore denies them.

24. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 24 of the Complaint and therefore denies them.

25. The text of 36 U.S.C § 80305, a federal statute, speaks for itself. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 25 of the Complaint and therefore denies them.

26. The BSA admits Serial No. 89/000,078 exists in the PTO's search records. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 26 of the Complaint and therefore denies them.

27. The BSA admits that GSUSA holds multiple trademark registrations for its GIRL SCOUTS trademark, and that the text of those registrations speak for themselves, and avers that GSUSA does not hold any trademark registrations for SCOUT, SCOUTS or SCOUTING alone, without the word GIRL immediately preceding it. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 27 of the Complaint and therefore denies them.

28. The BSA denies that GSUSA has trademark rights in the marks SCOUTS or SCOUTING alone, based in part on the facts that (1) GSUSA has specifically instructed its professionals and volunteers not to use such marks, and (2) GSUSA does not hold any trademark registrations for SCOUT, SCOUTS or SCOUTING alone, without the word GIRL immediately preceding it. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 28 of the Complaint and therefore denies them.

29. The BSA admits that the GIRL SCOUTS trademark has been used in various media in the United States, including at www.girlscouts.org. The BSA is without knowledge or

information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 29 of the Complaint and therefore denies them.

30. The allegations of Paragraph 30 of the Complaint set forth legal conclusions to which no response is required, but to the extent a response is required, the BSA denies the allegations of Paragraph 30 of the Complaint.

31. The BSA admits that GSUSA has always offered its services and programs to girls. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 31 of the Complaint and therefore denies them.

32. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 32 of the Complaint and therefore denies them.

33. The BSA admits that it is a congressionally chartered corporation, and avers that it provides youth development services and programs for boys and girls under the BOY SCOUTS trademark and other BSA trademarks, which are offered through local councils licensed to use such trademarks. The BSA otherwise denies the allegations of Paragraph 33 of the Complaint.

34. The BSA admits that its congressional charter, 36 U.S.C. § 30902, reads in part that the purpose is “to promote, through organization, and cooperation with other agencies, the ability of boys to do things for themselves and others, to train them in scoutcraft, and to teach them patriotism, courage, self-reliance, and kindred virtues, using the methods that were in common use by boy scouts on June 15, 1916.”

35. The BSA admits that both it and the GSUSA are congressionally chartered, and that it is not endorsed or sponsored by, or affiliated with, GSUSA. The BSA is without

knowledge or information sufficient to form a belief as to the truth of the rest allegations contained in Paragraph 35 of the Complaint and therefore denies them.

36. The BSA admits that the parties have coexisted in the market place for decades. The BSA admits that it has offered youth development services and programs using the “SCOUT,” “SCOUTS,” and “SCOUTING” trademarks for both boy members and girl members of its programs for many decades and continues to do so today, both with and without the word BOY preceding those marks. The BSA denies the remaining allegations of Paragraph 36 of the Complaint, and specifically denies that GSUSA uses the “SCOUT,” “SCOUTS” and “SCOUTING” trademarks alone, in part due to the fact that GSUSA instructs its professionals and volunteers not to do so.

37. The BSA admits that GSUSA has always offered its services to girls, that the BSA has offered services to boys since 1910, and that the BSA has offered services to both boys and girls since 1971 in connection with its trademarks. The BSA admits that the statements in the two websites referenced in the footnote to Paragraph 37 were made by the BSA or its representatives in 2016 and that the statements in the Petition for Writ of Certiorari referenced in the footnote to Paragraph 37 were made by the BSA or its representatives in 1999, but denies that the BSA holds these beliefs today. The BSA otherwise denies the allegations of Paragraph 37 of the Complaint.

38. The content of the filing attached as Exhibit B speaks for itself. The BSA otherwise denies the allegations of Paragraph 38 of the Complaint.

39. The content of the filing attached as Exhibit C speaks for itself. The BSA otherwise denies the allegations of Paragraph 39 of the Complaint.

40. The BSA avers that: it has offered numerous programs for both girls and boys under its various trademarks for decades, including but not limited to the marks EXPLORER, SEA SCOUTS, STEM SCOUTS (pilot program) and VENTURING; all of these co-ed programs also use the SCOUT and SCOUTING marks alone in various contexts; information about these programs has been located at www.scouting.org for many years; and the uniforms, accessories and handbooks for these programs are available at www.scoutshop.org. The BSA specifically denies that it has not used the marks SCOUT and SCOUTING alone in connection with programs for girls, and otherwise denies the remaining allegations of Paragraph 40 of the Complaint.

41. The content of the letter attached as Exhibit D speaks for itself. The BSA otherwise denies the allegations of Paragraph 41 of the Complaint.

42. The content of the letter attached as Exhibit E speaks for itself. The BSA otherwise denies the allegations of Paragraph 42 of the Complaint.

43. The BSA denies the allegations of Paragraph 43 of the Complaint.

44. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 44 of the Complaint.

45. The content of the document attached as Exhibit F, which the BSA published, speaks for itself. The BSA otherwise denies the allegations of Paragraph 45 of the Complaint.

46. The content of the document attached as Exhibit G, which the BSA published, speaks for itself. The BSA otherwise denies the allegations of Paragraph 46 of the Complaint.

47. The BSA admits that it issues charters to local councils and that the local councils properly identified in the Complaint are chartered by the BSA, and further admits that local councils, members and leaders pay charter or registration fees to the BSA. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 47 of the Complaint.

48. The content of the letter attached as Exhibit G, which the BSA authored, speaks for itself. The BSA otherwise denies the allegations of Paragraph 48 of the Complaint.

49. The BSA avers that it is currently welcoming girls into two more of its programs, and that such programs utilize the BSA trademarks, including the SCOUTS and SCOUTING marks. The content of the website attached as Exhibit H speaks for itself. The BSA otherwise denies the allegations of Paragraph 49 of the Complaint.

50. The BSA avers that it recently announced a new SCOUT ME IN campaign, and that it uses the BSA family of trademarks in connection with its Cub Scouts and Boy Scouts programs. The content of the BSA press release attached as Exhibit I speaks for itself. The BSA otherwise denies the allegations of Paragraph 50 of the Complaint.

51. The BSA admits that SCOUTS BSA is the name of the BSA's program for youth between the ages of 11 and 17. The contents of the BSA publication attached as Exhibit J speaks for itself. The BSA otherwise denies the allegations of Paragraph 51 of the Complaint.

52. The BSA admits that it has distributed marketing materials (including print and video) referring to both girl members and boy members as Scouts, consistent with the BSA's family of trademarks and its Language of Scouting.

53. The BSA admits that it has filed trademark applications that build upon the BSA's existing brand, including but not limited to applications for the SCOUTS BSA marks (Serial No. 87/906,567 and 87/906,407) and for the SCOUT LIFE mark (Serial No. 87/882,226), which applications speak for themselves. The BSA otherwise denies the allegations of Paragraph 53.

54. The BSA admits the allegations of Paragraph 54 of the Complaint, and avers that the text of its SCOUT registration speaks for itself.

55. The BSA denies the allegations of Paragraph 55 of the Complaint.

56. The BSA denies the allegations of Paragraph 56 of the Complaint.

57. The BSA denies that it authorized the material referenced in Paragraph 57 of the Complaint, the contents of which speak for itself. The BSA otherwise denies the allegations of Paragraph 57 of the Complaint.

58. The BSA denies that it authorized the material referenced in Paragraph 58 of the Complaint, the contents of which speak for itself. The BSA further avers that a local GSUSA representative specifically requested, approved or condoned this material. The BSA otherwise denies the allegations of Paragraph 58 of the Complaint.

59. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 59 of the Complaint and therefore denies them.

60. The BSA denies that it authorized the material referenced in Paragraph 60 of the Complaint, the contents of which speak for itself. The BSA further avers that the public sign referenced in Paragraph 60 of the Complaint refers to both the BSA and to the GSUSA (not to

girl members of the BSA). The BSA otherwise denies the allegations of Paragraph 60 of the Complaint.

61. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 61 of the Complaint and therefore denies them.

62. The BSA denies that it authorized the material referenced in Paragraph 62 of the Complaint, the contents of which speak for itself. The BSA otherwise denies the allegations of Paragraph 62 of the Complaint.

63. The BSA denies that it authorized the material referenced in Paragraph 63 of the Complaint, the contents of which speak for itself. The BSA otherwise denies the allegations of Paragraph 63 of the Complaint.

64. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 64 of the Complaint and therefore denies them.

65. The BSA denies that it authorized the material referenced in Paragraph 65 of the Complaint, the contents of which speak for itself. The BSA further avers that local GSUSA representatives specifically requested, approved or condoned this material, which references GSUSA, not girl members of the BSA. The BSA otherwise denies the allegations of Paragraph 65 of the Complaint.

66. The BSA denies that it authorized the material referenced in Paragraph 66 of the Complaint, the contents of which speak for itself. As to the programming in Chicago, the BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 66 of the Complaint and therefore denies them. The BSA otherwise denies the remaining allegations of Paragraph 66 of the Complaint.

67. The BSA admits that approximately four years ago, the image referenced in Exhibit 8 appeared in the BSA's Brand Center. The BSA otherwise denies the remaining allegations of Paragraph 67 of the Complaint.

68. The contents of the BSA correspondence attached as Exhibit K speaks for itself. The BSA otherwise denies the remaining allegations of Paragraph 68 of the Complaint.

69. The BSA admits that Exhibit L contains true and accurate copies of correspondence received by the BSA from GSUSA. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Exhibit L or the remaining allegations contained in Paragraph 69 of the Complaint and therefore denies them. The BSA further denies that it has engaged in any unfair business practices.

70. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 70 of the Complaint and therefore denies them.

71. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 71 of the Complaint and therefore denies them.

72. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 72 of the Complaint and therefore denies them.

73. The BSA admits that a third party agency, without authorization from the BSA, added the term GIRL SCOUT to a list of advertising keywords, and that after GSUSA complained, the keywords were removed. The BSA denies the remaining allegations of Paragraph 73 of the Complaint.

74. The BSA denies the allegations of Paragraph 74 of the Complaint.

75. The BSA denies the allegations of Paragraph 75 of the Complaint.

76. The BSA denies the allegations of Paragraph 76 of the Complaint.

77. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 77 of the Complaint and therefore denies them.

78. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 78 of the Complaint and therefore denies them.

79. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 79 of the Complaint and therefore denies them.

80. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 80 of the Complaint and therefore denies them.

81. The BSA denies that it authorized the material referenced in Paragraph 81 of the Complaint, the contents of which speak for itself. The BSA otherwise denies the remaining allegations of Paragraph 81 of the Complaint.

82. The BSA denies that it authorized the wording in the material referenced in Exhibits N and O of the Complaint, the contents of which speak for themselves. The BSA otherwise denies the remaining allegations of Paragraph 82 of the Complaint.

83. The BSA denies the allegations of Paragraph 83 of the Complaint.

84. The BSA denies the allegations of Paragraph 84 of the Complaint.

85. The BSA denies the allegations of Paragraph 85 of the Complaint.

86. The BSA admits that it has received some unfavorable publicity, but avers that it has also received positive publicity for having adopted some of the strongest youth protection policies that can be found in any youth serving organization, including: ongoing mandatory youth protection education for all volunteers, parents, and Scouts; a formal leader selection process that includes criminal background checks and other screening efforts; as well as policies and procedures mandating a “two-deep” leadership policy, which requires at least two adults be

present with youth at all times; prompt mandatory reporting to the authorities of any allegation or suspicion of abuse; and, a database system that is recommended by experts to prevent individuals from re-registering in Scouting who were removed because they do not meet the BSA's standards or because of known or suspected abuse or other misconduct, either inside or outside the organization. The BSA denies that any such BSA publicity, either positive or negative, has been associated with the GSUSA. The BSA otherwise denies the remaining allegations of Paragraph 86 of the Complaint.

87. The BSA denies the allegations of Paragraph 87 of the Complaint.

88. The BSA denies the allegations of Paragraph 88 of the Complaint.

FIRST CAUSE OF ACTION

FEDERAL TRADEMARK INFRINGEMENT UNDER 15 U.S.C. § 1114(1)

89. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

90. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 90 of the Complaint and therefore denies them.

91. The BSA denies the allegations of Paragraph 91 of the Complaint.

92. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 92 of the Complaint.

93. The BSA denies the allegations of Paragraph 93 of the Complaint.

94. The BSA admits that the BSA is not affiliated or associated with GSUSA. The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 94 of the Complaint and therefore denies them.

95. The BSA denies the allegations of Paragraph 95 of the Complaint.

96. The BSA denies the allegations of Paragraph 96 of the Complaint.

97. The BSA denies the allegations of Paragraph 97 of the Complaint.

98. The BSA denies the allegations of Paragraph 98 of the Complaint.

99. The BSA denies the allegations of Paragraph 99 of the Complaint.

100. The BSA denies the allegations of Paragraph 100 of the Complaint.

SECOND CAUSE OF ACTION

FEDERAL UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. § 1125(a)

101. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

102. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 102 of the Complaint and therefore denies them.

103. The BSA denies the allegations of Paragraph 103 of the Complaint.

104. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 104 of the Complaint.

105. The BSA denies the allegations of Paragraph 105 of the Complaint.

106. The BSA admits that the BSA is not affiliated or associated with GSUSA. The BSA further avers that the parties have participated in countless joint events for many decades, including with GSUSA's consent or at GSUSA's initiative, and that GSUSA itself has made various efforts to draw associations between itself and the BSA in order to trade off of the BSA's good name and reputation, including by claiming that "[t]he Girl Scout Gold Award is the highest and most prestigious award in Girl Scouting, comparable to the Boy Scouts of America's Eagle Scout." https://www.girlscouts.org/content/dam/girlscouts-gsusa/forms-and-documents/about-girl-scouts/advocacy/2016_Girl_Scout_Gold_Award_fact_sheet.pdf (last visited February 5, 2019). The BSA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 106 of the Complaint and therefore denies them.

107. The BSA denies the allegations of Paragraph 107 of the Complaint.

108. The BSA denies the allegations of Paragraph 108 of the Complaint.

109. The BSA denies the allegations of Paragraph 109 of the Complaint.

110. The BSA denies the allegations of Paragraph 110 of the Complaint.

111. The BSA denies the allegations of Paragraph 111 of the Complaint.

112. The BSA denies the allegations of Paragraph 112 of the Complaint.

THIRD CAUSE OF ACTION

FEDERAL TRADEMARK DILUTION UNDER 15 U.S.C. § 1125(C)

113. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

114. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 114 of the Complaint and therefore denies them.

115. The BSA denies the allegations of Paragraph 115 of the Complaint.

116. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 116 of the Complaint.

117. The BSA denies the allegations of Paragraph 117 of the Complaint.

118. The BSA denies the allegations of Paragraph 118 of the Complaint.

119. The BSA denies the allegations of Paragraph 119 of the Complaint.

120. The BSA denies the allegations of Paragraph 120 of the Complaint.

121. The BSA denies the allegations of Paragraph 121 of the Complaint.

FOURTH CAUSE OF ACTION

MODIFICATION OR PARTIAL CANCELLATION OF REGISTRATION

122. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

123. The BSA admits that it owns the U.S. trademark registration for the SCOUT mark (Reg. No. 4,865,183). The BSA denies the remaining allegations of Paragraph 123 of the Complaint.

124. The BSA denies the allegations of Paragraph 124 of the Complaint.

125. The BSA denies the allegations of Paragraph 125 of the Complaint.

126. The BSA denies the allegations of Paragraph 126 of the Complaint.

FIFTH CAUSE OF ACTION

**COMMON LAW TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND PASSING OFF**

127. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

128. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 128 of the Complaint and therefore denies them.

129. The BSA denies the allegations of Paragraph 129 of the Complaint.

130. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 130 of the Complaint.

131. The BSA denies the allegations of Paragraph 131 of the Complaint.

132. The BSA denies the allegations of Paragraph 132 of the Complaint.

133. The BSA denies the allegations of Paragraph 133 of the Complaint.

SIXTH CAUSE OF ACTION

TRADEMARK DILUTION UNDER NEW YORK GENERAL BUSINESS LAW § 360-L

134. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

135. The BSA is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 135 of the Complaint and therefore denies them.

136. The BSA denies the allegations of Paragraph 136 of the Complaint.

137. The BSA avers that its local councils are authorized to use the BSA family of trademarks by virtue of charters and bylaws granted by the BSA, and further avers that local councils, units and leaders are authorized by those charters to offer the BSA's programs in accordance with their charter, bylaws, and registration in accordance with the applicable publications of the BSA. The BSA otherwise denies the allegations of Paragraph 137 of the Complaint.

138. The BSA denies the allegations of Paragraph 138 of the Complaint.

139. The BSA denies the allegations of Paragraph 139 of the Complaint.

SEVENTH CAUSE OF ACTION

TORTIOUS INTERFERENCE WITH PROSPECTIVE ECONOMIC ADVANTAGE

140. The BSA incorporates by reference its answers to every allegation above as if fully restated herein.

141. The BSA admits the allegations of Paragraph 141 of the Complaint.

142. The BSA denies the allegations of Paragraph 142 of the Complaint.

143. The BSA denies the allegations of Paragraph 143 of the Complaint.

144. The BSA denies the allegations of Paragraph 144 of the Complaint.

145. The BSA denies the allegations of Paragraph 145 of the Complaint.

PRAYER FOR RELIEF

The BSA denies that GSUSA is entitled to any of the relief demanded in the Prayer for Relief. The BSA respectfully requests a judgment in its favor and dismissing Plaintiff's Complaint in its entirety with prejudice. The BSA reserves the right to seek all fees and costs, including but not limited to reasonable attorneys' fees and costs pursuant to 15 U.S.C. §1117(a), pre- and post-judgment interest to the fullest extent available, and any other and further relief as the Court deems just, equitable and proper.

AFFIRMATIVE DEFENSES

The BSA reserves the right to amend its defenses or assert additional defenses as warranted by discovery in this action.

**FIRST DEFENSE
(FAILURE TO STATE A CAUSE OF ACTION)**

The Complaint fails to state a claim upon which relief can be granted.

**SECOND DEFENSE
(FIRST AMENDMENT)**

Plaintiff's claims and/or the remedies sought are barred, in whole or in part, by the First Amendment to the United States Constitution and by the Constitution of the State of New York and other states, including because Plaintiff's claims infringe upon the BSA's right to freedom of association in connection with its extant trademark rights.

**THIRD DEFENSE
(STANDING)**

Plaintiff's claims are barred, in whole or in part, for lack of standing to the extent they are based on alleged infringement of marks for which Plaintiff does not or did not own or control the exclusive right allegedly infringed at the time of the alleged infringement. Plaintiff does not use the marks SCOUT, SCOUTS, or SCOUTING alone in connection with its programs. Plaintiff has also repeatedly and publicly instructed its volunteers and professionals not to use the marks SCOUT, SCOUTS, or SCOUTING alone without the "GIRL" prefix, including because the BSA has rights in these marks.

**FOURTH DEFENSE
(ABANDONMENT)**

Some of the trademarks on which Plaintiff relies, including SCOUT, SCOUTS and SCOUTING, have been forfeited or abandoned by Plaintiff. For many years, Plaintiff has

repeatedly and publicly instructed its volunteers and professionals not to use the marks SCOUT, SCOUTS, or SCOUTING alone without the “GIRL” prefix, including because the BSA has rights in these marks.

**FIFTH DEFENSE
(LACHES)**

Plaintiff’s claims and/or the remedies sought are barred, in whole or in part, by the doctrines of laches, including because the BSA has been using its family of trademarks (including SCOUT, SCOUTS, SCOUTING) in connection with services for girls for nearly 50 years, including but not limited to the BSA’s co-ed Exploring, Venturing, Sea Scouts, and STEM Scouts programs. Although Plaintiff knew or should have known of the BSA’s use of these marks in connection with programs for girls for decades, Plaintiff slept on its purported rights until now, and any such enforcement would prejudice the BSA.

**SIXTH DEFENSE
(WAIVER, ESTOPPEL, ACQUIESCENCE)**

Plaintiff’s claims and/or the remedies sought are barred, in whole or in part, by the doctrines of waiver, estoppel or acquiescence. The BSA has been using its family of trademarks (including SCOUT, SCOUTS, SCOUTING) in connection with services for girls for nearly 50 years, including but not limited to the BSA’s co-ed Exploring, Venturing, Sea Scouts, and STEM Scouts programs. However, Plaintiff knowingly and intentionally has slept on its purported rights until now and has repeatedly and publicly instructed its volunteers and professionals not to use the marks SCOUT, SCOUTS, or SCOUTING alone without the “GIRL” prefix, including because the BSA has rights in these marks, and any such enforcement would prejudice the BSA. Moreover, certain other alleged references to these marks were authorized, approved, or

condoned by Plaintiff's representatives, and Plaintiff intentionally relinquished any purported rights.

SEVENTH DEFENSE
(TRADEMARK MISUSE)

Plaintiff's claims and/or the remedies sought are barred, in whole or in part, because Plaintiff has engaged in trademark misuse. Plaintiff does not use the marks SCOUT, SCOUTS, or SCOUTING alone, but seeks to prevent the BSA from continuing to use these marks, which the BSA has used as part of its family of trademarks in connection with services for girls for nearly 50 years.

EIGHTH DEFENSE
(FAIR USE)

Plaintiff's claims and/or the remedies sought are barred, in whole or in part, by the doctrine of trademark fair use (15 U.S.C. § 1115(b)(4)), nominative fair use, and any other applicable limitation on exclusive rights offered under the Lanham Act. To the extent Plaintiff has provided sufficient information to investigate specific allegations of literal infringement, certain of the instances are actual references to Plaintiff or are otherwise instances of classic or descriptive fair uses, including to refer to or describe the BSA or its goods or services.

NINTH DEFENSE
(FEDERAL CHARTER)

Plaintiff's claims and/or the remedies sought are barred, in whole or in part, pursuant to 36 U.S.C. § 30905, which provides in part that the BSA "has the exclusive right to use emblems, badges, descriptive or designating marks, and the words or phrases that the [BSA] adopts." The BSA has adopted the marks SCOUT, SCOUTS, and SCOUTING and used them in connection with services for girls for nearly 50 years, including but not limited to the BSA's co-ed Exploring, Venturing, Sea Scouts, and STEM Scouts programs.

**TENTH DEFENSE
(UNCLEAN HANDS)**

Plaintiff's claims and/or the remedies sought are barred, in whole or in part, by the doctrine of unclean hands, including but not limited to the extent that Plaintiff's claims are premised on asserted ownership of or rights in marks that Plaintiff has knowingly abandoned, including SCOUT, SCOUTS and SCOUTING alone, without the word GIRL immediately preceding it.

DEMAND FOR JURY TRIAL

The BSA demands a jury trial on all issues so triable pursuant to Fed. R. Civ. P. 38(b).

Dated: February 8, 2019

Respectfully submitted,

By: /s/ Rachel Kassabian

Rachel Kassabian (*pro hac vice*)

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Attorneys for Defendant Boy Scouts of America

EXHIBIT C

**U.S. District Court
Southern District of New York (Foley Square)
CIVIL DOCKET FOR CASE #: 1:18-cv-10287-AKH**

Girl Scouts of the United States of America v. Boy Scouts of America
Assigned to: Judge Alvin K. Hellerstein
Cause: 15:1114 Trademark Infringement (Lanham Act)

Date Filed: 11/06/2018
Jury Demand: Both
Nature of Suit: 840 Trademark
Jurisdiction: Federal Question

Plaintiff

Girl Scouts of the United States of America

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V.

Defendant

Boy Scouts of America

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Date Filed	#	Docket Text
11/06/2018	<u>1</u>	COMPLAINT against Boy Scouts of America. (Filing Fee \$ 400.00, Receipt Number ANYSDC-15870914) Document filed by Girl Scouts of the United States of America. (Attachments: # <u>1</u> Exhibit A, # <u>2</u> Exhibit B, # <u>3</u> Exhibit C, # <u>4</u> Exhibit D, # <u>5</u> Exhibit E, # <u>6</u> Exhibit F, # <u>7</u> Exhibit G, # <u>8</u> Exhibit H, # <u>9</u> Exhibit I, # <u>10</u> Exhibit J, # <u>11</u> Exhibit K, # <u>12</u> Exhibit L, # <u>13</u> Exhibit M, # <u>14</u> Exhibit N, # <u>15</u> Exhibit O)(Ewing, Bruce) (Entered: 11/06/2018)
11/06/2018	<u>2</u>	CIVIL COVER SHEET filed. (Ewing, Bruce) (Entered: 11/06/2018)
11/06/2018	<u>3</u>	RULE 7.1 CORPORATE DISCLOSURE STATEMENT. No Corporate Parent. Document filed by Girl Scouts of the United States of America.(Ewing, Bruce) (Entered: 11/06/2018)
11/06/2018	<u>4</u>	REQUEST FOR ISSUANCE OF SUMMONS as to Boy Scouts of America, re: <u>1</u> Complaint,. Document filed by Girl Scouts of the United States of America. (Ewing, Bruce) (Entered: 11/06/2018)
11/06/2018	<u>5</u>	NOTICE OF APPEARANCE by Amanda Mary Prentice on behalf of Girl Scouts of the United States of America. (Prentice, Amanda) (Entered: 11/06/2018)
11/06/2018	<u>6</u>	AO 120 FORM TRADEMARK – NOTICE OF SUBMISSION BY ATTORNEY. AO 120 Form Patent/Trademark for case opening submitted to court for review.(Prentice, Amanda) (Entered: 11/06/2018)
11/06/2018	<u>7</u>	NOTICE OF APPEARANCE by Fara S. Sunderji on behalf of Girl Scouts of the United States of America. (Sunderji, Fara) (Entered: 11/06/2018)
11/07/2018		CASE OPENING INITIAL ASSIGNMENT NOTICE: The above–entitled action is assigned to Judge Alvin K. Hellerstein. Please download and review the Individual Practices of the assigned District Judge, located at http://nysd.uscourts.gov/judges/District . Attorneys are responsible for providing courtesy copies to judges where their Individual Practices require such. Please download and review the ECF Rules and Instructions, located at http://nysd.uscourts.gov/ecf_filing.php . (pne) (Entered: 11/07/2018)
11/07/2018		Magistrate Judge Ona T. Wang is so designated. Pursuant to 28 U.S.C. Section 636(c) and Fed. R. Civ. P. 73(b)(1) parties are notified that they may consent to proceed before a United States Magistrate Judge. Parties who wish to consent may access the necessary form at the following link: http://nysd.uscourts.gov/forms.php . (pne) (Entered: 11/07/2018)
11/07/2018		Case Designated ECF. (pne) (Entered: 11/07/2018)
11/07/2018	<u>8</u>	ELECTRONIC SUMMONS ISSUED as to Boy Scouts of America. (pne) (Entered: 11/07/2018)
11/07/2018	<u>9</u>	AO 120 FORM TRADEMARK – CASE OPENING – SUBMITTED. In compliance with the provisions of 15 U.S.C. 1116, the Director of the U.S. Patent and Trademark Office is hereby advised that a court action has been filed on the following trademark(s) in the U.S. District Court Southern District of New York. Director of the U.S. Patent and Trademark Office electronically notified via Notice of Electronic Filing (NEF). (pne) (Entered: 11/07/2018)
11/13/2018	<u>10</u>	NOTICE OF COURT CONFERENCE: Initial Conference set for 1/25/2019 at 10:00 AM in Courtroom 14D, 500 Pearl Street, New York, NY 10007 before Judge Alvin K. Hellerstein. It is Ordered that counsel to whom this Order is sent is responsible for

		faxing a copy to all counsel and retaining verification of such in the case file. Do not fax such verification to Chambers. Please include telephone numbers and fax numbers on all documents submitted to the Court. (As further set forth in this order) (Signed by Judge Alvin K. Hellerstein on 11/13/2018) (ne) (Entered: 11/13/2018)
12/10/2018	<u>11</u>	AFFIDAVIT OF SERVICE of Summons and Complaint,. Boy Scouts of America served on 12/10/2018, answer due 12/31/2018. Service was accepted by Steven P. McGowan. Document filed by Girl Scouts of the United States of America. (Ewing, Bruce) (Entered: 12/10/2018)
12/27/2018	<u>12</u>	FILING ERROR – DEFICIENT DOCKET ENTRY – MOTION for Rachel Marie Kassabian to Appear Pro Hac Vice . Filing fee \$ 200.00, receipt number ANYSDC–16111846. Motion and supporting papers to be reviewed by Clerk's Office staff. Document filed by Boy Scouts of America. (Attachments: # <u>1</u> Declaration of Rachel Kassabian, # <u>2</u> Exhibit A – Certificate of Good Standing, # <u>3</u> Proposed Order)(Kassabian, Rachel) Modified on 12/27/2018 (wb). (Entered: 12/27/2018)
12/27/2018		>>>NOTICE REGARDING DEFICIENT MOTION TO APPEAR PRO HAC VICE. Notice to RE–FILE Document No. <u>12</u> MOTION for Rachel Marie Kassabian to Appear Pro Hac Vice . Filing fee \$ 200.00, receipt number ANYSDC–16111846. Motion and supporting papers to be reviewed by Clerk's Office staff... The filing is deficient for the following reason(s): missing Certificate of Good Standing from Supreme Court of California;. Re–file the motion as a Motion to Appear Pro Hac Vice – attach the correct signed PDF – select the correct named filer/filers – attach valid Certificates of Good Standing issued within the past 30 days – attach Proposed Order.. (wb) (Entered: 12/27/2018)
12/27/2018	<u>13</u>	STIPULATION AND ORDER: IT TS HEREBY STIPULATED AND AGREED by and between the Parties that the deadline for Defendant Boy Scouts of America to respond to the Complaint is extended from January 2, 2019 to and including January 18, 2019. SO ORDERED. Boy Scouts of America answer due 1/18/2019. (Signed by Judge Alvin K. Hellerstein on 12/27/2018) (ne) (Entered: 12/27/2018)
12/27/2018	<u>14</u>	MOTION for Rachel Marie Kassabian to Appear Pro Hac Vice . Filing fee \$ 200.00, receipt number ANYSDC–16113553. Motion and supporting papers to be reviewed by Clerk's Office staff. Document filed by Boy Scouts of America. (Attachments: # <u>1</u> Declaration of Rachel Kassabian, # <u>2</u> Exhibit A – Certificate of Good Standing, # <u>3</u> Proposed Order)(Kassabian, Rachel) (Entered: 12/27/2018)
12/28/2018		>>>NOTICE REGARDING PRO HAC VICE MOTION. Regarding Document No. <u>14</u> MOTION for Rachel Marie Kassabian to Appear Pro Hac Vice . Filing fee \$ 200.00, receipt number ANYSDC–16113553. Motion and supporting papers to be reviewed by Clerk's Office staff.. The document has been reviewed and there are no deficiencies. (jc) (Entered: 12/28/2018)
01/02/2019	<u>15</u>	ORDER FOR ADMISSION PRO HAC VICE ON WRITTEN MOTION granting <u>14</u> Motion for Rachel Marie Kassabian to Appear Pro Hac Vice. (Signed by Judge Alvin K. Hellerstein on 1/2/2019) (ne) (Entered: 01/02/2019)
01/02/2019	<u>16</u>	NOTICE OF APPEARANCE by Rachel Marie Kassabian on behalf of Boy Scouts of America. (Kassabian, Rachel) (Entered: 01/02/2019)
01/15/2019	<u>17</u>	ENDORSED LETTER addressed to Judge Alvin K. Hellerstein from Rachel Kassabian dated 1/14/2019 re: We respectfully request an extension of time to respond to the Complaint. ENDORSEMENT: So ordered. Boy Scouts of America answer due 1/23/2019. (Signed by Judge Alvin K. Hellerstein on 1/15/2019) (ne) (Entered: 01/15/2019)
01/23/2019	<u>18</u>	MOTION to Dismiss . Document filed by Boy Scouts of America. Responses due by 2/6/2019(Kassabian, Rachel) (Entered: 01/23/2019)
01/23/2019	<u>19</u>	MEMORANDUM OF LAW in Support re: <u>18</u> MOTION to Dismiss . . Document filed by Boy Scouts of America. (Kassabian, Rachel) (Entered: 01/23/2019)
01/23/2019	<u>20</u>	DECLARATION of Rachel Kassabian in Support re: <u>18</u> MOTION to Dismiss .. Document filed by Boy Scouts of America. (Attachments: # <u>1</u> Exhibit A, # <u>2</u> Exhibit B, # <u>3</u> Exhibit C, # <u>4</u> Exhibit D, # <u>5</u> Exhibit E)(Kassabian, Rachel) (Entered: 01/23/2019)

		01/23/2019)
01/24/2019	<u>21</u>	NOTICE OF APPEARANCE by Todd Steven Anten on behalf of Boy Scouts of America. (Anten, Todd) (Entered: 01/24/2019)
01/24/2019	<u>22</u>	NOTICE OF APPEARANCE by Jessica Anne Rose on behalf of Boy Scouts of America. (Rose, Jessica) (Entered: 01/24/2019)
01/25/2019		Minute Entry for proceedings held before Judge Alvin K. Hellerstein: Initial Pretrial Conference held on 1/25/2019, (Status Conference set for 10/25/2019 at 10:00 AM in Courtroom 14D, 500 Pearl Street, New York, NY 10007 before Judge Alvin K. Hellerstein.). (Jones, Brigitte) (Entered: 01/25/2019)
02/01/2019	<u>23</u>	LETTER addressed to Judge Alvin K. Hellerstein from Ewing, Bruce dated 2/1/2019 re: Entry of Order. Document filed by Girl Scouts of the United States of America.(Prentice, Amanda) (Entered: 02/01/2019)
02/01/2019	<u>24</u>	LETTER addressed to Judge Alvin K. Hellerstein from Rachel Kassabian dated February 1, 2019 re: Plaintiff's Letter of February 1, 2019. Document filed by Boy Scouts of America.(Kassabian, Rachel) (Entered: 02/01/2019)
02/01/2019	<u>25</u>	RULE 26(f) DISCOVERY PLAN REPORT.Document filed by Girl Scouts of the United States of America. (Attachments: # <u>1</u> Proposed Case Management Plan)(Prentice, Amanda) (Entered: 02/01/2019)
02/08/2019	<u>26</u>	RULE 7.1 CORPORATE DISCLOSURE STATEMENT. No Corporate Parent. Document filed by Boy Scouts of America.(Kassabian, Rachel) (Entered: 02/08/2019)
02/08/2019	<u>27</u>	ANSWER to <u>1</u> Complaint, with JURY DEMAND. Document filed by Boy Scouts of America.(Kassabian, Rachel) (Entered: 02/08/2019)
02/12/2019	<u>28</u>	CIVIL CASE MANAGEMENT PLAN: The case is to be tried to a jury. Discovery due by 9/25/2019. Joinder of Parties due by 3/1/2019. Amended Pleadings due by 4/1/2019. Case Management Conference set for 10/25/2019 at 10:00 AM before Judge Alvin K. Hellerstein. Defendant's Answer shall be filed on or before 2/8/2019. Deposition due by 9/25/2019. (Signed by Judge Alvin K. Hellerstein on 2/11/2019) (ne) (Entered: 02/12/2019)
03/05/2019	<u>29</u>	LETTER addressed to Judge Alvin K. Hellerstein from Bruce R. Ewing dated March 5, 2019 re: request for an order closing out defendant's motion to dismiss. Document filed by Girl Scouts of the United States of America.(Ewing, Bruce) (Entered: 03/05/2019)
03/06/2019	<u>30</u>	MEMO ENDORSEMENT on <u>29</u> terminating <u>18</u> Motion to Dismiss. ENDORSEMENT: So ordered. The Clerk is respectfully directed to terminate the motion at ECF No. 18. (Signed by Judge Alvin K. Hellerstein on 3/5/2019) (ne) (Entered: 03/06/2019)
03/20/2019	<u>31</u>	PROPOSED PROTECTIVE ORDER. Document filed by Girl Scouts of the United States of America. (Ewing, Bruce) (Entered: 03/20/2019)
03/21/2019	<u>32</u>	STIPULATED PROTECTIVE ORDER AND PROTOCOL FOR ELECTRONICALLY STORED INFORMATION...regarding procedures to be followed that shall govern the handling of confidential material...IT IS SO ORDERED. (Signed by Judge Alvin K. Hellerstein on 3/21/2019) (ne) (Entered: 03/21/2019)