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

Proceeding no.	91291363
Party	Defendant Toro International, LLC
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Attachments	Toro Opposition to MTC.pdf(266850 bytes)

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

In the Matter of Application Serial No.: 97/825,971 For the mark: QUEER SCOUT Published: January 9, 2024	Opposition No. 91291363
Boy Scouts of America, Opposer, v. Toro International, LLC, Applicant.	

APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS

Toro International, LLC ("Applicant"), by and through its undersigned counsel, hereby responds in opposition to Opposer Boy Scouts of America's ("Opposer") MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS ("Motion to Compel"), and respectfully requests that the Board deny the Motion to Compel in its entirety. In furtherance thereof, Applicant states as follows:

I. Introduction

Opposer's Motion to Compel is procedurally unnecessary and misleading. Opposer seeks to characterize Applicant's communications and actions as made in bad faith, eager to ascribe

malintent where none exists. Applicant has acted in good faith in discovery, has communicated its willingness to provide discovery, and informed Opposer's counsel of Applicant's intent to imminently file a motion for summary judgment based on evidence that is publicly available to both parties for purposes of judicial efficiency. Opposer's counsel refused to engage in meaningful discussion with Applicant's counsel regarding the prospective merits or procedural efficiencies of Applicant's intended motion and did not put forth additional effort toward prospectively resolving or deferring the dispute in light of the same. Instead, Opposer rushed to file the Motion to Compel to delay filing of Applicant's planned motion. Opposer's generalized demand for further discovery is premature and unwarranted under the circumstances, serving only to delay and multiply these proceedings unnecessarily.

II. Relevant Factual and Procedural Background

Applicant does not dispute the general timeline and substance of communications set forth in Opposer's Motion to Compel or the supporting DECLARATION OF ATTORNEY MELISSA E. SCOTT IN SUPPORT OF OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS (27 TTABVUE at Exh. 1) ("Scott Decl."). Rather, Applicant disputes and objects to Opposer's characterization and inferences regarding Applicant's intent and bad faith. Moreover, Applicant submits that Opposer's Motion to Compel was filed as a procedural maneuver to delay Applicant's filing of its potentially dispositive motion.

III. Legal Argument

a. Opposer's Effort to Resolve the Dispute did not Meet the Requisite Standard

A motion to compel discovery must be supported by a written statement from the moving party showing that they have made a *good faith effort* to resolve the issues with the other party, but that the parties were unable to resolve their differences. *See* Trademark Rule 2.120(f), 37 CFR § 2.120(f); TBMP § 523.02 (2025). The Board has explained that one purpose of this rule is to avoid burdening the Board with ruling on motions to compel where the parties can resolve their discovery disputes if they make a good faith effort to do so. *See MacMillan Bloedel Limited v. Arrow-M Corp*., 203 USPQ 952, 953-954 (TTAB 1979).

The Board has clarified that "[t]he purpose of the conference requirement is to promote a *frank exchange between counsel* to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought." *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis supplied), *quoting Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988).

The Board has further explained that "the good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute. Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute." *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1083-1084. (TTAB 2014).

Here, the record does not reflect an unresolvable situation. Applicant is not unwilling to produce documents or to confer and reach agreement with Opposer regarding the number of document requests. *See* accompanying Declaration of Jeremy Kapteyn ("Kapteyn Decl.") attached as Exhibit 1, ¶¶ 8-10. Rather, Applicant proposed to defer resolution of the discovery dispute

regarding information that would not be relevant to the dispute should Applicant's motion for summary judgment be granted by the Board. *Id.* While Applicant admittedly did not provide Opposer with notice of its plan to file a motion for summary judgment prior to the meet-and-confer call, Applicant's broaching the planned motion during the call was intended as a courtesy to Opposer to prospectively reduce unnecessary efforts by the parties (and the Board). Applicant is under no obligation to advise Opposer of its plans to file such a motion, and Applicant might have undertaken the call with no mention of the planned motion, instead filing it subsequent to the call, or otherwise without notice to Opposer. Applicant's motivation in advising Opposer of its plan was based in a good faith interest in the parties engaging in a rational discussion regarding the potential impacts of Applicant's dilution evidence on the merits of Opposer's claims. However, Opposer's response to Applicant's disclosure foreclosed such a discussion (*Id.* at ¶ 9), and Applicant submits that Opposer's efforts in and subsequent to the meet-and-confer fell short of the requisite level of good faith required under the standards set forth by the Board in light of the circumstances.

Applicant further submits that while Opposer's attorney's statement that no agreement was reached regarding the discovery dispute is not inaccurate, it omits the lack of effort by Opposer toward prospective resolution in light of Applicant's disclosure and mischaracterizes Applicant's conduct during the meet-and-confer call. Opposer implies that Applicant's counsel maintained its position with respect to document request counts and its General Objection, and subsequently disclosed Applicant's intent to file the motion for summary judgment. *See* Scott Decl. at ¶¶ 17-18. The sequence set forth is inaccurate (created in particularly by the use of "then" in ¶18) and crafted to lead to the inference Opposer's counsel hopes the Board to draw – that Applicant is uncooperative with respect to the discovery dispute and acting in bad faith in its disclosure of the

planned motion. The call did not proceed in the linear sequence set forth stated in the cited paragraphs of the Scott Decl. Instead, Applicant's counsel acknowledge that no agreement could be reached by the parties when Opposer's attorney refused to engage substantively on the planned dispositive motion, supporting evidence, and prospective impacts the filing of the motion would have on the case schedule. Kapteyn Decl., ¶¶ 8-11.

Applicant's counsel expressed its willingness to discuss resolution of the disagreement regarding the discovery requests, but suggested deferment until after proceedings were potentially disposed or narrowed pursuant to the Board's consideration of Applicant's planned motion for summary judgment, or pursuant to discussion with Opposer, which Opposer's counsel seemed to dismiss out of hand based on her demeanor and response. Unfortunately, Opposer's attorney, while stating that she "did not want to be aggressive," was unwilling to engage in a constructive discussion or investigate prospective resolution (or deferment of resolution) of the dispute in light of Applicant's planned motion and asserted evidence, insisting on either working through each disputed request for production, or on ending the call so that she could state that no agreement was reached to enable filing of the instant Motion to Compel.

Applicant submits that Opposer's attorney's mischaracterizations of the call weighs further against a finding of good faith effort by Opposer toward resolving the dispute.

b. Applicant's Motion for Summary Judgment Relies on Publicly Available Evidence, and Document Production Not Necessary for Opposer's Opposition Applicant's Motion to Summary Judgment

As noted above and by Opposer in its Motion to Compel and supporting Scott Decl., Applicant's counsel notified Opposer's counsel of Applicant's intent to move for summary

judgment on all counts, relying solely on publicly available evidence consisting primarily on evidence consisting of hundreds of third-party trademark registrations for marks featuring "scout" or "scouts," all of which are available in the public record. This was communicated to foster transparency and judicial efficiency, not to "blindside" Opposer as alleged, as well as to address the issue of the outstanding discovery dispute by proposing to defer resolution of the dispute and burdensome production and review of documents by the parties that might be unnecessary or narrowed subsequent to the Board's consideration of Applicant's planned dispositive motion.

Applicant does not refuse to provide documents responsive to Opposer's requests. However, the principal evidence underpinning Applicant's forthcoming summary judgment motion consists of matters of public record—namely, evidence of third-party registrations for "scout" and "scouts" formative marks and evidence of their use that is equally accessible to Opposer. *See* Kapteyn Decl., ¶¶ 3-7. Applicant's planned motion relies entirely on evidence that is publicly available and equally accessible to Opposer and Applicant. *Id.* at ¶ 12. No unfair prejudice can result to Opposer, as Applicant's motion will not rely on any unique, internal documentation that Opposer needs to rebut. Discovery concerning such publicly available evidence is thus unnecessary for Opposer to defend the motion, and any suggestion to the contrary is misplaced.

c. Opposer Has Not Demonstrated Good Faith in Its Claims of Fame

Applicant respectfully submits that Opposer's claims regarding the "fame" of its SCOUT Marks asserted in the Notice of Opposition are unsupported. There exist over 300 registrations containing the terms "scout" or "scouts," with more than 100 demonstrably in active use in commerce—facts which are readily verifiable by both parties through public records. *Id.* at ¶¶ 3-7

Applicant submits that Opposer's assertion of fame of its SCOUT Marks appears to have been made without reasonable investigation, and continuing to press this matter in light of readily available contrary evidence does not constitute good faith.

IV. Conclusion

Applicant's General Objection was a good-faith effort to comply with the applicable discovery rules and to clarify the scope and proper counting of Opposer's requests for production. Applicant's counsel raised the planned summary judgment motion as a courtesy, to encourage discussion and potential resolution of the discovery dispute and overall dispute, and to assist both parties in achieving judicial efficiency. The meet-and-confer was candid and intended to streamline the proceedings, not to cause surprise or delay.

Opposer's decision to file the present Motion to Compel—given that the relevant evidence is in the public domain and discoverable by both sides—serves only to delay Applicant's filing of a potentially dispositive motion. The Board's and the parties' resources would be better served by addressing the merits of the summary judgment motion.

For the foregoing reasons, Applicant requests that the Board deny Opposer's Motion to Compel without prejudice and allow this proceeding to continue toward adjudication of Applicant's planned summary judgment motion.

Dated: September 2, 2025

Respectfully submitted,

KW Law, LLP

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CERTIFICATE OF SERVICE

I hereby certify that on September 2, 2025, I caused a true and correct copy of APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCUCTION OF DOCUMENTS AND THINGS to be served by email upon the following attorney of record for Opposer:

Gary Hecht; ipdocket@foxrothschild.com, ghecht@foxrothschild.com, colszyk@foxrothschild.com, dmcgregor@foxrothschild.com

/jkapteyn/

Jeremy Kapteyn

EXHIBIT 1

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

In the Matter of Application Serial No. 97/825,971 For the mark: QUEER SCOUT Published: January 9, 2024	Opposition No. 91291363
Boy Scouts of America, Opposer, v. Toro International, LLC, Applicant.	

DECLARATION OF JEREMY KAPTEYN IN SUPPORT OF APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS

I, Jeremy Kapteyn, Esq., declare as follows:

1. I represent Applicant Toro International, LLC in this matter.

2. I have knowledge of the facts set forth herein and in APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS.

3. On July 8, 2025, I conducted a trademark search for federal trademark registration containing the terms "scout" or "scouts" that were active and subsisting on the federal

trademark register and not owned by the Boy Scouts of America using the software platform TM TKO.

4. The results included over 350 trademark registration records. These include over 230 unique registrants and over 230 unique marks.

5. Beginning on July 16, Blake Scheffey, a paralegal in our office, began reviewing the registered marks and searching the internet to identify websites showing current use of the registered mark in commerce by registrants and capturing screenshots showing evidence of the same.

6. Based on my review of the registration records and screen captures, I can attest that over 100 parties are currently using marks comprising the terms “scout” or “scouts” for a wide range of goods and services.

7. Of the registered marks identified in our search, we identified evidence showing over 100 of the registered marks in apparent current actual use in commerce.

8. On August 13, 2025, during a meet-and-confer call with Opposer’s representative Melissa E. Scott, I stated Applicant’s intention to file a motion for summary judgment on all counts based principally on the publicly available evidence of dilution of Opposer’s asserted SCOUT Marks outlined herein, raising this topic as potentially, at least temporarily, foreclosing the need for the parties to resolve the outstanding dispute regarding discovery request counts and associated production and review efforts.

9. Opposer’s representative Melissa E. Scott was dismissive of the prospective merits of such a motion or the alleged evidence of dilution, instead insisting on either discussing

each document request dispute item or asking for my acknowledgement that that the parties could not come to an agreement on the document request dispute.

10. During the call, I did not indicate that I was unwilling to work with Opposer's representative to resolve the document request count dispute and suggested that minor amendments might aid in resolution of the dispute, but also suggested that suspension of the case and deferment of discovery for consideration of Applicant's planned dispositive motion would be a more efficient use of resources.

11. The call ended without meaningful discussion of any prospective alteration of the dispute case schedule in light of Applicant's intended motion for summary judgment, and Opposer filed OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO OPPOSERS FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS on August 13, the same day as the meet-and-confer call.

12. Applicant's motion for summary judgment is substantially complete and relies entirely on publicly available evidence equally available to Opposer and Opposer's counsel as to Applicant and Applicant's counsel.

I declare under penalty of perjury under the laws of the United States that all of the foregoing is true and correct.

Dated: September 2, 2025

Respectfully Submitted,

By: /jkapteyn/
Jeremy Kapteyn