

ESTTA Tracking number: **ESTTA1376546**
Filing date: **08/09/2024**

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

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers information

Name	Medecins Sans Frontieres International
Granted to date of previous extension	08/10/2024
Address	RUE DE LAUSANNE 78 CASE POSTALE 116 GENEVA 21, 1211 SWITZERLAND

Name	Medecins Sans Frontieres U.S.A., Inc.
Granted to date of previous extension	08/10/2024
Address	40 RECTOR ST., 16TH FLOOR NEW YORK, NY 10006 UNITED STATES

Attorney information	BO BRYAN JIN SIMPSON THACHER & BARTLETT LLP 2475 HANOVER STREET PALO ALTO, CA 94304 UNITED STATES Primary email: bryan.jin@stblaw.com Secondary email(s): barry.lau@stblaw.com, laura.lin@stblaw.com, emelyn.avina@stblaw.com 650-251-5000
Docket no.	076029/0006

Applicant information

Application no.	97891707	Publication date	06/11/2024
Opposition filing date	08/09/2024	Opposition period ends	08/10/2024
Applicant	Scale Without Borders Innovations Inc. 219 FORT YORK BLVD UNIT 205 TORONTO ON, M5V4A2 CANADA		

Goods/services affected by opposition


Class 035. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Providing employment counseling services; Providing employment counseling services via lectures and virtual events.
Class 041. First Use: None First Use In Commerce: None


All goods and services in the class are opposed, namely: Conducting workshops and seminars in job counseling and employment; Arranging and conducting of seminars and workshops in the field of employment; Providing on-line training workshops in the field of job counseling and employment

Grounds for opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)


Marks cited by opposer as basis for opposition


U.S. registration no.	2290906	Application date	02/18/1998
Register	Principal		
Registration date	11/09/1999	Foreign priority date	NONE
Word mark	DOCTORS WITHOUT BORDERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: 1971 First Use In Commerce: Jul 1990 charitable services, namely, providing emergency medical relief and assisting victims of disasters and conflicts worldwide and promoting public awareness of populations at risk		

U.S. registration no.	3032188	Application date	11/19/2004
Register	Principal		
Registration date	12/20/2005	Foreign priority date	NONE
Word mark	DOCTORS WITHOUT BORDERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Jan 1, 1971 First Use In Commerce: Jul 1, 1990 recruitment services for medical professionals to participate in international relief projects Class 036. First use: First Use: Jan 1, 1971 First Use In Commerce: Jul 1, 1990 charitable fund raising services for international relief projects		

U.S. registration no.	3028779	Application date	12/01/2004
Register	Principal		
Registration date	12/13/2005	Foreign priority date	NONE
Word mark	MEDECINS SANS FRONTIERES DOCTORS WITHOUT BORDERS		

Design mark	
Description of mark	NONE
Goods/services	Class 035. First use: First Use: Dec 1971 First Use In Commerce: Oct 2001 recruitment services for medical professionals to participate in international relief projects; promoting public awareness of populations at risk

U.S. registration no.	3028780	Application date	12/01/2004
Register	Principal		
Registration date	12/13/2005	Foreign priority date	NONE
Word mark	MEDECINS SANS FRONTIERES DOCTORS WITHOUT BORDERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 036. First use: First Use: Dec 1971 First Use In Commerce: Oct 2001 charitable fundraising services for international relief projects		

U.S. registration no.	3028781	Application date	12/01/2004
Register	Principal		
Registration date	12/13/2005	Foreign priority date	NONE
Word mark	MEDECINS SANS FRONTIERES DOCTORS WITHOUT BORDERS		
Design mark			
Description of mark	NONE		
Goods/services	Class 044. First use: First Use: Dec 1971 First Use In Commerce: Oct 2001 charitable services, namely, providing medical services to underdeveloped countries		

Attachments	75436137#TMSN.png(bytes) 78519817#TMSN.png(bytes) 78525091#TMSN.png(bytes) 78525098#TMSN.png(bytes) 78525106#TMSN.png(bytes) MSF_FINAL_Notice of Opposition to Scale Without Borders.pdf(370390 bytes) Exhibit A - Consent.pdf(35853 bytes)
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Signature	/Bo Bryan Jin/
Name	Bo Bryan Jin
Date	08/09/2024

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

MÉDECINS SANS FRONTIÈRES)	
INTERNATIONAL)	
- and -)	
MÉDECINS SANS FRONTIÈRES USA, INC.,)	Opposition No.: _____
jointly, Opposer,)	Serial No.: 97891707
v.)	Filing Date: April 17, 2023
SCALE WITHOUT BORDERS INNOVATIONS)	Mark: SCALE WITHOUT BORDERS
INC.,)	Int'l Classes: 35 and 41
Applicant.)	Published: June 11, 2024

NOTICE OF OPPOSITION

This Opposition is brought on behalf of Médecins Sans Frontières International, an international not-for-profit corporation with its principal place of business located at Rue de Lausanne 78, Case Postale 116, 1211 Geneva 21, Switzerland (“MSF International”), and Médecins Sans Frontières USA, Inc., commonly known as and doing business as “Doctors Without Borders,” a New York not-for-profit corporation with its principal place of business located at 40 Rector Street, 16th Floor, New York, NY 10006, USA (“MSF USA” and jointly with MSF International, “Doctors Without Borders”).

As grounds for opposition, Doctors Without Borders alleges as follows:

- MSF International has used the mark DOCTORS WITHOUT BORDERS since its founding in 1971 to engage in the business of, *inter alia*, providing humanitarian relief, including medical care, to those who are impacted by natural disasters, conflict, epidemics, and

other similar disasters. Doctors Without Borders also assists those who face discrimination or neglect from their local health systems.

2. Doctors Without Borders is one of the world's leading nonprofit providers of medical relief. Every year, Doctors Without Borders provides medical care to millions of people worldwide, from providing vaccines to performing major surgeries. Its projects have provided assistance in response to all kinds of emergencies in more than 70 countries, including Afghanistan, Greece, Haiti, Sudan, Syria, and the United States.

3. In response to the political and economic violence in Haiti, in 2023 alone, Doctors Without Borders provided 37,600 emergency room consultations and assisted in 1420 births. It has also supported health centers and operated mobile clinics in areas most affected by the violence and where impacted people have fled. Doctors Without Borders' access to these areas is credited to the positive perception of the organization by Haitian communities.

4. In 2022, Doctors Without Borders mobilized around 124 international and more than 686 Ukrainian staff working in response to the war in Ukraine, including medical staff (surgeons, doctors, nurses), psychologists, logistics and administrative staff, and management.

5. In 1999, MSF International was awarded the Nobel Peace Prize "in recognition of the organization's pioneering humanitarian work on several continents." Core to Doctors Without Borders' pioneering humanitarian work is a commitment to providing assistance to populations in distress, irrespective of race, religion, creed, or political convictions. As an essential complement to this commitment, Doctors Without Borders observes neutrality and impartiality in the name of adhering to universal medical ethics.

6. Doctors Without Borders' neutrality serves to shield its staff and volunteers from violence, and even the smallest perceived impartiality can put its staff at risk.

7. For example, on April 5, 2022, Doctors Without Borders was forced to suspend its medical and humanitarian activities in Cameroon in response to four of its staff members being detained. Two of these staff members were arrested on December 27, 2021, after the ambulance in which they were transferring a patient with gunshot wounds was stopped at a checkpoint. Despite the fact that Doctors Without Borders followed agreed-upon procedures to notify the authorities, the staff members were investigated for complicity with secessionism simply for carrying out their medical duties, and stood trial.

8. On June 24, 2021 three Doctors Without Borders aid workers were killed in a conflict zone in the Tigray region of Ethiopia. Despite public and bilateral discussions with the parties engaged in that conflict, Doctors Without Borders still has not received clarity as to who was responsible for the attack.

9. In October 2021, Doctors Without Borders was forced to temporarily suspend its activities in the zone of Bambu in Democratic Republic of Congo's Ituri province, after unidentified gunmen fired at a Doctors Without Borders vehicle, wounding two staff members.

10. And in October 2015, a Doctors Without Borders' hospital in Kunduz, Afghanistan was bombed by the United States military. In the wake of that attack, media reports provided evidence that Afghan government forces, due to misperceptions that Doctors Without Borders was aligned with the Taliban because Doctors Without Borders treated Taliban combatants in Doctors Without Borders hospitals, misled their United States allies in order to target and destroy the hospital.

11. Doctors Without Borders' services have been extensively provided and are recognized the world over, and it has built up substantial goodwill and consumer recognition of its services through its trademarks.

DOCTORS WITHOUT BORDERS' MARKS

12. MSF International is the owner of five registered trademarks in the United States containing the Doctors Without Borders name and of extensive common law use in the trademark DOCTORS WITHOUT BORDERS in other classes based on its first use beginning in 1971, first use in commerce in the United States beginning in 1990, and continuous use in commerce thereafter (collectively the "MSF Marks").

13. MSF International owns the incontestable registration for DOCTORS WITHOUT BORDERS (Reg. No. 2,290,906) in International Class 42 for use in connection with "charitable services, namely, providing emergency medical relief and assisting victims of disasters and conflicts worldwide and promoting public awareness of populations at risk." This mark was first used in 1971, was first used in commerce in the United States in 1990, was registered on the Principal Register on November 9, 1999, and is active, valid, and presently subsisting.

14. MSF International owns the incontestable registration for DOCTORS WITHOUT BORDERS (Reg. No. 3,032,188) in International Class 35 for use in connection with "recruitment services for medical professionals to participate in international relief projects" and in International Class 36 for use in connection with "charitable fund raising services for international relief projects." This mark was first used in 1971, was first used in commerce in the United States in 1990, was registered on the Principal Register on December 20, 2005, and is active, valid, and presently subsisting.

15. MSF International also owns incontestable registrations for a design mark containing DOCTORS WITHOUT BORDERS (Reg. Nos. 3,028,779; 3,028,780; and 3,028,781) in International Classes 35, 36, and 44, respectively, all based on first use in 1971 and first use in commerce in the United States in 2001.

16. In September 2000, MSF USA assigned the then-current MSF Marks and agreed to assign future MSF Marks to MSF International in exchange for a license to use the MSF Marks in the United States. MSF USA recorded the original Trademark License and Assignment Agreement between Bureau International de Médecins Sans Frontières (predecessor-in-interest to Médecins Sans Frontières International) and Médecins Sans Frontières USA, Inc., dated September 14, 2000 (as amended and restated from time to time) with the United States Patent and Trademark Office on March 29, 2001, at Reel 2265, Frame 0534. MSF USA and MSF International entered into a new Trademark License Agreement on February 4, 2016 (as amended and restated from time to time, the “License”), pursuant to which MSF USA is licensed to use the MSF Marks.

17. MSF International, as owner, and MSF USA, as licensee, have standing under Section 13 of the Lanham Act, 15 U.S.C. § 1063, to bring this Notice of Opposition based upon their rights with respect to the MSF Marks.

18. In accordance with the terms of the License, MSF International granted MSF USA consent and standing to bring this Notice of Opposition. A copy of the signed consent is attached hereto as Exhibit A.

19. Doctors Without Borders’ services have been the subject of unsolicited media consideration and reporting for decades, highlighting the organization’s unwavering

commitment to delivering medical assistance to those in need, even in the most dangerous of locales. This coverage has been extensive and continuous.

20. Due to the nature and impact of its services, Doctors Without Borders has built up substantial goodwill and recognition of the mark DOCTORS WITHOUT BORDERS.

21. For over 40 years, and continuing to the present, MSF USA has widely used the MSF Marks in the United States, and has been referred to by its staff, its donors and supporters, the press, the individuals that it assists and other third parties throughout the United States, and the world as DOCTORS WITHOUT BORDERS.

22. As a result of the nature and quality of Doctors Without Borders' services, its widespread use of the MSF Marks, the extensive and continuous media coverage, the high degree of consumer recognition of the MSF Marks, numerous trademark registrations, its receipt of the Nobel Peace Prize, and other factors, the MSF Marks are famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).

APPLICANT'S APPLICATION FOR THE WITHOUT BORDERS MARK

23. Notwithstanding Doctors Without Borders' prior rights in and to the above-mentioned trademark registrations and the famous nature of the MSF Marks, on April 17, 2023, Applicant "Scale Without Borders Innovations Inc." ("Applicant") filed an application with the United States Patent and Trademark Office to register the service mark SCALE WITHOUT BORDERS (Ser. No. 97891707) in International Classes: 35 and 41 ("Applicant's Mark"). The identification of goods and services was submitted as follows:

IC 035. US 100 101 102: Providing employment counseling services; Providing employment counseling services via lectures and virtual events.

IC 041. US 100 101 107: Conducting workshops and seminars in job counseling and employment; Arranging and conducting of seminars and workshops in the field of employment; Providing on-line training workshops in the field of job counseling and employment.

24. Doctors Without Borders is not affiliated or connected with Applicant or its products or services, nor has Doctors Without Borders sponsored or endorsed Applicant or its products or services.

25. Because Doctors Without Borders does not sponsor or endorse Applicant or its products or services, Doctors Without Borders files this opposition to enforce its rights with respect to the MSF Marks.

**FIRST GROUND FOR OPPOSITION:
Dilution of a Famous Mark**

26. Doctors Without Borders incorporates by reference Paragraphs 1 through 25 inclusive, as if fully set forth herein.

27. The MSF Marks are strong marks and should be offered a wide scope of protection.

28. Doctors Without Borders has used the MSF Marks since as early as 1971 and has offered a wide range of medical, humanitarian and mental health services in over 70 countries worldwide.

29. MSF International is the owner of numerous U.S. registrations for the MSF Marks, which are incontestable, and MSF USA is the licensee of these marks in the United States.

30. In 2023, Forbes ranked Doctors Without Borders USA 22nd on its List of the 50 Largest United States Charities, with \$670 million in revenue that year. Also according to

Forbes, MSF USA depends on donors for approximately 97% of its annual funding, with private donations totaling \$678 million in 2022.

31. MSF USA's publicly disclosed annual Form 990 Tax Return for 2020 reveals that over \$8.5 million dollars were expended on advertising and marketing in that year alone.

32. Doctors Without Borders and the MSF Marks have been the subject of extensive and continuous media attention, including for MSF International's receipt of the Nobel Peace Prize in 1999.

33. As a result of the considerable publicity and unsolicited media attention afforded the MSF Marks and the consistently large base of consumers who donate their time and money to, or receive services from Doctors Without Borders, the MSF Marks have extensive consumer recognition within the United States and worldwide.

34. The MSF Marks became famous before Applicant's filing of the SCALE WITHOUT BORDERS application on April 17, 2023.

35. Applicant's use of the SCALE WITHOUT BORDERS mark with its listed services will blur and diminish the connection drawn by the general public between the MSF Marks and Doctors Without Borders' goods and services, thereby diluting the distinctiveness of the famous MSF Marks to Doctors Without Borders' severe detriment.

36. Accordingly, Applicant's SCALE WITHOUT BORDERS mark is unregistrable pursuant to Sections 2(d), 13, and 43(c) of the United States Trademark Act, 15 U.S.C. §§ 1052(d), 1063, and 1125(c), and should be refused registration.

**SECOND GROUND FOR OPPOSITION:
Likelihood of Confusion**

37. Doctors Without Borders incorporates by reference Paragraphs 1 through 36 inclusive, as if fully set forth herein.

38. SCALE WITHOUT BORDERS is confusingly similar to the MSF Marks in appearance, sound, and commercial impression.

39. SCALE WITHOUT BORDERS uses two of the three words in the MSF Marks, in the same order and position as they appear in Doctors Without Borders' mark.

40. The close similarity between SCALE WITHOUT BORDERS and the MSF Marks is likely to cause substantial confusion in the minds of the public, who may mistakenly believe that Doctors Without Borders is affiliated with Applicant, endorses or sponsors Applicant's services, or is sponsored or endorsed by Applicant.

41. Moreover, any confusion between Doctors Without Borders and a third party is a potentially life-threatening matter. As discussed above, Doctors Without Borders depends on its reputation as an independent, non-political and neutral organization to allow it to operate in volatile territories where relationships with local leaders and authorities are the key to guaranteeing that aid can be provided safely. Doctors Without Borders' reputation as an independent, non-political, and neutral organization may be damaged if it is perceived to be affiliated with Applicant. The risk here is especially great because Applicant intends to offer goods and services in which its mark is used in connection with a variety of advertising and promotional efforts through the internet, television, and other media broadcasts, presumably reaching international audiences.

42. The MSF Marks are also used widely in connection with Doctors Without Borders' various charitable fundraising activities. Applicant's website appears to offer for-profit

services related to employment counseling and tech resources, and does not contain any visible disclaimer stating that it is not affiliated with MSF. A customer could reasonably infer that SCALE WITHOUT BORDERS is a for-profit affiliate of Doctors Without Borders.

43. Accordingly, registration of the SCALE WITHOUT BORDERS mark will cause injury to Doctors Without Borders by causing the public to be confused or mistakenly believe that the products and services provided by Applicant are associated with, endorsed, or sponsored by Doctors Without Borders. Doctors Without Borders cannot control the nature of the services offered by Applicant under the SCALE WITHOUT BORDERS mark, or guarantee the reliability of any services offered by those products. Doctors Without Borders' reputation and goodwill will be damaged and the value of the MSF Marks jeopardized, all to Doctors Without Borders' detriment.

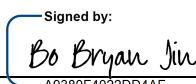
44. Registration of SCALE WITHOUT BORDERS will damage Doctors Without Borders because Applicant's Mark is likely to cause confusion, mistake, or to deceive in violation of Sections 32(1) and/or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), and justifying refusal of registration of Applicant's Mark under 15 U.S.C. § 1052(d).

WHEREFORE, Doctors Without Borders requests that application Serial No. 97891707 be refused registration in all classes; that no registration be issued to Applicant for the SCALE WITHOUT BORDERS mark; and that this opposition be sustained in favor of Opposer Doctors Without Borders.

DATED: August 9, 2024

Respectfully submitted,

SIMPSON THACHER & BARTLETT LLP

By:  _____
Signed by:

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Attorneys for Doctors Without Borders



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To: **Médecins Sans Frontières USA, Inc.:**

In accordance with Section 1.1 of the Trademark License Agreement, dated February 4, 2016, between Médecins Sans Frontières International ("MSF International") and Médecins Sans Frontières USA, Inc., ("MSF USA"), MSF International hereby grants to MSF USA, licensee in the United States of all rights in and to the service marks DOCTORS WITHOUT BORDERS (including, without limitation, U.S. Reg. No. 2,290,906), consent and standing to file a Notice of Opposition with the United States Patent and Trademark Office in connection with the application for the mark SCALE WITHOUT BORDERS (Serial No. 97891707). MSF International further consents to the use of MSF International's name as a party to such Notice of Opposition.

Signed: Médecins Sans Frontières International

Name: Andreu Maldonado Segler

Title: Deputy to the Secretary General

Signed:

Dated: 08/08/2024