

WHAT DO YOU CALL FEMALE MEMBERS OF BOY SCOUT TROOPS?

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In the song “A Rumor in Saint Petersburg,” from the musical *Anastasia*, the character Dmitry states: “They can call it Leningrad, but it will always be Petersburg. New name, same empty stomachs.”¹ On February 1, 2019, the Boy Scouts of America² changed the name of its Boy Scout program to “Scouts BSA,”³ along with creating the new advertising slogan “Scout Me In.”⁴ New name, same program.⁵

This is not the first time the Boy Scouts of America embraced a name change. In 1977, the organization branded itself as “Scouting/USA.”⁶ Despite using a modified version of “Scouting/USA,” the new marketing campaign has resulted in a legal action by the Girl Scouts of the United States of America⁷ alleging, among other things, trademark infringement.⁸ One of the reasons for the alleged violation

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1. *A Rumor in Saint Petersburg*, GENIUS, <https://genius.com/Anastasia-company-a-rumor-in-saint-petersburg-lyrics#note-12308829> (last visited Oct. 7, 2021).

2. The Boy Scouts of America will be occasionally referred to throughout the article as simply the Boy Scouts.

3. Ashley Thompson, *Boy Scouts Gets New Name to Include Girls*, LEARNING ENGLISH (May 2, 2018), <https://learningenglish.voanews.com/a/boy-scouts-gets-new-name-to-prepare-for-girl-members/4374743.html>. The program’s new name creates a title that would curdle the blood of a high school English teacher. “BSA” is a trademark of the Boy Scouts of America and is an abbreviation of “Boy Scouts of America.” See BOY SCOUTS OF AMERICA LICENSING PROGRAM, <http://licensingbsa.org/trademarks> (last visited Oct. 7, 2021). Thus, the program has the odd name, if written or stated without the abbreviation, of “Scouts Boy Scouts of America.”

4. Camila Domonoske, *Boy Scouts Changing Name to ‘Scouts BSA,’ As Girls Welcomed into Program*, NPR (May 2, 2018, 9:46 AM), <https://www.npr.org/sections/thetwo-way/2018/05/02/607678097/boy-scouts-changing-name-to-scouts-bsa-as-girls-welcomed-into-program>.

5. See *Girl Scouts v. Boy Scouts*, No. 1:18-cv-10287-AKH (S.D.N.Y. filed Nov. 6, 2018) (available at <https://int.nyt.com/data/documenthelper/643-the-girl-scouts-have-sued-the/f72de52b74cb964c6237/optimized/full.pdf>) [hereinafter Complaint], Exhibit J, pp. 3–4 (“Scouts BSA troops will be single gender The Boy Scouts of America, in name . . . remains the same . . .”).

6. See Joseph B. Treaster, *Boy Scouts of America Adopt Name of Scouting/USA*, NY TIMES Feb. 23, 1977), <https://www.nytimes.com/1977/02/23/archives/boy-scouts-of-america-adopt-name-of-scoutingusa.html>; see also Sarah Wyman, *The Boy Scouts of America Sparked Backlash in 2018 When It Announced It Would Accept Girls, But It’s Not the First Time the Group Has Been Coed*, INSIDER (Nov. 6, 2019, 3:05 PM), <https://www.businessinsider.com/boy-scouts-of-america-coed-history-2019-11>.

7. The Girl Scouts of the United States of America will be occasionally referred to throughout the article as simply the Girl Scouts.

8. Complaint, *supra* note 5, at 36.

is because the Boy Scouts began allowing females to join every program division of its organization.⁹ More specifically, it allowed females in the Cub Scout and Boy Scout programs.¹⁰

Exhibits attached to the complaint¹¹ establish violations of the intellectual property rights held by the Girl Scouts. The documents show that the infringements were by Boy Scout troops, districts, and councils.¹² Some of the trademark violations have been conceded by counsel for the Boy Scouts.¹³ However, these infringements were not committed by the national Boy Scout organization.¹⁴ The alleged sins of the national organization are allowing females to join the Cub Scout and Boy Scout programs, along with advertising the slogans “Scouts” and “Scout Me In.”¹⁵

The allegations against the national Boy Scout organization regarding the expanded admittance of females and the new national slogans cannot be defended by the organization’s volunteers. However, there are steps that volunteers of both organizations can follow to ensure that the intellectual property rights of the Boy Scouts and Girl Scouts are protected from infringement. The solution, although on the surface seems completely illogical, is astonishingly simple. More importantly, it avoids further toasting the marshmallows of the Girl Scouts.

I. CONGRESSIONAL CHARTERS

On June 15, 1916, President Woodrow Wilson signed into law Congress’s incorporation of the Boy Scouts of America.¹⁶ The Girl Scouts of the United States of America was incorporated pursuant to the state laws of New York in 1915, with the organization receiving its congressional charter on March 16, 1950.¹⁷

II. ALLEGATIONS

On November 6, 2018, the Girls Scouts filed a lawsuit against the Boy Scouts in the United States District Court for the Southern District of New York.¹⁸ The Girl Scouts alleged:

9. Elizabeth Zwirz, *Girl Scouts’ Lawsuit Accuses Boy Scouts of Trademark Infringement*, FOX NEWS (Nov. 6, 2018), <https://www.foxnews.com/us/girl-scouts-lawsuit-accuses-boy-scouts-of-trade-mark-infringement>.

10. *See id.*

11. *See* Complaint, *supra* note 5, and attached exhibits.

12. *Id.*

13. Complaint, *supra* note 5, Exhibit K.

14. *See* Complaint, *supra* note 5, and attached exhibits.

15. Complaint, *supra* note 5, at 3 and Exhibit I.

16. Bryan Wendell, *Accept No Substitutes: On June 15, 1916, Woodrow Wilson Made the BSA Official*, SCOUTING MAG. (June 15, 2016), <https://blog.scoutingmagazine.org/2016/06/15/june-15-1916-woodrow-wilson-made-bsa-official>; *see also* 36 U.S.C. §§ 30901–08 (2012).

17. *Girl Scouts of the USA History*, FUNDINGUNIVERSE, <http://www.fundinguniverse.com/company-histories/girl-scouts-of-the-usa-history> (last visited Oct. 7, 2021); *see also* 36 U.S.C. §§ 80301–07 (1998).

18. Complaint, *supra* note 5, at 1.

[C]ore 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."¹⁹

The Girl Scouts continued:

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.²⁰

The Girl Scouts also claimed:

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.²¹

In its seven count complaint, the Girl Scouts alleged violations of federal trademark infringement under 15 U.S.C. § 1114(1);²² federal unfair competition and false designation of origin under 15 U.S.C. § 1125(a);²³ federal trademark dilution under 15 U.S.C. § 1125;²⁴ modification or partial cancellation of

19. *Id.* at 2–3.

20. *Id.* at 3.

21. *Id.* at 4.

22. *Id.* at 36.

23. *Id.* at 39.

24. *Id.* at 41.

registration;²⁵ common law trademark infringement, unfair competition, and passing off;²⁶ trademark dilution under New York General Business Law § 60-1;²⁷ and tortious interference with prospective economic advantage.²⁸

The alleged trademark violations are serious. However, federal trademark violations are remarkably easy to *prevent*. Volunteers for the Boy Scouts are very capable of preventing future litigation with the Girl Scouts by educating their colleagues and the general public on how to prevent trademark transgressions. But to prevent trademark infringements, Boy Scout volunteers and the innocent public must know what they need to avoid. Therefore, a discussion of what constitutes a trademark and trademark infringement is warranted.

III. TRADEMARKS

Trademarks were never historically recognized to be worthy of protection as a property interest.²⁹ In the modern commercial world, however, a trademark can be the company's most valuable asset.³⁰ Trademark rights in the United States are acquired by using the mark in commerce on, or in connection with, goods or services.³¹ Therefore, when Henry Ford applied the "Ford" name to a car and sold the car to a customer as a "Ford," the "Ford" trademark was established.³² The millions of cars that followed welded the Ford Motor Company to the "Ford" trademark.³³ While registration of the trademark with the United States Patent and Trademark Office gave notice to the world that the Ford Motor Company claimed ownership in the "Ford" trademark for automobiles, the trademark is dependent upon the company's continued use of the mark with its products.³⁴

There are more than two million marks that have active federal certificates.³⁵ Thus, the challenge is to avoid the prior use of a mark by another party on the same or similar commodities. This means that if another car manufacturer had adopted

25. *Id.* at 42.

26. *Id.* at 43.

27. *Id.* at 44.

28. *Id.* at 46.

29. Frank D. Prager, *A History of Intellectual Property From 1545 to 1787*, 26 J. PAT. & TRADEMARK OFF. SOC'Y 711, 718 (1944).

30. *Trademark Law Revision Act of 1987: Hearing on S. 1883 Before the S. Subcomm. on Patents, Copyrights and Trademarks*, 100th Cong. 2 (1988) (statement of Sen. Dennis DeConcini, Chairman, S. Subcomm. on Patents, Copyrights and Trademarks); see also Maria Guerra, *The Rocky Road of the U.S. Accession to the Madrid Protocol: Could This be the Year?*, 11 DEPAUL-LCA J. ART. & ENT. L. & POL'Y 525, 553 (2001); James T. Caeshu, *Trademarks and the "Free Ride" Doctrine*, 16 STAN. L. REV. 736, 739 (1964).

31. William J. Keating, *Development of Evidence to Support Color-Based Trademarks*, 9 J. L. & COM. 1, 3 (1989); see also *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019); *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

32. Keating, *supra* note 31, at 3.

33. *Id.*

34. *Id.*

35. *Matal*, 137 S. Ct. at 1752.

and used the word “Ford” on an automobile in the United States before Henry Ford, the other car manufacturer would own the “Ford” trademark.³⁶

Another problem in granting trademark rights concerns the issue of what constitutes a trademark.³⁷ Words and symbols are easily identifiable as trademarks.³⁸ In contrast, the features of products, such as trade dress, container shapes, product configurations, slogans, and other such traits associated with a product or service are less defined.³⁹

Trademarks are a part of the British heritage of the United States.⁴⁰ In 1791, Thomas Jefferson became interested in creating a national trademark registration law.⁴¹ The proposal occurred after Jefferson, as patent commissioner, received a petition from a group of Boston sailmakers asking for the exclusive right to use certain marks on their products.⁴² The first federal law addressing trademarks was enacted in 1870.⁴³ The statute was pursuant to Congress’s authority under the Patent and Copyright Clause of the United States Constitution.⁴⁴ However, the Supreme Court invalidated the statute in the *Trade-Mark Cases*,⁴⁵ holding that Congress had exceeded its authority under the Patent and Copyright Clause.⁴⁶

The Court left open the possibility that Congress could enact a trademark law pursuant to the Commerce Clause of the United States Constitution.⁴⁷ Congress’s response was the Trademark Act of 1881.⁴⁸ This time the statute was enacted pursuant to Congress’s authority under the Commerce Clause.⁴⁹ The law was applicable to trademarks that were used in interstate commerce.⁵⁰ The law underwent major revisions in 1905.⁵¹ In the revised statute, materials that qualified for trademark registration consisted of non-descriptive words and symbols used on goods.⁵² Some states afford protection to other identifying devices pursuant to local common law.⁵³

36. Keating, *supra* note 31, at 3.

37. *Id.*

38. *Id.*; see also *Matal*, 137 S. Ct. at 1751 (citations omitted).

39. Keating, *supra* note 31, at 3.

40. SIDNEY A. DIAMOND, TRADEMARK PROBLEMS AND HOW TO AVOID THEM 1 (Crain Books, rev. ed. 1981). See, e.g., *Matal*, 137 S. Ct. at 1751.

41. DIAMOND, *supra* note 40, at 1.

42. *Id.*

43. *Id.*; see also *Matal*, 137 S. Ct. at 1751–52.

44. *Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

45. *Id.*

46. *Id.* at 93–94.

47. *Id.* at 94–96.

48. Trademark Act of 1881, ch. 138, 21 Stat. 502 (repealed 1946) (titled “An Act to authorize the registration of trademarks and protect the same”).

49. DIAMOND, *supra* note 40, at 1.

50. *Id.*

51. Keating, *supra* note 31, at 7.

52. *Id.*

53. *Id.*

Federal trademark jurisprudence was expanded in 1920 to allow for the registration of trademarks that did not qualify for protection under the 1905 Act.⁵⁴ Descriptive and geographic terms, that were previously denied registration, became eligible for registration.⁵⁵ The revision was designed to allow United States merchants to register their marks in foreign jurisdictions.⁵⁶ This was because foreign registration usually required registration in the country of origin as a condition precedent.⁵⁷

The Lanham Trademark Act was then enacted in 1946.⁵⁸ In passing the statute, Congress acknowledged that trademarks were essential to business competition because the trademark identified a business's products, protected the public from confusion concerning the source of the products, and promoted the quality of the products.⁵⁹ The objective of the Lanham Act was to provide federal registration beyond state common law protection.⁶⁰ The statute expanded the definition of trademark items.⁶¹ Not only were words and symbols protected, but items such as "numerals, slogans, phrases, configuration of goods, labels, surnames, and geographical names were specifically identified as capable of obtaining trademark status" if the items identified goods or services and distinguished them from the goods or services of others.⁶² The Lanham Act provides:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof —

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.⁶³

The United States Patent and Trademark Office is responsible for trademark registration.⁶⁴ The office "maintains a public record of all registered trademarks" and assists in determining whether a proposed new trademark is available.⁶⁵ Before adopting a trademark, a search is conducted to determine whether the mark

54. *Id.*

55. *Id.*

56. *Id.*

57. *Id.*

58. *Id.*; see *Matal*, 137 S. Ct. at 1752; see also 15 U.S.C. §§ 1051-1127 (2018).

59. Daniel J. Fetterman, *Pizzeria Uno Corporation v. Temple: Injunctive Protection of Federally Registered Trademarks*, 43 WASH. & LEE L. REV. 763, 763 (1986); see also *Matal*, 137 S. Ct. at 1751.

60. Fetterman, *supra* note 59, at 763.

61. Keating, *supra* note 31, at 8.

62. *Id.*

63. 15 U.S.C. § 1127 (2018).

64. *Iancu*, 139 S. Ct. at 2297; see also 15 U.S.C. §§ 1051-52 (2018).

65. Keating, *supra* note 31, at 3.

has been established by another entity for similar products or services.⁶⁶ Although registration of the mark establishes that it is unavailable, the absence of registration does not guarantee that the mark is available.⁶⁷ This is because another entity may have established a common-law right to use the unregistered trademark.⁶⁸

For Lanham Act protection, the mark must be used in interstate commerce or in a manner impacting commerce that is regulated by Congress.⁶⁹ Businesses that are limited entirely to *intrastate* transactions cannot qualify for federal trademark registration.⁷⁰ This is because the Lanham Act was enacted pursuant to Congress's authority to regulate commerce through the Commerce Clause.⁷¹ Thus, the mark must be used in *interstate* commerce to be within the mess kit of the Commerce Clause. Only through its use in interstate commerce may a mark obtain federal registration protection.⁷²

The advantage in obtaining trademark registration is the presumption of validity.⁷³ Although the presumption is rebuttable and is not binding upon the courts, registration carries significant weight.⁷⁴ The Lanham Act states that no trademark may be denied registration except for fraud, misrepresentation, obscenity, deception, or other violations of public policy.⁷⁵ Registration is also prohibited when a mark has been created and registered by another party.⁷⁶ In 2017, however, the Supreme Court declared unconstitutional the Lanham Act's ban on registering marks "which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute," finding the clause a violation of the First Amendment.⁷⁷ More recently, the Court also declared the statute's prohibition on the registration of "immoral[] or scandalous" trademarks offensive to the First Amendment.⁷⁸

Merely descriptive marks cannot be registered.⁷⁹ The exception to this prohibition is when consumers recognize and identify the source of the goods or services despite primarily being a descriptive mark.⁸⁰ The exception allows the owner of the trademark to continue to be recognized as the source of the mark because the public would be better served by the mark's registration rather than by its rejection.⁸¹ It is unclear the evidence required to prove that the mark is

66. *Id.* at 3–4.

67. *Id.* at 4.

68. *Id.*; see also *Iancu*, 139 S. Ct. at 2297.

69. Keating, *supra* note 31, at 4; see also *Iancu*, 139 S. Ct. at 2298.

70. Keating, *supra* note 31, at 4.

71. *Id.*

72. *Iancu*, 139 S. Ct. at 2298; see also *Matal*, 137 S. Ct. at 1752.

73. *Iancu*, 139 S. Ct. at 2297; see also *Matal*, 137 S. Ct. at 1753.

74. Keating, *supra* note 31, at 4.

75. *Id.* at 5.

76. *Id.*

77. *Matal*, 137 S. Ct. at 1753, 1765 (quoting 15 U.S.C. § 1052(a)).

78. *Iancu*, 139 S. Ct. at 2302.

79. *Id.* at 2298.

80. Keating, *supra* note 31, at 5.

81. *Id.*

recognized by the public as identifying the goods or services.⁸² This evidence is referred to as “secondary meaning.”⁸³ Five continuous years of use of the mark “may” be accepted as sufficient evidence of consumer recognition.⁸⁴

When the trademark holder seeks to establish secondary meaning for the mark, registration will be denied and the applicant will be required to establish that the public recognizes the subject matter as a trademark.⁸⁵ Thus, the trademark holder must establish that the mark has obtained secondary meaning.⁸⁶ Secondary meaning may be evidenced by affidavits from marketing personnel or consumers, along with extensive advertising campaigns adhering the trademark with the product.⁸⁷ No magical spell exists for creating proof of secondary meaning.⁸⁸ The determination is based on the facts.⁸⁹ “[T]he more descriptive the term is in relation to the goods or services, the greater the weight of evidence necessary to prove ‘secondary meaning.’”⁹⁰ Even if substantial secondary meaning is established, should the consumer associate the term with a class or group of goods, known as a “generic” term, without reference to a particular source, the term does not act as a trademark and registration will be denied.⁹¹

Registration does allow the holder of the trademark to nullify the common law defense of good faith to subsequent uses of the mark.⁹² The defense had provided that if a subsequent user of the mark, in a remote geographic location, adopted the use of the federally registered trademark, in good faith, and without knowledge of the registration, the subsequent user had the right to use the mark in the secondary user’s geographic market.⁹³ The Lanham Act shields a federal registrant from these good faith claims by creating a constructive notice of the trademark’s use through the registration process.⁹⁴

When the federally protected trademark is infringed, the owner may seek injunctive relief to protect the trademark.⁹⁵ The owner must show that the infringer’s use of the registered trademark will likely confuse the consumer.⁹⁶ Federal courts have created guidelines in determining whether a likelihood of confusion exists.⁹⁷ Under the guidelines, courts: 1) consider the distinctiveness of the trademark in question; 2) the similarities between the two contested trademarks; 3) the similarities of the products or services associated with the two

82. *Id.*

83. *Id.*

84. *Id.*

85. *Id.* at 6.

86. *Id.*

87. *Id.*

88. *Id.*

89. *Id.*

90. Keating, *supra* note 31, at 6.

91. *Id.* at 6–7.

92. Fetterman, *supra* note 59, at 763; *see also Iancu*, 139 S. Ct. at 2297–98.

93. Fetterman, *supra* note 59, at 763–64.

94. *Id.* at 764; *see also Iancu*, 139 S. Ct. at 2297–98; *Matal*, 137 S. Ct. at 1753.

95. *See* 15 U.S.C. § 1114(2)(a) (2018).

96. Fetterman, *supra* note 59, at 767.

97. *Id.*

contested trademarks; 4) the similarities of the parties' business facilities; 5) the similarities in advertising used; 6) the defendant's intent in adopting its trademark; and 7) the actual confusion created by concurrent use of the two trademarks.⁹⁸

Not every element may be relevant in every trademark infringement case.⁹⁹ The distinctiveness of the trademarks is the most significant element in determining whether the likelihood of confusion exists between the disputed marks.¹⁰⁰ Even with these considerations, federal registration of the trademark is prima facie evidence that the owner of the mark has the exclusive right to use the mark "in connection with the goods or services specified in the federal registration."¹⁰¹

IV. TRADEMARK DILUTION

Trademarks can also be targeted under a concept known as trademark dilution. The idea of trademark dilution was first proposed by Frank Schechter in a 1927 Harvard Law Review article.¹⁰² Although not using the actual word "dilution," Schechter defined the problem as a "whittling away or dispersion of the identity and hold upon the public mind of the mark."¹⁰³ Nearly a hundred years later, Schechter's description continues to impact trademark jurisprudence.¹⁰⁴ Although Schechter's proposition failed to receive much attention, a New York state court granted Tiffany & Company relief in 1933 against a theater that tried to use the Tiffany name.¹⁰⁵ The importance of the decision is that the court used the word dilution, rather than confusion.¹⁰⁶ No significant developments occurred in this area of the law following the decision.¹⁰⁷

Because the Lanham Act failed to protect from trademark dilution, Massachusetts enacted the first anti-dilution state statute in 1947.¹⁰⁸ Following Massachusetts, several other states enacted similar laws.¹⁰⁹ A model trademark dilution bill was also drafted.¹¹⁰ Courts were reluctant to apply the dilution theory in trademark disputes despite statutory authority.¹¹¹ Between 1933 and 1977, only

98. *Id.*

99. *Id.*

100. *Id.*

101. *Id.* at 768; *see also Matal*, 137 S. Ct. at 1753.

102. *See generally* Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927); *see also* David S. Villwock, *The Federal Trademark Dilution Act of 1995*, 6 DEPAUL-LCA J. ART & ENT. L. 213, 215 (1996).

103. Schechter, *supra* note 102, at 825; *see also* Villwock, *supra* note 102, at 215.

104. Villwock, *supra* note 102, at 215.

105. *Id.* (citing *Tiffany & Co. v. Tiffany Prods.*, 264 N.Y.S. 459 (Sup. Ct.), *aff'd*, 260 N.Y.S. 821 (1932), *aff'd*, 188 N.E. 30 (1933)).

106. Villwock, *supra* note 102, at 215.

107. *Id.*

108. *Id.* (citing Act of May 2, 1947, ch. 307 § 7a, 1947 Mass. Acts 300) (codified as amended at MASS. GEN. LAWS ANN., ch. 110B, § 12 (West 1990)).

109. Villwock, *supra* note 102, at 215.

110. *Id.*

111. *Id.*

the United States Court of Appeals for the Seventh Circuit found that the use of the “mark ‘POLAROID’ in conjunction with a heating and refrigeration business diluted the stronger mark ‘POLAROID’ for cameras.”¹¹² Even then the court ruled that Illinois’s dilution statute was useless because “it add[ed] nothing to the established law on unfair competition.”¹¹³

In 1977, the first judicial definition of dilution¹¹⁴ was given in the New York state court case of *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*¹¹⁵ The court explained that dilution *was not* confusion.¹¹⁶ Rather, dilution was a “cancer-like growth of dissimilar products or services which feeds upon the business reputation of an established distinctive trade-mark.”¹¹⁷ Despite creating the definition, the court found that dilution had not occurred in the case.¹¹⁸ Following *Allied Maintenance*, dilution became a common allegation in jurisdictions that had created the right.¹¹⁹

A federal dilution statute was subsequently considered in the late 1980s.¹²⁰ Federal intervention was desired due to the inadequacy of an injunction without the force of federal law and the difficulty in determining the distinctiveness of a mark.¹²¹ Existing protection was lacking because only a few states recognized trademark dilution.¹²² There were the difficulties of federal courts applying state laws: a state’s inability to define the concept of distinctiveness, and the question of whether the Lanham Act preempted state law.¹²³

Additionally, there were concerns regarding the First Amendment.¹²⁴ For example, if the purpose of the infringement was for criticism, the mark could be upheld on the grounds of free speech.¹²⁵ If the motive was for profit, the speech would be portrayed as commercial, resulting in reduced constitutional protection.¹²⁶

V. TRADE DRESS

Trade dress is also protected by federal law.¹²⁷ The design or packaging of an item can acquire a distinctiveness that identifies a product with the manufacturer

112. *Id.* at 215–16 (citing *Polaroid Corp. v. Polaroid, Inc.* 319 F.2d 830, 837 (7th Cir. 1963)).

113. *Polaroid Corp.*, 319 F.2d at 837.

114. Villwock, *supra* note 102, at 216.

115. *Allied Maint. Corp. v. Allied Mech. Trades, Inc.*, 369 N.E.2d 1162, 1164 (N.Y. 1977).

116. *Id.* at 1165.

117. *Id.*

118. *Id.* at 1166.

119. Villwock, *supra* note 102, at 216.

120. *Id.* at 217.

121. *Id.*

122. *Id.* at 218.

123. *Id.* at 218–19.

124. *Id.* See, e.g., *Iancu*, 139 S. Ct. at 2297, 2998–99; *Matal*, 137 S. Ct. at 1765.

125. Villwock, *supra* note 102, at 219.

126. *Id.*

127. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001).

or source of the item.¹²⁸ The concept applies to a design or package that has also acquired a secondary meaning.¹²⁹ Assuming all the requirements have been satisfied, an item's trade dress could be used in a manner that can confuse the "origin, sponsorship, or approval of the goods."¹³⁰ Trade dress protection was created to promote competition in commerce.¹³¹

Congress amended the Lanham Act to provide statutory protection for trade dress.¹³² 15 U.S.C. § 1125(a)(1) provides:

(a) Civil action

- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.¹³³

Thus, not only does the holder of a trademark have federal protection for the mark when used in interstate commerce, the product's look, design, or dress is also federally protected.

VI. FEMALES AND THE BOY SCOUTS OF AMERICA

Female membership in various divisions of the Boy Scouts of America is not new. For over a half-century, different programs within the Boy Scouts have been available to females. In March 1971, Exploring became coed.¹³⁴ At the time, the Boy Scouts announced that, "[t]he action taken nationally was in recognition of the chartered requirements to serve boys and young men, and it would enable Exploring to more effectively carry out its mandate to meet the needs and interests of today's youth."¹³⁵ The result was that "within four years of the change, roughly

128. *Id.*

129. *Id.*

130. *Id.*

131. *Id.*

132. *Id.* at 29.

133. 15 U.S.C. § 1125(a)(1) (West 2012).

134. Wyman, *supra* note 6.

135. *Id.*

20% of Exploring members were girls.”¹³⁶ Decades later, the number had risen to nearly 40%.¹³⁷

In 1972, the word “boy” was removed from Boy Scouts of America based upon a two-year survey.¹³⁸ The national organization justified the change, stating that “‘youths were being turned off’ by the word ‘boy.’”¹³⁹ Then, in 1977, the Boy Scouts rebranded itself as “Scouting/USA.”¹⁴⁰ The national organization stated that “the word ‘boy’ is objectionable to minorities, our young adult (male and female) leaders and naturally to the young women enrolled in our coed Exploring program.”¹⁴¹ Then, by the late 1980s, the word “boy” returned to both “Boy Scouts” and “Boy Scouts of America.”¹⁴²

Exploring is not the only coed program of the Boy Scouts. Sea Scouts have been coed for years, with more than seventy percent of Sea Scout ships (the equivalent of a troop) now having female members.¹⁴³ Then there are the Venturing crews. “Venturing is the coed program of the Boy Scouts . . . for older youth [that] focus[es] on high adventure.”¹⁴⁴ Venturing was officially created on February 9, 1998, but its roots date back decades.¹⁴⁵ The Boy Scouts created a Senior Scouting program in 1935.¹⁴⁶ The program not only included Sea Scouts, but also Air Scouts and Explorers.¹⁴⁷ With the exception of Sea Scouts, the senior programs were consolidated into the Exploring program in 1949.¹⁴⁸ A new Exploring program was implemented in 1959.¹⁴⁹ Exploring then began focusing on careers.¹⁵⁰ In 1971, Exploring became coed with the upper age limit for youth being increased to twenty-one.¹⁵¹ Subsequently, Exploring became divided into two focus groups: one career-based, the other outdoor adventure.¹⁵² “[T]he career-based focus became part of the Learning for Life non-traditional program under the name Exploring” in 1998.¹⁵³ The outdoor portion became the Venturing program.¹⁵⁴

136. *Id.*

137. *Id.*

138. *Id.*

139. *Id.*

140. *Id.*

141. *Id.*

142. *Id.*

143. *Id.*

144. *History of Venturing*, SR6 VENTURING, BSA, <https://sr6venturing.org/about/history-of-venturing> (last visited Oct. 9, 2021).

145. *Id.*

146. *Id.*

147. *Id.*

148. *Id.*

149. *Id.*

150. *Id.*

151. *Id.*

152. *Id.*

153. *Id.*

154. *Id.*

VII. SO, “WHAT’S IN A NAME?”¹⁵⁵

Despite the current litigation between the Girl Scouts and Boy Scouts, a volunteer and the public are liable to say, “So what?” There is the Girl Scout program, which is a separate entity from the Boy Scouts. The Girl Scouts sell cookies,¹⁵⁶ the Boy Scouts sell popcorn.¹⁵⁷ They are two distinct programs, with different requirements. Although both provide outdoor programs and leadership training, there is no confusion between the two programs. Why worry?

The exhibits¹⁵⁸ submitted with the federal complaint establishes the problem. The headline of one newspaper states: “Boy and Girl Scouts looking for members.”¹⁵⁹ Yet, the article is strictly about the Boy Scouts. The Girl Scouts are not mentioned. The article creates the false impression that the programs have merged. Other documents erroneously state that the two programs have merged.¹⁶⁰ The documents establish incontestable trademark violations. Sadly, the violations were easily avoidable.

So, what can volunteers and the public do to help avoid violating the trademarks of the Girl Scouts? Education is the key. Boy Scout volunteers do not have the ability to defend the contested “Scout Me In” slogan.¹⁶¹ Nor can volunteers defend the allegation regarding the Boy Scout’s “new name by which it will refer to its best-known Boy Scout program – ‘Scouts BSA’ with members being called ‘Scouts.’”¹⁶² The Explorer, Sea Scout, and Venturing programs are not being challenged by the Girl Scouts. Such a challenge is not necessary. The names of these programs are distinctive and do not cause confusion or dilution with the trademarks of the Girl Scouts.

The problem is this: what do you call the female members in the Cub Scout and Boy Scout programs of the Boy Scouts of America?¹⁶³ Female Cub Scouts are easy: they are Cub Scouts. There is no difference between referring to a female Cub Scout as a Cub Scout, to a female Explorer as an Explorer, to a female Sea Scout as a Sea Scout, or to a female Venture member as a Venturer.¹⁶⁴ The real issue is the Boy Scout program. As counterintuitive as it may seem, female members of the Boy Scout program must be called Boy Scouts. Like the name

155. WILLIAM SHAKESPEARE, *ROMEO AND JULIET* act 2, sc. 2.

156. *Meet the Cookies*, GIRL SCOUTS, <https://www.girlscouts.org/en/cookies/all-about-cookies/Meet-the-Cookies.html> (last visited Oct. 9, 2021).

157. Rick Allen, *Boy Scouts Peddling Popcorn to Raise Funds*, WASH. POST (Nov. 7, 1985), <https://www.washingtonpost.com/archive/local/1985/11/07/boy-scouts-peddling-popcorn-to-raise-funds/7f8c8ea9-f6b1-4219-8f82-1ab019a2c1a8>.

158. See Complaint, *supra* note 5, and attached exhibits.

159. Complaint, *supra* note 5, Exhibit N.

160. See Complaint, *supra* note 5, and Exhibits L and O.

161. Complaint, *supra* note 5, at 3.

162. *Id.*

163. Cub Scout packs and Boy Scout troops that contain females are not coed. The packs and troops are composed of a single gender, either all female members or all male members. Complaint, *supra* note 5, Exhibit J, p. 3. The only coed programs within the national Boy Scout organization are the Explorers, Sea Scouts, and Venturers. See *supra* text accompanying notes 134–37, 143–54.

164. *Venturing Terminology*, BOY SCOUTS OF AMERICA, <https://www.scouting.org/programs/venturing/about-venturing/venturing-terminology> (last visited Oct. 9, 2021).

designations of the other program divisions of the Boy Scouts of America, female members of Boy Scout troops are Boy Scouts and must be referred to as such.

VIII. WHY NOT THE TERM "SCOUTS?"

The natural tendency is to refer to members of both programs as "Scouts," regardless of the individual's program registration or sex. However, this abbreviated reference would still be a violation of the intellectual property rights of the Girls Scouts.¹⁶⁵

In a letter dated January 23, 1979, Mr. Downing Jenks, the then National President of the Boy Scouts America, responded to a complaint

by the Girl Scouts regarding the use of the word "Scout" in an article without reference to the formal name of the Boy Scouts.¹⁶⁶ Mr. Jenks wrote that activities of the organization must be designated as being those of the Boy Scouts of America.¹⁶⁷ He conceded that the simple use of the word "Scout" is erroneous and misleading.¹⁶⁸ Mr. Jenks stated that Boy Scout councils had been instructed that activities must be referred to as those of the Boy Scouts of America.¹⁶⁹ Attached to the letter were communications from the national office of the Boy Scouts to local councils explaining that the use of the single word "Scouts" creates confusion regarding whether the "Scouts" are Girl Scouts or Boy Scouts.¹⁷⁰ The explicit instructions were to use the terms "Cub Scout," "Boy Scout," or "Explorer" to identify the three age groups in the program.¹⁷¹

The Boy Scouts had attempted to trademark the word "Scouting."¹⁷² The application was denied, however,¹⁷³ as the United States Patent and Trademark Office found the mark to be merely descriptive.¹⁷⁴ The Office noted:

The identification of goods should be identified by indicating that the scouting instructions are primarily for boys and young men, 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.¹⁷⁵

As illogical as it may seem, all members of the Boy Scouts of America, male and female, are regarded, and must be referred to, as "Boy Scouts," or as members of

165. Complaint, *supra* note 5, at 2–4, 14–15.

166. Complaint, *supra* note 5, Exhibit D.

167. *Id.*

168. *Id.*

169. *Id.*

170. *Id.*

171. *Id.* Venturing would not have been mentioned in the late 1970s because the program was not created until February 9, 1998. See *History of Venturing*, *supra* note 144.

172. Complaint, *supra* note 5, Exhibit C.

173. *Id.*

174. *Id.* As previously discussed, merely descriptive marks cannot be trademarked. See *supra* text accompanying notes 81–93.

175. Complaint, *supra* note 5, Exhibit C.

the division of the Boy Scout program to which they are registered. Otherwise, the intellectual property rights of the Boy Scouts are being expanded beyond their boundaries and would infringe upon the rights of the Girl Scouts.

The trademark “Boy Scouts” belongs to the Boy Scouts of America.¹⁷⁶ The trademark “Girl Scouts” belongs to the Girl Scouts of the United States of America.¹⁷⁷ The confusion and dilution is created because young females can now be members of both programs. Prior to allowing females into the Boy Scout program, a picture of young girls camping could be easily identified as members of the Girl Scout program. However, by allowing female members into the Boy Scout division, that simple assumption can no longer be made. Thus, a strict reference to the program in question must be followed to avoid the trademark violation and dilution complained about by the Girl Scouts.

Some simple scenarios prove the problem. A picture is taken of a group of young females around a campfire at night. No uniforms or official equipment are present. Under the picture is the statement: “Our Scout Troop Likes to Camp.” It is impossible, now that the Boy Scout of America has female troops, to determine whether that troop of young females belongs to the Girl Scout program or to the Boy Scout program. If the label states: “Our Boy Scout Troop Likes to Camp,” the confusion is resolved.

In another scenario, a group of young females are out hiking. No uniforms are present. A Boy Scout leader says, “Here comes the Scouts.” It is impossible to determine with this reference whether the Boy Scout leader is referring to a group of Girl Scouts or to a group of Boy Scouts. If the comment was, “Here comes the Explorers,” or “Here comes the Cub Scouts,” or “Here comes the Venturers,” no confusion would exist. These comments explicitly identify the programs that are specifically part of the national Boy Scout organization. The word “Scout” is not distinctive.¹⁷⁸ The proper comment for the Boy Scout leader should have been either, “Here comes the Boy Scouts,” or “Here comes the Girl Scouts.”

This is why the Girl Scouts are so adamant in protecting their trademark rights. The admission of females into the Boy Scout division of the Boy Scouts of America has created a significant threat to the intellectual property interests of the Girl Scouts. It is the responsibility of all volunteers, and the public, to be conscious of the interests of each organization and avoid the egregious errors documented in the Girl Scouts’ complaint.

IX. “SCOUT ME IN”

As part of the litigation, the Girl Scouts are contesting the Boy Scouts’ new “Scout Me In” marketing program.¹⁷⁹ The objection is valid. The Boy Scouts have previously conceded in other legal proceedings that the marks “Scouts” and “Scouting” are jointly owned by both the Boy Scouts of America and the Girl

176. Complaint, *supra* note 5, Exhibit B.

177. *Id.*

178. *See supra* text accompanying notes 166–75.

179. Complaint, *supra* note 5, at 2–3 and Exhibit I.

Scouts of the United States of America.¹⁸⁰ The Boy Scouts further admitted that “the Boy Scouts controls use of the marks in connection with development programs for boys, while Girl Scouts controls use of the marks in connection with development programs for girls.”¹⁸¹

This confession condemns the “Scout Me In” slogan to the eighth circle of Dante’s *Divine Comedy*.¹⁸² Because the “Scout” mark is shared by both the Boy Scouts and the Girl Scouts, the “Scout Me In” slogan is confusing because it fails to identify which organization the slogan is promoting; therefore, the public confusion complained of by the Girl Scouts.

Added to this stew is the fact that females are now members of Boy Scout troops. By allowing female membership into the Boy Scout program, the national Boy Scout organization has expanded its admitted developmental program beyond its traditional focus on boys.¹⁸³ This expansion is why the additional terms “Boy” and “Girl” are so essential in any advertising and marketing campaigns of both organizations.

To be in compliance with the respective property rights of each organization, the marketing slogan could be “Boy Scout Me In”, “BSA Me In”, “Scout Me In, BSA,” or “Scout Me In With BSA”; these proposed modified slogans explicitly identify the particular program, are consistent with the trademark rights of the Boy Scouts, and avoid any confusion with the Girl Scout program.¹⁸⁴

X. EDUCATE, EDUCATE, EDUCATE

While the flames and smoke of the raging litigation campfire between the two organizations blinds and chokes the volunteers who are trying to help the country’s youth, what is the role of a Boy Scout volunteer and the public in this situation? The role is one of education. The use of the proper terminology referring to female members of the Boy Scouts is no different than teaching a square knot to a Tenderfoot Scout candidate. It is becoming familiar with the nuances of the programs.

Volunteers must train themselves to consistently use the terminology of the program in question. Explorers are referred to as Explorers, Cub Scouts are referred to as Cub Scouts, Boy Scouts are referred to as Boy Scouts. Volunteers and the public must become gender blind. The programs have not changed with the inclusion of females in the Cub Scout and Boy Scout divisions; they are the same programs with new diverse memberships.

The worst mistake any member of the Boy Scout program can make is using the word “girl” with the word “scout.” The lethal concoction of these two words is a violation of the intellectual property rights of the Girl Scouts. A member of a

180. Complaint, *supra* note 5, Exhibit B.

181. *Id.* at 21.

182. The eighth circle of Dante’s *Divine Comedy* is fraud. See Adam Burgess, *A Guide to Dante’s 9 Circles of Hell*, THOUGHTCO. (Nov. 1, 2019), <https://www.thoughtco.com/dantes-9-circles-of-hell-741539>.

183. See *supra* text accompanying note 181.

184. See Domonoske, *supra* note 4.

particular Boy Scout program must be referred to as a member of that division – it is that simple. Gender clarification is not required. The differentiation has never been required in the half-century since the establishment of coed Exploring posts. No such sexist terminology is now required in the Cub Scout and Boy Scout divisions.

All volunteers and professionals of the Boy Scout organization must be ever mindful of the rights of the Girl Scouts. Terminology must be practiced and shared among all registered Boy Scouts. Boy Scout units need to understand that any references to their unit must be the same as the division of the Boy Scout program to which the unit is assigned, regardless of gender composition. Any communication, in any format, should simply refer to the Boy Scouts of America or to the appropriate program division.¹⁸⁵

The consistent use of the applicable program names will ensure that the members of the unit will protect the intellectual property rights of both the Girl Scouts and the Boy Scouts. Like Argus Panoptes, the eyes of volunteers must never rest.¹⁸⁶

XI. CONCLUSION

Thus, members of both the Girl Scouts and the Boy Scouts can play an important role in protecting the intellectual property interests of each organization. Unnecessary and costly litigation can be avoided. With education among its membership, two of the finest youth organizations of the United States can concentrate their limited resources on the real purpose of their institutions: serving the youth of this country. The resulting “Kumbaya moment” will mean that the popcorn will continue to pop over the campfire and the cookies will remain sealed in plastic for freshness.

185. *See supra* text accompanying notes 166–75.

186. Argus Panoptes, GREEKMYTHOLOGY.COM, https://www.greekmythology.com/Myths/Creatures/Argus_Panoptes/argus_panoptes.html (last visited Oct. 9, 2021) (“Argus Panoptes or Argos was a hundred-eyed giant in Greek mythology. He was a giant, the son of Arestor, whose name ‘Panoptes’ meant ‘the all-seeing one.’”).

