

Procedures Protect BSA Trademarks for Future Generations

By Richard John Mathews, deputy general counsel and David Harkins, licensing and royalty programs

We've all benefited from advancements in technology, allowing us to pay bills, search for new products, or screen the latest movies with ease from our personal computers. Unfortunately, this same technology has made it relatively easy to create printed materials, embroidery, and other products bearing the proprietary marks, words, and phrases of the Boy Scouts of America without permission.

The Importance of Protecting BSA Trademark Assets

As the unauthorized use of BSA trademarked words, phrases, emblems, and insignia grows, the National Council must take action to prevent offensive, inappropriate, and inconsistent use of BSA trademark assets in the marketplace to protect these assets for future generations.

In late 2005, the BSA significantly improved its product-licensing program to put the National Council in better control of third-party use of BSA trademarks. Although many of these procedures have provided significant control over BSA brands, some misunderstandings remain as to who has the right to grant the use of the Boy Scouts of America's proprietary marks, words, and phrases to others. Many who are infringing have mistakenly believed that they were authorized to use BSA trademarks simply by obtaining what they thought was permission from a local council or unit. This is not accurate. *Only the BSA National Council may grant the rights for the use of BSA trademarks to any third party*, as granted in 1916 by the U.S. Congress federal charter (36 USC § 21 et. Seq.), which gives the BSA "the exclusive right to use emblems, badges, descriptive or designating marks, and words and phrases (BSA) adopts."

A Clarification for the Use of BSA Trademarks

For those working with local councils: To eliminate any confusion over who

had the right to grant the use of BSA trademarks, and legal requirements to enforce trademark rights, the National Council clarified the use of such proprietary marks, words, and phrases to local councils in October 2006. Included in this clarification were two key items:

- 1 The BSA must license all suppliers providing materials to local councils, which use BSA proprietary marks. The license will establish the standards under which BSA proprietary marks may be used.

This means that all products bearing BSA proprietary marks created by a third party, which are not for an administrative or educational purpose (as shown in the chart), must be produced under license.

- 2 A local council may not use BSA proprietary marks for commercial purposes (e.g., where a third party, in any way, benefits financially), nor may a local council grant such rights, either actual or implied, to any third party.

This means that a supplier may not produce, nor may a council request the production of, any product bearing a BSA trademark that will be sold (or will likely be resold) to a council, to BSA members, or to the general public without a license granting authorization for the production of such products.

For supporters of local councils who wish to donate products to a local council that will bear any BSA trademark(s), there is a royalty waiver provision, provided the product is not sold or resold. Permission for such a waiver must be obtained in advance.

BSA National Council groups, divisions, and departments are also responsible for adhering to these same requirements and standards for product purchases and must use either the Supply Group or an official licensee. The Supply Group, which is specifically charged with serving as the designated product supplier for the Boy Scouts of America, holds its vendors to a review process very similar to that of licensees.

Please note that the responsibility for becoming a BSA licensee rests with the manufacturers and suppliers and not with councils, chartered organizations, units, or volunteers.

What This Means to a Scouting Volunteer or Parent

As a Scouting professional, you can help explain that for some, this will be a significant change in the way products, such as T-shirts or patches, are purchased. In the past, a BSA trademark might simply be provided to a third party for reproduction, and while this third party did not have authorization to reproduce the trademark on a T-shirt or patch, they might have created a product anyway. Today, you should use only BSA official licensees to produce products bearing BSA trademarks.

Official licensees are contractually bound and regularly monitored by the BSA to ensure that they adhere to product quality standards, maintain levels of insurance necessary to protect the end user (and the BSA) in the case of product failure, and abide by a code of conduct that compels them, among other things, to provide acceptable working conditions for those producing products bearing BSA trademarks. The most recent version of the list of official licensees is available on ScoutNET, under BSA Info, and www.bsalicensing.org. Products that do not bear the Officially Licensed Product seal are not authorized by the BSA and, therefore, are not necessarily produced to BSA standards.

The BSA believes its members benefit because:

Scouting values are upheld.

Customers can be assured that a program exists to prevent the use of BSA marks or words and phrases in obscene, pornographic, commercially exploitive, or other ways inconsistent with the values and principles of the BSA.

Product confidence is increased. Products produced under BSA license undergo a stringent review process to uphold quality standards. Official BSA licensees are subject to regular review of their manufacturing processes and must comply with rigid product liability and safety requirements.

A greater range of products and services will be offered. Controlled licensing offers the BSA an opportunity to broaden the range of product quality and relevance, as well as services offered to BSA members, parents, and alumni.

The availability of products with BSA trademarks is increased. Officially licensed products can be offered in a variety of retail stores, making many BSA-branded products more easily accessible than ever before.

These are important changes for the Boy Scouts of America. Protecting our brands and creating stronger controls and programs for licensing our proprietary marks, words, and phrases will yield positive results for our members, local councils, and the National Council. Many local councils have already established unit and volunteer procedures to ensure that, when using BSA trademarks, they comply with these requirements. Please check

your local council's written procedures before producing a T-shirt, patch, or other product bearing a BSA trademark.

We encourage you to support this effort to protect BSA trademarks by buying, and encouraging others to buy, only official Boy Scouts of America products purchased from BSA Supply or BSA officially licensed suppliers.

Anyone seeking to use any marks, words, or phrases that may reasonably be related to the BSA and its programs should contact the BSA Legal Department at 972-580-2000 before such use. Requests for a licensing application or questions about licensing should be e-mailed to licensing@netbsa.org, or call 800-323-0732. In your planning, please allow 30 days for the licensing approval process to be completed.

Royalty and non-royalty items include, but may not be limited to, the following list. This list is subject to change.

Item	License required?	Royalty?	Primarily affects:
Stationery (letterhead, business cards, envelopes)	No	No	Councils Chartered organizations Units
FOS brochures and letters	No	No	Councils
Annual reports	No	No	Councils
Council and unit newsletters	No	No	Councils Units
Council and unit Web sites (informational only)	No	No	Councils Chartered organizations Units
Forms and council informational brochures	No	No	Councils
Donated items (by third party to a local council)	Yes; one-time, single-use license	Generally no; but an approved royalty waiver is required before beginning the project	Councils
Donor gifts (items purchased to give as premiums to donors)	Yes	Yes	Councils
Apparel (T-shirts, staff shirts, etc.)	Yes	Yes	Councils Units
Emblems and patches	Yes	Yes	Councils Chartered organizations Units
Signs and banners	Yes	Yes	Councils Chartered organizations Units
Recruiting printed materials (when using a commercial printer)	Yes	Yes	Councils Units
Non-council and non-unit Web sites	Yes	Yes	Volunteers Third parties