

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

FILED
FEB 17 2008
USDC W.P. SDNY

<p>ROBERT BURCK d/b/a THE NAKED COWBOY, Plaintiff, v. MARS, INCORPORATED and CHUTE GERDEMAN, INC. Defendants.</p>	<p>NO. 08 CIV. 1330 JUDGE CHIN</p>
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COMPLAINT

Parties

1. Plaintiff herein is Robert Burck d/b/a The Naked Cowboy ("Burck"), an adult individual residing in the State of New Jersey.

2. Defendants herein are:

(A) Mars, Incorporated ("Mars"), a corporation with a principal place of business at 6885 Elm Street, McLean, Virginia, 22101; and

(B) Chute Gerdeman, Inc. ("Chute Gerdeman"), a corporation with a principal place of business at 455 South Ludlow Street, Columbus, Ohio, 43215.

(C) Moreover, each of the Defendants herein is subject to the personal jurisdiction of this Court because, as alleged herein, each Defendant had sufficient contacts with New York State, and purposely availed itself of the benefits and protections of New York State's laws by establishing substantial contacts with New York State. Indeed, specific jurisdiction over each Defendant exists because each Defendant, as alleged herein, had numerous, prolonged and substantial contacts with New York State

which arise from or are directly related to Plaintiff's causes of action.

Statement of Jurisdiction

3. Jurisdiction is proper in this Court pursuant to 28 U.S.C. §1331 as Plaintiff has pled causes of action arising under federal trademark law.

4. Venue is proper in this judicial district given that all or substantially all of the acts giving rise to Plaintiff's claims occurred in New York City.

Statement of Facts

5. Over the past decade, Plaintiff Burck has performed as a street entertainer in New York City's Times Square under the persona known as The Naked Cowboy.

6. Always in character, Burck has performed live for hundreds of thousands of people in his trademarked get-up, which features a white cowboy hat, white cowboy boots, white underpants, and an acoustic guitar.

7. The Naked Cowboy's street performances, also known as "busking," have become a fixture of New York City culture, as well as one of the top tourist attractions for visitors to Times Square.

8. Burck began his street performance career in 1998 after a shoot at Playgirl, and first appeared on Venice Beach. After some disappointing starts, a friend had suggested to him that he dress only in his underwear.

9. The suggestion proved to be a good one, as The Naked Cowboy's unmistakable persona, underwear included, has been the *sine qua non* of a surging career as the most famous busker in the entertainment capital of the world.

10. Burck's character, in addition to being a Times Square staple, has appeared in a variety of media.
11. He auditioned in character for "American Idol" during its first season, as well as for the talent show "Star Search."
12. His character is part of USA Network's "Characters Welcome" campaign.
13. He appeared briefly in the PBS documentary Origins to give his opinion on the possibility of extraterrestrial life.
14. He is featured singing in the video game "True Crime: New York City at Times Square."
15. He has appeared in several movies and television programs, including "Starship Dave," "Survive This," "Mulva: Zombie Ass Kicker," "Steve Harvey's Big Time," "New York Minute," "Creature Feature," "Lonely Planet," "Troma's Edge," "American Icon," and "The Howard Stern Show."
16. He appeared on an episode of the game show "Street Smarts," and featured in the music clip for a song by the rock band "Cake."
17. He also appeared in a music video for the song "Rockstar" by the multi-platinum artist "Nickelback."
18. He recently released an album featuring many of his own original songs which he performs for live audiences.
19. In addition to his live appearances in Times Square, he is a regular in the streets of the French Quarter during the New Orleans Mardi Gras season and the Labor Day Riverfest Festival in Cincinnati, Ohio. He has also appeared in Austin, Texas during the South by Southwest Music Conference.

20. The Naked Cowboy is a prominent and well-known persona, particularly in the area where the infringements described below have taken place.

21. The Naked Cowboy's name and likeness are registered trademarks owned by Burck.

22. Burck has licensed The Naked Cowboy name and/or likeness to companies for the purposes of advertising and endorsement.

23. The Naked Cowboy, for instance, appeared in a Chevrolet commercial which debuted during Super Bowl XLI.

24. As one would expect, in light of the trademarks held by Burck for his persona, he requires compensation for the use of his name and/or likeness for commercial purposes.

25. Defendants Mars and Chute Gerdeman, however, decided to exploit and trade upon The Naked Cowboy's well-recognized likeness without a license and without furnishing any compensation.

26. Since April 2007, on two oversize video billboards situated in the heart of Times Square, Mars has been running an animated cartoon advertisement featuring a blue "M&M" dressed up exactly like The Naked Cowboy—white underwear, white cowboy hat, white cowboy boots, and white guitar included.

27. The M&M in question is unmistakably a reference to, and incorporation of, The Naked Cowboy's trademarked likeness.

28. Just like The Naked Cowboy does on a daily basis in Times Square, the M&M is not only dressed as “The Naked Cowboy,” it is playing The Naked Cowboy’s distinctive white guitar in the cartoon.

29. This video ad has evidently been running around the clock every three minutes or so since April 2007.

30. There is also a pictorial version of the “Naked Cowboy” M&M. This version depicts a yellow M&M posing in the same trademarked get-up described in paragraph 25.

31. Burck seeks to be compensated for the ongoing infringement of both his federal trademark rights, as well as the infringement of his rights of publicity under New York law.

32. Upon information and belief, Defendant Chute Gerdeman is the agency which created both the video ad and the pictorial ad featuring the “Naked Cowboy” M&M, and sold same to Defendant Mars for profit and for the purpose of helping Defendant Mars increase its sales and profits with respect to its products..

33. Upon information and belief, Mars is the purveyor of the M&M product, as well as the company which retained Chute Gerdeman to produce the infringing ads.

34. By correspondence dated January 2, 2008, Burck, through his counsel, demanded that the Defendants cease and desist the infringements of his trademark rights and right to publicity. The correspondence to Mars read as follows:

This law firm has been retained to represent the interests of Robert Burck d/b/a The Naked Cowboy (hereinafter “Mr. Burck”) in connection with the apparent infringement by Mars, Incorporated (“Mars”) of certain trademark—and other—rights owned by and inuring to the benefit of Mr.

Burck. As we understand the facts, Mars has featured an advertisement featuring an animated blue M&M trading upon the likeness and persona of Mr. Burck's trademarked and proprietary character, The Naked Cowboy. The video version of the ad advertisement has been running on a Times Square video billboard every 3 minutes around the clock, dating back to at least April 1, 2007. Further, a pictorial version of a yellow M&M dressed in the same manner has also been utilized.

As you may be aware, Mr. Burck deems the above unlicensed use of his likeness and persona objectionable and illegal. Not only does the use amount to a violation of the federal Lanham Act protecting registered trademark rights, it is also a clear violation of New York's statutory prohibition on infringements of one's "right of publicity." New York law provides some of the most expansive protection for individuals whose image, likeness and/or persona is exploited without their consent for a commercial purpose. As observed by the United States District Court for the Southern District of New York in *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, "the right of publicity [under New York law] recognizes the commercial value of the picture or representation of a prominent person or performer, and protects his proprietary interest in the profitability of his public reputation or 'persona.'" Lest there be any doubt as to the prominence of Mr. Burck's character, it must be noted that over the past ten years, The Naked Cowboy has grown to be one of Times Squares' most recognized and sought-after attractions. The fact that the infringement of Mr. Burck's rights has resulted from a Times Square video billboard only accentuates the illegality of the exploitation.

At this point, unless Mars agrees to adequately compensate Mr. Burck for the continued use of his likeness in the above-described ad (or in any other marketing medium of any kind), we are hereby making demand that Mars—together with any of its affiliates, representatives, agents, subsidiaries, or assignees—immediately cease and desist all such unauthorized use of same. We further demand that Mr. Burck be appropriately compensated for all instances of past infringement in an amount equal to \$1,500,000.00.

Please contact me within ten days to (1) advise that Mars will, without delay, cease and desist all use of The Naked Cowboy's likeness and persona, and (2) discuss the above monetary demand. Failing to hear from you within that time, we intend to file suit on Mr. Burck's behalf in a federal court of competent jurisdiction without further notice.

35. A correspondence with substantially the same content was likewise sent to Defendant Chute Gerdeman on the same date.

36. Following the demand to cease and desist the infringements, neither Defendant has done so, nor have they communicated any intention to do so. The advertisements at issue have continued to run. Defendants, therefore, despite Plaintiff's demands to cease and desist, are knowingly and maliciously continuing to wrongfully use and exploit Plaintiff's trademarks, persona, image, likeness, picture, and/or name.

37. Chute Gerdeman has actually denied that they were involved in the production of the ad, despite content on their own website which indicates otherwise.

38. Counsel for Mars wrote to the Plaintiff's undersigned Pennsylvania counsel several weeks ago merely to acknowledge receipt of the cease and desist letter, and promised to provide a substantive response. No such substantive response has been received by Plaintiff's counsel to date.

39. Burck has satisfied all conditions precedent to his right to recover pursuant to the provisions of federal and state law set forth below.

COUNT I
Violation of 15 U.S.C. § 1125(a)

40. Burck incorporates the foregoing allegation of this Complaint as if set forth at length herein.

41. Defendants, individually and/or jointly, have effected a false endorsement of the M&M product by featuring The Naked Cowboy in the above-described advertisements. Defendants' conduct has implied, falsely, that Burck's character, The Naked Cowboy, endorses the M&M product.

42. Defendants' conduct further amounts to a misappropriation of The Naked Cowboy's celebrity persona, the trademark of which is owned by Burck.

43. Defendants' conduct further amounts to both false association and unfair competition as defined in the Lanham Act.

44. Defendants' conduct has caused Burck to suffer losses in an amount equal to the full extent of recoverable damages permitted under the Lanham Act. Specifically, he seeks to recover his actual damages (including a reasonable license fee), the Defendants' profits, treble damages, attorney's fees, costs of suit, and interest.

COUNT II
Violation of N.Y. Civil Rights Law § 51

45. Burck incorporates the foregoing allegations of this Complaint as if set forth at length herein.

46. By reason of the aforesaid, Defendants knowingly, intentionally, and maliciously, used, published, and disseminated, and continue to knowingly use, publish and disseminate, Plaintiff's likeness, persona, picture, image, and/or name, within the State of New York, for purposes of advertising and/or trade, to promote the sale of Mars's products, without Plaintiff's written consent; and Defendants have caused to be transferred, circulated, sold, distributed, used, displaced, advertised, reproduced and/or published, both directly and indirectly, through diverse media, certain unauthorized representations of Plaintiff's likeness, persona, picture, image and/or name. Defendants' conduct, which continues unabated, constitutes an unauthorized use of The Naked Cowboy's likeness, persona, picture, image, and/or name, for an advertising and/or trade purpose, as defined under and/or pursuant to N.Y. Civil Rights Law § 51.

47. Defendants' conduct has caused Burck to suffer losses in an amount equal to the full extent of the damages permitted under N.Y. Civil Rights Law § 51.

Specifically, he seeks to recover his actual damages (including a reasonable license fee), the Defendants' ill-gotten profits gained from the aforesaid wrongful conduct, punitive damages, costs of suit, and interest.

48. Defendants have engaged in this selfish exploitation of Plaintiff's identity and persona for their own personal and commercial gain, and said Defendants have maliciously and unlawfully invaded Plaintiff's privacy and/or publicity rights in violation of §§ 50 and 51 of the N.Y. Civil Rights Law.

49. Defendants have caused Plaintiff to suffer serious irreparable harm, and caused him to be held to public view in a damaging manner, and as a direct and proximate result, Plaintiff has suffered and continues to suffer severe damages, including but not limited to a loss of personal and professional reputation and goodwill, lost earnings, and lost potential earnings, all in a sum not less than \$2,000,000.00.

50. Plaintiff's measure of compensatory damages, likewise, includes the extent to which Defendants' use of Plaintiff's image, persona, likeness, picture, and/or name, increased, and continues to increase, Defendant Mars's profits.

51. In addition, the reprehensibility of Defendants' conduct, in knowingly and maliciously using, publishing, and disseminating Plaintiff's image, persona, likeness, picture, and/or name, and Defendants' prolonged knowing and malicious continued use, publication and dissemination, as aforesaid, in wanton and reckless disregard of the harm caused to Plaintiff, and for the selfish motivation of increasing their profits, gives rise to punitive damages in favor of Plaintiff and against Defendants in a sum not less than \$2,000,000.00.

WHEREFORE, based on the aforesaid, Plaintiff respectfully requests that this Court issue a judgment in its favor and against Defendants, jointly and severally, as follows:

1. With respect to Count I, compensatory damages in a sum not less than \$2,000,000.00, plus treble damages, and attorney's fees;
2. With respect to Count II, compensatory damages in a sum not less than \$2,000,000.00, plus punitive damages in a sum not less than \$2,000,000.00, and attorney's fees; and
3. The costs and disbursement incurred in this action, along with any other, different or further relief as to this Court may seem just, proper, or necessary.

JURY DEMAND

Plaintiff hereby demands a trial by jury on all counts pled herein.

Dated: February 8, 2008
Orangeburg, New York

Respectfully submitted,

KEVIN T. MULHEARN, P.C.

By: 

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Civil Action No.

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ROBERT BURCK d/b/a THE NAKED COWBOY,

Plaintiff,

- against -

MARS, INCORPORATED and CHUTE GERDEMAN, INC.,

Defendants.

COMPLAINT

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Pursuant to 22 NYCRR 130-1.1, the undersigned, an attorney admitted to practice in the courts of New York State, certifies that upon information and belief and reasonable inquiry, the contentions contained in the annexed document are not frivolous.

Dated: February 8, 2008

Signature.....

Print Signer's Name: KEVIN T. MULHEARN

Service of a copy of the within

is hereby admitted.

Dated:

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Attorney(s) for