

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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STUART FRANKEL,

Plaintiff,

v.

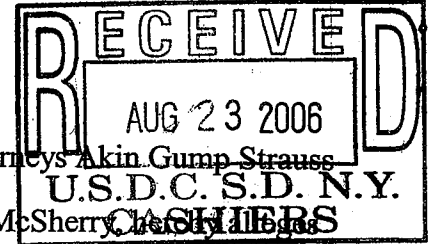
LYONS PARTNERSHIP L.P.,

Defendant.  
-----x

JUDGE STANTON

COMPLAINT

Case No. **06 CV 6413**  
Jury Trial Demanded



Plaintiff Stuart Frankel ("Dr. Frankel"), by and through his attorneys Akin Gump Strauss Hauer & Feld LLP and Fred von Lohmann, Jason Schultz & Corynne McSherry, et al., for his Complaint against Defendant Lyons Partnership, L.P. ("Lyons"), as follows:

**PRELIMINARY STATEMENT**

1. This is an action for Declaratory Judgment, arising from unfounded allegations and legal threats Lyons repeatedly made against Dr. Frankel in connection with his noncommercial website parody of the television show, *Barney and Friends*, and its star, Barney, the fictional purple dinosaur. Lyons' allegations and legal threats constitute an interference with Dr. Frankel's First Amendment-protected right to free expression. He therefore seeks a declaration that his parody qualifies as a fair use and does not infringe any protected copyright or trademark interest owned or controlled by Lyons.

**PARTIES**

2. Plaintiff Stuart Frankel is an individual residing in New York, New York. He maintains a personal website at <<http://www.dustyfeet.com>>.

3. Defendant Lyons Partnership, L.P., is a Texas limited partnership, with its headquarters in Allen, Texas.

## JURISDICTION AND VENUE

4. This Court has jurisdiction over the subject matter of this action pursuant to 17 U.S.C. §§ 1331 and 1338(a), as this action arises under the copyright and trademark laws of the United States.

5. Lyons has sufficient contacts with this district generally and, in particular, with the events herein alleged, that Lyons is subject to the exercise of jurisdiction of this Court over its person and that venue is proper in the Southern District of New York pursuant to 28 U.S.C. § 1391.

## FACTUAL ALLEGATIONS

6. Dr. Frankel maintains a personal website titled "Stuart Frankel's very small webpage," available at <<http://www.dustyfeet.com>>. Prior to November 2001, his site was also available at <<http://www.asan.com/users/gecko/>>.

7. Dr. Frankel's website serves as his personal homepage where he posts information and content that he finds interesting. Content on the website includes information on building a clavichord, a collection of Javanese culinary recipes by a Javanese musician, and Dr. Frankel's dissertation in the Department of Music at New York University, titled *Phonology, Verse Metrics, And Music*.

8. Dr. Frankel's website is entirely noncommercial in nature.

9. Dr. Frankel's website includes a web page, located at <<http://www.dustyfeet.com/evil/enemy.html>>, that pokes fun at the children's television show, *Barney and Friends*, and specifically at its main character, Barney, a fictional purple dinosaur. See Exhibit 1 This parody humorously suggests that Barney lives a secret "double life," with the character's friendly, public persona serving to conceal the dinosaur's true evil nature. In order to further illustrate this parodical message, the web page includes contrasting images of Barney: one image as the character appears on *Barney and Friends*, and another, entitled "What Barney Looks Like After the Show," featuring the character with horns, sharp teeth, a pentagram, and the number "666" emblazoned on his chest.

10. On February 11, 2002, Dr. Frankel received an email message from Matthew W. Carlin, legal counsel to Lyons, alleging that the parody web page violated Lyons' legal rights. See Exhibit 2 In the message, Mr. Carlin characterized Lyons as "owners of the children's character Barney, the purple dinosaur." The email message further alleged that Dr. Frankel's website "uses copyrighted Lyon's Partnership materials," and "insist[ed] that [Dr. Frankel] remove these copyrighted Barney materials." The email message expressly stated that Dr. Frankel's parody was "unlawful (pursuant to 17 U.S.C. § 501(a) and other laws)," and further mentioned that Lyons might "pursue legal remedies or contact your Internet Service Provider ('ISP') and inform it of your unlawful use of copyrighted materials (which is presumably a violation of your ISP's terms of service)."

11. On February 21, 2002, Dr. Frankel received a second email message from Mr. Carlin. See Exhibit 3 The message repeated the allegations contained in the February 11, 2002 message and further stated, "THIS IS YOUR SECOND NOTICE. We must hear from you by March 4, 2002. Your response must provide written assurances by that [sic] you have ceased and desisted from reproducing, distributing, performing by means of digital audio transmission, or displaying the copyrighted character Barney."

12. On March 1, 2002, Dr. Frankel responded by letter to Mr. Carlin through counsel. See Exhibit 4. The letter clearly informed Mr. Carlin that Dr. Frankel's parody of Barney constitutes a fair use, is entirely lawful, and that Lyons' contrary allegations were without legal foundation.

13. On October 11, 2005, Dr. Frankel received another "cease and desist" letter from Mr. Carlin, nearly identical to those received in February 2002. See Exhibit 5. The letter does not acknowledge the March 1, 2002 letter sent by Dr. Frankel's counsel. The letter states that Lyons is "the owners of the exclusive right to use the copyrighted children's dinosaur character Barney® as well as the federally registered and famous trademark and service mark Barney." The letter goes on to threaten legal action against Dr. Frankel, as well as threatening to interfere

with Dr. Frankel's contractual relationship with the Internet Service Provider hosting his website, stating that "Lyons Partnership would prefer not to have to pursue legal remedies or contact your Internet Service Provider ('ISP') and inform it of your unlawful use of copyrighted materials (which is presumably a violation of your ISP's terms of service). To avoid this, please provide us with written assurances by October 18, 2005, that these materials have been removed. If we do not receive a response, we will be forced to take other measures to have the content removed."

14. On October 14, 2005, Dr. Frankel again responded through counsel to Mr. Carlin. See Exhibit 6 (without attachment). The letter pointed out again that Dr. Frankel was represented by counsel, reminded Mr. Carlin of "the clear legal prohibition against direct communications to represented parties," and requested that "in the future [Mr. Carlin] abide by the clear ethical rules preventing direct contact to represented parties and direct all future correspondence on this topic to [counsel]." The letter also reiterated that Dr. Frankel's website does not violate any intellectual property rights asserted by Lyons.

15. On June 2, 2006, Mr. Carlin sent a *fourth* harassing communication directly to Dr. Frankel regarding his Barney parody web page. See Exhibit 7. The letter did not acknowledge Dr. Frankel's prior responses and was substantially identical to the prior messages, alleging infringement of Lyons' intellectual property rights and demanding that all Barney images be "immediately removed." Once again, Lyons threatened to "pursue legal remedies or contact your Internet Service Provider ('ISP') and inform it of your unlawful use of copyrighted materials."

16. In none of the communications directed at Dr. Frankel has Lyons responded to (or even acknowledged) any of Dr. Frankel's arguments rebutting Lyons' intellectual property claims. Nevertheless, each of Lyons' messages threaten imminent legal action against Dr. Frankel.

17. In addition, Lyons' messages threaten interference with Dr. Frankel's relationship with his ISP, threats that could lead to the removal of Dr. Frankel's website from the Internet. Accordingly, Lyons' threats jeopardize Dr. Frankel's free expression rights, as well as his

commercial relationship with his ISP.

18. Lyons has a history of aggressively enforcing its intellectual property rights in court, including claims against individuals and for parodies.

19. In 1998, Lyons had brought more than 77 lawsuits in 20 states based on its intellectual property claims.

20. In 1999, it sued additional commercial entities and individuals under copyright and trademark laws for the use of Barney costumes, and in 2002 it sued Pamela Holmes, an individual costume performer.

21. Lyons has also gone so far as to sue an individual performing as a sports mascot, "The Famous Chicken," over a parodical comedy sketch used in the mascot's performances. *Lyons Partnership v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999).

22. Lyons has also issued legal threats to other parodies published on the Internet, several of which have succeeded in intimidating parodists into removing their works from circulation.

23. The relief sought in this action would finally resolve this matter by determining the rights of the parties with respect to Dr. Frankel's website, relieving the anxiety created in Dr. Frankel about the lawfulness of his creative expression.

#### **COUNT 1: DECLARATORY RELIEF**

24. Plaintiff repeats and incorporates herein by reference the allegations in paragraphs 1-23 as if set forth fully herein.

25. Dr. Frankel maintains, and intends to continue making available, his parody of Barney on the web page located at <<http://www.dustyfeet.com/evil/enemy.html>>.

26. The materials available at <<http://www.dustyfeet.com/evil/enemy.html>> and their publication via Dr. Frankel's website constitute fair use and do not infringe any copyright interests owned or controlled by Lyons.

27. The materials available at <<http://www.dustyfeet.com/evil/enemy.html>> and their publication via Dr. Frankel's website do not infringe any trademark or service mark interests owned or controlled by Lyons, nor violate any provisions of the Lanham Act.

28. The "cease and desist" messages sent to Dr. Frankel were intended to create, did create, and continue to create in Dr. Frankel a reasonable apprehension that he will be sued by Lyons if he does not comply with Lyons' demands.

29. There is a real and actual controversy between Dr. Frankel and Lyons over whether Dr. Frankel's use of the images constitutes infringement of Lyons' copyrights or trademarks.

30. Dr. Frankel seeks a declaratory judgment pursuant to 28 U.S.C. § 2201 and Federal Rule of Civil Procedure 57 for the purpose of determining and adjudicating questions of actual controversy between the parties.

#### **DEMAND FOR JURY TRIAL**

31. Dr. Frankel requests a jury trial for all issues triable by jury including, but not limited to those issues and claims set forth in any amended complaint or consolidated action.

#### **PRAYER FOR RELIEF**

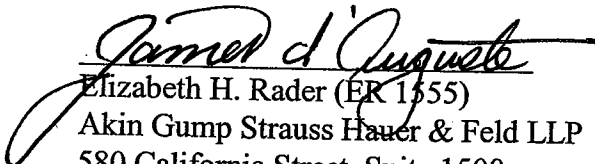
**WHEREFORE**, Dr. Frankel requests that the Court enter judgment in his favor and against Lyons on his Complaint as follows:

1. Declaring that Dr. Frankel is not liable for infringing any copyright interest owned or controlled by Lyons;
2. Declaring that Dr. Frankel is not liable for infringing any trademark or service mark interest owned or controlled by Lyons;
3. Awarding Dr. Frankel his costs incurred in this action, together with reasonable attorneys' fees pursuant to statute; and
4. Granting such other and further relief as the Court shall find just and proper.

Dated: August 23, 2006

Fred von Lohmann  
Jason Schultz  
Corynne McSherry  
Electronic Frontier Foundation  
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(415) 436-9333  
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Respectfully submitted,

  
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(212) 872-1000  
(212) 872-1002 (fax)

*Attorneys for Plaintiff Stuart Frankel*

**EXHIBIT 1**

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## This is the Enemy:



The Enemy is not a purple dinosaur. The Enemy drains the life forces from the unwary, leaving behind lifeless husks. The Enemy is concerned with selling itself. It has turned PBS into a Merchandise Mart, and cleverly insinuated its cheesy products into the most treacly web sites (note the lower right-hand corner of this one).

It is known by many names. Some call it Satan. Some call it The Antichrist, although the site which promulgates this truth is mysteriously shrinking, and many of the links devoted to fighting the Enemy are mysteriously no longer valid. Candid pictures of the Enemy, without its familiar disguise, can be found here. (The image at the bottom of this page was taken from there.)

Many are participating in this noble struggle. The best source of background information is here. The Jihad To Destroy Barney has some useful things, but is principally a role-playing game: the kitschification of a noble cause, perhaps indicative of Enemy activity. For a morale-boosting exercise, go here. Many tasty tips for preparing the Enemy can be found in the Barney Cookbook, here. Sound and movie files and a couple of excellent pictures can be found here.

The way home lies through the Enemy  
*The Enemy is dangerous!*  
*Do not take it lightly!*



**EXHIBIT 2**

February 11, 2002

BY E-MAIL: gecko@dustyfeet.com

Re: Copyrighted Barney Images on Your Website

Dear Sir or Madam:

This firm is counsel to Lyons Partnership, L.P. (?Lyons Partnership?), the owners of the children?s character Barney® the purple dinosaur.

It has come to the attention of Lyons Partnership that you are operating a website found at [www.asan.com/users/gecko/enemy.html](http://www.asan.com/users/gecko/enemy.html). Your website uses copyrighted Lyon?s Partnership materials and describes the use and threat of violence towards Barney. We are writing to insist that you remove these copyrighted Barney materials.

The images you are using of Barney are the intellectual property of Lyons Partnership. It is unlawful (pursuant to 17 U.S.C. § 501(a) and other laws) to use this property without the permission of Lyons Partnership. These materials must be immediately removed. Lyons Partnership would prefer not to have to pursue legal remedies or contact your Internet Service Provider (?ISP?) and inform it of your unlawful use of copyrighted materials (which is presumably a violation of your ISP?s terms of service). To avoid this, please provide us with written assurances by February 21, 2002, that these materials have been removed. If we do not receive a response, we will be forced to take other measures to have the content removed.

Please contact the undersigned if you require additional information.

Sincerely,

GIBNEY, ANTHONY & FLAHERTY, LLP

By: \_\_\_\_\_/s/  
Matthew W. Carlin

**EXHIBIT 3**

February 21, 2002

BY ELECTRONIC MAIL  
Gecko@dustyfeet.com

Re: Unauthorized Use of Intellectual Property

Dear Sir or Madam:

As you are aware, this firm is counsel to Lyons Partnership, L.P. ("Lyons Partnership"), the owners of the exclusive right to use the copyrighted children's dinosaur character Barney®.

We previously notified you of our client's objection to your website <http://www.asan.com/users/gecko/enemy.html> on the basis that it incorporates copyrighted images without permission from Lyons Partnership.

Lyons Partnership maintains its objection to your use of our copyrighted images as set forth in our February 11, 2002 letter.

THIS IS YOUR SECOND NOTICE. We must hear from you by March 4, 2002. Your response must provide written assurances by that you have ceased and desisted from reproducing, distributing, performing by means of digital audio transmission, or displaying the copyrighted character Barney.

Your immediate response is imperative to avoid legal action.

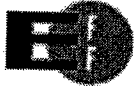
Sincerely,

GIBNEY, ANTHONY & FLAHERTY, LLP

By: \_\_\_\_\_  
Matthew Carlin

Cc: Angelo E. Mazza, Esq.

**EXHIBIT 4**



**Electronic Frontier Foundation**

March 1, 2002

**VIA: E-MAIL, FACSIMILE and REGULAR MAIL**

Matthew Carlin  
Gibney, Anthony & Flaherty, LLP  
665 Fifth Avenue  
New York, New York 10022  
Telephone: 212.688.5151  
Fax: 212.688.8315

Re: Another Copyright Infringement Claim based upon Barney Parody

Dear Mr. Carlin,

As you may recall, I am the Legal Director for the Electronic Frontier Foundation (EFF). As you also may recall from my last letter to you on July 9, 2001, the EFF is the leading online civil liberties organization in the world. For the past twelve years we have worked to ensure that constitutional and human rights, including the First Amendment rights of Americans, are respected online.

I last wrote to you in July, 2001 because you sent a letter to the EFF making baseless threats of copyright infringement and trademark infringement based upon the existence of a parody of Barney on the EFF website. In clear and unequivocal language, I explained to you that parody was protected expression under the First Amendment and a recognized exception to both copyright and trademark law. I also pointed out that making baseless legal threats was a breach of your ethical duties as a licensed attorney in the State of New York. I advised you to immediately cease making these threats. You failed to respond to my letter.

I write now because it seems that you also did not heed my advice. You are continuing to make unfounded legal threats to legitimate Internet speakers who parody Barney. EFF represents Dr. Stuart Frankel, who has received two threatening e-mails based upon a website that you identify as [www.asan.com/users/gecko/enemy.html](http://www.asan.com/users/gecko/enemy.html). The first e-mail was sent on February 11, 2001 and a second sent on February 21, 2002. For reasons unrelated to your threatening letter, Dr. Frankel's website has moved from the URL you mentioned to <http://www.speakeasy.org/~gecko/evil/parasite.html>.

