

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

STUART FRANKEL,

Plaintiff,

-against-

LYONS PARTNERSHIP L.P.,

Defendant.

06 Civ. 6413 (LLS) (MHD)

**MEMORANDUM OF LAW
IN SUPPORT OF DEFENDANT'S
MOTION TO DISMISS**

PRELIMINARY STATEMENT

Defendant Lyons Partnership, L.P. (“Lyons”) respectfully submits this memorandum of law, along with the accompanying declaration of Thomas R. Greenwood, in support of Lyons’ motion to dismiss the complaint of plaintiff Stuart Frankel (“Frankel”) pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure. (A true and correct copy of the Frankel’s complaint dated August 23, 2006 (the “Complaint”), is attached to the Greenwood Declaration (“Greenwood Decl.”) as Exhibit A.) For the reasons set forth below, and particularly in light of the clear and unequivocal covenant not to sue set forth in the Greenwood Declaration, Frankel has no reasonable apprehension that he will be sued for infringement by Lyons based upon the content of Frankel’s website. As a result, there is no actual case or controversy for this Court to decide, and so this Court lacks subject matter jurisdiction over Frankel’s Complaint. Accordingly, Lyons’ motion to dismiss should be granted, and the Complaint should be dismissed.

FACTUAL BACKGROUND

Lyons is a Texas limited partnership that owns or controls many valuable copyrights, trademarks and service marks related to the well-known fictional children's character Barney the purple dinosaur ("Barney"). Greenwood Decl. ¶4. Plaintiff Stuart Frankel maintains a personal website available at <http://www.dustyfeet.com>. Compl. ¶¶2, 6. Frankel's website includes a web page, located at <http://www.dustyfeet.com/evil/enemy.html>, which includes two images of Barney. Compl. ¶9, Exh. 1. The first of these images is of Barney as he appears on the television program "Barney & Friends." Compl. ¶9. The second image on Frankel's website is also of Barney, but this image has been defaced with violent, satanic symbols -- a pentagram and the number "666" have been placed across his chest, large black horns, red eyes, and sharp teeth have been added to his head, and blood is shown dripping from his right hand. Compl. ¶9, Exh. 1

In February 2002, counsel for Lyons twice wrote to the e-mail address associated with Frankel's website. The e-mails demanded that the unauthorized copyrighted images be removed from the site and that written assurances to that effect be provided by a date certain. Compl. Exh. 2, 3. The e-mails also stated that if no response was received by the specified date, then Lyons would take additional measures to have the images removed. Id. However, no other measures were, in fact, ever taken. The response dates set forth in those e-mails passed, and the images of Barney remained on Frankel's website.

For roughly three and a half years, Lyons took no further action with regard to Frankel's website. Then, once in October 2005 and once in June 2006, counsel for Lyons

again wrote regarding the site. Both letters demanded that the copyrighted images be removed and that written assurances to that effect be provided by a date certain. Compl. Exhs. 5, 7. Each stated that if no response was received by the specified date, Lyons would be forced to take other measures to have the content removed. Id. As before, however, no other measures were, in fact, ever taken. The response dates set forth in the letters passed, and the images remained on Frankel's website, where they remain today.

For some two and a half months following the June 2006 letter, there was no communication between the parties. Then, on August 23, 2006, Frankel commenced this declaratory judgment action, citing his "reasonable apprehension that he will be sued by Lyons if he does not comply with Lyons' demands." Compl. ¶28 The Complaint cites the Declaratory Judgment Act, 28 U.S.C. § 2201 (1994) and Rule 57 of the Federal Rules of Civil Procedure in seeking a judicial declaration that Frankel, through his website, is not liable for infringing any copyright, trademark or service mark interest owned or controlled by Lyons. See Compl., Prayer for Relief, at p. 6.

