



Bare Trademark Rights? Naked Cowboy's Infringement Action Against CBS Dismissed

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Robert John Burck has made a career as a New York street performer. He is (arguably) famous under his alias, "The Naked Cowboy", appearing with his guitar in Times Square, clad only in a hat, boots and briefs. In *Naked Cowboy v. CBS*, 101 USPQ2d 1841 (S.D.N.Y. Feb. 22, 2012), Burck sued CBS for what he believed was a take-off of his Naked Cowboy character in the CBS television soap opera "The Bold and the Beautiful," a segment of which CBS later posted on You Tube. In the soap opera episode, a character appears clad similarly to the Naked Cowboy, namely, with guitar, boots, hat and briefs only. Burck alleged trademark infringement, state and federal unfair competition, fraud, and violation of New York's right of privacy statute, New York Civil Rights Law §§ 50, 51. The court dismissed the complaint, holding that while Burck owned trademark rights in "Naked Cowboy," CBS had not used "Naked Cowboy" in commerce

CBS titled its You Tube clip "The Bold and the Beautiful – Naked Cowboy" and purchased the You Tube adword "naked cowboy." The court held that purchase of adwords was not trademark use because Defendants did not use the term "naked cowboy" in a way that denotes source or sponsorship. The holding with respect to adword use seems directly contrary to the holding in *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123 (2d Cir. 2009), which held that Google's sale of adwords constituted use in commerce. Indeed, for support, the *Naked Cowboy* court cited *Merck v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402, 415 (SDNY 2006), the holding of which *Rescuecom* cast into doubt.

The court also held that CBS's use of "Naked Cowboy" in the title of its You Tube clip was not intended (at least on the facts plaintiff pled) to trade on the plaintiff's goodwill, and therefore that it was "fair use." Fair use typically requires a showing that the mark is used nominatively, descriptively, or comparatively. Reading between the lines, the court must have considered that any performer with boots, briefs and a guitar was an (almost) "naked cowboy," hence the use was descriptive.



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Nor did the court find that the soap opera actor's costume infringed that of the Naked Cowboy, because Burck plasters "Naked Cowboy" and "Tips" across his articles of clothing, while the actor did not.

Finally, the court rejected the Naked Cowboy's claim that CBS violated New York's right of privacy statute, which forbids the "use [] for advertising purposes or for purposes of trade, the name, portrait or picture of any living person, without prior consent." N.Y. Civ. Rights § 50. The court rejected this argument, citing the Burck's previous loss in *Burck v. Mars*, a case in which the Naked Cowboy alleged that a talking M&M candy violated his right of privacy: "[T]he right of privacy does not extend to fictitious characters adopted or created by celebrities[,] and it does not protect 'a trademarked costumed character publicly performed by a person.'"

The case, while probably not doctrinally correct should give hope to naked cowboys everywhere.

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