

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF NORTH CAROLINA
WESTERN DIVISION

Civil Action No. _____

HURRICANES HOCKEY LIMITED
PARTNERSHIP,

Plaintiff,

vs.

TYRONE BANKS p/k/a TYE BANKS, and
TYTANIUM MUSIC, LLC

Defendant.

**COMPLAINT
(JURY DEMANDED)**

NOW COMES Plaintiff Hurricanes Hockey Limited Partnership (“Hurricanes Hockey”), by and through the undersigned counsel, and complaining of defendants Tyrone Banks (“Defendant Banks”) and Tytanium Music, LLC (“Tytanium Music”) (collectively, “Defendants”), alleges as follows:

INTRODUCTION

1. This is an action at law and in equity for, *inter alia*, trademark infringement, unfair competition, and declaratory judgment. Defendant Banks, a hip-hop music artist, and Tytanium, Banks’ independent record label, have advertised, promoted, and sold a song entitled “Carolina Hurricanes” on Defendant Banks’ website while using, without authorization, Hurricanes Hockey’s trade dress and registered trademarks in a manner that is likely to cause confusion and to deceive consumers regarding the source and sponsorship of the song and that is likely to suggest an affiliation between Defendants and Hurricanes Hockey, which does not exist.

THE PARTIES

2. Plaintiff Hurricanes Hockey is a limited partnership organized and existing under the laws of the state of Delaware, with a principal place of business located in Raleigh, North Carolina.

3. Upon information and belief, Defendant Banks is an adult citizen of North Carolina with his principal residence in Wake County. Defendant Banks performs under the name, and is professionally known as, Tye Banks.

4. Upon information and belief, Tytanium Music is a limited liability company organized and existing under the laws of the State of North Carolina, with its principal place of business in Garner, North Carolina. Upon information and belief, Defendant Banks is the controlling member of Defendant Tytanium Music.

JURISDICTION AND VENUE

5. This is an action for trademark infringement under the Lanham Act, 15 U.S.C. §§ 1114 and 1125 and for unfair and deceptive trade practices and unfair competition under N.C. Gen. Stat. § 75-1.1 and the common law of North Carolina. In addition, this action seeks a declaratory judgment that Hurricanes Hockey has not infringed Defendants' copyright(s), if any, in the "Carolina Hurricanes" song or breached any license associated therewith.

6. This Court has subject-matter jurisdiction over Plaintiff's claims pursuant to 28 U.S.C. § 1331 (Federal Question), 28 U.S.C. §§ 2201 and 2202 (Declaratory Judgment), and 15 U.S.C. § 1121 (Lanham Act). Venue has been properly laid in this district pursuant to 28 U.S.C. §§ 1391(b) and (c).

7. This Court has personal jurisdiction over Defendants because Defendant Banks is a resident and citizen of Wake County, North Carolina and because Defendant Tytanium is North Carolina limited liability company with a principal place of business in North Carolina.

FACTUAL BACKGROUND

8. Hurricanes Hockey is the owner of the National Hockey League (“NHL”) Carolina Hurricanes franchise. The Carolina Hurricanes franchise is the only NHL franchise in the Carolinas. Hurricanes Hockey has spent a considerable sum of money promoting the Carolina Hurricanes, building a strong and loyal fan base, and developing unique, famous, and valuable brand equity, in part through the use of various proprietary marks in commerce.

9. Hurricanes Hockey owns several federally registered trademarks, including, among others, the mark CAROLINA HURRICANES in standard character form, U.S. Trademark Reg. Nos. 2,336,473, and 2,254,170 (the “CAROLINA HURRICANES Marks”) and a stylized Marks consisting of a flag with a hockey stick, U.S. Trademark Reg. Nos. 2,215,407 and 2,215,408 (the “Design Marks”).

10. In or around early 2007, Defendant Banks wrote and/or produced a hip-hop song entitled “Carolina Hurricanes” (the “Song”) after the Carolina Hurricanes NHL hockey franchise won the 2006 Stanley Cup. The subject matter of the Song celebrates the goodwill associated with Hurricanes Hockey, and has a refrain with the lyrics, “What’s the name of your team? The Carolina Hurricanes!”

11. Upon information and belief, Defendant Banks produced the Song with the intent of trading on the fame and valuable goodwill that Hurricanes Hockey had developed in the Carolina Hurricanes NHL franchise, and that arises out of the public excitement and brand equity

associated with the Carolina Hurricanes generally and its winning of the 2006 Stanley Cup in particular.

12. Hurricanes Hockey first became aware of the Song in early 2007 when Defendant Banks gave Hurricanes Hockey a copy of the Song. As a favor to help promote his career, Defendant Banks requested that Hurricanes Hockey play the Song at the Carolina Hurricanes hockey games at the RBC Center in Raleigh, North Carolina. Defendant Banks expressly stated that Hurricanes Hockey could use the Song, royalty free, for any purpose associated with the promotion of the Carolina Hurricanes.

13. After listening to the Song, Hurricanes Hockey decided to play the Song at certain Carolina Hurricanes hockey games. In addition, Hurricanes Hockey gave Defendant Banks complimentary tickets to a Carolina Hurricanes game, during which Hurricanes Hockey played the Song refrain, highlighted Defendant Banks in the audience, and displayed his name on the large scoreboard located in the center of the arena.

14. Hurricanes Hockey and Defendant Banks never memorialized their agreement concerning the use of the Song in writing.

15. On numerous occasions, pursuant to the parties' oral agreement, Hurricanes Hockey played the Song refrain at Carolina Hurricanes hockey games, and later used short segments of the Song in connection with a television promotion for the Carolina Hurricanes and in an online video posted on the Carolina Hurricanes' website.

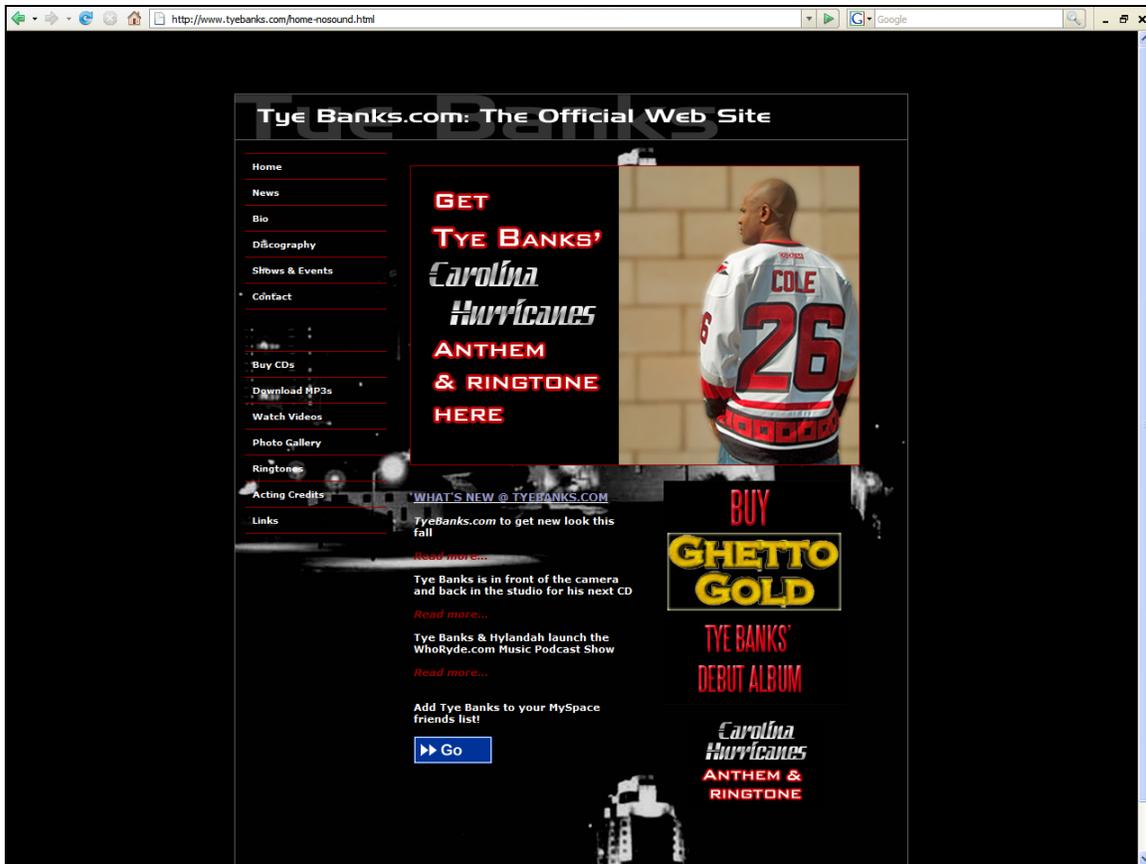
16. Upon information and belief, Tytanium Music is Defendant Banks' private independent recording company and/or record label. Defendant Tytanium Music has been involved in promoting and selling the Song publicly since 2008. Upon further information and belief, Defendant Banks owns and controls Tytanium Music.

17. Following Hurricanes Hockey's use of the Song, Defendants began to exploit the valuable goodwill and brand equity of Hurricanes Hockey in an effort to promote and increase sales of the Song and his other music to the public.

18. Upon information and belief, Defendant Banks owns and/or controls the website www.tyebanks.com ("Tye Banks website"), through which he sells and/or makes available for sale to the public copies of his music, including the Song.

19. Without authorization from Hurricanes Hockey, Defendants advertised on the Tye Banks website that the Song was the "the official Carolina Hurricanes song." Defendants referred to the Song as the "Carolina Hurricanes anthem" and the "anthem for the 2006 Stanley Cup-winning Carolina Hurricanes NHL team." Attached as Exhibit A are images from the Tye Banks website.

20. Defendants also included on the Tye Banks website a prominent link to download and purchase the Song in its full-length form and as a ringtone for mobile telephones. The link stated in large, stylized font, "Get Tye Banks' Carolina Hurricanes Anthem and Ringtone Here." Adjacent to this link is a large picture of Defendant Banks wearing a Carolina Hurricanes hockey team jersey for the player Erik Cole. Visible on the Erik Cole jersey is Hurricanes Hockey's Design Marks in conjunction with other associated designs constituting trade dress. The image below is a true and accurate image from the Tye Banks website:



21. By following this link or other links on the Tye Banks website, Defendants enabled visitors to the website to purchase and download a copy of the Song and associated ringtone.

22. Upon information and belief, Defendants have also made the Song and ringtone available for download to the general public at other websites. The Song remains available for purchase at such websites, including iTunes and Amazon.com, where the Song is displayed with album cover art depicting Defendant Banks in the Erik Cole Carolina Hurricanes jersey. The image below is from Amazon.com as of August 7, 2009.



23. Defendants’ actions, including their use of Hurricanes Hockey’s trademarks, and false representations that the Song is the “official” song or “anthem” of the team is likely to cause confusion and to deceive consumers regarding the source or sponsorship of the Song and is likely to suggest an affiliation that does exist between Hurricanes Hockey and Defendant Banks. More specifically, Defendants have sought to mislead the public into believing that the Song is sponsored or endorsed by Hurricanes Hockey or that Defendant Banks is somehow affiliated with Hurricanes Hockey when he is not.

24. Defendants’ use of Hurricanes Hockey’s registered marks, his use of the Carolina Hurricanes trade dress and jersey, and false statements that the Song is the “official” song or “anthem” of the Carolina Hurricanes hockey team violates Hurricanes Hockey’s trademark and trade dress rights and is an unfair and deceptive trade practice.

25. On or about February 19, 2009, Hurricanes Hockey sent a letter to Defendant Banks requesting that Defendant cease and desist from violating its trademark rights. After receipt of this letter, Defendants removed the reference to the Song as being the “official” song or the “anthem” of the Carolina Hurricanes hockey team and added general disclaimers in select locations on the Tye Banks website. Defendants did not, however, remove the picture of Defendant Banks wearing the Erik Cole Carolina Hurricanes jersey from the Tye Banks website or other websites and did not include disclaimers on any other websites that market, distribute and sell the Song.

26. Eventually, Defendants removed from the Tye Banks website the picture of Defendant Banks wearing the Erik Cole Carolina Hurricanes jersey; however, the image still appears on the other websites that market, distribute and sell the Song, including the site shown above.

27. Hurricanes Hockey has been damaged by Defendants’ unauthorized use of its trademarks and trade dress.

Further Exploitation by Defendants

28. Not only have Defendants sought to generate revenue from the sales of the Song by trading off of the valuable goodwill of Hurricanes Hockey, Defendants have also demanded compensation from Hurricanes Hockey for using the Song. Specifically, Defendant Banks now claims – contrary to his prior representations – that he authorized Hurricanes Hockey to use the Song only during hockey games so long as Hurricanes Hockey displayed his name, the song title, and the name of his record company while the Song was playing.

29. For the past several months, Defendant Banks has threatened to file a complaint against Hurricanes Hockey based upon Hurricanes Hockey’s alleged failure to abide by

30. Based upon the alleged breach of this agreement concerning the use of the Song, Defendant Banks has demanded, among other things, that: (a) Hurricanes Hockey pay him \$25,000; (b) play the Song during every home game in the 2009-2010 and 2010-2011 seasons for a minimum of 30 seconds during each game; and (3) while the Song is playing, display on the center-hung scoreboard of the RBC Center his name, song title, and the words “Label: Tytanium Music” and “Songs and ringtones available at www.tyebanks.com.”

31. Defendant Banks’ demand is nothing more than an effort to further exploit the valuable goodwill associated with Hurricanes Hockey and to gain publicity.

32. Not only is Defendant Banks’ current position regarding the scope of the agreement for the use of the Song contrary to Defendant Banks’ prior representations, it is also directly contrary to a written license agreement between the NHL and The American Society of Composers, Authors, and Publishers (“ASCAP”), of which Defendant Banks is a member and with whom the Song is registered for purposes of public performance of the Song.

33. Pursuant to the agreement between ASCAP and the NHL, the NHL and its franchises, including Hurricanes Hockey, are authorized to play any song that is registered with ASCAP during hockey games. Hurricanes Hockey has abided by all requirements of the license agreement with ASCAP. Therefore, based upon the ASCAP license, Hurricanes Hockey has the right to play the Song at hockey games without any further permission from Defendants.

34. Despite efforts to resolve this dispute amicably, an ongoing and unresolved justiciable controversy remains.

FIRST CLAIM FOR RELIEF
Infringement of Federally Registered Marks
(15 U.S.C. § 1114(1))

35. Hurricanes Hockey hereby incorporates by reference the preceding allegations contained in this Complaint as if fully alleged herein.

36. Defendants have used in commerce and without the consent of Hurricanes Hockey a reproduction, counterfeit, copy and colorable imitation of Hurricanes Hockey's registered CAROLINA HURRICANES Marks and the Design Marks in connection with the sale, offering for sale, distribution, and advertising of the Song and associated ringtone.

37. Defendants' use in commerce of Hurricanes Hockey's registered CAROLINA HURRICANES Marks and Design Marks in connection with the sale, offering for sale, distribution, and advertising of the Song and associated ringtone is likely to cause confusion, or to cause mistake, or deceive, in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

38. Defendants' use in commerce of Hurricanes Hockey's registered CAROLINA HURRICANES Marks and Design Marks in connection with the sale, offering for sale, distribution and advertising of the Song and associated ringtone has damaged Hurricanes Hockey in an amount to be proven at trial.

39. Some or all of Defendants' use of Hurricanes Hockey's marks is ongoing and will continue unless enjoined.

40. Hurricanes Hockey has no adequate remedy at law for Defendants' unauthorized use of Hurricanes Hockey's registered marks in connection with the sale, distribution, and advertising of the Song and associated ringtone.

SECOND CLAIM FOR RELIEF
Federal Trademark Infringement
(15 U.S.C. § 1125(a)(1)(A))

41. Hurricanes Hockey hereby incorporates by reference the preceding allegations contained in this Complaint as if fully alleged herein.

42. Defendants' use of Hurricanes Hockey's CAROLINA HURRICANES Marks, the Design Marks, and trade dress is likely to cause confusion, or to cause mistake, or to deceive the public into believing that there is an affiliation, connection, or association between Defendant Banks and Hurricanes Hockey.

43. Defendants' use of Hurricanes Hockey's CAROLINA HURRICANES Marks, the Design Marks, and trade dress is likely to cause confusion, or to cause mistake, or to deceive the public into believing that Hurricanes Hockey sponsored, approved, or otherwise endorsed the Song, ringtone or other music of Defendant Banks.

44. The aforesaid acts of Defendants have injured Hurricanes Hockey in an amount to be proven at trial.

45. The aforesaid acts of Defendants also have caused great and irreparable harm to Hurricanes Hockey, and unless restrained and enjoined by this Court, will continue to cause irreparable damage, loss and injury to Hurricanes Hockey, for which Hurricanes has no adequate remedy at law.

THIRD CLAIM FOR RELIEF
Common Law Unfair Competition

46. Hurricanes Hockey hereby incorporates by reference the preceding allegations contained in this Complaint as if fully alleged herein.

47. With knowledge of and disregard for Hurricanes Hockey's rights in the CAROLINA HURRICANES Marks, the Design Marks, and trade dress, Defendants have sought

to exploit the valuable goodwill of Hurricanes Hockey by offering for sale and, in conjunction with the offering for sale, representing to the general public that Hurricanes Hockey endorses or sponsors the Song.

48. By using the CAROLINA HURRICANES Marks on the infringing goods, Defendants are trading off of the valuable goodwill that Hurricanes Hockey has created in the CAROLINA HURRICANES Marks.

49. By virtue of the aforesaid acts, Defendants have been unjustly enriched at the expense of Plaintiff in violation of the common law of State of North Carolina.

50. The aforesaid acts of Defendants have injured Hurricanes Hockey in an amount to be proven at trial.

FIFTH CLAIM FOR RELIEF
Unfair & Deceptive Trade Practices
(N.C. Gen. Stat. § 75-1.1)

51. Hurricanes Hockey hereby incorporates by reference the preceding allegations contained in this Complaint as if fully alleged herein.

52. Defendants has engaged in conduct in and affecting interstate commerce, all of which constitutes unfair and deceptive trade practices within the meaning of N.C. Gen. Stat. § 75-1.1 *et seq.*

53. Hurricanes Hockey has suffered actual injury and has been damaged by virtue of Defendants' unfair and deceptive acts.

54. Pursuant to N.C. Gen. Stat. § 75-1.1 *et seq.*, Hurricanes Hockey is entitled to treble damages and attorneys' fees for Defendants' unfair and deceptive acts.

SIXTH CLAIM FOR RELIEF
Declaratory Judgment
(28 U.S.C. § 2201)

55. Hurricanes Hockey hereby incorporates by reference the preceding allegations contained in this Complaint as if fully alleged herein.

56. There is an actual and justiciable controversy between Hurricanes Hockey and Defendants inasmuch as Defendants have alleged that Hurricanes Hockey has violated an oral license agreement concerning Hurricane Hockey's use of the Song, and has demanded certain monetary compensation from Hurricanes Hockey as well as future performance and publicity rights.

57. Hurricanes Hockey denies ever violating an oral license agreement and, moreover, contends that it does not need authorization from Defendants to play the Song during games due to a written license agreement with ASCAP.

58. Hurricanes Hockey has not violated an oral license agreement or otherwise infringed any copyright that Defendants may have in the Song.

59. Hurricanes Hockey is entitled to a declaratory judgment from this Court that Hurricanes Hockey has not infringed Defendants' copyright in the Song, or breached a contractual or other obligation to Defendant.

JURY DEMAND

Hurricanes Hockey demands a trial by jury of all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Hurricanes Hockey Limited Partnership, respectfully requests the Court grant the following relief:

A. That Defendants be permanently enjoined from using any registered or unregistered mark, or any trade dress, belonging to Hurricanes Hockey, including the CAROLINA HURRICANES Marks and the Design Marks, or any confusingly similar variations thereof, without the consent of Hurricanes Hockey, in connection with the sale, offering for sale, distribution and advertising of the Song and ringtone;

B. That Defendants be permanently enjoined from selling or licensing the Song or Ringtone or otherwise using either in commerce;

C. That the Court award judgment in favor of Hurricanes Hockey and against Defendants for such monetary damages in an amount sufficient to compensate Hurricanes Hockey for losses it sustained as a consequence of Defendants' unlawful acts, as well as Defendant's profits attributable to the infringements;

D. That the Court award Hurricanes Hockey treble damages, costs and attorneys' fees for Defendants' acts of trademark infringement pursuant to 15 U.S.C. § 1051, *et seq.*, particularly including 15 U.S.C. §§ 1114 and 1125(a);

E. That the Court declare pursuant to 28 U.S.C. § 2201, *et seq.* that Hurricanes Hockey has not breached the license agreement between Hurricanes Hockey and Defendants or otherwise infringed any copyright that Defendants may have in the Song;

F. That the Court award treble damages, costs, and attorneys' fees for Defendants' unfair and deceptive acts pursuant to N.C. Gen. Stat. § 75-1.1 *et seq.*;

G. That post-judgment interest be awarded to Hurricanes Hockey at the highest legal rate; and

H. For any such other and further relief as the Court may deem just and proper.

Dated: August 7, 2009

Respectfully submitted,

/s/ Keith P. Anthony

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