

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

DAVID HESTER, an individual,

Plaintiff,

vs.

TREMINE NEVERSON, an individual,
TREY Songz PRODUCTIONS, L.L.C.,

Defendants.

) **CASE NO.: 11-CV-8163 (KBF)**
)
) Hon. Katherine B. Forrest
)
) Magistrate Judge Debra C. Freeman
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) **FIRST AMENDED COMPLAINT**
) **FOR DECLARATORY JUDGMENT**
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PRELIMINARY STATEMENT

1. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and the Trademark Act of July 5, 1946, as amended, commonly known as the Lanham Act, 15 U.S.C. § 1501 *et seq.*

2. Plaintiff David Hester (“Hester”) is the owner of the trademark **YUUUP!** Defendants Tremaine Neverson or Trey Songz Productions, L.L.C. (“Songz”) (collectively “Defendants”) or both have been advertising, distributing and selling clothing bearing the word **YUUUP!** within the United States and, on information and belief, elsewhere. Hester seeks a declaration that Hester’s use of his trademark **YUUUP!** in connection with his appearance on the nationally televised popular A&E Television Network (“A&E”) program “Storage Wars” and his advertising and sale of his **YUUUP!** brand name line of clothing and other merchandise prominently bearing the **YUUUP!** mark does not infringe any rights of Defendants.

3. Defendants have asserted that Hester’s use of Hester’s trademark **YUUUP!** in connection with his appearances on the A&E program “Storage Wars” and his **YUUUP!** brand merchandise is likely to cause consumer confusion with Defendants’ merchandise or performances. As a result, a declaratory judgment is necessary to clarify Hester’s rights in the **YUUUP!** trademark.

THE PARTIES

4. Hester is a resident of Orange, California and a citizen of the State of California.
5. Neverson, also known as "Trey Songz," is on information and belief a resident of the City of New York, N.Y. and a citizen of the State of New York.
6. Songz is a limited liability company organized and existing under the laws of the State of Florida. Neverson is, on information and belief, the managing member of defendant Trey Songz Productions L.L.C. Songz' only known member is Tremaine Neverson, a citizen of New York, N.Y. Therefore, Songz is a citizen of New York.

JURISDICTION

7. This action arises and is brought under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and the Trademark Act of July 5, 1946, as amended, commonly known as the Lanham Act, 15 U.S.C. § 1051, *et seq.*
8. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338 and 2201-2202.
9. This Court possesses personal jurisdiction over Neverson because he is a resident of this district.
10. This Court possesses jurisdiction over Songz because its member resides in this district and is a citizen of the State of New York.

VENUE

11. Venue is proper in this Court as to Neverson and Songz pursuant to 28 U.S.C. § 1391(b)(1) because they both reside in this district.
12. Venue is proper in this Court as to defendant Songz pursuant to 28 U.S.C. 1391(c) because it is subject to personal jurisdiction in this judicial district as its managing member, Neverson, is a resident of this judicial district.

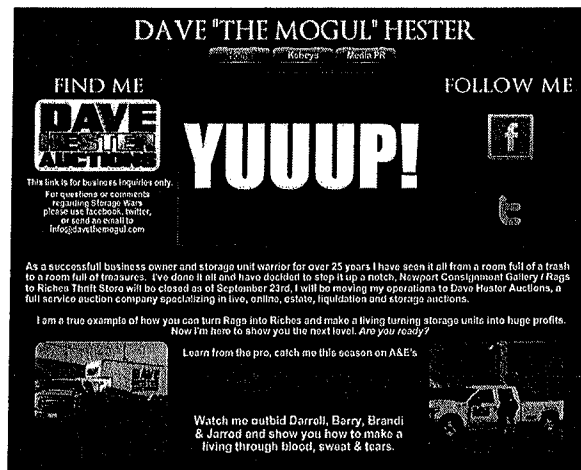
GENERAL ALLEGATIONS

Plaintiff Dave Hester's YUUUP! Trademark

13. Plaintiff Hester is the owner of the trademark YUUUP! registered on December

13, 2011 by the United State Patent and Trademark Office, Reg. No. 4,070,391 describing the mark as a standard character mark on the Principal Register for goods in International Class 25 that includes clothing: “namely, beanies, hats, caps, tops and bottoms.”

14. Hester, also known as Dave “The Mogul” Hester, is a well known television personality featured on the popular A&E television program “Storage Wars” on which he wears clothing bearing his distinctive YUUUP! trademark, an invented word that he uses in his well-known auction bidding on that show as follows:



15. “Storage Wars” is a reality television series which features an auctioneer and auction hunters, including Hester, the show’s recurring antagonist who frequently outbids other featured players on the show. When rent is not paid on a storage locker and the storage company has the right to take possession of the locker and its contents, the contents are commonly sold by an auctioneer as a single lot of items. The show follows professional buyers who bid on and, if their bids are successful, purchase such locker contents after being given only a five-minute inspection and based only on what they can see from the locker door when it is opened. The goal of the buyers is to turn a profit on the merchandise after guessing about the contents and purchasing them.

16. When Hester bids on the program he uses his trademark phrase “YUUUP!” while gesticulating to the auctioneer and wearing his trademarked clothes, including t-shirts and caps, which bear the distinctive trademark YUUUP! identified with Hester.

17. The premiere episode of "Storage Wars" in 2010 drew 2.1 million viewers nationally and the show was A&E's top-rated non-fiction show for 2010 with an average of 2.4 million viewers per episode.

18. The season two premiere consisted of back-to-back new episodes of the show; the second show drew 5.1 million total viewers nationally and provided the highest rating for an episode in a series in A&E history. (The combined season premiere outperformed competing original episodes of NBC "Love in the Wild" and ABC's "Primetime Nightline".)

19. "Storage Wars" has been renewed for a third season and is currently filming a twenty episode season on which Hester will continue to appear as the shows' recurring antagonist and "hunter" using his trademark bidding phrase **YUUUP!** and wearing clothes that bear his trademark, including t-shirts and caps.

20. Hester and his clothing have become associated with the use of the **YUUUP!** mark which is recognized by consumers as the source of his quality goods and services. Clothing products which bear his trademark **YUUUP!** are sold nationally include upper and lower body wear such as sweaters, t-shirts, tank tops and head wear. Hester has operated a consignment store in Newport Beach, California and an auction house in Costa Mesa, California which attracted thousands of customers because of his celebrity status and association with the **YUUUP!** mark. Plaintiff sold **YUUUP!** branded merchandise at his stores.

21. Hester also sells his **YUUUP!** branded merchandise through Internet websites.

Neverson's Claims

22. Upon information and belief Neverson, better known by his stage name "Trey Songz," is an American singer-songwriter, rapper, record producer and performer.

23. Neverson's discography includes four studio albums, "I Gotta Make It" (2005), "Trey Day" (2007), "Ready" (2009), and "Passion, Pain & Pleasure" (2010). Neverson has been nominated for numerous BET (Black Entertainment Television) awards and won the BET Award for Best Male R&B Artist in 2009.

24. Neverson claims a "signature" sound which, when phonetically spelled, has been

variously reduced to writing on Defendant's promotional materials and in the media as "yeeeeuuuuuppp", "yuuuuuup" and other iterations, including "Yuuup."

25. On one record album entitled "Best of Songz", Volume 1, which also features a second artist, DJ F.A.T.E., a title appears in print presented to the public as "I be like YUUUP!"

26. Upon information and belief Neverson has recorded this vocal sound for downloading from the Internet as his "signature" sound, on such websites as www.djdownloadz.com/trey-songz-dj-fate-i-be-like-yuuup-mixtape.

27. Upon information and belief Neverson's "signature" downloadable sound resembles an animal-like or non-human squeal which begins with a distinct "yeeee" sound before finishing with a squeal-like "uuuup" sound, and is distinct and different from Hester's more monosyllabic-sounding guttural auction bidding phrase when used on "Storage Wars" which is meant to convey the meaning of "yes" or an affirmative expression of agreement to a higher bid suggested by an auctioneer.

28. Upon information and belief Neverson uses his "signature" non-human-like squeal in the course of performances as a rapper and R&B Artist. Hester is not a rapper or R&B artist or musician or otherwise eligible for a BET award, nor has Hester ever released any studio albums of music of any kind.

29. Neverson claims that he has sold T-shirts decorated with the word YUUUP! printed on them. He also sells other T-shirts with other words, graphics, symbols and pictures decorating them along with those decorated with YUUUP!

30. Neverson has not identified and cannot identify any individual who has ever been actually confused and believed that Hester's mark for clothing originated from or was somehow affiliated or associated with Neverson.

31. If Neverson has any protectable rights in his sound or the word YUUUP! (which rights Hester otherwise expressly denies), there is no likelihood of confusion caused by Hester's use of the YUUUP! mark because, among other reasons: Neverson's sound or alleged mark is not protectable by trademark law because it is a lyric and musical/rap composition that is

protectable only by copyright, if at all; Neverson's alleged mark appears in print displayed to the public in a manner dissimilar from Hester's mark because Neverson uses various spellings and small and capital letters which are dissimilar from Hester's mark which has only one spelling and only uses all capital letters; Neverson's alleged mark is not in competitive proximity to Hester's mark because the products which display Hester's mark and Neverson's alleged mark do not appeal to the same consumers, nor are Neverson's and Hester's products marketed in a similar fashion or in the same channels of trade.

32. Neverson has no protectable trademark rights in the word YUUUP! because, among other reasons, Neverson has never used the word as a trademark but only as an ornamental feature on merchandise that are otherwise identified with the "Trey Songz" mark.

33. Neverson does not have any trademark rights that are senior to those of Hester in the mark YUUUP!

34. On September 2, 2011, a lawyer for Neverson sent a cease and desist letter to Hester and A&E claiming to represent "recording artist and performer Tremaine Neverson p/k/a 'Trey Songz', as well as Trey Songz Productions, LLC." The lawyer asserted Neverson "has used the mark YUUUP! continuously since at least as early as July 2009 ... in connection with both live and recorded performances, appearances, in entertainment services, and on merchandise, as well as displaying the mark on promotional materials and Trey Songz's website."

35. Defendants' lawyer further asserted that Defendants considered "any use of the YUUUP! trademark as a violation of his valuable state and federal rights" and intended to oppose Hester's trademark application.

36. Defendants' lawyer further demanded in the cease and desist letter that Hester and A&E cease and desist any manufacturing, licensing, distributing, and/or commercial exploitation of any merchandise bearing the YUUUP! trademark, refrain from using the YUUUP! trademark in any manner, abandon any ownership rights to the YUUUP! trademark and provide an itemized statement of account for all compensation received earned by or due to Hester or A&E

in relation to merchandise sold by Plaintiff and/or A&E.

37. The Defendants' lawyer's cease and desist letter of September 2, 2011 threatened that if Hester and A&E did not agree to the Defendants' demands by September 9, 2011, the Defendants would "pursue the legal and equitable remedies available to him to protect and enforce his rights," thereby causing Hester to reasonably anticipate an imminent lawsuit by the Defendants.

38. After receipt of the cease and desist letter exchanges between representatives of Hester and Defendants occurred, during which the dispute reflected by the cease and desist letter, and Defendants' threat to disrupt Hester's ongoing ability to market and sell his merchandise to which the YUUUP! trademark is affixed, were addressed but remain unresolved.

39. Under the circumstances a controversy of sufficient immediacy and reality exists with respect to Hester's use of his YUUUP! trademark to warrant a declaratory judgment.

40. Therefore, there exists an actual and justiciable controversy between Hester, on the one hand, and Neverson and Songz, on the other hand, regarding whether or not Hester is infringing the alleged trademark rights of Neverson and/or Songz, if any.

41. Hester has made a substantial effort and investment in developing, and promoting his mark, including entering into various agreements with A&E pursuant to which A&E purchases merchandise manufactured for Hester which prominently displays Hester's mark, then markets and sells the merchandise in conjunction with the reality television show "Storage Wars" in which Hester, the principal recurring antagonist, wears and displays such trademarked products. This substantial investment has developed significant goodwill in Hester's YUUUP! trademark.

42. Hester's right to use his trademark is now clouded as a result of Defendants' actions. Defendants' actions, unless curtailed, will continue to impede and interfere with Hester's legitimate business interests and objectives.

FIRST CLAIM FOR RELIEF
Declaratory Judgment of Non-Infringement

43. Hester incorporates each and every allegation set forth in the above paragraphs as though fully alleged herein.

44. An actual *bona fide* controversy exists between Hester, on the one hand, and Defendants, on the other hand, as to whether Hester's use of his trademark YUUUP! infringes any existing and valid trademark right of Defendants under the Lanham Act.

45. Hester seeks a judicial declaration that his registration and use of his mark YUUUP! does not infringe any existing and valid trademark right of Defendants under federal or state law with respect to the mark.

PRAYER FOR RELIEF

WHEREFORE, Hester prays for a judgment in his favor and against Defendants and for the following remedies:

1. That the Court declare that Hester's use of his trademark YUUUP! does not infringe any existing and valid trademark right of Defendants, or either of them;

2. That the Court order that Defendants, their employees, servants, attorneys, agents, representatives, distributors, licensees, and all persons acting in concert or participation with any of them, be enjoined and restrained permanently from infringing Hester's trademark YUUUP! and from interfering with Plaintiff's use of the trademark and from opposing, seeking to cancel or otherwise objecting to Hester's federal registration for the trademark YUUUP!;

3. That Hester be awarded his reasonable attorneys' fees and costs:

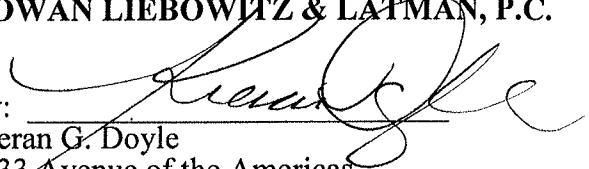
4. That Hester be awarded such other and further relief as the Court may deem just and proper.

Dated: March 8, 2012

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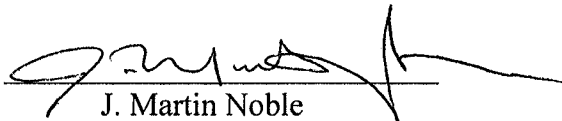
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CERTIFICATE OF SERVICE

I hereby certify that on March 8, 2012, I caused a true and correct copy of the foregoing **FIRST AMENDED COMPLAINT FOR DECLARATORY JUDGMENT** to be served on Defendant's counsel of record by first class mail, upon the following:

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J. Martin Noble