UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

August Term, 2006

(Argued: January 10, 2007 Decided: October 5, 2007)

Docket No. 05-6844-cv

SHARICE DAVIS,

Plaintiff-Appellant,

v.

MARY J. BLIGE, BRUCE MILLER, RONALD LAWRENCE, KWAME HOLLAND, DANA STINSON, AUSAR MUSIC, MARY J. BLIGE PUBLISHING, BRUCE MILLER PUBLISHING, KWAME HOLLAND PUBLISHING, MARY J. BLIGE MUSIC, DAYNA S. DAY PUBLISHING, WARNER-TAMERLANE MUSIC PUBLISHING CORP., UNIVERSAL MUSIC GROUP, INC., UNIVERSAL STUDIOS, INC., UNIVERSAL MUSIC PUBLISHING GROUP, UNIVERSAL-MCA MUSIC PUBLISHING, UNIVERSAL MUSIC & VIDEO DISTRIBUTION CORP., and MCA RECORDS, INC.,

Defendants-Appellees.

Before: WINTER and CABRANES, *Circuit Judges,* and KORMAN, *District Judge.*[1]

Plaintiff appeals from an order of the United States District Court for the Southern District of New York (Charles S. Haight, Jr., *Judge*) granting defendants' motion for summary judgment on plaintiff's copyright-related claims. The District Court concluded that (1) plaintiff's co-author transferred his rights under copyright to one of the defendants through a written agreement; (2) the transfer, which stated that it was "retroactive" to the date of the creation of the copyright, took effect before the alleged infringement; and (3) the "retroactive" transfer barred plaintiff's claim of infringement against the defendant, who was the beneficiary of the transfer, and his licensees. Plaintiff argues on appeal that the retroactive transfer was invalid and that plaintiff's claims were not barred by

[1] The Honorable Edward R. Korman, of the United States District Court for the Eastern District of New York, sitting by designation.

the transfer.

Vacated and remanded.

RICHARD J. J. SCAROLA (Alexander Zubatov, *on the brief*), Scarola Ellis LLP, New York, NY, *for Plaintiff-Appellant.*

JONATHAN D. DAVIS, New York, NY, *for Defendants-Appellees Mary J. Blige and Mary J. Blige Music.*

Cynthia S. Arato, Gibson Dunn & Crutcher LLP, New York, NY, *for Defendants-Appellees Warner-Tamerlane Publishing Corp., Dana Stinson, and Dayna's Day Publishing.*

Andrew H. Bart, Jenner & Block LLP, New York, NY, *for Defendants-Appellees Universal Music Group, Inc., Universal Studios, Inc., Universal Music Publishing, Inc., Universal-MCA Music Publishing, a division of Universal Studios, Inc., Universal Music & Video Distribution Corp., and MCA Records, a division of UMG Recordings, Inc.*

Gregory J. Watford, New York, NY, *for Defendants-Appellees Ronald Lawrence and Ausar Music Publishing, Ltd.*

George T. Gilbert, New York, NY, *for Defendant-Appellee Bruce Miller.*

JOSÉ A. CABRANES, *Circuit Judge*:

The question presented, one of first impression in the courts of appeals, is whether an action for infringement by one co-author of a song can be defeated by a "retroactive" transfer of copyright ownership from another co-author to an alleged infringer. This action arises under the current statute governing copyright law, the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.* ("the Copyright Act"), because "the complaint is [in part] for a remedy expressly granted by [the Copyright Act], e.g., a suit for infringement . . . , [and] asserts a claim requiring construction of [the Copyright Act], . . . or, at the very least . . . presents a case where a distinctive policy of [the Copyright Act] requires that federal principles control the disposition of the claim." *T.B. Harms Co. v. Eliscu,* 339 F.2d 823, 828 (2d Cir. 1964) (Friendly, J.).

Plaintiff Sharice Davis ("plaintiff" or "Davis") appeals from an order of the United States District Court for the Southern District of New York (Charles S. Haight, Jr., *Judge*) dismissing by summary judgment her claims under the Copyright Act, her claim for a declaratory judgment under 28 U.S.C. § 2201, and her state-law claims alleging unfair competition, unjust enrichment, and violations of New York's consumer protection statutes. *See Davis v. Blige*, 419 F. Supp. 2d 493 (S.D.N.Y. 2005). The District Court concluded that a "retroactive" written agreement between Bruce Chambliss, Davis's alleged co-author, and Bruce Miller, one of the defendants, purporting to assign Chambliss's rights in two disputed songs as of the time of their creation, was valid. Reasoning that "a co-owner has a legal right to grant a license without another co-owner's permission or transfer his rights in the copyright freely," *id.* at 500, the District Court held that the transfer of co-ownership rights by Chambliss to Miller—who had licensed the copyright to third parties also named as defendants (collectively the "third-party defendants") before the written agreement was executed—defeated Davis's claims not only against Miller but also against the third-party defendants, who were in privity with Miller.

We disagree, and therefore vacate the judgment and remand for further proceedings consistent with this opinion.

BACKGROUND

A. Facts

The facts of this case are laid out fully in Judge Haight's opinion. We recount here only those facts relevant to the issues on appeal. Unless otherwise noted, the facts are undisputed.

The dispute between the parties arises from the release in 2001 of an album entitled "No More Drama" ("the Album"). Defendant Mary J. Blige, the "Queen of Hip-Hop Soul," J.A. 325, was the performer on the Album, which achieved "triple platinum" status.[2] Davis alleges that two of the songs

[2] "Platinum" status, a term of art of musical-recording sales certification created by the Recording Industry Association of America, refers to the sale of over one million copies of a musical recording. Thus, "triple platinum" status means over 3 million copies of the Album were sold. *See* Recording Industry Association of America, Gold and

contained on the Album—"LOVE" and "Keep It Moving" (collectively, the "Album compositions")—infringe her copyright in two compositions (collectively, the "disputed compositions"). In particular, she claims that "LOVE" is virtually identical to her composition "L.O.V.E.," and that "Keep It Moving" bears substantial similarity to her composition "Don't Trade in My Love." Davis does not receive any song-writing credit on the Album; instead, the labels and packaging of the Album identify (1) Blige, Miller, and defendants Kwame Holland and Ronald Lawrence as the authors of "LOVE" and (2) Blige, Miller, Holland, and defendant Dana Stinson as the authors of "Keep It Moving." *See id.* at 495 n.2.

Davis claims the disputed compositions were co-authored in 1998 by her and Chambliss, Miller's father; Chambliss is not a party to this action. According to one witness, Hunter College Professor Barbara Ottaviani, the disputed composition "L.O.V.E." was written in 1998 during jam sessions in the home of Ottaviani attended by, among others, Davis, Chambliss, and Miller. A tape recording of "L.O.V.E." was made during one of these jam sessions, but the tape disappeared shortly thereafter. At about this time Davis met Blige, who is Miller's sister and the step-daughter of Chambliss. Davis states that she had performed "L.O.V.E." for Blige and that Miller subsequently approached Davis on behalf of Blige, seeking to buy several of Davis's songs, including "L.O.V.E." Davis alleges that she declined the offer. She also alleges that she wrote "Don't Trade in My Love" with Chambliss in or around November 1998 at Ruff Riders Studio.

In August 2001, defendants Ausar Music, Mary J. Blige Publishing, Bruce Miller Publishing, and Kwame Holland Publishing registered "LOVE" and defendant Universal Music MCA Music Publishing, and Blige, Miller, and Stinson registered "Keep It Moving" with the United States Copyright Office ("Copyright Office"). On February 28, 2002, Miller contracted with Universal Tunes, a division of defendant Universal, Inc., to provide an exclusive license to exploit his copyright interest

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Platinum, http://www.riaa.com/goldandplatinum.php (last visited Aug. 8, 2007).

in the Album compositions as well as his copyright interests in any other compositions not previously assigned to other music publishing companies. On August 14, 2002, Davis registered the disputed compositions with the Copyright Office, listing Chambliss as a co-author. In December 2003, Davis filed suit, alleging infringement of her copyright in the two disputed compositions and a variety of related state claims.

Defendants' April 30, 2003 and August 11, 2003 answers to Davis's complaint denied that anyone other than the defendants listed as authors on the Album wrote the songs. But in depositions given in December 2003 and January 2004 (Miller), and June and August 2004 (Chambliss), both Miller and Chambliss testified that *Chambliss* had initially written the disputed compositions and that they formed the basis for the Album compositions;[3] Chambliss denied ever collaborating on any songs with Davis.[4] Chambliss and Miller also stated that they had orally agreed Chambliss would grant Miller certain rights in the compositions, although the existence and nature of the alleged oral agreement is in dispute.[5] *See Davis*, 419 F. Supp. 2d at 498 (noting that "a genuine issue exists as to whether Chambliss

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[3] Miller testified that he and Blige contributed to the "revised" version of "LOVE."

[4] Chambliss's deposition testimony is somewhat confused on this point. Although during his deposition he categorically denied ever having written songs with Davis, Chambliss identified several instances in which Davis's handwriting or name appeared in his papers documenting several songs. Chambliss explained this documentation as either identifying songs meant for her as a performer, or areas where she added unauthorized verses.

[5] Miller's and Chambliss's deposition testimony contain inconsistent descriptions of the nature and timing of the alleged oral agreement. Miller stated during his deposition that he and Chambliss had a conversation "[p]robably like the end of '98, '99 . . . somewhere in there," during which Chambliss told him, "basically, 'Any song that I have written, if it needs to be used at any point in time, use it. It is yours.'" Miller said that this agreement was never written down, and that he never compensated Chambliss for any songs that Chambliss had given to him.

According to Chambliss, he "sign[ed] all of [his] songs over to [Miller]" because he "knew [Chambliss] was going to be in prison, and [he] knew [Miller] could handle everything." Chambliss also described the alleged oral agreement alternatively as an agreement that "[Miller] can *use* all of [the songs]." As the District Court noted, however, Chambliss was incarcerated sometime in 1997, and again from 2001 to 2003; thus, it appears that Chambliss could not have known "he was going to be in prison" during late 1998 or early 1999, when Miller says that the oral agreement was reached. *See Davis*, 419 F. Supp. 2d at 498. It is also worth noting that it is unclear whether the oral agreement (assuming *arguendo* that it existed) transferred all of Chambliss's interests in his compositions to Miller, or whether Chambliss merely intended to grant Miller only the right to *use* Chambliss's compositions. Finally, it is unclear whether the alleged agreement related only to the disputed compositions, or whether the agreement related to all of the 3000-4000 compositions that Chambliss claimed to have created.

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