20-1715
*Brandon v. NPG Records, Inc.*

# UNITED STATES COURT OF APPEALS
# FOR THE SECOND CIRCUIT

# SUMMARY ORDER

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**At a stated term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 28th day of December, two thousand twenty.**

PRESENT:

AMALYA L. KEARSE,
JOSEPH F. BIANCO,
STEVEN J. MENASHI,
*Circuit Judges.*

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JAMES M. BRANDON,

*Plaintiff-Appellant,*

v. 20-1715

NPG RECORDS, INC., NPG MUSIC PUBLISHING, LLC, THE ESTATE OF PRINCE ROGERS NELSON, COMERICA BANK & TRUST, N.A., SHELTON JACKSON LEE, FORTY ACRES AND A MULE MUSICWORKS, INC., TWENTIETH CENTURY FOX FILM CORP.,

*Defendants-Appellees.*

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For Plaintiff-Appellant James M. Brandon: David Ludwig, Dunlap Bennett & Ludwig PLLC, New York, NY.

For Defendants-Appellees NPG Records, Inc., NPG Music Publishing, LLC, The Estate of Prince Rogers Nelson, and Comerica Bank & Trust, N.A.: Lora M. Friedemann, Fredrikson & Byron, P.A., Minneapolis, MN, Michael J. Tricarico, Kennedys CMK LLP, New York, NY.

For Defendants-Appellees Shelton Jackson Lee, Forty Acres and a Mule Musicworks, Inc., and Twentieth Century Fox Film Corp.: Matthew S. Nelles, E. Adriana Kostencki, Nelles Kostencki, PLLC, Fort Lauderdale, FL, Howard J. Shire, Troutman Pepper Hamilton Sanders LLP, New York, NY.

Appeal from a judgment of the United States District Court for the Southern District of New York (Woods, *J.*).

**UPON DUE CONSIDERATION, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED** that the judgment of the district court is **AFFIRMED**.

Plaintiff-Appellant James M. Brandon appeals from the April 30, 2020 judgment of the United States District Court for the Southern District of New York (Woods, *J.*), granting Defendants-Appellees' motion to dismiss Brandon's amended complaint with prejudice pursuant to Federal Rule of Civil Procedure 12(b)(6). We assume the parties' familiarity with the underlying facts, procedural history, and issues on appeal, which we reference only as necessary to explain our decision to affirm.

## I. Background

In 2015, Brandon filed a lawsuit in the United States District Court for the Southern District of Florida (the "Florida litigation") alleging copyright infringement claims against a number of defendants, including, among others, some of the defendants in this action: Prince Rogers Nelson

("Prince"),[1] Shelton Jackson ("Spike") Lee, Forty Acres and a Mule Musicworks, Inc. ("Forty Acres Music"), and Twentieth Century Fox Film Corporation ("Twentieth Century Fox") (collectively, the "Prince and Lee Defendants"). Brandon alleged that the song "Girl 6," which had been written and performed by Prince for a Spike Lee film of the same name, infringed upon his 1995 copyright for the song "Phone Sex." By its terms, Brandon's copyright registration covered song lyrics only. However, in support of his copyright infringement claims, Brandon alleged, *inter alia*, that Girl 6 and Phone Sex both have "substantially similar . . . two-word, two-pitch hook[s]," the same "'trumpet hit' arrangement," and "a similar layout" using "an echo-sound reverberation effect." App'x at 108.

A number of defendants who are not parties in this action, including Tommy Elm ("Elm") and Warner Brothers Records, Inc. ("Warner Brothers"), moved to dismiss Brandon's complaint for failure to state a claim pursuant to Rule 12(b)(6). The district court in Florida (the "Florida court") granted the motions, finding that the operative complaint failed to state a claim for copyright infringement. In particular, the Florida court held that "short phrases or common or ordinary words," such as "phone sex," are not copyrightable as a matter of law, App'x at 63, and that, therefore, the alleged similarities between the lyrics of Girl 6 and Phone Sex could not provide a basis for Brandon's copyright infringement claim. The Florida court also declined to address whether Girl 6 infringed upon the melody, arrangement, or performance of Phone Sex because Brandon's copyright registration covers only the lyrics of the song, and rejected Brandon's assertion that a supplemental application he had filed with the United States Copyright Office while the litigation in Florida was pending expanded his copyright registration to include the

[1] Prince Rogers Nelson—better known as the recording artist Prince—passed away while the Florida litigation was pending.

melody, arrangement, and performance of Phone Sex. As to the Prince and Lee Defendants, the Florida court dismissed the case against them without prejudice for insufficient service of process. App'x at 70–73.

Brandon subsequently brought the instant action in the United States District Court for the Southern District of New York against the Prince and Lee Defendants and certain other parties, again alleging that Girl 6 infringed upon his copyright for Phone Sex. The district court in this action granted defendants' motions to dismiss under Rule 12(b)(6) and held that the doctrine of collateral estoppel bars Brandon from relitigating issues that previously have been decided against him.

## II. Discussion

We review a district court's dismissal of a complaint under Rule 12(b)(6) *de novo*, "'construing the complaint liberally, accepting all factual allegations in the complaint as true, and drawing all reasonable inferences in the plaintiff's favor.'" *Kim v. Kimm*, 884 F.3d 98, 102–03 (2d Cir. 2018) (quoting *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 152 (2d Cir. 2002)). In addition, we review *de novo* the district court's application of the doctrine of collateral estoppel. *See Hoblock v. Albany Cnty. Bd. of Elections*, 422 F.3d 77, 93 (2d Cir. 2005). Although a defense such as collateral estoppel is normally to be raised as an affirmative defense, *see* Fed. R. Civ. P. 8(c)(1), where "'it is clear from the face of the complaint . . . that the plaintiff's claims are barred as a matter of law,' dismissal under Fed. R. Civ. P. 12(b)(6) is appropriate," *Austin v. Downs, Rachlin & Martin Burlington St. Johnsbury*, 270 F. App'x 52, 53 (2d Cir. 2008) (summary order) (quoting *Conopco, Inc. v. Roll Int'l*, 231 F.3d 82, 86 (2d Cir. 2000)). In the present case this is clear from the amended complaint and its attached exhibits.

The doctrine of collateral estoppel, or issue preclusion, bars parties "from relitigating in a subsequent action an issue of fact or law that was fully and fairly litigated in a prior proceeding." *Marvel Characters, Inc. v. Simon*, 310 F.3d 280, 288 (2d Cir. 2002). Federal law applies in cases where, as here, the preclusive effect of a prior federal judgment is at issue. *See Purdy v. Zeldes*, 337 F.3d 253, 258 n.5 (2d Cir. 2003). Under federal law, "[c]ollateral estoppel applies when: '(1) the identical issue was raised in a previous proceeding; (2) the issue was actually litigated and decided in the previous proceeding; (3) the party [against whom collateral estoppel is being asserted] had a full and fair opportunity to litigate the issue; and (4) the resolution of the issue was necessary to support a valid and final judgment on the merits.'" *Marvel Characters, Inc.*, 310 F.3d at 288–89 (quoting *Boguslavsky v. Kaplan*, 159 F.3d 715, 720 (2d Cir. 1998)). Applying these factors here, we agree with the district court's conclusion that the Florida court's decision against Brandon precludes him from relitigating the question of whether Girl 6 infringed his copyright for Phone Sex.

First, it is undisputed that the instant case involves the same issue as the proceeding in the Southern District of Florida. In the Florida litigation and here, Brandon asserts, in a nearly identical manner, that Girl 6 infringed his copyright registration for Phone Sex. *Compare* App'x at 108, ¶¶ 33–35, *with* App'x at 169–70, ¶¶ 30–32. Second, it is clear that the copyright infringement issue was actually litigated and decided in the Florida litigation. After Brandon filed three amended complaints alleging copyright infringement, the parties in that action briefed that issue extensively in connection with defendants' motions to dismiss. The Florida court then issued a detailed order, dismissing Brandon's Third Amended Complaint and holding that the short phrase "phone sex" is not copyrightable, that Brandon's copyright registration covers only song lyrics, not melody, arrangement, or performance, and that Brandon's supplemental application

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