

David B. Rosenberg (*pro hac vice* motion to be filed)  
ROSENBERG LAW  
18851 NE 29<sup>th</sup> Ave., Suite 1005  
Aventura, FL 33180  
Tel: 305.602.2008  
Fax: 305.602.0225  
david@rosemberglaw.com

Steven M. Lucks  
Zachary W. Silverman  
FISHKIN LUCKS LLP  
277 Broadway, Suite 408  
New York, NY 10007  
Tel: 646.755.9200  
Fax: 973.679.4435  
slucks@fishkinlucks.com  
zsilverman@fishkinlucks.com

Attorneys for Plaintiff James Mtume

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

JAMES MTUME,

Plaintiff,

vs.

SONY MUSIC ENTERTAINMENT,  
INC., a Delaware corporation

Defendant.

Civil Action No.: 1:18-cv-06037

**COMPLAINT AND  
DEMAND FOR JURY TRIAL**

Plaintiff James Mtume, through his undersigned attorneys, files this Complaint for Declaratory Judgment against Sony Music Entertainment, Inc., and alleges:

NATURE OF ACTION

1. This is an action involving ownership interests in the copyrights for sound recordings authored by Plaintiff James Mtume (known professionally as “Mtume”). Defendant Sony Music Entertainment is the successor to the production company that originally acquired the copyright interests to the sound recordings at issue. In July 2015, pursuant to 17 U.S.C. § 203, Mtume served on Defendant a termination notice to reclaim his copyright interests in certain sound recordings that he created between 1978 and early 1983 pursuant to an agreement dated June 24, 1977 between Zembu Productions Inc. and Mtume. The notice served on Defendant and recorded in the U.S. Copyright Office has effective dates starting July 6, 2017.

2. Through this action, Mtume seeks a declaration that the termination notice served on Defendant is valid, and that the termination notice recaptures Mtume’s copyright interests and ownership for all sound recordings contained on the albums at issue on the effective dates of termination identified in the termination notice.

3. The issues presented here are believed to be issues of first impression in that no court has determined whether Section 203 of the U.S. Copyright Act applies to “gap works” which are works that were transferred and/or assigned by an agreement dated before the effective date of the U.S. Copyright Act (January 1, 1978) but not actually created until or after January 1, 1978.

4. In December 2010, the U.S. Copyright Office issued its analysis of gap works under the termination provision of title 17 and concluded that in a case of a grant signed before January 1, 1978, regarding rights in a work not created until after January 1, 1978, or later, such grant cannot be executed until the work exists. U.S. Copyright Office, Analysis of Gap Grants under the Termination Provisions of Title 17, at ii (2010), available at <http://www.copyright.gov/reports/gap-grant-analysis.pdf>. Accordingly, the Copyright Office

amended 37 C.F.R. 201.10 to allow termination notices for “gap works” to be accepted and recorded with the Copyright Office. *Id.* at 1.

5. The Copyright Office acknowledged the need for further resolution of this issue by noting that its “recording of notices of termination of Gap Grants is without prejudice to how a court might ultimately rule on whether any particular document qualifies as a notice of termination within the scope of section 203, consistent with the longstanding practices for all notices of termination recorded by the Office.” Gap in Termination Provisions, 76 Fed. Reg. 32,320 (June 6, 2011), available at <http://www.copyright.gov/fedreg/2011/76fr32316.pdf>.

6. Further, the Copyright Office stated that any dispute over the validity of such a notice of termination “should be settled in the courts (or in Congress, if Congress accepts the Office’s suggestion to enact legislation that will clarify the status of Gap Grants).” *Id.*

#### PARTIES, JURISDICTION, AND VENUE

7. Plaintiff James Mtume (“Mtume”) is an award-winning musician, songwriter, activist, and radio personality. Mtume is a resident of Essex County, New Jersey.

8. Defendant Sony Music Entertainment, Inc. (“Defendant” or “Sony Music”) is a corporation organized and existing under the laws of the State of Delaware with its principal place of business at 25 Madison Avenue, New York, New York. Defendant produces, manufactures, distributes, and markets prerecorded music, among other things.

9. This is a declaratory judgment action arising under the Declaratory Judgment Act, 28 U.S.C. § 2201 and §2202. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 and §1338(a) as this action arises under the U.S. Copyright Act of 1976, as amended, 17 U.S.C. § 101 et. seq., more specifically dealing with 17 U.S.C.A. §203 and §204A.

10. Jurisdiction over Defendant is proper because Defendant maintains its principal place of business in this Judicial District.

11. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and 1400(a) because a substantial part of the events giving rise to the claim occurred in the Southern District of New York.

#### FACTUAL BACKGROUND

##### **A. The Creation of the Sound Recordings at Issue and the Assignment to Defendant as successor to CBS Records, Inc.**

12. On or about June 24, 1977, Mtume entered into a recording contract with Zembu Productions, Inc. in New York. The 1977 Agreement was not a work for hire agreement.

13. Pursuant to the 1977 Agreement, Mtume agreed to render, on an exclusive basis, his services as a recording artist, and to deliver to Zembu Productions long playing (LP) record albums consisting of master recordings embodying Mtume's musical performances.

14. As part of the 1977 Agreement, Mtume granted to Zembu Productions all rights of copyright to Mtume's master recordings made during the term of the Agreement.

15. In exchange for his copyright grant, Mtume retained a contractual right to receive and to collect royalties on the sales of his recordings.

16. At issue in this action are the master recordings that Mtume composed and recorded under the 1977 Agreement that are contained on two LP record albums and one single record album that were first released to the public by Epic Records.

17. Mtume's first LP album, entitled, "Kiss the world goodbye," was released in the United States in May, 1978 and produced the following songs recorded by Mtume: (a) Theme (for the people) (Opening); (b) Just Funnin'; (c) Kiss this world goodbye; (d) Insert; (e) The Closer I get to you; (f) Love lock; (g) Funky constellation; (h) Closer to the end; (i) Metal flake

mind; (j) Phase I; (k) Day of the reggin; (l) This is your world; (m) Theme (for the people); (n) Exit. The above-listed songs are collectively referred to as the “First Album”.

18. On July 14, 1978, a single copyright registration for all of the sound recordings contained on the First Album (SR0000002379) was secured by CBS Inc. or its predecessor.

19. On August 27, 1979, Zembu Productions assigned the 1977 Agreement to CBS Records, Inc.

20. Mtume’s second LP album entitled “In search of the rainbow seekers” was released in the United States in 1980 and produced the following songs recorded by Mtume: (a) Give it on up (if you want to); (b) You can’t wait for love; (c) She’s a rainbow dancer; (d) We’re gonna make it this time; (e) Dance around my navel (doesn’t have to make sense, just cents); (f) So you wanna be a star; (g) Spirit of the dance; (h) Anticipatin’; (i) Everything good to me; (j) Mrs. Sippi. The above-listed songs are collectively referred to as the “Second Album”.

21. Through the 1977 Agreement, and as assigned to CBS Records, Mtume granted CBS Records ownership of the above master recordings and the all rights of copyright to the master recordings for Mtume’s Second Album.

22. On November 6, 1980, CBS Inc. secured a single copyright registration for all of sound recordings contained in the Second Album (SR00000023362).

23. In early 1983, Mtume recorded a song entitled “Juicy Fruit: pt. 2 (reprise); Juicy Fruit” that was released in the United States in February that same year.

24. Through the 1977 Agreement, and as assigned to CBS Records, Mtume granted CBS Records ownership of the above master recording and the all rights of copyright to Mtume’s master recording of this song.

25. On May 23, 1980, CBS, Inc. secured a copyright registration for “Juicy Fruit: pt. 2 (reprise); Juicy Fruit” (SR0000044844).

26. On or about October 21, 1983, CBS Records, Inc. and Mtume entered into a new artist agreement that terminated the 1977 Agreement, as amended by assignment to CBS Records. The 1983 Agreement has nothing to do with the rights granted under the 1977 Agreement.

27. In 1987, CBS Records, Inc. was acquired by Sony Music Entertainment, Inc. As a result, Defendant became the successor in interest to CBS Records, Inc. with respect to Mtume’s 1977 Agreement, and copyright interests in the sound recording created under that agreement.

**B. The Termination Notice**

28. On July 9, 2015, Mtume served on Defendant a termination notice pursuant to 17 U.S.C. § 203 to reclaim his copyright interests in the sound recordings at issue. A copy of the termination notice is attached as **Exhibit A**. The termination notice was subsequently recorded in the Copyright Office on November 13, 2015. *Id.*

29. The termination notice covers: (a) the First Album title “Kiss the world goodbye,” Reg. No. SR0000002379, with a termination effective date of July 6, 2017; (b) the Second Album title “In search of the rainbow seekers”, Reg. No. SR0000023362, with a termination effective date of September 12, 2017; and (c) the single recording title “Juicy Fruit: pt. 2 (reprise); Juicy Fruit”, Reg. No. SR0000044844, with a termination effective date of April 23, 2018.

**C. The Present Dispute**

30. Defendant waited nearly *two years before responding* to Mtume’s termination notice. In a letter dated July 21, 2017 – *more than 2 weeks after the effective date of termination* for Mtume’s First Album title “Kiss the world goodbye,” Defendant contested the effectiveness of the termination notice and disputed Mtume’s termination rights to the sound recordings in the First Album. A copy of Defendant’s July 21<sup>st</sup> letter is attached as **Exhibit B**.

31. Defendant sent a second letter dated September 11, 2017 – *one day prior to the effective date of termination* for Mtume’s Second Album title “In search of the rainbow seekers”—again contesting the effectiveness of the termination notice and disputing Mtume’s terminations rights to the sound recordings in the Second Album. A copy of Defendant’s September 11<sup>th</sup> letter is attached as **Exhibit C**.

32. Defendant sent a third letter dated April 19, 2018 – *four days prior to the effective date of termination* for Mtume’s single recording title “Juicy Fruit: pt. 2 (reprise); Juicy Fruit” contesting the effectiveness of the termination notice and disputing Mtume’s terminations rights for this single recording. A copy of Defendant’s April 19<sup>th</sup> letter is attached as **Exhibit D**.

33. Through its letter correspondence, Defendant maintains that Mtume’s July 2015 termination notice is ineffective for several reasons, including: (a) the recordings at issue are allegedly works made for hire; (b) the recordings at issue are not subject to termination pursuant to Section 203 because they were created pursuant to a grant contained in a 1977 agreement; (c) there may be additional potential authors other than Mtume whose grants were not noticed for termination; and (d) the termination notice relating to the First and Second Albums purportedly seeks only to terminate the copyright in and to the compilation of tracks on the album, and not the individual sound recordings that appear on the albums.

34. Mtume disputes each of Defendant's frivolous assertions and its refusal to acknowledge the validity of the July 2015 termination notice. Accordingly, Mtume brings this declaratory judgment action to resolve the parties' dispute regarding the validity of the termination notice and the parties' respective rights in the copyrights to the sound recordings at issue.

**COUNT I**  
**Declaratory Relief Regarding Copyright Termination**  
**(Pursuant to 28 U.S.C. §§ 2201, et seq. and 17 U.S.C. § 203)**

35. Mtume repeats and reincorporates by reference the allegations in Paragraphs 1 to 34 of the Complaint as if fully set forth herein.

36. This claim arises under the declaratory judgment provision of 28 U.S.C. § 2201 and § 2202 and under the Copyright Laws of the United States, 17 U.S.C. §§ 101 et. seq.

37. An actual and justifiable controversy exists sufficient for this Court to declare the rights and remedies of the parties in that there is a dispute between Mtume and Defendant concerning their respective rights and interests in the pre and post-termination U.S. copyrights in the sound recordings at issue.

38. Mtume seeks a declaration from this Court that the sound recordings at issue that were created pursuant to a grant contained in a 1977 agreement are terminable pursuant to Section 203 of the Copyright Act.

39. Mtume further seeks a declaration from this Court that the July 2015 termination notice is valid and complies in all respects with the provisions of 17 U.S.C. § 203 and related federal regulations for terminating all sound recordings at issue.

40. Mtume seeks a declaration from this Court that the sound recordings at issue were not created pursuant to a work-for-hire agreement.

41. Mtume further seeks a declaration from this Court that he is the sole copyright owner of the recordings at issue, and thus he recaptures the copyrights therein upon the respective effective dates set forth in the termination notice.

**COUNT II**  
**Accounting**

42. Mtume repeats and reincorporates by reference the allegations in Paragraphs 1 to 34 of the Complaint as if fully set forth herein.

43. Defendant has been and is engaged in the active exploitation of sound recordings at issue.

44. Defendant has the sole and exclusive control over the books and records that establish the applicable amounts of revenue on which royalties for the sound recordings at issue are to be calculated.

45. Based upon Defendant's position of exclusive control over the books and records, Defendant owes Mtume a duty to account and pay all royalties due.

46. Upon information and belief, Defendant has not properly accounted to Mtume for royalties earned on the sound recordings at issue post-termination.

47. An accounting is necessary because Defendant has erroneously failed to recognize termination, must account to Mtume for all income derived from exploitation of the sound recordings at issue from and after the effective dates of termination.

48. An accounting is also necessary and appropriate under the circumstances since the precise amount of money that is due to Mtume is unknown and cannot be ascertained without an accounting.

**WHEREFORE**, Mtume respectfully requests that the Court grant the following relief:

- A. A declaration that the sound recordings at issue are terminable pursuant to Section 203 of the Copyright Act;
- B. A declaration that the July 2015 termination notice is valid and complies in all respects with the provisions of 17 U.S.C. § 203 and related federal regulations for terminating all sound recordings at issue;
- C. A declaration that the sound recordings at issue were not created pursuant to a work-for-hire agreement;
- D. A declaration that James Mtume is the sole copyright owner of the sound recordings at issue, and thus he recaptures the copyrights therein upon the respective effective dates set forth in the termination notice;
- E. An accounting of all post-termination income;
- F. An award of the attorneys' fees and costs incurred by James Mtume in this action;
- G. Such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff demands a trial by jury of all issues triable in this action.

Dated: New York, NY  
July 3, 2018

*s/ Steven M. Lucks*

---

Steven M. Lucks  
Zachary W. Silverman  
FISHKIN LUCKS LLP  
277 Broadway, Suite 408  
New York, NY 10007  
Tel: 646.755.9200  
Fax: 973.679.4435  
slucks@fishkinlucks.com  
zsilverman@fishkinlucks.com

David B. Rosemberg (*pro hac vice* motion  
to be filed)  
ROSEMBERG LAW  
18851 NE 29<sup>th</sup> Ave., Suite 1005  
Aventura, FL 33180  
Tel: 305.602.2008  
Fax: 305.602.0225  
david@rosemberglaw.com

Attorneys for Plaintiff James Mtume