

**Tufamerica, Inc. v EMI Unart Catalog, Inc.**

2016 NY Slip Op 31705(U)

September 9, 2016

Supreme Court, New York County

Docket Number: 651197/11

Judge: Shlomo S. Hagler

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SUPREME COURT OF THE STATE OF NEW YORK  
COUNTY OF NEW YORK: IAS PART 17

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TUFAMERICA, INC.,

Plaintiff,

Index No.: 651197/11

Motion Seq. No.: 002

-against-

EMI UNART CATALOG, INC.,

Defendant.

**DECISION & ORDER**

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HON. SHLOMO S. HAGLER, J.S.C.:

Defendant EMI Unart Catalog, Inc. (“EMI” or “defendant”)<sup>1</sup> moves for summary judgment dismissing the complaint. Plaintiff Tufamerica, Inc. (“Tufamerica” or “plaintiff”) opposes the motion.

Background

Tufamerica and EMI are music publishing companies. In this action, Tufamerica alleges that EMI has misappropriated the rights to seven music compositions written or co-written by the late George Patterson, Jr. (“Patterson”) (Notice of Motion, Exhibit “14” [Complaint] at ¶ 1). Plaintiff has asserted causes of action against defendant for conversion (“first cause of action”), unjust enrichment (“second cause of action”), unfair competition (“third cause of action”), misappropriation (“fourth cause of action”) and for a declaratory judgment (“fifth cause of action”). Plaintiff essentially alleges that it is entitled to the revenue received by defendant in connection with defendant’s “exploitation” of the subject songs (*Id* at ¶¶ 19-20, 24, 29, 32, 36,

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<sup>1</sup>Originally named in the Complaint as defendants are EMI Music, Inc., and EMI Music Publishing (Notice of Motion, Exhibit “14” [Complaint]). Defendant avers that there is no legal entity known as EMI Music Publishing, and that it is not a division of EMI Music, Inc. Defendant states that “the parties have agreed that the proper defendant in this case is EMI Unart Catalogue, Inc.” (Notice of Motion, Exhibit “14” [Answer] at ¶ 3; Notice of Motion [Affidavit of Audrey Ashby], fn. 1). Plaintiff has not opposed this contention and in fact, the caption on all its opposition motion papers names EMI Unart Catalogue, Inc. as the defendant.

38).

Tufamerica bases its claims on an agreement that it allegedly executed with Patterson on February 7, 2001 (the “2001 Agreement”) which provides, in pertinent part, as follows:

“3 Patterson hereby conveys and assigns, in perpetuity, to [Tufamerica] fifty (50%) percent of [his] ownership interest and all worldwide copyright in and to the musical compositions and sound recordings which Patterson has been involved in including but not limited to those listed in schedules ‘A’ and ‘B’ . . .” (Notice of Motion, Exhibit “1”).

Schedule “A” to the 2001 Agreement lists compositions, including the subject songs:

“Can’t Stand the Heat,” “Mystery Woman,” “Mississippi Foxhole,” “Flight to Freedom,” “Lost for Words,” “Blackenstein,” and “Party” (*Id.*).

In support of its motion, EMI argues that it and its predecessors-in-interest have continuously co-owned the copyrights of the songs and owned exclusive administrative rights since 1973. By agreement, dated May 4, 1973, Patterson through his company Dimpaco Productions, Inc. (“Dim Paco”) conveyed co-ownership of the copyrights and exclusive administration rights of the subject songs to Kama Sutra Music, Inc.” (“Kama Sutra”) (Notice of Motion, Exhibit “12”; Notice of Motion, Affidavit of Audrey Ashby [Ashby Affidavit] at ¶¶ 18-22) (the “1973 Agreement”).<sup>2</sup> Schedule “B” of the 1973 Agreement provides, in pertinent part,

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<sup>2</sup>Kama Sutra was the publishing arm of Buddah Records, which had a recording agreement with Patterson and Dim Paco. After discovery was complete but before the Note of Issue was filed (on March 27, 2015), EMI obtained the 1973 Agreement from Sony Music Entertainment, which had acquired the Buddah Records catalogue. The 1973 Agreement included both a recording agreement and a songwriter agreement (the songwriter agreement established copyright and administration rights as between Dim Paco and Kama Sutra). The recording agreement is not at issue in the instant matter (Notice of Motion, Exhibit “12”). Defendant submits proof that by email, dated March 18, 2015, it notified plaintiff of its acquisition of the 1973 Agreement, and subsequently exchanged it with plaintiff by email on April 16, 2015 (Reply Affirmation, Exhibits “21” and “22”). Plaintiff’s allegation that defendant “withheld” the 1973 Agreement, and as such, this Court should disregard the agreement or allow

as follows:

"3. We [Dim Paco] hereby bargain, sell, assign, set over and transfer unto you [Kama Sutra], your successors and assigns, an undivided ONE-HALF (½) [sic] FIFTY (50%) PERCENT interest in and to said musical compositions and all copyrights therein throughout the world, including the right to obtain copyrights therein in our joint names throughout the world. We agree to execute any documents necessary to perfect such interest in and to said musical composition [sic] in both our names. You [Kama Sutra] shall have the sole and exclusive right during the term of this agreement to administer and protect the composition [sic] and you [Kama Sutra] shall have the sole right to designate all persons, firms or corporations to administer the compositions in any and all areas throughout the world; to collect all income from whatever source, which is due and owing to the Publisher of the compositions; to enter into agreements with said persons, firms or corporations, to sub-publish or otherwise deal with the compositions on the customary and standard sub-publication terms, and to make and grant any and all agreements, assignments and licenses with regard to the exploitation of the compositions and the rights therein, and to do any and all other acts which a copyright proprietor traditionally has the right to do.

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7. The term of this Agreement shall be for the full term of the copyright throughout the world, in and to the compositions, including renewals and extensions thereof, to the extent owned or controlled by you [Kama Sutra] or us [Dim Paco] (Notice of Motion, Exhibit "12" at 00170)."

EMI has also provided copies of the original copyright registrations of each of the subject compositions (Notice of Motion, Exhibits "2-8") showing Kama Sutra to be co-owner of the songs.<sup>3</sup> EMI argues that through a chain of title, EMI is the successor-in-interest to the rights

further discovery, is unavailing (Plaintiff's Memorandum of Law in Opposition, at 2). In any event, plaintiff's request for further discovery at this juncture is waived as it raised no objections or sought further discovery until filing its opposition to this motion.

<sup>3</sup>The copyright registrations show that co-owners of the songs were Kama Sutra and Dim Paco, except that the co-owners of the copyright for the songs "Blackenstein" and "Party" were Kama Sutra and Elmac Music. Karma Sutra purportedly became a co-owner of the copyrights in the songs in 1974, except became a co-owner of the copyright to the song "Flight to Freedom in 1973.

granted to Kama Sutra in the 1973 Agreement. EMI avers that “EMI cannot have converted or misappropriated rights that it already owns” (Defendant’s Memorandum of Law at 5).

### Discussion

#### Summary Judgment

“The proponent of a motion for summary judgment must demonstrate that there are no material issues of fact in dispute, and that it is entitled to judgment as a matter of law” (*Dallas-Stephenson v Waisman*, 39 AD3d 303, 306 [1<sup>st</sup> Dept 2007], citing *Winegrad v New York Univ. Med. Ctr.*, 64 NY2d 851, 853 [1985]). Upon proffer of evidence establishing a *prima facie* case by the movant, “the party opposing a motion for summary judgment bears the burden of ‘produc[ing] evidentiary proof in admissible form sufficient to require a trial of material questions of fact’” (*People v Grasso*, 50 AD3d 535, 545 [1<sup>st</sup> Dept 2008], quoting *Zuckerman v City of New York*, 49 NY2d 557, 562 [1980]). In considering a summary judgment motion, evidence should be “viewed in the light most favorable to the opponent of the motion” (*People v Grasso* 50 AD3d at 544 [internal citation omitted]).

#### Determination

At oral argument held on October 26, 2015, this Court granted defendant’s motion for summary judgment dismissing plaintiff’s complaint without opposition insofar as plaintiff alleges misappropriation by defendant of two of the subject music compositions known as “Blackenstein” and “Party” (Tr. of Oral Argument at 5).<sup>4</sup>

However, EMI has failed to make a *prima facie* showing that it owns the exclusive

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<sup>4</sup>It is undisputed that Patterson or Dim Paco had no interest in these songs, and thus could not have transferred any rights thereto (Tr. of Oral Argument at 4; Affidavit of Audrey Ashby at 11).

administrative rights and is the co-owner of the copyrights to the remaining five subject songs (the "Songs"). In its motion, defendant failed to submit a complete set of assignment documents demonstrating chain of title to the subject Songs from Patterson and Dim Paco to EMI, and only submitted further assignment documentation in reply. In any event, the chain of title, even taking into account the evidence provided in reply, is far from clear and is difficult to discern as it relates to the subject Songs. This Court requires a flow chart with documentary support demonstrating a clear chain of title of the copyrights and administration rights to the five remaining Songs at issue.

Conclusion

On the basis of the foregoing, it is

ORDERED, that defendant's motion for summary judgment is granted only insofar as defendant seeks to dismiss plaintiff's claims with regard to music compositions known as "Blackenstein" and "Party", and is otherwise denied without prejudice to renew; and it is further

ORDERED, that the Clerk is directed to enter judgment accordingly.

Dated: September 9, 2016

ENTER:



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J.S.C.

**HONORABLE J. S. C.**