

Usher's Still in the Clear in Copyright Suit

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The Third Circuit Court of Appeals recently affirmed the dismissal on summary judgment of copyright infringement claims brought by Daniel Marino (not that Dan Marino) against Usher and nineteen other defendants in *Marino v. Usher*. The decision underscores the bedrock principle that joint authors cannot sue their co-authors for copyright infringement and serves as a cautionary tale for joint authors, illustrating how *not* to vindicate their rights when their joint work has been licensed without their authorization.

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Marino was part of a songwriting trio with defendants Dante Barton and William Guice that co-wrote a song called “Club Girl” in 2001. Barton successfully shopped the song to the music industry, and landed a licensing deal with Usher’s representatives. “Club Girl” was re-worked with Marino’s assistance, recorded, renamed “Bad Girl” and released to the public on Usher’s 2004 album “Confessions.”

As the district court noted, Marino’s problems arose from entrusting the trio’s business affairs to Dante Barton. When Mr. Barton copyrighted “Club Girl,” he did not include Marino as an author. And when Mr. Barton negotiated the licensing agreement with Usher, Marino was named only as a musician, not as a songwriter. So when “Bad Girl” was released, Marino was not credited as a songwriter, and he never received any songwriting royalties.

After waiting several years, Marino sued Usher, the other members of the songwriting trio and seemingly every other entity affiliated in any way with “Bad Girl,” asserting myriad claims including direct, vicarious and contributory infringement. He also sought an accounting and a constructive trust. Ultimately, all the causes of action against all of

the defendants were dismissed on various grounds at various times. Marino appealed all of these orders, in addition to many other unappealable orders of the district court.

With the benefit of hindsight, it is surprising that the case lasted as long as it did, because Marino admitted from the start that he, Barton and Guice were joint authors of “Club Girl.” As a joint author, Marino could not sue Barton or Guice for copyright infringement. And it follows that there could be no vicarious or contributory infringement by the other defendants in the absence of an underlying direct infringement. These principles are straightforward, and the district court called Marino’s arguments to the contrary “absurd.”

Also, as a joint author, Marino’s consent was not required for Barton to license the song to Usher. Contrary to Marino’s claims, the licensing of “Club Girl” to Usher on an exclusive basis without Marino’s consent did not invalidate the license; rather, it transformed it into a non-exclusive license. Because Usher and his representatives were operating under a valid license and within its scope, they could not be liable for any direct infringement. The Court also found that Marino himself granted an implied license by assisting Usher and his representatives in creating “Bad Girl” from “Club Girl.”

Finally, although Barton was legally permitted to license “Club Girl” without Marino’s consent, he still would have been required to account to Marino for any profits earned from licensing “Club Girl.” But Marino’s accounting and constructive trust claims were not properly pleaded, so they were preempted by the Copyright Act. Marino based his accounting and constructive trust claims on the alleged underlying infringement. By doing so, he subsumed those claims within his infringement claims, which led to their preemption.

The lesson here, and what Marino could have done (and what he belatedly tried to do) was to assert accounting and constructive trust claims not based on the underlying infringement, but rather based on the profits earned by Guice and Barton from licensing “Club Girl.” These claims would not have run afoul of the laws applicable to joint authorship because they would not have challenged the basis for Guice and Barton earning profits from “Club Girl” in the first place, but instead would have asserted Marino’s valid right to share in those profits.

There may have been practical reasons why Marino did not choose this course. The accounting and constructive trust claims could not have been brought against the deep-pocketed (and famous) defendants, because licensees have no duty to account to joint authors for lost profits earned by the joint authors with whom they contract. Also, state law accounting and constructive trust claims would not have provided the same potential for the recovery of attorneys’ fees. But these decisions harmed Marino even more in the end. Due to the frivolity of his claims, he was assessed over one million dollars in defendants’ attorneys’ fees (an amount that was eventually reduced by ninety percent due to his financial condition).

Going forward, joint authors who feel wronged by their co-authors would be wise to understand the broad scope of permissible activities in which joint authors can engage

with respect to the joint work, and the restrictions inherent in seeking to right those wrongs through the Copyright Act, as opposed to more traditional remedies.