

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

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COMERICA BANK & TRUST, N.A. as))	
Personal Representative of the Estate of))	
Prince Rogers Nelson,))	
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Plaintiff,))	
))	
v.))	Civil No. 17-12418-LTS
))	
KIAN ANDREW HABIB,))	
))	
Defendant.))	
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ORDER ON CROSS MOTIONS FOR SUMMARY JUDGMENT (DOC. NOS. 77, 84)

January 6, 2020

SOROKIN, J.

This federal copyright law case concerns several audiovisual recordings of the now-deceased international superstar Prince Rogers Nelson (“Prince”) performing his own musical compositions live in concert. Plaintiff Comerica Bank & Trust, N.A., in its capacity as the appointed Personal Representative of Prince’s Estate (“Comerica”), alleges that several videos recorded and uploaded to YouTube by Defendant Kian Andrew Habib (“Habib”) constitute copyright infringement under 17 U.S.C. § 501 and violate the civil anti-bootlegging statute, 17 U.S.C. § 1101. Doc. No. 27 at 4-5. In response, Habib raises multiple defenses to Comerica’s two claims and counterclaims that takedown notices sent on behalf of Comerica to YouTube were “knowingly, material misrepresent[at]ions” in violation of 17 U.S.C. § 512(f). Doc. No. 30. For the following reasons, Comerica’s Motion for Partial Summary Judgment (Doc. No. 77) is ALLOWED IN PART and Habib’s Cross Motion for Summary Judgment (Doc. No. 84) is DENIED.

I. BACKGROUND¹

Prince is one of the best-selling musical artists of all time. Doc. No. 81-7 at 2 (representing that Prince has sold over 100 million records worldwide). A virtuosic performer and prolific songwriter, Prince crafted a unique amalgam of funk, rock, rhythm and blues, and soul, yielding chart-topping studio recordings and electrifying live shows. Id.; see also Press Release, The White House, Statement by the President on the Passing of Prince (Apr. 21, 2016), <https://obamawhitehouse.archives.gov/the-press-office/2016/04/21/statement-president-passing-prince> (“He was a virtuoso instrumentalist, a brilliant bandleader, and an electrifying performer.”). Over the course of his 38-year career, Prince also earned a reputation as a musician who demanded control over the release and use of his music, “enforc[ing] his intellectual property rights aggressively” to achieve that end. Doc. No. 81-7 at 2-3 (noting that Prince “employed staff whose sole task was to send take-down notices to [alleged] online infringers”).

After Prince’s untimely April 21, 2016 death, Comerica was appointed Personal Representative of Prince’s Estate and assumed its current role as a “fiduciary charged with monetizing and protecting the Estate’s intellectual property for the benefit of [Prince’s] heirs.” Doc. No. 83 at 2. In that capacity, Comerica now operates an official Prince YouTube channel, which includes live concert videos. Id. at 4. According to Comerica, the official Prince YouTube channel has yielded “well over \$1 million” in revenue for the Estate. Id. Given the YouTube channel’s success, Comerica “expects to monetize additional [Prince] concert videos in the future.” Id.

¹ Unless specifically noted, these facts are undisputed.

As Comerica aims to maximize the impact of the official Prince YouTube channel, it also “makes a concerted effort to identify and remove unauthorized Prince videos on other channels” that might divert interest and revenue away from the Estate. Id. at 5. To that end, from March 2017 to March 2019, Comerica utilized the services of MarkMonitor, which deploys a “proprietary software [that] scours the internet for potential infringements of [] clients’ trademarks and copyrights” and employs “experienced analyst[s]” who then review potential infringements before further action is taken. Doc. No. 81-8 ¶¶ 2, 5. Over the course of those two years, MarkMonitor “sent over 2,800 takedown notices” to YouTube on behalf of the Estate. Id. ¶ 4.

Five of those notices were sent in response to videos uploaded by Habib—the recordings at issue in this case. Id. ¶ 11. Habib filmed those recordings from his vantage point as an audience member at two different Prince performances, a December 27, 2013 concert at the Mohegan Sun Arena in Connecticut, and a May 23, 2015 concert at the Bell Centre in Montreal. Doc. No. 30 at 6-7. Habib concedes he did not have express authorization from Prince to record any portion of either performance. Doc. No. 110 ¶ 20.² Habib later uploaded five discrete portions of the two performances on YouTube: First, on February 28, 2014, Habib uploaded a 2 minute and 49 second audiovisual clip of Prince performing the song “Glam Slam” at the Mohegan Sun Arena, Doc. No. 30 at 7; next, on April 25, 2016, Habib uploaded a 4 minute and 48 second video including Prince’s performance of “Nothing Compares 2 U” at the Mohegan Sun Arena concert, id.; finally, on May 24, 2016, Habib uploaded (1) a 2 minute and 23 second video of Prince performing the song “Guitar” live in Montreal, Doc. 80-8 at 35, (2) a 2 minute

² Habib does contend that Prince granted Habib an “implied license” to record and post the performances, citing a 2014 BBC article with statements attributed to Prince. See infra Part III.A.2.

and 25 second video of Prince performing the song “Take Me With U” in concert in Montreal, Doc. No. 30 at 8, and (3) a 3 minute and 25 second video of Prince performing the songs “Sign o’ the Times,” “Most Beautiful Girl in the World,” and “Hot Thing,” id.

These five audiovisual recordings—fairly described as “grainy,” “blurry,” and “poor quality”—each contain significant and recognizable portions of six musical compositions that Prince composed and registered with the United States Copyright Office. Doc. Nos. 78-1–78-8 (providing copies of U.S. Copyright Office Registration Certificates for “Nothing Compares 2 U,” “Take Me With U,” “Glam Slam,” “Sign o’ the Times,” “The Most Beautiful Girl in the World,” and “Hot Thing”).³ For example, Habib’s audiovisual recording of “Nothing Compares 2 U” begins in the middle of the first verse of the song and continues until the end of the composition. Doc. No. 79-3 (Habib’s video on file with the Court); Doc. No. 81-6 (highlighting the substantial portion of the song’s lyrics captured by Habib’s video). In each video, the camera is focused on Prince and his band, with Habib intermittently panning between the stage and a jumbotron screen that magnified the featured performers. See, e.g., Doc. No. 79-3; Doc. No. 79-6 (videos of “Nothing Compares 2 U” and “Sign o’ the Times” on file with the Court). The parties do not dispute that Habib did not alter any aspect of the musical performances or the visuals captured by his recordings before he uploaded the videos to YouTube. Doc. No. 80-8 at 32; Doc. No. 81-4 at 22 (“I didn’t add anything to the music or anything.”). In addition, the parties do not dispute that Habib’s videos do not capture any spoken commentary and merely

³ While the parties do not dispute that Prince also composed the song “Guitar,” Comerica does not have in its possession the copyright registration that likely encompasses that song. See Doc. No. 81-9; Doc. No. 78-9. Comerica notes that it is not asserting a copyright infringement claim based on Habib’s use of “Guitar.” Doc. No. 83 at 7 n.2. However, Comerica does assert that Habib’s video of “Guitar” violated the anti-bootlegging statute, 17 U.S.C. § 1101. Id.

feature Prince’s “spontaneous interactions with his fellow band members and the audience, as well as the singing of the crowd.” Doc. No. 108 at 7.

Habib uploaded the five videos to the “PersianCeltic” YouTube channel that he operates. Doc. No. 110 at 11. When he did so, Habib gave titles to the various videos, see Doc. No. 83 at 6 (including titles like “Prince – Nothing Compares 2 U – Amazing LIVE rare performance – 2013” and “Prince showing off all his talents! LIVE at Mohegan Sun, Connecticut 2013”), but did not otherwise include any written commentary or criticism. Additionally, the parties do not dispute that Habib’s “PersianCeltic” YouTube page included an “About” section that described his channel as containing “[e]clectic” and “awesome content,” and encouraged YouTube users to “subscribe and comment.” Doc. No. 80-7. As of November 6, 2018, Habib’s channel had received 405,336 views, including thousands of views for each of the videos at issue in this case. Id.; Doc. No. 80-3.

In 2017, MarkMonitor identified Habib’s videos as potentially infringing Prince’s musical composition copyrights. Doc. No. 81-8 at 4. According to Erika Vergara, Client Services Manager at MarkMonitor, after Habib’s five videos were flagged as potentially infringing, “a MarkMonitor analyst watched the videos and applied [the company’s] standard practices, including an assessment of fair use.”⁴ Id. After concluding that the videos were infringing, MarkMonitor then sent takedown notices to YouTube on Comerica’s behalf for each of Habib’s five videos. Id.⁵

⁴ “Fair use,” as discussed at length below, is an affirmative defense to copyright infringement. 17 U.S.C. § 107.

⁵ This was not the first time that Habib had received notice that videos uploaded to his YouTube channel might contain infringing material. In fact, several other copyright owners—including copyright owners of songs performed by the rock band Arcade Fire and the pop star Miley Cyrus—had previously issued Content ID claims regarding Habib’s videos of live musical

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